

A Short Guide to Searching a New Trade Mark in the UK

In the UK, use of a trade mark can be stopped if there is either

- Use of the same or similar mark for the same or similar goods or services, (regardless of whether that mark is registered) on the basis of what is called the common law of passing off, or
- The same or similar mark is registered for the same or similar goods or services. It does not matter if the registered trade mark is currently in use - it can stay out of use for up to five years and still stay on the register.

Your use can infringe or amount to passing off even if you have

- no intention to cause confusion; it is whether confusion is likely regardless of intention to cause it that matters
- not actually "copied" – copying is not relevant to trade mark infringement or passing off.
- or you think you are using a word only as a description.

Why should searches be done?

To save you money. If searches are done before you put the mark on advertising, packaging and promotional literature, or shop fixtures or a website, and the searches reveal a problem, you will have the option of switching to another mark before you incur this expense.

The steps to follow when clearing a new mark for use in the UK are below. Clients can do the first three steps themselves, and need only contact a trade mark attorney at step four

1. Check your own sources of competitor intelligence: If the mark (or something similar to it) is already in use in the UK, by a direct competitor, there is no point in going on with your mark, as they will surely object and will have grounds to do so, even if not registered.
2. Put the mark in a internet search engine, and check the relevant domain name registers and see if this picks up use by any other company, competitor or not. If you think what you have found could give you a problem, send us details.
3. Put the name in the online search at Companies House: If there is a company with the same name as your proposed mark, and if it is already trading under that name in the same or related industry sector as you, then this company could give you a passing off problem.
4. Then have a search of the registers of trade marks in the UK (there is more than one) done. Note that even if the identical mark is not registered, it will be necessary to advance the search to find similar marks. The on line search at the Patent Office will not be enough for this, and the off line search provided by the Patent Office search and advisory service for £80 is not that much more extensive than its own on line search. On average, a fully extensive search costs about £100, and the time taken to have a trade mark attorney analyse it usually costs another £100-150.
5. If the trade mark registers search reveals marks which your use is likely to infringe, there may well be options for overcoming them. One thing clients usually ask in this situation is: could we ask the company concerned if they have a problem with what we are proposing to do and give their consent? The answer is well, yes, you can ask, but this invites them to say no. And it brings you to their attention, which had it not been for your approach, might not otherwise have been the case. The better course of action is to have enquires

made into the company, discreetly, to determine their level of interest in the mark and then assess if an approach is likely to result in obtaining consent. If not, then other options are to purchase the mark, or if it has been on the register for more than five years and out of use for *all* of that time, to indicate to the company concerned that you are willing to apply to the Patent Office to revoke it for non-use. This can usually, if the company accepts that there has been no use, result in the company voluntarily taking the mark off the register, thus saving the time and expense of a formal challenge. Typically, the costs of this step are round about £500.

6. Once any obstacles have been cleared out of the way, apply for registration of your mark. Until you do, it leaves the way open for someone else to apply for registration of the same or similar mark, and if they obtain registration, you will then infringe, *even if* your use began before their date of registration. (True there is a defence to infringement for anterior use. But this applies only if that use is a) in a "particular locality" b) so extensive that a passing action could be brought against the owner of the trade mark registration and c) the owner of the trade mark registration has no earlier use himself. Even if you have this amount of use, it will be expensive to prove it, as the forum for infringement actions is always the High Court. The cost of obtaining trade mark registration is a minimum official fee of £200 (with no further fees to pay until the first renewal is due 10 years later). The time taken to prepare the application for registration and to deal with correspondence with the Registry can be a minimum of £200.
7. Lastly, once you have obtained registration of your mark, you need to watch out for anyone else attempting to register it. If they succeed, then your ability to bring an action for infringement against them will be compromised. This is because they will then have what is called a Section 11(1) defence, that use of one registered mark does not infringe another registered mark. The Patent Office should object on your behalf, but quite often they do not. This is why the Patent Office, after it has accepted an application, publishes it in its own Trade Mark Journal, so that owners of other marks have an opportunity to object. The annual cost of having a watch made of the Trade Marks Journal, and reporting to you if we see a problem, is a minimum of £30 per year.

Note: you can be stopped from using a mark even if it is registered for goods and service which are entirely different from yours. But your use must be taking unfair advantage of the registered mark or be detrimental to its character. This type of infringement is less common; if we think however that your use might fall into it, we will advise you.

NB all figures above exclude Vat.

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