

Trade Marks: Some Facts and FAQs

Some Facts:

A trade mark is defined as a sign which can be used to distinguish between like goods and services provided by different suppliers. It gives the owner of the mark the right to stop another individual selling like goods or services under the same name. Trade marks can be protected in the UK by registering them with the UK trade marks registry. Words, logos, sounds and colours can all be protected either alone or in combination and there are 44 different categories that goods or services can be registered into. Trade marks can be identified by the ® symbol that appears next to them (for an example, see the Medipex logo on this fact sheet). Trademarks are territorial and therefore for a mark to be protected in all of the countries where it is used, it must be registered in each of these. There is a common system for trademark registration in use throughout the EU which is administered by the Office for Harmonisation in the Internal Market (OHIM), whereby registration of a trademark with OHIM gives protection of that mark throughout the EU, but individual member countries (including the UK) still have their own offices.

To qualify for protection, a trade mark must be unique for the good or service that it being used for and it must not be similar to any other marks being used for sale of that good or service. If a good or service is being sold using a name or logo similar to one that is registered, then it may be that infringement of the trademark is occurring. Trade mark infringement is more commonly referred to as "passing off". To demonstrate that passing off has occurred, then it has to be demonstrated that the trade mark has "goodwill" (reputation) associated with it, that there has been a "misrepresentation" (implying that the goods or services being sold under the infringing mark are associated with the owner of the trade mark being infringed) that is likely to deceive the public and that this "misrepresentation" has caused damage to the "goodwill" associated with the trade mark.

FAQS:

I want to trade mark the name of a device that I have come up with in the clinic but do not want to sell it commercially. Can I do this?

Trade mark law only applies to the names of goods or services which are being used commercially so if you do not want to sell your device commercially then it will not be possible to trademark the name of it.

My company have been selling a product for a number of years but we never registered the name as a trade mark. Now another company has started selling a competing product using the same name. Is there anything we can do?

In this scenario it may be worth trying to trade mark your product name now this other product has appeared on the market. It is still possible that you will be able to get your product name trade marked, especially if you can show a history of trading using it.

We have applied for a trademark for one of our services, but a previous customer has started to offer the same service using a very similar name to ours and has created confusion amongst our customers who think that he is selling our service. What can we do?

Firstly, because you have applied for a trade mark then it is likely that your product name will have a degree of protection, especially if your application becomes successful. If your current customers have been confused about the origin of the service that is being sold and the name is similar to that being used by yourselves then it is possible in this situation that there is a case of "passing off". You should contact Medipex for advice on what to do in this situation.

I have seen the term "TM" used on products. What is the difference between this and ®?

The term TM can be applied to a product name if you want it to be recognised as your brand but have not yet registered the name, although before using a product name, you should check that you will not be infringing another's trade mark. The ® symbol can only be used on product names that have been registered as trade marks; it is a criminal offence to use the ® symbol on a name which has not been registered.

Trade Marks: Some FAQs

I have developed a piece of software which has become known quite widely in my clinical domain. I now want to sell this and to protect it from competition I want to trade mark the name it has become known by. However, someone else already owns a trade mark for the name my software is known by for use in selling chemicals. Can I still obtain a trademark for my software?

It may still be possible for you to trade mark the name of your software. Product names to be trade marked can be registered in any of 44 classes of goods or services so long as the product which is going to be sold falls under that class (products can be registered in single or multiple classes). If the name that you want to use and protect for your product has been trade marked under a different class of good or service to the one you want to trade mark it in then it should still be possible for you to obtain a trade mark for it. However, if the name you want to use and protect has already been registered in the class of good or service that you want to register your product in, then it is highly unlikely that you would be able to obtain a trade mark for it yourself. However, if you want to register a trade mark then you should contact Medipex for specific advice.

Useful Websites:

The UK Intellectual Property Office: <http://www.ipo.gov.uk>

UK Intellectual Property Online: <http://www.intellectual-property.gov.uk>

OHIM: <http://oami.europa.eu/en/mark/>

Further Information or Advice:

Please contact Medipex on the contact details given below

This fact sheet has been produced in conjunction with Urquhart-Dykes and Lord, Patent Attorneys (Tel: 0113 245 2388; e-mail: email@udl.co.uk). It is provided for the purposes of information only and is not intended as a comprehensive guide to setting up and working in collaborations. In any cases where you have concerns or require advice regarding intellectual property matters, you should get in touch with your IP lead or Medipex.

