

Trade mark Q&A: What do you do if someone is using your trade mark without your permission?

A trade mark is a 'sign' (most typically a word or logo) that distinguishes your brand from those of your competitors. It can be used to prevent anyone else using the same or similar mark for similar goods and services in the territory in which you trade. But what do you do if you feel that someone else is infringing on your trade mark?

The questions and answers below outline the initial steps that you should consider taking if you feel that someone else is using your registered trade mark without your permission.

We have seen another business using our registered trade mark. Can we stop this?

Yes, provided they are using your trade mark for the same or similar products or services and have adopted the mark after you first put it into use or registered it.

How can we stop them?

We recommend that you write a letter to the business informing them that they are using your trade mark and that you require them to cease using it. You should also ask them to confirm in writing that they will not use the mark in the future.

Do we have to be careful about the terms of such a letter?

Yes, the UK Trade Marks Act contains provisions prohibiting the making of groundless threats of trade mark infringement. It is easy to get this wrong and to write a letter which contravenes these points. We can help you compose a letter which complies with the provisions laid out in the Act.

What if the other business continues to use our registered trade mark after being warned not to do so?

It may be necessary to consider bringing legal proceedings to stop the infringement of your trade mark. We have an excellent track record of stopping third parties from using our clients' trade marks by bringing any appropriate legal proceedings.

Where could any such legal proceedings be brought?

They would be brought in specialist courts with judges who understand trade mark law. This could be either the Intellectual Property Enterprise Court or the Chancery Division of the High Court, depending on the value of the claim.

Will this be costly?

Legal proceedings can be cost-effective when conducted in the right way and deliver appropriate commercial value.

Q: If legal proceedings are brought, will we have to continue discussion with them until a trial takes place?

A: Depending on the circumstances, we will usually encourage you to settle your differences with the other party. Mediation is a useful tool in this regard. If this cannot be attained, then it might be necessary to go to a trial, but this happens in a minority of cases.

Q: Will legal proceedings take up a lot of our management time?

A: Any litigation inevitably impacts on management time, but we are accustomed to handling frequently complex disputes and will aim to keep this disruption to a minimum, whilst ensuring that you are kept fully informed of what is happening and when we require your input.

Q: We are reluctant to get involved in legal proceedings. Is there any other advice you can give us?

A: We see litigation as a last resort and will do everything we can, both before and after the commencement of proceedings, to resolve the dispute to your satisfaction. We take pride in the fact that many of our clients have been with us for decades and we believe this is due, in no small part, to our policy of always doing what we believe to be right for our clients and to achieve the best commercially beneficial outcome.

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Contact us

If you would like to know more about this issue or if you have any queries please don't hesitate to contact us on 020 7830 0000.