

# Trademark searches

When building a coherent strategy of IP protection for a business, trade mark searches should be taken into consideration. They are conducted by experienced patent and trade mark attorneys and IP protection specialists and consist in searching for trade marks in professional databases and providing expert analysis of the search results. Depending on the client's intended purpose, the search may be used to help a company optimize its business strategy and avoid conflicts with competitors.

## What is a trademark search

A trademark search is a review and analysis of filed/registered trademarks that are identical and/or similar to the selected designation, performed by qualified patent and trademark attorneys and search specialists.

## The advantages of performing a trademark search

A trademark registrability search allows clients to accurately assess the chances of obtaining protection for a designation prior to filing. It also helps determine whether there are obstacles to the registration of a trademark or whether there is a risk of infringing the trademark rights of another party. If prior similar trademarks are found, it is possible to amend or modify the list of goods and services in a trademark application to increase the chances of obtaining protection. Moreover, a properly performed search enables clients to:

- draw up effective sales and promotion strategies for goods and services,
- make more informed decisions when engaging in brand development,
- protect their resources more effectively
- decrease the risk of infringing third parties' rights, and in this way save time and money when introducing products with the selected trademark to the market.

## Types of searches performed by our office:

### a. **registrability search of a word mark or design**

For whom? For businesses and individuals who intend to register a trademark. What are the benefits of performing a trademark registrability search? It allows clients assess their chances of obtaining protection as well as the potential danger of infringing other marks. Moreover, it is not limited to simply checking whether an identical or similar trademark is protected.

Indeed, the search report assesses whether the designation which is going to be filed with the IP office is registerable, i.e. whether on the basis of binding regulations and other factual circumstances it is possible to register the trademark. The search conducted by patent and trademark attorneys is complex, as not only identical and similar marks are taken into account, but, in the case of a word mark, also trademarks containing similar prefixes, synonyms, homonyms and names that have a similar stem or meaning.

For designs, the search is conducted on the basis of special search parameters which allow figurative elements to be screened. A design search is more time-consuming than a word mark search. It helps clients assess whether a logo is fanciful in comparison with other logos to the extent that it may function as a recognizable, standalone trademark without additional word elements, and be properly associated with the products or services originating from a specific business. A professional who regularly watches the case law of Polish and European courts as well as the changing guidelines of IP offices will offer advice on what can and cannot be included in the word mark or design. Therefore, if financial projects and investments are planned, a search should be performed as early as at the stage of designing a mark, as it dramatically reduces the risk of infringing third parties' rights.

Additional search options for trademark registrability search:

- **pharmaceuticals (class 5)**

In case of a search for a pharmaceutical product, it is possible to perform an additional search among identical and very similar names of dietary supplements and medicinal products which have obtained marketing authorization in Poland

- **countries of the European Union**

It is possible to perform an additional search among national trademarks registered in member states of the European Union. This option is especially useful if you intend to file a trademark with the European Union Intellectual Property Office (EUIPO). The service comprises a printout from the TMView database containing a list of identical and very similar marks. It does not comprise the analysis of trademarks or translation of the lists of goods. If necessary, these activities may be the subject of a separate order.



▪ **trade names and domain names**

We may also search identical names in the National Court Register and the Central Business Activity Register and Information Record, among national domain names (.pl, .com.pl), and global domain names (.com and .eu).

b. **trademark clearance search**

For whom? For clients who do not intend to file a trademark for registration, but only want to use it. What are the benefits of performing a trademark clearance search? According to the law, it is not obligatory to file a trademark prior to launching a product bearing that mark on the market. Therefore, businesses often do not intend to file a trademark with the IP office (seasonal products, short series) but only place it on their goods. In such a situation, the search will confirm whether the business will be at risk of being challenged or the subject of a lawsuit from third parties, not only on the basis of industrial property law, but other regulations as well.

c. **other types of search (for example, legal status verification, trademark portfolio search)**

Our firm also performs other types of searches, for instance legal status verification (when the client wishes to check the status of a trademark) or a trademark portfolio search (itemized trademarks filed/registered in the name of a specific entity).

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