

**The process of choosing a trademark** is an exercise in creativity and brand refinement. The following materials provide some general foundational features of trademarks that are relevant to this exercise, as well as a stepwise methodology that may help you streamline the process.

## What is a trademark?

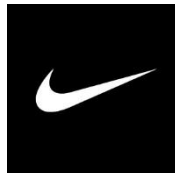
A trademark is a **source identifier**. Any word, symbol or device that identifies and distinguishes the source of particular goods of one party from those of other parties can serve as a trademark. Some well-known trademarks include:

Word marks:

“APPLE” for computers, consumer electronics, etc.

“CARIBOU” for coffee and other beverages

Images/logos:



Sounds:

The Pillsbury Doughboy “giggle”

Harlem Globetrotters “Sweet Georgia Brown”

## Why are trademarks important?

Trademarks (also referred to as “brands”) are important for a variety of reasons. Some significant reasons include:

- Brands are ubiquitous and influence consumers’ purchasing decisions.
- Trademarks can help companies build goodwill and brand reputation.
- A trademark can last indefinitely, so long as it is used in commerce and the owner takes steps to maintain his/her rights. This is a huge advantage over other types of intellectual property that expire after a set number of years (such as patents and copyright).

## What is an effective trademark?

When choosing a trademark, you want a mark that distinguishes your goods or services from everyone else’s. Additionally, when seeing your trademark, consumers should not be confused into thinking that your goods or services originate from another company, are sponsored or endorsed by another company, or are affiliated with another company.

## The focus of trademark law is consumer protection.

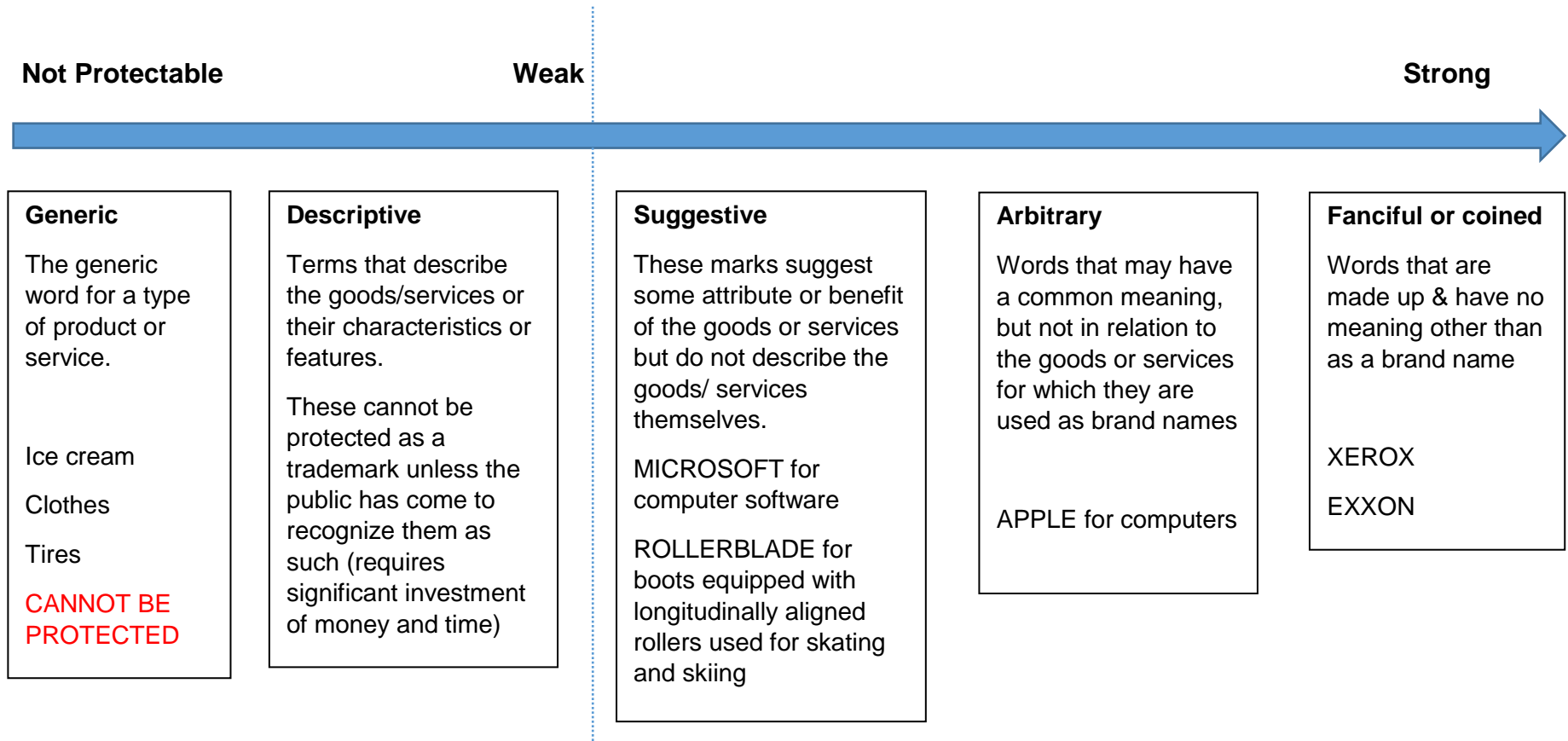
Trademark laws (federal and state) are centered on the consumer.

Some of my clients have been surprised to learn that trademark laws were not written with the primary goal of protecting a company’s investment in their brand. Trademark laws were crafted to protect consumers who come to rely on the quality and source of goods associated with a particular trademark. Therefore, the primary legal analysis is whether there is a likelihood that a consumer, encountering your mark, may be confused as to the source of those goods or services. See **Step 6** below.

The fact that trademark laws also protect the trademark owner who has invested resources to create the brand and product is an added benefit of trademark law, but not the focus.

## What is a “strong” trademark versus a “weak” trademark?

Trademarks can be described as having the following levels of strength:



Words on the left of the spectrum (to the left of the dotted line) are not protectable as trademarks. As you progress farther right on the spectrum, the strength of the trademark increases. You want to choose a trademark as far right on this spectrum as possible.

## Strategy for choosing a new trademark.

When choosing a new trademark, the following suggested procedure may help you streamline the process.

**Step 1.** Assemble your branding team. Possible team members include:

- a. Product development
- b. Marketing
- c. Advertising
- d. Legal
- e. Website design/domain name management

**Step 2.** Determine the scope of your brand.

a. Identify the intended purposes of the brand. Possibilities include:

- 1) Company name
- 2) House mark (a mark used in conjunction with a line of products, e.g., CRAFTSMAN)
- 3) Lead product
- 4) Secondary product or product line extension
- 5) Product feature, ingredient, or accessory

b. Geography – where do you intend to use the mark? United States only? Outside the U.S.?

**Step 3.** Determine how the brand will fit in the market.

- a. Who are the targeted customers?
- b. What are the anticipated channels of trade?
- c. Does the brand have a “personality?”

**Step 4.** Generate a list of ideas for proposed trademarks:

- a. Existing words
- b. Made-up words (consider combining portions of different words, to create a new word)
- c. Design elements

**Step 5.** Refine your list to your “top 3” or “top 5.”

- a. Compare to competitors’ marks
- b. Search Internet sources to survey possible uses by others
- c. Determine whether the proposed mark has any meaning in English and/or a foreign language

**Step 6.** Provide your refined list to your trademark attorney for trademark clearance.

\* It is critical to have your trademark attorney perform a trademark clearance search AND evaluate the trademark search results. The trademark clearance is a risk assessment of: (a) the odds that the USPTO will grant you a trademark registration, and (b) the likelihood that someone might try to stop you from using the mark in connection with your business. Before you invest time and resources into building your brand, you will want to know the answers to these two questions. It is important that this legal analysis is done by a trademark attorney with knowledge and experience in trademark law.

**Step 7.** Once you have clearance from your trademark attorney, choose your trademark.

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