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TRADEMARK OFFICE COMES TO CALIFORNIA

Tips for Effective Searching of Database

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MCLE: 1 Hour

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Conference Reference Materials

UNITED STATES
PATENT AND TRADEMARK OFFICE

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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

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Discussion topic

TESS basics

TESS basics

www.uspto.gov/SearchTrademarks

TESS basics

www.uspto.gov/SearchTrademarks

TESS hypothetical

Your new client wants to register:

TRAFFIC

as a brand name for

beach towels

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TESS searching: Clearance

Clearance

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

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Clearance

- 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?

Clearance

- Search string
  - Bullseye search

The **[comb] field code** searches for trademarks.

The **[ld] field code** searches whether the result is "live" or "dead."

"traffic"[comb] not dead[ld]

Quotation marks focus on exactly what's inside.

Boolean connectors tell TESS what to do next.

Clearance

- 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.

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Clearance

- 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.

Clearance

- 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?

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Clearance

- ## 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

Clearance

- 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.

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

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Clearance

- 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

Clearance

- ## 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 non-source indicating wording.

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

Clearance

- Search string
  - Limit by descriptiveness by register

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

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

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

Clearance

- 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   TRAFFIC

for   for

beach towels   surfboards

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TESS searching: Prosecution

Prosecution

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

Prosecution

- 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?

Prosecution

- 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]

Prosecution

- 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

Prosecution

- 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?

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Prosecution

- 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

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Prosecution

- Descriptiveness by acquired distinctiveness claim

"traffic"[comb] not dead[ld] and registrant[on] and "principal-2"[rg]

The **[comb] field code** searches for trademarks.

The **principal-2[rg]** strategy limits the search to marks registered with a Section 2(f) claim.

Prosecution

- 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

Prosecution

- 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

Prosecution

- 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?

Prosecution

- 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   TRAFFIC

for   for

beach towels   surfboards

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TESS searching: Enforcement and disputes

Enforcement and disputes

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

Enforcement and disputes

- 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?

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Enforcement and disputes

- 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?

Enforcement and disputes

- 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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Questions?

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