

TRADEMARK CORNER

Performing Trademark Clearance Searches

In selecting an appropriate trademark, one principal objective is to ensure that the proposed mark is available for use and protectable. One step towards accomplishing this objective is to perform a clearance search in advance. Doing so can minimize the possibility of prematurely investing resources in a brand that might ultimately be precluded by a competitor.

By contrast, failing to perform a clearance search can result in unanticipated claims of trademark infringement or dilution. Such claims have the potential to impose significant monetary damages or even an injunction to stop the launch of a new product or service. Moreover, the failure to perform any search at all could be construed as evidence of bad faith, leading to accusations of willful infringement and exposure to treble damages and attorneys' fees. The decision not to perform a clearance search should be the result of a knowing acceptance of these risks.



Informal Clearance Searches

One or more searches on the free and publicly available on-line database of the U.S. Patent and Trademark Office (USPTO) is good first step. A

proposed mark will be prevented from being registered by both identical and confusingly similar marks. Thus, searches on the USPTO website can reveal whether the same or similar mark has already been registered; whether the same or similar mark was previously registered, but has now been abandoned or canceled; and even whether there is a pending application on the same or similar mark. Generally, the legal test is called **likelihood of confusion**, which applies various factors under substantive trademark law to arrive at a determination as to whether the use of the proposed mark infringes or otherwise conflicts with another, earlier mark.



State and common law databases of trademarks also exist, but are not typically accessible by the public. Moreover, in the case of all on-line databases, text mark searches are relatively easy to perform, while design mark searches are very difficult to perform without the assistance of a trained professional.

Also, because most (but not all) businesses have a web presence, searches should be performed using one or more of the large Internet

search engines (such as Google, Yahoo, or Bing), which can reveal whether someone else may already have a confusingly similar mark in use in commerce for the same or similar goods/services, irrespective of whether that mark has been registered with the USPTO.



Finally, a search on the websites of various registrar companies (such as GoDaddy or Network Solutions) can reveal whether someone else already owns a domain name that may be confusingly similar to the proposed mark.



Formal Clearance Searches

The informal searches described above can give a business some comfort as to whether the mark is “clear.” Practically speaking, however, a comprehensive search of the available resources can only be accomplished by having the search performed by a reputable professional search firm, such as Corsearch or Thompson Compumark.



These firms possess access to a myriad of databases, including ones they themselves maintain, some of which may be industry-specific. Amongst the third-party sources they search

include the USPTO, state trademark offices, corporate name databases, trade directories, and Internet domain name registries. Based upon input from the business or its outside trademark counsel, they can craft tailored searches using sophisticated, proprietary algorithms that produce comprehensive search reports in a variety of different formats. After the search report is prepared, an outside trademark attorney should review the results to ascertain whether the use of the proposed mark infringes or otherwise conflicts with another, earlier mark.

Although the cost to run formal clearance searches is usually not negligible, especially because additional attorney review is needed, the results are, more often than not, more comprehensive than anything that can be obtained through informal searching.

Some Final Thoughts

No matter how comprehensive a search is performed, it is impossible to guarantee complete clearance. There will always exist the possibility that the proposed mark is confusingly similar or even identical to some other mark that just has not been captured in any accessible database or resource. But, as always, the more comprehensive the search, the more comfort a business will have proceeding. Performing a trademark clearance search can be complicated and requires an appreciation of both the applicable trademark law and the business context in which the proposed mark will be used. Consulting an experienced trademark attorney for assistance is often a prudent course of action.

For more information on the Trademarks and Unfair Competition Practice at Fox Horan & Camerini LLP, please contact Theo Cheng at tcheng@foxlex.com or (212) 480-4800.

**Fox Horan &
Camerini LLP**

825 Third Avenue
New York, NY 10022

www.foxhorancamerini.com

An international law firm located in New York City