

# THE RIGHT TO USE



## An introduction to Trade Marks

Trade Marks are a form of intellectual property right that protect signs which are used in trade to guarantee the origin of goods and/or services.

- REGISTRABLE IP RIGHT
- PROTECTS WORDS, LOGOS, TUNES OR SOUNDS, COLOURS, GESTURES AND SHAPES
- A BADGE OF ORIGIN AND MARKETING TOOL
- PROTECT CAN LAST FOREVER, RENEWALS EVERY 10 YRS

# WHEN ADOPTING A NEW **TRADE MARK** IT IS IMPORTANT TO CHECK AS FAR AS POSSIBLE THAT USE OF THE PROPOSED MARK WILL NOT CONFLICT WITH AN EXISTING TRADE MARK

Trade Marks are a form of intellectual property right that protect signs which are used in trade to guarantee the origin of goods and/or services.

It is possible to register words, logos, tunes or sounds, colours, gestures and three dimensional shapes as trade marks. A registered trade mark provides a monopoly in that it can be used to stop all third parties without the registrant's permission from using the relevant trade mark in relation to specific goods and services. Subject to the payment of renewal fees, the duration for enforcing a Trade Mark is unlimited.

**For registration, a Mark must be used, or be intended for use, in respect of goods or services and has to be distinctive, or to be shown to have achieved distinctiveness through considerable use. Before adopting a new Mark, a check of the official Register is strongly recommended to**

**ensure there is no possible conflict with existing Marks.**

International Agreements provide for the filing of a Community Trade Mark Application which covers all States of the European Community, as well as an International Trade Mark Application which can select member States to be covered. An International Application must be based on a National or Community Trade Mark Registration or Application.

When adopting a new Trade Mark, it is important to check, as far as possible, that use of the proposed Mark will not conflict with an existing Trade Mark, particularly where a considerable investment will be required in your promotion

of the proposed new Mark. In such circumstances we always recommend that a check be carried out of at least the UK Trade Marks Register and we can assist with this matter. Where we carry out a comprehensive search, our report would analyse not only whether your use of the proposed Mark would infringe an existing Trade Mark Registration or could possibly lead to passing off under common law, but would also enable us to assess whether your Trade Mark could be registered.

If you are considering registration of a Trade Mark which you have been using for some considerable time, without problems having arisen in the marketplace, then you may consider that a register search is not required.

# THE REGISTRATION OF A TRADE MARK CAN PROVIDE SEVERAL ADVANTAGES

Firstly, your use of a trade mark without registration only establishes a “right” if you have already gained a significant reputation under your Trade Mark. Other than in exceptional circumstances, such a reputation is considered to arise only after continuous use of a Trade Mark over a number of years. Without such a right you may not be able to prevent registration by another party of the same Trade Mark, even when their Application is filed later than your first use. Such a Registration could be infringed by your continued use of the Trade Mark. Filing an application for registration at the time you adopt a new Trade Mark should thus prevent such a situation from arising.

Secondly, the rights given by Trade Mark registration are generally considerably easier to enforce against other parties than ‘passing off’ rights under common law. To rely on passing off, you would again have to show that your trade mark had gained a significant reputation through use, and usually also that confusion would be likely to arise in the marketplace.

Thirdly, the registration of a Trade Mark can act as a deterrent to other parties adopting the same or a similar Trade Mark. If such a party were to carry out their own register search before adopting a proposed Trade Mark, your registration would hopefully persuade the other party to adopt an alternative Mark.

## UK TRADE MARK APPLICATION PROCESS

1 Preparation and filing of a UK Trade Mark Application – Approximately £430 to £500 (excluding VAT) for a single Mark in a single class of goods, plus £170 for each additional class.

2 2 weeks from (1). Receiving Examination Report from UK Intellectual Property Office. Overcoming Examiner’s objections by argument. Typically £150 to £400, depending upon complexity of objections.

3 1 to 3 months from (1). Publication of Trade Mark Application. 2 month opposition period follows publication.

4 5 months from (1). Registration of Trade Mark Application. Approximately £90 (excluding VAT).

5 The Registration remains in force for an initial period of ten years, whereupon it may be renewed indefinitely for further ten year periods.