



## TRADE MARKS - KEY FACTS

As IP lawyers, we are often asked what is a Trade Mark and why does it need to be registered? The simple answer is you spend vast sums of time and money in developing and marketing your brand or service which is key to your business. To distinguish this from your competitors and to enable you to establish your own identity, you would be wise to have a Trade Mark in place, which in turn raises awareness and identity.

This fact sheet simplifies what Trade Marks are, and how they can help your business.

### What is a Trade Mark?

A Trade Mark is effectively your brand. It is the 'badge' which distinguishes your goods and services from those of your competitors. Trade Marks usually take the form of words such as "Paris Smith" or a logo or a slogan. Wherever you look, there are recognisable brands which are unique to that business.

Trade Marks are valuable assets, which are often overlooked for their importance and the beauty of them, is that they are already there. You have already created it and are using it and it is continually generating goodwill and value for your business.

### What is the difference between a registered Trade Mark and an unregistered Trade Mark?

Your Trade Mark is enforceable whether you register it or not but a registered Trade Mark gives you automatic legal rights which are often more easily enforceable.

### What are the benefits of registration?

A registered Trade Mark:

- Helps to protect your brand
- Provides certainty as to your legal rights
- Removes the need to rely on "common law" rights
- Can be registered in the UK and EU
- Trade Marks can enhance balance sheets and can be licensed, franchised or even sold.

In order to enforce an unregistered Trade Mark, you would have to show the extent of goodwill/reputation you have acquired and prove that consumers have been confused or deceived by the unauthorised use of your mark, resulting in loss/damage.

### Can all Trade Marks be registered?

Not all Trade Marks are capable of registration. Words that are commonly used in the trade or which are generic may not be registerable.

Trade Marks that are not distinctive, designate geographical origin or which are offensive are also not registerable, so careful consideration has to be given when looking at the registration of your mark. Remember, APPLE in respect of computers is distinctive and not something which other traders might legitimately want to use. APPLE in respect of fruit and vegetables, is not!



## Can two businesses own the same Trade Mark?

Ideally you want your Trade Mark to be unique but yes, two businesses can own the same Trade Mark with the same name etc., if they are providing different goods and services. All goods and services are classified under different headings and there are now [45] classes. You must choose the goods and services that you wish to protect and allocate them into the appropriate class. The broader the range of goods and services you choose, the broader the range of your protection. But remember, that not only does more classes = more fees, but you are also increasing the scope and likelihood of conflict with an existing registration. The key message here is to ensure that your Trade Mark is registered in the appropriate class. It is sometimes advisable to carry out a pre-application search to see what is already on the register. It could be that by defining the scope of your goods and services carefully, you can avoid problems at a later date.

## What is the registration process?

Applications usually take around 6-9 months to register in the UK as long as they are straight forward. There is also the option of the fast track process. The speed of applications is very much dependent on how distinctive your Trade Mark is and whether an opposition is lodged by a third party who may have an earlier or stronger claim on the mark, as this can slow the process down.

On completion, a registration certificate is issued and the trademark is normally then valid for a period of 10 years from the date of application. At the 10 year period you can renew your registration for successive periods of 10 years and that way, unlike other intellectual property rights, protection continues indefinitely.

## Do I have to use my Trade Mark?

Any Trade Mark that is registered in the UK and has not been used by its owner for a continuous period of genuine use over five years can be challenged. A third party can apply for the Trade Mark to be removed if it has not been used appropriately or was originally applied for in bad faith.

## How can I monitor my Trade Mark?

Once your Trade Mark is registered, it is recommended that you have a monitoring service set up to monitor any competitors seeking to register a similar Trade Mark.

## Find out more

Please look at:

- Our fee schedule
- Q&A on Trade Marks

Please contact us to discuss your requirements or to find out more.



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