

SHOOSMITHS

Trade Marks at Shoosmiths

2023

Our Approach

Let's start with the important question; how do you want it to work? You will have trade mark experts and first class portfolio management at your fingertips. That's a given. But beyond that, how much you need from us is up to you. We can manage your portfolio for you and provide advice as and when you need it. We can work with your marketing team to provide targeted training on brand adoption and development. We can work with your management teams to adopt a commercially appropriate trade mark protection strategy. We can work with your finance teams to make estimating and budgeting a simple process. We can report, search, watch, file, advise and defend in a way that works for you.

Tell us how you want it to work, and we will make it happen.

KEY ASPECTS OF OUR APPROACH TO TRADE MARKS INCLUDE:

Fixed Fee Billing – Much of our trade mark provision can be provided on a fixed fee basis, providing you with clarity and transparency on costs, with no surprise bills. Take a look at the incorporated fixed fee schedules at pages 3 to 8 which provide an idea of the range of services we can provide on a fixed fee basis.

Document Access – We can store your key electronic documents, such as certificates of registration and renewal on our electronic database. We can also work with you to store key pieces of evidence, for example we can build up a bank of documentation demonstrating the use of your trade marks, such that information and evidence is available at the touch of a button should you ever be required to defend your rights.

Initial Free Trade Mark Watch – You will enjoy a free 6 month trade mark watch in respect of any new trade marks, enabling you to form a view on the benefit of the service before agreeing to costs. Following the free period, we will advise you of the proposed fixed cost for continuing the service, providing you with clarity and transparency on moving forward with the service.

Trade Mark Searching – We will work with you to develop a trade mark searching structure which meets your business and commercial needs.

Clear Reporting – We will work with you to develop a reporting method that meets your needs, whether this is on an as you go basis, or a more regular monthly reporting system.

Health Check – We can work with you and your knowledge of your business, using our expertise and experience gained over years of working with trade mark portfolios of all shapes and sizes, to provide a gap analysis of your current trade mark protection and to develop a trade mark protection and maintenance strategy that works for you.

Prior rights search

Usually, we advise clients that we should perform a "prior rights" search in the UK to look for possibly conflicting marks before an application is made, at an estimated cost of £750 (+VAT) *per mark for 1-5 classes* and this takes around four working days to produce. This lessens the risk that your application will encounter an insurmountable opposition from an unknown earlier rights holder and be refused registration with the loss of your filing fees. However, you may not wish us to perform this search and save the expense, in which case we would just file the application in the absence of a prior rights search bearing in mind the greater risk of refusal due to earlier marks and infringement of earlier marks. We can discuss this further if you wish.

The estimated cost to perform a "prior rights" search in the EU is £750 (+VAT) *per mark for 1-5 classes* and this takes around four working days to produce.

Therefore, if you wish to search both the UK and EU then this would be £1,500 (+VAT).

Please note - EU Trade Marks are included in the EU search, but it doesn't include national marks in every EU Member State (such as German or French Trade Marks for instance) – if this is needed it is £7,500 (+VAT). However, most client's forego this based on cost. Therefore, unless you instruct us otherwise, we shall assume that you wish to forego this EU national search based on cost.

Simple Summary of Costs

Please find below a summary for the estimated cost of performing prior rights searches in the UK and EU and filing trade marks in the UK and EU.

Estimated costs of registration in the UK

The estimated cost of registering a trade mark in the UK in one class only is £1,050 (+VAT) to file the application and prosecute it to registration, in the absence of any objections or oppositions (resolving these will be charged at our hourly rate if encountered).

If more than one class is required this is estimated to cost an extra £150 (+VAT) per class.

Estimated costs of registration in the EU

The estimated cost of registering a trade mark in the EU in one class only is £1,950 (+VAT) to file the application and prosecute it to registration, in the absence of any objections or oppositions (resolving these will be charged at our hourly rate if encountered).

If more than one class is required this is estimated to cost an extra £250 (+VAT) per class.

FIXED FEES - UK TRADE MARKS

FIXED FEES - UK Trade Marks
Description
Pre-filing searches
UK Trade Mark Search
Applications
UK Trade Mark Application in first class
Prosecuting application to registration*
Each additional class
Claiming priority
Series marks, per additional series
Transactions
Recordal of change of owner (excluding preparation of assignment document)
Drafting assignment document to assign one or more UK Trade Marks from the same owner for first 5 marks
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 marks when owned by the same owner
Recordal of change of name or address
Request for certified copy of a UK Trade Mark
Renewals
UK Trade Mark Renewal in first class
Each additional class
Late renewal

* these costs are fixed in all cases where no official objections, oppositions or other problems are encountered (resolving these will be charged at our hourly rate if encountered). However, if any of these events are encountered, we can give you a realistic estimate for any work needed. Lastly, to give clarity to our clients in respect of invoicing we invoice both the filing fees and prosecution fees at the time of filing the application in the assumption that no problems will be encountered with the application.

FIXED FEES - EU TRADE MARKS

FIXED FEES - EU Trade Marks
Description
Pre-filing searches
EU Trade Mark search (only for EU-wide Trade Marks, not including all Member States) Search for national marks in every EU Member State (such as German or French Trade Marks for instance) for first 3 classes**
Applications
EU Trade Mark Application in first class Prosecuting application to registration* Each additional class Claiming priority
Transactions
Recordal of change of owner (excluding preparation of assignment document) for first 5 marks Drafting assignment document to assign one or more UK Trade Marks from the same owner for first 5 marks Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 marks when owned by the same owner Recordal of change of name or address Request for certified copy of a EU Trade Mark
Renewals
EU Trade Mark Renewal in first class Each additional class Late renewal

* these costs are fixed in all cases where no official objections, oppositions or other problems are encountered (resolving these will be charged at our hourly rate if encountered). However, if any of these events are encountered, we can give you a realistic estimate for any work needed. Lastly, to give clarity to our clients in respect of invoicing we invoice both the filing fees and prosecution fees at the time of filing the application in the assumption that no problems will be encountered with the application.

** these searches do not include Non-EU member states, including Switzerland, Iceland, Norway and Liechtenstein.

FIXED FEES - INTERNATIONAL (IR)

Please note that the costs below are not inclusive of official fees as unfortunately they vary per country. However, we aim to give you complete clarity and understanding with respect to costs before moving forward with any action on your behalf. Therefore, if you wish to discuss the countries of interest with us and other relevant details, we can give you a comprehensive bespoke estimate for all foreseeable costs.

FIXED FEES - International Trade Mark Registrations (IR)
Applications
IR basic Trade Mark Application in first class
Each additional class
Each country designated
Prosecuting application to registration*
Claiming priority
Subsequent Designations (adding countries to an existing IR)
IR Application for Subsequent designation
Each class claimed
Each country designated
Prosecuting application to registration*
Transactions
Recordal of change of owner (excluding preparation of assignment document) for first 5 marks
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 marks
Recordal of change of name or address
Renewals
IR Trade Mark Renewal
IR Trade Mark Renewal per class claimed
IR Trade Mark Renewal per country claimed
Late renewal

* these costs are fixed in all cases where no official objections, oppositions or other problems are encountered (resolving these will be charged at our hourly rate if encountered). However, if any of these events are encountered, we can give you a realistic estimate for any work needed. Lastly, to give clarity to our clients in respect of invoicing we invoice both the filing fees and prosecution fees at the time of filing the application in the assumption that no problems will be encountered with the application.

FIXED FEES - OTHER COUNTRIES

Please note that the costs below are not inclusive of official fees or local attorney fees as unfortunately they vary per country. However, we aim to give you complete clarity and understanding with respect to costs before moving forward with any action on your behalf. Therefore, if you wish to discuss the countries of interest with us and other relevant details, we can give you a comprehensive bespoke estimate for all foreseeable costs.

FIXED FEES – Trade Marks in other countries
Applications
Other country basic Trade Mark Application in first class*
Each additional class
Prosecuting application to registration**
Claiming priority
Transactions
Recordal of change of owner via local attorneys per country* (excluding preparation of assignment document)
Recordal of licence, security or other registrable transaction via local attorneys per country* (excluding preparation of licence document)
Change of name or address via local attorneys*
Renewals
Other country Trade Mark Renewal*
Each additional class
Late renewal*
Declaration of Use in other country*

* cost does not include official fees or local attorney's fees as these vary, however, estimates from specific local attorneys can be obtained before any work is commenced.

** these costs are fixed in all cases where no official objections, oppositions or other problems are encountered (resolving these will be charged at our hourly rate if encountered). However, if any of these events are encountered, we can give you a realistic estimate for any work needed. Lastly, to give clarity to our clients in respect of invoicing we invoice both the filing fees and prosecution fees at the time of filing the application in the assumption that no problems will be encountered with the application.

TRADE MARK WATCHING SERVICE

Trade Mark Watches

Our cost is a fixed fee per year are below, which give predictability and visibility for budgeting purposes:

A UK Trade Mark watching service is £650 (+VAT) per year, inclusive of all disbursements and fees.

An EU Trade Mark watching service is £750 (+VAT) per year, inclusive of all disbursements and fees.

A World-Wide Trade Mark watching service is £950 (+VAT) per year, inclusive of all disbursements and fees.

Company Name Watches

A UK Company Name Watch is £750 (+VAT) per year, inclusive of all disbursements and fees.

An International business name watch (covering most new company names around the world) is £1,450 (+VAT) per year, inclusive of all disbursements and fees.

Domain Name Watches

Watching for domain names containing a defined word/Trade Mark £1,200 (+VAT) *per year* per mark

Domain Name Renewal

A management and renewal fee of £100 (+VAT) *plus disbursements* is charged per renewal of each domain name.

Domain Name Purchasing

A fee of £100 (+VAT) *plus disbursements* is charged per domain name purchase.

Meet the team



Dr Dominic Murphy

PARTNER

T +44(0)3700 864 462
M +44(0)7725 647 961
E dominic.murphy@shoosmiths.com

Dominic heads up the national Trade Mark Practice. He has significant experience in a diverse range of industries including pharmaceuticals, biotechnology, electronics, telecommunications, fashion, software, banking and confectionery. He assists clients with the entire range of trade mark work, including pre-filing searching, filing strategies, filing UK, EU and international trade mark Applications, oppositions, cancellations and invalidity actions.

Dominic's experience includes managing the worldwide trade mark portfolios of global Electronics Corporations, Biotechnology Firms, Clothing Retailers, Financial Software Companies and Confectionery Retailers. This global portfolio management routinely spanned from urgent pre-filing searching, to worldwide trade mark filing Strategies with tiered filing priorities and costs, to trade mark enforcement and oppositions, to budget forecasting and yearly management.



Tara Cusack

TRAINEE TRADE MARK ATTORNEY

T +44 (0) 3700 868 210
M +44 (0) 7761 279 615
E tara.cusack@shoosmiths.com

Tara is a qualified solicitor who specialised in contentious intellectual property in the UK, and she also qualified as a trade mark attorney in Australia.

She has worked in private practice and in-house, and therefore takes a commercial and holistic approach.

Tara enjoys getting to know the businesses she works with to understand their particular IP needs. This includes assisting clients with a wide variety of trade mark matters such as providing pre-filing advice incorporating clearance searches, prosecuting UK, EU and International trade mark applications, and reviewing portfolios to identify any gaps in protection and any cost savings that can be made. She also regularly advises on contentious matters such as oppositions, invalidity and revocation actions.



Niki Priest

SENIOR TRADE MARK PARALEGAL

T +44 (0) 3700 868 838
M +44 (0) 7740 514 261
E niki.priest@shoosmiths.com

Nicola is a paralegal in the national Trade Mark Practice, working from the Thames Valley office and dealing with day to day trade mark matters.

She is a qualified Trade Mark Paralegal and acts for a broad range of businesses from multi-national companies to major fashion brands.

She is responsible for filing, prosecution and registration of worldwide trade mark and design applications and assists with trade mark oppositions, invalidations and challenges on behalf of both applicants and opponents. Nicola also provides assistance to clients in relation to the ongoing management of their trade mark and design portfolios.



Elizabeth Murray

TRAINEE TRADE MARK PARALEGAL

T +44 (0) 3700 868 835
E elizabeth.murray@shoosmiths.com

Elizabeth is a paralegal in the national Trade Mark Practice, working from the Thames Valley office and dealing with day to day trade mark matters.

She is a trainee Trade Mark Paralegal and acts for a broad range of businesses from multi-national companies to major fashion brands.

Elizabeth assists with filing, prosecution and registration of worldwide trade mark and design applications, trade mark oppositions, invalidations, challenges on behalf of both applicants and opponents. Elizabeth also provides assistance to clients in relation to the ongoing management of their trade mark and design portfolios.


Sample Trade Mark Reports

Portfolio Report

Providing a clear overview of your entire portfolio

IPENDO®

Trademark Case List - by Title

Image	Title	Reference	Country	Type	Int.Classes	Status	Filing Date	Reg. Date	Reg. No	Owner
	ACCESS	1277GB	United Kingdom	Normal	9, 16, 36, 45	Registered	18 Sep 2009	26 Mar 2010	2526764	Shoosmiths LLP
	ACCESS LEGAL FROM SHOOSMITHS & Device (Series of 2)	1278GB	United Kingdom	Normal	9, 16, 36, 45	Registered	18 Sep 2009	05 Feb 2010	2526762	Shoosmiths LLP
	accesslegal device	TMD0661	United Kingdom	Normal	9, 16, 36, 45	Registered	11 Jan 2017	02 Jun 2017	3206099	Shoosmiths LLP
	NSN	1326GB	United Kingdom	Normal	9, 16, 35, 36, 38, 41, 45	Registered	06 Jun 2007	18 Jan 2008	2457894	Shoosmiths LLP
	PROPERTY DIRECT & Device (Series of 2)	1328GB	United Kingdom	Normal	42	Registered	12 Aug 1997	13 Feb 1998	2141708	Shoosmiths LLP
	SHOOBOX Device	1331GB	United Kingdom	Normal	35	Registered	30 Jun 2011	21 Oct 2011	2586254	Shoosmiths LLP
	SHOOSMITHS	1332GB	United Kingdom	Normal	9, 16, 36, 45	Registered	20 Jan 2012	27 Apr 2012	2607675	Shoosmiths LLP
	SHOOSMITHS ACCESS LEGAL & Device (Series of 2)	1333GB	United Kingdom	Normal	9, 16, 36, 45	Registered	22 Jan 2014	13 Jun 2014	3038806	Shoosmiths LLP
	SHOOSMITHS Device	1334EU	European Trademark-CTM	Normal	9, 16, 36, 45	Registered	02 Mar 2012	01 Aug 2012	10693398	Shoosmiths LLP
	SHOOSMITHS device (series of 2)	M-737573	United Kingdom	Normal	9, 16, 36, 45	Registered	21 May 2018	28 Sep 2018	3312217	Shoosmiths LLP

Powered by: **ipendo Platform™**

Manual Search

Created Date: 7 Feb 2019

Case Report

Providing a detailed report on particular records

IPENDO®

Trademark Case - SHOOSMITHS device (series of 2)

Title: SHOOSMITHS device (series of 2)
Reference: M-737573

Status: **Registered**
Sub Status:

Country: **United Kingdom (GB)**
Type: **Normal**

Earliest Priority Date: **21 May 2018**

Type of Mark: **Figurative**
Int. Classes: **9, 16, 36, 45**

Application Number: **3312217**

Filing Date: **21 May 2018**

Registration Number: **3312217**

Registration Date: **28 Sep 2018**

Next Renewal Date: **21 May 2028**

Maintenance Provider: **Other Channel**

Lapse Date:

SHOOSMITHS

Member states: **GB**

Active Records in Family

Pending:

Registered: **GB**

Related Parties

Client	<i>Shoosmiths LLP</i>
Owner	<i>Shoosmiths LLP</i>
Paralegal	<i>Niki Priest</i>
Responsible	<i>Rachel Nicholls</i>

Categorizations

Portfolio Relations

International Classes

Class 9:

Apparatus for recording, transmission or production of sound or images; magnetic data carriers; digital media; recording discs; recorded media; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; DVDs.

Class 16:

Paper, cardboard and goods made from these materials; printed matter; printed publications; pre-prepared legal documents for use by consumers.

Class 36:

Insurance; financial services; real estate agency services; financial services provided via the Internet.

Class 45:

Legal services; conveyancing services; legal services provided via the Internet.

Powered by: **Ipendo Platform™**

Manual Search

Created Date: **7 Feb 2019**

Family Report

Providing a status report of a particular Trade Mark family

Trademark Family - SHOOSMITHS device (series of 2)

IPENDO®

Family Reference: TM0379

Number of international classes: 4

SHOOSMITHS

Number of Cases: 1 (Registered: 1)

International Classes

Class 9

Pending:

Registered: GB

Class 16

Pending:

Registered: GB

Class 36

Pending:

Registered: GB

Class 45

Pending:

Registered: GB

Family Case Status Graph



Categorizations	Related Parties	Use Status
Product area:	Owners: Shoosmiths LLP	
Other categorizations:	Other related parties on family: Niki Priest - Paralegal Rachel Nicholls - Responsible Shoosmiths LLP - Client	

Powered by: Ipendo Platform™

Manual Search

Created Date: 7 Feb 2019

Distribution Report

Providing an at a glance overview of your geographical protection

IPENDO®

Trademark Distribution Report

Manual Search

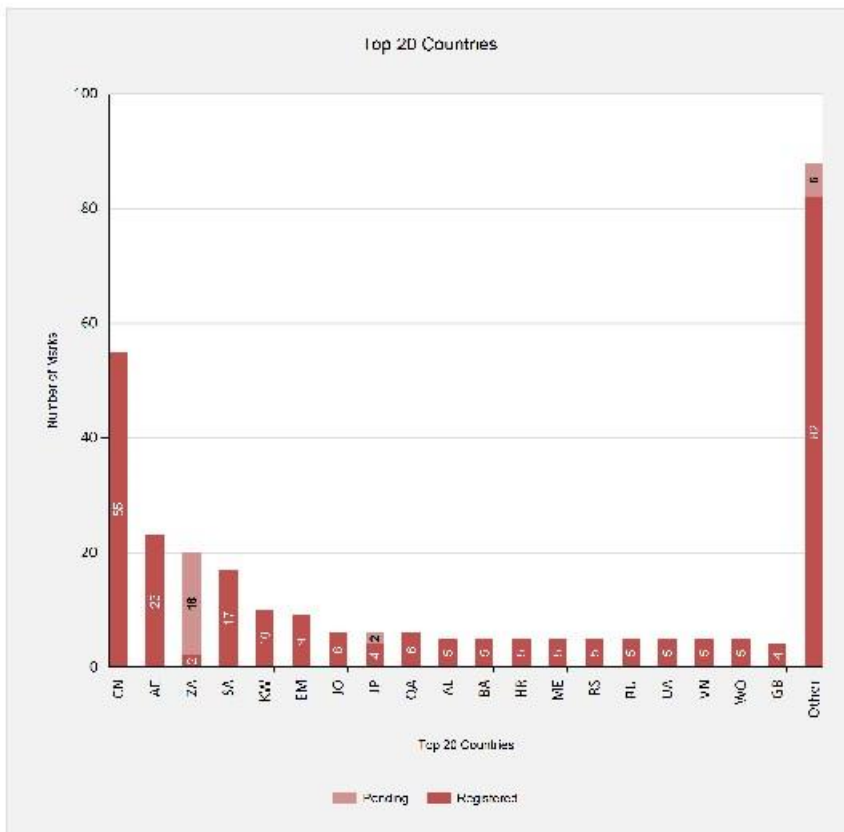
Total Number of Marks: 308

Number of Pending Marks: 26

Number of Registered Marks: 283

Number of Lapsed/Nat. Phase Marks: 17

Period: No period, all trademarks in selection



Powered by: Ipendo Platform™

Manual Search

Created Date: 7 Feb 2019

SHOOSMITHS