

Don't Be the Next Blank Solar

(Selecting a Strong Trademark for Your Start-Up)

A search of the United States Patent and Trademark Office records reveals over 1000 trademarks that include the word 'solar' for something related to solar. Talk about lost in the crowd. Be smarter than that!

We routinely represent start-ups and established companies whose marketing personnel just don't 'get it' when it comes to selecting a new trademark that is 'legally' strong. That said, what may be a strong trademark from a legal standpoint may not necessarily be a strong standpoint from a marketing standpoint in all situations, and we get that. However, for a long-term brand that is going to be important to your organization for the foreseeable future, a strong (i.e., legally strong) trademark is going to help avoid consumer confusion between your organization and your competition, and it is going to help your organization sell more products in the long run. In this brief article, I discuss what makes a trademark a strong and valuable trademark.

Briefly, a trademark is any word, name, symbol, device (~other thing~), or combination thereof used to designate the source of a product or service. It's your product's name. It's your company logo. It's the unique look of your product or product packaging. It's anything that distinguishes your product or service from your competition. It theoretically protects the public, because they know the quality of the product or service based on previous purchases of a product or service under the same trademark. When you purchase an Apple® computer, you expect it to be of the same quality as the Apple® smart phone that you own. When you go to a Nordstrom® department store, you expect to receive the same quality of service you received last time, or that you received at another location across the country.

Words, when used in a trademark sense, fall into one of five categories of distinctiveness on what we IP-types call the spectrum of trademark distinctiveness. These categories are identified below in increasing order of strength.

1. Generic words – words that simply identify, by definition, the product or service being sold (e.g., 'apple' for apples).
2. Merely descriptive words – words that describe some aspect of the product or service being sold (e.g., 'red delicious apple' for red (and presumably delicious) apples, or 'Washington apples' for apples from Washington).
3. Suggestive words – words that may suggest an aspect of the product or service being sold (e.g., 'Nike' for shoes, because Nike is the name of a goddess associated with victory. Therefore, 'Nike' may suggest that if you wear Nike® shoes, you're going to run faster than your competition).
4. Arbitrary words – existing words that have nothing to do with the product or service being sold (e.g., 'Apple' for computers).
5. Fanciful words – made-up words (e.g., Kodak, Verizon, Starbucks, Xerox).

Generic words (category 1) can never serve as a trademark. And this makes sense. One apple stand should not have the exclusive right to brand its products as 'apples,' because competitor apple stands need to be able to identify the fruit that they are selling.

Merely descriptive words and phrases (category 2) cannot initially serve as a trademark. And again, this makes sense. One apple stand should not have the exclusive right to be able to appropriately describe its products as 'red delicious apples,' if indeed the apples are red and delicious, again, because competitor apple stands should be able to appropriately describe their own red and delicious apples. However, over an extended period of time, a merely descriptive word or phrase may become recognized as a trademark in the minds of consumers, despite the descriptive nature of the word or phrase. For example, while the phrase 'red delicious apple' is not technically a trademark owned by any single entity, for argument, let's pretend that it is. When you see a Red Delicious Apple, you are pretty sure that it is going to taste similar to the last Red Delicious Apple that you ate, not only because it looks similar to the last one that you ate, but because the sign on the basket at the market indicates 'Red Delicious Apples.' This connection in a consumer's mind effectively makes the phrase a trademark. We call this 'acquired distinctiveness.'

Examples of merely descriptive phrases that now serve as trademarks for their owners include Rice Krispies (crispy puffed rice), Coca-Cola (cola made with coca), Hemp Balm (balm made from hemp), and the list goes on.

Suggestive, arbitrary, and fanciful words and phrases may immediately serve as trademarks for their owners, and therefore are considered to be inherently distinctive. That is, it does not take a period of time for these categories of words and phrases to acquire rights associated with them. Accordingly, they are legally stronger than descriptive marks. These are the marks that you want to select for your organization's brands!

Sometimes it may be (or at least you may think that it is) initially desirable to pick a descriptive name for your company or your primary product or service, because you think that it will help consumers find you, such as with online searches, and know what it is that you do and sell. Moreover, if you can convince the public that you own the descriptive word or phrase, then it will pop into their head whenever they think about needing a particular category of product or service. Unfortunately, it is going to be very, very expensive to convince the public—i.e., to educate the public through advertising campaigns—that the descriptive word or phrase is a trademark. In the meantime, your competition can use similar if not identical words and phrases to describe their own products and services—effectively pulling your customers away from you, even if by mistake. Additionally, even after you potentially acquire rights to the descriptive word or phrase, your competition can still use those same words in a descriptive manner (since that's what they mean); they just may not be able to use them in a trademark sense, such as in a logo or name of a product. Why ask for this headache when you are selecting your core brand? Why start with an uphill battle requiring enormous advertising budgets just to educate the public on the name of your company or product? Why choose words that your competition may use and may have the right to use no matter what?

Lesson? At least choose a suggestive mark, and the more arbitrary it is, the stronger it will be from a legal standpoint and from a long-term brand value standpoint. Make up a word! What are the chances that your competition is going to come up with the same made-up word? Zero! What are the arguments that your competition should be able to use your made-up word to brand its own products? There aren't any!

An example that I see in the consumer products industry all the time these days is the use of the word 'green' in connection with a product name. Green this. Green that. Green the other. I can't keep them

straight! What's the use in selecting a trademark that will prevent consumers from remembering which product is which.

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