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A rose by any other name

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If patents are the heart of a business's competitive edge, trademarks are the face. Businesses frequently seek information regarding choice of a company or product name. Despite the seeming ease, choosing a mark by which people will identify your product or company can be difficult. Opposing considerations come into play. Does the chosen mark add to marketability? Does the chosen mark infringe someone else's mark? Can the chosen mark be protected?

Picking a name for your business or product can be tricky. The more a name describes the product/business, the more the name is not protectable. Pick a generic name and get instant recognition, but anybody else can use the name also. Building a reputation into an unusual non-descriptive name takes time and effort, but typically yields a more protectable name. But don't choose a name chosen by somebody else because then you risk trademark infringement/dilution liability.

Marks are placed on a spectrum of protectiveness defining what must be done to make them protectable (i.e., are they inherently distinctive, distinctive only after acquiring secondary meaning, or never distinctive such as generic or highly descriptive marks). Inherently distinctive marks are most clearly represented by fanciful or arbitrary marks. A fanciful mark is a completely made up name that never existed before – think Prozac® prior to the drug being manufactured. An arbitrary name is a common word used in a completely different manner – again, think Apple® for computers or phones. Fanciful or arbitrary marks can be immediately protectable, but they give no information about the product whatsoever, so have no immediate marketing bump. Generic or purely descriptive names tell the purchaser exactly what the product is – like using Patent Attorney for patent attorney services. While generic marks immediately identify the nature of the product, such marks are not protectable in most jurisdictions, meaning your competitors can freely use them.

A business owner must therefore make a choice of whether to seek little or no protectability by picking name that is generic for the goods or services, highly descriptive of the goods or services, or picking a name that gives no immediate marketing bump with a fanciful or arbitrary name that tells the purchaser nothing about the product. A final option is to choose a name that falls somewhere in between (good luck with that!).

Once that choice is made, the business owner then has to determine whether someone else has the same or similar name for the same or related good. This would interfere with the business's ability to protect the mark from infringing users, and perhaps more importantly, open the business owner up to trademark infringement or dilution liability.

How does an entrepreneur navigate these shoals? First, make the choice of whether to seek immediate marketability using a descriptive or generic name, or to go with a name that is less immediately marketable but more immediately protectable. Second, conduct a trademark clearance or name availability search. Third, if a name is chosen that is potentially protectable, and a search reveals no conflicting uses, decide whether to seek formal registration of the mark.

Like growing roses, choosing a mark can be thorny, but when grown correctly can be just as sweet.

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