

The logo for Astrachan Gunst Thomas features a stylized, swirling blue graphic behind the text. The text "astrachan gunst thomas" is written in a lowercase, sans-serif font, with "astrachan" and "thomas" in black and "gunst" in blue.

astrachan gunst thomas

a professional corporation
attorneys at law
baltimore . washington, d.c.
www.agtlawyers.com

Advertiser's Guide to Choosing Effective Trademarks

By: Jim Astrachan

Advertising is not run without mention of the brand- not even political advertising. Brands speak to consumers. Brands communicate a product's source and serve as a point of comparison for competing products.

Brands allow consumers to select the same product over and over again without effort; brands become associated with consumers' expectations. Soap versus Ivory soap, for example. What marketers refer to as brands, courts and lawyers call trademarks.

Trademarks convey sources of goods and serve as a focal point for comparative advertising- advertising in which one manufacturer compares its goods to its competitors'. Trademarks, then, should convey to consumers certain impressions of the products they mark, and at the same time be protectable against marks that are similar in sight, sound or commercial impression.

A mark can be wonderfully clever, but if every competitor is free to use a similar mark, the mark will not serve its basic function – to distinguish the goods and services it brands from those of a competitive product.

Advertisers have a propensity for branding products with marks that describe the product's attributes or qualities. Doing so saves advertising dollars because the brand itself serves to educate the consumer. Now, think EVERSHARP for cutlery; NEVERMAR for linoleum. These brands immediately convey to the consumer a certain quality of the product. Think EXXON or KODAK. If a consumer is not already familiar with the products associated with these made-up words, he would be clueless. It took a lot of advertising dollars to create association between brand and product when the brand is a made-up word. But made-up words are highly protectable against infringement, while descriptive marks are not. Infringement occurs when someone other than the brand's owner uses the same or a confusingly similar term on the same or a related product or service in the same market. It is critical for an advertiser to be able to

prevent infringement of its mark- but often it cannot, only because it chose its mark poorly.

The strength of a mark is critical to its protection. Trademark law classifies those words, symbols, sounds, smells and devices that serve as trademarks into five categories. *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 284 (2d Cir. 1976).

Generic Marks

At the lowest end of the protection spectrum, where no protection is available, are the generic words; words that describe the product itself. They are never protectable against another's use and are not capable of serving as trademarks. They cannot be registered. Spoon, bottle and pitcher are examples of generic marks when used in conjunction with the goods they describe. They answer the question, "What is it?".

Many generic marks did not begin that way. How an advertiser advertises or uses its own mark, or allows the public to use it, can cast the mark out into the public domain and make it generic. When that happens, the mark ceases to describe the source of the goods and, instead, describes the product. Years ago, BAYER lost its trademark ASPIRIN when its advertising referred to the product as BAYER brand aspirin. Druggists and consumers began to refer to BAYER tablets as aspirin. By the time BAYER woke up it was too late to save the brand as it had slipped into the public domain. Today, every manufacturer of acetylsalicylic acid can describe their products as aspirin. ESCALATOR, DRY ICE, NYLON, KEROSENE, THERMOS, YO-YO, TRAMPOLINE, SHREDDED WHEAT, CUBE STEAK and CORNFLAKES once marks, are now mere words that describe the type of product. Any seller can use them.

Other famous brands are on the brink of genericide. "XEROX this paper"! "I'm going to buy a pair of LEVIS". "Bring me a STYROFOAM cup". "Hand me a KLEENEX". These are but a few examples of the way marks are ill-used that make these owners of famous brands cringe. Years ago a Judge Learned Hand wrote of BAYER and ASPRIN,

What do the buyers understand by the words for whose use the parties are contending? If they understand by it only the kind of goods sold them, I take it, it makes no difference whatever what efforts the plaintiff has made to get them to understand more. He has failed... .

Bayer Co. v. United Drug, 272 F. 505 (S.D.N.Y. 1921). Once the brand describes the type of goods, it is lost as a brand.

For years, XEROX has spent large sums on advertising to educate people that XEROX is a brand. One of its ads reads,

XEROX is a tradename and a registered trademark.
...It identifies our products. And it shouldn't be used
when referring to anybody else's copies, paper,
duplicator, whatever.

Other famous brands on the slippery slope of generocide are TABASCO, KLEENEX, REALTOR, BACARDI, KOTEX and PLEXIGLASS.

Some advertisers, like MATTEL, have gone to unrealistic lengths to prevent all uses of their brands even outside the context of advertising. Consider Mattel's ill-fated suit against AQUA'S recording label over lyrics parodying BARBIE and KEN in which the singers made fun of BARBIE's societal role. *Mattel, Inc. v. Universal Music International*, 296 F.3d 894 (9th Cir. 2002). Next, Mattel sued a photographer who was using BARBIE body parts in his photographic art. *Mattel, Inc. v. Walking Mountain Products*, 353 F. 3d 792 (9th Cir. 2003). Mattel lost both cases hands down. It should have. These were First Amendment cases that did not deal with commercial advertising. They concerned art and music. Judge Alex Kozinski summed up the court's feeling in the Aqua case when he wrote "If this were a sci-fi melodrama, it might be called Speech-Zilla meets Trademark Kong." The Judge also stated that no one should be able to prevent him from saying he could "put a BAND-AID on the problem". His point was that famous brands are becoming figures of speech, and their use as such will not be enjoined.

Descriptive Marks

If advertisers are fearful of the cost advertise a made-up mark, they simply adore the category of marks called descriptive for the opposite reason. Lawyers have been known to take long lunches when clients demand they protect their descriptive marks, for they cannot until the mark is said to be distinctive of the client's goods and services -- something the Lanham Act says happens after five years of continuous use, it can be protected, although the owner of a descriptive mark may be able to prove that the mark has become distinctive prior to five years' continuous use, often through expenditure of substantial ad dollars.

While a generic mark is never protectable against another's use, a descriptive mark starts off unprotectable and unregistrable with the United States Patent and Trademark Office and stays so until its owner can prove it acquired what is called "secondary meaning". A shorthand way to describe secondary meaning is to say that the mark associates the product with the source of the product in the minds of consumers, meaning that consumers will understand that the mark identifies the goods

or services of a particular person. Federal law presumes that secondary meaning exists after five years of continuous use.

It's hard to understand why advertisers are so enamored with descriptive marks that require proof of secondary meaning before they can be registered or protected against infringers. During the time that the mark is striving to achieve secondary meaning, the advertiser is spending money on promotion. That money is largely wasted if a competitor adopts the mark before secondary meaning is achieved.

Secondary meaning can be weak or strong. A weak showing, although capable of creating trademark rights, can severely limit the ability of the mark's owner to prevent third-party uses of similar, but not identical, marks or identical marks on non-competitive products, even in similar product categories.

Proof of secondary meaning is not necessary to establish rights in the next three categories of trademarks, as inherent distinctiveness, or secondary meaning, is presumed from the moment the mark is adopted. Why, then wouldn't advertisers adopt these marks more readily than descriptive marks? The answer in one word is "cost."

Suggestive Marks

Suggestive marks are the third category of marks, and they are protected immediately upon use because they are considered inherently distinctive. Not everyone can agree on whether a mark is descriptive or suggestive. The Federal Trademark Trial and Appeal Board affirmed a Patent and Trademark Office Examiner's refusal to register BROWN-IN-BAG on the grounds that the mark was descriptive. A federal court reversed, finding BROWN-IN-BAG suggestive, and not descriptive, of cooking methods, because browning was not the sole purpose or function of the product. *Applications of Reynolds Metal, Inc.*, 480 F.2d 902 (C.C.P.A. 1973).

It's difficult to describe how to test a mark to determine whether the mark is suggestive or descriptive. At least one court held that it need not distinguish between suggestive and descriptive as long as it can be determined that the mark is not descriptive, because if the mark is not generic or descriptive, it is inherently distinctive, regardless of whether it is suggestive, arbitrary or fanciful.

Courts have, however, adopted the "imagination test" to test for suggestiveness. If the customer's imagination is needed to draw a line between the product and its brand, likely the mark is suggestive. Think ESKIMO PIE. A cold, flat serving of ice cream -- similar to a deep-frozen pie; COPPERTONE suntan lotion; CHICKEN OF THE SEA canned tuna; HANDIWIPES dust cloths; and WRANGLER jeans. Each requires a modicum of imagination.

Arbitrary Marks

Arbitrary marks can be very strong and provide immediate protection against infringement. They are words in everyday use applied to wholly unrelated products. They are also inherently distinctive. Like the lines between suggestive and descriptive, the lines between arbitrary and suggestive can be blurred. Take, for example, the basketball team WIZARDS, a mark that might appear arbitrary, but was held to be suggestive. *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084 (D.N.J. 1997). The reason why WIZARDS, applied to a basketball team, would appear arbitrary is because an arbitrary mark is generally defined as a word or device in everyday common use without association with the product it brands.

PIONEER stereo equipment; APPLE COMPUTERS; and the MUSTANG car are examples of arbitrary marks, each protectable against infringement from first use.

Arbitrary marks are relatively strong and capable of registration and protection from first use, but they are not without a negative aspect, which, from the advertiser's perspective, was described by the Second Circuit Court of Appeals:

By repeatedly advertising the fact that the cocktail is made from the combined juice of eight vegetables, the plaintiff has undoubtedly taught the purchasing public... .

Standard Brands, Inc. v. Smidler, 151 F. 2d. 34 (2nd Cir. 1945). V-8 was the brand, and the advertiser's burden, recognized by the court, was the need to engage in repetitive advertising in order to "teach" the public about the brand or its attributes. Repetitive advertising, reach and frequency costs money -- lots of it.

But it would be hard to imagine that any drink or food manufacturer would dare to label its product V-8. In the food category, the mark is very strong and highly protectable. Yet V-8's owner is impotent to stop FORD from describing its car engines as V-8s or MOTOROLA from naming a phone The V-8. That's the risk faced by an advertiser who adopts an arbitrary mark. Others, in different product categories, may be using the mark and the manufacturer will not be able to prevent use of the mark in those categories, unless it can prove that a new use is so close to its category that it is likely the manufacturer would enter that market or an appreciable number of consumers would believe that it did.

Fanciful Marks

Fanciful marks are made-up, or invented words, and they are the strongest of these marks, meaning they will receive the most protection. Owners of well-known fanciful marks usually do not worry that courts will refuse to prevent others from using

their marks on unrelated products. If an advertiser seeks a virtual monopoly on the use of its mark as a brand, a fanciful mark is its best choice. VIAGRA snow shoes; EXXON water coolers; KODAK baseball bats? Not likely to ever happen, because the marks are so strong consumers would believe that the brand's owner was the source of the new product or that there was an affiliation between them. Either way, infringement occurs.

Fanciful words are literally invented to be applied to products as brands, or they may be real words totally removed from common usage. An expensive art is involved in creating these words. Consider VIAGRA. It is no coincidence that it sounds like VIGOR and NIAGRA FALLS.

Fanciful marks are the strongest of all marks, but they are born without any public association to the product they brand. That association only happens through advertising and promotion. The investment may be large, but if exclusivity, regardless of category, is what the advertiser seeks, fanciful marks are the ticket.

Conclusion

To be sure, lawyers and marketing persons view marks from different perspectives. Marketing persons typically want brands that immediately communicate product attributes to potential consumers. It's safe; it costs less. Lawyers want brands that can be protected from infringement. Judge Learned Hand, a lawyer himself before become a jurist, wrote:

I have always been at a loss to know why so many marks are adopted which have an aura, or more, of description about them. With the whole field of possible coinage before them, it is strange that merchants insist on adopting marks that are so nearly descriptive. Perhaps they are willing to interject into the name of their goods some intimation of excellence, and are willing to incur the risk.

Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc., 297 F. 247 (D.N.Y. 1923).

I, too, have always been at such a loss, but then again, I never had to squeeze reach and frequency out of a limited advertising budget.

James B. Astrachan is the author of The Law of Advertising, published by Matthew Bender-Lexis/Nexis.