Harper James Solicitors video transcript: Trade Marks Strategy

I’m Lindsay Gledhill and I’m an intellectual property solicitor at Harper James.

I’d like to talk about trade mark disputes and trade mark strategy and about how those two things are perhaps more closely connected than people might think. Our clients very often come to us saying, ‘I’ve got a trademark and I’ve discovered that somebody is trading under a name very similar to me.’ It might be in the UK. It might be elsewhere, in Europe or even further afield. They show us what the copier is doing and they compare this to their own branding on their website. That’s a great start. Even better, we’ll often find that in the very early days of their business our clients took the initiative and got their own brand name or logo registered at the Intellectual Property Office or the European Intellectual Property Office as a trade mark. That’s fantastic.

Sometimes we make a comparison between what the copier is doing and our client’s branding as shown on its website and the two are very close. When we look at the client’s trade mark registrations, the comparison can become more complicated. It’s not unusual to find that the logo the client registered in the early stages of its business has been amended and updated and so the registration is not exactly the form that they now use. Equally, sometimes the client wasn’t able to register their trading name when their business began because the registration was rejected as being too similar to the name of the goods and services they offer but, now that they’ve been trading for a good number of years, we may be able to help them overcome that objection from the Intellectual Property Office.

Interestingly, the discussion about a dispute can sometimes turn into a broader discussion about trade mark strategy and branding strategy. We’ll often end up with a to do list. It may be that what the most important thing to do is to get a new registration for an up to date logo or to get the main mark registered in a wider variety of classes or to get the main mark registered for the first time, since it may only recently have become distinctive enough through our client using it. All our clients have competing demands on their finances. We try to come up with a list of priorities and work through them with our clients. Sometimes our client who came to us with a dispute about a problem at the fringe of their business may decide that, in fact, what is more important is to update the trade mark protection that they have about the core of their business and only later to decide if it is still really necessary to take action against the infringer that they first spotted and so disputes about intellectual property can lead to a really positive and fruitful review of the intellectual property portfolio and whether we’re really protecting the heart of our business.