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Before we get to the slides. Here is a little more
information on:

‘What Intellectual Property is’

&

‘What type of Intellectual Property you need’.

WHAT IS INTELLECTUAL PROPERTY?

& WHO CAN HELP ME?

INTELLECTUAL PROPERTY LAW

Intellectual Property laws allow people to obtain legal protection preventing unauthorised copying of certain types of original ideas, transforming these ideas into valuable commercial assets.

There are four main types of Intellectual Property:

PATENTS

Legal protection for novel inventions, covering a wide range of products from pharmaceuticals and medical technologies through to some software, toys and games. It provides a right to exclude others from selling, making or using an invention.



TRADE MARKS

Legal protection for branding marks that identify particular products or services from others, including names, logos and jingles.



INDUSTRIAL DESIGNS

Legal protection for product appearance, shapes and colours, and packaging and decorations.



COPYRIGHT

Is automatic legal protection covering written work, films, music, visual art and architectural design, amongst other things. In the UK, there is no need to register copyright.



At Cleveland Scott York, we can help you with any patent, trade mark or design query. However, if you feel your query relates to a copyright matter then you need to speak to a general lawyer.

WHAT TYPE OF INTELLECTUAL PROPERTY PROTECTION DO I NEED?

PROTECT

Inventions
Products
Equipment

With a PATENT.

SAFEGUARD

Logos
Product Names
Jingles

With TRADE MARKS

SECURE

Product Appearance:
Shape, Packaging, Patterns,
Colours, Decorations

With Designs.

WHEN TO CONTACT US

New or unregistered product, invention, brand
or design.

Lapsed patent, trade mark or registered design.

Potential conflict over patent, trade mark or design.

ABOUT US

Cleveland Scott York are intellectual property lawyers; we are specialists in obtaining patent, trade mark and design registrations. We also handle litigation, opposition and cancellation matters and provide IP consultancy and management services.

Recognising and securing your IP can add enormous value to your business and improve your performance in the market. All of our activity is geared towards achieving those goals.





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Protecting your brand

Rebecca Silva

4 August 2020

Introduction to Registered Trade Marks



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- What are they?
- Why do you need one?
- How do you get one?
 - Clearance
 - Registration
- Are they expensive?
- What makes a strong trade mark?
- Practical considerations

What is a registered trade mark?



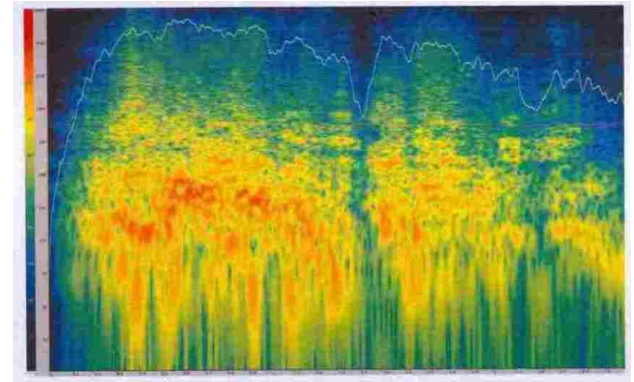
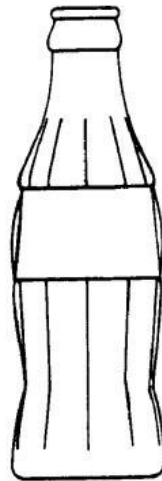
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- Identify origin of goods/services
- Word, logo, moving image, 3D shape, sound, multimedia, hologram, smell, colour, slogan, position
- Not domain names or company names

What is a registered trade mark?



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TOSHIBA





Why do you need one?

- Exclusive right to use the mark for the goods and/or services that it covers;
- Solid foundation on which to build reputation and goodwill;
- Easier to take action against infringers/cybersquatters – can avoid opposition and court action;
- Warning sign to third parties;
- Trading Standards, Police or HMRC can help to enforce.

Exploitation



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- Licensing
- Assignment
- Security for loans
- Facilitates investment

Availability searches



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Pre-filing availability searches to uncover earlier conflicting marks/rights:

- Obstacles to use
- Obstacles to registration (identical and confusingly similar marks)

Advisable to conduct clearance searches prior to use/registration.

Re-brand examples



WWF (World Wrestling Federation Entertainment Inc) re-branded to WWE (World Wrestling Entertainment Inc) in light of the World Wildlife Fund Inc's brand WWF.



Penneys re-branded to Primark in all countries outside of Ireland in light of US retailer JC Penney.



In Australia, Burger King re-branded to the name Hungry Jack's in light of an earlier business operating under the Burger King name in Adelaide.



How do you get one?



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- Representation of the mark
- Name/address
- List of goods/services
- Payment of filing fees
- Examination
 - Distinctiveness
 - Descriptiveness
- Opposition

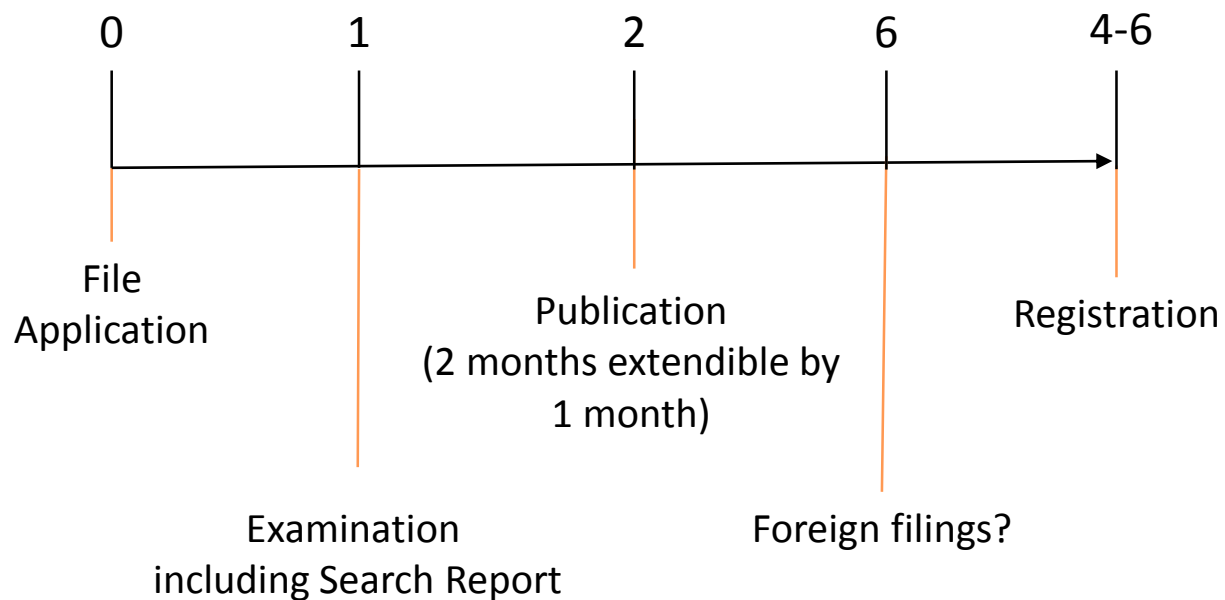


Intellectual
Property
Office



EU IPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

UK timescales



Are they expensive?



- Filing fees
 - goods/services
 - territory
- Prosecution
- Renewals
- Policing and Enforcement?



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What is a strong trade mark?

- Spectrum of distinctiveness

THE BODY SHOP®



- Greater the distinctiveness, easier to protect, the Greater the scope of protection
- Invented words

What to protect?



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Individual marks stronger than combined marks

MICROSOFT

and



v



MICROSOFT



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Practical considerations

Use your trade mark as an **adjective**

Examples of generic trade marks:

- Jacuzzi
- Bubble wrap
- Plasticine
- Velcro





Practical considerations

- Use the ® symbol as a deterrent
- Criminal offence to incorrectly use ®
- Use ™ as an indication of trade mark use / unregistered rights





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Practical considerations

- Non-use period
- Use on different products/services
- Use in a different form

Is your use sufficient?



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Mark registered	Mark used	Does this use constitute use of the registered trade mark?
		Yes
BEAR		No

Top Tips



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1. Identify important aspects of your brand (not necessarily just word or logos)
2. Identify all goods and services at the outset
3. Scope of protection
4. Sufficient time for brand clearance— can save time and costs in the design process
5. Brand evolution - reflected in brand protection
6. Strategy for policing and enforcement
7. Evidence of use
8. Evidence of confusion

Many thanks for joining us this morning!



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Rebecca is involved in all aspects of trade mark practice, including devising brand clearance strategies and advising on filing and prosecuting trade mark applications worldwide. She is experienced in UK and EU Intellectual Property Office (EUIPO) opposition proceedings and also regularly advises on trade mark infringement.

She has successfully obtained registration of a number of particularly troublesome marks and has a good record of overcoming inherent objections at the national and European Union level. She often advises on international trade mark disputes and favours a pragmatic and commercial approach to settlement. Her other areas of involvement include advising on comparative advertising, the risks of genericism and brand dilution. Rebecca has also been involved with providing in-house training to clients on brand protection and enforcement.

Rebecca enjoys getting to know her clients' businesses, has long standing client relationships and uses this to assist with creating tailored brand protection policies and guidelines. Rebecca represents clients from a wide range of sectors including a number of well-known charities, a publishing house, software providers, a global insurance group and those in the food and drinks industry. Rebecca is often described by her clients as "friendly, approachable and thorough".

Feel free to contact Rebecca if you have any questions - r.silva@csy-ip.com.



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