

SUMMARY OF SERVICES

- Advice on registrability of trade marks, collective marks and certification marks, including arrangement of pre-filing searches.
- Advice on appropriate classification of goods and services for trade mark registration.
- Filing and prosecution of UK, European Community and Madrid Protocol trade mark applications.
- Filing and defending oppositions to UK, European Community and Madrid Protocol trade mark applications.
- Filing and defending applications for invalidation and revocation of trade mark registrations before the UK Intellectual Property Office (IPO) and Office for Harmonisation in the Internal Market (OHIM).
- Enforcing trade mark rights against infringers and defending our clients when accused of infringement of other parties' trade mark rights.
- Instructing associates worldwide in filing, prosecution and enforcement of trade mark rights overseas and in defending allegations of infringement of trade marks rights overseas.
- Assistance with larger commercial transactions involving IP; including due diligence.
- Advice on licensing and other forms of commercial exploitation, including assignment and recordation programmes.
- Dispute resolution, including mediation.
- Trade mark renewals.

WHAT IS A TRADE MARK?

A trade mark is any sign which distinguishes the goods or services of one business from those of another. It may, for example, be a word or words, letters, numerals, a logo, a picture, the shape of goods or its packaging, a sound or, in limited cases, a smell. For most businesses, trade marks define the image and quality of their goods or services and serve as an indication of the source of those goods or services. They play an active role in influencing choice and enable customers to recognise particular products or services time after time.

WHY SHOULD A TRADE MARK BE REGISTERED?

The reasons are two-fold. Firstly, registration (after the appropriate pre-filing searches) ensures freedom to use and secondly, it provides owners with the power to stop third party use.

1) Businesses sometimes begin using trading names for their goods or services without considering whether a third party may have rights to their chosen name. Carrying out appropriate searches and then registering a name as a trade mark will ensure that you are not infringing third party rights.

2) Some businesses spend large sums of money and most invest significant time in devising trade marks for their goods or services. Money, time and effort are then spent on promoting goods or services under the marks. Unauthorised use of that trade mark or a similar trade mark by another party is likely to result in a loss of business and damage to goodwill.

Registered trade marks provide protection against unauthorised use of your trading name. Registration provides a relatively easy, cost-effective route to preventing your competitors plagiarising these marks.

Without a trade mark registration in place, a business may be able to rely on the common law tort of “passing off” (in the UK), but it has to demonstrate that it owns goodwill (which usually requires extensive use) and that the relevant public would be deceived by unauthorised third party use of the mark, before it can consider taking any action against that third party use. This can be an onerous task that can be avoided if the trade mark in question is registered. Many countries do not operate a common law system and so trade mark registration is the only effective way to protect an interest in a trade mark.

WHAT ARE THE BENEFITS?

A trade mark registration gives you the right to prevent others using the same or a similar mark, for the same or similar goods covered by the registration. A reputation or goodwill does not have to be proved by the registered proprietor, although use may have to be proved if the registered trade mark is of a certain age (five years in the UK). Additionally, instances of actual confusion or damage do not have to be shown in an action for trade mark infringement; a likelihood of confusion will suffice. As a result, an action for trade mark infringement is usually much cheaper to bring than an action for passing off.

Also bear in mind that registration of a trade mark creates a public record of your interest in the trade mark. Without registration another party may be unaware of an earlier interest to the one they are considering, so registration provides a useful notice to others not to adopt the same or a similar mark.

In some circumstances, deliberate unauthorised use of a registered trade mark by another person may constitute counterfeiting. In the UK, if the trade mark is registered, criminal proceedings may be initiated by the police or Trading Standards Officers, at no cost to you.

Registered trade marks are legal property. They can be licensed, assigned or partially assigned and can appear as an asset on your accounting books. If your product or service becomes successful, it is the trade mark and the goodwill associated with it that potential purchasers or investors will be interested in.

WHAT SHOULD BE DONE BEFORE USING OR REGISTERING A TRADE MARK?

Searches need to be undertaken to ensure that use of the trade mark concerned will not infringe the rights of another party and that you will not have to abandon it as a result of an earlier conflicting right. Searches will also reveal whether difficulties are likely to be encountered in obtaining registration of the trade mark.

WHERE SHOULD I REGISTER MY TRADE MARK?

If your business is exclusively in the UK, registration of your trade mark at the UK IPO is likely to be appropriate and the most cost-effective way of obtaining protection.

Trade marks are generally registered nationally and where you have an interest in a specific country the filing of a national application at the relevant national office for that country may be appropriate. However, there are systems which can assist in protecting trade marks where registration is required for several countries.

If you sell goods or provide services in several Member states of the European Union, a Community Trade Mark registration may be the most appropriate and cost-effective way of securing protection. A Community Trade Mark registration is a unitary right and a single registration, providing protection for all the Member states of the European Union, and may be obtained for the payment of single application and registration fees.

The Madrid Protocol, together with another treaty called the Madrid Agreement, govern the so-called Madrid system for the international registration of marks. These systems enable businesses to obtain protection for any

country which is a member of the Madrid Protocol or Madrid Agreement and allow businesses to obtain considerable cost savings over filing national trade mark applications when protection is required in several countries. Unlike the Community Trade Mark system, the applicant for a registration under the Madrid Protocol or Madrid Agreement can choose the countries that are of interest to them and ends up with a bundle of national rights for the countries in which the trade mark is accepted. Additionally, the Madrid Protocol and the Madrid Agreement have member countries outside the European Union (e.g. Japan and Switzerland). The UK is a member of the Madrid Protocol and as a result, companies in the UK can use this system for obtaining protection of their trade marks.

WHAT IS REQUIRED FOR REGISTRATION?

Examination requirements vary between countries as a consequence of different laws and practices. However, most countries will examine applications on 'relative' and/or 'absolute' grounds. An 'absolute' grounds check examines whether the nature of the mark itself is such that the applicant should be granted a statutory right; for example, consideration will be given as to whether the mark is descriptive, deceptive, laudatory, a known geographical location etc. A 'relative' grounds check examines whether there are any earlier registrations or applications with which your application conflicts. The tests for comparison will vary between countries but will generally include visual, phonetic and conceptual comparisons. Note that due to different laws and practices, as well as linguistic and cultural differences, two marks that are not similar in one country could be held to be similar in another country.

Some countries do not examine applications on either or both of the above grounds. The reasoning being that issues should be resolved in proceedings before the office concerned or in the courts.

The above represent general principles/guidelines only and should not be taken as legal advice. If you need more information or require advice, please contact us. Please see which of our specialist's best match your discipline in the Partners & Staff section of this site.