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# Myerson **Business**

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**Claimant's guide to trademark disputes**

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# Welcome

Copyright protects against the copying and unauthorised use of another's work. It is important to understand what rights you have when you create original work and how you can stop this from being exploited without your consent. Copyright disputes can happen due to numerous different reasons. However, the fundamental issue of copyright infringement is whether the work being disputed was protected and whether the new work is breaching any protection due to similarity.

## Why Myerson?

At Myerson, our expert trademark infringement solicitors are here to listen and help you and they have years of experience in dealing with trademark infringement cases. Trademark claims are often technical and complex and require specialist advice. We will outline all the potential options and strategies available. In many cases, the remedies for trademark claims involve a range of solutions, such as injunctions, damages, and costs.

We are proud to be ranked as '**Top Tier**' in the prestigious international directory **The Legal 500** and commended by The Times '**Best Law Firms 2023**'. So, you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex copyright issues.

Through our many years of service, we have developed close working relationships with trademark and patent attorneys and regularly liaise and work with them on a wide range of intellectual property issues such as trademarks and when disputes arise. These working relationships are a key and beneficial element of the service we offer to our clients. You can **find out more about our Intellectual Property Team by clicking here.**



# Trademark Disputes

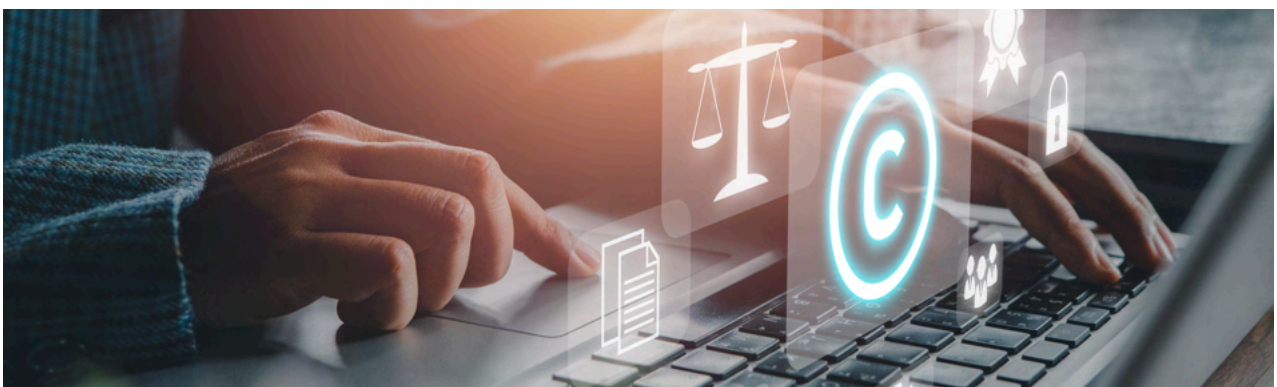
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## What are trademarks?

A trademark is a symbol, word or words used by a trader to distinguish its products or services from those of others. A trademark protects branding for businesses including product names, logos, acronyms, slogans, trading styles and even colours. Trademarks are a very valuable form of IP because they become associated with quality and consumer expectations in a product or service. It is therefore vital for businesses to identify, register and protect their trademark(s).

Trademark owners can apply for a Community trademark (CTM) or a UK trademark. A UK registered trademark is only enforceable in the UK, whereas a CTM is enforceable throughout the EU. Each type of registration lasts ten years and is renewable for further ten-year periods. It is also possible to register trademarks throughout the world, although it is advisable to initially register them in the countries where the goods or services are to be supplied.

To be registrable, a trademark must be distinctive, capable of being represented graphically, capable of distinguishing goods or services and not be excluded by statute. If you want to register a trademark, we always recommend seeking assistance from a trademark attorney who can help with the registration process.



# What is trademark infringement?

The law relating to the UK registered trademarks is contained primarily in the Trade Marks Act 1994 (TMA) which implemented the 2008 Trade Marks Directive and its successor the 2015 Trade Marks Directive. The law relating to CTMs is contained in the EUTM Regulations 2017.

The TMA and EUTM Regulations set out the various circumstances under which someone will be liable for trademark infringement.

These are when the infringer:

- Uses an identical sign on identical goods;
- Uses an identical sign on similar goods and there is a likelihood of confusion;
- Uses a similar sign-on identical or similar goods and there is a likelihood of confusion;
- Uses an identical or similar sign on any goods (identical, similar or dissimilar) and the registered mark has a reputation, and its use by the infringer is without cause and takes unfair advantage or is detrimental to the distinctive character or reputation of the registered trademark.

The infringer must have also used the infringing mark in the course of trade.





# What is the relationship between trademarks and passing off claims?

You can still protect your mark even if it is not a registered trademark. This is through the common law action of passing off. The underlying principle behind this action is that “a man is not to sell his goods under the pretence that they are the goods of another man”.

To succeed in a claim for passing off, a claimant must prove:

- Its goods or services have goodwill attached to them, i.e. they have a particular image and reputation attached to them which enable the public to easily recognise those particular goods or services;
- There has been a misrepresentation to the public (which does not have to be intentional) which would lead, or is likely to lead, the public into believing that the goods or services on offer are those belonging to the claimant; and
- There has been damage caused to the goodwill or reputation of the claimant.

The benchmark for establishing passing off is normally higher than for trademark infringement as the claimant must prove goodwill, misrepresentation and damage. In action for trademark infringement, if one of the prohibited acts set out above has been committed, the defendant is likely to be liable unless they successfully plead one of the statutory defences.

Commonly, if there is a registered trademark, claims are brought against the infringer for both trademark infringement and passing off. This is particularly so if there may be a challenge to the validity of the registered trademark.



# How to bring a breach of trademark claim?

## Specialist advisers

Breach of trademark claims can be extremely technical and complex meaning they are often dealt with by specialist courts in both England and Wales. For this reason, we always recommend that claimants in trademark infringement proceedings instruct specialist intellectual property solicitors. It is also quite common for a specialist intellectual property barrister to be instructed as well to represent claimants in court.

## Letters of claim

If infringement proceedings are contemplated, a claimant should first write a letter of claim to the potential defendant(s). This letter of claim should put the defendant(s) on notice of a claim and give the defendant(s) a reasonable amount of time (normally between 14 and 28 days but could be up to 3 months in complex cases) to respond to the claims made against them. The letter of claim must sufficiently identify the relevant trademark(s) to enable the defendant(s) to evaluate them and formulate a view on infringement. The best way to do this is to provide copies of the relevant trademark(s). All parties involved in trademark infringement claims are expected to act reasonably in exchanging information and evidence prior to court proceedings being issued.

## Court proceedings

If the claim cannot be resolved, then it is likely court proceedings will need to be issued. High-value claims for trademark infringement are brought in the High Court, specifically in the Intellectual Property List of the Business and Property Courts. Lower value claims are brought in the specialist Intellectual Property Enterprise Court (IPEC) where capped costs operate. IPEC also has its own small claims track which deals with trademark infringement cases which are worth less than £10,000.

Only the trademark owner or someone with an exclusive licence to use the trademark can bring infringement proceedings. If the trademark is jointly owned, any of the joint owners can issue a claim.



To issue court proceedings, specific court documents will need to be drafted. These are a claim form and particulars of claim. There will also be a court fee payable to issue court proceedings which depend on the value of the claim and the relief sought.

We always recommend that a barrister drafts these documents with assistance from a solicitor to ensure they comply with the court rules. These documents will identify the parties, state the cause(s) of action and the remedies sought. The defendant(s) will then be given an opportunity to file and serve a defence to the claim (normally within 28 days of the court proceedings being issued but extensions of time can be agreed).

After that, the Court is likely to order the parties to take the following steps to prepare the case for trial: disclosure of documents, witness statements and experts reports. It is our experience, however, that most trademark infringement cases settle without the need for there to be a trial

## **Remedies available for successful trademark infringement and passing off claims?**

There are several remedies available for claimants when a claim for trademark infringement and/or passing off is successful.

These are as follows:

- An interim injunction can be obtained before a full trial which prevents the defendant from continuing to “pass-off” their goods or services;
- A final injunction preventing the defendant from using the trademark without permission in the future;
- Delivery up and/or disposal of the infringing goods;
- Damages for loss of sales or damage to goodwill or an account of profits which means the defendant pays to the claimant a proportion of the profits it made as a result of the infringement; and
- Recovery of costs incurred in bringing the trademark infringement claim.



# You're in safe hands!

If you would like further information about how we can help you with **Trademark Disputes**, or if you have any questions, please don't hesitate to contact a member of our **Commercial Litigation Team** today.

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