

presents

TRADEMARK OFFICE COMES TO CALIFORNIA

Tips for Effective Searching of Database

Tuesday and Thursday, June 13 & 15, 2023 11:30 a.m. – 12:30 p.m.

MCLE: 1 Hour

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Conference Reference Materials

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UNITED STATES PATENT AND TRADEMARK OFFICE



Tips for effective searching of the trademark database

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Legal disclaimer

- This program is not legal advice.
 - It is for informational purposes only.
 - It does not include all aspects of searching.
 - It only covers general concepts and the mechanics of searching the federal register.



Discussion topics

- TESS basics
- TESS searching
 - Clearance
 - Prosecution
 - Enforcement and disputes
- TESS takeaways



Discussion topic **TESS basics**

TESS basics



United States Patent and Trademark Office

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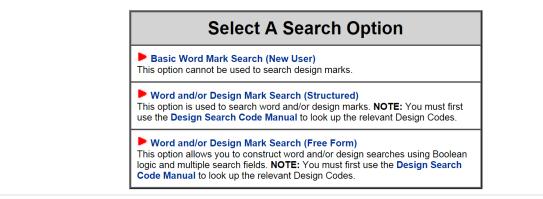
Are you filing electronically through TEAS?

Trademarks > Trademark Electronic Search System (TESS)

Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a **likelihood of confusion** refusal.

WARNING: Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click **TESS TIPS** for detailed information on these and other important search topics.

HELP News!



TESS basics



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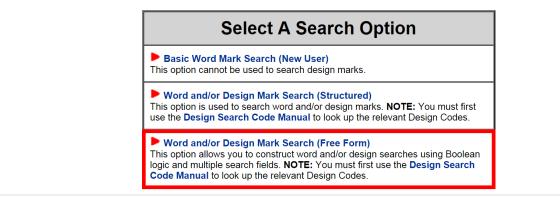


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HELP News!



TESS hypothetical

Your new client wants to register:

TRAFFIC

as a brand name for

beach towels

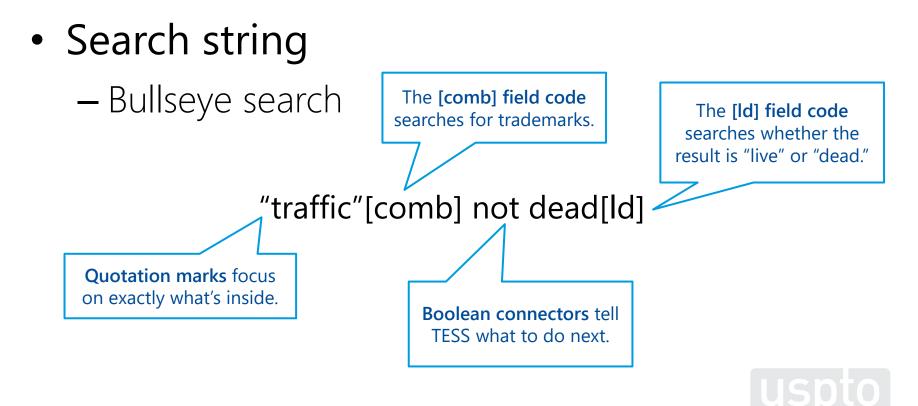


Discussion topic TESS searching: Clearance

- Using TESS as part of clearance search
 - Identify third-party risks to use and registration.
 - Gauge USPTO treatment of the mark.



- Questions that drive the search
 - Before you search:
 - Am I certain of mark appearance and spelling?
 - Do I understand the goods and services including related goods and services?
 - What am I intuitively expecting to find?
 - Do I start with a "bullseye" search? Or work toward it?



- Search string
 - Expanded search

A number ratio tells TESS to look for that range of instances of that character.

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld]

Asterisks search infinitely to that side of the mark.

Pattern matching tells TESS to look for an instance of one of those characters.

Search string

- Expanded search - compare as an alternative -

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld]

(*traff{v}* or *traf*{v} or *traph{v}*)[comb] not dead[ld]

Using OR operator is another way to search spelling variations – but consider parentheses. Removing final sounds can capture variations without pattern matching.

• Questions that drive the search

- As you search:

- What set of marks am I currently viewing?
- Is this a reasonable number of marks to view? Should I narrow? Should I expand?
- What is **not** covered by the present search that I still need to see?



• Search string

- Limit by coordinated class for narrow results

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld] and "024"[cc]

The **[cc] field code** searches coordinated classes – the identified class and those classes with goods and services that are frequently related to the identified class.



https://tmsearch.uspto.gov/webaka/html/help.htm#Coordinated_Class

Search string

- Limit by international class for narrower results

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld] and ("024" "035" "042" a b 200)[ic]

The **[ic] field code class** searches the international class only.

• Search string

- Limit by goods or services for narrowest results

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld]
and ("beach towels")[gs]

The **[gs] field code** searches for that specific good or service only.

This is not recommended.



https://tmsearch.uspto.gov/webaka/html/help.htm#Goods_and_Services

• Search string

- Limit by descriptiveness through disclaimers

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld] not "traffic"[ds]

> The **[ds] field code** searches for disclaimers of descriptive or nonsource indicating wording.



https://tmsearch.uspto.gov/webaka/html/help.htm#Disclaimer

• Search string

- Limit by descriptiveness by register

The **[rg] field code** searches for marks on that particular register only.



https://tmsearch.uspto.gov/webaka/html/help.htm#Register

• Search string

- Limit by descriptiveness by international class

tra{"fp"0:2}{"h"0:1}{v}{"ckqx"}[comb] not dead[ld] not "024"[ic]

The **[ic] field code** searches for marks in that particular class only.



https://tmsearch.uspto.gov/webaka/html/help.htm#International_Class

TESS hypothetical

You receive a likelihood of confusion refusal.

Your trademark

Registered trademark

TRAFFIC

for

beach towels

TRAFFIC

for

surfboards



Discussion topic TESS searching: Prosecution

- Using TESS to gather evidence
 - Argue against refusals.
 - Respond to procedural requirements.



- Arguing against likelihood of confusion
 - As you search:
 - How many marks exist in total?
 - How many marks are registered with reasonably related goods or services?
 - Does the owner of the cited registration have other registrations for the same mark?
 - Do other registrations evidence relatedness?

• Similar mark search

traffic[comb] not dead[ld]

traffic[comb] not dead[ld] and ("024" or "028")[ic]

traffic[comb] not dead[ld] and ("024" and "028")[ic]



Related goods and services search

("024" and "028")[ic] and live[ld] and registrant[on]

("towel" and ("surf board" "surfboard"))[gs] and ("024" and "028")[ic] and live[ld] and registrant[on]

("towel" and ("surf board" "surfboard"))[gs] and ("024" and "028")[ic] and live[ld] and registrant[on] and 1a[cb]

TESS hypothetical

You receive a descriptiveness refusal.

Your trademark

TRAFFIC

for

thermoplastic road marking paints



- Arguing against descriptiveness
 - As you search:
 - Is the wording typically disclaimed for those goods or services?
 - Is the wording typically part of a Section 2(f) acquired distinctiveness claim?
 - How is the wording treated on the Supplemental Register?

• Descriptiveness by disclaimer

"traffic"[ds] not dead[ld] and registrant[on]

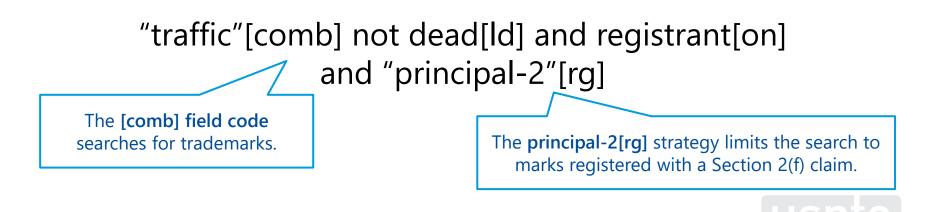
The **[ds] field code** limits the search to marks with that wording disclaimed.

The **registrant[on]** strategy limits the search to registered trademarks.



https://tmsearch.uspto.gov/webaka/html/help.htm#Disclaimer

 Descriptiveness by acquired distinctiveness claim



• Descriptiveness by Supplemental Register

"traffic"[comb] not dead[ld] and registrant[on] and "supplemental"[rg]

The **supplemental[rg]** strategy searches for marks on the Supplemental Register only.



https://tmsearch.uspto.gov/webaka/html/help.htm#Register

• Descriptiveness by goods or services

"traffic"[comb] not dead[ld] and "002"[cc]



https://tmsearch.uspto.gov/webaka/html/help.htm#Coordinated_Class

TESS hypothetical

You receive a requirement to amend the identification of goods.

Your trademark

TRAFFIC

for

paint for model airplanes, model cars and the like



- Arguing against the requirement
 - As you search:
 - Was the wording considered acceptable prior to filing?
 - Does the wording appear in the client's prior registrations?
 - Does the wording appear in the client's competitors' registrations?

• Previously registered identification

"and the like" [gs] and live [ld] and registrant [on]

"and the like"[gs] and "002"[ic] and live[ld] and registrant[on]

"and the like"[gs] and "002"[ic] and live[ld] and registrant[on] and 1a[cb]



TESS hypothetical

You receive a notice of opposition.

Your trademark

Opposer's trademark

TRAFFIC

for

beach towels

TRAFFIC

for

surfboards

Discussion topic

TESS searching: Enforcement and disputes

- Using TESS to gather evidence
 - Gather knowledge of the register.
 - Gather knowledge about competitors and their marks.



- Questions that drive the search
 - As you search:
 - How similar are similarly registered marks?
 - How related are those goods and services?
 - Is there room on the register for coexistence?
 - Is there a history of coexistence in the space?



- Questions that drive the search
 - As you search:
 - What is the claimant's overall portfolio?
 - Does the claimant have multiple registrations for the same mark?
 - What are the statuses of the claimant's marks?
 - Does the claimant have a history of disputing marks?

• Ownership search

"traffic surfboards llc"[on]

"traffic surfboards"[on]

"traffic"[on] and surf\$[on]

The **\$ truncation operator** searches for infinite characters on that side of the wording.



https://tmsearch.uspto.gov/webaka/html/help.htm#Owner_Name

Discussion topic

TESS takeaways

TESS takeaways

• Clearance

- Use TESS to assess risk of registration refusal.

- Prosecution
 - Use TESS to collect best evidence.
- Enforcement and disputes

- Use TESS to remain vigilant.







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