

United Kingdom

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1. Legal framework

The United Kingdom is party to the following international conventions and treaties:

- the Paris Convention for the Protection of Industrial Property (Stockholm Act);
- the Convention Establishing the World Intellectual Property Organisation 1967;
- the Hague Convention Abolishing the Requirement of Legalisation for Foreign Public Documents 1961;
- the Nice Agreement concerning the International Classification of Goods and Services (as revised);
- the Trademark Law Treaty 1994;
- the Madrid Agreement (Indications of Source) 1967;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1995;
- the General Agreement on Tariffs and Trade and the World Trade Organisation (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs); and
- the EC Treaty.

The following national laws govern trademarks:

- the Trademarks Act 1994 (as amended);
- the Trademarks Rules 2008;
- the Trademarks (Fees) Rules 2008;
- the Trademarks (International Registration) Order 2008; and
- the Olympic Symbol etc (Protection) Act 1995, as amended by the London Olympic Games and Paralympic Games Act 2006.

2. Unregistered marks

Protection is available for unregistered marks under the common law tort of passing off. It is available as a cause of action in a wide range of factual circumstances; however, in general, in order to succeed in a passing off action before the court, a claimant will have to show that:

- there is goodwill or reputation attached to the goods or services that it supplies, such that the purchasing public recognises the identifying trademark, packaging or get-up under which the goods or services are supplied and associates it specifically

- with the claimant's goods or services;
- the defendant has made a misrepresentation to the public leading the public to believe that the goods or services that it offered were those of the claimant; and
- it has suffered damage as a result of the mistaken belief arising from the misrepresentation that the defendant's goods or services were those of the claimant.

There is no proprietary right in the unregistered mark as such; the proprietary right protected is the goodwill and reputation in the business under the unregistered mark. Any party that owns the necessary goodwill can bring an action for passing off. These can be legal or natural persons that conduct commercial activities. The overriding requirement is for the claimant to show the necessary goodwill. There are no specific rules about how much use is necessary to establish goodwill and each case will depend upon its facts. There must be some business or market in the United Kingdom for goodwill to exist, but the fact that a claimant's business is small does not prevent goodwill from existing. Passing off actions can run together with trademark infringement actions.

Under Section 56(1) of the Trademarks Act, a mark that is entitled to protection under Article 6*bis* of the Paris Convention as a well-known mark, and that is also well known in the United Kingdom, will receive protection. This provision can be used as the basis of opposition and cancellation proceedings, as well as an action to prevent the use of any mark that constitutes a reproduction, imitation or translation of the well-known mark, and that is liable to cause confusion.

3. Registered marks

A registered trademark is a property right and can be applied for and owned by any party that can own property. Some organisations cannot own property under English law (eg, some trusts or partnerships), so are unable to apply for or own a registered trademark. Co-ownership of a registered trademark is possible. No power of attorney is required.

Any sign capable of being represented graphically may be registered provided that it is capable of distinguishing the goods/services of one undertaking from those of another. Trademarks may consist of words (including personal names), designs, letters, numerals and the shape of goods or their packaging. Slogans, sounds, musical marks, smells and three-dimensional marks can all be registered, provided that they can be represented graphically and are distinctive enough.

Under the absolute grounds for refusal, the following types of mark are not registrable:

- signs that cannot be represented graphically or that cannot distinguish the goods/services of one undertaking from those of another;
- trademarks that are devoid of distinctive character;
- trademarks that consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or rendering of the services;
- trademarks that consist exclusively of signs or indications which have become customary in the current language or established practices of the trade;
- signs that consist exclusively of a shape which results from the nature of the goods themselves, is necessary to obtain a technical result or gives substantial value;
- trademarks that are contrary to public policy or morality, or are deceptive;
- trademarks whose use would be prohibited in the United Kingdom by any enactment or rule of law or by any provision of EU law;
- trademarks comprising specially protected emblems such as:
 - royal arms or similar;
 - representations of crowns or royal flags;
 - representations of the queen or members of the royal family;
 - trademarks likely to lead persons to think that the applicant has royal patronage or authorisation – except where consent from the queen or the relevant member of the royal family appears to have been given;
- trademarks comprising the national flag

of the United Kingdom or the flags of England, Scotland, Wales, Northern Ireland or the Isle of Man, if the use of the trademark would be misleading or grossly offensive;

- trademarks that consist of or contain:
 - the flag of a Paris Convention country, or anything that imitates it;
 - armorial bearings or any other state emblem of a convention country that is protected under the Paris Convention or the WTO Agreement, or anything that imitates them;
 - an official sign or hallmark adopted by a convention country and indicating control and warranty protected under the Paris Convention or the WTO Agreement, or anything that imitates them, in relation to goods or services that are the same as, or similar to, those in relation to which it indicates control and warranty; or
 - armorial bearings, flags or other emblems, including anything that imitates them, abbreviations and names of intergovernmental organisations of which one or more convention countries are members, protected under the Paris Convention or the WTO Agreement.

This applies unless:

- the relevant authorities or organisation granted an authorisation; or
- it appears in the last case above that use in the manner proposed would not suggest a connection or is unlikely to mislead the public as to the existence of a connection between the user and the organisation;
- trademarks that consist of or contain protected Olympic symbols; and
- trademarks filed in bad faith.

A trademark that has acquired factual distinctiveness may nevertheless be registered.

Under relative grounds, the following types of mark are not registrable:

- a trademark that is identical to an earlier trademark and that seeks to cover goods or services identical to those of the earlier trademark;
- a trademark that is similar to an earlier

trademark and that seeks to cover goods or services identical or similar to those of the earlier trademark, and where there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier trademark;

- a trademark that is identical or similar to an earlier trademark which has reputation in the United Kingdom, where the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark; and
- a trademark whose use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trademark or other sign used in the course of trade, or by virtue of the law of copyright, design right or registered designs.

An 'earlier trademark' means:

- a UK registered trademark, an international trademark designating the United Kingdom, a Community trademark or an international trademark covering the European Union that has a date of application or a validly claimed priority date earlier than that of the trademark in question;
- a Community trademark or an international trademark designating the European Union that has a valid seniority claim from an earlier UK registered trademark or an international trademark designating the United Kingdom;
- a UK registered trademark or an international trademark covering the United Kingdom that has been converted from a Community trademark or an international registration designating the European Union with a valid seniority claim; or
- a trademark entitled to protection under the Paris Convention or the TRIPs Agreement.

An earlier trademark also includes applications for registration, subject to them becoming registered.

4. Procedures

Examination

The application will be examined to check that it conforms to the formal requirements. It will then proceed to substantive examination, which involves consideration of:

- the applicant's good-faith intention to use the mark;
- whether there are absolute grounds for refusal; and
- the acceptability of the specification of goods or services.

There is no examination on relative grounds for refusal, but searches of the register are conducted and the applicant informed of any earlier trademarks that might be potentially conflicting. The applicant has two months to confirm whether it wishes to proceed. Submissions or amendments can be filed to try to avoid potential conflict with the earlier marks; however, no objection will be raised on the basis of the earlier trademarks. Unless the application is withdrawn, it will be published for opposition purposes. The UK Intellectual Property Office (UKIPO) will notify the owners of earlier UK and international rights identified in the examination report, as well as the owners of any Community trademark rights which have opted into the notification procedure.

Opposition

After publication, there is a two-month period for opposition, extendible to three months by filing a notice of threatened opposition. Opposition can be based on absolute or relative grounds. Once the opposition has been filed and found formally admissible, it will be sent to the applicant, which has two months to defend the application. A cooling-off period of up to 18 months is available at the request of both parties. If no cooling-off period is requested, or if it expires without settlement, the applicant must file a counterstatement. Once the counterstatement is filed, the UKIPO may issue a non-binding, preliminary indication on the merits. If the parties elect to continue, the opposition proceeds to the evidence rounds. Once these are completed, the parties may either request a hearing or ask

for a decision to be made from the papers. A decision may be appealed if the UKIPO makes an error on a point of law. Costs are usually awarded against the losing party.

Registration

If no opposition is filed, or if the opposition is unsuccessful, the application is registered. Typically the UKIPO takes less than five months from application to register an unopposed mark.

Renewal

Trademarks are registered for 10 years and are renewable for further periods of 10 years. Proof of use is not required with renewal applications. Renewal can be effected in the six-month period following the expiry of the registration, provided an additional fee is paid. Merging of separate applications or registrations is possible.

Removal from register

A trademark can be removed from the register by several forms of action:

- **Revocation** – removal of a trademark from the register in its entirety or in respect of some of the goods or services only. Typically, revocation is based on the grounds that the mark has not been used over a five-year period or that it has become generic or deceptive. Revocation is effective from the date on which the grounds are shown to exist.
- **Invalidation** – removal of a trademark from the register in its entirety, or in respect of some of the goods or services only, as if it had never been registered. Typically, invalidation is based on the grounds that the trademark is unacceptable on absolute grounds or conflicts with an earlier trademark.
- **Rectification** – application to correct an error that has been made in the recorded details of a registered trademark. It can be used to challenge ownership.
- **Surrender** – voluntary removal of a trademark from the register in its entirety or in respect of some of the goods or services only.

Searches

The UK Register can be fully searched for identical and similar marks, including device marks. All classes can be searched. Historical information can be searched. Costs will depend on the type of mark, the number of marks and the number of classes searched. Searches of registered company names, domain names and unregistered marks in use can also be undertaken.

5. Enforcement

Actions for infringement or passing off may be brought before the High Court or the Patents County Court. Typically, the judges specialise in IP matters and there is no jury. Appeals to the Court of Appeal, and further to the Supreme Court, are possible with leave.

The rules and procedures for court actions are set out in the Civil Procedure Rules, which aim to:

- avoid litigation where possible;
- make litigation less adversarial and less complex;
- ensure that the parties are on an even footing;
- shorten the timescale of any litigation; and
- deal with the case in a manner that is proportionate to its complexity, the money involved, its importance and the parties' financial positions.

The court is responsible for managing the litigation. Through the pre-action protocols, which are intended to make parties more cooperative, it is recommended that each party review its case and organise its claims at the outset. This can result in significant costs being incurred at an early stage. Alternative dispute resolution and settlement are actively encouraged. If litigation proceeds, disclosure is available. Costs are available, but generally recovery is limited to costs that are proved to be proportionate to the value of the case.

The timeframe for resolution of an enforcement action is dependent on the seriousness and urgency of the matter. It can be as little as a few weeks, but the average time between instigating an action and trial is 12 to 18 months.

The Patents County Court has recently undergone fundamental changes designed to provide an affordable forum for IP litigation for small and medium-sized enterprises. The pre-trial procedures have been streamlined to limit costs, the trial will be limited to one or two days and the total recoverable costs will be capped at £50,000 for final determination of liability and at £25,000 for enquiries as to damages or accounts of profits.

6. Ownership changes and rights transfers

A trademark registration can be assigned either with or without the goodwill of a business. The assignment can be whole or partial (ie, in relation to only some of the goods/services for which it is registered, or in relation to the use of the trademark in a particular manner or locality). The assignment must be in writing and signed at least by, or on behalf of, the assignor. It is best practice to have the assignment document signed by the assignee as well. There is no obligation to state any consideration, but if the document is intended to be a contract with obligations, a consideration is required. There is generally an exemption from stamp duty (transfer tax) in respect of IP transactions, including goodwill transactions. The transfer in ownership should be recorded at the UKIPO as soon as practicable. No legalisation is required.

The right to use a trademark can be licensed, but a licence is not effective unless it is in writing and signed by the licensor. Use of the mark by the licensee will be attributed to the trademark owner (licensor).

7. Related rights

Registration of a trademark can be prohibited where, or to the extent that, the use of the mark is liable to be prevented by virtue of the law of copyright, design rights or registered designs. Accordingly, the proprietor of a copyright work, an unregistered design right or a registered design can challenge a later application or registration based on its earlier rights.

8. Online issues

Nominet is the registry for '.uk' domain names. Registration is on a first come, first served basis. Where there is dispute, Nominet operates a dispute resolution service based first on mediation and, if that is unsuccessful, an independent expert decision.

A domain name is not an IP right as such, since it does not give rise to a monopoly right. However, the second-level domain element of the domain name is often a trademark and use of this in the course of trade can give rise to both infringement and passing off claims. The mere registration of the domain name can result in infringement and passing off liability if the registration is considered an instrument of fraud. Generally, however, for infringement to be found, there must be use of the sign in the course of trade in relation to the relevant goods/services in the United Kingdom. The courts consider that "the fact that a website can be accessed anywhere in the world does not mean, for trademark purposes, that the law should regard them as being used everywhere in the world". Whether there is use in the United Kingdom will depend on the facts of the case, but there will be consideration of whether:

- the defendant is trading in the United Kingdom; and
- from an objective analysis, it appears that the website is aimed at, or intended for, UK customers.

The terms and conditions of sale and the payment methods will be relevant to this.

The European Court of Justice has held that Google's operation of its AdWords service does not constitute trademark infringement (*Joined Cases C-236, 237 and 238/08 Google France v Louis Vuitton Malletier, Google France v Viaticum Luteciel and Google France v CNRRH Pierre-Alexis Thonet Bruno Raboin Tiger*). The storing of keywords and organising and display of adverts on the basis of such keywords does not amount to trademark infringement. However, advertisers may still be liable for infringement if their advert does not enable an average internet user to ascertain whether the goods/services advertised originate from the brand owner or an unrelated party.

Unregistered rights		
Protection for unregistered rights?		✓
Specific/increased protection for well-known marks?		✓
Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?		X / X
Examination for relative grounds for refusal based on earlier rights?		No ex officio examination on relative grounds, but a search of earlier rights will be conducted for information purposes
Registrable unconventional marks		3-D, colours, slogans, smells, sounds (including musical marks)
Opposition		
Opposition procedure available? Term from publication?		2 months, extendible to 3 months ✓
Removal from register		
Can a registration be removed for non-use? Term and start date?		5 years' non-use from date of registration ✓
Are proceedings available to remove a mark that has become generic?		✓
Are proceedings available to remove a mark that was incorrectly registered?		✓
Enforcement		
Specialist IP/trademark court?		✓
Punitive damages available?		X
Interim injunctions available? Time limit?		No set time limit, but there must be no undue delay ✓
Ownership changes		
Is registration mandatory for assignment/licensing documents?		But advisable X
Online issues		
National anti-cybersquatting provisions?		But grounds may be available under trademark law X
National alternative dispute resolution policy for local ccTLD available?		Nominet operates dispute resolution service ✓