

# Trade Marks

## What do they protect?

Trade marks enable customers to identify goods or services as coming from a particular business, and to distinguish them from those of other businesses. They can therefore play a strong role in determining and developing your brand. As a form of intellectual property, trade marks can be licensed or assigned to third parties. Once registered, you will be able to take legal action against anyone who uses your mark without your permission, in the country in which the mark is registered.

Trade marks traditionally protect names, words or logos, but can also be phrases, symbols, sounds, shapes or colours, or often a combination of one or more of these. Trade marks are registered in respect of the goods or services to which the mark is to be applied.

## What is required of a trade mark?

In order for your mark to be registrable as a trade mark, it must meet a number of criteria.

- Your mark must be **distinctive**, i.e. capable of distinguishing your goods and services from those of another. Generic, or non-distinctive marks such as “we lead the way”, cannot fulfil this criterion.
- Your mark **cannot be descriptive** of the goods and services to which it is to be applied, or of their characteristics. Descriptive terms should be free for all to use!
- Your mark **cannot be misleading**. An example is the mark ORLWOOLA, which was refused as being misleading when applied to non-wool articles.
- Your mark **cannot be offensive**, for example contain swear words.
- Your mark must also **not cause confusion** with an earlier mark. Confusion tends to arise when there is an identical or similar mark registered for identical or similar goods or services. The UKIPO will perform a search of earlier marks to check whether confusion is likely to occur. You can increase your chances of getting a registered mark by performing a **trade mark search** before applying. A trade mark search can highlight such identical or similar marks on the registers of interest.

If your mark meets the above criteria, you may wish to file a trade mark application.

### **How do I get a registered trade mark?**

For trade mark applications filed at the UK Intellectual Property Office, you must provide a representation of the mark, along with a list of the goods and services to which it is to be applied. The application will then be examined by a trade marks Examiner, who will check that it meets the various criteria outlined above. If no objections are raised, or if objections are raised, and overcome (for example by providing appropriate argument to the Examiner, or by limiting the goods or services to which the application relates) the trade mark will be published. Once published, the mark is open to a period of opposition, during which third parties can oppose the mark. If no opposition is filed, your mark will be registered. The registration process should take approximately 4 months in total, if no objections arise.

### **Once registered?**

Once registered, a trade mark lasts for 10 years and can be renewed at 10-year intervals upon payment of renewal fees. Trade marks can therefore be kept in force indefinitely. Once registered, the symbol ® can be used alongside the mark.