Trademark & Copyright

Trademark Clearance Reports

Like many other law firms, Fish & Richardson performs and analyzes the results of trademark searches. Clients use searches to evaluate the risks of adopting a particular mark. The consequences of an adverse result in litigation or before the Patent and Trademark Office can differ drastically from case to case.

The two primary types of searches Fish & Richardson offers are (i) in-house "knockout" searches and (ii) "full" searches using an outside vendor. An in-house "knockout" search covers registrations and applications pending before the U.S. Patent and Trademark Office and U.S. state registrations, whereas a "full" search covers both of those sources as well as hundreds of databases of common law, unregistered marks the use of which may potentially create a conflict with the mark searched. Thus, an in-house search is less comprehensive, but less costly, than a full search.

Our clearance reports are not formal opinions of the Firm. Formal opinion letters require painstaking preparation and thorough peer review. We are willing to offer such formal opinions as to any particular possible conflict disclosed by a search if the client requests it, but we do not undertake such letters as a matter of routine.

Any search report, from Fish & Richardson or anyone else, also is subject to the following qualifications:

(1) DATABASE INTEGRITY: Databases relied upon by us or by outside vendors, while generally current, inherently suffer from some delay in entering the data into the database. To some extent this can be remedied by updating a search two to three months later, but by then there will be other data that has not yet found its way into the database. In addition, while the integrity of the data in the databases we use is high, it is not necessarily perfect. Similarly, the analysis by outside search firms that goes into the preparation of their reports is generally good, but it is not always perfect. For these reasons, in the most important cases, we suggest obtaining additional searches from different outside search firms to minimize the risk of omissions of significant references.

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(2) CONFLICTS BASED ON MEANING OF MARKS: Marks such as LONDON FOG and SMOG, JELLIBEANS and LOLLYPOPS, PLEDGE and PROMISE, and CYCLONE and TORNADO have been held to be too similar to coexist on the basis of meaning. There is no search methodology that is particularly well designed to find such conflicts.

(3) CONFLICTS BASED ON DILUTION OF "FAMOUS" MARKS: U.S. trademark law permits oppositions to applications, petitions to cancel registrations, and infringement suits to be brought against a mark that dilutes a "famous" mark. There is no separate registry of "famous" marks, and thus it is difficult to assess in a search whether a proposed mark would cause such dilution (i.e. the lessening of the capacity of the "famous" mark to identify and distinguish goods or services, even in the absence of competition between the mark owners or the likelihood of confusion between the marks). Furthermore, a search for a mark in a particular class of goods or services might not even find an arguably similar "famous" mark registered in a separate class.

(4) DESIGN AND TRADE DRESS SEARCHES: It is not possible to search designs or trade dress, whether manually or by computer searches keyed to design codes, with the thoroughness or precision of searches for word marks. There also is a dearth of reliable libraries of design and trade dress marks.

(5) APPLICATIONS BASED ON FOREIGN PRIORITY: Treaty obligations permit marks filed for in scores of foreign countries to be filed for in the United States within six months of their foreign filing date and to receive as a priority date their date of foreign filing. There is no practical method of searching for such marks before an application is filed in the United States.

(6) UNREGISTERED MARKS: In the United States, trademark rights arise from use, but there is no requirement that a trademark that is used be registered or listed anywhere, so there can be no absolute assurance that a potentially troublesome mark is anywhere to be found in a search.

(7) SUBJECTIVITY OF LIKELIHOOD OF CONFUSION OR DILUTION: Evaluating whether one mark infringes or dilutes another is a subjective judgment normally reached after balancing a number of factors, not all of which can be assessed by normal trademark search methods. Reasonable minds may disagree, and there are no guarantees that use or registration of a "cleared" mark will not be challenged, particularly if an adverse party's actions are based on emotion or some other factor besides legal analysis. The only definitive answer as to whether one mark infringes or dilutes another comes from litigation.

Document No. 17912