

No Lame Names!

HOW TO BUILD CREATIVE
BRANDS AND STRONG
TRADEMARKS FOR YOUR
NEW BUSINESS, PRODUCT,
OR SERVICE LAUNCH

KEVIN E. HOUCHIN, ESQ.



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Wooden Pencil, LLC,
201 South College Ave
Suite 205
Fort Collins, Colorado 80524
USA

or email: kevin.houchin@woodenpencil.com.

| | |
|--|----|
| Motivation..... | I |
| Creating Choices: Brainstorming | 3 |
| The Nine Emotional Strategies | 3 |
| The Creative Process of Naming | 6 |
| Evaluating Options | 11 |
| Trademark Law Gets Into the Mix | 11 |
| Trademark Strength v. Marketing Budget | 13 |
| Making the Final Choice..... | 14 |
| Suggestive Choices | 14 |
| Arbitrary or Fanciful Choices | 14 |
| Availability Research..... | 15 |
| Trademark Infringement Considerations..... | 17 |
| Next Steps | 20 |
| Register the Domain Names | 21 |
| File “Intent to Use” Trademark Applications..... | 21 |
| Ask Around: Market Research..... | 21 |
| Decide And Commit | 22 |
| Start Using the Mark in Commerce | 22 |
| Afterword..... | 23 |
| About the Author | 24 |

IMPORTANT MESSAGE:

This product provides information and general advice about the law. However, laws and procedures change often and people interpret them differently. This book is not offering specific advice about your situation. For specific advice about your specific circumstance, consult an expert. No book, software, or other published material is a substitute for the advice you will receive by hiring a competent attorney, licensed in your state capable of analyzing your specific situation.

Motivation

Before going to law school I was a graphic designer. I wasn't one of those people who would just buy a Mac and some software from Adobe and then call myself a designer. I spent 4 years at a top university and have a Bachelor of Fine Art in Graphic Design. I started my career in the design department of a Fortune 500 company and then built an Art Department in a small advertising agency. Next, I built my own design studio, worked as Vice President of Marketing and Internet for a retail software company, and finally provided large-scale branding and communications consulting for colleges and universities all across the United States.

I've designed dozens of logos and branding systems and supervised the design and implementation of dozens more.

The hardest part of those jobs: lame names.

Can you imagine how hard it is to design a great brand around a lame name? I'm sure you can. It may be the reason you bought and are reading this book. (Thanks for that, by the way!)

I went to law school because I always wanted a doctoral level degree and I thought I could help creative people start businesses and leverage their ideas through copyright and trademark. My fine art background precludes me from taking the Patent Bar Exam. While I am unable to help people secure their patents personally, I can still help them leverage their inventiveness. I do this by helping them brand, package, license, and protect their inventions (I've hired a patent associate to help clients secure patents).

Now I spend much of my time with people who want to start new businesses or launch new products and services. Our discussions often start because they've heard I can help them register their trademarks. That's a great start.

However, I've noticed that every trademark discussion I get into turns quickly into a brand strategy discussion, because the interplay between branding and trademark law is critical to business success.

Now, after more than 15 years of working with new company, product, and service launches from both the creative and legal perspectives, I still face one big hurdle.

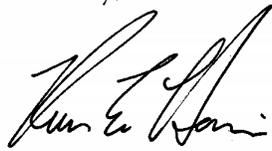
The lame name...

This book walks you through the discussions I have with my clients, which I usually charge at least \$175 an hour for by the way. If you follow the steps in this book you will develop a name for your new company, product or service that will be both MARKETABLE and PROTECTABLE. It's not easy, it can be frustrating, but the right name is the hub of your brand and few businesses or products will succeed in today's market without a great name. A great name is as important, if not more important initially, than enough capitalization.

Think about that.

Now let's begin.

Sincerely,

A handwritten signature in black ink, appearing to read 'Kevin E. Houchin'.

Kevin E. Houchin, Esq.

Creating Choices: Brainstorming

As in all creative engagements, the first idea is almost never the best idea. Usually your first idea is simply your subconscious reminding you of something you've seen or heard before. In the words of Jim Morrison and The Doors, you need to, "Break on through to the other side."

The goal is to come up with a name that:

1. Evokes positive emotions in your probable buyer,
2. Suggests what you do,
3. Connects your product or service with those emotions, and
4. Oh ya—completes those three tasks better than anyone else.

The Nine Emotional Strategies

My friend and client Mark Bodnarcczuk, Executive Director of The Breckenridge Institute (www.breckenridgeinstitute.com), has done extensive research into personality type and organizational culture. Mark bases his work largely on the Enneagram, which has allowed Mark to identify 9 "Strategies."

The Strategies are nine distinct patterns of interacting with our world. They are the way we go about interacting with others and satisfying the needs and wants of daily life. The strategies are at the heart of what many consider "personality type."

In naming your company, product, or service, you want to match your naming system to the strategies that you believe drive as many of your potential customers as possible.

The Nine Strategies are listed below for your reference.

1. Striving to be Perfect: the desire to be flawless, good, and to feel that everything is right with you and the world.
2. Striving to be Connected: the desire to feel appreciated and to feel deeply united with others and with your own feelings.
3. Striving to be Outstanding: the desire to stand out as an exemplary

member of the group and to feel valuable, successful, and skillful.

4. Striving to be Unique: the desire to be different, autonomous, creative, and to feel understood and appreciated for your special qualities.
5. Striving to be Detached: the desire to be autonomous, independent, and able to find serenity with your own thoughts.
6. Striving to be Secure: the desire to feel safe and to become part of a group, cause, or philosophy, and to trust others and your own judgment.
7. Striving to be Excited: the desire to feel stimulated, happy, and enthusiastic, have fun, and inspire others.
8. Striving to be Powerful: the desire to be strong, take action, and be able to express your will, influence, and vitality.
9. Striving to be Peaceful: the desire to be in harmony with your world, other people, and your own thoughts, and to feel calm and relaxed.

You can take the assessment yourself to find your own personal strategy for a minimal fee at <http://www.sikoraspi.com/>.

What people buy your goods and services? It makes a huge difference.

The name for snowboards shouldn't be similar to the name for herbal tea, because the EMOTIONS and STRATEGIES the buyer needs to fulfill are vastly different.

What do you think are the 2 or 3 Strategies from Mark's list that are driving your customers?

List them here:

1. _____
2. _____
3. _____

As your business grows or project progresses, you will want to confirm these assumptions during the normal course of your business by ASKING PEOPLE through surveys, emails and good-ol' customer service. But for now, you are the best person to answer the question because right now these are your GOALS, not necessarily your realities.

I'm a firm believer that your goals BECOME your realities, so I'm betting that if you identify this kind of customer, you'll attract this customer, and that your market research will simply confirm what you already know.

The Creative Process of Naming

Don't tell me you can't be creative. You can; and you already are; but if you're willing to get better, I'll show you how.

STEP I: LIST YOUR PROSPECTIVE CUSTOMERS' KEY EMOTIONS.

STEP 2: EMOTIONAL SYNONYMS

Now let's have some more fun. Let's start breaking those emotions down. Pick the top 5 emotions from your list in Step 1. Write them here, not in any particular order. Our goal is to move quickly here.

1. _____

2. _____

3. _____

4. _____

5. _____

Now for each of those, write down 5 words that mean roughly the same thing, the opposite or just remind you of the word itself.

1a. _____

1b. _____

1c. _____

1d. _____

1e. _____

2a. _____

2b. _____

2c. _____

2d. _____

2e. _____

3a. _____

3b. _____

3c. _____

3d. _____

3e. _____

4a. _____

4b. _____

4c. _____

4d. _____

4e. _____

5a. _____

5b. _____

5c. _____

5d. _____

5e. _____

Now we have another 25 ideas to consider. If you did that for all 30 emotions you listed initially, you would have produced 150 potential naming elements for your new venture.

Evaluating Options

Trademark Law Gets Into the Mix

Before you can start making some smart naming choices, you need to understand a little about trademark law. Don't worry I'll do my best not to bore you to sleep.

Trademarks and branding go hand-in-hand. In fact it is the "mark" that used to be and still is literally "branded" onto some commodities like barrels of bourbon and wine or on cattle.

Brands, and trademarks, suggest the source of goods or services in commerce. It's that simple.

Your trademark is anything that points to you as the source of those goods or services in commerce. These may include:

- The name, like "Coke" or "Pepsi;"
- The logo graphic such as Nike's swoosh;
- A Color or set of colors like "John Deere Green," "Windex Blue," or "University of Michigan Blue and Gold;"
- A Sound like the Windows start-up tones or the Intel tones; or
- A Fragrance, such as Chanel No. 5.

You get the idea.

Our focus is naming. In trademark law, names come in 4 varieties:

GENERIC NAMES

A "generic mark" is the common, descriptive name of the product or service, like "beer," or "bread." Nobody gets to keep others from using these words, so they are effectively not trademarks at all and the trademark office won't let you register a generic word as your trademark. Why would you even want to?

DESCRIPTIVE NAMES

A mark may be "merely descriptive" and thus INVALID as a trademark if:

- It serves to describe the product or service it identifies,
- It describes the geographical location from which the goods or services emanate, or
- It mainly uses a person's last name.

A merely descriptive mark can eventually gain trademark status after enough exposure in the market to gain "secondary meaning," but that's a topic beyond the scope of this book.

SUGGESTIVE NAMES

This is where you want to be.

Suggestive marks **INDIRECTLY** describe the product or service they identify. They need some engagement of mental processes by the consumer to associate the trademark with the product or service and then with you as the source of that good or service.

I have a marketing firm called "Wooden Pencil" – this is a great example of a "suggestive" trademark because for marketing services, it "suggests" writing and creativity. If I sold actual wooden pencils, the name would be merely descriptive, and thus invalid as a trademark, because everyone who sells wooden pencils needs to be able to use those words to describe their products.

I'm planning to create a publishing company, and I think Wooden Pencil will make a great name for a publishing company too.

Another great example is "Crocs" for non-slip shoes, because "Crocs" suggests teeth, and therefore traction.

ARBITRARY AND FANCIFUL NAMES

Arbitrary marks are regular, sometimes everyday words that have nothing at all to do with the products and services they represent, like "Apple" for computers or, "Virgin" for an airline.

Fanciful marks are words you just make up, like "Xerox," "Protonix," or "Lunestra." The pharmaceutical industry seems especially fond of fanciful names for products.

Trademark Strength v. Marketing Budget

Associating your brand with the product and your company takes money. It takes more money and large-scale marketing to create that mental and emotional association with an arbitrary or fanciful mark than it does with a suggestive mark.

Personally, as a designer and a businessperson, I also think suggestive marks lend themselves to better marketing because there is an inherent, subconscious and emotional tie that exists between the mark and the product or service at the start – or there would be no suggestion.

Recognizing and running with this emotional tie creates stronger marketing ideas from day 1, which will:

1. Save you money in the creative process.
2. Save you time getting your product or service to market.
3. Make your marketing efforts more memorable and emotional, which will guarantee higher effectiveness.

In my opinion, suggestive marks therefore offer a better return on investment than Arbitrary or Fanciful marks, especially for smaller businesses.

Now it's time to bring everything back together and get practical about which name you will settle on as the best choice.

We're in the homestretch now.

Making the Final Choice

Suggestive Choices

List all your favorite choices from page 8 that you think “suggest” your product or service.

| | | |
|-------|-------|-------|
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |

Arbitrary or Fanciful Choices

Now list all your favorite choices from page 8 that you think might be “arbitrary” or “fanciful” for your product or service.

| | | |
|-------|-------|-------|
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |
| _____ | _____ | _____ |

Some of your choices might seem like they would fit in either place, don't worry about that now; just get them down.

Availability Research

Finally, pick your top ten potential names and let's do some research in 5 different areas to complete the following chart.

THE KEY QUESTIONS WE'LL ASK:

1. Is the .com domain name available?
2. Is someone else using the name for anything close to my product or service?
3. Is anyone else using something that sounds confusingly similar to my name for anything close to my product or service?
4. Has anyone registered, or filed a registration application, on the same or a similar name?
5. Is the name available as a company name in my state?

| Potential Name | .com available | other user | other use | USPTO available | SOS available |
|----------------|----------------|------------|-----------|-----------------|---------------|
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Checking to see if the .com domain name is available is easy. I usually go to www.godaddy.com and see if I can buy the name. If it's available when you search, register it - NOW.

If the name isn't available, I like to check who owns the site, first by just typing it into my browser to see if a corporate name comes up. I also check <http://www.networksolutions.com/whois/index.jsp> to see who officially registered the domain name.

If someone is using a domain name that matches your potential name for anything even remotely similar to the good or service you have planned, cross the name off your list and move on... no matter how much you love the name.

Now is the time to give up on that name, rather than after you've invested a lot of time, money and emotion into creating a logo, stationery system, brochures, website, advertising system etc. and must throw all that out and start over after receiving a cease and desist letter from a trademark attorney like me.

Assuming the domain name you're hoping for is available, we still want to do some checking. Often the exact string of letters you searched as the potential .com domain name will be available, but just a letter or two off something that could get you in trouble. For instance, you may have searched "woodenpencils.com" for your marketing firm, which may be available, but would still infringe on my, "Wooden Pencil" trademark rights.

This works both ways; you can't avoid a trademark infringement claim by changing a couple letters in your domain name or company name.

Don't think that just because the domain name is available that you are home free. It's a good start, but that's it.

So, the next step is to type your proposed domain name into a general Google search. Dig deep. Odds are, if someone is using your proposed name for a similar good or service, you'll find it on the Net.

Remember that it's in your best interest to be diligent in this search, or risk wasting all your investment in the name somewhere down the road.

It's important to keep in mind the test for trademark infringement is NOT an exact match on the name or logo; a trademark infringement is some use in commerce that would:

Cause a notable number of consumers to become confused about the source of the goods or services, thinking that they came from or are affiliated with or backed or sponsored by the senior user of the mark.

Even if you think it's obvious that you and not the "senior" user (the first person or company to use the mark in commerce) are the source of the goods or services, you may still face problems if consumers become confused. Why? Because it looks like your products and services are even just somehow affiliated with, endorsed, or sponsored by the senior user of the mark.

In today's world of licensed sports apparel and movie merchandising these words have power.

Courts consider a relatively large number of reasons to decide whether your mark would be likely to confuse consumers. You'd be smart to consider the same reasons when deciding to move forward with a name.

Trademark Infringement Considerations

1. Similarity in appearance,
2. Similarity in sound,
3. Similarity in the mental image the marks evoke,
4. Similarity of buyers,
5. Similarity of marketing channels,
6. The sophistication of prospective buyers,
7. The cost of the goods or services,
8. Evidence of confusion,
9. The manner of presenting the mark,
10. The strength of the mark,
11. Similarity of the parties products or services,
12. The alleged infringer's good faith (or lack of good faith), and
13. The alleged infringer's interest in entering the senior user's market with the mark.

Also note that courts DO NOT assume consumers would be able to make a side-by-side comparison, and that any disclaimer would have to be EFFECTIVE, not just present.

So, now you better head back to Google and start searching on:

1. Synonyms of your name;
2. Things that sound the same – different spellings; and
3. Other terms that might, "Evoke a similar mental image."

Use your common sense on this. If there is any question in your mind, move on down your list of names. If you can't find something that scares you, you're probably in the clear.

There is no way to eliminate all risk.

However, you can sleep easier knowing that by doing this exercise, you are showing your "good faith" if you ever did have to defend yourself, so keep this paperwork!

Now that you've done your due diligence searching the Web for possible senior users of your mark, it's time to check just a few more places. The next Web site to search is the registration database of trademarks at the United States Patent and Trademark Office (USPTO).

"Crap! Another place to check! Houchin, I'm tired of checking! – Let's get started..." you exclaim. Well, just think that thanks to the Web, you can now do this work yourself, from your desk, in just a few hours. Before the Web you would have needed to hire a "search firm" in Washington DC to go and physically check things out for you. That is, if you wanted even half the peace of mind you can get today by just typing in www.uspto.gov into your Web browser.

When you get to the USPTO website, select "Trademarks," and then "Search." Again, search for your exact mark, sound-alike words, synonyms, and alternate spellings. It's rare that you will find something in this database that you didn't find in your Google searches, but it could happen. Also note the contents of the USPTO database do NOT come up in Google searches (at least during this writing), so you have to check both places.

The final place you'll want to check is the business database of your Secretary of State. Most states have placed their business listing records on line. Again, you completed your heavy lifting early in this process when you did the general Web searches, so the odds are small that you'll find a conflict on your SOS website.

Whew!

That's a lot of work.

Now go back and work down your list until you have at least three potential names that have cleared these hurdles.

Really, go back.

I'm serious, go back.

OK, at least go back and do the work until you have at least one more GREAT alternative. You need to have a couple choices to discuss before you move on to the next steps.

Next Steps

CONGRATULATIONS!

You now have at least two rock-solid, emotion-evoking, clever and suggestive names identified for your new product or service.

NO LAME NAMES GET PAST HERE!!!!

NO LAME NAMES FOR YOU!!!!

You're already in better shape than at least 80% of the companies out there. Yes, that statistic is a wild-ass guess on my part, based only on my experience and some intuitive jumps. Although, if someone did empirical studies on this exact topic, I'm betting that percentage would be on the low side.

I bet the percentage of successful launches for companies that have focused on the creative and trademark issues of naming before launching products or services is far higher than those who have not.

I can support my assumption with some related statistics from the book, *Blue Ocean Strategy* by W. Chan Kim, and Renée Mauborgne (ISBN: 978-1-59139-619-2). This book discusses a business strategy of making competition irrelevant because you're doing something NEW.

The authors studied 108 companies and found that 86 percent of all new product and service launches were line extensions (not big naming projects usually), accounting for only 62 percent of total revenues and a "mere 39 percent" of total profits.

The remaining 14 percent of product or service launches were aimed at creating "blue oceans" (which logically suggests some attention to creating a naming and branding strategy). These launches produced 38 percent of total revenues and 61 percent of total profits.

Granted, some of those launches could have succeeded even with a lame name, but I believe people and companies do much better with great branding strategies.

So, what now?

Register the Domain Names

First, register both .com domain names. You can do that with several services such as www.godaddy.com or have your Web developer handle it for you.

File “Intent to Use” Trademark Applications

Second, file an “intent to use” trademark application on the names as a wordmark in at least your primary classification of business. This will cost you a filing fee of \$275-325 plus legal fees if you hire a lawyer to file the application for you. I strongly suggest hiring a lawyer to help you because the USPTO often rejects applications a few times for various reasons and will send “office actions” you need to work through to secure registration. Your trademark lawyer knows how to handle these and can do so efficiently, while it’ll take you several hours of frustration to get through.

After you’ve started using one of the marks in commerce, you’ll have to go back to the trademark office and file an “allegation of actual use” before they’ll issue the registration. You’ll simply abandon the other registration if or when you decide not to use it. Yes, you might think this is throwing away some money, but it’s best to have both names on record at the USPTO and in process before going on to the next step, market research.

Ask Around: Market Research

Third, ask people what they think about the names. You can hire research firms, or do this yourself. I would ask at least a few prospective customers, your advertising-partner, and your graphic designer what they think will work best. You can do this informally, or through a more formal process of focus groups and questionnaires, depending on how risk averse you are, or how confident you are in your gut feeling.

Hopefully, the two or three choices you've vetted are all WONDERFUL, so the only indecision you're having is which great name to invest in. In that case, let your customers help you make the final choice. It's always good to let the creative team give input too, because some ideas are less expensive to impose than others.

The final point to remember is to NEVER let anyone talk you into doing something that doesn't "feel" right. In my experience, focus groups NEVER understand something truly new and different and sometimes market research can result in mediocrity instead of WOW!

You want WOW!

Now decide. Commit. Be "ALL-IN."

Decide And Commit

With all your creative work, due diligence, and market research backing you up, go back to the emotional list and personality strategies. Does one of the names sing to you in the tune of one or more of those strategies? If so, that's your choice. Go with it. Commit to making it a household name.

Start Using the Mark in Commerce

Trademark rights don't attach until you start using the mark as an indicator of source for your goods or services. So, start using the mark as soon as possible. You'll want to use the "TM" symbol next to the mark until your registration comes through.

Afterword

We've reached the end of the naming process, but you've only begun the process of marketing and branding your new product.

You'll now need to start thinking about:

1. Emotional Themes & Concepts: but you did much of that work early in the naming process, now you just need to reconnect your final name with the emotions you listed earlier.
2. Editorial Themes & Concepts: you need to translate those emotions into your tagline, "elevator speech," and descriptive paragraph. You'll want to create a list of talking points that you hit repeatedly in your different messaging.
3. Visual Themes and Concepts: an image is worth 1,000 words. You need to get a consistent visual "look" that works in any media.

All these points are discussed in my book "Kissing Toads: How to Market Your Left-Brain Products to Right-Brain People."

About the Author

Kevin E. Houchin, Esq.
Principal Creative and Attorney
Houchin & Associates, PLLC

Kevin is an attorney, designer, artist, counselor, speaker, author, husband, and father. He received his Bachelor of Fine Art in Graphic Design from Iowa State University in 1990. From 1990 until starting law school in 2001 he worked in the creative industry as a designer, art director, creative director, account executive, marketing vice president, and consultant. He has managed dozens of product and service launches for projects in the transportation, health care, sporting goods, retail, higher education, financial services, and high tech industries.

Kevin received his JD from The University of Iowa College of Law in 2003. His studies in law school focused on copyright, trademark, and business development. He is licensed in Iowa and in Colorado and is an active member of Colorado Lawyers for the Arts, presenting educational programs and providing pro bono legal services for artists in Northern Colorado.

Kevin lives in Fort Collins, with his wife and 3 young children.

Kevin E. Houchin, Esq.
Helping Creative People & Businesses

<http://www.houchinlaw.com>
<http://www.spacebetweencenter.org>
<http://www.sitecompliant.com>

Houchin & Associates, P.C.
201 South College • Suite 200
Fort Collins, CO 80524
Office: 970.493.1070
Cell: 970.214.6808
Fax: 888.524.8248

Author: *Fuel the Spark: 5 Guiding Values for Success in Law & Life*
Twitter: <http://www.twitter.com/kevinhouchin>
LinkedIn: <http://www.linkedin.com/in/kevinhouchin>
Facebook: <http://www.facebook.com/kevinhouchin>
Facebook Fan: <http://www.facebook.com/spacebetweencenter>