

# Practitioners' Checklists

## Trademark Clearance Search

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#### **A. Assembling Background Information**

1. \_\_\_\_ Record date of request, contact person and proposed mark.
2. \_\_\_\_ Identify proposed goods/services.
3. \_\_\_\_ Identify proposed International Class(es).
4. \_\_\_\_ Determine nature and form of proposed mark, for example:
  - is it a word mark only, in standard characters?
  - is it a composite word and design mark?
  - should design elements be included in the search? in what colors, or in black and white?
  - will mark be used as a slogan or tagline?
  - will mark be used with other marks? with a house mark?
  - is it a certification mark or collective mark?
5. \_\_\_\_ Determine possible factors affecting nature of mark, for example:
  - any meaning in any other languages?
  - is the mark an acronym, and if yes, for what?
  - any meaning in the relevant industry or trade?
  - geographic significance?

- surname significance?
  - is the mark descriptive of the goods or services, or any function, feature or characteristic of the goods or services?
  - synonyms?
6. \_\_\_\_ Determine nature and extent of expected use on Internet.
- as a domain name?
  - in advertising or marketing the underlying goods and services via the Internet?
7. \_\_\_\_ Identify countries where goods or services bearing the mark will be offered or sold, noting those countries (a) where rights are obtained solely through registration, and (b) where registration of the type of mark (e.g. slogan) may be an issue.
8. \_\_\_\_ Determine all jurisdictions where mark has already been used, if any (states and/or countries), and dates of first use where relevant.

## **B. Conducting Preliminary Screening Search**

1. \_\_\_\_ Conduct online trademark register searches for countries of interest where online searching is available, noting registers searched and parameters of searches (e.g., Classes, specific goods/services, spelling variations, synonyms covered).
2. \_\_\_\_ For each identical or closely similar mark found on each register, itemize mark, application or registration number, owner, Class, goods/services, and status (live or abandoned).
3. \_\_\_\_ Conduct online searches for uses of identical or similar names or marks, noting search engines and search terms used.
4. \_\_\_\_ For each identical or closely similar name or mark found, note search engine used, record name or mark and owner, and print or bookmark page(s) showing uses of name or mark.
5. \_\_\_\_ Conduct searches using online encyclopedias and dictionaries, noting sources searched, and any relevant results.
6. \_\_\_\_ Conduct domain name registration searches for domain name registrations matching the proposed mark, in relevant gTLDs and ccTLDs; search for active websites using registered domain names, and evaluate for possibly conflicting uses.

7. \_\_\_\_ Note any internationally-famous marks found through this preliminary screening process that are identical or closely similar to the proposed mark.
8. \_\_\_\_ Report results (*see* Part E below).

### **C. Instructing Comprehensive or Full Screening Searches**

1. \_\_\_\_ Identify relevant countries.
2. \_\_\_\_ Select research company or local associates in relevant jurisdictions.
3. \_\_\_\_ Provide research company or associates with identification of all goods/services/classes to be searched, including all related to the uses proposed for the mark being searched.
4. \_\_\_\_ Provide research company or associates with known translations of mark (both literal and foreign-language equivalents), and acronym definitions, if applicable.
5. \_\_\_\_ For each search, record date ordered and specific instructions supplied.

### **D. Evaluating Full Search Results**

#### 1. Gauge Proposed Mark

\_\_\_\_ How likely will problems be? Consider:

- How high a profile will the mark have in the industry/market?
- Will the proposed mark serve as a name of a company/division?
- How important will the mark be to sales and marketing?
- Will it be a house mark?
- Will it be a subsidiary mark for an aspect of the goods/services?
- Is there flexibility to consider further distinguishing the proposed mark by adding a distinctive word, design elements, or using the proposed mark with a house mark?

\_\_\_\_ How expensive will it be if problems arise?

- Extensive investment at stake?
- Logistical issues?

2. Review Search Strategy

- Were known third-party marks disclosed in the search?
- Can you identify any spellings or kinds of marks the search strategy may have missed?

3. Initial Review of Search

- Flag all relevant entries (marks, names, domain names, etc., live and dead, registered and not registered) that are sufficiently close in sound/meaning/or appearance for goods/services at all related to proposed goods/services.
- Flag identical marks that may be well-known.
- Double check for a pattern of “abandoned” marks similar to the proposed mark.
- Double check the search to be sure nothing is missed.
- Select marks that warrant special review.

4. Special Review of Marks of Possible Concern

- Check if applied for/registered in jurisdiction(s) of interest.
- Check for problems during application process.
- Consider if mark is famous, unique, or a house mark, so as to be entitled to broader protection.
- Check owners:
  - Deep pockets?
  - Check for any signs that an owner zealously protects against third-party marks, such as by filing oppositions, cancellations

5. In jurisdictions that recognize common law rights, and jurisdictions where there is cancellation for non-use:

- Consider whether goods/services in use appear broader/narrower than those registered (additional investigation may be required -- *see* follow-up investigations below).
- Consider where mark is used, and whether mark is used at all (additional investigation may be required -- *see* follow-up investigations below).
- Consider whether foreign mark may be used in jurisdiction of interest (additional investigation may be required -- *see* follow-up investigations).

- \_\_\_\_\_ Consider if domain name may also be used as mark (additional investigation may be required -- *see* follow-up investigations).
6. \_\_\_\_\_ Report results (*see* part E below).

## **E. Reporting Search Results**

1. \_\_\_\_\_ Consider form of communication:
- \_\_\_\_\_ Do deadlines/other concerns call for an oral report?
- \_\_\_\_\_ Should a written report also be provided?
- Helps insure accurate communication
  - Gives opportunity to provide explanations, attachments, and links where helpful
- \_\_\_\_\_ Consider attorney client privilege – who should receive the report, and what privilege notices should be used?
2. \_\_\_\_\_ Consider elements of advice:
- \_\_\_\_\_ Begin report with conclusion on the level of risk
- \_\_\_\_\_ Note any distinctions between degree of risk of being sued, and risk of losing if sued.
- \_\_\_\_\_ Note any applicable distinctions between risks of registration and risks of use without registration.
- \_\_\_\_\_ Suggest potential adjustments where they may help lower risk, including --
- \_\_\_\_\_ Adding (or avoiding) distinguishing material for use/application of mark:
- House mark
  - Other distinctive term
  - Logos
  - Fonts
  - Trade dress
- \_\_\_\_\_ Adding (or avoiding) the following:

- Particular goods/services
- Particular channels of trade

\_\_\_\_\_ Possibility of making fair use of term descriptively, avoiding all trademark use

\_\_\_\_\_ Explain scope and limitations of search and advice (can be done in a standard memorandum and attached to report).

\_\_\_\_\_ Explain any terms used that the recipient may not understand.

\_\_\_\_\_ Suggest filing one or more trademark applications where that is the recommended course of action, noting possible advantages of securing earliest possible filing date.

\_\_\_\_\_ Suggest potential follow-up investigations where applicable.

## **F. Steps For Potential Follow-Up Investigations**

1. \_\_\_\_\_ Identify third party names and marks for potential investigation in countries that recognize trademark rights arising from use.
2. \_\_\_\_\_ Determine type of investigation, if any, in accordance with all applicable ethical considerations:
  - Internet
  - “in use” investigation performed by research company
  - financial information from Dun & Bradstreet or other financial information vendor
  - discreet private investigator
3. \_\_\_\_\_ Instruct or conduct investigations, if any, noting instructions given/methods used.
4. \_\_\_\_\_ Itemize investigation results, if any:
  - \_\_\_\_\_ Note marks found to be in use, and information available on goods and services used, scope of use (both geographic and sales volumes), dates of first use, channels of trade, types of consumers, other information
  - \_\_\_\_\_ Note marks found not to be in use, including information available on whether mark was ever used and, if so, date use stopped and whether there is any evidence of intent to resume

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