

Be Careful How You Describe Your Product in Marketing Materials – You May Decrease Your Chances of Successfully Registering Your Trademarks

Kevin W. Wimberly

Businesses often pick trademarks for their products that describe some feature or characteristic of that product. From a marketing standpoint, a descriptive trademark can help link your customers' minds to your product.

However, a descriptive trademark faces long odds in ultimately receiving registration from the United States Patent and Trademark Office ("USPTO"). In fact, the USPTO expressly rejects trademarks that are merely descriptive of their goods. Even if the trademark itself is only somewhat descriptive of your product, your marketing materials may give the USPTO evidence that the trademark is in fact merely descriptive.

A recent example from the Trademark Trial and Appeal Board ("TTAB") underscores the importance of carefully planning your marketing strategy *before* seeking registration for your marks.



In refusing to allow the registration of "7SECONDS" for hair detangler, the TTAB found that 7SECONDS was merely descriptive of "a significant feature or function of applicant's goods, namely that it will detangle hair in seven seconds." See *In re Unite Eurotherapy, Inc.*, Serial No. 78/936,716 (August 20, 2008). How would the Examining Attorney come to the conclusion that the name of the product, 7SECONDS, described how long to leave the product in the user's hair as opposed to some other arbitrary meaning? The manufacturer said as much on its own website, which was provided to the USPTO during the registration process. The manufacturer's website stated: "Within 7SECONDS your tangles will be gone and your hair will start to feel alive again." This confirmed the mere descriptiveness of the trademark.

The USPTO may use dictionaries, websites, and other literature when making the determination that your mark is merely descriptive. With the enormous amount of information on the Internet, the last thing you want to do is contribute to your own trademark's demise by adding to the online evidence that may be used against you. Whether it is your ad copy for magazines, your product packaging or your website, always consider that how you publicly describe your product may affect your ability to obtain a registration for your mark.

We recommend that you consult an attorney early in your product's development so that you might avoid the pitfalls suffered by the marks addressed in this article.