



Posted on: July 25, 2017

## CREATING A MIGHTY BRAND NAME

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Creating a brand name for your business that not only appeals to you but also gets the legal nod for being a strong mark can be a difficult task. Business owners frequently gravitate towards obvious words or descriptive terms only to have a trademark specialist advise them that their name is wimpy or more specifically “weak”. Enforcing rights against a competitor will prove to be difficult if your name is powerless. In the case of a weak name, a competitor often can adopt a very similar mark and the Trademarks Office and the courts may consider it as being perfectly capable of bobbing, weaving and finding an acceptable spot in your marketplace.

It is important to keep in mind that a wider scope of protection is given under law to strong marks. This means the more muscle that your mark has, the less likely it will need to fight with competitors’ marks. And if your powerhouse of a name needs to get in the ring with another name, it can throw a quicker and less costly knockout punch.

### 15 Things to Avoid:

To help you create a gladiator of a brand name worthy of your products and services, here are some things to avoid:

1. Do not use a term which is the **actual name** of your products or services in any language. For example, CUPCAKES for a cupcake shop or CERVEZA for beer.
2. Avoid terms which **clearly describe a characteristic** of your products or services. For example, SWEET for candy, JUICY for mangos and TEACHERS for pension fund services for teachers.
3. Avoid terms which **clearly describe a quality** of your products or services (i.e. SUPERIOR, EXCELLENT, BEST, ULTRA, SUPER, SUPREME, PERFECT, etc.).
4. Do not use a **recognized designation** such as matter designating the kind, quality, quantity, destination, value, place of origin or date of production of any product or service. For example, GF for jewellery since GF is the marking for “gold filled”, grade names or stamps for meat or agricultural products, etc.
5. Do not use term which may be **deceptive** of your products and services.
6. Do not use **prohibited terms**. For example, do not use the words *bank*, *post* or *postal* unless you



have authorization under the appropriate Canadian legislation.

7. Do not use a **professional designation** which may suggest that your goods or services are produced by a professional who has qualified under that designation (i.e. engineer, doctor, etc.).
8. Avoid using the **name of a place**. This includes the names of continents, countries, provinces, states, regions, cities, neighbourhoods and streets (and their nicknames).
9. Avoid using a **surname**.
10. Do not use the name, surname, nickname, image or signature of an **unrelated person**; especially one who is living or has died within the last 30 years.
11. Do not use any **false matter** which may suggest a connection with a living person.
12. Do not use any **scandalous, obscene or immoral matter**.
13. Do not use any **prohibited or official mark** (i.e. words, symbols, crests, flags, arms, etc.) of any royalty, government, university or public authority.
14. Avoid using a **famous brand** of another business even if the third party is in a completely different field
15. Avoid minor changes thinking that it will add grit to the name (i.e. taking out spaces in-between words, adding punctuation or altering the spelling of a word often will not result in a protectable name).

**Strong Brand Names:**

The following spectrum provides examples of marks from strong to weak:

<b>Champion</b>	<b>Prize-Winner</b>	<b>Contender</b>	<b>Dud</b>
Coined / Invented XEROX for photocopiers	Arbitrary / Abstract APPLE for computers (i.e. has meaning but <u>not</u> in the relevant industry or trade)	Suggestive ZESTY for pizza	Descriptive BEST INN for accommodation services

**Tip:** You can search a thesaurus to find words that appeal to you visually and phonetically and then blend or fuse those words together to create a made-up word.

**Logo Design:** A trademark certainly can incorporate descriptive words. However, a sturdy mark does not need to lean on them. When developing a logo design, we often will suggest displaying the descriptive wording below the distinctive portion of the mark. This also provides flexibility if you wish to use different versions of the main logo design with different product or service categories or divisions of your business.

**Research:**





Trademarks, company and business names and domain names can be considered to be confusingly similar with one and another so you need to try to avoid adopting a name that could conflict with a competitor's mark or name. Marks and names do not need to be identical and the associated goods and services of another business do not need to be the same for there to be a conflict. For example, food and beverages often will be considered to be overlapping with not only other types of food or beverages but also with restaurant and food services. Clothing, handbags, sunglasses, cosmetics and fragrances generally are considered to be related since they all flow through the fashion industry. And when it comes to medical and health related products and services, more distinction is required because there can be serious consequences if a consumer is confused between products and services in the medical/health field.

A good start before getting too attached to a brand name is for you to research your industry and to conduct a good amount of Internet searching. If you locate another person using a similar mark or name anywhere in Canada in association with products or services that may flow through your field, there very well may be an immediate concern.

Once done, it is time to retain our firm's trademark specialists for a consultation. If there are no obvious concerns with your brand name, we can conduct an in-depth search of the Trademark Register to provide an opinion on availability and registrability of the proposed brand name as well as to strategize a plan moving forward.

**Registration:**

You are not required to register your brand name as a trademark with the federal trademarks office and you can simply rely on limited territorial common law rights. However, there are numerous benefits to registering a trademark, including the ability to enjoy use, advertisement and protection throughout Canada. For more information, please contact one of our trademark professionals.

**Richards Buell Sutton LLP** has a group of trademark agents and lawyers with extensive experience in the protection of trademarks in Canada, in the United States and around the world. We assist companies, advertising agencies, individuals and foreign law firms by providing advice at the conceptual stage of trademark development, by conducting availability searches and strategically filing trademark applications, by managing national and international trademark portfolios, by prosecuting opposition and cancellation proceedings and by assisting with the enforcement of trademark rights. To learn more about our Trademark Services, [click here](#).





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