

**MEMORANDUM**  
**THOMAS, THOMAS, AND THOMAS**  
***A Pretend Limited Liability Partnership***

FROM: Ira Nathenson, “Managing Partner,” T<sup>3</sup> PLLP  
TO: Spring 2014 “Associate” Class  
RE: Trademark “knock-out” search  
DATE: March 20, 2014

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**ASSIGNMENT**

**Background.** Broadly speaking, there are two kinds of trademark searches: a “knock-out” search and a full clearance search. Whereas a “knock-out” is intended to determine whether any clear obstacles exist regarding the proposed mark, a full search is more comprehensive and is geared towards possible clearance for actual use and registration. Your assignment is to do a “knock-out” search on a fictional trademark. You will invent a trademark and document a “knock-out” search on the mark using real-world search tools. For background guidance on trademark searching, see Tamar Niv Bessinger, *Ethics Issues in Searching Trademarks and Offering Opinions*, available at [http://www.frosszelnick.com/sites/default/files/20090506100518\\_86\\_PUBLISHED\\_PDF](http://www.frosszelnick.com/sites/default/files/20090506100518_86_PUBLISHED_PDF).

**Educational goals.** In the real world, you will do more than legal research and analysis; instead, you will utilize and develop a broad spectrum of legal skills, such as factual investigation, communication, and counseling. You will also soon recognize that professional values—those embodied in ethics codes as well as broader societal concerns—also play a huge role in the actions you take as a lawyer. As noted in proposals for reforms for legal education, it is vital that law schools find ways to treat students as apprentices, with a holistic approach that pulls together *analysis, skills, and values*. In 1992, the *MacCrate Report* provided a detailed taxonomy of lawyering skills and recommended that those skills be better incorporated into legal education. In 2007, two additional significant documents, the *Carnegie Report* and *Best Practices in Legal Education*, further advocated for curricular reform. Therefore, in this assignment, you will apply the legal doctrine that we have studied in a practical way.

**Details of assignment.**

- 1. Invent a trademark.** You will create a trademark or service mark for your client Acme, Inc., a small company in Dania Beach with limited financial

resources. To keep searching manageable, your mark must be a typed (*i.e.*, word) mark and not a stylized mark or design. You should select goods and/or services for the mark. **Do not conduct any searching prior to selecting your mark. Once you select your mark, you are stuck with it!** Because the purpose of the assignment is to consider potential conflicts, do not coin a mark that will easily pass the knock-out search (such as XZZMQ@17 or ZRGGHAXLY). Assume that the client's president is a lawyer and is familiar with trademark law.

2. **Conduct "knock-out" searching.** Once you select your mark and goods/services, begin searching. You should use the search tools available through the Trademark Office website (<http://www.uspto.gov>). Try various tools and search strategies. Your searching should not be limited just to the Trademark Office website: you may and should consider using other search tools. Print out documentation that reflects your search strategies and the results of various searches. **Bring preliminary results of your search to class on April 8 and be prepared to discuss the results in light of the assigned readings on "likelihood of confusion."**
3. **Draft a client letter of no more than ten (10) pages in Times New Roman discussing:**
  - a. **Registrability.** Whether registration of the proposed mark would be barred by Section 2 of the Lanham Act (for example, whether the mark is merely descriptive without secondary meaning);
  - b. **Protectability.** The degree to which the distinctiveness of the proposed mark may help to guard against later, junior users (for example, an arbitrary mark may get broader protection than a descriptive mark);
  - c. **Risk of liability.** The extent to which the client's use or registration of the proposed mark might cause a likelihood of confusion or dilution or other trademark liability with any pre-existing applications, registrations, or other uses belonging to third parties;
  - d. **Bottom-line recommendation.** Whether you recommend that your client proceed with a full search or instead select a different mark.
4. **Hand in a case file including:** a) the client letter; and b) documentation of your searches/strategy. **The file is due by 5PM EST on Monday, April 28.** You may hand in the assignment in hard copy or electronically to [inathenson@stu.edu](mailto:inathenson@stu.edu). As before, you may discuss the project with others so long as they are current members of this class. If you use any third-party materials as guidance, you must provide the materials or their citations to me.