Whose mark is being infringed?

Q) I run an online company that specialises in lifestyle products and has been operating successfully for two years. About a month ago we received a letter from a company with a similar name saying that we are infringing their Trademark by using their name and that unless we stop using our company name, they would begin legal action against us for trademark infringement. Part of their letter states that the domain name my company uses was one that they had owned many years ago. Upon checking for information of this, I can find no evidence that my domain was in existence prior to when I registered it in 2008, which was when I started my business. I searched the UK Patent Office for the trade mark they said I am infringing and it turns out that they have only recently applied for a trademark under MY business name and choosing services that MY business carries out. What should I do?

The first thing you should do is find out the publication date of this other company's trade mark application, which will begin a two month opposition period. You may have grounds to prevent registration if you had goodwill in your mark at the filing date of the application, or if it is deemed that the application was made in bad faith. A trade mark attorney will be able to advise you about this.

Rest assured that the other company will not be in a position to commence proceedings for registered trade mark infringement against you unless their mark becomes registered. However if the mark becomes registered then the proprietor may have the right to claim damages from the filing date, so it would be advisable to act quickly.

As a separate issue, if whichever party commenced use first had established sufficient goodwill by the time the second party came onto the scene, then the first party may be in a position to sue for passing off in the event of misrepresentation and damage.

Importantly, you should also consider filing a trade mark application of your own, since this will put you in a stronger position if something similar happens again.

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