

831-275-1401
chris@knowmad.law
www.knowmad.law



484 Washington St.
Suite B-313
Monterey, CA 93940

August 1, 2017

Christopher McElwain
Knowmad Law
484 Washington St., B-313
Monterey, CA 93940

Re: New U.S. Trademark Application – Search Report, Analysis and Proposed Filing Particulars for “KNOWMAD LAW”

Dear Chris:

Thank you for entrusting us with protection of the above-referenced trademark. We have conducted a brief preliminary clearance search and analysis, the results of which are summarized below. In short, we feel that “KNOWMAD LAW” has a fair-to-good chance of successful registration.

If you wish to proceed with this application, please confirm the following proposed filing particulars, which reflect our understanding of your trademark and goods/services.

Mark: “KNOWMAD LAW” (standard characters)¹

Owner: Christopher McElwain (individual, U.S. citizen), 484 Washington St., B-313

Goods & Services:

Class 045: Attorney services; Intellectual property consultation; Legal services; Providing on-line information in the field of intellectual property

First Use: May 1, 2017²

Search Results and Analysis

The USPTO will refuse registration of a trademark under a number of circumstances, including when the Examining Attorney determines that there is a **likelihood of confusion** with a prior-registered mark or prior-filed application or that the mark is **merely descriptive** of the goods or services.

¹ This means that the registration will claim exclusive rights to the phrase “knowmad law” in any style. It will not claim any design elements present in your logo.

² This date should reflect the earliest date you can confirm you were using the mark to promote your services

(1) Likelihood of Confusion

The two most important factors in determining likelihood of confusion are similarity of the marks and similarity of the goods or services. However, neither the marks nor the goods need be identical for the Examining Attorney to issue a likelihood-of-confusion rejection.

We have performed a cursory, preliminary search of the USPTO trademark registry and listed below several prior registrations and applications of which we think you should be aware. The most problematic prior mark is probably “KNOWMAD” for marketing services in Class 35 and web development in Class 42. However, due to the lack of meaningful overlap between legal and marketing services, we believe that the marks are likely distinguishable.

In the event that the registration for “KNOWMAD” and/or other prior mark(s) listed below (or one we may have missed) are cited against you, we would have the opportunity to argue that the refusal should be withdrawn. For example, in the case of “KNOWMAD,” we would have a compelling argument that the respective services are unrelated and that consumer confusion is therefore unlikely. However, there is no guarantee that this response will convince the Examiner.

Mark	Reg. No.	Owner	Effective Date	Relevant goods/services
KNOWMAD	4102282	Knowmad Services, Inc.	7/11/2011	IC 035: Advertising and marketing services [. . .] IC 042: Creation, design, development and maintenance of Web sites for third parties [. . .]
PROJECT KNOWMAD	5039446	Riverdale Country School	11/5/2015	IC 041: Education services, namely, providing classes and programs through experiential summer camp program to high school and middle school students; education services, namely, providing courses of instruction at the middle school and high school level.
KNOWMADICS	4782606	Knowmadics, Inc.	10/10/2013	IC 035: Business analytic services; Business data analysis; business records management; Business information management, namely, gathering and reporting of data analytics; Business management; Business Consultation services; Marketing services; Internet marketing services.

				IC 045: Monitoring of computer and telecommunications systems for security purpose
WE KNOW THE LAW	4451289	The Edwards Law Firm	2/8/2013	IC 045: Legal services.
NOMAD	s/n 87472746 [not registered]	Security In Motion, LLC	6/2/2017	IC 042: Providing temporary use of non-downloadable cloud software for mobile security and surveillance systems that provides analytics and reports regarding changes in conditions, electronic messages, archives of captured still-images and video, and video streaming functionality IC 045: Personal safety, security and monitoring services in the nature of monitoring notifications from a security surveillance system and notifying users, property owners and emergency facilities
MODERN DAY NOMADS	4249256	Tiffany Owens	2/20/2012	IC 045: House sitting; Pet sitting.
NANNIES 4 NOMADS	s/n 87167935 [not registered]	Mia Anthony	9/12/2016	IC 045: Nanny services

(2) Descriptiveness

You will likely be required to disclaim (i.e. claim no exclusive rights to) the term “LAW.” However, we think it is unlikely that the Examiner would determine that the mark “KNOWMAD LAW” as a whole is merely descriptive in connection with legal services.

(3) Unregistered Marks

In addition to the risk of a refusal by the Examining Attorney, owners of both registered trademarks and unregistered “common law” trademarks can block your registration by filing an opposition to your application. Parties claiming prior use of a similar mark can also demand that you cease use of your mark or even file a complaint alleging trademark infringement, regardless of whether or not you obtain a registration. Owners of foreign trademarks can pose an additional risk to registration, since they have 6 months to file a U.S. application claiming priority to their foreign application.

We have therefore conducted a very cursory Internet search to identify any businesses with obvious prior trademark rights. We encountered several references to a Scottsdale, Arizona law firm that appears to use the mark “NOMAD LAW FIRM” (see, e.g. <https://www.yelp.com/biz/nomad-law-firm-scottsdale>). However, the firm does not appear to have an active web presence, and its domain, www.nomadlawfirm.com, is expired. It appears probable that they are no longer in business and may have abandoned the mark.

In addition, we encountered the mark “LEGAL NOMADS” (www.legalnomads.com). However, the mark appears to be used in connection with a food blog rather than legal services.

In any case, we have no reason to believe that any of the parties mentioned above would oppose your application or would be successful if they did.

In conclusion, we believe that overall your mark has a fair-to-good chance of successful registration.

Please let us know if you have any questions regarding any of the above.

Best Regards,

A handwritten signature in black ink that reads "Chris McElwain". The signature is written in a cursive, flowing style.

Christopher R. McElwain