

Trade Marks Basics

www.patentable.co.uk



1. The purpose of this document

This document answers some very basic questions that are frequently asked about trade marks.

2. What is a registered Trade Mark?

A trade mark is a sign used in the course of trade that distinguishes the goods/services of one trader from those of another. A trade mark may be in the form of a word, a slogan, or a logo or even in the form of the shape of the goods being sold, the shape of the packaging in which the goods are sold, or a particular colour. Trade marks are commonly referred to as brands.

In the UK, property rights in a trade mark may be obtained through registration of the trade mark at the Trade Marks Registry. Trade marks may also be protected in the UK by means of a European Community Trade Mark Registration or by means of an International Trade Mark Registration.

3. Do I need to register my Trade Mark?

It is possible in the UK to acquire some rights (e.g. common law rights) solely through use of a given mark. However, the law in the UK generally favours the first person to register a mark, rather than the first person to use the mark. It is therefore generally advisable to register, if possible, any trade mark you wish to use and monopolise.

Registration of a trade mark allows action to be taken against third parties for infringement of the trade mark rights thereby afforded. Without a registration of the trade mark it might prove difficult, if not impossible, to prevent such unauthorised third party use. It is also likely to prove more expensive to take legal action without a registration.

Also, by not registering a trade mark, it might be open to a third party to apply to register a similar or identical mark in respect of similar or identical goods. Even if you have been using your trade mark before the date on which the third party applies to register the later mark, the registered rights could restrict your future commercial activities and in particular your ability to expand into new markets (whether new geographical markets in the UK or new products/services). In the worst case, you may have to cease use of your mark.

4. Are there any conditions which the Trade Mark has to satisfy in order to be registrable?

Yes. The trade mark must be registrable on absolute grounds of registration, that is to say be inherently registrable; see below under point 10 for further details.

Before a mark can be registered, it must also be published so that third parties can lodge opposition.

5. Should one have searches for earlier rights conducted?

Whether or not you choose to have searches conducted will depend on whether you have been using your mark for some time, your commercial position and whether the cost of the searching is justifiable in the circumstances. Before one adopts a new trade mark it is always advisable to have searching conducted in an attempt to ascertain whether the mark is free to use. If there are third party rights that you might infringe by using a given trade mark it is of course preferable (from a legal point of view) to adopt a different trade mark at the outset. Some clients choose not to have any searching conducted (in order to save on costs) and to accept the risks associated with proceeding in that way.

6. How do I apply to register my Trade Mark in the UK?

We would recommend that you consult a trade mark attorney before filing a trade mark application. It is of course possible for you to file an application yourself without being represented by a trade mark attorney.

A UK trade mark application should be submitted to the Trade Marks Registry at the UK Intellectual Property Office on a Form TM3 (if submitted on-line, the official fee is lower). To complete the form it will be necessary to have at least the following information:

- A representation of the trade mark;
- A specification of the goods/services in respect of which protection is to be sought and an indication of the relevant class(es); and
- Details of the Applicant for registration of the trade mark.

The form includes a declaration that the trade mark is being used by the applicant or with the consent of the applicant, in relation to all of the goods or services specified, or that there is a bona fide intention that it will be so used.

7. What should be included in the specification of the goods/services?

The specification of goods/services defines the scope of protection that is conferred by a trade mark registration. However, the application form includes a declaration stating that the trade mark has been used in respect of all the goods/services specified or that there is an intention that it will be so used. Therefore, the specification should ideally cover all those goods/services of commercial interest to

the applicant under the mark, but should not specify any goods/services where there is no intention to use the mark. It is common practice to define the goods/services with both specific terms and also broad “catch-all” terms. For example, if a specification of goods includes “bacon” and “gammon steaks” it might also be advisable additionally to include terms such as “pork products” and “meats”.

8. What is the classification system?

In order to assist in searching for earlier conflicting rights the Trade Marks Registry (and many other registries around the world) classify the goods/services in respect of which trade mark applications are filed into 45 separate classes under the Nice Classification System, details of which are published both by the UK Patent Office and WIPO. At the time of writing the Classification System in force is the 9th Edition. Whilst similar goods/services are grouped in the same class, it is entirely possible for use of a sign in relation to goods that would be classified in one class to infringe a trade mark registration relating to goods classified in a different class.

9. How does the Trade Mark Registry examine the application?

The Trade Marks Registry will examine the Trade Mark on absolute grounds (inherent Registrability – see below) and also conducts a search for earlier trade mark applications or registrations having effect in the UK.

10. What are “Absolute Grounds” of registrability?

A trade mark may be refused registration under any of the following absolute grounds of refusal:

- the sign can not function as a trade mark,
- the trade mark is not sufficiently distinctive,
- the trade mark is simply descriptive of characteristics of the goods/services,
- the trade mark is generic, and
- the trade mark is deceptive.

Most of the absolute grounds for refusal exist to protect the public from traders obtaining rights in signs that should be free for everyone to use. One would not expect to be able to obtain an absolute monopoly in the word “FAST” for cars, for example. Some of the absolute grounds for refusal can be overcome if the trade mark has acquired a reputation or distinctiveness through use of the mark. Thus, it may be possible for marks that would otherwise be non-distinctive or descriptive to become registrable after sufficient use has been made of the mark.

Other absolute grounds for refusal exist, but the ones listed above are the most common absolute grounds under which trade mark applications are rejected. We would of course be pleased to advise you on the registrability of a given trade mark in relation to possible absolute grounds for refusal.

11. Does the UK office object to new applications on the basis of earlier rights?

No. Until 2008, a trade mark could be refused registration by an Examiner at the UK Trade Marks Registry if it conflicted with an earlier trade mark right. The position is now that the UK Trade Marks Registry will accept for publication any Application for a mark which it deems inherently registrable, irrespective of whether it appears to be in direct conflict with an earlier mark. It is then up to the owners of earlier rights to lodge opposition if they wish to prevent the later mark proceeding to registration. In the event of an opposition, the UK Trade Marks Registry will then determine whether the opposition should succeed applying principles and legal guidance provided by case-law, in particular, that developed by the European Court of Justice.

12. Can third parties object to my Trade Mark application?

Yes. As part of the application process, once a trade mark is accepted by the Trade Mark Registry for registration in the UK it is advertised in an official Trade Marks Journal for the purpose of allowing third parties the opportunity of opposing its registration.

Opposition may be filed within a period of two months beginning with the date on which the application was published, although it is possible to extend that period by one further month.

13. Do I need to have used my Trade Mark before I apply to register?

There is in the UK no need to have used a trade mark before applying for its registration. There is however a requirement that the applicant for registration of the trade mark has a bona fide intention to use the trade mark in respect of all of the goods/services specified. A declaration relating to that requirement is included on the trade mark application form (TM3).

14. How much does it cost and how long will it take?

Preparing and filing a single UK Trade Mark application covering goods/services in a single class (where we have been provided with a list of goods/services and are provided with all other necessary information) would involve costs of the order of

£500 (plus VAT if applicable). Of course we would be pleased to provide further details on our costs in relation to a specific case.

15. How long does a Trade Mark registration last?

Trade marks renewed or registered under the 1994 Trade Marks Act are registered for a period of ten years from the date of filing (or from the date of expiry of the last period). The trade mark may be renewed for further periods of ten years. A trade mark may therefore be protected indefinitely.

16. What protection does a Trade Mark registration afford?

A UK registered trade mark enables the proprietor to prevent use by an unauthorised third party of an identical trade mark in respect of goods/services identical to any of those for which the trade mark is validly registered. Also, unauthorised use of an identical or similar trade mark in respect of identical or similar goods/services may be prevented if, because of the similarity, there exists a likelihood of confusion on the part of the likely customer. Further rights are afforded to trade marks that have become particularly distinctive or famous by virtue of the significant use made by them. Various defences to infringement of registered trade marks exist and we recommend that you contact a professional advisor for further advice if necessary. We would of course be happy to provide further assistance if required.

17. How do I obtain protection abroad?

A UK registered Trade Mark affords protection in the UK only. If you wish to obtain exclusivity over the mark in other jurisdictions separate applications must be made abroad. There are various means of obtaining foreign trade mark protection. Three important mechanisms, explained briefly below, include “claiming priority” (under the Paris Convention), filing a Community Trade Mark Application and filing an International Trade Mark Application (under the Madrid Protocol). We recommend that you contact a firm of Trade Mark Attorneys, such as ourselves, for further information and advice.

18. Claiming priority (the Paris Convention)

Most commercially important developed countries in the world (over 150 in total) subscribe to The Paris Convention. The effect of the Convention is that the first trade mark application filed in respect of a trade mark for given goods/services gives rise to a priority right, whereby a foreign trade mark application filed for the same trade mark has the benefit of the earlier filing date of that first application insofar as the goods/services are the same, provided that the later application is filed within six months of the first application. In other words, the Paris Convention

allows an applicant the option for six months to file abroad for foreign trade mark protection without losing the benefit to the earlier filing date.

19. Community Trade Mark applications

A single application may be filed covering all 27 countries of the European Community. The cost of filing such an application is significantly less than the cost of applying to register a trade mark in the countries individually. When more than a few EU countries are concerned, filing a Community Trade Mark Application has several advantages over filing separate trade mark applications in the individual countries.

20. International Trade Mark applications

A single application may be filed in English covering a selection of the many countries that are now a party to the Madrid Protocol, which governs the filing and prosecution of International Trade Mark Applications. There are currently over 80 contracting parties including the European Union, Switzerland, several Eastern European countries, the US, China, Japan, South Korea, Russian Federation, Singapore, Turkey, Australia, and Cuba.

If more than three Madrid Protocol countries are of interest the cost of filing a Madrid Protocol application will probably be significantly less than the cost of applying to register a trade mark in the countries individually. If you are considering filing a Madrid Protocol trade mark application we recommend your contacting us so we might explain the various advantages and disadvantages in obtaining trade mark protection via that route.

21. Do I need to be represented by a Trade Mark Attorney?

If you are based in the UK there is no legal requirement to be represented before the Trade Mark Registry. However, the process of obtaining, enforcing and maintaining a UK trade mark registration can involve complicated legal issues, where it would only be sensible to seek professional advice. Abel & Imray is of course able to provide such advice and trade mark attorneys of this firm are members or fellows of the Institute of Trade Mark Attorneys (ITMA).

22. Must I use a Trade Mark once registered?

No, but the trade mark must eventually be used, if the registration is not to fall vulnerable to attack through non-use. A registered trade mark may, on application by a third party, be revoked if, for a continuous period of five years after the date of registration, there has not been genuine use of the trade mark in respect of any of the goods/services in respect of which it is registered. The trade mark may thus be cancelled insofar as it covers goods/services where there has been no use.

23. What are common law rights and rights in passing off?

Common law rights are rights acquired through use of a trade mark (whether registered or not) that allow a trader to prevent a third party from “passing off” his/her goods as those that are sold under the mark.

In order to succeed in a case of passing off it is generally necessary for the claimant to prove that:

1. the claimant’s trade mark has acquired a reputation/goodwill in the UK
2. that the defendant has made a misrepresentation (e.g. a misrepresentation resulting in the public being confused as to the origin of the goods provided by the defendant), and
3. that the misrepresentation has, or will lead to, (financial) damage to the claimant. Taking a case to court can involve costs significantly greater than the costs that might be incurred if the defendant were clearly infringing a registered trade mark. Rights acquired through use of a mark are generally limited to the geographical region in which the mark has acquired the reputation. Therefore if the mark is only well known on a local level, there may be no case under the law of passing off for preventing a trader from adopting an identical mark in a different part of the UK.

It is generally advisable to seek to register important trade marks rather than simply relying on rights that are acquired through use of a mark. (See also the advice given under the heading “Do I need to register my Trade Mark?”)

Important Note

Trade Mark law, procedure and strategy have many complexities and subtleties. Therefore this document cannot be taken as the basis for action; you should take advice in any particular case.

Abel & Imray
October 2011



23 Windsor Place,
Cardiff CF10 3BY UK
t: +44 (0) 29 2034 7030
f: +44 (0) 29 2066 6637

Westpoint Building,
James Street West,
Bath BA1 2DA UK
t: +44 (0) 1225 469 914
f: +44 (0) 1225 338 098

abel
& imray

patent attorneys
trade mark attorneys

20 Red Lion Street
London WC1R 4PQ UK
t: +44 (0) 20 7242 9984
and + 44 (0) 20 7405 0203
f: +44 (0) 20 7242 9989

e: ai@patentable.co.uk
w: www.patentable.co.uk