

Your Trademark Search

A General Overview

Introduction to Searches

Searches are conducted to ensure that a trademark or service mark a business wants to use is available for use, and possibly for federal registration at the U.S. Patent and Trademark Office. Searches are a good way to help companies make an informed decision about whether they can use a trademark prior to investing time, money, and emotional capital in a mark.

The terms “trademark,” “service mark”, and “mark” are often used by attorneys to describe the same thing. Technically, a trademark designates goods (tangible products) and a service mark designates services, but the terms are interchanged frequently, and these references have no legal effect.

When is a mark available?

A mark is available for use in the U.S. if it does not conflict with the superior (prior) rights held by another person or company. A conflict arises when one mark is confusingly similar to an existing mark used by another person or company for related goods or services. The factors to consider include the similarity in appearance, sound, or meaning between the proposed mark and the pre-existing mark, the similarity of the respective goods or services, the similarity of the channels of commerce through which the respective goods or services pass and the sophistication of the prospective purchasers. Other factors, such as the strength of any existing mark and the intent of the latter party in adopting its mark, may also be considered. In the event of a conflict, the person or company who first began using the mark generally has superior rights.

A mark is available for registration in the U.S., if it does not conflict with the registered rights of another person or company – and if the mark complies with other legal requirements. For example, U.S. trademark law does not allow registration of generic terms and limits the registrability of marks that are merely “descriptive” of the goods or services they designate.

A trademark search is a good way to help evaluate the risks in using or trying to register a mark. A trademark search looks for possible conflicts with existing marks. We outsource the execution of the search to a reputable commercial search service. The search service compiles a report containing the information it considers the most relevant to the mark being searched.



Limitation of Searches

Your U.S. full search report encompasses records of the U.S. Patent and Trademark Office (“USPTO”), state trademark registrations, common law marks, trade names and domain names. While the databases searched are extensive, they are not exhaustive, and there can be no assurances that all relevant marks have been retrieved. The search report’s most important limitations are summarized below.

Federal: The federal search database includes all existing registrations and pending applications. There can be, however, up to a one-week lag time between the time an application is filed and when it appears in the database. Thus a third party may have recently filed an application for a confusing similar mark that will not be found by the search.

If a foreign applicant files a U.S. application within six months after filing an application for the same mark in a foreign country, under certain conditions, its U.S. application will be considered to have been filed on the same day as its foreign application. Thus it is possible that U.S. applications filed up to six months after you file could actually have an earlier effective date.

Also, abandoned applications may be revived for up to two months following the date of abandonment under certain conditions. Thus, it is possible that applications identified in the search report as abandoned could be subsequently revived.

It is also possible that, even when a federal application or registration is abandoned or cancelled, the mark is still in use.

State: Each state has a filing backlog ranging from two months to over two years. Moreover, the search does not review state registers of corporate names and, for most states, it does not review assumed names, trade names, or fictitious names. If you anticipate incorporating or registering to do business under the proposed mark, please advise us so we can consider additional searches that may be necessary or appropriate.

Common Law: The search covers a wide variety of databases, but it is not exhaustive. A significant common law use may not appear in any of the databases or it may not appear in sufficient detail to reveal its relevance.

Domain Names: The search covers only second-level domain names registered with ICANN-accredited registrars. It does not cover (a) information and sites on the web other than the home page connected to the identified domain name; (b) lower level domain names which cannot be registered; (c) domain names registered with various international registrars; or (d) email addresses, including those used through ISPs and online service providers such as AOL and MSN.

Analysis of the Search Report

Our discussions of the search report with you are intended to highlight what we consider to be the most significant risks uncovered in the search report, if any. Of course, it is impossible to predict how the USPTO or other people or companies may view the mark in question or how they may react. One company may be quite lenient, while another may be extremely aggressive and seek to stop your use of the mark or application to register the mark even though you feel the company’s case against you is weak. If you have any questions or concerns, please contact us.