



Practitioners' Checklists

TRADEMARK CREATION

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A helpful training and management tool, *Practitioners' Checklists* cover procedures for performing particular tasks or functions and illustrate the order in which relevant actions and other steps should be taken. As a valuable asset in the legal practice setting, this series of Checklists can help ensure that critical considerations are not forgotten and that myriad detail is managed in a focused and efficient manner.

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Trademark Creation

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This checklist organizes the major steps in the trademark creation process, addressing both business and legal points of view.

A. Assemble the Branding and Trademark Clearance Team

1. Check off below all who need to be in the room:

Product development

Marketing

Advertising

Legal

In-house

Outside

Website Design

Domain Name Management

Finance

International Business Representatives

B. Scope of the Brand

1. Check off all intended purposes of the trademark:

Company name

House mark

Lead product

Secondary product/product line extension

Product feature/ingredient

Product accessory

2. Lifespan: how long is the mark likely to be used?

3. Geography: where is the mark likely to be used?

C. Consider Positioning

1. Where does this brand fit in the market?

Define the target customers.

Define the anticipated channels of trade.

Define the “personality” of the brand.

2. Check off all consumer needs and desires the brand will serve:

Prestige

Value

Credibility

Comfort

Safety

Health

Other

3. List characteristics of the new brand that serve these needs and desires better than others in the market:

Design

Quality/Safety

Ease of use

Price

Other

4. List facts that substantiate claims.

D. Consider Distinctiveness

Market: stands out in the crowd

Legal: inherently distinctive (fanciful, arbitrary, suggestive) v. merely descriptive

Regulatory considerations: do any special regulations apply to selection or use of marks for the proposed goods/services?

E. Brainstorm

1. Generate a list of ideas for proposed marks

- Existing words
- Made-up words
- Names
- Slogans
- Design elements, fonts
- Colors
- Sounds
- 3-D

F. Winnow

1. Refine list of “contenders.”

Eliminate ideas that don’t support the desired positioning.

Compare to competitors’ marks.

Search Google, Facebook, other social media to survey other possible users/uses/connotations.

Research possible meanings in other languages.

Determine availability of relevant domain names.

Conduct preliminary trademark clearance of leading three to five contenders (see “Trademark Clearance Checklist”).

2. Evaluate findings.

3. Choose mark.

G. Registration Strategy

1. For trademark applications, consider:

Format of mark

Standard characters

Design only

Combined word and design marks

Non-traditional

Jurisdictions

Proposed goods and services

Bases for registration

Proposed use

Use

Priority or seniority

2. For domain names, check off all that may apply below:

Global Top Level Domains

.com

.net

.org

.edu

Custom gTLD

Others

Regional or Country code domains

Variations of the name

Translations and transliterations of the name

Non-ASCII character versions of the name

3. For company names, check off all that may apply below:

Country, province, state of incorporation

Regulations concerning names, such as requirements to include “Inc.” or “Co.”

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