



BRANDING

## What Happens When a Big Company Uses Your Brand Name? BY JILL KRASNY

App maker FiftyThree faces an uphill battle to remain relevant now that there's another app--just launched by Facebook--with the same name as its signature product.

*Update: FiftyThree filed to trademark the creative drawing app's moniker on Jan. 30, 2014, the same day Facebook unveiled its news-reading app of the same name.*

When Mark Zuckerberg announced last week that Facebook's new news reading app would be called Paper, it came as a shock to FiftyThree, the New York startup whose iPad drawing app had the same moniker. "Not only were we confused but so were our customers and press," wrote co-founder and CEO Georg Petschnigg on the company's blog. "Was this the same Paper? Nope. Had FiftyThree been acquired? Definitely not. Then, what's going on?"

The fact was, FiftyThree, like many startups before it, had fallen victim to its product's generic name. No matter that its app inspired 100 million ideas, as Petschnigg wrote, or received iPad App of the Year honors in 2012 from Apple. The name was so useful, so perfect, in fact, that Zuckerberg's company apparently couldn't be bothered to check if another business had used it. (Although to be fair, GeekWire reports that FiftyThree holds a trademark on the full

product name "Paper by FiftyThree," but not on "Paper" itself.)

"That's the problem with choosing a brand name that is such a common word," says Denise Lee Yohn, a brand-building expert who's worked with all-stars like Sony and Oakley, and the author of *What Great Brands Do*. "You can see how a lot of different companies would be thinking about services that fall under a brand name like that. I'm not saying that FiftyThree asked for it, but they should have known that was one of the consequences of choosing that name for their product."

Scrappy upstarts can probably relate to being torpedoed by a prominent corporation since they're used to being the underdog. After all, what is entrepreneurship if not being the David to someone's Goliath? Unfortunately, FiftyThree has found itself in a sticky situation, given that Facebook is one of the most recognizable Goliaths in the world. If this were another startup, perhaps FiftyThree would have a shot at grabbing its attention, but with a billion users to think of and pressure to turn profitable after its bungled initial public offering, "Mark Zuckerberg has other things on his mind," says Yohn.

Yohn says FiftyThree could try to sue Facebook for trademark infringement, despite not holding a trademark on the word, but it's unlikely to get very far. "In other circumstances, they could still make a case that they started using this trademark well before Facebook," she says. "But again, because it's generic that's going to cause problems." Facebook could claim it owned the trademark, or worse, point out that plenty of other things use the word paper. It's just not a compelling enough argument.

If it were inclined, FiftyThree could try to change the name of its product before it's too late. However, Petschnigg, tells *Inc.* that he would be reluctant to do so since "FiftyThree's story began with Paper."

Going forward at least, the startup should focus on avoiding generic words altogether, Yohn says. Not only are they harder for people to remember, they often require a little more creativity when choosing Web domain names. As a general rule, go for something that's more "evocative of the connection you're looking to create" with your users, she says. "Those are richer and more ownable."

And if you really believe in your brand, be sure to trademark it as much as you can. Here's hoping that FiftyThree is trying to do that with its other creative app, Pencil.

LAST UPDATED: FEB 3, 2014