



## Why Should I Conduct a Trademark Search?

Developing a new brand and launching a new product or line of products are exciting times. In a rush to put goods or services on the market, and come up with the perfect tag line, slogan, or brand name, it is easy to become confused about what type of trademark search you should do—or even skip performing a search altogether. Below, we discuss the benefits of performing this essential step and the different types of searches that are available.

### Why Conduct a Trademark Search?

The short answer is that you should conduct a trademark search for the following reasons:

- to have a better chance of successfully receiving a trademark registration;
- to avoid unintentionally infringing another trademark; and
- to avoid unnecessarily wasting time, money, and resources.

Here is the long answer. Performing a trademark search is definitely *not* the most glamorous part of a new product launch or a new business venture, but if done properly, a trademark search can save you time and money in the long run. Investing some time and resources up front to perform a trademark search provides extra protection for your new brand or product.

### Increase Your Chances of Receiving a Registration

One of the most common reasons that the United States Patent and Trademark Office (“USPTO” for short) rejects trademark applications is because the trademark sought is too similar to a mark that is already registered, and there is a “likelihood of confusion.” Translated from legalese, this term means that consumers might believe that your goods and services come from the same source as the other party’s goods and services. Thus, a trademark clearance search will give you a heads-up if there are any potentially problematic marks that might prevent your mark from being registered—or that might drag out the application process and drive up the cost of obtaining a registration.

Additionally, a review of other marks will give you an idea of other types of refusals that the USPTO may issue in your case and provide you with an opportunity to review your trademark strategy before filing your application. For example, if you have perfected the world’s best cup of coffee, and you want to brand your new coffee as THE WORLD’S BEST CUP OF COFFEE, a search of relevant marks might indicate that you are likely to receive a refusal because your proposed mark is descriptive or generic. This might prompt you to tweak your mark and add some additional distinctive words and design elements—or it might prompt you to rebrand before you have committed significant resources to packaging and marketing a relatively weak mark.

### Avoid Unintentionally Infringing Another Trademark

Infringement challenges can be costly and time consuming. If you are found to be infringing another party’s registered mark, you could be liable for damages *and* be required to pay for the other party’s attorney fees. You might also be ordered to destroy any product, packaging, business cards, promotional materials, etc. that bear the infringed mark. You would most likely be required to stop using the mark, and consequently, you would need to rebrand and/or repackage your goods and services. A trademark clearance search can provide a good view of the litigation-landscape and allow you to manage your risk accordingly.

## Avoid Unnecessarily Wasting Time, Money, and Resources

A trademark search can help you avoid the situations described above. Whether it is avoiding an unnecessarily long, costly, and uncertain registration process, or avoiding a challenge of infringement down the road, the early investment in a trademark search is time and money well spent. Additionally, a trademark search can give you some insight into potential competitors, their goods and services, and their branding and marketing efforts.

The advent of the internet and access to online databases has significantly reduce the cost and time required to perform a trademark search and has made the results generally more reliable than in the bygone analog era. Considering the potential costs that could arise from a failure to perform a search, including the costs of rebranding and the loss of marketing efforts, affording the extra time and resources to do so is a cost-effective way to give your trademark an added layer of protection.

## Types of Trademark Searches

Generally, trademark searches fall into two categories that differ based on cost and scope. Understanding the difference between these types of searches can help you optimize your search strategy.

A “**knockout**” search is usually the cheapest and quickest search. This can usually be done *pro se* by accessing the USPTO’s search database (called [TESS](#)), and by doing a quick internet search to see if there are any similar marks in use. A knockout search is just what it sounds like: a search to determine if your mark is “knocked out” by a prior registered mark or pending application. But, when performing this type of search, the results might be difficult to interpret. Let’s say you come across a mark that is identical to your, but it covers goods or services that are different from yours. In such cases, you should seek the advice of an experienced trademark attorney to help you understand the level of risk involved with pursuing registration of your mark. Knockout searches are narrow in scope, and generally, they are limited to considering whether there are any identical or similar marks that might preclude registration of your mark. They usually do not cover other types of refusals that the USPTO might issue (like mere descriptiveness, geographic descriptiveness, or deceptiveness). This narrow scope will not paint the full picture regarding registrability of your mark, but it also allows you to get a general idea about the risk associated with using and seeking registration for your mark in a relatively quick and cheap way. Therefore, a knockout search can be a cost-effective, fast way to understand the most obvious risks to a particular mark. If you are in the early stages of planning your brand, or if you are trying to choose between a number of potential marks, a knockout search would be a good option.

A **comprehensive** search is wider in scope than a knockout search, and therefore, it tends to be more time consuming and costly. This type of search involves searching federal and state trademark databases for active and inactive marks and internet searching for common law usage. Also, trademark rights are geographic in scope, so if you are planning expand your brand abroad, additional searching may be required to optimize your filing strategy.

Additionally, non-traditional trademarks—like sounds, smells, tastes, and motions—may be more difficult to search on your own, and you should consult with an experienced trademark attorney.

## A Word of Warning

There is no requirement that trademarks must be registered anywhere, and a party can have trademark rights to an unregistered mark at common law. It has been said that “it is almost impossible to find out with total certainty whether anyone has previously used a non-registered trade name in the United States such that every possible conflict can be foreseen in advance. Thus, even an expensive and extensive trademark search can only provide a conditional guarantee that no conflicts exist. But [any] search is better than no search at all.” (J. Thomas McCarthy, a trademark guru.) So, even under the best conditions, there is no absolute assurance that any particular search will reveal all potentially troublesome trademarks. Moreover, the test for infringement and registrability (recall the “likelihood of confusion” discussed above) is relatively subjective and reasonable minds may disagree on factors in that test. Therefore, there is no guarantee that a “cleared” mark

will not be challenged, and the only definitive answer to whether one mark infringes another is found at the end of litigation. )

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