

TRADEMARK SEARCHES – Are they worthwhile?

In this globalised world we live in today, finding a brand name that is apt for one's product and services is a challenge faced by every business.

With a borderless market facilitated by the ease of communication and transportation, businesses need to consider the availability of the mark not only in their local market, but also in the jurisdictions that they intend to venture into in the near future. This is where the challenge lies as there are a zillion prior marks existing in each jurisdiction, with more marks being applied for each day, especially in the European Union, United States and China.

Most businesses choose a brand, then go on to spend a large sum of money on the marketing, advertisement and promotion of the brand in Malaysia, creating brand awareness among Malaysians and regular tourists alike. However, when they venture into a foreign market (which most businesses would have planned and accounted for in their initial business strategy), they do not have 100% assurance that they can use the same brand as that which they created and nurtured in Malaysia.

We have had people who come to us too late into their business plans who are unable to use their local marks overseas due to a substantially similar or identical mark existing in that particular foreign country, and thus had to

1. Spend more money on designing a new mark;
2. Spend more money on new advertising and promotional material (brochures, posters, Radio ads, TV ads, etc); and
3. Spend more money on new packaging.

What can brand owners do to avoid their brand from being prohibited from entering another jurisdiction by the existence of a prior mark?

CONDUCT A TRADEMARK AVAILABILITY SEARCH!

This is why it is worthwhile.

A trademark search will enable you to ascertain whether the mark you intend to register is available for registration in all jurisdictions of interest under the relevant class of goods/services. This is to ensure that there are no other possible conflicting marks in the class.

With a search, you will be able to change your brand if there is a similar brand already on the register or pending registration in the various jurisdictions.

Whatever expenses incurred in conducting the search before the brand is chosen and then marketed will eventually save a company large sums of money, time and effort. A business would not need to start the whole branding process all over again.

Another important reason to conduct a availability search is to avoid infringing a third party's trademark, which would be a terrible start to venturing into overseas market as it will rack up legal fees in responding to the other party's allegations and it may cause negative publicity in the country and public you are trying to secure market share in.

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