Trademark Searching and Clearance

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I. Introduction

When should you conduct a trademark search? How do you plan the search and carry it out? How do you evaluate the results? This chapter takes you through the clearance process from start to finish. It also provides links to leading online sources of trademark data, where you can learn how to use the search tools offered by the United States Patent and Trademark Office (USPTO), commercial search firms, and non-U.S. trademark offices.

People search the Internet every day. Search engines and other online tools afford immediate access to a world of information. That world includes an array of databases offering information about trademarks. People are so accustomed to searching the Web that they might mistakenly assume that searching for a new trademark is just as easy as looking for used furniture on Craig’s List or esoteric facts on Wikipedia.

That is not the case. It takes skill to conduct a reliable trademark search. More specifically, it requires curiosity, intuition, patience, and attention to detail—and an understanding of trademark law. Doing it well is critical, because there is a lot riding on the search.

A trademark search is the critical legal step in the process of selecting a new mark. The search enables a trademark lawyer to determine whether a mark is

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available for use and likely to be registrable. For a business to launch a new product or service without first conducting a search is to flirt with commercial disaster. A search is necessary because, simply stated, trademark rights are granted on a first-come, first-served basis. In the United States, an individual or an organization obtains trademark rights by being the first in a given market either to use the mark or to file for (and ultimately obtain) its registration. Once the trademark owner obtains such rights, he, she, or it is entitled to stop newcomers from using similar marks in ways that are likely to cause confusion.

Thus, someone who contemplates adopting a new mark faces the risk that someone else may have already obtained rights to a similar mark in the same market. A trademark search is the primary means of assessing that risk. A trademark lawyer uses the search as a tool to determine, with a reasonable amount of assurance, whether the proposed mark is likely to be confused with a mark in which another party has already acquired rights. In the United States, this analysis takes into account the inherent similarity of the marks in appearance, sound, and meaning; the marketplace relationship between the newcomer’s goods or services and those of the owner of the preexisting mark; the inherent distinctiveness (or lack of distinctiveness) of the preexisting mark; and the other factors that courts consider in determining whether a newcomer’s mark infringes an established mark. At the same time, in addition to analyzing the likelihood of confusion, the trademark lawyer must also gauge the likelihood that the new mark will dilute any famous marks, because the owner of a preexisting famous mark can make a dilution claim without having to prove that confusion is likely.

A search is not infallible, but it is definitely a worthwhile investment. The failure to adequately search before adopting a new mark can result in considerable trouble and expense. A business that invests in bringing a trademark to the marketplace without assessing whether the mark is likely to cause confusion or dilution is putting that investment at risk. If it turns out that the mark infringes or dilutes another party’s mark, the other party can either enjoin the newcomer from using the mark or threaten litigation with the goal of forcing the newcomer to stop using the mark. In addition, a plaintiff who proves trademark infringement can seek disgorgement of the infringer’s profits, damages caused by the infringement (which may be trebled), the costs of the action, and, in
exceptional cases, reasonable attorney fees. A court may even order affirmative relief, such as the recall and destruction of goods bearing the infringing mark. Thus, a trademark search is an important and cost-effective precaution against financial loss and commercial disaster.

The trademark lawyer is ultimately responsible for advising the client whether the mark is available for use and registration, but the trademark administrator or paralegal (“Administrator”) can play an essential role in the search process—conducting some or all of the search, reviewing websites and other online resources for information about preexisting marks found in the search, and assembling the information necessary to communicate the search results to the client. These trademark professionals work together to make sure that the advice to the client is based on a thorough search and communicated clearly and accurately.

II. The Limits of Searching

Although the search process is intended to reduce the potential for infringement and dilution claims, the risk of challenge is never completely eliminated. Even an especially thorough search may not uncover every potentially conflicting mark, for several reasons.

In the United States, a newcomer to the search process might expect that it would suffice to check only the records of the USPTO. However, one cannot rely solely on a USPTO search, since registration with the USPTO is not a prerequisite to obtaining trademark rights in the United States. Many valid trademarks exist at common law without ever appearing on the federal trademark register. Thus, the search must encompass marks beyond those shown in federal applications and registrations, looking at marketplace use of unregistered marks and also at state trademark registrations (although state registrations do not always reflect actual use).

Searching common-law marks is easier said than done, however, since there is no single source that lists every unregistered mark in current use in the United States. There are many potential sources of information that could be searched, and it is not economical to try to search them all. Thus, the searcher must select
the combination of sources that he or she believes is most likely to contain relevant marks.

Even then, one cannot expect that every source will provide accurate, complete, and up-to-date information at the time the search is conducted. Every database has inherent blind spots. The U.S. practitioner’s most important data source, the USPTO, is never completely up to date, because a time lag exists between the time an application is filed and the time it appears in the search database. Thus, recently filed applications for federal registration will not appear in a search, even though the lag may be only a few days long.

Foreign applicants for federal registration under Section 44(d) or 66(a) of the Lanham Act (U.S. Trademark Act) (15 U.S.C. § 1126(d) and 15 U.S.C. § 1141f(a), respectively) may obtain an effective U.S. filing date that is as much as six months earlier than the actual U.S. filing date. These applications create a considerable risk in searching. A search could reveal no obstacles to a proposed mark, and a U.S. company could then file an application for the mark thinking that it had a clear path, only to have a foreign applicant “leapfrog” that application with a belated U.S. application based on an earlier foreign filing date. (For more information about preferences accorded to foreign trademark applications, see INTA, Topic Portal: Madrid System; INTA, Practitioner’s Guide to the Madrid Agreement and the Madrid Protocol.)

Searching outside the United States raises similar complexities. Countries based on an English law system (including the United Kingdom, Canada, and Australia) recognize common-law rights, and some civil-law countries also afford protection for corporate names or other marks that are not present on the trademark register.

Outside the United States, database currency can vary dramatically depending on the country, from a few days in some countries to many months in others. Unpublished applications may be inaccessible.

Even if databases were completely up to date, searching would still be an imprecise science. Trademarks do not always follow established rules of spelling, grammar, construction, punctuation, or meaning. Misspellings, word play,
unusual constructions, creative punctuation, and other inventive variations are commonplace, and they create unexpected pitfalls for searchers.

For all these reasons, it is possible to diligently perform and evaluate a search, and conclude that a mark is available, when in fact a direct conflict may exist, hidden from view. Since a search cannot completely eliminate risk, the realistic goal is to eliminate as much risk as the circumstances allow. The searcher can achieve this by understanding the shortcomings inherent in any search, by compensating for them as much as possible with intuition and experience, and by advising the client of the uncertainties.

III. Uses of Searching

Most searches are conducted for the purpose of determining whether a new mark is available for use, or whether use of an existing mark can be expanded to new products or new geographic markets. However, a search can be an important tool at other stages in the life of a trademark, as discussed in more detail below.

A. Availability Searches

As a general rule, a "clearance" or “availability” search should be conducted whenever one is selecting a means of identifying and distinguishing one's business, product, or service from those of others. Virtually all types of trademarks, service marks, trade names, and trade dress can be searched—words, phrases, numbers, letters, slogans, and logos, as well as distinctive package designs, product configurations, and retail interior and exterior designs—but not all of them can be searched with the same ease and comprehensiveness.

The test of availability is whether the mark is likely to cause confusion with a mark in which another party has already established rights. If confusion is likely, the mark will infringe and should not be adopted. If the mark is not judged to infringe, counsel nevertheless must also consider whether it is likely to dilute another mark.
In addition, a proper availability search also incorporates two other analyses: whether the proposed mark is distinctive and protectable and whether it is registrable.

1. **Ascertaining Distinctiveness**

In most cases, the mark that a client submits for searching will be distinctive and inherently protectable, but not always. Sometimes a search will reveal that the proposed mark is in fact descriptive or generic, and not a trademark. A descriptive term cannot be immediately protected as a mark, and a generic term cannot receive trademark protection at all. Thus, in some cases, the search reveals that the term chosen for use as a mark is in fact available for anyone in the industry to use generically or descriptively. In some situations a company might be satisfied to know that a word or phrase is free for use, even though others may be using it as well. More often a company is interested in a term that merits trademark protection, which it can use exclusively in its field.

2. **Ascertaining Registrability**

A search may reveal that the proposed mark, while protectable and available for use in the United States, is unlikely to be registrable. While this sounds like a paradox, it does occur with some frequency. Not all registered marks represent current, enforceable trademark rights. For example, the search may reveal that an identical mark is still registered, even though the registrant has in fact abandoned it or uses it only on a portion of the goods or services that appear in the registration. The risk of confusion in the marketplace with the prior registrant’s mark may be quite small or nonexistent in such circumstances, but the client must be advised that it faces problems in obtaining registration. The inability to register a proposed mark does not necessarily exclude it from consideration in the United States and other jurisdictions that recognize common-law trademark rights. Under common-law systems, a mark can be entitled to protection from infringement even if it is never registered. However, the client should understand that registration confers certain benefits, the most important being a presumption of nationwide rights in the mark effective as of the date the application is filed. In contrast, common-law trademark rights begin
only upon use and extend only to those geographic markets where the mark is
known. If the search suggests that the client will need to oppose a pending
application or cancel an existing registration in order to clear the way for
obtaining its own registration, counsel will want to apprise the client of how
much such a proceeding might cost and how long it might take, so that the client
knows the full implications of adopting the proposed mark. The prospects for
registration can be even more complicated if the mark is intended for use in
several countries, some of which recognize common-law trademark rights
without registration and some of which accord little or no trademark protection
in the absence of registration. In such situations, counsel will want to carefully
explain the implications of obstacles to registration on a country-by-country
basis.

3. Corporate Name Clearance

Corporate names usually require two types of clearance: (1) the trademark-type
availability search, described above; and (2) clearance with the Secretary of State,
corporation bureau, or similar agency in the state in which the corporation is to
be incorporated and in each state in which the corporation will qualify to do
dusiness. Under the latter process, the state agency’s role is limited to
determining whether a corporation can be formed or qualified under a given
name (i.e., recognized as a corporate entity under the laws of that state). It does
not determine whether the name can be used in the marketplace. Corporate name
clearance is necessary because most states, seeking to avoid confusion in state
record keeping, permit only one corporation to be incorporated or qualified with
a given name. It is wise, therefore, to make sure that the desired corporate name
is available before attempting to incorporate or qualify. This effort should
proceed in concert with the availability search.

4. Domain Name Availability

Separate and distinct from the trademark clearance process, but often closely
related, is the registration or acquisition of an Internet website domain name.
Since an Internet address is not, in and of itself, a trademark, a trademark search
is not essential if the registrant is merely seeking to create such an address.
However, if the proposed domain name will lead to a live website used in marketing the registrant’s products or services, often it is advisable to conduct some form of trademark search, comparing the proposed domain name with registered and unregistered marks and other domain names. In many situations, the domain not only will lead to a website but also will double as a trademark, and counsel will conduct a conventional trademark search.

### B. Other Uses of Searching

Although this chapter focuses primarily on availability searches, a trademark search is useful in several other situations. The basic principles outlined here for planning and conducting the search also apply in these situations, even though the analysis of the results serves a different purpose.

#### 1. Infringement Disputes

Search and investigation are essential steps before a trademark owner approaches a suspected infringer. The threshold issue in almost any infringement claim is, “Who was first?” Counsel should never send a cease-and-desist letter claiming a likelihood of confusion without first searching to see whether the client’s rights are indeed first in time over those of the recipient. The recipient of a cease-and-desist demand will want to conduct the same type of search to determine the parties’ relative priorities.

In addition, counsel for each party can also use a search to gauge the strength of the first user’s mark. The stronger the mark, the broader the scope of protection it will be given against other marks. Strength is in part a measure of a mark’s distinctiveness, and a search can help show whether consumers regularly encounter similar marks used by multiple companies, or whether the first user’s mark stands out from the crowd. A search may even show that the opponent’s alleged “mark” is really descriptive or generic.

#### 2. Trademark Registration

A search can provide information useful in responding to a USPTO examining attorney’s refusal to register a mark. Although the examining attorney has no
obligation to ensure that his or her decision on one application is consistent with another examiner’s decision on a similar mark, evidence that similar marks have been registered can nevertheless bolster one’s argument. For example:

- If the examining attorney claims that a word or phrase is descriptive, a search may show that the term appears in other registrations on the Principal Register without a disclaimer or claim of acquired distinctiveness.

- If the examining attorney cites a mark in a prior application or registration as confusingly similar, a search for similar third-party marks in that field may show that the cited mark is weak and not particularly distinctive. This arguably reduces the potential for confusion between the applicant’s mark and the cited mark.

3. Financings, Mergers, and Acquisitions

An ownership search of U.S. federal and state and foreign trademark registers is an essential part of the due diligence review whenever a company or one of its businesses is being sold, or when a company’s marks will serve as collateral in a financing. The search allows the buyer or lender to determine with greater assurance whether record title to the marks is in fact held in the seller’s or borrower’s name, and whether the trademarks are encumbered by security interests. It also allows the seller or borrower to warrant with greater confidence that the disclosure schedules listing its marks are accurate and complete.

4. Policing Infringement

Many trademark owners actively watch new trademark applications to see whether a third party has filed for a mark that could cause confusion with (and therefore infringe) the watcher’s established marks. A watching search takes the opposite perspective from an availability search—rather than determining the potential for confusion between the client’s proposed new mark and other parties’ preexisting marks, it determines whether other parties’ new marks are likely to cause confusion with the client’s preexisting marks. Watching searches can be conducted in one of two ways:
• The trademark owner can conduct its own search, periodically looking for new applications for marks similar to its own mark. Specifically, the searcher creates a template set of search queries designed to yield marks that are identical or similar to the client's mark, and then runs those queries weekly, monthly, or on some other regular basis.

• Commercial search firms offer watching services that serve the same purpose as a do-it-yourself watch service. Whether to outsource the watch to a commercial vendor will depend on the distinctiveness of the mark being watched and the geographic scope of the client's business. For example, if the mark contains extremely common elements (e.g., the letters MED in a health-related mark), a monthly watch may yield a large number of marks. If the searcher uses a database that incurs a charge for every trademark record retrieved, it may be less expensive to outsource the watch. If the search must encompass multiple countries, the do-it-yourself cost will be multiplied on such pay-as-you-go databases. Companies with large multinational trademark portfolios often use commercial watching services for convenience and because the trademark registers in some countries are not accessible online.

IV. Gathering the Basic Information for the Search

The first step in a search is to compile the necessary information to plan the search. Knowing the mark to be searched is not enough—much more information is required in order to effectively conduct the search and evaluate the results. The following is a list of questions that need to be answered before commencing the search.

1. What is the mark to be searched?

   • The searcher will want to verify the precise spelling of the mark. If pronunciation of the mark is not obvious, the searcher will need to know how it is intended to be pronounced.
2. **How was the mark selected? Is there a particular origin or source for the mark? Are similar marks used by other companies?**

- The searcher should ask the client why the mark was selected and how it was derived. The answer may reveal serious problems—for example, that the mark is descriptive or is calculated to call to mind a competitor’s mark. If there are any non-English-language words in the mark, the searcher will need a translation, so that the English equivalent can also be searched. If there are any technical words or industry jargon in the mark, the searcher will need a definition in order to determine whether the mark is protectable.

3. **Will the mark be displayed in a logotype (logo)?**

- If the mark is a word, phrase, or other alphanumeric term, the searcher will want to know if the mark will appear as part of a logo, in a distinctive typeface, or with some other visual element. Prominent or distinctive visual elements usually require a separate search.

4. **Has the mark been used? If not, when is the anticipated date that it will be used? What is the timing for making a final decision on the mark?**

- If the mark is already in use, the searcher will find it useful to know that the mark has in fact coexisted with other marks in the marketplace for some time, apparently without conflict. If the mark is not yet in use, knowing the timetable for proposed use will help determine whether the search needs to be expedited or can proceed on a more normal (and less expensive) schedule.
5. **What goods and/or services are intended to be offered in connection with the mark? Who are the target purchasers for the goods/services? What are the channels of trade (i.e., the wholesale and retail means for selling them)?**

- The potential for confusion between two marks depends in significant part on the goods and/or services with which they are used, where and how the goods or services are marketed, and who might buy them. Without a clear idea of these factors, it will be difficult to focus the search on the marks that are the most relevant to the client’s business, and to analyze the potential for conflict with other marks. This information is essential in allowing counsel to adequately determine whether the newcomer’s mark infringes; it is not nearly as influential in determining whether the mark dilutes an existing mark.

6. **Are there any plans to use the mark outside the United States? If so, where and when will the mark be used?**

- If the mark will be used in countries outside the United States, it will probably be advisable to commence searches and/or applications for registration in those jurisdictions, or at least in the most important ones.

7. **Will the mark also be used as a corporate name?**

- If the mark being searched will also be used as a corporate name, the mark should be cleared as a corporate name in parallel with the trademark clearance process.

8. **Will the mark also be used as a domain name?**

- Many marketing plans require that the proposed mark also double as an Internet address. If the domain name is already held by someone else, the client can then consider whether it wants to attempt to acquire it.
These questions can form the basis for a questionnaire that the person requesting the search can fill out before the search is conducted. A sample questionnaire is shown below.

**Request for Trademark Search**

Before a new trademark can be used, a search must be conducted to determine if it is available for use. If we don’t conduct a search, and then we discover that another business or organization already has rights in a mark that is so similar to our new mark that confusion is likely to result, that business or organization could stop us from using our new mark.

This questionnaire sets out the information that’s needed to conduct a search. Please complete it and return it to [contact/email address].

Here are several things to consider in beginning the trademark search process:

- **Your timing.** In order for us to provide you with timely search results, you will need to indicate below the deadlines for selecting and adopting the mark, including (1) the deadline for any market research to be conducted before the mark is selected, (2) the deadline for final selection, and (3) the target dates for announcing the mark to the public and for first sales. Rush and expedited searches often result in increased costs, so it’s important to provide accurate and realistic deadlines.

  If the mark is already in use, we’ll need the details as to how long it has been used, where it has been used, and what products/services are being offered. We’ll also need samples of packaging and marketing materials.

- **Our timing.** [If the company or firm follows a specific process or timetable in conducting the search or moving...
from a preliminary to a more extensive search, the questionnaire can include that information so that the client’s expectations are realistic.]

• **Costs.** [If a company charges the cost of a search back to the requesting business unit, that information can be included in the questionnaire. A law firm can indicate the legal fees and outside costs for the search.]

• **Internal approval.** [If the search request must receive management or budgetary approval before moving forward, it’s useful to remind the client of that at the beginning of the questionnaire.]

To move forward with the search, please provide responses to the following questions:

1. **What is the mark to be searched?**
   
   • If the pronunciation of the mark is not obvious, please provide pronunciation.
   
   • If the mark includes words from another language, please provide a translation.
   
   • If the mark will be used in a particular font or logotype, please attach an image file showing the mark in the font or logotype.
   
   • If the mark is a packaging design, product design, or retail design, please attach an image file.

2. **How will the mark be used? (Please check all that apply.)**
   
   ___ Brand name for a product
   
   ___ Brand name for a service
   
   ___ Corporate name
__ Business or division name
__ Feature of a product
__ Variety/flavor/color/fragrance name
__ Tagline or slogan
__ Logotype
__ Product packaging
__ Product design
__ Retail design

Please indicate whether it is also necessary or desirable to obtain an Internet domain name that incorporates the mark.

3. **How was the mark selected? Is it intended to describe or suggest any aspect of the product or service?**

Please explain or define any terms, abbreviations, or initials in the mark that have a recognized meaning to the target purchasers.

4. **Are you aware of any similar marks that are already in use?**
   (If so, please list each mark and the company that uses it.)

5. **Are you aware of any other marks that are used in connection with products or services with which the products or services to be used with the mark are likely to compete?**

6. **What products and/or services will initially be offered in connection with the mark? In the longer term, what additional products and/or services might be offered in connection with the mark?**

7. **Will the mark be used indefinitely, or only for a certain period of time?** (If use is limited, please specify the time period.)
8. **Who are the target purchasers for the products/services? What are the sales channels for the products/services?**

9. **Will the mark be licensed to others?**

10. **Please provide:**

    - The deadline for any market research to be conducted before the mark is selected.
    - The deadline for final selection of the mark.
    - The target date for announcing the mark to the public.
    - The target date when the product(s)/service(s) will first go on sale (if later than the announcement date).
    - The countries in which the mark will be used.
    - The target dates in each country for announcing the mark and beginning sales.

11. **Will the mark be translated from English into another language for use in any other countries?**

12. **If the mark is already in use, please indicate:**

    - How long the mark has been used.
    - The countries in which the mark has been used.
    - The products/services offered in connection with the mark.

Also, please provide samples of packaging and marketing materials.

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### V. **Preliminary vs. Full Searches**

In terms of thoroughness, searches generally are categorized as “preliminary” or “full.” That is an oversimplification—there are, in fact, a variety of options available beyond the preliminary search.
The purpose of a preliminary search (also known as a “screening” or “knockout” search) is to spot obvious conflicts at the outset. If an obvious conflict exists, and the mark is clearly unavailable, the company avoids the expense and time required for a more extensive search, and can move on to evaluate another candidate mark.

The preliminary search uses a limited number of resources and queries that the searcher deems most likely to yield relevant marks with minimum effort. The preliminary search is not an attempt to reach a definitive answer on the availability of those marks that survive the screening; the goal is merely to rule out marks that are clearly unavailable. Thus, while a preliminary search can yield a clear “no” to a proposed mark, it cannot yield a clear “yes”—only the potential for a “yes” after further research.

If a mark survives its initial screening, the trademark professional typically either requests a professional search firm to conduct a more extensive search or conducts one himself or herself. That is not always the case, however. Searching is not a “one size fits all” process that inevitably culminates in a full search from an outside search firm. The better view is that searching is an effort to reduce the risk in adopting a new mark, and different risks are inherent in different situations. With many marks, the marginal cost of additional searching beyond the preliminary search is worth the extra assurance, since the amount invested in the mark (and thereby imperiled in the event of a challenge) is likely to be so much larger than the cost of a search. In most instances, the combination of a preliminary search followed by some additional searching is cost-effective and reduces the risk to a reasonable level, but not always. Counsel and client need to decide what level of searching is desirable from a cost-benefit standpoint, and the Administrator can assist in making that decision.

A. Timing for the Preliminary Search

The first-come, first-served nature of trademark registration places conflicting pressures on the timing of a trademark search. On the one hand, a company that wants to use a particular mark has an incentive to file for registration as soon as possible. Waiting to file until a search is done presents the risk that someone else
will establish rights in a conflicting mark while the search is underway. On the other hand, money invested in filing for registration of a mark is money wasted if the subsequent search shows that the mark is unavailable. Thus, companies are forced to choose between the benefits of early filing and the cost savings of waiting until the complete search is in hand. If a company is interested in a mark that is commonplace, contains trendy buzzwords, or is in a “hot” field, the risk of someone else’s filing for a similar mark may be relatively high, and it may make sense to apply after receiving the preliminary search results. On the other hand, when the proposed mark is fairly unusual, or the use will be quite specialized, the company may feel more comfortable waiting for the full search results, because the risk is lower that someone else will apply to register a similar mark during the search process.

**B. Resources for the Preliminary Search**

In the United States or any other common-law country, the trademark searcher is looking in two different directions at once—toward the trademark office, where applicants are seeking or have acquired national trademark rights, and toward the marketplace, where businesses and organizations are using unregistered marks entitled to common-law protection. An efficient, comprehensive search employs resources that reveal marks in both dimensions. The effort usually begins with a search of national trademark office records (using the USPTO’s free search database or a pay-as-you-go database provided by a commercial search firm) and a search of the Internet (using search engines such as Bing, Google, and Yahoo!).

**Practice Tip**

With so many online search tools available for free, anyone can try to conduct a preliminary trademark search. However, trademark professionals will want to counsel their clients to be cautious in doing so. A marketer or advertising agency brainstorming a long list of new marks will find it convenient to quickly and inexpensively spot potential obstacles by looking for identical marks on an Internet search engine and the USPTO’s TESS database. However, the implications of such spot checks often are misunderstood. These first-glance efforts are a prelude to a proper searching, not a penny-pinching substitute. A search conducted by experienced in-house or outside trademark professionals, or by a professional search firm, will in the long run be more cost-effective and yield more reliable results than a do-it-yourself approach. Trademark counsel are also more dispassionate than their clients in interpreting the results, and are more likely to provide an impartial reading of the results.
Beyond these primary databases is a vast array of other resources, including business directories, domain name databases, news databases, industry-specific search tools, and local or regional governmental registers (e.g., state trademark registers in the United States, provincial company name registers in Canada).

In civil-law jurisdictions in continental Europe, Latin America, Africa, and much of Asia, trademark rights are customarily created by obtaining a national trademark registration; indeed, in many such countries, registration is the only way to establish trademark rights. The national register is often, but not always, the only search tool. Some civil-law countries afford protection to corporate or business names, or to trademarks that have achieved some measure of reputation or fame. U.S. trademark professionals must rely on the advice of counsel in a particular country for guidance on whether such protection is available and how such marks or names can be searched. (For more information on first-to-file versus first-to-use jurisdictions, see INTA’s Global Trademark Resources, Quick-Start Trademark Chart and Country Guides.)

A searcher usually will use more than one database in conducting a preliminary availability search. Choosing which databases to use involves two steps:

1. **Which type of database?** First, the searcher will decide which types of resources are likely to turn up the most relevant marks at the least cost (e.g., a national trademark register database, an Internet search engine, an industry-specific directory).

2. **Which source of data?** Having selected the types of resources to be used, the searcher must then decide which of several competing databases or search engines of that type to use.

Here is how the searcher can weigh these competing options.

1. **National Trademark Databases**

In the United States, the primary vehicle for conducting a preliminary search is a database of USPTO information. The federal trademark register is the most comprehensive trademark search source. It is particularly efficient, having been
devised expressly for searching. In other countries, the national trademark register is either the primary or the only search source.

The options for accessing such data vary around the world:

- In most countries in North America and Europe, the searcher has the option of using a free government database, or paying to use a commercial database. Commercial databases offer advantages that government databases do not (see below), and the searcher must weigh those benefits against the cost.

- In many countries beyond North America and Europe, there is no publicly accessible government database, and the only option is to use a commercial database. In countries where no commercial database is available, then the searcher cannot retrieve trademark records online on his own, and will have to request a search from counsel or a vendor in that country.

In countries where the searcher has a choice between using a government and a commercial database, the decision is a matter of cost efficiency. The USPTO’s TESS database is free, while commercial providers charge a fee for the use of their databases. All of them contain the same basic information, but commercial databases have several advantages that make them more efficient and comprehensive. Their user interfaces are more user-friendly, and allow for more complex search queries. Using a commercial database, it is easier to narrow a search by limiting the queries to retrieve only the most relevant marks—for example, by limiting the queries to particular letter combinations, goods/services descriptions, classes of goods/services, active or inactive status, filing dates, and so on. Commercial databases also incorporate useful tools to organize and sort search results, allowing the searcher to flag trademark records by importance, link to external data sources, share results with others, and create reports. More important, commercial search firms enhance the basic USPTO data to add useful alternate spellings and other cross-references. For example, the USPTO attempts to cross-reference a deliberately misspelled mark with the conventional spelling by adding a “pseudomark,” so that a search query asking for the conventional spelling also pulls up the deliberate misspelling. Such efforts can be hit-or-miss, however, and the commercial search firms comb through new filings to create
additional pseudomark references. Commercial search firms also enhance the coding of design marks. As a result, a given query on a commercial database will yield more marks than the same query on TESS.

Commercial databases are available on a pay-as-you-go pricing basis (the more information retrieved, the higher the cost), or via a fixed-cost subscription. If the searcher has a pay-as-you-go arrangement, a preliminary search is efficient only if a limited number of resources are used in a limited way. If the searcher searches too extensively, the cost could quickly exceed that of an expedited search from an outside firm. As indicated above, however, commercial databases make it easier to tailor the search to retrieve a limited number of relevant trademark records.

In short, if speed and accuracy are paramount when conducting a preliminary search, it usually makes sense to use a commercial database. If the primary concern is saving money, TESS is preferable.

The trademark offices in many countries offer free online databases, but if a mark requires multinational clearance, commercial databases are likely to be more efficient tools for the preliminary search. The most obvious consideration in choosing between a non-U.S. government database and a commercial database is whether the results are provided in English. However, even if English-language results are available on the government database, or if the searcher is fluent in that country’s language, a commercial database will be more efficient, for two reasons. First, each national database has its own peculiar functionality, requiring a learning curve to understand how to use it. Second, if the searcher is conducting a multi-country search, he or she need not search multiple databases—a single query in a commercial database will provide results covering multiple jurisdictions.

2. Search Engines and Other Online Databases

A wide array of Internet resources is available on the trademark professional’s desktop. Although not expressly designed as trademark search tools, these resources provide invaluable information for the search process.
An Internet search engine is likely to be the most important way of locating unregistered common-law marks, and usually will be the first, and sometimes only, Internet tool used for seeking relevant common-law marks. However, a Web search will obviously be more useful in searching marks that are coined or are unusual phrases. If the mark is a dictionary word or commonplace phrase, the searcher may need to include additional words (e.g., the proposed goods or services) in the search query in order to retrieve relevant marks.

Industry-specific sources can be highly efficient preliminary search tools for identifying relevant marks for some industries—for example, specialty retail websites for consumer products, and restaurant and travel websites for hospitality and travel marks.

If cost is not the paramount concern, the searcher may also wish to use a news database like NEXIS, which charges for searching but allows the searcher to tailor the search query with more precision than an Internet search engine or a website that is not specifically designed for searching.

3. **U.S. State Trademark Registers**

Marks that are registered at the state level can be searched via commercial databases, and commercial search firms typically include results from state registers in their standard full search reports. However, state search results are seldom significant. State registers are not always updated on a timely basis, and the data may be months out of date. State applications receive limited, if any, examination to clarify goods/services descriptions. More important, a state trademark registration does not necessarily represent real enforceable trademark rights, because use of the mark is not necessarily a prerequisite to registration. (See INTA, *U.S. State Trademark and Unfair Competition Law*.)

4. **Databases for Gauging Registrability**

A U.S. application for registration can be refused on the basis that the would-be trademark is descriptive, is a surname, or is geographically descriptive or misdescriptive of the goods. In order to advise the client on whether the proposed
mark can in fact be registered and protected as a trademark, the searcher can consult a variety of online sources, including the following:

- **General and technical dictionaries** are used to evaluate whether the mark is descriptive or generic as applied to the proposed goods or services.

- **Atlases and geographic dictionaries** can help determine whether a mark is not immediately registrable because it is primarily geographically descriptive or might be considered geographically misdescriptive.

- **Telephone directories** assist in the evaluation of whether a mark is not immediately registrable because it is primarily merely a surname.

**C. Prioritizing Search Databases**

With a wealth of search resources to choose from, the searcher might wonder where to start. The answer depends, in part, on the type of mark being searched. Here are some suggestions, designed to maximize the relevance of the information retrieved and minimize the time spent searching and the out-of-pocket costs:

- For most **word marks**, the best place to begin is a database of USPTO records. Depending on the nature of the mark, one can either limit the preliminary search to that database or check other databases as well. For example, if the mark is a **coined word** or an **unusual phrase**, it may be efficient to search for common-law uses with an Internet search engine or a pay-as-you-go database.

- For **design and trade dress marks such as logotypes, packaging**, and **product configurations**, a USPTO database usually is the only practical alternative, although an Internet image search will occasionally be a practical alternative.

- If counsel suspects that the mark is **generic or descriptive**, it may be best to start by searching the Internet to determine whether the word
or phrase is even eligible for trademark protection. The searcher can also check a USPTO database to see if the term is frequently disclaimed. Of course, descriptiveness may not be obvious to the searcher if the mark is in fact an esoteric or highly technical term. However, Wikipedia and industry-specific online databases can shed light on the meaning of the term.

VI. Commonly Used Preliminary Search Databases

A. National Databases

- U.S. Patent and Trademark Office
- Other trademark office databases can be accessed through INTA’s Country Portal

B. Commercial Search Databases

- Thomson Compumark
- CT Corsearch
- CSC

C. Internet Search Engines

- Bing
- Google
- Yahoo!

D. News Databases

- Nexis
VII. Conducting the Preliminary Search

To get the right answer from any computerized database, one has to ask the right question. In the context of trademark searching, getting the “right answer” is finding the trademarks in the database that are the most similar in sight, sound, or meaning to the mark being searched, for the most closely related goods and services. The search must also retrieve any similar famous marks that could be diluted by the proposed mark.

The USPTO database contains millions of active marks (appearing in registrations and pending applications) and inactive marks (from cancelled registrations and abandoned applications). A search query for a commonplace dictionary word can easily retrieve hundreds or thousands of trademark records. The searcher will seldom be able to justify the time or expense of reviewing all the marks containing a particular word. Thus, an efficient preliminary search requires a strategy—a way to reduce the number of marks to a manageable number that counsel can review. The preliminary search should aim to retrieve those marks that are most similar in sight, sound, or meaning to the proposed mark, for goods and services that are competitive with or related to those with which the mark will be used.
Brand names often incorporate deliberate misspellings, puns, slang, and other variations on otherwise common words. A thorough search should attempt to anticipate the unexpected by retrieving corrupted spellings, word plays, colloquialisms, foreign-language equivalents, and other variants on the proposed mark. The search design must also recognize that the English language contains many words with the same root and different endings, all of which could be considered similar in meaning or commercial impression. In addition, the language is rife with plurals, past tenses, and other variations on basic words that break the normal rules of pluralization or conjugation. Although the searcher cannot anticipate every possible variation on the proposed mark, the search plan must compensate for the inventiveness of those who coin brand names and for the eccentricities of the language.

Thus, if the searcher searches only for the proposed mark, he or she will miss other variations that might be considered confusingly similar. The searcher must instead create multiple queries or “search terms” for that purpose, all of which are variations on the proposed mark. The search term must be formulated with the database in mind. Some databases will automatically provide plurals and even some phonetic equivalents, while others will not.

On the major commercial search databases, the searcher has the choice of asking the questions or letting the computer do it—that is, the searcher can formulate search queries designed to elicit similar marks from the database, or can rely on the search database to formulate those queries automatically. With automatic searching available, one might question why searchers would bother to formulate search queries themselves. The answer is that automated searching is far from perfect. Computer-generated queries are sometimes overinclusive and other times underinclusive. For some marks, they fail to yield all the phonetic variations that a searcher might expect. For others, they yield far too many marks, forcing the searcher to wade through a long list of completely irrelevant marks. Automatic queries are also not designed to yield synonymous marks.
The various features of commercial search tools are described at:

- Thomson Compumark—Online Screening Tools
- Corsearch—Screening Platform
- Demo

The following pages outline some considerations in formulating the appropriate search query to be entered into the database in non-automatic searches. If the proposed mark is a single word, the searcher must decide whether to look for the word by itself, as a prefix, as a suffix, or appearing as a letter string anywhere in a mark. The searcher must also decide whether to enter the entire word into the database or to search for truncated forms, and whether to look for phonetic variations and irregular plurals.

A. Structuring the Search Query

If a proposed mark contains more than one word, the searcher must begin by deciding which word to search first. Some choices make for more efficient searching than others. For example, if the mark includes an extremely common word, that word could appear hundreds or thousands of times in a database of USPTO records. In a preliminary search, reviewing all of those records may be prohibitively expensive, or at least an inefficient use of the searcher’s time. Therefore, the searcher will usually want to narrow the number of marks retrieved by starting with the most significant, most distinctive, or least common word. Terms that might be considered descriptive or generic in the context of the mark generally should be searched last, both in combination with the distinctive terms in the mark and separately to verify descriptiveness or genericness.

For example, in the classes for beverages or restaurant services, the word STAR appears in almost 800 active federal marks, but BUCK appears in fewer than 150. HOME appears in almost 2,500 active marks in the class for retail services, with DEPOT in fewer than 300. YOU appears in more than 6,500 active marks in the entertainment services class, but TUBE is in fewer than 100.

If the first search term turns out to be unusual enough and retrieves relatively few trademark records, the searcher may decide to look at all of those records. If the
first search term is not that unusual, the searcher may try to narrow the search in one of several ways:

a. Limit the marks retrieved to those that incorporate the search term in a particular class or description of goods;

b. Look only at those marks in which the first and second search terms appear; or

c. Look only at those marks in which the first and second search terms appear in a certain order or proximity.

The rules for entering two or more terms in a single search query differ from database to database. Care must be taken to use the correct “logical operators” when combining search terms. Some databases give the searcher the option of explicitly indicating how the search should retrieve records containing these search terms. These “logical operators” can include the following commands:

AND retrieves the intersection of two search terms. Both terms must appear in the record in order for the record to be produced. Thus, a search of DEATH AND TAXES will retrieve only marks in which both words appear.

ADJ retrieves only records in which the two search terms that appear next to each other in the mark. A search of CLEANLINESS ADJ GODLINESS will retrieve the marks CLEANLINESS GODLINESS and GODLINESS CLEANLINESS, but not the mark CLEANLINESS IS NEXT TO GODLINESS.

OR retrieves marks in which one or both terms are present. A search of TRUTH OR DARE will retrieve marks in which only TRUTH appears, in which only DARE appears, or in which both TRUTH and DARE appear.

NOT eliminates a search term from the search results. No records containing the designated search term will be produced. Thus, a search of MARTIN NOT LEWIS will retrieve all marks in which
MARTIN appears except for those in which MARTIN appears with LEWIS.

In other search databases, the logical operators may not be explicit commands. One command may be the implicit default command, while the others must be entered explicitly. For example, the command AND may be implicit when two words are entered into the search field, but the searcher may need to insert other variations such as ADJ, OR, or NOT to vary the results.

B. Formulating the Search Query

In searching a mark composed of words and/or numbers, the searcher must decide exactly what letters or numbers to include in the search query. While this seems like an obvious task, it is not. It may require trial and error to find the “just right” search queries that retrieve a manageable number of relevant marks. In formulating the search query, the searcher must consider all of the variations and quirks inherent in language and branding. The following is a list of the factors the searcher must keep in mind, and suggested methods for dealing with them.

- Variations in Prefixes and Suffixes. A search for a common dictionary word like NATION is incomplete without considering plurals, possessives, and derivatives such as NATIONS, NATION’S, NATIONAL, and INTERNATIONAL. The searcher must also recognize that new marks are often coined by adding prefixes and suffixes to ordinary words or by combining ordinary words in new ways (e.g., NATIONS_BANK). Using the word NATION alone as the search term will fail to retrieve these variations. Thus, most databases allow the searcher to retrieve variations in suffixes by specifying that the search term appear as a prefix. For example, searching NATION* would retrieve all marks that either contain NATION as a stand-alone word or include the letters NATION at the beginning of the mark. Some databases also allow the searcher to obtain all marks in which the search term appears as a suffix. Selecting *NATION would retrieve all marks that either contain NATION as a stand-alone word or include the letters NATION at the end of the mark. Thus, the query NATION* will retrieve NATIONAL (where NATION is the prefix), but not
ILLUMINATION; the query *NATION will retrieve ILLUMINATION (where NATION is the suffix), but not NATIONAL; neither one will retrieve INTERNATIONAL, where NATION is bracketed by a prefix and suffix. Some databases also allow the searcher to search for “embedded letterstrings”—that is, all marks in which the search term appears anywhere in the word, whether as a prefix, as a suffix, in the middle of the word, or as the entire word. In such databases, the query *NATION* will retrieve marks containing NATION, NATIONAL, ILLUMINATION, and INTERNATIONAL. However, embedded letterstring searching may not be available in all fields of the database or for all countries. For example, it may be possible to search for a trademark and get all prefixes and suffixes of the search query, but it may not be possible to search for the name of a trademark owner and get all prefixes and suffixes of the trademark owner name.

- **Irregular Plural Constructions.** Some databases will allow the searcher to enter a word and retrieve all marks that contain the word in singular or plural form. However, this function typically works only with words in which the plural is created in the conventional manner—by adding the letter “s” at the end. Needless to say, not all English-language plurals are created that way. Unless the database is designed to cross reference irregular plurals, searching for BABY will not retrieve marks containing BABIES, nor will FOOT yield FEET or WOMAN yield WOMEN. The searcher must keep this in mind when searching words with irregular plurals.

- **Corrupted Spellings.** The trademark register is rife with deliberate misspellings of ordinary words such as "quick" (KWIK, QUIX, KWIX), "easy" (E-Z, EASI, EZEE), "excel" (EXSEL, X-L, XCELL), and "coat" (COTE, KOTE). The USPTO attempts to compensate for these quirks by cross-referencing the conventional spelling with the aberrant spelling, but does not capture all the variations. The commercial database providers add cross-references on variant spellings that the USPTO has missed, but may still miss some of them. The searcher can attempt to compensate for these corrupted spellings by searching obvious spelling variants on the conventional spelling.
• **Phonetic Similarities and Word Play.** Since similarity in “sight, sound, or meaning” is relevant to confusion, the search should be designed to yield marks that sound like the proposed mark, even if they are spelled quite differently. Thus, the search strategy should employ several variations on the search term in order to retrieve puns and play-on-words marks (e.g., KNOW SWEATS, WRITEBRAIN), homonyms (e.g., SEA, SEE, C), or letters with sound-alike counterparts (e.g., Y/I, PH/F, C/K, C/S, or KN/GN/N).

• **Names.** Names may have a variety of conventional spellings (e.g., BILLY or BILLIE), not all of which lend themselves to searching by prefix or suffix alone (e.g., KAREN or CARIN). Formal and informal variations on names (e.g., CINDY or CYNTHIA, BILL or WILLIAM) should also be included as alternative search terms.

• **Abbreviations.** If the word being searched has an abbreviation, both the full word and the abbreviation should be used as search terms (e.g., MOUNTAIN or MT., MISTER or MR.). This is particularly important for less common abbreviations that the USPTO or commercial database may not have cross-referenced (e.g., S.R.O. or STANDING ROOM ONLY).

• **Punctuation.** Most databases are designed to ignore punctuation for searching purposes (e.g., A.B.C. is the equivalent of ABC). Databases, however, may have different rules concerning how elements of the mark are treated after the punctuation is stripped (A. B. C. may become ABC or A B C, HONKY-TONK may become HONKYTONK or HONKY TONK).

• **Synonyms.** Since marks can be confusingly similar in meaning, the searcher must consider whether there are any synonyms for the proposed mark and whether to use them as alternate search terms. Thus, a search of a proposed mark containing the word SEA could include such alternate search terms as OCEAN.

• **Alternate Spellings and Equivalents in Other Languages.** Under the USPTO’s “doctrine of foreign equivalents,” words in other
languages are translated into English and then tested for descriptiveness, genericness, or likelihood of confusion. Search databases generally include translations of foreign words that appear in trademark registrations. However, some foreign equivalents have doubtlessly escaped the notice of USPTO examining attorneys or search firms and will not appear in the database. Even with English-language words, the searcher must check for alternate spellings. For example, a preliminary search of HARBOR would miss relevant marks unless the searcher also checked for marks containing the non-U.S. spelling HARBOUR.

- **Visual Equivalents.** A design mark that corresponds to a dictionary word may be considered the equivalent of that word for purposes of determining likelihood of confusion (e.g., the word JOCKEY and the image of a jockey, the word ARROW and an arrow design).

### C. Searching by Goods and Services

Because many terms appear in hundreds or even thousands of marks, it defeats the purpose of the preliminary search for the searcher to spend the time and money to review all of them. The searcher can reduce the number of marks retrieved by narrowing the search only to encompass marks for the client’s proposed goods or services or those that are related. The searcher can do this by looking only at marks in a specific class of goods or services, at marks with a specific identification of goods or services, or both.

Searching by class of goods or services can be an efficient way to search, but it is far from foolproof. New applications that have not yet been examined may have been misclassified by the applicant, and classification after examination is not entirely uniform, despite the USPTO’s efforts. In addition, although most trademark offices use the same basic classification system as the USPTO, the classification of particular goods and services is dictated by an office’s policy and may vary from country to country.

Searching by identification of goods or services is even less reliable, since such descriptions lack the uniformity and identifiable limits of the international
classification system. The USPTO examining corps tries to bring some consistency and specificity to these identifications. However, the “standard” USPTO nomenclature in the *Acceptable Identification of Goods and Services Manual* is not necessarily the terminology commonly used in the relevant business or industry, is not always uniformly imposed, and can vary over time as USPTO policy changes.

This compels the searcher to try alternate ways of limiting a search, using a variety of synonyms for the relevant goods and services and several different classes. For example, “computer software” is alternately referred to in some registrations as “computer programs” and, depending on the format in which it is provided, is classified in either Class 9 or Class 42. “Restaurant services” are currently classified in Class 43, but older registrations are in Class 42, where they were classified before Class 43 was created.

### D. Executing the Search Strategy

The search strategy is not a blueprint to be followed—it is a series of options to be explored. The searcher enters various combinations of words, classes, and goods identifications, on a trial-and-error basis. In most cases, it makes sense to begin with very narrow search queries, looking for the exact mark and the most relevant goods/services or classes. If the initial queries turn up no relevant marks, the searcher can expand the queries, searching variations on the mark and related goods/services and classes.

The searcher can use the following checklist to brainstorm possible search strategies and to make sure that all relevant search queries have been considered and entered into the database.

<table>
<thead>
<tr>
<th>Preliminary Search Checklist</th>
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<tbody>
<tr>
<td><strong>1. Database options:</strong></td>
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<tr>
<td>☐ U.S. Federal</td>
</tr>
<tr>
<td>☐ Internet search engine</td>
</tr>
</tbody>
</table>
## Preliminary Search Checklist

| ☐ | U.S. State |
| ☐ | Non-U.S. national or multijurisdictional |
| ☐ | Non-U.S. company names |
| ☐ | Specialty industry database (e.g., Pharma In-Use) (create a list of specialty databases based on the mark being searched) |
| ☐ | Domain names |

### 2. Options for search query:

| ☐ | Exact trademark |
| ☐ | Letterstring as prefix |
| ☐ | Letterstring as suffix |
| ☐ | Embedded letterstring |
| ☐ | Wild card substitution (substitutes any vowel or consonant in a particular location in the query) |

### 3. Variants on conventional spelling:

| ☐ | Phonetic variants |
| ☐ | Irregular plurals |
| ☐ | Abbreviations |
| ☐ | Puns, slang, nicknames |
**Preliminary Search Checklist**

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<tbody>
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<td></td>
<td>Punctuation</td>
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<td></td>
<td>Synonyms</td>
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<td></td>
<td>Foreign equivalents</td>
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**4. Options for narrowing the search:**

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<tr>
<td></td>
<td>Limit to records where search terms appear together</td>
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<td></td>
<td>Limit to active (pending or registered) records, or include both inactive (abandoned, cancelled, or expired) and active records</td>
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<tr>
<td></td>
<td>Limit by identification of goods/services</td>
</tr>
<tr>
<td></td>
<td>Limit by class of goods/services</td>
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</tbody>
</table>

**VIII. Common-Law Searching**

The pitfalls inherent in using a USPTO database are magnified when one uses other databases for finding common-law marks—Internet search engines, news databases, corporate informational databases, and the like. Since these databases were not expressly designed for trademark searching, even greater care must be given to crafting the search term.

The searcher must understand the capabilities of the database in order to use it effectively, determining in particular whether the database retrieves plurals when the singular is inserted, allows the user to exclude certain terms, or enables searches of combinations of words based on their proximity to one another. Even Internet search engines, which are arguably the most user-friendly common-law search resource, differ in functionality, and each is likely to produce different results in response to the same search request. Search engines attempt to determine and rank websites according to their relevance to the search query, but
each uses different techniques for doing so. Results may also be skewed to favor the searcher’s geographic location. Because of these variations, the searcher may want to consider using more than one engine if the goal is to conduct a thorough common-law search.

IX. Searches of Non-Word Marks

Many trademarks incorporate visual elements:

- **Stylized marks**—words, numerals, and other characters presented in a particular fonts
- **Logotypes**—marks with design elements
- **Trade dress**—packaging designs and the nonfunctional appearance of products, buildings, and retail environments

Sounds and scents can also be trademarks in some countries/jurisdictions. Such non-word marks pose special problems in searching, since electronic search databases are designed primarily for marks composed of letters, numbers, and other characters. Searches of non-word marks are likely to be inherently less comprehensive, and therefore sometimes less reliable, than searches of word marks, because the search tools available are so much more limited.

Searches of designs create several challenges. First, searching is essentially limited to designs that appear in federal trademark applications and registrations. Second, search strategies are more difficult to construct, especially for visual marks that are not easily described or categorized—for example, abstract designs, complex geometric figures, product configurations, and designs that contain several distinct graphic elements.
X. Searching Design Marks

Trademark professionals can conduct design searches using the major search databases by using either “design phrases” or “design codes,” each of which can be more time-consuming and frustrating than searching word marks.

A design phrase is the description of a design trademark that appears in a trademark application or registration. The USPTO in recent years has required applicants to provide a description of the design at the time the application is filed, but such descriptions were required in older registrations only if the examining attorney considered that the design was not obvious. Even where design phrases do exist, the language is not consistent, since different people may describe the same design in different ways. Thus, design phrase searching is not very reliable.

Design code searching is a good deal more reliable, but still quite subjective. The USPTO classifies each new design mark by assigning it one or more codes. Design codes are organized into three levels. The first level is a broad categorization of the nature of the design. There are 31 such categories, ranging from “Celestial Bodies, Natural Phenomena, Geographical Maps” (category 01) to “Other Designs” (category 31). Each of these categories is divided into narrower subsets at the second and third levels. For example, category 03, “Animals,” has 13 second-level subsets, including “Parts of Birds; Eggs and Nests” (03.17) and “Prehistoric Animals” (03.25). Each second-level subset is divided into even more specific third-level subsets. For instance, “Fish, Whales, Seals, Sea Lions” appears in the second level of design codes for animals (03.19), with specific types of fish at the third level (e.g., 03.19.04, “Swordfish, sawfish, sailfish”). Using these codes, the searcher can review all designs with a particular design code, or all designs that incorporate a combination of design codes (e.g., a swordfish wearing a sombrero would be found by entering the code for swordfish (03.19.04) and the code for “sombreros and cowboy hats” (09.05.05)).

Commercial search firms may add their own additional codes, and non-U.S. trademark offices use their own separate coding systems. Thus, the same codes may yield different results, depending on the country searched.
XI. Searching Trade Dress

Conducting a search of proposed trade dress poses even greater challenges than searching logotypes. As with designs, the federal trademark register is the only practical search resource, but trade dress registrations are only a small portion of all design registrations. Much protectable trade dress is unregistered, and some, such as the overall design of a restaurant, is difficult or impossible to depict in a trademark application drawing page.

Trade dress applications and registrations sometimes include a design phrase (“the mark consists of the configuration of the packaging for the goods...”), and all receive a design code. However, it is difficult to separate trade dress from registered designs generally, since the USPTO has not created a separate design code category for trade dress and the words “trade dress” or “configuration” do not appear in the design phrase in most registrations. Thus, a typical search for three-dimensional trade dress will yield many two-dimensional logotypes.

Relevant trade dress may also appear in design patents and, beyond the United States, in design registrations that are separate and apart from the trademark register.

XII. Beyond the Preliminary Search

With such a vast array of online search resources available, a trademark professional can conduct an in-depth search of a proposed mark without seeking outside help. Doing so, however, requires familiarity with how each database operates, skill in formulating search queries, and a payment plan that allows the searcher to review large numbers of search records. Because of these obstacles, most practitioners still rely to a great extent on outside search firms that specialize in trademark searching. These firms offer an array of U.S. and non-U.S. search services of varying comprehensiveness to augment the trademark practitioner’s own preliminary search. Trademark professionals often supplement the preliminary search with a search from an outside supplier. This search report generally is referred to as a “full” or “comprehensive” trademark
search, although such a search is just one of a number of types of searches that these suppliers can provide.

The full search is designed to be a reasonably comprehensive, but not exhaustive, review of the federal and state trademark registers, Internet Web pages, trade and business directories, domain name registries, and proprietary databases. The major search firms also offer more extensive, enhanced versions of the full search for an additional fee. An enhanced search, for instance, may also search for the names of corporate entities or social media user names that are similar to the proposed mark, rather than just searching federal and common-law marks. The enhanced report may also include searches of databases that are specific to the particular industry in which the mark will be used, such as pharmaceuticals, entertainment, or alcoholic beverages.

The most important factor in selecting a search firm is the skill and judgment of the search firm’s staff. The client relies on the searcher to devise the best possible search strategy and to execute it properly. Another important factor is the quality of the database used in conducting the search. Although all search databases use the same raw data from the USPTO, the major search firms enhance this basic information by checking for errors, and by attempting to compensate for spelling and grammar variations by cross-referencing them with the conventional spelling. These enhancements help compensate for some of the deliberate misspellings, sound-alikes, and other quirks found in trademarks.

Other factors to be considered when selecting a vendor include the following:

1. What does the firm charge for its standard full search? What is the trade-off between price and comprehensiveness compared with other firms?

Practice Tip

As a method of comparing search firms, it can be useful to order the same search from two different firms and compare the finished products. Each firm’s report will disclose the search strategy used and the number of marks cited. Are the strategies used comparable? Have potentially significant cites that appear in one search been omitted from another?
2. What is the standard search turnaround time? Are searches available more rapidly, and how great is the premium vis-a-vis the increase in turnaround time?

3. Will the search firm supplement its search without extra charge if the trademark professional believes it is incomplete? If so, how quickly will the supplement be delivered?

4. How will the search firm customize the format of the search to meet the client’s preferences?

The search firm can do a better job if the trademark attorney provides a clear and comprehensive definition of the goods or services to be searched. If the intended purchasers, users, and marketing channels are not obvious from the definition of the goods or services, counsel should provide the search firm with that information. In situations in which there is a special purpose to the search (e.g., seeking to show that a particular term or design is especially common), or any other unusual factor, counsel should advise the search firm of that special purpose.

XIII. Evaluating the Search Report

The central question in an availability search is whether the proposed mark is likely to cause confusion with another mark. Evaluating a search report is significantly more complicated than simply looking for “direct hits” (i.e., exact duplicates of the proposed mark). It is part legal analysis, part detective work, and part intuition and judgment.

Not every mark retrieved in a search is likely to be relevant, and the trademark professional reviewing the search must separate those that are relevant from those that are not. The basic task is to determine whether any marks in the search are sufficiently similar to the proposed mark that confusion or dilution would result. The person reviewing the search can use the following process:

(1) On the first pass through the search, identify those marks that are similar in appearance, sound, or meaning to the proposed mark, and
flag those for which the goods or services are in some way related to the client’s proposed goods or services.

(2) Select the marks from the first pass that merit additional scrutiny, and review the balance of the search for any significant marks that were missed on the first pass.

(3) Consider whether the search as a whole suggests that the flagged marks are commonplace and weak, and therefore entitled to narrow protection, or distinctive, strong, and entitled to broad protection.

(4) Check identical and near-identical marks, even where the goods or services are unrelated, to determine whether they are sufficiently distinctive and famous to give rise to a dilution claim.

These are only the first steps in reaching a conclusion about the proposed mark. The courts and the USPTO do not limit the analysis merely to the inherent similarity of the marks and the relatedness of the goods/services; they apply a multi-factor test to determine infringement, especially when the parties’ goods are not identical. Counsel needs to consider all of the factors that have an impact on the likelihood of confusion, including the sophistication of the potential purchasers and the care with which the purchasing decision is made.

After sorting the marks found in the search and making judgments about their relevance, the evaluator must examine each relevant trademark record in order to better determine the significance of the mark.

The following is a list of nine questions to be asked about each potentially relevant mark found in the search. Some of the answers will be obvious from the search record; some will not and will require further investigation.

1. **Does the mark appear in a federal registration, application for registration, abandoned application, or cancelled or expired registration?** Each has a different significance:

   - Marks registered on the Principal Register are entitled to a number of presumptions, the most important of which is the presumption that the registrant has the exclusive nationwide right to use the
mark for the goods and/or services described in the registration. Terms that the USPTO deems descriptive, and therefore ineligible for the Principal Register, can be registered on the Supplemental Register if the examining attorney determines that the term is nevertheless capable of attaining secondary meaning as a trademark. Such registrations do not afford the same presumptions.

- The filing of an intent-to-use application potentially constitutes constructive nationwide use of the mark, provided the application proceeds to registration on the Principal Register.

- Defunct applications and registrations create no presumptions, but occasionally such marks are still in use and the owner has common-law rights.

2. **Does the mark appear in a state registration?** State trademark registrations generally do not grant preemptive rights throughout the state, even as against other common-law users. (See INTA, *U.S. State Trademark and Unfair Competition Law*.)

3. **Does the mark appear in a common-law source?** A party, having established common-law rights by being the first to use a mark in a given field and geographical area, can stop others from using confusingly similar marks in the area in which its mark is known. Thus, even a relatively small, local business can prevent a newcomer’s use of a confusingly similar mark in its territory and can successfully oppose federal registration of that mark.

4. **Is the mark in use? If not, has it been abandoned?** If a trademark has been abandoned, a newcomer is free to use it. It is often difficult, however, to determine that a mark has been abandoned. Counsel should not assume that all federally registered marks are still in use, or that all marks in abandoned applications are no longer in use.
5. **Where is the mark used?** If a registered mark appears to be used only locally or regionally and the proposed mark will be used in a different part of the country, the federal registrant at a minimum has the right to enjoin a junior user outside its locality if it is likely to make an immediate, impending entry into the junior user's territory. In the absence of a federal registration, the geographical scope of rights in a common-law mark generally extends no farther than the area of the user's reputation. Generally, two parties may use the same mark for the same goods in different parts of the country so long as two conditions are met: (1) the junior user must offer its products or services in a geographic area so remote from the prior user's area that the public is unlikely to be confused or deceived; and (2) the junior user must have adopted the mark in good faith. In today's Web-based world, however, counsel has to be cautious in concluding that the reputation of any mark, whether unregistered or registered, is limited to a particular territory. A restaurant with a single location may be famous nationally; a single-location retail store may have a national mail order clientele via its website.

6. **What are the goods or services?** Trademark applications and registrations sometimes contain broad or ambiguous descriptions of goods or services, requiring trademark professionals to investigate further to determine whether the proposed mark and the mark in the search are likely to be used in connection with goods or services sold in the same markets to the same customers.

7. **Who is the trademark owner?** Some trademark owners are aggressive in protecting their marks; others are more passive. Counsel must take a senior trademark owner's previous policing activities into account in attempting to determine the chances that the owner will challenge the newcomer's mark. The search sometimes will show that a particular mark has been cited in numerous trademark oppositions, and one can search the major search databases for opposition and cancellation proceedings brought by a particular company.
8. **Is the mark famous or unique?** The traditional standard for determining whether a new mark conflicts with an existing mark—likelihood of confusion—does not apply in a claim for dilution. Dilution statutes are intended to protect unique or famous marks from tarnishment, or from the “whittling away” of their distinctiveness. The existence of dilution as an alternate claim to infringement forces counsel to evaluate the marks in a search under this criterion—as well as traditional confusion analysis. Determining whether a mark dilutes is especially difficult because of uncertainty in determining what constitutes a famous mark. In looking for possibly famous marks, counsel should give extra scrutiny to well-known, unusual, or house marks.

9. **Is a domain name a mark?** The registration of a domain name does not create trademark rights, but most domain names are chosen because they are identical or similar to a trademark that a company uses or intends to use. Thus, a domain name registration can in many instances signal underlying trademark rights. If the search reveals a domain name similar to the proposed mark, counsel should go beyond the search and try to determine whether the domain is also being used as a trademark. It is the trademark use of the domain—not the existence of the domain—that would prevent the client’s proposed use of a similar mark.

**XIV. Investigating the Cited Marks**

When a potentially conflicting mark appears in a search, it is usually necessary to investigate further to determine whether the mark has been abandoned, to better understand the nature of the goods or services sold under the mark and the marketing channels used, to ascertain the status of any pending applications and registrations, and to learn the status or outcome of prior disputes involving the mark. The most useful resources for doing so are the following:

- The USPTO application file for a registration or pending application (available through the TSDR (Trademark Status & Document
Trademark Searching and Clearance

Retrieval) System) can reveal any difficulties the company had in seeking to obtain registration, and what arguments the company made to the examining attorney. The file related to an opposition or cancellation (available through TTABVUE (the Trademark Trial and Appeal Board Inquiry System)) may shed similar light on the use or strength of a mark.

- Websites provide information on a company’s products and services, helping counsel to understand whether they are related to those of the client.

- Company directories and databases can provide information about a trademark owner, its geographical area of operation, the market to which it sells, its sales volume, and its corporate affiliations. News stories and corporate press releases can produce a wealth of information on the nature of the products or services, marketing channels, and their success or failure.

- The vast amount of material available on the Internet and in online databases has reduced the need for personal investigation of cited marks. In some instances, however, a telephone call or email to the trademark owner, a visit to its premises or a trade show exhibit, or an order for brochures, catalogs, or products can fill in gaps that electronic resources cannot, shedding light on what goods and services are actually sold under the mark, how they are sold, or where they are sold. Before making phone calls or initiating an investigation by an outside investigator, an Administrator will want to confer with counsel to verify that the investigation does not violate legal ethical standards, especially in situations in which the person making the call will not reveal his identity or will create a pretext for the inquiry.

XV. Approaching Owners of Cited Marks and Domain Names

If counsel concludes that the proposed mark would clearly infringe, counsel may want to consider whether it is feasible to acquire the mark found in the search. If
counsel instead concludes that the proposed mark can coexist with a registered mark, but the scope of the registration is vague or much broader than actual usage, counsel may want to consider seeking a consent from the registrant. However, acquiring a mark or seeking a consent is usually a last resort for resolving clearance problems, because of the following complications:

- A trademark owner has little incentive to consent to a stranger’s use of a similar mark (unless the stranger is willing to provide compensation), and it has many reasons to object if the party seeking consent is a competitor.

- Once an inquiry is made about acquiring a mark, the client should be prepared either to close the deal or to walk away and choose a different mark. If the client instead adopts the proposed mark after failing to obtain the assignment or consent, it is inviting an infringement dispute in which the failed attempt will almost inevitably be introduced as evidence of bad intent.

The clearance of many marks today is contingent upon acquiring a corresponding Internet domain name. Sometimes the prospective seller has acquired the domain name for its own use, but many domain names are registered by individuals or companies for the sole purpose of reselling them for the highest price. Counsel needs to approach domain name sellers (especially those without a traceable brick-and-mortar U.S. address) with caution to make sure that the transfer is properly effected.

XVI. Follow-up Searches

Even the most complete search provides only a snapshot of the trademark scene, and it is a snapshot that is already out of date at the time of the search. The most up-to-date electronic database will not include recently filed applications, and those “invisible” marks are potentially significant because the Lanham Act’s constructive use provisions create contingent rights as of an applicant’s U.S. filing date. In addition, new non-U.S. applicants under Lanham Act Section 44 potentially acquire U.S. rights dating back as far as six months before the U.S.
filing date. Counsel will want to consider conducting follow-up searches to help compensate for these blind spots.

**XVII. Delivering the Opinion**

In the client’s mind, the trademark search process comes down to one simple question: Can I use this mark? How the answer to that question is communicated to the client is obviously critical. The most diligent search is useless if the client either is given the wrong advice or gets the wrong message from trademark counsel. The opinion therefore should receive the same high level of care and attention as the search itself.

The search process is most effective when client and counsel have a dialogue. The client will be less likely to be disappointed if counsel spells out the costs, time constraints, and limitations at the outset, and the results will be more accurate if counsel has obtained adequate information before beginning the search. If the searcher discusses results with the client as the search moves from initial research to a more comprehensive search, he or she may receive new direction and insight from the client.

Search reports produced by commercial search firms generally are discoverable in litigation, while the lawyer’s search opinion itself is protected by attorney-client privilege. However, search opinions sometimes are introduced at trial as evidencing the defendant’s good or bad faith in adopting the mark. This creates an incentive to carefully tailor the written opinion to the client’s situation, setting out any assumptions about the extent of searching to be conducted and being careful to distinguish between suggestions and recommendations regarding investigations and further searching.

Counsel can deliver the search results by telephone more quickly than in writing and, in some situations, may find that a phone call can soften the blow of bad results better than a letter. There are pitfalls, however, in not putting this kind of advice in writing. Indeed, many lawyers give written search opinions as a matter of course. Counsel’s motivation for doing so is partially defensive. A client can misinterpret oral advice, especially if the results or the presentation is ambiguous, or if the results are bad but the client “hears what he wants to hear.”
A written opinion provides less opportunity for disagreement between client and counsel later on if problems with the mark arise. However, there are other good reasons for giving written opinions as a matter of regular practice. Search results often will be communicated from one individual in a company to another, and perhaps then to others. A written opinion gives everyone an equal understanding of the results and their implications. In addition, search opinions sometimes deal with unfamiliar concepts, such as the difference between registrations on the Principal versus the Supplemental Register. The significance of such factors often is better handled in writing. Finally, putting advice in writing can cause the writer to examine his or her conclusions more closely, and to improve the clarity with which they are expressed.

XVIII. Content of Opinion Letter

The average, uninitiated client expects that a trademark search will result in simple definitive advice: “Yes, you may use this mark” or “No, you may not use this mark.” Clients that have been through the process usually wish that the answers were that clear or simple.

Some searches do indeed yield very simple results—that is, that the search contains no apparently conflicting marks or reveals an obviously conflicting mark. Most searches, however, will not yield such unequivocal results, and counsel may be tempted to take the easy way out, either by saying “no” or by setting out the problems without a definitive conclusion.

Counsel should keep in mind that a trademark search is a means of gauging the level of risk in adopting a new mark. Even a “yes” answer does not mean that there is no risk, since the possibility always exists that the search somehow failed to locate a directly conflicting mark. A “yes” answer merely means that there is no risk apparent from the search. A “no” answer means that the risk is obvious. Every other search result is somewhere in between on the spectrum of risk. Counsel’s role is to help the client understand the level of risk and determine whether it is a reasonable business decision to assume that risk. While there is no magic formula for creating a good search opinion, the following suggestions may prove helpful.
1. **Reach a conclusion, and do it up front.** Most clients not only are looking for a conclusion—they are looking for it in the first paragraph of the communication. It is possible in virtually every opinion to give the client a clear sense of the level of risk in the initial paragraphs. The balance of the opinion can then explain the reasons for those risks, the unknown factors that might increase or decrease the risk beyond counsel’s estimate, and the steps that the client can take to reduce the risk.

2. **Make constructive suggestions.** The test for infringement, as formulated by the federal appeals courts, calls for the evaluation of multiple factors, none of which is necessarily dispositive. If the client is in a position to be flexible, it can adjust its mark and its marketing plans to reduce the number of factors that point toward infringement. Possible adjustments include avoiding particular typefaces and trade dress, combining a mark with a house mark, or avoiding use in a particular market or channel of trade.

3. **Distinguish between use and registration.** The opinion letter should clearly distinguish between risks in use and risks in registration. For example, some marks may be difficult to register because of prior “deadwood” registrations, but counsel may believe that there is little practical risk in using them. The opinion can spell this out.

4. **Distinguish between “black letter” and “real world” conclusions.** In determining availability, counsel has to gauge the potential for two related problems—whether the owner of the other mark would challenge the client’s use or application for registration and whether a judge or the Trademark Trial and Appeal Board would find likelihood of confusion. The two analyses do not necessarily yield the same conclusions. In some situations, the owner of the cited mark may have a reputation for being particularly aggressive in pursuing possible infringers, even when its case appears relatively weak. Counsel may believe there is a potential for challenge even though the challenger’s potential for winning on the merits is not high.

5. **Understand your audience.** Trademark counsel must obviously tailor advice to the client’s level of sophistication. Some clients have only a vague understanding of trademark law and the trademark selection process. A good opinion letter translates the technicalities into layman’s language, and either
avoids jargon (e.g., “ITU,” “secondary meaning”) altogether or provides clear definitions.

6. **Spell out the limitations and assumptions.** A client will not thoroughly understand the advice given unless the client understands the limits of the search process (described above). One method of providing this information is by way of a standard paragraph explaining the search process and database limitations. In addition, in carrying out the search, counsel almost always makes certain assumptions about the client’s products, services, markets, and marketing channels, and such assumptions should be spelled out so that the client understands what counsel believed he or she was searching.

7. **Suggest further investigation where appropriate.** Further investigation often is required to reach a definitive opinion on availability. If a client’s approval is required in order to undertake such an investigation, the search opinion should indicate what additional work counsel believes is necessary or desirable.

Following is a suggested outline of the structure of a search opinion.

**Outline for Search Opinion**

**Introduction:**

- Provide a brief summary of the searcher’s understanding of the proposed use of the mark (goods, services, geographic markets).

**Summary advice:**

- Provide opinion on the level of risk of third-party challenge if the mark is adopted, summarizing the marks (if any) that create risk and why.

- Provide opinion on the prospects for obtaining registration, summarizing the potential grounds for refusal (if any).

- Provide advice on potential steps to reduce the risk of challenge and obtain registration (e.g., conduct investigation, acquire marks, obtain consents, craft application to reduce potential for refusal).
• Provide information on the availability and current use of relevant domain names.

• Briefly outline the next planned or suggested steps in the search process.

  **Detailed discussion:**

  • Provide details on the marks (if any) that create a potential risk of challenge, and the most significant other federal and common-law marks in the search, with an explanation of their significance, information about their use and strength of third-party rights, and an analysis of potential for confusion.

  **Limited discussion:**

  • Briefly describe less significant federal and common-law marks, with explanation of why they are not significant.

  **Additional assumptions:**

  • Describe the searcher’s understanding of any additional assumptions about the use and timing of the new mark.

  **Caveats:**

  • Explain blind spots and other limitations in conducting the search.

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**XIX. After the Mark Is Adopted**

The opinion should not disappear into the file after the decision is made to adopt the mark. Ideally, it becomes the blueprint for the protection of the mark, outlining potential issues to be considered when crafting and prosecuting the application. The Administrator will likely play a key role in that process. If questions arise about possible conflicts or difficulties in the registration, he or she will be able to refer back and say, “Yes, we spotted that issue, and here’s the solution.”