



Intellectual Property Information Sheet

Trade Marks

What are Trade Marks?

Trade marks are proprietary rights that can arise through use or through a formal registration process.

Trade marks are defined in Section 1(1) of the Trade Marks Act 1994 as:-

"any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings".

Therefore, trade marks cover a wide range of marketing devices such as words, logos, images, three dimensional shapes and sometimes even gestures and sounds.

Trade marks form an important asset of any business.

What do Trade Marks do?

Trade marks have a double function. They protect the image and reputation of a trader's goods and services and at the same time, they protect the Consumer by allowing him or her to associate products or services with a particular brand name or logo.

Unregistered Trade Marks

There is no legal requirement to register a trade mark, as common law trade marks can arise through use. It is particularly difficult if the business has just recently started trading. If a third party uses a common law trade mark without the owner's permission, it may be possible to raise a court action known as a "passing off" action. In order to be successful, the owner must establish (i) goodwill or reputation in the mark; (ii) that consumers have been or are likely to be confused by the third party's unauthorised use of the mark such that they believe that the goods and services involved are those of the owner; and (iii) the owner has suffered damage as a result of consumers' erroneous belief.

If the name or mark is common or consists of ordinary language, a greater degree of use of the mark would be required before goodwill or reputation can be established. In addition, proving confusion and damage through the use of the mark by a third party can also be difficult. Accordingly each situation would have to be looked at on a case by case basis when a potential

infringement comes to light. Passing-off actions can often be difficult and expensive.

The "TM" letters can be added at the end of an unregistered mark as a deterrent indicating that it is a trade mark used in trade and is proprietary. The "®" symbol should not be used unless the mark is registered. It is a criminal offence to use this symbol if the mark is unregistered.

Registered Trade Marks

Since the introduction of the Trade Marks Act 1994, the rights to a trade mark are largely determined on a "first to register" basis.

To obtain a registered trade mark, a formal registration process conducted in the UK by the Trade Marks Registry (a Section of the Intellectual Property Office) requires to be undertaken.

If a trade mark is registered it provides a statutory monopoly to use that name in connection with the goods and/or services in respect of which it is registered.

As a deterrent to infringement, the registered trade mark symbol ® can be used in conjunction with a registered trade mark. The ® symbol must not be used if the mark is unregistered. It is a criminal offence to use this symbol if the mark is not registered.

Trade marks which are formally registered in this way are afforded more immediate protection than unregistered trade marks. Raising an action against a third party for infringing a registered trade mark is usually easier, cheaper and more effective than raising an action for passing off. However, each case will depend on its own facts and circumstances.

Applying for a UK Registered Trade Mark

Not all trade marks are inherently distinctive enough to be registrable. Trade marks are registered for specific classes of goods or services ("Use Classes") and the particular goods or services involved must be narrated. Infringement of a registered trade mark occurs when someone else uses the same trade mark (or one which is similar enough to cause confusion) in relation to the same or similar goods or services.

When making an application for a UK registered trade mark it is possible to instruct a third party to carry out a search of previous registrations in order to establish whether or not there are any similar marks which may give rise to difficulties with the application.

The costs involved in obtaining such a search vary according to the number of Use Classes involved. Quotation for searches can be obtained on a matter by matter basis.

The charge payable to the Trade Marks Registry for lodging a trade mark application is £200 for the first Use Class and £50 for each additional Use Class (VAT is not charged). Currently, the application will then be examined in accordance with the legislation to ensure that it does not conflict with existing registered marks or applications and to ensure that the mark is sufficiently distinctive and not deceptive any way.

Once the Trade Marks Registry is satisfied that the application meets all the requirements under the legislation, the mark will be advertised in the UK Trade Marks Journal. This allows third parties a three month period within which to oppose the application. If no successful opposition is made within this period then the mark will be registered.

Registered trade mark protection lasts for an initial period of 10 years and is renewable indefinitely thereafter on payment of renewal fees to the Trade Marks Registry.

The symbol ® indicates the fact that the mark has been registered as a trade mark and may then be used in conjunction with the mark.



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This Information Sheet is intended to provide general guidance on trade marks. For more specified guidance, legal advice should be sought. Thorntons is a trading name of Thorntons Law LLP.
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