

Choosing A Trademark

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A court holds that WINDSURFER is not a protectable trademark. The Trademark Office refuses to register GLUE STIK, saying it is only a misspelling of "glue stick." ULTRA PURE for a chemical is found to be so highly descriptive it is denied a trademark registration. Another court finds that the owner of the magazine title SOFTWARE NEWS cannot stop others from using it. How can this happen? Because the wrong type of term for a trademark was chosen, because a skilled trademark attorney was not consulted when the term was chosen, or because the trademark owner allowed the term to fall into the public domain.

Which terms should be avoided? Terms that have direct meaning in relation to goods or services have to remain available for all those in your industry to use to describe their goods or services. There are two categories of these terms, "generic" and "descriptive." The common or "generic" name of the product or service (eg. "shirt" for shirts and "chair" for chairs) can never be a trademark.

"Descriptive" terms may serve as trademarks, but can be very difficult to register and stop others from using. These are terms that describe a feature or function of the goods, such as GLOSSY for floor polish. Marks (short for trademarks or service marks) may also be descriptive of geographic origin, such as PALO ALTO SUPPLY for a business located in Palo Alto. Terms which are superlative or laudatory, such as SUPER, BETTER, EASY, PRO, PROFESSIONAL, and ADVANCED, are also considered descriptive. Merely misspelling a term may not avoid descriptiveness. KWIK still means QUICK.

A stronger category of words, from a trademark point of view, are terms which convey only a "suggestion" of what the goods or their characteristics might be or comprise. For example, ORACLE suggests seeing into the future; HERCULES suggests strength; WORDSTAR suggests excelling in manipulating words.

Real words with a real meaning, but that have no meaning in relation to the goods, are called "arbitrary." Arbitrary marks are stronger still than suggestive marks. Some examples of this are LOTUS for a car or software; SIDEKICK for a desktop organizer computer program; DISCOVERY for toys; and APRICOT for computers.

Made up terms with no meaning in any language are the strongest trademarks. These marks are dubbed "coined" or "fanciful." Examples include KODAK, XEROX, and CUTEX. Sometimes they contain components that are suggestive of the product, such as CLOROX, which has the misspelled prefix of one of its primary ingredients.

Armed with these principles, you are better able to select trademarks that are more easily protected and "stronger." Of course, advertising personnel often prefer marks that have some descriptive meaning to convey an idea of the product's attributes to consumers. Your trademark attorney prefers marks that are suggestive, arbitrary or made-up terms, rather than descriptive terms. There are, however, ways to accomplish the advertiser's goal without sacrificing trademark strength. A few tips:

1. Combine two highly suggestive components into one mark. A combination of two highly suggestive or even descriptive components can create a mark

which is much stronger than its component parts. Examples include WORDSTAR, MULTISOFT, and RAYBAN.

2. Stay away from terms that are widely used in the particular field or "diluted." Diluted terms are given a very narrow scope of protection because of the sheer numbers of them. Some examples are POWER, MINI, PLUS, ULTRA, PACK, STAR, MASTER, SYSTEMS, and DATA. A professional trademark search will show you just how diluted a term is.

3. If a weak (generic, descriptive) component of a mark is considered necessary, combine it with more distinctive components. An example might be SIZZLE CALC for a spreadsheet tool.

4. Combine descriptive components in unique way, for example, DISPLAYWRITE for a word processing program.

5. Use double meanings, such as SOFTSELL for a software distributor, YANKEE DOODLE for a drawing toy, and MY WORD! for a word processor.

6. Many foreign countries are much stricter than the United States in terms of the registrability of descriptive terms. If you anticipate selling your goods in a foreign market, choose a suggestive, arbitrary or fanciful term. Each foreign country has its own unique trademark laws. For example, in Great Britain, you cannot register as a trademark the name of a living member of the royal family, such as Prince Charles. In several countries, it is difficult to register single letters and acronyms as trademarks. If foreign use is contemplated, consult your trademark attorney.

7. Over time, the strength of weak trademarks can be enhanced through sales and advertising of the product in association with the mark. The association that a consumer acquires between your mark and your product is called "secondary meaning." The process can take considerable time and advertising dollars, however.

8. Once a trademark is chosen, it should be searched to determine if it is available. Use a trademark expert and obtain a full search which covers phonetic equivalents, non-registered uses, etc. It should then be registered federally.

9. Use the trademarks properly with guidance from your trademark attorney. Improper use could result in the loss of your trademark rights. In fact, this is what happened to the owners of the former trademarks CELLOPHANE, ASPIRIN, THERMOS, ESCALATOR, MURPHY BED, BUNDT, YO-YO, SHREDDED WHEAT, and KEROSENE. One aspect of proper use is to use your mark as an adjective preceding the generic product name (e.g., EQUAL artificial sweetener). It is especially crucial that "descriptive" marks be used properly. The last thing you need is to have an accused infringer use your own advertising literature to prove your mark is merely descriptive, and not a trademark.

By following these tips, you can give your company trademarks a better start in life.

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