

Developing brand names with trademarks

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SPECIAL TO THE NEW

Editor's Note: This is part one of a three-part series.

The world is full of goods, products and services that are constantly being marketed to us in many types of ways. The goal of a business person who has something to sell is to make the name of your product or service affixed to your customer's brain and on their mind 24 hours a day, seven days a week.

Close your eyes and think coffee. Do you think of Starbucks or Dunkin Donuts? Now think hamburgers. Do you think of McDonalds, Burger King or Wendy's? What about computers?

Do you think of IBM, Hewlett Packard Compaq, or Dell? The examples used are names of companies that are registered trademarks but they also all have products or services that are equally well known and protected.

Federal law is the primary law of the land for trademarks and filing your mark with the U.S. Patent and Trademark Office is the route to go if you want the maximum protection.

The federal statute for this body of law is the Lanham Act that is Title 15, Chapter 22 of the United States Code. Specifically, this Act prohibits a number of activities, including trademark infringement, trademark dilution and false advertising.

Named for Representative Fritz G. Lanham of Texas, the Act was

passed on July 5th 1946 and signed into law by President Harry Truman taking effect one year from its enactment, July 5th 1947.

Trademarks, Servicemarks and Tradenames are primarily used by businesses to develop a brand name so that the public will in turn identify their specific product, service or company in a more favorable way over any other competitor.

By definition, a trademark is associated with a specific product, a service mark with a specific service and a trade name with a company name.

The critical issue to be aware of when attempting to register your mark is whether or not the mark you are looking to protect is likely to cause confusion, mistake, or deceive the public into thinking you are something or someone that has already been established for a same or similar purpose.

Knowing whether or not your mark is or is not eligible for registration is the next issue. Trademarks, Servicemarks and Tradenames can be many types of things.

They can be suggestive or evocative words such as Slim-Fast and Travelocity.

They can be arbitrary made-up words such as Xerox, Kleenex and Google.

They can also be words that are surprising or unexpected in the context of their use such as Lexus, the car company, or ebay, the online auctioneer. Finally marks could be specific logos or sym-



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bols such as the Nike swoosh, the Playboy bunny or the Coca Cola bottle.

As a rule of thumb, marks that describe a specific identifier of a product, marks based upon a specific location or marks based on a specific name, are not eligible for trademark protection.

However, if the business can demonstrate public awareness of the mark through advertising, product sales or other means, then it is arguable that the business has developed a "secondary meaning" and may be eligible for protection. There are many famous examples of this which include: Ben & Jerry's, Ralph Lauren, Trump, Elvis, Mutual of Omaha, New York Stock Exchange, "Live Strong" (Lance Armstrong), and "We do chicken said right" (KF).

Developing the mark is only the beginning of the process.

In the next issue, I will address the specifics on registration and what other issues you must be aware of when proceeding with trademarks.