

TRADEMARKS & THE TOBACCO ADVERTISING BAN IN THE UK

In January 2003 we reported that the UK government had passed legislation (The Tobacco Advertising and Promotion Act 2002) which generally prohibits tobacco advertising in the UK. This new law does not just affect trademarks for “*tobacco products*”.

The Regulations for implementing the legislation come into force on 31 July 2005.

According to these Regulations, any new “*non-tobacco*” product or service cannot use a “*name, emblem or other feature*” which is the same as, or similar to, any *name, emblem or other feature* connected with a tobacco product, where the “*purpose*” (which can be one of a number of purposes) of such use is to promote a tobacco product, or whose “*effect*” is to do so.

The same applies to the use of a *name, emblem or other feature* for a “*tobacco*” product, which is the same as, or similar to, a *name, emblem or other feature* which is connected with a non-tobacco product or service.

Essentially the UK government believes that there should be a general prohibition on the use of “*shared*” brands for tobacco and non-tobacco products. However, in general terms, this prohibition of “*brandsharing*” will only apply where the “*purpose or effect*” of such use is “*to promote a tobacco product*”.

It is anticipated that the UK Trade Marks Registry will amend its examination procedures to take account of these Regulations.

There are only very limited exceptions to this general rule. For example, a *name, emblem or other feature* already in use for a non-tobacco product or service can continue to be used, even though it may be the same as, or similar to, an existing tobacco product’s *name, emblem or other feature*, provided (a) the use of the *name, emblem or other feature* in question pre-dates the first use of the tobacco product’s *name, emblem or other feature*, and, (b) where there is no intention of promoting a tobacco product. This first use of the non-tobacco product or service *name, emblem or other feature*, also had to have commenced before 1 September 2002. Such first use after this date will not fall within this exception.

Local Weights and Measures Authorities across the UK have a duty to take proceedings against those found to be in breach of these Regulations. Penalties include fines and/or imprisonment.

Recommendations

For an existing non-tobacco product or service *name, emblem or other feature* (namely, one first used prior to 1 September 2002), clients will need (a) to check that it is not the same as, or similar to, an existing tobacco product's *name, emblem or other feature* and, if it is, (b) to check that it is not used with the intention of promoting a tobacco product.

For any future non-tobacco product or service *name, emblem or other feature* (or one first used after 1 September 2002) clients should be aware that it can only be the same as, or similar to, an existing tobacco product's *name, emblem or other feature*, if its use will not "*promote a tobacco product, or have the effect of doing so*". Clients will, therefore, need to take steps to ensure that their "*branding*" of such a non-tobacco product or service is sufficiently distinctive of the tobacco product's branding. Changes to packaging, advertising, general presentation of the brand, or even the trademark itself, may be necessary.

For our part, we will continue to extend any UK registered trademark clearance searches we undertake for new non-tobacco product trademarks, to the tobacco products' class (Class 34). However, for new tobacco product trademarks, although we will continue to extend these clearance searches to cover the identical trademark in all other product and service classes, we obviously cannot automatically extend such searches to look for confusingly similar trademarks in all of these other classes.

Of course the legislation, and Regulations, relate to *names, emblems or other features* which are "*used*", as opposed simply to being *registered*. Clients should therefore be aware that a problem could arise if a non-tobacco product or service *name, emblem or other feature* is adopted which is the same as, or similar to, an unregistered tobacco product *names, emblems or other feature* which is being used – and vice versa. Relevant "*in-use*" searches should therefore be considered.

If you require any further information on this, please contact Ian Buchan, Sanjay Kapur or John Peacock in our Nottingham office.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

© Eric Potter Clarkson 2005

N:0102/cld/jp/iab/sk/lc

22 June 2005

Park View House · 58 The Ropewalk · Nottingham · NG1 5DD · UK

Tel: +44 (0)115 955 2211

Fax: +44 (0)115 955 2201

E-mail: epc@eric-potter.com

Website: www.eric-potter.com