

HOW SHOULD BUSINESSES CREATE A STRONG BRAND?

SERIES 1: WHAT IS THE IDEA AND FUNCTION OF A BRAND?

INTRODUCTION

This is the first article in a three-part series titled, “How Should Businesses Create a Strong Brand?” Most entities established for profit or non-profit purposes have a brand by which they are identified with. Not every brand is, however, strong enough to qualify for legal protection as a trade mark. So, what makes a brand sufficiently ‘strong’ or distinctive enough for it to be legally protectable?

The terms ‘**brand**’ and ‘**trade mark**’ are often used interchangeably by businesses and consumers to refer essentially to the same thing; the name/identity by which a business is known for. More specifically, the term ‘**brand**’ is the overall identity and reputation of a business. A ‘**trade mark**,’ on the other hand, is the legal sign to identify and which is used in connection with the goods or services of a trader to distinguish it from the similar goods or services of another trader in the market. To build a strong brand, it is necessary to first understand the legal prerequisites of a legally protectable trade mark.

In this 1st article series, we will explore what a trade mark is, the functions it serves and the legal requirements for protection. This article focuses on the purpose and function of a trade mark and why it is one of a business's most valuable assets.

WHAT IS A TRADE MARK?

To understand how to build a strong brand, it is necessary first to understand what a trade mark is. In simple terms, a trade mark is a

badge of origin. It is a sign that enables consumers to distinguish the goods or services of one business from those of another.

A strong trade mark performs this function instinctively. When consumers encounter it, they immediately associate it with a particular business or source without consciously thinking about the role the trade mark is playing.

WHAT FORM CAN A TRADE MARK TAKE?

As defined under the Kenya Trade Marks Act (Chapter 506 of Laws of Kenya), a trade mark may consist of one or more elements. In formulating a trade mark, businesses have the following options to consider;

- a) **Word marks**-These are the most common types of trade mark. They consist of letters or words and may be presented in a standard form or in a stylized font or design. In general, a word mark can be registered as a trade mark if it does not directly describe the goods or services for which it is used.
- b) **Device or figurative marks:** These consist of pictures, logos, symbols, designs, drawings,

or a combination of these elements. They may be two-dimensional or three-dimensional and may include colors or color combinations as part of the trade mark.

- c) **Slogans:** These are basically taglines consisting of words that form a phrase. For a slogan to be distinctive, it should be clear, memorable and capable of identifying the source of the goods or services as that of a particular trader. In general, shorter and more unique slogans are easier for consumers to remember and are more likely to be distinctive than long or descriptive phrases. Some examples of popular slogans are; *KFC's tagline "Finger Lickin Good"* and *Nike's tagline "Just do it"*.
- d) **Three-dimensional (3D) marks:** These consist of the shape of a product or its packaging. To qualify for trade mark protection, the shape must be distinctive and not result solely from the nature or function of the product. It should not be a shape that gives the product substantial value or a significant competitive advantage. For instance, the distinctive contour shape of the *Coca-Cola bottle* is a well-known example of a three-dimensional trade mark. In this example, consumers can recognize the product by its unique shape even without seeing the brand name.
- e) **Color marks:** These consist of one or more colors used to identify the goods or services of a particular trader. As they consist solely of a color, colors or combination of colors, they are rare. They

are also different from word marks, device (logo) or 3D marks that may be rendered

either in black or white or in color. Color marks may be applied to the whole or part of a product or its packaging. In many jurisdictions including Kenya, registering a color, colors or a combination of colors is immensely difficult as opposed to other forms of trade marks for the simple reason that colors are generic. A color per se used to identify the goods or services of a particular trader to distinguish it from the similar goods or services of other traders in the market place is unlikely to result in consumers to associate the used color(s) as a badge of origin between the trader and his goods or services. For this reason, marks solely consisting of colors are not inherently distinctive. **They can only be registered as trade marks under special circumstances with production of ample evidence of lengthy and extensive use of a particular color(s) by a trader on particular goods or services proving that consumers associate the usage of such color(s) on specific goods with the business of the trader.** A wellknown example of colour mark is *Cadbury's* distinctive purple used on the packaging of its chocolate products.

- f) **Non-traditional marks:** Unlike Kenya, jurisdictions such as USA, European Union and Australia allow registration of **non-traditional trade marks**. These include smell (olfactory) marks; taste marks, sound marks, and touch (tactile) marks provided they are capable of distinguishing the goods or services of one business from those of another.

WHAT FUNCTION SHOULD A TRADE MARK PERFORM?

1. To be capable of legal protection as a badge of origin (a trade mark), **a trade mark must be capable of distinguishing the goods or services of one undertaking from those of another**. This may sound straightforward. In practice, however, many businesses choose and use names, device/logos, or slogans that are generic, descriptive or commonly used by other traders in the same business sectors as a badge of origin for their products or services. In simple terms, they are not *distinctive*. We will discuss the legal requirements of what constitutes trade mark *distinctiveness* in the next 2nd article series.
2. At its core, a trade mark indicates the **trade source** from which the goods originate in order to identify the entity providing the goods or services. This is known as the **origin function**. It enables consumers to recognize where a product or service comes from without necessarily knowing the company's corporate history. Secondly, a trade mark acts as a guarantee of the quality of the goods or services. This is known as the **quality function**. It signals consistent quality, allowing consumers to associate the trade mark with a particular standard and experience. Finally, a trade mark serves as a marketing tool. It builds brand recognition, fosters customer loyalty, and creates commercial value. The law protects this value by allowing the owner to prevent others from using an identical or confusingly similar mark in a manner that could mislead consumers or weaken the brand.

CONCLUSION

Understanding what a trade mark is and the functions it performs is the first step in building a strong brand. Simply having a trade mark is not enough. The real question is whether it is distinctive enough to identify one's business and to qualify for legal protection. **In our 2nd article series, we will explore the qualities of a strong trade mark/brand.**

If you have any questions arising from this article, you can contact the intellectual property law team from LEX Africa's member in Kenya, Kaplan & Stratton:



Patrick Ikimire, Partner

Pikimire@kapstrat.com



Georgette Thuku, Associate

Gthuku@kapstrat.com