

# EXPERT GUIDE

CORPORATE *LiveWire*

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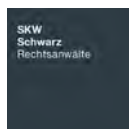
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## Why Register a Trade Mark?

*By Maggie A. Ramage*

A point which is often raised by clients, particularly in recessionary times, is why register a trade mark – what disadvantages exist if you do not register and what advantages are there for you if you do? I believe it can be a false economy to ignore trade mark registration and may prove expensive for a trade mark owner later on if no action to protect a mark is taken.

Always remember that a strong brand name may be a company's most valuable asset – it can be valued on your company balance sheet, has a value as it epitomises goodwill and the reputation built up under that mark and it may be bought, sold and used as security for raising capital.

Equally, a brand name may suffer damage in a short time if the goods or service provided under that mark fail for some reason. The consumer will then tend to avoid products sold under that mark and the value of the brand may suffer, even to the point of no return to a good reputation. Consumers recognise reputation via brands. All businesses have brands, whether they believe they do or not.

Your trade mark is often the first thing a potential customer will see and it needs protection.

In a large number of countries, such as the EU, it is the first to register who has the strongest right.

In some countries, you can only challenge someone else's trade mark by way of opposition if you have a similar or identical trade mark registered yourself, such as is the case in Japan.

You need a trade mark to be registered in order to challenge a domain name, which includes the same wording as your trade mark registration.

If you are involved in conflict, whether challenging someone else using a similar mark or being challenged yourself by someone else, having a trade mark registration proves your entitlement to the mark – it shifts to the other side to prove their position. If you do not have your mark registered, you have to prove your own reputation first, which is costly, time-consuming and uncertain.

One important point concerning trade mark protection is certainty. Your trade mark ownership goes into the public domain. It can be found by anyone and acts as a deterrent or a keep off the grass sign to others who are looking to coin a similar mark to your own trade mark for similar goods and services as yours.

Points to consider when registering a mark:

Is the mark ready to file or will the logo or wording change before launch? You cannot change a mark once filed and the golden rule is to use your mark as registered and register your mark as you propose to use it.

If the mark is brand new and unused, it is wise to search for availability first as you do not want to pour resources into a launch which could fail as you have inadvertently come up with a mark which is too close to someone else's earlier protected mark. Trade mark infringement proceedings are expensive and you do not want to have to re-brand at an early stage for this reason.

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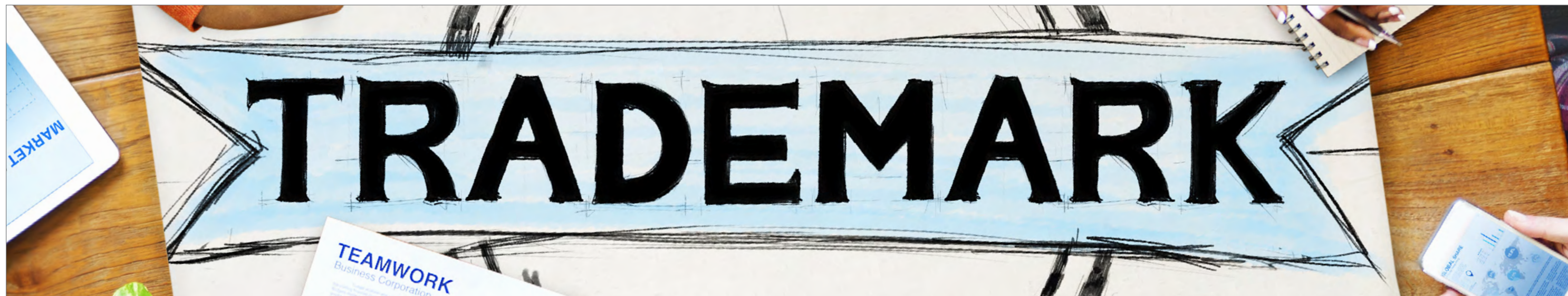
Is colour relevant in your mark? If so, include this in your application.

Check the goods and services covered. Are there imminent plans to add new products under this mark? If so, include them early on, but be aware that in many countries, such as the US and the UK, there is an assumption of intent to use your mark on all the services or goods you claim when you file, so do not be over-ambitious and include everything from washing-up liquid to hand guns if you do not propose to use your mark on those areas. If you do, you will incur unnecessary cost and could leave yourself open to a future challenge on the basis of non-use. In some countries, such as the USA, claiming use on goods where the mark is not used can constitute fraud on the local patent office.

Should you change your house mark, protect the updated version. It is very easy to forget this. Large companies are continually upgrading and re-designing their house mark but often forget to upgrade their trade mark protection at the same time. If your mark changes considerably, you



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could find that your older registrations are no longer enough to protect your new version of your house mark.

If you later on brand extend, remember to update protection. For example, fashion items such as clothing often eventually extend to areas such as bags, jewellery and cosmetics. Make sure you regularly review your trade mark registration portfolio and that all goods and services of interest are now covered.

Consider new markets. File in the countries where you have activity, but watch things like Internet sales. You may find that you do not have a retail outlet in a given territory, but

you may well have customers there already because of Internet sales from another country. If that is the case, it is imperative that you file first before someone else does it for you in the country where you have sales. Consider new product areas, for example, social media, blogs, chat-rooms, phone apps – If these become important to you, protect those areas. Most of these areas did not exist a few years ago, so you need to continually double-check to make sure new technology is included in your protection.

Where should you file? Consider your main markets and any planned in the future. File there. This includes countries where you have sales now

or perhaps a licensee or distributor for your goods. If you manufacture in a country – consider protection.

Consider territories where copycats are active. This is worth doing in areas such as China, Malaysia, Indonesia, Turkey, Brazil, India and Pakistan. It is economically sensible to spend a reasonable fee on protecting your mark in such countries rather than incurring more cost in attempting to acquire back your mark via expensive litigation and perhaps failing if someone else has protected your name, and China comes to mind here as being a territory you should consider in this instance.

Consider how to file? Should this be

via national filings or Madrid Protocol and/or the EU via the Community Trade Mark? Should you attempt a 3D registration of a mark? Perhaps you should file this as a design application at an early stage to protect the shape, ornament, configuration or pattern on a product.

Take advantage of Convention Priority, i.e. filing your overseas applications within six months of your first filed application. This can be invaluable to stop competitors who may copy your successful launched mark. It spreads the budget, by filing in your home territory first, then considering where else to go in six months' time. It also buys you time to see how the initial launch goes and to formulate



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your plans outside your home country before you incur the cost of filing.

Trade mark protection may have some downsides, although I believe these are few and far between. For example, you then become visible on public registers, so may be the target of spurious service providers attempting to sell you expensive services, such as entries into unofficial databases, filing EU applications, trade mark watching services or renewal services. However, once you are aware of these activities, you can simply ignore them, so this is not really a downside at all apart from the aggravation factor.

On balance, having a strong trade mark registration portfolio can be one of the most worthwhile projects you undertake.

Finally, use the services of a professional attorney to help advise on cost, strategy, priority of filings, where to file, what goods and services to cover, which marks to protect and also to deal with any objections which may be raised by local registries along the way.

You will not regret it if you have a strong trade mark portfolio which is properly registered around the world.

*Maggie Ramage is a UK and European Trade Mark Attorney, and started in the profession in the early 1980's. She is a member of INTA, ECTA and ITMA (the UK Institute of Trade Mark Attorneys), and is a past President of ITMA, having had that post 2010-2012. She is still active on their Governing Council. Maggie worked for Raychem Corporation in London and San Francisco (seconded to the US in 1987). Subsequently she worked for Beecham Group (now Glaxo), then British Telecommunications plc. She became a partner in Surrey-based Alexander Ramage Associates in 1991, and from April 2015 is now a Junior Equity Partner at Edwin Coe LLP in Lincoln's Inn, London. Maggie has extensive experience in trade mark matters, particularly in overseas jurisdictions, and has also worked very closely through her Institute (ITMA) with the UK IPO, OHIM, WIPO, and the Legal Services Board in the UK.*

