

# Publications

## Client Alert: Five Considerations When Selecting a New Brand

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Selecting a name or brand for a new product or service involves multiple considerations, some of which are not obvious at first and can haunt the company later. Marketing teams struggle with choosing a name that balances the right message and image to attract the target consumers while informing those consumers of the benefits and functions of the new product or service. During this process it is easy to forget that brands are valuable assets and protectable property under trademark law. Trademarks are the public face of a product or company and hold the reputation and goodwill of the company, typically for many years and even generations. Thus, it is important to select the strongest trademarks to lay a strong foundation for a long-term asset. Following are five considerations, beyond the marketing concerns, to assist in selecting a strong new brand.

### 1. Searching

While searching a trademark is not mandatory before selecting and adopting a new brand, there are many benefits to reviewing at least the Federal Register. For example, a search will reveal similar marks for similar goods or services. Knowing what similar brands are already in the marketplace can help you steer away from a mark that could embroil a company in infringement claims.

### 2. Descriptiveness

The most protectable options for trademarks are made-up words (like XEROX® or HÄAGEN-DAZS®) or common words used in an uncommon manner (like APPLE® for computers). On the other hand, marks that describe a characteristic, function, quality or purpose of a product or service, should be avoided because they are not entitled to trademark protection without evidence that consumers understand the mark as a brand, otherwise known as “secondary meaning” or “acquired distinctiveness.” For instance, selecting the term DELICIOUS for the name of a food product would require proof of secondary meaning/acquired distinctiveness because it describes the quality of the food item, namely it tastes good! If a company were able to use this

descriptive term to the exclusion of all others in connection with its food item, competitors would be barred unfairly from using a term commonly used and understood by the public to describe a particular quality of its products. Similarly, geographic locations and surnames need to acquire distinctiveness before being protected to the fullest extent.

### 3. Weak Marks

When there are many uses of a term in the market for similar goods and services it becomes difficult for that term to distinguish each companies' goods or services from one another. This is referred to as a weak mark. Because the primary purpose of a trademark is to be a short hand reference in the market to a particular product or service by a provider, when selecting a new trademark it is important to avoid weak terms that many other competitors use. Conducting a trademark search prior to adopting a new mark can reveal whether a term is weak for related goods and services.

### 4. Generic Words

Once a new trademark is selected it is also important to use it properly to maintain rights to the mark. Marks should be used as an adjective for the goods or services not as a noun. For instance, instead of saying "check out our latest model of ESCALATOR" say "check out our latest model of ESCALATOR brand moving stairs." When a trademark is used as a noun it may result in consumers calling **all** such products or service by your trademark, not just **your** products and thus losing its trademark significance (and rights). One of many examples of a trademark losing its trademark significance is the term ESCALATOR. It was once a brand name of moving stairs. Now it is an alternative or generic name for moving stairs instead of the valuable asset it once was.

### 5. Talk to an attorney

Although this last consideration appears self-serving, in the long run speaking with an attorney can help you avoid pitfalls and save money. However, don't just hire any attorney or the attorney that handled your divorce or corporate filings. Even great attorneys are likely unaware of the many nuances of trademark law. It is important to select an attorney experienced in trademark law who regularly practices trademark law, as they are in the best position to advise you about your trademark. After all, you would not hire even the best cardiologist if you need brain surgery!