

Dolleymores[®]

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What is a registered trade mark? Information Sheet

What is a registered trade mark?

A trade mark is a logo and/or name that you offer to sell your goods or provide services under, also known as a brand name. Examples of registered trade marks are KODAK®, COCA-COLA®, SAINSBURYS®, SAMSUNG®, KAREN MILLEN®. The use of a trade mark enables consumers to identify your goods or services from your competitors. It is a badge of origin.

What do I have to do to protect my trade mark?

The best form of protection you can have, in particular in the United Kingdom, is a Trade Mark Registration. This may be obtained by filing an application at the UK Intellectual Property Office. Provided the Office accepts the application and no complaints are received from third parties, then a Registration is granted and a certificate issued.

What does that registration enable me to do?

Once you have a trade mark registration you can prevent competitors using an identical or similar trade mark to yourself in respect of identical or similar goods and services covered by your registration. It is also an indication that you are free to use your mark in respect of the goods/services covered by your registration in the United Kingdom. This will reduce the worry of being sued by another party who are of the opinion that your mark is too similar to their earlier registered right.

Surely I have protection as the company name is registered at Companies House?

Unfortunately this is not the case. Companies House do not at this time conduct prior rights searches for the purpose of assessing whether there will be confusion in the market place because two companies share a similar name. Further by registering a company name you are not awarded the same protection that you gain through a trade mark registration.

This will cost money, so why do it?

There are various scenarios surrounding trade marks, their proprietors and competitors.

Imagine you have spent hundreds or thousands of pounds in preparing the launch of your new brand. The day you launch you receive a complaint from a third party/competitor, which means you have to pull all your stock off the market and re-brand it. This is an expensive exercise and can also result in bad press coverage. If you had conducted a trade mark search and/or filed an application at the UK Intellectual Property Office and obtained an examination report, you would have been able to see whether there were any conflicting applications or registrations that would prevent you using a mark. At that time, when only a few hundred pounds had been invested you could have either thought of a new trade mark, or looked at ways of overcoming the earlier right that caused concern.

Another scenario that too often happens is a proprietor starts use of his mark in a location within the UK. The business and the brand are a success and begin to grow. Then the proprietor of a registered trade mark learns of the existence of the brand and contacts you, asks you to stop using your mark immediately otherwise an action for trade mark infringement may follow. In some cases the registered proprietors rights in respect of the registration actually post date the date you started using your mark. Whilst there are possibilities of defending yourself in respect of an action like this, the preparation of evidence is expensive and the outcome of proceedings uncertain

Then comes a situation where you have again built up a reputation in your brand in say Birmingham. A competitor starts using your mark in respect of inferior products or services

in Brighton. It would be virtually impossible to stop that competitor if you are only able to show you have earned a reputation and goodwill in Birmingham, and not Brighton. If you had obtained trade mark registration you would be able to stop that competitor even if you are only using the mark in one area in the UK. The registration has effect throughout the entire UK.

These are just a few of the many scenarios we come across regularly. Whilst we can usually defend our client's position or negotiate with the third party, this can be a costly exercise and one, which could have been avoided by searching the Trade Marks Register or filing a simple trade mark application and obtaining a registration.

What do I need to do then?

Advise us of the mark that you propose to use and the goods and services in which that use is related. The reason we need to know which goods and services are of interest is so that we can ensure that your application is filed in the appropriate classes.

To enable the UK Intellectual Property Office to manage the Trade Mark Register, goods and services are allocated to certain classes. There are 34 goods classes and 11 service classes.

By way of example, soaps and perfumes fall in Class 3, computer software in Class 9, clothing in Class 25, retail services in Class 35, installation and construction services in Class 37.

We will assess whether we believe the mark to be sufficiently distinctive to qualify as a trade mark. In short the mark you choose must not be descriptive of the goods or services upon which it will be used, for example you could not register the mark BUBBLES for bubble bath, or SHIRT for clothing as these words need to be left free for other traders to use. Your trade mark needs to be fanciful, although it can be suggestive as to the goods or services, for example SPEEDCOAT[®] is a registered trade mark used in respect of paints. It suggests that the coat of paint can be applied quickly or dries quickly, without actually being descriptive of the goods.

Provided your mark is, in our opinion, distinctive enough then you have the choice of conducting a trade mark search or filing an application

Once an application is accepted it is then published in the Official Trade Marks Journal. Third parties/competitors have a period of two months, and this time can be extended by a further one month by the potential opponent, to oppose the application. The opposition could be based on earlier rights a proprietor has earned through use of a mark in the UK, or a pending application or registration that has a filing date earlier to your filing date and is effective in the UK.

If no oppositions are filed, or if filed are overcome, the application matures to registration.

How long does this entire process take?

On average we can expect to receive the first examination report from the UK Intellectual Property Office, within six weeks after filing an application. An application that is not subject to an adverse examination report or opposition normally matures to registration within eight months from the date of filing.

Whilst the application process is ongoing your rights in the mark are protected from the date the application is lodged.

How long does my registration last?

The registration runs for ten years from the date your application was filed. It is possible to renew a registration for further ten year periods.

What do I need to do to keep it valid?

It is important that the mark is not left unused for a continuous period of five years once it is registered as this could result in it becoming vulnerable to cancellation by a third party.

You should also ensure that you, or others authorised to use your trade mark, do not allow the mark to become the generic term for the goods available under your mark, for example did you realise that ESCALATOR was once a trade mark, but is now the generic term for moving staircases.

How do I let people know my trade mark is my property?

Before a registration is obtained we recommend that you use the TM symbol alongside your mark and where possible make a statement upon any literature/packaging used that the mark is a trade mark belonging to you i.e. SOAP is a trade mark belonging to Mr John Smith. Once the mark is registered you can substitute the TM symbol with the ® symbol and amend the statement to read SOAP is a registered trade mark belonging to Mr John Smith.

What if I want to use my mark overseas?

We are able to offer advice in respect of protection of your mark using a variety of cost effective filing programmes, including a Community Trade Mark Application, which covers the 27 EU territories including the UK and may be filed in place of a UK application, or an International Registration covering a wide variety of territories that are signatory to the Madrid Protocol.

Please contact a member of our trade mark team who can offer tailored advice and can help you devise the most appropriate and cost effective filing programme.

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Est 1969

9 Rickmansworth Rd,
Watford, Hertfordshire
WD18 0JU

+44 (0)1923 238311
info@dolleymores.com

www.dolleymores.com