

HEWITSONS

Trademarks

Most businesses have a name, symbol or logo that differentiates them or their products or services from those of their competitors and which their clients or customers can identify them by. This is called a trade mark. However, not all businesses have taken steps to register their trade marks, and this can be a costly mistake.

Although businesses are not required by law to register their trade marks, registration is highly recommended. If you register a trade mark, you will have the exclusive right to use the trade mark in connection with the goods or services that it has been registered for, in the territory in which it is registered. What this means for example in the UK is that, under the Trade Marks Act 1994, as the owner of the trade mark, you have the right to obtain an injunction and damages against anyone who, without your permission, uses an identical trade mark in connection with goods or services that are identical to those for which your trade mark is registered.

However, registering a trade mark gives you wider protection. Even if the trade mark used by the other person, and/or the goods or services in relation to which they use it, are not identical to your registered trade mark and the goods or services in respect of which you have registered it, you are still protected if the similarities are such that there is a likelihood of confusion on the part of the public.

In contrast to the position with unregistered trade marks, you do not have to show that you have built up goodwill in the trade mark and that the unauthorised use of it will damage the goodwill of your business, or that the use you object to constitutes a misrepresentation, for example that the user's business is connected to yours.

If you have not registered your trade mark, anyone can apply to register it. Although you may oppose

the application on the grounds of your prior use, if you are unsuccessful you may have to negotiate with the owner to obtain a licence to use the trade mark or to purchase it. The outcome of the negotiation is uncertain. If you fail to get the rights you seek, your continued use of the trade mark could result in legal action being taken against you for infringement and you may have to re-brand.

If your trade mark is being used without your consent and it has not been registered, the only protection you may rely on in the UK is a passing off action. However, this action is potentially expensive, time-consuming and success can be elusive. With a passing off action, you are required to prove that by use of the mark you have built up goodwill in it. You also have to show that the trade mark's use without your consent is an act of misrepresentation which is causing damage to the goodwill of your business, or is likely to do so.

It is therefore much easier to take legal action to protect your business from someone who is using your trade mark, or a mark similar to it, if you have registered your trade mark.

A trade mark can be a
valuable asset so make
sure it is registered.



Moreover, once your trade mark is registered, it can remain on the Register of Trade Marks indefinitely as long as you pay periodic renewal fees (the Bass red triangle was the first trade mark to be registered in the UK and has been on the Register since 1876). The Register is also accessible to members of the public for inspection, which may have the effect of deterring others from using your trade mark without your consent. As the owner of a registered trade mark, you can license others to use it. This has the advantage of giving you control over how your trade mark is being used, and, in some cases, you may be able to charge for use of it.

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This document is written as an outline guide only and any action should not be based solely on the information given here. Appropriate professional advice should always be taken in specific instances.

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