

10 Steps to Creating a Legally Strong Brand

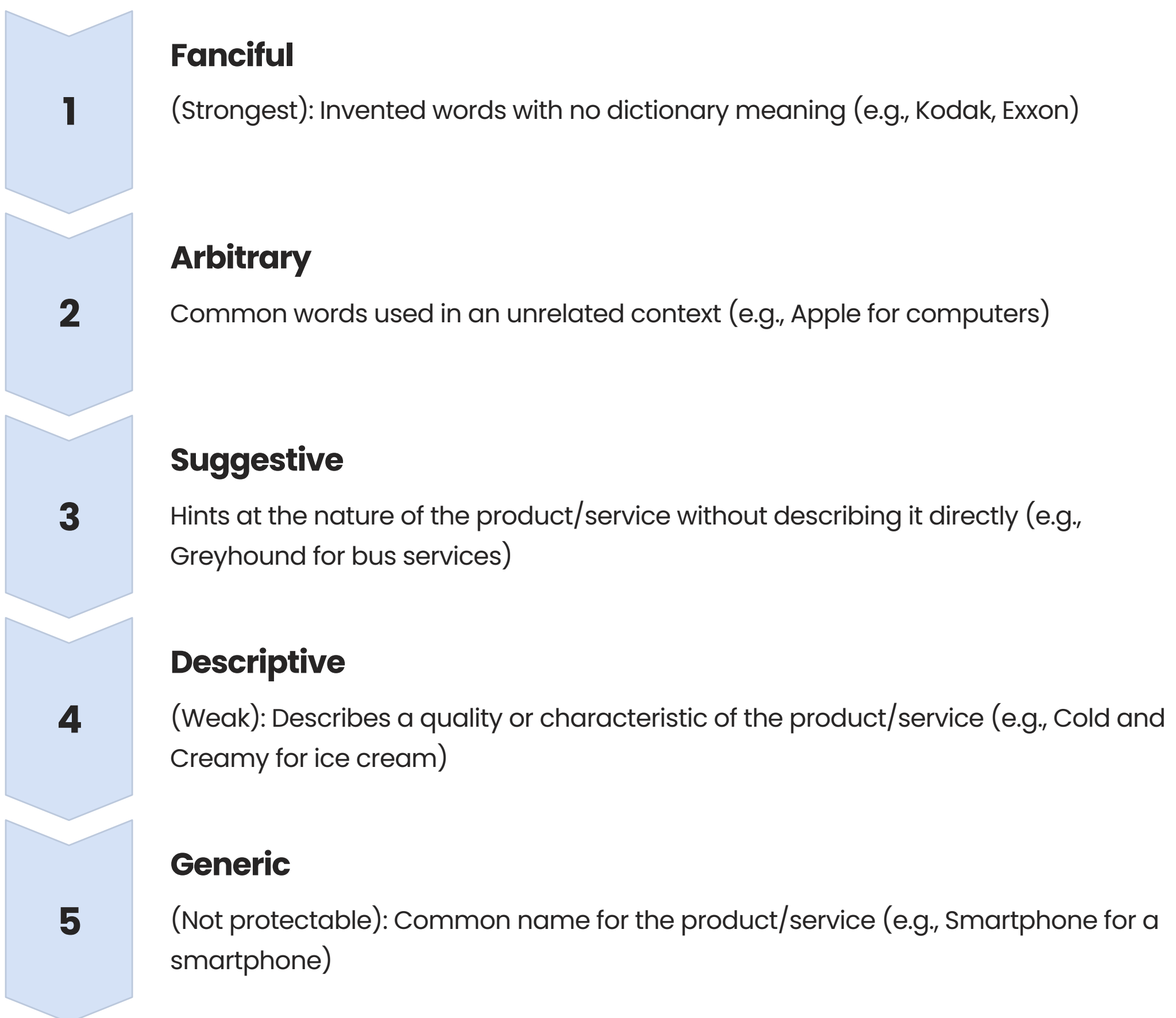
Selecting a strong trademark is a critical strategic decision that can significantly impact your business's success. A well-chosen mark not only provides legal protection but also becomes a valuable asset, distinguishing your products or services in the marketplace. This comprehensive guide will walk you through the decision-making process to help you choose a trademark that is legally strong, aligned with your business goals, and poised for long-term success.





Step 1: Understand the Strength Spectrum

Before diving into the selection process, it's crucial to understand the spectrum of trademark strength. Trademarks are categorized from strongest to weakest as follows:



Decision Point: Aim for the top three categories to ensure the strongest legal protection. Remember, the stronger the mark, the broader the protection it receives.

Example: If you're starting a coffee shop, "Java Junction" (suggestive) would be stronger than "Quick Coffee" (descriptive).



Step 2: Align with Your Brand Strategy

- 1 What image do you want to convey?**
(e.g., luxury, innovation, reliability)
- 2 How might your business expand in the future?**
(e.g., new product lines, services, or markets)
- 3 Will the mark work across different product lines or international markets?**
- 4 Does it align with your company's values and mission?**

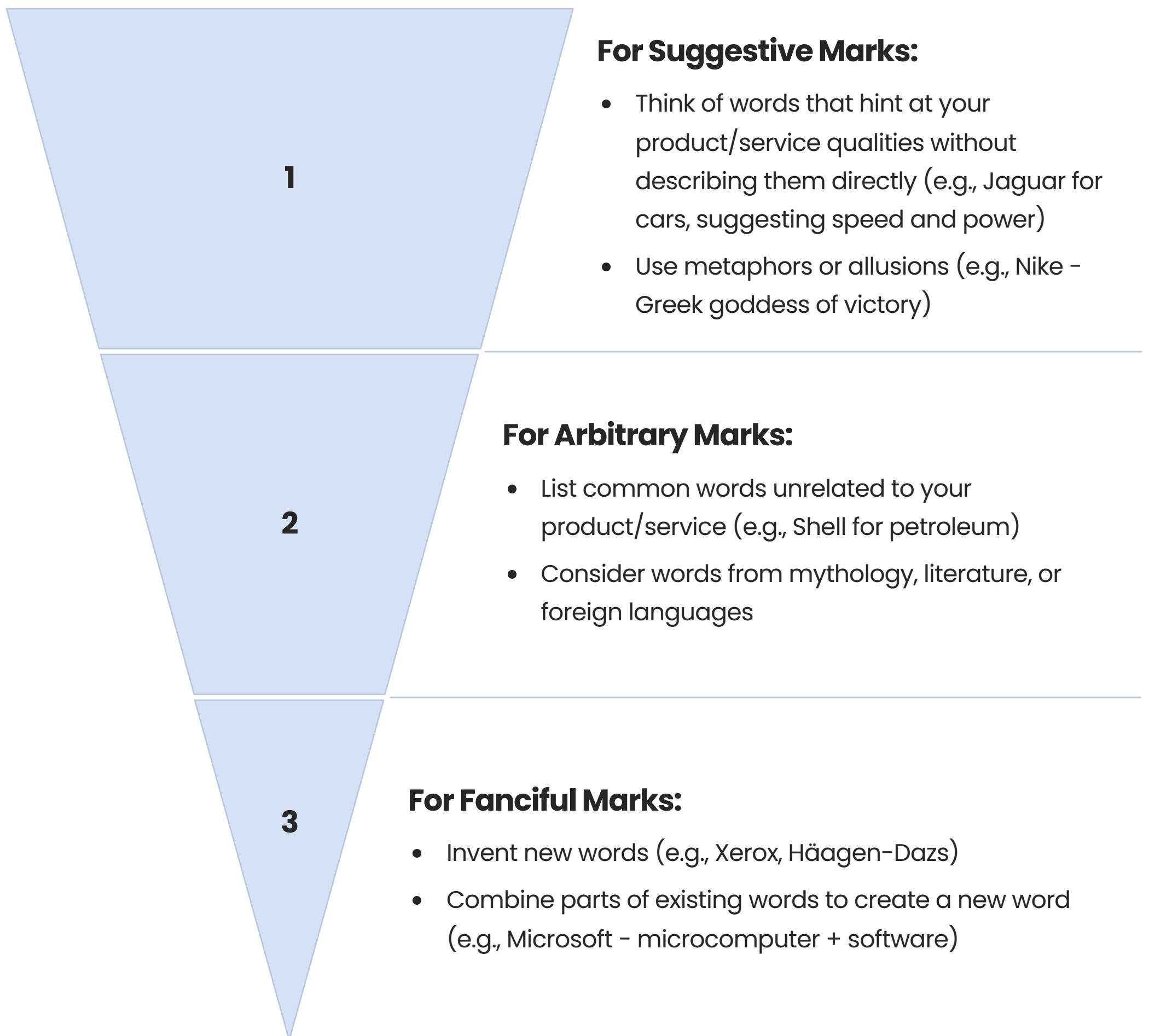
Decision Point: Choose a mark that allows for future growth and maintains relevance as your business evolves.

Example: Amazon, originally an online bookstore, chose a name that allowed them to expand into various product categories and services.



Step 3: Brainstorm with Strength in Mind

Now that you understand the strength spectrum and have considered your brand strategy, start brainstorming:



Avoid descriptive terms or generic words related to your product/service.

Decision Point: Create a list of at least 20-30 potential marks, prioritizing those in the fanciful, arbitrary, and suggestive categories.



Step 4: Preliminary Screening

For each potential mark on your list, ask:

Is it easy to spell and pronounce?

Ensure the name can be easily understood and pronounced by your target audience.

Does it have any negative connotations?

Avoid names with negative meanings in key languages to prevent misunderstandings.

Could it become generic over time?

Avoid overly descriptive or common names that may lose distinctiveness over time.

Does it translate well into other languages?

Check how the name translates to ensure it remains appropriate and meaningful globally.

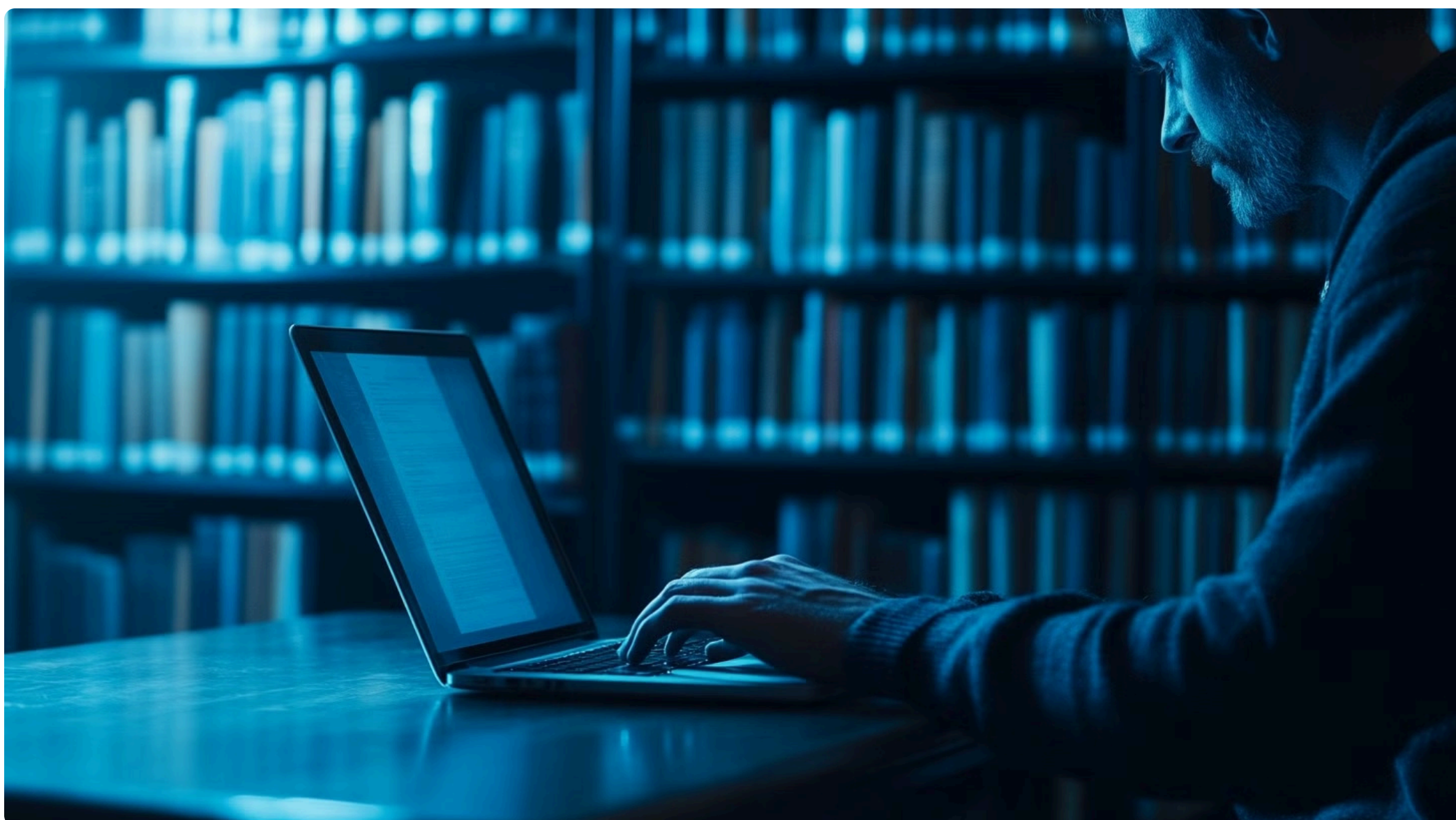
Is it visually appealing for logo design?

Consider the name's aesthetics and how it can be represented graphically in a logo.

Additional Considerations:

- Avoid geographic terms unless they're arbitrary for and unrelated to your goods/services
- Be cautious with surnames, as they're generally considered nondistinctive to avoid conflicts with other businesses similarly named because of the owner's real surname.
- Consider how the mark sounds when spoken aloud

Decision Point: Eliminate any marks that raise red flags in this preliminary screening. Aim to narrow your list to 10–15 strong candidates.



Step 5: Conduct a Knockout Search

For the remaining candidates:

1

Search the USPTO's [Trademark Electronic Search System \(TESS\)](#)

Look for identical and similar marks in related industries

Check for phonetic equivalents and alternative spellings

2

Do a thorough internet search

Use search engines to check for common law (unregistered) usage

Look for potential conflicts in news articles, social media, and industry publications

3

Check domain name availability

Search for exact matches and close variations, including any common misspellings.

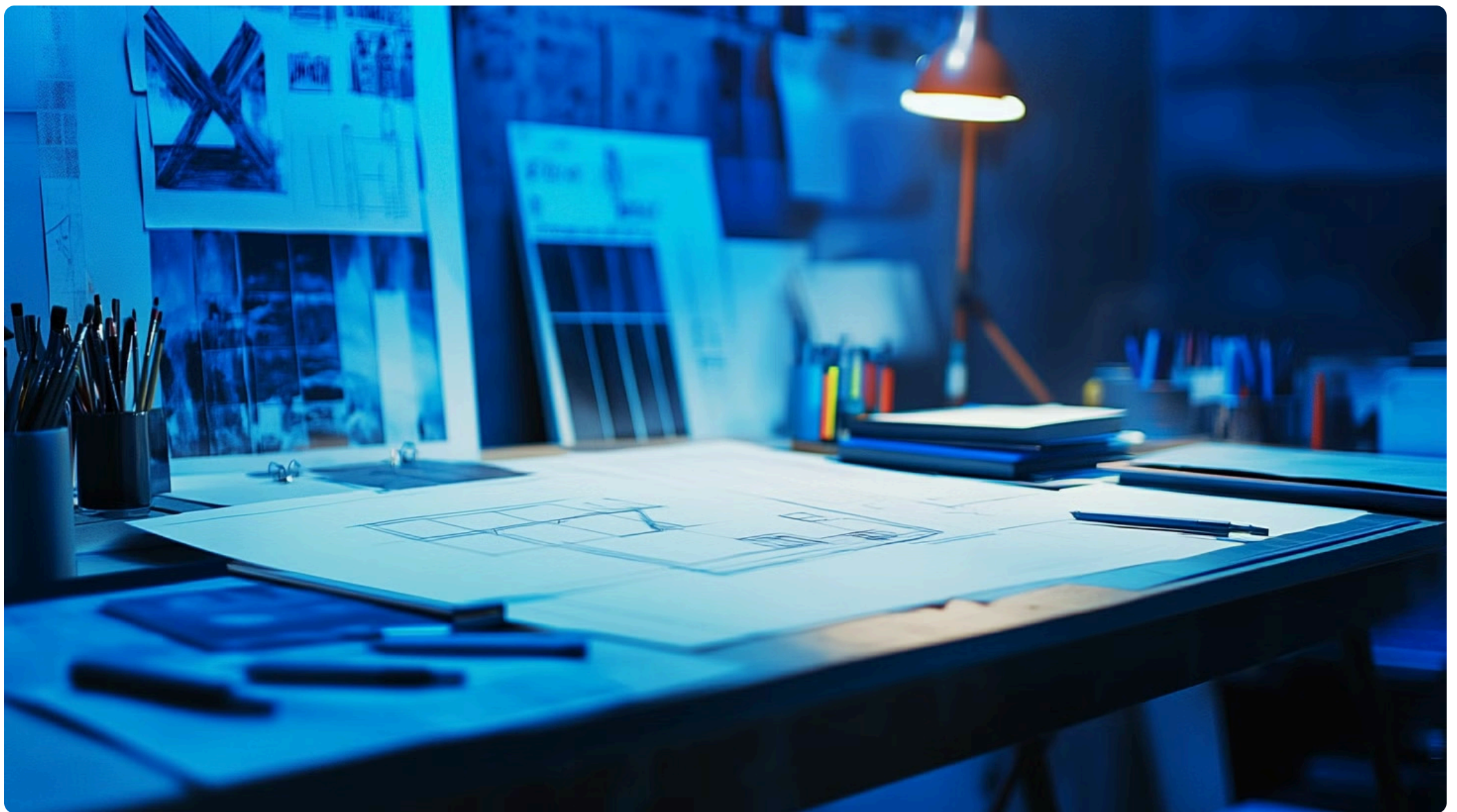
Consider different top-level domains (e.g., .com, .net, .org)

4

Search state trademark databases

Particularly important if you plan to operate in specific states

Decision Point: Remove any marks that have clear conflicts or unavailable domains. Prioritize marks with available .com domains. A mark does not need to be registered to be protectable.



Step 6: Consider Visual and Sound Elements

For your shortlist:

- 1** How does the mark look visually? Is it distinctive and memorable?
- 2** How does it sound when spoken? Is it pleasing to the ear?
- 3** Could it be represented effectively in a logo or other visual formats?
- 4** Does it work well in various fonts and sizes?
- 5** How does it look and sound in advertising or packaging contexts?

Decision Point: Prioritize marks that have strong visual and auditory appeal. Consider creating rough logo sketches to visualize potential.



Step 7: Comprehensive Search

At this point, you should have a shortlist of strong contenders. It's time for a comprehensive search with the help of a trademark attorney:

1 Conduct a full availability search, including:

- Federal and state registrations
- Common law uses
- Business names and corporate filings
- Domain names and social media usernames
- International trademark databases (if planning to expand globally)

2 Analyze the search results:

- Identify direct conflicts and potential opposition
- Assess the strength of similar marks in related fields
- Consider the geographic scope of potential conflicts

3 Decision Point:

Based on the search results, identify the marks with the lowest risk of conflict. Consult with your trademark attorney to understand the level of risk for each option. Trademark infringement analysis is too complex to attempt without a qualified trademark attorney and failure to consult a trademark attorney could effectively render the comprehensive trademark search useless.



Step 8: Test Market Reception

For your top choices:

1 Conduct surveys or focus groups with your target market

- Gauge first impressions and associations
- Test for memorability and likability

2 Get feedback on connotations and appeal

- Check for any unintended meanings or associations
- Assess how well it aligns with your brand image

3 Ensure the mark resonates with your intended audience

- Does it appeal to your target demographic?
- Does it convey the right message about your brand?

4 Consider A/B testing if you're between two strong options

Decision Point: Select the mark that balances legal strength with positive market reception. Consider both emotional appeal and brand fit.



Step 9: Final Legal Review

Before making your final decision:

1 Consult with a trademark attorney

- Review the comprehensive search results
- Discuss potential opposition and enforcement issues
- Consider the scope of protection you're likely to receive

2 Assess the overall legal strength and risks

- Understand the potential costs of clearing and defending the mark
- Consider the long-term value of the mark as a business asset

3 Review international considerations

- Check for any issues in key foreign markets
- Consider whether the mark is registrable internationally

Decision Point: Choose the mark that offers the best combination of legal strength, business alignment, and acceptable risk level.



Step 10: Secure Your Rights

Once you've made your final selection:

1

File a federal trademark application with the USPTO

- Consider filing an Intent-to-Use application if you haven't started using the mark yet. The earlier filing date is more important than the earlier claim of use since the filing date establishes a priority date.

2

Secure domain names and social media handles

- Register variations and common misspellings

3

Begin using the mark in commerce

- Use proper trademark designations (**™** for unregistered marks, **®** for registered marks)

4

Develop guidelines for proper use of your mark

- Ensure consistent usage across all platforms and materials

5

Implement a trademark monitoring program

- Set up alerts for potential infringements
- Regularly review the marketplace for unauthorized uses

Remember: The process doesn't end here. Proper use, monitoring, and enforcement are crucial to maintaining a strong trademark.

License

admission of

Additional Considerations

- **Trade Dress:** Consider whether aspects of your product's packaging or appearance could be protected as trade dress.
- **Non-Traditional Marks:** In some cases, sounds, colors, or even scents can be trademarked. Consider whether these elements are crucial to your brand identity.
- **Licensing and Merchandising:** If you anticipate licensing your mark or creating branded merchandise, ensure your chosen mark is suitable for these purposes.
- **Rebranding Risks:** If you're rebranding an existing business, carefully weigh the costs and benefits of changing your mark.

Conclusion

Choosing a strong trademark involves balancing legal considerations with business strategy and market appeal. By following this comprehensive guide, you can make an informed decision that provides robust legal protection, supports your long-term business goals, and resonates with your target audience. Remember, a strong trademark is an investment in your brand's future.

Contact us today to schedule your low-cost consultation and turn your innovative vision into a commercial reality.



To learn more about Dunlap Bennett & Ludwig and how we can help you, call today at **888-306-4030** or email us at clientservices@dbllawyers.com.

[Schedule Your Trademark Consultation](#)

Disclaimer

This guide provides a framework for decision-making but is not legal advice. Trademark law is complex, and the strength of a mark can depend on various factors specific to your situation. Always consult with a qualified trademark attorney for advice on your specific case and to navigate the legal intricacies of trademark selection and registration.