

Trade Marks & Service Marks on the Internet

The problem with trade and service marks on the Internet is that trademarks are territorial (i.e. they are registered for specific areas/countries) whereas the internet, by definition, is global and almost “anti-territorial”. This leads to major complications again beyond the scope of this handout. Just be aware of the following:

Class of Goods and Services

Trade & service marks are registered according to classes of goods or services, so that usually if trademark is registered in an entirely different class from your area of interest, it is not a registered trademark infringement to use the same name in another field. There may be other rights that protect the other name holder including “passing off” so be careful and never use a trademark without getting expert advice in advance.

Unjustified Threats of Legal Proceedings

Do not threaten legal action for breach of your own trademark without being sure you have a right otherwise the potential defendant may elect to sue you for harassment (a “threats action”) and claim damages for the damage caused to them. This option was inserted into the Trade Marks Act in the 1990s to prevent overzealous attempts to enforce trade mark rights and stop trade mark owners from participating in heavy-handed trading tactics.

Descriptive Trade Marks and Registrability

Not all names are registrable as a trademark - words that are descriptive or relate to a geographic area, for example. However, if you qualify, it is often well worth while registering your business name and product names as trademarks as it gives you much greater power over others using a similar or same name. If you carry out significant amounts of business outside the UK, you may need to select other key jurisdictions in which to register at the same time - if you can afford it, always use a trademark attorney. For further information on checking existing registrations or making new applications, visit the Patent & Design Office’s excellent web site: www.patent.gov.uk.

NEED TO KNOW MORE?

For further information on trade mark protection, contact Maitland Kalton. Should you prefer to telephone, call us on +44 (0)207 278 1817.

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