

INTELLECTUAL PROPERTY RESEARCH TOOLS AND STRATEGIES

TRADEMARK SEARCHING TOOLS AND STRATEGIES: QUESTIONS FOR THE NEW MILLENNIUM

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I. INTRODUCTION

The intent of this discussion is to raise questions about trademark searching which will be discussed in future issues of IDEA. I will lead you through the questions raised by my journey through primarily legal literature in treatises and periodicals on the Lexis and Westlaw platforms.

I taught trademark searching for many years at the Franklin Pierce Law Center using the Dialog®, Lexis®, Westlaw® and Micropatent® platforms. The trademark faculty basically teaches students to farm out comprehensive searches to Thomson and Thomson – now Thomson Compumark (hereinafter for ease of reference “T&T”). My belief was that consumers of trademark data need to know how to evaluate the searches they pay for. I suspended teaching this subject when T&T rolled out the Saegis® service which appeared to the trademark faculty at the time to make obsolete the need to learn the intricacies of online trademark searching. Many law and search experts believed that searchers would migrate from more learning intensive platforms such as Dialog®, Questel-Orbit®, Lexis® and Westlaw® to the native Saegis® platform and that other vendors would not venture into the market. The first question is,

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did those predictions come true? The access points to trademark data seem to have increased.

Whether that has happened is unclear. Much has changed over the past decade in the areas of:

- Trademark searching and technology
- Trademark law
- Trademark searching markets

In the final analysis, many of the questions discussed here come not from literature but from teaching trademark searching and monitoring the field. Many questions over the years have remained the same.

II. METHODOLOGY

Searches were performed using the Legal Resource Index® as well as the texts and periodicals databases using Lexis® and Westlaw®. Non-legal periodical literature in the Trade and Industry® database on Westlaw was also reviewed. Web searches were performed to find vendors and pages on the topic. Literature on the International Trademark Association (hereinafter “INTA”) Web was reviewed. Views were exchanged with trademark searchers.

Most of the discussion of trademark searching in legal literature can be found in intellectual property periodicals and treatises. Other items can be found in business and corporate counsel type resources. More detailed presentations can be found in various course handbooks published by the Practising Law Institute (hereinafter “PLI”) and American Law Institute - American Bar Association (hereinafter “ALI-ABA”).

But for my review of business and online professional journals in the Trade & Industry® and news database on Lexis and Westlaw I would have missed a good number of articles on new technology and services offered by a number of vendors.

The most prolific author on trademark searching is Glenn A. Gundersen, partner, and co-chair of the intellectual property group, practicing intellectual property law at Dechert, LLP for more than twenty-five years. He is the author of *Trademark Searching* (2d ed. 2000), an expert guide on clearance published by INTA as well as many articles and speeches on the topic. His book is unique in the trademark field and a “must read” for anyone involved in performing or consuming trademark searches.

Over a decade ago he talked about paradigm shifts in trademark searching. Glenn A. Gundersen, observed:

In the not-too-distant past, conducting a search to determine the availability of a proposed trademark was a relatively simple process. Trademark lawyers relied for the most part on outside professional search organizations, which provided reports focusing primarily on marks registered with the U.S. Patent and Trademark Office . . . Today, as a result of changes in U.S. trademark law and the development of dramatically improved search capabilities, the trademark search process has become considerably more complex. A trademark availability search is no longer a standard, “one-size-fits-all” process. Trademark lawyers face a number of choices when a client inquires about a mark that it plans to adopt. As a result, strategy and timing have become much more significant to the search process.¹

Half a decade later his observations were shown to be truer in the Internet era. Gundersen, states:

One of the biggest challenges for companies in the year 2000 is branding – the task of deciding what to name a business or a product. Finding a mark that doesn’t infringe a previously-established mark has never been simple, but the sustained economic growth of the last decade and the late ‘90’s .COM boom has drastically increased the difficulty in clearing new marks . . . The problem starts with the basic math of trademark clearance today compared with 10 years ago -- the number of applications for U.S. trademark registration almost doubled between 1991 and 1998, and rose by another 30% in 1999. To decide whether a company’s proposed mark is available in today’s environment, trademark counsel has to wade through a much longer database report than ever, and the sheer number of new filings means that the odds are increasingly slim that a given mark will be available.²

III. WHO ARE THE CONSUMERS OF TRADEMARK SEARCHING DATABASES AND SERVICES?

Many “traditional” trademark lawyers and professors present this topic in a cut and dried two step approach; perform a “knock out search” in house using free and commercial databases and farm out the full search to a firm. Some skip step one.

Many law students and lawyers are taught the two step approach, but are very technology savvy and surf the learning curve of trademark searching online platforms with ease. This perhaps explains why the number of trademark database vendors has increased. Vendors realize some lawyers prefer to do more comprehensive desktop searches and have developed their platforms to

¹ Glenn A. Gundersen, *Methods of Searching Trademark Availability Aren't Simple Anymore: A Search is no Longer a 'One-Size-Fits-All' Process. Strategy and Timing are now More Significant*, Natl. L.J. C39, col. 1 (May 16, 1994).

² Glenn A. Gundersen, *Borderless World of Internet Marketing Brings New Complexity to Trademark Clearance* (Dechert, 2001).

accommodate more robust searches without a prohibitive learning curve. One example is T&T. The TRADEMARKSCAN® database training takes about eight hours. T&T's Saegis® shortened user training to a few hours.

Why are there so many trademark database vendors? Why are there so many trademark search businesses? Perhaps the answer is because lawyers are not the only consumers in need of trademark data. A number of vendors package patent and trademark data for business consumers. Business consumers range from huge multinational corporations to new small businesses who can't afford the price tag of a subscription service or a search firm. Marketing, branding, communications and consulting professionals are also consumers.

The INTA *Practical Approaches to Trademark Clearance Issues Roundtable*, January 2006 began by defining the purpose and nature of the trademark search. It looked at the impact that the nature of the client, its sophistication and budget have on search and advice to client. It outlined the four client groups as individuals, start-up ventures, mid-cap companies and large multinationals. So, is it fair to ask the question whether lawyer consumers have changing habits and there are other consumers who do not have the funds to afford premium services?

IV. TRADEMARK SEARCHING AS A COST/BENEFIT RISK-BASED ANALYSIS?

A. *Z Factor*

Neal Gordon, begins his article, "Seek and ye shall find – not necessarily so in the trademark field. Clearing a new trademark can be a Herculean feat."³ The trademark lawyer should be aware and sensitive to the pressures marketing people are under. By the same token, product and marketing personnel must understand the lawyer's role – to clear the mark for use and avoid lawsuits.

Phillip G. Williams, states the challenge well:

There always exists the chance that some other company that is too small to appear in any of these directories or databases has adopted the very same name that you now cherish as your own. We refer to this possibility as the "Z factor," that element of uncertainty, however small, which cannot be eliminated. Those who want to reduce the Z factor to the greatest extent possible can do so by leaving no stone unturned, ferreting out every source of information on products, services, or manufacturers in their particular field of interest, as well as trade names in every field. Such thoroughness will give you the

³ Phillip G. Williams, *Trademark Clearance*, U.S.T.A. Exec. Newsltr. No. 34 (1982).

best possible assurances of a problem-free name. Whatever approach you adopt, whether the fine-tooth-comb search or just the basics, ma'am, keep in mind two, apparently contradictory, facts: (1) A conscientious search is essential for clearance. (2) No system of checking is absolutely fool-proof, and some element of uncertainty will always remain. One can worry oneself to death about this possibility, or accept it good-naturedly as the price of doing business in the real world. If you have done a competent search, or had an attorney do one for you, you have the added assurance of knowing that a company too small to show up in any of your investigations is, in all likelihood, not going to be in a position to take you to court over trademark or trade name infringement. There are no guarantees in this realm, however—only educated guesses.⁴

P. Jay Hines and Jordan S. Weinstein, further discuss the dynamics of trademark searching:

The more sources to be searched, the higher the cost, but the more potential conflicts to be uncovered. The fewer sources to be searched, the lower the cost, and the higher the probability that the searcher will miss a pertinent reference—and a potential conflict. Searchers obtain leverage when they can decrease the number of sources searched while increasing the probability of finding conflicting references. The highest leverage comes from searching the U.S. Federal Register, because every conflicting reference has a high probability of being cited against an application. Conflicting marks located in, for example, trade directories or foreign registries may never cause a conflict even though they may be identical to the mark being searched. This is because the USPTO will search pre-existing federal registrations during the application process, and will refuse registration if an Examining Attorney considers the applicant's mark likely to cause confusion with a prior federal registration, or defer registration based on a pending application. On the other hand, a common law reference can only be an obstacle to registration if its owner challenges the federal applicant's application during the opposition period, or after registration by means of a cancellation proceeding. A common law trademark can, of course, be an obstacle to use.⁵

Given this age old challenge, we should ask whether technology and the trademark searching product vendors have helped close the Z factor gap and increased search leverage. Another question is whether legal developments have made it more important to close the Z factor gap.

⁴ Phillip G. Williams, *Naming Your Business and its Products and Services: How to Create Effective Trade Names, Trademarks, and Service Marks to Attract Customers, Protect Your Goodwill and Reputation, and Stay Out of Court* 80 (P. Gaines Co., 1990).

⁵ P. Jay Hines & Jordan S. Weinstein, *Using The Madrid Protocol After U.S. Accession*, 93 Trademark Rep. 1003, 1004 (2003).

V. TRADEMARK SEARCHING IN LEGAL LITERATURE

Lawyers can be the consumer of both trademark search database services as well as reports generated by hired searchers. The dozens of book sections and periodical articles on trademark searching, discussed in the Methodology section above, constituted almost a thousand pages when printed. It is remarkable how most of these sources provide very similar basic outlines of the same material:

- Types of searches
- Importance of searches
- What and where to search
- Commercially available searches
- Trademark search problems
- Evaluating a search report
- Follow up investigation
- Foreign and international searches
- Advice of counsel issues

There is relatively little discussion dealing with:

- Trademark searching databases and vendors
- Evaluating and choosing databases and vendors
- Searching strategies
- Searching skills
- Problems searching non-word marks
- Ways in which technologies have changed searching strategies
- Web searching
- Role and growth of free searching on national office Websites
- Role and growth of search firms beyond the giants such as T&T and CCH

VI. WHAT IS THE IMPACT OF TECHNOLOGY ON TRADEMARK SEARCHING?

A. *Trademark Records Go Digital*

Before the mid 1980s trademark registration searching was done manually by hand through paper records in the USPTO Trademark Search Library. Manual searching was also done in collections and Libraries which contained trade literature, directories and phone books. Some of these non-registration resources were available on premium online services such as DIALOG.

The development of digital registrations in the United States as well as other national offices opened the door for commercial development of the electronic trademark searching industry. Trademark registration data is provided by the national offices to commercial database producers who add value to the data and produce a product called a database. These databases are licensed to online service vendors who offer the products to their customers. The vendors offer different search interfaces with varying levels of technical complexity. These vendors compete on comprehensiveness, searchability, price, customer service as well as many other factors beyond the scope of this discussion. One example is TRADEMARKSCAN® from T&T. T&T produces the database which it vends itself as well as through other vendors such as Dialog®.

There have been a number of stable trademark searching database producers and vendors doing business over the last two decades. There have been a number of new vendors enter competition. Several companies have changed names and ownership. I began teaching trademark searching in 1992. During that period several good survey articles appeared in non-legal journals. The first was Nancy J. Thomson, *Intellectual Property Materials Online/CD-ROM: What and Where*, Database 14 (Dec. 1992) followed by Carmen L. Miller, *Doing Your Own Trademark Search*, Online User 15 (Mar./Apr. 1996). These articles give a good picture of the producers, files and vendors at that time.

Two longtime producers are T&T and Imsmarq®. Let's look at Imsmarq® for example. AvantIQ® started out in 1986 under the name of Imsmarq® offering the IMS Pharmaceuticals-in-use database. Soon after this, Imsmarq acquired licenses for some national trademark databases including the Italian and French registers. Imsmarq was the first trademark research company to offer online searching in these national trademark databases. Over the years new databases and services were added including the German and Scandinavian trademark databases. In 1995, Imsmarq® changed management and ownership

and in 1997 they changed their name to AvantIQ®. Since then AvantIQ® has continued to grow and develop. In July 1999, they introduced a new Web-Search service which allows users to search the AvantIQ® trademark databases using flexible and powerful internet-based interface. Imsmarq® databases are also vended via the CCH Corsearch® and Questel-Orbit® platforms.

So, the first impact of technology was the digitization of trademark registrations and the rise of commercial trademark searching database producers and vendors.

B. Has Technology Improved the Ability to Search Beyond Mere Word Strings?

Some of the early search platforms only allowed the searching of simple word strings. U.S. trademark law is based on avoiding consumer confusion. As such, several of the case law elements of the test for “likelihood of confusion” involve looking at the similarity of the marks and the similarity of the goods and services. The challenge has been how to utilize technology to help deliver data to draw these conclusions.

This task is made more complex when the mark is more than mere words. There are four different types of marks: trademarks, service marks, certification marks, and collective marks. For the most part, the law governing all four is the same, both under the Lanham Act and state law. A trademark is a word, name, symbol, device, or any combination thereof, which is used to distinguish the goods of one person from goods manufactured or sold by others, and to indicate the source of the goods, even if the source is unknown.

The range of things that are capable of serving as trademarks is great and includes not just words but also such things as drawings and abstract designs; slogans; distinctive features of the product's packaging; and distinctive, nonfunctional features of the product itself. Even colors, sounds and smells have been registered as trademarks. So, for example, the manufacturer of a soft drink might claim as trademarks not only the brand name of the drink, but also the art work on the label, the distinctive shape of the bottle in which the drink is sold, and the slogan used on the label and advertising.

Here are some of the challenges of searching word marks:

- Deliberate misspellings
- Puns
- Slang
- Variations on otherwise common words
- Corrupted spellings

- Colloquialisms
- Foreign language equivalents
- Words with same root
- Tense variations
- Pluralization or conjugations
- Variations in prefixes and suffixes
- Irregular plural contractions
- Phonetic similarities
- Word play
- Abbreviations
- Punctuation
- Synonyms
- Alternative spellings
- Visual equivalents
- Repeating words
- Coined words
- Cardinal and ordinal numbers

How do search services help collate like marks? Over time producers and vendors have undertaken the labor-intensive task of cross-referencing such string marks that they identify as related. In addition, they use technology such as the “rotated trademark index” by T&T to locate trademark letter strings appearing as whole word, prefix, suffix or mid-word. Consumers need to evaluate the sophistication of the search system under consideration. This is no easy task as it involves reading multiple screens and help sections to ascertain how to make the computer do what you want.

One example is the free USPTO site. The site presents with a simple search template. Ask the question whether it will automatically search sound alike and other challenging letter strings and the site requires that you read through help screens to discover that *“The underlying TESS Search software from Dataware does not include a phonetic search option. Phonetic searches generally provide many unwanted records. The pattern matching capabilities of the TESS Search product provide the flexibility of creating your own phonetic searches. We are working towards providing additional hints in the online help for constructing phonetic searches using the existing capabilities of the TESS Search product. . . . Additionally, TESS includes a CLASS concept for searches.*

You can use classes to specify which of all the searchable characters should or should not be included in your results.”

Compare the FEDTM file on the premium Lexis service. This file contains federal trademarks and applications licensed to Lexis® through CCH Corsearch®, a member company of CCH Legal Information Services®. Lexis® provides several custom segments to find like marks. The WORD segment locates any words included in the trademark or trade name, including the name itself, English translation of non-English words, and words with similar meanings, spellings, and sounds. The TRANSLATION segment provides the English translation of any non-English words or notations appearing in the trademark. The challenge with Lexis is that the source description screen does not include detailed descriptions of exactly what each segment searches. Lexis customer service was called and I was told that customers need to call them for detail on how to search that file.

Lexis® FEDTM features search capabilities that are vital to successful trademark searching. When you search trademarks on the Lexis® service:

- You can search all words, including noise words, such as “at” and “is” or “it” and Boolean connectors, such as “and” or “or” (when you wish to use a Boolean connector as a search term, enclose it in quotation marks).
- You can take advantage of prefix/infix/suffix searching capability to find a term whether it's a word on its own, or appears at the beginning, in the middle, or at the end of word. For example, use of the search term apple! in the Words or Trademark segment will also retrieve occurrences of snapple, pineapple, apple bees, cranappleberry, and so on.
- Your search will take advantage of English translations of non-English words used in trademarks or trade names. For example, use of the search term house in the Words or Trademark segment will retrieve occurrences of casa, chez, haus, villa, and so on.
- Your search will retrieve trademarks or trade names that have similar spellings, similar meanings, or similar sounds. For example, used in the Words or Trademark segment, the search term crunch will retrieve occurrences of krunch, the search term are not will retrieve occurrences of ain't, and the search term apple will retrieve occurrences of applite.

So, the question presented is to what extent has and will technology make retrieval of this data meet the needs of the user. Will natural language and semantic searching replace the need to use field codes and copious effort with terms and connectors? T&T offers AutoQuery on its Saegis® platform which is a series of rules-based algorithms that automatically generate multiple search criteria to retrieve exact matches, near identicals, and similarities by entering basic search criteria.

If word mark searching appears to be a challenge, has technology done come to the assistance of those needing to search non-traditional trademarks? This category includes:

- Designs
- Trade dress
- Colors
- Animated marks
- Sounds
- Scents

Some of these searches are completed using design phrases and codes. Searching design phrases is risky as:

- Appear only if application includes it
- Appear only if examiner includes it
- Considered unreliable
- Descriptions not consistent or complete
- Design phrases use different terminology to describe similar designs
- Much protectable trade dress is unregistered
- Some trade dress impossible to depict in an application drawing

The use of design codes is more controlled but is risky due to the subjectivity of design coding. Also, if the searcher restricts by the incorrect code, records will be missed. So, the question is whether technology will produce a point and click interface to search the very difficult field of non-word marks. These search difficulties have been recognized for some time by INTA that has issued reports by various non-traditional trademarks subcommittees and task forces.

C. How Has the Web Impacted Trademark Searching?

Simply put, the Web has impacted trademark searching in the following ways:

- As a fast and reliable front end to online search vendors
- As a vast access point to global use of word marks
- As a potential search tool for non-word marks
- As a global marketplace for consumers of trademark searching

The original digital trademarks services were delivered using modems, phone lines and telecommunications software. The next development was the use of CD-ROM technology. There were no images online. As we know, a picture is worth a thousand words. This may produce a yawn for most readers, but at that time CDs were the hot technology, allowing local unlimited access to huge trademark databanks without dependence on slow and expensive connections. The giant Dialog® released a CD version of the T&T databases. Newcomers MicroPatent® and CCH Trademark Research® used CD-ROM format exclusively for years. I once had both come to Pierce Law and set up in back to back classrooms like a trade show to educate my students.

1. Has the Growth of Trademark Searchers and Search Firms Lead to Likelihood of Consumer Confusion?

The Web has become a global marketing tool for anyone offering trademark searching services. Search engine sites show hundreds of sites offering searches. The links lead to a wide range of search options. Businesses include lawyers, general searchers and dedicated trademark searchers. Price points, like trademark search databases are on the spectrum and include free, low fee and premium. Search reports at price points under one hundred dollars are common. One search company from India quoted me fifteen dollars to deliver a search report based on the USPTO trademark search engine.

My assistant, Stephen Straub, conducted a survey of several dozen such sites for this article. I have reviewed and analyzed the marketing approaches of these firms. This review leads to many questions. Why is there so much competition at such low prices? Who are the customers? Why would consumers risk using low priced firms when premium sources such as T&T and CCH CORESEARCH produce reports at rates considered reasonable by most lawyers? What is the training of these low fee searchers?

The survey produced the following marketing approaches:

- Providing results based on searching variations of mark
- Providing extensive report of matches (compared with only closest matches)
- Conducting searches in all classes
- Results are based on data updated weekly
- Searching state trademark registrations compared with corporate transaction records and portions of state business activity
- Fully knowledgeable staff that specializes in just trademark searching with professional judgment (professionalism and experience)

- Researching all pre-pending marks as well as abandoned, canceled and expired marks
- Common law searching in business databases as well as Web searches
- No registration necessary – just order and pay
- Full staffing with extended customer service hours
- Flat fee pricing
- Low risk – refund if challenging mark results in application denial
- Easy and convenient process
- Lawyer-free pricing
- Private and secure
- Satisfaction guarantee
- Highest quality for the price
- Free shipping
- Unlimited customer support
- Training and quality control
- Free preliminary search and evaluation
- Attorneys perform all services
- Choose the level of service which best meets your needs and budget
- Use premium databases such as Lexis and TRADEMARKSCAN not just the USPTO site
- Strive to build a lasting relationship with our customer
- No extra charge for same day service
- Length of time in business
- Many search companies bundle the searching of state and Federal registrations with a common law search. Unbundling the searches saves money on unneeded common law searches
- Research experts offer free analysis
- Free attorney referrals who discuss results at no charge
- Located minutes from the USPTO
- Worldwide network provides efficient and centralized system to meet needs
- Successful strategies

Karol A. Kepchar states, “[a] ‘thorough’ search is one that implements a creative and exhaustive search strategy, and utilizes resources appropriate to the product or service at issue, and the jurisdiction.” For example, for a web-based enterprise software product, it would be advisable to do an Internet search to supplement a Federal search.”⁶

So, these businesses compete on price, comprehensiveness, quality, experience, and customer service. Some claim value added by virtue of legal knowledge (lawyers perform, review or consult in search process) while others focus on online searching expertise. Many claim to be experts but provide little detail on the Web pages to support such claims.

David A. Cohen, advocates being a wise consumer of trademark search firms and establishing on-going relationships:

- * searcher should select one search company and order most, if not all, trademark searches from this particular company on an on-going basis;

- * layouts of search reports, and the order in which information is presented on each page differ according to the vendor. When reading through hundreds of pages of multiple reports, it is easier for the eye to miss important information if such information is not found in its expected location. It becomes easier to search through familiar reports.

- * make it easier to make preferential requests from time to time, such as expediting a search for no added cost or refunding the cost of a search that was sub-standard;

- * may qualify for a bulk discount off regular prices

- * allows the searcher to get to know the individual search consultants within the company allowing the searcher to better instruct the consultants and allows the consultants to better anticipate the

searcher's particular expectations

- * searcher may be able to insist on having one especially capable search consultant handle all full search requests.⁷

2. Digital Search Reports – What is the Value Added?

Alexei Oreskovic, reports on consumers of the new generation of digital search report tools:

⁶ Karol A. Kepchar, *Selecting and Searching Trademarks*, SF87 ALI-ABA 39 (Mar. 22, 2001) (stating in the section, “Comprehensive Search -- Is There Any Such Animal?” that “searches are only as good as the searcher.”).

⁷ David A. Cohen, *Preparing Trademark Legal Opinions, Trademark Searches and Investigations*, 668 PLI/Pat 35, *57-60 (P.L.I., 2001).

Traditionally, search results came in 200- to 300-page hard-copy reports. But in the last 2 years, CCH CorSearch, Thomson & Thomson, and NameProtect have all released online products that allow lawyers to sift through data in different ways. Instead of constantly flipping between pages, an attorney using the online versions can pull up abstracts, in-depth ownership records, and summaries of Trademark Trial and Appeal Board proceedings easily. It's more interactive, so your mind is engaged, says Manjari Datta, associate general counsel of Blyth Inc., a \$1.6 billion Greenwich, CT, candle manufacturer that owns 1600 trademarks worldwide. Because comprehensive trademark searches can contain thousands of results, services usually distill the initial reports into a more focused list -- a task that now can also be done online. Search services offer various ways to prioritize results, with color-coded tags and electronic notes that can be appended to each record. And while paralegals have traditionally had to manually type out the summary, copying relevant data from initial results, online products allow someone to assemble a new report and a chart as a word-processing document. Blyth's Datta says she and her paralegal can complete a summary in about 2 or 3 hours, instead of 8 with paper. There's very little manpower here to help us prepare a detailed report like that, Datta says. Sarah Westover, a senior legal assistant at St. Louis-based The May Department Stores Co., says she can compile reports in a quarter the time it once took.⁸

Let's take a look at CCH CORSEARCH® as an example. On March 8, 2005 Business Wire® reported on CORSEARCH Advantage® in, *CCH CORSEARCH Launches 'Investigative Tools' Module on CORSEARCH Advantage, Taking Trademark Clearance Search Review to Next Level*.

Investigative Tools, is a service that expands the capabilities of trademark practitioners in their review of clearance search reports. The new service allows the user to conduct follow-up, web-based investigations directly from within each record of the report, including the following:

- Mark In-Use Investigations
- US Patent & Trademark Office (USPTO) Real-Time Status and Documentation Investigations
- Financial, Legal, and Commercial Investigations of the Mark's Owner.⁹

In doing so, CCH CORSEARCH® offered unlimited web-based investigations built for each record of the report. In 2004, CCH CORSEARCH rolled out it's search review and analysis tool, CORSEARCH Advantage®, a product

⁸ Alexei Oreskovic, *The Brand-Name Game's New Rules New Tools Allow E-Commerce Counsel to Search for Trademark Usurpers and Brand Diluters Faster, Better*, 22 No. 3 e-Commerce L. & Strategy 9 (July 2005).

⁹ *CCH CORSEARCH Launches 'Investigative Tools' Module on CORSEARCH Advantage, Taking Trademark Clearance Search Review to Next Level*, Bus. Wire (Mar. 8, 2005).

that allows trademark professionals to review reports online, mark and annotate records electronically, and create custom charts consisting of only the records and the material within the records that the user finds most relevant.

“In less than a year Business Wire® reports that more than seventy five percent of CCH CORSEARCH's top clients have adopted the new service, which has allowed them to streamline their clearance workflows.”¹⁰

The new Investigative Tools enhances the existing product, allowing the user to both chart tagged records and comprehensively document the results of investigations that are so often required after finding records of concern in a search. Now, the trademark professional will have a fuller picture of the trademark environment that is needed to determine whether a mark may be cleared. New technology, never before offered in a search report, enables trademark attorneys and paralegals to launch their follow-up investigations while reviewing their searches, says Karen Abramson, General Manager of CCH CORSEARCH. According to so many of our clients, this could be the most important enhancement to the search review in a decade. Prior to this tool, professionals would have to conduct their investigations on a piecemeal basis, usually after reviewing the full report. Investigating records of interest after reviewing the complete report inevitably creates inefficiencies. Users of the existing CORSEARCH Advantage have consistently told us that the service helped them save 40% to 75% of time in reviewing and evaluating their trademark searches, and the Investigative Tools will only further streamline that process, agreed Andrew L. Popper, Director of Strategic Marketing at CCH CORSEARCH. However the key benefit is really the increased quality of clearance evaluations they provide their clients, as now they will be able to take a traditional, high-quality search and conduct a series of follow-up investigations that really establishes the environment that the proposed mark faces.¹¹

a. Will Digital Reports Lead to Clients Screening their Own Reports?

Oreskovic, reports that:

[A]t many in-house legal departments, attorneys trying to track down trademark infringers pore over lengthy, bound paper reports. But this Old World scene is fading as Web-based trademark-search products simplify the job. Whether investigating new product-name availability or domain-name squatters and cybershysters, these fee-based services do corporate legal departments' legwork. They also provide attorneys and staff with slick online tools to review and act on the information uncovered.¹²

¹⁰ *Id.*

¹¹ *Id.*

¹² Oreskovic, *supra* n. 8, at 9.

James E. Hawes and Amanda V. Dwight, raise this issue:

Due to the proliferation of publicly available and easy to use trademark searching databases, an increasing number of clients will be screening their own marks. Also, many marketing or advertising consultants will have screened their recommended slogans and marks, and have represented to the client that the slogans and marks are “clear.” The client will often feel that it is unnecessary to pay for a full search. Complicating the issue further is that the client or their consultants are unlikely to keep any records of their search, so the likelihood that these screening searches will be of much value in later court proceedings is reduced even further. Therefore, it is increasingly critical to know the limitations of the publicly available databases and be able to explain the reasons why a full search is recommended.¹³

3. Web Search Engines

a. Why Don’t Most Services & Firms Include Web Searching in their Full Search Reports?

I don’t know – could it be liability concerns? An informal review of trademark searching product vendors shows that despite the improvement of search engines, most don’t offer offer Web searching as part of their intitial clearance services. The review shows that most offer domain name searching as part of their full reports and offer web searching monitoring services to police the use of marks in use.

Take for example the company NameProtect® which offers the following mark and brand related Web monitoring services:

- Trademark Watching
- Global Domain Name Monitoring
- Internet Design Searches
- ActiveIP® International TM Screening
- Revenue Diversion
 - Traffic Diversion
 - Unlicensed Product Sales
 - Branded Product Counterfeiting
- Brand Theft
 - Trademark Infringement

¹³ James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice*, 1 Trademark Registration Prac. § 2:9 (West, 2005).

- Brand Dilution
- Offensive Content & Pornography
- Threats & Security
- Risk Management
- Competitive Activity
- Customer Commentary
- Phishing
- Online Credit Card Fraud
- Piracy
- Gray Market Sales Activity
- False Affiliation
- Corporate/Affiliate Standards
- Litigation Support Search
- Issue Management Search
- Internet Dilution Reports
- Search Engine AdTracker Reports

4. Anything New Searching Domain Names?

Sure, now its free and easy. Not so long ago that was not the case. In 2000 Network Solutions, Inc. (NSI), the world's leading Internet domain name registrar formed an alliance with T&T to provide trademark and brand protection services that cover both traditional and Internet identities. Network Solutions had the original monopoly from the U.S. government for registering Internet domain names in the *.com*, *.net*, *.org*, and *.edu* generic, top-level domain name categories. That monopoly ended in 1999.

The exclusive joint marketing and distribution agreement promoted reciprocal products and services through NSI's idNames division and through T&T and T&T's Saegis® and general Web site services. T&T has provided access to NSI data on its SAEGIS service for many years and made some of that data available free. However, this marked the first time that NSI users, specifically users of NSI's idNames commercial services, have had access to data generated by T&T.

In 2006 there are dozens of sites which allow trademark searchers to check all domain names at no cost. Domain name searches are included in most commercial search reports. So why pay? According to the Saegis Web, the value added is:

- * Efficiency - No more waiting for high-traffic Internet servers
- * Comprehensive Results - Locate a wide range of confusingly similar domain names in approximately 200 countries
- * Flexibility - Screen the data in the way that best suits your needs: search the world, a region, or an individual country
- * Sophistication - Use Boolean search logic (AND, OR, NOT, and NEAR operators) to formulate precise queries
- * Worldwide Domain Name Search is the only service that enables you to locate similarities by using prefix, suffix, mid-word, wild card, and phonetic queries. Most free sites only allow plain word string searches.
- * Specify any of the following four fields as part of your search strategy, Domain Name, Exact Domain Name, Phonetic Domain Name and Top-level Domain

5. What about the Web as a Trademark Searching Tool?

Several fee-based services do include Web page searching. For example, T&T's SiteComber screening search tracks the Web for common law occurrences of a proposed trademark in specific classes of products and services. Legal Zoom offers Cyber Common Law® search of over three billion web pages and 4,500 news sources. Most services appear not to offer this service.

Jane Shay Wald, recognizes this:

Apart from the internet searching that follows from the domain name element of the "complete" search report, there is a seemingly bottomless pit of internet searching one may perform. Some potentially relevant trademark uses may simply live below the radar of the vendor's search report databases. Consider whether your company or client wishes to utilize a search engine to enter the subject word and see whether additional references emerge. Some counsel are doing this as a first knock-out step -- before looking at the PTO database, and before ordering a search from an outside professional search company.¹⁴

Anyone can now conduct a thorough search for unregistered marks by using an Internet search engines. For instance, by entering your proposed name in the search field on Google, you will get a report of every instance where the name appears on Web pages that the Google search engine has indexed. Because no search engine is complete, an especially thorough search will include

¹⁴ Jane Shay Wald, *Preparing Trademark Legal Opinions, Trademark Searches and Investigations*, 668 PLI/Pat 9 (P.L.I. 2001).

several additional search engines. Also, it seems not possible to use search engines to find all of the sound alike marks as discussed above.

Using Google as an example, Google offers a number of tools that may benefit trademark searchers. Google's Language Tools overcome language barriers. Click on the "Language Tools" link to the right of the search box on Google's home page, or visit www.google.com/language_tools, or select the Language Tools menu option in the Google Toolbar to:

- Search for pages written in specific languages
- Search for pages located in specific countries
- Use the Google interface in another language
- Visit Google's site in a specific country (over one hundred)
- Translate any text or web page from a limited set of languages including English, French, German, Italian, Portuguese, or Spanish into another language in that set.

From the Preferences page, specify your global preferences, including

- Interface Language: the language in which Google will display tips, messages, and buttons for you
- Search Language: the language of the pages Google should search for you

You can restrict your searches to those pages written in the languages of your choice by setting the search language. By default, Google Web search includes all pages on the Web. If you want to restrict results to a single language for a few queries, consider using the Language Tools menu option in the Google Toolbar, the Advanced Search page, or Language Tools.

Google provides a translation link to enable you to get the gist of pages written in some languages. Want to translate some text or a web page? Try the Translate feature available from the Language Tools link on Google's home page. As the web has spread across the world, more and more web pages are available in languages other than English. Google provides a translation link and language tools to enable you to read pages written in unfamiliar languages. Google translates pages by computer. Machine translation is difficult to do well and tends not to be as clear as human translation. But it can give you the gist of what's written or suggestions for translating something into another language.

Your results may include a "Translate this page" link when a results page is written in a language different from your interface language (as specified by your Google Preferences,). Your interface language is the language in which Google displays messages and labels, buttons, and tips on Google's home page and results page. You can translate pages written in English, French, German, Italian, Portuguese, and Spanish into another language from that set.

In addition, you may want to review merchandise at an online store. For example, if you are selecting a trademark for a new toy, you can visit “ToysRUs” at www.toysrus.com. Once there, you can browse hundreds of toys and perform a keyword search for any toy trademark that is similar to yours.

These resources don't actually provide a list of unregistered trademarks. There is no such list anywhere. Rather, these sites list product and service names that qualify as trademarks because of how they are used to identify the underlying products or services in the marketplace. There are special searches which can be performed, including, among others, literary title searches, pharmaceutical/FDA searches, Bureau of Alcohol, Tobacco and Firearms name searches, and others.

6. Web Searching Designs and Nontraditional Marks – Have Web Technologies Helped?

Also discussed above are the difficulties searching non-traditional marks. Has technology facilitated finding such use on the Web? We discussed that U.S. trademark registrations are highly indexed by database services. They allow you to find many non-traditional marks by searching specific fields. Web search engines do allow you to search portions of Web pages. Nonetheless, Web documents are not controlled like trademark records, so those strategies do not work.

7. Image Searching

a. Search Engines

Let's continue to use Google as an example. Google's Image Search claims to be the most comprehensive on the Web, with billions of images indexed and available for viewing. To use Image Search, select the “images” tab or visit <http://images.google.com>. Enter a query in the image search box, and then click on the “Search” button. On the results page, just click the thumbnail to see a larger version of the image, as well as the web page on which the image is located.

How Does Google Image Search Work? Notice that when you search for images of the Nike Swoosh trademark Image Search returns some photographs of the Nike Swoosh marks in use. The words “Nike Swoosh” appear near images of the swoosh, or in image captions, or in links to those images. Google makes a guess that the words are related to the image. Google technology isn't yet to the point where it can tell what's in an image by looking at it directly.

b. Other Image Search Tools

As early as 1998 there were efforts to apply technology to find trademark images on the Web. One article, introduces the topic and provides some discussion of IBM's assertions that searching by similarity using software that features this technique has promising applications in the world of trademark retrieval.¹⁵

Searching by similarity, using a known item to find other similar ones, is a common strategy for optimizing the precision of a search. What works for text-based searches should also work for finding images. Unfortunately, description and classification of images lags far behind those of textual documents. Although there are exceptions, images often have only a very short title, or perhaps a more descriptive caption. Collections of artwork may have keywords about the artists, the medium, the period, or the object, but these are not as descriptive or precise as those used for journal articles, conference papers, or dissertations.

Keywords have been used to describe photographs, drawings, paintings, and other visual works of art by stock photo agencies, clip art collectors, and curators of museum collections, but words are often inadequate to describe such items. Shape, texture, color, brightness, and proportions are essential for defining images. While keywords and classification codes can help limit the domain of a search, similar items are best found by using an image's inherent traits.

Some early significant developments in search software help users find images by using visual attributes as search criteria. Three companies (Virage, Excalibur, and IBM) developed image retrieval software that used an image's traits (shape, texture, brightness, etc.) to locate similar images in a database or on the Web. Such software is usually licensed to third-party vendors for specific applications, unlike the software employed by the major search engines. But understanding how similarity-searching works opens new vistas for online searchers and others interested in information retrieval.

Also in 1998, John P Eakins, Jago M Boardman, and Margaret E Graham, describe how the Artisan system retrieves abstract trademark images by shape similarity.¹⁶ It analyzes each image to characterize key shape components, grouping image regions into families that potentially mirror human image perception, and then derives characteristic indexing features from these families and from the image as a whole. It was evaluated for the retrieval effectiveness

¹⁵ Peter Kasko, *Searching for Images by Similarity Online*, 6 Online 99 (Nov. 1998).

¹⁶ John P. Eakins, et al., *Similarity Retrieval of Trademark Images*, 5 IEEE MultiMedia 53 (Apr./June 1998).

of our prototype system on more than ten thousand images from the UK Trade Marks Registry.

8. Other Nontraditional Mark Searches on the Web

A thorough discussion of multimedia search engines are beyond the scope of this discussion. There is an entire section of the Search Engine Watch site at <http://searchenginewatch.com/> devoted to this discussion.

The next area of search might be sound. As stated above, a sound can also be a trademark or a service mark. The three-tone chime of NBC has been registered as a service mark. Sound trademarks were in the news when Harley-Davidson announced that it was attempting to register the exhaust sound of a Harley-Davidson motorcycle. Sound files such as chimes and exhaust sounds can be searched to some degree using tools such as FindSounds.com, a free site where you can search the Web for sound effects and musical instrument samples. FindSounds Palette is a software program that lets you search more than one million sounds on the Web and helps you organize and search your own sound collection. Each month FindSounds.com and FindSounds Palette process more than 2,000,000 sound searches for more than 200,000 users. FindSounds has been profiled on television and radio, in magazines and newspapers, and on countless Web sites.

9. Any Other Web Applications Help Trademark Searchers?

Have you ever gone to the US Patent & Trademark Office's "TARR" web page to check the status of a trademark application? Have you tired of typing in the same serial number day after day on that web page to obtain the current status of a trademark application? Then you may wish to try free Feathers® software developed by the firm Oppedahl & Larson LLP. The Feathers software lets you build up a list of the US trademark applications and registrations which you would like to monitor. You can run the software to obtain the status of each application and registration. Later, you can run the software again, and it will tell you what changes there have been to the status of the applications and registrations. The software can automatically send an email notification to one or more email addresses whenever the status of an application or registration changes. The software will also create a web (HTML) page which you may choose to place on an intranet web site for easy viewing and searching by persons within your organization.

TrademarkHunter™ is a software program that helps attorneys, businesses and entrepreneurs search, download, manage and generate search reports

for United States federal trademarks. Unlike commercial providers who charge for a single search session, searching and downloading federal trademarks with TrademarkHunter is free because TrademarkHunter searches and downloads trademarks directly from the U.S. Patent & Trademark Office website. TrademarkHunter was created by an intellectual property attorney, Michael S. Neustel of Neustel Law Offices, LTD. TrademarkHunter™ has the following features:

- Free searching and downloading of U.S. federal trademarks.
- Create professional trademark Search Reports.
- Import & Export Search Sessions Between Users.
- Easy trademark management in folders.
- Directly e-mail trademarks to others.
- Automatically redownloads failed downloads.
- Intuitive and easy to utilize search interfaces.
- Unlimited free product support.

10. Never Ending Web Developments?

As I went to put the final touches on this piece, I scanned recent issues of *Information Today*. Remarkably, I found a number of articles which could deal with trademark searching and the Web.

The March 2006 issue had an article on Google Video, marketed as the world's first open online video marketplace, where you can search for, watch and even buy an ever-growing collection of TV shows, movies, music videos, documentaries, personal productions and more. Just type in your search term (try NIKE) or do a more advanced search and Google searches their archive for relevant results. You can watch brief previews by clicking the “play” icon in the image thumbnail. Clicking on a thumbnail image will take you to a play-back page, where you can watch the preview or, for free content, the video itself.

The February 2006 issue discussed blinkx TV, which offers free searching of TV and radio content. blinkx creates its indexes from both Web-based video content and from direct video feeds, using its proprietary technology to create a searchable transcript. Users actually access a pop-up window with the video playing.

The December 2005 issue announced a product developed by trademark lawyers. RevaTrademark from RevaWare offers all these features at prices small and mid-sized firms might afford: track clients and their trademarks, merge from the database into Word letters or Outlook emails, check a trademark's

status on the USPTO with a single click, view and print all critical trademark dates from a single screen, track the actions you've taken on a trademark, create custom date templates for any jurisdiction, easily sort and filter your data, then choose from dozens of printed reports. Try the free demo version!

The November 2005 issue announced Questel•Orbit® announced a merger agreement to acquire Edital (<http://www.edital.com>), a Brussels-based provider of intellectual property solutions. According to the article, “[f]or the past five years, Questel•Orbit® has followed a vertical integration strategy in the patent area and is now merging with a company that followed the same path in trademarks. The companies stated that the agreement allows two complementary companies to join forces and confirm their global presence in both the trademark and patent markets.”¹⁷

11. Searching Registrations in National Offices – What is the Role of the Free Web?

Mary M. Squyres, has been an excellent longstanding resource for considering complex issues presented by foreign trademark searches.¹⁸ Consider all of the complex questions introduced above and then apply them to the many foreign national offices and trademark searching vendors. Here are a few of the considerations from *Trademark Practice Throughout the World*.

a. How Do We Deal with the Lack of Technological and Legal Uniformity Searching Foreign Marks?

Information a trademark search can provide – Identical or nearly similar phonetic marks

As discussed, the trademark practitioner should understand the breadth of the search to pick up phonetically similar marks. Often, the breadth depends on the searcher himself/herself and how the searcher frames the search. Some countries can still only offer manual searches. The trademark practitioner should inquire as to the searcher's methods as he or she goes through the records of the trademark office. The understanding of a search method is crucial to interpreting the results of the search. It is also important to determine if the searcher considers transliteration/translation/connotation issues.¹⁹

¹⁷ *Information Today* (Nov. 2005).

¹⁸ Mary M. Squyres, *Trademark Practice Throughout the World*, 1 *Trademark Prac. Throughout the World* § 2:0 et seq. (Westlaw Database, Apr. 2005).

¹⁹ *Id.* at § 2:3.

Information a trademark search can provide – applicant, registrant, trademark owner

Foreign manual searchers may not be able to perform this function if the records of the trademark office are not organized in such a way that this information is accessible. And it is important to note that not all searching software has this capability.²⁰

Information a trademark search can provide – Specific goods/services for a given mark

This information is not always available in those countries where an applicant can file for a class heading or a class number. This information is available on the databases of those countries which make an applicant limit its goods/services to those for which the mark will be actually used, e.g., common law jurisdictions in the United States and Canada (no classes) and civil code jurisdictions like Taiwan or Korea, etc. This information can give a strong indication of the goods/services actually used by the owner. A trademark practitioner may want to search one of these jurisdictions where he/she knows the mark that may prove to be an obstacle is registered in order to ascertain the goods/services of a given mark and possibly then determine the type of business that the applicant/registrant operates.²¹

Information a trademark search can provide – Designs

Only very limited numbers of software can search designs from the records of a given trademark office. This type of searching is available primarily through associates or search bureaus.²²

Civil code jurisdiction – Importance of civil code jurisdiction to the trademark owner.

Searching will tell the potential trademark owner who wishes to register its mark in a civil code country whether there are possible obstacles to that registration. In that rights are statutory and come from registration, there are no rights if a mark is not registered. Thus, only those marks which are registered may act as some type of block to registration or use of a mark. A trademark practitioner can therefore more readily advise searching in a civil code country before filing or using a mark in a given country.²³

²⁰ *Id.* at § 2:4.

²¹ *Id.* at § 2:5.

²² *Id.* at § 2:6.

²³ *Id.* at § 3:6.

Common law jurisdiction – Importance of common law jurisdiction to the trademark owner

Searching Reliability of searching in a common law jurisdiction is dependent on the sophistication and capabilities of the searchers in that jurisdiction. Not all common law jurisdictions offer searching possibilities for common law users such as databases of trade directories, trade names, telephone books, media, etc. Consequently, a trademark owner may not find potential senior users of a mark through searching. Therefore, it is somewhat more tenuous and unreliable for the trademark practitioner to advise searching in a common law country where it is virtually impossible to ascertain any senior users through databases or other means. Although searching can alert the trademark owner as to whether possible obstacles exist to registrability of a mark and from infringement lawsuits, searching will not necessarily inform the trademark owner of all potential conflicts with senior users.²⁴

Socialist law jurisdiction – Importance of socialist law jurisdiction to the trademark owner

Searching the availability of searching databases is more of an issue under the newly developed systems. Clearly, a trademark practitioner will have to work with the local associate to determine the searching capabilities of any given jurisdiction. Investigations of use of a mark and of businesses are also a newly developing capability in the newer jurisdictions. Often, the trademark owner's distributors, employees, licensees, and other local resources will be a more reliable source of information than unrelated third-party sources.²⁵

On the topic of foreign and international trademark searching, C.J. Fall and C. Giraud-Carrier, review various issues related to techniques for searching through collections of trademarks for phonetic and other verbal similarities.²⁶ Based on recent case studies, they survey judicial arbitrations that have established whether trademarks are similar or not and comment on popular algorithms for performing approximate searches, both phonetically and based on letter sequences. The particularities of international registrations and multilingual trademarks are also discussed. Overall, they conclude that “fuzzy searching for verbal similarities is a difficult task that calls for a cautious attitude. No solution can guarantee a fully automatic procedure. A manual validation of results will always need to be performed.”²⁷

²⁴ *Id.* at § 3:14.

²⁵ *Id.* at § 3:21.

²⁶ C.J. Fall & C. Giraud-Carrier, *Searching Trademark Databases For Verbal Similarities*, World Patent Info. 27, 135-43 (2005).

²⁷ *Id.*

So, is it fair to conclude that technology has not helped close the “Z Factor” gap with foreign searches? Do we still need to hire local searchers or counsel in many countries?

b. What Help from the Free Web?

Over the past five years the premium Dialog® Web collection of trademark databases has progressively grown to several dozen files. European and Central European files grew more recently with the addition of:

TRADEMARKSCAN® Ireland

TRADEMARKSCAN® Lithuania

TRADEMARKSCAN® Sweden

TRADEMARKSCAN® Norway

TRADEMARKSCAN® Finland

TRADEMARKSCAN® Czech Republic

TRADEMARKSCAN® Hungary

TRADEMARKSCAN® Poland and

TRADEMARKSCAN® Mexico being the most recent.

The question is why the producers invest in new files with the growth of trademark searching on the free Web. Could it perhaps be some value added to a uniform set of files that can be searched using words in the mark or with the powerful Rotated Trademark index (TR=)? Could it be the capability to perform group file searches?

While premium vendors have been adding new files, INTA has been monitoring free searching sites at national offices. In the 2000 February and March issues of the *INTA Bulletin*, *Bulletin* Editors issued a series of mini-reviews of free trademark searches offered via the Internet by various governments. In 2002 the Editors of the *Bulletin* provided an update on the sites covered in 2000 as well as reviews of new sites. The mini-reviews identified how well the database work, their ease of use, and the quality of the search reviews available.²⁸

The question is to what extent has this changed over the past several years? To what extent has technology served to make new and existing search sites more sophisticated? What lessons, if any, have new search sites learned

²⁸ See 55 *INTA Bulletin*, Nos. 2 & 3 (2000); see also 57 *INTA Bulletin* Nos. 1 & 2 (2002).

from existing sites? Answers to these questions is beyond the scope of this discussion. But, I will at least update the INTA list.

The INTA mini-reviews were of the following free Websites:

- Australia
- Canada
- United Kingdom
- European Community
- Hungary
- Japan
- New Zealand

I tasked my Assistant, Marilee Owens, MLS, to use the INTA portal of foreign office Websites to locate new sites offering trademark searching. She discovered approximately twenty additional national office with English search capabilities. The sites are in Appendix 1. These sites will be the subject of future articles in IDEA and perhaps by the editors of the *INTA Bulletin*.

Her summary of the survey was rather surprising, “Many trademark offices in non-English speaking countries have English search capabilities. Surprisingly some of the most developed nations, including Germany and France, had searches but none in English. Another surprise was the fact that many former Communist nations like Estonia and Lithuania have searches in English. Many Asian countries also have English searches. Another interesting fact is that some countries charge to do searches, like the Ukraine.”

She concluded that Countries with the best search engines include Canada, England, the EU, Australia, Benelux, and India.

VII. LEGAL

A. *What is the Effect of the Madrid Protocol on Trademark Searching and Clearance?*

In 2003 Nina Shreve in, *International Trademark Registration: The Madrid Protocol Takes Effect* predicted that “[f]inally, it is expected that implementation of the Madrid Protocol will greatly complicate and increase the cost of trademark searching and clearance in the United States.”²⁹ In order to

²⁹ Nina Shreve, *International Trademark Registration: The Madrid Protocol Takes Effect*, <http://library.findlaw.com/2003/Oct/17/133095.html>.

conduct a thorough search it will now be necessary to check records of international registrations for which coverage is or may be extended into the United States.

A review of the literature does not shine much light on the question of the impact of the Protocol on cost and search strategies. Web searching shows that the topic has been discussed over the last several years in a number of trademark CLE presentations.

The impact on trademark searching was addressed in detail in several INTA publications in 2003. The first discussion was part of the *Issue Brief, The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice 25* (INTA April 2003):

[C]omprehensive up-to-date searching of USPTO records is critical to ensure the availability of a proposed mark. Participation in the Madrid Protocol affects U.S. trademark searching and clearance in several respects. First, if it becomes clear that trademark registration in the U.S. by non-nationals is more efficient and/or less costly under the Madrid System, then more non-national applications (or extension requests) are likely to be filed. This would increase both the number of marks to be searched and the potential for conflict. Second, the “period of uncertainty” (the time during which a search will not reveal all possible conflicts) is longer, thus increasing the risk that a third-party application may have been filed in the interim, or the risk that a third-party application with superior Convention priority only later comes to light. Finally, U.S. trademark owners are likely to expand their search parameters to include WIPO's trademark records (which are now available online), which will increase search costs.³⁰

The second publication was an excellent article in *The Trademark Reporter*, P. Jay Hines and Jordan S. Weinstein, *Using The Madrid Protocol After U.S. Accession*, wherein the authors discuss how the Protocol will increase trademark search leverage. It is worth restatement in full:

United States accession to the Protocol will increase the leverage of international searching. The database of International Registrations concentrates the value of each mark in the register because each registration potentially represents 60 national registrations. Furthermore, International Registrations may be a more likely basis for seeking protection in the United States than national applications because the registrant has already invested in an extra-national filing in at least one country (and most likely several). Applicants can file International Applications with their local trademark office; International Registrants can seek extension of protection through their local trademark office or directly with WIPO. Neither will have to engage a U.S. attorney for the filing.

³⁰ Issue Brief, *The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice*, 25 (INTA, Apr. 2003).

Therefore, International Registrants risk only the filing fees and the cost for requesting an extension, and at least at the outset not U.S. counsel's filing fees.

New entities contemplating filing an application for trademark registration in the United States are well advised to consider adding WIPO's International Register to their list of sources when searching for potentially conflicting registrations. The cost of searching the additional database is worthwhile because: (1) International Registrants may have greater economic incentive to seek protection in the United States than owners of national applications; (2) WIPO's International Registration database includes registrations from each of the fifty-eight countries that are currently members of the Madrid Protocol, providing a large scope of potentially conflicting registrations, searchable online, and thus keeping costs, search and opinion time fairly manageable; and (3) Protocol International Registrations from every country may all be viewed--and searched--in English, while many national trademark databases are in the country's national language only, potentially requiring many different translations.

Once the Protocol becomes effective in the United States on November 2, 2003, all International Registrations currently on file with WIPO will be eligible for extension of protection into the United States. International Applications and Registrations based upon basic applications filed in Paris Convention countries within six months before U.S. accession may claim priority dating back to the filing date of the basic application. Therefore, when the United States accedes to the Protocol, such International Registrations extended to the United States that day may claim priority back to May 2, 2003, and be cited against later filed basic applications in the United States.

When a U.S. applicant seeks foreign trademark protection, a search of International Registrations may be beneficial even if the applicant does not ultimately use the Protocol as a filing vehicle. The International Registry contains a database of trademark registrations and applications that have been filed in at least two countries, and in most cases more than two because there is little or no cost savings to use the Protocol system for only a single filing. Every reference is available in English, making it unnecessary to obtain translations. Although the database is not conclusive because it does not contain national filings, it is nonetheless a good screening tool to eliminate some potential conflicts. One should always search the International Registry before filing an International Application. Although WIPO will not refuse to register one International Application because it is confusingly similar to another, the trademark offices in the designated countries are likely to do so.³¹

The authors then go on to discuss searching for owners of international registrations seeking to extend protection to the United States:

The owner of an International Registration seeking to extend protection of its mark to the United States should consider searching the USPTO trademark records. For the reasons discussed above, this database contains the references

³¹ Hines & Weinstein, *supra* n. 5, at 1004.

most likely to be cited against the extension request--and most likely to serve as a basis for an opposition or lawsuit to prevent use of the mark. But searching the International Register makes as much sense for foreign applicants seeking protection in the United States as it does for U.S. applicants seeking to eliminate sources of conflict from overseas. Having an International Registration does not prevent others from obtaining an International Registration for the identical mark, so long as each is based on a basic application that matures into a registration. For example, an entity in Greece and an entity in France could each have the identical mark registered in their respective countries. Both would be entitled to an International Registration so long as the other formalities are met; WIPO does not examine International Registrations for likelihood of confusion with prior marks.³²

The INTA Issue Brief turned out to predict the future. The major trademark search vendors quickly included Madrid databases and searches in their product lines. For example, Business Wire® on November 3, 2003 reported: *U.S.-Designated Madrid Protocol Trademarks Now Included in CCH CORSEARCH Federal Searches; International Treaty Brings New U.S. Clearance Issues*:

CCH CORSEARCH will now include U.S.-designated Madrid Protocol trademarks in their U.S. federal searches to ensure complete U.S. coverage . . . since these trademark filings will be important to consider when clearing U.S. trademarks, all CCH CORSEARCH U.S. federal trademark searches will now include coverage of U.S.-designated Madrid Protocol trademarks. The USPTO will not be including these trademarks in their database until January 2004, so CCH CORSEARCH will be searching the WIPO database directly to provide complete U.S. coverage. In addition, U.S. trademark owners can also use the Madrid System to file trademarks internationally directly at the USPTO. CCH CORSEARCH also offers a complete line of international trademark search services in all Madrid Protocol countries.³³

Ann Candura, Dialog® Client Services, offered training *The Madrid Protocol: Taking U.S. Trademark Searching on Dialog to a New Level*, “[a]lthough the Madrid Protocol now makes it easier and more cost-effective for U.S. trademark owners to obtain international trademark registrations, special considerations must be made with regard to searching.”³⁴

The question in 2006 is what additional lessons trademark searchers and lawyers have learned over the last several years.

³² *Id.*

³³ *U.S.-Designate Madrid Protocol Trademarks Now Included in CCH CORSEARCH Federal Searches; International Treaty Brings New U.S. Clearance Issues*, Bus. Wire (Nov. 3, 2003).

³⁴ Ann Candura, *The Madrid Protocol: Taking U.S. Trademark Searching on Dialog to a New Level*, Dialog Trademark News, Issue 1 (July 2005).

B. Is There Now a Duty to Perform a Trademark Search?

Good question. The bottom line legal answer may still be no, but the good lawyer answer is maybe! Let's look at the question from several angles.

1. Trademark Law

There is still no statutory duty to perform a trademark search before using a mark. Because of the risk of infringement or being forced to drop the use of a mark, practitioners and commentators almost universally recommend knockout and full searches. Whether and under what circumstances a trademark search was performed has become a hot topic since *Int'l Star Class Yacht Racing Ass'n v. Tommy Hilfiger, U.S.A., Inc.*, 80 F.3d 749, (2d Cir. 1996) which focused on the question from an infringement angle. Although there were earlier cases that looked to the question, it has been the *Hilfiger* cases which have caught the attention of legal authors. The literature review shows dozens of articles, which focus on this case. The Westlaw® IP-TP search on trademark searching articles shows the case cited now fewer than one hundred sixty two times. KeyCite® shows over three hundred citing references.

So, the question is where has *Hilfiger* led us? What is the current position in each of the circuits? We need a research tools and strategies approach. My literature review shows that loose-leaf treatises keep the researcher up to date on the issue. For example, Richard L. Kirkpatrick, presents a restatement of the law with up to date footnotes:

Prior to using a mark, one has no “duty” to conduct a trademark search or obtain advice of counsel in the sense that mere failure to do so automatically requires a finding of intent to infringe. Failure to search does not necessarily indicate bad faith, for example, if the defendant already knew of plaintiff's mark, or if it knew that no one else was using the mark for the product in question, or if the designation in question was believed to be descriptive. Failure to search is often deemed marginal or irrelevant to findings of both good faith and bad. Failure to search may not be a material omission if plaintiff's mark would not have appeared in the search report. However, failure to search or investigate can contribute, sometimes dramatically, to findings of intent to confuse when the failure is viewed in combination with other inculpatory facts, e.g., disregarding advice of counsel or taking advantage of economic power over the plaintiff. Failure to search in aggravated circumstances may be deemed “willful ignorance” reminiscent of two of the famous trio of monkeys who, by covering their eyes and ears, neither saw nor heard any evil.³⁵

³⁵ Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law* 8:5 (P.L.I., Nov. 2005).

Also consider reviewing CLE materials on this topic.³⁶

2. Malpractice and Ethical Considerations

Given all this uncertainty, what is the duty of care? What scenarios create malpractice? If cheap/poor reports and searching are a practice, are dire predictions of malpractice myth or reality? Comprehensive searching, discussed herein, can be very time consuming and expensive. What if the client puts you on a budget? What if the client can't afford a full search. Are the use of disclaimer letters adequate? While I found no malpractice cases, I did find warnings in the legal literature on the subject.

Jennifer Ward reports that, "the importance of due diligence in adoption of a mark has been emphasized by recent federal decisions which have suggested that an attorney who does not at least advise its client to obtain a comprehensive trademark search may be liable for negligence constituting malpractice."³⁷

Shane E. Greenberg warns that, "if a client refuses to heed the advice to do a full trademark search, as in *Hilfiger*, an attorney should be sure to document the advice given in case of malpractice."³⁸

Jane Shay Wald reports that, "[i]n an unreported 1996 trademark preliminary injunction hearing in the Central District of California, the Court pronounced it 'malpractice' for counsel to have failed to conduct a trademark search prior to opening three restaurants under the same name as the plaintiff's well-known food establishment."³⁹ Michael R. Friscia and Joshua L. Cohen, advises that "[t]o avoid malpractice, and to prevent the client from being sued for infringement, the careful attorney should conduct a trademark search on the proposed corporate name well in advance of the anticipated incorporation."⁴⁰

³⁶ See e.g. Richard L. Kirkpatrick, *Advanced Seminar On Trademark Law 2005, Trademark Searches And Advice Of Counsel* 834 PLI/Pat 97 (P.L.I., June, 2005).

³⁷ Jennifer Ward, *Trademarks 101*, 15-APR Utah B.J. 18 (Apr., 2002).

³⁸ Shane E. Greenberg, *The Crucial Step Of Performing A Full Trademark Search Prior To Use*, 4 *Intell. Prop. L. Bull.* 15 (Spring, 1999).

³⁹ Jane Shay Wald, *Ethical Issues In Trademark Practice - Current Developments*, SA71 ALI-ABA 125 (ALI-ABA, Apr. 18, 1996).

⁴⁰ Michael R. Friscia & Joshua L. Cohen, *Trademark Use Of Corporate Names*, 41 No. 2 *Prac. Law.* 19 (Mar. 1995).

3. Ethics

Another way lawyers get in trouble is violating ethical obligations. Again, while there are no reported cases, there are plenty of cases and commentary which suggest that failure to perform adequate research is a breach of the duty of competence, diligence and others. Other cases arise in the context of sanctions, abuse of process, contempt and what are known as the “scolding cases” where judges lambaste lawyers in opinions. A review of these cases is in many legal sources, but an excellent article is, Ronald B. Standler, *Why Do Legal Research*, <http://www.rbs2.com/legres.pdf> (2005).

VIII. CONCLUSION

As promised, this piece raises many questions. The answers turn on who the reader is and what applications they have for trademark data. Databases and search vendors range from free to premium. I hope this piece raises the questions and provides references to help think through the choices. Some of these questions will be discussed in future issues of IDEA. The answers you might formulate today will likely be different in the future with the development of further technology and competition. Yet, as I close this piece, I still hear the voices of the trademark faculty saying, “farm it out to T&T,” and wonder whether all these words are for the fascination of search professionals.

APPENDIX A: ENGLISH TRADEMARK SEARCH FUNCTIONS ON FOREIGN TRADEMARK OFFICE SITES

prepared by Marilee Owens, MLS

Algeria: <http://www.inapi.org/en/accueil/index.php>

Andorra: <http://www.omp.ad/indexang.html>

Argentina: No English resources, www.inpi.gov.ar

Armenia: No English Search, <http://www.armpatent.org/english/index.html>

Australia: Has several which can be found at <http://www.ipmenu.com/country/australia.htm#TRADEMARKS>

Austria: http://www.patentamt.at/Content.Node_opa_internet/Home/Markenschutz/Wienerforschungsbereich/11711_1.html

Azerbaijan: No English resources, <http://www.azpat.org/english/>

- Bahrain: Part of GCC, website not available at this time.
- Barbados: <http://caipo.gov.bb/search/search.php>
- Belarus: No English Searches, <http://www.belgopatent.org/english/>
- Belgium: See Benelux
- Belize: <http://www.belipo.bz/search.html>
- Benelux: <http://register.bmb-bbm.org/bmbonline/intro/select.do?language=en>
- Bolivia: No English Searches, <http://www.senapi.gov.bo/>
- Bosnia: Website no longer available.
- Brazil: No English resources, <http://www.inpi.gov.br/>
- Bulgaria: <http://www.bpo.bg/en/on-line.html>
- Canada: <http://strategis.ic.gc.ca/cipo/trademarks/search/tmSearch.do>
- Chile: Search but no English, <http://www.dpi.cl/tapa.asp?cuerpo=486>
- China: Websites not available at this time, www.ctmo.gov.cn
- Columbia: No English Searches, <http://www.bancopatentes.gov.co/>
- Costa Rica: No Trademark websites
- Croatia: No English Searches, <http://www.bancopatentes.gov.co/>
- Cuba: No English searches, <http://www.ocpi.cu/>
- Cyprus: No English searches, <http://cy.espacenet.com>
- Czech: <http://isdvapl.upv.cz/pls/portal30/oz.OZFRM>
- Denmark:
<http://onlineweb.dkpto.dk/pvsonline/varemaerke?action=201&subAction=front&language=GB>
- Dominican Republic: No Searches available,
<http://www.ipmenu.com/ipfirms/dominicanrepublic.htm>
- Ecuador: No Trademark website
- Egypt: No English searches, www.egypo.gov.eg
- El Salvador: No English on website, <http://ias.cnr.gob.sv/PI/online/>
- Estonia: <http://www2.epa.ee/Patent/mark.nsf/SearchEngl?OpenForm>
- Europe: <http://oami.eu.int/en/default.htm>
- Fiji: No website yet
- Finland: http://tavaramerkki.prh.fi/default_en.pl
- France: No English Searches, www.inpi.fr
- Georgia: No Searches yet, www.sakpatenti.org.ge

Germany: No English Searches, www.dpma.de/index.htm
Greece: No English Searches, www.obl.gr/online
Guatemala: No website
Haiti: No web site
Honduras: No English, <http://www.sic.gob.hn/PINTELEC/indice.htm>
Hong Kong: <http://ipsearch.ipd.gov.hk/trademark/jsp/index.html>
Hungary: http://www.hpo.hu/English/adatbazis/kozlonny_ab/
Iceland:
<http://www.einkaleyfastofan.is/focal/webguard.nsf/BrandENG/SimpleSearch>
India: <http://www.tmrindia.com/>
Indonesia: <http://www.dgip.go.id/cari/>
Irish: <http://www.patentsoffice.ie/eregister/Query/TMQuery.asp>
Israel: <http://patentim.justice.gov.il/>
Italy: No English Searches, <http://www.minindustria.it/>
Japan: http://www.jpo.go.jp/quick_e/index_search.htm
Jersey: <http://www.gov.je/JudicialGrefe/>
Jordan: No search capabilities, www.mit.gov.jo
Kazakhstan: No Searches, www.kazpatent.kz
Kenya: website not available, <http://www.kipo.ke.wipo.net/index.html>
Korea (South): <http://www.kipo.go.kr/eng/index.html>
Kuwait: No website
Kyrgyzstan: No English Searches, www.krygyzpatent.org
Laos: No Searches, <http://www.stea.la.wipo.net/aboutdism/index.html>
Latvia: <http://www.lrpv.lv/index.php?lang=EN&id=149>
Lebanon: No website
Lichtenstein: No website
Lithuania: <http://www.vpb.lt/engl/db/>
Luxembourg: See Benelux
Macedonia: No online English searches, www.ippo.gov.mk
Malawi: No website
Malaysia: <https://v880svr1.mipc.gov.my/online/main/main.cfm>
Mexico: No searches yet, www.impi.gob.mx

Moldova: No English Searches, www.agepi.md

Monaco: No website for Trademarks

Netherlands: See Benelux

New Zealand:

http://www.iponz.govt.nz/pls/web/DBSSITEN.main?p_access_no=&p_option=IPSEARCH

Nicaragua: No website

Norway: http://www.patentstyret.no/templates/Page____730.aspx

Oman: No website

Panama: No English Searches, <http://www.digerpi.gob.pa/>

Papua New Guinea: No Searches, <http://www.ipa.gov.pg/reasons.htm>

Paraguay: No Website

Peru: No English Searches, www.indecopi.gob.pe

Philippines: <http://ipophil.gov.ph/>

Poland: <http://www.uprp.pl/English/PPOs+databases/>

Portugal: No English search function, www.inpi.pt

Qatar: No Website

Romania: http://www.osim.ro/index3_files/database/datab.htm

Russia: <http://www.fips.ru/ensite/>

Saudi Arabia: No Website

Singapore: <http://www.ipos.gov.sg/main/index.html>

Slovak Republic: <http://www.indprop.gov.sk/eskipo.php?lang=en&idd=2>

Slovenia: <http://www2.uil-sipo.si/dse.htm>

South Africa: No Searches, <http://www.ipa.gov.pg/reasons.htm>

Spain: <http://www.oepm.es/Localizador/homeLocator.jsp>

Sri Lanka: Website not available

Sweden: Swedish only, www.prv.se

Switzerland: <http://www.ip-search.ch/E/default.htm>

Syria: No website

Taiwan: No Searching yet, <http://www.tipo.gov.tw/eng/>

Tajikistan: No Searches yet, www.tjpat.org

Thailand: No English search yet, <http://www.tipo.gov.tw/eng/>

Trinidad: Website not available

Turkey: no English search yet, www.turkpatent.gov.tr

Turkmenistan: No website for trademarks

Ukraine: <http://www.ukrpatent.org/cgi-bin/searchTM> \$

United Arab Emirates: No website

United Kingdom: <http://www.patent.gov.uk/tm/dbase/index.htm>

United States: <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=r1lhg4.1.1>

Uruguay: Website currently down

Uzbekistan: <http://www.patent.uz/eng/index.htm>

Venezuela: No website

Vietnam: No website

Zambia: No website

Zimbabwe: No website