

TRADEMARK CLEARANCE LEGAL OPINIONS

As your business begins to offer its products or services to consumers, it is wise to consider protecting your brand's name and image through trademarks. Think of trademarks as the face of your business, product, or service. They function to identify the source of a product or service, that is, connect your product and chosen mark to the identity of your brand in the minds of consumers. In short, trademarks are an important part of how any business represents itself and its products or services to current and potential customers. Therefore, they can be a key feature of brand building and marketing strategies for cultivating customer recognition with a view to increased business and profitability.

Before you begin using a mark to identify your brand, you should have a trademark clearance search conducted. This will allow you to determine whether there are any existing marks in use that are similar or identical to the one you wish to use, thereby avoiding wasted resources by having to change course later¹ and potentially being sued for infringing an existing trademark.

The government grants trademark rights based on use alone and not necessarily on registration. Therefore, only searching the USPTO database is not sufficient to determine whether your desired mark is free to use. Hence, one ought to investigate both existing and lapsed federal and state registrations, pending trademark applications, abandoned trademarks, databases of company business names, trade directories, brand registers, product catalogs, newspaper listings, domain names, design code logo searches, as well as common law (or unregistered) use of the mark to determine the obstacles a proposed mark's registration would face.

There are many reasons why the USPTO may reject an application. Instructing an IP attorney to conduct a search and to provide a legal opinion can help identify such risks in advance. Such a search and legal opinion can also provide significant benefits compared to the small resources spent. Your resources will be well-allocated to potentially save you a future headache.²

Although no trademark search can ever be completely definitive,³ once a search is conducted, then an analysis must be undertaken as to whether the proposed mark may be conflicting in any way and to what extent. Sometimes conflicts are obvious, such as near-duplicate marks. However, much more often, there

1 If you attempt to register your trademark without first clearing it, your company's proposed trademark may be rejected by the USPTO for being identical or confusingly like another's mark.

2 See, e.g., Lang v. Retirement Living Publ'g Co., Inc., 21 U.S.P.Q. 2d 1041, 1047 (2d Cir. 1991); Breuer Elec. Mfg. Co. v. Hoover Co., 48 U.S.P.Q. 2d 1705, 1716 (N.D. Ill. 1998). Here, counsel's trademark search & opinion letter was successfully relied upon to defend against willful infringement and mitigate potential damages exposure.

3 Due to possible delays in uploading mark information to the various government agencies and in having them displayed by those agencies, state or federal. Also, common law trademarks come from disparate sources, such as trade publications and yet they might not appear in any database that is normally searched.

will be varying degrees of similarity or other potential hurdles that will necessitate an evaluation to determine the likelihood of a successful registration. A legal opinion letter can guide you through these hurdles and provide you with an educated analysis of these issues, thus giving you valuable knowledge for maximizing your brand building strategy.

At **FALATI**[®], we have a basic and an advanced trademark clearance and legal opinion package. For the basic package, a preliminary search is conducted using various key words in search engines and other databases, to determine if there are any existing marks that will “knock-out” your proposed mark, *e.g.*, for being identical or confusingly similar. Our advanced trademark clearance and written legal opinion package includes a more exhaustive search and discussion of the potential legal issues that could arise.

Obtaining a trademark search and legal opinion is not required for filing a trademark application. However, on a balancing of benefits versus cost, it can be a good idea to ask your IP counsel to complete such a search and opinion letter prior to applying for a trademark.

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Should you have questions related to the above or seek legal assistance on a patent, trademark, copyright or related matter, please send an email to us at Mail@Falati.com. Your email must only be two sentences:⁴ one to state your name, company’s name and contact info. and the second sentence to very generally describe the type of assistance you need.⁴ We will follow-up with you thereafter.



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⁴ Please note we are not your attorneys unless we converse with you and explain what needs to happen before we can become your attorneys.