

FRY HEATH SPENCE – BEST PRACTICE GUIDE TO TRADE MARK USE

WHAT IS A TRADE MARK?

Badge of Origin

A trade mark is a badge of ownership which is used to identify goods or services and tell people where they come from. A trade mark can be any sign that uniquely identifies a business, provided the mark can be represented graphically and differentiates the owner's goods and services from those of other businesses. It can take the form of a word or words, numbers, a slogan, picture, shape, smell or even a colour.

Reputation and Goodwill

A trade mark embodies the *reputation* of the business which makes the goods. It is the visible manifestation of the *goodwill* a business has built up in its goods and services over a period of time.

Sign of Quality

The identity of the brand owner is often irrelevant; however, in an increasingly impersonal market-place, a well-known trade mark gives the customer a sign to which he can return for goods and services of the same quality and characteristics. The trade mark therefore becomes a symbol of *quality* and identifies the *unique character* of the goods it describes.

HOW SHOULD I USE TRADE MARKS CORRECTLY?

- Maintain Use of the Mark

It is important to keep using your trade mark for the goods and/or services covered by the registration – if use is suspended for five years or more (in some countries 3 or only 2 years or more), the mark becomes vulnerable to cancellation.

- Use the Mark as Registered

If the registered mark is used, say, in abbreviated form, is converted from singular to plural or vice-versa, is mis-spelt or otherwise altered in appearance from the form in which it was registered, use of the altered mark will not count as use of the registered mark. This means that the registration could be cancelled for non-use after 5 years (or less).

- Beware of Generics

Care must be taken by the owner not to allow use of the trade mark to become *generic*. A mark should always be accompanied by a descriptive noun, eg, KELLOGGS cornflakes, FAIRY washing-up liquid, JOHNSON'S baby lotion. If used alone, the trade mark may lose its distinctiveness and pass into general use, eg, BIRO, HOOVER, ESCALATOR, ASPIRIN. If a mark becomes generic the exclusive right to use the mark is lost and this inevitably leads to a loss of market share. Trade marks can also be cancelled if they become generic or misleading.

- Identify your Rights

Distinguish your trade mark from the surrounding text by using:

- highlighting
- CAPITAL LETTERS
- *italics*
- inverted commas
- a proprietary strapline e.g. "X is a registered trade mark of ABC Ltd";

Present your trade marks consistently; including scale, arrangement and colour, e.g., avoid using *italics* in one paragraph and CAPITAL LETTERS in another.

HEALTH CHECK

Is your trade mark portfolio up to date?

- Are you starting to use any new marks?
- Are you using any variations of existing marks?
- Has use of your mark extended into any new countries?
- Is mark being used on any new goods or services?

If a mark has not been put to use for five years, think about filing a new trade mark application to avoid cancellation.

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