

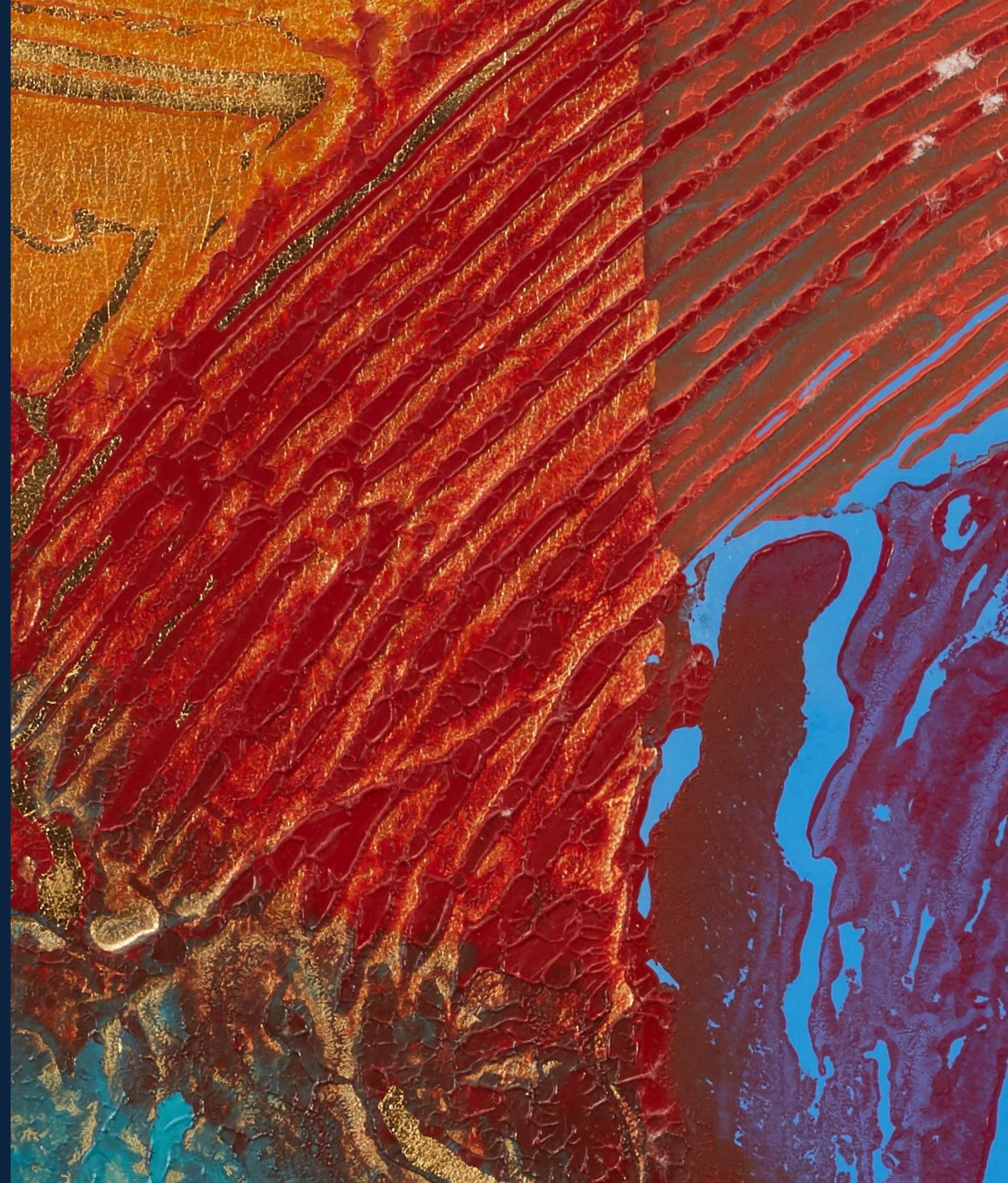
FARRER & Co

Trade mark use

Fact sheet

Intellectual Property Team

November 2023



Why is careful management of your registered UK trade mark so important?

Trade marks registered in the UK should be used in relation to the goods or services for which they are registered. If a mark is not used during the five-year period from registration, or if it is not used for any other uninterrupted five-year period, then the registration is liable to revocation on the grounds of non-use. A third party may file an application to revoke the registration on this basis.

Loss of exclusive rights

A trade mark will lose its exclusive rights if it becomes the common name in the trade for a product or service for which it is registered (it has become generic). For example the words “gramophone”, “linoleum” and “escalator” all began life as registered trade marks. Loss of the exclusive rights in a trade mark could dilute the brand image being promoted. It is very unlikely that rights in a trade mark, once lost for these reasons, can be regained.

How can I make proper use of my mark?

Distinguish the trade mark from the surrounding text, for example by use of different **fonts** or **colour**: create and maintain the distinctive character of the mark

Use the trade mark as an adjective, and not as a noun or verb. This will help prevent the mark becoming generic. For example “a WhatsApp message” not “a WhatsApp”

Do not hyphenate, pluralise or use the mark in the possessive form

With logos, stylised word marks and combined word/logo marks do not use a modified version of the trade mark, and especially ensure any colour or colours cited in the trade mark registration are correct

Use the mark consistently: the style and appearance of the mark should not be varied

Distinguish use of the company name from use of the trade mark

How can I make proper use of my mark? (cont.)

- Draw attention to the trade mark, especially on its first appearance in any literature. The symbol ® is frequently used as a shorthand indication that a trade mark is registered in relation to particular services and puts third parties on notice that the mark is registered. However, it is completely up to you as to whether or not you choose to do this. Do not use ™ as this denotes an **unregistered** trade mark,
- If you permit third parties to make any use of the trade mark do so under a written agreement that gives you the ability to monitor and control the use made by that third party (see following page),
- Do not use the mark in a way that is liable to mislead the public, otherwise the mark may be revoked, and
- Report and act immediately upon any misuse of the mark, whether by a competitor, industry, the general public or the media.



How do I renew the registration of my mark?

Registration lasts for a period of **10 years** and can only be maintained beyond this period by applying to renew the registration and by paying a renewal fee. There is no time limit on how long a mark can be kept registered. Should you wish us to do so, we will notify you in advance of the need to renew your registration.

Licensing the mark to third parties

Licensing of registered trade marks to third parties is often essential and helps build your brand. However, it is also the area that most commonly leads to problems. It is vitally important, therefore, to maintain control of the use of the mark in a **trade mark licence agreement** and impose appropriate obligations to ensure proper use.

Consider addressing the following issues within the **licence agreement**:

Make clear that you own the registered mark and not the licensee. It is worth insisting that any use of the mark is accompanied with a statement that the mark is registered by you. For example: "XY is a registered trade mark of XY Plc"

Set out guidelines on how the mark will be used on packaging and in advertising material

Require royalty payments and quality control provisions

Reserve the right to revoke the licence on any misuse of the trade mark by the licensee

Include a right of inspection of all samples of materials that will use the mark

If you would like to know more about applying for a trade mark or a registered design or if you have any further queries about the material set out in this note then please contact David Copping or Owen O'Rorke from Farrer & Co's Intellectual Property Team on 020 3375 7355 or by email at trademarks@farrer.co.uk.

*This fact sheet is a general summary of the law.
It should not replace legal advice tailored to your
specific circumstances.*

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