

## What is a Trade Mark?

A Trade Mark is a sign which serves to distinguish the goods or services of one trader from those of another. Registering a trade mark gives the owner the exclusive right to use the mark in relation to specified goods or services. A trade mark can be a very valuable asset to a business.

Trade marks are an essential part of doing business. Businesses can use trade marks in the development of their own unique 'brand image', allowing consumers to identify the source of the products and services of interest to them.

### What Trade Marks can I protect?

Any sign capable of being represented graphically can function as a trade mark. Usually trade marks are words, numerals, graphic designs, or a combination of any of these. However, it is also possible for trade marks to consist of the shape of goods or their packaging, colours or even sounds (e.g. advertising jingles). Whatever its nature, to be registrable a trade mark must generally be distinctive and not descriptive. For example, it is difficult to register merely laudatory words, common geographical names, common surnames or single colours, at least until such time as it can be shown that these have become distinctive for the goods/services through use.

### What type of protection is available?

Wherever possible, it is advisable for businesses to register their trade marks. In general, a trade mark registration is infringed by the unauthorised use of an identical or similar mark by a person in the course of trade in relation to goods or services which are identical or similar to those for which the mark is registered.

To some extent unregistered trade marks may be protected by other laws (e.g. in the UK, the law of passing off). However, rights in such unregistered marks are more difficult to enforce because of the need to show that the public is likely to be deceived by the other party's use of the mark. In contrast, the first user of a mark which is registered has an absolute monopoly in its use in trade.

It is up to the proprietor to enforce his rights in his (registered or unregistered) trade mark.

### How do I register my Trade Mark?

In the United Kingdom, the official body responsible for the official examination and registration of trade marks is the Trade Marks Registry, which is part of the Patent Office, a Government agency. To seek registration of a trade mark, an application is filed at the Registry in the prescribed form, identifying the goods and services in respect of which the applicant wishes to register the mark. The Registry then examines the application to assess whether it complies with the applicable law. In particular, the Registry considers whether the mark is sufficiently distinctive, and whether it may conflict with any earlier trade mark applications or registrations having effect in the UK.

In order to decide on the latter point, the Registry carries out its own database search. If objections are raised at this stage, the applicant is given the opportunity to overcome them, e.g. by argument or amendment of the list of goods/services. If and when the application is accepted, it is published and others may oppose the application. If there are no oppositions (or if an opposition is successfully overcome), the trade mark is registered.





### How long does a registration last?

Unlike other IP rights, trade mark registrations can remain in force indefinitely, subject to the payment of renewal fees. In the UK, registrations last for 10 years initially and are renewable every ten years thereafter. Registered marks which remain unused for five years are at risk of being removed from the register.

### Other countries

The protection afforded by a UK trade mark registration only covers acts done on UK territory. Other countries have their own national systems of trade mark law based on similar principles, although the details of law and practice vary widely. There are also a number of international systems by which it is possible to obtain trade mark protection in a number of countries at once. These include the European Community Trade Mark (CTM) and the Madrid Protocol. For further information, please see our briefing note entitled "[Overseas Trade Mark Protection](#)".

### Taking precautions

Although the UK has no mandatory marking requirements, it is conventional to identify trade marks by use of the <sup>TM</sup> symbol. This may be used next to any trade mark in which the user believes he has exclusive rights. If a trade mark is registered, it is recommended to use it together with the ® symbol. These symbols put others on notice of the owner's rights. It is also advisable for owners to keep records of their use of marks in case of any trade mark dispute with third parties. Of course, trade mark owners should be vigilant to any improper use of their marks.

### Further advice

If you would like any further advice please contact us at Dehns using the details below.

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