

TRADEMARK SEARCHES

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Clients are frequently more interested in having a trademark registered than in determining if another business might have already used that mark. This interest is driven by a belief that registration gives superior rights in the mark to the registrant. This is not the case: the rights in the mark arise from being the first to use of it. Registration simply (but importantly) makes it easier to enforce those rights.

The trademark search only begins to assume proper importance with respect to registration once a client understands that (1) its rights to the mark depend on being the first to adopt and use the mark in commerce rather than being the first to file an application to register it and (2) even if the client has successfully registered a mark, that registration will be useless against a prior user of the mark who never bothered to register it.

The object of a trademark search is to find out if there are any other marks that are likely to be confused with the candidate mark. Likelihood of confusion requires evaluation of a number of factors, including of course the similarity of the other mark to the candidate mark and the similarities of the goods or services. Sometimes the identical mark can be used by different businesses as long as the goods and services they use it with are different. On the other hand, if your candidate mark is the same as a famous mark or you find another mark that is used with different but objectionable goods and services, you should choose a different candidate mark.

Searching for marks (or anything else) involves looking in the most likely places first and only then in less likely places until the odds of finding a conflicting mark are slim. How exhaustive the search needs to be will depend on how much certainty the searcher requires that no one else is using the same mark. There is always a danger in stopping a search too soon, either because no conflicts have been found or when only one apparent conflict has been found. The cost and effort of a more comprehensive search should be set against the backdrop of the commitment that is going to be made to the mark in terms of, for example, advertising dollars.

It is impossible to perform a perfect search. There are a lot of existing marks, and marks are continuously being adopted and used in commerce. It takes time for information about these new marks to become publicly available. But today there are powerful databases and vast amounts of searchable information at our fingertips that can make trademark searching easier and more thorough than in the past.

The best place to search trademarks is on the internet. There are a number of databases that can help a searcher find other marks businesses are using, including the database of the Patent and Trademark Office and nationwide telephone business directories. The information available from the internet is constantly changing and dictates a constantly changing trademark search strategy. Furthermore, because of the importance of e-commerce and the frequent choice of trademarks as domain names, domain names ought to be searched as well.

Once a search indicates that a mark is clear of conflicts, a business ought to adopt it and use it in commerce as soon as possible so that it can acquire trademark rights as soon as it knows it has a good mark.