

Talking trade marks

Mathys & Squire is one of Europe's most established and well-regarded specialist intellectual property (IP) firms. Since our formation in 1910, we have been committed to building a genuine partnership with our clients.

We advise large UK and multinational clients on their global brand portfolios and have a strong working knowledge of the issues brands face in many sectors and jurisdictions.

What is a trade mark?

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. If you plan to sell your goods and/or services under a brand name, then the simplest step you can take is to register that brand name as a trade mark. If your reputation for your goods and services is what makes the difference for you, then a trade mark is the best form of defence for your reputation. Don't think that putting the letters TM after your name is enough – they might well serve to deter some from misusing your brand but the sign does not carry any legal weight in a courtroom fight.

Why do I need to protect my trade mark?

Companies invest significantly in their brands and it becomes an integral element of their identity. Without legal protection (in the form of a registered trade mark), they have very limited ownership of that brand and will struggle to stop others 'riding on their coat-tails'. An example of this is a football club. The club will sell replica shirts, scarves and hats, as well as posters, lunch boxes, pens and even screensavers containing their mark, and not just here in the UK, but internationally to fans around the globe. Much of the income for the club might come from the sale of branded goods. Counterfeit goods on which no royalty has been paid can make a serious dent in a business's finances, as well as damaging its reputation if the quality is not up to standard.

Trade mark protection provides you with the legal right to stop others from using the brand which you have invested in developing. Moreover, it is a company asset that can grow in value significantly. Coca Cola® is probably the best known brand in the world and of its estimated value of \$60 billion over 75% is associated with the brand alone. Little wonder that they take their trade marks very seriously. If a company is precluded from using one of their core brand identifiers, or if somebody else attempts to use that brand for their own commercial activity, this can be extremely damaging to ongoing sales. An example might be Toblerone®. Through its continued use of its triangular shape for chocolate and its various trade mark registrations, it has the exclusive rights to produce triangular chocolate bars. Any competitor producing chocolate of a similar shape could be infringing Toblerone's trade mark, and chocolate goods could, and have, been removed from the shelves and destroyed for such an infringement.

Why do I need to conduct an official search of currently registered trade marks?

Why invest thousands in the development of a brand if you are not certain that you can freely use or protect that brand in the future?

Many people believe that an in-depth Internet search alone can provide enough certainty and security that there are no other trade marks similar to theirs in existence. Unfortunately this is not the case. A quick search of the UK IPO website will provide a very limited snapshot of the register, one which cannot provide certainty for any brand owner. Furthermore, many believe that a Companies House registration equates to protection of your brand: it does not.

An official search will look through the UK, European and international registers in order to identify all potential legal risks to the adoption of a trade mark in the UK. For example, there are a number of ways of spelling a word that sounds the same; only one of these will be highlighted when searching against certain words.

Trade mark infringement is not only committed by the use of an identical mark, it can be committed by the use of a similar mark (whether that be in look, sound or meaning) in relation to similar goods. In some circumstances, use of a mark on wholly dissimilar goods could even constitute infringement, an act for which you can be sued. It is therefore imperative for you to ensure that you are free to use your proposed brand prior to embarking on a branding exercise. If you do not, you could find yourself the subject of costly legal proceedings, having spent a significant sum in developing a brand which you cannot ultimately own or use.

Why spend on intellectual property in addition to all other associated branding costs?

The costs incurred in branding, developing a logo, a website, promotional campaigns and so on, could all be completely wasted if you do not check whether that trade mark is free to adopt at the outset.

If someone else uses or has registered the same or similar trade mark, they may have the legal right to stop you trading and you could therefore have to go through the entire re-branding process again.

Why not file myself at a reduced cost?

Trade marks are not just branding tools, they are legal rights. This in itself suggests that the 'easy route' of filing independently should be avoided where possible. The UK IPO website will provide you with some guidance as to how to file and the types of goods/services included within each class. These are mere indications. There are thousands of terms that can be used to protect the relevant goods/services and the classes are not always obvious. Only a legal representative who formulates these specifications on a daily basis will know how to protect your trade mark on the register and what to cover in order to ensure the broadest and most profitable protection. By not seeking legal advice, you are taking the risk that you do not protect your commercial interests suitably from the outset, which could affect your business further down the line. Should you choose to protect your brand at a later date, there is a threat that someone else may have already filed a similar, if not identical, trade mark to yours already.

Even with legal representation, trade marks are affordable assets to obtain. They can provide protection for 10 years initially and this period can be renewed every 10 years. This is a legal asset that could serve you indefinitely. Why take such a risk at the imperative stages of a business and not seek legal representation?

What is next?

Trade marks often operate on a 'first to file' system and as such, all interests should be protected at the outset (insofar as they are envisaged). As such, consider what your key brand identifiers are, where you plan to expand the business geographically and what products/services you intend to sell under the brand. Consider where you wish to manufacture and distribute the products for sale under the brand, or if you intend to licence it. Then seek legal advice so that an appropriate IP strategy can be put in place to ensure secure and profitable growth in the future.

Following the registration of your brand, watch services can be implemented for a minimal annual fee. This service notifies your representative whenever a new application is filed for a trade mark which could be deemed confusingly similar to your own. A registered trade mark attorney will then report these to you with advice as to the potential risk and the best course of action.

What do I do if I feel someone has infringed my copyright?

Copyright is a vast subject because copyright applies to so many different areas. For example copyright applies to dramatic works, music, literary works including song lyrics, website copy, instruction manuals, books and business reports, artistic works including photographs, paintings, sculpture and even a work of artistic craftsmanship like a piece of jewellery or a carved feature in a fitted kitchen.