

**United States**  
**TRADEMARK SEARCHING**

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After a new mark has been selected, it should be determined if it is free for use. Because trademark rights are based on use or federal intent to use filings, the first to use a mark, or apply to register under the intent to use statute, owns it.

Prior searching before adoption and proper follow-through on the results of a search can be critical. In an important case, International Star Class Yacht Racing Association v. Hilfiger, 80 F. 3d 749 (2d Cir. 1996); 38 USPQ2d 1369, the Second Circuit concluded that an infringing clothing manufacturer had acted in bad faith in part because only a cursory trademark search was conducted without follow-up. In that case, Hilfiger wished to market a STAR CLASS line of clothing based on its knowledge of the Star Class Yacht Racing Association, an exclusive yachting group. A screening search of only federally registered marks in Class 25, the clothing class, revealed no registrations. Although counsel advised that a broader federal and further common law search be conducted, the client did not do so. Upon receiving a cease and desist letter from Star Class Yacht Racing, Hilfiger did not recall its clothing, but sold the line out, reasoning that no judgment could be obtained before all sales were made.

Failure to search thoroughly and continuing with sales after having been advised of the infringement were sufficient in the Second Circuit's view to support a finding of bad faith justifying disgorgement of profits to plaintiff (over \$3 million) and award of plaintiff's attorneys' fees. This case therefore significantly raised the stakes in searching and clearing marks.

Another serious factor with respect to evaluating the availability of marks is the passage of the federal anti-dilution statute, Section 43(c) of the Lanham Act, 15 U.S.C. 1123(c). The dilution statute provides protection for "famous marks" against their dilution - the tarnishment or blurring of a mark - which can occur in the absence of likelihood of confusion. While only "famous" marks may be protected by the federal dilution law, it nevertheless provides a basis for any owner of a trademark used on any product, no matter how unrelated, to protest a use of mark on even very different products or services.

Therefore, before advertising under a new mark, printing labels, letterhead, brochures, and the like, a trademark search should be conducted for each class of product or service on which the mark may be used.

Before ordering a formal search through a professional trademark search firm, clients and counsel should take advantage of free Internet search resources.

A good first place to look for potential conflict is in the United States Trademark Office website, [www.uspto.gov](http://www.uspto.gov). Marks may be searched free of charge. A brief search on Google or other

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reliable search engine is also a prudent first step before adopting a mark. The search can reveal not only if a third party is using the mark, but also if it has meaning in a particular industry and is thus descriptive. Another aspect of a preliminary search is to review registers of domain names. While offered as part of standard professional "full" searches, these types of searches should be performed by the interested party, in a law office or corporate law department as part of a "knock-out" or "screening" search. "Office searches", once consisting primarily of paging through a paper copy of the Trademark Register, now can be performed through a variety of search engines over the Web, as well as through pay-as-you-go on-line subscription services such as Trademark.com.

A search ordered from a professional search company typically canvasses state and federal trademark registrations, trade name and telephone book listings, trade directories in the trade areas in which a proposed mark shall be used, and Internet domain name listings to determine whether someone else already has used or applied to register the mark on identical, or related, goods or services. Although such searches are not an absolute guarantee that another party is not using a mark, or has established constructive rights, they are as comprehensive as necessary for most purposes and are relatively inexpensive. Be cautioned that considerable delays may occur in the processing of applications in the Trademark Office. Therefore, weeks can elapse between actual filing, which will create a constructive date of first use, and when the mark appears in Trademark Office records.

If a mark's availability is not checked before it is adopted, the user takes the risk that a prior user or applicant with superior rights could prevent use of the mark at a later date. Besides the inconvenience and expense of a legal dispute, the investment in months or years of goodwill as well as letterhead, signs, product labels, hang tags, and whatever else the mark has been used on, could be destroyed.

In some cases the same mark can be used by different persons on totally unrelated services or goods without confusion. For example, BLUE SHIELD mattress was found not to infringe the trademark rights of an entity selling BLUE SHIELD medical care plans. Nat'l Assoc. of Blue Shield Plans v. Standard Mattress Co., 478 F.2d 1253 (CCPA 1973). DOVE is used as a trademark for soap as well as for chocolate ice cream and chocolate confections.

Particularly strong marks, however, are accorded broad protection and may not be used even on unrelated goods and services. For example, although COCA COLA is used primarily on soft drinks, the owner of the mark probably could prevent its use on unrelated goods such as beach towels. Indeed, recent developments in merchandising demonstrate that the COCA COLA mark may very well function as a mark for clothing, beach towels and a variety of products that are not beverages.

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