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The name game: Tips for choosing your trademark

A well-chosen trademark can, if properly used and maintained, create and keep customer loyalty forever. In addition, a strong mark will not conflict with other pre-existing marks; it will be registerable with the United States Patent and Trademark Office; and it will be protectable against infringement.



INSIDER VIEW

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The two main concepts to understand in choosing a mark are distinctiveness versus descriptiveness, and likelihood of confusion.

Most people are not aware that trademark law exists to protect consumers from confusion. A trademark identifies a particular source for a product or service in the eyes of consumers. Therefore, for a name to function as a trademark, it must be distinctive.

Distinctive vs. descriptive

A mark can be distinctive in three ways. (Actually four. More later.) The best way to have a distinctive mark is to have a “fanciful mark,” meaning it is a made-up word, such as Xerox or Kodak. These are the strongest and most protectable types of marks.

A mark can also be distinctive by being “arbitrary” as used with the goods, in other words, taking a term that is usually used with one category of goods and applying it to another. A well-known example of an arbitrary trademark is Apple for computers. These are also strong marks.

Trademarks can be distinctive by being “suggestive,” meaning that the mark hints at the goods, but consumers must think a

bit before figuring out what the mark represents. Good examples of suggestive marks are Coppertone and Roach Motel. Suggestive marks are protectable, but not as strong as arbitrary or fanciful marks.

If your mark does not fall into one of the above categories, it is probably descriptive. A descriptive mark is just what it sounds like — it describes the product or service it represents. Examples of descriptive marks include Bed & Breakfast Registry, Jean Shop and Click & Deliver. Descriptive marks use common terms in reference to their product or service, terms that cannot be protected as trademarks because they are not distinctive and therefore do not and cannot signify a particular source of the products or services to consumers. In addition, others must be allowed to use such descriptive terms to describe their products or services, so such marks are almost impossible to protect.

Now, back to that fourth way to have a distinctive mark. In certain cases, an otherwise descriptive mark can acquire distinctiveness. If the owner of a descriptive mark uses the mark continuously for at least five years and invests in substantial advertising and marketing of the mark, it is possible that consumers will identify that mark with that particular company and the mark will have therefore “acquired distinctiveness.” An example is IBM, or International Business Machines. IBM began using the mark as early as 1920 and persisted with the use of this mark and the use of the initials of this mark until everybody in the civilized world knew that International Business Machines, IBM, represented computers coming from that particular company.

I do not recommend this path. If you are just starting out or just choosing a new mark, it is always better to choose something inherently distinctive.

Avoiding confusion

The second important concept to understand when choosing a trademark is likelihood of confusion. If a chosen mark for particular goods or services is similar enough to an existing mark for similar goods or services such that the consumer might be confused or misled, trademark law prevents the use of the second mark. In the United States, the first user of the mark has seniority — and will win out if the likelihood of confusion exists.

Ideally, companies should choose three marks they like and then complete a search on all three to see which will have the least problems being used, registered and protected. It is highly advisable to engage a trademark attorney for a comprehensive search done.

Search reports will turn up all possible conflicts, including various spellings and phonetically similar marks, which would be very, very difficult for most people to uncover on their own. Search reports also uncover marks that are only slightly similar but are owned by large companies or by particularly protective companies. Search reports also show similar state registrations, “common law” uses, and domain names — none of which would affect the PTO’s review of a federal application — but could represent a senior user who might object to your use and registration through a cease and desist letter, opposition to your application or even a lawsuit.

It is always better to evaluate fully the possible issues and make an informed decision rather than to apply, and then spend much more time, energy and money in dealing with a problem. There is much more to share with you about trademarks, but as far as choosing a good mark those are the basics. Be creative and be careful.

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