

Trademark Searching

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Q. HOW CAN I TELL IF A MARK OR NAME IS AVAILABLE FOR MY COMPANY TO USE?

The best way to assess mark availability for use and registration is by commissioning a comprehensive search with a review of the search results by an attorney experienced with trademark matters.

1. Searching a state's secretary of state office: Searching *only* a state's secretary of state office or corporate registration office to determine if a name or mark is available is *not sufficient*.

a. In the first place, a state corporate or mark registration office will typically indicate that a name or mark is not available only if there is an exact match between your desired name or mark and what is already registered. To be liable for trademark infringement, an exact match between names or marks is not required, only that the two marks be *confusingly similar*. Hence, being allowed to register your name or mark with a state office tells you almost nothing.

b. Secondly, many states allow multiple companies to use the same fictitious name. So, just because you can register a fictitious name, does not mean that name is actually available for you to use.

2. Searching the USPTO database: One also cannot do a comprehensive search merely by looking at the USPTO database.

a. The USPTO database has a listing of registered marks and applications to register marks. Some companies do not have registrations for their marks. Their marks could be just as strong and protectable as any mark on the USPTO database.

(If you read the information regarding Creation of Trademark Rights, you will recall that: In the U.S. trademark rights arise by using the mark and are only enhanced by registering the mark with the USPTO!)

b. The USPTO database does not tell us what marks are in use, only what are registered. Hence, you might be able to get a registration, however the registration might not be worth anything if there is a company with an unregistered mark that conflicts with your mark.

Thus, that a mark is available for registration is only part of the analysis of whether a mark is available to use.

c. Also, the USPTO database lists marks as live if the mark's last renewal fee was paid. The payment could have been several years ago and the mark could have been since abandoned.

The USPTO considers the registration "alive" because the last renewal fee was paid. That could have been years ago.

Conversely, one may have given up a registration (say for financial difficulty or by forgetting to pay the renewal fee), but is still using the mark.

d. Here are a couple of other points about the USPTO database.

Remember, that a USPTO database search is only a snapshot of what is going on in the USPTO at the time of your search. Relevant applications could come in at any time.

Also, in rare cases, a foreign mark may have rights that can turn back the priority date for the application based upon the marks earlier foreign date. This is rare, but it can happen.

3. Request a comprehensive search: Therefore, the best way to properly assess mark availability for use and registration is by commissioning a comprehensive search with a review of the search results by an attorney experienced with trademark matters.

Doing this search and analysis gives a higher confidence in the choice to use a particular mark. Remember, though, there are no guarantees that a mark is absolutely available in any particular region.

Bottom line: To get a workable confidence level, always request a comprehensive search with attorney review of search results.

It is not an absolute guarantee, but I feel it is the best money a company can spend on legal services.

Don V. Kelly
Evans & Dixon, LLC
Suite 2500
211 North Broadway
St. Louis, Missouri 63102
dkelly@evans-dixon.com