Trigg, Hampton, Ferris in FDLI Update: What's in a Name' Sometimes, a Claim

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PRACTICES FDA Regulatory and Compliance, Food, Beverage and Restaurant, Trademark and Advertising, Advertising, Marketing and Promotional Law, Intellectual Property

Savvy marketers know that a product name is important. It is part of what sets your product apart from a host of others on the market. In “trademark speak,” it is your source identifier.

Perhaps because they are so important, product names often undergo “clearance” by trademark counsel, who analyze the name’s suitability as a source identifier vis-à-vis third parties and the United States Patent and Trademark Office (USPTO). A “clear” name might next undergo prosecution in an attempt to obtain a federal registration. This clearance and prosecution process often happens without any input from regulatory counsel. This approach is both problematic and costly. Product names can be more than source identifiers. They can and often do make claims about a product’s attributes. Such claims may make marketers the target of enforcement actions from federal agencies like the Food and Drug Administration (FDA).

While clearance and prosecution are important steps in the branding process, trademark issues should not be the only considerations at the naming stage. Product names need to be more than cleared and applied for—they need to be reviewed from regulatory and false advertising risk perspectives. In our experience as outside counsel, many companies choose to undertake these types of assessments after the trademark name has been established (or, sometimes, not at all). Early consideration of these concerns, especially with respect to FDA regulations, can help mitigate the risk of enforcement action, avoid costly rebranding activities, and help set the stage for lower risk promotion of products. Regulatory counsel should be involved in the naming process, and marketing departments should consult regulatory counsel, simultaneously or before, trademark counsel. ...

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