

Why register a trademark?

In today's competitive and global market place, protecting your business identity has become one of the most important steps you can take. Online trading allows worldwide access to goods and services and your web site puts your business freely in the public domain. As a consequence it is now much easier for a competitor to take advantage of your hard-earned reputation. If you need to create a brand name or conduct expensive marketing campaigns and advertising, it is often wise to protect your identity with a UK registered trademark.

When considering trademark registration it is important to understand that the concept of trademark protection extends to the provision of services as well as goods and brand names. A trademark is a sign or text capable of being represented graphically and which distinguishes goods or services of one undertaking from those of another undertaking. A trademark may consist of words, designs, logos or combinations of letters and/or numerals. It may be as simple as the business name, although most trademarks tend to be stylized words including specific graphics and/or colour.

If you do not register a trademark it is easier for competitors to use a brand name or business logo similar to your own, meaning that they can reap the benefits of your hard work. If you do not possess a trademark, infringement may also occur innocently. Whilst you or your company has the natural right to copyright in law, legal action to prevent such an infringement known as "passing off", can be expensive and time consuming.

Passing Off

Passing off is the use of an unregistered mark in such a way that a third party using the mark represents the goods or services (or 'passes them off') as their own. You can take common-law action to prevent passing off, but there are a number of factors that you must consider before you can prove passing off. As the owner of an unregistered brand, you must be able to prove that:

- you trade in the goods or services to which the particular mark applies
- the public associate your mark with the goods you produce or the services you provide
- you have a reputation in those goods or services and therefore goodwill is attached to the name
- there is a likelihood of deception
- you have suffered, or are likely to suffer, substantial damages to your goodwill as a result of the third party passing off your mark

It can be very difficult and expensive to prove passing off, so it would be to your advantage to register your mark. If your mark is registered, the "passing off" would constitute infringement, for which you can take legal action.

How is my trademark registered?

The application generally takes around 4 months to complete. Once a trademark application has been accepted by the UKIPO, it will be advertised in the Trademarks Journal, which is published every Friday on the Patent Office web site. The Journal advertisement will last for a period of 2 months, which allows any interested parties with justifiable cause to oppose the registration of a trademark. Opposition is the legal procedure that allows anyone to try and stop the registration of a trademark. They may only do this by filing the appropriate documents with the UKIPO.

The most common reasons for someone wanting to oppose the registration of a trademark are:

- They think the trademark is one which is not unique to the applicant and should be free for everyone in that line of trade to use
- They own a brand name (which may or may not be a registered trademark) which is the same as, or similar to, the applicant's mark

CRO provides a full Trademark Registration Service and we can guide you through the process providing advice on suitability for registration before you commit to any fees.