

Considerations When Using Descriptive or Generic Trademark Terms

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I. Adding Distinctive Terms or Logos to a Descriptive or Generic Term Will Not Protect the Descriptive or Generic Term.

A descriptive trademark¹ is one that immediately brings to mind a use, purpose, function, characteristic, ingredient, or class of end users, of the product or service with which the mark is used. A descriptive mark can only be protected upon a showing of acquired distinctiveness, which is also called secondary meaning. A generic mark describes the category of the product or service with which it is used and can never be protected.

Examples of Descriptive Terms

“Titanium” for ski bindings made from titanium steel.

“Beef and Brew” for a restaurant that serves steak and beer.


“Sweet and Tart” for candy that is sweet and tart.

Examples of Generic Terms

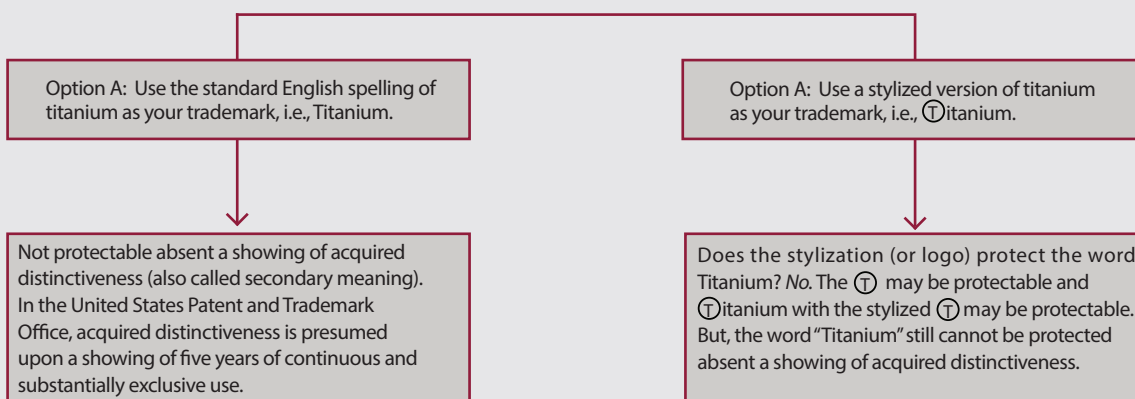
“Ski Bindings” or “Bindings” for ski bindings.

“Restaurant” for restaurants.

“Candy” for candy.

One question frequently asked is whether adding a unique term, phrase, logo, or background to a descriptive or generic term protects the descriptive or generic term. The answer is *no*. You may be able to protect the unique elements added to the descriptive/generic term, or the unique elements and the descriptive/generic term in combination, but *not* the descriptive/generic term itself. Consider an example of using the mark “Titanium” for ski bindings made from titanium steel. Because an ingredient of the ski bindings is “titanium,” the word titanium cannot be protected as a trademark unless acquired distinctiveness is shown. Let’s examine the rights obtained by using two versions of “Titanium” – the first is the word mark “Titanium” alone, and the second uses a distinctive design element, i.e.,  titanium.

Example: Your Mark is “Titanium” for Ski Bindings Made of Titanium Steel

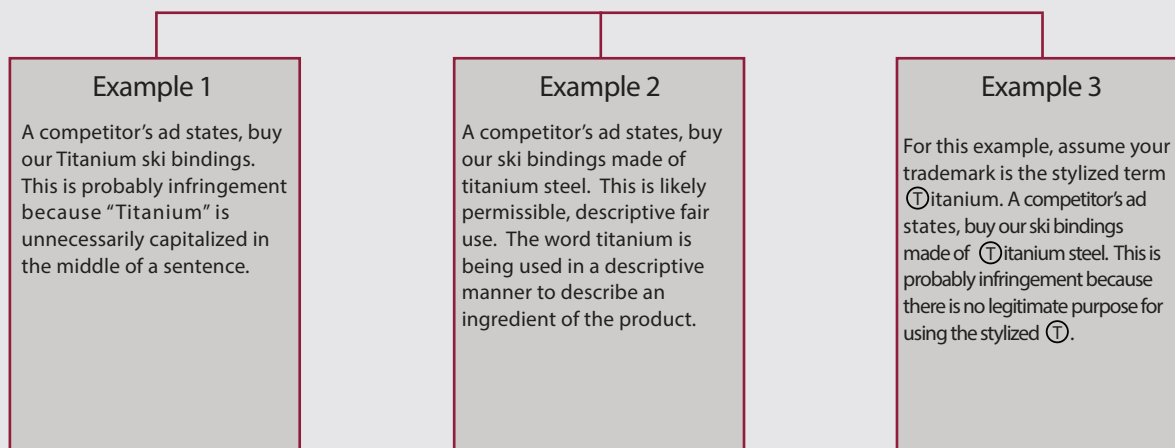


¹ In this article, “trademark” refers to trademarks and service marks.

Limitations on Rights in a Descriptive Term

Even if acquired distinctiveness was shown, and “Titanium” was legally protected as a trademark for ski bindings, that would not prevent others from using the word “titanium” in a descriptive manner (i.e., not as a trademark) to fairly describe ski bindings including titanium. For the examples below, assume that you have acquired distinctiveness in “Titanium,” and it is a protected trademark.

Examples of Permitted and Infringing Uses



Adding a Unique Word to a Descriptive or Generic Word

Assume you were to add the word “Xenon” to “titanium,” so your ski bindings would be called “Xenon Titanium” ski bindings. Does that protect the word titanium? No. You could protect the term “Xenon,” which is arbitrary with respect to ski bindings. You could protect the entire phrase, “Xenon Titanium,” but you could not protect the descriptive word “titanium” absent acquired distinctiveness, and competitors could still use it to fairly describe their products. If you added the term “Xenon” to the generic term “bindings” to create the trademark “Xenon Bindings,” that would not protect the generic term “bindings.”

II. Using Acronyms as Trademarks.

Does an acronym for words that are admittedly descriptive or generic mean that the acronym is also descriptive or generic? No. Acronyms stand or fall on their own merits just as any trademark. As an example, “apple pie a la mode” is descriptive or generic of apple pie with ice cream. But, its acronym, “APALM,” would likely be considered a fanciful, strong mark, because relevant consumers would not associate APALM with apple pie a la mode or any feature, characteristic, or ingredient of it.

Returning again to the example of “titanium” for ski bindings, what if you instead called the ski bindings “TSB,” which you know stands for “titanium ski bindings,” but consumers do not. In that case, “TSB” would likely be considered a fanciful and strong trademark, even though it is an acronym for descriptive words. In contrast, acronyms such as “RF” and “LED” are commonly known to stand, respectively, for the generic words “radio frequency” and “light emitting diode.” Consequently, these acronyms are as generic as the words for which they stand and cannot function as trademarks for “radio frequency” or “light emitting diode.”

Acronyms for Descriptive or Generic Words Can Lose Their Source-Indicating Function Over Time

Over time, relevant consumers usually learn the underlying meaning of an acronym for descriptive or generic words. Once consumers associate the acronym with the underlying descriptive or generic words, the acronym itself becomes descriptive or generic, and could no longer be protected (unless it is descriptive and has acquired distinctiveness). So, best to stay away from even the acronyms of descriptive or generic words. In contrast, an acronym totally unrelated to a product or service (for example, “KSR” for ski bindings made of titanium steel, or “LED” for gloves) would be a strong mark as long as its owner enforces it against infringing uses.

III. Conclusion.

There may be valuable marketing considerations for including a descriptive or generic term in your trademark. But, be cognizant of the potential issues with such marks, including certain limitations to their scope of protection.



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David Rogers practices patent, trademark, trade secret and unfair competition law, including litigation, patent and trademark preparation and prosecution; trademark oppositions, trademark cancellations and domain name disputes; and preparing manufacturing, consulting and technology contracts.