

# Intellectual Property Update



Howes Percival's Intellectual Property expert, **MATTHEW TALBOT**, explains the importance of trade mark protection

## DOES YOUR BUSINESS NEED TRADE MARK PROTECTION?



A trade mark is normally a word or combination of words, a sign or logo (or indeed a combination of all of these), which is used by and are unique to a business to distinguish it from others. Easily recognisable word trade marks include Coca Cola, Adidas and Microsoft. Logo type trade marks include Nike's tick, Audi's rings and McDonald's golden arch. Big or small, the thing that these all have in common is that trade marks are often the trading styles or brand names of the organisation.

Trade marks are most often used in advertising and marketing and it's almost impossible to calculate their value but there is a strong argument that trade marks and intellectual property generally, are the bedrock of many businesses.

Every business from the one man start-up to the multinational has a trade mark – the company name. It may not be registered as such, but the company name or trading style is unique to that organisation. In addition, many businesses have specific products, packaging or slogans, all of which are trade marks which could potentially be protected.

Any name or logo can be registered as a trade mark so long as it is distinctive and not generic (i.e. not commonplace), not descriptive of the goods or services being offered and is not already registered by someone else for the same class or goods or services. Trade marks can be registered in the UK only or as a European or an international trade mark.

## Why register?



If you don't register your company name, trading style or product range, competitors may well trade off the goodwill that you have created in your trade marks - goodwill that has taken many years and thousands of pounds to generate. This could be something as simple as selling identical or similar goods, using the same or similar product names. This could be even more damaging where someone attempts to trade using the same or similar company name or trading style - essentially stealing your company property. Unfortunately this kind of intellectual property theft is on the increase.

If you haven't protected your marks by way of registration then you are wholly reliant on common law to stop competitors from eroding your business. Claims have to be pursued under the law of passing off which is notoriously difficult to prove, costly and time consuming. Amongst other things, you have to prove that you own the trade mark, despite the fact that you may have done so for many years.

If your marks are registered you can prevent competitors from using them or similar marks, in the same type of goods or services for which you have the mark protected. When it comes to stopping companies from stealing your business, you only have to show two things. Firstly, that you own the trade mark - by way of producing your trade mark certificate. Secondly, that you are actually using the trade mark. One piece of paper demonstrates that the trade mark is yours.

If your trade mark is infringed you can potentially recover damages or profits made from the illegal use your trade mark. In other words, the trade mark provides you with a monopoly.



Matthew Talbot specialises in Intellectual Property litigation including disputes involving infringement of trade marks, copyright, design rights, patents and domain names. He has made numerous UK and European trade mark applications on behalf of organisations wishing to protect their company names, trading names and branded products. He has successfully acted on behalf of claimants against Northern Foods, Kraft Foods plc, Nestle and Adams Childrenswear and in defending clients in cases brought by Adidas, Puma, Lacoste and Microsoft.

If you have any questions in relation to Intellectual Property matters please call Matt on **0116 247 3500** or e-mail [matthew.talbot@howespercival.com](mailto:matthew.talbot@howespercival.com).