

# ENFORCING A TRADE MARK: THE BASIC PROCESS



**POTENTIAL INFRINGEMENT**

S.10(2) TRADE MARKS ACT 1994

**IS THERE AN UNAUTHORISED USE**

of an identical or similar mark (irrespective of whether or not the goods/services are similar) where the earlier registered mark has a reputation and where use of the mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the earlier registration?

YES

NO

**POTENTIAL INFRINGEMENT**

S.10(3) TRADE MARKS ACT 1994

**POTENTIAL REMEDIES INCLUDE:**

- Damages or an account of profits
- An order for erasure, delivery up or destruction of infringing goods
- An injunction to restrain future acts of infringement
- Dissemination and publication of judgment
- A contribution to legal costs.

**IF YOU STILL WISH  
TO TAKE ACTION  
CONSIDER**

## COULD THE INFRINGER HAVE A POTENTIAL DEFENCE?

- Use of own registered trade mark for goods/services for which the mark is registered
- Use of own name and address (subject to conditions)
- Use of signs or indications which are not distinctive or which concern the characteristics of goods/services (subject to conditions)
- Use is for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where that use is necessary to indicate the intended purpose of a product or service—in particular, accessories or spare parts (subject to conditions)
- Infringer has an earlier right in the mark in a particular locality

YES

IF YOU STILL WISH  
TO TAKE ACTION

CAREFULLY CONSIDER

NO

IF YOU STILL WISH  
TO TAKE ACTION

CONSIDER

## ENFORCEMENT: FIRST STEPS

Consider, as may be appropriate:

- Letter before Action to the infringer
- Notification to third parties
- Application for Injunctive Relief

**HOWEVER BEFORE TAKING ANY ACTION:  
WE RECOMMEND YOU OBTAIN LEGAL ADVICE FROM A  
SOLICITOR SPECIALISING IN INTELLECTUAL PROPERTY LAW**

If you wish to discuss enforcing trade mark rights further, please contact our Head of Intellectual Property  
**Will Charlesworth**  
[will.charlesworth@saunders.co.uk](mailto:will.charlesworth@saunders.co.uk)