



# Myerson Dispute Resolution

Defendant's guide to  
trademark disputes

0161 941 4000  
myerson.co.uk  
lawyers@myerson.co.uk



myerson

# Welcome

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. Due to this, claims relating to trademark infringement are becoming more commonplace as businesses seek to protect their trademarks.

## Why Myerson?

Our expert trademark infringement solicitors are here to listen, help you and have years of experience in dealing with trademark infringement cases. Trademark claims are often technical and complex and require specialist advice. In our discussions with you, we will outline all the potential options and strategies available to you if you find yourself defending a trademark infringement claim. Whatever the desired outcome, we will always make sure that you are confident and informed of the advice we are providing. Our award-winning legal team will stand by your side throughout the process.

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 2019**'. So, you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex trademark issues.

We are also a member of the Intellectual Property Lawyers Association (IPLA), which is an association of law firms with an established IP department. Our membership provides both our clients and us with access to a wealth of knowledge and expertise relating to intellectual property.

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 in relation to trademarks.

You can find out more about our [Intellectual Property Team](#) by clicking here.

# How We Work.

Every case is different, and we are here to support you every step of the way.

**Personal, Partner-Led Service.** Our experienced solicitors get to know you and your business inside out, so we can best advise you. We know that dealing with litigation can be stressful, and we aim to take that stress away from you. We strive to become your trusted advisers, providing value and most of all, a genuine, personal service.

**The Highest Level of Expertise.** Combining commerciality, practicality and legal expertise enables us to deal with trademark disputes in the most effective way.

**Trust. You are in safe hands.** We help clients nationwide with complex trademark cases, acting for businesses who are both bringing and defending trademark claims. You can rest assured that our expert team knows its stuff!



# Your Solicitors



## Tim Norman

Senior Partner  
Commercial Litigation

0161 941 4000

[tim.norman@myerson.co.uk](mailto:tim.norman@myerson.co.uk)



## Vicky Biggs

Senior Associate  
Commercial Litigation

0161 941 4000

[vicky.biggs@myerson.co.uk](mailto:vicky.biggs@myerson.co.uk)

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The solicitors that will be working with you are specialists.

All of the solicitors in our Intellectual Property Disputes Team are specialists and have a detailed understanding of trademark and how to handle business disputes involving trademarks.

Your matter will be handled discreetly and efficiently and overseen by Tim Norman, a Senior Partner in the Commercial Litigation Team.

Your team of solicitors will provide practical advice and work with you to deal with your trademark dispute in the best way possible. This means you can concentrate on what's important, running your business.

You can find out more about our [Intellectual Property Disputes Team](#) by clicking here.



# Trademark Disputes

## 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.

## The relationship between trademarks and passing off claims

Trademarks can still be enforced even if they have not been registered. 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”. Broadly speaking, passing off occurs when:

- A claimant’s 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 offered by the defendant belong 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 an action for trademark infringement, if one of the prohibited acts set out above has been committed, a defendant is likely to be liable unless they successfully plead one of the statutory defences.

Commonly, if there is a registered trademark, a claim is likely to be brought for both trademark infringement and passing off. This is particularly so if there are grounds for a defendant to challenge the validity of the registered trademark.

## Defences to a trademark infringement claim

There are defences to trademark infringement such as:

- Using another registered trademark;
- Use of own name or address;
- Use to indicate characteristics of goods or services;
- Use to indicate the intended purpose of goods or services;
- Honest concurrent use; and
- The claimant's trademark not being registered at the time of the defendant's infringement.

In addition, there may be further defences relating to exhaustion of rights in relation to goods put on the market in the EU.

The principle is that a trademark holder that has put goods for sale in the EU cannot then interfere with any subsequent commercialisation or re-sale of the goods in question.

Finally, Section 21 of the TMA and the Intellectual Property (Unjustified Threats) Act 2017 provide remedies against groundless threats of infringement proceedings.

These pieces of legislation are intended to protect secondary infringers, such as manufacturers or importers, from groundless threats made by trademark holders.

The legislation clarifies what can be sent in correspondence with alleged infringers and allow limited communications with secondary infringers. We would always recommend obtaining specialist legal advice as to what would and would not constitute groundless threats.



# How to avoid trademark infringement?

Prevention is always better than the cure as defending trademark infringement proceedings can be costly in terms of legal fees, potential damages and in lost management time.

If you are creating a sign or a brand, make sure that it is not already registered. A simple search on Google or the Intellectual Property Office (IPO) website may reveal that a sign is already registered. For a more sophisticated search, you should seek advice from a Trademark Attorney. We have excellent relationships with a number of Trademark Attorneys who we can refer you to if you need their advice.

Taking an assignment or licence of third-party marks, where possible, is an obvious way of avoiding trademark infringement. However, care should always be taken to make sure you do not go beyond the terms of the licence agreement. We would always suggest that a licence agreement is drafted by a specialist intellectual property solicitor.

Take steps to register your mark. The sooner, the better as this will not only protect your brand from other third parties but may also be a defence to any future trademark infringement claim (see above).

Trademark holders often take swift action against infringers, especially where they seek immediate injunctive relief which can be lost if there is a delay. A defendant will normally receive a strongly worded cease and desist letter which will likely insist on various undertakings being agreed in order to cure the infringement and avoid court proceedings being issued. If you do receive a cease and desist letter, do not ignore it. Specialist legal advice should be sought. There may be defences (see above) available which can head off a claim before it escalates.

## What happens if you breach trademark law?

There are a broad range of remedies available to a claimant if it is successful in proving trademark infringement. These include:



- An interim injunction can be obtained before a full trial which prevents defendant(s) from continuing the trademark infringement or from continuing to “pass-off” its goods or services.
- A final injunction preventing a defendant from using the relevant 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 the claimant a proportion of the profits it made as a result of the infringement.



# Don't just take our word for it...

*"Myerson Solicitors LLP has a really strong IP team which is growing."*

*"We have received excellent professional services from Myerson Solicitors to help resolve the dispute on the IPO on our former company name TechCleaners Limited. We ended up getting a better brand name <https://techdisinfect.co.uk>. They provided great advice and with their professional advice, we managed to resolve the dispute in no time with a great outcome overall. Myerson are highly recommended to anyone for their services on any legal matters".*

*"The Intellectual Property Disputes Team has a lot of experience of litigating unregistered IP rights. They are very strategic and extremely thorough. The team routinely advises on a broad range of disputes relating to trademarks, copyright, patents, confidential information, and data protection. They are also skilled at advising on design rights and reputation management issues and are regularly instructed by clients from the arts, media, textile, and clothing sectors in the UK and internationally. They are attracting work from a broad range of clients".*

*"The team has an excellent way of dealing with clients and managing cases generally, as well as good judgment – they know when to push, and when to take the victory".*

*"The team are phenomenally hard workers who produce first class written work, even from difficult clients".*

*"The firm has a huge range of satisfied clients from all over the country, despite not being the most high profile of firms, so they must be doing something right".*

To view more Myerson reviews visit our Review Solicitors page by [clicking here](#).

# You're in safe hands!

If you would like further information about how we can help you, or if you have any questions, please don't hesitate to contact a member of our Dispute Resolution Team today.

**Call: 0161 941 4000**

**Click: [myerson.co.uk](http://myerson.co.uk)**

**Email: [lawyers@myerson.co.uk](mailto:lawyers@myerson.co.uk)**



Because  
life is rarely  
**black and  
white.**



## Myerson Solicitors LLP

Grosvenor House, 20 Barrington Road, Altrincham WA14 1HB  
Tel: 0161 941 4000 | Fax: 0161 941 4411 | DX19865 Altrincham  
[lawyers@myerson.co.uk](mailto:lawyers@myerson.co.uk) | [www.myerson.co.uk](http://www.myerson.co.uk) | [@myersonllp](https://twitter.com/myersonllp)

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