

Trade Mark 'Use' Requirements





Introduction

The purpose of a trade mark registration is to protect marks that are either a) in use; b) intended to be used; or c) are not being used, but with a valid reason.

Where a registered trade mark is not in use, there are common situations that arise where lack of use might impact on a) the validity of that mark; and/or b) the ability to enforce that trade mark.

Can an application be made for a mark not yet in use?

Many brand owners want to protect a new mark before it is used for the following reasons: a) to prevent situations where third parties seeing that a brand has just been launched then try to hijack the mark by applying for it first as a trade mark or domain name and b) to enable the brand owner to have a registered mark in place at the time of launch so that it can rely on it for infringement purposes. Trade mark laws accommodate these reasonable commercial desires by allowing applications to be filed before use is commenced.

Does a trade mark applicant need to have a genuine intention to use a mark at the time of filing?

Certain territories, and the UK is one, require that an applicant has a genuine intention to use a trade mark at the date of filing an application. This does not extend as far as meaning that there is a present intention to actually use for all goods and services contained within the specification, but that there is a reasonable commercial expectation of potential expansion into those goods/services.

Does a trade mark need to be used before it is allowed to proceed to registration?

For the UK, EU and most territories this is not required. However, certain territories depending on the basis of the application (e.g. US and Canada) whilst allowing applications to be made for unused marks, will not actually permit the application to mature into a registration until use can be demonstrated.

What happens if a registration is never used, or its use ceases?

Where a trade mark has not been used for a continuous period (5 years in the UK and many others) then it is at risk of a third party applying to cancel the registration on the grounds of non-use, unless there are valid reasons for non-use.

This risk typically materialises where a trade mark

owner is relying on a registration in proceedings against a third party who then responds by trying to cancel the mark relied on.

It also occurs where a third party wants to register a same/similar trade mark and realises that the trade mark is a threat to their use/registration. A revocation action is then brought against the unused registration to remove it as a threat.

Is use required to renew a registration?

For the UK, EU and most territories this is not required. However, certain territories, (e.g. USA, Mexico, Philippines) do require that evidence of use must be submitted with the renewal request otherwise it will be rejected and the registration will be lost.

What is 'Evergreening'?

This is the practice of applying for a trade mark, often where there is no real intention to use the mark, but where the applicant wants to block others from registering it. Once the fifth anniversary of its registration approaches (and therefore becomes vulnerable to cancellation on the grounds of non-use), the owner then files a further application for the same mark thereby creating a new 5 year period where it will not need to demonstrate use of its mark.

This practice is contrary to the spirit of trade mark principles and many IP offices (such as the EUIPO) take a dim view of this practice. That stated, it is routinely encountered in many jurisdictions.

Can use assist in persuading an IP office to accept an application?

IP offices will commonly reject applications if they consider them descriptive or otherwise non-distinctive. However in many jurisdictions even though a trade mark might at first sight appear descriptive/non-distinctive, it may be possible to overcome that objection by demonstrating that notwithstanding its descriptive nature, it has been used for such a long time (generally 5+ years) and is so closely associated with the applicant by the relevant public that the mark has acquired distinctiveness through use.



What if use can only be shown for some of the goods/services covered by the registration?

If use cannot be demonstrated in respect of all the goods/services covered by the registration, then the unused goods/services are at risk of being vulnerable.

Relevant dates of use

This is an important point and one that is often overlooked leading to considerable wasted time and costs through the collation of irrelevant evidence, or compromising a mark by failing to submit relevant evidence.

You will be advised of the appropriate dates at the relevant time of the precise period, but broadly stated:

'Use' for proving acquired distinctiveness needs to have taken place prior to the application date for the trade mark.

'Use' to defend a mark that is subject to a cancellation action. This use needs to have taken place within in the 5 years prior to the date of the application to cancel the mark.

How much use is required?

This depends on the purpose for which the use is being demonstrated. If being used to evidence 'acquired distinctiveness' then this needs to be substantial and thorough as it is being used to try and reverse the IP office's initial opinion that the mark should not be registered. Where is it is being used to demonstrate that the mark has been used in the last 5 years then this is less stringent and can be supported by evidence of modest usage/sales.

This highlights the importance of ensuring that a trade mark owner of not only using its mark for the goods and services for which it is registered, but also of keeping records of such use to defend potential revocation actions or proof of use requests.

What evidence is required to prove use?

The table below provides a brief overview of the types of evidence that should be provided in

order to satisfy proof of genuine use of a mark or to support a claim for acquired distinctiveness through use:

<u>Date and proof of first use of the mark in each of the relevant countries</u>	This can include: <ul style="list-style-type: none"> a. Annual Reports b. Invoices c. Extracts from the internet d. Advertisements e. Flyers f. Reports g. Press articles h. Business correspondence
<u>Geographic spread of the mark</u>	Show the mark has been used in the relevant period for the relevant goods and services throughout the countries of interest, which can include evidence shown in a) to h) above. Ideally, the evidence will show use in the various regions of a country i.e. not just Paris for France if providing evidence for France. The evidence must bear the mark and be dated.
Intensity of Use within the Relevant Period	Providing sales figures and units for the goods and services, broken down per year and by country will be useful within the evidence bundle. For services, you can include the number of website hits from the countries of interest to show views and purchases online.
Advertising and advertising spend	Good examples include: <ul style="list-style-type: none"> ➤ Invoices to third parties in relation to the relevant goods and services showing the date, address of third party and which has a reference to the mark ➤ Advertisements in magazines, publications, supermarket handouts, brochures, TV/radio and social media, and preferably including how many times the advert took place and when.
Market share in the countries of interest	This can be evidence of the proprietor's presence in the production/distribution of the mark in the relevant industry. This could be in the form of a report from an industry-specific magazine, periodical or press article and must show a date which is within the relevant period.

Genuine reasons for non-use

When a mark has not been used, then this might be permissible if there is an acceptable reason for non-use. In the UK and EU these include scenarios such as the inability to put a pharmaceutical produce on sale until the requisite governmental licences are in place. Commercial constraints, such as a lack of funding to launch a new brand would be unlikely to be considered sufficient justification.

For further information on this subject please contact:

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