



## Introduction to Trade Marks

### What is a trade mark?

A trade mark, often known as a brand, is a sign (whether it is a word, logo or something else capable of graphic representation) which identifies your goods or services from those of another. It is the badge by which customers find your product or services in the marketplace, and know how to find it again. Following use, a trade mark becomes a symbol with which your reputation and goodwill are associated. It is therefore likely to be one of your most important assets, deserving the best possible protection.

### How can you protect it?

In 'common law' countries such as the UK, a measure of protection is achieved following use of a brand and the acquisition of a reputation associated with it. However these so-called 'common law' rights are often weak, can be difficult to prove, and are even harder to enforce. They are also not available in many countries of the world. As a result, the law provides a system, in almost all countries, whereby traders can register a trade mark for particular goods or services of interest, and gain exclusive rights to use it for those goods or services, whilst protection can extend to related goods or services when certain criteria are fulfilled.

### What can be protected?

With a few exceptions, anything can be registered as a trade mark so long as it is capable of identifying one trader's goods or services from those of another. Signs that fall foul of these requirements are ones that cannot perform this function for one reason or another, usually because:

- They lack any distinctive or identifying feature which enables the public to recognise the sign as a trade mark, and/or
- They describe a characteristic of the goods or services or the sign is the generic name for, or the shape or other characteristic of, the goods.

A trade mark attorney can advise you on whether or not your chosen brand can be protected. An attorney can also represent you in trying to overcome objections from the authorities or third parties who may challenge your application or registration.

### Where can it be protected?

Most countries in the world offer a trade mark registration system, though the protection is territorial and will be limited to that territory once registration is achieved. Trade is usually international and there are some 'supranational' systems (the EU has one) that reflect this. The World Intellectual Property Office offers a system which can assist in protecting a trade mark on a multi-regional basis in a cost effective manner. A trade mark attorney can advise you on how to protect your mark in as wide or

narrow an area as you require, devising and prosecuting a trade mark filing strategy that will give you the protection that you need.

### How long does the protection last?

Unlike a patent or design registration, in theory the monopoly in a trade mark registration is open ended, so long as the registration is renewed at the required time (usually every 10 years). You also need to use your trade mark in the jurisdiction of registration, or that registration can become unenforceable against third party infringement, and open to challenge on the basis of this non-use. A trade mark attorney in conjunction with a renewals agency will ensure that you are reminded when a particular registration is due for renewal. Should the need arise, an attorney will also advise on questions of use of a trade mark and defend against applications to cancel a registration.

### What should I do when I am choosing a trade mark?

A trade mark, unlike a patent or design, does not need to be original to be protected. However you cannot just choose any name or logo for your new product, because someone else may already have registered it or something similar. A trade mark attorney's service includes searching existing brands on the register and/or in the market, and assessing the possible risks associated with the planned use and registration of your chosen trade mark. You need this information to decide whether or not to proceed.

### What if someone else adopts a trade mark the same as or similar to my own?

It is a fact of life that the more successful a brand becomes, the more others try to imitate it. Where those imitations are identical to an earlier trade mark, are likely to cause confusion with it, take unfair advantage of it or have the potential to damage its reputation, a trade mark registration can be used to prevent the imitation. A trade mark attorney can advise you on action to prevent third party infringements of your rights, as well as action to prevent third parties trying to register trade marks that are too close to your own. An attorney can also advise you on how to defend against a third party's objection, in relation to either your use of the trade mark or your application to register it.

### How can I check to see if others are adopting trade marks similar to my own?

The benefits of trade mark registration mean that most companies who use or intend to use a trade mark will apply to register it as well. A trade mark attorney's service includes watching the trade mark registers around the world and notifying you of potentially conflicting trade mark applications filed by a third party, so that you can decide to object to that application if you wish. An

attorney can also watch company name registrations, domain name registrations, and use of a trade mark in a particular market.

### **What about my other registered names, such as domain names or company names?**

Unlike a trade mark registration, the registration of a company or domain name does not give you an exclusive right to that name. All it does is prevent others from registering that exact name themselves. A trade mark registration can be used to prevent third party registration of similar company or domain names. A trade mark attorney can act on your behalf in actions to stop

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registrations that could be a threat to your business.

### **How should I use my trade mark?**

It is a good idea to notify to third parties that you consider your brand is a trade mark. This can be done by using the ™ symbol next to the mark, or, once registration is achieved (not before), the ® symbol. A trade mark should not be used as a substitute for the common name of the relevant goods or services. Ideally, you should use your trade mark as if it were an adjective, followed by the name of the goods or services it is used in relation to. It should also always be differentiated from surrounding text. It is also a good idea to indicate on product literature that the trade mark belongs to you.

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