



## Doing Your Due Diligence Before Picking A Name

May 6, 2014

By [Paul A. Borovay](#), Associate

[Entrepreneur Magazine](#) recently published an article about [things to consider before naming your business](#).<sup>1</sup> It is a good (and short) read for anyone considering starting a company, or even for those individuals who have a company and are thinking about rebranding it under a new name or concept.

To start, consider what makes a company name so important: it must be unique, easy to spell, and nowadays, ideally, play nice with [Google's](#), Yahoo's, and [Bing's](#) be-all and end-all algorithms, among other necessities. As the Entrepreneur article points out, several names, like Apple, Snapple, Oreo and Virgin, are fun to say and easy to spell – and they stick in consumers' minds.

But the article fails to mention one important aspect about the “picking a name process:” entrepreneurs must do their due diligence before investing time and money in a name.<sup>2</sup> There is nothing worse than getting excited about the *perfect* name only to be sued for infringing someone else's trademark after launch.

There are several ways to avoid this scenario. A good start is to check the [United States Patent and Trademark Office](#) (USPTO) website to see whether someone else is already using your name. The USPTO provides for both word and design mark searches. Next, conduct your own internet search. If you get several results with a name that is similar to your proposed name but covers different goods or services, you *might* be okay. Trademark attorneys focus on these types of risk analyses.

---

<sup>1</sup> As a complete disclosure, neither I nor this law firm has any connection to Entrepreneur Magazine – though I do own a subscription.

<sup>2</sup> An Entrepreneur Magazine article published on April 8, 2011, titled [How Can I Find Out Whether a Business Name Is Already Taken?](#) did discuss the importance of trademark searches.



PATTISHALL  
McAULIFFE  
NEWBURY  
HILLIARD &  
GERALDSON LLP • 200 South Wacker Drive, Suite 2900 • Chicago, IL 60606-5896 • T (312) 554-8000 • F (312) 554-8015 • [www.pattishall.com](http://www.pattishall.com)

These materials have been prepared by Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for general informational purposes only. They are not legal advice. They are not intended to create, and their receipt by you does not create, an attorney-client relationship.

One of the most popular services trademark attorneys offer are clearance opinions. First, the attorney will conduct a clearance search for your proposed mark. A clearance search may be obtained from a professional search vendor and reviewed by the attorney. The professional search vendors offer the broadest coverage, including reviewing federal and state trademark registrations, business names across the country (or world if you would consider selling your goods or services abroad), similar internet and domain name references, and variations and colorable imitations of your proposed name revealed through their own proprietary databases.<sup>3</sup> These searches are far more comprehensive than anything you or I could do on our own. They are not cheap, but they really show just how unique and protectable your name might be. Following the search, a trademark attorney will provide you an opinion assessing whether the mark is available for use, as well as your likelihood of getting a state or federal registration.

If you plan to operate your business internationally, securing the advice of a trademark attorney is definitely the way to go, as different countries have very different trademark systems. If you don't secure trademark rights in the countries where you want to do business, someone else might easily register your name there, and there might not be anything you could do about it.

Once you do secure your perfect company name, you should consider retaining a watch service. As the name suggests, a watch service watches federal and state trademark registrars for similar trademark applications. Getting an early start to protecting the brand you have spent so much time and money developing is imperative and will help keep the scope of your rights in your name as broad as possible.

\* \* \*

[Paul A. Borovay](#) is an associate with [Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP](#), a [leading intellectual property law firm](#) based in Chicago, Illinois. Pattishall McAuliffe represents both plaintiffs and defendants in [trademark](#), [copyright](#), and [unfair competition trials and appeals](#), and advises its clients on a broad range of domestic and international intellectual property matters, including [brand protection](#), [Internet](#), and [e-commerce](#) issues. Paul's practice focuses on litigation in [trademark](#), [media](#), [online gaming](#) and [entertainment](#), [advertising](#), as well as [trademark prosecution](#) and [counseling](#).

---

<sup>3</sup> For example, would you think to search for the term "Fit You" if you were conducting your own trademark clearance search for your *proposed* new company name "U Fit"? Maybe, but maybe not. See [You Fit, Inc. v. Pleasanton Fitness, LLC, 8:12-CV-1917-T-27EAJ, 2013 WL 521784 \(M.D. Fla. Feb. 11, 2013\)](#).