

# Copyright, Trademarks and Design Rights

## What are trademarks and how do they work?

**Duncan Clark:**

*Welcome to the fourth video in our series on copyright, trademarks and design rights. This series of videos is presented by Dr Hayleigh Boshier of Brunel University, London. This video: 'What are trademarks and how do they work?', will cover the following:*

- *An introduction to what a trademark is*
- *What's the purpose of a trademark?*
- *How do you get a trademark?*
- *What do TM [™] and 'R' in a circle [®] mean?*
- *Why is it important for businesses to understand how trademarks work?*
- *What international differences should be taken into account?*
- *How can disputes be solved?*
- *What action do businesses need to take with regards to trademarks?*

### What is a trademark?

**Hayleigh Boshier:**

A trademark is a logo or a slogan or a brand name that is protected for an organization or company. It can be simply a word and it can also be registered as the shape of the word, the font, the appearance of the word, or it can be a logo or an image. It can also be a slogan, so some words together. They're registered against all services. So, depending on what the company are using the logo for, it might be a product in which case they register that logo against that product.

### What's the purpose of a trademark?

The purpose of a trademark is to distinguish goods or services, so there's actually quite a lot of emphasis on the consumer as well as the benefit for the organizations. What that means is the consumer can purchase an item or use a service and be able to trace that back to the organization.

### How do you get a trademark?

A trademark can be registered or unregistered, but most organizations tend to go for the registered option because that gives you the greatest protection. Once you've registered it can last for 10 years and then you can keep registering it as long as you're using it. The saying goes; "use it or lose it", your trademark is only valid as long as you are actively using it.

If you want to register the only thing you have to do is to go and look at the register online and check that someone else hasn't already registered a similar trademark to you. Within the class, which is the category that you are operating in, it's your responsibility to check that register before you try and register your own trademark. Other than that, it's a pretty straightforward process, bigger companies tend to hire a specific trademark attorney to help them do that and that can be very useful, but that doesn't mean to say that you can't do it for yourself. You just need to understand beforehand the requirement of what a trademark needs to be registerable, and also to make sure you're definitely not infringing someone else's when you register.

In terms of the actual application process you go to the UK Intellectual Property Office website and you just register it there, if you want your trademark registered in this country. If you're operating in another country you might want to register your trademark there and then you would go to their intellectual property office website and register there as well.

### **What do ™ and ® mean?**

That's a really good question actually, that's a really common misconception that TM means 'registered trademark', when actually TM means 'unregistered trademark', and the 'R' in a circle means 'registered trademark'. So, you can only use [®] once you've registered with the local intellectual property office. Sometimes companies use [™] because they know their trademark wouldn't be registerable, and other times it's because it's in the process of being registered. Sometimes it's not strategic for them to register that trademark because they're only using it for a short-term and they don't need to. Another time you see [™] is actually for big companies with a strong brand, such as Google, where they don't need to register their trademark necessarily because it's such a household name now. The registered trademark is important for companies particularly when they're building their brand and then protecting the brand. If it's registered, the protection is easier.

If you haven't registered your trademark then you can't use [®], it would be misleading. Also, from the perspective of the protection that you want for your trademark, it's good to adhere to the consumer and competitors which of your trademarks are registered and which are not, so you need to make sure that you're using those symbols in the correct way.

### **What's the most expensive trademark?**

Trademarks are actually hugely valuable for companies. I think Google is one of the most expensive, it's about 44 billion estimated value (in Dollars). But there are many, the golden 'M' of McDonalds, Coca-Cola is another huge one, IBM, Apple, these are the biggest ones in the world.

When a company is trading that can be one of the things that's most important in terms of the negotiation. For example, in TV formats the show gets sold purely on the name alone and everything else can change. So, in those kinds of circumstances the trademark becomes very valuable.

### **Why is it important for businesses to understand how trademarks work?**

I think there's two reasons. The first is to do with building your brand, some it comes back to purpose of the trademark and that's to enable the consumer to recognize that that product or service is made by you. So, in building your band you want your trademark to be recognizable, you want it to be original and you want to make sure that nobody else within your field, within your category or class that you've registered in, is using something similar that might be confusing to the public. So, there's that, and there's also the element of you also don't want to be infringing someone else's. In a way, if you are infringing someone else's, that's actually not beneficial for your company because then people might be confused that you operate together with another company when you're actually not. And that's one of the risks of not checking the register first. When you're coming up with a name of a different product or service it's a good idea to see what's already out there.

For example, there was this trademark case where loads of hotels have the name, 'Titanic', for some reason. So, they all came together in this big case where everybody was fighting to have the 'Titanic' name, but some of them were called 'Hotel Titanic' others 'Titanic Hotel' and 'Hotel and Spa Titanic', all these different versions, and in the court case they had to separate out who owned what and it became very complicated. So, if I was acting for a hotel and they were considering calling themselves 'Titanic' the advice would be to choose something else, like something more original, so you can't be confused with the ones that already exist.

### **What international differences should be taken into account?**

It's really important to know, for your company, what you need to do. If your company only operates within the UK, then you can only register your trademark in the UK because you have to be using it. So, I can't have my trademark in the UK and also France if I don't actually operate in any way in France. Equally, if I am operating, for example if I work in fashion and I have factories and offices in different parts of the world, I'm going to want to register my trademark in those countries as well to protect myself against competitors there.

Sometimes what can happen is you can't always predict where your company is going. You might start off small and then build and expand into different countries. For example, there this festival called 'Tomorrowland' and that's based in Belgium and they had a registered trademark in the category of entertainment and that was absolutely fine. There's also Disneyworld in America that has a ride called 'Tomorrowland' and they registered the trademark 'Tomorrowland' in America, and at this point everything is fine because the festival has their trademark in Belgium and Disney have theirs in America. Nobody's crossing over. But then what happened was the festival wanted to expand over to America and Disney wanted to make a movie based on the theme of the Tomorrowland ride and call it 'Tomorrowland', and that would obviously be distributed across the world. So, then becomes a dispute between the two companies about who can have the trademark where. In the end, what happened was they got to keep their respective trademarks and they had to alter the name of their branding for their products that cross over. For example, Tomorrowland (the festival) in America is now called 'Tomorrow-world', and the film (made by Disney) was called 'Tomorrowland' in countries other than the ones where the festival is registered.

## How can disputes be solved?

So, if you have registered your trademark and you think that someone else is using either the same trademark or something very, very similar to you, first thing you do is go online and check the register to see if they have registered. If you are serious about your IP strategy, then actually you'll keep an eye on the register. They publish a journal in the category you're registered in, so you can actually keep an eye on people coming and registering, and it's a good idea (if you're vigilant about your IP protection) to keep an eye. What usually happens is you would send a letter to the people who have the similar trademark informing them of your registered trade mark, maybe with the picture and some information about the registration and say: "This is protected".

Trademark is a monopoly right, so that means that if you own it you own the whole thing and there's no exception. Unlike copyright where there's some balances and limitations, and two people can come up with the same idea and that's not necessarily infringement unless there's been copying, with trademark it's not the same. If it's registered, it's yours and so if someone is using it exactly without your permission in the same field.

For example, I could have a company called 'Hayleigh Boshers Dry-Cleaning' and the someone else could have a pencil case making company and call it the same thing, this is not in conflict. There's no confusion because they're completely different products and services. If, however, somebody else down the road opened another dry-cleaning company (same industry) and called it something similar or exactly the same, then that might be an infringement.

So, we need to understand whether it would be infringement or not. Is it a similar logo or name? Is it within a similar class (goods or services)? If you feel that it is, the first step is always to write to them and ask them to stop what they're doing, sometimes people ask for damages, but it really depends on whether any damage has actually occurred. There are preliminary steps you have to take before you go to court, which include this letter-writing process, you can't actually just go straight to court, you have to follow this 'pre-action protocol'. But, if it was a small company or individual the best would be to seek some kind of legal advice, maybe from a pro-bono center that's free, maybe from a legal consultant or hiring a lawyer if they thought things could progress beyond any kind of level of negotiation.

## What action to businesses need to take with regards to trademarks?

I think it's really good to think about the beforehand, it can be really beneficial to the company to understand what makes a good trademark, and what doesn't make a good trademark. For example, trademarks aren't created equally. The best trademarks are maybe a made-up word, so that it's completely original. The more original a trademark the more effective it can be. Sometimes that's displacing. For example, if you think of Apple, one of the most famous trademarks, 'Apple' is not an original word. But, applied to computer software it is. There's a couple of things your trademark can't be. So, it can't be descriptive, you can't register the word 'chair' for a chair, because then nobody could ever have a chair sale. Do you see what I mean? It's because you'd have a monopoly on that word.

It is important, especially at the beginning when you're thinking up what your trademark might be, to understand what the threshold is. So, the things that it needs to be in order to registerable, which is things like; it has to be a sign, it has to be graphically represented. When you fill out the form for the register you need to be able to put what it is that you're registering, which sounds straight forward when you're thinking of a logo or a word, but these days people are pushing the boundaries of what a trademark is and registering things (or trying to register things) like colors, sounds and smells. The reason they're not always successful is because they're hard to register graphically, and the other thing is that they aren't able to distinguish the product or service. Those are the things that it definitely needs to be and the more original it is the more effective it is.

And there's a couple of things that your trademark can't be. It can't be descriptive, there's also some things that are 'no-goes'. You can't register the flag of a country, or the rings of the Olympics, things like that. But, depending on the organization, they'd have to research into their particular field what words were commonly used within their industry and those words wouldn't be able to be registered.

**Duncan Clark:**

*Thanks there for Dr Hayleigh Boshier. Join us in video 5 when we look at design rights. Thanks for watching and see you next time.*