

Asserting your IP rights

Asserting intellectual property rights does not necessarily entail going to court. There are other more cost effective ways of enforcing such rights, or knocking out those of competitors

Sofia Arenal, a trade mark partner at Mewburn Ellis LLP.

Procedures before Trade Mark Offices, otherwise known as oppositions or cancellation actions, provide a means of attacking someone else's trade mark either before or after registration, without the expense of litigation. "These procedures are much less expensive than equivalent court proceedings, and often achieve a commercially valuable result" says Arenal.

She continues: "However, that's not to say that oppositions bar you from going to court, as was recently confirmed at the Court of Appeal in the Special Effects case."

Preserving your monopoly

Whilst applications are often monitored by competitors to gain an indication of competing business strategies, they should also be monitored by owners to ensure that intellectual

property rights (IPRs) are not encroached upon. She adds: "If a particular field becomes crowded, it becomes harder to stop others joining the crowd, which may result in the loss of competitive advantage."

If a trade mark application is filed which is too similar to a previous mark, an objection may be made, in the form of an opposition, to protect the earlier right. Evidence may be filed and a decision will either be taken on the basis of the papers, or following a hearing, where both sides have the chance to argue their case orally. She continued: "It goes without saying that a thorough knowledge of the case and careful preparation of the evidence can be crucial to a successful outcome."

A "cooling off period" occurs fairly early in the trade mark opposition process, which allows the parties time



to negotiate. This can be very valuable, and negotiated settlements are achieved in a fair proportion of cases. "Filing an opposition can be a good way of applying pressure on another company to come to the negotiating table and settlements usually cover what can do what, in terms not only of trade mark registration, but also what will happen in the market," comments Arenal.

Attack as a form of defence

Where a rival company has a trade mark, patent or design registration which stands in the way of a proposed new product launch, it is important to avoid infringement. "Clearly you do not wish to be on the receiving end of enforcement proceedings. So, in order to avoid this, it may well be possible to limit the earlier right by attacking it, and/or obtain a licence or negotiated concession from the earlier right owner that they will not sue you, or that you can go ahead in a particular sphere, provided you keep out of another. There may be competition law issues involved, but your legal team can advise on this" she adds.

Arenal concludes: "In essence, in order to enforce your IP rights, you need to nurture them and use them effectively in the marketplace. Like any business tool, IP rights need to be kept sharp."

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