

# US TRADEMARK SELCTION — FOR HIGH TECH COMPANIES

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For a company in the process of selecting a trademark to register in the United States for goods or services, the process of the actual selection of that Mark is a critical step.

## The Law:

Under US law, trademark law is primarily a consumer protection statute under Federal Law. The overriding principle is to facilitate consumer ability to identify a specific product or service as emanating from a specific source.

Trademarks are divided into several different categories in descending order of protectibility. The best Marks are those, which are either arbitrary or fanciful. These Marks are either made up words which do not have a dictionary definition, or Marks which while existing in the common language, are used in a way entirely unrelated to the goods or services offered. A good example of this latter type of mark is the word "Apple" for computers. (This particular Mark posed no registration problems until the technology and music industry began to grow in proximity and "Apple Corp Music", the Beatle's record company raised concerns, which resulted in both litigation and a complex Agreement to co-exist.)

In the next category of protectible Marks are those which are deemed "Suggestive". That is, a trademark, which suggests a feature or use for the goods or services involved.

Falling below suggestive Marks are the Marks which most new companies seem to want the most. These are called "descriptive" marks, which do exactly what the name implies; they describe the goods or services offered. For obvious reasons, the problem with this type of trademark is one the one hand, a marketing professional is likely to choose this type of Mark since it significantly reduces



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start-up marketing costs. On the other hand, descriptive Marks are routinely rejected by the USPTO.

The final category of Marks are "generic" marks and are also unregistrable. Ironically most generic marks started out as arbitrary or fanciful Marks that were so extensively used (often as an adjective), they were transformed into generic words for certain products. Examples are Thermos, which was originally coined by the Thermos Company for containers to keep hot beverages hot and cold beverages cold. The Escalator Company creator of moving staircases allowed their Mark to become the generic word for all moving staircases irrespective of the manufacturer. Xerox and Google face the same problems. For example the more consumers who use the phrase "to google" something without regard to the search engine used or to Xerox a document, without regard to the brand of photocopier are gradually weakening these previously strong trademarks.

## The Selection Process:

Because the process of selecting and registering a Mark can be time consuming and

expensive, it is often advisable to form a working group for the selection process. Management, marketing, and legal are all essential elements.

Considerations in the process should always start with an attempt to select a Mark that is either arbitrary or fanciful. Marketing may often be resistant since cost associated with a PR campaign can often increase in cost. Another consideration is to examine the use of a unique graphic design in the body of the Mark. In addition, a company with previously registered Marks should consider developing a "family" of Marks which all incorporate a common corporate identity.

The next step is to perform a "screen" of the range of selected Marks online. This is by no means a guarantee that that your choice is available, but may give you the ability to exclude certain selections and identify potential Domain names and search engine placement.

Having narrowed the field, it is essential, prior to filing an actual application that a trademark firm perform a full search.

## Conclusion:

While this article is a very brief summary of the issues which might arise, it should point out the care to be exercised prior to the filing of a formal application.

Finally, beware of words from another language. If an examiner finds that a Mark is merely descriptive while using a foreign language dictionary, the Office may refuse registration.

Consult as early as possible with counsel not only on selection but also the process post registration necessary to police your Mark and renew your Mark at statutorily provided intervals. ■

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