Federal trademark searching: basics

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Discussion topics

• Trademark basics
• Likelihood of confusion
• Comprehensive clearance searching
• Federal trademark searching
• Common search strategy
• How to find help
USPTO restrictions

• The USPTO does not provide legal advice.
  – This program is for informational purposes only.
  – It only covers the mechanics of searching the federal register.
  – It does not cover full clearance searching.
  – It does not cover everything you need to know about federal and common law trademark rights.
Discussion topic

Trademark basics
Trademark basics

• Trademark
  – Identifies the source of goods and services.
  – Distinguishes them from the goods and services of another party.
  – Provides legal protection for a brand.
Trademark basics

• Remember:
  – You are not “buying” a trademark.
  – Not every trademark is registrable.
  – Filing fees are not refundable.
Discussion topic

Likelihood of confusion
Likelihood of confusion

• Concept:
  – Avoid confusing consumers about the source of the goods and services.

• Test:
  – Are the trademarks confusingly similar?
  and
  – Are the goods and/or services related?
Likelihood of confusion refusal

• Examining attorney issues refusal if:
  – The trademark in the application is confusingly similar with a registered trademark.
  and
  – The goods and/or services in both the application and the registration are related.
Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

T.MARKEY

for

pants
### Likelihood of confusion example

<table>
<thead>
<tr>
<th>Your trademark</th>
<th>Registered trademark</th>
</tr>
</thead>
<tbody>
<tr>
<td>T.MARKEY</td>
<td>TEE MARQEE</td>
</tr>
<tr>
<td>for shirts</td>
<td>for pants</td>
</tr>
</tbody>
</table>
## Likelihood of confusion example

<table>
<thead>
<tr>
<th>Your trademark</th>
<th>Registered trademark</th>
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<tbody>
<tr>
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<td>TEE MARQEE</td>
</tr>
<tr>
<td>for shirts</td>
<td>for golf flags</td>
</tr>
</tbody>
</table>
Knowledge check

Your trademark

TRAQ

for

racquet ball rackets

Registered trademark

TRAK

for

snow skis
Discussion topic

Comprehensive clearance searching
Comprehensive clearance searching

• Hire a private trademark attorney.
  – Search might include:
    • USPTO database of registrations and applications
    • State trademark databases
    • Business name registries
    • Foreign trademark databases
    • The internet

www.uspto.gov/trademarks/basics/why-hire-private-trademark-attorney
Comprehensive clearance searching

• Conduct searches on your own.
  – Search might include:
    • USPTO database
      – Federally applied-for and registered trademarks
    • The internet
      – Looking for common law use by others

www.uspto.gov/SearchTrademarks
Discussion topic

Federal trademark searching: live demonstration
Live demonstration (basic)

You want to register:

RABBIT

as a brand name for

racquet ball rackets
Live demonstration (basic)

• Access the USPTO database.

https://www.uspto.gov/trademarks/search
Live demonstration (basic)

• Select “wordmark” and insert search term.

https://www.uspto.gov/trademarks/search
Live demonstration (basic)

- Look for conflicting trademarks.

https://www.uspto.gov/trademarks/search
Live demonstration

• Learn more about the potential conflict.

https://www.uspto.gov/trademarks/search
Knowledge check

Does a search of the USPTO database guarantee that your trademark is federally registrable?

Yes  No
Federal trademark searching: word mark searching
Word mark example

You want to register:

ZEBRA

as a brand name for

t-shirts
Word mark example

• Common search strategy
  1. Execute dead-on search.
Word mark example

• Search string
  – Dead-on search

CM:zebra

The CM: field code searches for trademarks in multiple areas of the database.

The search term appears in all lowercase.
Word mark example

• Common search strategy
  1. Execute dead-on search.
  2. Execute expanded search.
Word mark example

• Search string
  – Expanded search

CM:/.*zebra.*/

The "dot star" tells the system to look for an infinite number of characters.

Forward slashes on both sides of the search term tell the system you want to use advanced searching mechanics.
Word mark example

• Common search strategy
  1. Execute dead-on search.
  2. Execute expanded search.
  3. Execute alternate spelling search.
Word mark example

• Search string
  – Alternate spelling search – option 1

CM:(/.*zebra.*/ OR /.*sebra.*)

Using the OR operator is one way to search spelling variations – but note use of parentheses.
Word mark example

• Search string
  – Alternate spelling search – option 2

CM:/.*[sz]e{1,3}br.*/

Pattern matching tells the system to look for one instance of one of the included characters.

A number ratio tells the system to look for that range of instances of that character.

Removing final sounds can capture variations without pattern matching.
Knowledge check

You want to register PEPZI for soft drinks. Which search strategy would help you find more potential cites?

- CM:pepzi

- CM:(/.*pepz.*/ OR /.*peps.*)
Word mark example

You want to register:

**ZEBRA STAR**

as a brand name for

t-shirts
Word mark example

• Common search strategy
  1. Execute dead-on search.
  2. Execute expanded search.
  3. Execute alternate spelling search.
  4. Execute combined term search.
Word mark example

• Search string
  – Dead-on search

CM: “zebra star”
Word mark example

• Search string
  – Expanded search

  CM:/.*zebrastar.*/
Word mark example

• Search string
  – Alternate spelling search – option 1

  CM:(/.*zebra.*/ OR /.*sebra.*/)
  CM:(/.*star.*/ OR /.*ztar.*/)
Word mark example

- Search string
  - Alternate spelling search – option 2

CM:/.*[sz]e{1,3}br.*/
CM:/.*[sz]tar.*/
Word mark example

• Search string
  – Combined term search – option 1

CM:/.*[sz]e{1,3}br.*/ AND /.*[sz]tar.*/)
Word mark example

• Search string
  – Combined term search – option 2

CM:/.*[sz]e{1,3}br.*/
CM:/.*[sz]tar.*/
1 AND 2

Using previous search strings is a way to combine search terms – but must be in expert mode.
Discussion topic

Federal trademark searching: design mark searching
Design mark example

You want to register:

as a logo for
t-shirts
Design mark example

• Common search strategy
  1. Look up the relevant design codes.
    • Use the Design Search Code Manual.
TABLE OF CONTENTS

TABLE OF CATEGORIES
INTRODUCTION
GENERAL GUIDELINES
DESIGN SEARCH CODE

KEYWORD SEARCH
APPENDIX - 2007 DESIGN CODE UPDATES
ALPHABETICAL INDEX

01 Celestial bodies, natural phenomena, geographical maps
This category includes objects that appear in the sky, including clouds, stars, moons, sun, planets and constellation. Additionally, designs associated with weather conditions such as rainbows, lightning, and snowflakes are found here. Maps of countries and continents are also in 01.

02 Human beings
This category includes representations of men, women and children regardless of the activity they are engaged in or how they are dressed. Stylized humans, those in caricature form, stick figures and parts of the human body are also in this category.

03 Animals
This category includes most animals, except mythological animals. Animals found here include mammals, birds, kiwi, kiwi bird, fish, reptiles and insects. Prehistoric animals, stylized animals and animals with human attributes are also coded in category 03.

https://tess2.uspto.gov/tmdb/dscm/index.htm
Design mark example

- Trademark:

- Design codes:
  - DC:030503 – Zebras
  - DC:010103 – Single star with five points
Design mark example

• Common search strategy
  1. Look up the relevant design codes.
  2. Execute a design code search.
Design mark example

• Search string
  – Design code search

DC:030503
DC:010103
Design mark example

• Common search strategy
  1. Look up the relevant design codes.
  2. Execute a design code search.
  3. Execute a combined design code search.
Design mark example

• Search string
  – Combined term search – option 1

  DC:(030503 AND 010103)
Design mark example

• Search string
  – Combined term search – option 2

DC:030503
DC:010103
1 AND 2
Knowledge check

You want to register:

ORGANIC

as a logo for

t-shirts
Knowledge check

Which search strategy would you use to perform a narrow “knock-out” search?

• DC:010103 OR DC:030503 OR CM:organic

• DC:(010103 OR 030503) AND CM:organic

• DC:(010103 AND 030503) AND CM:organic
Discussion topic

Federal trademark searching: narrowing your results
Narrowing your results

• Search string
  – Limit by coordinated class for narrow results

CM:/.*[sz]e{1,3}br.*/ AND CC:025

The [cc] field code searches coordinated classes – the identified class and those classes with goods and services that are frequently related to the identified class.

https://tmsearch.uspto.gov/webaka/html/help.htm#Coordinated_Class
Narrowing your results

• Search string
  – Limit by international class for narrower results

CM:/.*[sz]e{1,3}br.*/ AND IC:(025 035 042 a b 200)

The [ic] field code class searches the international class only.

https://tmsearch.uspto.gov/webaka/html/help.htm#International_Class
Narrowing your results

• Search string
  – Limit by goods or services for narrowest results

CM:/.*[sz]e{1,3}br.*/ AND GS:t-shirts

The GS: field code searches for that specific good or service only.

This is not recommended.

Discussion topic

Common search strategy
Common search strategy

1. Search for owner in ON: field.
2. Execute “dead-on” search in CM: field.
3. Execute alternate spelling searches in CM: field.
   - Pro tip: “Not out” your previous search to avoid looking at already viewed results.
Common search strategy

4. Execute additional searches looking for alternative versions of the trademark.
   - Words/designs alone and together
   - Words that have similar meanings
   - Acronyms and what they stand for
   - **Pro tip:** Search for pictorial equivalents using the DC: field tag.
Common search strategy

• Narrow if needed:
  – By coordinated class with CC: field tag.
  – By international class with IC: field tag.
    • Pro tip: Use the IC:(xxx 035 042 a b 200) formula.
  – By goods and services with GS: field tag.
    • Pro tip: Only narrow this way if absolutely necessary.
How to find help
Caution: scam alert

• Beware of scams.
  – www.uspto.gov/TMFraud

• Beware of filing firms.
  – www.uspto.gov/trademarks/protect/filing-firms

• Beware of misleading notices and offers.
  – www.uspto.gov/TrademarkSolicitations
USPTO resources

• Website
  – www.uspto.gov

• Trademark videos
  – www.uspto.gov/TMvideos

• Trademark basics registration toolkit
  – www.uspto.gov/TrademarkBasicsToolkit
USPTO resources

• IP Identifier
  – https://ipidentifier.uspto.gov

• Free services and resources
  – www.uspto.gov/FreeServices

• USPTO virtual assistant
  – www.uspto.gov/trademarks/basics
USPTO resources

• Trademark Assistance Center
  – Main support center for all trademark customers
    • Phone: 1-800-786-9199
    • Email: TrademarkAssistanceCenter@uspto.gov
USPTO resources

• The USPTO does not:
  – Provide legal advice.
  – Enforce legal rights.
  – Recommend specific private attorneys.

www.uspto.gov/trademarks/basics/why-hire-private-trademark-attorney
Legal resources

• Remember:
  – Best resource is an experienced trademark attorney.
  – Most trademark filing companies can only provide limited services.

www.uspto.gov/trademarks/basics/why-hire-private-trademark-attorney
Questions?