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Start with a strong trademark when branding a technology

Practically any word, slogan, phrase, name, or symbol that distinguishes a seller's products or services from others can be classified as a trademark. To properly brand its technology, however, a company should apply four rules, says Doug Elliott, a partner in the Houston office of Patterson & Sheridan LLP, a national intellectual property law firm.

RULE NO. 1: SELECT A STRONG TRADEMARK

"The best time to develop a strong brand is at the beginning when the technology is initially presented to the public, keeping in mind the law gives different levels of protection based on the trademark type," Elliott says. He lists five types of trademarks:

- **Generic term** — the weakest type of trademark.

"This should be avoided at all costs," he says. "Generic marks receive no protection as they are simply the common name of a product or service."

For instance, the term "fruit" applies equally to apples, oranges, and grapes.

To identify whether the proposed trademark is generic, Elliott says to ask several simple questions: Do others in this particular industry already use this word? Is the word used as a noun? Does the same word apply equally to similar products or services offered by different companies?

"If any answers are 'yes,' then steer clear of that proposed trademark," he says.

- **Descriptive term** — another weak trademark which identifies some characteristic or quality such as color, odor, function, dimensions or ingredients. An example would be "vision center" in reference to a place where one purchases eyeglasses.

"The only way a descriptive word is given legal protection is if the trademark owner can present substantial evidence that the primary significance of the word is not the product, but the producer, and that it denotes a single thing coming from a single, specific source," Elliott says.

- **Suggestive mark** — terms that allude to — rather than describe — an attribute of the good or service.

"They require consumers to exercise their imagination, such as 'Igloo' in connection with an ice chest or 'Bowflex' in connection with exercise equipment," Elliott says.

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Doug Elliott
Patterson & Sheridan LLP

- **Arbitrary mark** — a commonly known word, but the attachment of the word to the particular thing is arbitrary and does not imply anything about the product or service. An example is "Blue Bell" for ice cream.

- **Fanciful trademark** — one that has no meaning except as a brand or trademark. The term "Exxon" is an example.

"Suggestive, arbitrary and fanciful words are all considered strong, and the law gives them instant legal protection," Elliott says.

RULE NO. 2: AVOID INFRINGEMENT

"Make sure the proposed trademark does not create a legal conflict with another trademark by infringing or 'diluting' another trademark," Elliott advises.

"Infringement occurs whenever the mark creates a likelihood of confusion by essentially implying that the products or services for each trademark are associated with the same manufacturer or supplier," he says.

He adds that a host of factors is considered to determine infringement, but "the two threshold questions are the extent to which the two

trademarks are similar, in terms of sight, sound and meaning and the overlap of the products or services, such as whether they are competitive in any way."

Once a potential brand name is selected, an online search of issued or pending trademarks can be performed in minutes, he says. This can be followed up with a more intensive investigation by engaging a company that specializes in trademark searches. The results of the search will provide helpful data in deciding whether a trademark can be used without future conflicts.

RULE NO. 3: PROPER ADOPTION AND USE

"The selected trademark should be used properly," Elliott stresses.

"Even without registration, a company can establish common law trademark rights by simply using the mark in commerce (on labels for products or in advertising for services). Further, it helps to use a 'TM' on all published usages of the trademark, particularly on labels and in advertising, and even on invoices sent to customers," he says. "On the other hand, failing to use the mark at all may result in no trademark rights being developed, and publishing the word without a trademark symbol can create the inference that the word is not actually a trademark."

RULE NO. 4: SEEK REGISTRATION

A company can file for federal registration in the U.S. Patent and Trademark Office and with the Secretary of State for the state where most of the business is conducted.

"Registration carries a number of advantages," Elliott says. "The owner of a federal registration is entitled to not only identify its mark with the familiar circle 'R' (®) but also to certain legal presumptions and benefits," he says. "For example, even a state registration creates a legal presumption that the party registering the mark is the rightful owner and that the registration is valid and exclusive to the registrant."

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