



20 FACTS ABOUT TRADE MARKS

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1. A SIGN

A Trade Mark is a visual or audible identification of goods or services offered by the owner of the mark and used to distinguish his goods and services from those of another.

2. TYPES OF SIGN

A Trade Mark may be a word, combination of words, phrase, design, logo, sound, smell or even a shape applied to the product.

3. NATIONAL CHARACTER

Trade Marks are national rights. A Trade Mark used or protected in one country does not enjoy protection in another country, where no use or registration exists. However, the protection obtained by a Registered Trade Mark can be extended to other territories by filing applications for registration in the countries of interest.

4. INTERNATIONAL REACH – ‘PRIORITY’

Protection in additional countries may benefit from the filing date in a first country, if they are filed within six months of the first application and “priority” is claimed from the first application. This allows the Trade Mark owner to ensure the Trade Mark in question is protectable in a home country before incurring the cost of an extensive foreign filing programme.

5. REGISTERED AND UNREGISTERED RIGHTS

Although we always recommend that Trade Marks be registered at the relevant Trade Mark Offices, a degree of protection may be afforded in some, albeit limited, countries if the Trade Mark has been used extensively and/or has acquired an extensive reputation through use.

However, unlike a registered Trade Mark, which provides prima facie evidence of the ownership of a Trade Mark, in the case of an unregistered Trade Mark, the owner has to prove the extent of his reputation, the fact that customers are getting confused or are likely to be confused and that damage has occurred or is likely to occur. This can be difficult and expensive to show and is another reason why registration should be sought.

6. UK TRADE MARK REGISTRATION NO1.

The first UK registered Trade Mark was for the Bass pale ale label, with its red triangle device. This was filed on 1 January 1876 and the red triangle is used on beer bottles to this day.



7. INHERENT DISTINCTIVENESS

You cannot register words which are descriptive of the character or quality of the goods/services on offer, as to do so would prevent legitimate use by others, in the same trade, who would simply be making use of the everyday meaning of the words in question. Further,

generally speaking, Trade Marks cannot be obtained for names which have a geographical reference since this would otherwise prevent others from referring to the geographical origin in relation to their own products or services.

8. SELECTING THE RIGHT BRAND

A good Trade Mark is invented (e.g. Kodak) or provides a “skilful allusion to the character or quality of the goods or services” on offer under the Trade Mark without being descriptive. The less descriptive the selected Trade Mark, the better protection can be achieved, but the harder the marketing team needs to work at the outset in order for customers to understand the meaning of the brand (e.g. Gold Fish for credit cards or Orange for mobile telecommunications).

9. TERM

A registered Trade Mark lasts indefinitely - but renewal is subject to periodic payments of a renewal fee, normally every 10 years. However, there is always a risk that a third party could apply to cancel the Trade Marks, on the grounds of non-use or that it is invalidly registered (see further below).

10. SIMILAR MARKS

An application for a registered Trade Mark is subject to a search to identify any similar or identical applications or registrations filed in relation to the same or similar goods or services.

11. SELF POLICING

In some countries, a Trade Mark application may be rejected by the Trade Mark Office if it conflicts with earlier Trade Marks. In other countries, including the UK, the onus is on the owner of the earlier Trade Mark to raise its own objections. The UK Office will advise the owners of any earlier potentially conflicting marks of the later application so as to allow them to decide whether or not to oppose the new application. However, since this is a subjective test on the part of the Office, Trade Mark owners may also use watching services which will alert them to third parties applying to register the same or similar marks anywhere in the world. We offer a watching service and can provide further details upon request.

12. OPPOSITIONS

If a Trade Mark application is opposed, the owner of the application may be liable for any costs associated with the filing of the opposition and any subsequent proceedings. However, often a compromise can be reached in which the applicant amends the specification (description) of goods or services so as to exclude those of the opponent.

13. USING THE TRADEMARK

A Trade Mark should only be filed in relation to goods and services which the applicant is already using it on, or for any goods or services in respect of it has an intention to do so in the future. Speculative applications, where the applicant has no intention of using the Trade Mark in relation to the goods or services applied for, are liable to cancellation and removal from the Trade Mark Register.

14. INFRINGEMENT

Trade Mark applications are filed in respect of specified goods and services. These are arranged in a well-defined international classification system with particular goods, such as automobiles, being in one class and, clothing for example, being in another.

This means that the same Trade Mark can be registered by different companies in respect of different goods and services as long as they are not considered to be similar, or complimentary, to each other. Further, this is not permitted where there is a likelihood of confusion or public danger. Such a danger may arise if a mark well known for use on detergents was to be allowed for use on soft drinks.

15. MULTIPLE CLASSES

A single Trade Mark application can be used to cover multiple classes of goods or services, but an additional fee is payable for each class.

16. EVIDENCE OF USE OF A TRADE MARK

To ensure the maintenance of a Trade Mark at the renewal date, it is often necessary to make a declaration of use and file evidence of such use. Without that, the renewal may be rejected and the mark would be open to others to use or register.

17. LICENSING

Use of a Trade Mark by a licensee or sub-division, with the approval of the Trade Mark owner, is counted as use by the Trade Mark owner.

18. LOSING A TRADEMARK

A Trade Mark registration can be revoked (cancelled) if the Trade Mark becomes synonymous with the product or type of product. Examples of lost Trade Marks include ESCALATOR, VELCRO and TRAMPOLINE.

19. TRADE MARKS IN THE EU

European Trade Marks may be filed at the European Intellectual Property Office (EUIPO), in Alicante, Spain.

Such Trade Marks cover all Member States of the European Union (being most of Europe – but not Switzerland, Iceland or Norway or, since 31st December 2020, the UK) in one application /registration.

20. INTERNATIONAL TRADE MARK - THE MADRID PROTOCOL

It is possible to file a single application covering a number of countries – this is known as an International Trade Mark. These countries must be signatories of the Madrid Protocol. Notable signatories include the UK, the EU, the USA, China, Japan, Australia and New Zealand. This is considered to be a cost-effective way of covering a number of countries, although there are disadvantages to this system including the need for applicants to meet certain requirements before such an application can be filed. We can provide further details relating to International Trade Marks upon request.