

## CORRECT USE OF A TRADE MARK

A trade mark represents the reputation of your goods or services in the marketplace. A trade mark is your company's unique selling point. It distinguishes your goods and services from those of your competitors and acts as a badge of origin for the consumer to identify your products and services. How your trade mark is used can therefore affect your company's reputation and the perception of your brand in the eyes of the consumer.

A trade mark is a valuable asset to any company. It is important that it is used in the correct form to ensure that the protection you have obtained is maintained. You may think that just registering your trade mark is enough but it is critical to ensure that the mark is correctly used: otherwise it can be vulnerable to cancellation by a third party. Your competitor may be looking for any reason to cancel your trade mark. It is therefore wise to observe the points in this leaflet.

Once a trade mark has been registered, there are a number of ways in which the protection registration provided can be relinquished and the registration cancelled:

- if the trade mark is not used over a continuous period of five years: this is known as the non-use provision
- if, due to the activity or inactivity of your company, the mark becomes a common name in the trade for the product for which it is registered. An example of this is ESCALATOR, now a generic term
- the way you or others use the mark which may mislead the public as to the nature, quality or origin of the goods on which it is used

A registered trade mark provides you with the exclusive right to that mark in relation to the goods or services for which it is registered to stop someone else from using the same or a similar mark on similar or identical goods or services. You can even stop others from using the mark on dissimilar goods and services where you have a reputation and you can show that, without due cause, the use of the sign would take unfair advantage of or would be detrimental to the distinctive character of your mark. Follow the basic principles below to safeguard your rights.

### Using your trade mark to make an impact

As a business, you will produce many documents including packaging for your goods, advertising materials, labels, swing tags, etc. It is important that the trade mark is indicated clearly and is treated as a distinctive element in any printed documents so that the reader is put on notice that the sign is a trade mark. If you do not make your trade mark stand out from its surroundings, third parties may not know that the word is a trade mark and may then use or even misuse it to the detriment of your business's reputation and resulting in lost sales. Failure to notify the public that your sign is a registered trade mark may also affect your ability to claim full damages in an infringement action.

There are many ways of showing that a sign is a trade mark. Taking HGF as an example, the following are ways to distinguish your mark from surrounding text:

- Quotation Marks: “HGF” trade mark lawyers.
- Capital Letters: HGF trade mark lawyers.
- Different Typeface: *HGF* trade mark lawyers.
- Bold Print: **HGF** trade mark lawyers.
- Colour: **HGF** trade mark lawyers.
- Footnote: \*Place an asterisk next to the mark and then place at the end of the publication \*trade mark.
- Symbols: R in a circle symbol ® (if registered) or ™ (if not registered).

Many businesses trade internationally. A trade mark can be used in several countries but may be registered in only one. If the trade mark is not registered in all the countries where the material is to be distributed then you should ideally use the ™ symbol in preference to the word “registered” or the ® symbol.

It is a criminal offence in the UK and also in many other countries to use the ® symbol in relation to any trade mark which is not registered. However, it is acceptable for products marked with the ® symbol to move freely throughout the EU even if the trade mark is registered in only one member state of the EU.

#### Trade mark used as an adjective

A trade mark is not a noun and it is not a verb. A trade mark should always be used in print as an adjective qualifying a noun or a phrase:

##### **Incorrect:**

Use HGF and receive excellent client service

##### **Correct:**

Use HGF legal services and receive excellent client service

If a trade mark is used in an incorrect form as highlighted above, it is liable to become a common descriptor of a type of product, as has happened with LINOLEUM, now a generic term. Please note that other marks such as BIRO, JACUZZI and PERSPEX are often thought by the public as being common names but are still registered trade marks due to the vigilance of their owners in ensuring that their trade marks are always used correctly in the press and in their marketing materials.

Trade Marks are neither plural nor possessive

A trade mark, being an adjective, must not appear in the plural or possessive sense:

##### **Incorrect:**

Eight thousand **BMW**s have been sold in the last two months  
**MICROSOFT'S** best feature is...

##### **Correct:**

Eight thousand **BMW** cars have been sold in the last two months  
The best feature of the **MICROSOFT** computer programme is...

#### Using the trade mark as registered

Your trade mark must be used in the manner in which it is registered. Failure to do this affects the validity of your legal rights in a trade mark and may result in cancellation of the registration.

A registered trade mark should never be amended in use, for example by alterations to a logo, without prior consultation with your trade mark attorney. The trade mark should only be used in relation to the goods or services for which it is registered. If your trade mark is to be used on new goods or services or you are completely re-branding your business, you should ensure that the mark is free to use on those goods or services and that a registered trade mark is obtained. It is advisable to conduct a full clearance search to determine any infringement risks prior to any launch into the marketplace.

#### Top tips for using your trade mark:

- Ensure the trade mark makes an impact by standing out in any materials
- Never use the trade mark as a noun and always use it as an adjective
- Use the trade mark in the form in which it is registered and for the goods or services for which it is registered
- Monitor and act immediately on any misuse of the mark.

If you are unsure whether your use is correct or require further advice, please contact a member of the HGF trade mark attorney team.

#### How can HGF help?

HGF is a full service Intellectual Property law firm consisting of qualified trade mark and patent attorneys.

Our trade mark attorneys can advise you on how best to protect your trade mark and, most importantly, ensure that you cover the relevant goods and services in any trade mark application. Once a trade mark application has been filed, additional goods or services cannot be added.

HGF's sister firm, HGF Law, specialises in trade mark and patent litigation and can assist you if action needs to be taken against infringers or you need to defend your position.