



SMALL BUSINESS & NONPROFIT CLINIC

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4/27/09

Doing a Thorough Trademark Search

Federal Trademark Search

When your client starts their new business, they put a lot of time and effort into thinking of the perfect name. It can be devastating to your client if they start using a name that's catchy, descriptive or unique and begin to build brand equity, only to receive a cease-and-desist order from another company using the same (or a similar) name. That's why you should always conduct a thorough trademark search for your client.

To give you an idea of how a search should look, we offer up a hypothetical for your convenience. Here, we conduct a search from the standpoint of a lawyer; however, anyone can follow the same steps that follow. Let's say your new hypothetical client is starting a web site and wants to call it CommonLaw.com. It will be an electronic database that helps people conduct legal research, like Westlaw or Lexis.

Introduction to TESS

TESS is the USPTO's (United States Patent and Trademark Office) trademark electronic search system database. It contains hyperlinks to all pending and registered United States trademarks and information about dead trademarks, at least since January 1, 1984; common law, state, or foreign trademarks are not included on TESS. To get to TESS:

- Go to the USPTO's home page, at <http://www.uspto.gov>.
- On the left side of the screen, click on the tab entitled Trademarks.
- Then, click on "Search TM database (TESS)," the third listing under the Trademarks tab.

Selecting the Search Form

TESS has several different search form options to choose from: the New User Form Search (Basic), the Structured Form Search (Boolean), the Free Form Search (Advanced Search),

Browse Dictionary (View Indexes), and Search OG Publication Date or Registration Date. Each of these search options will be explained in turn below.

New User Form Search (Basic)

This search option allows users to search within some of the most commonly searched fields: word marks, serial or registration numbers, and owners. Combined word mark is the default search field; it appears across from the “Field” category of search options and includes a search of the word mark field and the translation indexes. If you know the serial or registration number of a particular trademark you are searching for, you can select this category by clicking the drop-down menu where “Combined word mark” is shown. Finally, if you know the owner name or address of the mark you are searching for, you can also select this category by clicking on the same drop-down menu as used to find the mark containing a certain serial or registration number. Thus, the New User Form can be used by those users seeking conflicting trademarks to the one they hope to use, as well as by those users seeking a certain trademark but who only have certain information pertaining to that trademark.

Type any word into the blank space located across from the “Search Term” field and hit the “Submit Query” button. A list of results will pop-up on the screen. In our case it would go as follows:

- I start by typing “commonlaw.com” into the space located across from the “Search Term” field, using the “Combined word mark” as my search field, given that I am trying to find out whether commonlaw.com is already in use as a trademark. Then, I hit the “Submit Query” button.
- Nothing appears on the screen. No records match my search.
- I return to the New User Form Search screen to search a variation of ‘commonlaw.com’ just to be sure that the “no records found” really was a signal that my trademark hasn’t already been taken.
- I type in “common law” into the blank space. I hit the “Submit Query” button.
- On my screen appears a list of 13 results, each one similar to the search term I used.
- Since only 13 results appeared, my next step is to check out each of the results further to see if any of the marks are of identical or substantially similar goods or services and are identical or substantially similar in name to commonlaw.com . I can do this by clicking on any of the highlighted fields.
- The eleventh listing, commlaw.com, is the result most similar to commonlaw.com, so I will start by clicking it.
- On the screen appears information relating to commlaw.com’s trademark, including a description of what it pertains to under the “Goods and Services” field and its filing date.
- Commlaw.com’s description reveals that it is a website that provides just the type of information we are looking to provide. Given this, and that commonlaw.com is likely substantially similar in name to commlaw.com, it could lead to trademark infringement should we go ahead and register commonlaw.com.
- However, the information listed under commlaw.com’s trademark also relates to us that this trademark has been abandoned, that it is no longer active, and thus we would not be in conflict with this mark should we go ahead with our plans.

Information on a trademark's active status can also be found on the page listing all of the results, under the Live/Dead category located on the right side of the screen. The Live/Dead category indicates whether a trademark is still being actively used by a person or entity or whether it has been abandoned, leaving it open for use by another person or entity, with the proper registration of course. Using the blue "TARR Status" button located near the top of the screen listing further information on a mark, or on the page listing results (under the Check Status category), pulls up even more information on a mark, including the owner's name and address.

One trick to using this search is to shorten your search term to produce more results, to make sure that a potentially conflicting trademark is not missed. To do this, simply add a * (to make the search a wild card search) to the beginning or end of a word and, by doing so, you will be able to retrieve a list of marks with common variations of the word. For example, if you were to type in the word "dog*," you would be able to retrieve a list of marks not only featuring the word "dog," but also common variations of dog, including dogwalk, that may not be listed under a search of the word "dog" by itself.

Structured Form Search (Boolean)

Using this search form requires you to search using Boolean operators. These are standard electronic search term connectors, typically "AND," "OR," and "NOT." The USPTO database features these three plus others including "ADJ" (for adjacent), "NEAR," "WITH," and "SAME." For example, if you wanted to search for marks that had the word "dog" but not the word "cat," type in the first search term "dog," pull down the "NOT" from the operator menu, and then type in second search term "cat." If you wanted to search for marks that had both the words "dog" and "cat," search "dog" AND "cat."

For our hypo client we ran a search that used the search term "common" adjacent to "law." There were 8 records total found. One, Commlaw.com, "provide[d] on-line information via a computer network connected by common protocols featuring information regarding legal issues." It was abandoned on 2/22/2001. Another one, Digital Common Law, however, is a live mark for "research in the field of intellectual property, namely trademark search services." However, a disclaimer says that "no claim is made to the exclusive right to use "common law" apart from the mark as shown." This means that the holder of a trademark of a common phrase, such as "common law," will only hold the trademark with respect to how it is registered. In other words, if the trademark is "commonlaw.com," the owner of the mark will only be able to enforce its rights against other uses of "common law" in a domain name, not that the owner holds the exclusive right to every use of "common law."

Free Form Search (Advanced Search)

This search menu allows you to search a term and also narrow it down by selecting one or more sub-categories under which to search. This type of search is most helpful if you are looking for a search term that features a fairly common word, or have more detailed information about the mark or the application for the mark – such as registration date, registration number, or attorney of record.

For instance, you may narrow your search by category of good/service by checking in the particular international class category that your trademark will fit into. There are two main

categories – Goods and Services. Our client’s site would fall into Services sub-category “042” which correlates to Computer, Scientific and Legal. Since our client is developing an electronic legal database, this is the best match. If you want to search for marks by class, or narrow your search to include marks with similar names in the same category as your client, Enter “NUMBER”[IC] to retrieve all documents in that particular class category, or ((IC WITH “042”) SAME COMMONLAW [GS]) to retrieve marks containing the word “commonlaw” occurring in international class 042 in the goods and services category. (Keep in mind that US Class categories do not correlate exactly.)

You may also want to try the Pseudo Mark Index [PI]. It may help you identify relevant marks related to your search term, but not spelled exactly the same. This is helpful particularly if your client is either a web site or trying to appeal to young people by featuring a trendy spelling. The USPTO offers two examples:

- a document with the word mark “4U” might contain a pseudo mark of “For You”
- searching a pseudo index field for *QUICK*[PI] should retrieve marks whose word mark field contains words like “kwik,” “kwix,” “quik,” etc.

We tried running a few different types of searches in this search form. The most effective was “COMMON and LAW[PI],” which looked for any Pseudo Mark Indexes that featured the words “common” and “law.” There were five records returned. One was Corpus Juris Secundum, the well-known legal research publications produced by Westlaw. Another mark, which had not turned up in previous searches, was Lawworld, a British-based company which comprises an international network of independent law firms.

Dictionary Browse (View Indexes)

This type of search allows you to enter a search term (or part of one) and see that term as well as 10 other items that surround it alphabetically (5 that precede it alphabetically, the search term, and 5 that follow it). We ran a search for the term “commonlaw.” The terms returned were as follows: commonknowl*; commonknow*; commonkno*; commonkn*; common*; commonlaw; commonleaf; commonleaf*; commonlea*; commonle*; and commonlib. The results box indicated that there were 32 docs returned for “commonlaw.” While this may at first appear to be a long list of trademarks with “commonlaw” as part of the mark, it actually returned documents that contained the word “commonlaw” *within the trademark record itself*. None of the actual returned marks contained the term “commonlaw.” Every return had the word “commonlaw” appear as part of its disclaimer as to commonlaw rights retained in using certain well-known words as part of their trademarked terms in the trademark application. Therefore, this particular type of search was not effective in returning a potentially competing mark. You can increase the effectiveness of your search in this index by adding the suffix “[MP]” after your word mark search – this will only look for word marks with punctuation. Another search with “commonlaw[MP]” returned 11 dictionary terms, none of which had “commonlaw” as part of their registered word mark.

Search OG Publication Date or Registration Date

This search option was designed to assist new users in performing effective searches of marks recently published for opposition. Searching under this option is simple. Type a date into the blank space located across from the “OG Date” field. Then clarify whether the date is the date

the mark was published for opposition, which is the default search field, or click on the drop-down menu where “Publish for Opposition Date” is shown and click on the Registration Date option, for when the mark was first registered with the USPTO. After you have done this, click the “Submit Query” button and a list of marks corresponding to that date will appear.

Note: The “OG Date” refers to the date that the mark is published in the Official Gazette -- Trademarks, either for registration or for publication for opposition.

Remember, even if you have conducted a thorough search using TESS, it may be wise to still consult a trademark attorney for proper analyses of your search results.

Following are the *likelihood of confusion* search principles used by the USPTO that you may want to consider prior to submitting a trademark application. You must decide which of these search principles may be appropriate for your trademark search. Even if you diligently follow all these search principles, that does not necessarily guarantee that you will find all potential citations under Section 2(d) of the Trademark Act.

- 1. Conduct a Thorough Search.**
- 2. Search All Forms of all the Distinctive Elements of the Mark.**
- 3. Search Each Distinctive Element Alone.**
- 4. Search Acronyms AND What They Stand For.**
- 5. Search All the Legal Word Equivalent of Terms.**
- 6. Search Component Parts of Individual Terms When Necessary.**
- 7. Searches for Marks Consisting of Two or More Separate Terms Should be Conducted so that the Two Terms Would be Retrieved Whether They Run Together or are Separate.**
- 8. Search Pictorial Equivalent for Distinctive Terms and Vice Versa When Appropriate.**
- 9. Search all Phonetic Equivalent.**
- 10. Search all English Equivalent.**

State Trademark Search

Searching for Michigan trademarks can be done a variety of ways. The most obvious way to search for a Michigan trademark would be to look at DLEG’s (the Department of Labor & Economic Growth) listing of registered state trademarks and service marks, available at <http://www.dleg.state.mi.us/bcsc/forms/corp/mark/markcom.pdf>. Unfortunately, the list does not have a search function (apart from the pdf’s own search tool), rather marks are listed in alphabetical order according to the mark itself. Information on the registration, renewal, and expiration dates can also be found along with each mark’s listing.

Another way, perhaps less thought of, is to use DLEG's Business Entity Search, found at http://www.dleg.state.mi.us/bcs_corp/sr_corp.asp, under the Bureau of Commercial Services' home page under the "Quick Links" tab located on the right side of the page. Simply type in the mark you are searching for in the blank space next to the "Entity Name or ID Number" field and press the "Search" button.

Our example from above looks as follows:

- Typing "commonlaw.com" into the blank space once again produces no results.
- Changing it to a search for "common law" produces one result for us, for The Common Law Group, PLLC.
- Clicking on this result doesn't help us much in terms of finding out what the business involves, to see if there would be any trademark infringement concerns; however, most listings come with a link entitled "View Document Images" located at the bottom of the listing. That link may provide you with some of the company's founding documents, which provide more information with respect to the company's operations.

Although the listing of results doesn't indicate that the names listed are trademarked or not, using this search function can at least provide you with some leads in your search for possible state trademarks or service marks.

Finally, as you can do to supplement federal searches, you can perform a simple Google (or another internet search site) search by simply typing in the mark, or variations of it, you are looking for and hitting the search button. As with the Business Entity Search, the list of results that appears upon searching doesn't necessarily indicate that the names listed in the results are trademarked or not, but using this search function can at least provide you with some leads in your search for possible marks. The same can be said of using a phone book for any major U.S. city or Internet phone book.