

# An agency guide to trade mark searching



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## Introduction

Whenever a new launch is proposed, whether it is for a product, brand, business name or an advertising campaign, there is always a risk that someone else is already using an identical or a similar name or design. If so, then that party may be entitled to obtain an immediate injunction from the court to prevent the launch and obtain damages for trade mark, design right or copyright infringement and/or passing off.

It is for this reason that most well advised businesses will undertake a comprehensive search programme prior to adopting a new name or design in order to minimise exposure to such risks. The financial consequences of a failed launch, together with the attendant PR damage and loss of management time, must not be underestimated.

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## Trade mark searching

Searching is an area that requires considerable skill and experience to ensure that appropriate searches are conducted and at the required level of complexity. Because searching can be an expensive and sometimes uncertain business, the aim of this guide is to illustrate the variety of searches that are available together with their benefits and limitations.

Searching is about risk management. It is about doing what is necessary to keep your clients product selling. It is ensuring that a competitor or some other third party cannot force your client to pull their advertising or even their branding.

By using an appropriate level of expertise the aim of the search is to highlight the legal risks to the use of a name, the client's chances of success in registering it as a trade mark and the degree of exclusivity they will enjoy.

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## First steps

Sometimes there will be a part of the name creation process where inspiration needs to be drawn from the existing trade mark registers, or from the bank of trade marks owned by a particular competitor. Lewis Silkin are able to provide listings of all trade marks featuring a particular word or character string in all classes, or alternatively all trade marks owned by a particular company. Prices for this service vary according to whether both printed and electronic results are required and how much information is to be included.

Sometimes a number of names will be created for a project. As the cost of fully searching each variant is prohibitive, we can offer 'Screening Searches'. These searches are the only searches which can be run on any level from country, to region to even worldwide. The purpose of these searches is to identify which trade marks are good candidates to take forward. The reason for this is that these searches have a number of significant limitations:-

1. No trade marks shown before 1976
2. Only publication details, (trade mark may be alive or dead)
3. Limited phonetic variations / substitution.

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## I want a worldwide search! But do I need it?

It is very easy to get carried away with searching. From experience there are very, very few companies which conduct exacting searches in every country of the world.

### Why not you may ask?

The cost of full searches in every country of the world would be prohibitive at around £1,000 per country for just over 200 countries...

Most responsible companies identify which countries are their key markets. In other words if they can for example obtain the trade mark in the United States, Canada, Europe and Japan, then they may be prepared to put up with the possibility of not getting the trade mark in say Afghanistan or Zimbabwe.

This is a reality of global branding in that inevitably there will be some countries of the world where obtaining the trade mark ranges from extremely difficult to impossible.

If however a client has zero tolerance for risk then they'll just have to bear the cost of the searches in order to gain the requisite level of comfort. However, please remember that because trade mark clearance involves the comparison of words, across different languages, dialects and pronunciations, sometimes there cannot be a definitive answer.

Where it is a matter of opinion, Lewis Silkin will always try to provide a realistic assessment of the risks involved and if necessary get specific advice from foreign associates where necessary.

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## What variables should be considered?

### The trade mark and its context:

The first questions to establish are whether the trade mark is going to be used to designate a new company, corporate name or a re-branding; or whether the trade mark is a new brand, a sub brand and whether it appears on the actual product as well as the packaging and advertising.

The reasons why these questions are asked are that wherever you are in the world there are



largely always two sources of rights. There are the Trade Mark Registers, which give their owners the rights to prevent third parties from using the same or confusingly similar trade marks.

Then in the UK, and also Ireland and the United States amongst others, there are rights attached to the use of trade marks and company names. These are called 'Common Law' rights. Whilst Continental Europe does not recognise the notion of 'Common Law' they do have a broadly parallel right, namely acts covering Unfair Competition.

These two sources of rights require distinctly different types of searches. The higher the number of types of searches you require, then the higher the cost... It would be very easy to spend large sums of money on searching but without necessarily achieving the desired effect.

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## What we will look at now is the information required to ensure that the appropriate searches are conducted with an appropriate degree of thoroughness.

**Trade mark:** The first variable is the name, design or stylised word itself. Is the search intended to locate a specific registration only, or is to look for any trade marks that might be regarded as similar or having a phonetic variation?

Where a trade mark consists of a number of words, what you are looking for are the dominant and distinctive elements of the trade mark.

**Similarity:** What the search aims to do is to locate not only identical, but also 'confusingly similar' trade marks. The notion of confusingly similar trade marks is exactly that, namely any trade marks that members of the public may (for different specific reasons) find confusingly similar.

One of the factors affecting the assessment of similarity is how well the existing trade mark is known, generally speaking the more well known a trade mark is, the greater the likelihood that members of the public will be confused by a similar trade mark.

**Classes:** All goods and services are subdivided for trade mark purposes into 45 "classes". Should the search focus only on identical goods and services in the same class of interest, or should the search extend to similar goods and services in different

classes? This is of particular importance where a class has been changed; for example "Restaurant services", for many years in Class 42 but now Class 43.

**Territory:** In which countries is the trade mark to be used in? Trade marks and design rights are territorial in nature and each country has its own register. Our UK searches will as a matter of course cover the European Community, and also the International Registers (insofar as these "IRs" apply to the UK). It is often overlooked that many UK companies also sell products in Ireland.

**Costs:** The level of complexity of the search needs to be considered as this will impact on fees and disbursements. Broadly speaking, screening and identical searches are the cheapest and the fastest as they can both be conducted on-line. Full availability searches are the most expensive and have a standard five day turnaround. These are dealt with in more detail at the end of the report.

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## What types of searches are available?

### Screening searches

Screening searches are not intended to guarantee that a trade mark application will be successful. They are a fast and effective way of identifying other trade marks which may constitute fatal obstacles to the proposed use or the ability to obtain a registration without the need to incur the costs of a full availability search. Screening searches are particularly useful for trimming down a large list of potential names to a more manageable number.

Whilst the existence of the European Union Trade Mark Register (which covers all the member states of the EU) and the International Register undoubtedly makes the filing of Pan-European and international trade mark applications cheaper, they of course make searching more expensive as there are more territories in which there might be prior trade marks on the national register. Again, screening searches are a fast way of locating obvious international issues. There are two types of screening search:-

#### 1. Specialist screening search

This is conducted from a specialist database covering the entire world and dating back to

1976. Searches for identical / similar trade marks can be conducted on a country, regional or global basis. Whilst the results have many limitations, it is principally used to indicate whether a more detailed full availability search is justified, or to see patterns in trade marks that have already been filed and published.

#### 2. Identical trade mark search

This is a search of the full trade mark register in the country of interest. However, the fact that the search is restricted to identical trade marks only means that it is considerably quicker and cheaper than a full availability search.

#### Full availability searches

These are the most comprehensive searches and, in addition to identical and similar trade marks, cover phonetic variations of the word concerned. Typically, these searches are available on five day turnaround (although they can be expedited to two days for an additional fee). The full legal assessment will then be produced within 24 – 48 hours depending on the size and complexity of the search.

#### Common law searches

In the UK, Ireland and the United States, and other 'Common Law' countries, the continuous use of a trade mark, brand or business name, even if it is not registered, can generate rights such as passing off in the UK and unfair competition in the USA which can be enforced against third parties.

This is an extremely difficult area in which to search, not least because often it involves proving a negative (i.e. that there has been no use). Although clients will often be familiar with other trade marks in use in their sphere of business, from a risk management point of view a common law search is advisable, particularly if undertaking an important product launch in a country where such rights are recognised.

#### Device searches

These searches focus on trade marks consisting of or containing an image, colour or shape whether complex or simple. In general trade mark terms, these pictures, logos and images are referred to as 'devices'.

Device searches take longer to turn around and are more expensive because they rely upon



comparison by the human eye. Therefore, unlike word searches where a single agency can be used, device searches (beyond the UK, the European Community and the Republic of Ireland) have to be sent to local associates in each country. Please note these searches do not cover copyrights or designs where these can be registered.

### Proprietor searches

Searches may also be conducted as part of a 'due diligence' program or an internal audit. They may even be used to specifically monitor competitor activity. With limited business details, it is possible to obtain details of a competitor's portfolio in a number of key jurisdictions.

### Design searches

In certain circumstances, it may be more appropriate to register a trade mark as a design, particularly where it falls between the respective laws governing trade marks and registered designs and could be registered as either. In cases such as this, we instruct specialist agencies to conduct these searches at the relevant national intellectual property.

### Domain name searches

We can carry out on-line searches for all levels of domain name, usually on the same day. Regrettably there is not yet a system enabling one to identify all the domain names owned by one person / company.

### Company names

We can search company names in a number of jurisdictions on-line and report back the same day.

### Strapline searches

Advertisers are facing increasing reluctance from the Trade Mark Registry to accept trade mark applications for strap lines. Consequently, these are now less likely to be found by conventional trade mark searches. We can however assist in identifying whether a strap line has been, or continues to be in use, in the marketplace by liaising with specialist search agencies in the advertising market. These agencies have access to databases containing thousands of strap lines that have been used both in the UK and globally.

The fact that it covers names which have been used is significantly different from the other

searches conducted which do not necessarily indicate whether a strap line/trade mark is actually in use.

## Key Limitations

**Scope of search** - The goods and services for which a trade mark can be registered are subdivided into 45 classes. Unless otherwise stated the on-line search is restricted to those classes containing goods and services which are identical to those for which your proposed trade mark is to be used.

**Screening searches** - These searches only reveal trade marks published since 1976. They do not indicate whether the trade marks ever achieved registration, or whether they are still in force.

**Device searches** - Ultimately is impossible to take any search as being conclusive because of the problems with device classification and perception, by the IP Office and the searcher concerned.

**Design searches** - These also have severe limitations as for example certain goods may appear in different classes according to the materials which they are made from e.g. metal and plastic pens, again the principal difficulties are the differences on perception / classification between the IP Office and the searcher concerned.

**Infringement** - A registered trade mark can be infringed in the following circumstances:

- When an identical trade mark is used in relation to identical goods/services to those of the registered trade mark
- When an identical/similar trade mark is used in relation to identical/similar goods/services to the registered trade mark where there is a likelihood of confusion or association with that registered trade mark
- Where an identical or similar trade mark is used on goods or services which are not identical/similar to those of the registered trade mark where that registered trade mark has a "reputation" in the UK

**Famous trade marks** - Proprietors of trade marks which are "well-known" in the UK (regardless of whether that trade mark is used or registered in the UK) may prevent the use of an identical or similar trade mark where such use is likely to lead to confusion.

**Unregistered trade marks** - It is possible that a third party may already be using an identical or similar trade mark for goods or services which are the same or similar to your proposed trade mark as an unregistered trade mark or business name. In these circumstances, there is a possibility that a third party might have sufficient grounds to bring an action for passing off based on their use of that trade mark. The third party will need to demonstrate that it has a significant reputation in the unregistered trade mark, and that the similarity between the respective trade marks is sufficient to give rise to both a likelihood of confusion between the two trade marks and of damage to the third party.

**Further searches** - With the exception of a full availability search, other searches are not intended to provide a comprehensive analysis of the risks of using a particular trade mark. If initial search results are favourable the following further searches are recommended:

**Full trade mark search** - A search which covers all UK registered trade marks, European Union trade marks and International trade marks designating the UK. This is a far more comprehensive search and is relied on for a fuller risk assessment of similar trade marks.

**Company search** - A search of the list of companies at Companies House to ensure that a company is not using the proposed trade mark as part of its corporate name.

**Common law search** - A limited search for unregistered trade marks intended to minimise the risk of passing off. The search is conducted from standard reference works such as telephone directories, dictionaries and relevant trade directories. This search is not exhaustive as it is restricted to the material available.

**Domain names search** - A search to ascertain whether the proposed trade mark has been adopted as part of a third party's top level domain name.

**Foreign priority claims** - The Paris Convention enables a third party that has applied to register a trade mark in a foreign convention country to claim the foreign filing date as the filing date for its UK application, provided that the application in the UK is filed within six months of the foreign application. Priority claims are a concern as it is



possible for a third party to file an application in the UK up to six months after the date of this search and to claim a priority date that pre-dates this search.

**Copyright** - You should be aware that image trade marks or stylised word trade marks such as logos may infringe a third party's copyright. As there is no copyright register in the UK no such third party rights will be revealed by these searches.

**Domain names** - Please note that existing domain names which are same/similar to the trade mark may impact on the ability to commercially exploit the proposed trade mark and domain names.

**Database errors** - The on-line search is conducted from a specialist database that has been compiled from the UK and European Union trade mark registers. Databases can contain inaccuracies which reduce the reliance which may be placed on any search.

**Delay** - There is a delay of several weeks before details of newly filed trade mark applications are placed on the records of the UK Trade Marks Register and the European Union trade marks. The search will not reveal such recently filed applications.

Please see the attached trade mark search order form

**Costs** - For the countries listed in the search order form, Lewis Silkin have agreed a special price for a search in up to three classes of £250, additional blocks of classes are available at £100 for each block of up to three classes.

N.B. for highly descriptive trade marks there may be an additional charge. If so this is purely on a 'disbursement only' basis as Lewis Silkin incur a charge of €2.5 for the full details of each trade mark.

If your client would like the comfort of a full availability search then this can be arranged. However the pricing for these services is dependent upon a third party supplier. As such they have surcharges in place for not only expedited searches, but also searches falling into certain classes of goods, namely:-

1, 3, 5, 9, 16, 25, 30 these searches cost an additional 25%

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