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# Myerson **Business**

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**Defendant's guide to trademark disputes**

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# 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 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.

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.



# 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.

## 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.



Generally, if a registered trademark is involved, 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 the defendant(s) from continuing to infringe on the trademark 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.



# 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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