



WING TIPS

The Value of Intellectual Property – Trade Marks

Introduction

Trade Marks are crucial for any business in any sector.

A trade mark or brand name identifies your business, your product or service. It distinguishes your business from a competing business.

Your name is what your customer recognises when they come back for more, it could be the single most important identifier of your business. This means that a trade mark is an extremely valuable asset.

Protection

The first question to ask yourself is not “Is somebody infringing my trade mark?” but “Am I infringing somebody’s trade mark?” You should search and clear any trade mark you are interested in using before you use it, to ensure that you are not infringing somebody else’s trade mark rights.

The next step is to register a trade mark. The benefit of a trade mark registration is that it enables you to prevent a third party from using your mark or a similar mark for identical or similar goods and services. You do not get this benefit from a company name registration or a domain name registration.

Your registration is a searchable entry on a publicly available database so your trade mark registration serves as a warning to third parties to ‘keep off the grass’.

Generally speaking rights go to the first to register a mark rather than the first to use. It is important therefore to secure your position of priority by obtaining a filing date. This can put you in a position of strength over a third party who is using the mark but who has not registered it. Conversely, you could use an unregistered mark for 12 months or more only to find that a third party has registered it and that the third party can exert their trade mark rights against you. If you are forced to stop using your trade mark after say two or three years, this means that all your goodwill in the name will disappear and your investment in the name by promoting it on your website, in your literature and by educating your clients could be lost. The cost of defending your unregistered mark is likely to far exceed the cost of registering it in the first place.

The need for a trade mark registration will become more apparent as your company acquires a higher profile, as you consider licensing/franchising your business or entering distributorship arrangements. When third parties become increasingly exposed to your mark, you really need the security of a trade mark registration under your belt.

You can protect your trade mark in the UK only, in the EU as a whole or on a country by country basis. Many companies begin with a UK or an EU application, and file applications later in other countries as they become of interest to the business. Your strategy should be to concentrate on your key marks in key countries.

Maintenance

Over time, a trade mark registration becomes vulnerable to cancellation if the mark is not used on the registered goods in the territory in which it is protected. It is advisable therefore to keep records of your use of a mark so that you can prove use if necessary.

You ought to watch for conflicting trade mark applications by subscribing to a watching service. This gives you early warning of potentially conflicting marks so that you can oppose if necessary.

Summary

Search your trade mark - are you free to use it without risk of trade mark infringement?

Register your trade mark - get a position of priority.

Use your mark, keep records of use and watch for your mark.

For further information on The Value of IP – Trade Marks, please contact Richard Jackson, Anthony James or Gary Small at Carpmaels & Ransford on: +44 (0)20 7242 8692 or visit www.carpmaels.com