3.02 Searching and Clearance

Once a mark has been selected, it must be determined whether there are any prior uses or registrations of a mark with which the proposed mark might conflict. This clearance process should occur before money is invested or use of a new mark commences. It could be costly for a company to ignore trademarks or trade names already in use in the marketplace that are similar to the proposed mark. While there is no clear legal obligation to conduct a search prior to adopting a mark, such a lack of knowledge would not serve as a successful defense to an objection raised by one of these prior users. Nor would this approach provide any consolation to a company that has invested in advertising, packaging and labels featuring a new mark only to learn that someone else is already using the same mark or one confusingly similar.

3.02(A) U.S. Searching

3.02(A)(1) Preliminary Search

After the paralegal or administrator has reviewed the information set forth in the clearance request memo, a search for prior conflicting marks should be performed. Clearance of a mark requires searching for conflicts with
existing marks. Probably the best place to begin is with a preliminary or “knockout” search. Often this serves as a quick and inexpensive means of eliminating or “knocking out” those proposed marks that contain an obvious conflict, and will weed out any marks that are either descriptive of, or frequently used in connection with, a particular type of product or service. It is important to note that not finding an obvious conflict does not mean the proposed mark is clear. It is simply a first step in lowering the risk of infringing on a prior user.

It may be possible to resolve existing conflicts in a manner that will permit the client to adopt, use and register its proposed mark. This could involve obtaining consent letters, purchasing rights from owners of existing conflicting marks, entering into a license agreement or other strategies. If the client expresses an interest in exploring this possibility, the clearance process should be continued in the manner set forth below. Of course, even if these initial conflicts can be resolved, additional conflicts could still be revealed by the full commercial search.

3.02(A)(1)(a) Searching Resources

Initially, the paralegal or administrator should determine what resources are available with which to implement the search. These would normally consist of the following:

- Online resources—LexisNexis, Dialog, SAEGIS, Compu-Mark, Imsmarq, CCH CORSEARCH and the Internet (including the USPTO website, which contains a searchable database (www.uspto.gov))
- Commercial CD-ROMs supplying searching tools
- Shepard’s Intellectual Property Citations, which lists trademarks subject to previous litigation or USPTO proceedings
- Industry-specific dictionaries and any product directories that include listings of trademarks and trade names used by companies with products similar to those set forth in the clearance request memo (e.g., Thomas Register of American Manufacturers, Physicians’ Desk Reference)

This list is by no means intended to be exhaustive. There may be other research materials available in the legal department or law office library pertinent to the specific products and services of a given client. If the paralegal or administrator can determine what research materials are most pertinent to the client’s usual products and services (e.g., catalogs, product lists, the client’s website and e-commerce information), copies of any other
pertinent materials that are not in the office law library or within the legal department’s intellectual property group can be secured.

Preliminary searches with CD-ROM and online resources provide a quick and cost-effective means of knocking out proposed marks that encounter obvious conflicts. These tools provide the paralegal or administrator with immediate access to USPTO and state registration office records via a computer terminal in the law firm or legal department. This facilitates the clearance process and expedites the conveyance of information to the client. Most online search companies provide training in use of their database at no cost. Fee-based providers, like SAEGIS, typically provide more up-to-date information on the chain of title for a registered mark than does the USPTO website or other free Internet databases.

The USPTO website maintains a database of records of pending and abandoned applications and of existing and canceled or expired registrations. (A printout is shown in Exhibit 3-3.) This no-cost database can be useful in performing a preliminary or knockout search. A previous drawback of this database was its lack of information pertaining to the chain of title; however, a link is now available to the chain of title for most, if not all, records. For unavailable records, a fee-based commercial database may be used to obtain the information.

### 3.02(A)(1)(a)(i) Federal Registrations and Pending Applications

These resources will provide information as to current federal registrations and pending applications to determine whether someone has already registered or applied to register an identical or similar mark in the same class of goods or services. Searches can be narrowed by limiting the search to classifications of goods or services related to those for the proposed mark. These databases also allow for searching of corrupted spellings of English words, as well as use of a word with different prefixes or suffixes. If a proposed mark is the phonetic equivalent of an ordinary English word, the search should also include words having phonetic similarities to the proposed mark. Today most online search engines like SAEGIS have the capacity to search logical phonetic spellings. (A sample printout from a SAEGIS search of federal registrations is shown in Exhibit 3-4.) If the proposed mark is the foreign-language equivalent of an English term (e.g., *aquila* = *eagle*), the search should include the English word as well, since the words would be considered identical for purposes of determining confusing similarity.

If a paralegal or administrator is asked to clear a design or logo, most search companies have design code databases for searching design elements for obvious conflicts. While the paralegal or administrator can
perform an online design code search, a search company can perform a
more thorough design search at less cost. Paralegals or administrators in a
legal department should be aware that even if the client is not charged for
their time spent in conducting an online search, the client will incur charges
from the search company when potential conflicts are viewed or a search is
generated as a result of a search inquiry. Paralegals or administrators
working in a law firm will have to bill clients for their time spent in
searching. As a rule, therefore, these preliminary searches should focus on
identifying only obvious conflicts with the proposed mark or the same or
similar goods or services.

3.02(A)(1)(a)(ii) State Registrations

Some, but not all, states have searchable trademark registration databases.
(See Exhibit 2-5 for a comprehensive listing.) The searching criteria and
procedures for searching these databases vary from state to state. As a
result, searching individual state databases is likely to be time-consuming
and ultimately not cost-effective for the client. It makes more sense to use a
fee-based database, such as SAEGIS, that offers a 50-state search of a
proposed mark. (A printout from a SAEGIS search of state registrations is
shown in Exhibit 3-5.)

3.02(A)(1)(a)(iii) Common Law

There are a number of useful resources available for searching common-
law trademark uses. If a mark survives the initial elimination round,
therefore, the next step should be to review online resources and research
materials available in a law library, especially those pertinent to the
relevant industry or field. Online searching can include Internet search
engines (e.g., www.dogpile.com, www.google.com), Nexis, Dun &
Bradstreet and other credit reports and electronic yellow pages. A Nexis
search and searches of online dictionaries and atlases will indicate whether
a proposed mark is descriptive/generic or geographic.

Many companies now operate websites that list existing and recently
introduced products. Since these materials will vary depending on the type
of product or service involved, no definitive list of such materials can be
provided. This portion of the search may involve a review of trade
directories containing lists of trademarks and trade names already in use
by other companies. A particular industry, such as tobacco or food
products, may also publish separate directories, and these should be
reviewed at this time. Remember that a prior user of a mark can have rights
based on use, even though federal registration was never sought; these
research materials are useful in determining whether anyone has such
common-law rights. (See section 4.01.)
There is also a certain interface between trademarks, trade names and corporate names that should be taken into consideration when clearing a trademark. It is possible for a trademark to conflict with an existing trade name or corporate name depending on the similarity of the name and the mark and the proximity of the goods and/or services. Consequently, consideration of existing trade names and corporate names will always play an important role in the clearance process. Many secretary of state offices are accessible via the Internet, and a search of a secretary of state’s online database may prove very useful in determining whether a corporate name has been reserved. It should be noted, however, that an increasing number of secretary of state offices are imposing a fee for accessing their information.

### 3.02(A)(1)(a)(iv) Domain Names

There are currently three inexpensive techniques for researching trademark usage and domain names on the Internet:

1. The most basic technique involves searching the Whois of common top-level domains (TLDs) to determine whether any domain names incorporating the trademark have been registered. The registry operators of common TLDs in the United States are:
   - Network Solutions Inc. (www.netsol.com) ................. .com/.net
   - Public Interest Registry (www.publicinterestregistry.org) .... .org
   - NeuStar, Inc. (www.nic.us/) ................................................ .us
   - NeuLevel, Inc. (www.neulevel.biz) ..................................... .biz
   - Afilias Limited (www.afilias.info) .................................... .info
   
   Whois search sites such as Uwhois (www.uwhois.com) and Allwhois (www.allwhois.com) provide simultaneous searching in multiple TLDs. More advanced Whois search capabilities may be found at sites such as HyperWHOIS (www.hyperwhois.com), which provides searches for computer-generated word combinations, and DomainSurfer (www.domainsurfer.com), which provides searches for terms appearing at the beginning, middle or end of domain names.

2. Trademark usage and domain names may be disclosed by performing Internet searches of pertinent keyword terms using such search engines as Google (www.google.com) and Yahoo! (www.yahoo.com). Google also provides advanced search options for fine-tuning searches.
3. Freeware or shareware such as Copernic Agent (www.copernic.com), Whois Web (www.rietta.com) and Available Domains (www.alphacomsoft.com) offers search options for researching trademark usage and domain names, permitting simultaneous searching of domain names across multiple keyword terms, parallel searching of keyword terms across multiple search engines, categorical searches and customized reporting.

In addition, Thomson & Thomson’s SiteComber and CCH CORSEARCH’s IntelliCite offer a fee-based search service of Internet web pages. This entails a detailed search of web pages for actual trademark usage. In this day of e-commerce, such searches may prove beneficial, since trademark owners are more likely to offer or advertise their goods online and through e-commerce.

3.02(A)(2) Full Availability Search

3.02(A)(2)(a) Searching Services

If the preliminary search discloses no conflicts with existing trademarks or trade names, a full availability trademark search should be ordered from an outside commercial search firm. (See Exhibit 3-6.) There are a number of companies that provide these computer searches. A full availability search generally is recommended for clearance of a proposed mark. Most search reports are generated in three to four business days, although companies usually will be able to provide search results to accommodate any need for expedited handling. The search reports typically provide information compiled from a number of different databases.

Searches can be ordered by telephone, but the paralegal or administrator should confirm to the searcher the correct spelling of the mark and the correct description of goods and/or services. Also, it may be advisable to request confirmation from the search company of the telephone request by fax or email. Search firms often provide their own format for ordering searches by fax or email. Most search companies now offer online ordering via their website, as illustrated in Exhibit 3-7. Ordering a full search online through the search firm ensures not only the correct spelling of the mark to be searched but also the inclusion of all goods and services associated with the proposed mark. Additionally, most search firms provide email confirmation of the online order and will deliver a copy of the search to an online mailbox (see Exhibit 3-8).

In relaying the description of goods and/or services to the search company, care should be taken to be as precise as possible. While there may be some temptation to broaden the description in order to have the search cover a wider range of marks, this may actually work to the client’s detriment. For
example, if the client has a specific type of goods or services in mind, a
searcher working with an overly broad or vague description and having no
knowledge of the specific goods or services might overlook a mark
registered for the same specific goods or services. If the client is
contemplating an application based on intent to use, it may be prudent to
request from the client a “wish list” of all possible goods and/or services in
connection with which the mark is to be used. This will be especially
important if the new mark is to be part of a new-product launch or is an
“umbrella” mark expected to be used in connection with many products.
The paralegal or administrator should also obtain from the client a time
frame within which a launch or rollout of additional products is
anticipated. A full search with many products (also known as a brand
expansion search or dilution search) typically carries additional search fees;
this will help to place a reality check on the client’s wish list.

Most companies offer a variety of searches covering different facets of
registration and use. In general, a full search should be ordered because it
will cover existing registrations and pending applications in the USPTO,
state trademark registrations, a common-law directory search, a search of
trade name listings and a search of Internet domain names. Since it is
possible for another company to have acquired rights through use of the
mark without applying for federal registration, a search limited to USPTO
records is inadequate.

3.02(A)(2)(a)(i) Federal Registrations

The full search will provide pertinent references from the USPTO database
concerning federal registrations and applications. While the paralegal or
administrator will already have performed a preliminary search of the
same database, search firms typically have more sophisticated searching
abilities that are likely to disclose marks not found during a preliminary
search. Search companies generally also provide more up-to-date
information on the chain of title for a registration, as well as information on
opposition or cancellation proceedings, and usually perform a more
sophisticated search of design features in federal registrations and
applications.

3.02(A)(2)(a)(ii) State Registrations

While some attempt to review state registrations during a preliminary
search may have been made, a full search will provide information
contained in the search firm’s database of state registrations. A state
registration provides the registrant with limited rights, and it can indicate
that the registrant may have current use in a specific geographical area;
confirmation of such use of a potentially conflicting mark is pertinent to the clearance process.

### 3.02(A)(2)(a)(iii) Common Law

A full search will also include information compiled from databases of information pertaining to common-law uses of trademarks, trade names and company names. The common-law databases available for the full search, which include databases proprietary to the search firm, typically are much more extensive than the resources available to a corporate legal department or law firm. Thus, the full search provides a meaningful enhancement to any preliminary clearance of a proposed mark.

### 3.02(A)(2)(a)(iv) Domain Names

Full trademark searches typically include listings of registered domain names and links to active websites offering some indication of the nature of the registrant’s business and whether the domain name is used as a mark. While a domain name typically serves as the registrant’s address for a website on the Internet, the registrant might also use the dominant portion of the domain name in the manner of a trademark as a source identifier for its products or services. If the search identifies an active domain name that incorporates the client’s proposed mark, the client’s adoption of the identical domain name will be precluded regardless of the nature of the prior registrant’s business, since a domain name is not registered with respect to a particular class of goods or services. While it may be possible to register a domain name with a variation in spelling, addition of hyphens or registration under a different TLD, the paralegal or administrator should first consider whether the goods and/or services of the client and the prior registrant are so related as to create a likelihood of confusion. The same assessment should be made even if the client does not intend to use the proposed mark as a domain name, since similarities in the proposed mark and a registered domain name, together with similarities in goods or services, could indicate a potential for likelihood of confusion.

### 3.02(B) International Searching

Where a client has expressed an interest in using and registering its mark outside the United States, the paralegal or administrator should be prepared to conduct a preliminary knockout search on the mark for any countries listed in the proposed mark information request form.

The format of an international search should if possible be the same as that of a U.S. search, with a preliminary search followed by a full availability
search. Because the availability of searchable databases varies by country, an international search is not likely to result in the same level of information as that compiled in a U.S. search. Many legal departments, therefore, will also rely on their attorneys in local jurisdictions (see section 3.02(B)(1)(d).

3.02(B)(1) Searching Resources

3.02(B)(1)(a) Internet Databases

If a proposed mark is to be used outside the United States, the paralegal or administrator can search databases for certain countries. For example, the USPTO database provides a link to the trademark databases of a number of different countries. Some of these countries, such as Canada and the United Kingdom, allow searching of databases for conflicting marks in a manner similar to the USPTO database. Since such searching typically requires an expenditure of time and money, paralegals and administrators who must bill a client for their time should remain sensitive to that fact when conducting preliminary international searches.

3.02(B)(1)(b) Fee-Based Databases

Commercial search firms also provide access to trademark databases for a number of countries, as well as International Register and Community Trade Mark databases. (For example, SAEGIS maintains such information for a growing number of countries.) Such international searches typically are more costly than searches of U.S. federal and state registration databases.

3.02(B)(1)(c) Searching Services

Trademark search firms in the United States usually provide international search reports. Not all countries can be searched. Moreover, the quality and utility of information will vary from country to country depending on the nature of the information maintained in local trademark offices. Worldwide and regional identical screening search reports will be limited to identical marks and goods or services and will not provide information as to the current status of a reference or an up-to-date chain of title.

3.02(B)(1)(d) Local Agents

If the international search report identifies potential conflicting registrations or pending applications, further information concerning a reference usually is available from local agents. Many legal departments
and law firms rely on local agents in other countries to implement trademark searches specific to each country of interest. In addition to fleshing out information on a proposed mark, the local counsel will be able to advise on the registrability of the mark under local trademark laws.\(^1\)

A local agent in a non-English-speaking country can also opine on whether a mark, when translated into the local language, will have an undesirable connotation or translate poorly to a customer in that country. It is important that clients and marketing or advertising partners remain mindful of a simple rule: What makes sense from an advertising or marketing perspective in the United States may not appeal to a customer in Europe or South America. Indeed, trying to “Americanize” a mark in another country will not always work, for a variety of language and/or cultural reasons.

### 3.02(C) Searching Techniques

There is no single best way to approach searching the availability of a mark. This chapter outlines the procedures for U.S. preliminary and full availability searches and, where appropriate, preliminary and full availability international searches. This information should provide a good foundation for a trademark paralegal or administrator to participate in the clearance and searching process. He or she will quickly come to realize that trademark searching is not a rote procedure and that each search must try to meet the client’s particular needs or concerns.

### 3.02(D) Limitations of Searching Methods

In conducting a preliminary search, it is important to remember the limitations of each resource and the time involved in conducting these searches. As the preliminary search is intended to find obvious knockout references, it should focus on identical or similar marks for similar or related goods and/or services.

More versatile and sophisticated, the techniques of a full availability search typically will broaden the scope of marks searched. Even a full search, however, cannot guarantee that all potentially conflicting references to the proposed mark will be uncovered. The information provided in databases and commercial availability searches is always limited to a time frame that ends sometime before a search is performed or ordered. Thus, there may be pertinent filings that occurred during this time gap or even after the closing

\(^1\) The question of registration in an international filing program involves a variety of different considerations. These are discussed in Chapter 7.
date of the search; these may require a later check of at least the USTPO database just before a trademark application is filed. Additionally, there may occasionally be a local user of a trademark (e.g., a small-business operator) that is not picked up by the common-law portion of a search. Such a local user has rights in its mark, even if only in its limited area of use. These rights may come to a company’s attention only after it has begun using and promoting its mark in the marketplace.

### 3.02(E) Reviewing Search Results

The results of the trademark search—consisting of lists of potentially conflicting references—must be analyzed by an attorney and an opinion furnished to the client. The extent of the paralegal or administrator’s participation in this process will depend on his or her level of expertise. Several factors should be kept in mind when reviewing and analyzing a search report; these are discussed below (see sections 3.02(E)(1)–3.02(E)(3).

#### 3.02(E)(1) Descriptiveness

A search report should provide some indication whether the proposed mark is likely to encounter an objection based on the ground of descriptiveness. For example, if the search report discloses a number of abandoned applications for identical or similar marks, this may indicate that the proposed mark is likely to meet the same fate. Other telltale signs of descriptiveness are frequent disclaimers of a word mark in registrations and applications and registration of the same or similar words on the Supplemental Register rather than the Principal Register.²

#### 3.02(E)(2) Likelihood of Confusion

To assess the likelihood of confusion with a mark disclosed in the search report, it is necessary to consider the strength and fame of any potentially conflicting marks or names; the similarity of the marks; and the similarity of the parties’ goods and/or services. Where the marks and the goods and/or services are sufficiently related that confusion is likely, the proposed mark probably is not available for use and registration.

#### 3.02(E)(3) Dilution

A potential conflict can also arise even where the proposed goods or services and those identified in a registration or application are different

² The differences between the Principal Register and Supplemental Register are discussed in Chapter 4.
and noncompeting. If a cited mark is famous or well known, it could be entitled to a broader ambit of protection under the concept of trademark dilution. This is an exception to the general rule that the same or a similar mark can be used and registered in connection with different and unrelated goods or services. Use of a famous mark on different and noncompeting goods or services, even though not likely to cause confusion, may nevertheless injure the mark by diluting the distinctive quality and goodwill associated with it. While the scope of the dilution doctrine is subject to ongoing judicial interpretation, the paralegal or administrator should be sensitive to similarities between the proposed mark and a famous well-known mark, even one in a different and unrelated field.

### 3.02(F) Use Investigations

There are times when a potentially conflicting mark disclosed in a search report can be investigated to determine whether the mark cited in the search is in use. For example, when a mark appears in a registration that was recently cancelled for failure to file a declaration of use or that expired as a result of nonrenewal, this does not necessarily indicate that the mark is no longer in use, since the cancellation or expiration may have been inadvertent. As a result, it is advisable to confirm that the mark is no longer in use.

#### 3.02(F)(1) Internet Searching

The paralegal or administrator can perform an Internet search attempting to locate a website for the owner of the application or registration at issue. The website typically will list current products. The absence of a product offered under the mark at issue could be viewed as some indication that the mark is no longer in use. It should be kept in mind, however, that just because a mark is not located on a website does not necessarily mean that the mark is not in use.

#### 3.02(F)(2) Agents

Since the absence of a mark from the owner’s website may not conclusively establish that a mark is no longer in use, it may also be advisable to have an agent perform an investigation to confirm that use of the mark has been discontinued, for how long and under what circumstances. The agent is usually more accustomed to contacting companies to obtain such information. In addition, should the issue of nonuse ever arise in a subsequent litigation, it will be helpful to have the testimony of an independent agent so that counsel will not be disqualified to enable that testimony. Companies that provide full searches may also provide the
service of calling the owner to ask if the mark is in use. This service is usually free or available at minimal cost.

3.02(G) Resolving Conflicts

If a search report contains one or more references that appear to preclude use and registration of a proposed mark, the opinion letter to the client should advise of this prior conflict. Presumably, the client will decide not to proceed with adoption of the proposed mark and will continue the selection process with clearance of additional marks.

There may be times, however—for example, when adoption of the proposed mark is particularly important to the client or when the client has already adopted the mark without waiting for proper clearance—that an attempt to overcome the obstacle should be considered. If the client expresses an interest in this approach, an investigation could be conducted to determine whether the conflicting name or mark is still actually in use, and if so, the nature and extent of such use. The paralegal or administrator should have investigators on call for clients and/or should endeavor to locate an investigator for that purpose.

If the prior reference is a federal trademark registration, an attempt could be made to purchase the registered mark from the registrant, in some cases anonymously. The purchase price may be nominal if the mark is no longer in use and may increase considerably if the mark is still in use. If this cannot be accomplished, and it can be shown that the registered mark has been abandoned as a result of nonuse or that the registration should not have been granted, it also may be possible to petition the USPTO to cancel the registration. This would overcome any citation of the prior registered mark by the USPTO against the client’s application to register its proposed mark.

Similarly, if an investigation shows that use of an unregistered mark or name appears to have been discontinued, it may be possible for the client to adopt its proposed mark and raise the defense of abandonment if the owner of the prior mark or name raises any objection. If the mark is important, an attempt may be made to purchase the prior user’s common-law rights in the mark or name.

If the question of likelihood of confusion between the prior mark or name and the client’s proposed mark appears to be debatable, it may be possible to approach the owner of the prior mark in order to determine whether it

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3 For a further discussion of the cancellation proceedings alleging abandonment, see section 8.02(D).
would consent to the client’s use and registration of its proposed mark in a manner that would not be likely to cause confusion. The letter typically takes the form of a letter issued by the owner of the prior mark and countersigned by the client. Even in the absence of such consent, the client may adopt a form of the mark that differentiates it from that of the prior user (e.g., combined with the client’s house mark, a distinctive design, different spelling).

### 3.02(H) Reporting Search Results

An opinion is only as good as the information upon which it relies. As a result, an opinion should state that it is based on the results of the full search report, as well as any other independent investigations conducted with respect to certain trademark references. This is because a search report, no matter how comprehensive, cannot conclusively establish the availability of a mark. There is also a time lag before information on recently filed federal applications becomes available.

The most that can be said in preparing an opinion is that a particular search did not disclose any references that are deemed likely to be the source of a challenge. It is impossible either to predict the scope of protection to which any owner of a mark may believe itself entitled or to know whether any references not included in the search results might exist. A search report that cites no apparent conflict may more accurately be said to reflect an acceptable level of business risk. Nevertheless, there is no better alternative to a search.

In some situations, the task can be facilitated by the use of preprinted memos. Certainly, if a proposed mark does not run into conflict with the general prerequisites for trademarks or the specific client policies on new marks, a simple one-paragraph memo over the attorney’s signature could be sent out approving the mark. The paralegal or administrator could even offer a telephone approval, followed by a confirming memo signed by the attorney. On the other hand, in-house paralegals and administrators and trademark counsel typically have more direct contact with the client. As a result, once the paralegal or administrator and the attorney have reviewed the search report, the paralegal or administrator may be able to communicate the results to the client via interoffice memo or email. In all cases, however, the paralegal or administrator should stress that he or she is speaking for his or her supervisory attorney. Additionally, when using email, care must always be taken to avoid breach of confidentiality. Email is rarely secure across the Internet, and this lack of security should always be considered in each circumstance where its use is proposed.

The letter or memo should advise the client (1) whether certain reported marks need further investigation to determine if they are still in use; (2)
whether, where the search report does not disclose a company’s goods or services, it may be necessary to determine the company’s business activities; or (3) if it is necessary to determine the reason for an abandoned application.

Because it is a legal opinion, it is important that an attorney review and sign the letter or memo advising the client as to the availability of the proposed mark. Moreover, there are many fine points in the analysis of a trademark search that may not be apparent to a paralegal or administrator who has not had extensive experience in drafting such opinions.

Depending on his or her level of expertise in trademark law, the paralegal or administrator may be asked to review a search report and prepare a draft letter or memo providing an opinion, based on the search report, as to whether the proposed mark is available for use and registration (see Exhibit 3-9). The letter or memo should always stress to the client (1) that approval of a proposed mark was based on information disclosed in the search report and any other sources identified in the letter or memo; (2) that a possibility still exists that the search failed to disclose conflicting references; and (3) that references not deemed by the attorney rendering the opinion to be conflicting might, nevertheless, be considered conflicting by owners of the referenced marks or by the USPTO.

A more detailed memo will be required if adoption of a proposed mark is advised against. While this memo can be brief (in order to preserve the speed of the clearance process), it should give some explanation as to why the mark failed to pass muster. For example, the memo should advise (1) whether the proposed mark is overly weak (e.g., a merely descriptive word, a surname, a geographic term or a laudatory word); (2) whether it will be difficult to claim exclusive rights in the mark or to obtain a registration of the mark; (3) whether the mark is likely to conflict with a mark identified in the search report; and/or (4) whether a proposed mark violates a corporate policy on trademarks (e.g., the mark may display a company logo without the proper graphics or consist of an unacceptable variation of an existing mark). Clients desiring further information as to an acceptance or rejection of a proposed mark could make further written or verbal inquiries.

### 3.02(i) Follow-Up Search

If no response is received from the client within a month of the initial clearance memo, it may be appropriate to send a follow-up memo inquiring as to the status of the client’s interest in adopting the cleared mark. It is also important to explain to the client that the results from a full trademark search can become stale even after a short time, since new applications superseding the client’s rights could be filed during this
period or filings not searchable at the time of the original search might now have become amenable to a fresh search.

In some instances, for one reason or another, a client may delay after clearance of a new mark before deciding to adopt the mark. If the period of time between clearance and adoption goes beyond three to six months, a new or supplemental trademark search probably should be obtained. Beyond that period, the entire clearance process probably should begin anew. This is because a competitor may have had sufficient time to adopt the same or a similar mark for a similar product or to file an intent-to-use application according it nationwide priority vis-à-vis the client and its proposed mark. On the other hand, if an intent-to-use application for the proposed mark is filed very soon after the search, the client will be accorded nationwide priority as of the filing date, conditioned on issuance of the federal registration. This will eliminate the need for follow-up searches.

When the follow-up search is received, the paralegal or administrator should review it in the same manner as the initial search. A memo to the client, advising the client whether the mark is still available for use and registration, should then be prepared for the attorney’s review and signature.
4.03 Prosecution of a U.S. Application

4.03(A) Procedural Refusals

The examining attorney may raise certain concerns about various aspects of the application. If those concerns are not satisfied either by explanation or by amendment, he or she may refuse registration unless the applicant accedes to the requirements set forth in the final refusal. (See section 4.03(D).)

4.03(A)(1) Identification of Goods and Services

In every application for federal registration, the applicant must set forth a description of the particular goods and/or services on or in connection with which the mark is used or to be used. This description should be formulated with great care. If it is unduly broad, the application may be rejected on the basis of likelihood of confusion with a mark that is the subject of an existing registration, or a prior application that may mature into a registration, when a narrower description might avoid such an issue.

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On the other hand, a broad description of goods and services often is desirable, because the broader the description, the broader the protection that may be available later against a subsequent application for registration. Thus, in formulating the description of goods and services, the paralegal or administrator and the attorney must rely on the results of the earlier search report and have an eye to future defense of the registration against subsequently filed applications. In formulating an appropriate description, the Acceptable Identification of Goods and Services Manual must be consulted (see section 4.02(A)(4)(a)).

An examining attorney may object to the wording chosen by the applicant to identify the goods and/or services specified in an application. Sometimes the objection is related to a lack of specificity in the description (which examiners call “indefiniteness”); ordinarily the examining attorney will then require that a suggested clarifying phrase be added or substituted. For example, if “athletic equipment” is the goods in the original application, the examining attorney might require that the identification be amended to “athletic equipment, namely…” (followed by the type of equipment sold or to be sold by the applicant). Occasionally, the applicant may view the examiner’s request for specificity as being too specific. At that point, the applicant may advance to the examining attorney reasons why his or her proposed identification is too narrow.

The identification must be worded in a way that is consistent with the Acceptable Identification of Goods and Services Manual. Not every type of good or service is included in the list, and sometimes the applicant must use good judgment in identifying the goods and services.

The formulation of the goods and services identification might lead to a refusal if, in the eyes of the examining attorney, the applied-for mark is likely to be confused with another mark that is for the same, similar or related goods and/or services and that is the subject of a previously filed application or a previously issued registration. This is why conducting a search and reviewing and understanding the search results are vitally important—because by doing so the applicant can anticipate these types of citations. The goods and services identification in and of itself will not provoke a refusal based on likely confusion if the marks themselves are not similar; however, the applicant substantially increases the likelihood of rejection the closer the description of goods and services is to the goods and/or services of any mark that is featured in a prior registration or prior application and that bears some similarity to the applied-for mark. The paralegal or administrator can make an important contribution by learning to understand from search results the approved manner of identifying goods and/or services and applying that knowledge to preparation of new applications.
It should also be kept in mind that a very detailed identification that reads identically to the detailed identification of a prior application or registration may sometimes provoke a “Eureka!” reaction in the examining attorney, where the suspicion of any observed similarity in the marks is then confirmed by the odd mirroring in the goods and/or services of the later-filed application.

Another consideration in formulating the goods and services identification is the need to avoid providing evidence to the examining attorney that the mark is merely descriptive or generic. (See sections 1.05(D), 1.05(E).) If words in the mark are mirrored in the identification of goods and services, the chances of rejection based on mere descriptiveness or genericness will be increased. The desire to avoid a refusal tied to the goods and services identification must be balanced by the need to try to get issued a registration that provides protection as broad a swath of goods and/or services as possible. The broader the identification, the broader the protection that may be available when later attacking any mark, or application for any mark, that is deemed likely to cause confusion.

Therefore, in formulating the identification of goods and services, one must simultaneously anticipate and strategize how to avoid refusal by the examining attorney, based on an objection to the identification, while still moving forward to try to obtain the strongest registration possible. Sometimes this requires initial formulation of the goods and services identification in a broad manner, knowing that it may likely elicit an objection that could later be handled by a narrowing of the identification. In other instances, the strategic decision to provide a narrow identification initially would be more appropriate.

In summary, formulating the goods and services identification is not as routine or mechanical as it might first seem. This is one of the areas where a skilled trademark lawyer and trademark administrator can shine, because, while most others are not likely to recognize the strategic significance of goods and services identifications at the time of filing, the skilled professional will soberly understand how this part of the process will significantly affect the later success or failure of the application.

4.03(A)(2) International Class

As noted above, the USPTO uses an internationally accepted classification system to keep track of the applications filed and the marks registered (see section 4.02(A)(4)(f)). Every application must identify the particular international class or classes in which the identified goods and/or services associated with the mark are categorized. An applicant may include, in a single application, goods or services, or both, that may fall into more than one class, provided the applicable filing fee for the total number of classes
is paid. The way an applicant matches the goods and services with the right international class is by using the USPTO’s *Acceptable Identification of Goods and Services Manual*.

If the application incorrectly identifies the class into which the goods or services fall, the applicant will be requested to amend it to correct the class. If the applicant refuses to amend in a satisfactory way, the examining attorney can reject the application.

Why would an applicant resist the examining attorney’s suggestion that the class designation be changed? In some instances, the applicant may have filed for a particular class because he or she (or it) wants to obtain a registration covering that particular class. This may be part of strategic thinking related to the applicant’s competitors, or a perception that this is the most likely class that third parties might look at when searching marks for similar goods or services before filing themselves. The designation of one class, rather than another, might be the consequence of the applicant’s already having coverage in one class and desiring coverage in another. If the application is shifted to a class for which the applicant already has obtained coverage under another application or registration, the prospect of obtaining two registrations, both in the same class, might be undesirable. Unless the class identification is clearly wrong as stated in the application, this is another area where applicants may engage in arguments with the examining attorney supporting the correctness of the original class selection.

The examining attorney may accept the class or classes as stated in the application for some of the goods and/or services, but may suggest that the remainder of the goods or services fall into a different class. He or she may invite the applicant to add a class to the application in lieu of deletion of the goods or services that the examiner believes fall into the new class. The applicant might (1) choose to do so and proceed with a multiple-class application; (2) decline to add a class or classes, and thus have the goods or services deleted; or (3) accept the added class and then break out the additional class into a separate application upon the payment of the applicable fees for dividing out a class or classes (see section 4.03(H)(6)). The third alternative may be a wise strategic choice to protect the original application.

Changing a single-class to a multiple-class application, at the invitation of an examiner, may change the strategic and economic dynamics of an application. It will certainly add the cost of another class, which will layer hundreds of dollars into the cost of the application. If any one class of a multiple-class application is opposed by a third party at the time of publication, the whole application gets held up. If any one class provokes substantive problems with the examining attorney, the whole application gets held up. The addition of another class may bring the application closer
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to prior registrations or applications, which the applicant may have been trying to avoid. In short, one must consider very seriously the ramifications of adding a class at the invitation of the examiner. It may be a good idea to do so, but certainly the decision must be analyzed in the context of (1) cost and (2) likely effects on the further prospects for the application.

4.03(A)(3) Description of Mark

Where the mark contains elements beyond words, the examining attorney may require a description of the mark, or it may be offered voluntarily by the applicant. The requirement for a description is triggered if the mark (1) has a significant element that is “unclear or ambiguous”; (2) is three-dimensional; (3) is a configuration of the goods or packaging for the goods; (4) has broken lines to indicate placement or a feature that is not claimed as part of the mark; or (5) has color or motion or is a sound, a scent or nonvisual. [See TMEP § 808.01.] If a description is filed with the original application, it may not be amended if the amendment causes a material alteration. In the course of the application, the examining attorney may suggest a different description and, if the applicant did not provide one, may offer one up, but the change must not be a material alteration. If a description is unsatisfactory or harmful, the examining attorney may require the applicant to delete it or correct it; the failure to comply with this requirement could lead to a refusal.

4.03(A)(4) Disclaimer

Trademark words must be distinctive, not merely descriptive or generic. (See sections 1.05(D), 1.05(E).) Generic or merely descriptive words or elements that comprise part of a mark may be required by the examining attorney to be disclaimed—that is, that the applicant add a disclaimer that the words or elements disclaimed are not “owned” by the applicant apart from the whole mark as shown. The usual form of the disclaimer is: “No claim is made to the exclusive right to use [term to be disclaimed], apart from the mark as shown.” [See TMEP § 12.13.09(a)(i).] If the applicant refuses to accept such a disclaimer, that can be the basis for a refusal to register. An applicant may be reluctant to accede to the request for a disclaimer if he or she (or it) believes that the words or elements are distinctive, are not merely descriptive or generic and give the applicant a competitive advantage. In some instances where the words or elements are claimed to be merely descriptive, the applicant may have separately used the particular words or elements as or for a trademark for at least five years, enough to establish acquired secondary meaning. Under Section 2(f) of the Lanham Act (15 U.S.C. § 1052(f)), if sufficient proof is shown through
evidence, acquired distinctiveness can be claimed as a basis for registration of descriptive elements.

4.03(A)(5) Specimens of Use

The applicant’s failure to provide acceptable specimens may be the basis for a refusal by the examining attorney. The examiner may object to specimens of use for a variety of reasons:

- They may not show use of the mark in connection with the identified goods and/or services in the application.
- For service marks, the specimens may not show use of the mark in connection with services being offered to others. (Commonly, specimens showing advertising slogans being used in connection with one’s goods are the source of a rejection insofar as no service is being offered to third parties.)
- The applied-for mark is not being affixed to any particular goods or, if affixation is not practical, is not available at the point of sale.
- Specimens may be defective if the applicant tries to submit advertising or promotional materials ordinarily suitable only for a service mark application, in connection with a trademark application related to goods (rather than a photo of the mark affixed to the goods or a duplicate of the label, tag, container or display associated with the goods and bearing the mark).

4.03(A)(6) Other Procedural Refusals

There are other procedural reasons for refusing an application, including, but without limitation, the following:

- If the applicant improperly attempts to register more than one mark, such as by including a “phantom” or changing element (e.g., “Best Guide to [fill in city name]”). [See TMEP § 1214.]
- If the applicant is identified as the wrong party in the application. [See TMEP § 1201.02(b).]
- If use of the mark is not by the applicant and not by a company considered a “related company” under the rules. [See TMEP § 12.01.03.]
- If the applicant is a mere distributor or importer of the goods for the owner of the mark. [See TMEP § 1201.06(a).]
4.03(B) Substantive Refusals

4.03(B)(1) Not a Mark

Some words or symbols cannot serve to identify the goods or services of one source because they are the common name of the goods or services themselves—in other words, the purported mark either is merely a generic term or does not function as a mark (i.e., it functions only as a corporate name or trade name).

A generic term, such as “ice cream” for an ice cream product or “grocery store” for grocery store services, can never function as a mark because it is the commonly used term to describe the product or the service. (See section 1.05(E).) Similarly, if the mark consists merely of a descriptive slogan or a slogan that is not being used as a mark, registration will be refused. [See TMEP § 1213.05(b).]

A common mistake made by applicants is to submit as a proposed mark matter that is not distinctive but is used only as a corporate name or trade name. For matter to function as a mark, it must distinguish particular goods or services of one provider from all others. Unlike a trade name, commercial name or corporate name, a mark is not a reference to the business of the applicant as a whole but is, rather, an indication of the source or origin of particular goods or services. Applicants who submit as specimens of use firm letterhead stationery or business cards that refer merely to the entire business usually receive a rejection. Such submissions provide a telltale sign that the use by the applicant is not as a mark.

This does not mean that a trade name, commercial name or corporate name cannot function as a mark, but if the evidence of use indicates that use is only as the former, registration will be refused.

4.03(B)(2) Descriptive/Misdescriptive

An application may be refused if the mark is either merely descriptive or deceptively misdescriptive. (See section 1.06(F).) If it is merely descriptive, this means that in the eyes of consumers the mark would be seen, at least initially, as being directly descriptive of some quality or attribute of the goods or services being offered, rather than as a mark denoting a single source. In contrast, a coined mark has no meaning at all to consumers in relation to the goods or services on or in connection with which the mark is applied, and would not be associated with any particular aspect of the goods or services being offered. A good example of this might be EXXON, which is a made-up word. (See section 1.05(A).) A suggestive mark might suggest or imply something about the goods or services without being directly descriptive, but it requires an additional mental step to move from
the mark to the goods or services. A good example of a suggestive mark would be COPPERTONE. (See section 1.05(C).) Both coined marks and suggestive marks usually are considered inherently distinctive and are entitled to registration on the Principal Register, assuming that all other application requirements are met; a mark that is merely descriptive must be proven to have the necessary level of distinctiveness. If a mark is merely descriptive, and the applicant cannot demonstrate that through long and substantially exclusive use consumers have come to associate it with a single source, the mark will be refused registration on the Principal Register, although it may be eligible for Supplemental Register registration.

Similarly, if a mark is descriptive, but falsely—in other words, if it is deceptively misdescriptive—the examiner may refuse registration. (See section 1.06(F).) If the examining attorney concludes that the mark is deceptively misdescriptive, the mark is not registrable on the Principal Register unless there is a showing of acquired distinctiveness. A deceptively misdescriptive mark may be registered on the Supplemental Register if acquired distinctiveness cannot be proven. [See TMEP § 1209.04.] If the examining attorney determines that a mark is not deceptively misdescriptive but is deceptive, the mark is not registrable on either register under any circumstances. (See section 1.06(A).)

A mark that is geographically descriptive of the origin of the goods or services, and that consumers would perceive as such, is unregistrable on the Principal Register absent a showing of acquired distinctiveness. (See section 1.06(G).) If acquired distinctiveness cannot be shown, a geographically descriptive mark may be registered on the Supplemental Register.

A mark may also be rejected for being geographically deceptively misdescriptive if the primary significance of the mark is geographic and if consumers are likely to think that the goods or services originate in the geographic place identified by the mark when, in fact, they do not originate in the identified place. [See TMEP § 1210.01(b).] (See section 1.06(G).) A geographically deceptively misdescriptive mark may be registered on the Supplemental Register or, if sufficient acquired distinctiveness is shown, on the Principal Register. Going a step further, an examining attorney may conclude that a mark is geographically deceptively misdescriptive but that the consumer’s mistaken belief as to the origin of the goods or services would materially affect his or her decision to purchase the goods or services. In this instance, the mark is deceptive and not registrable on either register.
4.03(B)(3) Surname

If the examining attorney finds that a mark would be perceived by U.S.
consumers as being primarily merely a surname, the application may be
refused. [See TMEP § 1211.] (See section 1.06(H).) The word “primarily” is
the key to both the understanding and the application of this principle. The
determination of whether something would be perceived as having primary
rather than secondary significance to the relevant consumer involves an
examination of five factors: (1) whether the surname is rare, (2) whether it
is the surname of someone connected to the applicant, (3) whether the term
has meaning over time as a surname, (4) whether subjectively it looks like a
surname and (5) whether the letter stylization is so distinctive that the
overall mark has a commercial impression separate from a surname.

The fact that the applicant can find a meaning other than a surname for an
applied-for mark does not automatically solve a surname refusal. If the
meaning is an obscure one, and the primary meaning to consumers is still a
surname, the refusal will stand. Initially, the burden of establishing that the
applied-for mark is primarily merely a surname falls on the examining
attorney. This is most often done through citation to phone book listings
and LexisNexis® research. Once a prima facie case is made, the burden of
rebutting the showing shifts to the applicant. [See TMEP § 1211.02(a).] The
key for an applicant trying to overcome this kind of refusal is to try to
argue that the primary significance to U.S. consumers of the term applied for
is not as a surname.

4.03(B)(4) Likelihood of Confusion

A previously registered mark that so resembles the applied-for mark that it
is likely to cause consumers to be deceived is almost always the basis for
most “likelihood of confusion” refusals. [See TMEP § 1207.] This is not a
mechanical test, but one in which the examining attorney examines the
similarity of marks in the context of any relationship between the goods or
services of each and determines whether, in the particular situation, source
confusion is likely.

Examiners cite to In re E.I. DuPont de Nemours & Co. [476 F.2d 1357, 177
U.S.P.Q. (BNA) 563 (C.C.P.A. 1973)] as the analytical framework for
determining likelihood of confusion. The examining attorney will look at
the various factors set out in that case and may apply them if there is
applicable evidence in the record to determine whether a likelihood of
confusion exists. [See TMEP § 1207.01.] Such factors include the following:
(1) the similarity or dissimilarity of the marks in their entirety as to
appearance, sound, connotation and commercial impression; (2) the
relatedness of the goods or services as described in an application or
registration or in connection with which a prior mark is in use; (3) the
similarity or dissimilarity of established, likely to continue trade channels; (4) the conditions under which, and the buyers to whom, sales are made; (5) the number and nature of similar marks in use on or in connection with similar goods or services; and (6) a valid consent agreement between the applicant and the owner of the previously registered mark. [See TMEP § 1207.01.] Technically, the examiner could also cite a mark or trade name that is currently in use in the United States and whose use predates the filing date of the application, where the applied-for mark would be likely to deceive. It is rare to have a “likely to deceive” refusal, however, because the examining attorney usually is not privy to the kind of information that could help establish any intent to deceive. [See TMEP § 1207.02.]

If the examiner finds that the applied-for mark might be confused with a previously applied-for mark the application for which is still pending, he or she is required to suspend the later case pending the outcome of the application for the previously applied-for mark. In such a situation, the applicant can advance arguments as to why the cited previously applied-for mark is not likely to be confused with the applicant’s mark. If the applicant’s date of first use predates the priority date of the cited previously applied-for mark, the applicant could move to oppose the still-pending application provided the timing permits. Similarly, if the cited mark is already registered, the applicant could seek to cancel the registration of the cited mark.

Much strategic thinking necessarily goes into deciding what to do with a refusal for likelihood of confusion. The arguments one makes in the USPTO should be consistent with the long-term strategy, as these statements are part of the file history and are likely to be discovered and used by adversaries in the event that a likelihood-of-confusion allegation between the marks later frames a dispute in the courts rather than in the USPTO. The analysis for likelihood of confusion is different in the USPTO than in a court proceeding because, ordinarily, less evidence will be looked at in any USPTO proceeding.

### 4.03(B)(5) Other, Less-Common Refusals

Other, less-common bases for refusal include, without limitation, the following: (1) the mark applied for is a protected word or symbol under a federal statute or regulation that reserves the designation for specific purposes and in a prescribed manner (TMEP § 1205.01); (2) the mark applied for is a state emblem of another country that, like the United States, is a signatory to the Paris Convention (TMEP § 1205.02); and (3) the mark applied for is the name of a living individual or a deceased U.S. president and no consent to the registration has been given (TMEP § 1206).

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