

How to Create a Strong Brand®

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SELECTING A STRONG BRAND

A lot of thought should go into choosing a brand name, because some marks are stronger and therefore easier to protect and enforce than others. From a marketing perspective it is tempting to select a mark that is directly descriptive in some sense of the goods or services it is to be used in relation to (for example “Hastings Native Plant Nursery” for a native plant nursery in Hastings). From a trademark perspective however, it is difficult to obtain legal protection for a descriptive mark, as it is considered that any trader should fairly be able to use a mark that is descriptive of the goods or services in relation to which it is to be used. The exception to this is that it may be possible to obtain trademark protection for a descriptive mark where there has been substantial and prolonged use of the mark.

In comparison, a mark that is fanciful, completely made up or unrelated to the particular goods or services it is to be used in relation to, is much easier to obtain legal protection for, as it is considered to be inherently distinctive.

Examples of marks from weakest to strongest are as follows:

- 1) Wholly descriptive marks — very difficult to protect and enforce (e.g., Spray-n-Wipe™).
- 2) Somewhat descriptive marks — still likely to encounter difficulties (e.g., ConQuip™ for concrete equipment services).
- 3) Unrelated common words — e.g., Blackberry® for a handheld computer/phone, or Hurricanes® for a rugby team.
- 4) Completely fanciful — e.g., Kodak®, Adidas®.

So how do you choose?

Choosing a mark that is not directly descriptive of your goods or services may be slightly more challenging to start with. It may involve more marketing to establish a reputation in relation to the mark. Ultimately however it should result in a stronger brand that will in the long run be easier to protect and enforce.

PROTECTING YOUR MARK

Once you’ve chosen a brand name you want to use, how do you go about protecting it? The best way to protect a brand is to register it as a trademark at the Intellectual Property Office of New Zealand (IPONZ). This involves filing a trademark application specifying the mark and the particular goods or services in relation to which you intend to use the mark.

IPONZ will then examine the application to ensure that:

- There are no other identical or confusingly similar marks already registered or applied for in relation to the same or similar goods or services; and
- The mark is distinctive in relation to the goods or services specified in the application.

Assuming IPONZ does not raise any objections on either of these grounds, an application will be accepted, and then advertised in the monthly IPONZ journal.

Provided no third party objects to its registration within a 3-month period following its advertisement, the application will proceed to registration.

Once registered the trade mark owner has the legal exclusive right to use the mark anywhere in New Zealand in relation to the goods or services specified in the registration. This right lasts for an initial period of 10 years, but can be extended indefinitely upon the payment of renewal fees every 10 years. If you do not register your trademark, you may still acquire legal rights to the mark through extensive use in trade that establishes a reputation and goodwill in the mark. If this occurs you may be able to take action under the tort of passing off or the provisions of the Fair Trading Act 1986 that prohibit deceptive or misleading conduct in trade.

The disadvantages of relying on unregistered (or common law) rights to your trademark are:

- They only arise in the specific geographical locations in New Zealand that you can prove you have established a reputation and goodwill; and
- It can take considerable time and cost to make sufficient use of a mark in trade to have established the necessary goodwill.

It is therefore often more difficult and costly to enforce unregistered versus registered trademark rights.

MARKETING YOUR BRAND

Once you've chosen and registered your mark, you may want to market it to promote the goods or services you are offering. When doing so it is important that your mark is always used in a trademark sense, so that it does not become a generic term for your goods or services. If it does, then it may not be possible to enforce your rights in it.

The following guidelines should be followed for trademark use:

- Use the symbol ® in close connection to your trademark (usually to the top right of your mark) once you have obtained trademark registration. Prior to registration of your mark, you should use the ™ symbol.
- Display the trademark differently from surrounding text, for example in capitals, bold, italics, with quote marks, or with initial capital letters.
- Use the trademark as an adjective followed by the generic name for the goods/services.
- Do not use the trademark as a noun, verb, in the plural, or hyphenated.
- Do not use the trademark as a plant variety/cultivar name. Variety/cultivar names are by definition generic.

ENFORCING YOUR TRADE MARK

If a third party makes use of your trade mark (or a mark which is confusingly similar to your trade mark) in relation to the same or similar goods or services to yours, it is important that you contact an intellectual property lawyer and determine if legal action can be taken. If you do not take action against the third party, the value and usefulness of your trade mark, may well decrease. It may also make it more difficult, if not impossible, to take action against a different infringer or the same infringer at a

later date if no action was taken in the first instance. Your lawyer will consider if you have legal grounds for taking action. If so, they will in the first instance contact the third party and ask that they “cease and desist” their apparent infringement of your trademark. Ideally the infringement will either cease absolutely or you reach some settlement acceptable to both parties. If this does not occur it may be necessary to take court action to obtain an injunction instructing the third party to stop infringement and, in some cases, to pay damages for their infringement.

CONCLUSION

By selectively and knowledgeably choosing your brand and protecting it by registering it as a trade mark, then by appropriately marketing your brand and enforcing any infringement of it, you will build a strong and long-lasting brand of great value.

ADDITIONAL READING

Intellectual Property Office of New Zealand <www.iponz.govt.nz>.

The Effect of Gibberellic Acid, Potassium Nitrate, and Cold Stratification on the Germination of Goldenseal (*Hydrastis canadensis*) Seed[®]

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A laboratory experiment was conducted to measure the effects of various factors on germinating goldenseal seed. Seeds were soaked in gibberellic acid (0.5 g·L⁻¹, GA₃) or potassium nitrate (2 g·L⁻¹, KNO₃) for 2, 6, 12, or 24 h, followed by periods of cold stratification at 4 °C (0, 2, 4, 8, or 12 weeks). GA₃ treatment accelerated the germination process with 61% of the seed germinating to the seed splitting stage in 47 days compared to 4% in the non-GA₃ treatments. Neither soak time nor osmotic conditioning with KNO₃ had any effect on germination. Cold temperature stratification at 4 °C had a negative effect on germination. Increasing the stratification time from 0 to 12 weeks induced secondary seed dormancy and reduced overall germination after 6 months incubation at 1 °C by 23% compared to fresh, untreated seed, which gave 80%–90% germination after 3 months. Germinating seed from all treatments was observed to be highly susceptible to disease under laboratory conditions suggesting this may also be a factor in the poor establishment of goldenseal crops in the field. The lack of seedling development following seed splitting suggests that the conditions, which favour the early germination process are different from those that promote seedling growth.

Keywords: Goldenseal, germination, gibberellic acid, stratification, Ranunculaceae, osmotic conditioning.

¹Deceased