

TRADEMARK SEARCHES

Why do a trademark search?

You have developed a new product, invented a new service and you would like to christen it to let the relevant public know about it. Before investing in printed matter and advertising, you ought to find out whether the name you have chosen is already the exclusive property of a third party, failing which the third party could destroy all your marketing efforts.

Only a search can check whether the name you have chosen is available and has not already been reserved.

When should a trademark search be made?

The search should be made on two occasions.

1°) Preliminary screening search = elimination of poor candidates

First of all, when the name of the product has not yet been clearly defined, but several possibilities are envisaged, a preliminary “sort out” should be made. This is done in the form of a screening search on the basis of a series of “candidates”. This eliminates names which are clearly reserved and for which the likelihood of conflict with the prior mark is too great.

A screening search has to be made **before** the final product name is chosen and before investing in the creation of a design and printing documentation.

2°) Extensive search = selection of the best trademark

Secondly, when only a small number of candidates remain, a more extensive search can be carried out. This will preferably also cover trademarks comprising graphic elements as well as similar trademarks. It will also include, as far as possible, pending registration applications.



In all cases, the search has to be carried out before incurring expenses that may prove wasteful if the name chosen has to be altered.

The extensive search offers a **greater level of certainty** as to the availability of the name chosen.

What types of signs could come into conflict with your trademark?

When you choose a name, it may infringe the rights of an existing trademark, but it may also come into conflict with other types of signs, in particular:

- a company name
- a business sign
- an Internet domain name
- a distinctive unregistered sign, affixed to a product.

Can an absolute guarantee be given that the trademark is available?

A search not only allows the most obvious risks to be eliminated, but also a defence strategy to be prepared if a conflict nonetheless arises. Existing databases unfortunately do not always allow an exhaustive check of signs that might come into conflict with your trademark. This is due, in particular, to the diversity of applicable legal regimes and to the nature of the signs searched (trademarks exclusively composed of words or combined with a logo, business names, Internet domain names, etc.). This is why a search, whether made on prior marks, corporate names, business signs, Internet domain names or even distinctive signs used without registration, **cannot give an absolute guarantee as to the availability of a trademark.**

How is a trademark search made ?

The way in which the search is made depends upon the objective that one wishes to achieve. If a screening search is made in order to eliminate candidates, it is possible to search only for strictly identical prior trademarks. Likewise, if the market is exclusively local, there is no need to search trademarks filed in Japan and South Africa.

If the purpose of the search is to prevent with the greatest possible certitude any conflict with the owner of a prior right, a similar trademark search must also be made. This search can also cover trademarks comprising a logo (figurative trademarks). Likewise, if the



envisaged market is international, a search in the registers of the countries concerned is useful. This enables a single name to be used in all of the countries in which the product will be marketed.

How much does a trademark search cost ?

The cost of a trademark or priority search varies greatly depending on the registers to be considered. First of all the scope of the search must be defined. Should it be limited to trademarks or also to other signs such as corporate names or domain names? Should it cover only Swiss national trademarks, or, for example, also European Union and United States trademarks? Is the search only for identical trademarks or also for similar trademarks? Should the search be extended to logos or only to the verbal part of trademarks?

An estimate can be provided upon request for any search.