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Series on Intellectual Property Issues: Part 16

What should I bear in mind when selecting or creating my trademark?

Selecting or creating an appropriate trademark is a critical step, because it is an important element in the marketing strategy of your business. So what is an appropriate trademark for your product(s)? It seems there are no hard and fast rules, but the following are recommended points to consider:

- ❑ The proposed trademark should meet the legal requirements so that it may be registered.
- ❑ It is advisable to ensure that, if the trademark consists of one or more words, the word/s are easy to read, write, spell and remember, and suitable for advertising purposes in all types of media.
- ❑ The text should not have undesirable connotations either in your own language or in any of the languages of potential export markets.
- ❑ The trademark should not be identical or confusingly similar to existing trademarks and the corresponding domain name (Internet address) should be available for registration.

When selecting one or more words as your trademark you should also take into consideration the implications of selecting the following types of words:

- ❑ **Coined or 'fanciful' words.** These are invented

words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, however, they may be more difficult to remember for consumers, requiring greater efforts in advertising the products. Typical examples are Kodak and Exxon.

- ❑ **Arbitrary marks.** These are words that have a meaning that bears no relation to the product they advertise. While these types of marks will be easy to protect, they may also require heavy advertising to create the association between the mark and the product in the minds of consumers. Typical examples would be Apple and Sun for computers.
- ❑ **Suggestive marks.** These are marks that hint at one or some of the attributes of the product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that some countries may consider a suggestive mark to be too descriptive of the product and reject its registration. One example of a suggestive mark would be Coppertone for sun cream.

Irrespective of the type of mark you choose, it is important to avoid imitating existing trademarks. A slightly altered competitor's trademark or a misspelt well-known or famous mark is unlikely to be registered.

References:

IPR-Helpdesk. Website at <http://www.ipr-helpdesk.org>. Basic information and guides for download and numerous links to other portals on IP. Includes guide on trademarks, under the link *Distinctive Signs*, and covers why trademarks should be protected.

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