Searching U.S. Trademarks

22 September 2015

Marian G. Armour-Gemmen
Evansdale Library
West Virginia University

Trademark ®™ SM

• A word, name, symbol, or device that is used in trade with goods to indicate the source of goods and to distinguish them from the goods of others.
• A service mark is the same as the trademark except that it identifies and distinguishes the source of service rather than a product.

Trademark ®™ SM (cont.)

• Administered on federal level by USPTO.
  – http://www.uspto.gov
• Can be granted on the state level.
  – West Virginia Secretary of State
  http://www.sos.wv.gov/business-licensing/trademarkservicemarks/
• Common Law (protection derived from use)
• International applications handled through the USPTO as well

Common Law and State Trademarks

• USPTO does not review common law (unregistered) trademarks when making allowance
  – May be found in
    • Directories, catalogs, trade journals, newspapers, web search engines
• USPTO does not review state trademarks when making allowance

Videos

http://www.uspto.gov/trademarks/process/TMIN.jsp
Topics include
1. "Introduction to the USPTO and Trademark Basics"
2. "Before You File"
3. "Searching"
4. "Applicant Information"
5. "Drawing Issues"
6. "Goods and Services"
7. "Filing Basis Information"
8. "Specimen"
9. "After You File"
10. "Statement of Use"
• Review Chapter 1400 for the appropriate class scope notes in order to confirm the terms and classes you have chosen.

• For example, Class 8 (Hand Tools) includes cutlery but not surgical knives, which are in Class 10 (Medical Apparatus), or fencing weapons, which are found in Class 28 (Toys and Sporting Goods).
Trademark Assignments

Trademark Assignments

Searching for Non-Traditional Marks

Search for non-traditional marks
- structured search of trademarks

Categories
- Scent
- Sound
- Taste/Flavor
- Touch
- Color
- Shapes

Non-traditional Trademarks must meet three tests
- Non-function
- Acquired Distinctiveness
- Likelihood of Confusion or Dilution

What makes up a mark?
- Word
- Phrase
- Packaging
- Design
- Symbol
- Color, Sound, Smell

Strong Marks

- For a discussion of what makes a strong mark see Trademark.Legal Care for your Business & Product Name, Chap. 9, pp. 258-280.
- Important terms
  - Distinctive Marks
  - Nondistinctive Marks
  - Generic Labels
  - Composite Terms and Slogans
Reasons for Trademark Registration Refusal

Not all words, names, symbols or devices function as trademarks. For example, matter which is merely the generic name of the goods on which it is used cannot be registered.

The grounds for refusal under Section 2 of the Trademark Act (15 U.S.C. §1052) may be summarized as:

1. the proposed mark consists of or comprises immoral, deceptive, or scandalous matter;
2. the proposed mark may disparage or falsely suggest a connection with persons (living or dead), institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
3. the proposed mark consists of or comprises the flag or coat of arms, or other insignia of the United States, or of any State or municipality, or of any foreign nation;
4. the proposed mark consists of or comprises a name, portrait or signature identifying a particular living individual, except by that individual’s written consent; or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow;
5. the proposed mark so resembles a mark already registered in the Patent and Trademark Office (PTO) that use of the mark on applicant’s goods or services are likely to cause confusion, mistake, or deception;
6. the proposed mark is merely descriptive or deceptively misdescriptive of applicant’s goods or services;
7. the proposed mark is primarily geographically descriptive or deceptively geographically misdescriptive of applicant’s goods or services;
8. the proposed mark is primarily merely a surname; and
9. matter that, as a whole, is functional.

Likelihood of Confusion

Courts have objected to the following marks when used with identical or similar products:

- Seycos: Seiko® (for watches)
- Cleo Cola: Coca Cola®
- S.O. Esso® (petroleum products)
- Toro Rojo: Red Bull® (beverages)
- Oral-Angle: Oral-B® (toothbrushes)

Filing Basis

- Section 1(a): based on use in commerce
- Section 1(b): based on intent to use
  - Evidence of use must be submitted 6 months from Notice of Allowance (Statement of Use)
  - Extensions of Time can be requested (6-month increments) not to exceed 36 months
  - Statement of Use reviewed by Examining Attorney; if accepted mark registers; if not applicant notified of deficiencies/issues

Specimens

- Drawing
- Specimen
Checklist for Specimens

- Is the mark legible on the specimens?
- Does the mark on the specimens match the mark shown on the drawing?
- Do the specimens reflect the goods or services listed in ID?
- Are the specimens an acceptable type? Examples for goods: the goods themselves, packaging, labels, tags, displays associated with the goods.
- Examples for services: advertising, brochures, signs.

http://www.uspto.gov/trademarks/law/ornamental.jsp

Two Registers

- Principal Register
- Supplemental Register
- It allows for registration of certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant’s goods or services.
- Can use registration symbol
- Marks registered on the Supplemental Register receive protection from conflicting marks and other protections excluded from receiving the advantages of certain sections of the Trademark Act of 1946. The excluded sections are listed in 15 U.S.C. §1094.

Components of a Trademark

- Type of Good or Service sold under the proposed Trademark
- Symbol, or word or phrase used


- Guides, Manuals and Resources
Additional Search Tips

Coordinated Class Table
- Searches related Goods using the CC command with 3 digit number
- Automatically includes related International Classes in the search results when the primary International Class is searched.
- For example, a search for the International Class 007 utilizing the Coordinated Class index includes results containing any of the following International Class designations: 007, 008, 011, 012, 035, 037, 040, 042, A, B, 200.
- See “Help” when searching TESS.

Design Code Manual

- Design Elements have a three level numerical designations:
  - Example: Clown Design
  - Category
  - Division
  - Section
  
  02 (humans)
  01 (men)
  17 (clowns)
  02.01.17

Design Code Manual Tips

- Include every element of the design
  - So a bear with balloons would be both
  03.01.14 Bear & 21.01.13 Toy balloons
  - Image List just displays images
Searching U.S. Trademarks

Marian G. Armour-Gemmen

Top Search Mistake

#1 Assuming that you only have to search for exact spelling of trademark.

- If there is a registered U.S. trademark of application that is not spelled exactly the same but is similar in Sound, Appearance, or Meaning and is for related good/services the application will be rejected
- Reason: consumers would be confused

Other Common Mistakes

- Thinking that the mark will be issued if it is not in the USPTO database
- Believing that a “dead” trademark record necessarily means that the trademark is available for use by others
- Forgetting that there are state and common law trademarks that do not appear in the USPTO database.

Trademark Electronic Search System (TESS)

Search Tips:

- Main Truncation tools: * and $
- * can used in front and behind
- Often search in [bi,ti]
- Hyphens seen as spaces

Additional Search Tips

Using Free Form Advanced Search

Search Techniques

Quotation Marks—Exact Phrase: “Happy Camper”

*Retrieves HAPPY CAMPER and BE A HAPPY CAMPER

But not CAMPUIER HAPPY or HAPPY AS A CAMPER

Boolean Set Operators: And, Or, Not

Boolean Set Operators: And, Or, Not

Field Codes from Help Menu of Advanced Search Form
Additional Search Tips

Fields of BI and TI are often searched.

The Basic Index field contains the word mark and pseudo mark information indexed for optimal searching efficiency.

The search *DOG*[BI] will retrieve marks that have the word segment DOG anywhere in the word mark or pseudo mark.

Alternatively, the search *DOG*[BI, TI] will retrieve the word segment DOG occurring anywhere in the word mark, pseudo mark or translation.

Additional Search Tips: Truncation

Allows user to search from a root term

$—zero to unlimited number of characters

?—one additional character

Both $ and ? may be placed to left, right or internally in a word

Can represent a hyphen but never a space between terms

*—may only be places to left or right

*—cannot be used internally

*—must be used in Basic Index [bi] and Translation Index [ti]

Additional Search Tips: Applying Search Principles

Search Component Parts of individual terms

• HAPPY CAMPER: *hap*[bi, ti] AND *camp*[bi, ti]

• WORK AT HOME: *work*[bi, ti] AND *hom*[bi, ti]

• DUGOUT: *dug*[bi, ti] AND *out*[bi, ti]

Pattern Matching—substituting for class of characters

V All vowels—A, E, I, O, U, Y

PEN p{v}n [bi, ti]

D All decimal digits 0-9

200[d] [bi, ti] would retrieve years 2000-2009

Questions?

Marian Armour-Gemmen
Patent and Trademark Reference Librarian
marmour@wvu.edu
293-9758