

# WHAT'S IN A NAME?

The Guide for Pursuing Legally  
Defensible and High-Value Trademarks





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### Powerful brands:

- Provide clarity of thought and action for every part of business operations;
- Help companies and products stand out and stand above the competition;
- Shape perceptions, enabling companies to earn recognition and loyalty;
- Elevate perceived value and lower barriers for marketing and sales efforts;
- Strengthen employee recruitment and retention efforts, and
- Protect against negative market and PR events.

Company and product names are foundational elements of brand identity, helping you establish a presence and image in the minds of your customers and other important audiences. Strong brands share five characteristics. They are distinct, authentic, memorable, enduring, and defensible. On the next page we describe these characteristics and provide tips for making sure your brand name has them.

## TWO DELTAS

Can two companies have the same name? Yes. A trademarked product name like Delta® (faucet) does not infringe on Delta Air Lines® or vice versa because the companies' industries are distinct. Their marks don't cause confusion among consumers, which is one of the primary tests for defensible marks.

## 1. DISTINCT

In order to stand out from your competitors, and create clarity among your target audiences, a strong brand name must be distinct, especially within your industry. Depending on the nature of your business, you may also want to consider your name's uniqueness from a geographic perspective. Are there other significant businesses in your geographic region that share the same, or similar name? Even if these other businesses aren't currently competitors, or even in the same general industry as you, their brand name could create confusion with your name, prevent future expansion of your brand, and dilute its value in the marketplace.

## 2. AUTHENTIC

Your name must fit your company, not in describing what you do, but in capturing the essence of who you are. What is your company's personality? Why do you do what you do? What makes your company different? Understanding the answers to these questions will help to inform the naming process. You want a name that is uniquely "you."

## 3. MEMORABLE

A brand name doesn't have much value if no one can remember it. Find a name that is short, easy to pronounce and, ideally, evocative. Alliteration usually helps.

## 4. ENDURING

Developing a brand takes time and effort, so it's important to find a name that will last as your business evolves. Is the name flexible enough to accommodate new strategies, new services, new products, new acquisitions? Will the name still fit if your focus changes or expands? How will the name fit into an overall brand architecture?

You should also be careful about trendiness when it comes to naming. Unless you're eager to rebrand again in a short period of time, avoid latching onto trends that will disappear or, worse yet, become unfashionable.

## 5. DEFENSIBLE

Is the name available and defensible from a legal perspective? That's a question for the lawyers, and we'll explore that next.



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The following is an overview of what types of intellectual property can be trademarked.

**PRODUCT NAMES** — Product names are the names by which consumers usually call a product and under which marketers promote it. Monster Energy® is a type of beverage distributed by Monster Energy Corporation.



**HASHTAGS** — As long as they are not too generic or descriptive, some companies have successfully trademarked defensible hashtags. Some real examples include #freecheesefriday, #McDstories, #makeitcount (Nike).



Within the U.S. Patent and Trademark Office (USPTO), there are 45 classes that are used to categorize the thousands of marks registered each year — 34 for products and 11 for services. These 45 classes are aligned with an international classification system and confirmed by global treaties. The global nature of mark categorization makes these categories difficult to change or expand. Within those classes are more than 400 subclasses that further categorize products and services.

*When registering a trademark, it is mission critical to file a federal application under the appropriate class or classes.*



Once a company has confirmed the right class or classes for its application, the next step is to dive deeper into those classes to avoid conflicts with existing marks. To build a defensible application, this is the process in which intellectual property law becomes as much of an art as it is a science. It requires the careful and detailed eye of an experienced IP attorney. The application must be specific enough to enforce the mark, but also broad enough to cover future anticipated use and marketing scope.

The wrong classification can result in denial of the application and loss of all fees associated with it. Even if approved, the wrong classification could also make the mark harder to defend. Fees can be as high as \$400 per class, but there are different fee options depending on the nature of the application and how quickly the company would like to pay fees and expedite results. Filing a trademark application outside the U.S. can also potentially cost thousands more in fees.

A basic knowledge of trademark considerations can be extremely helpful when undertaking a naming process for a new product or company. Fundamental knowledge of the legal considerations addressed in this paper can help you establish a powerful, protectable name, while minimizing the likelihood of problems down the road.



## WHICH CLASS IS CORRECT?

Where does a “self-serve kiosk with a touch-screen interface” belong? It depends. It could be a computer device (Class 009). Or furniture (Class 020). Maybe it’s both. It may also fit Class 038 (Telecommunications Services). An experienced trademark attorney can deal with challenging classifications like this one.

## THE NAMING PROCESS: WHERE CREATIVITY AND THE LAW MEET

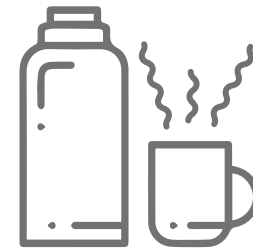


The naming process can be exciting, but also carries with it many emotional, political and cultural implications. People will assign their own biases to name options. Some people are concerned with how the name maintains context and history. Some want to know bottom line impact in the market while others desire buy-in from the internal team. At its core, naming a product, initiative or organization is a subjective process that very rarely satisfies all stakeholders involved.

After many years of guiding companies through the naming process, our experience shows that market and brand research set the foundation for the right name. Interviewing clients, researching the market and competition and understanding the company vision will inform the process.

Start with creating a short list of five to seven relevant and effective names. With that short list in hand, it's time to conduct a baseline name search to narrow the list further. Sometimes a focus group of clients is organized to support the naming process, but companies can also organize an internal branding committee. In small companies, the leaders or an executive team may go through this process on their own, although hiring branding experts is not a bad idea.

Many of the common mistakes or pitfalls of the naming process occur in the early stages. After falling in love with a particular name, companies don't take the time to thoroughly search for businesses in similar industries with the same name in their geographic market and elsewhere.



### GOT A THERMOS?

The rare Catch 22 of a popular brand is to become genericized. A once valid trademark may lose the right of enforcement if the name has lost its distinction as a brand. Former brands such as thermos and laundromat no longer carry trademark protection.



Don't assume that if a domain name URL is available, then the name must be available, too. Under federal law, "cyber-squatters" are prevented from purchasing a domain and holding it without permission if it's associated with a highly valuable business name. Those names may or may not be trademarked, so don't assume that an available domain is also an available business name.

Sometimes the search isn't thorough enough. In addition to searching the USPTO database, a common law trademark search through search engines or business directories can identify businesses that demonstrate strong common law trade rights to a certain business name. It is also helpful to do a state trademark search to determine if names have been registered only at the state level.

At this point, bringing in a brand strategist and IP attorney is ideal. They can work together, compare notes and help to strengthen the full brand identity so that it's understood and enforceable. During that process, they will not always see eye-to-eye, but there is usually room for compromise. With that in mind, we imagined what a naming strategy meeting between marketing and legal might look like and created the following point-counterpoint conversation. While not a comprehensive list of commonly debated branding and legal issues associated with the naming process, it does illustrate how important it is to include a brand strategist and IP attorney early in the process. We hope it provides further understanding of what each professional takes into consideration, as well as some talking points for improving collaboration.



## LOST IN TRANSLATION

Most people have heard about the epic fail of Chevy "Nova" in Mexico (the name translates to "no go"). Make sure that company names and spellings don't translate to something humorous, negative or gross in other languages.

Another common situation that can prevent a trademark from achieving federal registration is if the term is generic for the products in another language. For example, "café" means coffee in French and could never be protected as a coffee trademark, even in an English-speaking country like the U.S.

## COFFEE TIME WITH LEGAL AND CREATIVE



Imagine your brand strategist and IP attorney sitting down with you for coffee to discuss the naming process. They both have your best interests in mind, but they'll also "debate" the line between creativity and legal protections. The conversation might go something like this:

**You:**

"I have this list of potential names. What's next?"

**Creative:**

That's great! A list is an excellent place to start, but be sure you include others in your process. The best approach is to conduct a group brainstorm to generate a large number of options organized around different categories and themes. Blend options together, try variations and continue to explore until you've generated multiple options that align with all of your criteria. No matter how brilliant your original idea may be, it's probably not going to be the final selection for any number of reasons.

**Legal:**

This is actually the perfect time to bring in the legal team. Send us your list so that we can conduct a trademark search. It could narrow down the choices right away, and doing so early helps avoid any trauma associated with someone becoming "too attached" to a specific idea.

"I really want our name to tell a story. What are your thoughts about that?"

Story is an important component of branding, but typically we try to create names that evoke an idea or feeling rather than something that tells a complete story. In order to evoke anything, it is critical to understand what your name means to all relevant audiences, and this understanding requires research. Who are your audiences? Where are they located? How do they read, interpret, and understand your brand name? Does your name have other meanings or associations, positive or negative? Is there any chance that your name may be offensive to certain groups?

Well, there is also such a thing as being too descriptive. A descriptive name identifies one or more characteristics of a product or service covered by the mark and only serves to describe the product. Names that are deemed “descriptive” by the USPTO are not eligible for trademark registration. Also, avoid playing off someone else’s brand. Being too inspired by trends can get you into trouble.

“Once we have some names narrowed down, how many people should be involved in the final decision? I don’t want anyone to feel left out.”

The answer to your question varies depending on the company, but it's important to keep in mind that naming is a foundational component of any brand. Stakeholders tend to be heavily invested in the process and outcomes, and extremely attached to their own ideas.

On this we agree. Remember that the goal is long-term value for the company. Defensible names with strong trademark protection have long-term value. Also, trademark infringement lawsuits can be very expensive if the name is chosen based on a popular vote rather than on research and strategy.

**You:**

“How do I make sure that branding is consistent and people don’t shorten or change the name after we’ve developed it?”

**Legal:**

Consider whether or not it makes sense to register those modifications. Might you use a popular modification in a marketing campaign down the road? You may also want to block others from using the modification. It’s important to weigh the cost of each option.

**Creative:**

When possible, use interviews, surveys or focus groups to validate brand-naming decisions. This process may reveal potential issues before they become a problem, or it may just help set stakeholder minds at ease before moving forward with the development of a full brand identity.

**Creative:**

Ultimately, no matter how much effort you put into managing your brand, people may decide to shorten it or modify it in a variety of interesting and creative ways. This is especially true for longer, multi-word brand names, which often lead naturally to acronyms or nicknames (think “B-Dubs” for Buffalo Wild Wings). Consider these possibilities during your process, and review names in context in order to help uncover variations. What does the name look like when written out? What does it sound like when spoken? Is there a natural tendency to shorten the name or modify it in some other way? If the name is modified, how will that impact your identity and your brand strategy?

**You:**

We are investing a lot of time and money into this process and there’s no guarantee the brand name we choose will resonate with customers. How can we improve our odds?

**Legal:**

We actually advise that you don’t tell anyone about your idea until it’s protected. Okay, we understand the value of focus groups, but make sure you talk with an attorney about potential need for nondisclosure agreements. Be prepared to file quickly once a decision is made. Also, be careful about communications internally or externally before you launch.

Once your name is chosen, develop visual concepting and design of the brand identity. Your early market research, and brand platform (e.g. core values, brand position, vision, attributes, and brand promise) will serve as inspiration. The identity can include font and color choices and any symbols or glyphs recommended for the branded logo that will be filed for trademark registration.

From concepting to reviewing and approvals, the visual process can take weeks depending on the complexity of the design. Once approved and finalized, the logo design is included in the trademark application.

Brand identity guidelines and a logo kit will support a consistent launch and use of the name for all materials and marketing. Consistent and regular trade use of the name is important to support trademark enforcement.

## DISPLAYING, RENEWING, MONITORING AND ENFORCING TRADEMARKS

The ® and ™ symbols put third parties on notice that you are claiming rights to a certain term or name. Use of these symbols can be important to help establish that infringement is willful during enforcement actions. The ® is used only for registered marks. The ™ can be used for both registered and unregistered marks, including claiming trademark rights or “common law” rights to a term. These symbols can sometimes be disruptive in advertising copy. However, as a best practice it is recommended to use these symbols in connection with the prominent uses of trademarks on packaging and in advertising.



Federal trademark registrations are valid for five years after they become registered, with optional renewals every 10 years after that. However, a company must show it is still using its trademark when each renewal is filed. From then on, they must file for optional renewal toward the end of every 10-year period. Failure to renew a registration by the deadline may require a completely new trademark application be filed with no guarantee of approval.

Because trademark law only protects marks as long as they are in continual and consistent use, companies can lose a valid registration if they stop using a mark in regular commerce.

It is also important to monitor consistent use of trademarks in all company communications and materials to increase brand value and enforcement. IP attorneys want to demonstrate a history of consistent use when litigating infringement claims. This is a key point to discuss with anyone in the company who doesn't understand the harm of using an old logo or altering the registered brand name in communications.

If a possible infringement is identified, companies should consult legal counsel to confirm the infringement. Consumer confusion is often the main topic of debate in most infringement cases. If the infringement is detrimental enough to warrant a formal "cease and desist" notification, this correspondence should not be taken lightly. Federal law requires that cease and desist actions carry a duty to enforce. That means that if the mark infringement is not ceased immediately by the defendant to the satisfaction of the trademark owner, the trademark owner must enforce the trademark through legal channels such as arbitration or litigation.

## GOOGLE IT

Within the world of intellectual property, Google® has fought off trademark challenges that claim the trademarked brand "Google" has become genericized. (Go ahead, Google it.) For now, Google is still a recognized and enforceable trademark, but will it become another Bayer® "aspirin"—a once distinct and now indefensible U.S. trademark? Time will tell.



When Google's co-founders announced in August 2015 that they were changing their corporate name to Alphabet, the move seemed counterintuitive to leveraging the power of a multi-billion dollar, globally recognized brand. The co-founders cited the ability for Google to focus on its core functions as a holding company for search and advertising ventures while other "non-core" companies under the Alphabet umbrella can develop their own distinct brands.

Google has arguably contributed to a monumental shift in consumerism that makes the naming and trademark process much harder for companies, products and services. What used to be a fun exercise on cocktail napkins now requires a more diligent approach to trademark search clearance and enforcement in the information age.

Infringement is a serious threat to business owners who don't have a tangible defense for denying the infringement. Possible defense strategies can include:

- legal exceptions;
- delay in enforcement by the trademark owner;
- attacking the validity of the registration, and
- claiming abandonment or fair use.


State or federal courts will hand down judgments on trademark infringement that could include the defendant compensating a trademark owner for the infringement, removing all references and use of the offending mark and even disposing of inventory and shutting down the business altogether. Defendants can choose to appeal, but this can be a very expensive proposition while also trying to operate a business.

## FINAL THOUGHTS



Due to the serious consequences of trademark infringement and the owner's legal rights and duties to enforce registered trademarks, the decision to clear and register a company name should be handled with care.

Enjoy the naming process, but build value from the start by including experienced branding professionals and IP legal counsel on your team.



*P.S. You can still use cocktail napkins during your brainstorming process. Just save your list to the cloud later.*

## TRADEMARK USAGE CHECKLIST

Certain rules of practice have evolved to ensure a trademark is properly and consistently used. Here is a handy checklist to ensure you and your team are following best practices.

<input type="radio"/>	Always use trademarks as adjectives, not as nouns or verbs.
<input type="radio"/>	Always use trademarks in their original registered form.
<input type="radio"/>	Variations or rearrangements should be considered for separate trademark protections.
<input type="radio"/>	Never use trademarks in the plural or possessive form.
<input type="radio"/>	Use trademarks only in connection with their approved product or service.
<input type="radio"/>	Use the ™ symbol on all your marks or the ® symbol if your trademark is registered.
<input type="radio"/>	Use distinctive type or font to differentiate your trademark from surrounding text.
<input type="radio"/>	Never abbreviate or alter the spacing of your trademark.
<input type="radio"/>	Never change the spelling or type form or graphic elements of your trademark.
<input type="radio"/>	Include trademark notices when using trademarks in advertising and packaging (not mandatory in U.S. but helpful for enforcement).
<input type="radio"/>	Don't assume you have rights to a trademark just because you own a domain name containing the term.
<input type="radio"/>	Don't threaten third parties who are using your trademark accurately in product comparisons.

## SOURCE LIST



### Trademark Classes

<https://www.nolo.com/legal-encyclopedia/trademark-classes.html>

### USPTO Search Database

<https://www.uspto.gov/trademarks-application-process/search-trademark-database>

### USPTO Trademark Fee Structure

<https://www.uspto.gov/trademarks-application-process/filing-online/trademark-application-fee-structure>

### Slogan infringement cases

<http://mentalfloss.com/article/57293/8-times-companies-faced-lawsuits-their-slogans>

### Ice cream truck showdown

<http://www.nydailynews.com/new-york/queens/mister-softee-master-softee-article-1.1774733>

### Slogan infringement case against Apple

<http://www.nydailynews.com/new-york/nyc-street-artist-apple-stole-slogan-article-1.1788402>

### The Consumerist – Google is still a trademark

<https://consumerist.com/2017/05/16/google-avoids-genericide-will-remain-a-protected-trademark/>