

Imagine this situation: you receive a request for a full “EU-wide” search. A “word search” of the EUIPO register produces hundreds of results and, when combined with searches of the national registers of the 28 Member States, the result is a daunting number of prior trade marks to be reviewed. So what can you do to produce a meaningful “first cut” report for your client and, ultimately, get to “yes”?


As I hope the suggestions in this article will show, it is possible to navigate through the thousands of hits likely to result from a dictionary word search of EU registers. And although getting to “yes” may not be feasible for each search result, providing the client with a focused, considered and manageable search report that identifies the greatest legal and commercial risks certainly is.

1. PRELIMINARY CHECKS

Where appropriate, and particularly with new or smaller clients, confer with the client on any pre-checks it may already have done. A UK-based client may tell you that it has already checked the UK IPO register, there are no identical marks and all is well – job done. Now is the time to highlight any marks that stand out in the client’s pre-checks that, although not identical, may be (closely) similar to the target mark, which may already have been enthusiastically released through a premature press release. In this scenario, now is the time to manage client expectations. ▶

BEAT THE CROWDS

Claire Lehr offers eight key steps to help you navigate the EU's crowded registers with confidence



In addition, a website search at this stage can throw up use of a mark – possibly unregistered – for the goods or services of interest.

2. DEFINE YOUR RANGE

Few clients actually require in-depth searches of each EU Member State's register in addition to searches of EUIPO and the WIPO International Registry (IR). Many UK clients work in, or target, four or five "top" EU territories. Reviewing with the client the territories of most interest and importance will likely result in a compromise search strategy – perhaps full availability in the UK, EU and IR in those territories, and an "identical plus" search in the four or five EU territories of most interest. Such a search strategy will give a sufficient view of the most pertinent registers to allow you to assess the risks involved.

3. CONSIDER CLASSES

Consider the core use or proposed use by the client. The use may be complex – for example, a bookstore with an in-store coffee shop, or an online portal to be accessed exclusively by clients in the field of insurance broking. Ideally, the classes searched should be broad. Practically, however, your search report may well end up focusing on a single core good or

service, particularly if the search is for a dictionary word.

4. TYPE OF MARK

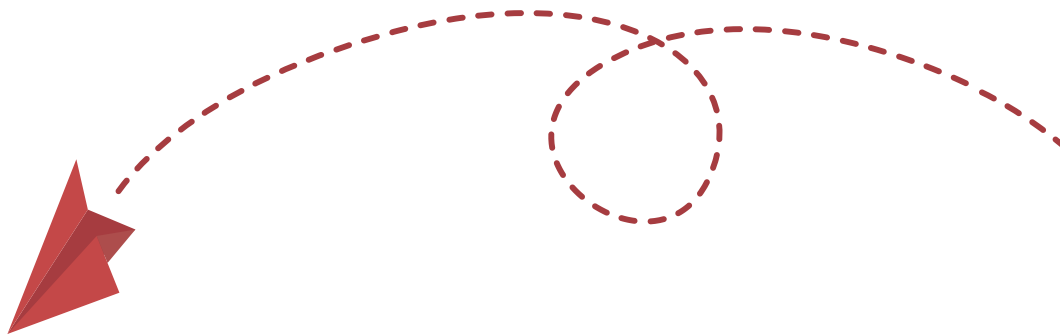
The EU registers are increasingly crowded, and rarely is it possible to "clear" a mark for use. The marks producing the most hits are dictionary words. Consider the ultimate use of a mark – will it be used with a house mark? Including the house mark will reduce the number of hits and provide a more focused result. Establish whether the mark is to be used within a more prominent device; such use will likely affect the commercial risk element of the search report.

5. ADD-ON ACTION

The internet is your friend! A surprising number of businesses still use a mark but do not seek to register their rights. Yet those unregistered rights can be used to challenge use and registration of a later-filed mark. Other "quick check" search sources include Companies House or a local EU equivalent. Take note of country-specific rights – for instance, in Spain and Sweden, which give proprietors particular rights for company names. Many retailers also use Twitter and Facebook. A domain-name search may already form part of your full availability search package(s).

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6. NARROWING YOUR TARGETS

When your initial results are in, they might run to more than 2,000 pages of citations. Selecting marks with “double identity”, including local EU language equivalents, might narrow this to, say, 25 citations. Some basic checks may help reduce that number:

- Age of citations – do a website search to see what use, if any, has been made of marks that are more than five years old. A mark may be (partially) vulnerable to revocation proceedings on the basis of non-use, and may not safely be relied on in opposition proceedings.
- Family of marks – one entity owning more than three marks with the same characteristics may have increased rights in those marks. Check if at least three are used.
- Renewed marks – renewal could indicate an ongoing interest.
- Thomson Life¹ house mark bugbears – can you exclude marks that are confusingly similar according to Thomson Life if the search has revealed an identical mark(s) to that of interest?
- IP Translator² and class heading specifications – it can be difficult to identify the core interest of the proprietor, and online checks are essential to help narrow down the goods/services of real interest to the earlier rights holder.

7. WEIGH UP THE RISKS

Almost inevitably, there is a difference between the legal and commercial risk of using a chosen mark. A mark may have “double identity” with the mark searched, but if the earlier mark is

more than five years old and a website search reveals no information about the proprietor or its use of the mark, the commercial risk may be manageable. That said, a mark in the name of a company or individual about which no or scant information is available should not be instantly dismissed. The company may be a “straw” company, behind which lie the resources of a large company. Similarly, an individual proprietor may not be as innocuous as it appears on the register.

Certain names crop up repeatedly, including “mass filers” (so-called “trade mark trolls”) who file marks with the intention of “reserving” them on the registers and selling them at a later date – and for a high price. Such proprietors are more likely to challenge registration of a later mark to preserve their own rights.

Marks that are similar or identical to company names tend to present a higher commercial risk. Most companies are understandably more sensitive about a (perceived) variation of their house mark(s) and will be watching the registers closely.

Where a proprietor has opposed before, it knows the opposition ropes and will likely oppose again. Check to see which proprietors have opposed and the extent of the opposition(s).



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8. LATER STEPS

A client resolved to use a mark may “file and be damned”. Others may be cautious and try to close off possible challenges through mitigation – eg by purchasing an older mark through a straw company and/or instructing in-use investigations with a view to filing revocation proceedings. Some clients are more direct and approach the owner of a blocking older mark to demand its withdrawal following the results of an in-use investigation. ■

1. Case C-120/04, Medion AG v Thomson Multimedia Sales Germany & Austria GmbH.
2. Case C-307/10, Chartered Institute of Patent Attorneys v Registrar of Trade Marks.