



Confronting the perils of trendy trademarks

Marks using popular components are often the most difficult to protect because of distinctiveness objections or challenges.

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Trademark counsel may increasingly feel they are tilting at windmills when advising clients seeking popular-sounding or trendy marks. For instance, the prefix “eco” and adjective “green” are being used in connection with services, products, ad campaigns and domain names at an ever increasing rate. The popularity of these marks presents a paradox for the trademark practitioner: Trademarks utilizing popular components are often the most difficult to protect because of distinctiveness objections or challenges, yet because they are chosen from a crowded field of similar marks, they may be likely to draw adverse third-party infringement claims. Trademark counsel may be wise to advise the client to buck the trend and select more clearly distinctive, though possibly less trendy, nomenclature.

During the past decade, companies

and individuals have filed thousands of applications for trademarks with environmentally friendly attributes. An unscientific review of the U.S. Patent and Trademark Office (PTO) records shows a significant increase in applications for marks containing “green” and “eco.” The ecologically friendly terms “green” and “eco” were included in approximately 2,500 and 1,200 applications, respectively, during the 1990s. From Jan. 1, 2000, through Jan. 1, 2010, those numbers increased to more than 11,000 for “green” and just more than 4,000 for “eco,” growth that markedly exceeded the growth in PTO trademark filings generally in that period.

Countless more eco-friendly marks are being introduced into the marketplace without attempts at registration. Whatever the societal benefits of this eco-friendly nomenclature trend, there is apparently a marketing edge to be had. Because the client and not trademark counsel decides

product names or new brands — often based on marketing analysis of popular trends — attorneys can only encourage clients to select more distinctive (and therefore more broadly and easily protectable) trademarks.

The business client may very well be less concerned by a potential trademark’s fitness for registration or other protection, and the long-term benefit that an uncluttered communication channel provided by a clearly distinctive mark can provide. Clients are often more concerned about the ability of a mark to “speak for itself” through a close connection between the mark and the related goods and services, thereby possibly requiring less up-front marketing cost to establish its meaning to customers. However, the legal issues of clearing and protecting the mark are left for counsel.

As background, the law has defined five types of nomenclature: coined or fanciful, arbitrary, suggestive, descriptive

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and generic. *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763 (1992). A coined mark is one created solely for the product or service to which it will be applied. “Kodak” and “Exxon” are classic examples of marks falling in this most protectable end of the continuum. Also on the distinctive end of the spectrum are arbitrary marks such as “Apple” for computers or “Old Grand Dad” for Kentucky bourbon. Both marks use common words to identify products with no connection to their normal definitions. A suggestive mark is one that suggests what the product or service is but does not actually describe it. Examples of suggestive marks include “Word Perfect” for computer word-processing software, “Greyhound” for bus service and “Passion” for perfume. Suggestive marks, while still inherently distinctive, are less strong than coined or arbitrary marks.

A descriptive term is accorded protection only with acquired secondary meaning that identifies its user to the public as the source of the respective goods or services. Descriptive terms have no source-indicating trademark significance when first adopted and take significant and sustained marketing effort and vigilant policing in the hope of developing the secondary meaning needed for strong protection. Examples of descriptive marks are “Vision Center” for an optical store or “Park N Fly” for a parking facility for air passengers. Finally, generic words are not registerable or otherwise capable of protection, because third parties have the right and need to use the terms to describe the goods or services. These words have become one of the terms to identify a product or service. Generic words such as “shredded wheat” and “personal computer” are accorded no protection. “Baseball bat” is generic, while “Louisville Slugger,” a brand of bat manufactured only by Hillerich & Bradsby since 1893, is a very strong mark.

Companies determined to keep their brand or product in the public eye, even in the current tight financial conditions, are able to bring new eco-friendly or green

trademarks into their product mix with the prospect of less short-term marketing cost, but with less protection and possibly greater risk, precisely because so many others are doing the same thing.

Just as in the late 1980s Internet market, it seemed every company utilized the “i” or “e” prefix or attached the words “net” or “.com” to existing marks, today’s market is replete with established and newly launched trademarks sporting “eco” or “green.” A risk is that some of these eco-friendly trademarks may fall to the less protectable side of this spectrum.

Yogi Berra observed about a popular St. Louis restaurant, “nobody goes there anymore — it’s too crowded.” His statement is as true about the crowded, eco-friendly trademark landscape companies now encounter. The limitations on enforcement rights and scope of trademark protection, as well as relative uncertainty as to potential adverse third-party infringement claims, is as much part of the green territory as it was for the Internet entrepreneurs two decades ago.

During the dot-com frenzy, the Trademark Trial and Appeal Board ruled that the prefixes “e” or “i” do not magically change a descriptive term into a registerable trademark by some sort of linguistic alchemy. The board observed, “We see no difference in the meaning or connotation of ‘e-server’ and ‘eserver,’ and consider them both to be an abbreviated form of ‘electronic server.’ ” *In re International Business Machines Corp.*, 81 U.S.P.Q.2d 1677, 1679 (TTAB 2006); *In re Zanova Inc.*, 59 U.S.P.Q.2d 1300 (TTAB 2000) (ITOOL is merely descriptive of Web page design software).

Not all “e” or “i” marks were rejected during the dot-com era. Similarly, the inclusion of an eco-friendly term or prefix is not, nor should it be, the kiss of death today if the mark as a whole is distinctive. However, applicants should be prepared for nondistinctiveness objections during prosecution of trademark applications and

corresponding challenges when enforcing the marks when eco-friendly terms are used.

Trademark counsel should be prepared to advise against use of an eco-friendly trademark when there is little chance of protecting the mark. As attractive as such a mark may be for the sake of the short-term marketing budget, it will be of little value if it is rejected or subjected to limiting disclaimers by the PTO, is regularly infringed by confusingly similar marks or is diluted in an ocean of eco-friendly nomenclature. A weak trademark offers the prospect of little visibility in the market while risking future conflict with other adopters of such marks. As more players enter the crowded field of eco-friendly trademarks, the value of those marks declines and the ability to protect the investment in the names drops as well.

A confluence of challenging economic times combined with a new set of buzzwords brings back the problems and opportunities and, perhaps, the temptations of the dot-com era. In Yogi Berra’s words, it is déjà vu all over again.

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