

Protecting Descriptive Trademarks Through the Supplemental
Register
by Dana Tangren

Identifying an effective trademark can be a daunting task. Besides trying to find a mark that is not already being used, trademark owners are faced with the challenge of selecting marks that will have a strong market appeal. It is natural to want to select a “descriptive” mark. A mark is considered to be merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services with which the mark will be used. For example, THE BREATHABLE MATTRESS has been held merely descriptive for beds and mattresses while EXPRESSERVICE has been held merely descriptive of banking and trust services. Descriptive marks can be appealing from a marketing standpoint because they can be selected to create a quick and positive association with consumers.

Although descriptive marks can be used, the problem is that descriptive marks, at least initially, are not registerable on the Principal Register of the United States Patent and Trademark Office (USPTO). The Principal Register is the main register at the USPTO and having a mark registered thereon provides the trademark owner with valuable statutory rights for protecting and enforcing the mark. The USPTO typically refuses registration of a mark that is deemed “merely descriptive,” thereby limiting enforcement and protection of the mark. Trademark owners should thus be cautious about spending time and money to select and market descriptive marks because their right to preclude others from using the same or similar mark may be limited. From an enforcement standpoint, it is better to select marks that are arbitrary or fanciful relative to the related goods or services, or, at a minimum, are only suggestive of the goods or services. Barring other objections, such marks are entitled to registration on the Principal Register.

On occasion, however, the appeal of using a descriptive trademark may be too strong. In that case, steps should be taken to optimize rights in the mark. Initially, an application can be filed seeking registration of the mark on the Principal Register. Even if the owner is concerned that the mark may be descriptive, the examiner should be forced to make the determination. Many terms that may be thought of as descriptive are not deemed descriptive by the USPTO. If registration of the mark is refused for being “merely descriptive” and there are no compelling arguments otherwise, an amendment can be filed seeking

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registration of the mark on the Supplemental Register. The Supplemental Register permits the registration of some descriptive marks.

Marks on the Supplemental Register do not enjoy most of the protection and enforcement right granted those on the Principal Register. However, registering on the Supplemental Register does have benefits. For example, by having a mark registered on the Supplemental Register, the owner is entitled to use the symbol ®, designating that the mark is federally registered. Without further investigation, a third party seeing the mark with the registration symbol is unable to ascertain whether the mark is registered on the Principal or Supplemental Register, thereby discouraging others from using the same or similar mark. Furthermore, marks on the Supplemental Register are listed on the USPTO on-line, trademark database. As such, the mark and related registration can be discovered by those doing trademark clearance searches. The registration thus gives notice to others that the mark is being used in commerce as a trademark, thereby further discouraging others from using the same or similar mark.

A registration on the Supplemental Register can also be used to bar the registration of other marks that are sufficiently similar to create a likelihood of confusion. See *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) and *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d at 1042. Furthermore, once a descriptive mark has been sufficiently used and marketed that it acquires secondary meaning, i.e., consumers no longer view the mark as merely descriptive, Section 2(f) of the Trademark Act permits registration of the mark on the Principal Register. Section 2(f) of the Trademark Act also states that proof of substantially exclusive and continuous use of the mark in commerce for 5 years can be considered a presumption that the mark has acquired secondary meaning, thereby providing a basis to seek registration of the mark on the Principal Register.

It is noted that not all descriptive marks are granted registration on the Supplement Register. In some cases, the examiner can hold that a mark is so descriptive that it can never acquire secondary meaning. In that case, the examiner can refuse registration on the Supplemental Register. Furthermore, only marks that are being used in commerce can be

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registered on the Supplemental Register. However, where a descriptive mark is being used, there are significant benefits in seeking registration on the Supplemental Register. Furthermore, continuous and exclusive use of the mark can eventually warrant registration on the Principal Register and the granting of the rights associated therewith.