

## brief guide to trade marks

### what is a trade mark ?

A trade mark, or brand, is an indicator of origin for your goods or services. It is the way in which you identify and distinguish yourself from your competitors. It can be a word, logo, colour, picture, shape or a combination of these. Theoretically a trade mark can even be a sound, smell or gesture if you can show that it serves the purpose of identifying the source of the items sold.

A trade mark is important because it is the signal to the customer that the goods or services they are buying from you will be of a particular quality and that subsequent purchases will be of equal quality.

Trade marks are assets which become more valuable to the business as your brand recognition grows. It is the symbol that embodies the goodwill of your business.

### how do trade mark rights come into existence ?

This will vary from country to country.

#### unregistered rights

In some countries there are laws providing rights to unregistered trade marks. These can be useful in many circumstances but are invariably more difficult and expensive to enforce than registered rights.

Such laws normally run in parallel with rights provided by registration and examples are the common law rights in “passing-off” in the UK and “unfair competition” laws which operate in some European jurisdictions.

Rights in passing off protect the goodwill in a business. In order to succeed it is necessary to show that the requisite goodwill exists. Proof of goodwill requires collection and submission of substantial amounts of evidence. The nature of this evidence will depend on the facts of each case but the materials must support the claim that there is recognition of the alleged goodwill. Details of the past use including annual turnover figures, advertising expenditure, volumes of sales, and consumer surveys can be positive contributions. However, without a trade mark registration there is a great deal of uncertainty surrounding your rights in a brand.

#### registered rights

Most countries around the world enforce Trade Mark laws and operate a trade mark registration system. A Trade Mark Registration is the most effective way of protecting the rights in your brands.

In many countries the **only** way to protect your Trade Mark is by registration and the first to register owns the right. It is therefore important to file trade mark applications as early as possible.

Different types of registration are available:

**National Registration:** This provides protection in relation to a particular mark in a particular country and is obtained through the National Trade Mark Office of that country.

**Community Trade Mark (CTM) Registration:** This is a single registration obtained at the Office for Harmonisation of the Internal Market (OHIM) and provides protection in all member states of the European Union (currently there are 27).

**International Registration:** This is a system operated under an international convention (the Madrid Agreement and Protocol) which enables a bundle of National Registrations to be sought in one or more countries which are party to the convention, by filing an application centrally at the World Intellectual Property Organisation (WIPO).

There are advantages and disadvantages to each of these types of registration and your HallMark IP attorney will be able to advise you on the best choice for your case.

## the registration procedure

The detail of trade mark registration procedure varies from country to country but the general principles are similar. These are summarised as follows:

- An application is filed at the local government Trade Mark office
- The application is examined by the government office (unless the country runs a deposit system – this operates in very few countries and the application is registered automatically with no examination)
- The examination looks at whether the mark is inherently registrable – descriptive "marks" such as COUTURE for clothing do not qualify – and/or for conflicts with earlier marks on the register
- If objections are raised you are given the opportunity to try to overcome them
- The application then proceeds to publication for opposition purposes
- If oppositions are filed you are given the opportunity to defend the mark
- If the application successfully negotiates these stages the mark proceeds to registration

## what rights are given by registration ?

Registration of a trade mark gives you a monopoly right to the mark in a particular territory in relation to relevant goods or services. It enables you to prevent unauthorised use of the same or a similar mark by others in respect of the same or similar goods and services.

In certain circumstances you can also prevent the use of the same or a similar mark in relation to different goods or services.

It is essential that you have adequate trade mark protection for two main reasons:

- To ensure that you can enforce your rights against infringers should that be necessary; and
- To reduce the risk of others being in a position to limit your business activities by obtaining conflicting rights ahead of you.

## how can we help you ?

We can advise you on all aspects of Trade Mark law from brand development and clearance to registration and enforcement. Once you have made a decision on the best strategy for you we can implement appropriate trade mark filings in all trade mark jurisdictions around the world and take care of all registration and maintenance requirements.

### HallMark IP Limited

1 Pemberton Row • London EC4A 3BG  
t + 44 (0)20 3102 9000 • f + 44 (0)20 3102 9001  
e-mail: [info@hallmark-ip.com](mailto:info@hallmark-ip.com) • [www.hallmark-ip.com](http://www.hallmark-ip.com)

This Brief Guide was prepared as an overview of the subject matter. It is not intended as a substitute for considered advice from one of our attorneys and should not be relied on as such. For assistance on IP related issues please contact the HallMark IP attorney who normally deals with your matters. Alternatively, you can make a general inquiry at [info@hallmark-ip.com](mailto:info@hallmark-ip.com) or call us on +44 (0)20 3102 9000. We look forward to helping you.

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