



[U.S. App. No. 86283010](#)



Aversano IP Law | aversanoiplaw.com

E: Trademarks@aversanoiplaw.com | T: (310) 904-9380

IS IT A PUMPKIN OR JACK-O-LANTERN?

One of the more challenging aspects of clearing a design mark in the United States is finding similar marks that have already been registered with the United States Patent and Trademark Office (“PTO”). Unlike searching words or phrases, designs are given codes (“coded”) based on 29 Categories found in the PTO’s Design Search Code Manual. (See <http://tess2.uspto.gov/tmdb/dscm/index.htm>).

DESIGN CATEGORIES: For example, Category 4 covers supernatural beings, mythological or legendary beings, fantastical beings or unidentifiable beings that includes devils, angels, leprechauns, witches and super heroes. Also found in Category 4 are plants, objects or geometrical figures that represent humans or animals. Each Category is divided into many sub-categories that further categorize the designs. For example, there is a sub-category for mythological beings, superbeings, ghosts and aliens (04.01.07), sphinx (half human, half lion) (04.03.02) and plants, parts of plants, or combinations of plants representing a person (04.07.01). See below:

04.01.07 Mythological beings, superbeings, ghosts, aliens



04.03.02 Sphinx (half human, half lion)



04.07.01 Plants, parts of plants, or combinations of plants representing a person



CONDUCTING A DESIGN SEARCH: To search the PTO website for designs coded, for example, as mythological beings, superbeings, ghosts and aliens (collectively “mythological beings”) go to the Trademark Electronic Search System (TESS) at the USPTO and select [Word and/or Design Mark Search \(Free Form\)](#). Enter the design code 04.01.07 (removing the dots “.”) and add the design search code [dc] (i.e., 040107[dc], also shown below). Click Submit Query.

TESS Home NEW USER STRUCTURED SEARCH DOC SEARCH QG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE “O.K.,” DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED. THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

View Search History:

Records Returned: 100 Plurals: Yes

Search Term:

Please logout when you are done to release system resources allocated for you.

US Trademark Field Codes

Code & Name	Code & Name	Code & Name
[AD] Abandonment Date	[IC] International Class	[RD] Registration Date
[AF] Affidavits	[IR] International Registration Number	[RE] Renewals
[AR] Assignment Recorded	[LD] Live/Dead	[RG] Register
[AT] Attorney of Record	[MD] Mark Drawing Code	[RN] Registration Number
[B] Basic Index	[MI] Mark Index	[SF] Section 44 Indicator
[CB] Current Basis	[MN] Mark Non-Punctuated	[SD] Single Design Code
[CC] Coordinated Class	[MP] Mark Punctuated/Word Mark	[SN] Serial Number
[CD] Cancellation Date	[OB] Original Filing Basis	[SO] Serial - Other Formats
[CR] Change in Registration	[OD] Other Data	[ST] Standard Characters Claimed
[DC] Design Search Code	[ON] Owner Name	[SR] Date Amended to Current Register
[DD] Design Description	[OW] Owner Name and Address	[TC] Trademark Search Facility Classification Code(limited to 8-28-07 through 1-31-11)
[DE] Description of Mark	[PD] Priority Date	[TD] Total Designs
[DM] Decimal Mark	[PF] Physical Filing Date	[TF] Distinctiveness Limitation Statement
[DS] Disclaimer	[PO] Published for Opposition	[TI] Translation Index
[FD] Filing Date	[PM] Pseudo Mark	[TL] Translation
[FM] Full Mark	[PI] Pseudo Mark Index	[TM] Type of Mark
[GS] Goods and Services	[PR] Prior Registrations	[UD] Update/Load Date
		[US] US Class

All records that contain this design code will be disclosed in the search results. In this case there are 3,579 records that contain design code 04.01.07. An excerpt of the search results is below:

[TSSB Home](#) [NEW USER](#) [STRUCTURED](#) [FIND FORM](#) [WWW.DCI](#) [SEARCH Q&A](#) [PANEL LIST](#) [MARK LIST](#) [BOTTOM](#) [HELP](#)
 Logout | Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **3579 Records(s) found (This page: 1 ~ 100)**

Refine Search:
 Current Search: S1 [040107\[dc\]](#) docs: 3579 occ: 3579

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86656230		TSDR	LIVE
2	86650012	AIR CANADA SKYRIDERS	TSDR	LIVE
3	86610253	ATTITUDE EVERYBODY'S GOT ONE.	TSDR	LIVE
4	86587559	AU FUDGE LOS ANGELES AF	TSDR	LIVE
5	86435667	HOOD HERO ENT	TSDR	DEAD
6	86167023	GREEDY GIRL GREEDY IS GOOD	TSDR	DEAD
7	86425055	TORTILLERIA SANTA FE . AREA 51 MEXICAN PRODUCTS	TSDR	LIVE
8	86359325	TEAM DUCK ASSASSIN	TSDR	LIVE
9	86757793		TSDR	LIVE
10	86755783	GROW YOUR HEART 3 SIZES	TSDR	LIVE
11	86651073		TSDR	LIVE
12	86651071		TSDR	LIVE
13	86644342	DOGGONE GOOD! VALUE PACKED DOG FOOD FOR ALL DOG BREEDS!	TSDR	LIVE
14	86643215	DC	TSDR	LIVE
15	86586922	MOE MOUNTAIN HOT SAUCE SINCE 2014	TSDR	LIVE

Click on “image list” and each record is displayed by the design:

 85875192	 85874991	 85873079
 86635276	 86592981	 86518868

Undoubtedly, searching 3000+ records is too daunting. The search can be narrowed by other criteria such as a key word in the mark description [de] or by international class [ic]. For example, enter 040107[dc] and ghost[de]. The search results are narrowed to 134 marks that contain ghost designs. Examples below:



Or the search can be limited to a certain class such as toys (Class 28) (040107[dc] and “028”[ic]). The search results change to 344 marks of mythological beings for toys. Examples below:



KEY WORD SEARCHES: But what if the design does not exactly fit into one of the 24 categories? For example, a mark is described as a “jack-o-lantern” but there is not a design code for jack-o-lanterns. It could be described as a pumpkin:

05.09.12 Pumpkins



But if the design is not an actual pumpkin, what other design codes can be used to describe the design? For the purposes of this discussion, two “jack-o-lantern” designs are analyzed.

1) The first design is described as: “a profile view of a jack-o-lantern with carved human facial features and sunglasses and having a wheat hair Mohawk with an ivy vine interspersed” for “beer” in Class 32. The design was coded for several design elements including: 04.07.01 - person formed by plants; plants forming a person; plants or combinations of plants representing a person; plants representing a person and also 05.09.12 - pumpkins. A search of either of these design codes would disclose this design.



2) The second design is described as a 3D “configuration of the packaging for the goods, namely, a beverage container featuring a globular bottle shape resembling a jack-o-lantern” for “sports drinks” in Class 32. This design is coded as: 04.07.02 - objects forming a person; person formed by objects and 19.09.02 - bottles, jars or flasks with bulging, protruding or rounded sides; flasks with bulging or protruding sides; jars with bulging or protruding sides.



In these two jack-o-lantern examples, searching the individual design codes would not reveal both marks but searching by the key word, “jack-o-lantern” would disclose both marks. A search of “jack-o-lantern” in class 32 discloses only these two results. However, a search by the key word “pumpkin” in class 32 reveals a total of 18 marks. Some of which are also pumpkin head designs shown below:



CONCLUSION: As shown above, there is not one way to clear a design mark. It requires use of all the tools - design codes, key words, class designations and the like - in various combinations depending on the design. Design codes can designate the (i) form of the design, e.g., pumpkin or persons or objects formed by plants and; (ii) function (the second jack-o-lantern mark was also coded as a bottle). Key words can include a variety of terms and in the case above, both “jack-o-lantern” and “pumpkin” revealed different and relevant results.

On the applicant side, it is important to thoroughly describe the mark as this is one of the criteria used by the PTO to code the design. Also, once the codes are entered into the record, applicant can request that additional codes be included in the record. This could improve the ability to

uncover more relevant marks that in turn would increase the chances of avoiding a potential conflict and reduce unnecessary costs associated with such a conflict.

Aversano IP Law provides strategic advice in the global marketplace for securing, protecting and enforcing intellectual property rights by way of trademark, trade dress, copyright and design patent.

 Aversano IP Law | aversanoiplaw.com

E: Trademarks@aversanoiplaw.com

T: (310) 904-9380

Follow the Blog on Non-Traditional

Marks: <http://ntmblog.wordpress.com/>

Disclaimer: The views expressed in this Newsletter are not intended as legal advice or an endorsement of any marks and should only be construed as the author's observations based on information provided through public records. Links to websites are for informational purposes only. Descriptions of the registrations are not intended as legal advice or to assert that likely results will occur in similar situations.