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## factsheet

## TRADE MARK & MARKETING CLEARANCE

Before a new trade mark is adopted, its use should be cleared by an infringement search on the trade marks register in the relevant territory, and preferably also in the marketplace.

This also applies to existing trade marks if they are to be used for new products or services of a different kind – for example, extending a footwear business into selling handbags, or a motorcycle manufacturer beginning to offer leather jackets.

Clearance searching can be vital to prevent having to alter literature and packaging after stocks have been ordered and supplies obtained – something which can then mean considerable cost.

It is necessary to check not only for an identical trade registration or application for your kind of business, but also anything confusingly similar in respect of other goods or services – an energy drink named *Viagrene* was held to infringe the *Viagra* drug trade mark registration, for example.

Because of the complex issues which can be involved, making a sufficiently comprehensive search and interpreting its results should preferably be handled by a trade mark attorney, who will be familiar with the specialist area of law involved.

Language is another consideration if you intend to market overseas. For example, if you are in the giftware business and exporting to Germany, you have to be careful since the word *gift* in German means 'poison'.

Be careful also that you do not inadvertently infringe through mistaking something as a generic term in the public domain when it is, in fact, a trade mark registered by someone else who will object strongly to your use and may threaten legal action.

For instance, *Yellow Pages* may be a generic term in the USA but in the UK is a registered trade mark of Yell Ltd for classified directory services. Conversely, *Telex* is a term in the public domain in the UK in respect of telecommunications, but a registered trade mark in Canada of AT&T Canada Corp.

Take care also about using words or symbols protected under other legislation than trade marks, such as the Olympic and Red Cross names and symbols, or the words 'Bank' or 'Royal'.

Marketing another company's products as a independent distributor - or supplying parts, accessories, consumables or repair services for another company's products – needs particular care as well. For example, describing oneself as a '*Honda dealer*' is not simply the same as '*dealing in Honda cars*', and a '*part for a Honda car*' can come from anywhere, whereas a '*Honda part*' should be Honda original equipment.

