
UNITED STATES
PATENT AND TRADEMARK OFFICE
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Trademark basics boot camp: Searching

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Trademark basics boot camp

- Reminders:
  - This session is being recorded.
  - The slides will be emailed after the presentation.
  - Captioning is available.
  - Post your questions to the Q&A box.

Discussion topics

- Trademark basics
- Comprehensive clearance searching
- Likelihood of confusion
- Search system fundamentals
- Field tag 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 (cont'd)

- Remember:
  - You are not “buying” a trademark.
  - Not every trademark is registrable.
  - Filing fees are not refundable.

Discussion topic

Comprehensive clearance searching

Comprehensive clearance searching

- Concept:
  - Determine whether your trademark conflicts with the rights of a trademark owner who filed before you.
- Potential benefits:
  - Avoid a likelihood of confusion refusal from the USPTO.
  - Avoid an opposition proceeding at the USPTO.
  - Avoid a trademark infringement lawsuit.

www.uspto.gov/trademarks/search/comprehensive-clearance-search-similar-trademarks

Comprehensive clearance searching
(cont'd)

- 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

Comprehensive clearance searching

(cont'd 2)

- 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

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 #1

Your trademark

T.MARKEY

for

shirts

Registered trademark

T.MARKEY

for

pants

Likelihood of confusion: example #2

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

pants

Likelihood of confusion: example #3

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

golf flags

Knowledge check #1

Your trademark

TRAQ

for

racquet ball rackets

Registered trademark

TRAK

for

snow skis

Discussion topic

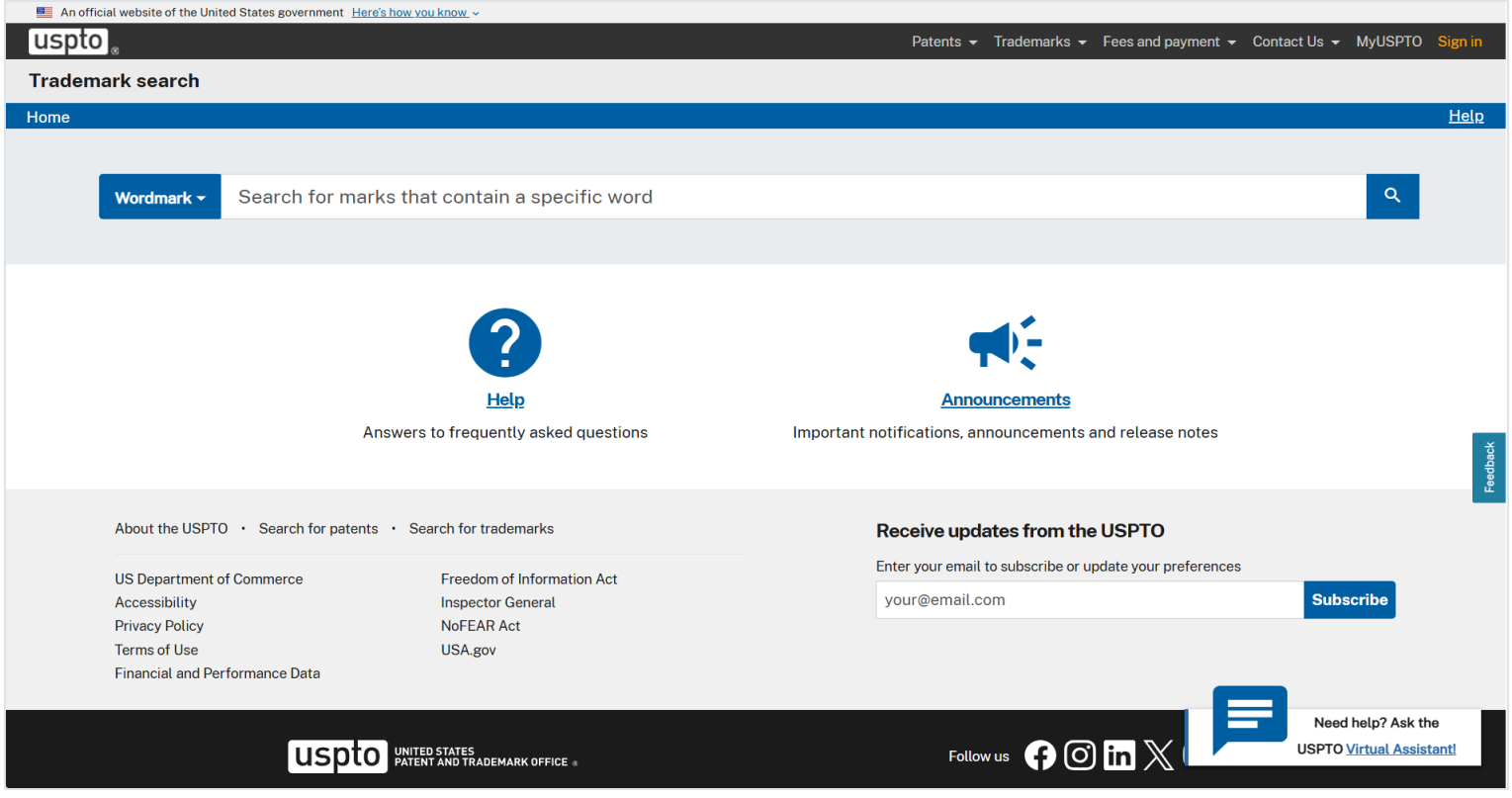
Search system fundamentals

Search system fundamentals

- Reasons to use the search system
  - Conduct a clearance search before applying to register your trademark.
  - Research how the USPTO treated similar marks.
  - Research marks owned by a particular owner.
  - Check the status of your application or registration.

www.uspto.gov/SearchTrademarks

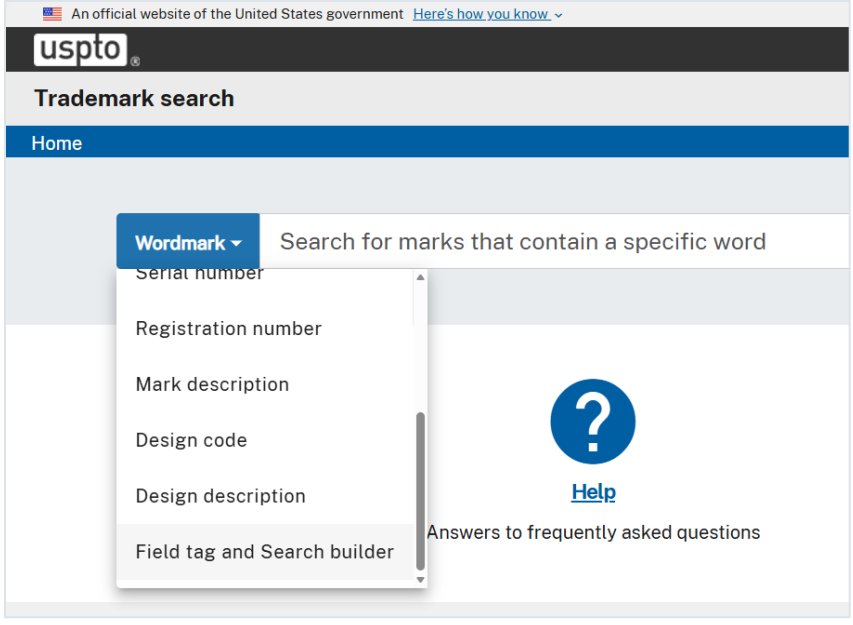
Search system fundamentals (cont'd)



www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 2)

- Two ways to use the system
  - Dropdown searches
  - Field tag searches

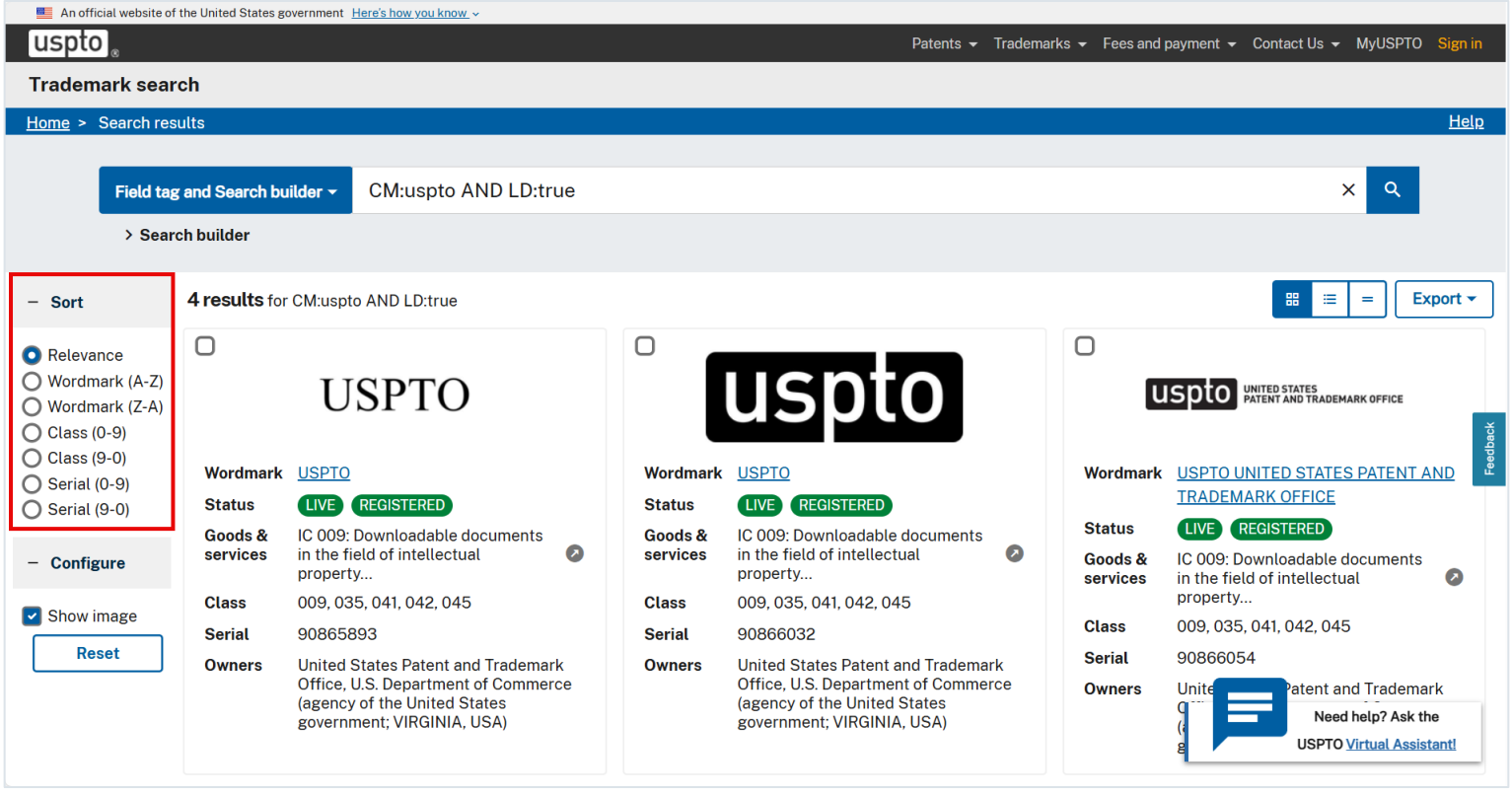


www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 3)

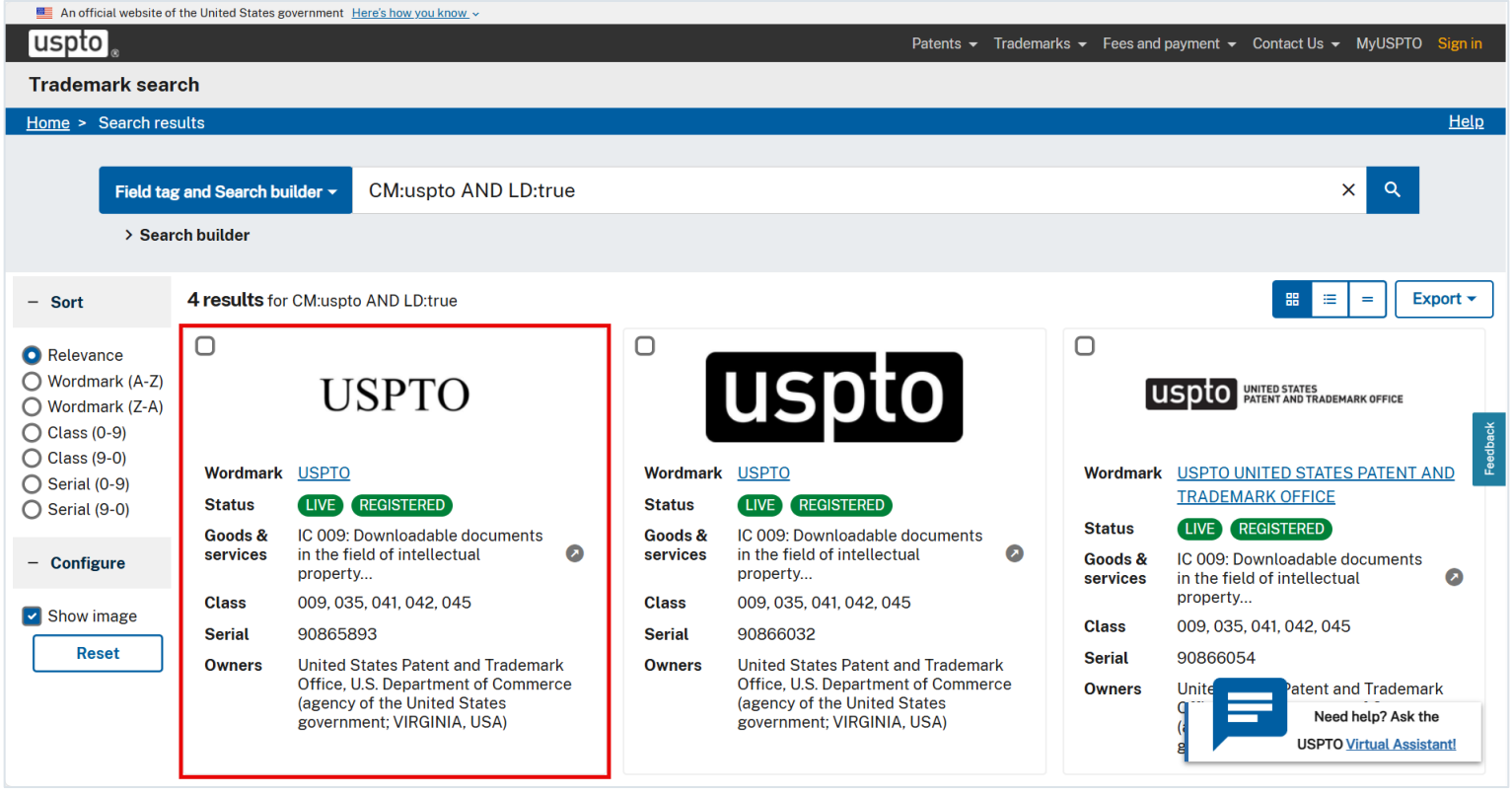
- Dropdown searches
  - Good for exact match, single-term trademark searches
  - Don't allow for "exact phrase" trademark searches
- Benefits of field tag searches
  - Good for complex, multiple-term trademark searches
  - Allow for "exact phrase" trademark searches
  - Good for alternate spelling searches

Search system fundamentals (cont'd 4)



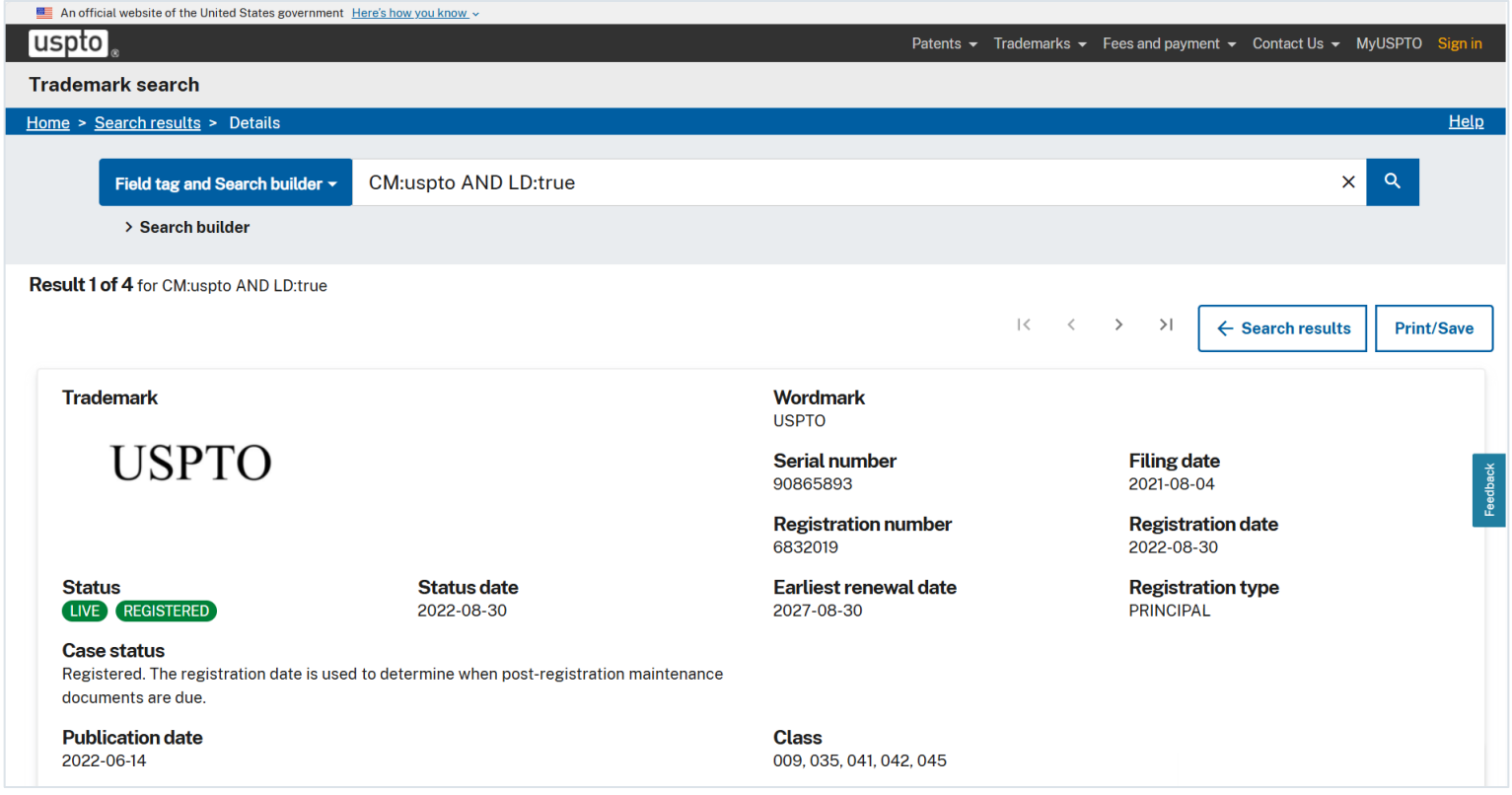
www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 5)



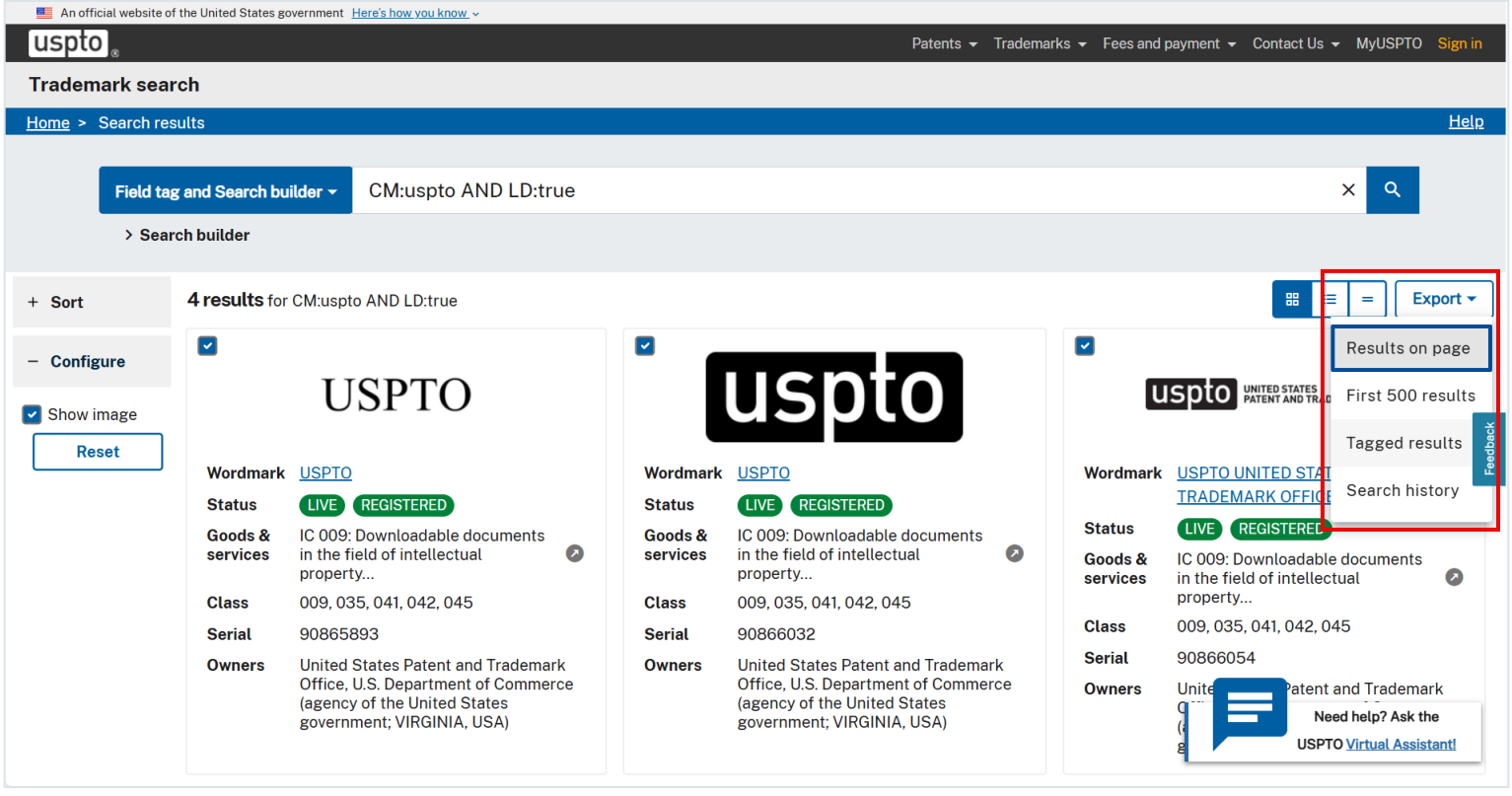
www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 6)



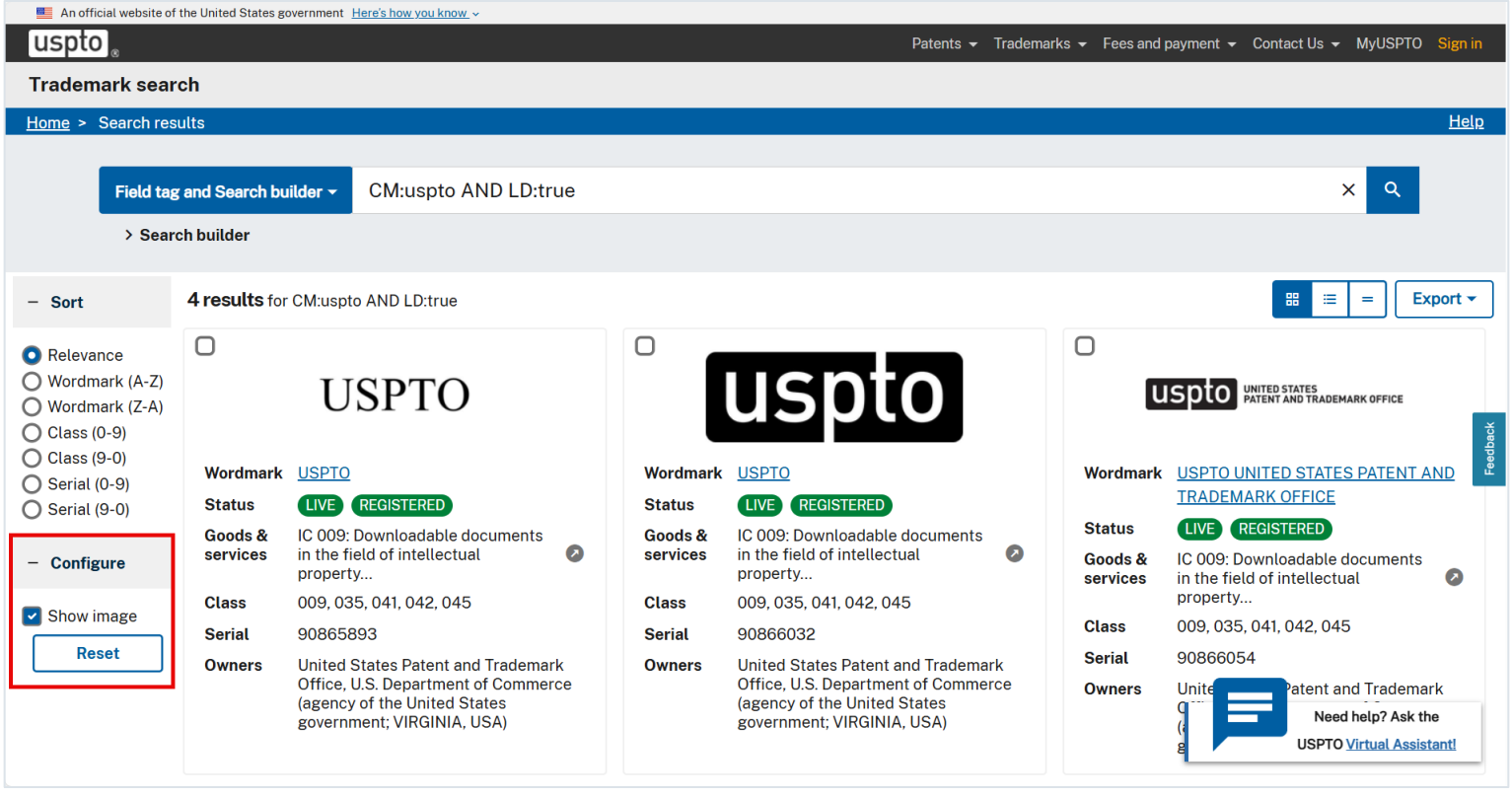
www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 7)



www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 8)



www.uspto.gov/SearchTrademarks

Discussion topic

Field tag searching: Single word

Field tag searching

- Tips for search construction
  - Field tags precede the search term.
  - Field tags must be in all caps.
  - Field tags must be followed by a colon.
  - Search terms must be in lowercase.

CM:trademark

Search fields and field tags

Search field	Field tag
Combined mark	CM:
Live/dead	LD:
Design code	DC:
Coordinated class	CC:
International class	IC:
Goods/services	GS:
Disclaimer	DS:
Serial number	SN:
Registration number	RN:
Owner name and address	OW:
Attorney of record	AT:

Single word hypothetical

You want to search:

QUANTUM

as a brand name for

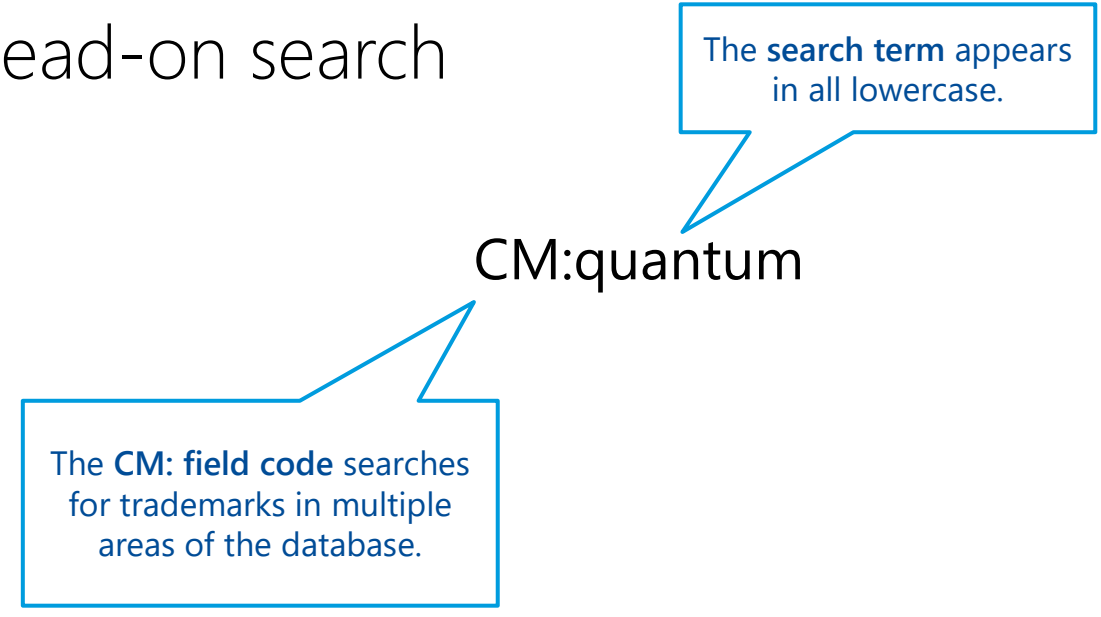
shirts

Single word hypothetical (cont'd)

- Common search strategy
  1. Execute dead-on search.

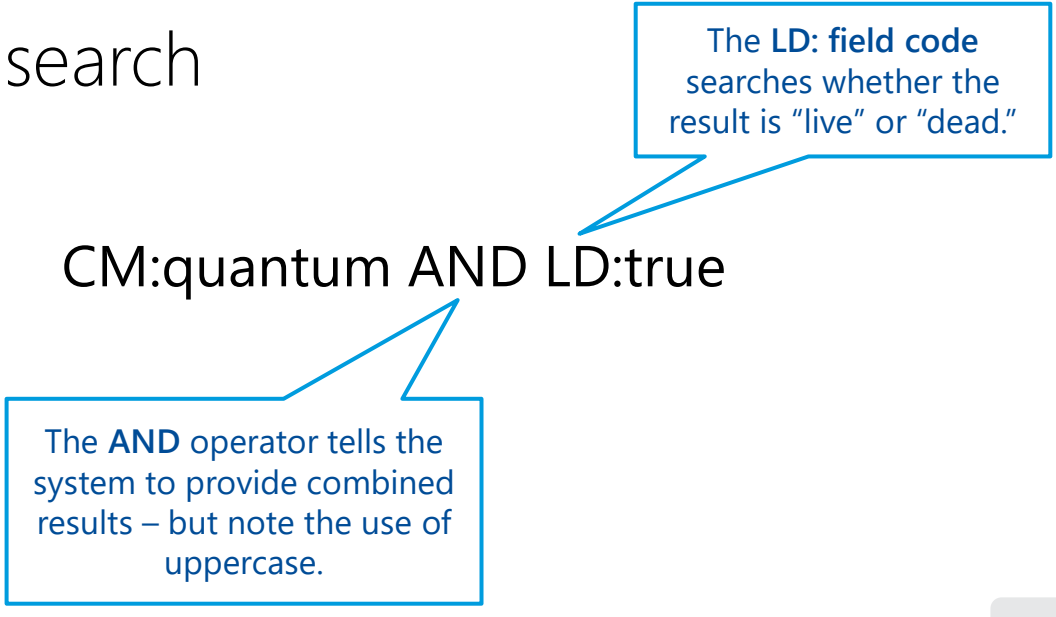
Single word hypothetical (cont'd 2)

- Search string
  - Dead-on search



Single word hypothetical (cont'd 3)

- Search string
  - Dead-on search



Single word hypothetical (cont'd 4)

- Common search strategy
  1. Execute dead-on search.
  2. Execute expanded search.

Single word hypothetical (cont'd 5)

- Truncation and wildcards
  - Use wildcards to search for variations of a mark.
    - Example: **?** (to return one character)
    - Example: ***** (to return infinite characters)
  - External truncation
    - Examples:
      - CM:?appines? (returns **happiness**)
      - CM:*appines* (returns **happiness**, **happinest**, and **wrappiness**)

Single word hypothetical (cont'd 6)

- Search string
  - Expanded search

CM:*quantum* AND LD:true

The **asterisk** tells the system to look for an infinite number of characters.

Single word hypothetical (cont'd 7)

- Common search strategy
  1. Execute dead-on search.
  2. Execute expanded search.
  3. Execute alternate spelling search.

Single word hypothetical (cont'd 8)

- Search string
  - Alternate spelling search

Removing **final sounds** and adding an **asterisk** can capture variations in spelling at the ends of words.

CM:(*quant* OR *qwant*) AND LD:true

Use the **OR operator** to search spelling variations – but note use of parentheses.

Discussion topic

Field tag searching: Multiple word

Multiple word hypothetical

You want to search:

QUANTUM LEAP

as a brand name for

shirts

Multiple word hypothetical (cont'd)

- Search string
  - Dead-on search

CM:"quantum leap" AND LD:true

Multiple word hypothetical (cont'd 2)

- Search string
  - Expanded search

CM:*quantumleap* AND LD:true

Multiple word hypothetical (cont'd 3)

- Search string
  - Alternate spelling search

CM:(*quant* OR *qwant*) AND LD:true

CM:(*leap* OR *leep*) AND LD:true

Multiple word hypothetical (cont'd 4)

- Search string
  - Combined term search – option 1

CM:(*quant* OR *qwant*) AND CM:(*leap* OR *leep*) AND LD:true

Remember to use a **field tag** in front of each search term when combining terms.

Multiple word hypothetical (cont'd 5)

- Search string
  - Combined term search – option 2

CM:(*quant* OR *qwant*) AND LD:true

CM:(*leap* OR *leep*) AND LD:true

1 AND 2

Using previous search strings is a way to combine search terms.

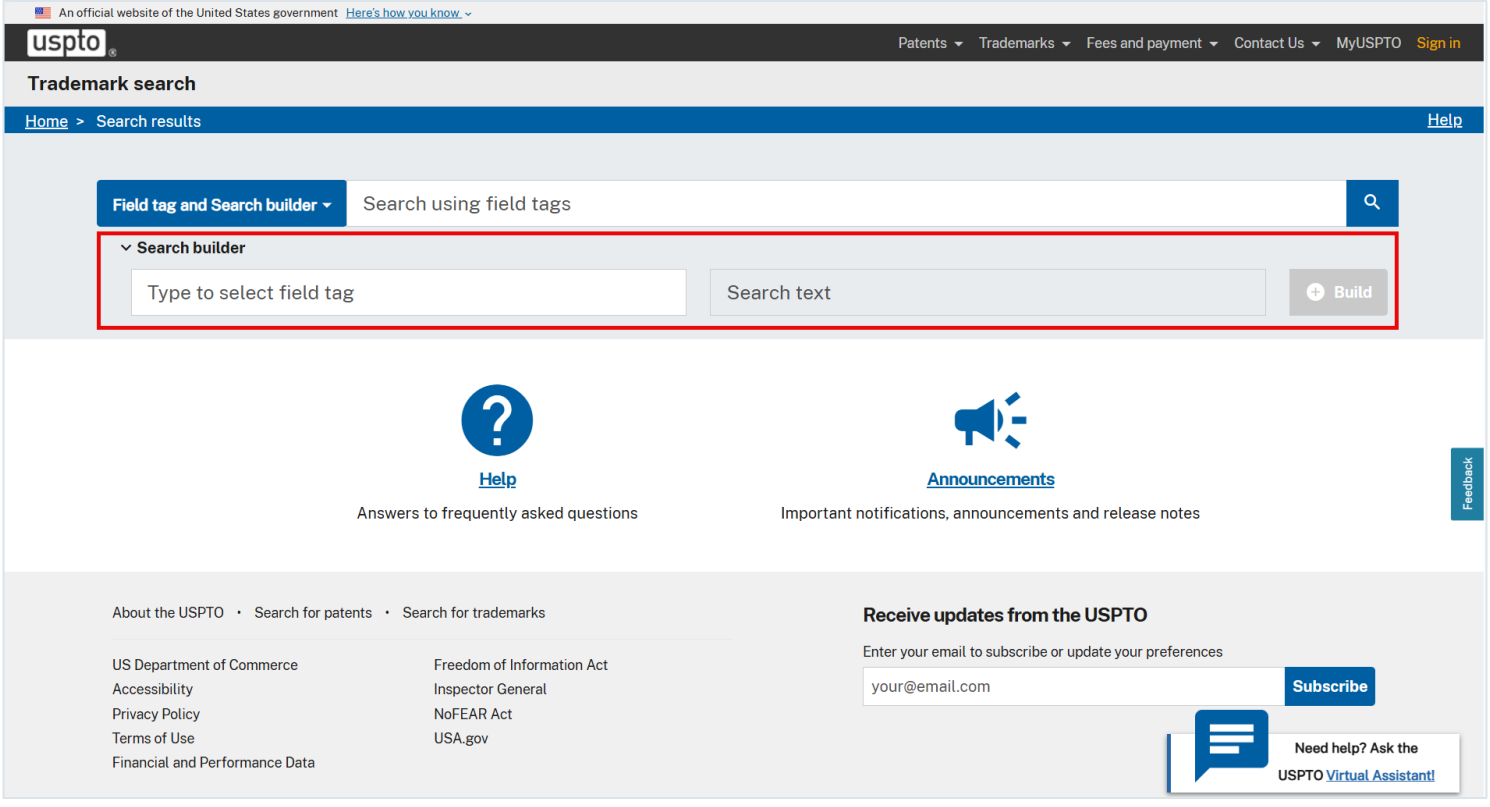
Discussion topic

Field tag searching: Using the search builder

Using the search builder

- Search builder
  - Allows you to create complex searches without learning the search syntax.
    - Choose the field you want to search.
    - Enter your search term, including wildcards.
    - Refine your search by adding more criteria.
    - Edit your search in the search bar.

Using the search builder (cont'd)



www.uspto.gov/SearchTrademarks

Discussion topic

Field tag searching: Logo or design

Design hypothetical

You want to search:



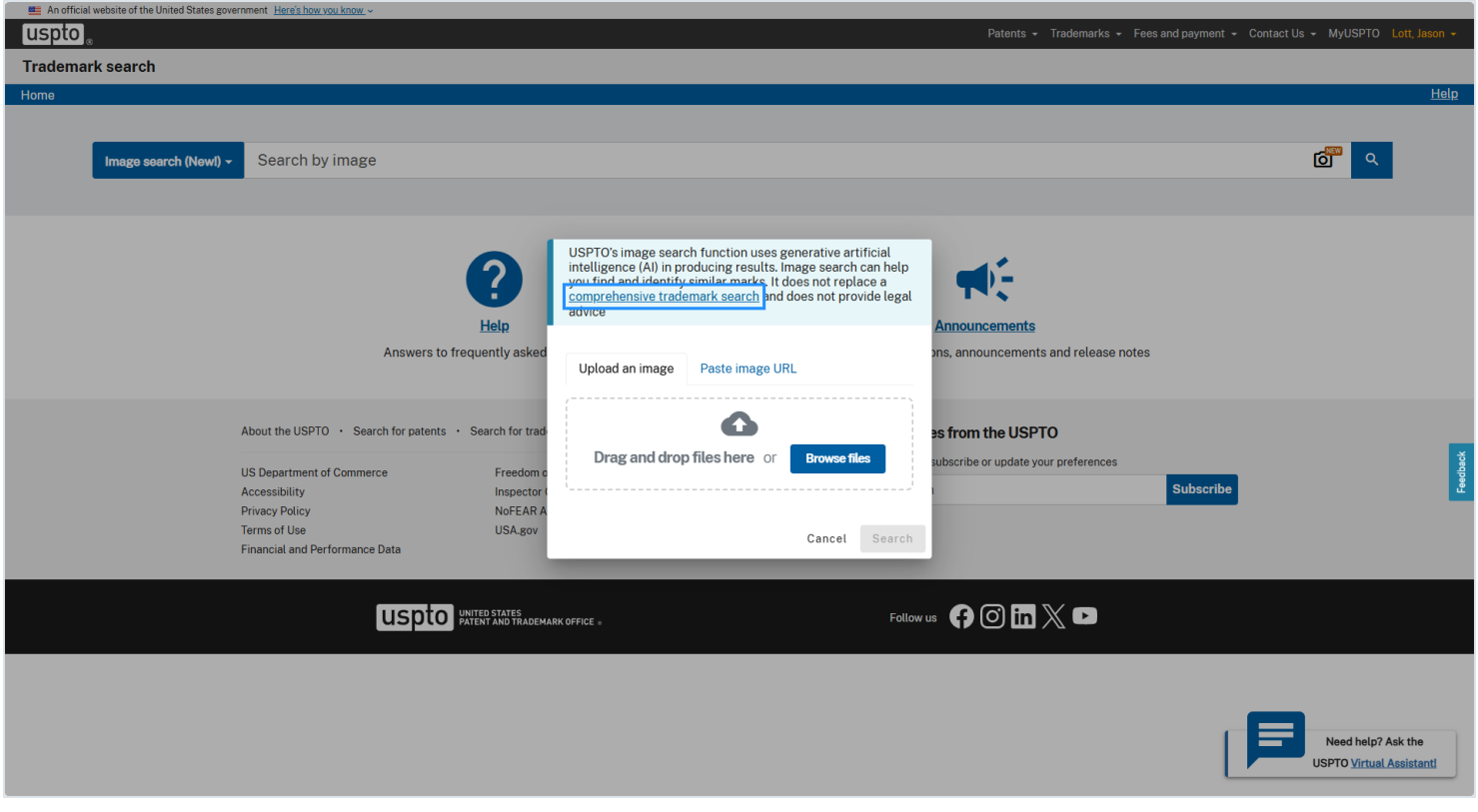
as a logo for

soft drinks

Design hypothetical (cont'd)

- Common search strategy
  1. Log in to your USPTO.gov account.
  2. Select the camera icon.
  3. Upload an image or paste a URL.
  4. Search through the provided results.

Design hypothetical (cont'd 2)



Discussion topic

Field tag searching: Wording and design

Wording and design hypothetical

You want to search:



as a logo for

soft drinks

Wording and design hypothetical

(cont'd)

- Common search strategy
  1. Log in to your USPTO.gov account.
  2. Select the camera icon.
  3. Upload an image or paste a URL.
  4. Search through the provided results.

Wording and design hypothetical

(cont'd 2)

- Search string
  - Alternate spelling search

CM:(*pepsi* OR *pepzi*) AND LD:true

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 (cont'd)

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 (cont'd 2)

- 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.

Discussion topics

How to find help

Caution: scam alert

- Beware of scams.
  - www.uspto.gov/TrademarkScams



- Beware of non-attorney 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 (cont'd)

- IP Identifier
  - https://ipidentifier.uspto.gov
- Free services and resources
  - www.uspto.gov/FreeServices
- USPTO virtual assistant
  - www.uspto.gov/trademarks/basics



USPTO resources (cont'd 2)

- Trademark Assistance Center
  - Main support center for all trademark customers
    - Phone: 1-800-786-9199 (press 1)
    - Email: TrademarkAssistanceCenter@uspto.gov

USPTO resources (cont'd 3)

- 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:
  - The 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?



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