



SafeLaunch

Potter Clarkson



POTTERCLARKSON.COM

CLEAR FROM RISK.
CLEAR FROM THREAT.
CLEAR FROM CHALLENGE.
**CLEAR FOR
LAUNCH.**



If your client is launching a product or service under a new brand, there is always a risk that someone else already has rights in a conflicting trade mark.

If this is the case, you need to know as soon as possible.

You need to be able to warn your clients if there are risks in using their new trade mark before they find themselves having to bear the cost of redesigning, rebranding, repairing any reputational damage or even rebuffing any potential legal action.

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

In this case, the best way to limit risk is through a brand clearance search.

WHY SHOULD YOU PERFORM A *CLEARANCE SEARCH?*

A clearance search will give you and your client the security of knowing that the new brand is clear from risk, clear from possible legal threats, and clear from any third-party challenges.

It will help confirm that your client is clear for launch.

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

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- » **LAUNCHING ONLY TO FIND THEY HAVE INFRINGED AN EXISTING BRAND AND ARE LEFT WITH THE COSTLY PROSPECT OF NEGOTIATING WITH, SETTLING WITH AND COMPENSATING THE OTHER SIDE.**

Responding to a Cease & Desist letter from a company who believes their trade marks rights have been infringed will typically cost upwards of £2,000 (and sometimes, far more). If the issue is not resolved, even defending a straightforward trade mark infringement claim to trial can cost upwards of £250,000 depending on the complexity of the case, and the only alternative in this circumstance may be for your client to change its brand. Running a clearance search before launch is the best way to avoid this risk.

- » **PRESSING AHEAD WITH A BRAND THAT CANNOT BE REGISTERED AS A TRADE MARK .**

If a trade mark cannot be registered, whether because a third party owns conflicting rights or because it does not meet the legal requirements for registration, will have a direct impact on the value of the brand and your client's ability to enforce it against infringement.

- » **RUNNING YOUR OWN SEARCHES WITHOUT INCLUDING ALL THE RELEVANT PARAMETERS.**

This issue arises on a regular basis. Conducting the right searches with the right parameters takes legal training and experience. Without this knowledge, something crucial may be missed which could be problematic when a new brand is launched onto the market.

Most of all, conducting a search will allow you and your client to take any necessary preventative action before reaching the market so your client's new brand can enjoy a safe and trouble-free start and avoid any disruptive, time consuming and expensive challenges.

HOW WILL SafeLaunch HELP?



SafeLaunch has been specifically designed for creative agencies to make the clearance process as easy, time-efficient and cost-efficient as possible for you and your clients. It is also a collaborative process where we:

1. Start by understanding your clients' plans - for instance, sales plans, technological development and brand expansion plans.
2. Then we recommend the level of search that we think best meets their needs to minimise their exposure to risk.

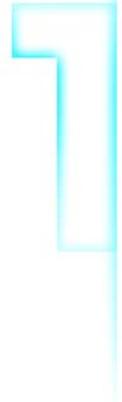
Our searches are transparently priced, with each option provided at a fixed price and with a fixed outcome. We take a very directive approach so that you know what needs to be done to reduce any risks revealed by the searches.

Once you have our assessment and our recommendations, you and your client can take an informed decision as to whether you feel the level of risk associated with your planned launch is acceptable.

If you decide it's not, we can suggest how you might adapt the branding to minimise the risks.

WHAT ARE THE DIFFERENT TYPES OF CLEARANCE SEARCHES?

The type of search you need will depend on your client's product or service, business plan and commercial objectives. So that you get exactly what you need, we offer a range of search options for new brands:



THE IDENTICAL SEARCH

This is an initial screening search designed to help you narrow down your list of possible brands on behalf of your client.

You can provide us with a shortlist of up to five new marks and we will run screening searches to identify which of these marks should be ruled out because of existing trade marks that pose a significant risk to your proposed brand.

The results will give you a clear indication of which proposed marks are realistic options (and which should be dropped) without you incurring the cost of a full search.

£450 (exc VAT)

Can be done within a day



THE FULL CLEARANCE SEARCH AND RISK ASSESSMENT

This is the most comprehensive search and will provide you with a full assessment of the risk in proceeding with the mark of interest. It includes:

- » **FULL UK TRADE MARKS**
Covering identical trade marks, similar trade marks and phonetic variations.
- » **INHERENT REGISTRABILITY ADVICE**
Does your brand meet the registrability criteria of the UK registry?
- » **DOMAIN NAMES**
The internet plays such a huge part of an online brand, it might not be worth adopting a brand if the domain name is not available. Domain name searches identify if top level domain names are already taken, and what alternative domain options might be available, as part of your client's pre-launch preparation.
- » **COMMON LAW RIGHTS**
Some countries - including the UK - may allow rights to be enforced under common law even if a mark hasn't been registered at the Trade Mark Registry. In the UK, this is known as "passing off". Our searches cover a variety of databases which may indicate that relevant unregistered third party rights exist, and therefore a risk of passing off. This search can provide an additional level of comfort and security.

Logos and visual elements can also be included in the search although this can take longer and is subject to additional pricing.

From £1200 for UK rights advice;

We are also able to search and advise on the presence of conflicting rights on the EU Trade Mark registers and charge £600 for such EU Trade Mark advice (exc VAT).



THE BRAND REFRESH

Our search services aren't limited to new brands.

If your client is thinking about a brand refresh and is unsure how best to tweak their branding or wants to see if their new identity will need a new trade mark, we can help.

Our initial consultation will give us the opportunity to discuss the existing protection and how you and your client intend to adjust the existing brand. If modifications have already been made, then we can discuss how they might affect the existing trade mark protection and whether any further trade mark searches are required or whether a trade mark portfolio audit might be beneficial.

Following our initial consultation, we will provide a complete set of recommendations that highlight any new trade marks or designs you may want to register and any clearance searches you should undertake to ensure the modified brand is capable of the right protection.

£400 (exc VAT)

This would usually take 2-3 days



THE OVERSEAS CLEARANCE

Trade marks are territorial rights so conducting a clearance search in the UK will not give you or your client any indication of whether or not a trade mark is free to use abroad.

If your client plans to use the new brand abroad, then similar clearance searches should be carried out in those countries to make sure they have freedom to use there too.

Our trusted network of attorneys around the world can advise on clearance and protection issues in their country. We can run these searches in parallel to the UK-based searches mentioned above, or at a later stage. Either way, it is beneficial to clear your client's brand in as many core countries as possible so you know where it can be launched without risk of infringement.

Price dependent on territory

This would usually take 4-5 days



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:

**£920 in one class;
£110 for each additional class.**

We can also file applications covering the European Union. Our standard filing costs for an EU Trade Mark, assuming no objections or oppositions are encountered, are:

**£1660 in one class;
£195 for each additional class.**

The costs above include official registry fees but do not include VAT. If your application faces objection or opposition, our further work will be charged based on our hourly rates.

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** - Trade marks can usually 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 territory of interest.
- » **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.

YOUR CORE TEAM

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IP SOLICITOR



SARAH TALLAND
PARTNER
TRADE MARK
ATTORNEY



MARIA MUNTEAN
ASSOCIATE
TRADE MARK
ATTORNEY



A PROVEN APPROACH

OUR ACCOLADES

You can be truly confident in our abilities – we are recognised as a top-tier firm in Europe, having received accreditations from the IP profession's leading benchmarking organisations and programmes.



An excellent firm to deal with. They have invested in gaining a thorough understanding of our approach to projects, their communication is timely and concise, and their advice is easy to understand.”

Chambers & Partners, 2022

A key strength of Potter Clarkson is their combination of expert attorneys with solicitors, which gives comprehensive advice on highly technical matters using patent attorney expertise and solicitor know-how, as well as commercial and branding matters with trade mark attorneys and solicitors working together.”

Legal 500, 2022



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