

Intellectual Property Fact Sheet

Trade Marks

This fact sheet addresses some of the issues relating to trade marks that are frequently encountered by our clients. We cover the following issues:

What is a trade mark?

I have a registered trade mark - can I stop other people from using it?

What should I do if I think someone is infringing my trade mark?

Can a trade mark be infringed by online use?

I have been accused of infringing someone else's trade mark – what should I do?

Special issues relating to employees and consultants

Can I grant a license to use my trade mark?

Do I need to register my trade mark?

How should I use my trade mark?

What is a trade mark?

A trade mark is a “sign” used to differentiate goods or services originating from one source from those originating from another source. Trade marks must be registered at the Intellectual Property Office.

Trade marks can take a variety of forms, the more conventional being words, slogans, numerals and figures. More unusual types of trade marks such as colours, sounds and gestures might be registerable, if they are capable of being represented graphically.

There are a number of grounds for refusal of a trade mark. These include (but are not limited to):

- That the mark consists of a shape that results from the nature of the goods, or which gives it a technical result. These aspects of a product might be better protected by other intellectual property rights such as patent rights, copyright or design rights (each of which will form the subject of future fact sheets).
- That the mark is devoid of distinctive character.
- That it exclusively indicates features such as the kind, quality, value, geographical origin or other characteristics of the goods or services.

I have a registered trade mark - can I stop other people from using it?

Yes - the owner of a trade mark can bring infringement proceedings against anyone who, without authorisation, uses an identical or similar mark in the course of trade in connection with identical or similar goods. Where the marks, or the goods, are not identical, it is also necessary to show that this use caused confusion.

If your trade mark has a reputation in the UK, you may also be able to prevent others from using the same or a similar sign where that use takes unfair advantage of, or is detrimental to, your trade mark. It is important to note that there is no need for the goods or services to be similar in this case.

What should I do if I think someone is infringing my trade mark?

Whilst sending a letter to someone who you think is infringing your intellectual property rights seems like a good idea, care needs to be taken not to fall foul of the UK Threats legislation. [Click here](#) to read a more detailed briefing note on this issue.

Suitable disputes can be advanced through the Intellectual Property and Enterprise Court (IPEC), which contains measures for cost capping and a shortened timeframe. This Court is often an attractive route for clients, particularly SMEs, as it allows them to assess their costs exposure at the outset of a dispute. For a more detailed note on this court, [click here](#).

Can a trade mark be infringed by online use?

Yes - use of a trade mark in a domain name or other location on-line, for example in Amazon listings for the sale of counterfeit products, can amount to trade mark infringement.

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I have been accused of infringing someone else's trade mark – what should I do?

First of all, if you have received a letter, take note of any deadlines. Failure to respond within that deadline might lead to legal action being taken or, in a worst case scenario, a judgment being entered against you. We suggest that you take legal advice as soon as possible. Your lawyer will need to understand the allegedly infringing activities that you were undertaking, as well as any rights that you have to use the trade marks. They will also want to look at the possibility that the trade marks that are being enforced against you are not valid, as invalidity would form a defence against an infringement action.

Special issues relating to employees and consultants

There is no assumption under English law that a trade mark filed by an employee automatically belongs to an employer. Therefore, employment contracts should clearly deal with ownership of all intellectual property. The same applies to work performed by consultants. Consultancy agreements should be carefully drafted to address ownership of all intellectual property, including trade marks.

Finally, if a mark is owned by a company, it should be registered in the name of the company, not the employee or director who filled in the form. Unfortunately, completing the paperwork incorrectly frequently creates issues in circumstances in which the relationship between the company and the director deteriorates.

Can I grant a license to use my trade mark?

Trade marks confer an exclusive right to use that mark in connection with particular goods or services. However, you can grant or authorise others to use the mark on either an exclusive or a non-exclusive basis. Such licenses should be worded carefully, and we recommend obtaining legal advice before entering into any license agreement.

Do I need to register my trade mark?

Guidance for how to register a UK trade mark can be found on the [UKIPO website](#). A trade mark owner can apply for registration themselves, however we recommend that you speak to a qualified UK Trade Mark Attorney, who can guide you around some of the pitfalls, and help you to maximise your brand's value.

How should I use my trade mark?

The short answer to this is with care and consistency! With the success of a brand in a sector comes the risk of losing distinctiveness and becoming a "generic" name for the goods or services in question; examples of this include the now invalid trade marks, escalator and trampoline.

Your trade mark should be used exactly as it is registered, do not be tempted to vary aspects such as colour or design. If your goods or services are re-branded, the trade mark portfolio should also be updated. Word marks should be distinguished from the surrounding text, for example by using capitals and the ® symbol. Do not use your trade mark descriptively (as a verb).

Debenhams Ottaway is a member of Marques - the European association representing the interests of brand owners.



If you have any questions relating to trade mark law please contact one of our intellectual property law specialists. This Fact Sheet does not constitute legal advice and the information contained in it is correct as at June 2018. In reading this Fact Sheet you accept that no reliance may be placed upon it and accept that Debenhams Ottaway LLP excludes any liability arising from reliance upon it.

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