



an introduction to trade marks

Any mark that is used to distinguish the goods and services of one trader from those of another can be registered as a trade mark. Trade marks can be words, letters, numerals, logos, pictures, shapes, colours or a combination of these. Even smells have been registered as trade marks.

A trade mark acts as a badge of origin, which identifies products or services that have been made or supplied by a particular business.

Once a trade mark is registered, the owner has a monopoly right to use that mark for the goods and services for which it was registered and can obtain court orders requiring infringers to take products off the market and/or pay damages. The motive of the infringer will be irrelevant.

Before filing an application it is advisable to carry out a search of the Trade Marks Register to check that the mark selected for registration does not infringe anyone else's mark and that it is available for registration. A basic search will indicate whether any identical or similar trade marks have already been applied for. A more detailed search will reveal identical or similar trade marks and phonetically similar marks.

Trade marks are registered in connection with specified goods and/or services to which they will be applied. In total there are 45 classes of goods and services of which 34 apply to goods and the remaining 11 to services. This form of classification has been adopted in most of the world.

When applying to register a trade mark, the applicant identifies the class(es) in which registration is sought and submits a description of the goods/services to be covered within that class ("the specification"). Care must be taken to draft the specification widely enough to cover the goods/services to which the trade mark is intended to apply, without including goods/services on which the trade mark will not be used.

How do I register a trade mark?

To be registrable your trade mark must be:

- Distinctive of the goods or services for which you are applying;
- Not deceptive, or contrary to law or public policy; and
- Not similar or identical to any earlier marks for the same or similar goods or services.

The application procedure and fee payable depends on the country/countries and the number of classes in which you wish to register. In the UK, an application is made by submitting a form to the registry and paying an application fee. It costs from £450 plus VAT to file an application.

Once the application is received, it is examined and a report is issued to indicate whether the mark is acceptable. If it is accepted, the application will be advertised in the Trade Marks Journal and if there are no objections to the mark within three months of the date of the advertisement, the mark will be registered. If all goes smoothly, the procedure takes around six months.

What marks will not be registrable?

Marks which are too descriptive of the goods or services, or of any characteristic of the goods or services to be protected will not be registrable. This is to prevent any one business monopolising descriptive words for their goods and services alone.

Marks that are contrary to public policy or morality will not be registrable.

Words that have become customary in the trade will not be registrable. "Hoover" and "Linoleum" were once registered trade marks, but were removed from the register when they were deemed to have become customary expressions for vacuum cleaner and floor covering.

Can I register my trade mark internationally?

At present there is no world-wide Registry. However, you can obtain registrations in foreign countries and costs savings and tactical advantage can be gained through selecting appropriate filing strategies. We can help with this.

You can apply to each individual country where you would like to register the mark, or you can apply to register the mark through a regional organisation such as the European Registry or the World Intellectual Property Organisation (WIPO):

- A European Community Trade Mark (CTM) is registered through the Office of Harmonisation in the Internal Market (OHIM) and will provide protection for your mark in all of the countries in the European Union.
- The Madrid Protocol is an international treaty which provides a mechanism for obtaining protection in any country which is a member.

Using either of these procedures can be more cost effective than using national registries.

What are the benefits of the CTM?

- A single application results in one registration which covers all 25 member states of the EU;
- The cost of filing an application (approx. £920 plus VAT including our fee and OHIM's fee) is much lower than the cost of seeking individual registrations in each member state;
- The registration of the trade mark only needs to be renewed every ten years;
- Any action for infringement of a CTM will be dealt with under the rules of the CTM and European Law;

- A CTM can include marks which are:
 - Word marks including letters, numbers or combination of letters, numbers and words;
 - Figurative marks, whether or not including words;
 - Figurative marks in colour; or a combination of colours;
 - Three-dimensional marks; and
 - Sound marks
- A CTM will only need to be registered in two languages. The first language can be any language of the EU. However, the second language must be registered in one of the five working languages of the EU, that is Spanish, French, German, English or Italian.
- OHIM only examines applications to check that they are inherently distinctive (unlike in the UK where they are examined for distinctiveness and conflict with prior rights).

What are the disadvantages of the CTM?

- The main disadvantage is that OHIM has an 'all or nothing' approach to the registration of a trade mark. That is to say that if the trade mark cannot be registered in any one country on the basis of a conflict with another mark OHIM will reject the application for the whole of the EU. This process will also apply where your registered CTM is challenged and found to be an invalid mark. If the challenge is successful, you will lose your CTM protection throughout Europe.
- A CTM registration is one registration. It cannot be divided, for example, if you wished to sell the rights you have in only a few of the member states. (It can, however, be converted into national registrations).

What are the benefits of the Madrid Protocol system?

- Many countries including the USA, China and Australia are members;
- A single application in one language (English or French) filed at WIPO is all that is required for registration;
- The registration only needs to be renewed every ten years;
- After a five year period, the international registration becomes independent of the office of origin;
- There is no 'all or nothing' approach within the CTM. This means that although registration may be refused by some of the designated countries, the whole application will not fail just because it fails in one designated country;
- Any action for infringement of an international registration must be brought separately in each of the countries concerned.

What are the disadvantages of the Madrid Protocol?

- The main disadvantage is that not all countries are signed up to the Protocol. Notable exceptions include Canada, New Zealand, India and Hong Kong;
- You need to base your WIPO application on a "home" application (this could be a UK application or a CTM application) and for a period of five years from the date of registration, an international registration remains dependant on the "home" mark. If the "home" mark fails, the international registration will fail;
- You may not be able to obtain the protection you would like in some countries, since your mark could be unregistrable according to their national laws.

What is the extent of the protection once my trade mark is registered?

Once registered, your rights are clearly defined and generally speaking you can take action to prevent others using an identical or similar mark on identical or similar goods/services. You should arrange a trade marks watching service so that you will be alerted to any applications that conflict with your registration so that you can take appropriate action to oppose those applications.

Can I use another's trade mark for my own purposes?

This will depend on how you intend to use it. If your intention is to put the mark on your own products without the permission of the trade mark owner, then the answer is no. However, trade mark owners often license the use of their marks to other businesses. For example, a trade mark owner may license the use of its marks to a business to allow that business to manufacture and sell its products under the trade mark. The user may pay a licence fee or royalty to the owner.



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