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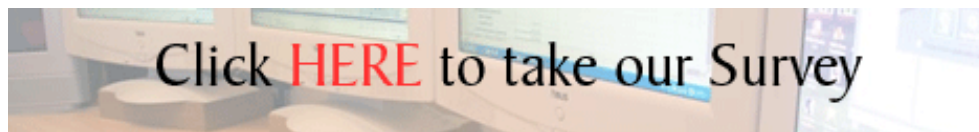


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## Brand Basics 101

by Bryan Sugar

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Developing an 'optimal' brand name has become a complex process in the global marketplace, but it can be a compelling and indispensable component of success

You know your business. You know your customers. And you know how to reach them. So, it would seem logical that when it comes to selecting a brand name, the name choice would come first; the call to a lawyer, second.

But developing a brand name has become a complex process in the global market. The type of name selected influences how much trademark protection will be enjoyed. Even before beginning the name selection process, it helps to understand the framework that will affect brand investment.

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A compelling brand name can be a determinant to the success of a company, product, or service. An 'optimal' name, on the other hand, can create a commercial impression in the market. It can also have sufficient legal strength to enable a company to prevent others from using it and does not infringe on another's rights.

### Levels of protection

Not all types of brand names are afforded the same protection. Under U.S. law, trademarks are categorized on a continuum, ranging from most distinctive and most protected to nondistinctive and unprotected.

In determining the type of brand name to adopt, marketers must weigh the desire to be 'distinctive' against the need to be 'descriptive.'

The more distinctive the name, the greater legal protection it will receive. Descriptive names communicate product and service attributes, but may be harder to protect.

As important as choosing a brand name is protecting the name. Steps need to be taken at the outset to protect the brand even before resources are invested to obtain consumer loyalty. Otherwise, a company may begin marketing under a name that has to be given up. Or worse, a company may use a name to which another party had a prior legal right—and risk a claim for trademark infringement.

Brand names that receive the highest level of trademark protection are those that fall under the category of 'arbitrary' and 'fanciful' marks. Arbitrary marks are real words that have nothing to do with the product or service marketed, such as the card game 'UNO.' Fanciful marks are made-up words created solely to identify the source of a company's product or service, such as 'Nerf' toy sporting equipment, 'Atari' video games and 'Lego' construction toys.

While these marks receive the most legal protection, brand professionals may decide against adopting fanciful or arbitrary names because of the investment needed to link such names to their corresponding service or product.

Trademarks that receive the next level of protection are 'suggestive' marks, which evoke a characteristic of an underlying good or service. Examples include 'Soaker' water squirting toys, and 'Tinkertoy' construction toys. While these brand names do not describe the goods or services they market, they identify important attributes. Other suggestive marks incorporate portions of existing words—such as 'Pictionary.'

Inherently distinctive, suggestive marks are afforded a high degree of protection. They can make ideal brand names, because they afford substantial legal protection while allowing a company to communicate product or service attributes.

Merely 'descriptive,' trademarks such as 'My Little Pony' for a toy pony, are not inherently distinctive because they describe a quality or characteristic of the good upon which the mark is affixed. However, descriptive trademarks like 'My Little Pony' can acquire secondary meaning and be protected. Marks acquire secondary meaning when the consuming public primarily associates that mark with a particular

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## Making your mark

Once the type of brand name has been selected, potential names need to be run by a trademark attorney who generally will perform two types of searches to determine whether the name can be legally protected.

These searches will determine if an application to register the name with the United States Patent and Trademark Office (PTO) will likely be rejected because of a conflict with a preexisting mark. Because registration with the PTO can take a year or longer, finding out whether a first-choice brand name is conflicted can save time and money. It also protects from infringing existing third-party marks as investment is made in the branding process.

The first trademark screening determines whether the exact name selected has already been federally registered as a trademark. If the proposed name is not federally registered, the attorney may suggest a comprehensive clearance search to eliminate other possible conflicts.

While companies are not required to register their trademarks there are many benefits to doing so. Obtaining and maintaining trademark protection for a brand name is vital to protecting a company's investment.

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