

CONSIDERATIONS FOR DECIDING WHETHER TO HAVE A TRADEMARK SEARCH AND OPINION PREPARED

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Trademarks often play a vital role in branding and marketing strategies for companies as they allow consumers to easily identify the source of goods offered for sale. In addition to selecting potential trademarks that fit a particular business marketing strategy, it can be critical to determine whether a mark is likely to be registered or to create potential legal liabilities prior to use or even filing the initial trademark application. One strategy for gathering potential information about a proposed trademark is to have a comprehensive trademark search and opinion prepared. Comprehensive trademark searches and written opinions can be useful for:

1. Determining the likelihood of being able to register a proposed trademark;
2. Determining the likely scope of protection provided by a proposed trademark;
3. Providing guidance as to how the mark should be filed (e.g., whether to include a logo with the mark); and
4. For determining whether trademark infringement may be a concern if the proposed trademark is used.

A comprehensive trademark search typically includes searching the following areas:

1. U.S. federal registered marks;
2. U.S. state registered marks;
3. Common law marks (from articles and product announcements);
4. Domain names;
5. Business names listed in Dun and Bradstreet; and
6. Corporate names registered with any of the states of the US. The search results are typically organized into booklet form and provided to you for consultation while reviewing the written opinion.

Risks associated with not preparing a trademark search and opinion prior to filing the trademark applications include, but are not limited to:

1. Having to change advertising;
2. Having to pull product from distributors and store shelves;
3. Having to change your product name;
4. Having to explain to current or prospective customers the reason for the change;
5. Losing the time, money and expense involved with selecting the trademark and filing a trademark application; and
6. Legal fees and possible damages resulting from an accusation of infringement.

While all of our clients are notified of the advantages of preparing a trademark search and opinion prior to filing a U.S. trademark application, some choose to accept the above risks and not conduct a search or have an opinion prepared prior to filing the application. Normally, we

advise that the choice of whether to have a trademark search and opinion prepared should be determined in a fashion similar to any other business decision.

In our opinion, the potential cost/loss resulting from the above risks should be calculated and compared to the cost of having the search and opinion prepared. Then, it is a judgment call for the client as to whether to have a search performed. For example, if you are going to launch an expensive advertising campaign in the U.S. using the proposed trademark, then it may be very worthwhile to try to determine whether the use of the proposed trademark will create liability and whether the use of the proposed trademark is likely to be protectable prior to making the advertising investment.

If you have any questions regarding your trademarks and related branding strategy, please contact Garcia-Zamor Intellectual Property Law.