

# Trade Mark and Domain Name Watch Services





## Introduction

There is a temptation for trade mark owners to breathe a sigh of relief as they eventually file their trade mark applications. It is often the culmination of months of work searching for any prior rights and perhaps investigating, negotiating, cancelling or acquiring such rights. It is an end, but only to the beginning of a brand's lifecycle. Once the application is filed, this is when the brand protection programme begins in earnest.

## Protection

A trade mark "watch" is a service that monitors the trade mark registers in a particular country, region or even globally and sends a notification whenever a trade mark application is filed that is identical or similar to the word, image, logo or design that is the subject of the watch.

The principal use of a watching service is to alert brand proprietors to the fact that a third party may be trying (consciously or not) to register a trade mark that is identical or similar to that of the proprietor. This advance notification then gives the proprietor an opportunity to warn the business concerned that they may be engaged in potentially infringing activities and, if necessary, to file an opposition against their trade mark application in order to prevent it from achieving registration. It is often far easier to resolve disputes at this early stage rather than at a later stage when the third party may have put more spend behind their mark or have actually launched it in the marketplace (in which case exit costs may be substantially higher).

If a third party manages to successfully register a similar trade mark then this may not only give them a defence to any infringement claim, but it could correspondingly narrow the scope of the proprietor's rights. It is vital that the brand owner protects the exclusive rights associated with the trade mark to prevent others from using and/or registering confusingly similar marks.

The possible consequences of failing to take appropriate action include customers mistakenly purchasing competitors' goods or services and the dilution of the brand's integrity and value.

## Prevention

Watching services are available for more than just trade marks; it is also possible to set up watches against company names, domain names and certain registered designs.

The rationale for watching company names and domain names is that the advance notice watching provides is a key tool in preventing, or swiftly stopping, commercial evils such as fraud, misrepresentation and passing off.

A watching service on a company name may provide you with early notice that a third party has sought to register a similar company name, but before trading under that name has commenced. Action can then be taken to prevent or modify the registration as appropriate before any commercial harm is inflicted.

It is an unfortunate fact that many businesses are poorly informed about the role of a company name registration and the rights it confers. Some assume that it is similar to a trade mark registration and that merely having registered a particular company name:

- prevents others from trading using that name;
- prevents others from registering similar names; and
- actually gives them the absolute right to use that name.

The reality is that third parties can register very similar names, simply by adding dates, numbers or descriptions. Owning a company name does not give that company any specific rights to use that name commercially, as any use is still subject to existing registered trade marks, other common law rights and any other laws governing designations of origin etc..

Similarly, owners of domain names sometimes presume that mere ownership empowers them to freely use the domain name but, as with company names, this is not the case. Businesses frequently run into difficulties because third parties, sometimes criminals, deliberately register similar domain names in the same country or an identical domain in another country, with the express intention of persuading businesses to part with money or to extort money in return for transferring the name. There are of course various dispute resolution procedures whereby wrongfully registered domain names can be acquired by a rightful owner, however these procedures take time, money and can attract unwanted PR attention.

It may come as a surprise to many businesses in common law countries (including UK, Eire, US, Canada, Australia and New Zealand) to learn that in certain territories the first business to acquire a trade mark can acquire the exclusive rights to that mark in that territory, notwithstanding the fact that a different business may have already developed a reputation in that market.

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