

## **For the New Company on the Block: How Cool Do You Want to Be?**

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So how cool does your client want to be? Mayor Ed Lee of San Francisco meets with a new company every week as part of his community development initiatives “just to talk to them, find out what their crazy name means, like Indiegogo, Yammer.”<sup>1</sup> This observation by Mayor Lee underscores an issue for a new company. Does a Newco want to be so cool that its brand does not connect with public except for its uniqueness or should the brand convey more to the customer?

Branding for a start-up or new business for an existing company presents the challenges illustrated by Mayor Lee’s comment. The new venture’s identity should be catchy and protectable but also should convey the core values of the goods/services to the consumer or investor. The brand is not only the mark and identity for the new business, but can be leveraged to protect other IP assets. Also, brands are tools for social media that can be used or misused. This paper is a brief summary of branding basics and ways to use your brand as part of an overall technology based IP strategy and interface with social media

### **BRAND SELECTION**

#### **Background**

A trademark is a word, logo, design, slogan or any other designation that indicates the source or origin of goods or services. A mark is an adjective not a noun or a verb e.g. LIPITOR® cholesterol lowering medication; PerkinElmer® mass spectrometer. Trademark law rubric is the strongest marks are unique as made up words such as EXXON® or common words that are not associated with the goods/services such as APPLE® for computers. Descriptive marks such as TAX SURVIVAL KIT for tax preparation software or GENE ID for PCR kits are difficult to protect without years of use. Generic marks such as “3-D Tissue Imaging” for a machine that performs three-dimensional imaging for tissues are not protectable at all.

There is a tension between marketing and legal protection, because often a mark is selected to convey a function or quality to the end user and tends to the descriptive end of the spectrum. For

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<sup>1</sup> The Magazine, New York Times, November 17, 2013 p. 12.

a new product coming on the market this tension is even more severe, because marketing specialists tell us that new brand must convey the value proposition to the potential market. This paper will review how the IP attorney who is often one of the first legal professionals supporting a Newco can interface with the marketing brains. The IP attorneys, as a trusted advisor to Newco, can assist in the brand development while understanding the marketing needs that may be in some conflict to legal protection.

The initial emphasis of a Newco is typically product oriented – we have discovered this new product (or service) and how can it be optimized. Of equal or even more importance is what market need or want does this product satisfy and how does Newco convey the product attributes. This is the “Brands versus Product” tension that IP counsel finds themselves advising on both technology protection and branding. The product technology is protectable through patents and software and the brand strategy must convey attributes attractive to the consumer known as the “value proposition” to the marketplace.<sup>2</sup>

## **Marketing Strategy**

Knowing the market for the new product is key in selecting the brand. Often the brand selection is prior to any market analysis of why the likely customers will want to purchase a product or how the retailer or distributor will source customers for the product. “Technology categories are created by customers and external forces, not by companies themselves”. Keller at 21-26. Merely re-inventing a wheel that is already working reasonably well will not create a market for a new product. “Brands are owned by customers, not engineers” and the reason a product will be attractive to a customer is not necessarily why the innovator is enchanted with the creation. Id.

Vetting the consumer on the new product should be the first step in developing a brand. The consumer perception of the new product should be positioned with the existing repertory of products. This exercise is the most important to devise a brand that is in sync with what your customer thinks is important about the new product according to market specialists. Also, the investigation with the customer may give you insight into the new and unexpected benefits of the product that can be emphasized in a patent application. The benefits stated in a patent application may be useful in arguments about patentability in addition to being sure you are properly targeting the brand name and any catch phrase used with the brand.

Brand elements that should be considered once your client has researched its market and customer are (1) memorability-easy to recall, (2) meaningfulness, (3) likability, (4) transferability to other brand lines, (5) adaptability such being updatable and (6) protectability.

Brand elements include the word, visual presentation, including logo and color. The use of color and the number of colors used in a brand convey psychological meaning to consumers. [www.precisionintermedia.com](http://www.precisionintermedia.com). A new product should have the right “hook” to connect with the

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<sup>2</sup> See, *Strategic Brand Management*, Kevin Lane Keller, Pearson, Prentice Hall (3<sup>rd</sup> Ed. 2008) pp. 140-141 (Brand strategy text by leading expert in the field).

new customer. The following mark was developed by a team of MBA students for a new software company.<sup>3</sup>



The product is software that allows users to access the various programs used by a business from any computer or hand held device and provide mobility for the users. Techne is an accent Greek term for “craftsmanship” and the word was selected because it combined a classical sense with innovation. Red was chosen to represent energy and movement. While the color blue with the puzzle piece for the “n” represents the calming feature that the TECHNE product can introduce into a hectic business environment. The puzzle piece further conveys to the customer that TECHNE is a solution driven product.

When Newco is making the elevator pitch, the prospective customer needs something to remember other than an unmemorable mark. If Newco has selected a unique word mark suggest using a catch phrase or tag line is helpful to convey the value proposition of the product to the public along with the mark. When Jeff Bezos started Amazon.com, he used “the earth’s biggest bookstore.” Amazon.com has expanded beyond books, but this catch phrase conveyed to the consumer what Amazon.com was all about. This phrase is also called the brand mantra or short phrase that conveys “core brand associations, points of parity and points of difference”. Keller at 39.

If your client has a registered mark already, consider building a family of marks with the “house” brand. The repetitive use will strengthen the mark and increase awareness in the marketplace. A federal registration will be much easier to obtain for new products when there is an existing registration for related goods. There is often a desire to create a different brand identity for even related products that can dilute the major brand.

Marketing specialists note that too often Newco’s with more than one product develop totally different marks for each product and this also confuses the marketplace.<sup>4</sup> When a company has multiple products, this may lead to an over emphasis on the branding of each product. With distinct marks for products in rapid succession, the portfolio is “cluttered” and the consumer does not understand the “brand hierarchy”. *Id.* Choosing a primary brand that can be used with product extensions for each innovation is the recommendation by marketing experts.

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<sup>3</sup> *Marketing Project* by Taquina Luster, Xinyang Meng, Jayce Radcliffe, Morrison Supple and Alex Vidal Prepared for Prof. Utpal M. Dholakia Jones Graduate School of Business, Rice University.

<sup>4</sup> *Supra*, Keller at 16 citing Patrick Tickle et al.

## **MARK CLEARANCE**

Many clients use Internet searching to clear marks. Clients can perform knock-out searches, but do not understand that the USPTO will reject a mark that contains a synonym of a prior registration such as “CYCLONE” and “TORNADO” or “PUMA” and “LION” have been held too similar to coexist on the basis of meaning. Also phonetic equivalents such as ENTELEC and INTELECT are likely to confuse and need to be considered in the clearance process.

Most clients do not consider clearance issues outside the U.S. The PRC is particularly difficult, as there are more registered marks than anywhere else in the world. Broader protection is provided for a registered mark in the PRC, because registration in particular category such as computer hardware or audio equipment, will also serve as a basis for rejection of totally unrelated software products that are not in the same channel of trade.

Trademark clearance is part art and part science. Many clients fall in love with a brand prior to vetting for worldwide or even U.S. clearance. Only well-known brands such as CHANEL or MICROSOFT can be protected outside the U.S. without a registration. Part of the IP counseling includes explaining the risks of adopting a brand that cannot be protected in the worldwide market for the brand. The sooner a decision is made to change a brand because it cannot be registered, the better.

In addition to the mark clearance, a domain name should be selected that incorporates the mark or suggests the brand or the company to the consumer. Often the tech clients will have considered the online presence first before analyzing protection of a brand based on the domain name. The ownership of a domain does not automatically support trademark rights.<sup>5</sup> A coordinated approach to mark and domain presence presents a unified brand to the customers and industry.

## **BRAND PROTECTION AND VALUE THROUGH REGISTRATION**

How many times have you heard, “but I just want to be able to use the mark in the future”. Use of a mark without a registration is an ephemeral right. The best way to protect a mark in the U.S. is a registration on the principal register, although here is a fallback position to obtain a registration on the supplemental register that has less protection discussed below. A senior user of a mark without a registration faces the additional burden of presenting evidence of use of a mark throughout the U.S. to prevail in an infringement case to secure rights in a challenge to a junior user of the same or similar mark. Filing an application based on intent to use establishes preemptive national rights once the mark registers after use. 15 USC § 1057 (c). The pendency

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<sup>5</sup> Trademark Manual of Examining Procedure § 1215(a) (October 2013). (A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark, as depicted on the specimen, must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a website. *See In re Roberts*, 87 USPQ2d 1474, 1479 (TTAB 2008))

of an application based on intent to use can be extended at least three years thereby protecting the mark from use by third parties, allowing the applicant time for product development and approval. 15 USC § 1051 (d)(1). The value of a registration can be invaluable to protect other IP rights as explained below.

A federal registration puts the public on notice that the owner has national rights in a mark. 15 USC §§ 1072, 1111. In the U.S., only marks registered with the U.S. Patent and Trademark Office can use the “®” designation. 15 USC § 1111. A third party is liable for infringement if a mark is adopted that will likely be confused by the public with the registered mark. 15 USC § 1114.

A trademark registration lasts as long as the mark is in use in interstate commerce. 15 USC § 1059. If a trademark infringement lawsuit must be filed to enforce a mark, the federal registration on the Principal Register provides prima facie evidence of “the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate”. 15 USC § 1057 (b). Incontestable registrations that have been registered for more than five years and have not been challenged enjoy an even broader range of protection and may be cancelled only if the mark has become generic, abandoned or was procured or maintained by fraud. 15 USC §§ 1064 (3); 1065 (4). If no federal registration is obtained by a senior user protection is limited to geographic area of use in the U.S. So a third party who adopts the same or similar mark and receives a federal registration freezes the senior user to their area of actual use. *See Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1394 (3rd Cir. 1985).

A registration in the U.S. does not provide protection in any other country. In most countries the first to file a trademark application is entitled to exclusive use of the mark even if another party adopted the mark previously in the U.S. Contrary to the U.S., in most countries, use of a mark is not required to obtain a registration only to maintain a registration. Proof of use after three years of registration is typically required to maintain a registration if challenged. If countries outside the U.S. are important markets, a trademark filing program outside the U.S. must be considered to protect the market for a brand.

Often Newco spends considerable funds on patent filing programs and little or no money on trademark protection outside the U.S. If the product has potential outside the U.S., a marketing plan needs to be evaluated for brand protection. The potential countries where the product will likely be sold are the first avenue of inquiry. In the author’s experience there are several jurisdictions that are more challenging than others to receive a trademark registration. Australia, Singapore and Norway are strict in rejecting marks as descriptive, when in the US or other jurisdictions the marks are registerable and considered suggestive (not descriptive) of the goods/services. The Community Trademark Office (OHIM) has in the last year more carefully reviewed and rejected applications based on descriptiveness. The examiners review general Internet usage to determine if a word used in a mark is descriptive or not and this exposes the applicant to wide range of possible rejections. For instance, if a word in a mark for a diabetes test strip is “QUICK”, it could be rejected in the CTM even though “QUICK” is not at all descriptive of the product, but the OHIM will assume that the test is “quick” and refers to a quality of the product.

A budget for brand registration worldwide must be considered at the outset when the patent portfolio analysis is underway. The cost of protection of the brand is typically far less than the patent protection and can be used to protect company assets in addition to the brand.

## **LEVERAGE YOUR BRAND PROTECTION**

Implementing an aggressive brand use and protection plan can often protect more than just the association of the brand with the goods/services of the company. Creative content of the company and well as trade secrets and proprietary material that incorporates the brand can be helpful in preventing unauthorized use and distribution in the digital environment. The use of trade dress branding for products can also broadly protect the company IP.

Without a trademark registration it is difficult to enforce unauthorized use of a brand on the Internet. Ask Newco what the first goods/services to be sold in interstate commerce, and get a registration in the US as soon as possible. For instance, a company that is developing a drug or vaccine may have consulting services for these and a registration can be procured ahead of the sale any product that will be waylaid by a regulatory process. Any take down procedure will be vastly simpler if Newco can show the unauthorized use of a registered trademark. Often the jurisdiction of the registration does not matter; a registration from any country is evidence the ownership of a mark and may be useful for a take down. Most jurisdictions unlike the US do not require evidence of use to obtain a registration. One consideration may be obtaining a registration abroad in a target market first to protect a brand if interstate commerce is down the road. Of course, having more than one registration worldwide is even better evidence for a take down.

## **Domain Names**

Domain squatting was one of the first enforcement issues on the Internet and the procedure to protect the unauthorized use of a mark in a domain is well developed. Often a request made directly to the domain owner to remove the mark from the domain name is successful, and again having the registration is very helpful to support the request. If the domain owner is not responsive, review the IP policy of the internet service provider (ISP). Once you have made a request to the domain owner, if you can show ownership rights to the brand, the ISP may takedown the website because of unauthorized use of the mark in the domain name.

If these routes above are unsuccessful, unauthorized trademark use in a domain name by a third party in bad faith is protected through the World Intellectual Property Organization (WIPO) Uniform Dispute Resolution Procedure (UDRP) for top level domains such as “.com”. The owner of the mark must show bad faith and an unhonored request to take down the domain is typically precedes a UDRP complaint. A trademark registration is not specifically required, but it is, by far, the best evidence of rights to a mark. An unauthorized user must meet the following three requirements:

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

ICANN, *Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/dndr/udrp/policy.htm> (last visited Dec. 27, 2013) [hereinafter UDRP], § 4(a)(i)-(iii).

The country top level domains such as “.uk” do not have to comply with UDRP proceedings, but most top level domains have an intellectual property policy with compliance procedures to protect mark owners. Often the registration does not need to be in same country as the top level domain. In the US, the First Amendment protects gripe sites that include an unauthorized use of a mark such as the “suck” sites, but the cite content may use the mark in a more ambiguous way and a take down of the website content may be possible as explained below.

### **Social Media Handles**

The next generation of cybersquatting was the use of trademarks as social media handles. The explosion of Internet use and social media forces new enterprises developing brands to keep protection on the top of the list of marketing priorities. To put the issues in context, in 1987, there were 100,000 internet hosts and the “www” project was proposed. By 1998, network Solutions had registered its 2 millionth domain. In 1999, a forged BLOOMBERG® web page successfully promoted a pump and dump scheme and was among the first Internet hoaxes using a brand. Facebook was launched in 2004 and Twitter in 2006.

The social media companies will pull handles that misuse trademarks. For instance, a handle that includes a company name and/or brand used by a former disgruntled employee to mimic the company can be terminated. Unauthorized uses of a brand in this manner that are not classic trademark infringement are leveraged use of a trademark. Providing the registration of the mark that is being used as the social media handle or in a misleading manner in social media postings is always the best evidence of a claim. Social media sites have complaint procedures. Twitter has a site [www.twitter.com/safety](http://www.twitter.com/safety) for complaints. To file a complaint on FACEBOOK® you must use a direct entry through their website.

### **Use of Trademark with Copyright Infringement Claims**

The digital era has led to widespread copyright infringement. The inclusion of a registered trademark in works of original authorship is also helpful in the take down of the content infringing a copyright. Often the trademark owner has obtained a registration, but not gone to the trouble of either placing a copyright notice on the work or obtaining a registration in jurisdictions like the U.S. that have a copyright registration process.

If the trademark owner has a registration, a complaint can be made to the Internet Service Provider (“ISP”) regarding the unauthorized use of the trademark and the copyright infringement. Most ISPs have intellectual property policy statements on their websites and an

email address to send complaints. Providing the trademark registration to the ISP to support the rights of the mark holder is best evidence of unauthorized use, if the request has been made to the website owner without avail. The registered trademark can be used as leverage to take down not only the unauthorized trademark use, but also the content infringing copyright material.

The trademark owner should use its mark with the ® in copy especially in digital media for potential use against not only trademark infringement, but also copyright infringement.

### **Use of Trademark to Protect Trade Secrets**

The digital era has also led to increasing difficulty in protecting trade secrets and proprietary information. This material becomes accessible by an unauthorized party and is disseminated on website, the owner has a problem of drawing attention to the trade secret material even in a takedown situation. If a registered trademark is used in the documents that contain sensitive material, then a takedown can be requested based on the unauthorized use of a mark.

A registered trademark can be used as a watermark, header or footer of digital or paper copies on trade secret information including software code, customer information, processing steps for methods of making products, raw material sourcing or any other information that gives the client an economic benefit. A company should standardize the use of its brand on all pages of all documents that include original content or trade secret information. This procedure will facilitate the take down of the sensitive and/or infringing content. If the entire website is devoted to unauthorized activities by a third party, access to the website may be blocked by a request to the ISP. Many of the site owners use a privacy companies to shield their identity from the public, so the ISP is the only known entity to lodge a complaint. The ISP may rely on the evidence of the ownership of the mark used in the website as a basis for the takedown.

The danger of requesting enforcement of IP rights may result in the third party going offshore with the website to a jurisdiction with less interest in protecting IP rights. If a registered trademark is not in a posting of proprietary information so the unauthorized use of a registered trademark infringement allegation cannot be asserted, the ISP may request a subpoena to provide the identity of the site owner and not takedown the site based on lack of evidence of unauthorized use of IP. Also, using traditional investigative methods to locate a leak of a trade secret may be necessary.

### **SOCIAL MEDIA AND BRANDS**

The availability of social media by the owners and employees of Newco can be problematic to a brand if controls are not in place. The brand must have a consistent visual presentation with logo and color standard. Those posting company information need to use the brand as an adjective and not noun or a verb. With new products there is less of a chance of the mark becoming generic, but there is a danger of using the mark in a descriptive manner. More and more the trademark examiners are searching the Internet in support rejections that marks are descriptive and not protectable unless secondary meaning can be shown which usually take either five years

of use or a large ad budget to promote awareness of the mark. Typically neither alternative is available to Newco.

An example of a misfire using a known mark LEAN CUISINE® would be ad copy stating that “Our meals are cuisine that is lean”. Often a mark that can be categorized as suggestive of the goods/services will be undermined by its owner by using the words of the mark in advertising that are descriptive of the qualities of the product. If the trademark examiner finds this copy on the Internet that was posted by the owner and/or employee, this can be fatal to the registration. If the mark gets to publication, however, a third party can challenge the issuance of the registration based on lack of distinctiveness.

Descriptive marks can be registered on the supplemental register if they have been in use for at least one year and capable of distinguishing the trademark owner’s goods/services from those of others. 15 USC § 1091. The owner of a supplemental registration may use the ® designation, does not have the prima facie evidence benefits of a principal registration. (*See supra p. 4-5*).

The brand owner must control comparisons of the new product with existing product to avoid improper comparative advertising and Lanham Act and other claims from a competitor. Although puffing is allowed, head to head comparisons must be well documented to avoid claims.<sup>6</sup> Often the Newco wants to tout its advantages and would like to mention other brands in their advertising. This is dangerous territory and the IP specialist needs to provide guidance in proposed cooperative advertising and a caution to those with access to the company website to avoid specific product comparisons that do not have full testing back up for the data presented to the potential consumer.

Social media sites are also an avenue for posting by employees of information that is not proper for public distribution. This includes a variety any information about the financial status of the company, potential business deals and product development. The Newco must have a social media policy with its employees that prohibits or strictly limits the use of Newco name, mark and company information on public media.

The use of social media can lead to personal jurisdiction throughout the US. *In Wine Group LLC v. Levitation Management, LLC*, No. CIV.2:11-1704, 2011 WL 4738355 ( E.D.CA Oct. 6, 2011) an online ad campaign throughout the U.S. including interactive Facebook Fans supported personal jurisdiction. Lanham Act liability can be conferred by the use of misleading Facebook and website posting using a trademark. *Doctor’s Assocs., Inc. v. Subway.SY LLC*, 733 F. Supp. 2d 1083, 1089 (D. Minn. 2010) ( SUBWAY sandwich shop mark).

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<sup>6</sup> “Statements regarding general comparisons or declaring that one product is the best on the market are considered ‘puffery’ and is not actionable as false advertisement.” *Nikkal Indus., Ltd. v. Salton, Inc.*, 735 F.Supp. 1227, 1234 n. 3 (S.D.N.Y.1990); *Brignoli v. Balch Hardy and Scheinman, Inc.*, 645 F. Supp. 1201, 1209 (S.D.N.Y. 1986); *United States Healthcare, Inc. v. Blue Cross of Greater Phila.*, 898 F.2d 914, 926 (3d Cir. 1990). However, statements including specific and measurable aspects or references to test are not puffery and can lead to false advertising claims. *Castrol Inc. v. Pennzoil Co.*, 987 F. 2d 939, 946 (3d Cir. 1993).

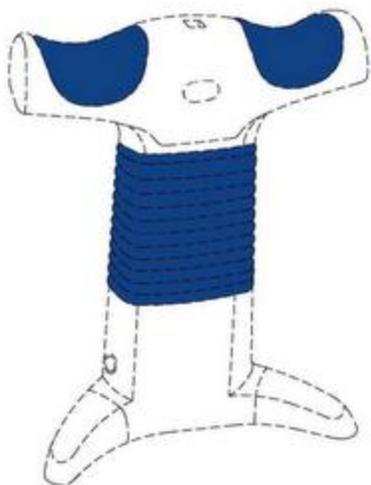
The use of social media sites by the owner of the mark can be very beneficial. Marketing specialists originally thought the Internet would drive consumers to the lowest priced product and brand value would decline. In fact, the Internet with social media and other sites has increased brand awareness and led to more price elasticity. The popularity and the demand for a product have been boosted by social media through recommendations of Facebook friends, Twitter and websites with product ratings by consumers and other sites. There is more price elasticity post-Internet than before. And the larger circle of personal acquaintances we have through social media who may mention a particular new brand of phone, app or other product has increased. So the consumer's awareness of brands has increased.

If Newco is selling a tech service communication it is even more important, because there is no actual product to place literally in the hands of the customer. Having a protectable and catchy brand spread through the Internet by the mark owner in the appropriate channels will increase the customer base.

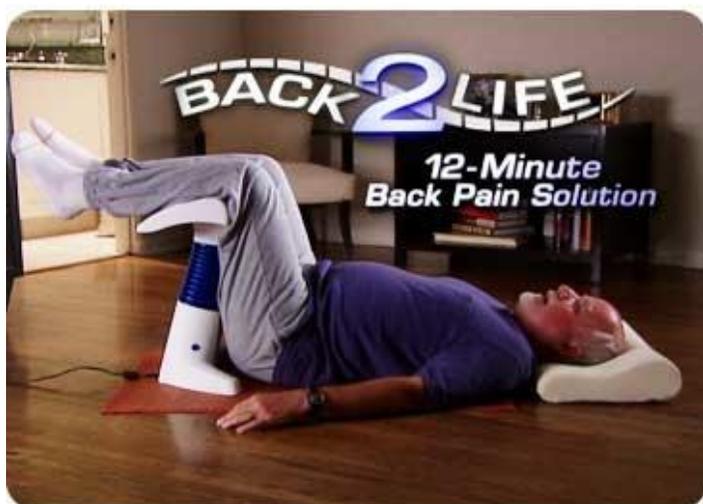
## **BRANDING THROUGH TRADE DRESS**

Product or packaging features that are not functional can be part of a branding program and protected by common law and federal trademark registrations. Any branding program for a product should include consideration of the use of eye catching shapes for product design and color. For a new product the trade dress needs to be inherently distinctive so protection does not rely on secondary meaning that is acquired through years of use leading to customer recognition. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). The use of the same colors in word mark or logo with the product will reinforce the brand identity in the consumer's mind.

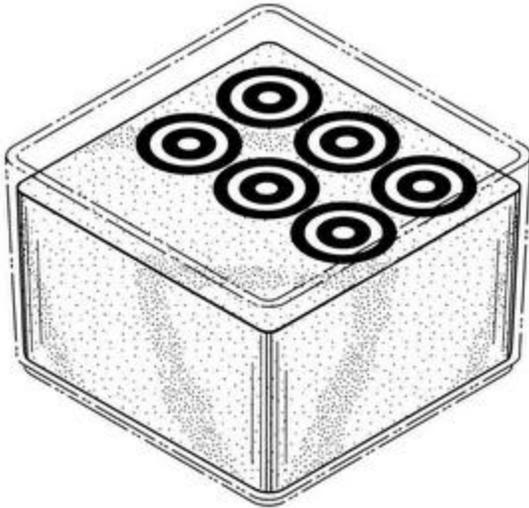
One example of product branding is Registration No. 3,844,089 obtained by Back in Five, LLC with use of the color combination blue and white with a device to relieve back pain. The mark is described "the color combination of white and blue as applied to the entire surface of a medical device for relief of back pain comprising a generally T-shaped body, wherein a lower portion is white, a central portion is entirely blue, and the upper portion comprising the crossing arm of the "T" is white having two discreet islands of blue symmetrically placed on the arm. The dotted outline showing the goods is intended to show the position of the color combination on the goods and neither the broken lines nor the configuration of the goods is claimed as a feature of the mark."



An ad for the device is shown below:



Another illustration of product design features that do not include color is Registration No. 3,084,483 owned by Merit Medical Systems, Inc. for a container holding needles for medical use.



The mark consists of a “configuration of a container for holding medical devices, namely, needles and other sharp objects, and a plurality of target designs printed on the upper surface of the container. The matter in dotted lines is not claimed as features of the mark, but shows the mark's position on the goods.”

The most talked about branding through trade dress are the Apple iPod and iPhone “look” that led to an initial \$1 Billion dollar infringement award against Samsung. The drawing from Registration No. 3,457,218 is reproduced below and the description of the mark is “... the configuration of a rectangular handheld mobile digital electronic device with rounded corners.” The matter shown in broken lines is not part of the mark. The registration is subject to a cancellation action that is on suspension pending resolution of the civil actions. The drawing from the registration and the actual product are shown below.



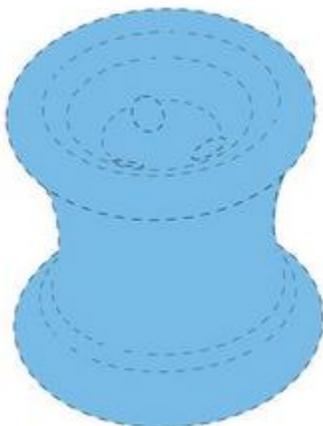
Drawing from Registration No. 3,457,218



Apple iPhone

The registration was obtained based on acquired distinctiveness that consumers in the market place recognized the shape of the product as originating from Apple. But this is an illustration of the breadth of trade dress protection that should not be overlooked.

If the design does not have acquired distinctiveness, a supplemental registration may be obtained if the trade dress can be shown to distinguish from goods of other parties. (*See supra p. 4-5*). An upgrade to the principal register can be requested after the mark has acquired distinctiveness and the benchmark five years of use in commerce and customer promotion. For products with a long life cycle a supplemental registration may be worth consideration. The following supplemental registration for the color blue for surgical ports for accessing the body during surgery is owned by Covidien LP.



When considering what trade dress to protect, your client must avoid functional features. Purely utilitarian features for products or product packaging when no alternatives are available to

competitors cannot be protected trade dress including colors that are specific for particular products such as orange or bright yellow for safety products or the color that is natural by-product of a manufacturing process. The following are factors to consider:

1. Do not choose a feature that was covered by a utility patent or claimed to be useful in a utility patent application.
2. Do not choose a feature that is advertised as useful in marketing materials such as the shape of a tool that is easier to grip.
3. Do review alternative designs available to competitors.
4. Evaluate if the feature chosen to protect is cheaper or easier to manufacture than the alternatives. If so, the feature may be functional and incapable of trademark protection.

A branding program that includes trade dress protection for product design will create a memorable look for Newco's consumers. A consistent color theme with the word mark and logo will provide greater impact for market recognition.

## **SUMMING UP**

The coolest branding strategy for the Newco on the block is one that takes the consumer into consideration first. Choose a protectable brand and/or a catch phrase that is going to convey the core benefits of the product. The new technology alone will not sell the product.

Obtain a U.S. registration. Evaluate the worldwide protection of the brand to be sure registration rights are available outside the U.S. Leverage the potential protection of the brand by using the registered mark with the ® liberally on internal and external company and marketing material. Using the mark extensively increases the possibility that Newco's brand will be in any content copied by a third party and the unauthorized use of the mark can be a basis for a takedown on the Internet.

Newco must enforce the consistent use of the brand in all media. Newco should have a strict social advertising media policy for employees so the strength of the mark is not inadvertently undermined by friendly fire.

Consider non-traditional branding including product design and packaging. Consistent color use for the mark and the product color will present a unified brand identity to the marketplace.

Lastly, consider consulting a branding expert or material to vet Newco's customer and market approach. It's not just about legal protection, but selling the product.