

# Is my trade mark available?

Before using or registering a trade mark, you need to check whether it is available. The only sure way to find out if your trade mark is available to be used or registered, is to carry out a comprehensive trade mark search.

You need to search both the marketplace and registered trade mark databases.

The effects of not checking whether your trade mark is available for use before starting to use it can be serious.

You could be:

- sued for trade mark infringement
- forced to stop using the trade mark, and
- forced to pay damages and costs.

## How do I check whether my trade mark is already being used?

To be confident your trade mark is exclusive to you and your business, you not only need to search the official trade mark databases, but need to know what is used in the market. A search is critical and quite complex. It should be conducted by an intellectual property specialist.

Our searching strategy for each trade mark depends on:

- the nature of the trade mark
- the trade mark's presentation
- the goods or services (or both) on which it will be used, and
- the country and database being searched.

## Trade mark databases

A J Park's specialists search trade mark databases for identical trade mark applications and registrations, as well as any confusingly similar trade mark applications and registrations that could prevent you from using and registering your trade mark.

Trade mark databases are split into 45 classes of goods and services. It is important to be familiar with these classifications and their inter-relationship when searching.

## Marketplace searches

Your search needs to go beyond the registered trade mark databases. This is because in some countries, it is possible to get rights in a trade mark simply by using the trade mark for a long time. It is important to search the market place to find out what other businesses are doing before starting to use a trade mark. You may find that others use unregistered trade marks, which may prevent you from using and registering your trade mark.

## What are the pitfalls of DIY searching?

Often when an individual or business chooses to undertake their own trade mark clearance search, they go no further than entering the exact trade mark as the search criteria.

While you might find an exact trade mark, you still have no idea whether there are similar trade marks lurking on the database or are in use. As New Zealand and some other countries have infringement laws that extend to cover 'similar' trade marks, any search needs to keep this in mind.

## How do I search overseas trade mark registrations?

If you plan to export goods from New Zealand, then you should clear your trade mark in each of the countries where you will use your trade mark.

Some countries offer online searching of trade mark databases. The way trade marks are entered onto a database differs between countries. You need to be familiar with the differences to have a reasonable chance of finding potentially relevant trade marks.

It is essential to check availability of any new trade mark before investing in its development and use – the risk of not doing so can be expensive. If you would like A J Park to carry out a search for you, please talk to us.

Call A J Park for the best trade mark searching advice in New Zealand. We'll help you protect your valuable trade marks.

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