

## 1 A Brief Introduction to Trade Marks

Governed principally in the UK by the Trade Marks Act 1994, trade marks are a form of intellectual property used to distinguish the goods or services of one undertaking from those of another. In many cases, trade marks are often used interchangeably with “name, brand, logo” and other terms.

Trade marks may be registered or unregistered. From a day-to-day trading perspective this may make little difference. From an enforcement perspective, however, the differences are significant. As will be covered in more detail below but simply put for now, registered trade marks can be protected as such with a specific action designed for this purpose. Unregistered trade marks may be protected by the common law action known as passing off.

Trade mark symbols can often be confusing. The “TM” device, for example, does not mean that a symbol is a trade mark. The ® device, on the other hand, means that a trade mark is registered. The ™ device, on the other hand, means that a trade mark is registered but which is not registered constitutes an offence.

## 2 Registration – The Basics

As you will see, it is reasonable to expect that a well-prepared trade mark application will be successful. It is unlikely that a trade mark application will be likely to infringe another mark.

First and foremost, if a mark is identical to, or similar to, the one for which you seek registration, then registration will not be possible. This work is done by the Intellectual Property Office (“the IPO”) as part of the application process. It is not do well to search the IPO database before you start your application preparation.

Further safety is provided in the form of a two-month opposition period after approval by the IPO, trade marks can be opposed for two months.

If your trade mark is unopposed, then it is registered. In the event that your trade mark is opposed by another party who failed to oppose, then it is registered.

## 3 Unregistered Trade Marks

For various reasons, you may choose not to register your trade mark. It may be that you need the additional protection offered by registration, or it may be that you have used your trade mark for many years and have acquired a reputation for it and feel that this is quite sufficient.

When weighing up the respective advantages and disadvantages, it should be borne in mind that, in the UK, trade marks can be protected by the common law action known as passing off.

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mark is infringed if:

- which is identical to the trade
- identical to those for which the

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## M

which is identical to the trade  
similar to those for which the  
similar in relation to goods or  
there exists a likelihood of  
likelihood of association with

- relation to goods or services  
which is identical or similar to  
reputation in the UK and the use  
is unfair advantage of, or is  
of the trade mark.

a trade mark is defined in the

- or  
 ed for sale under the mark; or  
 ; or  
 ; or  
 or part of a trade or company  
 ertising; or  
 n a manner that is contrary to  
 ing Regulations 2008.

# P

require registration in order to be used as “passing off” can be used

L

- st have acquired a reputation  
on of the public;  
(be likely to be) confused with  
rk, must be (or likely to be)  
(e) by the use of the infringing

# F

forward. Nevertheless, each questions of degree contained above, pursuing a passing off is, it is likely to be simpler and

more cost-effective to register a trade mark than the common law alternative. Nevertheless, you should be aware of passing off and of the possibility of a trade mark infringement claim. For more guidance, please refer to BS.IP.GN.03 Passing Off and Infringement.

### **Opposing a Trade Mark Application**

As noted above, for a two-month period after the date of publication of an application, trade marks are open to opposition. If, therefore, you believe that a trade mark which is either the same as, or similar to, your own trade mark should not be registered, you may oppose it.

To begin the opposition procedure, you must submit a form available from the IPO. This must be filed within the aforementioned period. If you wish to proceed with the opposition, the next step is to file a 'Notice of Opposition'.

As with all matters of this kind, it is advisable to get your ducks in a row before proceeding. The following information will be required for your opposition:

- The details of the trade mark which you are opposing;
- Details of your opposition:
  - The proposed grounds for opposition. For example, the mark is identical to or similar to an earlier registered trade mark;
  - You have already used a trade mark which is the same as (or similar to) the mark in question in relation to identical goods or services;
- Additional information including:
  - Details of your own trade mark;
  - Details of your own goods or services (including details);
  - Details of any relevant prior use of your trade mark;
  - Relevant categories of goods or services;
  - Details of similar trade marks (including details of the part of the mark which is similar to the distinctive character of the mark in question);
  - Details of earlier registered trade marks.

The above represents a summary of the information which you will need to provide. The more information and grounds you provide, the better. You will then be invited to attend a hearing in order to obtain the best result.

The official opposition procedure is conducted directly with the applicant. It is possible to deal with your opposition through a solicitor. In some cases, an amicable agreement can be reached between the parties.

## **4 Dealing With Infringement**

Infringement, as noted thus far, is a civil wrong. As with any civil wrong, the first step is to gather evidence of the infringement.

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used to relying on the common law alternative. Nevertheless, it is wise to be aware of passing off and of the possibility of a trade mark infringement claim. For more guidance, please refer to BS.IP.GN.03 Passing Off and Infringement.

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- Additional information (including grounds for your opposition) including:
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  - Details of your own goods or services (including details);
  - Details of any relevant prior use of your trade mark;
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are seeking to oppose an app  
template to follow.

Unless you are in fact opposing you carefully follow the IPO's the infringer. Even if you regard to attempt to resolve the situation legal proceedings. It is always are, in fact, inadvertent and infringement may sometimes you will notice their infringement to resolve a dispute in a relatively advice is sought and costs will significantly lower if the first rather than immediately suing below.

### Threats Actions

It is recommended that all communications from a qualified solicitor. There is a risk that legal action may follow, and communication in a threats action is to ensure that communication, merely informing the recipient of the threat, inviting the recipient to discuss the matter, does not constitute "desist".

The purpose of threats actions proceedings being made, so paying out some form of settlement there are situations in which infringer with legal action:

- The application of your
- The supply of services
- The importation of goods (including the packaging thereof).

While the above may appear matter of degree and of intent, you may choose to challenge you on the basis that it is to be infringing yours. Once again, this is understated.

## Cease and Desist

Whilst taking serious account  
be a useful means of contact.

- Establish your ownership
- Set out your (well-founded) demands
- Set out your requests to cease and desist the re-

Information set out above is a good

In case it is recommended that the next step should be to contact the infringer as remote, it is often wise to contact the infringer prior to diving straight into litigation. In many cases of infringement, the infringer is not aware that the infringer doesn't think they are infringing. If caught. Even when seeking legal advice, it is vital that full and proper legal advice is sought. However those costs may be incurred, it is often better to resolve the matter in good faith than to incur the risks involved for which see

ger is made through a suitably  
infringement and suggesting  
ued by the recipient of your  
avoid the potential for a threats  
letters) are non-accusatory in  
e of your trade mark, possibly  
requiring them to “cease and

endless threats for infringement  
 n of scaring the recipient into  
 fact innocent. Nevertheless,  
 safer to threaten a suspected

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ging);
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has been applied (or applied to

That many legal disputes are a  
 nt's lawyer may nevertheless  
 not consider their client's mark  
 seeking legal advice cannot be

a cease and desist letter can  
r should:

- whether registered or not);  
 ment;  
 st, include the requirement to  
 nd

- Establish a deadline for acknowledgement and response.

The requests made by a cease and desist letter (in addition to the obvious) may include one or more of the following:

- The delivery-up of materials for destruction of the infringing trade mark for destruction;
- The withdrawal of application of the infringing trade mark;
- The withdrawal of applications for cancellation or assignment of the infringing trade mark;
- A written undertaking from the infringer that they will cease and desist from using the infringing trade mark or any other confusingly or deceptively similar trade mark in the future.

You may also wish, particularly in the case of infringement of an unregistered trade mark, to briefly describe the nature and goodwill of your trade mark. Even in the case of a registered trade mark, evidence may still be persuasive – if the infringer declines to be persuaded, your chances of success would be that much less.

### ***What if my allegation is disputed?***

In many cases, it is quite likely that the infringer will be dealing with the matter for your benefit. If, however, rebuttal, there may still be an opportunity to discuss the matter privately simply by discussing it. This may still not be enough, however all is not yet in the hands of the courts.

If the infringing party is open to discussion, it is advisable to turn to some form of alternative dispute resolution for infringement. Mediation, for example, may resolve the matter without incurring the considerable time and expense associated with taking the matter to court.

If neither private attempts at a settlement nor alternative dispute resolution methods have succeeded then you may wish to seek legal advice on an action for infringement. Under the Trade Marks Act 1994, trade mark owners may, under an action for infringement, seek legal relief which may take the form of damages, injunctions or an order for delivery up.

### ***Live and Let Live***

So, you can oppose an application for a trade mark, seek an injunction against an infringer, or simply try asking them nicely to “stop it and don’t do it again”. But what if you are considered trying to get along?

A trade mark co-existence agreement is an agreement between two parties (usually registered) trade mark owners that is seeking to establish a co-existence of two trade marks. The agreement allows the new trade mark to continue using their trade mark. In certain cases, the agreement may require limited alterations either to the new party’s trade mark or to the goods and/or services to which they plan to apply that trade mark, in order to avoid a reasonable overlap and limiting the potential for confusion.

From a contractual perspective, in the hands, the all-important 'consent' of the mutual undertakings and parties to maintain a balance when discussing an agreement.

## 5 Conclusions

Trade marks and all that they represent to customers, your brand and image, whether they are registered or not, give you the time and exercising your name that won't tread on anyone else's (your business stand out!) is a continuing care and maintaining it. Traders will help to ensure that your business is free from the activities of others.

These guidance notes have been prepared in order to give businesses an overview. They do not, however, stand in lieu of any action – particularly where a suitably qualified solicitor – or other professional informed should you choose to

that, as no money changes hands, the contract legally binding, is the agreement. It is essential to agree to the terms of such an

putation, the goodwill of your business is a valuable business asset. Whether you are new or old, at the outset, ensure that you are choosing a name, of course, one that will make your business stand out down the line, exercising your rights of your market and your fellow traders doing its job, free of hindrance

the introduction to trade marks and the law when dealing with them. They strongly discourage the taking of any action – without first consulting a suitably qualified solicitor – or other professional informed should you choose to