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Planning the Search

A trademark availability search should not be a standardized, "one-size-fits-all" process. The search needs to be tailored to fit the situation. This requires gathering adequate information, making choices about the "what," "when," and "how" of the search, and designing the search accordingly.

GATHERING THE BASIC INFORMATION

The following is a checklist of questions that trademark counsel needs to have answered before commencing the search:

- What is the mark (or marks) to be searched?
- Has this mark been used? If so, for what products and services, and in what countries?
- If the mark has *not* been used, when is the anticipated date that it will be used?
- What goods and/or services are intended to be offered in connection with this mark? (List those goods/services that are currently intended as well as any possible longer-range plans for expansion to additional goods/services.)
- Describe the target purchasers for the goods/services.
- Describe the channels of trade for the goods/services, i.e., the wholesale and retail means for selling them.
- Are there any plans to use this mark outside of the United States? If so, where and when will the mark be used? For what goods/services?
- How was the mark selected? Is there a particular origin or source for the mark? If there are any non-English language words in the mark, please translate them. If there are any technical words or industry jargon in the mark, please define them. If pronunciation of the mark is not obvious, please provide it.

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- Are similar marks used by other companies? If so, please identify the marks, the companies that use them, and the goods/services.
- Will the mark appear in a logo or design? If so, please attach a copy of the logo or design.
- Will any other marks, slogans, designs, or distinctive packaging be used with the mark? If so, describe.
- Please provide any actual or proposed advertisements, brochures, or packaging designs.
- Will the mark also be used as a corporate name?
- Will the mark also be used as a domain name?

Suggestions on the best ways to elicit this information from the client appear in Chapter One, Educating the Client. The most important items from this checklist are usually the following:

The Mark to be Searched

The obvious first question in any search is "What is the mark to be searched?" The answer, however, is not always straightforward. If the mark consists of letters, words or other characters, it is necessary to ask if they will appear as part of a logo, in a distinctive typeface, or with some other visual element. Prominent or distinctive visual elements usually require a separate search. For example, the proposed logo for iSEA requires two separate searches—one of the word iSEA and one for the design elements, which include a fish in party attire, a lower case "i" with sunglasses, and waves. (See Chapter Six, Searches of Non-Word Marks, Designs.)

In addition, if the client anticipates using alternate forms of the mark, or envisions the mark as the beginning of a family of marks, the search should be designed to retrieve all of the relevant variations of the proposed mark.

Clients may find it more convenient to develop several potential marks to be screened by counsel at once, since the client's first choice will often prove to be unavailable.

Goods or Services and Channels of Trade

The potential for confusion between two marks depends in large part on the goods or services for which they are used, where and how the goods or services are marketed, and who might buy them. Without a clear idea of these factors, it will be difficult to focus the search on the marks that are the most relevant to the client's business, and to analyze the potential for



conflict with other marks. The search will be less efficient and the resulting opinion less useful.

Two principles of trademark law illustrate why such information is essential:

1. Goods or services need not be competitive in order for confusion to occur; confusion can result if they are sufficiently related. The searcher must therefore know enough about the proposed goods or services to understand what goods or services might be related to them.
2. Confusion does not necessarily result simply because two parties' goods or services are in the same category. One party may market in different channels than the other or sell to different purchasers. For example, describing the proposed product as "computer software" does not tell the searcher what purposes the software will serve, how it will be marketed, or to whom it may be licensed.

Thus, the more detail which the client can provide to trademark counsel or to a trademark search, the better.

Derivation of the Mark

Counsel should ask the client why the mark was selected and how it was derived. The answer may reveal serious problems, e.g., that the mark is descriptive or is calculated to call to mind a competitor's mark.

Area of Projected Use

If the mark will be used in countries outside the U.S., it may be necessary to commence searches and/or applications for registration in those jurisdictions. This can occur on a parallel track with the U.S. search or begin as soon as the U.S. results are clear. (See Chapter Twelve, Searching Marks Outside the United States.)

Use as Corporate Name

If the mark being searched will also be used as a corporate name, the mark should be cleared as a corporate name in parallel with the trademark clearance process. (See Chapter Two, The Uses of Searching, *Corporate Name Clearance*.)

Use as a Domain Name

Many business plans today require that the proposed trademark also double as an Internet address. Trademark counsel must have this infor-

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mation in conducting the search, since the inability to obtain the desired domain name may doom the rest of the search.

PRELIMINARY VERSUS FULL SEARCHES

In terms of thoroughness, searches are generally categorized in one of two classes, "preliminary" or "full", although there are in fact a variety of options available beyond the preliminary search.

The purpose of a preliminary search (also known as a "screening" or "knockout" search) is to spot obvious conflicts at the outset, thereby avoiding the expense and time required for a more extensive search (see Chapters Four and Five). The preliminary search uses a limited number of resources and queries that the searcher deems most likely to yield relevant marks with minimum effort. It serves to rule out marks that are clearly unavailable; it does not attempt to reach a definitive answer on the availability of those marks that survive. Thus, while a preliminary search can yield a clear "no" to a proposed mark, it cannot yield a clear "yes"—only the potential for a "yes" after further research.

If a mark survives its initial screening, counsel usually either requests a professional search firm to conduct a more extensive search or conducts one itself. (See Chapter Seven.) The marginal cost of additional searching is usually worth the extra assurance, since the amount invested in the mark is likely to be so much larger. In most cases, the combination of a preliminary search followed by an outside firm's full search (or some other form of thorough searching) is cost-effective and reduces the risk to a reasonable level.

WHO CONDUCTS THE SEARCH

Trademark search databases are readily accessible to any company or law firm, either by opening an account with an Internet-based provider, by licensing a CD-ROM search system, or by obtaining access to a database provider such as DIALOG, LEXIS, or Westlaw. In addition, more rudimentary forms of the federal trademark register are available free on the Internet at the Trademark Office's website (USPTO.GOV) and, at this writing, on at least one advertiser-supported private site.

This allows anyone to try to conduct a preliminary trademark search online. However, using outside or inside trademark counsel or a professional search firm will be more cost-effective and reliable than a do-it-yourself approach, because the task of conducting and evaluating even a prelimi-

nary search is not nearly as simple as it may seem. Searching requires an investment in training and practice, and search skills become rusty when infrequently used. Most companies will not require a large enough number of searches to merit developing and maintaining competent in-house search capability. The investment in resources and training for preliminary searches does make sense for in-house counsel at companies with large trademark portfolios and for lawyers in private practice who do a large volume of trademark work. Even then, however, most trademark counsel conduct only the preliminary search and rely on professional trademark search firms for a more thorough search.

The real benefit of these resources to non-trademark professionals is the ability to spot-check the availability of marks as a prelude to a substantive preliminary search. A marketer or advertising agency brainstorming a long list of new marks will find it very convenient to quickly and inexpensively spot potential obstacles, without having to wait for results from counsel. However, trademark counsel will want to advise their clients that such spot checks are easy to misunderstand, and should not take the place of professional searching. Moreover, from a risk management standpoint, companies will want to ensure that the accessibility of search resources does not displace the role of trademark counsel, because those who coin marks quite understandably tend to want to interpret search results in the most positive light. Trademark counsel are more dispassionate about the results, and more likely to provide an impartial reading of the results.

TIMING

The first-come, first-served nature of trademark registration places conflicting pressures on the timing of a trademark search. On the one hand, a company which wants to use a particular mark has an incentive to file for registration as soon as possible. Waiting to file until a search is done presents the risk that someone else will establish rights in a conflicting mark while the search is underway. On the other hand, money invested in filing for registration of a mark is money wasted if the subsequent search shows that the mark is unavailable. For companies that create a significant number of new marks each year, the expense of filing for registration of each mark without knowing whether it is available can increase its trademark budget significantly. Thus, companies are faced with the trade-off between the benefits of early filing and the cost savings of waiting until the complete search is in hand.

This tension results from the fact that, under the U.S. intent-to-use registration system, an applicant need not wait until use begins to file for reg-

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istration. An applicant can file as soon as it has the requisite *bona fide* intent to use the mark in commerce, which could be months or years before use begins. The "constructive use" doctrine creates an incentive to file promptly, in that a federal trademark application filing date potentially constitutes a nationwide constructive date of first use. Thus, the benefits of thorough searching must be balanced against the benefits of seeking registration as promptly as possible.

Fortunately, in the U.S. the gap between the search request and the decision to file for registration need not be that great. Sophisticated electronic search databases enable trademark lawyers to conduct extensive screening searches themselves, and to provide clients with preliminary advice very rapidly. Thus, companies that want to file promptly can make filing decisions based on preliminary searches of the databases in which conflicting marks are most likely to appear.

Outside search firms at this writing produce their standard-priced searches in five business days and premium priced expedited searches in one or two days. Thus, it need not take long to obtain and review a full search. Still, most companies cannot budget every search at a premium price for expedited service, and trademark counsel needs to decide on an everyday basis whether to recommend whether the client should seek registration before knowing the full search results, or should wait until the full results are in hand. Here are two possible scenarios, followed by a discussion of the pros and cons of each:

THE "FILE FIRST" SCENARIO

Step 1. Counsel conducts a preliminary search of one or more proposed marks, and reports the results to the client.

Step 2. Counsel prepares and files an application to register the mark which survives the preliminary search.

Step 3. Counsel conducts a full search on the mark which survives the preliminary search.

Step 4. Possible follow-up search if full search was conducted during application "blind spot".

Step 5. Client begins using the mark

THE "SEARCH FIRST" SCENARIO

Step 1. Counsel conducts a preliminary search of one or more proposed marks, and reports the results to the client.

Step 2. Counsel conducts a full search on the mark which survives preliminary search.

Step 3. Counsel prepares and files an application to register the mark which survives the full search.

Step 4. Possible follow-up search to compensate for full search "blind spot".

Step 5. Client begins using the mark

The **"File First" Scenario** emphasizes filing an application for registration on the earliest possible date. With the time saved by using electronic search databases, and a Trademark Office certificate of mailing or electronic filing, the client may receive an application filing date not long after requesting the preliminary search. The full search can be conducted after filing to determine whether any obstacles to use or registration exist that did not appear in the preliminary search.

The timing of the full search depends on the client's lead time for introducing the mark. If planning and investment for the new mark need not begin immediately, a company could delay ordering the full search until the application receives a filing date and appears in the search database (at this writing, usually a period of 5 to 8 weeks). This would permit the other applications that were filed in the 5 to 8 weeks prior to applicant's filing to appear in the search. The applicant could then change its plans if an application for a confusingly similar mark was filed prior to its own. Unfortunately, in today's marketplace most companies do not have the luxury of waiting 8 weeks for assurance on whether a mark is available, and the 8-week wait would not remedy all of the blind spots inherent in searching, only the most egregious one (the Trademark Office delay in processing new applications).

The shortcoming of the **"File First" Scenario**, of course, is that the client spends money to file an application for registration before having the complete picture on availability, an expense most companies will not want to shoulder on a regular basis. If the full search subsequently reveals that the mark is unavailable, the client must start from scratch.

Under the alternative **"Search First" Scenario**, the full search results arrive before the application is filed. The applicant sacrifices the earliest possible filing date in exchange for greater assurance of availability, and assumes the risk that another party did not file for a conflicting mark while its own search and evaluation were underway. The tradeoff under this scenario need not be so great if the client is willing to pay the premium price for an expedited full search, but most companies will not want to incur this added expense on a regular basis.

These timing problems, and the **"file first/search first"** choice, grow more complicated if the proposed mark must be cleared for use in a number of countries. The lead times in obtaining clearance outside the U.S. are likely to be longer, since many countries cannot match the speed with which search firms can provide U.S. search results. If a company files for U.S. registration based on a positive U.S. preliminary or full search, while non-U.S. searches are still underway, it does so knowing that the mark

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may turn out to be unavailable in one or more countries still being searched. However, if a company refrains from filing in the U.S. because it is awaiting non-U.S. results, the chances of an intervening third-party U.S. applicant increase, as it may take weeks to obtain and review non-U.S. results on the mark.

The expenses and the risks obviously mount if the company files in a number of countries without having received full search results in any of them, or if the company waits to file in any country until waiting the weeks necessary to receive full search results in all of them.

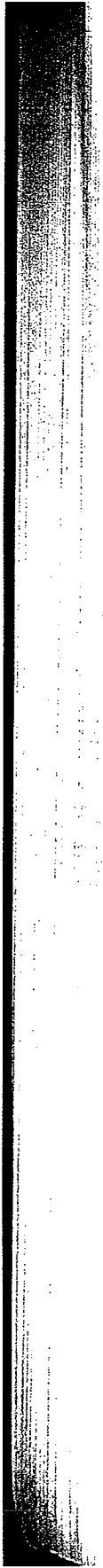
Whether the "File First" or "Search First" strategy is best depends on the circumstances. The "File First" approach is appropriate if a client is strongly committed to a single mark. This allows the client to minimize the risk that someone else will file with the Trademark Office first. The "Search First" approach may be an attractive alternative when a number of possible marks are being screened simultaneously, and the client wants to base its final decision on the results of a full search of each mark. This scenario may also be appropriate when the proposed mark is fairly unusual, because the risk is lower that another applicant will file for a similar mark during the search process.

A newer timing issue is presented by the marketing importance of domain names, and the rush to obtain them by legitimate users and by those who hoard and resell them. Given that the volume of domain name registrations far outpaces new trademark filings in the U.S., a delay in seeking a desired domain name is even more risky than a delay in filing for trademark registration. Thus, if the preliminary search suggests that a mark may be available, and is also registrable as a domain name, a company is well-advised to register the domain without waiting for full search results.

Resources for the Preliminary Search

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■ **The Menu of Search Resources**
Manual Resources
Electronic Resources
Specialized Searches



Resources for the Preliminary Search

The preliminary search is a fairly recent development in trademark practice. Until the early 1980's, trademark lawyers relied almost entirely on outside search firms to conduct searches. These specialist organizations conducted a full search, and counsel reviewed the finished report and provided the client with an opinion.

Trademark lawyers had one practical do-it-yourself option—a manual search of bound volumes that listed registered marks and pending trademark applications. However, these books were of limited usefulness in clearing marks. They contained very little information about each mark, did not provide current status information, and very quickly fell out of date. More important, they permitted only the most basic alphabetical searching, and did not allow for searches of word fragments or provide cross-references to soundalikes.

The turnaround time on outside searches was excruciatingly slow by today's standards, as search vendors lacked today's sophisticated computer search tools (as well as the ability to deliver results via the Internet or overnight courier). Because lawyers could conduct only rudimentary preliminary searches for obvious conflicts, they had to wait days or weeks, and pay the cost of a complete search to get results, sometimes only to discover a direct conflict on the first page.

Counsel's role has changed dramatically since the introduction of computerized databases. The widespread availability of online search tools makes it possible to conduct preliminary or "knockout" searches for obvious trademark conflicts, without the wait or expense of a full search. While most lawyers still rely on search firms for complete search reports, lawyers, paralegals and librarians have learned how to conduct preliminary searches themselves by computer. The primary vehicles for such searches are databases of Trademark Office information and state records.

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However, a wide array of news and informational databases and Internet resources are also available at the trademark professional's desktop. Although not expressly designed as trademark search tools, these services provide additional useful information for the search process and, given that registration is not a prerequisite to trademark protection in the U.S., have become the essential means of locating unregistered common law marks.

Traditional online databases are designed on a pay-as-you-go basis—the more information retrieved, the higher the cost. Thus, a preliminary search is efficient only if a limited number of resources are used. If the searcher searches too extensively, the cost could quickly exceed that of an expedited search from an outside firm. Trademark professionals need to be careful when embarking on do-it-yourself searching—to make it economical, the searcher has to decide which resources to use, how extensively to search each one, and where to draw the line before opting to order an outside search.

The advent of the Internet has provided a new dimension to the preliminary search. With vast amounts of information available, sometimes without a pay-as-you-go pricing scheme, counsel needs to determine when and how the Internet can be useful as an additional search tool. Although it is free, the Internet is a far less efficient and reliable search tool than proprietary databases, and generally requires considerably more time to obtain useful information. Therefore, in deciding how to use the Internet vis-a-vis proprietary databases, the cost of the searcher's time has to be factored into the equation.

The sum of all of these developments is that the choices available for preliminary searching are almost overwhelming. There are proprietary databases of Trademark Office records from several different vendors accessible via vendor websites, through traditional dial-up online services such as DIALOG and LEXIS, or on CD-ROM; Trademark Office records available from the agency's own website; a wide variety of specialized proprietary informational databases used for searching common law marks; and searches of Internet website content for common law marks. Some resources are free for use, some are not. While all have the advantage of frequent updates, the timeliness of information varies—users sometimes mistakenly assume that online or Internet information by its nature is up-to-date, which may not be the case. Different search techniques are used from database to database.

Having so many choices is both comforting and confusing. More than ever, counsel needs a framework for determining the best uses for the

many available preliminary search resources. The following pages outline the key factors for trademark professionals to consider when selecting resources for the preliminary search.

THE MENU OF SEARCH RESOURCES

The resources for conducting preliminary searches fall into two basic categories:

1. Manual resources (books, directories, and other source material published in "hard copy" form); and
2. Electronic resources (proprietary electronic on-line and CD-ROM databases and the Internet).

Electronic databases and the Internet have not made old-fashioned "hard copy" search resources obsolete, but such print resources are certainly of diminishing usefulness in conducting preliminary searches. Many of the manual resources described in the first edition of this book have since gone out of print, a testimony to the efficiency of online search tools. Today, manual resources are more efficient for determining the protectability of marks than for determining availability. The following continue to be useful, low cost search resources for specific tasks:

- General and technical dictionaries are used to evaluate whether the mark is descriptive or generic as applied to the proposed goods or services;
- Atlases and geographic dictionaries can help determine whether a mark is not immediately registrable because it is primarily geographically descriptive or might be considered geographically misdescriptive;
- Telephone directory white pages assist in the evaluation of whether a mark is not immediately registrable because it is primarily merely a surname; and
- Local telephone directories can be used to search for any obvious conflicts with marks that will only be used in a particular locality.

However, the bulk of preliminary searching is most efficiently done via electronic resources. Such searches rely primarily on databases of federal and state trademark records, and secondarily on databases where common law marks appear.

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Electronic resources come in three forms, each with a pricing scheme that directly affects how it is best used—on-line proprietary databases (with pricing dependent upon the number of records retrieved and/or time spent online), CD-ROM databases (a single, flat monthly or annual price for unlimited use), and the Internet (most resources are free of charge but unwieldy and time-consuming to use).

To get a sense of the variety and complexity of options available, one need only consider that a leading vendor of Trademark Office searching provides information via all three methods—a dial-up service, the vendor's own website, and CD-ROM—and each version operates using different commands and search techniques. Different versions use different pricing structures, and different volume pricing plans are available to high-volume users. In one of these modes, the searcher does not even have to formulate search queries—the database will do it automatically.

Which is best? The answer is clearest at the polar ends of the searching spectrum—an occasional user may prefer search tools which operate "automatically", developing a search strategy for the user and producing results for a set fee, while some heavy users may prefer CD-ROM, which is expensive but allows a searcher to perform an unlimited number of searches for a fixed subscription cost. However, many heavy users dislike the fact that CD-ROM searches must be supplemented with on-line searching in order to ensure that the search contains the most current information.

For users in the middle ground, the choices are less clear. The chart on the next page provides a framework for comparing the advantages and disadvantages of each type of electronic resource, and deciding which is best for a particular task, and which suits a particular law firm or corporate legal department.

The most commonly used manual and electronic search resources are described in the following pages. For organizational purposes, the resources in each category have been presented in order of their relative efficiency in a typical search. Those which are generally more likely to contain relevant marks and which better lend themselves to preliminary searching are listed first.

Resources for the Preliminary Search

	Internet search engines	Proprietary on-line databases	Proprietary CD-ROM databases
Technology required	Internet access	Internet access and user access password, or access to database provider	Multi-disc CD-ROM equipment
Initial acquisition cost of data access	None	None; most databases do not charge a fee to initiate access	High; subscriber pays fixed subscription fee for unlimited access to database
Marginal cost of use; efficiency	No out-of-pocket cost, but time-consuming—can be used for unlimited periods without usage charges, but a large percentage of data retrieved is likely to be irrelevant because of vast amounts of unorganized information, erratic search capabilities	Efficient only for limited searching because cost is based on usage; with proper training, however, time spent here is more likely to yield relevant information than the equivalent amount of time on the Internet	After the initial investment, can be used for unlimited periods without usage charges; with proper training, time spent here is more likely to yield relevant information than the equivalent amount of time on the Internet
Versatility	Searching of word fragments limited; images not searchable	Some databases allow searching of word fragments, portions of phrases; image retrieval available on trademark databases	Some databases allow searching of word fragments, portions of phrases; image retrieval available on trademark databases
Speed of use	Varies considerably with resource being used	Lends itself well to rapid, complex searching	Lends itself well to rapid, complex searching
Timeliness	Resources frequently updated	Resources frequently updated	Updated with some frequency, but must be supplemented online to be reliably current
Reliability	Skilled searching may not yield relevant marks	Skilled searching likely to yield almost all relevant marks available on the database	Skilled searching likely to yield almost all relevant marks available on the database

MANUAL RESOURCES

Manual resources are most useful in determining whether the word or phrase in question can actually be protected as a trademark or whether it could be deemed generic, descriptive, geographically descriptive, or a surname. Some manual resources can be useful as a secondary resource in determining availability.

A **dictionary** is often a good starting place for a manual search, since it could provide guidance in determining the meaning of a proposed mark. If all or part of the proposed mark appears in the dictionary, the searcher will need to evaluate whether the mark is descriptive or generic as applied to the proposed goods or services. Of course, dictionary listings must be viewed with a critical eye, since dictionaries sometimes contain misleading references to terms that are actually registered trademarks.

Specialized dictionaries may be useful to a searcher who frequently works in a specialized area such as pharmaceuticals or computers. Such dictionaries may reveal that a word is generic or descriptive in a particular industry, even though a general purpose dictionary would not include such specialized or idiosyncratic meanings. Examples of such publications are *Dictionary of Information Science and Technology* (Academic Press), *Dictionary of Computing* (Oxford University Press), *Dictionary of Food Ingredients* (Van Nostrand Reinhold), and *Dictionary of Insurance Terms* (Barron).

Atlases and geographic dictionaries can help determine whether a mark is not immediately registrable because it is "primarily geographically descriptive" of the goods or services. See 15 U.S.C. Section 1052(e)(1). Such sources are cited by the Trademark Office in rejecting marks as geographically descriptive. See *In re Loew's Theaters, Inc.*, 223 U.S.P.Q. 513 (TTAB 1984), *aff'd*, 769 F.2d 764 (Fed. Cir. 1985).

Telephone directory white pages are a valuable resource on the issue of whether a mark is not immediately registrable because it is "primarily merely a surname." See 15 U.S.C. Section 1052(e)(3). Trademark examining attorneys have historically used white pages directories for major cities to support a surname rejection, although they now use a multi-city CD-ROM database for such purposes. See *e.g.*, *In re Picone*, 221 U.S.P.Q. 93, 94-95 (TTAB 1984); *In re Stromsholmens Mekaniska Nerksstad AB*, 228 U.S.P.Q. 968, 969 (TTAB 1986); *In re Industrie Pirelli Societa per Anzioni*, 9 U.S.P.Q. 2d 1564, 1566 (TTAB 1988). If the proposed mark is to be used despite its status as a surname, telephone directories can reveal alternate spellings for use as search terms when searching the mark in other databases.

Local telephone directories are an efficient way to begin a search for marks and trade names if use will primarily be local.

Industry trade directories relevant to a particular industry can be useful in determining availability or descriptiveness. For example, *Best's* directory of U.S. insurance companies is a useful source in clearing new insurance marks.

Trade periodicals are valuable sources of information on competing products, but they are usually searched more efficiently on-line or on CD-ROM.

Trademark, trade name, and general business directories can be good sources for unregistered marks, but are usually more efficiently searched on-line or on CD-ROM.

Shepard's United States Citations comes in print and electronic versions and contains an alphabetical list of trademarks that have appeared in the Trademark Office *Official Gazette* or been mentioned in court decisions. The court decisions may be useful in determining whether a mark has been deemed strong or weak, or whether a word or phrase has been found to be descriptive or generic.

ELECTRONIC RESOURCES

The following is a list of the types of information available in electronic databases.

Federal Trademark Registrations

A database of federal trademark registrations and applications for registration is usually the first electronic database to search. The federal trademark register is the most comprehensive trademark source in terms of sheer numbers, and federal trademark databases are particularly efficient, having been devised expressly for searching. The federal trademark register is the most significant source from a legal standpoint, since federal registration provides certain rights and presumptions beyond the common law. (See Chapter Eight, *Is the Mark Registered?*) Applications for federal registration are just as important. An application may reveal that the applicant claims to have already established common law rights in a mark through use. Alternately, even if the application alleges only an intent to use a mark, the applicant has, in effect, acquired a contingent right in the mark. If and when use commences and a registration is issued, a federal

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intent-to-use applicant's rights will mature into national rights which date back to the application filing date or a prior foreign filing date. (See Chapter Eight, Is the Mark Registered?)

The federal trademark register is also of critical importance from a practical risk avoidance standpoint. If the ultimate purpose of searching is to minimize the chances that a mark will be challenged, one should focus on the most likely challengers—companies who were sufficiently proactive and protective of their marks that they sought federal registration.

Since federal registration affords national rights in a mark, the federal trademark register should be searched whether the proposed mark will be used nationally or locally. Even if the registrant of a potentially conflicting mark is known to be selling solely in another locality, that registrant is entitled to enjoin use in new areas into which it can show a likelihood of entry. (See Chapter Eight, Where is the Mark Used?)

All commercial U.S. federal trademark search database suppliers derive their information from the same source—data sold to the suppliers by the Trademark Office. With a few exceptions, these suppliers display basically the same information about the mark (i.e., the class of goods or services, a description of the goods or services, the filing date and serial number, the registration date and registration number, the filing information about Section 8&15 affidavits and renewals, ownership and subsequent chain of title, and opposition and cancellation proceedings involving the mark). A typical record for a registered mark looks like this:

MARK: CHEEZ WHIZ LIGHT
STATUS: REGISTERED; SECTION 8 & 15—ACCEPTED AND
ACKNOWLEDGED; INTENT TO USE APPLICATION
GOODS/SERVICES: Reduced fat pasteurized processed cheese
product
SER. NUMBER: 74-270,994
REG. NUMBER: 1,800,943
INT. CLASS: 29 (Meats & Processed Foods)
U.S. CLASS: 46 (Foods & Ingredients of Foods)
REGISTERED: October 26, 1993
FIRST USE: October 12, 1992
FIRST USE IN COMMERCE: October 12, 1992
PUBLISHED FOR OPPOSITION: May 25, 1993
AFFIDAVIT SEC 8&15: May 1, 1999
ORIGINAL APPLICANT: Kraft General Foods, Inc., (Delaware
corporation), Three Lakes Drive, Northfield, IL 60093 USA
ASSIGNEE: Kraft Foods, Inc., (Delaware corporation), Three Lakes
Drive, Northfield, IL 60093 USA
BRIEF: Change of Name
RECORDED: January 17, 1995
REEL/FRAME: 1290/0260
DISCLAIMS: "CHEEZ" and "LIGHT"
OTHER U.S. REGISTRATIONS: 795,650
FILING CORRESPONDENT: Douglas W. Cherry, Kraft Foods, Inc.,
Law Dept. NF352, 3 Lakes Dr., Northfield IL 6093

Suppliers differ, however, in how they compile, present, and update information, in whether they display designs as well as text, and in the amount of historical information and inactive records they provide. Some enhance their data with useful cross-references. Not every database allows searching in every category. Different databases employ different search methodologies, and some methodologies are better for certain search purposes than others. Some retrieve all records containing a particular "alphanumeric string" (i.e., a combination of letters and/or numbers), while others retrieve all records containing a particular alphanumeric string *along with* certain phonetic equivalents. In addition, some can be used to perform design searches.

The major commercial U.S. federal databases are listed in the Appendix. Trademark Office records are also available at the Trademark Office's web-

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site at USPTO.GOV, but this database, at least as of this writing, is only suitable for rudimentary searching, and does not have the breadth or timeliness of the commercial databases. For a more detailed description and comparison of the features of the various commercial databases and the Trademark Office website, see Chapter Five, Choosing the Database.

State Registrations and Fictitious Name Filings

Although state trademark registrations and fictitious name filings afford little or no rights beyond those available at common law, state search databases are an important resource. One must view each listing with caution, however, since most states have little or no examination of applications. Thus, descriptions of goods and services are often cryptic or non-existent. Little actual use may be required for registration, and infrequent renewals make it difficult to gauge whether use has continued. These resources are listed in the Appendix.

Internet Domain Names

Although the registration of an Internet domain name in and of itself does not create trademark rights (see, e.g., *Brookfield Communications, Inc. v. West Coast Entertainment*, 174 F.3d 1036; 50 U.S.P.Q. 1545 (9th Cir. 1999)), domain names are an important part of any trademark search, for two reasons. First, companies often want to use a proposed mark as a domain name, and may want to rule out any mark which isn't available for that purpose. Second, because many domain names are also used as trademarks at websites, domain name searches have become an important source of common law marks. The primary resources for domain name searches are shown in the Appendix.

News Information Databases

Databases of newspapers and periodicals can be very useful in locating common law marks which do not appear in federal and state trademark records. The most comprehensive databases include NEXIS, WESTLAW, and DIALOG. Detailed descriptions of these resources are listed in the Appendix.

NEXIS is an excellent tool for availability searches on coined words, uncommon phrases, and slogans. It is also an essential resource in determining the descriptiveness, genericness, or geographic descriptiveness of a proposed mark. In fact, Trademark Office examining attorneys regularly perform NEXIS searches to determine whether a term is generic, de-

scriptive, or geographically descriptive with respect to the applicant's goods or services, and they often include the results of a NEXIS search as part of an office action rejection on such grounds. NEXIS can also help show whether or not a mark is primarily a surname. In some circumstances, NEXIS and other news databases may reveal any negative connotations associated with the proposed mark, in that they show how the term is used in news reports on particular industries or in particular localities.

These news databases are essential in finding out more about possibly-conflicting marks that have appeared elsewhere in the search. News accounts found on NEXIS and other databases can provide clues as to whether the mark is still in use and which marketing channels are used.

Other Informational Databases

Informational databases can reveal common law uses of trademarks and tradenames which do not appear in the major news databases. These informational databases may include full texts or abstracts of periodical articles, or may present directory-style presentation of information about companies or products. Some databases frequently used for trademark searches include **American Business Directory** and **Dun & Bradstreet** (for company names and trade names) and **Brands and their Companies** (for trademarks). (See Appendix.)

Legal Research Databases

The two major legal research databases, **LEXIS** and **WESTLAW**, provide information on litigation involving trademark owners and their marks. **Shepards**, as described above (see Manual Resources), provides citations of marks mentioned in litigation.

Internet Search Engines and Indexes

Tools for searching the content of Internet websites are increasingly important in locating common law marks. Extensive comparative information about Internet search engines and indexes is available at www.searchenginewatch.com. Two Internet search tools of particular interest are CCH Trademark Research Corporation's *Intellicite* and Thomson & Thomson's *Sitecomber*, which allow the searcher to limit the search to classes of goods and services which correspond to the international classification system used by the Trademark Office.

SPECIALIZED SEARCHES

In particular industries, it may be advisable to search government records that may reveal uses of trademarks. For instance:

- The Securities and Exchange Commission maintains its own records, listing the names of securities broker-dealers, mutual funds and investment companies, which can be searched through Disclosure and other SEC search firms.
- The Bureau of Alcohol, Tobacco and Firearms maintains microfilm and computer database records of all label approvals issued since 1968 for alcoholic beverages. Searches are available through the Bureau or through trademark search firms.

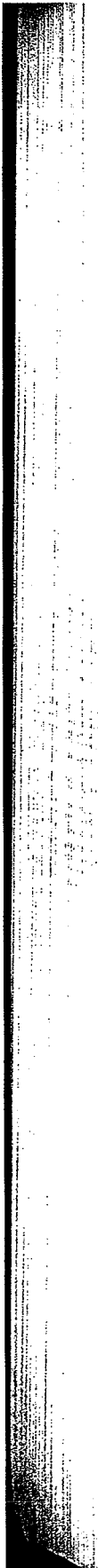
If the mark being searched will be used as the title of a periodical, multimedia work, book, motion picture, television series or cartoon, or the name of a fictional character, a search of titles of works registered with the Copyright Office may be useful. Copyright titles can be searched at the Copyright Office, on-line, or through search firms (see Appendix).

The Motion Picture Association of America also maintains its own register of titles, but its services are available only to subscribers who must be producers or distributors of motion pictures. MPAA provides registration and search services, and circulates a daily report on new registrations to its subscribers.

Planning and Conducting the Preliminary Search

5

- **Choosing the Database**
- Comparing Databases of Trademark Office Information**
- Mapping Out the Search Strategy**
- Formulating the Search Term**
- Searching by Goods and Services**
- Devising Alternate Strategies**
- Executing the Search**
- Using Databases for Common Law Searching**
- Comparing Internet Search Tools**



Planning and Conducting the Preliminary Search

To get the right answer from any computerized database, one has to ask the right question. In the context of trademark searching, getting the "right answer" is finding the trademarks in the database which are the most similar in sight, sound, or meaning to the mark being searched, for the most closely-related goods and services. The search must also retrieve any similar famous marks that could be diluted by the proposed mark.

This chapter describes how a lawyer or paralegal can ask the "right questions" in the preliminary search. The focus is on searches of databases of federal and state trademarks, although the fundamental principles described here also apply in large part to searches for common law marks in news and informational databases and on Internet websites.

The goal of the preliminary search is to find any obvious obstacles to the proposed mark without spending too much time or money. Planning and strategic thinking is required in order to ask the right questions, because aimless use of a search database can be overly time-consuming, expensive, or both.

An efficient plan is especially important when searching proprietary electronic databases, because the cost usually increases with the number of entries retrieved. In order to minimize the time spent searching and the number of irrelevant records retrieved, a searcher will want to map out a strategy before logging onto the database. If the searcher does not limit the number of marks retrieved, an on-line search may turn out to be more expensive than an expedited full search performed by an outside search firm.

One can avoid this cost pressure by using a proprietary CD-ROM trademark database, in which the subscriber pays a set fee for unlimited use of the database, regardless of how much time is spent searching or how many records are retrieved. In fact, the major advantage of a CD-ROM database is that it allows the searcher to conduct preliminary searches in greater depth. However, the high cost of a CD-ROM subscription will make this type of database prohibitively expensive for all but heavy users. An effi-

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cient search plan is still necessary even on CD-ROM to minimize the time spent retrieving and reviewing trademarks which have no relevance to the mark being searched.

On certain proprietary trademark search databases, the searcher has the choice of asking the questions or letting the computer do it—that is, the searcher can formulate search queries designed to elicit similar marks from the database, or can rely on the search database to formulate those queries automatically. With automatic searching available, one might question why searchers would bother to formulate search queries themselves. The answer is that automated searching is far from perfect. Computer generated queries are sometimes over-inclusive and other times under-inclusive. For some marks, they fail to yield all the phonetic variations that a searcher might expect. For others, they yield far too many marks, forcing the searcher to wade through a long list of completely irrelevant marks. Automatic queries are also not designed to yield synonymous marks.

Even if automatic searching were foolproof, the accomplished searcher will still sometimes want to move beyond the federal and state trademark registers and incorporate Internet websites and various common law news and informational databases in the preliminary search. These databases were not designed for trademark searching, and generally do not offer an automatic option. The searcher must learn how to formulate thoughtful search queries in order to get the most relevant results from these resources.

Thus, effective preliminary searching is a matter of choosing the most appropriate databases, and then formulating search queries designed to efficiently yield the most relevant marks, using automatic search options where appropriate or available. Creating and executing an efficient search plan for a preliminary search requires knowledge of the databases available, language skills, intuition, knowledge of the peculiarities of the Trademark Office's classification and identification system, and experience with trademarks themselves.

CHOOSING THE DATABASE

Searchers will sometimes use more than one database in conducting a preliminary availability search. Choosing which databases to use involves two steps:

1. First, the searcher will decide which types of resources are likely to turn up the most relevant marks at the least cost (e.g., a federal trade-

mark register database, Internet websites, a periodical articles database, print resources, etc.).

2. Having selected the types of resources to be used, the searcher must then decide which of several competing databases or search engines of that type to use.

For searches of the U.S. Trademark Register, one can choose from among several commercial search databases (see Appendix). Each has different features and operates differently, as described in Chapter Four, Electronic Resources, and later in this chapter (Comparing Databases of Trademark Office Information). Searchers can also check the Trademark Office's own search database at USPTO.GOV, although it has limitations which make it unreliable for conducting preliminary searches (see this chapter, Comparing Databases of Trademark Office Information). Similarly, there are multiple vehicles for searching Internet website content, domain names, newspaper and periodical articles, and specialized informational databases. They differ from one another in the material they cover and in the way the search is conducted (see Chapter Four, Electronic Resources, and Appendix).

Where to start first? The answer depends on the mark being searched. Here are some suggestions, designed to maximize the relevance of the information retrieved and minimize the time spent searching and the out-of-pocket costs:

- For most **word marks**, the best place to begin is an online or CD-ROM Trademark Office database. Depending on the nature of the mark, one can either limit the preliminary search to that database, or check other databases as well. For example, if the mark is a **coined word** or an **unusual phrase**, it may be efficient to search NEXIS and the Internet for common law uses. NEXIS, the Internet, and other news and informational databases are unlikely to be efficient in searching commonplace dictionary words or phrases, however, unless the search is limited to articles or websites containing other terminology relevant to the product or service for which the mark will be used.
- For **logotypes, packaging, product configurations, and other design and trade dress marks**, an online or CD-ROM Trademark Office database is the only practical alternative.
- The search plan must also reflect the fact that a search must determine not just whether a mark is available, but the threshold question of whether the word or phrase is protectible as a mark at all. If counsel suspects that the mark is a **surname, generic, descriptive, or geo-**

graphically descriptive, the best resources for starting the search will probably be manual resources such as dictionaries and atlases. The Internet and NEXIS will be useful if the suspected descriptive term is used in a highly technical area and may be too arcane to appear in printed resources. An online or CD-ROM Trademark Office database can also be used to see if the word or phrase has been disclaimed as generic or descriptive in registrations and examined applications.

These are only basic rules-of-thumb, however, and won't apply in every situation. In order to map out a cost-effective search strategy, the searcher must think through what is best for each new search, and then select the best databases to use, decide which part of the mark to search first, formulate the "search term," and define the relevant goods and services. The following pages provide a roadmap for this effort.

The road begins with databases. One database may be better than another for a particular search. The following is a checklist of the factors to consider in selecting the best database for the job.

COMPARING DATABASES OF TRADEMARK OFFICE INFORMATION

Trademark search databases can be evaluated on measures such as comprehensiveness, versatility, search methodology, and reliability. Trademark counsel can use these factors to make decisions between commercial databases, and to evaluate them vis-a-vis the government's database.

At this stage, the government's database does not lend itself well to the needs of professionals who are seeking to determine the availability or registrability of a new mark or to conduct a due diligence search of a company's trademark portfolio. The site receives only infrequent updates, so timeliness is a problem. In addition, the government database does not include the cross-references and enhancements which the major commercial search firms include in their databases for added reliability. It is most useful for retrieving information about a particular trademark registration or application.

The following are the key considerations in comparing and selecting databases of Trademark Office records:

Comprehensiveness and Timeliness

All federal trademark databases provide basic information about the mark, but some contain more records than others. Every major database

contains all active federal trademark registrations and applications, but databases vary in the number of cancelled and expired registrations and abandoned applications that are included. As a rule of thumb, databases with more inactive records are preferable, since some inactive records could reflect marks that are still in use or provide information about past oppositions and cancellations of marks similar to the mark being searched.

It is also vital that trademark search databases contain as many newly-filed applications as possible. Unfortunately, no database can be completely up to date, since information must be gathered and entered into the database before it can be searched. Obviously, the more current the information, the better. The searcher should compare the frequency with which databases are updated, and should also compare database update cycles. A CD-ROM database which is updated monthly may be nearly as current as, or more current than, an on-line database at the beginning of the cycle, but could be several updates behind at the end of the cycle.

Timeliness and comprehensiveness are also considerations in searching non-trademark databases. News and information databases and Internet search tools vary in the frequency with which they are updated. A database like NEXIS, which contains a large number of periodical and newspaper articles, will be more productive for searching coined words or unusual phrases than a database that is less comprehensive. However, databases which are limited to trade press articles in a particular industry such as computers can be very efficient for searching marks to be used in that industry, especially when the word or phrase being searched is more commonplace.

Versatility

Databases are composed of "fields" of information in different categories (e.g., trademarks, owner names, etc.), but not all fields in a given database are searchable. All of the major trademark search databases allow searches for a particular mark, a particular registration or serial number, or a particular class of identification of goods or services. However, they may vary in the number of additional fields that can be searched and the ease with which those fields can be searched. The more fields that can be searched, the greater the flexibility in narrowing a search.

Versatility can be especially important when choosing a database for specialized search tasks. For example, a database without a searchable field for oppositions cannot be used for retrieving all marks opposed by a particular party.

Methodology and Reliability

Search databases operate logically and mechanically, but trademarks do not behave that way at all. Trademarks reflect creativity, sometimes even eccentricity. For example, they often deliberately incorporate corrupted spellings, word plays, colloquialisms, and sound-alikes. These unexpected variations on normal spelling and grammar create problems in searching because, as a general rule, computerized databases retrieve only the exact combination of letters, numbers, or other characters that the searcher enters into the database, and only in the order in which they are entered. Unless the searcher or the database compensates for the unexpected quirks in trademark coinage, the search could miss something critically important.

Similarly, although the Trademark Office employs an elaborate scheme for defining and categorizing the goods and services with which marks are used, many newly-filed trademark applications don't follow this scheme. In fact, the Trademark Office itself is not always consistent in defining and classifying an applicant's goods and services. Therefore, the searcher or the database must compensate for these variations in classification or the search could omit relevant marks.

All of the major commercial trademark databases receive their information in the same form from the same source—a computer tape provided by the Trademark Office. Some vendors merely provide access to this data as is, and their databases will retrieve variant spellings, sound-alikes and translations only to the extent that these variants are cross-referenced by the Trademark Office. Other database providers, however, enhance the raw Trademark Office data by attempting to compensate for spelling and grammar variations so that a search query using the conventional spelling of a word also yields unconventional spellings. Some even add their own cross-references to classes of goods and services, so that a trademark search of one class will also yield some marks which are registered in related classes. These enhancements do not compensate for anything close to 100% of the aberrant spellings and misclassifications, but they do provide some trademark records that might escape the "logical" search queries formulated by the average searcher. It is important to note that even enhanced databases cannot compensate for the quirks of trademark coinage 100% of the time—the searcher must still be careful and creative in devising the search.

The databases of two long-established vendors—CCH Trademark Research and Thomson & Thomson—reflect years of these data enhancements, and thus offer superior reliability over databases of unenhanced

Trademark Office records. Sources of unenhanced data are available on the Internet at little or no cost, but there are tradeoffs. Searchers must recognize that using such databases may save money, but will result in more frequent client disappointment, in that relevant marks are less likely to appear in the preliminary search than they would if an enhanced database were used.

Thus, before initiating a search, the searcher needs to understand whether a given search database incorporates enhancements and how those enhancements operate. Alternately, the searcher may want to consider using an "automatic" search database as an alternative to the conventional search approach. Under this option, the search program automatically searches for phonetic and other variations and retrieves marks according to a particular search logic. As discussed above, automatic search programs are only as good as their programmed search logic, and can sometimes generate reports that are over-inclusive or under-inclusive. They also will generally not yield synonyms.

The searcher needs to choose the database most appropriate to the task. If the searcher believes that the mark has only a limited number of variant spellings, it may be more efficient to use a database where the searcher creates the search queries. For coined marks, the searcher may want to use an automatic database, allowing the computer to select and search a large number of alternate spellings.

The features and capabilities of search databases change over time, and new search products are introduced with surprising frequency. To maintain state-of-the-art searching capabilities, counsel must keep up with new entrants in the field, and new features and enhancements offered on existing products.

MAPPING OUT THE SEARCH STRATEGY

The Trademark Office database contains an ever-increasing number of marks—with more than 1,000,000 active marks (appearing in registrations and pending applications) and more than 1,000,000 inactive marks (in cancelled registrations and abandoned applications). With such volume, the searcher will seldom be able to justify the time or expense of reviewing all the marks containing a particular word. Thus, an efficient preliminary search requires a strategy—a way to reduce the number of marks to a manageable number that counsel can review. The preliminary search should aim to retrieve those marks which are most similar in sight,

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sound, or meaning to the proposed mark, for goods and services which are competitive or related to those for which the mark will be used.

If the proposed mark is a single word, the search strategy begins by formulating the appropriate search terms to be entered into the database, as described in the next section of this chapter. However, if a proposed mark contains more than one word, the searcher must begin by deciding which word to search first. Some choices make for more efficient searching than others. For example, if the mark includes an extremely common word, that word could appear hundreds or thousands of times in a database of Trademark Office records. In a preliminary search, reviewing all of those records may be prohibitively expensive, or at least an inefficient use of the searcher's time.

Therefore, the searcher will usually want to narrow the number of marks retrieved by starting with the most significant, most distinctive, or least common word. For this purpose, the searcher can follow the continuum used by most courts in classifying marks. Coined or obscure words are likely to be the most distinctive and should be searched first. Arbitrary and suggestive words follow next on the continuum, although they may or may not be common. (For example, APPLE is a classic example of an arbitrary mark for computers, but the word appears in various forms in almost 1000 active records on the federal register trademark register database.) Terms that might be considered descriptive or generic in the context of the mark should generally be searched last, both in combination with the distinctive terms in the mark and separately to verify descriptiveness or genericness.

If the first search term turns out to be unusual enough, the searcher may decide to look at all of the records in which the first term appears. If the first search term is not that unusual, the searcher may try to narrow the search in one of several ways: (1) by limiting the marks retrieved to those that incorporate the search term in a particular class or description of goods (see Searching by Goods and Services below), (2) by looking only at those marks in which the first and second search terms appear, or (3) by looking only at those marks in which the first and second search terms appear in a certain order or proximity.⁷

FORMULATING THE SEARCH TERM

Brand names often incorporate deliberate misspellings, puns, slang, and other variations on otherwise common words. A thorough search

should attempt to anticipate the unexpected by retrieving corrupted spellings, word plays, colloquialisms, foreign language equivalents, and other variants on the proposed mark. The search design must also recognize that the English language contains many words with the same root, and that the language is rife with plurals, past tenses and other variations on basic words that break the normal rules of pluralization or conjugation. Although the searcher cannot anticipate every possible variation on the proposed mark, the search plan must compensate for the inventiveness of those who coin brand names and for the eccentricities of the language.

Thus, it is often insufficient to search only the proposed mark. The searcher must instead create multiple queries or "search terms" for that purpose, all of which are variations on the proposed mark.

The search term must be formulated with the database in mind. Some will automatically provide plurals and even some phonetic equivalents, while others will not. (See Choosing the Database above.)

The following are the most common variations a searcher must consider, together with suggested methods for taking them into account in formulating the search term.

Variations in Prefixes and Suffixes

A search for a common dictionary word like NATION is incomplete without considering plurals, possessives, and derivatives such as NATIONS, NATION'S, NATIONAL, and INTERNATIONAL. The searcher

⁷Care must be taken to use the correct "logical operators" when combining search terms. For instance, many databases (including DIALOG, LEXIS, and WESTLAW) provide several different commands:

AND retrieves the intersection of two search terms. Both terms must appear in the record in order to be produced. Thus, a search of DEATH *AND* TAXES will retrieve only marks in which both words appear.

OR retrieves the union of two search terms. Either term or both terms can be in the record in order to be produced. Thus, a search of TRUTH *OR* DARE will retrieve marks in which only TRUTH appears, in which only DARE appears, or in which both TRUTH and DARE appear.

NOT eliminates a search term from the search results. No records containing the designated search term will be produced. Thus, a search of MARTIN (*NOT* LEWIS) will retrieve all marks in which MARTIN appears except for those in which MARTIN appears with LEWIS.

Other logical operators (e.g., terms such as "PRE/" or "W/") allow the searcher to specify that the words appear within a certain proximity or in a certain order.

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must also recognize that new marks are often coined by adding prefixes and suffixes to ordinary words or by combining ordinary words in new ways (e.g., NATIONSBANK). Using "NATION" as the search term will fail to retrieve many of these variations. Thus, most databases allow the searcher to retrieve variations in suffixes by specifying that the search term appear as a prefix. For example, selecting "NATION!", "NATION?" or "NATION*" in some databases automatically retrieves all marks beginning with those six letters. Some databases also allow the searcher to retrieve all marks in which the search term appears as a suffix or in which it appears anywhere in the word (i.e., as a prefix, suffix, in the middle of the word, or as the entire word).

Whether to formulate the search term as a prefix, a suffix, or a character string embedded anywhere in the mark is a critical choice. Searching for "NATION" as a prefix will retrieve NATIONAL, but will miss INTERNATIONAL. To retrieve INTERNATIONAL, one must enter NATION as an embedded character string (i.e., the letters "NATION" appearing anywhere in the word). Searching for this truncated form of the mark is likely to retrieve more marks than a prefix or suffix command. Whether it is efficient to do so depends on the mark's distinctiveness.

The following exemplifies the wildly varying numbers of "hits" that different search terms yield on a trademark record database:

<i>Searching:</i>	<i>Yields:</i>
NATION alone	500 active marks
NATION alone or as prefix	4,000 active marks
NATION alone, as prefix or as suffix	5,000 active marks
NATION as embedded character string (i.e., alone, prefix, suffix, or embedded in word)	10,000 active marks

Irregular Plural Constructions

Using a prefix as a search term will yield marks with a variety of suffixes, and will therefore retrieve both the singular and plural of most words. But searching for BABY will not retrieve most marks containing BABIES, nor will FOOT yield FEET. Some databases attempt to cross-reference irregular plurals, but others do not. Some allow internal truncation using a "wild card" in the search. (For instance, if a database uses "?" as its wild card symbol, the term "WOM?N" will retrieve both WOMAN

and WOMEN.) If the database does not provide such a feature, the singular and plural forms should be searched as separate search terms.

Corrupted Spellings

The Trademark Register is rife with deliberate misspellings of ordinary words such as "quick" (KWIK, QUIDX, KWIX), "easy" (E-Z, EASI, EZEE), "excel" (EXSEL, X-L, XCELL), and "coat" (COTE, KOTE). Searchers should attempt to compensate for these corrupted spellings by searching such variants, and those who review searches should understand the possibility of undetected spellings. Most databases that are designed specifically for trademark searching attempt to cover corrupted spellings, but they may not succeed with every entry. For example, entering "CHEESE" as a search term will retrieve most, but not all, of the marks in which the word is spelled as CHEEZ.⁸ Similarly, entering SURF into a major database yields such unexpected variations as ZURF, but the terms ZAP and ZAPPA in the same database were not cross-referenced to yield sound-alikes XAP or XAPPA. It is also important to note that while a search of the conventional term may yield the variant spelling, searching the variant usually does not retrieve the commonplace spelling (e.g., searching "CHEEZ" will not also turn up all "CHEESE" marks). Databases which are not designed for trademark searching usually lack both phonetic search capabilities and cross-references of unconventional spellings, and retrieve only the exact word entered. Thus, it is wise to search using deliberate misspellings of the search term in addition to the term itself.

Phonetic Similarities and Word Play

Since similarity in "sight, sound, or meaning" is relevant to confusion, the search should be designed to yield marks which sound like the proposed mark, even if they are spelled quite differently. Thus, the search strategy should employ several variations on the search term if the proposed mark is a pun or play on words (e.g., AQUATYKES/AQUATICS), has one or more homonyms (e.g., iSEA, I SEE, EYE SEE, IC), or contains

⁸Using one major database, the query "CHEEZ" retrieved over 150 records, while the query "CHEES" retrieved 120 "CHEEZ" marks but missed 30. Some of the missing 30 references were irrelevant to food (e.g., STRETCH-BEZ for shoe laces, ACHE-EZE for therapeutic rub), but others were clearly relevant (CHEEZELS for cheese-flavored puffed corn snack, CRUNCHEEZ for dehydrated cheese chips).

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one or more letters which have sound-alike counterparts (e.g., Y/I, PH/F, C/K, C/S, or KN/GN/N). The number of phonetically similar formatives can be especially large when soundlike letters appear in combination (e.g., SIN, SYN, SIM, SYM, CIN, CYN, CIM, and CYM).

Databases which are designed to look for phonetic equivalents are more likely to uncover corrupted spellings, homonyms and phonetic similarities than conventional databases. With conventional databases, the searcher must rely on creativity to include all of the possible "alphabetic strings" which are relevant.

Even phonetic search databases, however, may not retrieve more inventive marks which rely on word play ("1 A CHORD" or "X S R E"). The major databases attempt to cross-reference these types of marks to their standard English equivalents. For example, entering WIZARD and OZ in one major database will turn up such marks as THE WIZARD OF ADS, LIZARD OF OZ, WIZARD OF ODDS, WIZARD OF AHHS, and THE WIZARD OF ID. However, such cross-referencing does not occur with every mark. For example, a search for the term ACCORD on a major database will yield 1 A CHORD, but the search term ACCESSORY will not retrieve X S R E.

Names

Names may have a variety of conventional spellings (e.g., BILLY or BILLIE), not all of which lend themselves to searching by prefix or suffix alone (e.g., KAREN or CARIN). Formal and informal variations on names (e.g., CINDY or CYNTHIA, BILL or WILLIAM) must also be considered.

Abbreviations

Some databases may cross-reference common abbreviations with the complete word (e.g., MOUNTAIN or MT., MISTER or MR.), but less common abbreviations may not be cross-referenced (e.g., S.R.O. or STANDING ROOM ONLY).

Punctuation

Most databases are designed to ignore punctuation for searching purposes (e.g., A.B.C. is the equivalent of ABC). Databases, however, may have different rules concerning how elements of the mark are treated after the punctuation is stripped (A. B. C. may become ABC or A B C, HONKY-TONK may become HONKYTONK or HONKY TONK).

Synonyms

The third part of the "sight, sound or meaning" trilogy is perhaps the most challenging to the searcher. A search revealing no direct hits for TORNADO for fences, but failing to reveal the mark CYCLONE, would be less than complete. See *Hancock v. American Steel & Wire Co.*, 203 F.2d 737 (CCPA 1953). The searcher must consider whether there are any synonyms to the proposed mark and whether to use them as alternate search terms. Thus, a search of the proposed mark iSEA should include such alternate search terms as OCEAN for SEA, and perhaps even the prefix "e" for electronic in place of "i" for Internet. A dictionary or thesaurus is a good source for developing this aspect of the search strategy.

Alternate Spellings and Equivalents in Other Languages

Under the "doctrine of foreign equivalents," words in other languages are translated into English and then tested for descriptiveness, genericness, or likelihood of confusion. Thus, a foreign word may be treated the same as its English equivalent in determining registrability, the need for disclaimer, or confusing similarity with other marks. For example, an application to register the mark BUENOS DIAS for bar soap was refused on the basis of an existing registration of GOOD MORNING, its English equivalent, for shaving cream. See *In re American Safety Razor Co.*, 2 U.S.P.Q.2d 1459 (TTAB 1987). Search databases generally include translations of foreign words that appear in trademark registrations. However, some foreign equivalents have doubtlessly escaped the notice of Trademark Office examining attorneys or search firms and will not appear in the database.

It is also important to check alternate spellings for English language words. For example, a preliminary search of VIRTUAL HARBOR would miss relevant marks unless the searcher also checked for marks containing the non-U.S. spelling HARBOUR. HARBOUR appears in more than 25 records which are not retrieved by searching HARBOR.

Visual Equivalents

A design mark may be considered the equivalent of a word for purposes of determining likelihood of confusion. See, e.g., *Jockey International, Inc. v. Butler*, 3 U.S.P.Q. 2d 1607 (TTAB 1987) (design of a jockey held confusingly similar to the word JOCKEY). If a visual equivalent exists for the proposed mark, or vice versa, counsel should consider using it as an alternate search term. It is possible to search designs on some electronic databases (see Chapters Four and Six).

SEARCHING BY GOODS AND SERVICES

Because many terms appear in hundreds or even thousands of marks, it may defeat the purpose of the preliminary search for the searcher to spend the time and money to review all of them. The searcher can reduce the number of marks retrieved by narrowing the search only to encompass marks for goods or services that compete with or are related to the client's proposed goods or services. The searcher can do this by looking only at marks in a specific "class" of goods or services,⁹ at marks with a specific identification of goods or services, or both.

Searching by class of goods and services can be an efficient way to search, but it is far from foolproof. New applications that have not yet been examined may have been misclassified by the applicant, and classification after examination is not entirely uniform, despite the Trademark Office's efforts.

Searching by identification of goods or services is even less reliable, since such descriptions lack the uniformity and identifiable limits of the international classification system. Part of the problem arises from the fact that the identification is drafted in the first instance by the applicant. Descriptions written by inexperienced pro se applicants can vary wildly—some are clear and precise, others incomprehensible. Those drafted by trademark practitioners tend to be more uniform, but can occasionally be deliberately vague or evasive for strategic reasons (e.g., omitting an apt descriptive term because the term is part of the mark itself, or defining the goods in an intent-to-use application as broadly as possible).

The Trademark Office examining corps tries to bring some consistency and specificity to these identifications. However, the "standard" Trademark Office nomenclature is not necessarily the terminology commonly used in the relevant business or industry, is not always uniformly im-

⁹The Trademark Office classifies all goods and services in 42 different classes, following the International Classification of goods and services used in many countries. The International Classification system was adopted for all applications filed after September 1, 1973. Prior to that time, the United States used its own classification system, and the Trademark Office still includes the U.S. Class in all applications and registrations. On most databases, registrations and applications are listed in both classes. However, searchers must determine whether a search by international class on a particular database includes pre-1973 marks.

posed, and can vary over time as Trademark Office policy changes. For example, the search for iSEA will need to encompass marks for Internet-related products and services, but such marks are not easily found:

- For a considerable time the Trademark Office would not include the word "Internet" in identifications. In most applications and registrations, the phrase "global computer network" appears in its place, but some applications contain variations such as "global communications network".
- The term "chat room" appears in some registrations, but in others the Trademark Office has required that the service be described in less obvious ways, such as "providing online facilities for real-time interaction with other computer users concerning topics of interest".

This compels the searcher to try alternate ways of limiting a search, using a variety of synonyms for the relevant goods and services, and several different classes. The search for a mark for computer software, for example, demonstrates the difficulty of narrowing a search without being too narrow. One might initially limit such a search to International Class 9, but Class 9 also includes many other products besides software (e.g., cameras, eyeglasses, burglar alarms, and stereos). The searcher may need to further narrow the search to exclude those extraneous goods.

However, if the searcher seeks only Class 9 marks whose identification of goods includes the words "computer software," potentially relevant marks can be lost. One reason for this is that the Trademark Office's "standard" definition has changed over time. The term "computer programs" appears in about 40% of trademark records, and "computer software" in about 60%. Moreover, the term "computer software" is inherently too narrow, because confusion could be likely between the same mark used for software and other computer-related products or services.

A possible solution is to search for all marks in Class 9 whose identifications include any form of "comput" (i.e., compute, computer, computing). Even then, some descriptions of computer hardware or software never use the word "computer," and a search in Class 9 will omit related goods and services. Many computer games, for example, are classified with toys in Class 28, and many online services are found in Class 42 ("Miscellaneous Services"). Searching all marks in Class 42, however, will also yield restaurant, retail, catalog, medical and legal services, among oth-

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ers. To avoid irrelevant marks, the searcher might seek only marks in Class 42 with identifications that include "data", "comput", and the various euphemisms for "Internet" described above.

Finally, if the client's proposed software is designed for a particular industry, the searcher should consider searching in classes relevant to that industry. For example, if the mark will be used for financial planning software, marks in Class 36 (Insurance and Financial Services) may also be relevant.

In short, a searcher who uses classes and descriptions to limit a search must do so carefully and creatively to ensure that the search does not omit potentially relevant marks.

DEVISING ALTERNATE STRATEGIES

The search strategy is a combination of variables, each of which influences the others. The searcher will not know whether the best strategy has been chosen until the search unfolds. The key is to evaluate incoming results and adjust the strategy appropriately. For example, if the initial search term turns out to be more common than anticipated, the search can be narrowed by seeking only those marks in a particular class, with a particular identification, with a particular prefix or suffix, or together with another search term. On the other hand, if the initial search term turns out to be more unusual than expected, there may be no need to narrow the search. In fact, it might be prudent to broaden the search instead to include spelling and phonetic variations and synonyms.

Thus, the best overall search strategy is more of a contingency plan than a definitive blueprint. The searcher identifies a range of options rather than a single path. If the first approach is unproductive, the searcher must be prepared to try a different approach which will provide the client with a preliminary picture of the trademark landscape.

EXECUTING THE SEARCH

The following pages present an example of how a preliminary search might play out. Trademarks often contain deliberate misspellings, puns or other linguistic quirks, and the hypothetical mark in this book fits the

bill—iSEA for a children's Internet service, with possible television, multimedia, and merchandising spinoffs.

Most preliminary searches begin with a review of the Federal trademark register. However, since an Internet domain name will be essential for this service, counsel or client will likely have checked the availability of domains such as ISEA.COM, I-SEA.COM, and ISEA.NET. For those domains which are unavailable, counsel should also check any websites associated with those domains to determine if any of them are using ISEA as a trademark in a manner which would conflict with the client's proposed use.

In this case, ISEA.COM is owned by Internet Services Engineering Associates, ISEA.NET is owned by a British company called Ellipsis, and I-SEA.COM is owned by a domain name seller. With this information in hand, the client's next move may be to negotiate the sale of one of these domains.

If the domain name search does not preclude use of the mark, the search can then move to the federal trademark database. The searcher might logically begin by looking for the exact mark in various formatives:

- I and SEA (any mark in which I and SEA appear as individual words)
- I and SEA* (any mark in which the letter I appears by itself and in which SEA appears by itself or as a prefix)
- ISEA (any mark in which the term ISEA appears by itself)
- ISEA* (any mark in which the letter string ISEA appears by itself or as a prefix)
- *ISEA (any mark in which the letter string ISEA appears by itself or as a suffix)
- *ISEA* (any mark in which the letter string ISEA appears by itself or as a prefix, suffix, or embedded character string)

As it turns out, all but the last of these queries yields a manageable number of marks or "hits":

<i>Marks</i>	<i>Search query</i>
5 marks	I and SEA (any mark in which the words I and SEA appear)
18 marks	I and SEA* (any mark in which I appears by itself and SEA appears by itself or as a prefix)
2 marks	ISEA (any mark in which the term ISEA appears by itself)
7 marks	ISEA* (any mark in which the letter string ISEA appears by itself or as a prefix)

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12 marks *ISEA (any mark in which the letter string ISEA appears by itself or as a suffix)

561 marks *ISEA* (any mark in which the letter string ISEA appears by itself or as a prefix, suffix, or embedded character string)

The searcher now reviews all of the marks retrieved by these queries (except the last) and finds nothing that constitutes a direct conflict. Instead, the search reveals marks which appear to be completely unrelated:

ISEA

Pending; Publication/registration review complete

Goods/Services: Association services promoting the interests of education, educational employees, and students in the state of Iowa

Applicant: Iowa State Education Association

ISEA

Registered; Section 8 & 15 accepted & acknowledged

Goods/Services: Association services, namely fostering public awareness of equipment, hazards, and interest in safety.

Registrant: Industrial Safety Equipment Association

I-SEA-U

Pending; Publication/registration review complete; intent-to-use

Goods/Services: Rear view mirror for scuba diving masks

Applicant: Varrichione, Andy

Other marks retrieved are for relevant goods and services, but are not identical:

FREEI-SEARCH

Pending; New Application

Goods/Services: Providing access to local and global computer networks and electronic mail services

First use: December 1998

Applicant: FreeI Networks, Inc.

The searcher may now want to move on to other search alternatives. There are a variety of options:

- Look at marks containing *ISEA* as an embedded character string, but limited to certain classes of goods and services (e.g., 9, 28, 38, or 42) or to certain goods/services descriptions (e.g., "Internet", "children", "global computer").
- Look at variants such as ESEA, E-SEA or IOCEAN.
- Look for exact marks containing soundalikes such as EYE (for I) and SEE or C (for SEA); or

The last of these will turn up marks which hit closer to home:

ISEE

Pending; New Application

Goods/Services: Providing access to local and global computer networks and electronic mail services

First use: December 1998

Applicant: FreeI Networks, Inc.

I SEE YOU

Registered; Intent-to-use application

Goods/Services: Children's book series

Registered: November 5, 1996

First use: January 1996

Registrant: McClanahan Book Company

At this point, counsel may want to bring these marks to the client's attention and, since the marks are in use, investigate them to determine the potential for conflict. Depending on the results of the investigation, counsel may conclude that its client's mark can co-exist, or may suggest certain alternatives to be considered, such as always using ISEA with the AQUATYKES house mark or changing it to "eSEA".

Of course, this preliminary search is far from exhaustive. For example, it would not reveal marks in which SEA or OCEAN appear for the relevant services. However, having brought the preliminary search this far on a trademark database, the searcher may now want to consider looking at several other databases for exact hits. For example, the searcher may want to look for ISEA or I-SEA marks on a database such as NEXIS or DIALOG.

As this example demonstrates, the preliminary search process requires flexibility, imagination and frequent judgment calls. The results sometimes

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raise complex questions that must be resolved before moving, if at all, to the full search.

USING DATABASES FOR COMMON LAW SEARCHING

The same considerations that apply to the selection of a Trademark Office database also apply to Internet search engines, news databases, corporate informational databases, and other databases for common law searching. Since these databases were not expressly designed for trademark searching, even greater care must be given to crafting the search term. In most cases, the databases will not be cross-referenced to retrieve corrupted spellings, irregular spacing or punctuation, or other variations. Some databases like NEXIS do retrieve plurals when the singular is inserted, but others do not. Some allow truncations and retrieval of imbedded character strings and others do not. Narrowing the search may be difficult. Some databases such as NEXIS, WESTLAW, and DIALOG allow the search to be limited to records in which combinations of words appear in a particular order or proximity, but others do not. With the exception of CCH's *Intellicite* and Thomson & Thomson's *SiteComber*, common law searches cannot be narrowed by Trademark Office International Classes of goods and services, although some, such as Dun & Bradstreet, can be limited by SIC code.

Because of all these variations, searchers who move from database to database must carefully keep track of the features and limitations of each in order to formulate a proper search.

COMPARING INTERNET SEARCH TOOLS

For word marks and phrases that are sufficiently distinctive, the Internet can be a useful addition to a searcher's portfolio of preliminary search databases. The cost of searching website content is limited to the searcher's Internet access costs, and many marks appear on the Internet which do not appear in traditional databases. However, the adage "you get what you pay for" applies here—Internet searches may cost little or nothing, but they often fail to yield relevant marks, for several reasons.

First, web searching is very much like looking for a needle in a haystack. Even the most comprehensive search engines cannot come close to covering all websites on the vast and ever-changing Internet. Even if one as-

sumes that anyone can accurately measure their reach, studies show that even the most comprehensive search tools cover a relatively low percentage of all Internet content. Second, the various search engines perform in different ways. The searcher needs to understand how to formulate search queries on each engine in order to use it effectively. Without an understanding of the search engine being used, searching is likely to be scattershot. Finally, Internet websites are littered with metatags and other diversions designed to attract websurfers even though they may have little relevance to the site. These websites may pop up in prime positions on search result listings in lieu of more relevant sites.

Thus, Internet searching appears to be less of a bargain when one factors in the value of the searcher's time spent in pursuing dead-end "hits". Still, if carefully conducted, it can be a useful tool for conducting preliminary searches of coined words and distinctive phrases.

Several different types of Internet search tools are available:

Search engines: Unlike trademark search databases, search engines do not search in "real time". Instead, they utilize the results of past electronic reviews of site content, matching the words in the user's request to the search engine's index of previously-searched content. Search engines provide some of the search features found in trademark databases, often allowing the user to exclude certain terms, and to search combinations of words based on their proximity to one another. Some also allow the searcher to enter a truncated portion of a word to find all words which contain that fragment.

Each search engine has its own quirks, and each is likely to produce different results in response to the same search request. Search engines attempt to determine and rank websites according to their relevance to the search query, using as general factors the location in which, and frequency with which, the requested words appear in the site. However, different engines use different techniques. Some factor the website's popularity (i.e., number of visits by websurfers) into its ranking. Some give extra weight to sites that have the search terms in their metatags. Others, in contrast, will discount a website's importance if the site excessively repeats a particular word in order to boost its ranking. At least one engine even gives priority to websites who pay for it. Because of these variations, one would have to perform separate searches on multiple search engines in order to be absolutely thorough, and then comb through pages and pages of results. This is likely to be inefficient for a preliminary search, which is intended to detect obvious problems quickly and inexpensively.

Metasite search engines: These conduct searches using several search

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engines at once, and provide a time-efficient substitute for searching multiple sites. They do not provide all "hits" from each search engine used; but instead provide the websites ranked highest by the search engines used.

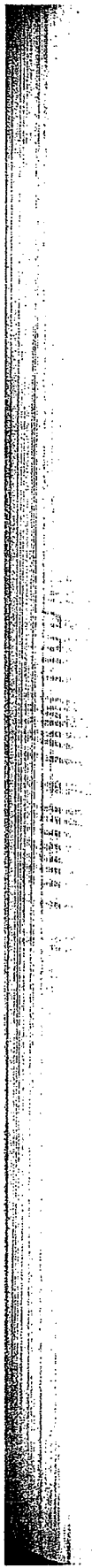
Selective Indexes: Unlike the above-described search engines which electronically read websites, website indexes such as Yahoo! are compiled by individuals who review and categorize websites according to content. Because of this difference, searches may yield fewer, but more relevant, sites. As trademark search tools, indexes are more efficient at finding references to specific companies, and less useful in finding specific product brand names or slogans buried in text.

More detailed comparative information on Internet search tools is available at www.searchenginewatch.com.

Searches of Non-Word Marks

6

- **Designs**
- Colors**
- Animated Marks**
- Sounds**
- Scents**



Searches of Non-Word Marks

Trademarks can incorporate a variety of visual elements, including typefaces, pictures, abstract designs and characters. In addition, the appearance of products, packaging, and buildings can be protected as trade dress. Sounds and scents can also be trademarks.

Such non-word marks pose special problems in searching, since electronic search databases are designed primarily for marks composed of letters, numbers, and other characters. Searches of non-work marks are likely to be inherently less comprehensive, and sometimes less reliable, than searches of word marks, because the search tools available are so much more limited.

DESIGNS

Searches of logotypes, trade dress, and other designs create several challenges. First, searching is essentially limited to designs that appear in federal trademark applications and registrations. At this writing, there are no significant resources of common law designs that lend themselves to searching. Second, search strategies are more difficult to construct, especially for abstract designs, product configurations, and designs that contain several distinct graphic elements.

Designs can ordinarily be searched using either "design phrases" or "design codes." This makes it possible for trademark professionals to conduct design searches using the major search databases, although it can be more time-consuming and frustrating than searching word marks.

Searching with Design Phrases

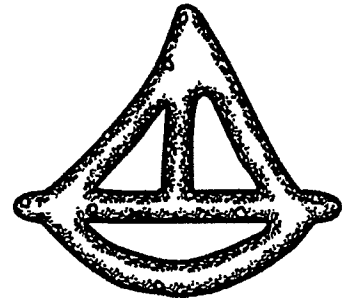
A design phrase is the description of a design trademark which appears in a trademark application or registration. For example, each of

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these marks was registered with a design phrase which describes the design:



"The mark consists of a representation of a man's head with a lighted bomb over his face."



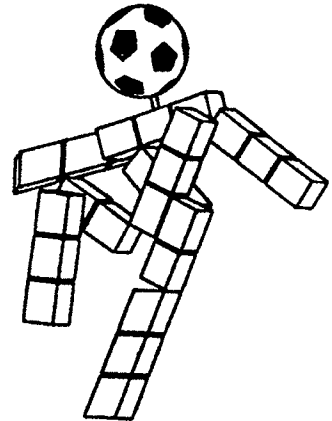
"The mark consists of the configuration of a distinctively shaped pretzel in the form of a sailboat. The pictured particles denote salt particles which are positioned on each of the pretzels randomly."

A design phrase appears in a newly-filed application only if the applicant voluntarily includes it, and appears in a registration only if the examining attorney determines that the design is not obvious. (See 37 CFR §2.35; Trademark Office *Manual of Examining Procedure* §808 (1993).) Whether to require a design phrase is obviously a judgment call for the examining attorney. For example, of the designs following, all of which feature various forms of aquatic life wearing sombreros, only ROCK LOBSTER has a design phrase ("the mark consists in part of a fanciful representation of a lobster wearing a sombrero and glasses):



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Thus, design phrase searching is not very reliable. Even when design phrases appear, the language used in these descriptions is not always consistent or complete. For example, the following mark is registered with a design phrase which neglects to mention that the figure has a soccer ball for a head:



"The mark consists of a stylized representation of a human being."

Searching with Design Codes

Design code searching is a good deal more reliable, but still quite subjective. The Trademark Office classifies each new design mark by assigning it one or more codes using a coding system based on that established by the World Intellectual Property Organization. The Trademark Office provides its coding of each new design to search database vendors. The vendors may either rely on the Trademark Office coding or do their own review and coding for each design. Some vendors have also created their own more detailed code categories to supplement the Trademark Office codes.

Design codes are organized into three levels. The first level is a broad categorization of the nature of the design. There are 31 such categories, ranging from "Celestial Bodies, Natural Phenomena, Geographical Maps" (category 01) to "Other Designs" (category 31). Each of these categories is divided into narrower subsets at the second and third levels. For example, category 03, "Animals," has 13 second-level subsets, including "Parts of Birds; Eggs and Nests" (03.17) and "Prehistoric Animals" (03.25). Each sec-

ond level subset is divided into even more specific third-level subsets. For instance, "Fish, Whales, Seals, Sea Lions" appear in the second level of design codes for animals (03.19), with the following specific types of fish at the third level:

03 ANIMALS

- 03.19 Fish, whales, seals, sea lions
Excluding: Fish and seafood products cooked or prepared for cooking (08.11.06)
- 03.19.01 Sharks
- 03.19.02 Whales
- 03.19.03 Porpoises, dolphins
- 03.19.04 Swordfish, sawfish, sailfish
- 03.19.05 Snake-like fish (eels, etc.), squid, octopi
- 03.19.07 Sea horses
- 03.19.08 Crabs
- 03.19.09 Shrimp, lobsters and crayfish
- 03.19.11 Starfish
- 03.19.12 Clams and other mollusks
Note: Cross-reference with 03.19.18 (Shells) if appropriate.
- 03.19.13 Coral formations
Excluding: Coral reefs (06.03.09); islands, reefs (06.03.02)
- 03.19.14 Seals, sea lions, walruses
- 03.19.15 Schools of fish
- 03.19.16 Tropical fish and fish in aquaria
- 03.19.18 Shells, including sand dollars, nautilus, conch shells and scallop shells
- 03.19.24 Stylized fish in this division
- 03.19.25 Other fish
- 03.19.26 Costumed fish in this division and those with human attributes

A searcher can review a database vendor's code manual and use the design codes as search terms, much as one would search using words. Thus, in a preliminary search for the redesigned Aquatykes mascot (a fish wearing sunglasses and a party hat), the searcher might begin by looking only at a particular category of fish (e.g., "03.19.24/stylized fish" or "03.19.26/costumed fish"), and perhaps even limiting that category of fish to the relevant class or description of goods/services (e.g., goods/services = "global computer network").

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When the mark contains a number of different visual elements, it can be searched using a combination of design codes, which can be more productive than a search using design phrases. For example, the following marks are two very different visual renditions of the same idea. Each has



"The mark consists of a stylized design of a shaded circle containing the silhouette of a walking man carrying a briefcase and talking on a telephone."



"The drawing consists of a person in motion holding a phone."

a design phrase, but the design phrases use completely different terminology to describe the design:

Fortunately, each has been coded with the design codes for humans carrying objects (02.09.13) and telephones (16.01.08). Thus, each would appear in a search for design marks picturing a person holding a telephone.

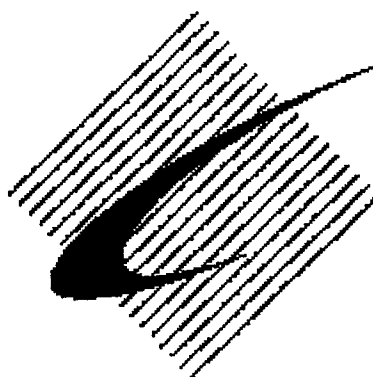
Unfortunately, it is not always true that similar marks will have similar codes. Because each design mark is coded by individuals, the coding is subjective. Some designs are like Rorschach tests—different people see dif-

ferent things in them. For example, the Nike swoosh has been classified under the following design codes:

24.19.15 (check marks) and 24.17.02 (other angles)



However, a similar shape has been classified quite differently:



01.13.25 (astronomic orbits, such as a moon orbiting a planet)

The potential for such inconsistencies will influence a design search for the hypothetical. Aquatykes mascot—a fish wearing a party hat and sunglasses and blowing a party streamer. Even though the client has used it for a number of years on restaurants, it plans to redesign the fish and use it for new Internet-related entertainment services, and a search is advisable.

This search is complicated by the fact that no design codes exist for the key elements in this logo—party hats or party streamers. Therefore, the searcher cannot easily find other marks showing aquatic life in a partying mood. A search using the broadest possible design codes (e.g., all designs incorporating images of animals AND all designs incorporating images of apparel) would certainly locate a large number of irrelevant marks. The better approach would be to narrow the search in one of several ways. The searcher could limit the search to marks which feature both aquatic life

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(03.19 "fish, whales, seals, and sea lions") and hats ("09.05/headwear"). If that produced too many records to be efficiently reviewed, the searcher could try narrowing the search to the third level of design codes, specifying either the particular type of fish (03.19.26 "costumed fish and those with human attributes") or the particular type of hat (09.05.25 "fezzes, turbans, berets, other visorless and brimless hats"), thereby eliminating marks containing such images as "top hats" (09.05.02) and "chefs' hats" (09.05.06).

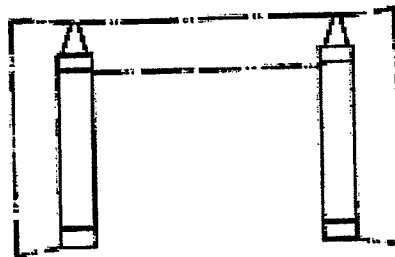
That would not necessarily retrieve fish who are shown wearing sunglasses or blowing party streamers. Thus, the searcher could search using the design code for fish in combination with a code for musical instruments (22.01) or for 16.03.07 (optical and spectacle lenses, including eyeglasses). The search could even be narrowed by using the design codes for all three or four elements—i.e., restricting the search to only those designs which incorporate fish (second level of codes) AND hats (no type specified) AND musical instruments (no type specified) AND eyewear in all classes.

If this approach retrieved very few marks, the searcher could search more broadly, conducting a series of searches looking for fish designs with another element (e.g., particular types of hats, particular types of musical instruments, particular descriptions of goods or services, particular classes of services, or particular design phrases).

Searching Trade Dress

Conducting a search of proposed trade dress poses even greater challenges than searching logotypes. As with designs, the federal trademark register is the only practical search resource, but trade dress registrations are only a small portion of all design registrations. Much protectable trade dress is unregistered, and some trade dress, such as the overall design of a restaurant, is difficult or impossible to depict in a trademark application drawing page.

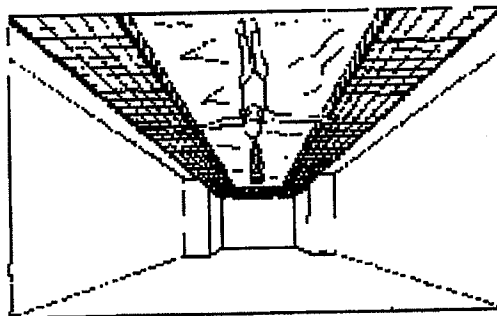
Trade dress applications and registrations sometimes include a design phrase ("the mark consists of the configuration of the packaging for the goods..."), and a searcher could search for the word "configuration" along with other appropriate terms in the design phrase. For example, the following design phrase appears in the registration of the design of an entrance to a candy store:



"The mark consists of the configuration of decorative columns each in the shape of a crayon, located at the entrances to applicant's retail stores."

The registrant has included several words which would be helpful to searchers seeking to clear similar marks—"column", "crayon", "entrances" and "retail".

Unfortunately, not all design phrases are as helpful. The design phrase in the registration of the ceiling design of a Speedo Authentic Fitness retail store merely says:

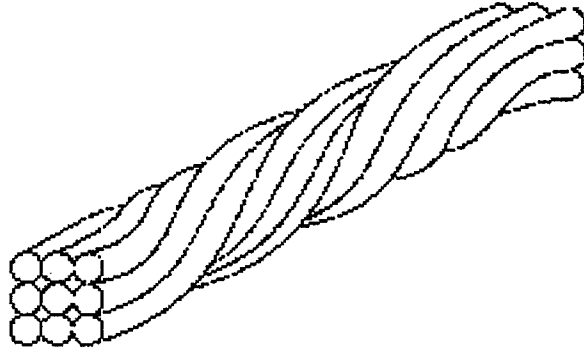


"The mark consists of the configuration of a ceiling design as shown in the drawing."

A searcher might still find this by searching for all marks in the retail services class which contain the word "configuration" in the design phrase. However, there is no mention of the swimming pool or the swimmer mannequins to help those who might be searching similar design elements.

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Even more frustratingly, many trade dress marks contain no design phrase at all, and those that have design phrases often lack the word "configuration" or other easily predictable terminology. The registration of the configuration of Twizzlers licorice has no design phrase, and describes the product merely as "candy":



As a result, the registration has less value in putting others on notice of the registrant's rights, since it is more difficult for others to find it.

Fortunately, each trade dress application receives a design code, as if it were a two-dimensional logo rather than the graphic representation of the shape of the product or the design of its packaging. However, it is difficult to separate trade dress from registered designs generally, since the Trademark Office has not created a separate design code category for trade dress. Thus, a typical search for three-dimensional trade dress will yield many two-dimensional logotypes.

The subjectivity of design coding complicates trade dress searching as it complicates the clearance of two-dimensional designs. This configuration of a cookie, for example, is intended to look like a flower, is sold in trade dress designed to resemble a bouquet, and is coded as a flower (specifically 05.05.05 "daisies, sunflowers, dandelions").



However, a cookie intended to be shaped like a sunburst, or a gear, or an abstract geometric might not look terribly different. The searcher looking for design marks incorporating suns would probably not think to also look for designs incorporating flowers. The problem could be avoided if the Trademark Office required all configuration marks to contain a design phrase indicating that they are configurations, since searchers could then look for all configuration marks for all goods described as cookies, crackers, etc., or all goods in International Classes 29 and 30.

COLORS

A registration will usually indicate if color is claimed as part of a mark. (See T.M.E.P. §807.06.) This information will appear in a design phrase or claims field in a search database. In addition, one can use design codes for searching colors, as follows:

- 29.02 Single color used for the entire goods/services
- 29.03 Single color used on a portion of the goods/services
- 29.04 Single color used on packaging, labels
- 29.05 Multiple colors used on the entire goods/services
- 29.06 Multiple colors used on a portion of the goods/services
- 29.07 Multiple colors used on packaging, labels

Thus, United Parcel Service's registration of the color brown for parcel services, as used on its trucks and uniforms, contains both a claim of color and a design phrase, and has a design code for the color brown: