



HOW TO READ
A TRADEMARK
RESEARCH
REPORT

IN PLAIN ENGLISH

HOW TO READ A TRADEMARK RESEARCH REPORT

IN PLAIN ENGLISH

Legal Disclaimer:

We are not lawyers and this information does not constitute legal advice. The writers of this document have over 10 years experience in the "Trademark Search" field and although they go to great lengths to make sure the information is accurate and useful, we recommend you consult a lawyer if you want professional assurance that our information, and your interpretation of it, is both correct and appropriate to your particular situation. The information contained in this document is provided to you "AS IS". We make no claims, promises or guarantees about the accuracy, completeness, or adequacy of the information contained in this document.

Created By:

Creative Trademark Services

a div. Of Botown Inc.
370 w. Pleasantview Ave. #300
Hackensack, NJ 07601

www.TrademarkSearch.Legal

info@TrademarkSearch.Legal
info@CreativeTrademark.com

© 2016 - All Rights Reserved

No part of this report may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, be they electronic, mechanical, photocopy, recording, or otherwise, without the prior expressed written permission of Creative Trademark Services, except in the case of brief quotations embodied in critical articles or reviews.

Congratulations on taking the first step to securing your trademark or Service Mark by purchasing a Comprehensive Trademark Search.

The name of your business, product or slogan is one of your most valuable assets, and today you are taking the first steps to protecting it.

Whether you are starting a new business, or have been conducting business for years, every time you advertise your name, receive word of mouth advertising or use your name in the course of doing business, you are investing in that name.

If you are reading this and have NOT already purchased a search, remember:

Before you spend time and money investing in your business, you should make absolutely sure that your name is not already owned by someone else and that it is available for your use. Protecting that name may very well be the most important business decision you ever make.

Having a name search conducted will not only help you decide if your name is available, but will let you look at any conflicting names that may already exist.

Attorney's all over the Country know that www.TrademarkSearch.Legal brings you the highest quality searches for the lowest possible prices and you can purchase that very same research yourself by visiting www.TrademarkSearch.Legal.

Why do you even want to get a trademark search to read?

To find out:

- If someone else is already using this name and it doesn't belong to you.
- If someone else IS using this name, or a similar one, but they are doing something completely different then you are.
- What are my chances of someone else suing me if I use this name?
- If your name can be Registered as a US Trademark/Service Mark with the United States Patent & Trademark Office or "USPTO" If you so choose.

This is a process of assessing your risk because, believe it or not, Trademark law says that an owner of a trademark or Service Mark is whoever uses it first in commerce.

Notice it doesn't say ANYTHING about the owner being someone who "registered" the mark.

This is important so let me repeat this.

The true owner of a trademark or Service Mark is NOT necessarily the person who registers and receives a trademark/Service Mark registration from the government.

That would be far too simple!

What's commonly thought of as a "trademark" is actually, "Trademark **Registration**" which is just the government registering that you have laid claim to the name. This doesn't mean someone can't sue you, actually, **anyone, can sue anyone, for anything, in this great Country of ours**, and you need to remember that as we go on.

Sometimes even though you may think a name looks fine, you may be making a mistake registering it because it has a high chance of bringing on a lawsuit. For example, if you call your new brand of auto, a "McCar", you can bet you'll be hearing from your friends at McDonalds.

I know this sounds a little crazy, but it's true and it brings up a HUGE can of worms. Since there is no list or database or final say on who owns a name, there is also no 100% way to ever know for sure if you own the name you are using. No lawyer can make this claim, no agency.

Here is an Example of what I'm talking about:

Let's say you have a company called "House Eaters". This company let's thousands of termites loose in your home, which then eat all the wood and make demolition a snap!

Ok, you probably won't make a lot of money with this business, but let's say that's your name. You decide you don't want to do a search and you just apply for a Federal Service Mark on the name. The government looks in their own Federal records, sees no one using that name or anything close and awards you the registration on the name.

You go merrily along, investing in signs, posters, letterhead, business cards and other marketing materials and begin your business. Things are going well and you've made quite a few sales when suddenly a registered letter comes with a cease-and-desist demand, warning you that you can no longer use your name!

It seems that a huge conglomerate has been using the name for 15 years and claims ownership. You write back a smug letter telling them you have the trademark registration and the name is rightfully yours. They reply "See you in court".

Unfortunately "you" are in trouble. They have never registered the name with the government so it was no where to be found when the USPTO was deciding if they should award you a registration.

However, they predate your use significantly and worse have all the money in the world to keep you in court for years and bleed you dry.

Technically, by letter of the law, EVEN THOUGH YOU HAVE THE TRADEMARK REGISTRATION, YOU DON'T OWN THE NAME!

Wait... you mean the government is only going to look in their own records to decide whether or not to award me a trademark/Service Mark?

YEP!!

They don't check State marks or Common Law???

NOPE!

Believe it or not, the government says...

"It's not our problem to look around, that's your job."

Since they don't look at state or common law, the government will give you a trademark "registration", even if there is an existing state mark or even if the name has been used so regularly in commerce that it's the first result in a Google search.

Even if you rightfully do own your name, it could cost thousands of dollars in court costs trying to defend yourself and months if not years of your valuable time!

This makes it very scary for the little guy, as he can be unlucky and be sued by some large Corporation with mega bucks and just not have the resources to fight such a situation. If you are unlucky enough to go to court, it often winds up being a case of whose lawyer can beat up whose lawyer, and in that case, the little guy rarely wins. **That's why the best way to handle the situation is to try to AVOID it all together**

So many years ago, lawyers got together and said, "We need some sort of industry standard due diligence. Something that:

1. Did a really thorough job of "looking around" to see if anyone else was using a name.
2. Could show that their client tried their best to find out if anyone else was using this name. (Due Diligence)

From this concept comes what is now currently known as a "**Full & Comprehensive Trademark Search.**" Such a search can include more, but lawyers demand that it at least include:

1. **Federal** - Looking through all the names already registered, applied for, abandoned, expired and even cancelled in the federal records.
2. **State** - Looking through the files of each of the 50 states and US territories.
3. **Common Law** - Endeavoring to find people using a name that have not ever registered it with the federal or a state agency.

Remember, as we said before, **just doing business with a name technically gives you ownership of that name**, so there has to be some attempt to find people who are using the name, or you really won't know if someone is going to come by and sue you.

So that's why almost all attorneys do a 3rd party, industry standard, due diligence search. This is so they are at least doing the best they can to protect you.

Wow... so don't I need an attorney to do this?

I always answer this question like this:

If you can afford it then OF COURSE YOU SHOULD USE AN ATTORNEY! If you can afford it, you'd be foolish not to.

However, many of you reading this report do not have thousands of dollars to spend every time you come up with a new business name, add a new product, or create a slogan.

The DIRTY LITTLE SECRET about trademark searching is that, most of the time, what you pay an attorney to do can be done yourself.

So let's go over the three basic steps that an attorney does when you hire them to protect you.

1. **Do the industry standard due diligence, Full Comprehensive Trademark Search.** If you have not already, visit www.TrademarkSearch.Legal to get yours.
2. **Form an "opinion" on the search** and give you their professional opinion/best guess on the likelihood someone might sue you.
3. **Fill out the paperwork and apply for the mark** at www.USPTO.gov, if you so choose.

Step 1: Do an Industry Standard Search - Since the first thing most attorneys will do is to buy a standard trademark search, we think that should be your first step as well. The good news is that you can **buy the EXACT same search that they do.**

If you buy a Trademark Search it is CRUCIAL that you buy a search from a reputable company that does consistent work with attorneys. Why?

First and foremost, **the Trademark Search Industry is completely unregulated** and NO ONE, not even the largest companies, guarantee their work is complete.

In fairness, it would be almost impossible to do so, since the information supplied to them could be incomplete, but every company sells their search "as is". So it's very important you work with someone who has a good reputation and actively does work for attorneys.

Attorneys demand certain types of information, from certain sources, with specific parameters. So not only will you be getting a highly accurate and complete research report, but maybe more importantly, you guarantee that you will **ALWAYS SAVE AT LEAST SOME MONEY AND PROBABLY A LOT OF IT**, when going through this process.

To explain why that is, let's look more closely at the second step:

Step 2: Form an opinion on the search - Your attorney will purchase a search from a reputable company like www.TrademarkSearch.Legal and read it over. They will then decide what the likelihood is that someone might feel you are infringing upon their mark and take legal action against you. They will assess and advise you of the risk.

Remember, there is no foolproof way to do this, so no attorney can tell you the answer for sure. Again, anyone can sue anyone. Your attorney is giving you their best guess, albeit an educated one (at least we hope... more on that below).

You can also purchase that very same search, at the wholesale price your attorney would have purchased it for. Armed with the information in this report and some common sense, a reasonably intelligent individual can come pretty close to duplicating what an attorney would do for you in a majority of the cases.

In a group of searches, quite a few will be easily determined. The name will either very obviously taken or very obviously available. Then there will be a large portion where you'll be able to use the information in this report to make a very solid decision.

For the small amount of cases where you might feel uncomfortable and "in over your head", you can ALWAYS just bring the search to an attorney and pay them to "make an opinion" on the search.

Attorneys would rather you don't know this. They want to sell you their complete package so they make more money. There is nothing wrong with that, using an attorney is very convenient, but it costs a lot of money.

Often what this really means is that **you are going to pay a lot of money because you don't understand what's involved.** As noted above, in the majority of situations, all they have to do is read the search and apply the information that you'll receive in this report and give you their opinion.

Many times, the attorney has NO EXPERIENCE AT ALL with trademarks.

I'll tell you a little secret... you wouldn't believe how many attorneys have asked MY advice over the years.

"So, is this name available?"

Sometimes they'll even ask me...

"Should my client register it?"

Armed with this report you will actually know a LOT MORE than quite a few of the attorneys you might hire.

IF YOU ARE GOING TO HIRE AN ATTORNEY, make sure you hire one who has trademark EXPERIENCE. **There are some brilliant attorneys out there who know trademark law inside and out.** Use one of them, because if not, you are paying mostly for their common sense vs. your common sense. I don't know about you, but I find a lot of people, (and attorneys are just people, after all) who do not have a lot of common sense.

Step 3: Fill out the paperwork and apply for trademark registration - Federal registration is not "required" to establish rights to a trademark. Common law rights arise from actual use of a mark. Generally, the first to either use a mark in commerce or file an "intent to use" application with the Patent and Trademark Office has the ultimate right to use and register a mark.

HOWEVER, registering your mark with the USPTO is a powerful way to help you protect your name and there are many other benefits of federal trademark registration.

Most attorneys will urge you to register the mark, and we strongly agree with that. It is extremely powerful, so if you can afford to do it... DO IT.

But, remember that you don't need to do it through an attorney or pay for an expensive "all inclusive" package that they may offer you. Even though it's a little bit more mysterious, filling out the paperwork and applying for a Trademark/Service Mark yourself is, in many ways, even easier than reading a search report.

Again, let me stress, when registering a mark, **IF YOU CAN AFFORD AN ATTORNEY, we always recommend you use one.**

The funny thing about having an attorney, or especially some of the paralegal companies that provide this service, is that they will need to ask you every single exact question on the form, so they can fill it out for you. I don't know about you, but this seems like a lot of double work to me, and I'm paying for it no less.

Really, it's not that hard to do it yourself and when you inevitably don't fill it out perfectly, I promise that the government won't send the black helicopters for you. They'll just politely tell you, "that they suggest you change this" or "you have to do this".

Also, we do **sell a course that teaches you, step-by-step, how to do this yourself if you want additional help.**

What are you looking for when you read a search?

When you are reading a trademark search, your goal is to figure out if any of the names you find, when combined with their use, is so similar to your name and use that it would reasonably cause a **"Likelihood of Confusion to the General Public"**.

Ohhhhhh... well that's easy.... Wait... what is a "likelihood of confusion to the general who"?

Basically, **"You can't trick someone into buying YOUR stuff, when they might mistake it for SOMEONE ELSE'S stuff!"**

Whether it was your intention or not, you can't trick someone into buying your stuff. It's just not fair, (or legal for that matter) for one company to work hard at developing a reputation and a familiarity with people and then for someone else to come along and ride on their coat tails for free.

If I'm the ABC Bread Company and I have bread stores all over the country and someone else says, "let me open the ABC Bread Consortium", that's not going to work. It's obvious that a lot of people would just see the sign and think it said "ABC Bread Company" or assume that you are owned or in partnership with them. This is called "infringement".

So what's considered "tricking someone," or infringing?

Unfortunately, there is no definite answer to this question. What we can tell you is what is taken into consideration by the courts and the USPTO.

1. **Are the names "exactly" the same or just similar?** - The USPTO and courts are not stupid, so adding a "the" or just making the name plural is almost never going to work. But, the more you can do to make the two names different, the better.

This also depends on what the goods are. If you sell aardvarks, and your name is "Best Aardvarks", then adding "John's Best Aardvarks" or "Super Best Aardvarks" is probably not going to help since there are so few Aardvark companies, there is a very likely chance of confusion with something that close. However, if you are a band, very similar names are often allowed to co-exist because, over the years, there have been so MANY bands and musical groups, the public has become more used to the possibility that band names are often similar. Hence, there is LESS chance of something close being confusing to the public.

2. **Are they in the same international class?** - Check the Appendix in the back of this report and you'll find a listing of all the "International Classes". These were created to try to group together things that were marketed to the same people, distributed similar ways, etc.

If you find that your name is in the same group as one in the search report, that's not good, but maybe not fatal. There are some obvious exceptions to the rule, as these groupings are far from perfect and some things are obviously not in conflict even when they are in the same use group. Conversely, just because you are in a different group, it doesn't mean that you are definitely safe! Scrutinize everything! Remember, it still boils down simply to, "**would the average person confuse these two things?**"

3. **Are the names promoting the same type of product to the same audience?** - This is really very similar to #2 but without the International Classes to guide you. Use your own common sense, as the International Classes are a very inexact science. Is this being marketed to the same audience? Is it pretty much the same type of product?
4. **Is your name the same or close to a very well known name?** - If you are unlucky enough to have picked a name that is the same as some huge company or a really famous brand, it often doesn't matter if you are in the same use category or not. Why? Because:

You can expect that the company has the resources to make your life completely miserable and, they will. Large corporations monitor all trademark applications like a hawk, and they will object to any name that's close to theirs whether it's in the same use or not.

There is actually a special provision for this type of company called the "right of expansion." Simply put, this means that once a big company has moved into using their name on multiple products, they are given a lot of leeway as to where they might expand next. Some companies have businesses so diverse that it's almost impossible for anyone else to use that name for almost anything else, since it's possible and reasonable that they might expand to almost anything. *Bottom line: If your name is the same as a famous company with almost any use, you are playing with fire. Probably best to find another name.*

Let's have a little Reality Check

When in doubt, find a new name or make it different enough so it's not confusing! AND never forget these 2 crucial points:

1. ANYONE CAN SUE ANYONE IN THIS COUNTRY.
2. IT COSTS A LOT OF MONEY TO DEFEND A LAWSUIT.

If you are reading this, chances are you don't have the budget to survive a big lawsuit. Otherwise, your expensive lawyer would be handling this for you.

Viewing the Report

Each company's report is slightly different, but if you purchased a search from us at TrademarkSearch.Legal, the first several pages included in your search report are the Alphabetical Listing Section. This is an alphabetical listing of Trademarks and Service Marks similar to your proposed mark that were found in the Federal Record.

Next is the Detail Section. In these sections there are two categories; Federal Trademarks and State Trademarks. These areas will contain the detailed information of trademarks and services marks that we retrieve that are the most similar to your proposed mark. These may include marks in all International classes of goods and services and is broken down in list format by status.

International class is just a phrase used by the USPTO to try to link similar businesses together, to further assess the likelihood of confusion. This has nothing to do with protection internationally. If the name you want is already used by someone, and they are in the same class as you, there is a very good possibility that you won't be able to coexist. There are some situations where two different entities in the same class don't happen to interfere, but since the whole reason of having these classes is to find conflict, this should raise a very big red flag.

The Common Law Section is the third section contained in the report. This section includes the similar company names currently conducting business in the United States, but do not necessarily have a Trademark and/or Service Mark on their name.

Once you conduct business in interstate commerce, which is over state lines, you have technically established common law rights. This gives you limited rights to that name in the geographic area in which the mark is used, even though there is no registered state or federal trademark.

With the internet, things have changed drastically. Now, anyone with a website is really doing "interstate commerce". This makes it pretty easy for someone who wants trademark protection to claim Federal/Nationwide Common Law Rights.

Once a domain name is in use, this also constitutes as common law rights. We provide a basic domain search in our Common Law Section. We check all common extensions, to provide you with domain name availability. This will also show you detailed ownership information for any registered domain names found.

Remember, just because you find someone has your domain name, it does NOT mean you are prohibited from using the name, for a couple of reasons.

1. They may be using the name for a completely different use.
2. They may be sitting on the domain name and not using it in commerce at all. If you see a domain that is only registered, but no real website is up conducting business, then that domain, by itself, is NOT acquiring any Common Law Rights for that mark. They may be acquiring rights to the name some other way, but if they aren't, and you started using the name that day, then you would technically predate them even though they may have registered it first.

They have to USE the name in commerce for it to matter!

Also included in the Common Law Section is the World Wide Web Search. The web sites are retrieved for the domain names that came back as registered in the domain name section. This web search also includes additional web sites found that have the same or similar names as your proposed mark, who may have established common law rights to the name.

The government does not check for common law rights to a name when determining eligibility for a trademark. Unfortunately, if someone already has common law rights to this name, and has established the name longer than you have, they have the right to oppose your registration of the trademark and ultimately block you from using it. If they do not find out about you until after you have received a trademark, they can sue you and potentially stop you from using your name.

Let's hear from our research department and let them give you some of their insight.

Warning: It's a little bit "legal-eezy," but important stuff if you can follow it.

When applying for a Federal Trademark, the government will conduct their own screening process to determine if a mark is eligible for trademark registration. There are several reasons an application for trademark registration can be rejected.

Name Conflict

The most common reason for an application to be rejected is because there is a potential name conflict. For the US Patent and Trademark Office to determine a conflict, the marks need not be identical and the goods and services do not have to be the same. They determine whether there would be likelihood of confusion, that is, whether relevant consumers would be likely to associate the goods or services of one party with those of another party. The principal factors considered are the similarity of the marks and the relationship between the goods and services identified by the marks.

To determine the likelihood of confusion, the USPTO will evaluate several factors. No one factor is determinative in and of itself and how important one factor is over another is very case specific. The factors are:

1. **Whether or not the goods and/or services using the same mark compete** with one another. Marks that are used on similar or related goods or services are more likely to confuse consumers as to the source of those goods or services. Even when the products are not exactly similar, the court may, in some cases, consider how likely the plaintiff is in the future to sell similar products.
2. **Whether or not the goods and/or services are so closely** related that they are being marketed through the same stores or channels of distribution.
3. **Whether or not the proposed mark is intended to maliciously** lead consumers to believe their products are those of another's.
4. **Whether the marks are similar in sound, appearance or meaning.**
5. **Whether or not the businesses have an overlapping customer base.** If both businesses market goods and/or services to the same industry, there is more likely to be consumer confusion.
6. **The legal power of each of the marks.** The greater the consumer recognition of a mark as a source identifier, the more likely that similar uses will be considered confusing.

The reason for the many restrictions and regulations is that trademark law is not as much about protecting business interests as it is in protecting consumers.

There are several other statutory reasons for a trademark to be rejected for registration by the USPTO.

It is required by the U.S. Patent and Trademark Office that all marks must be considered to be distinctive. A mark may be denied if it is thought to be generic, primarily descriptive or ornamental.

Generic marks

Marks that are words that describe a product or service itself as a category, rather than distinguishing between competing versions of the product or service are considered generic. Generic words are not protected as trademarks specifically because to do so would be granting a monopoly in the product itself, not in a word or symbol. *An example of a generic mark is “Spring Water”, for a type of water beverage.*

Descriptive and Deceptively Misdescriptive

Trademarks that describe the ingredients, qualities, features, function or characteristics of a product or service are considered to be descriptive, and will be denied registration by the examining attorney. A mark will also be denied if the primary significance of the mark is geographically descriptive and/or primarily geographically deceptively misdescriptive. *An example of a descriptive mark is “15 Minute Oil Change”, for an oil change service.*

Primarily a Surname

The examining attorney may refuse registration of a mark if the primary significance to the purchasing public is merely a surname. *An example of this type of mark is “Smith’s”, for a bakery.*

Ornamental

The USPTO attorney will deny a registration if the proposed mark is merely a decorative feature or part of the appearance of the goods. This ornamentation does not serve the trademark function of identifying and distinguishing the applicant's goods from those of others. *An example of an ornamental mark is “Flowery Shirt” for a clothing with a flower motif.*

Again, the goals of a trademark are to associate your goods and/or services with a specific level of quality and to differentiate those goods and/or services from those of others' goods and services. Trademarks that meet these requirements are not generally generic or descriptive, and are considered to be either suggestive, arbitrary or fanciful marks.

Thank you good people of our research department. You guys are the best in the biz!

The realities of a search

Now that you've learned all the specifics of how to read a trademark search report, and the letter of the law, I'm going to tell you a few more important things so don't stop reading now!

If a close friend asked my personal advice, these are some important facts I'd point out.

If you haven't started using your name yet and you find anything you even think MIGHT cause confusion in the federal part of the search, then it's probably wise to just choose another name.

Why would you want to take the chance?

You have nothing invested in that name yet, so move on to another name. Never is this more important than if the company that owns the name that is close to yours is a HUGE, WELL FUNDED COMPANY.

Remember, even if they are wrong and you would win your case if you go to court, you will have to be able to afford to fight them. So, if it's even close, I strongly advise that you find a new one or at least change the name enough to avoid confusion.

I can hear all of you already making plans to be cute and just add a plural, different spelling or words like "the", "and", etc. That won't help!

Remember, the letter of the law is "likelihood of confusion." I promise that if you start a shoe company called "Knikey", you will be sued by "Nike". If you start a food company called "The McDonalds", it's the same thing as calling it "McDonalds."

This goes for even a much smaller company with limited resources too. Probably most importantly, the USPTO would never give you the registration on a name with that little difference.

You'd waste your time, waste your money (since the registration fee is not refundable) and then get sued! Loads of fun... eh?

One effective thing you can do is to add another word or name that might help make your name different enough to coexist. So, going back to our earlier example; if you do a search and find that there already is a company with the name "House Eaters," try changing it. Maybe call it "Colonial House Eaters" or "House Chewing Demolition."

This is NOT a fool proof method to keep you from getting sued if the company finds out you are using a similar name and thinks you are infringing, but, it helps to give you a much better chance of receiving the registration from the USPTO and then you BOTH would have a trademark on your respective names.

Even though it's still debatable whether or not the names are confusing to the general public, only if you are VERY unlucky and you come up against a company with a LOT of money to burn will someone be likely to take suit against a name that has been scrutinized against an existing mark and one the USPTO has decided they can coexist. Again, I promise you that if you start a shoe company called "Bob's Nike's," you are getting sued!

This is especially important when you find a similar name in the common law and state reports.

Let's say you search the name "House Eaters" and find a direct match in the common law report in Florida. You do some checking on the internet and you find out that they seem to have a business that does pretty much the same thing you want to do, up in NYC, but they never bothered to register the name.

Remember, the government is not going to see any information from state or common law, so as long as the same name or something confusingly similar doesn't show up in the Federal search you can be pretty sure you will be awarded the trademark registration on that name.

Even though you already know, **by the letter of the law, this company in Florida may already own the name and you don't** unless you predate them and can prove it.

Some people will really take a big chance and think; "these people are going to be more scared of me because I'll have the trademark," and in many cases they will be right.

Many small companies choose to not register their name but technically still own their name via common law. If another company, (company "B") comes along and registers that name federally, small company "A" probably will never know until after company "B" is awarded the registration.

Most of the time in this situation, company "A" will never even know this or if they do, they will do nothing and just hope that the now federally registered company "B" will leave **them** alone. Even though they technically own the name, they will be afraid that by opening a can of worms, they may lose the name due to not having the financial resources/time/stomach, to take them to court.

That would be very risky however, because you would be investing into a name that you already know you technically don't own.

What is a good idea is to change your name slightly to something else. Perhaps, "Premiere House Eaters," or something like that. Technically, if brought to court, you may still be found infringing, but a huge amount of effort would have to have been taken by someone who didn't even bother to register their trademark in the first place, vs. a name that isn't even exactly the same. Unless you are really unlucky, you would probably coexist peacefully.

Also, remember that even if you find someone in the Common Law or State sections, that doesn't automatically mean that they can even claim Common Law Rights! They need to be actively using it in interstate commerce. You may find a website that only has a "coming soon" page or has been up for 6 years and has never been changed, or a company in the State search that is only in Nevada.

You have to do your homework here!

Call the number from the website or call the company found in the State search. Are they still using that name? Are they out of business or barely selling anything anywhere and not across state lines? There is a good possibility that they are no longer eligible for federal protection.

What if you are already using a name and you've never bothered to look and see if you are infringing until now?

If you find a match or close match in the Federal Section, some people actually try to use federal registration as a way to coexist, almost as a defensive maneuver. If you were starting with a new name, you would ordinarily be better off just picking a new one, but in this case you have certain rights to the name by having used it, and so will the people you find in the search.

If you each have different uses, then just apply for the mark and hope that you will be awarded the mark. But if you realize that you probably conflict and that they definitely predate you, many times people will try to make a small change, as we mentioned above, and then apply for the slightly different mark.

Either way, the hope here is that the USPTO agrees with you and awards you the registration. At least this way you have a lot less chance of being sued or getting a cease and desist letter from the registered owner, if you yourself, also have the name or a similar name registered.

If you are denied registration, you can just continue to use the name with the same amount of risk as you had before. The USPTO is not the "name police." They won't go and tell the existing owner and they probably won't know you that tried to register the mark, (unless they subscribe to a trademark alert service, which wouldn't be that often).

If you find a name that is the same or similar in the State or Common Law Section, often people will apply for the mark no matter what, and will receive it, since the person does not have anything registered in the federal records. This way, since you have the mark, they would have to sue you, even if they did predate you. This is not recommended, but it is a tactic we see people use.

Appendix

International Schedule of Classes of Goods and Services

Goods

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5. Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; nonelectric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.
8. Hand tools and implements (hand-operated); cutlery; side arms; razors.

9. Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus.
10. Surgical, medical, dental, and veterinary apparatus and instruments, artificial limbs, eyes, and teeth; orthopedic articles; suture materials.
11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes.
12. Vehicles; apparatus for locomotion by land, air, or water.
13. Firearms; ammunition and projectiles; explosives; fireworks.
14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.
15. Musical instruments.
16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
19. Building materials (non-metallic); nonmetallic rigid pipes for building; asphalt, pitch and bitumen; nonmetallic transportable buildings; monuments, not of metal.
20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

21. Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel-wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
23. Yarns and threads, for textile use.
24. Textiles and textile goods, not included in other classes; beds and table covers.
25. Clothing, footwear, headgear.
26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
29. Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.
32. Beers; mineral and aerated waters and other nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
33. Alcoholic beverages (except beers).
34. Tobacco; smokers' articles; matches.

SERVICES

35. Advertising; business management; business administration; office functions.

36. Insurance; financial affairs; monetary affairs; real estate affairs.

37. Building construction; repair; installation services.

38. Telecommunications.

39. Transport; packaging and storage of goods; travel arrangement.

40. Treatment of materials.

41. Education; providing of training; entertainment; sporting and cultural activities.

42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

43. Services for providing food and drink; temporary accommodations.

44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

45. Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.