



trade marks

What rights apply?

Your brand is a key asset, reflecting the 'good will' and reputation you have built up, and this can be represented and protected by your trade marks. You can seek to register your trade mark to get an exclusive right to use it for selected classes of goods or services. Even if you don't register your trade mark, you can protect the good will in your brand by bringing a claim to stop others passing off their goods and services as yours (or yours as theirs).

| REGISTERED TRADE MARKS ® | UNREGISTERED TRADE MARKS™ (PASSING OFF') |
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| <p>You have to file an application at each relevant Intellectual Property Office to obtain national/territorial right (e.g. UK, EU, US)</p> <p>You can register any sign capable of distinguishing your goods/services from those of others, that is captured via generally available technology (logos, names, slogans, shapes, colours (Pantone/other code), jingles/other sounds (MP3 file/musical notation), 'movement' marks, holograms, smells)</p> <p>UNLESS</p> <ul style="list-style-type: none">• Devoid of distinctive character (in eyes of reasonably well informed consumer; you can show evidence of 'acquired distinctiveness' through use before date of registration)• Descriptive of goods/services (kind, quality, quantity, purpose, value, geographic origin, time of production/supply)• Generic in relevant trade (e.g. 'hoover' for vacuum cleaner)• Immoral/'bad faith' (eg no intention to use mark)• Protected sign (e.g. crown insignia, olympic rings, country flag)• Consists exclusively of characteristics that (i) result from nature of goods or (ii) are necessary to achieve a technical result (e.g. lego bricks), or (iii) give substantial value to the goods (e.g. shape of diamond)• Excluded on 'relative grounds' (conflicts with earlier trade mark (registered or not), copyright, design right or protected geographical indication/designation of origin) <p>You have to specify which (classes of) goods or services will be covered: more classes, higher cost</p> <p>Once published, your application may be opposed by anyone citing any of the above grounds. Once granted, use the ® symbol. So long as you renew every 10 years and use it, it can last forever. A UK registration typically takes 3-6 months/EU 6-9 months. UK costs £250-500 + attorney fees/EU: €600-€900 + attorney fees.</p> | <p>Sometimes known as 'unfair competition'</p> <ul style="list-style-type: none">• No registration <p>You need to bring a legal claim showing:</p> <ul style="list-style-type: none">• Goodwill: that you have a reputation in the trade mark that the public associates with your product/service• Misrepresentation: by the other person confused the public AND deceived/misled customers to believe their goods/services are yours.• Damage: to your goodwill/reputation or financial loss resulted from this misrepresentation or is likely/foreseeable. <p>Also 'reverse' passing off: of someone else's goods/services as yours and 'extended' passing off: misrepresentation of particular quality of goods/services damages another person's goodwill.</p> <p>You can use the 'TM' symbol against unregistered trade marks. You must bring a claim within 6 years.</p> <p>Try to avoid using trade marks that describe your products or services: may help SEO but harder to get registered protection. Choose a distinctive name, logo, etc.</p> |

Who owns it?

Registered trade marks: if granted, applicant will own
Unregistered trade mark: owner of business with goodwill has right to bring 'passing off' claim
HOWEVER

If you commission design for trade mark: contractor/designer will own underlying copyright/design right in image so make sure ownership of these rights is assigned to you. Designs by employees in course of employment: employer owns underlying copyright/design right.

When are trade mark rights infringed?

UNREGISTERED TRADE MARKS: you have to show 'goodwill', 'misrepresentation' and 'damage' (see above).

REGISTERED TRADE MARKS: using a sign in course of trade on goods, packaging, business papers or advertising OR offer or expose for sale or put on market goods under the sign or stock these goods to do so OR offer or supply services under the sign OR import or export goods under the sign

WHERE:

- sign is identical with registered trade mark and used for goods/services identical with those for which trade mark is registered.
OR
- sign is identical and used for similar goods/services or sign is similar and used for identical or similar goods/services AND this causes likelihood of confusion on part of public (including likelihood of association)
OR
- sign is identical with registered trade mark and used for any goods/services (whether or not identical/similar) if the registered trade mark has reputation in the relevant territory AND use without due cause takes unfair advantage of/is detrimental to distinctive character or repute of the registered trade mark

What defences are there?

UNREGISTERED TRADEMARKS: show there was no goodwill, no misrepresentation or no damage, or that you are using your own name or have other concurrent rights OR that there was undue delay before the claim for passing off was brought

REGISTERED TRADE MARKS: In accordance with honest practices in industry/commerce:

- you use the TM to identify goods/services of the TM owner and do not without due cause take unfair advantage/detrimental to distinctive character or repute of the TM OR
 - the mark you use is also registered for the same goods/services
 - you use your own name or address
- you are indicating kind/quality/quantity/intended purpose/value/geographic origin/time of production or supply etc
 - using the TM is necessary to show intended purpose of product/service (e.g. accessories, spare parts)
- you have continuously made prior use in course of trade of earlier unregistered trade mark, copyright or design right in the relevant geographic area
 - product/service with relevant trade mark has already been put on market in EEA by/with consent of trade mark owner (exhaustion of right)

How to handle trade mark claims

| WHERE TO BRING A CLAIM | WHAT TO THINK ABOUT |
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| <p>Opposing registered trade mark application:</p> <ul style="list-style-type: none">• UK IP Office (appeal from IPO to Court) <p>Registered Trade Mark Infringement/Passing off:</p> <ul style="list-style-type: none">• Online marketplace/social media internal take-down process• Court: Initial claim (cease and desist letter) then<ul style="list-style-type: none">• Intellectual Property Enterprise Court: <£500k damages claim)• High Court (damages > £500k); appeal to<ul style="list-style-type: none">• Court of Appeal (on point of law); appeal to• Supreme Court (if of great public importance)• Be ready to consider mediation/try to settle before you get to Court <p>Counterfeiting (criminal offence):</p> <ul style="list-style-type: none">• Trading Standards• HMRC• Magistrates/Criminal Court <p>(need to show intentional infringement of registered trade mark 'beyond reasonable doubt')</p> | <ul style="list-style-type: none">• Don't panic• Instruct IP attorney, at least for Court claims• For registered trade mark infringement, can claimant show all aspects of claim:<ul style="list-style-type: none">• Is there a relevant valid trade mark (all criteria met)?• Does claimant have right to bring claim (owns the right/ has exclusive licence, not left it too late)?• One or more infringing acts carried out?• No defence available?• For passing off claims, can claimant show goodwill, misrepresentation and damage suffered?• Any possible counterclaim(s) by defendant (including for groundless threats of court action for trade mark infringement)?• What do you want to achieve? (Claimant: stop others selling relevant goods/services or licence fee, or access to their IP/products in return? Defendant: right to continue selling, prepared to pay licence fee? - or have registered trade mark revoked/reduced in scope?)• Do you have time/energy/resources to fight all the way? |

What Remedies are available?

- Opposition: competitor's trade mark application refused/restricted
- Online take-down: removal of infringing goods/content from relevant site/apps only
- Settlement agreement before court decision: may be payment and/or licence grant
- Infringement: court order stopping infringing act, damages/account of profits; delivery up/destruction of infringing items; registered trade mark - affirmation of validity/revocation/restriction
- Counterfeiting: seizure of goods; fines; prison

Also think about

- Domain Names • Brands & Marketing
- Registering trading name or company at Companies House (and Trading Structure)
 - Logos, designs: Copyright, Design Rights
- Food & drink from recognised region: protected geographical indications/designations of origin
 - Licensing Your Creations, Technology & Brands
 - Online Copying