



## UK Trade Marks Law

The law relating to trade marks has undergone considerable change since the 1994 Trade Marks Act and there is no longer any distinction between trade and service marks.

### **To be capable of registration a trade mark has to satisfy two tests:**

- (i) it must be capable of being represented graphically; and
- (ii) it must be capable of distinguishing the applicant's goods or services from the goods and services of other businesses.

It is now possible to file applications for words, logos, three dimensional shapes, colours, sounds (including jingles), smells and even concepts and gestures provided such marks can be represented graphically and distinguish the applicant's goods or services from those of other traders.

The general rule is that the first person to apply can register a mark. However if the mark consists of descriptive words, an applicant is unlikely to succeed in registering that mark without evidence of reputation. In addition, earlier registered trade marks and pending applications and owners of earlier rights may prevent applications proceeding.

Registration is by classes of goods and services and the rights arising from a trade mark are the exclusive right to use that mark in relation to those categories of goods and services in respect of which the registration has been obtained.

The owner's rights are not however confined to preventing third parties from using identical marks in relation to identical goods and services as the registration.

The owner's rights extend to stopping third parties using identical or similar marks on identical or similar goods or services to those registered and in some exceptional circumstances dissimilar goods and services.

Anyone wishing to use a mark must therefore obtain the licence of the registered owner.

The owner, and in certain circumstances exclusive and non-exclusive licensees, can take action for registered trade mark infringement. No action is possible until the trade mark is registered although once registration is obtained the owner may be able to take action in respect of infringements of the mark going back to the date of application. Infringing acts include using the mark on goods or packaging, importing or exporting goods under this mark and using the mark on business paper or in advertising.

The use of registered trade marks in comparative advertising is now permitted subject to certain restrictions.

The content of this fact sheet is of benefit interest only and is not an exhaustive explanation of copyright in UK trade marks law. This fact sheet is not intended to apply to specific circumstances. The contents of this fact sheet should not therefore be regarded as constituting legal or other advice and should not be relied upon as such. In relation to any particular problem that you may have, you are advised to seek specific and specialist advice.

Trade marks fall due for renewal after ten years and then can be renewed for consecutive periods of ten years upon payment of renewal fees. They are however liable to cancellation if they are not used for a continuous period of five years or more after they have been registered.

Any person can apply to remove a mark in these circumstances and they do not have to be a person wanting to use that mark. It is possible to file one application for a Community trade mark which covers all the EU countries. It is also possible to file one application under what is known as the Madrid Protocol covering signatory states. Those trade mark owners or licensees considering taking action for trade mark infringement should take particular care since making groundless threats of such proceedings may give the threatened party a right to take legal action.