

Register your trading names and product names as trade marks

The following tale is a real life situation faced by one of our clients last year. We have changed the names of the parties and the business sector to preserve anonymity. The Birmingham Drama Academy started to use the acronym BDA in July 1998. They filed a trade mark application for BDA in November 2002 and registered this as a trade mark for training and educational services. The Birmingham Dance Academy was founded in September 2001 and started to use BDA to refer to itself almost immediately.

The two academies co-existed until 2010 when the Birmingham Drama Academy became aware of the use by the Birmingham Dance Academy of the letters BDA. As the Birmingham Drama Academy had a trade mark registration for BDA for the same services as those provided by the Birmingham Dance Academy and had started to use this acronym from an earlier date, they were able to force the Birmingham Dance Academy to stop using BDA, even though the Birmingham Dance Academy had been using BDA since September 2001. The reason was that the trade mark registration and earlier use trumped everything else. This was a very unfortunate situation because the Birmingham Dance Academy had come to be known by its own clients as BDA.

Had the Birmingham Dance Academy filed its own trade mark application when it started to use BDA, the situation would have been different and they would have been in the driving seat.

The moral to this tale is that a trade mark application should be filed to protect any distinctive trading name, trade mark or sign used in business immediately to avoid future difficulties. This is because, generally speaking, in the European Union (and many other) countries the first person to file a trade mark gains the rights to that trade mark.