

LAND MY BRAND

HOW TO LOCK IN YOUR WORLD CHANGING BRAND

NAME WITHOUT GETTING SUED



AUTHOR: EVAN SAUER

“Your brand is the single most important investment you can make in your business”

STEVE FORBES, EDITOR IN CHIEF OF FORBES MAGAZINE

What if you spent thousands of dollars to start a business, picked a brand name, created a website, and spent months building your social media groups and reputation only to find out you don't have the right to use your brand name? This usually comes with a cease and desist or lawsuit by a competitor.

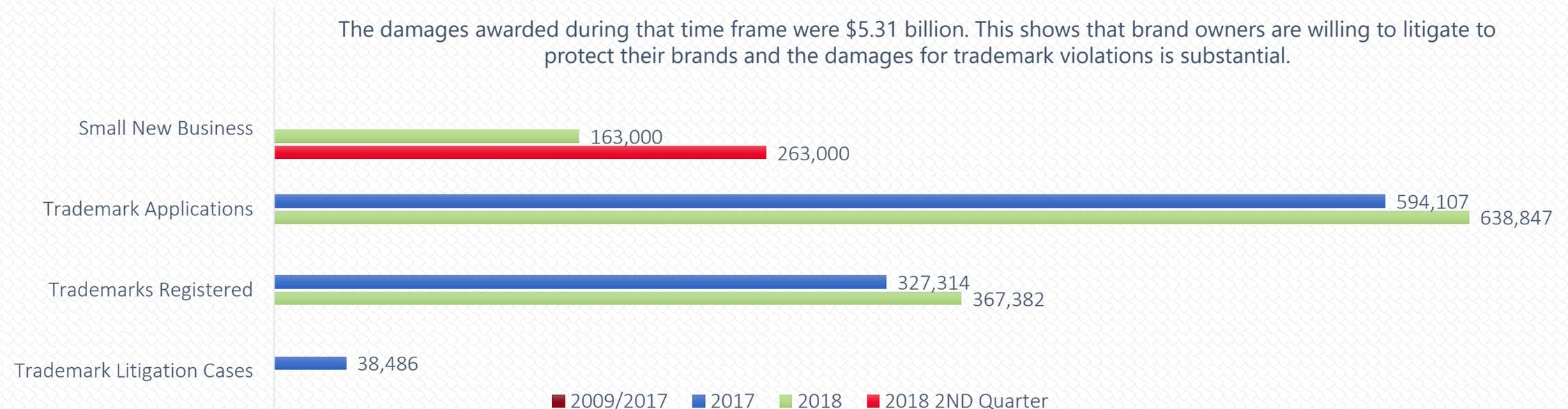
After spending all of that time and money, you now have to start over with a new name.

Don't let this happen to you.

Consider these statistics: there are roughly 30 million small businesses in the United States. In the first half of 2018 alone, 263,000 new business were started ^[1]. These are only the businesses that have registered with the government. There are likely thousands more that have not been included in these reports. All of these businesses have names that you likely cannot use.

In 2018, there were 638,847 trademark applications submitted for registration. This is up from 594,107 filed in 2017. In 2018, Close to 367,382 trademarks were registered, which was up from 327,314 in 2017 [ii]. What does this mean? Each year, more and more business owners are filing to protect their name.

From 2009 through October 2017, roughly 38,486 trademark litigation cases were filed. These cases involved trademark infringement, false advertising, validity of trademark ownership, and other related trademark matters. The damages awarded during that time frame were \$5.31 billion [iii]. This shows that brand owners are willing to litigate to protect their brands and the damages for trademark violations is substantial.



Before spending tons of money and hours developing a name, make sure you choose a strong name and do a thorough search to ensure you can legally use it.

It's not difficult, it just takes a little time. It's well worth it. Here's how.

STEP 1

CHOOSE A STRONG BRAND NAME

There are many factors that go into deciding on a brand name. Making sure the name reflects your brand clearly and concisely is one of the factors. Another is ensuring you not only have the right to use that name, but that if you decide to trademark it, you will have the ability to do so. A "trademark" is a word, name, symbol, or device used to identify goods and distinguish them from others. 15 U.S.C. Section 1127.

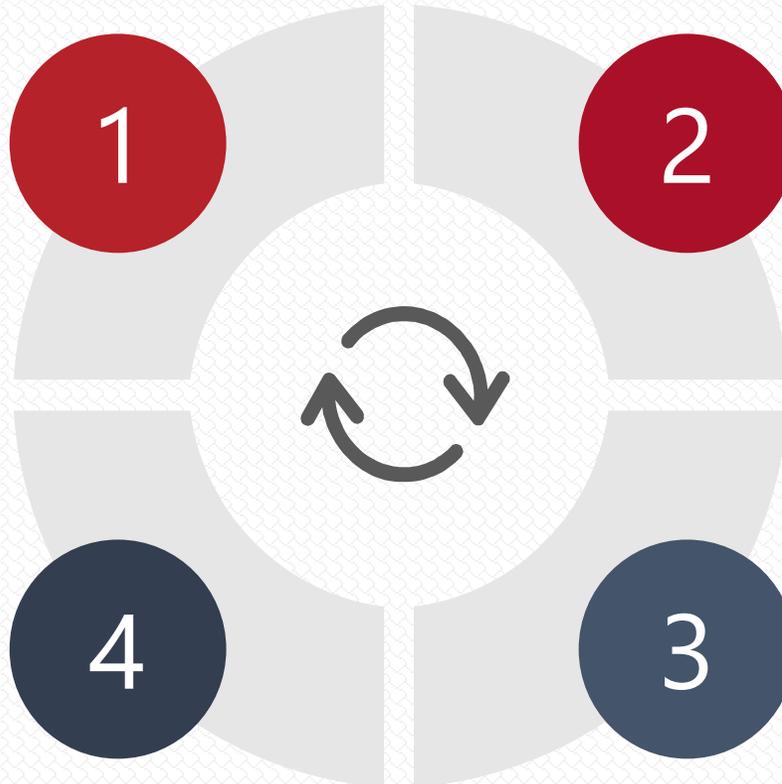
To ensure you have the strongest chance of being protected from "copycats" stealing your brand and being able to register your name as a trademark, having, consider the hierarchy of below (weakest to strongest) in picking your name:

GENERIC

A generic trademark is really not a trademark at all. Using the term "banana" to describe a "banana", for example, is not subject to trademark protection. Thus, when choosing a trademark, it is improper to choose a name that is defined in a dictionary to mean the type of product on which the trademark is being used.

Arbitrary trademarks are the best choice from a legal protection viewpoint. These are words that have absolutely no meaning prior to their adoption. These marks instantly become identified with the particular brand, and the exclusive right to use the mark is easily asserted against potential infringers. An example of an arbitrary trademark is the trademark "Nike®".

ARBITRARY



DESCRIPTIVE

Descriptive marks are also poor candidates for strong trademark protection. A mark is descriptive if it describes what the product is. For example, if the product is a drawer that goes in a desk, the trademark "desk drawer" would be considered descriptive since it merely describes what is being sold.

Suggestive marks are stronger trademarks, especially if they hint at the type of the product without actually revealing what the product is. For example, the trademark "Chicken of the Sea" which suggests an image of the type of product but does not indicate what the product is that is actually being offered.

SUGGESTIVE

For legal protection and for the best chance a name is not already taken, choose a brand name that is arbitrary.

STEP 2

GOOGLE & DOMAIN SEARCH

Most business owners think the only place that needs to be searched for brand name availability is the United States Patent and Trademark Office's ("USPTO"). This is a huge mistake. To do a thorough search, you need to read through databases, news, business and public records, legal and financial records, and the USPTO. In the US, trademark/legal rights to use a brand name/mark, result from use, and not registration with the USPTO. The first business to use a name/mark for commercial purposes and on an ongoing basis owns common law rights to it.

Therefore, I like to start my search with sources besides the USPTO first. The first step is to simply Google your brand name/mark. If your Google search reveals an exact match or similar match (this includes domain names as well), you may not be able to use your brand name. See below for searching variations.

STEP 3

SECRETARY OF STATE SEARCH

The next step is to search the Secretary of State's website in any State you plan to use your brand name or sell your products/services. A person may register for a trademark at the State level if they want to be protected to use a certain name in a specific State. If your State search reveals an exact match or similar match, you may not be able to use your brand name in that particular State. See below for searching variations.

After doing preliminary Google and Secretary of State searches, the next step is to search on the USPTO Trademark Electronic Search System ("TESS") database.

A

Likelihood Of Confusion

When doing a search for a brand name to make sure it is clear to use, the standard in choosing a mark is "likelihood of confusion". A "likelihood of confusion" exists when (i) the names/marks of the parties are similar; and (ii) the goods and services of the parties are related in such a way that consumers are likely to believe they come from the same source. That is, the marks look alike, sound alike, have similar meanings, or create similar overall commercial impressions and the goods and services are identical or are related in such a way that consumers would be likely to assume that only one company provides all of the goods and services when, in fact, the goods and services come from more than one source.

Remember, when searching for names think...**same or similar mark; related goods and services.**

When searching the USPTO, I like to search as broad as possible and then narrow my search if needed. Perform the following search methods in order.



Try the obvious first and enter the mark as it exactly appears (business name, phrase, etc.). Start at the [USPTO homepage](#), go to "Find it Fast", "Trademarks", and click on "TESS - Search Trademark Database". Select "Word and/or Design Mark Search (Free Form)". It will look similar to this:

TESS HOME NEW USER STRUCTURED BROWSE DICT SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO **NOT** ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT **REFUSE TO REGISTER** YOUR MARK.

View Search History:

Records Returned: 100 Plurals: Yes [Quick Tips](#)

Search Term:

Please logout when you are done to release system resources allocated for you.

US Trademark Field Codes

Code & Name	Code & Name	Code & Name
[AD] Abandonment Date	[IC] International Class	[RD] Registration Date
[AF] Affidavits	[IR] International Registration Number	[RE] Renewals
[AR] Assignment Recorded	[LD] Live/Dead	[RG] Register
[AT] Attorney of Record	[MD] Mark Drawing Code	[RN] Registration Number
[BI] Basic Index	[MI] Mark Index	[SF] Section 44 Indicator
[CB] Current Basis	[MN] Mark Non-Punctuated	[SD] Single Design Code
[CC] Coordinated Class	[MP] Mark Punctuated/Word Mark	[SN] Serial Number
[CD] Cancellation Date	[OB] Original Filing Basis	[SO] Serial - Other Formats
[CR] Change in Registration	[OD] Other Data	[ST] Standard Characters Claimed
[DC] Design Search Code	[ON] Owner Name	[SR] Date Amended to Current Register
[DD] Design Description	[OW] Owner Name and Address	[TC] Trademark Search Facility Classification Code(limited to 8-28-07 through 1-31-11)
[DE] Description of Mark	[PD] Priority Date	[TD] Total Designs
[DM] Decimal Mark	[PF] Physical Filing Date	[TF] Distinctiveness Limitation Statement
[DS] Disclaimer	[PO] Published for Opposition	[TI] Translation Index
[FD] Filing Date	[PM] Pseudo Mark	[TL] Translation
[FM] Full Mark	[PI] Pseudo Mark Index	[TM] Type of Mark
[GS] Goods and Services	[PR] Prior Registrations	[UD] Update/Load Date
		[US] US Class

TESS HOME NEW USER STRUCTURED BROWSE DICT SEARCH OG TOP HELP

In the “Search Term” box, enter your exact word or phrase with quotes and click “Submit Query”. See if you get a hit right away. If you do, examine each record.

If you don’t get any hits with quotations, search your word or phrase without them. You may get thousands of hits. If you search Soap & Basket (made up name for this guide), for example, without quotes, it is the same as “Soap or Basket”. The search will return any trademark record with either word anywhere in the listing.

If the exact phrase shows up in a search as a registered active trademark, you will not be able to use that brand name (unless you were the first one to use the mark in commerce – more on that topic in [another article](#)). If the search produces several results or does not produce any results, you should continue your search as detailed below. The idea is to get your results list to a manageable number (below 150).

Here is where the real money is made. Think of all of the possible variations of your brand name (and each word of the phrase).

1

Look for obvious misspellings: "Thanks" vs. "Thx", for example.

3

Check for consonant substitutions "ks" for "x", "c" or "z" for "s", "k" for "c".

2

Check for vowel substitutions: "oo" for "long-u", and so on.

4

Look for word/number substitutions: "two" for "2".

5

Don't forget plurals. The free form search page has a "plurals" box - change it to "yes" to search for obvious grammatical plurals.

Use Truncation Characters. It may be impossible to think of all of the possible variations so the USPTO helps you out with the use of truncation characters (*, \$, \$n, and ?). You can use truncation characters in your search to represent one or more optional characters ("*" works in the [BI] field only, see below). The \$ character matches zero or more continuous characters. The \$ character can be used in any search field to represent 0, 1 or more than one character other than a blank space character. For [BI] searches (see below) use the asterisk * instead of the \$ character. For example, if you searched So\$p, you would find Soap, Soup or Somprop. The \$n character matches between zero and n continuous characters. By including a numeric value following the \$ character, the \$ character is limited to at most n characters. For example, if you searched So\$2p, you would find Soap, Soup, but not Somprop (four characters between So and p). The? character matches a single non-blank character. For example, if you searched So?p, you would find Soap, Soup, or Soop, but not Sooop.

If you get through the above search methods and your search provides too many hits, next try narrowing down the fields.

Use Field Codes

Use the [BI] field code when searching for words in a mark - this covers the word mark, translation and "pseudo mark" fields. Pseudo marks are translations, correct spellings of deliberate misspellings, spelled-out abbreviations, and so on. Without the [BI] field code, your search could appear in an owner's name, attorney's name, etc.

A helpful hint when you are using the [BI] code to search is to use * to replace any number of letters. Try each part of the name separately and in combination: Soap*[BI] and *Basket [BI]. Prefix and postfix truncation searches can be very useful. Soap* gets you any name starting with "Soap", and *Basket gets you any mark ending with "Basket".

Look for Related Goods & Services

Narrow your search to marks for goods and services which might be competitive with yours. Remember: same or similar mark; related goods and services. Perform a search in the USPTO's [Trademark ID Manual](#) ("ID Manual") to find goods and services that are classified like yours.

Open the [ID Manual](#). In the search bar, type the name of one of your goods or services and hit enter. Your results will list every description in the ID Manual that includes the term you entered. Look at the description column for a description that accurately reflects your good or service. If you find one, look at the class column for the class number of your good or service. If you hover over the class number with your cursor, you'll see an explanation of the type of goods or services in that class.

Your results may show descriptions that appear to be duplicates. Sometimes, similar goods are listed in multiple classes. These goods are classified based on their purpose, their composition, or some other factor. Repeat this process for the other goods or services you offer to get a sense of how each one is classified.

After you've looked up the goods and services you provide, repeat the process for goods and services that are related to yours. If you're not sure what those are, here are a few questions to help you get started:

To find relatedness between goods and/or services, the goods and/or services do not have to be identical. It is sufficient that they are related in such a manner that consumers are likely to assume (mistakenly) that they come from a common source. The issue is not whether the actual goods and/or services are likely to be confused but, rather, whether a likelihood of confusion would exist as to the source of the goods and/or services.



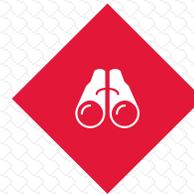
When a consumer knows what goods and services you offer, what other goods and services might they reasonably expect you to offer?



What goods or services do your competitors provide that you don't?



In a department store, what products might be displayed in the same aisle as yours?



What other products are commonly used with yours?

My preferred search field for related goods and services is [CC] "Coordinated Class". The USPTO has compiled a list of goods and services from different classes that are so related that they are called coordinated classes. You can find a list of the coordinated class by clicking on the [CC] Coordinated Class link, in the table of field codes below the search term. It looks similar to this:

TESS HOME NEW USER STRUCTURED BROWSE DICT SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

View Search History:

Records Returned: 100 Plurals: Yes [Quick Tips](#)

Search Term:

Please logout when you are done to release system resources allocated for you.

US Trademark Field Codes

Code & Name	Code & Name	Code & Name
[AD] Abandonment Date	[IC] International Class	[RD] Registration Date
[AF] Affidavits	[IR] International Registration Number	[RE] Renewals
[AR] Assignment Recorded	[LD] Live/Dead	[RG] Register
[AT] Attorney of Record	[MD] Mark Drawing Code	[RN] Registration Number
[BI] Basic Index	[MI] Mark Index	[SF] Section 44 Indicator
[CB] Current Basis	[MN] Mark Non-Punctuated	[SD] Single Design Code
[CC] Coordinated Class	[MP] Mark Punctuated/Word Mark	[SN] Serial Number
[CD] Cancellation Date	[OB] Original Filing Basis	[SO] Serial - Other Formats
[CR] Change in Registration	[OD] Other Data	[ST] Standard Characters Claimed
[DC] Design Search Code	[ON] Owner Name	[SR] Date Amended to Current Register
[DD] Design Description	[OW] Owner Name and Address	[TC] Trademark Search Facility Classification Code(limited to 8-28-07 through 1-31-11)
[DE] Description of Mark	[PD] Priority Date	[TD] Total Designs
[DM] Decimal Mark	[PF] Physical Filing Date	[TF] Distinctiveness Limitation Statement
[DS] Disclaimer	[PO] Published for Opposition	[TI] Translation Index
[FD] Filing Date	[PM] Pseudo Mark	[TL] Translation
[FM] Full Mark	[PI] Pseudo Mark Index	[TM] Type of Mark
[GS] Goods and Services	[PR] Prior Registrations	[UD] Update/Load Date
		[US] US Class

TESS HOME NEW USER STRUCTURED BROWSE DICT SEARCH OG Top HELP

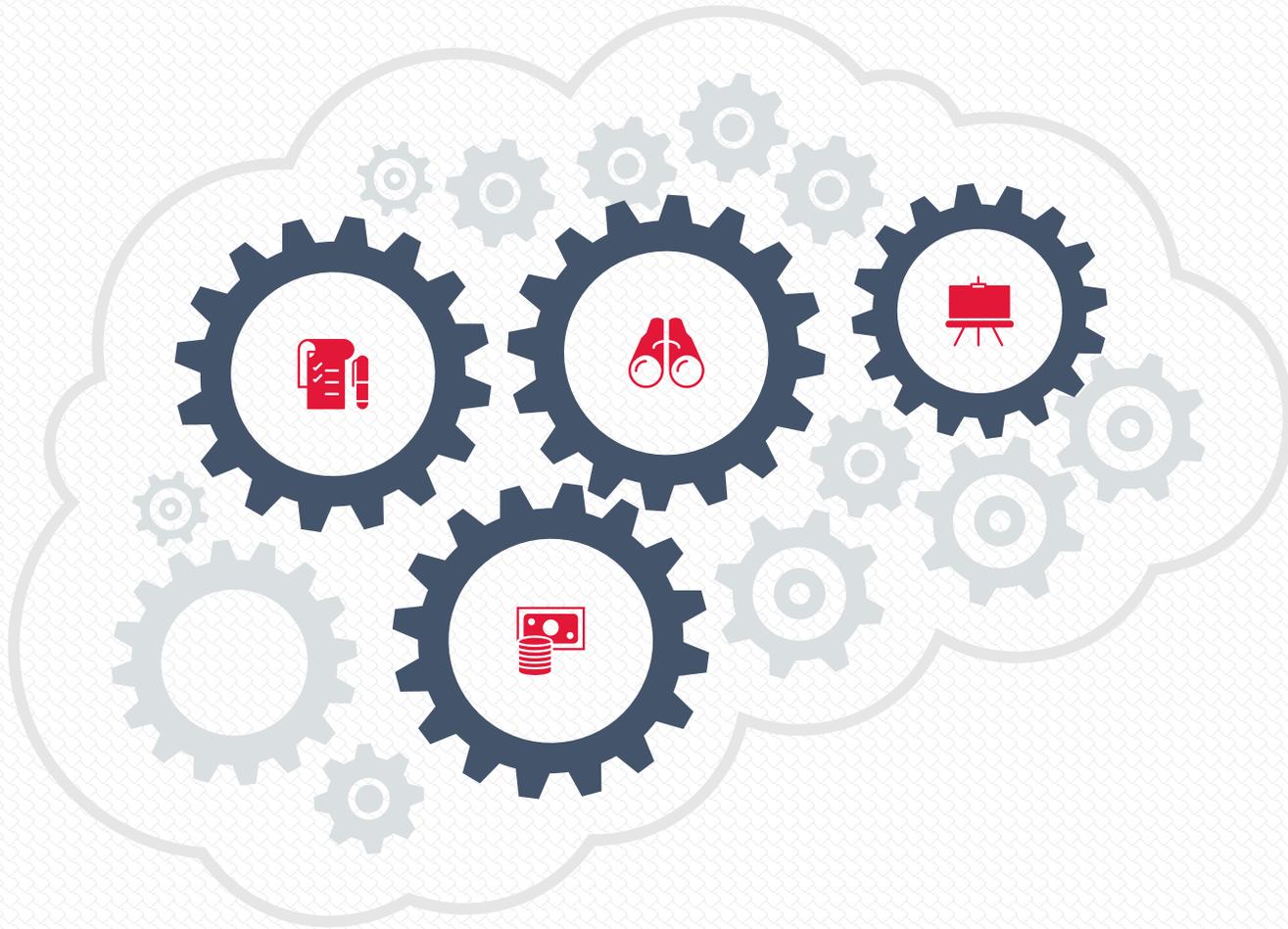
Coordinated Class [CC]

Search the **Coordinated Class** field to retrieve marks from International Classes related to a specific International Class. The search **“009”[CC]** will retrieve marks in coordinates class 009, i.e., marks related to International class 009. Usually, this search field is used in conjunction with other search fields.

This field is not displayed; consequently, search terms for searches of this field will not be highlighted.

The Coordinate Class Table (reversed April 2006) was designed to automatically include related International Classes in the search results when the primary International Class is searched. For Example, a search for International Class 007 utilizing the Coordinated Class index to designate that the search is for the Coordinated Class associated with International Class 007 will include results containing any of the following International Class designations : 007, 008, 011, 012, 035, 037, 040, 042, A, B, 200.

Primary International Class	Related International Classes
001	005, 017, 035, 042, 044, A, B, 200
002	017, 019, 035, 037, 040, 042, A, B, 200
003	005, 021, 035, 042, 044, A, B, 200
004	001, 035, 037, 042, A, B, 200
005	001, 003, 010, 035, 042, 044, A, B, 200
006	011, 017, 019, 020, 035, 037, 040, 042, A, B, 200
007	008, 011, 012, 035, 037, 040, 042, A, B, 200
008	007, 021, 035, 037, 040, 042, 045, A, B, 200
009	010, 016, 028, 035, 038, 041, 042, 044, A, B, 200
010	005, 035, 042, 044, A, B, 200
011	006, 007, 009, 019, 020, 035, 037, 040, 042, A, B, 200
012	007, 035, 037, 042, A, B, 200
013	028, 035, 042, 045, A, B, 200
014	025, 026, 035, 037, 040, 042, A, B, 200
015	028, 035, 041, 042, A, B, 200
016	009, 035, 041, 042, A, B, 200
017	001, 002, 006, 019, 035, 037, 040, 042, A, B, 200
018	014, 025, 035, 042, 044, A, B, 200
019	002, 006, 011, 017, 035, 037, 040, 042, A, B, 200
020	006, 021, 028, 035, 042, A, B, 200
021	003, 008, 020, 035, 042, 044, A, B, 200
022	023, 024, 035, 042, A, B, 200
023	022, 024, 026, 035, 042, A, B, 200
024	023, 025, 026, 035, 042, A, B, 200
025	014, 018, 024, 035, 042, A, B, 200
026	023, 024, 035, 042, A, B, 200
027	019, 024, 035, 037, 042, A, B, 200
028	009, 016, 020, 025, 035, 041, 042, A, B, 200
029	005, 030, 031, 032, 033, 035, 042, 043, A, B, 200
030	001, 005, 029, 031, 032, 033, 035, 042, 043, A, B, 200
031	005, 029, 030, 032, 035, 042, 043, 044, A, B, 200
032	005, 029, 030, 031, 033, 035, 042, 043, A, B, 200
033	005, 029, 030, 031, 032, 035, 042, 043, A, B, 200
034	004, 035, 042, A, B, 200
035	036, 037, 038, 039, 040, 041, 042, 043, 044, 045, A, B, 200
036	035, 037, 038, 039, 040, 041, 042, 043, 044, 045, A, B, 200
037	035, 036, 038, 039, 040, 041, 042, 043, 044, 045, A, B, 200
038	035, 036, 037, 039, 040, 041, 042, 043, 044, 045, A, B, 200
039	035, 036, 037, 038, 040, 041, 042, 043, 044, 045, A, B, 200
040	035, 036, 037, 038, 039, 041, 042, 043, 044, 045, A, B, 200
041	035, 036, 037, 038, 039, 040, 042, 043, 044, 045, A, B, 200
042	035, 036, 037, 038, 039, 040, 041, 043, 044, 045, A, B, 200
043	035, 036, 037, 038, 039, 040, 041, 042, 044, 045, A, B, 200
044	035, 036, 037, 038, 039, 040, 041, 042, 043, 045, A, B, 200
045	035, 036, 037, 038, 039, 040, 041, 042, 043, 044, A, B, 200
A	B, 200
B	A, 200
200	041, 042, A, B



If Soap & Basket was planning to sell soap dishes, for example, which falls in the 021 class, then by searching 021[CC], the results would include other classes like 003 soap powder. A word of warning when narrowing your search using goods and services. Famous marks have a much broader range of protection, so, for example, if you search "Nike" and limited your search to soap, you would not get any hits; However, that does not mean you could use a brand name such as Nike Soap.

After you have managed to narrow your search results down to 150 or less, the last step is to review each record. In the list of records, click on the "word mark" column to view the record of each mark. You will get something like this:

[TSDR](#)
[ASSIGN Status](#)
[TTAB Status](#)
(Use the "Back" button of the Internet Browser to return to TESS)

THE SOAP MARKET

Word Mark	THE SOAP MARKET
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: Soaps; perfumery, essential oils, cosmetics, skin lotions. FIRST USE: 20110201. FIRST USE IN COMMERCE: 20110201
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86370960
Filing Date	August 19, 2014
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	January 27, 2015
Registration Number	4719726
Registration Date	April 14, 2015
Owner	(REGISTRANT) Stephanie Wallingford INDIVIDUAL UNITED STATES 2810 N. 9th Street Carter Lake IOWA 51510
Attorney of Record	Gerald M. Keller
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOAP" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

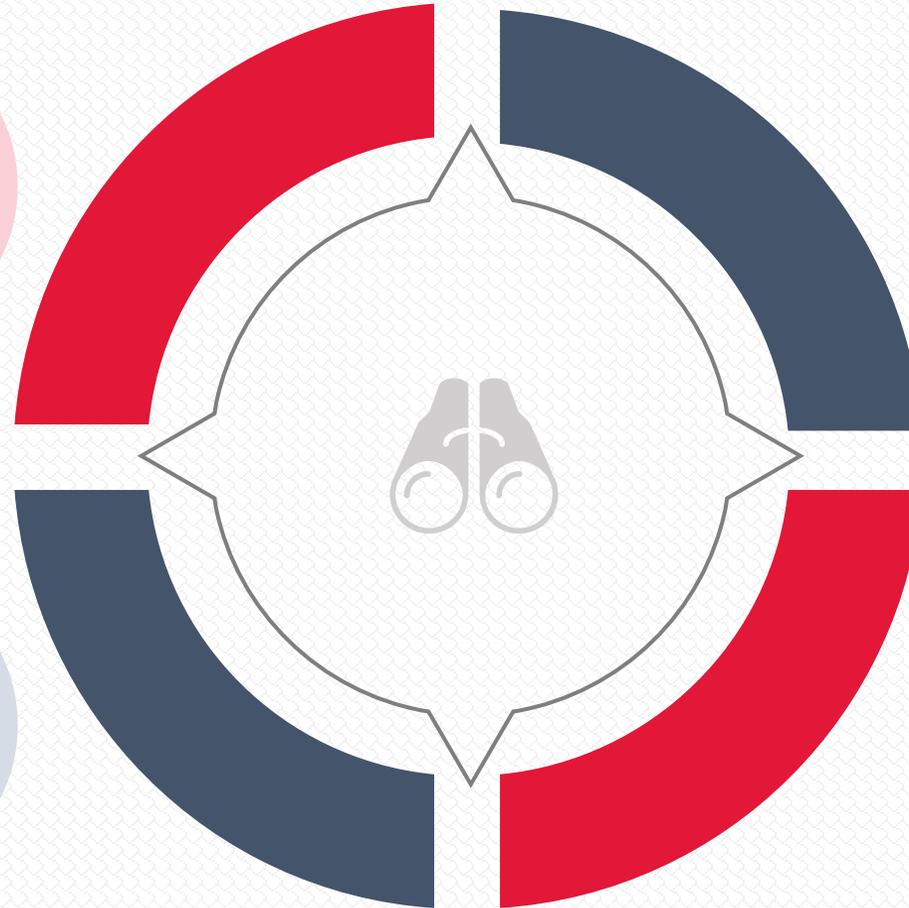
[TESS HOME](#)
[NEW USER](#)
[STRUCTURED](#)
[FREE FORM](#)
[BROWSE DICT](#)
[SEARCH OG](#)
[TOP](#)
[HELP](#)
[PREV LIST](#)
[CURR LIST](#)
[NEXT LIST](#)
[FIRST DOC](#)
[PREV DOC](#)
[NEXT DOC](#)
[LAST DOC](#)



FOCUS ON THESE DETAILS:

**1. The mark at the top of the page**

- Is the mark similar (in sound, appearance, meaning, or commercial impression) to yours?



3. Goods and services – Are the goods and services similar or related to your goods and services?

2. Word mark - Is the wording similar to the wording in your mark?

4. Live/dead - Is the mark live?

If you answered “yes” to these questions, there may be a likelihood of confusion between your brand name and the name you are reviewing. You may not be able to use your name.

In building your business and reputation, your brand is everything. This connects your customers to you and creates loyalty and ultimately more sales.

Before choosing a name make sure you do a thorough search. There is no way of getting around the fact that there are a lot of steps involved in performing the necessary search. But I believe if you take the time (only 30 minutes to an hour) to go through these steps, you can avoid wasting months of your time and thousands of dollars marketing a brand name you will not be able to use. Just use the handy Brand Name Search Checklist below.

Sure, this can take more time up front than you initially intended, but I guarantee that you will not be disappointed!

P.S. This is a simple guide to get you started. There may be other search methods you need to utilize. If you want any more help or advice with your brand name, these steps, or just need a listener, please contact me here: [click here to schedule a free consultation](#)

BRAND NAME SEARCH CHECKLIST

Search Type	Searched (Y or N)?	Reviewed (Y or N)?	Cleared/Likelihood of Confusion/Exact Hit (C, LOC or EH)?
Google/Domains: Exact Phrase			
Google/Domains: Phrase			
Google/Domains: Variations			
Secretary of State: Exact Phrase			
Secretary of State: Phrase			
Secretary of State: Variations			
USPTO: Exact Phrase			
USPTO: Phrase			
USPTO: Variations			
USPTO: Narrowed by Search Fields			
USPTO: Related Goods & Services			

Evan Sauer is a business lawyer at Reda & Des Jardins, LLC a forward-thinking, technologically savvy law firm providing top-notch legal services to clients ranging from startups to large companies in a variety of industries.

R&D's practice includes:
business, real estate, litigation and estate planning

Learn more at www.rdlawyers.com or contact Evan at evan@rdlawyers.com



⁽ⁱ⁾SBA Office of Advocacy, 2018 Small Business Profile (2018).

⁽ⁱⁱ⁾USPTO, Data Visualization Center Your Window to the USPTO Trademarks Dashboard (2019) <https://www.uspto.gov/dashboards/trademarks/main.dashxml>.

⁽ⁱⁱⁱ⁾ Brian C. Howard, Trademark Litigation Report 2017, Lex Machina (2017).