

Enforcing rights in unregistered trade marks

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**CHAMPIONS
OF INNOVATION.**

The owner of an unregistered trade mark may bring legal action against a competitor using that mark under the common law action of passing off or under the Fair Trading Act. In both cases, to enforce rights in an unregistered trade mark the owner must prove to the satisfaction of the Court that:

1. It has reputation in the disputed mark in the particular geographic locality in which the breach of rights occurred;
2. This reputation applies to the particular type of goods or services in which the alleged breach of rights occurred;
3. The unauthorised use of the unregistered trade mark will (or is likely to) cause confusion amongst its customers;
4. That confusion will cause actual loss to its business or a strong likelihood of same; and
5. The other party has no legitimate right of its own to use the disputed mark.

Compared to an action for breach of a registered trade mark these Court proceedings can be costly and uncertain, as they are often reliant on the Court's interpretation of the evidence.

Enforcing the rights conferred by a registered trade mark is simpler, more certain and often less expensive to achieve.