



Trademark Availability Search  
in Europe and beyond





## TRADEMARK CLEARANCE SEARCHING MADE EASY

**Clearing a new trademark globally or in a region like the European Union (EU) can be a tiresome and costly task for in-house and outside counsel. With MULTISEARCH®, administered by Knijff Trademark Attorneys, we have found a solution which will make a complicated multi-country search project no longer a challenge.**

It is not easy to be original when creating a new trademark. In the European Union alone there are about 15 million valid trademark registrations, of which more than 500,000 are active Community trademarks (CTM). This makes it a real challenge for companies to clear new marks before launching them on the market.

Trademarks are an important tool for expansion and building brand identity. Unfortunately it is no longer easy to create and register new strong trademarks since so many names have already been taken. As a result, also trademark clearance has become increasingly difficult.

Taking these facts into account many applicants have chosen specialized private firms such as Knijff Trademark Attorneys to carry out their search projects.

### **DO NOT BE AFRAID OF SEARCHING**

*“While conducting a trademark search may not be necessary or even appropriate in every instance, choosing not to conduct a search is not a viable option.” (Tommy Hilfiger U.S.A. versus International Star Class Yacht Racing)*

Once a new name has been selected by the marketing team, it remains critical to submit the name for a trademark search. Without performing a search, it is impossible to know whether another company or individual is already using the same name or a confusingly similar one in the marketplace. A clearance search will also determine whether the proposed name is available for registration.

Trademark professionals who manage a multi-country trademark clearance project are faced with a fairly complicated and time consuming task. But the right strategy will keep the risks to a minimum.

### **WHERE DO YOU START IN CASE OF A EUROPEAN UNION TRADEMARK CLEARANCE PROJECT?**

Before starting a new search process it is important to define a clear strategy. This implies that you have to consider the geographical scope of where the new mark will be used. Let's assume that you would like to clear a new trademark (or a few trademarks) in the expanded European Union (EU), which means 27 countries.

Furthermore you have to determine the type of mark that will be used (is it a new product or service, is the mark a tagline, is the name an extension of a house brand, etc. ...) as well as a clear description of the goods and services. Determine also how important the mark is and how long it will be used. Last but not least decide on the timeline of the launch as well as your client's risk tolerance.

### **WHO TO USE FOR YOUR SEARCH PROJECT?**

When faced with clearing trademarks in the EU, the first hurdle is to find the proper type of search to obtain a well-founded legal assessment of the availability of marks.

The ex officio search issued by the Office of Harmonization for the Internal Market (OHIM), might be an option but is not a useful tool to clear a mark in a territory as large as the EU. The report is not clearly structured, it comprises limited data, it does not provide a description of goods and services and it takes between 1 to 2 months to get results of only 12 countries. Moreover since 10 March 2008 the ex officio search has become optional.

You can also contact 25 outside counsel firms, but that usually results in a longer turnaround time and administrative burden, which often also means more costs.

**Therefore, MULTISEARCH® has developed different products which each take into account the clients key considerations: quality, time and budget.**

The search results are compiled and presented in one report with a uniform format, including an overall analysis and summary followed by a clear conclusion. All searches and reports can be customized to meet special requirements such as the countries to be searched, further clearance steps or alternative ways of distribution and delivery.

### MULTISEARCH®Scan

In today's information age, the trademark practitioner has ready access to a wide variety of sophisticated databases, many at no charge. However there are a lot of limitations when carrying out screening searches. Not all European PTO databases are available online and easily searchable, not all countries are included in the database of the commercial search companies, some search engines only look at identical marks and search algorithms are more limited than in a full search. In such cases additional information must be obtained by contacting local trademark firms, which takes time.

With the **MULTISEARCH®Scan** you can outsource the initial screening process.

The search report you receive from **MULTISEARCH®** provides you with identical and phonetically identical names in the countries of your interest as well as a brief legal opinion on pertinent names found. The search report is available in 3 working days and at a fixed price.

Generally only a small number of candidate marks will survive the first round of screening. However ultimately conducting identical searches is not enough to make good decisions about a trademark's availability. Additional full searches with a local legal opinion and an overall legal conclusion or full searches with an overall legal conclusion are recommended.

**MULTISEARCH®** offers both solutions, **MULTISEARCH®Pro** and **MULTISEARCH®Lite**.

### MULTISEARCH®Pro

To clear the shortlisted marks, as a result of the **MULTISEARCH®Scan**, full searches have to be conducted in all countries of interest. For the 27 European Union countries this can be done in one or several steps, for example starting with the major markets (France, Germany, Italy, Spain and UK cover approx. 60% of all active EU trademarks) and the secondary markets at a later stage, depending on your time and budget limitations.

**Searching in individual countries is one thing, but managing multiple searches on a timetable and budget is another, especially with individual search reports varying from country to country.** The challenge is to interpret and compare the results of the individual reports. Ultimately, the decision has to be made whether a mark is available for use and registration.

**MULTISEARCH®Pro** is designed to clear a trademark in collaboration with local experts. Local counsel has firsthand knowledge of the country's trademark laws and practices, trends in decisions by the Registry, local customs, linguistic issues (the EU has 23 official languages and many more dialects), etc. This is essential because in an eventual trademark infringement action the decision of the local judge is based on the same local laws. The search reports will give valuable understanding of the registrability and availability for registration of the mark, and of the availability for use of the mark in each individual country.

In addition the **MULTISEARCH®Pro** also contains a summary

and analysis of the conclusions of the national reports as well as an overview of the main obstacles in the countries searched. Also a strategy on how the obstacles can best be addressed, will be provided by an experienced EU Trademark Attorney. The search report is available in 10 working days (in case a clearance project involves more than 5 marks, a delivery schedule will be discussed upfront) at a fixed price.

### MULTISEARCH®Lite

Taking into account the substantial price of a **MULTISEARCH®Pro** and the fact that companies often allocate limited budgets to trademark clearance we also offer **MULTISEARCH®Lite alternatives, which are a cost-effective way to make a calculated risk assessment of the availability of a mark as a CTM.**

For this type of search the data are analyzed by an experienced EU Trademark Attorney, who will provide an overall conclusion on the registrability and availability for registration of the mark as a CTM.

#### • OPTION 1 (FULL SEARCH + IDENTICAL SEARCH + OVERALL CONCLUSION)

For this alternative you can choose to carry out a FULL AVAILABILITY search in the 15 "original" (Western) EU countries - Austria, Benelux, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Portugal, Spain, Sweden, United Kingdom (excl. Common Law) – and/or combined with an IDENTICAL SCAN search in the 12 "new" (Eastern) EU countries - Bulgaria, Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Romania, Slovak Republic and Slovenia.



The IDENTICAL SCAN search covers identical and phonetically identical marks. The result is that a high percentage of all marks with international importance (valid in more than one EU country) should be found with this combination.

**STANDARD PRICE € 5575 (1ST CLASS) AND € 1820 (EACH ADD.CLASS) - INCLUDING OVERALL CONCLUSION**

#### • OPTION 2 (CREATE YOUR OWN PACKAGE)

It is of course also possible to limit your search to a number of countries and combine the countries and search types the way you prefer.

**MULTISEARCH®Lite** reports are available in 4 or 7 working days at a fixed price.

### MULTISEARCH® ADD-ON SERVICES

Trademark searches and opinions are indispensable in assessing the risk of adopting a new trademark. Once the results and conclusions of the clearance searches are available you also can use **MULTISEARCH®** for further investigations on the use of trademarks and other follow-up for your project such as company names, trade names and/or domain name checks.

### EUGENO™ BY MULTISEARCH®

Convenience and efficiency, key features of the **MULTISEARCH®** Services that are very much valued by our clients. That is why **MULTISEARCH®** has developed its special and unique web platform, called EUGENO™. This platform allows you to manage your trademark clearance search projects in an efficient way. With the EUGENO™ Webplatform you can Order, Review, Edit, Print and Archive all your search projects.

Once you have placed your order using EUGENO™, the **MULTISEARCH®** team and its network of local associates takes care of the search request. When the reports are finalized, the results are made available electronically, on the EUGENO™ Webplatform, in a secure online environment, where you can view and download the reports anytime you want from anywhere in the world, without the inconvenience of global time zones or business hours. The tool can also be used for tracing pending searches and archiving finalized searches.

Do you need an EUGENO™ Webplatform login and password call +31.294.490900 or send an email for your login details to [eugeno@multisearch.info](mailto:eugeno@multisearch.info).

### TRADEMARK CLEARANCE PROJECTS - EFFICIENT, RELIABLE AND COST-EFFECTIVE.

A survey was conducted in cooperation with Robin Rolfe Resources, Inc. on the costs of in-house trademark searching. The research included in-house trademark counsel from different industries and geographical locations.

The overall conclusion was that using **MULTISEARCH®** was less expensive than conducting a search in-house, saving corporate law departments over 50% of their overall in-house searching expenses.

Apart from the higher costs, opportunities to address more productive tasks are also being lost during time spent on in-house searches. Therefore using **MULTISEARCH®** will allow in-house counsel to use their staff more effectively, promote cost savings in the department, and make it easier to manage the department.

The **MULTISEARCH®** search services are designed to facilitate trademark clearance projects in an efficient, reliable and cost-effective manner.

### CONTACT US FOR MORE INFORMATION

If you would like to discuss your particular trademark clearance project with one of our trademark professionals, please contact us.

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