

## Origin: Trade Mark Guidelines

**Function of this document:** Your trademarks are valuable assets. This guide will provide information concerning the proper acquisition, usage, protection, and attribution of these trademarks.

The most important steps you can take in protecting your trademarks are to:

- ensure that proper clearance searches are completed before use begins: a failure to clear a mark for use could lead to litigation against you and the need for you or your licensees to withdraw products from the market.
- use your trademarks properly. Trademarks must also be handled with care because improper use can destroy a trademark. The rules and examples in this note show proper use of trademarks and illustrate some of the most common examples of misuse.

### Instructions:

If you wish to use a new trade mark, please:

- Read this entire document, including the Appendix: "Trade Mark Guidance Notes".
- Do as much Internet searching as you can to check for possible conflicts with your proposed mark.
- Complete the following table AT LEAST 2 months before you need to use the trade mark you have devised; send the completed table back to us if you would like us to advise you. We will then initiate a trade mark clearance process, if appropriate. Clearing trade marks (i.e. checking to see if use might infringe someone else's marks) is time consuming; most good trade marks are already taken in some form so you **MUST** give yourself time to produce a new mark in the event that your first choice mark is unavailable.
- Where budgets allow, you may wish to propose several trade marks for clearance.

<b>Your Name</b>	
<b>Your Group</b>	
<b>Proposed Trade Mark</b>	
<b>Are there any artwork or logos which use the trade mark? If so, please include these.</b>	
<b>What kinds of products/services will the trade mark be applied to?</b>	
<b>Which countries will the trade mark be used in?</b>	
<b>When will the mark first be used? Has it been used?</b>	

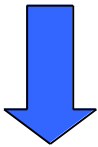
<b>Do you know of any similar marks being used?</b>	
<b>Have you conducted an Internet search? If so, please provide the results.</b>	
<b>Are any domain names required? If so, have you checked for their availability?</b>	
<b>On a 1 to 10 scale, how potentially important do you think that this trade mark might be to you (10 is the most important)</b>	
<b>On a 1 to 10 scale, how potentially damaging would it be if you or your Licensees had to withdraw products/services carrying the trade mark? (10 is highly damaging)</b>	
<b>What brand values is the mark meant to convey?</b>	
<b>Which countries do you think protection should be sought in?</b>	
<b>Does the trade mark relate to any innovation which is being patented?</b>	
<b>Will the mark be used by our Licensees? If so, how?</b>	
<b>Do you need us to supply a trade mark license agreement to enable others to use the trade mark?</b>	
<b>Date of submission to us</b>	

## Trade mark flow chart

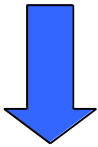
Brand conception



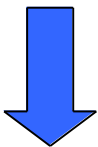
Brand clearance: broad range of costs; much depends on the downside costs of hitting problems down stream. Towards the lower end, £1K per country should highlight major problems but there's still quite a high level of risk. Towards the upper end, £5K per country will be a more detailed picture, but may identify so many risks which wouldn't in fact materialise that you feel stymied .



First filing – usually a CTM. Costs approx £1.2K.



Within 6 months of the first filing, file in other relevant countries. Budget £2K per country for the applications.



1 – 2 years: Arguing the cases through to registration. Budget £2K per country

## Appendix 1: Trade Mark Guidance

### 1 What is a trade mark? compared to

Today, virtually anything can become a trade mark. Slogans, colours, packaging, smells, musical jingles, in fact anything which contributes to products' or services' brand identity can be a trade mark. You need take no specific legal steps to obtain a trade mark: it simply arises whenever you have significant levels of consumer or business recognition of the mark. These kinds of marks are often called "*unregistered marks*" or "*common-law marks*". They should be identified with a symbol (although there is no legal requirement to do so, its useful since it can warn others off using the mark). But these are typically not the best kinds of marks to own because to attack someone using the same or a similar mark requires proof of adequate levels of brand recognition of your own brand and, often, marketplace confusion. That is usually very costly: a typical High Court case can cost in excess of £300K.

We prefer where appropriate to obtain *registered* trade marks. These are easier and cheaper to police and are more potent weapons in litigation. Today, virtually anything can become a registered trade mark. The registration process is usually straightforward and incurs costs of typically £3K to £5K for European coverage, £4K for US and typically £2K for individual countries. It can take 1 to 3 years to obtain registration. For major brands we recommend filing in many different countries. For subsidiary brands, we may recommend that you file solely in the UK and the US, or not at all. (We like to recommend filing in the US because it is the most litigation intensive country. Although it may not be your largest market, it carries disproportionate litigation risks. Because having US registrations can be an important offensive and defensive weapon, we like to recommend obtaining US registrations where possible.)

### 2 Selecting new trade marks; avoiding infringement

Whenever you devise a new trade mark, it is very important that a search is performed so that you have a legal opinion that you can use the mark. Please talk to us about this if you wish: we're happy to work with you in this area. But before seeking legal clearance, you should take a few minutes to do a WWW trawl to see if the mark is clearly already in use on the same or similar goods/services to those you want to cover. You may be able to discard your trade mark without incurring significant costs and rapidly move on.

When briefing us, please let us know of any similar marks you already know of and let us have a copy of any possibly relevant WWW hits you located. You should also tell us what countries the mark will be used in and what products/services will be branded. The searching process typically takes 1 to 2 weeks, although a much faster turn around is possible where needed. The typical costs are £5K for Europe, £2K for the US and additional countries at around £1K or less. Where budgets will not stretch that far, we can obtain a less comprehensive search for around £3K or less covering many of the main Trade Mark Registries. For many purposes, that level of searching is adequate.

Seek advice as early as possible. Consumer and industrial electronics attract many trade mark registrations and there is a very significant risk that your first choice brand will already be taken. You must give yourself time to devise alternative brands in case your first choice is not available.

If we fail to search adequately, you will be running a significant risk of infringing someone else's trade mark. They could sue you, be awarded damages and obtain an injunction requiring you to withdraw stocks, advertising materials etc. That can be very damaging indeed.

### 3 Trade marks can be both a Company Name and a Brand

A company name is the name by which a legal entity, such as a company, does business. For example, "Microsoft Corporation" is the official company name of Microsoft. However people sometimes refer to Microsoft Corporation as "Microsoft". Since MICROSOFT is used as both a company name and as a brand or trade mark, it is even more important that the rules provided below are followed for it. It is important to recognise the proper, grammatical use of the word MICROSOFT. If you are referring to Microsoft Corporation, then the word MICROSOFT may be used as a noun, may be used in the possessive form and is not followed by a trademark symbol. But none of that applies if you are referring to the MICROSOFT brand name. **In fact, people should never use the MICROSOFT brand name as a noun, or in the possessive.** Wherever possible, it should be followed by a trademark symbol. We'll discuss the proper trade mark use rules in detail later on.

### 4 Proper Use of Trademarks

Trademark rights may be lost if the marks are not used properly. ESCALATOR, ASPIRIN, and CELLOPHANE are examples of names which once were trademarks but which have now fallen into such common usage that they may be used by anyone. To maintain your trademark rights, all its marks must be used in accordance with the following rules:

#### 4.1 Rule: never use trademarks as nouns; use them with generic terms wherever possible

Trademarks are adjectives, and should always be used as adjectives modifying a generic term. For example:

Correct: *The Hoover vacuum cleaner is well engineered.*

Incorrect: *The Hoover is well made.*

Your copy should read as though the word "brand" followed the trade mark. This rule should be applied consistently to any use of the mark in the text of advertising and other promotional materials, on packaging and in documentation. You may, however, omit the generic term in headlines, slogans and titles, and on labels, where impractical (See also Section 5: 'Breaking the Rules').

**4.2 Rule: do not use trademarks as possessives, plurals, or verbs**

This rule follows from the principle that trademarks are adjectives:

Correct: *Let's vacuum the house with the Hoover cleaner.*

Incorrect: *Let's hoover.*

**4.3 Rule: retain the distinctive appearance of our trademarks**

Trademarks should always be presented in a distinctive fashion, such as by the use of all capital letters, italics or distinctive typeface. If you have any questions about the proper stylisation of any of your trade marks, please contact us.

**4.4 Rule: always use the proper trade mark markings**

Your trademarks should be clearly designated as such, and attributed to you. The following rules apply to materials distributed in the UK and US. If you are designing materials for international distribution, these rules may not apply. Please consult us for international considerations.

When using marks (as noted above) which are registered in the U.K or US you should use the registered trademark symbol ( ) at the upper right corner or baseline immediately following the mark. Unregistered trademarks (as noted above) should immediately be followed by the trademark symbol at the upper right corner or baseline. These markings should be used with both the most prominent appearance (e.g. headline) and at least the first appearance of text of the trade mark in advertising and promotional material, web pages, documentation, packaging, labels, and so forth. Failure to use these markings can cause you to lose valuable legal rights.

**4.5 Rule: Always use the proper attribution (i.e. legal fine print)**

All advertising and promotional material, web pages, documentation, packaging, labels and so forth, should contain the following statement:

"[insert your brand here!] is a trademark of [insert your company name here!]. All other brands or product names are the property of their respective holders.

**4.6 Rule: always use trademarks properly in all internal or external communications**

History shows that a company's own internal correspondence as well as its advertising or labelling frequently is at fault when a trademark is lost by conversion into a generic term or loss of distinctiveness. This can be prevented by using the rules as noted above both in internal correspondence as well as in any communications to the external world. Proper trademark use would be almost automatic if we train ourselves to follow the rules as noted above.

**4.7 Rule: use other companies' trademarks as you would have them use your own**

When you use the trademarks of other companies in your literature, you should follow the same rules as you do in using your own trademarks properly. For example, the trademark should be used as a proper adjective and separated from other words in the text. Although there is usually no legal obligation to do so, unless you have agreed to do so in a contract, you may choose to acknowledge the trademarks of other companies

with a footnote. When trademarks of a number of companies appear in the same piece of literature, you may need to clarify ownership of each of the trademarks with a footnote. However, usually the attribution language as noted above will suffice to give legal notice of the trademarks of others.

NEVER let outside companies use your trademarks without a formal license. Failure to keep others from using your marks without a license may result in your loss of rights to the trademark. Please bring suspected unauthorised use to our attention.

## **5 Breaking the Rules**

Where a trade mark is particularly strong and the likelihood of it becoming a generic term is low, then you can occasionally depart from these rules. There may therefore be times when some bending of the proper rules is acceptable to maximise the impact of textual fluency or to keep artwork uncluttered.

Departure can be an attractive prospect: not only can following the proper-use rules lead to awkward, sometimes stilted text, but manifestly improper use can give a trade mark energy and authority. For instance, consider the use of the INTEL trade mark as a noun in the slogan "INTEL INSIDE". Technically, that's arguably a violation of the proper use rules. But we have to balance the risks of that violation with the marketing impact an effective slogan may bring. Generally, we will take a very commercial view on the need to allow you to use creative and effective copywriting. But it is important that you involve us when considering a departure so that we can ensure that no undue and excessive departures from proper use occur. Generally, where there is a slogan that clearly violates proper-use, we advise you to include the symbol together with a standard trade mark notice in a reasonably prominent position. In the industries in which you operate, the symbol and trade mark notices are used so liberally that the public have virtually developed a 'blind spot' to them. So although copywriters may be concerned about unwanted clutter, a standard trade mark notice rarely if ever dilutes the primary advertising message.

## **6 Review of Materials**

The information in this Appendix should help you ensure that you broaden your trade mark portfolio of trade marks, is not exposed to unnecessary litigation and that its trademarks are being used properly. Should you have questions about trademark usage or need clearance for a proposed mark, please contact us.

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