

Limitations on Trade Mark Searching / Due Diligence

Common Law Rights

Unless indicated otherwise, the search has not covered common law rights. In the UK, rights can be granted to a trade mark owner through use as well as by registration. A search of trade mark registers will not locate any such rights acquired purely by use. If required, common law searches can be conducted.

Accuracy of Search

There is generally a short delay between marks being filed and then entered onto commercially-maintained/Registry databases which are searched. Recently filed trade marks may not be located. If necessary a further update search can be conducted at a later date. In addition, HGF Limited cannot be held responsible for inaccuracies and/or omissions in the commercial databases searched.

Which parts of the search report HGF reviews

Sometimes, the HGF attorney will use the TMgo365 platform provided by Clarivate CompuMark to search for potentially relevant marks. (CompuMark is the commercial search provider we instruct to conduct searches and which provides HGF with the raw data that we analyse). The TMgo365 platform may list hundreds or thousands of trade marks, which the HGF attorney will review to select those which he/she considers most relevant. At other times, the attorney will instruct an initial report to be provided by a CompuMark analyst. As regards Trade Mark Register search reports provided by a CompuMark analyst, these come in two parts. The first part consists of the selections made by the CompuMark analyst of potentially relevant marks. Such marks are selected from the second part of the report which consists of all marks located by the search program devised by CompuMark. This usually consists of many pages with each page containing brief details of many marks.

In providing our analysis we only rely upon the selections made by the CompuMark analyst in the first part of the report. We do not as a matter of course review the second part of the report. To fully analyse the second part of the report would substantially increase costs.

Potential conflicts identified in search results

If our analysis of the search results identifies a potential conflict of interest in HGF providing advice, although we can report this trade mark to you, we will be unable to provide you with our own comments. If this situation arises and you wish to receive our comments/advice you will need to let us know. We will discuss the potential conflict internally to decide if we are able to advise you further in this matter.

Applications claiming priority

Applicants for marks which have been filed in member states of the Paris Convention or the World Trade Organisation (i.e. most countries in the world) can base an application in the UK or European Union (EUTM) on a trade mark filed in such a country. Such an application can claim rights dating back to the filing date of that overseas application if the UK and/or EUTM application is made within six months of the overseas application. This might mean that after the search is carried out, an application is then filed in the UK or EU which enjoys rights backdated to the date of an overseas filing. In this situation, the mark would not of course have been revealed by the search results. This is relatively unusual but happens occasionally.

European Union Trade Marks / Brexit

The EUTM system grants enforceable rights in the in the 27 member states of the EU but NOT THE UK. The UK left the EU wide trade mark system on 31 December 2020. This means that from 1 January 2021 EUTM registrations (including EUTMs obtained by designating the EU under the Madrid International trade mark registration system) no longer cover the UK. However, to protect owners of EUTMs, the UKIPO automatically created cloned UK trade mark registrations with the same application/priority dates.

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A search of the EUTM register alone will not locate all potentially conflicting marks registered in EU member states. Such national rights can block the use and registration of a EUTM or a national trade mark application in a country. If necessary searches of overseas national trade mark registers can be organised.

Territorial Coverage of Search

Unless otherwise indicated, the search only covers the availability for use and registration of the mark in the UK. Please advise if you wish the search to be expanded to cover other territories.

Identical Searches Only

If the search has been limited to cover identical trade marks only, this provides only a narrow and limited form of clearance for the mark. Specifically, such searches will not locate marks which are similar and may constitute obstacle to use and registration of the mark searched.

Famous or Well-Known Marks

Owners of well-known marks may be able to prevent the use of a mark which is the same or similar to their mark, even if the proposed mark is to be used on dissimilar goods/services.

Knockouts

Where a search has found a mark/right which we believe significantly puts into question your likely right to use and/or register your trade proposed mark, we may terminate the search or preparation of the search report early to reduce expense. If you decide to go ahead despite what we have found, please let us know so that we can advise whether it is necessary to carry out additional searching.

Descriptiveness

Generally, trade marks are not registrable if they are descriptive of the goods/services claimed. It is not practical for us to check this except in obvious cases, since the range of terms in any commercial activity is large. You are frequently in the best position to know the terms used in your business to denote products or services or characteristics of them. Please let us know if you believe there is a problem so that we can assess it.

Cost Effectiveness

It is necessary to make a judgement concerning the scope of a search carried out your behalf unless the search is conducted in a very elaborate and consequently expensive way. This is especially the case if you have placed a cost limit on the search.