



TRADE MARKS AT SHOOSMITHS

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.

Direct Access – You can enjoy direct access to your Trade Mark portfolio held on our records, including the ability to run reports on several factors. The sample reports at pages 11 to 14 provide a good idea of how you can view your data, and we can work with you to provide more tailored access where required.

Document Access – We can store your key documents, such as certificates of registration and renewal on our 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.

Estimating Tool – We can provide direct access to a Trade Mark estimating tool allowing you to easily and quickly obtain an indication of likely costs in Trade Mark filings and Trade Mark searching.

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.

FIXED FEES - UK TRADE MARKS

FIXED FEES - UK TRADE MARKS Description	Fixed Cost (£) plus VAT where payable (inclusive of <u>all</u> official fees)
Pre-filing searches	
UK Trade Mark Search	600
Applications	
UK Trade Mark Application in first class	550
Prosecuting application to registration*	250
Each additional class	150
Claiming priority	50
Transactions	
Recordal of change of owner (excluding preparation of assignment document)	350
Drafting assignment document to assign one or more UK Trade Marks from the same owner for first 5 marks	400
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 marks	350
Recordal of change of name or address	100
Request for certified copy of a UK Trade Mark	70
Renewals	
UK Trade Mark Renewal in first class	450
Each additional class	100

* 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	Fixed Cost (£) plus VAT where payable (inclusive of <u>all</u> official fees)
Pre-filing searches	
EU Trade Mark search (only for EU Trade Marks, not including all Member States)	600
EU Trade Mark Search (including EU Trade Marks and all EU Member States)	1,200
Applications	
EU Trade Mark Application in first class	1,350
Prosecuting application to registration*	350
Each additional class	250
Claiming priority	50
Transactions	
Recordal of change of owner (excluding preparation of assignment document) for first 5 marks	350
Drafting assignment document to assign one or more EU Trade Marks from same owner	400
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) per mark	350
Recordal of change of name or address	150
Request for certified copy of a EU Trade Mark	70
Renewals	
EU Trade Mark Renewal in first class	1,100
Each additional class	200

* 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 - INTERNATIONAL REGISTRATIONS (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 Registrations (IR)	Fixed Cost (£) plus VAT where payable (<i>costs not inclusive of official fees as unfortunately they vary per country</i>)
Applications	
IR basic Trade Mark Application in first class	500
Each additional class above three	70
<i>(Please note that there is no additional charge per country, so that costs are kept to a minimum)</i>	
Prosecuting application to registration*	300
Claiming priority	50
Subsequent Designations (adding countries to an existing IR)	
IR Application for Subsequent designation	300
Each additional class above three	70
<i>(Please note that there is no additional charge per country, so that costs are kept to a minimum)</i>	
Prosecuting application to registration*	150
Transactions	
Recordal of change of owner (excluding preparation of assignment document) for first 5 marks	400
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 marks	400
Recordal of change of name or address	200
Renewals	
IR Trade Mark Renewal in first three classes	600

IR Trade Mark Renewal in each additional class above three <i>(Please note that there is no additional charge per country, so that costs are kept to a minimum)</i>	60
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* 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 TRADE

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 – OTHER COUNTRIES TRADE	Fixed Cost (£) plus VAT where payable (<i>costs not inclusive of official fees or local attorney fees</i>)
Applications	
Other country basic Trade Mark Application**	500
Prosecuting application to registration*	300
Basic filing in Ireland**	300
Claiming priority	50
Transactions	
Recordal of change of owner via local attorneys per country** (excluding preparation of assignment document)	200
Recordal of licence, security or other registrable transaction via local attorneys per country** (excluding preparation of licence document)	200
Filing cancellation, invalidity action via local attorneys per country**	200
Change of name or address via local attorneys**	100
Renewals	
Other country Trade Mark Renewal**	300
Declaration of Use in other country	400 + local attorney fees

* 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.

** 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.

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 £500 (+VAT) per year, inclusive of all disbursements and fees.

An EU Trade Mark watching service is £600 (+VAT) per year, inclusive of all disbursements and fees.

A World-Wide Trade Mark watching service is £750 (+VAT) per year, inclusive of all disbursements and fees.

Company name watches

A UK Company Name Watch is £500 (+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 names

Generic top-level exact domain name registrations £300 (+VAT).

Country code top-level exact domain name registrations £400 (+VAT).

Generic and country code top-level exact domain name registrations £500 (+VAT).



Domain name renewal

A management and renewal fee of £40 is charged per renewal of each domain name.

MEET THE TEAM

Please find below biographies of your **core Shoosmiths' trade mark team**.

TRADE MARKS TEAM - CORE CONTACTS

	<p>Dr. Dominic Murphy Partner and Head of National Trade Mark Practice T: 03700 86 4462 M: 07725 647 961 E: Dominic.Murphy@shoosmiths.co.uk</p>
<p>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.</p> <p>Dominic's experience includes managing the world-wide 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 world-wide trade mark filing Strategies with tiered filing priorities and costs, to trade mark enforcement and oppositions, to budget forecasting and yearly management.</p>	
	<p>Sonia Burgess Chartered UK and European Trade Mark Attorney T: 03700 86 5740 M: 07738 349 619 E: Sonia.Burgess@shoosmiths.co.uk</p>
<p>Sonia assists clients with a wide variety of trade mark matters such as providing pre-filing advice incorporating clearance searches, and prosecuting UK, EU and International trade mark applications. She regularly advises on contentious matters such as oppositions, invalidity and revocation actions. Sonia has particular experience in brand resurrection and brand refreshing.</p> <p>Sonia's experience includes: assisting one of the UK's leading food and drink brands to reach an amicable settlement following a nine-year dispute with a Portuguese company involving numerous oppositions, cancellations and revocation actions; advising a major food and drink manufacturer on the resurrection of a thirty-year-old trade mark and conducting clearance searches in order to advise on the associated risks; and handling the worldwide assignment of trade marks for a market-leading tobacco company.</p>	



Mark Armitage

Trade Mark Consultant

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Mark has a very extensive range of experience both in-house and working within patent and trade mark attorney firms, with particular expertise in carrying out clearance searches and attending opposition and trade mark hearings.

Mark's experience includes handling the European Union trade mark portfolios of large multinational companies in the computer and electronics sectors at one end of the scale and advising individuals requiring protection for a single mark just in the UK at the other. Notable achievements include prosecuting trade oppositions through to a successful conclusion, negotiating settlement agreements and successfully challenging adverse decisions of the EU Trade Marks Office.



Nicola Priest

Trade Mark Administrator and Paralegal

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M: 07740 514 261

E: Nicola.Priest@shoosmiths.co.uk

Nicola is a paralegal in the national Intellectual Property group and works from the Thames Valley office, specifically dealing with trade mark matters.

She is a qualified Trade Mark Administrator 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.

SAMPLE TRADE MARK REPORTS

PORTFOLIO REPORT

Providing a clear overview of your entire portfolio



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	TM00661	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	2457694	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	3039806	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

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CASE REPORT

Providing a detailed report on particular records



Trademark Case - SHOOSMITHS device (series of 2)

Title: SHOOSMITHS device (series of 2)	Status: Registered
Reference: M-737573	Sub Status:
Country: United Kingdom (GB)	Earliest Priority Date: 21 May 2018
Type: Normal	Application Number: 3312217
Type of Mark: Figurative	Filing Date: 21 May 2018
Int. Classes: 9, 16, 36, 45	Registration Number: 3312217
	Registration Date: 28 Sep 2018
	Next Renewal Date: 21 May 2028
	Maintenance Provider: Other Channel
	Lapse Date:



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.

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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**

Number of Cases: **1 (Registered: 1)**

SHOOSMITHS

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	

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DISTRIBUTION REPORT

Providing an at a glance overview of your geographical protection



Trademark Distribution Report

Manual Search

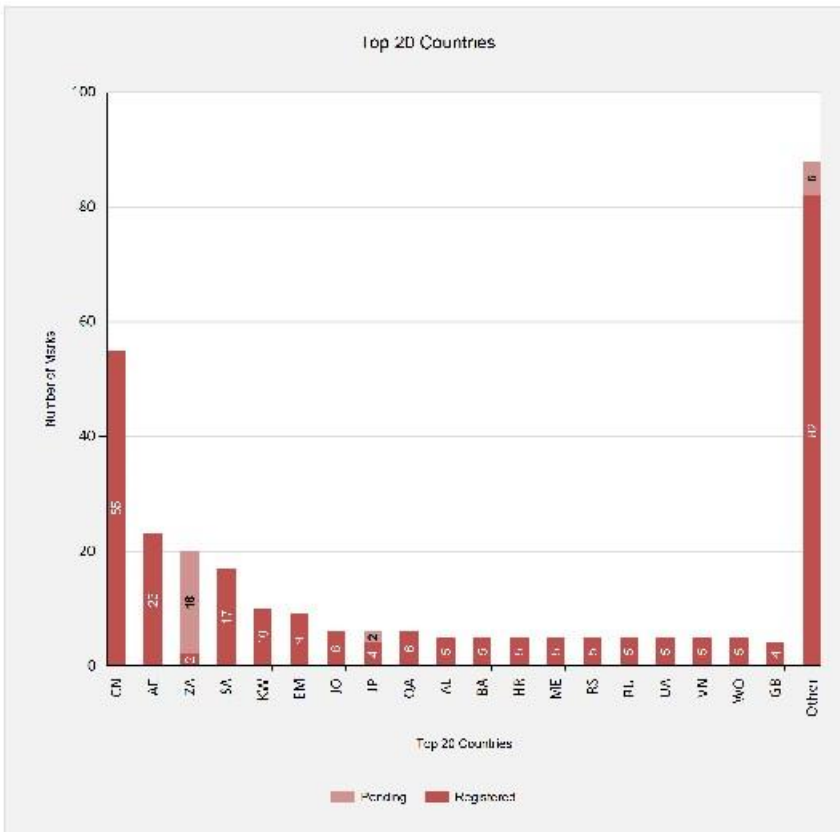
Total Number of Marks: 306

Number of Pending Marks: 26

Number of Registered Marks: 263

Number of Lapsed/Nat. Phase Marks: 17

Period: No period, all trademarks in selection



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Created Date: 7 Feb 2019

