

Davee: Initial trademark considerations when advising clients

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When a client begins a new business endeavor, often some of the things they are most adamant and excited about is development and protection of their budding brand, which frequently manifests itself as a desire to pursue federal trademark registration. To achieve this goal, when helping the client form their business, there are several items that should be discussed early on, particularly if the client has any desire to pursue federal trademark registration. (Even if the client has not expressed that desire, the attorney should advise them of the availability and benefits of federal registration, and whether pursuit of a federally registered mark would be appropriate and cost-effective for the business.)

Particularly for small to mid-size businesses, providing early advice to the client on the same before the costs related to entity formation, advertising materials, logo design, business cards, website development, and other expenses associated with startup are incurred, can be especially beneficial. Being on top of such considerations, and making them a part of the initial intake interview, is one way for attorneys to be seen as value-adding rather than money-draining.

First, selecting the name of the business, which is often the touchstone for names of brands, products, product lines, and/or services offered, can be a critical initial determination if brand strength and protection are the goal. If the client has their heart set on a name, running clearance searches of state and federal trademarks — with an eye toward the goods and services the client intends to provide and the geographic space in which they intend to operate — is a good first move to be able to advise on availability or potential roadblocks that may arise. If, however, the client is open to suggestion, advise them of the advantages and disadvantages associated with strong and weak marks, respectively, so that they are fully informed in their eventual selection of a name.

The strength of a mark affects the ease with which it may be registered and protected from unauthorized use, but clients often select weak marks without even knowing they have done so. This is not uncommon because people are often inclined to select marks that describe the function or products of their business. However, a descriptive mark is an inherently weak mark. Trademarks are classified in the following categories, from weakest to strongest: generic, descriptive, suggestive, arbitrary, and fanciful. Fanciful marks are those that are made-up; Google and Kodak are classic examples. Arbitrary marks are those that are existing words, but have no logical connection to the goods and services provided under them; Apple and Amazon, for example. Suggestive marks are those that suggest, but do not actually describe, the goods and services, e.g., Netflix and Chicken of the Sea. Descriptive marks are descriptive of the goods and services or their corresponding characteristics, e.g., Play-Doh and Best Buy. Finally, generic marks are most direct as they simply identify the goods and services provided under the mark, e.g., roller skates and coffee shop. Generic marks are not eligible for trademark protection.

Although clients may be attracted to descriptive marks because they give customers an indication of what their business does, such a mark has its own pitfalls because as marks become more descriptive, they become less distinctive and therefore receive less protection in the marketplace. Specifically, descriptive marks are less likely to be granted a federal registration because the United States Patent and Trademark Office considers them to be “merely” descriptive. Practically, this often means that the mark may be required to spend time on the Supplemental Register until it is able to acquire secondary meaning, at which point the owner may apply to move it to the Principal Register, which affords the full slew of federal registration benefits. Secondary meaning means that, while the mark was initially considered “merely descriptive,” through its use in the marketplace, it has become protectable as a trademark because people associate it with the source of the product, rather than the product itself.

Suggestive, arbitrary and fanciful marks are all inherently stronger than descriptive marks. If a client is in the initial stages of branding, consider advising them of the potential difficulties that can be attendant to generic or descriptive marks. If it fits within the client’s business plan, their best bet for future options relating to trademarks is to select a mark that is inherently distinctive. Although a descriptive mark does just that, if protection of the brand is the goal, arbitrary and fanciful marks are best. •

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