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Outsourcing and Technology

The Basics - Trade Marks

A trade mark is defined as:

'Any sign which is capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.'

In essence, a trade mark can be anything, which distinguishes your business from those of other traders. A trade mark may be a word or combination of words, it may be a logo, it may be shape of your products or their packaging, it may be the colour you use to promote your goods and services, it may be a musical composition used in advertising. As long your trade mark is capable of distinguishing your business from other traders, does distinguish your business from other traders (either inherently or through use over the years) then your trade mark acts as 'a badge of origin' and is protectable.

How are trade marks protected?

In the United Kingdom, trade marks are protected in two main ways.

Trade Marks or more precisely the goodwill associated with the business conducted under the trade mark is protected via the common law tort of 'passing off'. If you can prove that you have established, via the use of the trade mark, 'goodwill' in the business associated with that trade mark, then this goodwill is protectable. Goodwill is essentially a reputation in the mark.

If another trader 'passes off' his goods or services as being yours and misrepresents in some way, either deliberately or innocently, that his goods and services are yours or you are in some way connected to him or you have endorsed his goods and services, then if you can show that you have or are likely to suffer damage as result of such use, you will have a remedy in passing off.

Trade Marks are also protected via statutory protection under the Trade Marks Act 1994. Trade Marks can be protected by registering the trade mark at the UK Trade Marks Registry. A registered trade mark in the United Kingdom is infringed by

the use of the same or similar sign in relation to the same or similar goods and services for which the trade mark is registered.

Trade Marks can also be registered in foreign countries and across the whole of the European Union via a so-called 'Community Trade Mark'. There are also various trans-national Trade Mark Registration systems such as the International system known as 'The Madrid Protocol'.

Why should I register a trade mark?

The problem with relying on passing off in the United Kingdom is that you have to first prove that you own goodwill in the business conducted under the trade mark. Also by definition passing off rights are limited to the particular geographical location within which you trade. If you have only traded in Somerset and you are only known in Somerset, your passing off rights will be limited to Somerset.

By contrast if you register a trade mark, there is a presumption that the trade mark registration is valid. Also if you register your trade mark as a United Kingdom Trade Mark Registration, your rights will cover the whole of the United Kingdom. If you register your Trade Mark as a Community Trade Mark your rights will extend to the whole of the European Union, even though you may only actually trade in a limited locality at present.

Outside the United Kingdom, rights to trade marks are often only achieved via registering the trade mark. In many countries, the proprietor of a trade mark is deemed to be the 'first to file' not the 'first user' of the mark. Therefore, it is important to obtain registered protection before someone else does.

Continued on reverse

Must I register a trade mark?

No, but for the reasons given above it makes good sense to register your trade mark. However, you do not have to register a trade mark to use it. Trade Mark Registrations are designed to stop others using the mark and are not a pre-requisite for your use. However, it is possible that if you do not register your trade mark, other traders could stop you using your mark at a later date. Also, even if you decide not to register your trade mark, you should conduct a search to determine if others have already registered the same or similar mark and thus could prevent your use of the mark.

What should I do when I have chosen a trade mark?

You should first conduct a search in the country or countries where you are to use the trade mark to determine if any others have registered the same or similar trade mark first and thus could prevent your use of the trade mark. Then, if the search is clear, you should register the trade mark to help prevent other traders using the trade mark.

How do I register a trade mark?

A trade mark is registered by filing a trade mark application at the Trade Mark Office of the country or countries where you wish to trade. Trade Mark applications can take between three months and a number of years to register, but we, via qualified Trade Mark Attorneys, can file trade mark applications and take the applications through to grant on your behalf. Please refer to our explanatory sheets on registering trade marks in the United Kingdom, internationally through the Community Trade Marks Office and through the Madrid Protocol system. Trade Mark Registrations are generally renewable every ten years, but in contrast to registered design and patent protection, trade mark registrations can be maintained indefinitely.

How much does a trade mark application cost?

The cost of registering trade marks varies from country to country. The cost of a trade mark application also depends on the breadth of goods and services covered by it. All goods and services are classified into 45 classes. The more classes covered the higher the cost of filing. We can provide fixed and detailed costs for filing trade mark applications.

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This note does not constitute legal advice. Specific legal advice should be taken before acting on any of the topics covered.

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