

## Trademarks and Names - How to Select a Good Trademark By Elias Borges

Your trademark is the most important asset your business will ever own. A good trademark will distinguish you from the competition and help you stand out in a crowd. A poor trademark will entangle you in legal disputes and blunt your marketing efforts. Selecting a good trademark is as simple as following the following guidelines.

**1. Avoid Trademarks that cannot be Registered.** There is no point investing in a trademark that you can't register. Registering the mark protects it from competitors, ensures your ownership rights in the mark and makes it easier to enforce your rights against copy cats. As you will read below, certain types of words are inherently poor choices for inclusion in a trademark because they cannot be registered.

**2. Avoid Purely Descriptive Words.** Words which describe the nature or quality of the goods or services sold with the mark are not permitted to be registered. Hence, the mark "Cold Beer" for use with malt beverages cannot be registered because it describes the actual product being sold. If registered, it would prevent anyone from using the terms Cold and Beer to describe their malt beverage.

**3. Avoid Surnames.** Surnames cannot be registered as trademarks. Hence the mark "Wilson Power Boats" is a poor choice for a trademark because the word Wilson is a surname (and the rest of the mark is descriptive).

**4. Avoid Confusing Trademarks.** A trademark which is confusingly similar to a registered trademark cannot be registered. Hence, the mark "Sun-Screen" cannot be registered if the trademark "Sun Screen" has already been registered for a similar type of product. A search of the US Trademarks Database ([www.uspto.gov](http://www.uspto.gov)) and/or the Canadian Trademarks Database ([www.cipo.gc.ca](http://www.cipo.gc.ca)) is a good idea.

**5. Avoid Generic Words in a Trademark.** The goal is to select a trademark which is as unique and distinctive as possible; therefore, avoid generic words. Examples of generic terms include "green, superior, Canadian, American, deluxe, gold, premium, economy," and a plethora of others. These words are generic and if you incorporate them into your trademark, you ensure that you blend into the crowd, not stand out in front of it. Geographic words fall into this category.

**6. Avoid TLA's (Three Letter Acronyms) and Numbers.** IBM, ATT, and CNN are distinctive trademarks because their respective owners poured tens of millions of dollars into making the marks famous. Even a poor trademark can be made famous if you through enough money at it. But acronyms are intrinsically difficult to remember, while words, especially colorful words, are easily remembered. Hence "ELS Software Solutions" is not as memorable as "Volcanic Silicon." Likewise, avoid using numbers in a trademark as they tend to be less memorable. Furthermore, there are a limited number of unused acronyms available, so there is an excellent chance that your TLA will be confused with someone else's.

**7. Do use invented words.** Invented words are words which do not exist in any language, apart from your trademark. Examples include Spandex, Exxon, Kodak, Viagra, and several other famous trademarks. Invented words are a good choice for use as trademarks because they are not descriptive and they tend to be quite distinctive. You can create an invented word by simply combining parts of other words. For example, Microsoft is a combination of “Micro computer” and “software.”

**8. Try animal or plant names.** Animal and plant names tend to be quite memorable and, if used appropriately, can convey a good image while still being distinctive. Apple Computers is a good example, but other examples include Tiger Direct, Ford Mustang, and countless others.

Finally, make sure that the first word in your trademark is as distinctive as possible. It is often necessary to add descriptive words to the trademark in order to convey what is being sold or marketed in association with the mark. If generic words must be included then it is doubly important to ensure that the first word of the mark is as distinctive and unique as possible.

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