



## Choosing a Brand – Key Trademark Issues

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Brands, or trademarks, are important in any industry, but especially in the food, retail or hospitality arenas. The name of a product, store, restaurant or hotel can create coveted consumer brand recognition and loyalty ... or not. Choosing a trademark is a creative and strategic process, but as trademarks are protected under federal and state laws, there are many legal implications as well. The following are the most important things to consider from a trademark perspective when choosing a new brand.

**Be Creative.** Before *using* a trademark, it helps to carefully *choose* the mark. Try to avoid names that merely describe your product or service or an attribute of your product or service. This proves to be quite difficult for many people, because of course, the marks that are the most attractive in terms of creating an instant consumer connection, such as “Atlantic Grill” for a seafood restaurant, or “Smooth Shave” for a razor, are also typically descriptive and unprotectable. The more inventive names take time, effort, and advertising to build up an identity with consumers, but are the most protectable, and in the long run are the best source identifiers and the most valuable (think “Exxon,” “Google” or “Pringles”). Arbitrary marks (“Gap,” “Onyx Hotel”) and suggestive marks (“Cracker Barrel,” “Staples”) are also protectable and are good choices if you do not want a completely invented mark. Be aware that trademark law generally considers geographic terms and surnames to be descriptive, so use these types of terms carefully or not at all.

**Suggestive Marks.** A word of caution about suggestive marks: if the mark is too suggestive, the chances of someone else also choosing the mark are higher, and this will cause huge trademark headaches. This issue is especially common with restaurants, because restaurateurs generally *want* to give the consumer an immediate idea of the restaurant style to attract them in the door. For example, if I have a Mexican-style restaurant and I want to call it “Salsa’s,” I would find that there are dozens of “Salsa’s” (and “La Salsa” - soon to be Baja Fresh?) restaurants in the U.S. I would probably have a hard time using or registering this mark, and even if I could use it in an isolated market, it would be very difficult to stop others from also using it, so I have not really achieved the goal of distinguishing my establishment. Again, the more creative you can be, the better.

**Search!** There is a duty to do a search before adopting a trademark to ensure that no one else is using it already – great minds often think alike. Doing a Google search and a search of the United States Patent & Trademark Office (USPTO) site is good start, but a full search report from a reputable trademark research company is best to turn up all possible conflicts. If you plan to operate internationally, an international search is also helpful. The ideal strategy is to choose two or three marks, search them all, and then make a decision about the brand name.

**Use and Registration of Your Mark.** Once you have chosen and cleared your mark, you should begin using it (with the “™” symbol) to start building up your trademark rights. If your mark is truly unique and there does not appear to be anyone else using it for a similar product or service, you can work with your trademark attorney to register the mark with the USPTO. Alternatively, if you will be operating locally and not in interstate commerce, or if you are aware of a preexisting non-confusing use of your mark in a different market which does not hinder your use but will prevent you from registering federally, you can

perhaps register through your state system instead. This will give you some additional protection in case of infringement. Also, be advised that in the U.S., the first, or “senior” user will probably prevail in a trademark conflict, but in the rest of the world, one obtains rights only through registration, so if you plan to operate internationally, you will need to register in the appropriate countries.

**These are just some of the considerations when choosing a new trademark. Later issues of “At Your Service” will discuss other trademark issues, such as proper use of a mark, navigating the federal registration system, and foreign registration. Please contact Stacey Friends at 617-742-4200 or [sfriends@riw.com](mailto:sfriends@riw.com) if you have any questions about this article.**