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If My Business Name Is Similar To An Existing Business, Could This Be Trademark Infringement?

[Kristie Prinz](#)

Q. I am starting a business and have chosen a business name. However, I have discovered that another existing company has a name that is somewhat similar to mine. For example, let's say that my company's name is "Pretty Princess Books." The other company's name is "Princess Books." Would I be infringing on the other company's rights if I chose to name my company "Pretty Princess Books"?

-- Anonymous

A.

Based on the information you have provided, if you go forward with the name you have selected for your business, then the other company already using a similar name may have a valid claim of trademark infringement against you.

What constitutes a trademark? Section 45 of the Lanham Act, 15 U.S.C. Section 1127 states:

[T]he term 'trademark' includes any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if the source is unknown.

In the example you have provided, "Princess Books" clearly constitutes words that identify and distinguish goods of a particular company in commerce, satisfying the definition of a trademark under federal law, as does the proposed name of your company, "Pretty Princess Books" which will likewise constitute a trademark under the same definition.

So, where is the problem? Well, the problem lies in the fact that, because the names are so similar, a court may find in any trademark action against you that your use of the "Pretty Princess Books" mark creates a likelihood of confusion as to the source of the goods in question.

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Courts typically look at seven factors to make this determination, which are as follows:

1. the strength of the mark;
2. the similarity of the marks;
3. the relatedness of the goods;
4. the evidence of actual confusion;
5. the sophistication of the buyers;
6. the defendant's intent in selecting the mark; and
7. the likelihood of expansion of the product lines.

Section 32 of the Lanham Act further states that trademark infringement exists when:

Any person who shall, without the consent of the registrant--

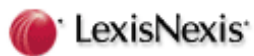
1. use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
2. reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

While it is not clear from your example as to what the ultimate result would be on any action taken against you on trademark infringement grounds, there is little doubt that the existing company's position would have some merit. As a new business owner myself, it is my view that it would probably be best for your new business if you could simply avoid the discussion on this issue altogether and select a new name, since this issue, regardless of the outcome, will divert your attention and focus from building your business to defending your business. This type of diversion can be very detrimental to any new business.

From a legal perspective, however, I would consult with an attorney specializing in trademark law in your jurisdiction to discuss the specifics of your particular matter. Your attorney can look at the specific marks at issue and advise you as to the likelihood of litigation against you and what your options might be if such a case arises. After you have spoken with this attorney, you should be in a position to make a definitive decision on how best to proceed.

-- *Kristie Prinz*

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