

OUTSIDE PERSPECTIVES

# Selecting A Brand Name That Shines: Avoiding The Perils And Pitfalls

SELECTING A BRAND NAME FOR A NEW product can be as important to the product's commercial success as the development of the product itself. The



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brand name should be catchy and memorable, elevating the product and distinguishing it from competitive alternatives. But all too often, a trademark is selected as an afterthought

and hastily. Choosing an effective brand name at the outset will not only enhance the success of the product but also can avoid objections, enforcement issues, and even litigation down the road. The following are some tips to consider when selecting a new mark.

## Select a “Coined,” “Arbitrary,” or “Suggestive” Mark Rather Than a “Descriptive” Mark

There is a natural tendency to select a brand name that somehow describes the product. A “descriptive” mark describes in a direct way the product or service, or some characteristic or feature of the product or service (for example, CORN POPS for breakfast cereal). When releasing a new product, conveying this information through the brand name may seem like a good idea because it can immediately communicate to consumers what the product is. However, from a trademark perspective, it is best to avoid using descriptive terms for a brand name. Descriptive marks are more likely to have already been used by competitors. Additionally, descriptive words must remain available for others to use in describing their own products or services. For this reason, they are more difficult to protect than coined, arbitrary, or suggestive marks, which are considered inherently distinctive and therefore stronger marks at inception.

A “coined” mark is a word that does not exist in the English language, but was created for the appeal of its look, spelling, and sound (for example, EXXON for gasoline). An arbitrary mark is a word that exists

in the English language, but with a meaning entirely unrelated to the product or service with which it is used (for example, APPLE for computers). Coined and arbitrary terms are often considered the strongest kinds of trademarks. A “suggestive” mark is a word that suggests a characteristic of the product or service, but still requires some effort of thought, imagination, or perception to figure out what the product or service is (for example, COPPERTONE for suntan lotion).

## Consider the Geographic Possibilities – Where Do You Want to Go?

Is your company's marketing plan limited to the United States? Or will you eventually expand to neighboring countries, and important overseas markets? If so, it will be important to consider how the brand name will be perceived in other regions. Remember that “American English” is not always the same as “British English,” or “Canadian English,” or “Australian English.” For example, “Elevator” in the United States versus “Lift” in the United Kingdom, or “Faucet” in the United States versus “Tap” in Canada.

If your plan is to go into non-English speaking markets, consider whether the same meaning will be conveyed. This is particularly important where a non-roman alphabet is used. For example, if China will be an important market, consider whether to use a Chinese character version of the mark. When selecting a Chinese character version of the mark, consider the transliteration of the mark and its possible literal meanings to the Chinese consumer.

## Make Sure the Domain Name is Available

It is important to determine whether the brand name is available as a domain name. Given the importance of the Internet in business and marketing, consider whether the new product will require a separate domain name and check whether it is available in the desired Generic Top-Level Domains (“gTLDs”) as well as any important Country Code Top-Level Domains (“ccTLDs”). If you plan to register a domain name

for the mark, this should be done as soon as possible. Generally the cost is nominal (typically under \$20 to register the domain name for a year) and will limit the likelihood that a third party, whether legitimately or not, will register the domain name. Of particular concern are “cybersquatters” who may misappropriate the brand name and register it as a domain name in one or more of the gTLDs and ccTLDs. While legal remedies are available against cybersquatters, the cost to enforce your trademark rights against a cybersquatter is significantly higher than the cost to register the domain name outright.

Even if the new product does not warrant a separate domain name, it is important to check whether any identical or substantially similar domain name are already registered and review the website that it resolves to. You do not want customers looking for your product to be directed to a controversial website.

### **Adequately Clear the Mark**

It is vitally important to conduct adequate clearance of a mark before it is adopted. A company should avoid adopting a brand name that is identical or so similar to another brand name that consumers are likely to be confused by use of both in the marketplace. This means a search should be done to determine whether the mark is available from a legal perspective. A trademark clearance search will locate earlier identical and similar marks, which are then analyzed to determine whether they pose an obstacle to use and registration. Since trademark rights in the United States may be obtained simply by using the mark first (so-called “common law” rights), the search should include databases of common law marks as well as marks filed or registered with the United States Patent and Trademark Office and with the 50 state trademark offices. While it may be tempting to limit or avoid the costs associated with a trademark search, especially at the launch of a new product, the consequences of not searching can be devastating. A company could begin building significant goodwill in the new brand name and wide-spread recognition amongst consumers, only to find itself faced with a claim of trademark infringement which can threaten all of the time and money invested in developing that brand equity.

### **Conclusion — Avoid the Afterthought**

Giving considered attention early to brand name selection as part of the product development pro-

cess, rather than as an afterthought, can yield many benefits for the business and avoid many headaches for in-house counsel.

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