What’s in a name? Beware before you brand

So, you have decided to launch a new product or service. After several brainstorming sessions, you selected a new brand name.

To make sure that the name has not already been taken, you searched the Internet for previous uses of the same name. You also examined the online records of the U.S. Patent and Trademark Office (USPTO).

After finishing this background work, you find that other companies aren’t using the proposed name. At this stage, you are ready to direct your trademark attorney to immediately file a trademark application to protect your new brand, right?

Well, not so fast.

Extend your search

I always advise clients to do their own initial Internet and USPTO searches to eliminate direct hits that are obviously going to conflict with the proposed new name.

However, I encourage them to have a trademark attorney confirm the results before they make a significant investment. Reading X-rays is an analogy that I use with clients.

While the untrained eye will spot obvious problems in an X-ray, a skilled radiologist will see subtleties that a novice might miss. Similarly, your trademark attorney may see problems with the proposed mark that you may not notice.

Even if the initial search doesn’t reveal any obvious obstacles, your attorney will likely suggest ordering a more comprehensive full-trademark search before you commit.

Full trademark searches provide additional information about the availability of your proposed mark and can potentially save you time and money.

The full trademark investigation includes not only searching the Internet and USPTO records but also exploring state trademark registrations, other common law (unregistered) uses of the same or a similar mark, and domain names that incorporate the proposed one.

Clear your mark

It is particularly important to investigate unregistered uses of the same or similar name because, in the United States, trademark rights are based on who is first to use a mark in commerce — not who is first to register it.

As a result, even if you don’t find any direct obstacles in your USPTO and Internet searches, there remains risk that some other company has already adopted and is using the mark you want.

A prior user can enforce its common law rights and force you to stop using your trademark, at least in the geographic regions where the common law user was operating.

Adopting and investing in a trademark that has not been properly cleared creates multiple potential conflict risks, including legal fees, potential monetary damages, loss of goodwill, and the embarrassment of having to change your brand shortly after its launch.

The opinions expressed in this article are intended for general guidance only and are not intended as recommendations for specific situations. Readers should consult a qualified attorney for specific legal guidance.

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