

TRADE MARKS

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As a firm of Chartered and European Patent Attorneys and Trade Mark Attorneys, we act in all professional matters relating to patents, designs and trade marks. This note provides a brief explanation of the topic of trade marks. Separate notes are available regarding patents and regarding designs and copyright.

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Trade Mark Rights

There is no legal requirement in the United Kingdom or the European Union that any word, logo, or other matter used as a trade mark be registered. Indeed, there are some trade marks in use which, for a variety of reasons, have never been registered. However there are a number of advantages in registering a trade mark. For example, registration grants the proprietor a statutory monopoly in that, subject to certain terms and conditions, it confers upon the proprietor the exclusive right to use of the trade mark for the range of goods or services for which registration is granted and for similar goods and services. If

infringed and held valid, this right will be upheld by the Courts, which may, on successful application by the proprietor, grant an order including:

- (1) an injunction restraining further infringement of the registration;
- (2) the delivery up for destruction of any goods marked with the infringing mark as well as of deceptive labels, advertising material, and the like; and,
- (3) damages or profits in respect of the past infringement.

The Advantages of Registration

Under British law it is possible to acquire certain rights in an unregistered trade mark solely through use. However, the action (commonly called "passing-off") to restrain use of the same or a confusingly similar trade mark by a competitor is under common law and is different from an action for infringement of a registered trade mark.

For example, in an action for infringement of a registered trade mark, once the proprietor has proved that the defendant is using the same or a confusingly similar trade mark in respect of the same or similar goods or services to those covered by the registration, the burden shifts to the defendant to establish some defence.

On the other hand, in an action under common law in which the trade mark is not registered, the proprietor has to prove: (a) that he is the proprietor of the trade mark; (b) that the proprietor has an exclusive reputation in the trade mark; (c) that the defendant's activities will

probably lead to confusion; and (d) that this confusion is likely to damage the proprietor's trade. It will be appreciated that this can be, and often is, a formidable task.

Further, a mark that is first used for example within only a part of the United Kingdom will be vulnerable to remaining geographically limited. Thus a third party may be able to obtain a valid registration for a conflicting mark in the United Kingdom and in this way prevent the first user from extending his business under the mark beyond its original boundaries.

It should also be remembered that in many countries, and significantly many countries of the European Union, it is generally not possible to establish rights to a trade mark through use. To obtain effective protection in such countries, a mark must be registered either nationally in the country concerned or through a Community Trade Mark Registration (CTM) for the countries of the European Union.

However, probably the most common job which a trade mark registration does is one

about which the proprietor very rarely learns. Before a trade mark can be registered, examiners at the UK Trade Marks Registry will conduct searches of the United Kingdom and CTM registers to ensure that the trade mark will not conflict with existing registrations or applications. Accordingly, many traders, and virtually every major British and international company, will conduct searches of the relevant registers before adopting a new trade mark to ensure that the new mark will not conflict with an existing registration. If confusion with an existing registration seems likely, the proposed trade mark should not be, and usually is not, adopted for use. Accordingly, a registration may protect the proprietor's interests many times over during its lifetime without the proprietor's knowledge.

Searches

As indicated earlier, before any commitment is made to a trade mark, and in view of the powerful monopoly which a trade mark registration confers on its owner, it is important that

searches be conducted to ensure that there is no conflicting mark registered in the country or countries in which the trade mark is to be used. We can carry out such searches or arrange for such searches to be carried out, and can advise on what action might be necessary in the light of the results of the searches.

Applying for registration

Trade marks are registered in respect of specified goods or services in any one of 45 classes. In the UK, additional fees are payable for each class of goods or services claimed in the application, and in the EU such additional fees are payable after the third class claimed.

The resulting registration will remain in force for ten years from the date of the application. The registration can be renewed indefinitely for subsequent periods of ten years at a time until no longer required.

Overseas protection

A British registration provides protection only within the United Kingdom. A Community Trade Mark registration (CTM)

provides protection in the UK and in each of the other 26 countries of the EU. A business involved in the export of goods or the supply of services outside the UK should therefore always consider securing protection for its trade marks in the relevant territories. As stated earlier, many countries do not provide for common law rights established through use of trade marks. The only means by which protection may be secured in these countries is by registration of the trade mark. Indeed, in many countries it is the first applicant for registration who will be granted registration whether or not there is an earlier user of the trade mark. In this connection, whilst many commercial agents and distributors are entirely trustworthy, it is not unusual for a distributor in a particular market to register his supplier's trade mark in his own name. Usually, but not always, such misappropriation can be remedied, although almost certainly substantial legal

fees are incurred which could otherwise have been avoided.

There are now three different routes available to a UK applicant wishing to protect a trade mark overseas. First, national registrations may be obtained in each of the relevant countries. Second, all the 27 EU member countries may be covered by a CTM. Third, many countries, including most of the countries of Europe, the USA and Japan, may be covered by an International Registration under a treaty known as the Madrid Protocol. Which of these methods of protection is most cost effective for a given business needs careful consideration and will depend on the individual circumstances of the business concerned.

Please contact us if you require any advice or assistance in connection with trade mark matters.

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