



Trade Mark Basics

What is a Trade Mark?

A trade mark is anything that identifies and distinguishes someone's products or services from those of others. In a competitive marketplace, adopting a distinctive trade mark is essential to ensure that a product or service stands out from the crowd.

Searching Trade Marks

Before using a trade mark it is important to carry out a clearance search to check that the mark is available (i.e. someone else doesn't already own the same mark or something close to it) and that your use of the trade mark will not infringe existing third party trade mark registrations.

If use of your trade mark would infringe an earlier trade mark registration, the owner of the earlier registration may take legal action to prevent the use of your mark. This could result in you incurring significant legal costs and being unable to sell goods, or offer services, under your mark.

To check whether your mark is available for use and registration a trade mark clearance search should be carried out. This is done by searching the trade mark registers in the country/countries where your mark will be used.

A clearance search will show what marks already exist and ensure you are not wasting time and money in applying for a mark that you will not be able to use or register.

Types of Trade Marks

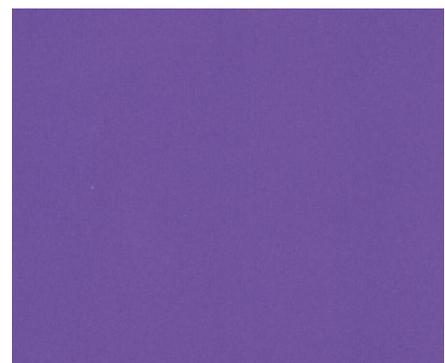
There are numerous types of trade marks, many of which can be registered/protected. These include words, images, word and logo combinations, the name of an organisation or a strap-line. Others include:-

Sounds : Simple jingles or more complex sounds can be registered as trade marks, provided that they are distinctive.

Click here to listen to the recording of Meditronic Minimed's registered sound trade mark. 

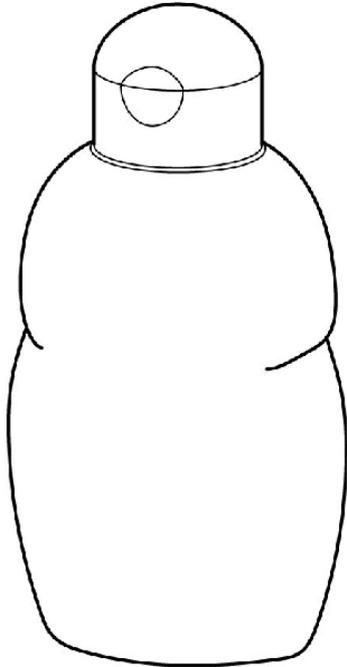


Colours : Specific shades of colours can act and be registered as trade marks, such as Glaxo Group's purple colour mark which is registered for pharmaceutical preparations for the treatment of asthma and/or chronic obstructive pulmonary disease.



Smells : These can also act and be registered as trade marks, provided that the smell is not of the product itself or results from the nature of the goods. For example, the smell of roses couldn't be registered as a trade mark for flowers or scented candles.

Shapes : The shape of a product, or its packaging, can act as a trade mark and be registered.



Johnson & Johnson's 3D shape registration for the shape of one of their bottles.



Pfizer's 3D shape trade mark, which is registered for "pharmaceutical and veterinary preparations and substances in tablet form containing sildenafil".

Position marks : You can register the position of a thing as a trade mark, such as Levi Strauss's registration for the red tab on clothing.

Other types of mark : You can protect film clips, sounds and moving images too. You can even protect a hologram.

Why register a Trade Mark?

A trade mark registration gives its owner defined legal rights in the mark for certain goods and/or services. It also allows its owner to stop others from doing certain things. For example, once you have registered your trade mark you have rights in the mark to do the following in the place/country of registration; you can stop anyone else from:

- Using your mark in relation to identical goods or services.
- Using your mark in relation to similar goods or services.
- Using a mark that is confusingly similar to your own, for any goods or services that are the same as or similar to your own.
- Using a mark that is similar to your own and will damage your mark's reputation (if you are able to prove that your mark has a reputation).

Goods and/or services

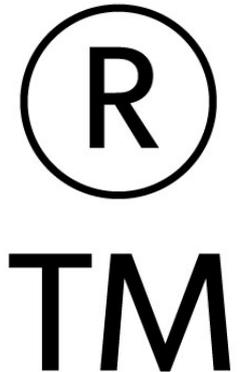
Trade marks are registered and used in relation to goods and/or services.

When applying for a trade mark you will be required to list the goods and/or services of interest. This list of goods and services will determine the scope of your trade mark rights following registration.

Use of TM and ®

When a trade mark is registered the ® symbol can be used to indicate this (i.e. that the mark **has legal protection** as a registered trade mark).

TM is used to indicate that something is being used as a trade mark, but is not yet registered. Use of TM affords **no legal protection** in the UK.



Is Your Mark Registrable?

To be registrable a trade mark must be distinctive and not fall in to one of the other exclusions set out in the trade mark legislation, otherwise it will be rejected by the Trade Mark Office.

Distinctiveness – this is the ability of a trade mark to distinguish products and/or services from those of others.

For example: an application to register ‘Health Care’ would not be permitted for products or services relating to healthcare.

For example: Apple is distinctive in a trade mark sense for computing products, but would not be distinctive in a trade mark sense for fruit.

Descriptiveness – if a trade mark describes a characteristic of the goods or services, then it will be refused protection.

For example: if you have developed a calendar organiser app and want to register the name of this, you will not be able to register ‘Diary Manager’ because this would be deemed descriptive of the function/purpose of the app.

Other Grounds for Refusal

There are various other grounds for refusal too, including trade marks which are considered misleading or offensive.

For example: if you produce base-layer clothing for skiing and mountaineering, and you apply to register the trade mark ‘Magic Silk’ for ‘clothes made of cotton’, your application will be refused.

A qualified Trade Mark professional will be able to advise further on grounds of refusal.

Avoiding or Overcoming Non-distinctiveness

If you are concerned that your trade mark lacks distinctiveness, there are ways to increase the level of distinctiveness of a mark. For example, 'Health Care' would be considered non-distinctive for healthcare services if applied as a simple word mark. However, by adding stylisation and colour to the mark this will increase the chances of the mark being accepted for registration.



Where to Protect your Trade Mark

Budget permitting, you should protect your trade mark in all countries where it will be used.

Trade mark rights are territorial rights granted by national or regional Trade Mark Offices. The UK Intellectual Property Office (UKIPO) is responsible for granting UK trade marks. The European Union Intellectual Property Office (EUIPO) is responsible for granting EU-wide trade marks. Other national and regional trade mark offices also exist.

In most countries trade mark rights are obtained on a first to file basis.

You will only be able to enforce your registered trade mark in the territory in which it is protected. A UK trade mark can only be enforced in the UK. An EU-wide trade mark is capable of being enforced across the whole of the EU.

A EU-wide trade mark is a unitary right which covers all EU Member States. Due to its unitary nature, if a trade mark cannot be registered in one EU Member State (e.g. because it is descriptive in the language of that member state), it cannot be registered as an EU-wide trade mark.

Routes for Trade Mark Protection

Various routes are available for protecting trade marks in overseas territories. Advice should be sought from a qualified Trade Mark professional on the most appropriate trade mark filing strategy for your business.

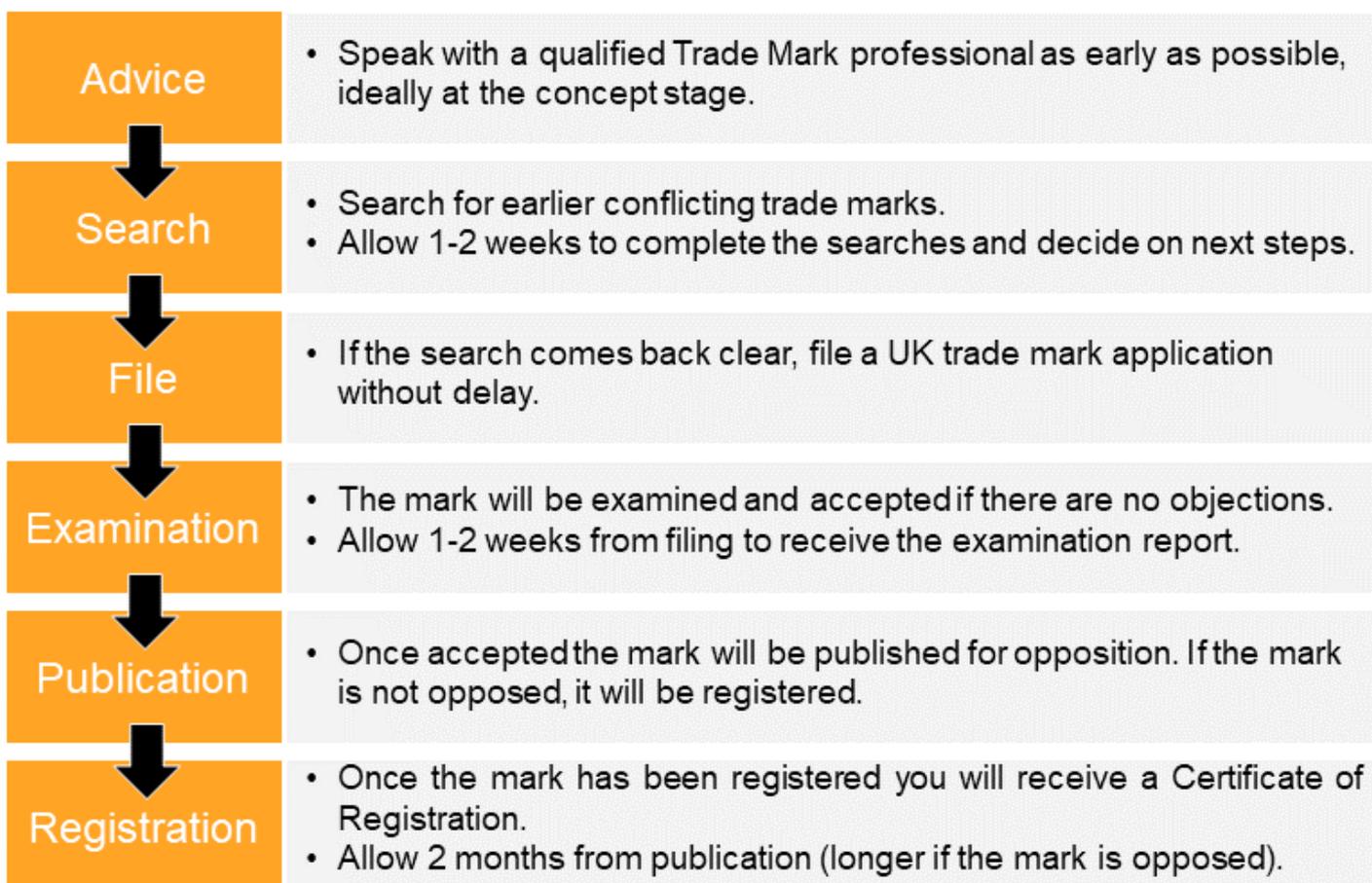
A Side-note on Brexit

Once the UK leaves the European Union (EU) in December 2020 it is anticipated that all EU trade marks will cease to have effect in the UK. It is widely expected that EU-wide trade marks in existence prior to the UK leaving the EU will receive automatic protection in the UK (i.e. a UK trade mark right will be created automatically). These proposals are the subject of ongoing negotiations and the specifics may change before the UK leaves the EU.

If you are currently selling goods or supplying services in the EU, or propose to do so, you should speak with a qualified Trade Mark professional for guidance on how Brexit might affect your business.

Further Brexit (and other IP) updates can be found [here](#).

Step By Step Guide



You should apply to register your mark as soon as possible after completing the clearance search (assuming the search doesn't identify any earlier conflicting marks). If you delay, a third party could register your mark, or something similar to it, and take action against you to stop the use of your mark. Costs for searching and registering a mark are significantly less than the cost of defending a trade mark infringement claim and/or re-branding.

Trade Mark Filing and Registration Costs

These will depend on a number of factors, including the country/territory in which the mark is filed and the number of classes of goods/services. Filing costs for UK and EU trade marks through Reddie & Grose LLP are set out below.

Country/Territory	Filing costs for 1 st class	Filing costs for additional classes	Registration costs **
UK Trade Mark	£520 + VAT	£150 + VAT for the second and each additional class	£250 + VAT
EU Trade Mark	£1,300 + VAT*	£45* + VAT for the second class £240* + VAT for each additional class	£250 + VAT

*Subject to fluctuation in exchange rate.

**Assuming no objections or third party oppositions.

Unregistered Trade Mark Rights

If you are using a mark but have not registered it, you may have built up unregistered rights in the mark. These rights can be enforced against someone who attempts to 'pass off' their goods/services as your own.

Enforcing unregistered trade marks is considerably more difficult and expensive than enforcing a registered trade mark. As such, where possible you should register your trade mark in order to ensure that you are in the strongest position to enforce these valuable rights.

Contact

If you require any assistance with trade marks or other Intellectual Property rights, please contact us at:

London office

Reddie & Grose LLP Tel: +44 (0)20 7242 0901
The White Chapel Building Fax: +44 (0)20 7242 3290
10 Whitechapel High Street Email: enquiries@reddie.co.uk
London, E1 8QS

Cambridge office

Reddie & Grose LLP Tel: +44 (0)1223 360 350
Clarendon House Fax: +44 (0)1223 360 280
Clarendon Road Email: enquiries@reddie.co.uk
Cambridge, CB2 8FH