10 Steps to Creating a Valuable Trademark

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What is a Trademark?

A trademark is a word, phrase, symbol, or design created to identify the source of goods or services in the marketplace, the most common form of which is a word mark and/or logo. A primary purpose of trademarks is to create a distinctive brand in the market that distinguishes your goods or services from those of your competitors and some marks are inherently stronger than others. Ranking them from weakest to strongest are:

- generic marks (not registerable)
- descriptive marks (only registerable on the Supplemental Register)
- personal names (sometimes registerable)
- suggestive marks
- arbitrary marks
- fanciful or coined marks.

Descriptive and suggestive marks are typically the easiest to think of, such as WINE RACK for a wine organizer, but they are rarely capable of securing strong trademark rights. At the other end of the spectrum, arbitrary or fanciful marks, such as APPLE® for computers, are typically capable of acquiring very strong trademark rights, but they also take the most effort to create. For more detailed information on these levels, please see *Creating a Strong Trademark: Key Considerations*.

Trademark rights arise under common law through the actual use of the mark in commerce, without registration. However, registration of the trademark with the Trademark Office, i.e., the United States Patent and Trademark Office (USPTO) provides several advantages. Common law trademarks are typically designated with a "™" symbol, and federally registered trademarks are typically depicted with a "®" symbol once registered. However, it is best practice to register a trademark whenever possible, because registration includes many benefits including instant rights in all U.S. states and territories. A mark is generally registerable with the USPTO if there are no active registered marks or applications in the USPTO that are for the same-or-similar trademark and for the same-or-similar goods and/or services. If the marks are very different but for the same goods, that is not an obstacle to registration. If the marks are similar but for very different goods and/or services, that should not be an obstacle to registration unless the mark is a famous mark, such as COCA-COLA®.

In terms of new word marks, the strongest marks are arbitrary, fanciful, or coined, and they are also the most difficult to think of on a predetermined timetable rather than waiting for inspiration to strike. Add in the fact that there are millions of active trademark registrations in

the United States alone that could pose obstacles to registration of a same-or-similar mark for the same-or-similar goods and/or services, and the question becomes how does one create a new trademark for your goods or services that can be registered with the United States Patent & Trademark Office and can create valuable and strong trademark rights?

Process for Creating a Strong and Valuable Trademark

When a new and strong mark that no one else has, that is registerable, and that has the potential to grow into a strong and valuable brand is desired, try these 10 steps:

1. Brainstorm a ***first list*** of words that describe your goods and/or services. Try to come up with at least ten words, from nouns that describe what your product is, to adjectives that describe features or characteristics of your product or service.
2. Develop a ***second list*** of words that are not directly descriptive of your goods and/or services, but instead are merely suggestive or tangentially related in some way to the words in the first list. Try to come up with at least one new word for every word on the first list; these could include short phrases combining 2 or 3 words.
3. Think about your goods and/or services, and identify any images, emotions, or messaging that spring to mind that you want to elicit in your customers when they think of your new brand. Put those images, emotions, or messaging into a ***third list***.
4. With the images, emotions, or messaging from your ***third list*** in mind, extrapolate from that ***second list*** of "merely suggestive words" a ***fourth list*** of words that are arbitrary, but that also have hints of association with the images, emotions, or messaging from step 3; they may or may not have any obvious connection with the goods and/or services. Again, try to come up with at least one new word or short phrase for every word or short phrase on the second list.
5. As you examine your ***fourth list***, ask yourself if there are any words that you could combine to coin a completely new word? If so, add any newly coined or made-up words to your fourth list.
6. At this point in the process, there should be at least as many words as you started with in your first list, and preferably more. Look over this fourth list of words and/or short phrases (three words or less) and rank them from the ones that really resonate with you at the top to the ones with lesser appeal at the bottom.
7. Next, take your top five words and/or phrases representing your top five preferred potential trademarks and do a quick search at the USPTO trademark database (click on the "Search our trademark database (TESS)" button. Then select "Basic Word Mark Search (New User)". Then in the "Search Term" empty box on the next page type one trademark (word or short phrase) at a time, select "Combined Word Mark" in the first drop down box, and select "All Search Terms" in the second drop down box. Then click on the "Submit Query" button to search all active and inactive trademark registrations or applications for trademark registrations in the United States). If you are going through this exercise in another country, search for a similar public database on that country and implement the same search.
8. If the number of results is manageable to review, click on and assess each result. If the result is indicated as "Live" then it is an active application or registration and requires consideration. If the result is indicated as "Dead" then it is inactive and likely does not pose any obstacle to registration. As you review the "Live" marks, click on the mark to review the "Goods and Services". If the "Goods and Services" are similar to or the same as your goods and/or services, then this active mark may pose an obstacle to registration. If your goods and/or services are very different, then there is less chance of the active mark posing an obstacle to registration of your proposed mark.
9. If the number of results is too high to reasonably review one-by-one, then there are two options. One, move on to the next mark on the assumption that the proposed mark is probably too confusingly similar to an active mark and therefore not registerable. Two, try narrowing the results by goods and/or services by doing a structured search (Go back to the above link, click on the "Search our trademark database (TESS)" button; select "Word and/or Design Mark Search (Structured)"). This search is a bit more

complex and more difficult to describe. Enter the mark in the first field next to the first "Search Term". To the right of that, select "Basic Index" from the drop-down menu. To the right of that, change the "or" operator to "and". On the next line down is a second "Search Term" box where you enter your desired good or service. To the right of that select "Goods & Services" from the drop-down menu. Click "Submit Query" and decide whether the number of results is manageable.

10. Repeat this process. Revisit other marks lower on your list first and if none of those work then start at the beginning and brainstorm a new list, until you have narrowed your search down to three or fewer potential trademarks. Most importantly, consult your trusted trademark attorney to discuss whether additional, more sophisticated searching may be prudent, or if you are ready to proceed with filing applications for trademark registration.

Creativity + Discipline = Success

Creativity is required to generate new trademarks that are strong and have the potential to transform into valuable brands. However, even if you don't consider yourself to be particularly creative, thoughtfully going through the 10-step process above should generate some marks with good potential. If you hit a dead end partway through, step away for a while and come back to it another time. Above all, don't settle for a mark that is too descriptive of your goods and/or services or too similar to someone else's active mark because that may cause problems in the future. And remember, if you have any questions along the way, consult your trusted trademark adviser.

For more information, please contact **Sean Detweiler**.