What’s in a name?
Much goes into protecting a brand, says Michael Foster of Mewburn Ellis

You’ve spent considerable time, money and energy in finding a suitable name for your new product. Or you have a name that you have been using for some time on a product that has become an important part of your portfolio. But they are not just names. In the first case, the name is an investment, the name for a product that may well become very important in the future. In the second case, the name is an asset, and one that you will therefore continue to invest in. In both cases, you will probably be investing in the names—for example, through marketing, advertising, building up the reputation of the product, and through increasing brand awareness.

To help protect these assets and investments, you need to register these names as trademarks. Why?

• It is prima facie evidence of ownership of your trademark. Although rights in a trademark can exist by use (without there being a registration), it can be difficult and costly to prove these rights, should the need arise. The existence of a registration puts the owner in a much stronger position, enabling action to be taken promptly and efficiently, both as regards to stopping infringement and also preventing third parties from obtaining registration for the same or similar marks for the same or related goods/services.

• The existence of a registration acts as a warning to others, because they are registered, they are on a register and so are of public record and easily searchable. Third parties might be contemplating a new mark, and so ask their trademark attorney to carry out a search against that mark. If the same or similar mark is found for identical or related goods and/or services, the trademark attorney will advise that another mark be adopted.

• A trademark registration can be used to oppose a later application for the
What characteristics should a trademark have?

- A trademark registration often ensures a successful outcome in a domain name dispute where a third party has registered a domain name that is likely to be confused with an existing mark. For example, F Hoffman-La Roche AG, owners of the trademark ‘Valium’, successfully objected to the registration of the domain name valiumonlinepills.com, and so the domain name was transferred to it. An important ground of the complaint was that Hoffman-La Roche had registered ‘Valium’ as a trademark.

- In many countries, customs authorities can be notified of registered trademarks. If customs detect what its suspects to be unauthorised imports or counterfeit goods bearing the registered trademark, it will notify the trademark owner or a representative, who can then advise customs as to whether the import is legitimate or not. If it is not, appropriate action can be taken.

- A number of countries, including the UK, have criminal provisions dealing with counterfeit goods bearing marks likely to be confused with existing registered trademarks.

- Registered trademarks can be valuable intangible assets. Trademarks are evidence of ownership. They can be sold and licensed, and it may be possible to use them as collateral for loans.

**Seeking trademark protection**

Most trademarks are plain words, either invented words, or surnames and/or given names, or else dictionary words that have no meaning or no direct meaning in relation to the product. But they can also include words in a special format, perhaps including a graphical element. They could be a logo, or even unconventional marks such as a sound, a gesture or a three-dimensional object.

Although not in the same league as patents, the costs of seeking trademark protection can add up, particularly if a large number of countries need to be covered, and also if oppositions and other objections arise. There is no such thing as a worldwide trademark—protection needs to be applied for in general on a country-by-country basis, in general instructing local trademark attorneys, as there is usually a requirement for local representation.

However, assuming that protection is required for a number of countries, there are usually two ways of streamlining this process, thereby reducing costs.

One is to apply for a Community trademark. This covers all 28 countries of the EU with a single unitary trademark. The fee levels are such that typically if protection is required in more than two EU countries, this will be a less costly option than seeking protection in the particular EU countries of interest. There are some disadvantages; in particular, the application could fail because of a problem relating to just one EU country (which may possibly not be a country of actual interest). However, taken overall, especially in the long run, the advantages outweigh the disadvantages.

The other is to use the international registration system. This is a ‘closed’ system, and so is only available to applicants who belong to a country or a region that is in the system. It is a way of applying centrally for trademark protection in one, some or all of the countries and regions that are in the system.

The membership includes: the UK, Norway, Switzerland, Russia, the US, China, Japan, Australia, New Zealand, India, South Korea, and many others, including the EU, which means that the advantages of the Community trademark can be obtained via the international registration system.

There are current notable exceptions, including Canada, Brazil, South Africa and Malaysia.

If a trademark is to be put into use rapidly, it is worthwhile having searches carried out, particularly if a large number of countries are of interest, as the costs of searching can be very substantial. Therefore, some preliminary checking to identify obvious ‘direct hits’ and perhaps to search larger numbers of countries, which are more likely to have problematic prior marks, is sensible. It is not just identical marks for identical goods/services that would be a bar to registration and use. Similar marks for related goods/services can also be bars, which is why comprehensive searching can be a costly process.

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