

MCC INTERVIEW: Danielle M. DeFilippis & Ami Bhatt / Norris, McLaughlin & Marcus, P.A.

Making Your Mark

A distinguishing trademark is the heart of effective brand strategy

As members of the firm's intellectual property practice, Danielle M. DeFilippis and Ami Bhatt of Norris, McLaughlin & Marcus, P.A. regularly counsel clients on trademark matters. Their remarks here on establishing strong branding strategies have been edited for length and style

MCC: How are brands and trademarks related?

Bhatt: Branding refers to the strategy companies employ to identify and differentiate their business, products or services from those of their competitors. Trademarks are an important component of an effective branding strategy, and frequently a brand can consist of more than one trademark – whether it be a company name, a product name, a logo or a slogan. An important distinction is that trademarks are eligible for protection under state law or federal trademark law, the Lanham Act, whereas not all elements of a branding strategy may be so protectable.

MCC: From the perspective of trademark law, what factors should a company or entrepreneur consider before selecting a brand?

DeFilippis: The most important consideration is to make sure you pick a brand that is clear. This could entail conducting a search on a search engine such as Google; a search through the database provided by the Trademark Office; or by commissioning a search from a third-party search company that provides a comprehensive review of registered and unregistered marks, business names, and the like, to determine whether others may be using a mark that is identical or similar to your desired mark.



Registering a mark is recommended as it offers a host of benefits not available to common law marks.

– Danielle M. DeFilippis

Bhatt: The other most important element of picking an effective branding strategy underpins the considerations of selecting a strong trademark – select a brand name that distinguishes your company in the marketplace. The more distinct and unique the selected name, the more memorable it will be. Likewise, the more distinct and unique a trademark, the greater protection it is afforded under trademark law.

There is often a desire to pick a name that describes your company or product so that consumers immediately understand the purpose of your company or recognize the exact product or service offering. However, such names are afforded very little, if any, trademark protection. Marks that are descriptive, i.e., that describe the good or service being offered (think, Car Land for a car dealership or Shake 'N Bake for bread crumb coating), are considered weak marks. And while it may require less marketing effort and expenditure to explain your business or products to consumers, a company may have to make great investments in marketing to differentiate its brand in a crowded marketplace of similarly named competitors.

In contrast, marks that are fanciful, i.e., coined works (such as Kodak or Starbucks),

or arbitrary and have no relationship to the product or service at hand (such as Apple for computers or Ivory for soap), are considered strong marks and given stronger protection under trademark law. In addition, while there may be initial investment costs to educate consumers about the given brand, in the long run, such investment will lead to strong consumer recognition and a stronger brand identity overall.

MCC: So how do you balance selecting a strong brand that will allow consumers to recognize the product, with having a strong trademark?

DeFilippis: In addition to choosing a strong trademark, your brand includes your product's or website's trade dress, as well as your online and social media presence. The trade dress of your product can be very powerful when established over time in creating consumer recognition. Steps should be taken early in the development process to identify the trade dress, which is the total image and overall appearance of the product or packaging. This includes size, shape, color and color combinations. As long as the trade dress is nonfunctional, it can be registered and entitled to protection.

MCC: What do you recommend with respect to an online presence and social media?

DeFilippis: Presumably prior to entering your market for goods or services, you will have identified your target markets and will have an understanding of the best ways to advertise and market your brand. Generally, your online presence will be a powerful marketing tool, and promoting your brand through your

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website and social media will increase brand recognition. However, having a poor or out-of-date website, and failing to regularly maintain your social media platforms, may hurt more than help. So at the outset, identify the channels through which you wish to advertise, and take steps to develop a web presence that consistently uses your trademark and branding features. One way is to select and purchase the appropriate domain name or names after ensuring they are available.

Bhatt: Another aspect of this is to consider how your brand connects with your social media strategy. As social media continues to be a larger and larger part of branding, you may want to select a name that is not only available from the perspective of a trademark clearance search or Web domain, but that is also available as a handle or username on sites such as Twitter, Instagram, Snapchat, Facebook and Tumblr.

MCC: *The world of domain names has grown considerably. Any recommendations for how many or which new generic top-level domains to select?*

DeFilippis: The Internet Corporation for Assigned Names and Numbers (ICANN) has introduced many different generic top-level domains (gTLDs), such as “.nyc” and “.beer.” This was an effort to open up space in the Internet world and provide alternatives to the traditional gTLDs such as “.com”. There are now hundreds to choose from and many more waiting to be registered. The constant new additions of gTLDs may affect the way people find information online and the ways that businesses develop their online presence. But before you run out and buy every domain that could include your trademark, think about those that are most appropriate to your business. If you are a financial institution, purchasing a domain with “.finance” may be worthwhile and give your customers a clear understanding of your product or service.



Proper use and promotion of a trademark is critical to maintaining the protections afforded to trademarks.

—Ami Bhatt

MCC: *Once you select a trademark and develop a brand, what additional steps should a company take in selecting its brand name to ensure appropriate use?*

DeFilippis: After clearing a name for selection and use, a company should consider seeking federal protection of its trademark. It is important to note that as trademark rights in this country are based on “use in commerce” instead of solely registration, U.S. trademark law recognizes what are called “common law marks” which are marks that are not registered and that are obtained because the owner is using the mark in its business in a particular geographic territory. So registration is not necessary to obtain trademark rights. Still, registering a mark is recommended as it offers a host of benefits not available to common law marks, including benefits such as presumptive nationwide rights in the mark, instead of only in the specific territory in which the common law mark is used, as well as the ability to use U.S. Customs to stop the import of counterfeit goods.

Bhatt: In addition, while use is required to obtain trademark rights in the U.S., the Trademark Office does permit the filing of what are called “intent-to-use” applications. Such applications permit parties to apply for a mark before they have begun use, provided they have a good-faith

intent to use the mark on the goods or services in question. If the application is allowed, an applicant then has between six months, and even up to three years to file a statement showing that it is using the mark in commerce. This is an important tool for companies who have identified the brand they would like to use, but are not immediately in a position to enter the market. The intent-to-use application permits companies to “reserve” rights to a mark while they prepare their business or product lines for launch.

MCC: *Once it has a brand and begins use, what factors should a business consider then?*

Bhatt: Proper use and promotion of a trademark is critical to maintaining the protections afforded to trademarks. This requires that a mark be used consistently and properly across different advertising and media platforms, as well as in advertising and promotional materials. When using or referring to a trademark, always remember to use it as an adjective instead of a verb. As an example, proper usage would be to say “use the Xerox copier to copy these documents” instead of “Xerox these documents.” Create a use protocol for the mark, and make sure all references to the mark are used in accordance with the established protocols. Thus, if the mark is always used in a particular font, stylization or color, ensure that it is consistently used in that manner. Finally, use the ™ and ® symbol to designate that you are using a given term as a trademark. The ® symbol can only be used for marks that have been registered with the U.S. Trademark Office. The ™ symbol can be used for any mark, including common law marks and marks that have been applied for but not yet registered.

DeFilippis: It is always useful to consider what steps would be taken should you need to enforce your rights. Establishing protocols for monitoring usage by other parties will allow you to promptly identify any potential infringer and take appropriate steps to enforce your rights in a timely manner.