



## Trade Marks

### What do they protect?

Trade marks enable customers to identify goods or services as coming from a particular business, and to distinguish them from those of other businesses. They can therefore play a strong role in determining and developing your brand. As a form of intellectual property, trade marks can be licensed or assigned to third parties. A registered trade mark provides you with a right to take action to prevent the use or registration of identical, or confusingly similar marks by others in the country in which your mark is registered. Usually, the right will only extend to the same, or similar goods and services to those covered by a registration and so it is often possible for similar marks to co-exist in non-competing areas of commerce.

Trade marks traditionally protect names, words, or logos, but can also be phrases (such as straplines or slogans), symbols, sounds, shapes or colours, or often a combination of one or more of these. Trade marks are registered in respect of the goods or services being provided under the mark.

### What is required of a trade mark?

In order for your mark to be registrable as a trade mark, it must meet a number of criteria.

- Your mark must be **distinctive**, i.e., capable of distinguishing your goods and services from those of another business. Generic, or non-distinctive marks such as “we lead the way”, cannot fulfil this criterion.
- Your mark **cannot be descriptive** of the goods and services to which it is to be applied, or of their characteristics. Descriptive terms should be free for all to use.
- Your mark **cannot be misleading**. An example is the mark ORLWOOLA, which was refused as being misleading when applied to non-wool articles.
- Your mark **cannot be offensive**, for example contain swear words.

If your mark meets the above criteria, you may wish to file a trade mark application.



## What about existing registrations of others?

Ideally, your mark must **not present a likelihood of confusion** with an earlier mark. Confusion tends to arise when there is an identical or similar mark registered for identical or similar goods or services. The Examining Office (e.g., UKIPO, IPOI or EUIPO) will perform a search of earlier marks to check whether confusion is likely to occur. Procedures vary depending on which Office is examining the application – for instance the UKIPO will not refuse to register your mark on the basis of a pre-existing registration, but it may notify the earlier trade mark owner of your application, which could then lead to an objection or opposition being lodged. Conversely, the IPOI will not register your mark if there is a perceived conflict with a pre-existing registration, but will write to you setting out the objection and giving you the opportunity to respond and/or amend your application.

You can decrease the risk of such objections by performing a **trade mark search** before applying. A trade mark search can highlight such identical or similar marks on the registers of interest.

In addition, the owner of an earlier trade mark has a right to take action to prevent **use** of an identical, or confusingly similar mark. This may involve bringing **legal action for infringement** and it is therefore worth considering whether your use of a new trade mark could put you at risk of infringing existing third-party registrations. Performing a **full trade mark clearance search** is a useful exercise for assessing this risk and flagging potential conflicts at an early stage in the branding process.

## How do I get a registered trade mark?

You must provide a representation of the mark, along with a list of the goods and services to which it is to be applied. The application will then be examined by a trade marks Examiner, who will check that it meets the various criteria outlined above. Some offices, such as the UKIPO and IPOI, will check earlier registered marks to assess whether confusion is likely to occur, whereas other offices will check your application for formal requirements only. If no objections are raised, or if objections are raised, and overcome (for example by providing appropriate argument to the Examiner, or by limiting the goods or services to which the application relates) the trade mark will be published. Once published, the mark is open to a period of opposition, during which third parties can oppose the mark. If no opposition is filed, or an opposition is filed and subsequently settled, your mark will be registered. The registration process should take approximately 4 months in total, if no objections arise.



## Once registered?

Once registered, a trade mark lasts for 10 years and can be renewed at 10-year intervals upon payment of renewal fees. Trade marks can therefore be kept in force indefinitely. Once registered, the symbol ® can be used alongside the mark.

This information has been condensed for explanatory purposes and should not be taken as legal advice.  
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