

Guidance on the correct use of trade marks in a business—checklist

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It is important for the proprietors of trade mark registrations to ensure that they are used correctly, so as to ensure that they are recognised by the public as badges of origin for the goods and/or services in respect of which they are used, and to minimise the risk of challenges by third parties on the basis that the marks have become generic or misleading, or that they lack distinctiveness.

For more information, see:

- [Trade mark transactions and management—overview](#)
- [Managing a trade mark portfolio](#)
- [Removal of trade marks from the register](#)
- [European Union Trade Mark registration—opposition, registration, renewal and cancellation](#)

To assist with this, clear internal guidelines should be created, and education provided to internal teams, as well as to third-party users of trade marks such as distributors, advertising agencies and retailers, as to the correct usage of trade marks. A checklist of points to include in such guidance is set out below:

- **Distinguish trade mark in text:**
A trade mark should, where practicably possible, be distinguished from surrounding text by use of different script, font, lettering size, and an initial capital letter.
Acceptable examples include:
 - COLGATE TOTAL
 - Colgate Total
 - *Colgate Total*
 - **Colgate Total**

Where possible, indicate at the foot of text and definitely somewhere on a product either that:

- the words COLGATE TOTAL are a trade mark of Colgate-Palmolive Company (in the case of an unregistered mark), or
- COLGATE TOTAL is a registered trade mark of Colgate-Palmolive Company (in the case of a registered mark)

It is possible to use the symbols ® or ™ beside a word mark in text. This is common practice in the USA (but see below in relation to the restrictions relating to the use of the ® symbol in the UK)

- **Use of the trade mark as an adjective, not a noun:**

Where possible, the trade mark should be used as an adjective, rather than as a noun. For example, the following should be avoided:

- Buy our new COLGATE TOTAL
- AJAX for cleaning the floor
- COCA COLA for quenching thirst

Each of the above encourages others in the trade to use the trade marks as product names themselves, rather than as trade marks to distinguish one proprietor's product from that of another. The following examples are preferable:

- Buy our new COLGATE TOTAL toothpaste
- AJAX products: No 1 as cleaning agent
- COCA COLA products satisfy your thirst

In short, as a minimum requirement, use the generic term in addition to the trade mark at least once in every written communication and preferably the first time the mark appears, eg KLEENEX tissues, VASELINE petroleum jelly, PAMPERS nappies.

- **Other formats to avoid:**

In addition to avoiding the use of a trade mark as a noun, the following formats should be avoided if possible:

a) Plurals	COLGATE TOTALs go straight to the target
b) Verb use	For floor protection needs—AJAX!
c) Possessive	COCA COLA's qualities are well known
d) Qualifications	Avoid using qualifications such as 'size', 'kind', 'type', 'genuine', 'original' or 'real' in conjunction with a trade mark.

The use of plurals, verbs and the possessive encourage genericism.

If qualifications such as 'size', 'kind' and 'type' are used in conjunction with a trade mark, there is a risk that the distinctiveness of the mark will be weakened. In addition, qualifications such as 'genuine', 'original' and 'real' should be avoided as they acknowledge the presence of imitators.

- **Maintain a consistent style:**

Do not deviate from an agreed typeface or style; it will help both to reinforce the brand image and to identify to third parties that you are aware of the importance of trade mark protection. If any updating of image is undertaken, the change should be made consistent throughout the mark's use; no variations on the agreed new format should be accepted.

- **Advertise your rights to the world in general:**

a) Use of ®	<p>This is for registered trade mark rights only and must not be used alongside an unregistered mark or a mark which is the subject of a pending application.</p> <p>In the UK, pursuant to section 95 of the Trade Marks Act 1994, it is a criminal offence to falsely represent that a mark is registered, if you know or have reason to believe that the representation is false.</p>
b) Use of ™	<p>This symbol is commonly used to denote the existence of an unregistered trade mark. It has no legal effect, but it is sensible to use it as a deterrent. Marking unregistered trade marks in this way can also be helpful when it comes to demonstrating that goodwill or reputation have been accrued in a mark, if it is necessary to assert it in a passing off action.</p>
c) Use of 'brand'	<p>It is advisable to use this in conjunction with the trade mark on some occasions to reinforce its function as a trade mark, ie the COLGATE brand.</p>

- **Police your property and guard adjacent third party encroachment:**

Some trade marks have descriptive qualities. Consequently, it is crucial to their maintenance to keep alive their trade mark function to competitors. Take every opportunity to remind competitors of the trade mark function, for example, by:

- placing advertisements periodically in trade journals
- notifying major wholesalers and retailers of your rights and encouraging them to be alert to look-alike products
- using the symbols ® and ™ as appropriate on all printed matter relating to the trade mark, from packaging, to invoices, to job advertisements, and to trade announcements

PROFILES



Carrollanne Lindley

Carrollanne qualified as a barrister, then a Trade Mark Attorney, and is now a partner at Kilburn & Strode. Having been called as a barrister, Carrollanne spent a year in pupillage with a Queen's Counsel specialising in intellectual property. She moved then into industry, first in-house at Rothmans International working on both luxury goods and tobacco products, and later on to 'The Body Shop'. Finally she moved into private practice, and describes this transition as 'poacher turned gamekeeper'. She joined Kilburn & Strode in 2000 and heads the firm's prominent Trade Marks Group.



Lorraine Lowell Neale

Lorraine is a solicitor with experience in contentious UK, EU and international intellectual property law across a broad range of industry sectors including Automotive, Broadcasting, Fashion, Food and drink, Pharmaceuticals, Publishing, Retail, and Telecoms. Lorraine joined Kilburn & Strode in September 2016 and is currently training to qualify as a UK and European Trade Mark Attorney. Lorraine assists in preparing, filing and prosecuting UK, European Union and International Trade Mark applications, with general portfolio management and clearance searches.



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