

SHOOSMITHS

Designs at Shoosmiths

2023

Our Approach

Let's start with the important question; how do you want it to work? You will have Design 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 Design development. We can work with your management teams to adopt a commercially appropriate Design protection strategy. We can work with your finance teams to make estimating and budgeting a simple process. We can report, search, 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.
- **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 Design portfolios of all shapes and sizes, to provide a gap analysis of your current Design protection and to develop a Design protection and maintenance strategy that works for you.

Simple Summary of Costs

Please find below a summary for the estimated cost of filing Designs in the UK and EU.

Provided that the designs have not been disclosed to the public for more than 12 months prior to the filing date for the UK and/or EU design in question, then we can work with you to assess which designs to file and in which countries.

The estimated costs for UK designs usually work out around £900 (+VAT) for one Design, in a straightforward case with drawings pre-prepared and ready for filing.

The estimated costs for EU designs usually work out around £1,400 (+VAT) for one Design, in a straightforward case with drawings pre-prepared and ready for filing.

The design is registered without examination - in other words the relevant office will not assess whether the design is "new" or has "individual character" over prior designs. This matter is resolved only when a third party tries to attack the registration (for example in reply to a claim for infringement).

The initial term of protection is 5 years, and the registration is renewable in four further 5-year blocks (to a maximum of 25 years).

In order to file the design application, it would be useful to have a selection of monochrome line drawings (not shaded, without any measurements on them). We can use up to seven views, and we suggest using at least one side view, top view, bottom view and both end views as well as a couple of angled "perspective" views.

We can disclaim certain features of the design by showing them in dashed line. This means that the design protection is not limited by the feature in question, which can broaden protection. The way to approach this is to firstly consider what makes your design unique. We should then look at the other ancillary features to decide if they would unduly limit protection.

We also suggest that any logos or trade marks are removed.

Finally, please let us know if there are any envisaged variants (particularly in shape) and we can talk this through.

Fixed fees - UK designs

FIXED FEES - UK Designs Description
Applications
UK Design Application for 1 Design (without deferred publication)
Each additional Design
Claiming priority
Transactions
Recordal of change of owner (excluding preparation of assignment document) for first 5 designs
Drafting assignment document to assign one or more UK Trade Marks from the same owner for first 5 designs
Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 designs when owned by the same owner
Recordal of change of name or address
Request for certified copy of a UK Trade Mark
Renewals
UK Design Renewal for one design
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 Designs

FIXED FEES - EU Designs Description
Applications
EU Design Application for 1 Design (without deferred publication) Each additional Design Claiming priority
Recordal of change of owner (excluding preparation of assignment document) for first 5 designs Drafting assignment document to assign one or more EU Trade Marks from the same owner for first 5 designs Recordal of licence, security or other registrable transaction (excluding preparation of licence document) for first 5 designs when owned by the same owner Recordal of change of name or address Request for certified copy of an EU Trade Mark
EU Design Renewal for one design 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.

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 National Trade Mark Practice, working from the Thames Valley office 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.

SHOOSMITHS