

## Trade Mark FAQs

### What is a Trade Mark?

A trade mark is any Mark used to distinguish the owners goods or services from those of its competitors. Properly used and promoted, a trade mark may become the most valuable asset of a business. Trade marks such as FORD, TAYTO and WATERFORD are household names and serve as an indication of origin of the goods as well as an indication of quality.

Trade Marks can be names and symbols, but also slogans, colours, shapes and even smells.

### Why do I need a Trade Mark?

Registration of a company or business name does not in itself give protection against others who might commence using identical or similar marks. Trade marks should not be confused with trade names. There is a misconception that having a limited liability company name, business name registration or domain name registration allows use of that name and provides trade mark protection. Not so! The only way to obtain exclusive rights to, and protect, the name under which you wish to trade is by way of trade mark registration.

A trade mark provides exclusive statutory rights so that a rival cannot legally use an identical or confusingly similar trade mark to an earlier registration for identical or similar goods or services. Similarly, if you infringe, then all the investment in design, printing and promotion may be wasted.

### What happens if I do not register my Trade Mark?

If a trade mark is not registered, the only redress against an unscrupulous competitor who uses an identical or similar Mark is by way of the common law action of "passing-off". Such an action requires the owner to establish reputation and is much more expensive than an infringement action and is difficult to prove. Accordingly, it is now more important than ever to register your trade mark.

The five characteristics which must be present in order to create a valid cause of action for passing-off are

- A misrepresentation
- Made by a trader in the course of trade
- To prospective customers of his or ultimate consumers of goods or services supplied by him
- Which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence), and
- Which caused actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

## I want to register a Trade Mark. What should I do first?

Before you do anything else, first search the Trade Marks Register in each target market. This will uncover any existing names/marks that are the same, or confusingly similar, to that which is proposed and where the owner would have a sustainable objection to the new entrant.

## Why do I need a Trade Mark Attorney?

Advice from a Trade Mark Attorney is advisable because what appears to be clear to the untrained eye may, in fact, conceal a sustainable objection from a rival. If the search is clear, then an application should be made to register the Mark in all target markets. This application should be filed as soon as possible as search results quickly become obsolete as new applications are filed.

## What are Trade Mark Classes?

All goods and services are divided into 45 [classes](#). You should try to gain exclusivity for the name in whichever classes you are intending to trade in the future.

## How long does a Trade Mark last?

The initial life of a registration in many countries is 10 years. This can be renewed indefinitely thereafter.

## How do I apply for a Trade Mark?

You can apply to register either nationally or seek a Community Trade Mark (CTM) registration. A CTM registration provides exclusive use of the trade mark in all member states of the European Union. With just one application, protection can be obtained in all countries of the EU. Also, it is only necessary to use the mark in ONE of the 25 countries to maintain exclusive protection in all 25 member states. The costs involved in both the national and CTM options are relatively modest. In both cases the period of cover is for an initial 10 years and is renewable.

Once you have filed or registered an Irish or CTM application, you can then consider filing an International Application

## The Golden Rule of Trade Marks

Do not attempt to market goods or services until the identity under which you intend to trade has been cleared for use. That is, that it does not conflict with an earlier trade mark registration in the target market.

## Where should I register my Trade Mark?

If you want to ensure that the name under which you trade has the necessary protection, apply to register it in whichever countries you trade or intend to trade. Then, if someone begins to offer goods or services similar to yours, using your mark on a web site directed to those markets, you can take action against them.

Even if expansion into EU countries is not contemplated in the immediate future, you should seek registration in any field of activity where there is a possibility of use. By covering these additional product/service classes in target markets, you have the opportunity to get on with current matters while

preserving future options. Moreover, by virtue of multi class filings, in a market place as big as the EU, the intrinsic value of the original trade mark is enhanced.

Many foreign companies are availing of the CTM facility (at last count it was in excess of 100,000 and growing at 500 per week), and so it is imperative that companies in Ireland protect their national interests at least. Otherwise someone with the same or confusingly similar identity may obtain registration before the indigenous user. Then the burden of proof falls on the complainant to prove, in a court of law, that his goodwill is being damaged by the new entrant; an expensive and time consuming exercise, with no guarantee as to the outcome. The simple way to avoid possible lengthy litigation is to seek to register now!

Once you have CTM registration you have a protected environment for personal expansion and also the prospects for franchise arrangements and licensing agreements.

### **Please Note**

While this guide has covered several topics, it is intended as a very basic introduction to trade marks, and certain procedures surrounding them, and as such, it is no substitute for consulting with a qualified trade mark attorney.

If you have any further questions please [contact us](#).

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