CHAPTER 3

How to Protect Trademarks

'I have very little notion of what the section intended to convey and particularly the sentence of 253 words which constitutes sub-section (1). I doubt if the entire statute book can be successfully researched for a sentence of equal length which is of more fuliginous obscurity.' (Lord McKinnon on the old Section 4 (1) (b) of the Trade Marks Act 1938, since amended and greatly improved!)

What Can Be Registered?

Trademark registration and legislation in the European Union has become more harmonized. The UK Trade Marks Act, which became law on 31 October 1994, is based upon the Community Trade Mark Directive which has been adopted by most of the other European Union members. Up to that point there was a significant difference in approach by European countries as to what could be registered as a trademark. In the UK the definition of a mark has been widened as a result of the new Act:

- In addition to distinctive words and designs it will now be possible to register distinctive container shapes; the distinctive shapes of the goods themselves; colours; sounds and smells as trademarks. (These are discussed in detail below.)
- It appears to be generally accepted that the distinctiveness threshold previously applied as a prerequisite to registration will be lower under the new law. This means that it will be easier to register packaging/label designs than was previously the case.
- Although under the old law it was possible to register a truly distinctive label design, it was not always easy. This was reflected in the fact that very few designs/labels had been registered and therefore the issue of trademark infringement had generally not arisen with regard to them.

This contrasts with the Benelux countries and France which traditionally had a wide definition of what could be registered as a trademark, and as a result packaging designs and labels often enjoyed the benefit of registration.
Trademark Registration – What is Now Included

Europe: Anything represented graphically and capable of distinguishing goods/services.

- words
- designs
- letters
- numbers
- shapes
- packaging
- colours
- sounds
- smells

USA: Any word, name, symbol or device used to identify and distinguish goods. Specifically includes get-up protection which can be registered or protected as an unregistered trademark under Section 43(a) Lanham Act.

Strong versus Weak Marks

Strong marks, which can easily be protected by way of registration, usually consist of invented words (such as Kodak, Exxon), words which have no direct meaning in relation to the goods or services (for example, Lotus for cars or Enigma for lager) or distinctive device marks such as the Black Horse logo for Lloyds Bank. By contrast weak marks often consist of words which directly refer to the character or quality of the goods, laudatory epithets, slogans, geographic names or surnames. In the past, marks which have been refused protection by way of registration include Mild for cigarettes, Have A Break for chocolate biscuits and York for trailers. Such marks are difficult to protect, especially by means of registration, because they are words other traders may wish to use when describing their goods or services. For a mark to be registrable it must be capable of distinguishing one particular trader’s goods or services from those of his or her competitors.

However, under the Trade Marks Act 1994, many of these weaker marks may now be capable of registration if they have become distinctive through use. Prior to this laudatory epithets, such as Perfection, or well-known geographical place names, such as York, could never have been registered regardless of the extent of use because they were not regarded as distinctive in law.

The new Act also enables sounds and smells to be registered as trademarks, provided they can be represented graphically. Examples of sound marks are MGM’s Lion’s Roar for films and Direct Line Insurance’s (maddening) jingle for insurance services, which are distinctive and should be capable of registration. Smells, however, are not very distinctive as trademarks, particularly for goods such as perfumes, as they are characteristic of the goods themselves and, as such, would be excluded from registration.