

and even scents and sounds have been registered as trade marks. (The smell of fresh cut grass was registered in Europe as a trade mark for tennis balls, but this is very unusual.) Trade marks capture the essence of brands and the energy, investment and know-how that goes into them. They play a very important role in the marketing of chocolate products and are often fought over. There have been well-publicised disputes in the UK between Cadbury (owned by Mondelez International), who opposed Nestlé's trade mark application for the three dimensional shape of the KIT KAT® chocolate wafer product, and Nestlé, who opposed Cadbury's application for a particular shade of purple as a trade mark for chocolate.

If you are thinking up a word to use as a trade mark for a new product, the strongest protection is obtained from fanciful, invented words with no previous connection with that type of product. The SNICKERS® confectionery bar is believed to have been named after one of the Mars family's favourite horses. Your trade mark cannot be a sign that merely describes the goods that you offer. For example, the word *Dark* could not be a trade mark for a new dark chocolate product as it is descriptive. In between these two extremes there is a range of possibilities, decreasing in level of protection as the words become less arbitrary and more descriptive. The same applies for other signs such as shapes. The shape of a strawberry is unlikely to be accepted as a trade mark for a strawberry-flavoured product, although it might be an acceptable trade mark for hair care products. Trade marks are registered for a specific class of goods. A three-dimensional trademark is not allowed to be a shape required to obtain a technical result as this would give protection which goes beyond simply indicating the origin of the product. Other intellectual property rights such as patents are available for protecting technical aspects of products.

There are a number of other restrictions on what can be used as a trade mark. Trade marks cannot be misleading, for example *sugar sweet* would not be allowed for a chocolate sweetened with artificial sweetener and they cannot designate the place of origin or mislead the public about the place of origin. There are also marks which are prohibited. You must not register a trade mark which resembles certain official emblems such as the symbol of the Olympic Rings and trade marks should not include profane language or include obscene visuals.

After selecting a trade mark it is important to search to see if anyone else has the same or a similar trade mark. Trade Mark agents can assist with this, but it is possible to search the trade marks register yourself and this may be a good starting point. However, it is advisable to pay for a professional search before filing an application as the fee is not refunded if the application is refused. If the trade mark is to be used internationally, it is also good idea to check that the word does not have unintended or vulgar meanings in other languages.

In a few countries the legal rights to a trade mark are established simply by using it. However, it is generally advisable to register your trade mark as it

makes it easier to enforce your rights, and in many countries this is essential. Like patents, trade marks are territorial rights and so need to be established in individual countries. There is no such thing as an international trade mark, but as with patents there is a system to simplify the registration of a trade mark in multiple countries. This is known as the Madrid system. Once you have filed an application to register a trade mark in your own country you apply for an International Trade Mark to be registered with the World Intellectual Property Organisation (WIPO). You specify the countries where you want trade mark rights (who must be members of the Madrid Union) and the application is equivalent to applying in each of the countries individually. Within the European Union there are both national trade marks and EU trade marks. EU trade marks cover all the member countries of the EU.

Details of the registration process vary, but generally the trade mark office will check that the trade mark complies with the rules and has the required distinctive character. However, even if a trade mark lacks distinctive character it may still be possible to register it if you can prove that the public exclusively associates the mark with your product. This is called *acquired distinctiveness* (or *secondary meaning* in the USA) and typically applies to well-established products.

29.3.1 Maintaining trade mark rights

Trade mark rights may be lost over time if the trade mark is not used. For example, in the UK a person can apply to have your trade mark removed from the register if it has not been used for a period of five years. The registration of a trade mark must be renewed, for example a EU trade mark must be renewed every 10 years with payment of a fee.

Incorrect use of trade marks can lead to a loss of protection if they start to become a generic description. The word *margarine* was originally a trade name, but now it is a generic term for a wide range of butter substitutes. Trade marks are adjectives which should be followed by a noun – for example a box of FERRERO ROCHER® *chocolates*. Companies should use their trade marks correctly and also insist on other people doing the same. In order to prevent a trade mark becoming generic, the owners of the trade mark often contact publications that appear to be using the trade mark incorrectly and ask them to use the trade mark properly. It can seem petty, but legally it is important for the trade mark holder to show that they are attempting to prevent the mark becoming the generic term for the product.

It is advisable to use trade marks consistently and be cautious of making changes such as altering the typeface; this helps to emphasise that the term is a trade mark and not just another word. One way of identifying that a word is being used in a trademark sense is to use the symbol TM after it. If the trade mark is registered, then you can use RTM or ®. In some countries it is an offence to use the RTM or ® symbol for an unregistered trade mark.