

INTRODUCTION TO TRADEMARKS



Intellectual Property covers four main areas:

Patents - How something works

Trade Marks – What you call it

Designs – What it looks like

Copyright – Artistic or literary expression

Sometimes a single item can be covered by all four elements, for example, a new lock mechanism could be covered by a **Patent** for the mechanism, by a **Design** for the appearance given to the outside, by a **Trade Mark** for a logo and by **Copyright** for the installation instructions.

Trade marks are badges of origin. They distinguish the goods or services of one trader from another and can take many forms; for example words, slogans, logos, shapes, colours and sounds.

Trade Marks are registered for specific goods or services within individual subjects, known as classes. It is possible for others to register identical or similar marks as long as it is in a different, unconnected class. For example Swan rental cars, Swan matches and Swan electricals. There are 45 classes to choose from, A list can be found at <http://www.ipo.gov.uk/tm/t-applying/t-class/t-class-guide.htm>

They should not be descriptive and must not include common surnames, geographical names, registered company names or anything implying royal patronage.

In Europe Trade Marks must be registered in order to have protection. Provided they are looked after properly, see below, a Trade Mark can last indefinitely. An example of a Trade Mark still in use includes the very first UK Trade Mark, number 1 from 1876: The red triangle used by Bass for beer.

To continue protection the Trade Mark must be

Used in commerce

Have fees paid as required to keep it in force

Must not become generic, such as a noun or verb in common usage

Must be identified as a Trade Mark by ® In some countries

Make sure that your chosen trade mark does not infringe someone else's and that you are free to use it. You can complete a free search in the Business and IP Centre. This database is linked directly to the Intellectual Property Office.

Decide which types of goods or services you need to protect. You should think about your future plans to ensure your protection covers all the areas your business might need.

Think about the geographical coverage you need. You can register a trade mark to protect you in the UK, throughout the European Union, Internationally or in individual countries.

Make sure your trade mark is used in the correct way. It is the mark that identifies your goods or service to consumers, so incorrect use could harm your reputation. Allowing your trade mark to become a generic name, like aspirin, escalator and linoleum, results in the loss of your trade mark – so beware.

Once you have a registered trade mark you need to check to make sure no-one infringes it by having a similar trade mark in the same classes as your goods and services. If you see someone infringing your trade mark, seek advice from a trade mark attorney. They can take action to stop the infringement or could negotiate on your behalf to license your trade mark. Cases rarely end up in court though that is the ultimate sanction of owning a trade mark.

For a British Trade Mark fees are required every 10 years to keep a Trade Mark in force.

Protection in Britain can also be obtained by using a national mark. Since 1st April 1996 two schemes have become available.

The Community Trade Mark (OHIM, from Alicante, Spain). Details can be found in the Community Trade Mark Bulletin, This allows protection in designated states within this agreement the EU.

The Madrid Agreement Protocol, (By WIPO, Geneva). Details can be found in the WIPO gazette of international marks. This allows protection in designated states within the agreement Internationally.

Generally there are two types of Trade mark searching

Trying to identify the proprietor of a known mark

Establishing clearance to use a Trade Mark

The latter is more complicated because it means searching for similar marks rather than an identical match. The phonetic spelling of a Trade Mark must be taken into account, also unregistered trade names not normally found on databases.

Until recently the only international registration was 'The Madrid Agreement' but this did not include Britain or USA. 'Les Marques Internationales' published from 1893 arranges the registrations in numerical order with annual name indexes. In 1996 the gazette changed its name to 'WIPO-Gazette of International Marks'.

In April 1996 'The Protocol to the Madrid Agreement involves designating member states, which then have the freedom to refuse registration. This does not affect registration elsewhere.

The new scheme for Community Trade Marks also became available from 1996. Registrations are valid for the entire of the European Union. As with Madrid a country can object to a registration, but in this case the entire registration for the EU will fall if the objection is sustained.

The Paris Convention of 1883 regulated trade mark activity - it provided for the '6ters'. Marks for governmental or inter-governmental organisations where a flag, names, initials etc are excluded from registration.

References

The British Library Business & IP Centre

The Business & IP Centre has all the business and Intellectual property information you need as an innovator and entrepreneur.

Can be contacted by phone– 020 7412 7454 or by email bipc@bl.uk.

You can take a look at our Web page <http://www.bl.uk/bipc/>

The Intellectual Property Office

The IPO is the official government body responsible for granting Intellectual Property rights in the United Kingdom.

Can be contacted by phone– 0300 300 2000 or by email- information@ipo.gov.uk.

You can take a look at their web page <http://www.ipo.gov.uk/home.htm>



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