



TRADEMARK SEARCHING: OFTEN WORTH THE COST

Before adopting a new trademark, consider whether or not to search its availability for use and registration. There are generally two kinds of trademark searching: computer database searching and full searching. Whether in the U.S. or abroad, we can run a computer database knockout search to preliminarily screen the availability of the mark. However, there are limits to the database search in terms of searching strategy and the data searched. In order to provide an opinion on the availability of the mark, we usually recommend ordering a comprehensive search. In the U.S., we order a full search from an outside provider. In addition to searching the records of the U.S. Trademark Office, the full search covers state registrations, domain name registrations, common law references, and the internet. Outside the U.S., we have local counsel conduct the searching. The primary benefit of full searching is knowing sooner rather than later whether there is any obstacle to adopting the mark. In the U.S., others have five years after registration to petition to cancel based upon priority and a likelihood of confusion, so obtaining registration is no guarantee that the mark is free and clear of risk.

TRADEMARK WATCH NOTICES: A GOOD VALUE

Once you fully search a mark and file an application, do not assume that the job is finished and nothing more need be done in order to entirely protect a mark. The U.S. Patent and Trademark Office should cite the mark against confusingly similar marks in later filed applications. However, the quality of examination is often inconsistent and conflicting marks may slip through and be approved. Plus, many foreign trademark offices do not even examine on so-called relative grounds. At least in the U.S., trademark law imposes a duty of vigilance on the trademark owner. The best way to fulfill that duty is to order a watching service. The watching service provides us with notice when a confusingly similar mark is published for opposition so that we can discuss with you whether an opposition is warranted. The cost of ordering an annual watching service, even on a worldwide basis, is quite low. An easy way to think about the difference between trademark searching and watching is that searching captures a snapshot of the register or the marketplace at any given time, but trademark watching is prospective in nature. Each has a role in fully protecting the valuable investment in trademark rights.

NEWS, MEDIA, AND UPDATES:

[Marty Schwimmer](#) spoke at the 20th Annual Intellectual Property Law & Policy Conference at Fordham Law School on April 12 & 13. Marty moderated a panel on the new gTLDs and discussed the protection of shapes. He addressed how 3D printing has the potential to do for three dimensional objects what the photocopier did to books – namely create great possibilities for creativity, but also potential for infringement. Marty also spoke on 3D printing and IP law at a seminar for the Intellectual Property Law Section of the State Bar of Michigan on March 25, 2013.

Leason Ellis advanced from 189 to 168 in the list of top U.S. patent filers in Intellectual Property Today magazine: <http://goo.gl/ocUH2> (subscriber view only). Utility patents obtained for our clients rose almost 25% over the previous year.

[Peter Sloane](#) moderated a Table Topic titled "Trademark Opinions: What Do They Look Like These Days?" at the INTA Annual Meeting in Dallas on May 4, 2013. Issues covered included the

function and form of opinions, disclaimers, the means of preparing and sending opinions, and different kinds of opinions including in the context of trademark searching word and design marks as well as infringement.

On February 26th, [Rachel Weiss](#) was a panelist on "Landing a Job in Entertainment and IP: A Panel Discussion and Resume Critique with Young Alums" at Brooklyn Law School.

[Elizabeth Barnhard](#) has joined the Editorial Advisory Board of the "Technology Transfer & Entrepreneurship" journal. The journal's publisher is Bentham Science Publishers and the first edition of the journal is slated for publication in 2014.

The Second Circuit affirmed a judgment granting summary judgment to Leason Ellis clients Scientific Games International, Inc. and Scientific Games Corporation, Inc. on claims of trademark infringement and related causes of action brought by The Gameologist Group, LLC. In affirming the judgment dismissing the case, the Second Circuit held that a license agreement, various

promotional efforts, and sales of approximately 250 products over several years cannot satisfy the use in commerce requirement necessary to support a trademark infringement claim. The case can be found at <http://goo.gl/tmngT>.

[Nicole Kaplan](#) and [Nathan Renow](#) have joined Leason Ellis. Nicole represents and counsels clients in all aspects of trademark clearance, prosecution and enforcement. She is a graduate of Fordham Law and the University of Michigan. Nathan focuses his practice primarily on patent prosecution and litigation, with additional experience in licensing. He received a J.D. from Cardozo Law School and a B.S.E.E. from The City College, CUNY.



Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, New York 10601
(914) 288-0022

Attorney Advertising