



TRADEMARKS

What's in a name?

Have you ever thought about selling your business? Chances are, if you have built up a business with a good reputation, interested parties might offer you a tempting amount of money to buy it up. Not only will they want the physical assets, the IP and know-how, the customer lists etc, but they may well need to acquire the goodwill in the name of your business.

What happens if that name happens to be your own? What you will often find is that, as part of any deal, you will be expected to enter into a 'restrictive covenant' restraining you from using your own name in the same or any other field of business for a specific period of time, say five years. But even once those five years are up, you are not necessarily free to use your own name again (particularly in the same line of business) because to do so may well constitute passing off your new business as that of the old one you sold. It is also likely to mean that you cannot register your own name as a trade mark, or that the new owners will trade mark your name for their own use, which can stop you from using it in the same business.

In short, before you enter into any kind of agreement concerning the sale of the goodwill in your name or the assignment of trade marks that incorporate your own name, think twice and take legal advice to ensure you fully understand the consequences.

What is a trade mark?

A trade mark is badge or emblem showing who makes a product. Words, logos, signs, shapes, colours or pieces of music can be registered as trade marks. A trade mark is a badge of originality distinguishing the goods and services of one trade from those of another.

What are the criteria for registering a trade mark?

In order for your "badge of origin" to be registrable your trade mark must be "distinctive for the goods or services which you are applying to register it for" according to the UK Intellectual Property Office. It must not be deceptive, or contrary to law or morality. It must not be similar or identical to any earlier marks for the same or similar good or services.

The application process

As with design registrations, you can file trademarks in the UK at the UKIPO and for the EU, at the EUIPO.

- Apply for your trademark, and receive a receipt of acknowledgement.



- An examiner checks the application and sends an examination report
- If there are objections and you cannot overcome them, you can either withdraw your application or the examiner will refuse it.
- If there are no objections, the application will be published in a trade marks journal
- If no-one opposes the application within 3 months, your trade mark will be registered and you will be sent a registration certificate.

Trade mark applications are filed covering the goods and services of interest to the applicant. These goods and services are, for administrative purposes, divided into many different classes and the total cost of filing a trademark depends on the number of classes required. Trademarks are then subject to renewal to keep them active, usually every 10 years.

The benefits of using a specialist design lawyer:

- Reassurance that the application has been completed correctly.
- Confidence that the application has been suitably tailored to your business and fulfils your needs. The Official Registries will only check that the forms have been filed in correctly – they will not advise on whether you have filed the best trade mark, or in the correct categories of goods and services for your business. Similarly, they will not advise you on the best representations of your designs to use to give you maximum protection, or which parts of a design may be worth protecting separately.
- Confidence that any deadlines issued by the Registries during the prosecution of the application will be recorded and met. Missing these deadlines could result in the rejection of an application.
- Knowledge that you will receive comprehensive advice where objections are raised on examination of an application or oppositions filed by a third party.
- Advice on an international filing strategy, including making appropriate cost savings where multiple applications are involved.
- Advice on when to file a trade mark instead of a design, and vice versa.
- Advice on related practical steps for design protection and enforcement in conjunction with the filing programme.
- Management of renewals to ensure that key renewal dates, filing dates and priority dates are not inadvertently overlooked.
- Continuity of details of the address for service for the Official Registries to use, to avoid any lapses and missed deadlines resulting from a change of personnel or

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address within your company.

- Kudos from having a specialist law firm named as your advisors on the public registers, which will reinforce the strength of your trade mark and design registrations.

Is trade mark protection enough?

You should also register your company name with [Companies House](https://www.companieshouse.gov.uk/). However, this does not mean the name will automatically be accepted as a trademark.

Points to Remember:

It is an offence – with criminal sanctions – to use the ® symbol in conjunction with a trade mark which is not in fact registered. This applies both to names and logos (etc):

- which you have no intention of registering;
- which you are unable to register (because, for example, they are not sufficiently distinctive); or
- in relation to which an application for registration has been made, but has yet to be granted.

However, it is perfectly legitimate to use the ™ symbol in these instances.

Have you signed the ACID IP Charter?

Join a growing number of people who are about IP ethics, respect, and compliance.

<https://www.acid.uk.com/become-a-charter-signatory/>

