

## TRADEMARK AND SERVICE MARK SEARCHES

Under trademark and service mark law, a company cannot obtain or use a mark (brand) for goods (products) or services which, when compared with **prior marks** for the same or similar goods or services, would tend to **confuse** buyers about which company is the **source** of those goods or services. Searches are made to identify prior marks of others. These searches enable a Gordon & Rees attorney to advise the client about the availability of proposed marks for the client's use, the potential for registration of the mark and the potential for conflicts with the marks of others.

## AVAILABILITY AND INFRINGEMENT SEARCHES

The purpose of an **availability search** is to assist the client in selection of an appropriate and effective mark for use with the goods or services which the client intends to provide to the marketplace. The search results list existing similar prior marks and the goods or services with which they are associated.

An **infringement search** is undertaken when there is actual or potential litigation regarding the client's use of a trademark or service mark. Such a search seeks information on how the opposing mark was obtained and registered, and whether there are third parties' marks which may have an effect on the scope or strength of the opposing mark.

## EXTENT OF SEARCHES

The most basic search is one where our firm uses published directories and commercial computer databases which are available to us **in-house**. These focus on prior marks which are registered or applied for with the U.S. government (through the U.S. Patent and Trademark Office) or with individual state governments. This level of search is comparable to the search which will be made by the Trademark Examiner and, therefore, is useful in predicting whether a registration application will be successful.

A more extensive search is the **comprehensive** search. For such searches our firm works through outside services which have access to lists of registered marks or registration applications as well as collections of various unregistered uses such as are found in telephone and city directories, trade directories, the Internet and other sources of common law use information. A comprehensive search is usually appropriate when there would be substantial expense or loss of good will if the company had to discontinue use of its selected mark. A comprehensive search is normally completed in two weeks. Expedited 48 hour comprehensive searches can be obtained.

## SEARCH LIMITATIONS

It will be evident that **no** search can ever be absolutely complete, since no one can guarantee that all possible relevant marks have been identified, regardless of how much time has been devoted to the search. The practical extent of a search is normally determined by the amount of search time that the client is willing to pay for. Lesser search and analysis time is often authorized for availability searches, since a client usually wants to make a decision quickly on whether to put a mark into use or apply for its registration. Infringement searches are more extensive, since litigation is usually involved.

Specific **omissions** or **gaps** are inevitably present in all information collections. Operators of computer databases seek to provide reliable information, but individual data items can be incorrectly or incompletely indexed and therefore be inaccessible when searching that database. Similarly, published directories will not always have completely accurate information. Also all databases and directories will contain some obsolete information as owners adopt, revise or abandon marks between updates of a database or directory.

## WHAT ABOUT FOREIGN MARKS?

Some searching of **foreign** registrations, databases and directories can be done through U.S.-based services. An Identical Mark Screen Search is useful to assess the likelihood that a mark will not directly conflict with existing registrations. More comprehensive searching of foreign marks may require retaining searchers abroad who are familiar with their countries' information systems.

## SHOULD I AUTHORIZE A SEARCH?

A Gordon & Rees attorney will provide the client with cost estimates and an evaluation of the coincidence factor in the search results so that the client can determine whether it will be **cost effective** to have a search performed, given the nature of the business and the practical results which can be anticipated. Consult with a Gordon & Rees attorney when defining the scope of any search. The attorney can advise what information sources may be available, how long it will take to search such sources, what costs and fees can be estimated, and what disadvantages there may be if a search is not undertaken.

---

Copyright Gordon & Rees LLP. All Rights Reserved.

This brochure is intended to provide general information for clients and friends of Gordon & Rees. It should not be construed or relied upon as legal advice. Applicability of the legal principles discussed in this brochure may differ widely in specific situations. Please consult a Gordon & Rees attorney for advice regarding specific legal questions and matters.