

Most common mistakes when registering a trademark and how to avoid them

Registering a trademark is not merely a formality; it is about **protecting and safeguarding the identity of your business**, adding value to what you have built, and preventing third parties from exploiting it in the future, while maintaining and monitoring the value that the trademark brings to the business.

In practice, most people interested in registering a trademark make errors in form and substance that can cost **months of prosecution time, money invested, blocked opportunities**, and can even **prevent the trademark from being registered**, with all the negative consequences that this entails.

Most common mistakes in trademark registration

1. Not conducting a background check on registered records

Many people apply for registration directly, without checking whether an identical or similar trademark already exists in the same area or class. Prior to initiating the trademark registration process, it is highly recommended to conduct a registration viability research of the trademark you wish to register in order to detect others that may be identical or similar (in one or more classes) that could prevent the registration of your trademark.

In addition to conducting this preliminary research, it is also advisable to obtain a legal report that determines (or not) the **registrability of the trademark**.

2. Choosing a term that is too generic or descriptive

Another common mistake is to believe that a term that describes the good or service is sufficient to register it.

Very generic or descriptive trademarks that serve to designate the good or service or qualities or characteristics related to them, lack distinctiveness and are likely to be rejected.

In order to avoid this potential issue, it is advisable to devise a unique term that does not directly describe what is being sold, since otherwise, in Spain, the Spanish Patent and Trademark Office (SPTO) may reject the application on the grounds that the trademark lacks distinctiveness.

Do you want to protect your trademark and need advice and support? At **UNGRIA**, we have a team of **trademark attorneys** that can help you register a trademark in Spain.

REGISTRATION OF TRADEMARKS

3. Not considering the Nice Classification or choosing the wrong class

Registering the trademark in the wrong class or only in one class, when the business actually needs more, is another of the most common mistakes when registering a trademark.

In order to avoid making this mistake, you need to know how **to identify the goods or services for which you want to register the trademark**, choosing the right class according to the Nice Classification.

4. Failing to consider possible international expansion

When registering a trademark, it is also important to consider other aspects such as the possibility of operating in new countries.

When seeking to enter a new international market, it is possible that another company has already registered the trademark there. If there is the possibility of operating in other markets, it may be worth considering different alternatives:

- National trademark route: i.e., registering the trademark country by country.
- Regional trademark route: in certain areas, such as the European Union or Benelux, there are regional systems that allow a trademark to be protected in several countries with a single registration.
- International trademark route: i.e., applying for international trademark protection in up to 131 countries by filing a single application (Madrid System).
- In any case, it is crucial to bear in mind the right of priority recognized by the Paris Convention.

Europe | U.S.A | Argentina | Brazil | Mexico

5. Failure to monitor trademark misuse

Although registration grants exclusive rights to use the trademark, it does not automatically guarantee compliance: the relevant Trademark Office (SPTO in Spain) is not responsible for prosecuting those who misuse it.

Without **active monitoring**, competitors or third parties may start using similar names, logos, or signs to confuse consumers and exploit someone else's reputation.

To prevent this, a monitoring system should be established to track new trademark applications published in Official Bulletins and the use of similar marks on the internet, social media, and marketplaces. Only through a **constant supervision** and an immediate response to any infringement can the trademark retain its full strength and exclusivity.

6. Failure to renew the trademark on time

Another common mistake with potentially negative consequences is failing to renew the trademark before the legal deadline. In most jurisdictions (such as Spain), a trademark registration **is valid for ten years** from the filing date and can be renewed indefinitely for successive periods of the same duration. This means that the legal life of a trademark could be indefinite.

Need advice on registering a trademark?

Registering a trademark involves many details, from the preliminary search to subsequent prosecution and surveillance any mistake can cost you time, investment, and opportunities.

At **UNGRIA**, we have a team of trademark attorneys that will guide you through every stage of the registration process, ensuring that your trademark is safeguarded against competitors and potential conflicts.

CONTACT US

Europe | U.S.A | Argentina | Brazil | Mexico

Disclaimer: Please note that the present communication is of a general nature. It is not intended as legal advice and does not create an attorney-client relationship. No warranty of any kind is given with respect to the subject matter included herein or the completeness or accuracy of this note and no responsibility is assumed for any actions (or lack thereof) taken as a result of relying on or in any way using information contained in this note. In no event shall we be liable for any damages resulting from reliance on or use of this information. Any analysis regarding or related to the developments indicated above needs to be applied to a case in particular and consulted or verified with local counsel in each jurisdiction.