

Trade Marks: Things you should know

A 'trade mark' is a sign that distinguishes your goods or services from others. It may comprise of words, signatures, logos, shapes, 3D marks, colours and sounds.

If I've got my company registered at Companies House, do I still need to register my trade mark?

Yes. It is a common error that registration of a company name provides trade mark protection. The registration of a company name only stops a third party from registering the identical company name. A company name registration does not enable you to stop a third party from using an identical or similar name or trade mark.

I've registered my domain name, so do I still need a trade mark registration?

Yes, the brand name element or your URL should be registered as a trade mark wherever possible, although some descriptive URLs are not suitable for TM protection. As a general rule, domain names are issued on a first come first served basis, taking no account of existing trade mark registrations. Our trade mark attorneys will be happy to advise on whether your URL can be registered as a trade mark.

Does writing TM after my logo give me any protection?

Writing TM indicates to others that you consider the logo to be your trade mark, albeit that it is unregistered. Whilst in the UK unregistered trade marks are given some protection under common law, this is no substitute for registering a trade mark. Furthermore, there is little protection in most other EU countries for unregistered trade marks.

Deciding on your trade mark

What trade marks can be registered?

Any sign capable of being represented graphically that can distinguish the goods or services from those of other traders may be registered. Trade marks that are descriptive of the goods or services or are of a laudatory nature are not generally susceptible to registration. A trade mark application which is identical or confusingly similar to an existing trade mark registration is likely to be opposed.

What trademarks should I cover?

A trade mark will only provide protection for the goods/services listed in the application. For administrative purposes, goods and services have been classified into 45 classes and a full list is available at <http://www.ipo.gov.uk/types/tm/t-applying/t-class.htm>

I want to use a product name which I think is a trade mark owned by someone else but I don't think they use it any

more: can I just go ahead and register the trade mark for myself? Unless you know for sure that a mark is not registered then you should seek professional advice from a trade mark attorney, who can conduct investigations and advise how to avoid any potential trade mark dispute. For example, if the mark is registered but is no longer needed by the third party, it may be possible to purchase the registration, or alternatively to apply to have it cancelled.

I want to register the name of my business, but I know that someone already uses a trade mark with the same name. They are not in the same industry as me; can I still register my business name?

Probably; it depends on the goods or services for which the existing trade mark is registered. It is unlikely, for example, that car repairers would have a registered trade mark for goods and services which conflict with those provided by a clothing company. However, you should ask a trade mark attorney to conduct a search before an application is filed to register your trade mark; this should alert you to any potential difficulties.

Trade Mark registration

How can I get foreign trade mark protection?

Overseas trade mark protection can be obtained by filing separate trade mark applications in each desired country. However, a cheaper option to secure trade mark protection in several foreign countries is to file a Community trade mark application (CTM) or an international trade mark application through the Madrid Protocol. A CTM registration extends to all of the countries of the European Union. A Madrid Protocol registration must be based on an existing UK registration and may extend to any of the countries party to the Madrid Protocol, which includes more than 80 countries. Each country examines an international registration and may accept or refuse to grant protection, and the international registration remains effective in the countries that accept it. Our trade mark attorneys are experienced in developing international trade mark portfolios for clients and would be happy to advise you.

How long does a trade mark registration last?

A trade mark registration lasts for an initial period of 10 years and can be renewed indefinitely for similar periods subject to paying renewal fees.

Once I own a trade mark registration, do I have to use it?

Yes. If you don't make use of your trade mark then after a period of time (5 years in most jurisdictions) a third party can apply to have your registration cancelled.

Benefits of trade mark registration

What legal rights does a registered trade mark give me?

The owner of a valid trade mark registration has exclusive rights in the relevant country/territory to use that mark in relation to the products and/or services for which it is registered.

When can I use the registered trade mark symbol?

Only after you have registered the trade mark. It is generally an offence in most countries to use the ® symbol unless you own a registered mark.

I am thinking of making my business into a franchise operation: should I register my trade mark?

The value of your franchise is connected to your brand, which needs to be fully protected by registration as a trade mark. When you sign up franchisees, they will be paying you for the right to use your trade mark under licence. If you fail to register your brand as a trade mark, your franchise operation could effectively be worthless.

Enforcement of trade mark rights

Someone has just registered a trade mark to which I believe I own the rights: what can I do?

Depending upon the circumstances, there are various options available to you to challenge or remove a third party's registration. A trade mark attorney will be happy to review your individual circumstances and explain to you how best to protect your interests.

I think that a competitor has infringed my trade mark registration: what should I do?

Seek early professional advice. In matters of infringement, the earlier you seek advice the better as inaction can adversely affect your rights. Don't risk approaching or writing to the suspected offender yourself as the law may protect them from unjustified threats of action.

I suspect that a competitor is using my trade mark to attract visitors to their website using pay per click advertising: what can I do?

Currently the use of trade marks in pay per click advertising is a grey area in law. However, if you own a trade mark registration you are much better placed to win a legal action. Seek up-to-date legal advice from a trade mark attorney.

Note:

The above Questions and Answers are only intended to provide general information; for advice on specific situations, you should always consult your trade mark adviser at Mathys & Squire.