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Robert Berry

Sacred Heart University, berryr@sacredheart.edu

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How to Create a Highly Distinctive Trademark: Orienting Patrons to Trademark Policy in Fifteen Minutes

Rob Berry, Research Librarian, Social & Behavioral Sciences, Sacred Heart University Library, Fairfield, CT

One of the challenges of assisting PTRC trademark patrons is to provide them with a brief overview of trademark policy that is both practical and engaging. One approach is to set aside 15 minutes to prioritize some of the most central aspects of trademark policy and to explain that, by understanding a few basic principles, they will find it much easier to design distinctive marks. A few key areas that are desirable to cover are: (1) the overarching public policy behind trademark law; (2) the role of a mark in identifying the source of goods and services; and (3) the substantive grounds for rejecting marks. Once patrons have a basic understanding of trademark policy, they are in a much better position to create distinctive marks—or to ensure the marks they have already designed are distinctive. This understanding will also help patrons conduct more effective searches.

The public policy explanation can serve as an introduction to the importance of distinctiveness. Once a patron understands the two-fold public policy—(1) to allow consumers to make more informed choices because they can identify the source of goods or services and (2) to protect trademark owners who have invested in advertising and have built goodwill—the importance of distinctiveness becomes clearer. There may be an opportunity at this juncture to add that this policy applies to all four types of marks: (1) Trademarks identifying the source of goods; (2) service marks identifying the source of services; (3) collective marks, such as the mark owned by the PBRA—the Professional Bathtub Refinishers Association; and (4) certification marks, such as the Certified Genuine Idaho Potatoes Grown in Idaho mark.



Because some patrons may find it confusing that the role of a mark is solely as a source identifier—as opposed to being a description of goods or services—it may be helpful to briefly run through some examples of non-traditional marks. Non-traditional marks are great examples of marks that identify the source of goods and/or services without being descriptive. It might be helpful to preface these illustrations by explaining that while most marks are made up of words and/or design elements, in theory any device that identifies the source of goods or services functions as a mark and can be registered. For instance, sound marks (the NBC chimes, an arpeggiated C-major chord); color marks (UPS’s Brown, no. 462C in the Pantone Matching System); motion marks (The Peabody Hotel Duck March); three-dimensional marks (the Rolls Royce Spirit of Ecstasy, or “Flying Lady” hood ornament); texture marks (the David Family Wines leather label); scent marks (Amyris Biotechnologies citrus-scented biofuel); and hologram marks (the American Express Blue hologram) have been registered.

The citrus-scented biofuel example provides an opportunity to address the concept of functionality. The citrus scent functions as a mark because it helps consumers identify the source of the fuel—and not because it has any other functions. Consumers are not buying the fuel for the scent, as they would scented candles. The scents associated with scented candles, on the other hand, cannot be registered as a mark precisely because consumers do purchase the candles for the scents. The scent associated with the candle functions to create a more appealing ambiance when the candle is burning, but does not function solely as a source identifier.

It may be worth mentioning that marks do not identify the source of goods and services in the sense of identifying a manufacturer or retailer, but instead establish an identity for specific goods and services. This allows consumers to easily recognize them and to distinguish from

other similar goods and services. For this reason it is desirable that a mark be inherently distinctive and clearly distinguishable from other marks.

While it is not generally feasible to spend a great deal of time introducing patrons to trademark policy, Section 818 of the TMEP—the Application Checklist—is worth calling to a patron’s attention. TMEP Section 818 alerts patrons to several procedural requirements they must meet in applying for a trademark registration and provides a concise list of the substantive grounds for rejecting an application. Showing patrons the Application Checklist provides an opportunity to highlight some of the most important substantive grounds for refusal. These include refusals because the proposed mark: is the generic name for the goods or services; comprises immoral or scandalous matter; is deceptive; or “so resembles a previously registered mark as to be likely, when used with the applicant’s goods and/or services, to cause confusion.” Because the Application Checklist provides links to TMEP sections discussing the substantive grounds for refusal in detail, it provides a great starting point for patrons.

To emphasize the importance of inherent distinctiveness it may be desirable to quickly explain the hierarchy of distinctiveness with examples. (1) Fanciful marks, which consist of invented words or phrases, are the strongest marks in terms of distinctiveness (Polaroid, Xerox, Pepsi, or Exxon). (2) Arbitrary marks, which consist of recognized words or phrases applied to a situation which they do not describe, are also very strong (Apple applied to computers, Black and White applied to scotch, Victoria’s Secret applied to Lingerie, or La Veuve [French for “The “Widow”] applied to Champagne). Also strong in terms of distinctiveness are (3) Suggestive marks. These connote some quality, characteristic, or ingredient of goods or services, but require the consumer to use “imagination, thought, or perception to reach a conclusion as to the nature of those goods or services” and “to make a connection between the mark and the goods” (TMEP 1209.01(a) (Fanciful, Arbitrary, and Suggestive Marks)). Examples include Orange Crush, Coppertone, and Noburst (an antifreeze/rust inhibitor for hot water heaters).

Less distinctive and more problematic than fanciful, arbitrary, or suggestive marks are Descriptive marks, which describe a good or service. Here, if time allows, it may be useful to mention that these descriptive marks may be entitled to the protections enjoyed by more inherently distinctive marks if it can be shown that they have acquired secondary meaning, that is, that words associated with the mark have acquired a meaning that allows consumers to identify the source of goods or services. This was the case with Warren D. Barton’s Dyanshine shoe polish, *Barton v. Rex-Oil Co.*, 2 F.2d 402, 405 (3rd Cir. 1924). Patrons may find it helpful to know that marks that are capable of acquiring secondary meaning, but do not yet have an acquired distinctiveness, may not be registered on the USPTO’s Principal Register and are not entitled to the full protections of the Trademark Act (including the ability to bring an action concerning the mark in federal court). However, a mark capable of acquiring distinctiveness can be registered on the USPTO’s Supplemental Register.

Finally Generic terms and phrases that are not capable of acquiring distinctiveness (when standing alone) cannot be registered with the USPTO. For example, the term “duck tour” has been held to be generic. *Boston Duck Tours, LP v. Super Duck Tours, LLC.*, 531 F.3d 1 (1st Cir. 2008).

While it is not possible to exhaustively cover trademark policy during a consultation, a short overview provides a handy introduction to searching. For example, while discussing generic marks it might be helpful to refer to a sample trademark record to illustrate how generic terms—including laudatory phrases such as best, fresh, super, or original—are disclaimed in trademark records. This is illustrated by the trademark record for the Original NY Pizza Company of Raleigh North Carolina, which disclaims the exclusive right to use “The Original NY Pizza”, “New York Certified” and “Est. 1991” apart from their use as components of the overall mark.

Once patrons have a brief overview of policy, many of the basic approaches to preliminary trademark searching—such as searching for word and design elements in conjunction with words relating to goods and services—will make more sense to them. While it may be not be practical to cover trademark policy in depth, a brief policy overview will assist patrons in designing distinctive trademarks. While some amount of pure creativity may be necessary to design a striking and highly effective mark, the starting point for trademark design is an understanding of a trademark’s basic functions and the importance of distinctiveness.