

## VELOCITY LAW, LLC

BUSINESS LAW FIRM

5449 BENDING OAKS PLACE

DOWNERS GROVE, ILLINOIS 60515-4456

[nfallon@velocitylaw.com](mailto:nfallon@velocitylaw.com)

630-963-0439 x 22

[www.velocitylaw.com](http://www.velocitylaw.com)

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### **Name Search & Selection Checklist**

(To Pick Your Business Name, Tag Line or Product Name)

#### **I. Name Selection Process - How to Pick a Great Name** **(For Business Name, Product Name, d/b/a, or Tag Line)**

- A. **Pick a "Suggestive", "Fanciful" or "Arbitrary" Name.** "Suggestive", "Fanciful" or "Arbitrary" names are best choice for available names and trademark-able names; Don't pick "descriptive" names, as they are generally not trademarkable. Create a brand from a uniquely applied key word or words, rather than trying to describe what you do in your business name. Or add a "branding" word to the descriptive words; or a word that is suggestive of what the company does or the result of its service or product, or an allusion to, the service or product.
1. **"Suggestive"** word or combination of words. Alludes to or suggests the industry, product, service, positive result of the service or product, but that is not directly Descriptive. Or uses a term of art from the industry, a part or tool used in your industry; or uses innuendo or double meaning. ***"Federal Express", "Think or Swim"*** (Options Trading Firm), ***LiquidPoint*** (Options Trading Firm), ***Spokes Bike Shop*** (bike shop); ***Full Stack*** (Tech Employment Search Firm covering the "full stack of back-end and front-end coders/designers"), ***Great Wall*** (Chinese Restaurant) or ***MarchFirst*** (web design and management Consulting); ***Rootstock Wine Bar*** (bar); ***Second Wind*** (used exercise equipment); ***Oasis Irrigation*** (Lawn sprinkler systems); ***Triple Toe Skate Shop***, ***CleanCycle*** (laundrymat) ***Soap Opera*** (laundrymat) ***Forget Me Not*** (Florist), ***Slide Rule*** (Engineering); ***NetRoadShow*** (online securities broker-dealer firm), ***TripleNet*** (real estate investment)
  2. **"Fanciful"** word or words, a made up word or words, create from scratch. Combines words, syllables, or elements of words, into a new made up word. It may, or may not, have relevance to the business. Use a combination of syllables from other words, or other unique creation. Examples (Not saying these are all good names): ***Orbitz*** (travel site), ***Groupon*** (Group Coupon), ***Twitter***, ***Instagram***; ***Kleenex*** tissues, ***eBay***, ***Google*** (search engine), ***Wikipedia*** (online encyclopedia), ***Zulily*** (online clothing); ***Motorola*** (electronics), ***Scubaquarium*** (indoor scuba diving facility); ***Brandless*** (marketing and branding); ***Helter Skelter*** (Song Title) ***Zoomerang***, ***Razorfish***, ***Buzzmetricks***, ***Intelliseek***, ***Photovoltaics***; ***ZyStor Therapeutics***; ***Neoglyphics*** (web design); ***Ganymede***, ***Efoora***;

3. “**Arbitrary**” word, arbitrarily use a word from another genre or subject area, apply that word to your industry, makes a perfect “brand” for your business or product. “Apple” used to mean “a fruit”, now it means “computers and phones”.

Use a word from your hobbies or interests, from music, art, nature, or a geographic element, but apply it to your business name.

Use something unrelated to your industry. Use an unexpected word to create a “brand” in your industry. An “**Amazon-like**” brand, an “arbitrary” word that is out of the element of the industry, but adopts a whole new meaning or brand when applied to your industry. “Amazon” previously meant “a river” or “a jungle”; now it means “Books/Music/Retail Goods”. **Apple** was a fruit, now computers. **Target** was an archery tool, now a retailer. **Blackberry, Apple Computers, Monster (job site), Survey Monkey, FeedBurner; WordLab; “Soap Opera” (laundrymat); Red Hat Software; Dog Pile** search engine, **Blue Meteor** consulting; **Smokeball** Software, **eGumball** (SEO and Internet Maps Services)

- Geographic elements from nature either local landmarks, national landmarks, parks or places names, generic elements, such as rocks, mountains, rivers, jungles, (generic or proper names),  
**Amazon Books, Eagle River, Pearl Design**

Street names sometimes work (though some street names may be deemed to geographically descriptive and therefore may not be able to be trademarked):

- Avoid names of oceans and great lakes; all taken. “Water” and most derivations of it, are taken.
- Avoid overused/tired words, like “American” or “National”, or probably even “Southern”, “Northern” etc., and probably even “Midwest”, and “Southwest” or most directional names are overused, or at least taken.
- Avoid the city name like “Chicago” or “Miami” etc., they will be taken and they are non-memorable, and too geographically specific to trademark
- Use a word that is a physical object, food, **Blackberry, Apple Computer,**
- Use A tool used in the business,
- Use parts of body, any noun or object. Or a verb added to a noun, where the verb.
- Use animal names, or derivations: **Razorfish, Dog Pile, Black Dog, Green Cardinal; SurveyMonkey**
- Use a name of a street, combined with a word from your industry: Unlimited choices perhaps? Or use a combination of two street names, like “**Smith &**

**Wollensky”, or “Haight & Ashbury”.** Avoid an obvious common name like “Elm Street Pharmacy”. (But be careful of street names, don’t use street names alone, as they are too geographically descriptive and not trademarkable)

- Combine two words, normally unrelated, resulting in a catchy combination: **MarchFirst** (consulting), **Tap Root Pub**, **LiquidPoint** (options brokerage firm); **CrowdCheck** (crowdfunding portal). **eGumball** (SEO Services)
- Color combined with object: **Blue Meteor Design**, **Red Hat Software**, **Blue Martini**, **Green Chilies**, and **Black Dog**. But many colors overused, search first before getting too excited about this. “Green” is totally overused, given the “Green Industry”. Blue becoming overused. Maybe Red too.

B. **Avoid “Descriptive Names”, Though Some Work.** Descriptive names, or names whose key word or root word, describes what your business does, directly states what the business does, are “too descriptive” to trademark or even establish name use rights to. And they are very often already taken in any given industry. As an added “feature”, descriptive names are usually non-memorable or boring, and are therefore less effective for branding. **“Fundamental Financial Solutions”**

Good Descriptive Names: **CareerBuilder** (job site), **Muscle Mechanic** (massage) **Red Lobster Seafood**, **FeedBurner** (web feed management provider); **Instagram**

A name can be Descriptive, but add elements that make it unique and catchy as above.

Cannot trademark general language words, unless you add a brand-like word with it (i.e. cannot trademark the word “car repair” or “without wheat”)

C. **Sir Names Work Sometimes - With Caveats.** Use of sir names is fine, sounding like a law firm, CPA firm, or ad agency: **Smith & Jones**, **Kirkland & Ellis**, but avoid using more than 2 or 3 names, as more than 2 or 3 will confuse the reader. And if your last name is a famous name that is already used in the industry, for example “Welch” in food or beverage industry, then you can’t use it, even if it is your own name.

D. **Non-English Language Names.** Use words from other languages, as long as the name searcher has checked English translations: **Melati Home Furnishings**, **Appana Realty**

Check English Translations for possible unfortunate results: “Nova” the Chevy Car, means “It Does Not Go” in Spanish.

E. **Words to Avoid**

- a. **Avoid Root Words Already Trademarked, Even if Other Words Around Them**, if the root word or words are already used in your industry or a related industry, either avoid using, or be very careful to add words that clearly distinguish the name. Proceed with caution if you are adding additional words to an “in use” root word”. Carefully check industry use and USPTO Goods and Services Categories
- b. **Avoid Word LIKE a Word Already Used by 800 pound gorillas**, or sound like their words, even if they are out of your industry, like ***McDonalds, Apple, Microsoft, Excel, Palm, Target, Rolodex, Vanguard***. Avoid them in ***any*** industry, as those big boys will try to stop you even if your business is different from theirs, and they may be able to.
- c. **Do Not Use of Acronyms and Letters**. Don’t use acronyms, ABC, TBD, XYX, etc. even if they are your own initials.
- Highly likely to be already taken (not available) from a common law standpoint, or trademark standpoint.
  - Highly “diluted” (there will be many occurrences of them in use)
  - Confusing to reader, causes “likelihood of name confusion” to reader;
  - Non-memorable to reader, they will have no Impact on your reader or customers to remember YOUR three letters or the order of them; people will type them backwards on web address (and email addresses).
  - Not trademark-able,
  - Web domain will not be available;
  - Challenging or impossible to market; and
  - Unworkable in almost every way as a business name.
- d. **Don’t Use Misspellings**. If the name (or domain name) is taken in the natural spelling or correct spelling, then misspelling the name, or the domain name, does not solve the “name taken” problem. Then the trademark or business name is most likely not available, if operating in your industry. Someone else owns rights to the correctly spelled name, and maybe to the domain name and they will therefore have priority rights over your misspelled version, if in the same or similar industry.

Why? : It sounds like the correctly spelled name. A sound-alike, is a conflict, and infringing name.

Problem names: “Starz” for “stars”, or “sftware” “insurnce” or “brker”. If the name **sounds** the same, then it **is** the same, for purposes of common law trademark and tradename conflict.

If the domain is not available, it may simply be owned by a cybersquatter who has no trademark rights, because they are not “doing business” in your industry.

- e. **Avoid “Descriptive Names”**. Descriptive names, or names whose key word or root word, describes what your business does, directly states what the business does. See above on “Descriptive Names”.

## II. **Name Search – How to Search a Name**

To conduct your own name searches:

### A. **Federal USPTO; State Trademarks and Corporate Names; Google; Domains.**

First search the federal trademark database, [www.uspto.gov](http://www.uspto.gov) , <http://www.uspto.gov/trademark> because if someone has a name trademarked at the federal level in your industry, then you can't use it.

Then search your state corporation and LLC database, then your state trademark database, then Google, then do a domain search.

### B. **Search Tips on Your Selected Name; Managing “Hits”**

#### 1. ***Thoroughly search before forming your business entity or before launching the product or using a tag line.***

Eliminate all possibilities of prior name use, or similar uses. Thorough search – look everywhere! Put on your “surveillance” hat, and look for the name as if you were someone looking to sue you over the name use for being similar to their name in the industry. If you don't, someone else will.

It is tempting to rationalize away why you think the name is different enough from an already used name; but if you were that business owner, and saw your new similar name show up on the web, would you go after the name infringer?

#### 2. ***Search “key words” or “root words”, Don't Secondary Words, and Don't search the Full Name.***

A federal judge ordered **Houston College of Law** to change its name in 10/2016, after HCL sued by **University of Houston Law Center** in trademark fight with the recently-renamed HCL.

The “key words” or “root words” are the words that are the most important to screen for prior use. The “root words” are relevant to establish name conflict or name clearance. A trademark owner can potentially have the rights to a word in the entire industry, if they'd filed trademarks. Search only the KEY words in your initial search, to determine if the Key words are used by someone else; and search all permutations and spellings of the key words.

While the secondary words, generic words, or descriptive words around the root words are not relevant, and often do not add enough difference to distinguish the name from a name already in use to allow you to use it. For example, “Microsoft

Software” and “Microsoft Technologies” would be deemed the same name. i.e., you can’t use “Microsoft” in the technology industry.

Similarly, “Strong Fund”, “Strong Advisors”, “Strong Capital” and “Strong Equities” would all be deemed the same name in the financial services industry, i.e., you can’t use “Strong” in the fund or financial industry if anyone is using “Strong” in Trademark Goods and Services Class 035 or 036.

Don’t use “Corporation” or “LLC” etc. in the name search. Those words are irrelevant. Don’t use “the”, “and” “of” in your searching, just the root words or key words.

### **3. Words to Avoid – See I.E. Above.**

#### **C. Search All of The Name Permutations and Spellings Including Odd Spellings.**

- Use Boolean searches
- Search all permutations, spellings and misspellings, plurals and singulars; and search reverse word combinations. For “Men’s Clothes”, you must also search “Man” and “Men” and “Clothes” and “Clothing”. For “Innovation”, also search “Innovator” and “Innovate” or
- After tips on how to search, do the initial searches yourself: Reviewing the results will alert you to other usages of the name, where other word combinations are used and in other types of businesses. Doing some of the “knock out” searches on your own will save you in added legal fees, if additional searches beyond initial search are required.
- *Allow much time, especially for the Google searches, examine all hits. Find out what type of business is behind each hit. Determine if business type is relevant to name conflict.*
- Search the root of the word, for “Tricky Pictures” search “trick”, for “Running” or “Runner”, start by searching only “Run”. But also search “Runner” and “Running”.
- Search synonyms, same meaning, different words, such as “Space” and “Area”, Including Latin, “Voice” and “Vox”. Though some leeway can be allowed with synonyms in some cases.
- Search Homonyms (“sound-alikes”), such as “Pique”, “Peek”, “Peak”.
- Don’t use intentional misspelling of a name. Does not solve the problem of a taken name, like “starz” for “stars”. If the name **sounds** the same, then it **is** the same name, for common law name conflict purposes.
- Use Boolean search method so you can find synonyms and reverse word orders, like “Car Gas” and “Gas for Cars”, would probably be deemed in conflict with each other.
- If similar name, though not exactly the same, but similar business – don’t use the name.

- Find out what is the business of each hit found. Research it online, or call them.
- If there are many hits, better off paying someone to do the research to distinguish business types and Goods and Services. Hire: CT Coresearch, or Government Liaison Services or Thompson & Thompsons (now Thompson Reuters).

#### **D. Single Word Searches (Especially in Less Sophisticated Databases Like State Corporation Data Bases)**

Single word searches and reverse word order combinations may reveal many hits, but also reveal an interesting survey of the lay of the land.

- Instead of searching “Oak Technology”, first search “Oak” and then “Technology”, or
- Instead of searching “Premier Communications”, first search Premier, the Communications
- Instead of searching “Madison Travel”, search first Madison, then Travel.

Google, and the Search Engines, as well as the US Trademark Office, are ‘smart search engines’. On the [your state] Secretary of State, and Delaware Sec of State, as well as other state websites, the search engines are not “smart search engines”, instead they are “dumb search engines”. They can’t understand or find combinations of 2 or more words. Therefore, search all single key words in name, separately as individual components of your name. And do reverse word combinations.

#### **E. Search in the Trademark Goods and Services Categories in Which You Will Operate**

If the name you select is taken outside of your industry, then usually not a problem, unless the user also does some business, or dabbles in your industry. If the name is taken in your industry, then you can’t use it.

“Industry” in trademark world is essentially determined by the USPTO “Goods and Services” categories, with some other judgment call decisions on industry or use overlap.

Especially search “sound a likes, “homonyms” in the Goods and Services Categories in which you will be operating

Goods and Services Categories in the US Trademark database, which is used for the barometer for searching in all state data bases and in Google, in addition to US Trademark:

[http://www.tmweb.com/trademark\\_classes.asp](http://www.tmweb.com/trademark_classes.asp)

##### **Short definitions - Goods**

- [Class 01](#) Chemicals
- [Class 02](#) Paints, Coatings & Pigments
- [Class 03](#) Cleaning Products, Bleaching & Abrasives, Cosmetics
- [Class 04](#) Fuels, Industrial Oils and Greases, Illuminates

- [Class 05](#) Pharmaceutical, Veterinary Products, Dietetic
- [Class 06](#) Metals, metal castings, Locks, Safes, Hardware
- [Class 07](#) Machines and Machine Tools, Parts
- [Class 08](#) Hand Tools and implements, Cutlery
- [Class 09](#) Computers, Software, Electronic instruments, & Scientific appliances
- [Class 10](#) Medical, Dental Instruments and Apparatus
- [Class 11](#) Appliances, Lighting, Heating, Sanitary Installations
- [Class 12](#) Vehicles
- [Class 13](#) Firearms, Explosives and Projectiles
- [Class 14](#) Precious Metal ware, Jewelry,
- [Class 15](#) Musical Instruments and supplies
- [Class 16](#) Paper, Items made of Paper, Stationary items
- [Class 17](#) Rubber, Asbestos, Plastic Items
- [Class 18](#) Leather and Substitute Goods
- [Class 19](#) Construction Materials (building; non-metallic)
- [Class 20](#) Furniture, Mirrors,
- [Class 21](#) Crockery, Containers, Utensils, Brushes, Cleaning Implements
- [Class 22](#) Cordage, Ropes, Nets, Awnings, Sacks, Padding
- [Class 23](#) Yarns, Threads
- [Class 24](#) Fabrics, Blankets, Covers, Textile
- [Class 25](#) Clothing, Footwear and Headgear
- [Class 26](#) Sewing Notions, Fancy Goods, Lace and Embroidery
- [Class 27](#) Carpets, Linoleum, Wall and Floor Coverings (non-textile)
- [Class 28](#) Games, Toys, Sports Equipment
- [Class 29](#) Foods - Dairy, Meat, Fish, Processed & Preserved Foods
- [Class 30](#) Foods - Spices, Bakery Goods, Ice, Confectionery
- [Class 31](#) Fresh Fruit & Vegetables, Live Animals,
- [Class 32](#) Beer, Ales, Soft Drinks, Carbonated Waters
- [Class 33](#) Wines, Spirits, Liqueurs
- [Class 34](#) Tobacco, Smokers Requisites & Matches

#### **Short definitions - Services**

- [Class 35](#) Advertising, Business Consulting (This also covers any business services except financial, it covers website services)
- [Class 36](#) Insurance, Financial
- [Class 37](#) Construction, Repair, Cleaning
- [Class 38](#) Communications (This also covers website services)
- [Class 39](#) Transport, Utilities, Storage & Warehousing
- [Class 40](#) Materials Treatment, Working
- [Class 41](#) Education, Amusement, Entertainment, Reproduction
- [Class 42](#) Scientific and technological services and research and design relating thereto
- [Class 43](#) Services for providing food and drink; temporary accommodations.
- [Class 44](#) Medical services; veterinary services; hygienic and beauty care for human beings or animals
- [Class 45](#) Personal and social services rendered by others to meet the needs of individuals

Other Search info and tools for federal trademark searches:

[http://www.uspto.gov/trademarks/resources/IDManual\\_Help.jsp#](http://www.uspto.gov/trademarks/resources/IDManual_Help.jsp#)

<http://tess2.uspto.gov/netathtml/tidm.html>

<http://www.uspto.gov/trademarks/resources/tmidmanualsuggest.jsp>



1. Example: Trademark Goods & Services Categories for Social Media & Advertising:

If the business is characterized as social media and advertising related, then the Trademark Searches should be done in these goods and services categories.

Other industries may be pulled in as well, depending on the full description of your business idea. A determination of your “Trademark Goods and Services” categories would have to be made and determining ALL of the categories in which you will operate, before the name search is finalized and determined to be clear.

Social Media and Advertising businesses are typically categorized in **all** of the following categories:

- 09 Software Programs;
- 35 Advertising and Business Consulting (Category that applies to almost any business services or business consulting, and also to financial services)
- 36 Financial Services, Insurance (Category applies to funds and fund managers)
- 38 Communications
- 41 Entertainment
- 42 Scientific and technological services
- 45 Personal or Social Services. (Social media classified in other categories too.)

“Facebook” for example, has its trademarks classified in 09, 35, 38, 41, 42, 45.

<http://www.uspto.gov/trademarks/notices/international.jsp>

Short cut excerpts by a third party website, Trademark office:

[http://www.tmweb.com/trademark\\_classes.asp](http://www.tmweb.com/trademark_classes.asp)

2. Example: Trademark Goods & Services Categories for Financial Services, Funds, Fund Managers Trading Funds, Investment Funds, Real Estate Funds:

- 35 Advertising and Business Consulting (Category that applies to almost any business services or business consulting, and also search this for financial services)
- 36 Financial Services, Insurance (Category for funds and fund managers)

**F. Knock Out Search Process**

With a more detailed discussion about what your company intends to do, now and in the future services and products, I can narrow down the hits search, or you can search on your own at the “Goods and Services” (“GS”) classes. (This will save you some money in legal fees to do an initial pass of this leg work on your own.)

After these initial knockout searches, then you would hire either a trademark lawyer, or the 3<sup>rd</sup> party name search provider (either CT Corsearch or Government Liaison or Thompson & Thompsons) to do a full name search around the country.

### **III. Name Search Databases and Sources to Search**

Check USPTO first, then your state databases (trademark and corporation/LLC), then Google, then domain name search.

If your business will be an internet company, or a product or software or service sold everywhere, then absolutely must search the US Trademark database. Federal trademark trumps all state trademarks; if someone else has a federal trademark on your name, or one like it, or even the root word or key word of it, in your industry, then you can't use the name.

#### **A. US Patent & Trademark office.**

USPTO Trademark search is the key search, [www.uspto.gov](http://www.uspto.gov).

- <http://www.uspto.gov/trademarks/index.jsp>
- When searching USPTO, after broad search, to narrow down the search, then search in the Goods and Services category in which your business will operate. A determination of your "Trademark Goods and Services" categories would have to be made (you can search those by Googling it, and determining ALL of the categories in which you will operate.)  
<http://www.uspto.gov/trademarks/notices/international.jsp> or short cut excerpts by non-Trademark office: [http://www.tmweb.com/trademark\\_classes.asp](http://www.tmweb.com/trademark_classes.asp)
- <http://www.uspto.gov/products/library/ptdl/services/tmsearch.jsp>

#### **B. International Searches**

- The Madrid Express, international trademarks (US residents can be precluded from using names that have been filed in other countries under the Madrid Protocol) <http://www.wipo.int/portal/index.html.en>
  - <http://www.wipo.int/trademarks/en/>
  - <http://www.wipo.int/madrid/en/>

#### **C. U.S. Only ?**

If your business will be local only (which is highly unlikely in these days of the internet), then you can get by with searching only the state corporate database and the state trademark database. However, if someone has federally trademarked the name, it may not likely show up in your own home state searches, unless they also redundantly filed a trademark in their own home state if the same as your state.

#### **D. State of Incorporation – Secretary of State**

- In Illinois, [www.sos.state.il.us](http://www.sos.state.il.us), under "Services to Business, check Corporations **and** LLCs. Separately search Not-for-Profit Corporations. (Possibly check LPs, depending on type of business and depending on whether the state aggregates the databases.)

- IL SOS site and search tool is unsophisticated, “dumb”, and not Boolean like Google or USPTO. Use the search tool called “Key word”, but “Key word” only allows you to search one word at a time. Therefore, search each key word separately. Ditto with Delaware and other states.
- Don’t search using the “Name” tool, as it only gives you names that START with the word, but it skips names that CONTAIN the word. The search feature therefore is very limited, so you must work around it.

#### **E. States of Qualification to do Business**

1. Check with the Secretary of State in which the Corporate Office is, or will be, located, as opposed to just formed.
2. Check other state’s name availability now, if you may do business in that state in the future, or if you will do business over the Internet. Use incorporation service [www.corp-links.com](http://www.corp-links.com) (for a fee in each state), or use Thomson’s to search all states at once (see below).

#### **F. Delaware Secretary of State – Regardless of Your Formation State or Location**

1. Check Delaware, Regardless of Where you are Formed

Since many corps and LLCs are formed in Delaware, also check Delaware before forming or using the name, regardless of what state in which you are operating. Delaware: <https://sos-res.state.de.us/tin/GINameSearch.jsp> . Therefore, they will not show up in your home state search, even if they are doing business in your home state, unless they filed a local qualification in your home state. A Delaware business could be the first to use your name, and using it nationally.

2. Other methods of checking Delaware or other states:

- Use <http://www.knowx.com/delaware/delaware-corporate-records.jsp>
- Or call Delaware: (302) 739-3073 or (302) 739-4111, or
- Use incorporation service that can check on line [www.corp-links.com](http://www.corp-links.com) (charges a fee).
- Call and phone search the county where you want to do business, for any potential d/b/a filings.

#### **G. State Trademark Searches**

1. Illinois [or your home state) Trademark Office, for names that have been trademarked in Illinois, even if they are not formed as corps or LLCs  
[http://www.cyberdriveillinois.com/departments/business\\_services/trademark.html](http://www.cyberdriveillinois.com/departments/business_services/trademark.html)
2. Google “Trademark Search [state name] to find your own state’s trademark. This is in addition to your home state’s corporation and LLC database.
3. Search trademark office of any state in which you will do business. State trademark offices are also important to search, and the name must be searched in every state trademark office where the name will be used, internet or bricks and mortar. The

general public does not have access to the state trademark databases in many states (including Illinois), and can only be accessed by a trademark lawyer or someone who subscribes to a paid service. Trademark lawyer can do a “knock-out” search for about \$200. CT Corp, Coresearch, Thompsons or Government Liaison, also offer that service.

#### **H. State Departments of Revenue Searches for Unincorporated Sole Props**

Check the **Department of Revenue** in State of Incorporation or where you will do business: Catches use of Sole Proprietor names who are not required to file with the Secretary of State, and therefore that SOS Corporations search would not catch. Illinois Department of Revenue is (217) 785-3707. (Phone checks only, no internet checks.)

- I. **Domain name search** [www.register.com](http://www.register.com), (Critical!) to find other businesses that may be using your selected name. Use of a domain name does not necessarily mean “Use” of a business name has been established, but it’s a pretty good bet if someone has secured the domain name, that they probably have formed a business by that name.

#### **J. Securities and Exchange Commission and FINRA**

Search SEC online EDGAR search includes public companies and any private company that has ever filed an SEC Form D

<http://www.sec.gov/edgar/searchedgar/companysearch.html>

For financial services firms, funds, fund managers, advisers, also check FINRA and IARD.

<http://www.iard.com/>

- K. **Google and Yahoo search** or other web browser or search engines.

#### **L. Business Directories**

Search Online Business Directories:

Dun & Bradstreet <http://smallbusiness.dnb.com/company> and other business data bases, and search [www.dnb.com/us](http://www.dnb.com/us) to track reports on certain businesses.

Search "infoUSA", formerly American Business Information, at

[http://www.infousa.com/fs/business.htm?bas\\_fssession={bas\\_fssession}&bas\\_vendor=190000&bas\\_type=FADA&bas\\_page=1&bas\\_action=search](http://www.infousa.com/fs/business.htm?bas_fssession={bas_fssession}&bas_vendor=190000&bas_type=FADA&bas_page=1&bas_action=search), to check for business names.

Check [www.knowx.com](http://www.knowx.com) business names, and [www.thomasregister.com](http://www.thomasregister.com), which track down companies that sell goods

#### **M. Industry Directories and Industry Registries**

Check industry registers for matches or similar names in industry, especially if you will operate in a regulated or licensed industry. Your search is easier and narrowed by using the industry data base for your search. There are databases for insurance agents, real

estate, doctors, lawyers, securities brokers, banks, and many other regulated industries. See Item I. above about securities regulated industries.

For example, in trading fund industry:

- <http://www.advisorregistry.com/listall.asp?state=IL;>
- [http://www.snl.com/links/investment\\_advisers\\_il.asp](http://www.snl.com/links/investment_advisers_il.asp)
- <http://directory.google.com/alpha/Top/Business/Investing/MoneyManagers/>
- [www.marhedge.com](http://www.marhedge.com)

- N. **Phone Directory, online.** Search [www.switchboard.com](http://www.switchboard.com) search for use in phone directory.

Call 411 and search name in your local area, your entire city, and other states where you think a company by the same name could be located.

#### **IV. Buy a Professional 3<sup>rd</sup> Party Name Search From a Service Provider Government Liaison, or Coresearch or Thompson's; or From a Trademark Lawyer**

If you tire of the complexity and tediousness of doing these manual searches in various steps listed above, or if you don't have time to do them, then you can instead hire out a third party name search company to do all the leg work for you, for \$675 to \$1,600. Providers are: Government Liaison Services, CT Coresearch, or Thompson & Thompson's. They use computer generated, algorithmic searches that think of all the permutations and spellings of the name. They electronically search many databases at once. They search all 50 states, in the entire US, in all the data bases listed in this memo.

Their search report provides a list of names used in your industry, and other industries, what the businesses do, how long they have been in business, where they are located, whether the name is trademarked. Their results provide the Trademark Goods and Services Category, so that you can pinpoint names already used in your industry

Even if your business does not have a website, your clients, as well as other users of the same name, can find your business on the web in other sources and business publications. Other name users of your name can bring action against you if you use their name. Therefore, critical to perform at least some version of a nationwide name check, if not a "full formal search" of entity names (Corporate names, LLCs, LPs, NFPs, trade names, USPTO-filed trademarks, state trademarks, company names (unincorporated), domain names, secretaries of state, and some common law names, and some general publications:

##### **A. Search Company Options**

1. Government Liaison Services, Inc. <http://www.trademarkinfo.com/> Less costly at \$650 + \$25 = \$675 than Thompsons or Coresearch and seems equally as effective. <http://www.trademarkinfo.com/trademark-services/>

2. Coresearch (800) 872-6275;

<https://www.ctcorsearch.com/CtcorsearchApps/ctcorsearch/MasterFrame.aspx>  
<https://www.ctcorsearch.com/ctcorsearchapps/ctcorsearch/Products.aspx>

Comprehensive Name Search: \$700 (3 day), Corporate Name Search is \$700,  
Comprehensive and Corporate: \$1,200, include DBAs \$1,600 for 3 day turn around.

3. Thomson & Thomson's: (800) 692-8833 Comprehensive & Company Name Search: \$1,600 (4-day turn), similar prices to Coresearch [www.thomson-thomson.com](http://www.thomson-thomson.com) .

## **V. Trademark Lawyer Review and Comment on Search Report: Name Availability Confirmation**

Have a trademark lawyer review the search, comment on report and determine name availability. Add \$700 to \$1,100 for legal fees for trademark lawyer, depending on the type of search the lawyer will be reviewing.

The combination of the name search and the trademark lawyer's review and blessing, is one of the most valuable \$2,000 you will spend to start your business,

Compare with litigation costs of \$10,000 - \$25,000 or defending a Cease and Desist letter costs of \$5,000+.

## **VI. Actions to Protect Your Available Name**

After the trademark lawyer confirms that your name is available, you can take steps to protect the name you've selected:

- Use the name "in commerce", and retain proof of use for filing. Using it is the first step to establishing protective rights. And you can only file, and be issued, a trademark after you have used the name.
- Form the entity as soon as name is cleared. Upon formation of the LLC or Corp, the name of the formed entity will show up on most search databases, putting the world on notice that you are using the name.
- Reserve a domain name, and all similar / related domains; as many as you can afford, **and** put up a working website. The purchase of a domain name alone, does not protect your name, until you use that domain name "in commerce", by at least getting a working website up and running.
  - Be prepared to buy a domain name from a domain squatter, if someone else already owns it. Prices hover around \$1,500 to \$2,000 and can go as high as \$10,000 or more.

- File a trademark at the state trademark level (less costly than federal, by a lot, but it only protects your name in the state or states in which you file). Illinois for example is a \$10 filing fee per goods and services category.
- File a trademark at the federal level (the most costly and the most protective and inclusive. Filing fee is \$750 per class)
  - File “Intent to Use” with USPTO
  - Consider trade-marking the name, especially if branding is important to your business concept, product or services. Hire an intellectual property / trademark attorney to file them. If you can’t use your name after you have established brand identity, then you don’t have a business.
  - Trademark with federal USPTO
- **Qualify your out-of-state (“foreign”) entity** (i.e. Delaware) to do Business in Illinois, if non-Illinois entity. Qualify Delaware entity in your home state, and in states where you will do business. File before doing business in other states, opening office in, buying or renting real estate in, placing assets in, or before taking investor checks from the other states. The IL qualification filing fee is based on the net capital of the corporation. Delaware is based on number of shares authorized or issued.
- **County Recorder Filing** required in which business is located (only if state requires.)
- Illinois **REG-1 Business Taxpayer** registration with Illinois Department of Revenue filing. Or similar filing in other states. Required before hiring employees, or making sales from Illinois. File **early** if you will be selling goods subject to sales tax. Sales tax reports are due the 15<sup>th</sup> of the month following the month of sales of the goods.
- **Website Development and Online Branding.** Start sooner than you think. It takes longer, requires more time, attention, thought and revisions than you think. Informational websites are inexpensive and generally fast; however, any type of product or service website or e-commerce transaction and SEO can be expensive and take long to build.

## VII. **Name Check On Your Existing Company**

- If the corporation is already formed, do name check anyway.
- May find name infringers on your name.
- May find that ***you are*** a name infringer.
- May find, for example, a Delaware corporation operating in your home state.
- If out-of-state corporation is operating in your home state, it has the right to use the name before you do, even in your home state.
- Consider name change and other options if business name being used by others.

## VIII. **Name Ownership Rules of Intellectual Property** **(Ownership of Company Name, Product Name, DBA, and Tag Line)**

Now for the legal reasons behind all these searches.

Intellectual property is a key business asset, adding value to the business. “Business name”, “Product name”, “DBA”, “Assumed Name”, and “Tag line”, and the “brand identity” established around them, are intellectual property (“IP”). One must own the rights to use IP when starting a business or launching a new product.

Confirm that the name you select is **legally** available for use, under common law and trademark law, before forming the business. Avoid using a name that is owned by someone else, through doing a proper name search & screening (in the various databases). If the name is owned by someone else, any brand you build around it, would be on shaky foundation, with liability risk & cost to the business (the cost of defending name challenges and changing the name, the website, the halting the brand development.)

The business owner is obligated to determine who owns, and has the legal rights to use, the business name, product name and tag line, before the business owner uses them. Without legal rights to use, the business risks potential lawsuits over name use in the future.

### **Name Conflicts with Other Spellings, and Same Spellings in Other States**

Even if the name is available on own your state’s Secretary of State website, a similar name with a slightly different spelling, but sounding the same, might be in use by someone with priority rights in time, under common law or trademark law. Or the exact name might be in use in a different state (in which you might eventually do business).

### **Key Words, Root Words**

Search “key words” or “root words” screening for prior use. Then search secondary words around the root word(s). Sometimes the “secondary words” are not enough to distinguish the name from a name already in use, if the root words are already used in the industry, if the user has taken steps to establish brand, including filing federal trademarks.

## **IX. Name Clearance First: Business Formation or Product Build After Name Clearance**

**The corporation or LLC cannot be formed until name selection is finalized and the name is clear in the industry in which the business will be conducted.**

*Allow sufficient time to research names, and review similar names already in use by others in your industry, or similar industries. Allow time to rethink name selection, because first choice is rarely available.* The time-consumption and delay caused by thinking through multiple name choices, when your first choice is unavailable, is indeed frustrating. (Plan ahead on the corporate formation.)

However, thorough name search and selection **before** forming the business is immensely more productive than the alternative of changing the name after forming the business. Post-incorporation name change is costly, time-consuming and inefficient; and stalls business momentum and erases brand identity.



## **Current Climate for Name Availability and Detection**

- Internet triggers national competition for limited number of names in same industry. We are all doing business in the same space.... the internet.
- Many businesses have (or will eventually build) a presence on the Internet, even if they only now have an informational page out there as a start. If they have a webpage for a real business and they have used the page and the business name “in commerce” then they have the right to use. Therefore:
  - You are competing nationally (even internationally), rather than locally, for names in your industry, and
  - Your business name is **exposed**, nationally (and internationally) on the internet; therefore:
    - Other users of the name, or similar name, in your industry, will find you using the name, through Internet surveillance services, and
    - The 1st user of the name in the industry can sue you as a “name infringer”.
- Name overlaps frequently occur; almost every new business must make additional selections other than first choice.
- Find the overlaps before forming your business entity, avoid costly name change.
- The advice in this document, and each separate search, applies to:
  - Your company name,
  - Any short-cut company name
  - Any DBA or “assumed name”
  - Tag line used for the business, or
  - Any product name (each product name must be searched separately)

## **X. Name Claim Rules – First to Use the Name Wins**

### **A. Timing of Use; Name Confusion Concept**

The “*First to Use (in the same industry, or similar industry) Wins*”, is the general common law rule of trademark and name use. This rule applies whether or not you intend to trademark the business name.

- First to use the name “in commerce” (in a business) wins, over the 2<sup>nd</sup> user, even if :
  - 1<sup>st</sup> user has not trademarked name,
  - 2<sup>nd</sup> user has trademarked the name,
  - 1<sup>st</sup> user has not formed a corporation or LLC,
  - 1<sup>st</sup> user has not filed the name as a DBA or assumed name, or has not otherwise filed it in a state’s records.

Even an unincorporated sole-proprietorship or “DBA” has 1<sup>st</sup> rights over your use of the name, if they have used the name “in commerce” before you have. Conduct a thorough search to find any 1<sup>st</sup> users. Even if you later trademark the name, the first user can come back and force you to stop using the name.

- Therefore, the two similar names cannot occur in the same industry.
- National scope for your industry (perhaps international).
- Local scope (even outside your industry), very close geographic location is relevant, if another business in same close local area, even in a different industry, could cause name confusion.
- **“Likelihood of Confusion”** is a test of name availability.
  - As a 2<sup>nd</sup> user, you may be able to use the same name, or similar name, as long as your use will not cause “likely confusion”.
  - Apply the 8 trademark law factors required to analyze “likelihood of confusion”. I can refer you trademark lawyers to discuss this.
  - Sometimes issues arise with using the same name in separate industry for some names (e.g., McDonald’s and Microsoft).
- **“Dilution” may be a good thing for use, but not for trademark plans:** If name is diluted by many users, the likelihood of confusion is decreased. You may be able to use the name, but you will not be able to trademark it in future.
- **Name Selection is one of the hardest, and most time-consuming, issues of starting a business.** Don’t be discouraged if your first choice or first few choices are taken by someone else.
  - Have alternatives in mind.
  - Be prepared to relinquish your first choice, and even your second choice.
  - Sometimes takes weeks or months to think of that second or third name choice!
- **Law Suit Potential:** A company using your name (before or after you) can sue you demanding that you stop using the name. The other user could sue you regardless of whether that company has first rights to use the name. (They could be incorrect in filing the lawsuit.) The decision as to who has the rights to use the name is an issue to be determined in the trademark filings, or in a court case, using the 8 factors.

## **B. Establishing Evidence of Use**

Establish evidence of use for your name “in commerce”, or look for evidence of use by others using the name “in commerce”, by taking the following actions, which also act as steps to protect your name. The ultimate step in name protection is filing a federal trademark application and having it granted. However, until then, taking as many of these steps as possible will work toward protecting your name:

- File corporation or LLC entity formation with state,
- File name with county as a d/b/a or “assumed name”, if no corporation or LLC formed,

- Trademark name at the state level (inexpensive),
- Trademark name at the federal level (more expensive),
- Create a website and use it to operate the business,
- Place business ads in publications, such as phone book, internet web page, with proof of dates of publication,
- Sign (and date) contracts with other business parties, proving use in business, and
- Print, and use, stationery and business cards, with proof of dates.