

Prior rights search – Trademarks

The search of the prior signs is a means of identifying, before taking any step to register a trademark, a certain number of prior filed/registered signs which could jeopardize the registration/use of your sign or company name as a trademark.

➤ When and why should you perform a search?

It is highly recommended to perform a search of the prior signs **before filing the application for registration of your own trademark**.

However, long before this stage (which often occurs downstream of a communication strategy on the name chosen), it is highly desirable to carry out a search of prior signs.

In fact, **before incurring an important investment** (that may prove futile) in terms of communication, marketing, packaging, image consolidation, etc, it is **advisable to determine the risks that the name chosen** for your company, products, services, etc, may violate (or may be regarded as being possibly confused with) one or several intellectual property rights of third parties.

Registration of a trade name in the commercial register gives its owner only a **limited monopoly on the use of the name**. Moreover, this registration **does not exclude the existence of a possible trademark of a third party that is prior to this registration** (see our “Trademarks” sheet).

➤ Where this search should be performed?

Depending on the level of sophistication of the search strategy adopted, various possibilities are available to perform a search:

✓ The databases of patent offices (free)

Certain intellectual property offices offer access to their trademark registry in the form of databases in which a simple search may be performed (exact sign/content, owner, etc.).

For Switzerland:

www.swissreg.ch

For international registrations (notably designating Switzerland):

<http://www.wipo.int/romarin/search.xhtml?jsessionid=01777CDA0A466F7B137B2974ACFCB26F>

<https://www.tmdn.org/tmview/welcome>

<http://www.wipo.int/branddb/en/>

For Community registrations:

<https://euipo.europa.eu/eSearch/>

For national registrations:

- Germany: <https://register.dpma.de/DPMAreger/marke/einsteiger>

- France: <http://www.icimarques.com/>
- Great-Britain: <https://www.ipo.gov.uk/tm/t-find/t-find-text/>
- United States: <http://www.uspto.gov/trademark>

✓ **Professional databases (not free)**

Professional databases are offered by specialised service providers. These databases, for which an access fee is applicable, require a thorough understanding of the search engine. In return, they offer extensive possibilities in terms of geographical coverage, existing rights (trademarks, industrial names, domain names, product names, pharmaceuticals, etc.) and the level of sophistication of the search (combinations, phonetic similarity, etc.).

✓ **Delegating your search to a patent office**

Certain intellectual property offices offer tailor-made search services. A fee is applicable. The Swiss intellectual property office, for instance, offers its own search services: <http://www.ip-search.ch>

➤ **Which search strategy should be adopted?**

The search strategy must be **adapted according to the desired products and services classes** as well as to the following criteria:

✓ **Levels of search**

- **“Screening” of candidate signs** for an assessment of the risks associated with the use/registration of each one
- **Thorough search** on the chosen sign (or already used) for a detailed analysis of existing rights

✓ **Types of search**

- ✓ Existence of identical trademarks
- ✓ Existence of similar trademarks (close phonetically, figuratively, etc)
- ✓ Status of geographical protection of a certain trademark
- ✓ Owner of a certain trademark
- ✓ ...

➤ **How should the results of a prior signs search be used?**

The results of a search concerning trademarks must be analysed according to various criteria such as the difference between the lists of products and services of the prior trademarks and the sign to be registered/used, the level of similarity between the signs (that depends on national case law), the use made by the owner of the earlier trademark if the registration is not recent.

This analysis will make it possible to propose a protection strategy that is appropriate in terms of the object of the protection (word, graphic, combined, etc), its geographical scope, and the nature of the products and services claimed.

➤ **Which guarantees does a search provide concerning the freedom of use or registrability of a trademark?**

While prior rights searches **make it possible to identify the most obvious risks, they do not necessarily provide exhaustive information on prior rights** (specificities of national case law, not listed prior uses, incomplete/inaccessible registers in some countries, etc.) which may conflict with your sign. This is why a search of prior rights does not fully guarantee the availability of a sign.

Moreover, the result of a positive prior rights search where no prior right was found does not, however, guarantee that your sign can be registered, since this depends, among others, on its distinctive character (see our “Trademarks” sheet).

➤ **Is a search useful if a trademark application has already been filed?**

Trademark-related searches do not end when you file your trademark application. A search (or continuous watch) of a trademark may indeed be useful in order to verify whether a competitor impairs your recently registered trademark, so as to envisage a defence strategy or partnership.

We offer prior rights search/analysis services in order to provide strategic consulting regarding trademarks protection. For a precise estimate, you may contact us at:

reuteler & cie SA

Patent and Trademark Attorneys

www.reuteler.net