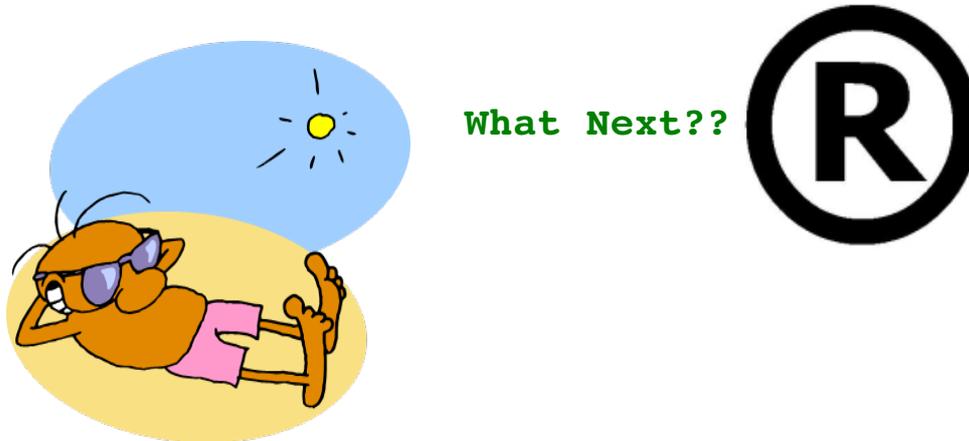


Post registration maintenance of a registered Trademark



What should a Trademark proprietor do after his mark has been successfully registered onto the official register of Trademarks? Well, a simple answer would be to continue using the mark as an indicator of Trade and Origin, and a Guarantee of Quality on everything that the mark has been affixed to. However most often the reality is seldom simple, especially for strong trade marks. Circumstances may arise in which the proprietor's mark may be threatened, and there may be need for action by the proprietor to reassert his rights and protect the Trademark.

There are several ways in which a registered Trademark may lose its capacity to sufficiently perform Trademark function, or even lose its status altogether.

Non-use

The most common form of loss of rights in Trademark cases pertain to non-use. This is when either (i) within a period of five years following the date of completion of the registration procedure, the mark has not been put to genuine use in the U.K. in relation to the goods or services for which the mark was registered and/ or (ii) such use has been suspended for a period of five years, and there are no proper reasons to justify non-use respectively [TMA 1994 Sec 46 (1) (a) & (b)]. In such a situation, competitors would have a case in commencing revocation proceedings, and may succeed if no genuine reasons for non-use are offered (*La Mer Technology Inc v Laboratoires Goemar SA*).

If a Trademark is revoked, a proprietor may need to re-register the mark, but may be stopped short, as most often times the party commencing revocation proceedings have an interest in the mark, and may block the original proprietor from re-registering it, once it has been revoked. In order to be safe, registered Trademark proprietors should make sure that they use their mark for the goods or services

for which the marks have been registered continuously, and in this context use need not be on a substantial scale. On the other hand, such use does not include 'token use' for the sole purpose of conserving rights. Unlike other jurisdictions such as Japan, Trademark banking is not accepted in the U.K.

Similarly, under Art 50 (1) (a) of the Community Trade Mark(CTM) regulation a CTM can also be revoked for non-use. The Burden of proof in proving use in both cases lie with the Trademark proprietor.

Genericide

“If you 'google' it, you should find it....” . Most of us have heard these words spoken numerous times, and for the Sales and Marketing guru, it is the epitome of accomplishment: that your brand is on the lips of every Jim and Jack.

Yet, using a registered Trade mark like 'Google' in such a manner is suicidal to the distinctive character of the Trade mark because although the system of trademark protection is ‘for the good of the public’, a trademark is not a public good, but a property right. If Google develops a strong Trademark for their brand, that others are free to use carelessly, as in this case, the *information Capital* embodied in the trademark will soon be lost, and the mark could be revoked as being 'generic' in the industry [TMA 1994 Sec 46(1)(c)]. The process through which a trade mark becomes generic is usually known as “trade mark dilution” or “genericide.” It weakens the power of the mark in the market. For example, if the term “Xerox” has become generic, the company which makes Xerox photocopiers may lose customers to other companies which use the company's trademark. A genericized trademark can destroy a company's profits if it is not dealt with. Generic marks like Escalator, Aspirin, Gramophone, Hoover, Thermos were once famous trademarks but because the owners of these marks allowed unrestricted use of their marks, the information capital embodied in the marks was eventually lost and the mark became the common name of the goods in the industry.

Thus trade mark owners of marks such as Google ® should ensure that their marks are used properly as trade marks. Unlike non-use, which theoretically can be resolved, if a mark falls foul to genericide it is almost impossible for the mark to gain registration again or be distinctive for the goods or services for which it was originally registered for.

When a proprietor senses that their Trade mark is facing a threat of genericide, he can take steps to protect it, like using the ® symbol with the mark. Also use of generic descriptors, clarifying the definition of a product when used in combination with the trademark and clearly differentiating the

trade mark and the product I.e. Xerox copier or Kleenex tissues. Also they may insert the word “brand” into their marketing and advertising, distinguishing the presence of a trademark, as in “Hoover brand vacuum cleaners”. Giving prominence to the trade mark by using it in capital letter all the times. Trademark proprietors should ensure that all licensees use the mark correctly. All licensing agreements should be reviewed carefully, and must state the standard or quality of goods or services with which the trade mark will be used.

Misleading

The registration of a trade mark may be revoked if its use by the proprietor or with his consent for the goods or services for which it was registered is liable to mislead the public, particularly as to the nature, quality or geographic origins of the goods. For example when in 2005 Feta cheese finally gained a Protected designation of Origin (PDO), it meant that all manufacturers producing “Feta cheese” in Denmark were forced to rename their cheese unless it was in fact produced in Greece, and from Sheep's/ goats milk. (See *Federal Republic of Germany and Kingdom of Denmark v Commission of the European Communities.*)

Logo's

If a registered trademark is used with a device such as a stylised logo or other colourful variation which is different to the original logo with which the mark was registered, then the distinctive character of the mark is said to have been altered and the mark can not be said to perform trade mark function. Competitors could then argue that the mark has ceased to be recognizable, and their logo could be revoked for non use and they would again need to re-register the logo.

Expansion of rights

This includes both registering the mark in other countries and also re-registering the mark for other similar goods and services of the proprietor, including incorporating a logo's or registering a domain name. In expanding a trademark portfolio into other countries, the proprietor should ensure that sufficient due diligence is undertaken so as to understand the culture of the new market, and what the mark or close variants of the mark, mean in the local or regional language(s) or dialects before making an application.

There is also a need to register domain names both as a defensive strategy against potential infringers and as new domain codes are introduced. For example when the .eu country code top-level domain (ccTLD) was introduced most companies rushed to register a domain name with this code, thus stopping cybersquatters registering their mark with the .eu ccTLD.

It is also a good idea to use the mark into secondary product classes with the view of expanding the use of the mark as this may strengthen the trademark. This is important because if later it becomes expedient to register the same mark for additional classes in response to a competitor activity, the proprietor could then use “reputation through use” as a reason for distinctiveness for the goods or services sought. To this effect the proprietor should keep a record of advertising expenditures as this could be useful in an opposition case and to show that the proprietor has invested in building a reputation for the mark.

Finally, it is a good idea to invest in a monitoring services, so that the trade mark is kept under regular watch. These services usually include weekly audits in trade mark journals in the major markets, and around the world, and competitor practices. They are intended to keep a lookout for potential infringer's and or applications for confusingly similar marks in respect of identical/ similar goods. For a few hundred pounds, this service could successfully fence the Trademark and ensure its continuous effectiveness in the market place.

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