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Introduction

Trade marks function to ensure that the origin of goods and services are known by consumers and other interested parties. Brands, on the other hand, deliver your product or service promise encompassing your personality, emotions and principles.

This guide’s focus is on how to create, use and protect a strong brand. It explores which intellectual property (IP) and other rights are involved and how they can be used together for this purpose.

Chapter 1 explains why having a strong brand is important and why brands are valuable. It also looks at what makes a brand successful, the characteristics a strong brand typically possesses, and how branding strategy and the overall business strategy should be interlinked.

Chapter 2 provides practical guidance on how a strong basic brand identity is created including how to choose a distinctive name and what other aspects are required to build value in the brand proposition. It also addresses how you can tell whether your efforts are paying off.

Chapter 3 aims to help you determine which elements within your brand can be registered and which ones should be prioritised. It also looks at a broader range of assets which go beyond IP rights such as the domains you should obtain, and how your registered rights can provide a framework that supports your other assets and brand characteristics such as your brand values.

Finally, Chapter 4 sets out steps to defend your brand and ensure that it remains distinctive in the marketplace.

Produced by IPOS International, these intellectual property management (IPM) business guides aim to deliver a suite of IP solutions for enterprises based on industry best practices. As the expertise and enterprise engagement arm of the Intellectual Property Office of Singapore (IPOS), IPOS International helps enterprises and industries use IP and intangible assets for business growth. Some of these engagements may be eligible for Enterprise Singapore (ESG) funding, such as the intangible asset audit and strategy development aligned with business goals. IPOS International’s business portal www.iposinternational.com also contains case studies and videos of enterprises leveraging IP to gain a competitive edge in their innovations. Should you have questions on IPM matters or wish to speak with our Intellectual Property Strategists, do email us at enquiry@iposinternational.com or call +65 63308660.
What makes a brand valuable?

01
What makes brands successful?

It is relatively easy and inexpensive to create a brand identity, but much harder to make one which is a fully rounded package and a valuable business asset. This section explores some of the characteristics of a brand package that make it valuable (and what destroys value), examining it through the lens of IP.

We can probably all think of brands that we can assume are highly valuable, but what makes them worth so much? Is it all just about sales, or do leading brands share common features or characteristics that less valuable ones lack?

It is important to stress at the outset that a brand is an asset that is much more than a trade mark (although one or more trade marks are usually an essential component, as explained later in this guide). A brand forms part of how a company can differentiate its offering, creating a type of ‘shorthand’ that makes the buying decision process easier for customers.

Clear identification is particularly significant in the digital age, as increasingly time-poor consumers search for goods and services and seek to make quick buying decisions. Arguably, this makes brands more valuable than ever.

However, it’s not all plain sailing with brands: they can also lose value quickly for reasons which may not be related to the IP they contain. Sometimes this loss of value will be attributable to a problem with the goods or services to which they relate (such as a product quality or safety issue); sometimes it will be down to business mismanagement; sometimes it will be compromised by copycats; sometimes it is affected by wider market trends (take Blockbuster Video, for example). We consider this issue further in the following sections.

“A brand is a lot more than just a trade mark”
How does a brand acquire a ‘personality’?

Through the intrinsic qualities of the product or service, and how both the goods themselves and the underlying company that produces them are marketed, brands become associated with particular characteristics (for example ‘value for money’ or ‘premium’ or ‘durable’).

Sometimes these associations can go beyond the actual characteristics of the product or service. When carefully communicated, brands can conjure up emotions or feelings when they are encountered. Of course, the emotion or feeling will vary greatly depending on the type of products or services involved. But the main point is that the brand develops its own ‘personality’ and associated set of values.

Use of a brand with other elements, such as a particular type of packaging, colour palette or shape helps these additional assets to acquire a personality. As more elements are associated with the brand, brand recognition is enhanced and a larger ‘bundle’ of rights and assets is created. This helps to cement a market position, as others who try to use a similar shape or colour palette may be seen to be impersonating the ‘original’ brand. As will be shown, imitation is a double-edged sword.

Brands that have strong personalities tend to have several characteristics in common, as shown in the diagram on the left. They are instantly recognisable by both customers/stakeholders and more widely in the general public. This is because they are well-differentiated and consist of a relatively large number of assets that have been used together and presented consistently over an extended period of time.
Strong brands tend to have several common characteristics. They usually consist of a series of distinguishing features that are intended to be immediately recognisable. They build recognition by sticking to an agreed form of presentation that is always followed, and by promoting a series of values with which they come to be associated.

As with any IP, every brand is different. The whole point of a brand is to allow your business to differentiate itself from the competition, and to allow your consumers to distinguish your products and services from those of your competitors.

Despite these differences, when strong brands are studied, several common characteristics can usually be found. The best brands are often widely recognised—well beyond their immediate customer base—and this typically happens as a result of continuous and consistent use over an extended period.

A brand normally consists of several elements. In addition to elements that are protectable by a trade mark, brands are associated with emotions and a personality.

Each component in the bundle helps to reinforce and support the other elements and they become intrinsically associated and linked with each other. Some, but not all, are formally protectable with a trade mark or other IP right.
Brands can only become really valuable assets for a company if there is a good ‘fit’ between a firm and its products and services. Every brand should be created to reflect the values and ethos of the company and support its overall strategy. The company name will not necessarily be the same as the brand, and if they are separate, it is easier to drive value from them independently.

Brands need to be chosen to project the kind of company you are and the kind of company you wish to become. If there is a misalignment between the ‘values’ associated with the brand and the company that owns it, this will dilute the brand and/or undermine the company values, which in turn is likely to confuse the consumers of the brand and the company’s products and services.

However good a brand is, it will not make either the company or its products something they are not. Fancy branding will not transform an inexpensive product into a high quality one, nor will it rescue a business in difficulty or quickly transform a company from having a bad reputation into a good one—though changing the identity of a brand that has somehow become tarnished is a popular and frequently-adopted strategy.

A company may, of course, trade using several brands. Multiple brand use is more common in business-to-consumer (B2C) rather than business-to-business (B2B) contexts, because B2C activity is often directed towards sales of a specific product or service, and allows messages to be tailored both to particular attributes or advantages and to a certain target audience.

B2B is more commonly associated with building up trust in a supplier of a variety of products or services. However, B2B firms may also see advantages in being able to establish and protect a range of names, especially if their goods or services are quite diverse.

Where there is a separation between the company and the product or service brand, this opens up the possibility of re-sale. Brands have value because they provide a shorthand that the customer can recognise and make a repeat purchase confident that they will receive a product or service with familiar qualities. In B2C markets, these associations often persist even if the brands change hands, provided that the product or service quality is not compromised. Product and service brands are therefore, in theory, highly mobile and saleable if they are successful.

What are your brand values and what is your brand voice?

If you have not already done so, draw up a list of the things that contribute to your current product or service reputation in the marketplace. As well as being a useful marketing aid, this may help you identify additional opportunities to protect brand and company identities using trade marks.
1. What makes a brand valuable?

How can brands be weakened, and what is at stake if they are?

Well-managed brands can be expected to increase in value. Unfortunately, however, they can also lose value quickly if something untoward happens. If your brand is weakened, the risk is that you will no longer be able to charge a premium for your goods and services affecting your margin. You may also see your market share diminish.

Sometimes, damage can be caused by a technical or operational issue associated with the branded product or service. For example, a product may be shown not to be safe, a food item may contain an unadvertised ingredient, claims made about a product’s performance may turn out to be false or misleading, or a service experience may fail to meet expectations. In these circumstances, the brand promise is undermined, and the underlying value of the brand is reduced.

Sometimes a valuable brand can suffer badly if the underlying business goes into administration and the brand’s products/services can no longer be made available (especially if staff, customers or suppliers are left being owed money). However, as brands are mobile and scalable, a company going into administration may not prove fatal, especially where goodwill has been built up over a number of years. As one example, Triumph Motorcycles went into receivership in 1983, but now under different ownership has worldwide sales of nearly $1bn.

Success breeds imitation. This is not always a bad thing. A certain level of competition is sometimes quite helpful to a brand because it means that other people are also spending their marketing dollars on raising awareness in your market, and some of that benefit is likely to spill over to your advantage. Similarly, other brands provide you with an opportunity to demonstrate how your offering is different and (in some respect) preferable.

However, if other businesses start copying your offering so closely that they are infringing your rights, and if they sell products or services with branding that is the same or similar to those of your brand, consumers may begin to lose sight of the differences between these two offerings, and start falsely to associate a potentially inferior product or service with your business.

The presence in the market of inferior products using your branding elements may also detract from the exclusivity, distinctiveness and prestige of your product. In some sectors (toys for example), imitation can even have safety implications. Therefore it is important if you want to build a strong brand, to actively monitor for infringement and to act quickly and decisively once any infringement is found.

“ Inferior products may detract from your exclusivity, distinctiveness and prestige ”
The accompanying guides in this series should help you with brand policing and enforcement. *Knowing Your Competition* explains how you can monitor and detect infringement, and *Upholding Your IP Rights* provides detail on how your rights can be enforced should you suspect your brand is being copied.

Separately, another guide—*Keeping Your IP Out of Trouble*, maybe instructive in explaining what you are and are not permitted to do with other people’s trade marks (as an example, you don’t have to get a trade mark owner’s permission to feature their name in comparative advertising).

A weakened brand is not a purely theoretical, academic issue. Brands are valuable primarily because of economic reasons—they help the owner to sell more products/services and to charge a premium over competing products which do not enjoy such a strong reputation. When brands lose value, diminishing market share and reduced margins are likely to be the result. It is therefore vital that once a strong brand is built that everything possible is done to maintain the brand leadership.
## 1. What makes a brand valuable?

**CHECKLIST**

**What makes a brand strong and successful?**

The checklist below highlights some of the factors that contribute to making a successful, valuable brand.

<table>
<thead>
<tr>
<th>Areas</th>
<th>Examples</th>
</tr>
</thead>
<tbody>
<tr>
<td>Attached to large volumes (of users, sales and/or profits)</td>
<td>Valuable brands are usually associated with substantial market traction. This may relate to their volume of users, or to sales of associated goods or services. The brand and its associations commonly enable a company to charge a premium for the product or service being offered.</td>
</tr>
<tr>
<td>Strong association with specific products or services</td>
<td>When you think of a strong brand, it is likely to bring to mind one or more products or services with which it is used. In some cases, the brand can become synonymous with a particular implementation of the product or service. When branding is combined with innovation, an association with market leadership often follows. The branded goods or services will be considered to be 'original', leading competing products to be considered 'imitations'.</td>
</tr>
<tr>
<td>Long-lived and well-known</td>
<td>Valuable brands will typically have been in use for an extended period within their target markets. They will have developed a reputation and developed a degree of recognition amongst a large proportion of the ‘relevant public’ (people who may be interested in the brand category as a customer, a supplier or a distributor).</td>
</tr>
<tr>
<td>Have an associated personality</td>
<td>Valuable brands also tend to conjure up some emotions, feelings or characteristics when they are encountered. Typically, the qualities that are evoked will involve aspects like luxury, quality, price-competitiveness, comfort, relaxation or excitement.</td>
</tr>
<tr>
<td>International</td>
<td>Many of the most valuable brands cross borders and are ‘multi-lingual’, being recognised globally rather than just in a single geographic market (although this does not mean they do not make some adaptations to suit local markets).</td>
</tr>
<tr>
<td>Tradeable</td>
<td>Strong brands are often a driver of merger and acquisition activity.</td>
</tr>
</tbody>
</table>
How can I create a strong brand?

02
2. How can I create a strong brand?

What's in a name?

The most important component of most well-known and valuable brand identities is an original name that differentiates the product, or its origin, from the competition. Often the name (particularly of a product) has some echo in it of what the thing in question is or does, but strong names are seldom purely descriptive of the company, good or service.

One advantage of choosing a name that is not descriptive of your goods or services is that it is generally easier to obtain registered trade mark protection (because it is more likely to be available, and less likely to be ruled non-registrable on technical grounds). The great benefit of having one or more registered rights at the core of your brand identity is that it provides a kind of legally recognised ‘hook’ on which other brand assets can hang.

A distinctive name will likely be a ‘made-up’ word, or an existing word used in an unusual context (e.g. using the name of a fruit to sell a range of electronic devices).

Choosing a good brand name is not easy, but as the name of your brand has the possibility of becoming one of your company's most valuable assets, it is worth spending some time ensuring that the one chosen is right for your business. The right name should conjure up the desired emotions and connotations in those who hear it. Assuming you may wish to use it for export, you also have to be careful that the name does not have any negative or unintended associations in other countries or any other foreign language.

At some point—preferably, before you have launched your business or product!—you will need to check that the name ‘resonates’ in the market. Do your target customers like it? Do they think it sums up the values and characteristics of the product/service? Are they drawing the associations you are trying to convey?

CHECKLIST

What makes a suitable name?

<table>
<thead>
<tr>
<th>Things to check</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Image / personality</td>
<td>Does the name convey the appropriate image or personality for your business? Does it evoke the right sort of characteristics?</td>
</tr>
<tr>
<td>Originality</td>
<td>Is the name capable of distinguishing goods/services sold by you from those of your competitor? If it is a generic term used in the industry or a generic shape, then it will not meet these requirements.</td>
</tr>
<tr>
<td>Things to check</td>
<td>Detail</td>
</tr>
<tr>
<td>----------------------</td>
<td>---------------------------------------------------------------------------------------------------------------------------------------</td>
</tr>
<tr>
<td>Not descriptive</td>
<td>Ensure the name is not descriptive of what you selling, that it is not laudatory and that it is not offensive or immoral. If it is any of these things, you may be unable to obtain registered trade mark protection.</td>
</tr>
</tbody>
</table>
| Not already trade marked | Check whether your name is already trade marked in the classes of goods or services you want to use. If it is, this is not necessarily fatal, as several identical or similar marks may co-exist even in the same class provided that they are associated with distinctly different goods or services.  
If you have international operations (or ambitions to have them in the future), you should also check whether the proposed name is trade marked in the other countries regions that are likely to be of most interest. |
| Domain names are free | Most businesses now need a strong online presence, and so having a strong domain name (or series of domain names) to support your brand is likely to be important. You can check whether or not the required domains are free. If they are not, you could consider whether you can be creative and add other words onto the end of the domain name.  
Also, if key domains are already registered, you should check whether they are being used and if so what for – would you be happy for your product/service to be associated with what the domain name owner is selling?  
Sometimes, you may find that the domain registrations are for sale: whether it is worth purchasing such a domain is a commercial decision and will depend on the particular circumstances. |
| Translations         | Before investing further in a name, you should check whether the name has any negative connotations in other languages in countries where you may wish to trade. This is not an easy task, and even large companies often make mistakes in this area.  
However, diligent searching and use of online machine translation tools should help to spot some of the most obvious issues that may arise. |

Several guides in this series will be useful in considering your naming strategy. **Keeping Your IP Out Of Trouble** explains what you are allowed to do with other people’s brands; **Upholding Your IP Rights** explains trade mark infringement and sets out what the penalties may be if you are found to be infringing a third party trade mark; **Knowing Your Competition** sets out where and how you can search for trade marks that are already in force; and **Going Global** provides some guidance on how you can ensure your name will not have negative connotations in foreign markets.
2. How can I create a strong brand?

What are the other components in a typical brand identity?

Certain components are commonly found in a strong brand. It will normally consist of much more than just a name; it usually comprises a series of registered and unregistered marks, which work in concert to create the overall character and personality of the brand. At the core of this will be the fundamental brand identity.

Most strong brands also contain a logo. Sometimes, this incorporates the company or product name, but with time, the shape and style alone may become so well known that the associated brand name comes to mind when the logo is seen. (Coca-Cola, or Pepsi, both being good examples). An effective logo is one that is distinctive and stands out from others used by competitors in your industry, which is particularly important if you wish to obtain trade mark protection for it.

The basics of trade mark registration for words, images and other devices that make up your brand identity are contained in an accompanying guide—Safeguarding Your Competitive Edge.

A specific colour set (often referenced using Pantone numbers) and a distinctive typeface are two more common components of a brand’s identity. Care is needed when choosing these, to ensure they reflect the values of the company: as an extreme example, a cartoon font or very bright primary colours may not be appropriate for an accountancy firm. Colour and font combinations are easy for consumers to recognise and associate both consciously and subconsciously with your brand. This connection will be strengthened if the fonts and colours are used consistently on the company website, on product packaging and in any advertising materials which are created.

You may also consider using a slogan as part of your branding, to encapsulate what you believe to be the key feature or characteristic of the company, product or service on offer. Although it may not be possible to register a trade mark for the slogan initially, it can subsist as an unregistered mark and may eventually be registered once a large proportion of your target audience associates it with your business.

You can also introduce other elements into your identity such as music (like a ‘jingle’) and a place name. The following checklist will help you think about how they might be protected.
<table>
<thead>
<tr>
<th>Asset</th>
<th>Detail</th>
<th>Primary protection mechanism (see next chapter)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Name</td>
<td>Not descriptive; could include some point of reference to your activity or product, but probably tangential; different and easy to distinguish from your closest competitors; probably made-up, or a word used outside its normal context.</td>
<td>Trade mark (word)</td>
</tr>
<tr>
<td>Logo</td>
<td>Similar qualities as for your name; does not necessarily have to contain the company or product name; if it does contain the name, it should ideally be distinctive enough to recognise even if the name were not there.</td>
<td>Trade mark (image). May also enjoy some protection under copyright</td>
</tr>
<tr>
<td>Colour set</td>
<td>Choose something bright or something more reserved depending on the image you wish to project, but ensure you do not pick the same colour as your direct competitors.</td>
<td>Trade mark (when used in conjunction with logo). May enjoy some protection under copyright</td>
</tr>
<tr>
<td>Typeface</td>
<td>Font should have an appropriate ‘personality’ for your business—you may need something ‘no-frills’ for a serious professional service, elaborate for a boutique, cute for a baby product, fun for a toy.</td>
<td>Trade mark (when used in conjunction with logo). May enjoy some protection under copyright</td>
</tr>
<tr>
<td>Slogan</td>
<td>Can be more descriptive, but should still be distinctive (not copying any competitors).</td>
<td>Copyright: over time, can become sufficiently distinctive that trade mark registration (for the words) becomes possible</td>
</tr>
<tr>
<td>Music</td>
<td>Needs to be an original composition for you to own the IP in it.</td>
<td>Copyright: over time, can become sufficiently distinctive that trade mark registration becomes possible</td>
</tr>
<tr>
<td>Geographic Indicator</td>
<td>A geographical indicator (GI) is a sign used on products that have a specific geographical origin and possesses qualities due to that origin. In Singapore, GIs only apply to food and beverage and agricultural products. Use of a GI may help to emphasise your product’s authenticity, but usage is often tightly controlled (for example, ‘champagne’ can only come from a designated region in France).</td>
<td>GIs are capable of being enforced—Singapore operates a registry for them Make sure you are authorised to use the term you choose. You may need approval from a government or Industry body to use a particular place name, and your use may also be subject to adherence to prescribed standards</td>
</tr>
</tbody>
</table>
2. How can I create a strong brand?

What characteristics make a brand distinctive?

Having a bundle of rights does not necessarily mean that you will create a strong brand to rival the major competitors that may already be present in your industry. It is important but to use these assets appropriately, to maximise their staying power and increase the chances that they will develop traction.

Strong brands are well-known with the community where they are used. A large proportion of the ‘relevant public’ (customers, suppliers, distributors and other stakeholders) in an industry recognise the brand and associate it either with a particular organisation or a specific range of products and services. These brands have a reputation in the marketplace and enable customers to distinguish the goods and services associated with them from the same or similar goods/services offered by other organisations. In short, they are distinctive.

Brands do not become distinctive or acquire a reputation by accident. Consistency of presentation is one of the keys to their success. The marks making up the brand will have been used consistently over an extended period of time so that the relevant public is exposed to the brand in just the same way on many occasions.

CHECKLIST

How do I achieve consistent brand presentation?

<table>
<thead>
<tr>
<th>Asset</th>
<th>Detail</th>
</tr>
</thead>
<tbody>
<tr>
<td>Branding guidelines</td>
<td>It is important to draw up internal guidelines on the ‘look and feel’ of all company-generated materials to ensure that your brand is used consistently in formal and informal marketing materials (e.g. slide presentations). This helps to ensure that your brand and corporate identity is not inadvertently undermined (see Chapter 4 of this guide).</td>
</tr>
<tr>
<td>Policing</td>
<td>To ensure guidelines are correctly followed, you will need to police the authorised use of your brand. This is particularly important if you change aspects of it—agents, distributors and licensees are liable to continue using out-of-date versions until you insist.</td>
</tr>
<tr>
<td>Packaging</td>
<td>If you sell products, packaging represents an important opportunity to reinforce your brand values—potentially across a range of sizes and shapes of goods. It is not just a question of ensuring your logo is used: shape, styling, colouring and weight should all be made consistent.</td>
</tr>
<tr>
<td>Asset</td>
<td>Detail</td>
</tr>
<tr>
<td>-------</td>
<td>--------</td>
</tr>
<tr>
<td>Invoices and other external and internal documentation</td>
<td>In addition to statutory requirements, your logo and other branding elements (such as your slogan) should be present on invoices, purchase orders and other official documents so that your customers become used to seeing them. Branding should also be applied to internal documentation to increase staff familiarity with how you expect your brand to be represented.</td>
</tr>
<tr>
<td>Website</td>
<td>Most companies are good at ensuring their website presents the basic elements of their brand (colour scheme, logo, etc) correctly. Few firms think about how creative incorporation of video and inclusion of interactive mechanisms (social media, chat facilities/chatbots, etc) can help to present the image they are seeking to convey. It is also important to design and code websites with the many different devices now in use in mind. The same site can look very different on a mobile, tablet and PC.</td>
</tr>
<tr>
<td>Social and other media</td>
<td>If appropriate for your business, consider actively maintaining social media accounts (Facebook, Instagram, Twitter, LinkedIn, etc.) and brand these appropriately. You may also find it useful to set up a media channel (for example on YouTube).</td>
</tr>
<tr>
<td>Advertising</td>
<td>Being a controlled environment, your advertising provides a perfect opportunity to use all your branding elements together to promote your products and services exactly as you wish them to be seen.</td>
</tr>
</tbody>
</table>

How can I tell whether I have created something distinctive?

Determining whether you have created a distinctive, well-respected and valuable brand is not as straightforward as it sounds. Aside from sales volume and customer recruitment indicators, measures that indicate distinctiveness include widespread brand recognition and the ability to charge a premium for your products and services.

A good way to gain objective evidence to determine whether you have a strong brand is to survey the relevant public and gauge the level of awareness that is present. Clearly, this cannot be expected to deliver strong results at start-up, but if you have been marketing to your chosen niche for some time, useful insights may be obtained.

If the majority of respondents recognise your brand and react favourably, then you are likely to have created something distinctive, and you have some further evidence to add to the conclusions you may be able to draw from sales.

Commercially, owning a strong brand should allow you to charge a premium for the products or services that carry it (unless of course your strategy is to position the brand as being associated with a lowest cost provider). You should be able to detect this in your financials. Are you

"Owing a strong brand may allow you to charge a premium for your products"
2. How can I create a strong brand?

Out-competing generic market offerings and are your products thought to have certain qualities that your competitor’s products and services lack, which allows you to charge extra? If so, then you are likely to have created a distinctive and valuable brand.

CHECKLIST

For your naming strategy

Choose a name

- Does the name resonate with customers and other stakeholders?

  - Y  
  Is the name distinctive and not descriptive of products/services?

    - Y  
    Trade mark search. Is name is use by competitor in Singapore or internationally?

      - Y  
      Language search. Any adverse meanings in current (or potential future) markets?

        - N  
        Work up a brand and test with consumers

        - Y  

How do I build protection around a brand?
As long as the name and other marks you choose to use are not already in use in the regions where you trade, there is no legal imperative to register your marks. However, registering a mark makes it much, much easier to enforce your rights. In some cases, it can also provide you with a defence against accusations of infringement; and it creates an asset that can be easily licensed, sold or even used as security to assist in a funding round.

The most compelling reason for registering your trade mark is that once your mark is registered, you can use the legal system to stop others from using the same or similar marks for similar purposes. As well as having redress against people imitating your name, you also gain access to various sanctions that can be used to stop counterfeit goods from being imported and sold, which is vital for some businesses.

Without a registered trade mark, bringing such legal action can be much more difficult. Using the common law of passing off, the burden of proof shifts to you to demonstrate that the other mark is similar (or the same), that its use is damaging your reputation and that you have lost revenue due to its use. With a registered trade mark, the burden of proof shifts to the defendant, who must then prove that they are not infringing your mark.

Below, this guide has a detailed description of ‘passing off’ and the three main aspects that have proved necessary to address in order to bring a successful action.

If you are considering trading overseas, or are already selling goods or services outside Singapore, you should consider obtaining or extending protection for your most important registered marks to other territories around the world. In doing so, you may find that you need to make some adaptations to localise your brand, for example, to accommodate different consumer habits. Otherwise, you could find that a brand that is highly relevant and attractive in Singapore may not be understood and may not gain traction in your new market.

Several other guides in this series will help extend and enforce your rights. Upholding Your IP Rights provides more detail on how you can enforce your trade mark rights should you suspect infringement is occurring; Going Global explains how to extend your rights to other countries; and Keeping Your IP Out Of Trouble gives more detail on exceptions to trade mark infringement.
Finally, a registered trade mark is also a piece of intellectual property. Like other forms of property, it can be sold or licensed to a third party. It can also, should the lender be prepared to accept it, be used as security to support a debt-based funding round.

If you are trying to build a corporate brand, or have a wide range of product brands, you are quite likely to end up with an array of marks you could potentially register. It may not be possible for budgetary or other reasons to register every single one, and so it is important to prioritise. If you have to choose, it is useful to know that word marks generally provide the most protection.

As set out in Chapter 2 of this guide you may have a name, a logo, a colour scheme, a slogan and potentially a range of other distinguishing features like music which you could potentially register as trade marks. Although every case is different and it pays to take professional advice from a trade mark agent, there are some common principles which may be useful in helping you decide where to focus your efforts.

In general, protecting a company, product or service name as a simple, unformatted word mark is most important. The name is central to the brand and is the single biggest ‘hook’ on which all the other assets hang. By protecting the word for use with the goods and services you choose, you effectively prevent anyone else being able to use the same or similar name for those purposes, irrespective of whether the rest of the branding elements they choose (logos, slogans, colour schemes, typography) are quite different. It also means that if you do decide to redesign a logo featuring your name, you will still be protected.

Should the name you have chosen be deemed by a trade mark examiner to be descriptive, to lack distinctiveness or to be commonly used in the industry, then you may not be able to obtain a word mark for it—at least, not initially. You may be able to protect the name once it has acquired distinctiveness through use, but this can only be the case once the brand has gained a reputation and a solid position in the marketplace.

In the meantime, your next priority would normally be to consider seeking to obtain trade mark protection for a stylised version of the name (for example, in a logo). Logos can often be deemed distinctive even when the word they incorporate is not, and so are more widely amenable to trade mark protection.

Although protection with a stylised word is not as strong as the unformatted word (it only protects use in the particular style and any style similar to it), it does provide some degree of protection. It can help prevent claims of infringement, assist in building the brand, and act as a deterrent to would-be infringers who find you have registered the mark.

Which marks should I prioritise protecting?

“Protecting a company, brand or service name as a simple word mark is generally most desirable.”
3. How do I build protection around a brand?

Not all aspects of a brand are amenable, at least initially, to trademark protection as they are not inherently distinctive of your brand. If used consistently and over an extended period, however, some aspects may acquire distinctiveness, and some may then be protected by a registered trade mark (or other methods).

As well as the core brand identifiers discussed in Chapter 2, the way you market your products or services is likely to have several other elements. If these are not individually distinctive, but collectively create a ‘look and feel’ to your offering that is different, they are sometimes called your ‘get-up’ or more technically, your ‘trade dress’.

Over time, if you use them consistently, one or more of the components of your trade dress may start to become associated with your business. They will become distinctive of your products or services. You may find, for example, that eventually one or more of the colours that you use can distinguish your products from your competitors and that consumers associate that colour scheme with your business. For coffee shops, dark green branding with white lettering suggests you are looking at a Starbucks; a convenience store with a set of coloured stripes (orange, green and red) is likely a 7-Eleven.

Once this happens, these features have been said to have ‘acquired distinctive through use’ and there becomes the possibility to register these features as additional trade marks further strengthening and protecting your brand. To increase the chances of success, it is important to keep records showing that you have used them in the same way over an extended period of time, and be able to evidence this by reference to samples and past advertising and marketing campaigns.

Some aspects of trade dress may attract copyright protection: in copyright law, it is not only the particular set of words you choose but also how they are laid out (their visual appearance). Any original illustrations or images that you use in promotions or packaging will also attract copyright, which you will need to have assigned to you if they have been created by third parties on your behalf.

Under some circumstances, elements of your trade dress might also be suitable for protection by registered designs, though under Singapore design law you would need to register this before it has been publicly disclosed. Designs are used to protect aesthetic, non-technical features such as the shape, colour, contours and textures that are used. An example of this would be a highly distinctive new packaging shape: the styling of a perfume bottle, for example, or a particular presentation box that has some unique visual elements which you think other people might want to copy. (If they are functional advantages they are not suitable for design registration).

“...It is important to keep records showing you have used your brand in the same way over an extended period.”
In some jurisdictions outside Singapore, there is a 6-month or 1-year grace period in which registered design protection can be obtained following initial disclosure of the design. This means that if you are trading internationally, it may be possible to extend registered design protection for packaging even when it is already in use in Singapore, as long as you act quickly.

Core aspects of your brand should be relatively straightforward to protect as a trade mark. Other aspects such as trade dress can be protected to some extent with copyright or design rights, and might attract trade mark protection over time. But what happens with even less tangible aspects—such as the values, emotions and personality of the brand?

Brand values are often complex. There may be an ethos behind your products (such as sustainability or eco-friendliness) that sets you apart in a particular market; there may be particular steps you take to ensure high quality that is well above the norm; you might always seek to provide excellent value for money. Sometimes, there will be a blend of attributes, and this can be hard, to sum up in a few words.

If it is possible to describe your values fairly succinctly or ‘boil them down’ to a key phrase, this may enable you to convey them in a **slogan** or **strapline**. This can then be communicated over an extended period of time, in advertising, on product packaging, on the company website and sometimes in the customer experience. If you can create a neat and original description, this will attract some protection under copyright law, and over time, it might acquire distinctiveness through use (like other components of your trade dress) and become amenable to trade mark protection.

With a large proportion of trade now occurring on the web, and traditional ‘bricks and mortar’ companies requiring a strong web presence to survive, domain name registrations are becoming an important asset for almost every type of business. Your domain names can be valuable and important assets in their own right.

Domain names are not a form of intellectual property, not least because they are never owned by the company that is using them. Rather, they are a form of contract via which a registered owner obtains exclusive rights to use the domain for a certain period of time.

Despite this, domains may share many of the characteristics of an item of intellectual property. They are often bought and sold along with a bundle of surrounding IP (usually software code, a database and a brand) and they can quickly be worth substantially more than the registrar’s fee.

There are a few things that you should consider with regards to domain names. If you are only planning on trading in Singapore, the .sg domain may be all that you require. However, if you are considering trading internationally, it may be preferable to obtain the .com domain name,
purchase domains for each specific country, or use domains that use a specific top-level domain (TLD) that is appropriate for your particular industry.

If you find that these domains are not available, it is important to investigate whether they are hosting content that suggests your brand is not unique, or whether the domains are parked and being offered for sale (sometimes at inflated prices: speculators have a habit of buying domain names that they think will be popular).

It is often a good idea to register domains similar to the one that you are using or similar to your brand to prevent the risk of 'cybersquatting'. This is where someone fraudulently registers a domain so that they can impersonate another party to sell competing goods and services or earn advertising revenue by diverting traffic or acting as an intermediary prior to forwarding visitors on to the genuine site.

If you find that someone has registered a domain similar to yours and is behaving dishonestly, you may be able to use the courts, mediation, arbitration, or either the Uniform Domain Name Dispute Resolution Policy (UDRP) or the Singapore Domain Name Dispute Resolution Policy (SDRP) service. SDRP or ICANN should be able to have the domain registration removed from the offending party and transferred to your ownership.

In some circumstances, it is possible to use your registered trade mark to prevent the registration of domain names similar to your existing trade mark. The accompanying *Upholding Your IP Rights* guide provides more information on how domain name registrations from third parties can be prevented when they use your trade mark.

**How can I benchmark myself against my competitors?**

It is often helpful to look at what your competitors are doing, to see whether there are any lessons you can usefully learn. As well as comparing brand value, you can examine the ‘depth’ of other brands (how far do they go to try to put across their brand identity and values in everything they do) and their diversity of brand applications.

One way to benchmark your brand is by comparing the range of ways in which the different brands are being communicated. Do your competitors associate a sound with their brand? Do they have very specific badging or tag designs (e.g. in a clothing range, like Levi’s Jeans)? Do they use a particular smell? How do they use several similar features across a diverse range of products to create a common identity? If you find that your competitors are using their brands more creatively or
more extensively than you are, you can work out what else you should be considering.

Another point to examine is how far your competitors have ‘stretched’ their brand and used it to promote a range of diverse products and services. As an example, the multinational excavator brand, Caterpillar, started out by making large trucks and mining equipment but has stretched its brand successfully into ranges of clothing and boots that use the same registered marks. This has worked because the products embody many of the same characteristics and personality as the original products (rugged, study, unbreakable, tough).

This is a different strategy from simply producing merchandise featuring character properties—though, for certain forms of IP, this can be highly effective. The Hello Kitty brand became one of the world’s top sellers by appearing across a vast range of goods; this creates high visibility—to the point that it essentially becomes free advertising.

If you do stretch your brand, it is important to remember that trade marks are always registered in relation to a series of specific goods and services, classified into one of 45 classes. As your business grows and your brand reaches new areas, you may commonly find that your existing marks do not cover all your current activities.

It is therefore important to review your trade marks regularly, to ensure that the list of goods and services attached to them accurately reflects the company’s current operations. It is not possible to add new product or service classes or descriptions to an existing mark, because fresh examination is needed—so if you find that your marks are no longer listing all the goods and services they should, a new application will need to be undertaken.
How do I keep my brand well protected?
Having invested the time and effort in building up a strong and valuable brand which is supporting your business’s sales, the brand’s contribution must be maintained. A key part of this is ensuring that the brand is well protected.

Aside from the obvious sources of potential trouble, such as a company running into financial problems or issues arising with its products or services (such as a product recall), most potential issues are likely to relate to the defence and use of the trade marks and their associated ‘get up’.

Brands can be weakened by inconsistent use, by imitation, by infringement or by neglect. This chapter explores these scenarios and the steps you can take to mitigate these risks and ensure your brand remains strong, differentiated and optimally protected.

Brand guidelines, if used consistently across an organisation, can ensure that a company’s messaging is consistent and that the brand becomes recognisable and distinctive faster. Unapproved uses of the brand, whether internal or external to the organisation can damage the brand. For this reason, effective internal ‘policing’ of brand use is highly recommended.

Having everyone inside an organisation ‘dancing to the same tune’ and using the brand in a consistent, standardised manner will assist in increasing brand recognition among the relevant public. It will also help unregistered elements of the brand to acquire distinctiveness more quickly and make sure that the underlying personality of the brand is not confused.

This is where brand guidelines are valuable. By producing a set of instructions on how the brand can and cannot be used, communication of a consistent message is ensured. These instructions can be very detailed—for example, specifying the amount of white space that must be left around the logo to ensure it can be seen clearly—but should also emphasise the core brand values that are to be communicated.

If the trade marks are not consistently used, or the same presentation is used for many different purposes (for example, being associated with expensive luxury items on one occasion and with cut-price bargains on another), the brand values and the personality can become confused. This is a surprisingly common problem, especially in larger organisations where multiple departments may have access to the same roster of trade marks and use them for their own purposes.

With brands that contain multiple trade marks, this risk is amplified. It is greatest if these brands are controlled by different departments, different regions or, in a group structure, owned and controlled by different entities. The larger and more complex the organisation, the more important it is that the brand values are consistently communicated and that rules and procedures are put in place to ensure that the marks are only used in the approved manner that was originally intended.
4. How do I keep my brand well protected?

One particular issue that should be addressed in the branding guidelines is the use of a registered trade mark as a verb. (there is a classic example of this in the vacuum cleaner industry). This might seem like a desirable development because it helps to put a brand name into common parlance. However, professional advice is that this temptation should be avoided.

If used in this way, your mark runs the risk of becoming generic, and even a dictionary word, which by definition is no longer distinctive of products and services relating to your company. There have been well-known past cases where leading brands have lost their trade marks simply because their names have become generic through their use as verbs.

This is not the only way in which words can become generic (think of ‘escalator’, once a registered trade mark, or ‘aspirin’, no longer a trade mark in most countries). Acting on instances where other firms start using your marks is vital, since trade marks are, potentially, the longest-lived of all the IP rights. If they continue in use, they can be renewed indefinitely.

Your branding guidelines should make it clear that your registered trade marks should not be used as verbs, and that any use of your marks by competitors needs to be acted on immediately.

Can I track how my brand is used by others?

As well as policing the use of your brand internally, by your staff, it is also important to ensure your brand is used consistently by other parties who are outside your organisation. This includes partners, distributors, licensees, franchisees and other collaborators, as well as your customers.

The stronger and more well-known your brand becomes, the less likely it is that your own staff will be the only people using the brand. If you have distributors, for example, they will require the use of your brand at the point of sale and also, potentially, in advertising and promotional literature.

Licensees may also have rights to use your brand. Unless this usage is actively monitored, they may not necessarily represent it in the same consistent way that the organisation wishes (which should be set out in the branding guidelines). Where a licensee is international, there may also be the added complication that if you do not have a full suite of registered trade marks in that territory yourself, your licensee may attempt to register some of your brand’s marks themselves in their home market.
This should be actively policed and prevented. In many jurisdictions, such registrations are considered to be ‘in bad faith’ and so are prohibited, provided the brand owner can notify the appropriate authorities.

The accompanying guide—Knowing Your Competition, provides more detail on how you can detect potential infringement and set up a watch service to identify potentially disruptive trade mark applications including from your overseas licensees.

Franchisees would normally be expected to operate to a very detailed set of instructions, and so of all the possible external stakeholder groups, their brand use should be the easiest to control. This will normally be based on a franchise operating manual, that should include detailed branding guidelines relating to the franchise.

These should be actively policed along with the other aspects of the franchisee’s operation, to ensure that their actions do not damage the brand. The whole point of a franchise is to provide a consistent experience across its different franchisee-owned businesses.

The accompanying guide—Making Money From Your IP, discusses ways to manage licensees and franchisees and to ensure their operations do not damage the underlying brand.

How do I detect and discourage infringers and counterfeiters?

Your marks are also vulnerable to being used without authorisation by third parties. Detecting such use requires diligent searching. Once discovered, it is important that your rights are enforced, otherwise, they will lose their deterrent value. You can deter many forms of unauthorised use by appropriate deployment of the ® and ™ symbols.

As your marks become well known, they will likely be used with increasing frequency without your permission. While some uses are permitted by law (such as accidental inclusion in a photograph, or use for comparative purposes), you may come across other cases where it is clear that someone is trying to trade off the back of your reputation.

The accompanying guide—Upholding Your IP Rights discusses the importance of enforcing your IP rights to maintain their deterrent value, while Keeping Your IP Out Of Trouble discusses the use of ® and TM as deterrents in more detail.

If you are fortunate enough to have a brand that is recognised to have a well-established reputation (such as a major automobile brand), you may be able to argue that any use of your brand name in connection with goods that do not originate from you should be stopped because consumers will inevitably be confused about their origin. BMW, for example, is not known for making chocolates, but if someone marketed
4. How do I keep my brand well protected?

chocolates with something confusingly close to the BMW brand, they would be entitled to object on these grounds.

Most companies are not that fortunate, and will only be able to stop infringers that are copying something they already do. It is generally preferable however to discourage them from using your registered trade marks in the first place. One way of doing this is to feature the ® symbol next to them wherever possible (in other words, in territories where these marks are in fact registered).

In territories where no mark has been registered, it is an offence to use ®: in these cases, there is some merit in using 'TM' instead (as this at least puts others on notice that you consider this mark to be distinctive, and that it should not be used without permission). Over time, this may also make it easier to argue that the mark has acquired distinctiveness, should registration be a requirement in the future.

How do I address ‘passing off’ and ‘lookalikes’?

If you manage to create a successful brand, it is almost guaranteed that others will look to profit from your image by creating lookalikes, soundalikes or other forms of imitation, to try to benefit from your brand and its associated values in their competing products.

Direct copying of a registered trade mark is relatively easy to prevent, and there are well-established enforcement procedures that place the burden of proof on the other party. Harder to prevent is the situation where the ‘essence’ and other non-registered characteristics of a brand are copied.

The accompanying guide—*Upholding Your IP Rights*, explains what you should do if you think your IP is being infringed, including the care required before issuing a cease and desist letter.

Impersonation may take different forms. It is common for imitators to borrow various features of a successful brand’s packaging (colours, layout, fonts) to produce ‘lookalikes’. Sometimes these stay far enough away from the original that a customer is unlikely to be confused, but on other occasions, there is a deliberate intent to profit from the confusion.

For companies trading in China, ‘soundalikes’ represent an additional complication. Impersonators may choose to trade with a Chinese character set which, although different from yours, sounds similar. (‘Qiao Dan’ sounds similar to ‘Jordan’). Their products may be such close copies of your successful brand that consumers are confused and buy products or services from the competitor rather than from you by accident.
If you wish to take legal action to prevent lookalikes or soundalikes, and if no infringement of any registered trademarks or designs have occurred, you will have to rely on the common law of ‘Passing Off’. It is illegal to misrepresent yourself or another entity, especially if it means that you can trade off the reputation and goodwill that has been built in a brand which you do not own.

In Singapore (and many other countries), case law has established that in passing off cases, the burden of proof is on you as the plaintiff to show three things (known in legal circles as the “Classic Trinity”). These are explained in the accompanying checklist.

**CHECKLIST
What you need to prove to bring a successful passing off case: The Classic Trinity**

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<thead>
<tr>
<th>Areas</th>
<th>Examples</th>
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</table>
| **The existence of goodwill** | You have to show that your brand has associated ‘goodwill’. That is to say, your brand adds value and is used by consumers to select and choose your product over that of competitors.  
This can be a challenging thing to prove, and is likely to require you to submit market survey results to the court (which can be cross-examined). You can expect your opponent to submit competing market survey reports suggesting there is no goodwill in your brand.
If you have a registered trade mark there is no requirement for you to demonstrate that you have goodwill in your mark(s). |
| **Misrepresentation**       | You have also show that the provider of the offending product or service misrepresented themselves. That is to say, they intentionally set out to confuse the public into thinking that their product or service came from you.
If their product simply suggests that their offering is equivalent or an alternative to yours, then there is no misrepresentation. Unlike a registered trade mark, where the defendant has to prove that there is no confusion, it is down to you to demonstrate that there is misrepresentation. |
| **Actual damaged suffered** | You also have to show that actual damage (for example loss of sales) has occurred or is likely to occur. That is to say, the misrepresentation was successful and consumers/customers purchased a product from the defendant rather than from you, resulting in loss of sales.
Again, with a registered mark, you do not have to prove that you have suffered or are about to suffer actual damage. |
4. How do I keep my brand well protected?

With the burden of proof on you, it is relatively difficult to ‘prove’ passing off and to bring a successful claim. There are cases where passing off actions have been successful, but if you wish to pursue this route, do not underestimate the size of the task.

**CHECKLIST**

**What procedures to protect my brand will help maintain its position in the market?**

<table>
<thead>
<tr>
<th>Areas</th>
<th>Examples</th>
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<tbody>
<tr>
<td>Marking</td>
<td><em>Marking your products and services and using the ® and ™ symbols appropriately will help you to assert your rights. This will increase the reach of the brand and act as a deterrent to would-be infringers.</em></td>
</tr>
<tr>
<td>Additional registrations</td>
<td><em>Always be on the look-out for the need to register additional marks. It may be that some of your trade dress features (colours or slogans) have acquired distinctiveness and now can be registered as trade marks. It may be that your brand is being applied to new products or services and new trade mark registrations are required. Can you file any designs for new packaging that is being introduced?</em></td>
</tr>
<tr>
<td>Brand guidelines</td>
<td><em>Develop branding guidelines that cover the details of how your brand is to be used. These guidelines should be aimed both at your internal audience (employees) and at any partners, distributors, licensees or franchisees who will also have rights to use your brand.</em></td>
</tr>
<tr>
<td>Enforcing policies with collaborators and authorised users of your brand</td>
<td><em>Having developed strong brand guidelines, they must be adhered to. Make sure that the contracts you have in place with your partners contain provisions that provide appropriate sanctions should they not follow your instructions. You also need procedures to monitor the usage of your brand by external parties, and have processes in place to enforce the stipulated guidelines if required.</em></td>
</tr>
<tr>
<td>Enforcement against infringers</td>
<td><em>If you find your brands are being used by potential competitors without your permission (i.e. you suspect infringement), you should find the most appropriate way to enforce your rights without delay. An accompanying guide in this series explains why this is important and what the most appropriate method may be.</em></td>
</tr>
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Where do I get help?

05

GETTING RIGHTS GRANTED
IPOS : www.ipo.gov.sg/resources

GETTING PATENTS RIGHT
• Patent search and examination (for both national and international PCT applications)
• Patent analytics
• Customised search services

DEALING WITH DISPUTES
IP Legal Clinic (IPOS) : www.ipo.gov.sg/e-services

GETTING IP ADVISORY
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• Commercial analytics on patents
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