

RAPID, GLOBAL TRADEMARK SCREENING: REVEALING THE POSSIBILITIES.

In today's crowded trademark environment, intellectual property (IP) professionals have to think globally and act rapidly. Both inside counsel and outside counsel must be able to assess the viability of proposed, new brands in markets around the world—quickly and cost-effectively. These realities have made trademark screening solutions like Thomson CompuMark's Identical Screening Search Plus (ISS Plus), more important than ever.



To understand the role of trademark screening and Identical Screening Search Plus, we spoke to two paralegals from two highly respected organizations: Kristen Koines, senior paralegal with Arent Fox LLP; and Sarah Beggs, currently a paralegal for Starbucks Coffee Company.

GLOBAL MINDSET

Clients everywhere are thinking globally when considering new trademarks and brands, Kristen Koines says. And that means screening proposed marks internationally.

"Clients today don't want to make large investments in a trademark they can only use in the U.S. because the reality is they will eventually want to use the mark in other countries," she says. "They may be manufacturing their product in another country and may want to register with customs. Or, if they are planning to market via the Internet, they want to make sure they have the ability to use the mark internationally."

Kristen notes that many clients also want to take advantage of the six-month priority filing window provided under the Paris Convention. Within six months

of filing an application for trademark registration in the U.S., brand owners may file in other Paris Convention jurisdictions and their application seniority will date back to the original U.S. filing date.

"If clients have an idea of where they might be going in the next three to five years, they will file a foreign application with the U.S. priority," she explains.

SCREEN EARLY

Paralegal Sarah Beggs says avoiding potential conflicts in key international markets early in the process is absolutely critical.

"When planning a broad product launch, it's a smart investment to screen more broadly early in the process," Sarah says. "ISS Plus is very helpful in providing a broad understanding of who has what marks in which countries or regions. It's great for getting a quick snapshot in multiple countries at a time. That's very helpful in determining the course of the rest of the clearance process."

Kristen agrees. "Marketing departments often get attached to a mark before they get permission to use it.



They want it right away. So we usually perform an ISS Plus at the same time as a U.S. clearance search to determine at the outset if there are any countries that would be off-limits. If a potential conflict is in a core target market, the client may decide to move on to another trademark. But it's important to know from the start where they can't go."

STATUS MATTERS

It's also important to know more than just the published date of a potentially conflicting mark. That's why Identical Screening Search Plus provides current trademark status information for 47 of the world's most commercially important jurisdictions—in addition to identical screening coverage for more than 200 registers worldwide.

"The status information is quite timely," Sarah says. "The more current the information, the more useful it is when making decisions about a potential mark."

Kristen of Arent Fox notes that having updated status information reduces the need for follow-up research on key findings. That saves time and money when referring a potential conflict to local counsel for their opinion on the mark's availability in a particular country.

"When I send the ISS Plus results to the local counsel, I'm able to provide more information on which to base their opinion," Kristen points out. "This saves the client money because we don't have to ask local counsel to get their own report and issue a full opinion. When you're going into 20 countries, requesting full opinions in all those jurisdictions is just cost-prohibitive. The information provided by the ISS Plus really helps us narrow down those opinions."

SPEED SAVES

Both paralegals agree that in today's fast-moving business environment, the speed of delivery for screening results is a critical success factor. "With ISS Plus, I've always had great turnaround time and great service. I'm really pleased," Sarah says.

Kristen points to the speed, ease and convenience of using the SERION® Analysis Tool to review Identical Screening Search Plus search results and report back to clients.

"The Analysis Tool really saves time when creating reports for clients. We can quickly export specific information to show the client what the higher risks or lower risks are, so they can make informed decisions quickly," Kristen explains, noting that clients appreciate

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receiving reports via email. "That's what they expect from us now. Back when I was an in-house paralegal eight years ago, we used to get these big, thick memos in the mail. Now, everyone wants to receive reports via email."

Kristen notes that accelerating the process of creating and delivering custom reports saves money, too. "With the old paper reports, first the paralegal would review the paper. Then it would go to the associate or partner to be written up. That takes a lot of time," she says. "Now, using the Analysis Tool, we can all look at the online report simultaneously and collaborate online. So it's much more efficient."

In fact, Kristen estimates that the Analysis Tool reduces the time to review results and create a custom report from five hours down to as little as one hour. "For a client doing 10 or 20 opinions a week, there is no way they would pay for five hours to review results and provide a report," she says. "These days, because many attorneys go back and forth between working in-house and at law firms, they know how it works. You can't sit there and say it took you that long to do something, because they'll say you weren't doing it efficiently."

THE RIGHT TOOL

The global trademark will continue to evolve. But no matter what direction it takes, both Kristen Koines and Sarah Beggs will continue to rely on ISS Plus for that critical, early "knock out" screening search to help manage risk—and costs.

"I've really been very pleased with ISS Plus," Sarah says. "It's a great screening tool and it's always delivered for me."

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