

Registered UK & Community Trade Marks

08

What are they?

Protect signs capable of distinguishing goods or services of one trader from those of another. The sign must be capable of being represented graphically (e.g. words, logos, symbols).

Ownership/Registration

Registered following registration process. Owned by applicant for registration.

Duration

Indefinite monopoly protection provided renewed every 10 years.

Rights and Remedies

Give the owner exclusive use of the mark in connection with the goods or services for which it is registered. Infringement occurs where the "infringer" uses:

- an identical sign on identical goods/services, or

- an identical sign on similar goods/services or a similar sign on identical/similar goods/services **provided** there is a likelihood of confusion or association, or

- an identical/similar mark on **any** goods/services **provided** the registered mark has a reputation in the UK and the "infringing" use takes unfair advantage of or is detrimental to the distinctive character or repute of the registered mark.

The Court can order the removal of goods/services bearing the infringing mark from sale and order either a damages payment or an account of the infringer's profits. Innocence is no defence.

Law of "Passing off"

What is it?

Protects the goodwill/reputation attached to goods/services sold by a trader under or by reference to a brand name, trading "style" or "get up".

Ownership/Registration

Arises automatically through use in the course of trade (no need to register).

Duration

Lasts for so long as the goodwill/reputation subsists.

Rights and Remedies

Gives the owner the right to bring an action to prevent the "passing off". Passing off occurs where the owner has goodwill/reputation attached to the goods/services sold and can demonstrate that:

- the mark/style/"get up" is recognised by the public as distinctive of the owner's goods or services; and
- a misrepresentation has been made by the offending trader leading or likely to lead the public to believe that its goods or services are either those of, or are endorsed by or associated with, the owner; and
- it has suffered or is likely to suffer damage as a result.

The Court can order the removal of infringing goods/services from sale and order either a damages payment or an account of the infringer's profits. Innocence is no defence.

Patents

11

What are they?

Protect inventions consisting of products or processes **provided** that the invention:

- is new
- involves an inventive step **and**
- is capable of industrial application

To be considered "new" an invention must not form part of the "state of the art" (i.e. all matter which has, at any time before the "priority date" of the invention, been made available to the public). To contain an "inventive step" it must not be "obvious" to the relevant skilled person, having regard to the "state of the art" at the "priority date". (The "priority date" is normally the filing date of the application.)

Ownership/Registration

Registered following registration process. Owned by the applicant on registration, who will either be the inventor or the employer.

Duration

20 years provided renewed annually (after the 5th year).

Rights and Remedies

12

Give the owner a national monopoly to use the invention in exchange for disclosure of the invention (so that anyone can use it after the patent has expired). The Court can order the removal of infringing products/processes from the market and order either a damages payment or an account of the infringer's profits except where the infringer is "innocent".

This guide was published in March 2007 and is intended only as a general guide. It should not be relied upon as a substitute for taking advice in particular circumstances. Before acting on anything contained within this publication, please consult your usual Halliwells partner.

File: Halliwells 0501 03/07

www.haliwells.com

Haliwells LLP is a limited liability partnership registered in England and Wales under registered number OC307980 whose registered office is at St James's Court, Brown Street, Manchester M2 2JF

A list of members is available for inspection at the registered office. Any reference to a partner in relation to Haliwells LLP means a member of Haliwells LLP. Regulated by the Law Society

Haliwells LLP Tel: +44 (0)870 365 8000
St James's Court, Brown Street, Manchester M2 2JF
Fax: +44 (0)870 365 8001 DX 14317 Manchester 1

1 Threadneedle Street, London EC2R 8AY
Fax: +44 (0)870 365 8002 DX 98933 Cheapside 2
City Plaza, Pinfold Street, Sheffield S1 2GU
Fax: +44 (0)870 365 8003 DX 10525 Sheffield

The Plaza, 100 Old Hall Street, Liverpool L3 9TD
Fax: +44 (0)870 365 8004 DX 14126 Liverpool 1
info@haliwells.com www.haliwells.com

Haliwells



The Intellectual Property, Commerce & Technology (IPCT) department specialises in all aspects of intellectual property (IP) law and commercial and business support, ranging from IP litigation and licensing to IT contracts, commercial trading agreements and outsourcing.

For further information regarding the IPCT department and IP, commercial and information technology matters generally, please contact:

Jonathan Moakes
Partner, Head of IPCT Department
Direct Tel: +44 (0) 870 365 9300
jonathan.moakes@halliwells.com

Craig Chaplin
Partner
Direct Tel: +44 (0) 870 365 9312
craig.chaplin@halliwells.com

Copyright

What is it?

Protects:

- original literary, dramatic, musical or artistic works
- sound recordings, films or broadcasts
- typographical arrangements of published editions
- computer software (as literary works)

Protects the form of expression of ideas, not the ideas themselves, and protects design drawings but generally not 3D designs themselves.

Ownership/Registration

Arises automatically (no need to register). Generally owned by the "author" or employer. Rights in commissioned work are **not** automatically owned by the commissioner.

Duration

Life-time of the author plus 70 years for most types of works.

Rights and Remedies

Gives the owner the right to prevent unauthorised copying and unauthorised "dealing" in works. The Court can order the removal of infringing articles from sale and order either a damages payment or an account of the infringer's profits except where the infringer is "innocent".

Database Rights

What are they?

Protect original collections of independent works, data or other materials which are arranged systematically and are individually accessible by electronic or other means, provided there has been a substantial investment in obtaining, verifying or presenting the contents of the database.

Ownership/Registration

Arise automatically (no need to register). Owned by the "maker" of the database (i.e. the person who took the initiative and made the investment) or employer.

Duration

15 years from the end of the calendar year in which the database was completed.

Rights and Remedies

Give the owner the right to prevent unauthorised extraction or re-utilisation of all or a substantial part of the contents of the database and may also give the right to prevent the repeated and systematic extraction or re-utilisation of insubstantial parts. The Court can restrain the unauthorised dealing and order either a damages payment or an account of the infringer's profits except where the infringer is "innocent".

UK Unregistered Design Rights

What are they?

Protect original "designs", being any aspect of the shape or configuration of the whole or part of an article, but do not protect methods of construction, "must fit" or "must match" features or surface decoration.

Ownership/Registration

Arise automatically (no need to register) provided the design is recorded in a design document or an article is made to the design. Generally owned by the "designer" or employer. Rights in commissioned designs are automatically owned by the commissioner.

Duration

The lesser of 15 years from recording in a design document or making an article to the design and 10 years from first marketing.

Rights and Remedies

Gives the owner the right to prevent unauthorised copying and knowingly unauthorised "dealing" in articles. The Court can order the removal of infringing articles from sale and order either a damages payment or an account of the infringer's profits except where the infringer is "innocent". Compulsory licences are available during the last 5 years.

UK and EC Registered Design Rights

What are they?

Protect new designs with individual character except where the design is dictated solely by its technical function.

Ownership/Registration

Registered following a registration process. Owned by the commissioner (in respect of UK Registered Designs) or otherwise by the designer or employer. Applicants have a 12 month "grace period" from disclosure of a design in which to apply for registration.

Duration

Up to 25 years provided renewed every 5 years.

Rights and Remedies

Give the owner the right to prevent unauthorised copying and unauthorised "dealing" in articles made to the design and in articles that do not produce a different overall impression on an informed user. The Court can order the removal of infringing articles from sale and order either a damages payment or an account of the infringer's profits (except, in the case of UK registered designs, where the infringer is "innocent").

EC Unregistered Design Rights

What are they?

Protect new designs with individual character, except where the design is dictated solely by its technical function.

Ownership/Registration

Arise automatically on first marketing (no need to register). Owned by the designer or employer.

Duration

3 years from first marketing.

Rights and Remedies

Give the owner the right to prevent unauthorised copying and unauthorised "dealing" in articles made to the design and in articles that do not produce a different overall impression on an informed user. The Court can order the removal of infringing articles from sale and order either a damages payment or an account of the infringer's profits. Innocence is no defence.