

CLEMENZA LAW GROUP

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THE PRIVATE BRIEF · CHECKLIST

The Trademark Clearance Checklist

Run this before the logo, the domain and the packaging, not after. Every item is cheap at the naming stage and expensive once the name is load-bearing. It will not tell you what the trademark office will do; nothing can. It will let you decide with the facts in front of you.

The reasoning behind each item is in the Trademark Owner's Handbook on this shelf.

Before you search

☐ **Place the name on the strength spectrum, honestly**

Coined or arbitrary: strong. Suggestive: good. Descriptive (says what the product is, does, or where it is from; or mainly a surname): expect a refusal. Generic: not ownable.

The name that sounds best in the meeting is often descriptive, because it does marketing work. That is exactly why it will be refused.

☐ **Have several candidates, not one**

Clearance eliminates names. A shortlist survives the process.

☐ **Settle the goods and services**

What you sell now, what you will sell within a few years, and which adjacent categories a buyer would assume you were connected to. These set the classes, and the classes set the boundary of the answer.

☐ **Check the obvious sources yourself**

A web search, the app stores, social handles, the domain. A business in your field already using the name ends the inquiry before it costs anything.

☐ **Flag any name that includes a living person, a place, or a surname**

Each has its own rules and its own refusal ground. A living person's name needs their written consent.

The searches

☐ **A knockout search on the shortlist**

The federal register for identical and near-identical marks in related classes, plus the obvious web and business-name sources. Fast; for deciding whether to keep thinking about a name at all.

☐ **A comprehensive search on the finalist**

A commissioned report across federal filings, state registrations, business-name filings, domain names and unregistered use in trade sources and on the open web, with a written opinion on the risk.

A free search of the federal database for the exact name is not clearance. The conflicts that hurt are similar, not identical, and many are not on the register at all.

☐ **Search for sound and meaning, not only spelling**

Marks that are spelled differently and sound the same are treated as the same. So are marks that mean the same thing.

☐ **Search the right classes, and the neighbouring ones**

A clean result in the wrong class is worse than no search, because you will believe it.

Reading the results

☐ **Ask the two confusion questions of every hit**

Do the marks feel like the same thing, in sound, look, meaning and impression? Would an ordinary buyer expect the goods or services to come from the same source?

☐ **Read for posture as well as presence**

A live registration for the name in your class is a stop sign. A family of registrations, oppositions and variants is an owner who will fight. A dead registration is a warning that someone wanted this name and may still be using it.

☐ **Weigh the unregistered users**

A business that has used the name in your field for years, without filing anything, has rights that can block you. Their absence from the register means nothing.

☐ **Get the opinion in writing**

The conflicts found, the reasoning and the risk, on paper. It is what you decide on, and what a buyer or investor will later ask to see.

☐ **Decide, and accept what a search cannot do**

It reduces risk; it does not remove it. An examiner may cite a mark you discounted; a third party may object on rights no search would surface. Registration is never guaranteed.

If the name clears: the filing decisions

☐ **The right owner**

The entity that controls the goods or services, usually the company. If the named applicant did not own the mark on the filing date, the application is void from the start and an assignment cannot cure it; a misspelled name for the right owner is a different thing and can be fixed.

This is the mistake that surfaces years later, in diligence, when the registration turns out to belong to nobody.

☐ **Use or intent to use**

Already selling: file on use with a real specimen. Not yet: file on intent to use, reserve the date, and calendar the proof-of-use deadline and its extensions.

☐ **Word mark first, logo second**

A standard-character word mark protects the wording without committing you to one stylized treatment, for the goods and services you registered it for. The logo protects a design that will be refreshed.

☐ **The identification of goods and services**

From the office's pre-approved language wherever it fits; drafted carefully where it does not. It sets the scope of what you own for the life of the registration.

☐ **The classes you use and will use soon**

Not every class imaginable. Each class you cannot prove use in is a weakness at maintenance and audit.

☐ Every date in a calendar the day the filing receipt arrives

The office action deadline (three months plus one three-month extension for most applications, six months and no extension for a Madrid Section 66(a) application), the publication window, the proof-of-use deadline, and, years out, the fifth-to-sixth-year maintenance window.

This is general information about how these instruments and obligations usually work, not legal advice about your situation, and reading it does not make you a client. Deadlines and requirements turn on facts particular to you: your fiscal year, your state, the agreement actually in front of you. Confirm your own before you rely on any of it.

THE ESSAYS BEHIND THIS

Protecting Your Name and Likeness: A Primer for Creators

clemenزالaw.com/insights/protecting-name-likeness-creators

Structuring Your Startup: LLC vs. Corporation

clemenزالaw.com/insights/startup-structure-llc-vs-corporation

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The current version of this checklist is kept at clemenزالaw.com/reference/trademark-clearance-checklist