

# LegalArrow® Guide to Trademark Search Results

## About Comprehensive Search

### **Databases Used**

The Comprehensive Search executed by LegalArrow® includes searches in four databases: federal registrations (USPTO), state registrations, common law (business directories, etc), and domain names (.com, .net. and .org).

### **Search Techniques**

The above databases are searched for exact and for similar trademark matches. To find similar trademark matches, different search techniques are used including wildcards (e.g., “\*”), truncation, etc.

### **The Report**

Generally, the report lists first the queries which revealed no matches (i.e., the best news). Subsequently, the report includes each query which revealed some exact or similar matches. For each such query, the federal registration matches, if any, are listed first, followed by state, common law, and domain names. Where available, detailed information is included about potential matches revealed by the search.

## How to Interpret the Report

### **Federal Registration (USPTO) Results**

First, examine carefully the report to see if there are exact/identical trademarks or similar/almost identical trademarks, which are already applied for or registered with the USPTO. Secondly, if you find any identical or similar trademarks, identify the category of goods or services those trademarks are associated with. This is very important as an identical or similar match translates in a likely denial of the registration by the federal trademark office, especially if the proposed trademark is associated with the same category of goods or services as the one associated with the already registered or applied for trademark.

Similar trademarks are trademarks which are likely to create consumer confusion as to the origin of the respective goods or services. This is why they are often called “confusingly similar” trademarks. The followings are some of the factors considered by the courts for the purpose of determining if a trademark is “confusingly similar” with another:

- How similar are the trademarks when comparing their appearance, sound, and implied meaning;

- How similar the goods or services associated with the two trademarks are;
- How similar the market areas and the advertising methods are, and whether or not the goods or services of the two sources are sold to the same customers;
- How strong is each of the competing trademarks; for example, a fanciful trademark like Google would enjoy more protection than a descriptive trademark like Good Search.

For the purpose of determining if a conflict exists, the first two factors are very likely among the factors considered by the USPTO trademark examiners when comparing a proposed trademark with one already registered or applied for with the USPTO. Consider the factors above when browsing the search results. If you identify an exact match or a “confusingly similar” trademark, you probably should consider choosing a different trademark. If you are not sure about what to do because you really want that trademark, you may need to ask an experienced trademark attorney for legal advice and an opinion letter.

Third, when browsing the search report, determine if the potentially conflicting trademark is abandoned or dead. While there is no guarantee, generally this detail about potentially conflicting trademarks increases the likelihood that your trademark is registrable. This may be especially true when the potentially conflicting trademark was dead or abandoned for a long time.

### **State Registration Results**

Use the above method also when you survey the state registration results. Keep in mind that traditionally a state registration conferred the registrant the right to use exclusively his trademark only in the respective state. So, if you wanted to conduct business in Texas, and someone else already registered the trademark in Texas for the same goods or services, you had to choose a different trademark. Nevertheless, you might have been able to use and register the trademark in a different state, and even to obtain federal registration. By contrast, in today’s internet era, that state registrant may have expanded rights if, for example, he/she is using a website to market his/her goods or services to the entire country.

### **Common Law Results**

In United States someone can acquire rights in a trademark by simply using it to sell goods or services. When more than one person or business is using the trademark, the one that used it first has priority, and may stop others from using it. Use the method described above to browse the common law search results. Keep in mind that traditionally the common law rights were acquired generally only for the market in which the trademark was initially used. This means that if it was used only in a small town, the first user would have exclusive rights only in that small town, and maybe in some adjacent areas. You would have been able to use it in different market areas and even to register it. However, as explained earlier, if that small town business has now an internet presence, additional rights may be available to it.

## **Domain Names Results**

Simply because somebody reserves a domain name does not mean that trademark rights are automatically acquired. The name has to be used in commerce by selling goods or services under that name and/or registering at state or federal level. However, you may not want to choose a trademark for which the domain name is not available if you one day intend to promote your business online. Even if it is true that later you might have the right to force the cancelation of the prior reservation of the domain name matching your trademark, and to acquire that domain name for yourself, the process is expensive and time consuming.

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