

Trade Marks: Common pitfalls to avoid

- Failure to search
- Failure to register – UK
- Use of trade marks abroad
- Non-use of a registered trade mark
- Loss of distinctiveness

The information provided in this section is a simplified summary of intellectual property matters and is not intended to be, nor should be used as, a substitute for Professional advice from a suitably qualified person

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Failure to search

- UK Registered Trade Marks are valid throughout the UK – therefore a company acting on a local scale may be unaware that their trade name has already been registered by a third party.
- However, this is not restricted to local companies! *E.g. Eurostar suffered problems as a result of the popularity of this name in many business sectors*

Failure to register – UK

- Use of a trade mark in the UK without registration can lead to problems at a later date;
- Where the mark is not inherently registrable *e.g. BLACK N' RED stationery – well known but could not be registered as a trade mark in the UK.*
- Where the mark is later used/ registered by a (more well-known) third party *e.g. UK research firm IIR has operated an email service called GMAIL since 2002 but never registered the mark – it is now also used by Google!*

Use of Trade Marks abroad

- Expansion abroad can lead to further problems;
 - The trade mark might be inappropriate in a foreign language *e.g. Vauxhall NOVA – “no va” means “doesn't go” in Spanish!*
 - The mark might already be registered by a third party in that country

Non-use of a registered Trade Mark

- Trade mark registrations can be revoked if a mark is not used in relation to the goods or services for which it is registered.
 - *E.g. STARBUCKS was apparently registered in Russia by the US coffee company, revoked for non-use and now has been registered by a third party!*

Loss of Distinctiveness

- Well known trade marks can be victims of their own success and can lose value if they become generic.
 - *E.g. Sony lost a registration for the WALKMAN trade mark in Austria as the word was held to be a generic word for personal stereos.*

Protecting your Trade Mark

Some guidelines to follow:

- Identify trade marks on products and in literature
 - ® if registered
 - ™ if not
 - Use block capitals in literature
- Use trade marks as an adjective only:
 - “Buy a new HOOVER® vacuum cleaner!” ✓
 - “Buy a new Hoover!” ✗
 - “Hoover your living room!” ✗