The challenges of developing a name for a new product.

- <u>What is your process for developing a name</u>? Our process follows a traditional PDCA cycle.
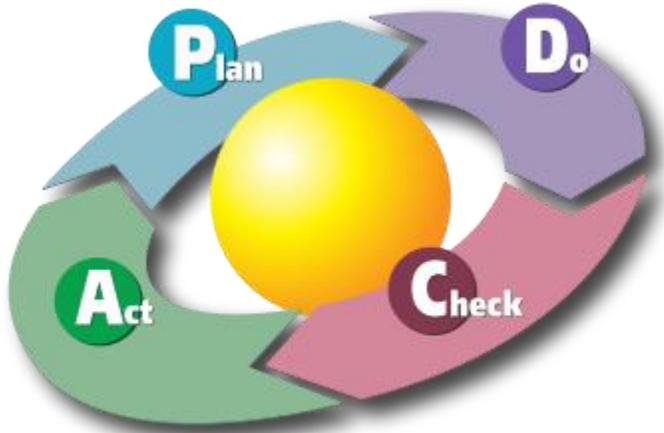

Diagram by Karn G. Bulsuk (http://www.bulsuk.com)

In the Planning Phase, we work with the client to develop a Name Development Brief (here is a good resource for how to do that: https://nancyfriedman.typepad.com/away_with_words/2011/11/how-to-write-a-naming-brief.html). The Do Phase is all about name generation and most name developers have an easy time with this. The Check Phase is where we select our favorite names and screen them for potential trademark conflicts prior to presenting to the client. Without this step we run the risk of having our client fall in love with names that turn out to be unavailable, which reflects poorly on us. Finally, the Act Phase is where we present to the client and gather feedback that can be used to tweak and develop a Round 2 list of names.

- <u>What are the most difficult parts of the process</u>? If you take the time to develop a great brief, you will have a clear direction for name development and an even clearer path for name evaluation. And as I said, generating names is not the hard part of the process. The difficult part of the process is the Check Phase, as trademark clearance work can be time consuming and/or expensive.

- <u>Why is trademark clearance so difficult</u>? There are two major ways to conduct trademark clearance work. You can pay someone to do it for you (which is very

expensive) or you can try to do it yourself (which can be very time consuming and/or expensive). In the past I've hired attorneys or trademark analysts to conduct searches but the cost has been significant (roughly $25 - $40 per name). When you have a list of 50 - 100 names to check, that cost adds up pretty quickly. There are a number of free trademark clearance tools (such as https://www.trademarkengine.com/) but the free resources only identify direct matches or worse identify potential conflicts that really do not exist (due to a lack of similarity of goods and services). You can also attempt to clear the trademarks yourself using the US Trademark Office database (https://www.uspto.gov/trademarks-application-process/search-trademark-database) but this database is not exactly user friendly. Finally, once you clear a name for registered trademarks in the US you still have to consider common law rights, international filings, and domain names.

- Are there special challenges in developing names in different categories? Some product categories are trademark nightmares. A lot of my naming projects involve OTC medicines or natural supplements which fall into the Nice classification IC 005 and this area is a "trademark rich" environment. What this means is we have to generate and evaluate a lot more names to get to a list of clear names because so many will have conflicts with existing trademarks.

Cleared Name   IC 005 Cleared Name
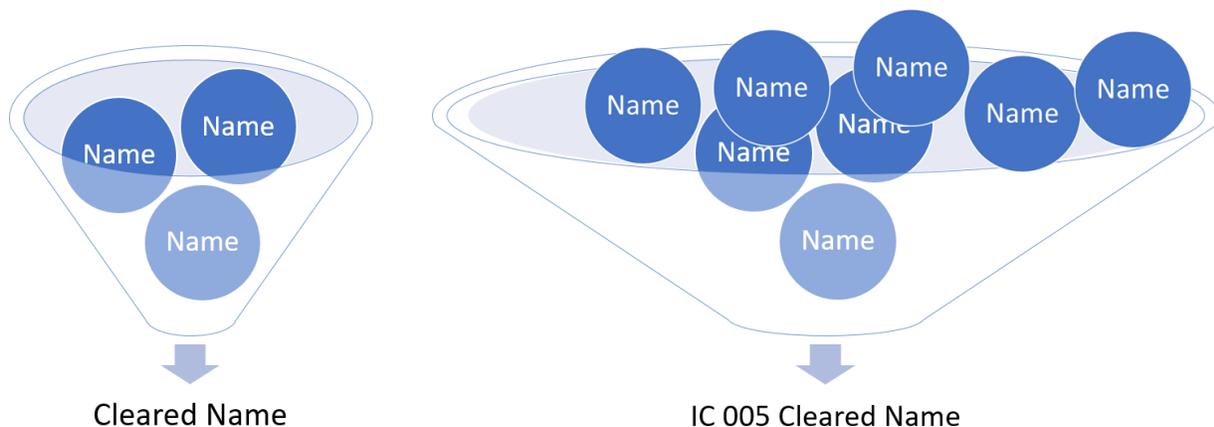
Conducting the Check Phase.

- What were you doing to check trademark availability? Over the years I've become an effective user of the USPTO's Trademark Electronic Search System, or TESS (https://tess2.uspto.gov). However, searches are time consuming and review of potential conflicts can be a complex task that involves painstaking effort. And

being very honest, I'm not a trademark expert so there is a risk of inaccurate or incomplete results. When I did not have the time to do searches myself, I've hired outside help at a significant cost.

- Summarize the major points of frustration you faced. There really was not a good option for trademark searches. You either invested the time to do it yourself or spent a lot of money on an outside expert. Neither of these are optimal.

- When did you decide to try something new? When I was between naming projects, I began searching for alternative trademark clearance methods.

- What led you to try BOB®? I was given a free 30-day trial of BOB. Fortunately, my trial coincided with a new naming project I had just received.

Actual experience using BOB.

- How easy or hard was it to get started with BOB? The process is quite easy to use and there are instructional videos on the site that get you started quickly.

- How has it helped you to overcome the challenges you had before? BOB gives me confidence that I can conduct a thorough and accurate review of names at a reasonable cost before presenting a list of names to clients.

- How is it different than other alternatives you've tried? BOB provides results that are as good as the ones provided by hiring an outside expert, but at a fraction of the cost. BOB is fast and easy to use and saves tons of time versus doing searches yourself. Finally, BOB provides a thorough and accurate result that enables me to present names with confidence that a trademark can be available.

- What is your favorite feature of BOB? BOB evaluates the relatedness of goods or services to assess likelihood of confusion between marks. Other trademark clearance services evaluate based on mark similarity within International Class Numbers. Therefore, BOB can identify opportunities for similar trademarks to exist within the same International Class, which prevents us from rejecting a name just because there is a similar name in the class.

Actual results of using BOB.

- Can you share a specific example of how you use BOB? I'll use an example from a number of years ago (past the term of client confidentiality, although only public information will be provided). I had a client who wanted to develop a name for a

new line of skincare products that were based in organic and ethically developed ingredients, and blended by a Master Herbalist. They wanted to see a wide range of names from descriptive names through created names. Some of the names we considered are on this spreadsheet, which is the input sheet for BOB.

Mark	Component	LongForm	WildCard
Affinique			Affiniq$$
Belovia			Belov$$
Beneluma	Bene, Luma		
Bontierra	Bon, Tierra		
Brillanzia			Brillanz$$
Epiviv			Epi$$
Namaste			Namast$$
Natrali			Natral$$
Natura			Natur$$
Natural Wonder	Natural, Wonder		
Naturalist			Naturali$$
Naturaluxe			Naturalu$$
NatureWay	Nature, Way		
Nupura			Nupur$$ OR $$pura$$
Nuvation			Nuva$$
OEB		Organic Ethical Blend	
Omvivo			$$vivo
Opurelle			$$pure$$
Organic Blend	Organic, Blend		
Puritaire			Purita$$
Sensorist			Sensor$$
True Naturel	True, Naturel		
Vivactia			Vivact$$

- <u>What were the results provided by BOB and how did you interpret them</u>? The results can be seen by clicking <u>HERE</u>. I usually apply a "Green Light, Yellow Light and Red Light" status depending on potential conflicts. My interpretation of the results was as follows:

  o Affinique – No result found = GREEN LIGHT

  o Belovia – A few results found but nothing close = GREEN LIGHT

  o Beneluma – Luma has several trademarks that suggest the need for further study = YELLOW LIGHT

  o Bontierra – Although there are several marks noted by BOB nothing is very close = GREEN LIGHT

- o Brillanzia – No result found = GREEN LIGHT

- o Epiviv – By searching for names that start with "Epi-" BOB determined that substantial dilution exists, which could enable use of this name. Further study required = YELLOW LIGHT

- o Namaste – Has several marks that appear to be in conflict = RED LIGHT

- o Natrali - Has several marks that appear to be in conflict = RED LIGHT

- o Natura – Existing mark for this name = RED LIGHT

- o Natural Wonder – NATURAL WUNDERZ trademark for similar goods likely prevents use of this name = RED LIGHT

- o Naturalist – Existing mark for this name = RED LIGHT

- o Naturaluxe – While there are several Natural Luxury marks there are not any similar marks = YELLOW LIGHT

- o NatureWay - Existing mark for NATURE'S WAY = RED LIGHT

- o Nupura – While there appears to be dilution around the "pura" component, there are no directly conflicting marks = GREEN LIGHT

- o Nuvation - Although there are several marks noted by BOB nothing is very close = GREEN LIGHT

- o OEB - No result found = GREEN LIGHT

- o Omvivo - Has several marks that appear to be in conflict = RED LIGHT

- o Opurelle - Has several marks that appear to be in conflict = RED LIGHT

- o Organic Blend – Although dilution is present, the name appears to be generic = RED LIGHT

- o Puritaire - Although there are several marks noted by BOB nothing is very close = GREEN LIGHT

- Sensorist - Although there are several marks noted by BOB nothing is very close = GREEN LIGHT

- True Naturel – Existing mark TRUE NATURAL would prevent use = RED LIGHT

- Vivactia – No result found = GREEN LIGHT

Conclusion and recommendation.

- <u>What was the result of this project?</u> This project was executed back in 2009, and the client chose Nupura as the name for their skin care product (it is no longer on the market).

- <u>Would you recommend use of BOB for future work</u>? Absolutely. BOB provided in-depth results in 5 minutes. If I would have conducted this search on my own it would have taken days and BOB's results were more thorough than mine would have been. With BOB, I had the confidence to present my names to the client and provide assurances that the names were able to be trademarked.