LEWIS SILKIN

Trade Mark and Design Searches

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Searches are an essential risk management tool allowing a business to use a new name, brand, logo or design without fear of infringing any third party rights

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, should not be underestimated.

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.

What variables should be considered?

Mark: The first variable is the mark itself. Is the search intended to locate a specific registration only or is to look for any marks that might be regarded as similar or having a phonetic variation?

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", formerly Class 42 and now Class 43.

Territory: In which countries is the mark to be used in? Trade marks and registered designs are territorial in nature and each country has its own register. Our UK searches will as a matter of course cover the European Union Trade Mark and International Registers insofar as these 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 5 day turnaround.

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 marks which may constitute fatal obstacles to the proposed use or the ability to obtain a registration for the mark in question 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 marks 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 international trade mark applications cheaper, they of course make searching more expensive as there are more territories in which there might be prior 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 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 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 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 marks, cover phonetic variations of the word concerned. Typically, these searches are available on 5 day turnaround (although they can be expedited to

2 days for an additional fee). The full report 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 USA 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 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

The above searches focus on trade marks consisting of words, characters, numerals or letters. There are a far wider range of 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 Union 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 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 trade mark and patent offices.

Domain Name Searches

We can carry out on-line searches for all levels of domain name, usually on the same day.

Company Name Searches

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

ADSLOGANS

Strapline Searches through AdSlogans

Advertisers are facing increasing reluctance from the UKIPO 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 through AdSlogans a unique specialist search agency in the advertising market, which we acquired in 2018. AdSlogans has a proprietary database containing hundreds of thousands of strap lines that have been used both in the UK and globally and is used by both advertising agency of brandowner clients.

If you require any of these services, please contact us for specialist guidance in selecting and conducting the most appropriate searches.

**For further information
on this subject please contact:**

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