
So you want to call your brand X. Is that wise?

A tick list on dos and don'ts:

DO select a mark that is distinctive.

To function as a trade mark and be considered by the trade mark offices as registrable, it needs to identify the trade origin of your goods or services and distinguish your goods and services from those of others.

It should not be descriptive of, or refer to, a characteristic of the goods or services it is being used on, e.g. BREAD for bread, CHOCOLATE for cakes.

Nor should it be too simple, commonplace or laudatory e.g. PREMIUM, as this is likely to be seen by consumers as indicating the good or service is a premium or more expensive one, not its trade origin.

Marks that are not distinctive will not be considered as registrable by a trade mark office. There is not likely to be anything stopping you using a sign that is not registrable as a trade mark, but these will be very difficult to protect through common law rights and to enforce against others.

DO check whether any prior conflicting rights exist.

You need to consider whether any third parties already have rights in a trade mark that is identical or similar to your proposed mark. Prior rights could arise from existing trade mark registrations as well as common law rights acquired through use.

While not obligatory, various types of searches can be conducted to determine what potentially conflicting prior rights exist and should be done before committing to use and/ or registration of a mark.

Searches should be considered even for marks that you do not think are registrable as it is possible in some circumstances to get rights in these marks through use.

DON'T neglect other factors such as:

- Is the mark in any way deceptive as to the characteristics of your goods and services? Deceptive marks are not registrable.
- If the mark is in a foreign language, that mark may be descriptive for your goods or services or have an unattractive meaning in that language, which will make it difficult or not ideal to use and/ or register in the country of that language, if you ever wanted to.

Can we register it or does it belong to someone else? Options:

Searches will assist in checking what third party rights already exist and in determining how available a mark is for use and registration. If you become aware of a potentially conflicting right, your options are:

- Investigate if and how the mark is being used. If the use of the prior right is targeted at a different type of commercial field, there may be room to agree with the owner of the prior rights that you can use and register your mark in your particular commercial field.
- If there is no use of the prior right and it is registered consider the possibility of trying to cancel it on the basis it is no longer being used by the owner.
- Approach the owner of the prior right to see if you can purchase or license use of it.
- Consider whether there is any way you might revise your mark, e.g. adding some design elements, to differentiate it.
- Change mark! If the prior right is a very clear infringement risk, this is the best option.

It's available – hurrah. Now how do we protect it?

■ Register it

Registered trade mark rights are obtained on a country by country basis; there is no 'worldwide' trade mark registration. To obtain registration of a mark covering the UK the options are:

- a UK trade mark application which has effect just in the UK;
- or a Community trade mark application, which is a single application that covers all 28 countries of the EU.

To obtain trade mark registrations in other countries, we can file national applications directly with each country's national trade mark office.

Alternatively, many countries are party to the International registration system (the Madrid system), which offers a centralised application process to file applications in selected countries around the world. The UK and European Community trade mark can be designated as part of an International application.

Before filing a trade mark application you need to identify:

- Your mark
- The list of goods or services for which you would like the mark protected
- The applicant (owner)

■ 'Unregistered' rights

Using a mark can in some countries provide 'unregistered' rights to a mark (known in the UK as common law or passing off rights). These can be a useful tool in some cases of infringement but are more expensive and difficult to enforce against third parties than a trade mark registration.

Furthermore, some countries do not consider use of a mark as giving rise to any form of trade mark rights and operate a first to file system, where prior rights to a mark are given to the party that applies to register the mark first.

If a mark is commercially important to you, register it.

Cool - you've got a trade mark registration - now how do you look after it?

There are various things you need to think about once you have a trade mark registration:

■ Renewals

A trade mark registration is only valid for a certain period of time and needs to be renewed periodically for a fee. In most countries, including the UK, the renewal period is 10 years.

■ Use

You should use the trade mark the subject of your registration, to avoid losing it. This means that the mark as it is registered should be used to sell the goods and services covered by the registration in the relevant country.

Most countries allow a period of time (normally 3 or 5 years) after registration when non-use of a registered trade mark has no adverse consequence. After that period of time if the mark is not used the registration of it cannot be enforced against third parties and can be attacked by third parties on the ground of non-use, unless there are exceptional reasons as to why the mark could not be used.

■ Infringers

You can take action to stop identical or similar marks being registered and/or used by third parties without your consent in relation to identical or similar goods or services. Making an objection to use by a third party typically begins with issuing a cease and desist letter. If the third party does not comply with the demands made, formal proceedings then need to be issued.

Enforcing your registration against third party infringers can in some cases become very expensive. Trade mark owners should however be prepared to wherever possible and practicable take appropriate action against infringement and later filed conflicting applications.

■ Genericism & Correct Use

A trade mark should never be used as the generic name of a product but always as an adjective, e.g.

- *KODAK cameras are sold in many electrical stores.* (**Correct** usage as an adjective).

- *KODAKS* are sold in many electrical stores. (**Incorrect** usage as a noun and therefore the name of the product).

As a trade mark owner you should ensure that your marketing material does not inadvertently refer to your mark incorrectly, and where third parties are lawfully using your trade mark, that they are doing so correctly i.e. as an adjective.

A trade mark registration can be attacked on the basis that the mark has, either because of use by third parties or use by the actual trade mark owner, become generic.

Common pitfalls and points worth remembering

■ A trade mark registration does not provide a guarantee that the mark is available to you to use.

It is *prima facie* evidence of a registered right in the mark for the goods and services covered, but can still be attacked post-registration by a party with prior rights, although there is a limit on the time a party can wait to do this.

■ Changing a mark and not re-filing.

If you begin to use your mark in a new format then we should consider whether a new application is required to protect that format. Changing a mark does not always occur overnight but can happen slowly over time when a mark is periodically 'modernised' or 'tidied up', and can cover things like changing the font of a word or adding images to a mark.

■ Assuming your existing registration covers any expansion into new product ranges and territories.

Trade mark registrations are limited territorially and by the list of goods and services covered in the registration. New applications should be filed to cover that new use of a mark, ahead of committing to that new product or territory.

■ Using the mark incorrectly i.e. as a noun not an adjective (covered under Genericism & Correct Use).

■ Forgetting countries where you manufacture

In some countries, applying a mark to a product in a factory and then shipping that product out of the country to be sold elsewhere is trade mark use and could be considered infringement if a third party owns a conflicting trade mark registration. So, when considering which territories to file in, don't just consider those where you sell your goods but also those key to you manufacturing the product as well.

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