

Trademark Searching and Watching

Rothwell Figg's Trademark Searching and Watching group combines experience and a 360-degree view of the trademark landscape to help clear the availability of a trademark. By obtaining an objective risk assessment, clients can decide what level of risk is acceptable, adopt and use marks with confidence, and file appropriate applications for registration in what can be a complex, ambiguous legal area in the development of valuable brands.

The number of registered and pending marks has increased dramatically over the years. This, combined with the explosion of available data, means that almost every trademark search will generate some results which could raise questions. Watch services, too, now tend to provide an unwieldy number of results. Almost every search now generates at least dozens of immediate decisions concerning the level of risk each may present.

With so much information coming from so many sources, conducting searches for reasonable fees without compromising on the results is a challenge. Meeting this challenge requires the trademark lawyer to separate results which do not present any likely conflict from those which do.

At Rothwell Figg, it all comes down to experience and commitment. Our team of attorneys has advised clients on thousands of trademarks. Our experience includes the trademark application process and a strong sense of whether the Trademark Office may find a mark to be registrable and prosecuting the applications through to registration; experience in challenges to the applications before the Trademark Trial and Appeal Board; and leading-edge experience in the federal courts where the trademark rights are challenged or form the basis for challenging others. This all comes into play to help us craft opinions on the availability of new terms to be used by our clients as their trademarks.

We help to ensure that our clients neither chase after every mark filed in the Trademark Office nor overlook a mark which may present a risk to their brand. In the hands of Rothwell Figg's practitioners, the baseline direction of a search is enhanced by judgment that only comes with – again – experience.

These issues are exacerbated when searches are global. We have access to databases which allow us to identify conflicts in other countries. We also have a worldwide network of experienced associate lawyers and firms – many of whom we have known personally for decades – to assist us in understanding the specific and unique legal landscape in each country, as well as prevailing local customs. These in-country lawyers are an invaluable resource in helping to avoid missteps and legal entanglements.

An everyday example of this is where we discover a mark which we believe may be problematic. We have a spectrum of available actions, from demanding the other party stop to assessing whether the risk poses a serious business threat. But there are also situations in which we have had to assess whether the advantages of challenging a mark would be outweighed by the potential social media battle that would result. For example, the other party, highly reliant on social media, may be better positioned to “win” in the eyes of consumers. In one such case, the client weighed the modest risk of trademark infringement versus the higher risk of bad publicity to the brand and company overall, and refrained from acting.

Instead, they chose to conduct a heightened campaign to monitor the other party's activities in case the modest risk levels changed.

By integrating the power of search, the strategic thinking that comes with experience, and above all, a relentless commitment to focusing on what each client needs (even if they may not be fully aware themselves), Rothwell Figg's Trademark Searching and Watching practice delivers a singular level of knowledge and business orientation for each and every client.