



DESCRIPTIVE TRADEMARKS

The Number One Issue in Selecting New Trademarks

Marketing versus Trademark Law

There is an epic battle being waged between the forces of marketing and the forces of trademark law. Believe it or not, marketing departments and trademark attorneys engage in hand-to-hand combat every day.



Marketers

At the core of the dispute is something called “descriptiveness.” Marketers tend to love descriptive trademarks. From their point of view, the purpose of a trademark is to describe their product or service. The reasons go something like this:

- The marketplace is noisy and our customers have short attention spans. We need to tell our customers what we sell every chance we have.
- If our trademark is not descriptive, it will take a lot of marketing resources to get our customers to associate the trademark with our products.

Trademark Law

Now let's look at the other side of the battlefield. One underlying policy of trademark law is to discourage protection for merely descriptive trademarks. The reason for this policy is straight forward; trademark law should not keep people from using words and symbols that describe what they sell.

Descriptive Trademark

Let's say that a clothing company obtained trademark protection for the word COTTON used with shirts. Other clothing companies would then not be able to use COTTON to describe their shirts.

Most people would agree that this is a bad result. It gives the trademark holder an unfair monopoly on a word that manufacturers commonly use to describe their products. Instead of COTTON SHIRT, a competitor may have to label the product as SHIRT MADE FROM GOSSYPIUM HIRSUTUM FIBERS.

Not only is this inefficient, but most people would not know what it means. This descriptive phrase would become a trademark and other manufacturers would have to find new descriptive terms. The cycle would continue.

The Battle Rages On

When we review new trademarks, descriptiveness is by far and away the most common issue. But companies should avoid descriptive trademarks. Here are a few reasons why:

- Descriptive trademarks may be unprotectable. You may not be able to prevent competitors from using the trademark.

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- Even if a descriptive trademark is protectable, it will be weak and it will be more difficult and expensive to enforce your trademark rights.
- Although descriptive trademarks can be registered in some cases, it will be more difficult, expensive and time consuming to register these marks.
- If you ever sell or license your trademark or business, you will receive less value for a descriptive trademark.
- Make a list of the 10 greatest trademarks that come to mind. Chances are good that none of them are descriptive.

How are you going to educate your customers?

Those picking trademarks should understand that the purpose of a trademark is not to educate consumers or to communicate what a product is. The purpose of a trademark is to distinguish your products and services from others. The more unique and distinctive a trademark is the stronger and more valuable it will be.

However, there are a number of powerful ways to educate your customers that do not require descriptive trademarks. Here are a few to consider:

1. Taglines.

One of the best ways to educate consumers is through taglines. Taglines are short descriptive phrases that can be placed on marketing material. They are often placed close to a trademark. You can use taglines to briefly describe the product or service that you are offering. The key with taglines is to make them short; the shorter the better but usually less than eight words. Here are some examples:

- For virtually spotless dishes. (Cascade)
- Kills bugs dead. (RAID)

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- Adhesive Bandages (Band-Aid)
- Facial Tissues (Kleenex)

2. Slogans.

Slogans are similar to taglines, except they are less descriptive. Slogans are often trademarks in themselves because they are not merely descriptive, but they are often suggestive of the product. Slogans are also great for calling customers to action, injecting humor, providing a mental image and evoking an emotion or state of mind. Slogans can make a play on words and they can rhyme. Here are a few examples:

- Just Do It (Nike)
- Reach out and touch someone. (AT&T)
- Got Milk? (milk producers)
- Think outside the box. (Apple)
- Takes a licking and keeps on ticking. (Timex)
- Dream • Build • Protect (ATIP Law)

3. Images.

One of the most powerful ways to describe your product is with an image. Your trademark can be placed over or adjacent to an image related to your product or service. Images can be used with many different types of marketing media, except of course with audio-only media.

4. Logo

A logo can be used to describe some aspect of a product. While the logo as a whole must not be merely descriptive if you want it to be a protectable trademark, there is usually no problem incorporating a descriptive element into a logo. For example, a

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tire company logo could include a tire and a travel company could include an aircraft.

5. Suggestive Trademarks.

A trademark may be suggestive. That is, the trademark requires some imagination or thought on the part of the consumer to identify a quality or characteristic of a product. Here are some trademarks that have been found to be suggestive by the Trademark Office:

- SPEEDI BAKE for frozen dough
- NOBURST for antifreeze
- DRI-FOOT for antiperspirant deodorant for feet
- SNO-RAKE for snow removal hand tool
- TINT TONE for hair coloring

None of these trademarks plainly describe the product, but you can perceive some aspect of the product from the trademark.

6. Descriptive Elements.

A trademark should not be merely descriptive, but it can incorporate descriptive elements. Although these are not the strongest trademarks and we do not generally recommend them, part of a trademark may describe the associated product. The descriptive element will likely have to be “disclaimed” before the trademark can be registered.

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7. Text.

If all else fails, use text to describe your product. There is nothing wrong with using a short sentence or two to tell your customers what your product is or why they should buy it.

About the Author



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Burns is also a speaker, inventor, entrepreneur and angel investor and he enjoys many outdoor adventures.

About ATIP Law

American Technology & Intellectual Property Law is a law firm based in Nevada that practices primarily in intellectual property and business law. We help companies develop, secure and maximize the value of their intellectual property. We take the time to get to know our clients and to understand their specific needs and business situations. We create and execute custom strategies that achieve our clients' goals.

Contact Us

We really enjoy talking with entrepreneurs, innovators and pioneers in all fields. Please contact us with any questions, comments or suggestions you may have.

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