

Choosing Trademarkable Names

(Avoid “Taken” or “Merely-Descriptive” Names)

Prospective trademarks fall into three relevant categories: arbitrary/fanciful (good/novel), suggestive (salvageable) and [merely] descriptive/generic (deficient).

Arbitrary/fanciful names are good, like Amazon[®] for an online internet book seller or Apple[®] for a computer company. These names are creative; they are, wisely, a bit peculiar for the product they represent.

Who would instantly think of a South American Rainforest for an internet book seller? Who would automatically think of an edible fruit as a name for a computer? The names are distinctive (and trademarkable) *because* they are so disparate from the product.

The names are sufficiently unique to prevent consumer confusion. These word marks were therefore quickly rewarded with a ® Trademark on the USPTO General Registry.

Conversely, “merely-descriptive” marks comprise words that are not inherently distinctive. These marks blandly describe their industry, often fruitlessly trying to distinguish themselves by adding irrelevant “qualifying words” like ‘best’ or ‘precision’ or “inc/corp/assoc/ltd.” The USPTO TMEP expressly notes that these “qualifiers” do not help distinguish a mark for the American consumer (TMEP §807.14).

Nonetheless, these antiseptic ‘merely-descriptive’ marks may still receive full USPTO registration on the Principal Registry by eventually acquiring a “secondary meaning,” or “acquired distinctiveness” over time (discussed in detail, *infra*). Note, however, that even applicants who successfully secure ® registration for their merely-descriptive marks may face future challenges to their validity or to their exclusive use.

[Merely] Descriptive Marks

Descriptive marks are those marks that merely describe "the intended . . . use of the goods[;] the size of the goods[;] the provider of the goods ... [;] the nature of the goods ... [;] the class of users of the goods ... [;] a desirable characteristic of the goods . . . [; or] the end effect upon the users. Generally, these marks are not protectable.

Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source of the goods, and hence the mark cannot be protected without “acquired distinctiveness,” discussed *infra*.

PHRASES & SLOGANS

If a proposed trademark consists of a phrase that is entirely generic, descriptive or merely informational, the phrase will not be considered a “trademark” and will be denied registrability by the USPTO.

According to the Trademark Manual of Examining Procedure (TMEP): “A phrase is ‘a group of words that are used together in a fixed expression,’ ‘two or more words in sequence that form a syntactic unit that is less than a complete sentence,’ and ‘a sequence of two or more words arranged in a grammatical construction and acting as a unit in a sentence.’

Rules to Successfully Trademark a Phrase

- A. The Trademarked Phrase cannot already be registered by another applicant for a similar product or service;
- B. The Trademarked Phrase cannot simply describe the nature of the product or service;
- C. The Trademarked Phrase must actually be used in conjunction with the sale of a product or service.

ACRONYMS

Rule: the acronym, abbreviations or initials must not be [merely] descriptive; consumers must not be able to recognize them as synonymous with a particular product. Examiners at the PTO have determined that acronyms, abbreviations and initials must have a meaning that is distinct from the generic descriptive terms they represent.

When the above conditions are met, the acronyms, abbreviations or initials may be identifiable to the trademark’s source. This allows acronyms, abbreviations or initials to be eligible for trademark protection.

The Trademark Manual of Examining Procedure’s section concerning acronym trademarks, §1209.03(h), states: [a] mark consisting of an abbreviation, initialism, or acronym will be considered substantially synonymous with descriptive wording if:

- (1) the applied-for mark is an abbreviation, initialism, or acronym for specific wording;
- (2) the specific wording is merely descriptive of applicant’s services; and
- (3) a relevant consumer viewing the abbreviation, initialism, or acronym in connection with applicant’s services will recognize it as the equivalent of the merely descriptive wording it represents.

In order for trademark protection to be extended to include abbreviations, acronyms, and initials, the trademark applicant must prove the letters hold a distinct meaning separate and apart from the underlying words it represents.

*Note: [as with any basic word mark] continuous use, substantial sales and advertising may corroborate a claim to trademark protection of an acronym, abbreviation or initials. A mark can acquire distinctiveness within its market through long-term presence, advertising, and sales when its use is largely exclusive to a particular product or service.

FURTHER DISCUSSION OF THE PROSCRIPTION AGAINST DESCRIPTIVE/GENERIC MARKS

Descriptive marks can acquire distinctiveness and achieve protection if they come to represent not simply a description of a given good or service, but a single source of that good or service. This transformation is known as "acquired distinctiveness" or [loosely] "secondary meaning." As long as consumers identify the mark with a single source, regardless of consumers' ability to identify the source, a descriptive mark can be found to have acquired secondary meaning.

Likelihood of Confusion

The Trademark Act states that all registered mark holders may defend their marks against another's use if that use is in commerce and "is likely to cause confusion, or to cause mistake, or to deceive [the consumer]" The Lanham Act does not, however, define "confusion."

Courts conduct a subjective factual inquiry to determine the level of confusion caused by one mark's effect upon another, or upon the American consumer. To accomplish this, courts employ the eight *Polaroid* factors:

1. The degree of resemblance between the conflicting designations;
2. The similarity of the marketing methods and channels of distribution;
3. The characteristics of the prospective purchasers and the degree of care they exercise;
4. The degree of distinctiveness of the senior user's mark;
5. Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user;
6. Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory;
7. The intent of the junior user; and
8. Evidence of actual confusion.

The above factors will be applied by a Judge and Jury, whose analysis fortunately comprises a "real world inquiry" as to whether American consumers are genuinely confused.

Conversely, USPTO TM Examiners may mechanically apply the "likelihood of confusion" analysis to reject a proposed mark in favor of a preexisting Registered mark even when no logical, legitimate "likelihood of confusion" exists. For this reason, the trademark applicant is advised to choose a creative name, to search the TESS system to ensure the name is absolutely free of already-registered competition [in any permutation derivation or spelling alteration], and then to respond to each stage of trademark prosecution with diligence, candor and transparency.