



## **TRADE MARK FACT SHEET**

### **What is a Trade Mark?**

A trade mark is a sign which helps to distinguish your goods or services from those of your competitors. A trade mark can be for example a word, phrase, slogan, device, logo or a shape (providing the shape meets certain requirements). In order to be registered it must be distinctive.

Trade marks are not registrable if they:

- describe your goods or services, or a characteristic of your goods or services;
- have become the generic (customary) name in the trade for the goods or services for which the mark is used;
- are offensive;
- are deceptive, for example if the mark would lead the public to believe that your goods or services have a quality, which they do not.

Trade mark rights are territorial. To protect your mark in the UK, you can either obtain a UK national trade mark registration, a Community registration, or an International registration, which designates the UK.

### **Why bother to Register my Trade Mark?**

Obtaining a registration gives you the exclusive right to use your mark for the goods and services for which it is registered. A registered trade mark also:

- acts as a deterrent to others who wish to use and/or register the same or similar mark in respect of the same or similar goods;
- allows you to take legal action against a third party who is using an identical, or confusingly similar mark in respect of identical or similar goods to those protected by the registration in any member state;
- allows you to enlist the help of the Trading Standards Officers, or Customs to prevent the use of your mark on infringing or counterfeit goods;
- is a tangible asset, which can be sold or licensed to a third party;
- You can only use ® if the mark is registered.



If you use an unregistered mark you will always be in a vulnerable position. For example, a third party could register the same or similar mark for the same or similar goods. The owner of such a registration could then instigate infringement proceedings against you. Depending upon the circumstances you may have a defence against such an action, but it would be extremely costly to defend yourself.

Having a Domain name registration, or a registered company name does not automatically entitle you to use that name as a trade mark.

### **Why do my Goods/Services have to be identified and classified?**

When filing a new application the goods and services for which the mark will be used must be identified. This enables a third party clearly to define what is protected under the registration, thus helping it to avoid conflict for example by using an identical or similar mark in respect of identical or similar goods. It also helps the courts clearly and without ambiguity to identify what goods and services are protected under the registration in for example in an infringement dispute.

Most countries throughout the world utilise the International Classification of Goods and Services, which is governed by the World Intellectual Property Organisation. For registration purposes, all goods and services are classified into one of 45 classes.

A new trade mark application must specify the goods or services of interest by class. A UK application can cover one or more classes, but separate fees are payable for each class of goods and/or services covered by the application.

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