

Introduction

We have prepared this brief guide to trade marks to enable our clients to get an overview of the regulatory framework and to understand the differing options that are available to take forward a trade mark application.

What is a Trade Mark?

Trade Marks Act 1994 (s1) defines a trade mark as any sign which can be represented graphically and distinguishes the goods or services of one undertaking from those of other undertakings. Therefore a trade mark may consist of words, designs, letters, numerals, or the shape of goods or packaging.

Can my mark be registered?

In order to register a trade mark needs to comply with the requirements for registration. These can be summarised as follows:-

- It must be distinctive
- It must not be descriptive
- It must not be deceptive
- It must not contain "sensitive words or symbols"
- It must comply with the Trade Marks Act 1994

What does registration offer?

The registered owner of a trade mark has *prima facie* proof of ownership and entitlement to the mark. Registration gives the owner a statutory monopoly for use of the mark in relation to the class of goods or services for which it is registered. Using a confusingly similar mark (only distinctive marks can be registered) does not require the owner to prove actual damage and gives rise to the right to commence an infringement action. This can be extremely useful as under the common law an unregistered mark would require protection from a "passing off" action, which can be time consuming and expensive.

The tangibility of a registered trade mark ensures the property can be licensed, alienated or secured to third parties. A trade mark has a value which can be treated as an asset for balance sheet purposes. Registration secures the mark and prevents others claiming ownership and right of use.

Where can I register my trade mark?

Trade marks can be registered in the UK, the European Community and in other jurisdictions worldwide. The process for registration differs from one jurisdiction to another. It is advisable to define the geographic locations of the likely markets for your goods or services and consider registration in those jurisdictions.

A UK trade mark can be considered as the basis for registration of a community trade mark, and very often is used as such.

What is the Registration Procedure?

The United Kingdom

A trade mark registration application must be presented to the Patent Office, who *inter alia* deal with trade mark registration. Provided the requirements for registration as outlined above are met the application will be accepted and the presenter notified accordingly. A short time thereafter (in the next available publication) details of the application will be published in the Trade Mark Journal. From the date of publication a period of three months is allowed for the receipt of objections by the Patent Office.

If no objections are received a certificate of registration is issued. The mark is also entered in the Register for an initial period of ten years. Registered trade marks can be renewed every ten years.

Community Trade Marks

The then fifteen member states of the European Union adopted legislation under EU Regulation 40/94 on 20 December 1993, which came into effect on 1st April 1996, when the Office for Harmonization in the Internal Market (Trade Marks and Designs), referred to as "the Office", commenced public operations to handle the administration of Community trade marks. With the accession of the further ten member states on 1st May 2004 this now applies to twenty five European Union countries. A list of member states is available in our Intellectual Property Resources leaflet.

The International Route

The Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27 June 1989 (the Madrid Protocol) became community law on 1 December 1995 and became operational on 1 April 1996.

The Madrid Protocol provides for the international registration of marks at the International Bureau of the World Intellectual Property Organization (WIPO) at Geneva. Registrations effected under the Madrid Protocol are called international as every registration has effect in several countries and regions, potentially in all the Contracting Parties, including States and intergovernmental organizations who have a regional Office for the purpose of registering marks with effect in the territory of the organization.

Enquiries

To make an enquiry about trade mark services, please contact our office in Manchester in the first instance and we will then discuss the proposed trade mark with you in detail. We will need to see a sample of any proposed mark in order to give you the fullest advice. You can send this to us (where convenient) by email to client@mtmlegal.co.uk. If possible, please include a contact telephone number so that we can revert to you to for a preliminary discussion about the proposed trade mark.

MURPHY THOMPSON MOORE LLP

**+ + 44 161 835 2080
WWW.MTMLEGAL.CO.UK**