

BRANDED!

“ “ A modern international
business with robust
foundations. ” ”

Introduction

BRANDED! are a firm of trade mark attorneys specialising in trade mark and registered design matters and based in the historic city of York in the North of England.

Responding to the need for trade mark advice amongst the growing number of technology-based local companies, Carin Burchell, a trade mark attorney with extensive experience gained in both the UK and Hong Kong, founded the firm in 1995.

BRANDED! have invested heavily in IT and have a state of the art trade mark management software system. The BRANDED! website can be found at www.trade-mark.co.uk

BRANDED! attract a global clientele and have strong links with attorneys in countries around the world. BRANDED! attorneys practice before the UK Trade Marks Registry and the Office for Harmonisation in the Internal Market (Community Trade Mark and Registered Designs Office of the European Union in Alicante) and handle International Trade Mark Registrations obtained through the World Intellectual Property Organisation in Geneva.

BRANDED! offer advice on all aspects of trade mark, design and copyright law including:

- ▶ Development of new trade marks
- ▶ Selecting a trade mark and searching for availability
- ▶ Filing and prosecution of trade mark applications
- ▶ Oppositions
- ▶ Rectification
- ▶ Licensing and other post registration matters
- ▶ Trade Mark Infringement
- ▶ Filing and prosecution of registered design applications
- ▶ Invalidation actions
- ▶ Registered Designs
- ▶ Infringement
- ▶ Copyright
- ▶ Copyright Infringement

What is a trade mark?

A “brand” or trade mark can take many forms. It can be a word, a logo, a shape or even a sound - or a combination of any of these. In fact, a trade mark is anything which distinguishes one product or service from others and indicates where it comes from.

A trade mark helps consumers to buy a product or service again, or to recommend it to their friends and colleagues.

Only by registering and policing the use of a trade mark is it possible to ensure that you have the exclusive right to use it. You will then, hopefully, be able to stop others from infringing it – and so benefiting from, or even damaging your reputation.

A trade mark registration lasts for 10 years. It can be renewed for further 10 year periods, forever.

What goods or services?

The goods and/or services on which the trade mark is to be used. There are 45 classes of Goods and Services and everything (even the most innovative and unusual service) can be categorised into one of these classes.

BRANDED! can help you to identify the classes which are relevant to your business.

What is a good trade mark?

Trade marks identify where goods or services come from. Therefore, it is very important that a trade mark stands out from those of other organisations and competitors. A good trade mark should be:

- ▶ Distinctive
- ▶ Memorable
- ▶ Easily pronounced
- ▶ Linguistically appropriate

Marketing specialists will often want a trade mark to indicate some of the beneficial qualities of the product or the results that it can achieve, and will therefore favour a descriptive mark. However, from a legal point of view, a trade mark should be capable of distinguishing your goods or services from those of your competitors so that it is more likely to be able to be registered.

The best new trade marks often have no meaning. KODAK is an example. An invented word may look strange and unattractive at first, but it is more likely to be registrable, will be easier to police and will eventually be more memorable.

BRANDED! can assist with trade mark creation and linguistic checks in key language countries.

Search

Before beginning to use, or applying to register a trade mark, BRANDED! recommend that you search for possible conflicting marks. This could well save on legal costs in the long run by drawing your attention to the existence of any trade mark rights which your use would infringe.

The last thing you would want to have to do, after building up a reputation in a trade mark (and printing all your labels and stationery), is re-brand. Without doing a full trade mark search beforehand, how can you know that you won't have to?

BRANDED! can arrange trade mark searches in all countries of the world where they are possible.

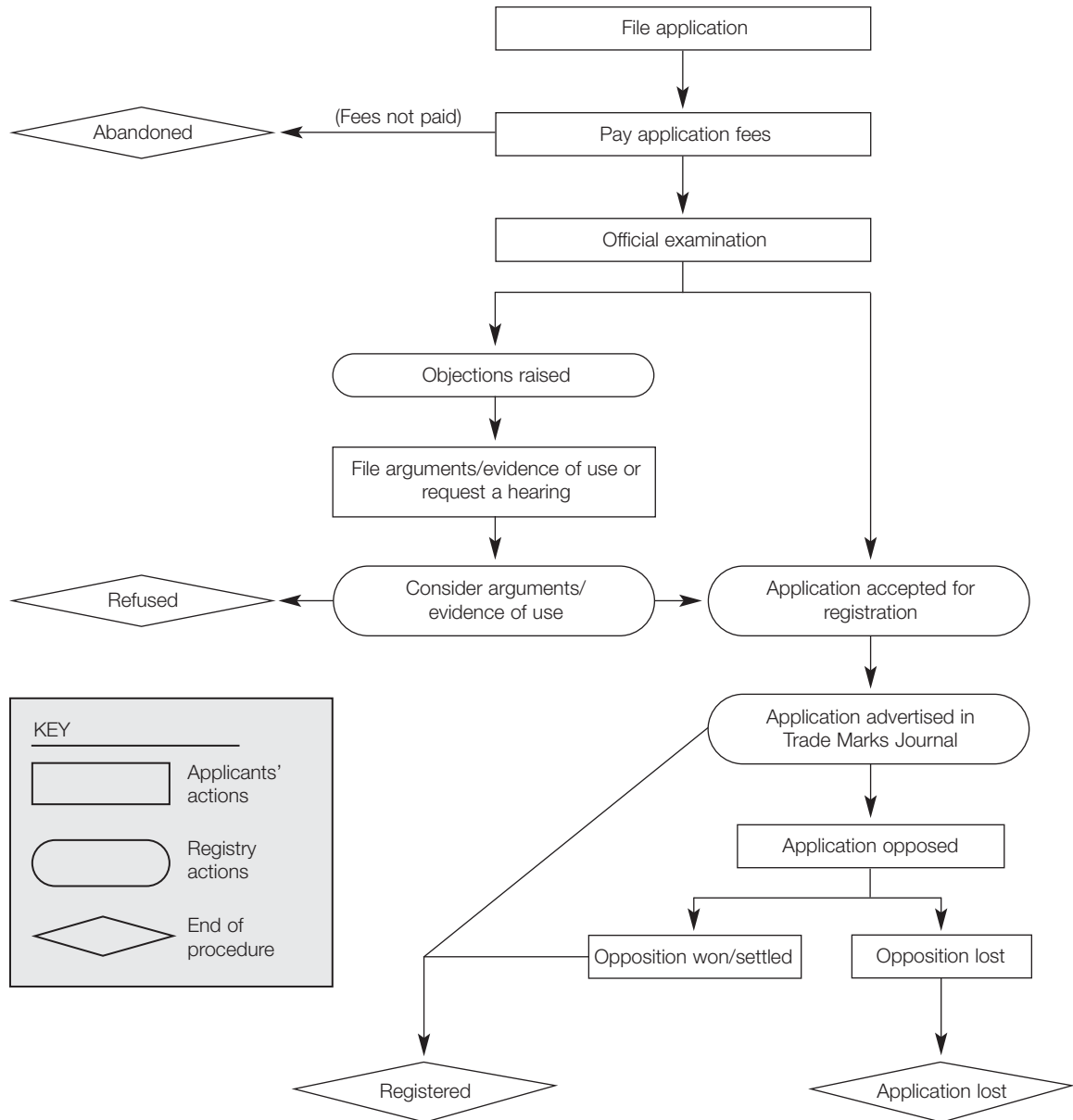
Where to register

Trade marks should be registered wherever you intend to use them. This could be the UK, the European Union, Kazakhstan or anywhere else. If you don't, someone else may register the mark in their own name and thus prevent you from using your mark there.

It is possible to register trade marks in over 200 countries around the world. This can be done by individual applications in single countries, or under the Community Trade Mark or International Registration systems. The CTM covers the whole of the EU and is organised through a central registry in Alicante. The International Registration can cover as many or as few of the member countries as you like from an ever growing list via a central office in Geneva.

There are different advantages and disadvantages of each system – and BRANDED! can advise the best strategy for you, depending on your circumstances.

UK Trade mark application procedure



What next?

USE CONSISTENTLY

BRANDED! can produce a tailor made Good Use Guide.

POLICE

Once registered, your trade mark should be policed. BRANDED! recommend that it should be placed on a trade mark watching service so that you will be notified of the existence of any conflicting marks. You will then be in a position to object to them if you wish.

LICENCE

The use of your mark by manufacturers and distributors may need to be licensed or franchised. You may be able to earn royalties.

DOMAIN NAMES

Obtain a domain name registration, if this has not been done earlier.

Trade mark notice

Once registered, ® may be put next to the trade mark on labels and in publicity material.

Before registration, or in other jurisdictions where you have no registrations or in respect of other goods or services, TM or SM may be used next to the trade mark.

BRANDED! recommend that a trade mark notice is used e.g., “[TRADE MARK] is the registered trade mark of [name of owner]”, where appropriate.

BRANDED! always recommend that TM is used in respect of trade marks on websites because they can be viewed throughout the world and it is unlikely that the trade mark will be registered in every country where it can be viewed.

Copyright

Copyright exists automatically in all original works from the date on which they are created. The term “work” has a very wide meaning and includes literary, dramatic, musical and artistic material as well as sound recordings, films, broadcasts and published editions. In order for a work to be original, it must not be copied.

Copyright is owned by the author of the work. This is usually the person who creates the work, unless the work is created as part of a contract of employment, in which case the owner will usually be the employer. Care should be taken in the case of work which is commissioned, for example logos and websites, as the creator of the work will retain the copyright, unless it is stipulated otherwise in the contract, or a separate document is signed which transfers the copyright. BRANDED! can assist you with the wording of such a contract or preparation of a document to transfer copyright.

The duration of a copyright term depends on the type of work it is. For literary, dramatic, musical and artistic works the copyright expires at the end of the 70th year following the death of the author. Other types of work, however, have shorter a copyright term.

As copyright exists automatically in the United Kingdom, there is no need to register it. However, the creator should sign and date their work and use the © symbol so as to indicate that they are claiming copyright in the work. In order to prove the date of creation, a creator will often send a copy of the work to themselves.

Copyright entitles an owner to prevent a third party from, without their permission, copying a work, issuing copies to the public, performing a work in public, renting copies to the public, broadcasting or cable-casting, playing or showing a work in public.

Registered design protection

It is possible to protect designs in the UK through one of two different systems:

- ▶ UK Registered Designs (“URD”); or
- ▶ Registered Community Designs (“RCD”).

Both systems are based on similar law with the main difference being the geographical scope covered by the registration. URD only covers the UK, whereas RCD covers the whole of the European Union.

For the purposes of registration, a design is “the appearance of the whole or a part of a product resulting from the features of the product itself and/or its ornamentation”. In order to be registrable a design must have the following characteristics:

- ▶ Novelty, i.e. not be identical to an earlier design; and
- ▶ Individual character, i.e. the overall impression it produces differs from that of any design which has already been made available to the public.

Registered designs last for 5 years. They can be renewed for further 5 year periods for a maximum 25 years.

Registered designs offer a relatively inexpensive way of obtaining protection for a new product. Whilst copyright will nearly always exist in designs and thus give a degree of automatic intellectual property protection, the main advantage of registered design protection is that there is no requirement to show copying to succeed in an infringement action.

There is also an ever increasing overlap between registered designs and trade marks, given that many device trade marks now fall within the broad definition of a registered design. Registered design protection may be an attractive interim alternative to registered trade mark protection for a device which is unlikely to obtain registration without supporting evidence of use.

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Or visit our website, which has regularly updated articles about developments in the world of trade marks, copyright and registered designs:

www.trade-mark.co.uk



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