

# Common misconceptions about trademarks:

Everything you wanted to know and  
should have asked already

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# Common misconceptions about trademarks:

## Everything you wanted to know and should have asked already

by Jerome McDonnell and Paola Norambuena

### **MISCONCEPTION #1: A trademark has to be a name/tagline/logo.**

You might be surprised, but a trademark can be anything that functions as a source indicator. Beyond words and names, forms that have secured protection include sounds, colors, shapes, trade dress (packaging, design, and décor)—even smells. Brands that have successfully secured legal protection for such distinct attributes include the NBC chime, the robin's-egg blue color of Tiffany & Co., the shape of the Apple iPod, the layout and color-scheme of McDonald's restaurants, the smell of fruits for a brand of motor lubricants and fuels.

### **MISCONCEPTION #2: My name is not identical to an existing trademark, therefore there should be no conflict.**

Trademarks don't have to be identical to cause consumer confusion. Merely being "confusingly similar"—such as sounding alike, looking alike, or even having a similar meaning—is enough. For example, the search engine Kazaa was previously deemed to be confusingly similar to Casa database search software, and an application for Brews Brothers was denied because of the already existing mark for the *Blues Brothers* film.

The bottom line: Proof of actual consumer confusion is not required—just the likelihood of confusion.

### **MISCONCEPTION #3: I own the trademark, therefore I own the domain name –right?**

You might think in this Internet age that domain names and trademarks are synonymous. But owning the trademark does not guarantee you ownership of the .com—just as owning a .com does not automatically allow you rights to use the name as a trademark. If a domain name is already taken, you need to prove the .com was registered in bad faith, or if you don't, the original owner likely will retain legitimate rights to it—and is by not obliged to relinquish ownership. This is why purchasing available .coms early on in the naming process is highly recommended.

### **MISCONCEPTION #4: I don't need to bother prescreening—let's cut straight to the full legal search!**

Prescreening is an inexpensive way of getting an indication of a name's chances, identifying obvious problems up front. Depending on the type of name, the type of offering, and the

number of different geographies involved, 85-95 percent of names will already be taken as a trademark—so prescreening saves time and money and reduces the risk you'll start running with a name that is clearly unavailable or inappropriate for use. A thorough prescreen will not only check for registered and pending trademarks, but will also search common-law usage, .com status, possible negative associations, and linguistic issues.

### **MISCONCEPTION #5: I have a great name, the prescreen shows no one owns it, I'm good to go!**

Prescreening is just the first step in the trademark clearance process. A name that survives the prescreen has cleared the first hurdle, but still needs to undergo further analysis—namely the comprehensive clearance ("full legal") search. This needs to be done for all relevant geographies, and an attorney must review the results. The attorney will investigate as necessary and render a legal opinion as to the name's availability for use and/or registration. In some locales, a trademark clearance report can be obtained in as few as 24-48 hours,

but when multiple geographies are involved the process may require the input of foreign associates. The watchword here is: Budget time appropriately.

**MISCONCEPTION #6: I cannot use my brand name before filing the trademark application, or before being granted official trademark registration.**

While some entrepreneurs are too gung-ho, others may be a bit gun-shy. In common-law countries such as the U.S., rights are acquired through use. Once properly cleared, the sooner you use the name in commerce, the sooner you establish a legal right to the name. You do not need to wait to file your application or receive a registration in order to commence use.

However, it's crucial to remember that trademark laws vary by country. In countries that employ the first-to-file system, it is imperative that you file the application before beginning use.

**MISCONCEPTION #7: I cannot use the ™ symbol until I have filed a trademark application.**

In the U.S., the ™ symbol can be used to indicate the owner's claim of rights to the mark, and can be employed as soon as the name is used as a trademark. You can fly the ™ symbol before you even file an official trademark application—but keep in mind that use of the ™ symbol does not guarantee that the owner can claim protection of trademark laws.

As for the ® designation, a trademark is only permitted to carry that after it has been granted registration by the trademark office. Proceed with caution: Use of the ®

symbol without this approval (Certificate of Registration) may result in claims of fraud.

**MISCONCEPTION #8: If I register the name in English, I automatically obtain protection in other languages.**

Registering your trademark in one language does not automatically confer rights to the name translated into other languages. But if you file for a trademark in a foreign country, your trademark may be translated into the native language to determine that it does not conflict with an existing trademark in that language. Trademark transliteration is the conversion of a trademark from its native language into a foreign conceptual equivalent. When expanding into foreign markets, the literal translation as well as transliteration(s) may need to be cleared and registered before use.

**MISCONCEPTION #9: Once I register my trademark, I own it for any type of goods or services I want to expand into.**

Think twice before you use your trademark for different offerings. Trademark rights are granted for use in connection with specific goods and/or services, and you are only permitted to use the trademark accordingly.

You cannot assume your trademark can be extended to other goods or services, and this is why it's possible for the same name to be owned by different companies for different offerings—such as Dove soap and Dove chocolate, Delta airlines and Delta Dental.

**MISCONCEPTION #10: Once I register the trademark, I'm entitled to use it in anywhere.**

Trademark rights are bound by jurisdiction, and you can only use the trademark in the

geography in which it has been cleared. Lenovo was known as "Legend" in China, but had to change its name due to numerous conflicts with trademarks registered in other countries. It's never too early to address plans for expansion and/or licensing, and it's wise to investigate name availability in future geographies and trademark classes as soon as possible.

**MISCONCEPTION #11: Now that I registered my trademark, it's mine forever.**

Everything has its life span: Copyrights run their course, and patents eventually expire. The good news is that trademarks can last forever—but only if you continue to use them in commerce. And you must be able to provide evidence of continuous use to the trademark office in order for your mark to be renewed.

*Securing a viable trademark is becoming an increasingly complex challenge. At Interbrand we have a rigorous risk management process that takes into account the common pitfalls of trademark development. Through prescreening all names prior to presentation, we reduce the risk of wasting valuable time and money evaluating names that are clearly unavailable for use. At each step of the name development process we offer guidance to help secure a mark in the most expedient and efficient manner possible. Working closely with proven partners and leading trademark search databases, we minimize risk and maximize the chances of securing a powerful and protectable trademark.*

**This article is intended for informational purposes only and does not constitute legal advice.**

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### **Jerome McDonnell**

Jerome McDonnell is Senior Trademark Consultant with Interbrand's New York Verbal Identity team. He leads the office's trademark prescreening practice, and is responsible for the research and risk analysis of names, taglines, and logos. Jerome is a member of the International Trademark Association (INTA), and has contributed to Interbrand's *Brand Glossary* book.



### **Paola Norambuena**

Paola is Senior Director of New York's Verbal Identity department, where she specializes in naming and verbal identity. Paola joined Interbrand with over a decade of career success developing integrated marketing, creative, and branding strategies. She has used her diverse experience to ensure the success of Interbrand's clients.