

I. TRADE MARKS

I.1 INTRODUCTION

The Trade Marks Directive was implemented in the UK by the Trade Marks Act 1994 (TMA). The UK offers protection to both registered and unregistered trade marks. Unregistered trade marks can be protected at common law by means of a passing off action and registered trade marks can be protected under statute by means of trade mark infringement.

I.2 REGISTERED TRADE MARKS

Under the TMA, a person may register as a trade mark a sign which is capable of distinguishing the goods or services of one undertaking from those of another, subject to the “absolute” and “relative” grounds for refusal. Trade marks cover, for example, words, the shape of goods, smells, sounds or colours.

An application to register a trade mark will be rejected if it falls within one of the ‘absolute’ grounds for refusal. These include the mark being devoid of distinctive character, merely descriptive of the goods or services for which it is to be registered or consisting exclusively of signs which have become customary in the current language or in trade practices.

Furthermore, an application may be refused on one of the ‘relative’ grounds for refusal if the holder of an existing trade mark objects to the application on the grounds that the mark is:

- identical to an earlier trade mark which is registered in relation to identical goods or services;
- similar to an earlier trade mark which is registered in relation to identical or similar goods or services where there is a likelihood of confusion with the earlier mark; or
- identical or similar to an earlier trade mark and the earlier mark has a reputation in the UK and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

Registration of a trade mark confers on the proprietor an exclusive right to use the mark in relation to the goods or services for which it is registered. It also gives the proprietor the right to bring an action for trade mark infringement against third parties who use an identical or similar mark in connection with identical or similar goods or services without consent where there is a likelihood of confusion on the part of the relevant public.

Trade mark registrations last for an initial period of 10 years and can be renewed for periods of 10 years thereafter. Trade mark registrations can however be revoked if the mark has not been used for a period of 5 years following registration.

1.3 UNREGISTERED TRADE MARKS

In order to succeed in an action for passing off, the proprietor of the unregistered trade mark must show that he has goodwill or reputation in the mark and that there has been a misrepresentation by the defendant to the public, which has caused, or is likely to cause, damage.

2. PATENTS

2.1 INTRODUCTION

In the UK, patents are subject to the provisions of the Patents Act 1977. A patent may only be granted in respect of an invention if it:

- is new and does not form part of the state of the art;
- involves an inventive step and is therefore not obvious to a person skilled in the art;
- is capable of industrial application; and
- is not specifically excluded from protection as a patent.

A patent confers on the proprietor a monopoly right as it allows the proprietor to prevent third parties using the invention. Patents are protected for 20 years from their filing date.

The UK operates the first to file system. A patent application will be invalidated if the invention has been made available to the public before the priority date of the patent. The inventor must therefore keep the invention confidential before the patent application is filed.

2.2 DISTANCE SELLING AND E-COMMERCE

The Electronic Commerce (EC Directive) Regulations 2002 (SI 2002/2013) were introduced to implement the E-Commerce Directive. The Regulations set out certain obligations with which businesses must comply with when contracting on-line with consumers, in particular in providing certain information to the consumer.

The E-Privacy Directive was implemented in the UK by the Privacy and Electronic Communications (EC Directive) Regulations 2003 (SI 2003/2426). The Regulations prevent businesses from sending direct marketing by email, SMS, telephone and fax to individuals unless the recipient has consented to receiving such marketing or where the recipient is an existing customer, provided certain provisions are complied with. The Regulations also provide that cookies may only be used on a website if visitors are provided with clear and comprehensive information about the purpose of cookies and are given the opportunity to refuse them.

The Consumer Protection (Distance Selling) Regulations 2000 (as amended by the Consumer Protection (Distance Selling) (Amendment) Regulations 2005) implemented the provisions of the EC Distance Selling Directive. The Regulations apply to businesses selling goods or services to customers at a distance (i.e. over the internet, telephone, fax or digital television)

and require suppliers to provide consumers with clear information about the transaction and, subject to a few exceptions, provide consumers with a right to cancel the contract within a 'cooling off' period.

2.3 DATA PROTECTION

The UK implemented the Data Protection Directive by enacting the Data Protection Act 1998 (DPA) which replaces the Data Protection Act 1984 in its entirety. The DPA regulates the collection and "processing" of personal data of "data subjects" by "data controllers" and requires, for example, that data:

- must be processed fairly and lawfully;
- must be adequate, relevant and non-excessive;
- must not be kept for longer than is necessary; and
- must not be transferred outside the EEA unless the destination country ensures an adequate level of protection for the rights of the data subject.

The DPA also introduced the role of the Information Commissioner to oversee and enforce the provisions of the Act and, as a result, all data controllers are required to notify the Information Commissioner's Office prior to processing personal data. Failure to do so is a criminal offence. The DPA also provides additional guidelines on the use of "sensitive" personal data.

2.4 REGISTERED DESIGNS

Registered designs are governed by the Registered Designs Act 1949 (as amended). The Registered Designs Regulations (SI 2001/3939) implemented the Designs Directive.

In the UK, registered designs can protect the whole or part of a product resulting from, for example, the features of the lines, contours, colours, shape, texture or materials of the article or its ornamentation. Registered designs can therefore protect both three-dimensional and two-dimensional designs. For a design to be registered, it must be new, which means that it must not be known anywhere in the world prior to the application, and have individual character, which means that the design must produce a different overall impression from earlier designs on the "informed user". The design need not have aesthetic appeal.

Registered designs confer a monopoly right on the proprietor to make articles incorporating the design. Protection of a registered design lasts for 5 years and can be renewed for further period of 5 years up to a maximum of 25 years.

2.5 CONFIDENTIALITY AND KNOW HOW

In the UK, there is no formal protection of confidential information, trade secrets or know how. The protection of confidential information therefore ultimately depends on employers putting into place strict working practices and relies upon employees respecting the secrecy of the information. In all cases, confidential information should only be disclosed on a need-to-know basis and where confidential information or trade secrets are to be disclosed, it is advisable to do so only under detailed confidentiality agreements, although such agreements will not guarantee protection as they will only be effective if adhered to by the recipient of such information.

2.6 COPYRIGHT

Copyright in the UK is governed by the Copyright Designs and Patents Act 1988 (CDPA). Copyright is an automatic right and protection extends to original literary, dramatic, musical or artistic works; sound recordings, films or broadcasts; and the typographical arrangements of published editions. Copyright does not protect ideas; rather it protects the form of expression of the ideas.

In general, the right lasts for the life of the author plus 70 years from the end of the calendar year of his death.

Copyright is infringed if a person does, or authorises another to do, any of the following acts without the consent or licence of the copyright owner:

- Copies a copyright work;
- Issues copies of the copyright work to the public;
- Performs, shows or plays a copyright work in public;
- Communicates the work to the public;
- Makes an adaptation of a copyright work or does any of the acts listed above in relation to an adaptation.

2.7 DESIGN RIGHT

Design right is an unregistered right protected under the Copyright Designs and Patents Act 1988 which protects the appearance of purely functional products. In order to be protected by design right, a design must comprise an aspect of shape or configuration, be original and not commonplace and be recorded in a design document or be an article made to the design. Design right does not extend to designs which constitute a method or principle of construction or which comprise features of shape or configuration of an article which enables the article to fit with another article so that either article can perform its intended function or which is dependent on the appearance of another object of which the article is intended to form an integral part.

Design right allows the designer to prevent copying of the design and the right lasts for the lesser of 10 years from the first marketing of articles made to the design or 15 years from the creation of the design document or, if earlier, from when an article was first made to the design.

3. PROTECTION OF IP RIGHTS

3.1 PATENT AND TRADE MARK REGISTRARS

The Intellectual Property Office has jurisdiction to hear applications for opposing, invalidating or revoking registrations (and applications for registrations). In respect of trade marks in particular, appeals against decisions of the Hearing Officer may be made to the Appointed Person (a leading barrister or solicitor), or to the High Court. The Intellectual Property Office now also operates a mediation service for the resolution of disputes.

3.1.1 Patents

In order to obtain a UK patent, an inventor must put together, often with the help of a patent attorney, a patent specification, which usually contains an abstract setting out the nature of the invention, a detailed description of the invention and the claims of the invention, setting out the boundaries of the monopoly claimed by the applicant.

Approximately 12 months after the initial application is made, the applicant should make a full application and an examiner will carry out a search of the prior art, if not previously requested, in order to establish the state of the prior art in existence before the priority date. The full application will be published 18 months after the initial application. At this stage, the applicant must request substantive examination and pay a further fee. Third parties may then write to the examiner with examples of prior art of which he may have been unaware. Following examination, the patent may proceed to grant.

PCT Procedure

Under the PCT, the applicant must file an application with his local patent office, after which a single publication will take place and a single search will be carried out. Each national application will then proceed separately and each national examiner will carry out a substantive examination.

3.1.2 Trade Marks

Trade mark applications must be made to the Intellectual Property Office, often with the assistance of a trade mark agent. The application must include a specification of the goods or services for which the mark is to be registered.

Once the application has been filed, it will be examined by the Registry to ensure that it complies with the criteria for registrability. The examiner may raise objections to the application and set a deadline for response by the applicant.

Provided any objections have been overcome, the application will be published in the Trade Marks Journal, following which interested parties may raise objections to the application within a two month opposition period. If there are no oppositions to the mark, the application will proceed to registration.

3.1.3 Registered Designs

Applications for registered designs are subject to the Registered Design Rules (SI 2006/1975) and are submitted to the Intellectual Property Office. The application is generally examined within two months of its receipt and if no objections are received, the application will proceed to registration.

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