

Naming Your Open Source Software -- Part 2

by Lawrence Rosen

Selecting a good trademark, like selecting good wine, requires skill and sophistication. Intuition and common sense can often lead to ineffective trademarks, just like guessing over a wine list can lead to a disappointing dining experience. Trademark selection is a job best done with the assistance of your trademark attorney.

Some marketing managers who should know better suggest legally ineffective trademarks for their products. Obviously I cannot reveal too many specific details, so I will create some examples to illustrate bad trademark choices I have seen.

You cannot simply take a noun that is generic for the goods or services you're selling and make it into a trademark. This is to prevent someone from claiming private ownership over a common word. Thus, you can't use the word "Computer" as your trademark for a computer you sell or the word "Programming" as a service mark for your business creating software.

You cannot use tricks of written or spoken language to get around these restrictions. "Le Car" would not be registerable to describe the newest model of automobile. Making the trademark sound like an exotic foreign language doesn't make the mark less generic. You cannot create a trademark simply by describing obvious product features and writing it in a unique way. Thus "PhoneRinger" would not be registerable for a device that makes a sound when a telephone call arrives. And you cannot deliberately deceive consumers by being misdescriptive. The mark "OpenSource" could not be applied to a proprietary closed-source operating system. Trademarks that are "merely descriptive or deceptively misdescriptive" cannot be registered. 15 U.S.C. §1052(e).

Another frequent mistake is to try to capitalize on a competitor's trademarks ("MacPizzas" for a new chain of pizza parlors or "Pentalium" for a microprocessor) to get instant recognition in the marketplace. These trademarks would probably be attacked because they are likely "to cause confusion, or to cause mistake, or to deceive" as to the origin of the goods or services. 15 U.S.C. §1052(d).

Trademarks can incorporate the adjectives "Supreme," "Superior" or "Enhanced" but such marks are of limited value. These terms are used on so many different items and by so many different companies that they have lost their ability to distinguish goods or services. And of course, you cannot take someone else's trademark and add one of those words to create your own trademark.

You must take steps to prevent your trademark or service mark from becoming generic for your goods or services. That is why Xerox tries diligently to prevent people from saying "I'm going to make a xerox of that document" -- instead of "Xerox copy," where the word "Xerox" is an adjective modifying the generic noun "copy." To prevent your trademark from becoming generic, *always* make sure it is used as an adjective and never as a noun. The word "aspirin" was once a trademark, but it became generic and lost trademark status.

A trademark does not exist in isolation. It must be used in conjunction with specific goods or services to signify the source or origin of those goods or services. For this reason, the same word can be used by more than one company as a trademark, as long as the goods or services are different. Thus you can buy a Cadillac automobile and Cadillac dog food. You can

buy Sun computers and Sun gasoline. These marks can coexist because there will be no confusion among customers seeking one product and accidentally buying the other.

Trademark attorneys describe a spectrum of possible trademarks. In ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are:

- *Descriptive*: Certain marks are *descriptive* of the product, the name of the owner, or the place where the product originates. A mark is descriptive if it conveys an immediate idea of the ingredients, qualities or characteristics of the goods. The distinction between a generic and a descriptive term was illuminated by one commentator, using the example “Deep Bowl Spoon,” as follows:

“Deep Bowl” identifies a significant characteristic of the article. It is “merely descriptive” of the goods, because it informs one that they are deep in the bowl portion.... It is not, however, the “common descriptive name” of the article, [since] the implement is not a deep bowl, it is a spoon.... “Spoon” is not merely descriptive of the article -- it identifies the article -- [and therefore] the term is generic. Fletcher, *Actual Confusion as to Incontestability of Descriptive Marks*, 64 Trademark Rep. 252, 260 (1974).

- *Suggestive*: A mark is *suggestive* if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. For example, the marks “Orange Crush,” “Cuisinart” and “London Fog” are suggestive.
- *Arbitrary*: When a common word is used in an unfamiliar way, the use is called *arbitrary*. Examples of that are “Apple,” “Apache” and “Python.” Arbitrary terms often make good trademarks because they are likely to be more appealing to customers, are more easily remembered and are therefore easier to promote.
- *Fanciful*: The term *fanciful* as a classifying concept is usually applied to words invented solely for their use as trademarks. Examples of that are “Altoids” or “Kodak.” Fanciful marks can make excellent trademarks because there is no possibility of confusion with real words.

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