



CARSWELL WEBINAR SERIES

How to Select and Protect a Great Brand Name

October 3, 2013

John Torella – J.C. Williams Group

John S. McKeown – Goldman Sloan Nash & Haber LLP

Moderator: Dr. Ruth M. Corbin – CorbinPartners Inc., and
Osgoode Hall Law School

J.C. WILLIAMS GROUP

GLOBAL RETAIL ADVISORS



GOLDMAN SLOAN NASH & HABER LLP
BARRISTERS & SOLICITORS

dedicated to your success



THOMSON REUTERS

J.C. WILLIAMS GROUP

GLOBAL RETAIL ADVISORS

BRANDS and the Process of Branding

John Torella – J.C. Williams Group



THOMSON REUTERS

Purpose

- Information, ideas, insights
- Dynamic, evolutionary world of brands and the process of branding

Objective

- Another point-of-view
- Holistic perspective
- Practical, useful
- Issues/opportunities
- Selecting/protecting Brands

Outline

- Brand name guidelines
- Concept of Brands
- Process
- Deliverables
- Measurements
- Future

Brand Name Guidelines

- Distinguishing the Brand and the business it's in:
 - Toys 'R' Us
 - Bass Pro Shops
 - Drugstore.com
- Say something positive:
 - Jiffy Lube
 - Best Buy
 - President's Choice
- Avoid acronyms

-
- Careful with real people:
 - Harry Rosen
 - Armani
 - Charles Schwab
 - Upbeat and cheerful vs. bland
 - Simple is best
 - Name and symbols are better than just name:
 - Prudential and the rock
 - McDonalds and golden arches
 - Apple
 - Flexibility to work in multiple channels

Tagline/Positioning Line/Symbols/Slogans

- Tagline: description of business
 - Ace Hardware
- Positioning Line: Brand promise
 - Target Expect More. Pay Less
- Symbols: effective way to paint a picture
 - Maytag repairman
 - Michelin man
 - Energizer bunny

Avoid

- Double meanings
- Unpronounceable
- Too close to existing name
- Obvious legal complications
- Contradictions of positioning
- Clichés

Branding Mishaps

- Chevy Nova: in Spanish “it doesn’t go”
- Clairol Mist Stick: mist is slang for manure in German

Not the Rules; Break the Rules

- Häagen-Dazs
- Yahoo
- Snickers

Concept of Brands

- Name, logo, symbol, sound
- Differentiates one product from another
- All Brands are products/services/stores/websites
- But not all are Brands

Brands

- Add value
- Emotional connection
- Sub-conscious relationship
- Distinct personality
- Idea/word
- DNA

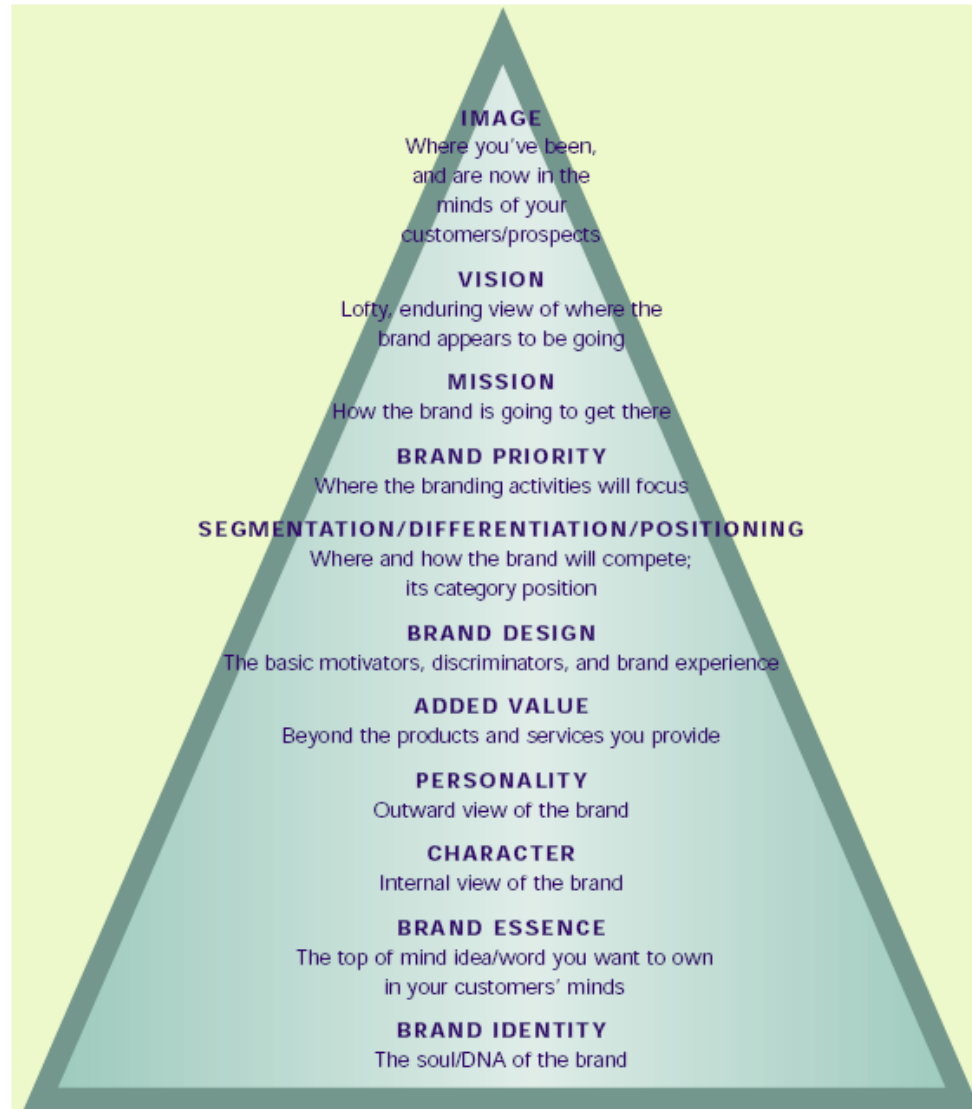
Process – Art, Science, Craft

- Creative/research base
- Rational/emotional
- Style and substance
- Logic and magic

Steps to Success

- Current image
- Future vision
- Mission
- Priority
- Segmentation/Differentiation/Positioning
- Brand design
- Added value
- Personality
- Character
- Essence
- Identity/DNA

Brand Pyramid



Deliverables

- Strategic direction
- Executional road map
- Compass
- Set of guardrails
- Total alignment

Measurements

- Top of mind awareness
- Superior brand attributes
- Own idea/word
- Loyalty and advocacy
- Intent to purchase
- Willingness to recommend

Future

- Grow in importance
- In new digital world
- Move from 4Ps to total experience
- Biggest and best are coming
- Only mighty will survive

Thank you and keep in touch



J.C. WILLIAMS GROUP

Global Retail Advisors

Toronto • Chicago • Montreal

www.jcwg.com

416-921-4181

John Torella

jtorella@jcwg.com



dedicated to your success

How to Select and Protect a Great Brand Name

John McKeown,
Specialist in IP Law (Trade mark/Copyright)
Goldman Sloan Nash & Haber LLP

mckeown@gsnh.com | 416-597-3371



@mckeown15



John McKeown



@GSNH_Law

www.gsnh.com



THOMSON REUTERS

Introduction

- In order to influence the decision making process a brand name should symbolize the image and values desired to be associated with the brand.

Introduction

- A brand name must distinguish the brand owner's goods or services from those of its competitors.

Introduction

- A brand name may also be presented in connection with a design component or logo. The design may become a symbol which represents the brand.



Desirable Brand Name Characteristics

- Any proposed name should have the following desirable characteristics:
 - (i) Brevity. A brand name should be simple and easy to understand.

COCA COLA[®] becomes COKE[®]

Desirable Brand Name Characteristics

- (ii) Easily remembered. Consumers have limited time and energy to devote to brand names. They are faced with a multitude of product choices. It is advantageous to choose a brand which is memorable and distinctive.



Desirable Brand Name Characteristics

- (iii) Easily readable and pronounceable.

ABARTH® for Fiat automobiles is not everyone's idea of a great mark

Desirable Brand Name Characteristics

- (iv) Be meaningful. A name should communicate positive product attributes and avoid unpleasant connotations.

LEAN CUISINE[®] for frozen prepared foods

DIE HARD[®] for automobile batteries

Desirable Brand Name Characteristics

- (v) Allow for some flexibility. If possible a brand name should allow for adaptation to changing market needs.
- ACCENTURE[®] for business management consulting
- BOSTON MARKET[®] instead of BOSTON Chicken for restaurants
- JUST WHITE SHIRTS AND BLACK SOCKS

Desirable Brand Name Characteristics

- (vi) Be suggestive of the product class. It may be advantageous to choose a brand name which suggests the attributes of the class of product in issue.
- TICKETRON® for vending tickets

Desirable Brand Name Characteristics

- (vii) Work with a symbol or slogan. It is advantageous if a brand name works well with a symbol or slogan.

- Apple Inc.



Desirable Brand Name Characteristics

- (viii) The proposed name must be legally available in the countries in which it is proposed to be used. This means that trade mark availability searches need to be carried out.

Desirable Brand Name Characteristics

- (ix) The proposed name should also be protectable under the *Trade-marks Act*. Ideally the mark should be legally strong; marks that are descriptive or common to the trade, even if protectable, will only be entitled to limited protection.



Desirable Brand Name Characteristics

- Any Brand name must also comply with relevant Federal legislation. Mark as used cannot be false or misleading or contrary to the Food and Drugs Act.

- FACTORY CARPET OUTLET®

Brand Architecture

- There are advantages to be gained by tying the brand name to the brand owner's name. If goodwill has been built up over the years, a new brand extension can gain acceptance by being linked with this historical goodwill.
- HEINZ[®] brand products sold by H.J. Heinz Company

Brand Extensions

- There are significant risks and costs associated with launching a new product or service. Many new products fail. One method of reducing the risk is to extend an existing brand to a new category of products or a service.
- VIRGIN[®]
- NIKE[®]

Brand Extensions

- Unfortunately there are potential costs associated with leveraging a brand in this fashion. First, if one of the products loses creditability all of the products and services associated with the brand may be affected. Second, the core brand may be become diluted.
- HEWLETT PACKARD

Trade Mark Protection in Canada

- In Canada, the *Trade-marks Act* applies to a brand name and is of fundamental importance. Obtaining a trade mark registration facilitates the protection of the brand name. There are also common law rights associated with a brand name which may be asserted independently.

Trade Mark Protection in Canada

- The *Trade-marks Act* provides for a public registry system which is national in scope, showing proscribed information for each registered trade mark. The *Act* facilitates the protection of trade marks by granting exclusive rights to owners and providing for public notice of the rights

Trade Mark Protection in Canada

- The legal purpose of trade marks continues to be their use “to distinguish wares or services manufactured, sold, leased, hired or performed by (the trade mark owner) from those manufacture, sold, leased, hired or performed by others” within the meaning of section 2 of the Act.

Trade Mark Protection in Canada

- The Act also rests on principles of fair dealing and is sometimes said to hold the balance between free competition and fair competition.

Trade Mark Protection in Canada

- The purpose of a trade mark is to create and symbolize linkages. A trade mark is a symbol of a connection between a source of a product and the product itself. This is reflected in the definition of a trade mark contained in the Act.

Trade Mark Protection in Canada

- This registration system co-exists with common law trade mark rights. Common law rights are acquired through actual use of the common law mark in association with wares or services.

Bars to Registration

- Subsection 12(1) of the *Act* lists a number matters which may preclude obtaining a registration. The subsection provides that a trade mark is not registrable if it is
 - a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

Bars to Registration

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

(c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used.

Bars to Registration

- Subsection 12(2) of the *Act* provides relief for a trade mark that is not registrable by reason of the limitations of subsections 12(1)(a) or subsection 12(1)(b). A mark that is not registrable as a result of these subsections is registrable if it has been so used in Canada by the applicant or its predecessor in title as to have become distinctive at the date of filing an application for its registration.

Entitlement

- In general terms an applicant who has filed an application that complies with the *Act* for a mark that is registrable is entitled, subject to the completion of opposition proceedings, to secure a registration for a mark in association with the applied for wares or services, unless at the priority date, the mark was confusing with
- (a) a trade mark, whether registered or not, that has been previously used or made known in Canada by any other person;

Entitlement

- (b) a trade mark in respect of which an application for registration had been previously filed by any other person; or
- (c) a trade name (the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual.) that had been previously used by any other person

Trade Mark Searches

- Once a potential trademark is selected searches should be conducted to determine whether or not it is available for use and whether it can be registered under the *Act*. It is extremely important to conduct these searches at as early a stage as possible and certainly prior to any use of the mark.

Trade Mark Searches

- Consideration should also be given to domain names and associated websites. The necessary steps to secure domain names should be taken before any public announcement to minimize the risk of cybersquatting.

Types of Searches to be Carried Out

- Frequently preliminary screening searches can be conducted on an on-line basis to ascertain whether there are any obvious impediments.
- If the screening search does not disclose any conflicts which cannot be overcome, a complete trade mark search can be carried out.
- In addition, searches may be carried out directed to the common law rights of individuals or businesses who have used similar marks or business names but have not obtained trade mark registrations.



Types of Searches to be Carried Out

- Once these searches have been carried out a written opinion should be obtained from counsel, qualified in providing such opinions, concerning the potential availability and registrability of the proposed mark.

Cautions

- A brand owner should be cautious in choosing a coined word as a brand name.
- EXXON[®] for petroleum based products

Descriptiveness and Related Issues

- A brand name which is descriptive of the product, the brand owner or the geographic locality from which the product originates may not be a good choice.
- FRENCH PRESS for non-electric coffee makers

Descriptiveness and Related Issues

- A brand name which suggests but does not describe characteristics or properties of the product may be more acceptable.
- TALON[®] for zippers

Descriptiveness and Related Issues

- There may future problems associated with the choice of a descriptive mark as opposed to a more unique mark.

Name Changes

- The considerations relating to a change of the brand name are very similar to those associated with choosing a new brand name.

Name Changes

- A well planned and well executed communications campaign will be required in order to implement the change.

(CBS News) It happened this week, the biggest news in music this side of the Grammys.

We learned of the demise of "Muzak" -- not the music, just the name.

In a re-branding by parent company Mood Media, Muzak will henceforth be simply known as "Mood."

Name Changes

- The brand owner must also consider the potential market responses which may result when a brand name is discontinued.
- The BREEZE®

Thank you



John McKeown
Specialist in IP Law
(Trade mark/Copyright)

mckeown@gsnh.com

416-597-3371

 @mckeown15

 John McKeown

www.gsnh.com

 @GSNH_Law