

TRADE MARKS

A trade mark is a sign that distinguishes the goods or services of the trade mark owner from those of competitors. Most trade marks are words or logos but more exotic signs such as shapes of packaging, sounds, smells, colours or gestures may also qualify.

When choosing a trade mark it is important to make it distinctive. It should not be too similar to an existing trade mark or to an ordinary word that competitors might reasonably want to use to describe their goods. Invented words (e.g. KODAK or PENTIUM) and words unrelated to the goods (e.g. APPLE for computers) are most likely to be distinctive. Well known geographical names are unlikely to be distinctive.

Registered Trade Marks

When a distinctive trade mark has been used enough to acquire a wide reputation in the United Kingdom, it may be capable of protection under the law of "passing off". However, it is preferable to register a trade mark because:

- a registered trade mark is easier to enforce;
- other people can find out that the mark is registered and avoid using it;
- a registered trade mark strengthens a corresponding Internet domain name;
- there is no need to wait until the mark has acquired a reputation; and
- if you do not register your trade mark, somebody else might do so.

Registered trade marks are different from company names. When a company is set up, its name is recorded on a register and no other company can have an identical name. But a company name registration does not prevent someone else from using the identical word as a brand for their goods or services; or from forming a company with a quite similar name even in the same field of business. A trade mark can be registered by a company or by an individual, for specified goods or services, and it does give protection against the use of similar trade marks.

A United Kingdom registered trade mark is infringed if a competitor uses a similar trade mark in the United Kingdom on goods or services similar to those specified in the registration. A trade mark registered as plain words gives protection against the use of those

words in any typeface. A UK registration does not give any rights in foreign countries: foreign registrations are discussed below.

The trade mark registration may be enforced by applying to the High Court for an injunction against the infringer and for damages. For wilful infringement of a registered trade mark, criminal proceedings are also possible.

It is an offence to use the ® symbol or otherwise to claim that a mark is registered if it is not. However, there is no objection to using ™.

Trade Mark Applications

A trade mark application can be filed at the UK Intellectual Property Office at any time: before or after use of the trade mark has started. The application must specify the goods or services for which the mark will be used. There are 45 classes of goods and services and the application fee depends on how many classes are covered. The application should be in the name of the person or company who will use the mark or someone who can control the quality of the goods or services.

After about a month the Office will examine whether the trade mark is inherently distinctive. We will attempt to overcome any objections by correspondence, failing which we may occasionally attend a hearing to discuss the application face-to-face with an official. Objections of lack of distinctiveness can sometimes be overcome by evidence that the trade mark has been used extensively and acquired a significant reputation. The Office will also search for existing trade marks that are similar to the new application but, under the rules in place since 01 October 2007, it will not make objections on that ground. In some cases it will notify the owners of the existing, similar trade marks about the new application.

After the application has been found acceptable by the Office, it is published so that within a period of two months any person can oppose registration of the trade mark, usually on the ground that that person has earlier rights to a similar trade mark. If there is no opposition, or after any opposition has been disposed of, a certificate of registration will be issued. The trade mark is initially registered for 10 years from the application date and can be renewed for further periods of 10 years by the payment of renewal fees. If the trade mark is not used during any continuous period of 5 years the registration can be revoked.

Warning

Within a few days after a trade mark application has been filed, the details will be made public on the UKIPO website. There are some organizations that use these details to send out invoices directly to the trade mark applicant for unsolicited services, unnecessary registration fees and similar scams. Please ask our advice before paying any invoice that does not originate from us.

Trade Mark Searches

Before filing a UK trade mark application, we can carry out a search for conflicting earlier trade marks. For marks consisting of words only, we can carry out the search within a couple of days using an online database and for such searches we offer a fixed price. Now that the UK Intellectual Property Office no longer makes objections on the basis of earlier marks, the interpretation of the search results inevitably involves some guesswork about whether the owners of the earlier trade marks will think it worthwhile to file an opposition, so the decision whether to pay extra for a pre-filing search is not so clear. If there is a need to be sure that the trade mark is clear of potential objections without waiting for the outcome of the application, then a search may be worthwhile. Naturally we cannot guarantee that a clear search will always lead to registration.

Trade Mark Watches

As well as registering your trade marks, it is important to know if other people are trying to register marks that are similar to them. Neither the UK Intellectual Property Office nor the Community Trade Marks Office will object to a new trade mark application on the basis of your existing mark, therefore the burden falls on you to monitor what applications are being filed by other people. We recommend a watching service that will tell you of any potentially conflicting application in time for you to file an opposition against it.

Foreign Trade Marks

Trade marks can be registered in most other countries but the application systems differ and we can provide more details and cost estimates on request. Besides the separate national systems two international systems are available: the Community Trade Mark and the Madrid Protocol. In all these cases, if the foreign trade mark application is filed within six months of the UK application it can claim the original date (known as "claiming priority"). It is possible to carry out advance searches for foreign trade marks but the cost is often high.

A Community trade mark is a single trade mark registration that has effect throughout all member states of the European Union. Its advantages are that the application and renewal are simpler and cheaper than a large number of national applications would be, and that the trade mark only needs to be used in one place in the Community to avoid being revoked. The main disadvantage is that an objection to registration arising anywhere in the European Union (bearing in mind the different languages and the many existing trade marks) can prevent a Community registration.

The Madrid Protocol is a scheme in which a single international application can be used to obtain registrations in selected member countries of the Protocol. The application procedure and the renewal procedure are centralized but the cost depends on the number and on the identities of countries selected. The international application must be based on an earlier application or registration in the home country.

We hope that you will find this general information helpful but this is a complex area of law and we strongly recommend that you seek our advice in relation to any particular case.

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