

Trademark Screening

Recall that unusual and distinctive marks are more likely to be worthy of legal protection. Selecting a generic or descriptive mark at the outset may result in a frustrating experience that ends up bearing no useful fruit. Thus, selecting unusual and distinctive marks make the trademark process much more pleasant. We suggest you try to coin a new word (e.g., Clorox or Nike) or use a familiar term in a new way (e.g., Apple Computer or Yahoo).

Once a desired mark (e.g., name or logo) is identified for your product or service, a screening search, sometimes called a clearing search, should be conducted to determine whether the name or a similar name is already in use by another for similar products/services. Investing money and time in a trademark that is already in use by another is simply a waste of company resources, and use of such a mark can have substantial legal liability. In addition to screening searches for intended marks, a company should continue monitoring industry publications, electronic and print, for its current marks as well. It is the responsibility of a trademark owner to police its own marks, and to take appropriate action when others are found to be using similar marks for similar goods or services.

To begin the screening search, write down variations of the selected mark (assuming the mark includes words), and play around with alternative spellings and phonetic variations. Likewise, note any mark that looks or sounds similar to the intended mark. Also, it is wise to contemplate substitute or alternate marks just in case the desired mark is unavailable.

Once the list is developed, a first level screening search can be performed via the Internet. There are several different areas that can be searched; the federal trademark register, state trademark registries, and international registries (if desired). Also, a common-law search for evidence of commercial usage should be conducted, and a domain name search is very important as well.

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Federal Registry

To add a degree of precision to searching, the Trademark Office assigns every trademark into one or more classes depending on the mark's specified usage. Some marks will fit squarely within one class, while others may fall under several classes. Go to the [Trademark Office Goods and Services Manual](#) and search for the relevant classes associated with the intended mark. For example, if the intended mark is "Flea Flicker" for a pet day-care center, the relevant classes might be class 043 (nurseries and day care centers) and class 044 (pet sitting and pet hospitals).

Once the class or classes for intended goods/services are known, develop the search list. The search list for "Flea Flicker" might include: Flea Flicker, Flea* Flicker, Flicker* Flea, Fle*, Fli*, Phlea, Phlicker, etc. The wildcard symbol * is a common search tool and refers to any letters or symbols following the initial letter set.

Next, go to the Trademark Office's "[Trademark Electronic Search System](#)," referred to as [TESS](#).

TESS provides various searching mechanisms that allow the different terms on the search list to be aggressively searched. There are several types of search engines, and they each have certain attributes that will require some time and effort. Print out any relevant marks that are somewhat similar in appearance. Also, try searching for any marks that are closely related to the intended goods and services.

State Registries

A state trademark search is also recommended, and a full state search can be performed at various commercial vendors such as [Thomson & Thomson](#), [Micropatent](#), [Nameprotect](#), to name a few. These are commercial service providers that charge a nominal fee for the searching, and there are numerous other commercial search providers available.

Common-Law Search

A common-law search for evidence of commercial usage of the intended mark should also be done, using search engines, telephone directories, and other applicable databases. For example, the search engines could include [Google](#) and [Yahoo](#). The online telephone directories may include [Switchboard](#) and [Anywho](#). Other relevant databases that should be checked include, for example, [Thomas Register](#).

Domain Name Search

If a domain name on the Internet is anticipated, the domain name search should be conducted as well. There are numerous facilities, such as Whois, that allow domain name searching. Most registrars also provide searching and many offer various other features and associated services.

Analyzing the Results

Once the search is completed, the results must be analyzed by a competent trademark attorney. The 'likelihood of confusion' analysis is the legal test for assessing a mark. In particular, the test is employed to determine whether there is a likelihood that concurrent use of two marks in question will cause confusion as to the source, sponsorship, or other association of the goods/services on which the marks appear. A number of factors are considered in this analysis, and no one factor is determinative. The factors generally include the distinctiveness of the mark, the similarity of the marks, as well as their respective goods/services, the similarity of marketing strategies, the sophistication of the purchasers, bad intent, actual confusion, and likelihood of expansion of mark into other markets. A trademark professional should be consulted on such issues. Clearly, candidate marks that are similar to marks already registered for similar goods/services stand of good chance of being rejected.

It is difficult to identify, let alone avoid every relevant mark in use, and even a robust search can miss a similar mark in use by a small company in a remote place like Dixville Notch. In the long run, however, a robust trademark screening search is generally worth the effort and expense. A strong trademark can be a valuable asset to your business - invest the time to lay a good foundation.
