

## TRADE MARKS

### General

A trade mark is a legal means to protect a brand. Trade marks are protected by registration in the Trade Mark Registry.

Trade marks serve as an indication of the origins of a particular good and give assurance to the public. A trade mark indicates to the consumer a certain level of quality and is a symbol for the investment, advertising and building up inherent in the brand.

Trade marks originally applied only to goods but now apply to both goods and services. A trade mark gives the owner certain exclusive legal rights. Trade mark registration can last indefinitely.

The registration of the trade mark provides significant protection. It is quicker, cheaper and far less uncertain to sue for breach of a trade mark, than to take a legal action for “passing off”. A trade mark is presumed to be valid and puts the claimant in a very strong position. The claimant does not need to prove reputation or prove that the competitor or other party is providing goods or services which are confusingly similar.

The public record of trade marks means that third parties can verify if a similar name has been registered or applied for. This acts as a disincentive to those seeking to register a similar name or mark. A trade mark can be registered before it is used. This effectively reserves the particular mark logo or name. It is not necessary to wait until the brand or reputation has been built up.

Failing to register means that another party may register the same mark while the business reputation is being built up. A trade mark can be struck off for five years non use, so it is not possible to raise a purely defensive mark forever.

## **Criteria for Registration**

A trade mark cannot be registered if its use could be prevented by a third party on the grounds of passing off. There must be some use of the trade mark in connection with goods and services.

A trade mark is any sign which is capable of distinguishing goods or services of one business from those of another. A trade mark could be a word or could be a sign. A trade mark could be a shape name, a jingle, a logo or anything capable of distinguishing one product or service from another. A combination of colours or lines could be registered as a trade mark. It is not permitted to register a common English name in relation to a product as it will not distinguish the products of one business from another.

A trade mark must be registered in relation to specified type of goods and services. This must be entered on the particular Trade Mark Register. The famous Coke Cola trade mark is registered as in a class in connection with “beers and non alcoholic drinks” and is described as “syrup for use in making a beverage”.

Trade marks are divided into 44 classes. A trade mark can be registered for several different classes. This is relevant where companies seek to transfer the brand for trade mark from one type of product to another using the strength of the first brand.

A trade mark must be distinctive. Indications of kind, quantity, purpose, graphical origin or similar characteristics will not be generally trade marks as they do not indicate the distinct character of one good against another. Marks which are descriptive of the kind of quality of goods or services can't be registered (for example cornflakes is descriptive). A trade mark can be distinctive because it is a “made up” name e.g. “Kodak”. Because a trade mark gives them a monopoly right it is difficult to obtain and is usually refused for common names, surnames or forenames.

Descriptions of quality especially in the praising sense are not registerable. The best kind of trade marks are the ones with no connections with the characteristics for example Mars or Galaxy for confectionery. Most geographical names will not be

registerable as trade marks. If the geographical name is incorrect it would be misleading and therefore unregistrable. It is generally not possible to monopolise a geographical name.

It is possible for trade marks which offend the above criteria to be registered in a more restrictive fashion, if the brand is already well known and failure to register would unfairly deprive the owners of the benefit of a well established brands. For example, if a reputation in a descriptive mark has been built up and made, thereby making it distinctive through use, it can be registered.

Trade mark applications are published and third parties can oppose them. A trade mark may be revoked because it is misleading.

A trade mark can become generic as a result of action or inaction, if becomes a common name for the goods concerned. In this case, the trade mark no longer distinguishes the goods or services from business to another. Good examples would be Hoover, biro, etc. They were once registered trade marks but have now lost their ability to distinguish.

It may be possible to prevent a trade mark from becoming generic by using a particular script or font or putting it in bold or quotation marks.

### **Infringement of Trade Marks**

An infringement of a trade mark may take place where it is used in the course of a business by a third party. It will not generally be infringement for a third party merely to use the trade mark. For example the photography or painting of a trade mark itself would not constitute a breach of the trade mark.

There are four types of infringement:

- the use of identical goods for identical goods and services

- the use of a similar sign for similar goods and services if there is likelihood of confusion
- use of a similar sign for dissimilar goods if the use is detrimental to the distinctive character or reputation of the mark
- the use of a trade mark which is not in accordance with honest practice

Honest use is not an infringement provided it does not over step the boundaries. It is a defence to trade mark infringement or that it was not validly registered and should be removed.

An infringement on a trade mark is enforceable through legal action by its owner. The court is allowed to make an award of damages or grant an injunction to stop infringement. The Court can also order the offending trade marks to be erased from the offending goods or order the destruction of the goods. Certain goods can be seized. The offending goods can be ordered to be delivered and handed up to the owner of the trade mark.

### **International Elements**

Trade marks are national rights so the infringement must be in the U.K. in order to be protected under UK law. Intellectual Property Law is United Kingdom wide and not just England and Wales.

If a trade mark is well known in the U.K, then its foreign owner may be able to get an injunction to sustain the use in the U.K. if it would cause confusion. This protects foreign trade marks that are not registered in the U.K. An example might be a well known shop or restaurant with no branches in the U.K.

The registration of a trade mark in the U.K. will give protection in the U.K. It is necessary to make a separate application in other jurisdictions to obtain protection. However within Europe there are certain wider protections available.

The European Union allows for Community Trade Marks that give protection throughout the European Union on the basis of one registration. The difficulty is that it can be defeated by similar trade marks registered anywhere in the European Union. The European Union System does not involve extensive investigation of existing marks but leaves the owners of existing marks to object to published applications. If the application is unsuccessful they are left with the possibility of applying to countries where there is no problem in order to get a bundle of national register trade marks.

It is a principle of European Law that goods put on the market in one country in the EU can be legitimately be sold under that trade mark in another country.

There is a system which permits application in one country initially which is followed by an application for registration in all other countries which are members of the Madrid protocol. This is run by the World Intellectual Property Organisation.

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This Guide is intended as an overview and broad outline of the matters covered in it. Its purpose is to inform and raise awareness. We are happy to offer specific legal advice on particular circumstances.

This Guide should not be relied on as a substitute for comprehensive legal advice with reference to the particular circumstances.

While we have taken due care in the preparation of this publication, we do not accept legal liability as a result of any reliance placed on anything in this Guide. The reader should rely only on specific legal or taxation advice.