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TRADE MARKS

AN INTRODUCTION



The Institute of
Trade Mark
Attorneys

A Word:

**"WANDERING
MONKEY"**

A Jingle:

*"Air on a
G-string"*

Hamlet Cigars

**A Form of
Packaging:**



**A Personal
Name:**

Cadbury's

A Sound:

**A barking dog –
Dulux**



A Slogan:

*"It's the
Real Thing"*
Coca Cola

Letters:



A Number:



Why does business need trade marks?

Business puts a lot of time and money into developing and marketing a product or service. By giving the product or service a trade mark, the public can readily identify that it has come from a particular company.

It gives brand recognition and helps guarantee the origin, quality and consistency of the goods or services. It allows for the introduction of different products or services into the marketplace under the same trade mark by way of brand extension and effectively helps build brand loyalty.

Having a trade mark avoids confusion with others in the same line of business. It also enables action to be taken against anyone counterfeiting or copying a registered trade mark, or innocently using an identical or similar mark, for identical or similar goods or services.

For many of today's major companies a trade mark is a precious asset and can be worth millions of pounds. Like any asset, it must always be carefully looked after, using expert professional help where necessary.

Why can it pay to register trade marks?

Having a registered trade mark enables action to be taken under trade mark law. Under trade mark law the most common principal test of whether infringement has occurred is whether, due to the similarities in the marks and goods/services, there is a likelihood of confusion.

Immediate action should be taken against anyone using a confusingly similar trade mark for the same or similar goods or services. This helps to maintain the reputation built up under the trade mark. By registering a trade mark, rights to it are established even before it is used – a valuable advantage for a new product or service.

Trading Standards Officers will be able to take immediate action against counterfeiters where proof of ownership of the trade mark in question has already been established by virtue of its registration.

Rights for unregistered marks and passing off

There are also rights for unregistered marks. The UK recognises common law rights which are acquired through extensive use. Under these rights action can be taken against "passing off" if somebody is representing their goods as the goods of someone else.

The main difference between the action that can be taken to protect a registered trade mark and one that is not registered is that, for unregistered trade marks, the complainant has to prove that the mark he or she is protecting has an established reputation. The onus of proof for this falls to the complainant, whereas with a registered trade mark, mere proof of ownership of it is all that is needed without the need to prove a reputation.

What is a trade mark?

A trade mark is essentially a way of identifying goods or services; differentiating between the goods and services of one trader and another. It is something which is unique to your business and is a sign or symbol that allows for instant recognition.

It can be in a variety of forms including, for example, a word, a slogan, a logo, a jingle, a colour, a shape, a sound, letters, a number, a form of packaging or a personal name.

How do you choose a trade mark?

A trade mark is something which is going to be unique and which symbolises the goods or services on offer and can come in many forms, so long as it can be represented graphically.

The aim should be to find a mark that is distinctive, attractive and suitable, as well as being easy to remember and, preferably, easy to spell and pronounce.

Suitable trade marks are usually of three kinds:

- **invented words** – such as Google for internet services or Wii for video games;
- **words** which may suggest a particular quality but have no direct relevance – such as Virgin for airline services;
- **symbols** with no obvious relevance to the goods or services in question – such as the Nike swoosh design for sportswear.

There are, however, certain things that you cannot register other than in exceptional circumstances e.g. something that describes goods or services directly.

Signs which cannot be registered at all include:

- **Something that deceives** the public;
- **Something that conflicts** with a mark already registered or extensively used for the same or similar goods or services if the owner of it successfully opposes;
- **Signs consisting of shapes** necessary to obtain a technical result

As a rule, marks consisting of words (including common misspellings) liable to indicate geographical origin may not be regarded as distinctive enough for registration.

Can I register my company name as a trade mark?

The company's name should be registered with Companies House but that is not the same as registering the name as a trade mark. Note that no trade mark protection is given by simply registering a company name. To stop imitators effectively, the distinctive part of the company name should be registered as a trade mark. A Trade Mark Attorney will be able to advise whether the company name can be registered as a trade mark.

Can domain names be registered as a trade mark?

Domain names are registered on a first come first served basis and take no account of trade marks that may already exist. The advice from ITMA is that, where possible, domain names should be registered as trade marks as soon as possible. Similarly, it is worth considering registering a trade mark as a domain name to prevent others from doing so. Under the domain name dispute procedures the ownership of a registered trade mark can be very helpful.

How much will it cost?

The Institute of Trade Mark Attorneys does not set down a prescribed list of charges for Trade Mark Attorney fees. Costs will vary and are dependent on the difficulty of obtaining the trade mark registration sought depending, for example, on whether the application attracts objections from the examiner at the UK Intellectual Property Office ("IPO") or from third parties during the opposition stage. Costs will also vary according to the range of goods/services for which protection is required (for the purposes of trade mark registration goods and services are divided into 45 different classes) and for the country or countries in which protection is desired.

What are the other forms of Intellectual Property?

Intellectual Property, or IP, allows people to own the means of expressing their creativity and innovation in the same way that they can own physical property. Apart from trade marks there are three other forms of intellectual property:

COPYRIGHT

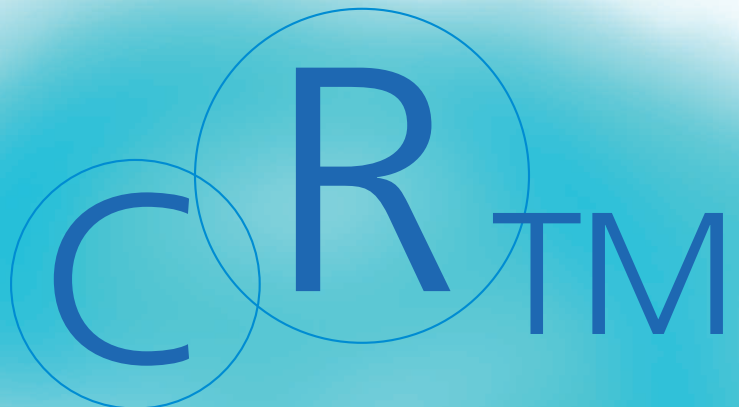
Copyright gives the creators of a wide range of original material such as literature, graphic art, music, sound recordings, films and broadcasts, economic rights enabling them to control use of their material in a number of ways.

DESIGNS

A design refers to the features of shape, configuration, pattern or ornament which can be judged by the eye in a finished article or set of articles.

PATENTS

A patent gives an inventor the right to stop others from making, using or selling an invention without the permission of the inventor. Patents generally protect functional and technical aspects of products and processes.



How do you register a trade mark in the UK?

1 Choose a trade mark

Choose a trade mark that you think is suitable and which you think meets the requirements for registration (see previous).

2 Check you can use it – search

Before launching a new product or service with a new trade mark, businesses should carry out searches to ensure they are not infringing an existing trade mark owner's rights. Checks need to be made to see whether a) anyone has already registered, or applied to register, that mark, b) anyone has already registered, or applied to register, a confusingly similar mark and c) anyone owns that mark, or a confusingly similar earlier mark, through extensive use.

It is possible to undertake limited searches without employing a Trade Mark Attorney. The IPO website www.ipo.gov.uk enables word searches of the UK Trade Marks Register on-line and the Community Trade Marks Register can also be searched online at www.oami.europa.eu. However, neither of these facilities allows searches for what might be seen as confusingly similar marks. There is, also, often a delay in posting International Registrations covering the UK on the UK register.

A Trade Mark Attorney, however, can undertake relevant searches including searching for marks which may be deemed to be confusingly similar and would use their searching expertise, experience and knowledge to ascertain whether anyone has prior claim to the proposed trade mark through use. A Trade Mark Attorney's advice is, therefore, more comprehensive.

A Trade Mark Attorney can also conduct searches in any new overseas markets for the purposes of extending use of existing trade marks for different goods or services or in different countries. They can also arrange for searches for figurative marks (logos).

3 Appoint a Trade Mark Attorney – register the mark

Trade Mark Attorneys can undertake the whole registration process for you. It is worth employing a member of the Institute of Trade Mark Attorneys (ITMA) as they are experts in this field. They can smooth the entire process and provide specialist help on all aspects of registering and protecting a trade mark.

A Trade Mark Attorney can handle the entire application process though it is possible to apply direct. Official fees are payable to the IPO whether a Trade Mark Attorney or an individual handles the application.

The IPO then examines the mark and completes a report as to whether the mark is acceptable for registration. If they raise objections they will offer the opportunity, within two months, to argue the case, if necessary offering the opportunity to appear before a Hearing Officer.

4 Opposition period

Once any objections are overcome then the application is advertised for two months in the Trade Marks Journal, a weekly on-line publication issued by the IPO, during which time anyone may file opposition against the application. This period can be extended by one month on application.

5 Registration

If no oppositions are filed, or they are overcome, then the application proceeds to registration and a certificate is issued.

What do you do once trade marks are registered?

1 Watching

Trade marks are the quality indicators of the goods or services being provided and are an important asset. As such they need to be protected.

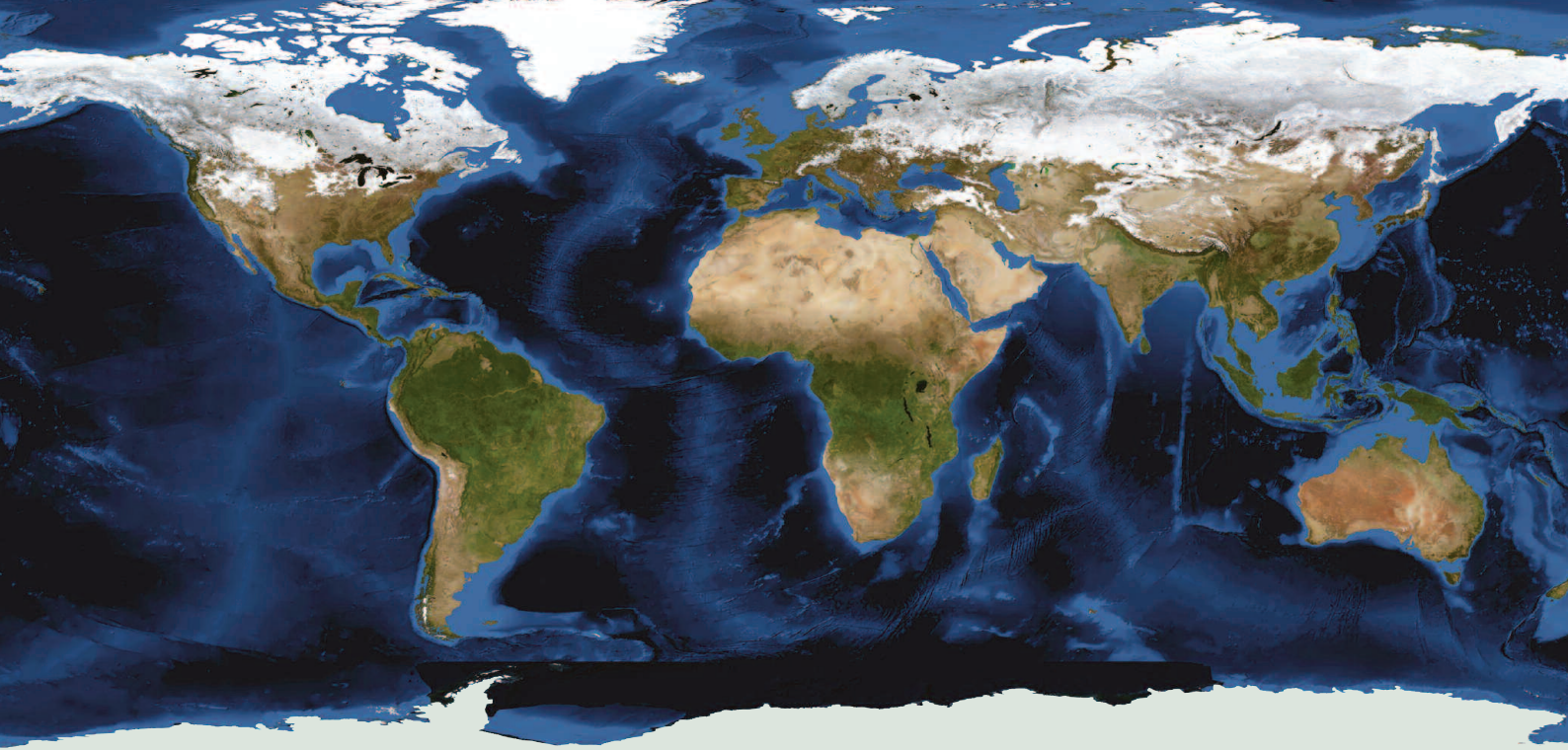
Every company should ensure that it maintains a list of its current trade mark registrations and applications, with a note of the goods or services covered.

It is good practice to appoint a named individual or department to maintain the lists. To protect trade mark rights it is advisable to keep a constant eye on newspaper articles, periodicals, trade literature and advertising in your particular field.

If it is thought any of your trade marks are being improperly used by others, action needs to be taken immediately to ensure misuse does not recur. A Trade Mark Attorney can handle any such action and offer appropriate advice. The Institute's leaflet "Best Practice on Trade Mark Use" is also a useful guide.

2 Renewal

Trade mark registrations usually last for 10 years and are renewable on request, by payment of the appropriate renewal fee. However, if they have not been used for 5 years, anyone can apply to have them removed.



How do you register trade marks overseas?

There are two main systems which allow trade mark registrations to cover several countries:

Community Trade Mark

Since April 1996, there has been a European Community Trade Mark ("CTM"), issued through the CTM Office known as OHIM – the Office for the Harmonisation in the Internal Market, based in Alicante, Spain.

A single registration gives trade mark protection in all Member States of the European Union. This system means:

- **Less to pay** – one application, registration and renewal fee
- **Less paperwork** – simultaneous registration throughout the EU
- **Lower attorney costs** – working through OHIM reduces the number of European attorneys involved
- **Faster results** – single EU application can save time over multiple national applications in individual European countries
- **Easier to apply for** compared with national applications as the application goes direct to OHIM or through the IPO.

The registration gives trade mark rights through the whole of the EU so that if it is acceptable to OHIM then the mark is protected in all EU countries. OHIM searches its own Register for similar marks and notifies the owners and some Member States also perform searches of their registers for the benefit of the applicant only. If the mark is unacceptable in one country it will be refused throughout the EU.

The Madrid Protocol System of International Registrations

Also since April 1996 UK companies have been able to register trade marks on a wider international scale through a scheme known as the Madrid Protocol. Under the Protocol, when an

applicant has registered (or filed an application to register) a mark in their own country, they can apply for an International Trade Mark to be registered with WIPO – the World Intellectual Property Organisation in Geneva – for all or some of the countries who have signed up to the Protocol.

Once WIPO is satisfied with the application, it will enter the mark on the International Register and notify the countries specified in the application. Each country usually has up to either 12 or 18 months to examine the request for protection and raise any objections.

If one or more countries object, and the case is either not argued or lost, the mark will not be accepted in those countries. However, it may be acceptable in other designated countries and the International Register, as well as the national local register, will reflect this. The advantages of registering through the Protocol are:

- **Ease of administration** – there is no need to work through Trade Mark Attorneys in every Protocol country unless you face oppositions or objections to the application in that country
- **Cost savings** – through keeping professional and official fees to a minimum
- **Flexibility** – in that you can register in one or more Protocol countries and add in extra countries at any time.

National Registrations

It is possible to apply to register trade marks in selected overseas countries, whether they are signatories to the Madrid Protocol, part of the EU, or not.

A Trade Mark Attorney can work through local associates to secure registrations throughout the world and can advise on the procedures, costs involved and mechanics of securing protection for your trade marks wherever you wish.

Symbols

The symbols most commonly associated with trade marks are R in a Circle ® and ™. It is not compulsory to use either, but you should not use the R in a Circle ® symbol unless your trade mark is actually registered. It is a criminal offence to do this.

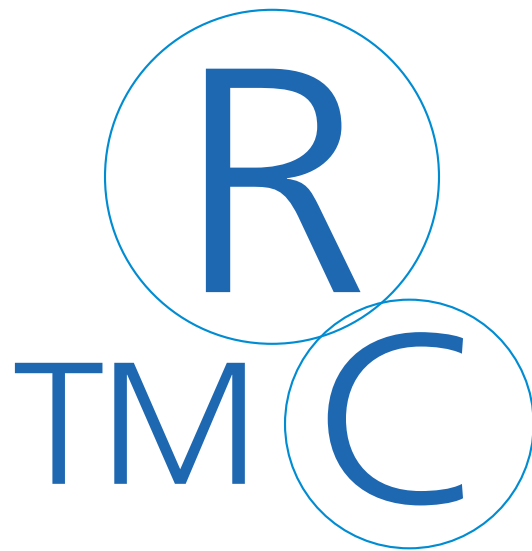
™ by the side of a word/logo or other sign can be used whether the sign is a registered trade mark or not (unregistered marks may enjoy protection if used extensively) and is often used by businesses to indicate that they consider a word/logo or other sign to be their trade mark. Alternatively, or in addition, the phrase "x is a trade mark of y" where x is the trade mark and y is the trade mark owner/company is acceptable".

The Copyright symbol of C in a Circle © is used to denote a claim to ownership in original creative works e.g. drawings, photos, text, music or a computer program. There is no UK register for copyright but it is advisable to date the piece of work and keep a record of its creation to assist with proving ownership.

What is ITMA – the Institute of Trade Mark Attorneys?

The Institute of Trade Mark Attorneys (ITMA) is the UK body dedicated to the promotion and protection of trade marks. It has around 1,600 members throughout the world in various categories of membership and is one of the few professional bodies of practitioners concerned primarily with trade mark matters.

Fellows and Ordinary Members of ITMA have all qualified to be entered on the Official Register of Trade Mark Attorneys. They are well qualified to practice in this field and are subject to stringent requirements for Continuing Professional Development (CPD) guaranteeing up to date knowledge of the subject matter.



Where can you get help?

ITMA – the Institute of Trade Mark Attorneys

ITMA can provide a list of firms in the UK in which their members work. This is also available on the ITMA website.

Contact the Institute office at:

The Institute of Trade Mark Attorneys

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Intellectual Property Office

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