

U.S. Trademark Registration Essentials I: Pre-Application Clearance Search—Why Checking for "Identical" Marks Is Not Enough

When preparing to apply for a U.S. trademark, many applicants start by entering their desired brand name into the official United States Patent and Trademark Office ("USPTO") search system. If the screen shows "no results found," they happily assume that the trademark is guaranteed to be approved.

This is actually the most common misconception in U.S. trademark applications.

When evaluating a trademark, the core standard used by the USPTO to determine registrability is called the **"Likelihood of Confusion"**. In other words, when an examining attorney reviews your application, they do not just see if someone has an "identical" mark. Instead, they look at it from the perspective of an ordinary consumer and ask: **"If this new trademark coexists with an existing mark in the marketplace, will consumers be confused about the source of the goods or services?"**

Therefore, simply checking for "identical" marks is far from enough. In a professional clearance search, we must evaluate three invisible landmines:

1. Similarity in Sound (Sound-Alike)

Even if trademark spellings differ, a high degree of phonetic similarity can easily lead to a refusal. For example, if you wish to apply for "KAIZEN" while "K-ZON" is already registered for similar goods, the examining attorney will likely issue an Office Action citing likelihood of confusion based on sound similarity, despite the different spellings. Likewise, homophones or easily confused phonetic components (such as S/Z, F/H, or K/C/Q) can also trigger a refusal due to similar pronunciation.

2. Similarity in Appearance and Commercial Impression

The USPTO places great emphasis on the "overall impression" a trademark creates, which includes translations and visual associations. For instance, if there is already a well-known trademark for "Apple" watches, and you attempt to register the Chinese characters for "蘋果" (Apple) for watches, the USPTO will likely find a likelihood of confusion. Even though one is in English and the other is in Chinese, they convey the exact same "commercial impression" and meaning.

SHENZHEN 深圳

Rooms 1203-06, 12/F.
Di Wang Commercial Centre
5002 Shennan Road East
Luohu District, Shenzhen, China
中國深圳市羅湖區深南東路5002號
地王商業中心12樓1203-06室
T: +86 755 8268 4480

SHANGHAI 上海

Room 1201, 12/F., Tower A
Guangqi Culture Plaza
2899A Xietu Road, Xuhui District
Shanghai, China
中國上海市徐匯區斜土路2899甲號
光啟文化廣場A座12樓1201室
T: +86 21 6439 4114

BEIJING 北京

Room 303, 3/F.
Interchina Commercial Building
33 Dengshikou Street
Dongcheng District, Beijing, China
中國北京市東城區燈市口大街33號
國中商業大廈3樓303室
T: +86 10 6210 1890

TAIPEI 台北

Rooms 7F-702, 7/F., 188 Section 5
Nanjing East Road
Songshan District, Taipei
Taiwan 105411
台灣台北市松山區南京東路五段
188號7樓7F-702室
郵編: 105411
T: +886 2 2711 1324

TOKYO 東京

Rooms 502-03, 5/F.,
Lions Mansion Matsugaya
1-4-6 Matsugaya, Taito, Tokyo
Japan 111-0036
日本東京都台東區松谷1-4-6
獅子大廈5樓502-03室
郵編: 111-0036
T: +81 3 5776 2637

SINGAPORE 新加坡

138 Cecil Street, #13-02 Cecil Court
Singapore 069538
T: +65 6438 0116

KUALA LUMPUR 吉隆坡

Menara Suezcap, Tower 2
E-13A-3A, No. 2 Jalan Kerinchi
Gerbang Kerinchi Lestari
59200 Kuala Lumpur, Malaysia
T: +60 19 2177 344

NEW YORK 紐約

202 Canal Street, Suite 303, 3/F.
New York, NY 10013, USA
T: +1 646 850 5888

LONDON 倫敦

Room 5, 2/F., 39-41 High Street
New Malden, Surrey
KT3 4BY, UK
T: +44 20 3910 8392

3. Relatedness of Goods or Services

Trademark protection never exists in a vacuum; it must be tied to specific goods or services. If two marks are slightly similar, but one is for "computers (Class 9)" and the other is for "cosmetics (Class 3)," they can generally coexist because the industries are unrelated. However, if an existing mark is registered for "clothing (Class 25)" and you want to apply for "shoes (Class 25)" or "bags (Class 18)," the chances of refusal are extremely high. In commercial practice, these products are often produced by the same companies and are considered highly related goods.

Conclusion: The Necessity of a Professional Search

USPTO examiners exercise substantial subjective discretion. Relying solely on a basic exact-match search risks overlooking potential conflicting marks. Conducting a comprehensive fuzzy and logical search—evaluating sound, meaning, visual appearance, and commercial relatedness of goods—prior to submitting the application and paying non-refundable official fees is the most effective way to secure registration while avoiding wasted time and expense.

If you wish to obtain more information or assistance, please visit the official website of Kaizen CPA Limited at www.kaizencpa.com or contact us through the following and talk to our professionals:

Email: info@kaizencpa.com

Tel: +852 2341 1444

Mobile : +852 5616 4140, +86 152 1943 4614

WhatsApp/ Line/ Wechat: +852 5616 4140

Skype: kaizencpa