

Searching and watching

Felicity Hide and Henry Schlaefli
3 December 2020



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Why search?

- “Freedom to use”?
- Assess defensive position against potential claims
- Assess possibility of registration and future enforcement position
- When expanding goods/services or territories
- When altering mark





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Search what?

- Boult Wade Tennant LLP
- Boult



- Even tabbed shape



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How will you use it?

- House mark
- Product/service mark
- Strapline
- With other marks



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What will you use it on?

- Goods/services in 45 classes
- Assess which class
- Assess whether “similar” classes to be searched
- “all of class 9” vs. “software” vs. “audio processing software”



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... and where?

- Worldwide
- Regional
- Country-specific

- Brings in issues of
 - Translations – by meaning
 - Transliterations – by pronunciation
 - Equivalentents (especially China)



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As well as searching registers...

- Meaning in other languages?
- Is it an acronym?
- Would someone in the industry know its meaning?



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Put together a search strategy, considering:

- ID searches worldwide/regionally;
- Detailed searches in key territories
- Common law searches in territories where those are recognised – especially UK, USA, Canada
- ... and consider doing these in sequential steps to save costs



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What the searcher does

<input checked="" type="checkbox"/> Rule	<input checked="" type="checkbox"/> Phonetic	Questions
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Identical Same Class
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One Letter Added
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One Letter Suppressed
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One Letter Replaced
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Two Letters Added
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One letter added, one letter replaced
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One letter added, one letter suppressed
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Two Letters Replaced
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One Letter Replaced, one letter Suppressed
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Two Letters Suppressed
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 8 letters
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 7 letters
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 6 letters

*Please note that only selected rules will be run when the query is executed



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What the searcher does

Strong Word(s)	Weak Word(s)	
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 2 letters, suffix 2 letters, 1 other letter in common
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 2 letters and 3 other same letters, last letter in common
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Suffix 2 letters and 3 other same letters, first letter in common
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 3 letters and 2 other same letters, last letter in common
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Suffix 3 letters and 2 other same letters, first letter in common
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Suffix 3 letters, prefix 2 letters
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Prefix 3 letters, suffix 2 letters
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Sequence of consonants, 1 vowel
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	String of 3 letters
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	One letter replaced, same structure
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Consonant Sequence, 1 vowel in common, same structure
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Consonant Sequence, same structure
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Two letters replaced, same structure
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	Multiword 1 identical word

*Please note that only selected rules will be run when the query is executed



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What the advisor does

CORSEARCH Inbox | Order Online | Cart(0) | Language: English | Settings | Help | Training | Contact

Screening [Enter Reference Info](#) Felicity Hide | Text Size | Translate

44 of 54 | Back to Query | Chart | New Screening

View: [Grid] [Table] [List]

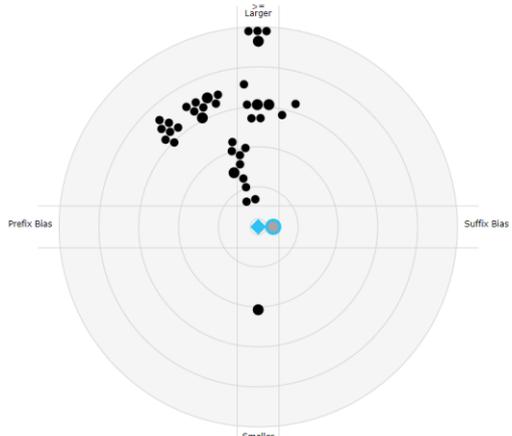
Mark on Web | EUTM | Company on Web | My Favorites | Pharma To

Results 54 of 54 Reviewed 1

0% FULL RESET

RESET SCORE UNTAG MARK READ MARK UNREAD

<input type="checkbox"/>	▼ %	▲ DB	▲ Mark	Annot.	Status	IC	Owner
<input type="checkbox"/>	100	EU	BOULT		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	100	EU	BOULT		Registered	16, ...	Boult Wade Tennan
<input type="checkbox"/>	100	GB	Boult		Registered	32	UK Boult Wine Limi
<input type="checkbox"/>	100	GB	BOULT		Registered	15	Christopher Boult
<input type="checkbox"/>	100	EU	BOULT and Design		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	100	EU	boult and Design		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	100	GB	BOULT IN		Registered	16, ...	Boult Wade Tennan
<input type="checkbox"/>	97	GB	BOULT ON		Registered	16, ...	Boult Wade Tennan
<input type="checkbox"/>	94	EU	BOULT WADE		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	93	EU	boult bites		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	88	GB	BOULT WADE & TENNA...		Archived	35	Boult, Wade & Tenn
<input type="checkbox"/>	88	EU	BOULT WADE TENNANT		Registered	16, ...	Boult Wade Tennan
<input type="checkbox"/>	88	GB	BOULT WADE TENNANT		Registered	42	Boult Wade Tennan
<input type="checkbox"/>	88	GB	BOULT, WADE & TENN...		Archived	42	Boult, Wade & Tenn
<input type="checkbox"/>	86	GB	Boultier		Registered	45	Andrew Joannides;
<input type="checkbox"/>	84	EU	BOULTVIEW		Registered	9, 3...	Boult Wade Tennan
<input type="checkbox"/>	83	EU	BOLT		Registered	9, 3...	Bolt Financial, Inc.
<input type="checkbox"/>	83	GB	BOLT		Registered	9, 3...	Bolt Financial, Inc.
<input type="checkbox"/>	82	EU	BoultRenew		Registered	9, 1...	Boult Wade Tennan
<input type="checkbox"/>	74	GB	nc newbould commerci...		Registered	36, ...	Newbould Commer
<input type="checkbox"/>	74	GB	NEWBOULD COMMER...		Registered	36, ...	Newbould Commer
<input type="checkbox"/>	72	EU	La grande famille des p...		Registered	9, 3...	D2D2
<input type="checkbox"/>	68	WO	BOLDT		Registered	35, 45	bokIT AG



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Screening Enter Reference Info

Edt Tags: ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ ■ Show: [All Records] Find and Highlight More View:

Tag All [] Untag All [] Sort by: Please select a sort option

<input type="checkbox"/>	Mark <input type="button" value="↕"/>	Country/Jurisdiction [...]	Status/Status Date	Owner/Company C...	Goods/Services (Brief)	Notes
<input type="checkbox"/>	eu 7	Boltian	Jurisdiction: European Union (EUTM) App No: 011767761 Reg No: 011767761 App Date: April 25, 2013 Reg Date: August 19, 2013	Registered August 19, 2013	Owner: Karol Martinka	access to websites relating to music; providing of websites relating to music; providing of... (Int'l Class(es) 41) Songwriting, music composition services; publication of musical works; production of music; production of musical works in a recording studio; production. (Int'l Class(es) 45) Licensing of intellectual property; licensing relating to music. (Int'l Class(es) 09) Scientific, nautical surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments. (Int'l Class(es) 16) Paper, cardboard and goods made from these materials not included in other classes, printed matter; bookbinding material; photographs; stationery; adhesives... (Int'l Class(es) 36) Telecommunications. (Int'l Class(es) 42) Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer... (Int'l Class(es) 45) Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet...
<input type="checkbox"/>	eu 8	BOLT	Jurisdiction: European Union (EUTM) App No: 017996306 Reg No: 017996306 App Date: December 5, 2018 Reg Date: February 17, 2020	Registered February 20, 2020	Owner: Bolt Financial, Inc. Correspondent: Anne Yves Lacaze-Masmontiel	(Int'l Class(es) 09) Downloadable software for use in electronic transfer of money for others; downloadable software for use in electronic funds transfer; downloadable. (Int'l Class(es) 35) Subscription-based billing for online merchants; business administration services for processing sales made on the internet; business organisation; business consultancy; business. (Int'l Class(es) 36) Electronic transfer of money for others; electronic funds transfer; services for making and processing payment transactions with credit cards; debit. (Int'l Class(es) 42) Providing temporary use of non-downloadable software for use in electronic transfer of money for others; providing temporary use of non-downloadable... (Int'l Class(es) 45) Payment services in the nature of providing onboarding solutions for merchants; namely, financial fraud detection services; identity verification; identity validation. (Int'l Class(es) 09) Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; computer software; bank.
<input type="checkbox"/>	eu 9	BOLTECH and Design 	Jurisdiction: European Union (EUTM) App No: 018196178 Reg No: 018196178 App Date: February 13, 2020 Reg Date: June 19, 2020	Registered June 25, 2020	Owner: Connection Power Protection Pte. Ltd Correspondent: FOX WILLIAMS LLP	(Int'l Class(es) 09) Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; computer software; bank.

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For common law results...

<input type="checkbox"/>	DNN 15	BOLT.COM 	Domain Status: ACTIVE	02/14/2028	Company: On behalf of bolt.com owner	
<input type="checkbox"/>	DNN 16	BOLT.NET	Domain Status: ACTIVE			
<input type="checkbox"/>	DNN 17	BOLT.ORG	Domain Status: ACTIVE			
<input type="checkbox"/>	DNN 18	BOLT.INFO 	Domain Status: ACTIVE			
<input type="checkbox"/>	DNN 19	BOLT.BIZ 	Domain Status: ACTIVE			
<input type="checkbox"/>	Web Results	Mark	Web Page Status App. Date Reg. Date	Page Title	Abstract Correspondent	Co
<input type="checkbox"/>	WEB_1	 BOULT 	Web Page Status: Accessible	BOULT	Abstract: BOULT...	
<input type="checkbox"/>	WEB_2	 Boult Wade Tennan 	Web Page Status: Accessible	Boult Wade Tennan	Abstract: Boult Wade Tennan ...	
<input type="checkbox"/>	WEB_3	 BOULT WADE (UK) LIMITED 	Web Page Status: Accessible	BOULT WADE (UK) LIMITED	Abstract: BOULT WADE (UK) LIMITED...	
<input type="checkbox"/>	WEB_4	DennisBoulServices	Web Page Status: Accessible	DennisBoulServices	Abstract: DennisBoulServices...	
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When/if conflicts are found

- Consents
- Revocations
- Invalidities
- Full scorched earth – if cascade of rights
- “Choose a different mark”



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Risk assessment, risk tolerance

Use:

- Google (with caution)
- Local opinions

Ask:

- Importance – total company rebrand down to limited edition strapline...
- Risk tolerance
- Budget for future disputes



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What searches might not cover

- Database errors or omissions (esp. some territories)
- Local equivalents/translations/transliterations
- Common law rights
- Stealth filings
- Late filings further to priority claim – consider top-up searching after six months/ahead of launch



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What is “watching” and why should I do it?

- A regular report of newly filed trade mark applications
- Can identify potential infringers at an early stage
- Allows an opportunity for early dispute resolution
- Can identify the activities of your competitors
- Separate task to brand monitoring



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Watching strategies

- Free or passive watching – EUIPO/UKIPO only
- Regular watching service
- Worldwide and all class watches
- Competitor watches
- Pre-launch watch



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Watch Type	Class(es) Watched	Mark Watched	Mark Found	App.No. of Mark Found	Jurisdiction	Class(es) of Mark Found	Owner of Mark Found	Opposition Deadline
World Watch	9,16,35,41	GO	GOSHIP.COM  No cases with Mark Found See watch notice for verbally similar marks	1863426	CA Canada	35, 39	Pittsburgh Logistics Systems, Inc., 3120 Unionville Road Building 110, Suite 100 Cranberry Township, PA 16066, United States of America  No cases with Owner of Mark Found	January 4, 2021
World Watch	9,16,35,41	GO	GO  557 cases with Mark Found See watch notice for verbally similar marks	1915843	CA Canada	05, 21, 30, 34, 41	TS BRANDCO INC., 40 King Street West Suite 2100 Toronto, M5H3C2, Canada  No cases with Owner of Mark Found	January 4, 2021
World Watch	9,16,35,41	GO	ARIS ONE & GO   No cases with Mark Found See watch notice for verbally similar marks	652162	PT Portugal	09	PATRICIO GORDO SANCHEZ, Spain  No cases with Owner of Mark Found	January 5, 2021
World Watch	9,16,35,41	GO	GONEUTRAL  No cases with Mark Found See watch notice for verbally similar marks	652362	PT Portugal	01, 04, 09, 12, 36, 37, 39, 40, 42	SEEDSPARADISE UNIPESSOAL LDA, Portugal  No cases with Owner of Mark Found	January 11, 2021

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Brexit?

- UK search reports now vs post 21 Jan
- A lot more register clutter
- Will more cited marks mean more oppositions?



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Benefit and proportionality

- Cost saving by early dispute resolution
- Register gives an indication of real life
- Competitive advantage
- Budget
- Proportionality
- Notification and opposition



Thank you

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