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Craig Bailey has been with Questel-Edital for over seven years and has been involved in various stages of product development, particularly with regards to implementing client feedback. Recently, he has been spending much of his time conducting seminars in the new Member States of the EU on the value of trademark searching and watching



Searching and monitoring trademarks

The service-provider's perspective

The concept of searching for existing trademarks before filing an application has been in practice for about 100 years. Manually performed in the early years, technology now streamlines the process with algorithms and search strategies that help the analyst make more focused selections out of electronically-generated listings.

This is not to say that the work has got any easier. Databases of these marks continue to increase in size and the broader results require the analyst to spend a fair amount of time sorting through information that might not have previously been considered. While generating a list of trademarks might almost be immediate, selecting the most relevant information remains a human process that requires a good methodology and experience.

We have certainly advanced far beyond those days in which a few dedicated visionaries travelled around with microfilm cameras taking pictures of each individual mark in the journals or compiling 'punch-cards'.

Today, most patent and trademark offices have their databases available electronically. In some cases, the service providers go the extra mile and create their own electronic version of the database by scanning the old journals and encoding the information. This is no small task and it requires patience and skill to produce.

The challenge – creating a usable product

The demand for reliable information creates needs that must be answered by the service providers. These companies have the knowledge and expertise to ensure that practitioners have the most accurate and up-to-date information presented in a professional report that can easily be forwarded to their clients or superiors. They are pressed to provide this in a timely fashion and their results

are expected to reflect a variety of perspectives.

Here at Questel, the work begins with the preparation of a database. Any company trying to create search capability across multiple registries must adapt the information they receive from the official patent and trademark offices to make it searchable on their interface. This is not always an evident task as many offices provide their data in assorted formats.

Of course, other issues regarding language (and alphabet), unique fields, update frequency and many other variables add to the challenge and this is why there are only a few different companies that have 10 or more registries available on their interface.

The full availability search

Deciding what search will best suit your needs can be a daunting decision. Sit down with 10 trademark attorneys and ask about their searching strategy and you will likely have eight to 10 unique answers to your question.

Clearly, a full availability search is considered to be the safest route. Algorithms covering the simple (1 letter added, 1 letter suppressed, 1 letter replaced...) to the more complex (anagrams, sequence of vowels or consonants, mid fix...) are searched both alphabetically and with phonetics to reach an exhaustive listing of possible matches to existing applications and registrations that might present a problem.

Sometimes, to keep the lists manageable, elements will be excluded that produce a lot of irrelevant hits. After this, a list is generated and the analyst will make a selection of the most relevant marks and place these at the front of the report with the full details of each mark selected. A listing of all the marks generated by the software is then shown to the client so it is aware of other possibilities not brought to the forefront by the analyst. This basic format has been

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adopted by most of the major service-providers with some variances.

The 'human factor' is an important consideration in this process. Technology is used for many stages, but the expertise of the analyst is imperative for a good search result. While we attempt to create a system of consistency, search selections are rarely identical because the perceptions of different analysts will create variations in the final reports. Nonetheless, the most relevant marks will generally be included in the final selection, even with different searchers.

As this is a service to the legal sector, the need for transparency is imperative. These reports are intended to reflect the ability of a mark to be registered and clients expect to see how the information was compiled and all elements that have been applied to the search should be presented. Another important aspect shown in the reports of some companies is the 'register status' that does not merely show the last date the system was updated, but also the last application and publication dates of marks searched giving the attorney a more accurate image of what period the search has covered.

Self-searching online

In order to cover the different needs of their clients, search companies provide different types searches. Phonetic searches and prefix, suffix or midfix are sometimes available. Many attorneys prefer to have a more 'hands-on' approach however and 'do-it-yourself' databases have been around almost as long as the personal computer. We introduced our first in 1997 with the original version of CaTaMaran, which was a CD-ROM including the applications and registrations of OHIM (Community Trade Marks, CTMs) and, as the internet became a more viable, worldwide option these tools have become available online.

Quick searches done online will seldom cover all the possible matches to a mark and most service providers try to separate this from the illusion that such searches are able to indicate full availability. Nonetheless, some products have been introduced recently that are much more effective and an online similarity search based on a limited number of algorithms and phonetics is more reliable today than ever before.

Some searchers will try to use wildcards and other operators to perform their own 'availability search'. This is a manual work that requires a lot of thought and concentration and it is difficult, if not impossible, to cover all possibilities. Take, for instance, the word 'KEAUNNYA'. The strategy of some searchers might look something like this (the asterisk * is our wildcard):

k*aunnya or ke*aunnya or k*nnya or c*nnya or...

I think you get the idea.

It is entirely possible that potential matches such as Commia or KONYA-Döner might be missed using this approach and these are only phonetic matches. Take a letter added or replaced or other algorithms and a potentially relevant mark like 'Kamaya' could slip right by.

Nevertheless, these online databases provide a valuable service by providing instant results that can be helpful before deciding to go to the next level. Clients are still served with results that can help avoid problems later on.

Professional results v easy interface

The real challenge is creating a database that is also user friendly. A special logic must be applied so someone who checks in a few times a year is not intimidated, yet an experienced searcher can still produce results befitting the firm or department he or she represents. When adding new features based on client feedback, we still need to ensure the simple, online search based on mark and classes remains easy to carry out.

Information should be presented in professional formats and be easy to export into office applications such as Microsoft Word and Excel. It also needs to be clear enough that someone who is not a trademark professional understands the main points of the report when it is presented to him or her.

Result required yesterday

Today, speed and convenience are valued alongside reliability. Multiple database searching is in high demand and some countries can be under as many as three different jurisdictions. For example, in the European Union every country finds itself under its own national authority, the European CTM and the Madrid system of international marks. Only WIPO marks

claiming the European Union status can be valid in Malta as it is not a member of the Madrid Protocol.

For this reason, there is a rush among providers to have as many databases as possible in one place. These programs (including our own CaTaMaran Plus) allow searching among 20 or more databases in one operation. Results are all presented in English and within seconds.

In the case of CaTaMaran Plus, an advanced search uses up to 15 different algorithms (both alphabetically and phonetically) and allows slogans and translations of words with meaning to be included. The results are produced in seconds and presented in a detailed report in Microsoft Word.

Case study of searches using varied criteria on CaTaMaran Plus

Searched word: Keaunnya
Nice classes: 9, 16, 21

Identical search: No matches found

Search using wildcards in place of vowels and at beginning and end of searched word:

Kenye
Kanyathek

Phonetical identical search

Commia
KONYA-Döner
(identical other class)

Tailor-made similarity search using 15 algorithms alphabetically:

Kondia (1 letter added with phonetics)
MOONYAH (1 letter replaced with phonetics)
nonya-k (1 letter replaced with phonetics)
Kinonia (2 letters added with phonetics)

"Probably the best beer in the world"

Deciding the best way to search for the availability of a slogan can be difficult as one must decide if any of the words are so predominant that they should be searched on a "similarity" basis or if making identical matches will be enough. Usually a slogan will not have any unique words, but the meaning derived from the combination of the words will determine the approach that is needed.

The Carlsberg slogan is well known, but let us assume it is new and we are searching its availability. At Questel we have developed the CaTaMaran Plus tool for just such a scenario and our advanced searching allows for the input of strong words that can stand on their own and weak words that must be supported by other elements.

By listing 'probably' as a strong word we ensure finding all trademarks with 'probably' or a similar element. This is (probably) a good idea as this word would be unusual in class 32 and we would wish to see all possible connections.

Words like 'best', 'beer' and even 'world' would produce too many, mostly irrelevant hits on their own. If we group them together as 'weak words', only marks with a combination of two of the words will be listed. We also allow the searcher to modify and add to the criteria used so someone in France could include the French translations where needed or a search done in Slovenia could do the same in Slovenian.

Trademark watching

Before the 1970s, watching for trademark applications that might possibly infringe the rights of existing marks was done on a local basis by attorneys hoping to generate oppositions and other litigation work in their markets. The idea of watching registers around the world within one system was not even considered realistic. Until recently, a large number of trademark professionals

did not consider the need to outsource trademark watching (monitoring) for local clients. This changed for many with the ever-expanding coverage of the Madrid Protocol and, more recently, the introduction of the CTM. The service providers have become invaluable in their ability to simplify things to the point that the attorney only receives notices and can then decide whether the client needs to be informed.

Today, the results are delivered electronically encouraging a paperless workflow that many consider to be more ecologically responsible. This also means the work is becoming easier to follow and a well-organised office can handle a large portfolio of watched marks in a fraction of the time required 10 years ago.

Conclusions

Despite official patent offices becoming more organised with websites and other services, independent companies still serve their clients with a wider-array of options and high-quality results. Their services cut into the time required to perform both simple and complex tasks and, consequently, help offices to become more efficient and profitable.

No matter whether you are a single-person operation or whether you have more than 100 people, these service providers are valuable partners and colleagues in the task of protecting your trademark rights and those of your clients.

Word mark watching – similarity based on word element

Watched Mark
Edital

New Mark
TIDAL

Figurative mark watching – similarity based on logos

Watched Mark



New Mark
AXEN





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