



Newsletter

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Our office will be closed for the following holidays the second quarter of 2001:

April 12th through the 19th - vacation

May 28th - Memorial Day

July 4th - Independence Day

Our next newsletter will be mailed out the beginning of August 2001.

Remember if you have an article that you would like to contribute to our newsletter just fax it to us for our review. We must receive the article no later than July 15th for our August newsletter. ♦

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TRADEMARK CONSIDERATIONS IN CLASSIFYING A NAME

Composite Terms

These marks can also be called cross-category marks. Examples are: *Shorty's Mean Motorcycles*, *Gino's New York Pizza*, *Stormy Weather Home Rehab Services*, *K-Mart*.

Composite marks are not easy to analyze, because they usually consist of weak components and yet still are strong marks. As a general rule, if all the components of a mark are descriptive, the trademark as a whole is also descriptive, and therefore weak. But this is by no means always true. In some circumstances, the kind of service or product it is attached to, the context of its use, and even the public's reaction can result in weak words combining to form a strong mark. Let's see how this can work, looking at the two main types of composite terms separately.

a. Composites of Whole Words

This type of composite mark consists of individual words with different trademark strengths, like *Gino's Chicago Style Pizza*, which contains a personal name and a geographic term. The first rule about these is that the whole name is stronger than the sum of its parts. So for example, *Such a Business* is a



strong mark for a children's store. It consists of ordinary words, but they are not used descriptively; that is, "Such a Business" tells you nothing about what the business is or what it hopes to purvey. It's the combination of the phrase and the nature of the service that makes it funny, surprising, unique and

memorable. The same could be said of *Pea in a Pod* for a maternity store.

Other composites of weak elements can also make a stronger whole. For example, *Houlihan's Old Place* is an effective trademark for a restaurant. This composite of two sorts of names is much more suggestive than simply *Houlihan's* (which as a personal name can get no trademark protection without secondary meaning), or the *Old Place* (which, although not necessarily descriptive, is vague and not particularly memorable.) again, taken together, the elements of this mark are more distinctive than either is alone.

On the other hand, *Bette's Oceanview Driner*, in the Oceanview section of Berkeley, CA, is a moderately weak composite mark. This is not a recipe for a strong mark. Unless such a mark can show secondary meaning, the only protection Bette is likely to get is under state unfair competition laws, and then only if a rival restaurant uses a similar mark in the same local area, and if customers are likely to be confused by it.

Now consider the composite mark, *I Can't Believe It's Not Butter!* For the uninitiated, this is a brand of margarine, not just a promotional slogan. It is descriptive because it conveys the information that the product is a close imitation of butter. Furthermore, it's exactly the kind of phrase that a rival margarine producer might want to use in advertising. But the fact that the brand name is a complete sentence with an exclamation trademark at the end makes it unusual, and even memorable. That makes it somewhat distinctive and therefore a protectible mark.

Take another example. Colin Moriarity runs a chimney cleaning service called *The Irish Sweep*. The mark is a composite of descriptive terms, because he is in fact an Irish chimney sweeper. But we bet you'd remember the name. Why? Because it plays on a famous horse race, the Irish Sweepstakes. Also, one word, "sweep," is an archaic term for a chimney sweeper, and gives the whole trademark a more evocative feel. To some extent the strength of this trademark depends on whether many people recognize "sweep" as equivalent to chimney cleaner. If they do, it's descriptive. And yet, people can know what it means and still recognize it as archaic. On the other hand, if the mark's key feature, "sweep," is just a term in common use, then the trademark using it is just descriptive and too ordinary to be a protectible mark, without secondary meaning.

Composites of Elements of Words

These are one-word marks, such as *Ultraswim*, *Bushhawk* and *Microsoft*, make up of recognizable separate words. They are different from coined words discussed above. Coined marks are wholly new words that mean nothing. But because

these composite marks contain elements of words, they carry meaning, even if it is only to evoke an image. That makes them more akin to suggestive or descriptive marks than to coined terms. For example, *Bufferin* is considered an inherently descriptive mark, even though it's a composite that's not in the dictionary. That's because it's simply a contraction of buffered aspirin, and the result is too close to the descriptive word "buffered" and the generic term "asprin" to be distinctive.

What makes this kind of composite mark strong or weak is not what its elements are, but how it is used. For example, *Ultraswim* as a trademark for a piece of swimming equipment would be descriptive and so weak. But as used on shampoo designed for swimmers, it is suggestive, and so stronger.

Many businesses have latched on to the idea of creating a mark out of word fragments. Unfortunately they often select erms, at least in computer and technological fields, that are so overused that they have become hackneyed and therefore descriptive. The result is that trademarks using elements like super-, macro-, -tech, -soft, data- and compu-, even though they are made-up, are not unusual, and so not very distinctive or memorable. This is really an instance where the early bird got the worm. Only the first ones to pick such marks, like *Microsoft*, who got in before the genre became so common, had a strong mark even before they built up extensive public recognition.

Slogans

"Reach out and touch someone" and "This Bud's for you" are advertising slogans that are protectible because they function as marks. That is, they are used to identify and distinguish one product or service from all others, not merely to inform. To qualify as protectible marks, slogans must be either:

- 1) distinctive and creative; or
- 2) have developed enough secondary meaning to immediately call a product or service to mind.

Only slogans with these factors are protectible as marks. So "Don't leave home without it" is a protectible mark for *American Express* because it is creative, strictly promotional and well known.

While trademark slogans need not be clever or novel, (in fact they can be almost any phrase that's short – under 12 syllables is a good general rule), the more mundane a slogan is, the more secondary meaning the owner will need to show to obtain protection from imitators. Thus the owners of *Excedrin* had to prove that "Extra Strength Pain Reliever" had developed a strong secondary meaning, thus converting it into a trademark in the public's view, before a court would protect it. Their slogan described, as well as promoted, the aspirin product, and did not distinguish their product from others until

It has been used extensively.

Design Elements of Word Marks

Typefaces

The design element of a word-based mark, as opposed to a symbol, shape or container, is part of what makes a trademark distinctive. But “part” is the operative word here. If the design element of the trademark is simply an unusual typestyle or letter shape, it cannot constitute a separate trademark, because no one can monopolize a typestyle. So the use of one style or font can be reserved to someone’s exclusive use only in combination with a particular set of words and in a particular context.

For example, *New Yorker*, is the trademark of a magazine, but without its distinctive typeface (in which it always appears), the words would not signify the magazine, but instead any person who lives in New York. That magazine is entitled to exclusive use of the name in the context of magazines and in the context of that typeface only. But neither is a trademark on its own. This example shows how a visually interesting typeface can help transform an ordinary name into a distinctive trademark. It makes the development of secondary meaning quicker because the trademark is more memorable if consistently used with an unusual typeface.

Background Design

On the other hand, an unusual design used consistently as background to a word mark can serve as a separate mark, if it creates its own commercial impression on the buyer. For example, the *Bird’s Eye* frozen food picture mark (a drawing of a bird) constitutes a separate trademark from the *Bird’s Eye* word mark, because the public recognizes it separately as a symbol of that brand of food. Usually the separate commercial impression has to be reinforced by advertising that singles out the background design. An example would be an ad that says “look for the red diamond” where the word mark is always used with a red diamond background. As with all marks, to be protected from imitation, the design must either be inherently distinctive from the outset (an original drawing or a combination of colors and shapes that are novel could be distinctive in this context), or the design must have acquired secondary meaning.

Symbols, Shapes, Containers

Many symbols, designs and other non-word features that businesses use in advertising are also protectible as trademarks under the same principles as apply to words: the symbol must be distinctive and

unusual to qualify as a strong trademark, or it must have acquired secondary meaning. In addition, it must meet the test described above, of making its own separate commercial impression. And as described below, the symbol, shape or design can not be a likelihood that consumers will be

Certification Marks

1. What is a certification mark?

A certification mark certifies the nature or origin of the goods or services to which it has been applied. This includes, for example, region or location or origin, materials of construction, method or mode of manufacture or provision, quality assurance, accuracy of the goods or services or any definable characteristic of the goods or services. It can also certify manufacture or provision of services by members of a union or other organization to certain standards.

2. To obtain a certification mark registration what criteria or conditions must be satisfied?

You will be required to produce operating rules and regulations identifying what is being certified by the mark and the required standards. The organization doing the certifying cannot itself engage in the production or marketing of the goods or services but must be competent to certify that the requirements have been met by any user. Through the agreement executed by the user confirming adherence to the rules and regulations, the organization must be able to control, or legitimately exercise control, over the permitted use. There will need to be methods of testing and quality control with appointed individuals or bodies to periodically ensure conformance by any user. Anyone who can satisfy the rules and regulations and comply with the required criteria set forth in the standards must be granted the right to use the certification mark. The rules and regulations must also include provisions for appeal to a third party where use is refused and the applicant feels that this is unjust.

3. Are the systems or requirements the same for all countries?

In most countries a common thread of requirements is applied and most of the important provisions, identified above, are the same or very similar. There are some national differences of a minor nature, for example in some countries it is necessary to show that registration is in the public interest and to the public advantage. Once you have obtained approval of the rules and regulations in a major country they should be acceptable in other countries with some slight amendments as to form and content taking into account local requirements such as public policy and

local rules on aspects of the operation of the scheme.

4. What happens when I apply to register a certification mark?

As with an ordinary application it is examined as to registrability and conflict with prior rights, depending on the jurisdiction concerned. Thereafter the rules and regulations are examined to establish whether they meet the specific requirements for registration under local law. Very often there will be some amendments necessary or some additional requirements to be added for the operation of the certification scheme to be approved. This can be a lengthy process and it is not unusual for it to take many years before registration is granted.

5. Can I obtain a certification mark registration in all countries?

While this type of registration is available in most of the major industrialized countries it is only available in a minority of countries. In other jurisdictions where certification registrations are not available alternative means of protection are required.

6. What can I do in those countries where certification mark registrations are not available?

In some countries where there are no provisions for certification it may be possible to obtain registration as a collective or association mark. The requirements are similar to those of certification marks in most cases, but may be more relaxed in others. With some minor amendments to the "certification scheme", registration should be achievable. Other than that the only option is to apply for an ordinary trademark registration and enter into a licensing arrangement with approved users for the country concerned.

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ADDRESS CORRECTION REQUESTED

Difference Between Trademarks And Domain Names

1. What is a domain name?

A domain name is an alias for an Internet Protocol (IP) address. An IP address points an Internet user's computer to the web site they want to view. Instead of having to remember a long number (e.g. 64.244.180.150), an Internet user can just type in an easy to remember "domain name" (e.g. inta.org). In a domain name, the ".com" is called a top-level domain (TLD). The current top-level domains are: .com, .org, .edu, .net, .int, .mil and .gov. Each top-level domain designates whether the site is a commercial entity (.com), a nonprofit organization (.org), a military organization (.mil), an international organization (.int) or a government agency (.gov). The name portion of the domain name (inta) is called a second level name. The domain name applicant chooses the second level domain name. This name must be unique.

2. If I have a domain name, do I have a trademark?

No, a domain name is not the same thing as a trademark. Use of a domain name merely as an informational part of the domain holder's Internet address does not qualify as trademark use. In order to qualify as a trademark or service mark, the domain name must function as a mark, that is, it must serve as an indicator of source and not merely as an informational part of an Internet web address. If the domain name functions separately as an indicator of source, the domain name may be registered with the United States Patent and Trademark Office as a trademark or service mark.

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The way to secure success is to be more anxious about obtaining than about deserving it.

William Hazlitt

