

## TRADEMARKS AND THE TOBACCO ADVERTISING BAN IN THE UK

The UK government has now passed legislation (The Tobacco Advertising and Promotion Act 2002) which will generally prohibit tobacco advertising in the UK. This new law affects trademarks for other products, as well as “*tobacco products*”.

According to the draft Regulations for implementing the legislation, any new “*non-tobacco*” product or service **cannot** use “*a name, emblem or other feature*” (brand) which is the same as, or similar to, any brand 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 brand for a tobacco product, which is the same as, or similar to, a brand 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, this prohibition of “*brandsharing*” will only apply where the “*purpose or effect*” of such use is “*to promote a tobacco product*”.

There are only very limited exceptions to this general rule. For example, a brand 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 brand, provided that the use of the brand in question pre-dates the first use of the tobacco product’s brand, **and** where there is no intention of promoting a tobacco product. This first use of the non-tobacco product or service brand has 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 brand (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 brand, 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 brand (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 brand, if the use of the brand 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 distinct from the tobacco product's brand. 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 Trade Marks Register clearance searches we undertake for new non-tobacco product trademarks, to the tobacco products' class (Class 34). However, for new tobacco product trademarks, while 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 draft Regulations, relate to brands which are "*used*", as opposed to being simply registered. Clients should therefore be aware that a problem could arise if a non-tobacco product or service brand is adopted which is the same as, or similar to, an unregistered tobacco product brand which is being used – and vice versa. Relevant "*in-use*" searches should therefore be considered.

***Footnote:***

The UK government has expressed the intention of introducing these Regulations in early 2003. A transitional period of 18 months is envisaged commencing from the Regulations being finally approved. The Regulations are, therefore, likely to come into force in the first half of 2005.

Clients are therefore advised to start looking into this matter now.

If you require any further information on this, please contact Ian Buchan, David Minto, 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](http://www.eric-potter.com).

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