UNITED STATES
PATENT AND TRADEMARK OFFICE

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Federal trademark searching: Overview

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Images used in this presentation are for educational purposes only.

Federal trademark searching: Overview

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

Discussion topics

- Comprehensive clearance searching
- Likelihood of confusion
- Search system fundamentals
- Federal trademark searching
- Common search strategy
- How to find help

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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.

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)

- 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 (cont'd 2)

- 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

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

Registered trademark

T.MARKEY

T.MARKEY

for

for

shirts

pants

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Likelihood of confusion example #2

Your trademark

Registered trademark

T.MARKEY

TEE MARQEE

for

for

shirts

pants

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Likelihood of confusion example #3

Your trademark

T.MARKEY

for

shirts

Registered trademark

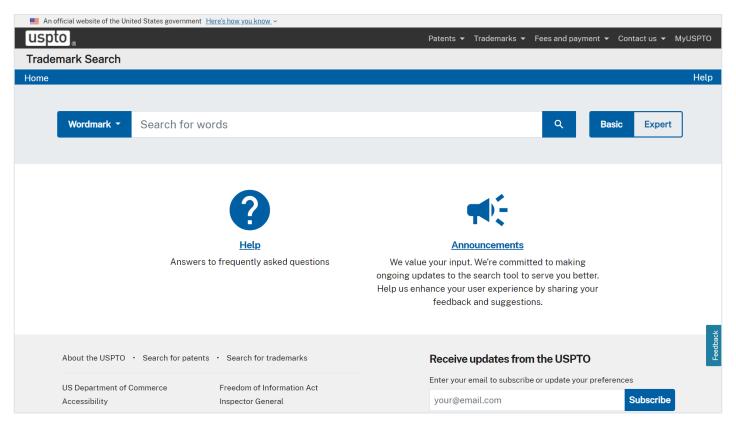TEE MARQEE

for

golf flags

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

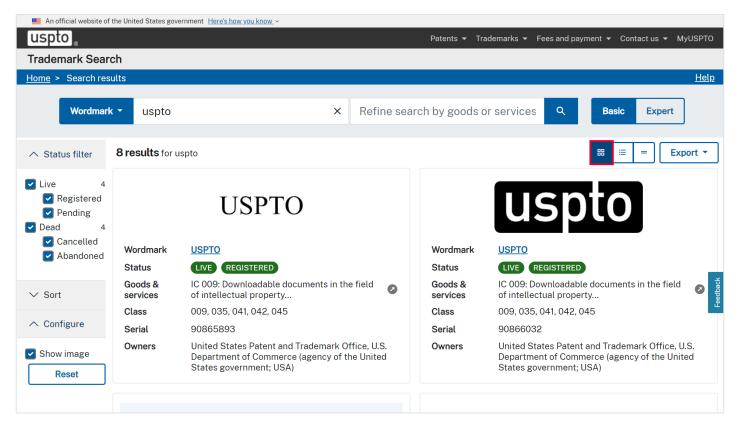# Search system fundamentals (cont'd)

www.uspto.gov/SearchTrademarks

Search system fundamentals (cont'd 2)

- Two ways to use the system
  - Dropdown searches
  - Field tag searches
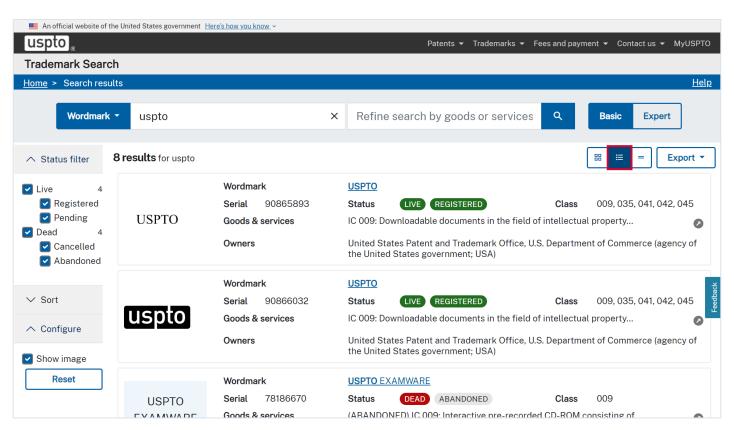- Two ways to adjust your options
  - Basic mode
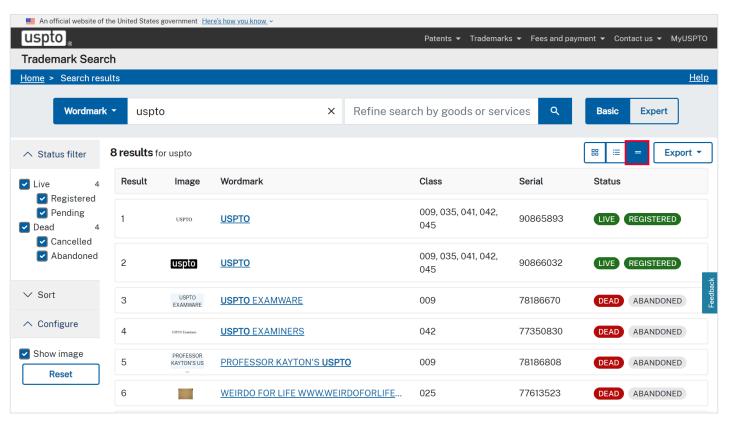 - Expert mode

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Search system fundamentals (cont'd 3)

www.uspto.gov/SearchTrademarks

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)

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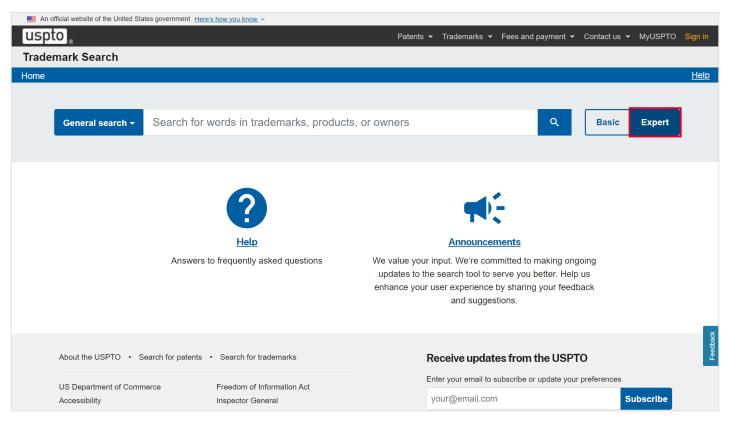 - Good for alternate spelling searches

Federal trademark searching: Dropdown searching

Dropdown searching

www.uspto.gov/SearchTrademarks

Dropdown searching (cont'd)

- Filtering by live/dead

Dropdown searching (cont'd 2)

- Filtering by live/dead
- Filtering by class
  - Coordinated class
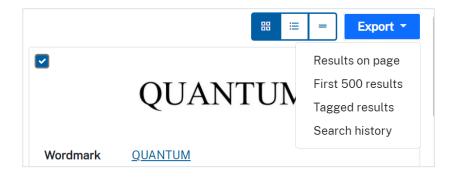
www.uspto.gov/SearchTrademarks

Dropdown searching (cont'd 3)

- Filtering by live/dead

- Filtering by class

  – Coordinated class

  – International class

    - Consider 035, 042, a, b, and 200

www.uspto.gov/SearchTrademarks

Dropdown searching (cont'd 4)

- Filtering by live/dead

- Filtering by class

- Tagging
  - Export to Excel spreadsheet

Dropdown searching (cont'd 5)

- Filtering by live/dead

- Filtering by class

- Tagging

- Summary page

  – Must be logged into
    your USPTO.gov account.

www.uspto.gov/SearchTrademarks

Dropdown hypothetical

You want to register:

QUANTUM

as a brand name for

t-shirts

Federal trademark searching: Field tag searching

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:
Design code	DC:
Live/dead	LD:
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:

Field tag hypothetical

You want to register:

QUANTUM LEAP

as a brand name for

t-shirts

Field tag hypothetical (cont'd)

- Common search strategy

  1. Execute dead-on search.

Field tag hypothetical (cont'd 2)

- ## Search string
  - Dead-on search

The **search term** appears in all lowercase.

CM:"quantum leap"

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

Use **quotation marks** to search for exact phrases or multiple-term marks.

Field tag hypothetical (cont'd 3)

- ## Search string
  - – Dead-on search

The **LD: field code** searches whether the result is "live" or "dead."

CM:"quantum leap" AND LD:true

The **AND** operator tells the system to provide combined results – but note the use of uppercase.

Field tag hypothetical (cont'd 4)

- Common search strategy

  1. Execute dead-on search.

  2. Execute expanded search.

Field tag 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**)

Field tag hypothetical (cont'd 6)

- Search string
  - Expanded search

CM:*quantumleap* AND LD:true

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

Field tag hypothetical (cont'd 7)

- Common search strategy

  1. Execute dead-on search.

  2. Execute expanded search.

  3. Execute alternate spelling search.

Field tag 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

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

Field tag hypothetical (cont'd 9)

- ## Search string
  - – Combined term search – option 1

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

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

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

Field tag hypothetical (cont'd 10)

- ## 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 – but must be in expert mode.

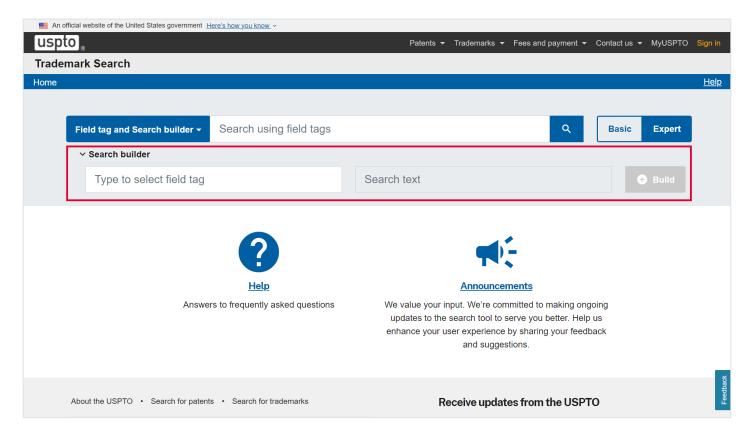# Federal trademark searching: Using the search builder

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.

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Using the search builder (cont'd)

www.uspto.gov/SearchTrademarks

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.

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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

USPTO resources

- Website
  - www.uspto.gov
- Trademark search
  - www.uspto.gov/trademarks/search
- Trademark search help
  - https://tmsearch.uspto.gov/help

USPTO resources (cont'd)

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

USPTO resources (cont'd 2)

- 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

Caution: scam alert

- Beware of scams.
  - www.uspto.gov/TMFraud
- Beware of non-attorney filing firms.
  - www.uspto.gov/trademarks/protect/filing-firms
- Beware of misleading notices and offers.
  - www.uspto.gov/TrademarkSolicitations

Questions?

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