



SafeLaunch

Potter Clarkson

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Clear from risk.
Clear from threat.
Clear from challenge.
CLEAR FOR LAUNCH.

When you help a client launch a new brand, you should be aware there is a risk someone else is already using or has registered an identical or confusingly similar trade mark.

If so, you need to know as soon as possible.

You need to warn your clients of any risks they face in using their new brand before they find themselves bearing the costs of redesigning and rebranding, as well as repairing any reputational damage or even rebuffing legal action.

As with most things in life, prevention is better than cure when it comes to protecting your clients' brands.

In this case, that means avoiding any risk through a trade mark clearance search.

Why do you need a clearance search?

A clearance search gives both you and your client the security of knowing their new brand is clear from risk, possible legal threats or other third-party challenges.

It will confirm your client is clear for launch.

A thorough clearance search will also help your client side-step potential pitfalls including:

- Finding after launch that they have infringed an existing brand and are faced with the costly prospect of rebranding and/or compensating the existing brand owner.
- Pressing ahead with a brand that isn't registrable and which can't be protected or enforced.
- Your client might have a false sense of security in their new brand.

Above all, a clearance search allows you and your client to take any necessary preventative action before reaching the market, so their new brand enjoys a safe and trouble-free start.

If adaptations to the proposed brand are needed, you'll have that all-important opportunity to make those changes before your client is faced with any disruptive, time-consuming and expensive challenges.



How can SafeLaunch help?

SafeLaunch is specifically designed to make the clearance process as easy, time and cost-efficient as possible for you and your clients. It is a collaborative process where we can help you to develop a protectable brand right from the start.



We start by finding out about your clients' plans - for example, when it comes to sales, technological development and brand expansion. We also look at the potential brand or brands that you have developed.

We will then recommend the level of search we think best meets your client's needs to minimise their exposure to risk.

To ensure total transparency, each search has a fixed price with any further costs needed to address any of the risks raised outlined in full. This means you and your client always know exactly how much you are paying, allowing you to budget for the cost as part of the brand development.

With our assessment and our recommendations, you and your client can make an informed decision on how to proceed. We can also suggest an alternative course of action if you decide the risk level is too high.



WHAT ARE THE DIFFERENT TYPES OF CLEARANCE SEARCHES OFFERED BY SafeLaunch?

The type of search required will depend on several factors, such as the product or service, the potential brand(s), your client's business plan and their commercial objectives. We therefore offer a range of search options:

1

THE IDENTICAL SEARCH

This UK-specific initial screening search will help you and your client narrow down the list of possible brands at an early stage.

You provide us with a shortlist of up to five new marks with information about how your client plans to use them. We will run screening searches of the UK Trade Mark Register to identify which - if any - should be ruled out due to existing rights that pose a significant risk to the proposed brand in the UK.

The results mean you will know which options are realistic (and which should be dropped) without your client incurring the cost of a full search.

£450 (exc VAT)

2

THE FULL CLEARANCE SEARCH AND RISK ASSESSMENT

This is our most comprehensive search and provides you and your client with a complete assessment of the potential risks faced by using the proposed mark in the UK. It includes:

- **Full search of the UK Trade Mark Register**
Including identical trade marks, similar trade marks and phonetic variations.
 - **Inherent registrability advice**
Does the proposed brand meet the registrability criteria set by the UK Trade Mark Registry? We will advise you if we think registrability objections might be raised and suggest ways of alter the brand to improve its registrability.
 - **Domain names**
The internet plays a huge part in a brand's online success. We will carry out domain name searches to identify if top-level domain names are already taken and, if so, what other options might be available.
 - **Common law rights**
Some countries - including the UK - allow rights to be enforced under common law even if a mark hasn't been registered. In the UK, this is known as "passing off". Our searches cover a variety of databases to protect your client from possible passing off claims, providing additional peace of mind.
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- Additional classes of goods and services, as well as logos and visual elements, can be included in the search for an additional fee.

£1200 (exc VAT)

3

THE BRAND REFRESH

Our search services aren't limited to new brands.

If your client is considering a brand refresh or extension to cover new product lines but is unsure how best to alter any existing branding or wants to see if its new identity needs a new trade mark, we can help there too.

Our initial consultation will give us the opportunity to discuss your client's existing protection and how you intend to recalibrate their branding. If your client has already modified a trade mark, we can discuss how this might affect their existing protection and whether any searches are required or if an audit of their trade mark portfolio might be beneficial.

Following our initial consultation, we will provide a complete set of recommendations that highlight any new trade marks or designs your client may want to register and any clearance searches they should undertake to ensure their brand is protected.

£400 (exc VAT)

4

THE OVERSEAS CLEARANCE

Trade marks are territorial rights. Conducting a clearance search in the UK gives no indication of whether or not a trade mark is free to use abroad.

If your client plans to use its new brand outside the UK, similar clearance searches should be carried out in the relevant countries.

Our trusted network of attorneys around the world can advise on clearance and protection issues in their countries. Potter Clarkson has attorneys across the Nordics and can advise on clearance and protection in a number of overseas territories using our in-house teams.

We can run these searches in parallel to those based in the UK, or at a later date. Either way, it is beneficial to clear the new brand in as many core countries as possible so your client knows where they can launch without risk of infringement.

Price dependent on territory

PROTECTING YOUR BRAND

If, after reviewing our searches and advice, your client decides to file a new UK trade mark application, we will work with them to prepare a suitable filing programme for protection of their new brand. We will also assist in preparing a suitable description of goods and services. Our standard filing costs for a trade mark in the UK, assuming no objections or oppositions are encountered, are:

£820 in one class;

£100 for each additional class.

The costs above exclude VAT and the cost of any further work required to progress the application to registration. The costs include official registry fees.

We can also register trade marks overseas; costs are dependent on the territories of interest.

LIMITATIONS OF OUR CLEARANCE SEARCHES

Please note clearance searches are never perfect as the data they are based on changes constantly. We therefore draw your attention to the following limitations:

- **Delays** - Trade Mark Registers change constantly so can never be completely current; recent applications may not appear in the results.
- **Non-registered rights** - whilst non-registered rights can be problematic because they are recognised in law, they will not appear on the register of trade marks. Non-registered rights include rights in passing off, unregistered design rights, and copyright. Our full clearance searches will look for indications of some of these rights but, by nature, they are difficult to pinpoint.
- **Overseas applications** - UK trade marks can be 'backdated' by up to six months because of corresponding rights already filed overseas. Our searches won't locate these rights if they have not yet been filed in the UK.
- **Well-known trade marks** - some well-known brands may enjoy wider protection even if they are not registered in the UK. These rights are based on overseas registrations and the well-known nature of the mark. We would hope to recognise conflicts with well-known marks but they will not be covered by the searches.
- **Disclaimer** - searches involve a significant amount of data that must be reviewed and processed. Data providers, including the trade mark registries and external search providers, accept no responsibility for errors made in searching, and therefore we cannot accept it either.

Searches do not provide an absolute guarantee of freedom to use and/or register a mark but they can provide a clear indication of prior rights. Problems such as those mentioned above rarely arise, but it is important you are aware of them.



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