

## Introduction

No amount of trademark searching can completely clear a proposed mark for use and registration. There are numerous factors that determine whether one trademark is confusingly similar to another under Canadian or U.S. trademark law. Although there is no "litmus test" the following thirteen elements, when relevant, must be considered:

1. Appearance, sound, connotation;
2. Goods or services;
3. Channels of trade;
4. Care that is used in purchasing (i.e. Are the goods expensive?);
5. The fame of the prior mark;
6. Similar marks in use on similar goods;
7. Nature and extent of any actual confusion;
8. Concurrent use without actual confusion;
9. The variety of goods on which a mark is used;
10. Agreements/relationship between mark owners;
11. Applicant's right to exclude others;
12. The extent of potential confusion; and
13. Any other established fact of relevance.

## Types of Trademark Searches

**Web-based:** Searching the Internet through a comprehensive search portal (Google, Yahoo, MSN) is a good start. It is important to search for variants of a proposed mark. For example, if the proposed trademark is MATCHSTIK GUITARS it is appropriate to search at least:

MATCHSTIK	MATCHSTICK
MATCHSTIC	MATCHSTIK
MATCHSTICK	MATCHSTIC

**CIPO and USPTO:** The Canadian Intellectual Property Office (CIPO) and U.S. Patent & Trademark Office (USPTO) maintain searchable databases of registered trademarks and pending applications for registration. Just because a similar trademark is shown on the CIPO or USPTO search result does not necessarily mean that the proposed trademark cannot be registered. It is possible the trademark registrant has abandoned use of the trademark even though it is still technically registered.

**Thomson & Thomson "Full" Search:** Scope of this search includes: active USPTO applications and registrations filed with the USPTO since 1884, and expired, canceled or abandoned marks since 1984. New applications and status changes are updated daily, and provide enhanced Trademark Trial & Appeal Board detail; state trademark database including records from all 50 U.S. states, plus Puerto Rico and Guam; Shepard's Intellectual Property Law Citations are included as they pertain to trademarks involved in or cited in court decisions; search for trademarks that may not be registered but may be protected under common law rights, common law databases include Gale, Dun & Bradstreet and American Business Information databases; and domain names including the generic top-level domains .com, .edu, .gov, .info, .org, .net, .and .biz. Includes identical and similar Madrid Protocol applications and registrations which have requested protection in Canada and the United States. The Thomson & Thomson search is by far the most comprehensive and the only search report on which our office will write a formal opinion.

## What Level of Searching Should be Done?

**Reasons to Forgo a Full Search & Opinion:** If your company is already using a mark and has invested substantial marketing capital into a trademark then a full trademark search is optional. In addition, if the company is starting up with a limited legal budget, the cost a full trademark search may not be feasible.

**Reasons to Obtain a Full Search & Opinion:** The primary reason for conducting a full search is to reduce business liability. A full search has a better chance of spotting a potentially conflicting use before capital is invested in product or service marketing. In addition, use of a confusingly similar mark may expose the business to legal liability in the form of a trademark infringement lawsuit. Deciding whether to institute a full search and opinion comes down to a company's legal budget and its tolerance for risk. While a full search is no guarantee of permissible use and registration of the proposed trademark it is considered a standard procedure in business due diligence.

## Patentability Search

Before a client makes any investment in a patent application, we conduct a patentability search. Under the law, an invention is not new if it has been known to the public in any country. To evaluate the strength of the invention, we search the Canadian Intellectual Property Office (CIPO) and U.S. Patent & Trademark Office (USPTO) databases. Based on the search results, a client can decide whether to file a patent application. The patentability search is strongly recommended. First, if the invention is not new, the search prevents the unnecessary expense of filing an application certain to be rejected. Second, being familiar with other patents in the field allows us to draft a better application and present better arguments to the patent examiner.

## Patent Application

Drafting an application involves writing an abstract, specification, claims and selecting drawings and diagrams. The claims are the most important part of the patent: they define the scope of the inventor's rights. A claim can be thought of as a fence surrounding a parcel of land. The greater the fence, the greater the rights it encompasses. At the same time, a fence that encroaches on the property of another will be taken down. In other words, a poorly drafted claim will not protect the invention. A court will invalidate a patent containing such a claim. Not surprisingly, drafting patent claims involves specialized knowledge and skills.

The specification is a description of the invention. While not as crucial as the claims, the specification is also very important. If the meaning of a claim is disputed, one looks to the specification for resolution. Claims often stand or fall depending on the language of the specification. It must also be noted that, while claims can be amended during prosecution, nothing new can be added to the specification. While the inventor provides the material for the specification, it is the experience and skill of the patent lawyer that determines the strength of the patent.

## USPTO and CIPO Representation

After we submit a patent application, the CIPO or USPTO acknowledge its receipt and assign a serial number. The first office action addressing the merits of the application is expected in ten to eighteen months from the filing date. In almost every case the patent examiner requires that the application be amended before a patent can be granted. In some cases, the changes are minor. More often, however, the patent examiner comes up with several reasons why a patent should not be granted. Then it may take a series of written exchanges until, through argument and amendments, the examiner is persuaded to grant a patent. In terms of cost, this step is the least predictable. Accordingly, our office stays in constant communication with the client. The client always has a final say on whether we should proceed with the arguments in view of the additional costs. In our practice, we are often able to find a less costly option. For example, if the inventor is willing to curtail the scope of the claims, rather than continue the argument, the examiners are willing to accept the compromise and grant the patent.

## Continuation of Application

After the patent is allowed, the applicant pays the government issuing fee and receives the patent grant. For most of our clients, this does not end the journey of innovation. When the invention is further developed or improved, it is recommended that a continuation application is filed. In many cases, the continuation builds upon the prior application. As such an application often lands on the desk of the same patent examiner, it has become the case with our long-term clients, that the patent examiner and our lawyers have become very familiar with the technology, making any subsequent application process go much smoother and faster.

Through a continuous relationship with our office, some of our clients have amassed an impressive patent portfolio, giving them a unique advantage in the marketplace. The patent portfolio becomes an ever-expanding fence that grows further, as more land is being developed and added to our client's territory.