



WHY TRADEMARK CLEARANCE SEARCHES?



Jackson, Etti & Edu

It is not uncommon for brand owners or marketing heads to ask why they need an availability search before they apply for a trademark. After all, a clearance or availability search does not guarantee that the trademark will be accepted by the IP Office and consequently registered.

Well, the following short stories will buttress the point in this post.

In 1976, American TV giant company, News Broadcasting Corporation (NBC) rolled out a new trademark with a big "N".



In no time, [Nebraska ETV filed a lawsuit against NBC for trademark infringement](#). NBC had to settle out of court in damages in excess of \$800,000 for ETV to rebrand. Lucky NBC, they could retain their new mark after all. Meanwhile, a clearance search would have cost around \$2,000.

Not-so-lucky "Speakeasy" blog owner, Robyn Hatcher ([in her exclusive interview with Forbes' Kelly Watson](#)), had to quickly rebrand 'overnight' to avoid an expensive lawsuit from the registered trademark owners in the U.S.

A quotable quote from Hatcher in the Forbes blog post was, "As a first-time entrepreneur I jumped into the business naively. My research consisted of Googling the name and seeing what came up in the top searches. What came up were several companies that were completely different, so I considered myself safe." This summarises what many brand/trademark "creators" often do.



In Kenya, the hostile struggle for the trademark “BUPA” between [British United Provident Association Limited \(BUPA International\) v. BUPA Kenya Limited](#) led to stiff sanctions for the defendant and an order to “change its name to exclude the word BUPA”. In Nigeria, the famous case of [Niger Chemists Ltd v. Nigeria Chemists](#) lingers on, as there was no chance for the defendants to rebrand before paying heavily for their errors. Although, the Nigerian example will be regarded more as a case of bad faith. However, the lessons are pristine.

An availability search will do the following:

1. **Clearance:** Helps you determine if a trademark is available for application. While there are no 100% guarantees that there will be zero margins on the search report or that your application will be accepted, you can at least make an informed decision. Often times, you can amend or tweak the trademark or add a house mark to aid the application process.
2. **Avoid Infringement Actions:** If you use a trademark without conducting a search, your ignorance of a prior usage and registration will not be a defense. If you or your company is lucky, you will get off the hook with a Cease & Desist Letter. Otherwise, you could be facing a really expensive lawsuit and damages that could shut down your operations forever. It is that serious.

3. **Expose Bad Faith Applications:** Well-known brands can discover trademark squatters or bad faith filings by conducting ‘sweeping clearance searches’ across all the trademark classes. By doing so, they can avoid Bentley’s late show in the U.K., where the famous car maker was **denied its use of its house mark “Bentley”** and the popular “B-in-Wings” logo by Bentley Clothing. Bad faith filings in Nigeria can be cured by filing cancellation proceedings.
4. **Avoid Generic Names:** Often, an availability search will show if the “unique” name you are about to use in marketing a product or service has been severely used by others in that line of trade. Therefore, a clearance search will easily expose the frailty of the proposed mark.

If anything, marketing departments and brand designers need to conduct clearance searches before releasing a product or service into markets in Africa to avoid infringement suits for injunctions and damages. More so, the bad press that comes with it and the loss of potential investments.

In Nigeria, while there is no public electronic database, you can instruct a local agent to conduct availability searches with a turnaround time of 5 – 7 working days. Meanwhile, you can also conduct availability searches for logos, symbols, insignia and so on.



Below is a breakdown of how trademark clearance searches work in some African countries:

Country/Region	Mandatory Clearance Search	Electronic Search	Turnaround Time
African Regional Intellectual Property Organization (ARIPO; Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome and Principe, Sierra Leone, Somalia, the Sudan, the United Republic of Tanzania, Uganda, Zambia and Zimbabwe)	No/Highly recommended	Yes/available to agents only	15 – 20 working days
African Intellectual Property Organization (OAPI; Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, the Comoros, the Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, the Niger, Senegal, and Togo)	No/Highly recommended	Yes/available to agents only	15 – 20 working days
Angola	No/Highly recommended	No	Informal searches - 3 working days. Formal searches - 3 months.
Cape Verde	No/Highly recommended	No	10 – 15 working days
Democratic Republic of Congo	No/Highly recommended	No	10 – 15 working days
Ghana	No/Highly recommended	Yes/available to agents only	5 – 7 working days
Kenya	No/Highly recommended	Yes/available to registry officials only	7 – 10 working days
South Africa	No/Highly recommended	Yes/available to agents only	10 – 12 working days
Nigeria	No/Highly recommended	No	5 – 7 working days working days

As a brand owner, the foresight to protect your business is as good as your current protection for your IP rights.

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Jackson, Etti & Edu is a full-service law firm with a sector focus, rendering legal services to Nigerian, Pan-African and International clients in diverse jurisdictions.

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