

# How to protect a trademark?

*Are you an entrepreneur? Maddyness has compiled a toolkit to help you create, grow, and even sell your own startup. From recruiting a team and protecting your brand to financing your innovation, you will find tips, tools and advice to help you navigate the entrepreneurship labyrinth. In this article: several recommendations to protect your trademark.*

Temps de lecture : minute

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23 April 2020

A trademark is the distinctive symbol of the products and services of a company. It allows you to differentiate yourself from your competitors. It can be made up of a word, numbers or letters, a slogan, a drawing, or a combination of these elements. The Pacte law, promulgated on 23<sup>rd</sup> May, 2019, permits companies to register audio or multimedia files which allow you to hear and see the sound or movement of a trademark.

## Too Long? Here's the key takeaways

- A trademark must be distinctive (not generic or a description of your product or service), not already in use, conform to public order as well as to good moral standards, and shouldn't be misleading
- Your trademark must be registered in the right location. If it's just in the UK, you will need to register with the Intellectual Property Office (IPO) via the gov.uk site. If it's at the European level you must contact the EUIPO, and if the business is divided into several countries outside of the EU, you must register your trademark in each of the countries concerned
- The trademark and the domain name are not the same thing. If they

are similar, you must make sure not to register them in the same location. The domain name should be registered with Nominet (.uk), the Eurid (.eu) or in the domain name registry (.com or .net)

- If someone has the same trademark name as you, you can appeal against their request to the IPO for an *inter partes* hearing

## Define your trademark well

A trademark is the distinctive symbol of the products and services of a company. It allows you to differentiate yourself from your competitors. It can be made up of a word, numbers or letters, a slogan, a drawing, or a combination of these elements. The Pacte law, promulgated on 23<sup>rd</sup> May, 2019, permits companies to register audio or multimedia files which allow you to hear and see the sound or movement of a trademark.

Certain conditions do need to be respected to be able to register and protect your trademark:

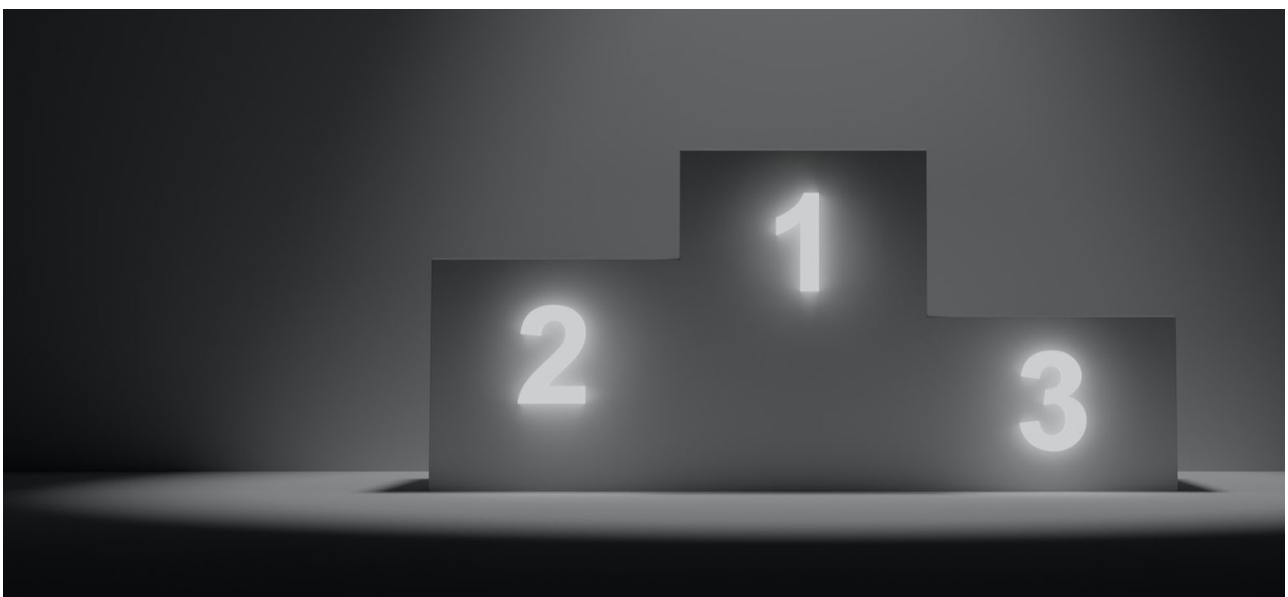
- The trademark should be distinctive: it should identify the products or services of a company. It doesn't have to be a generic term corresponding to the name of the product or service being sold, nor does it have to be a description of it ("soft skin" for a hydrating cream, for example).
- The trademark must be available: it shouldn't already belong to a third party; it should have trademark rights and also a copyright or personality rights (it is impossible to use the name or image of a third party as a trademark without their approval).

Yet, you must know that trademarks are industry or sector-specific, ie. A trademark isn't registered just to identify certain products and services, which means that it is possible to use a trademark that is already

registered and apply it to a completely different sector of products or services than the original trademark (use a computer trademark name for a company that sells clothes, for example). Renowned trademarks and well-known trademarks are not subject to this principle of speciality and so cannot be “re-used”.

- The trademark must conform to public order and to good moral standards. The trademark “Cannabia” for food products, for example, might not be allowed. It should also not mislead. This would be the case if a company led the consumer believe something about the quality of a product or where it came from, for example, a trademark that contains the word “organic” when the product isn't made through certified organic production would be dismissed.

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## Respect the formalities of registering a trademark

Once you've made sure all the previous points have been completed and you have chosen the trademark name, you should register the trademark. To do so, you must be aware of a couple of things:

- Choose the right place to register your trademark: in order to protect a trademark in just the UK, you must register with the IPO, which lasts for 10 years. To register in another country, you must find out who ensures the trademark registration there. It is also possible to register your trademark through [EUIPO](#) so that you are directly protected in all European Union nations. This is a simpler and less expensive solution and should be used by a company that wants to do business in several European countries since it protects the trademark in all countries by the means of a single procedure instead of having to do so in each country.
- Choose the categories for which your products or services will be trademarked: as explained in the previous part, the trademark will only be exclusive for the designated industries. It is important for these to be clearly and comprehensively defined as it is possible to register a trademark in several categories. For some extra help, you can use [the Nice Classification](#). This is an international classification of products and services applied for the registration of trademarks. The 2019 eleventh edition came into force on 1<sup>st</sup> January 2019. You shouldn't register for categories that your company doesn't provide any business for, because there is also a degradation principle in which a registered trademark that isn't used for five years will not be

protected any more.

*"You must ask yourself where to register your trademark. If it's just in the UK it will be part of the IPO [Intellectual Property Office], if it's at a European level you must address the EUIPO and if the business is divided into several countries outside of the EU, you must register your trademark in each of the concerned countries."*

## Protect your domain name

Be careful, the trademark shouldn't be confused with the domain name, which identifies the company's website. It's possible, of course, to match both and register the domain name as a trademark, or to adopt the name of the trademark as a domain name. The appropriate authorities for registering a domain name are as follows:

- Nominet in order to reserve a domain name under ".uk"
- The [Eurid](#) in order to reserve a domain name under ".eu"
- The [domain name registry](#) in order to reserve a domain name under ".com" or ".net"

To have ownership of your domain name, if it isn't the same as the company's name, you must also register it as a trademark in all the categories of products or services that the company works in. In the case of using a domain name that isn't protected by the trademark of a competitor, the company in the wrong cannot take action for infringement, but only on the basis of a dishonest or freeloading

competitor.

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# Know how to defend your trademark

You've made it! You have registered your trademark, and everything seems to be going well. However, a little later on you find out that someone is using the same name as you, or you are a victim of infringement. Here is what you can do:

- Oppose the registration of a new trademark: this procedure must be completed through the IPO and, if it is successful and the request is considered justified, the new trademark will be rejected.

Owners of a previous trademark can fight against new ones. This covers UK trademarks that are in the process of registration or already registered, the Community trademarks that are in the process of registration or already registered, and any international trademark that is in effect in the UK or in the European Union. The opposing party is considered as an application for registration of a UK trademark or an international trademark that is in effect in the UK, which is identical to or imitates your trademark. Be careful, as explained earlier, the products in question and services must be identical to the ones sold under your previous trademark.

You can file an opposition within 2 months of the publication of an application for registration of a new trademark through the IPO or, if it is international, through the World Intellectual Property Organisation (WIPO).

- Starting an Invalidation procedure allows someone to remove a trademark from the IPO register.
- Revocation also allows someone to try to remove the whole, or only some, of the registration.
- Rectification can also be submitted if someone would like to correct an

error of a registered trademark.

- Finally, the intervention involves someone who allegedly has interests in a registered trademark.

You can surrender your rights to a trademark, but doing this is absolute and final. Surrendering a trademark also leads to the nullity of the allowed licences of the trademark for which the application is cancelled. Good to know: the cancellation of a trademark can be total or partial (in the latter case, the trademark is useless for certain products and services but valid for others).

- In the case of infringement: if you are the holder of a previous trademark, you can exercise your rights by bringing the dispute to the civil courts, or mediation is also available to try to resolve the dispute. The act may result in the award of damages or costs, according to damages suffered (financial and moral damages, damage to the image of the company, negative economic consequences suffered, profit made by the counterfeiter, investment savings, etc.). If it is deemed to be a criminal case, however, offenders risk punishments up to a £50,000 fine and up to ten years in prison (additional punishment can be added, like complete, partial, final, or temporary closure of the establishment that produced the counterfeits.)

*"If someone has the same trademark name as you, you can oppose their request to the IPO. If you are a victim of infringement, you can take action in the civil courts, but there is also mediation, which could be an easier and less costly solution."*





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Article by Maddyness