

NameTM of the game

By KEN SCHACHTER

Jozef Lopez is doing it. So are North Fork Bank, Howard Stern and Symbol Technologies. Donald Trump has done it repeatedly.

All, it turns out, have distinctive names that help define a place in their respective marketplaces.

And all have had their names trademarked. In the case of Holtsville-based Symbol, about half of its roughly 300 trademark registrations worldwide cover its name, "Symbol" or "Symbol Technologies," said Aaron Bernstein, the company's vice president, intellectual property. Unlike copyrights, which protect artistic or literary work (such as this article), or patents, which safeguard inventions, trademarks cover a word, phrase, symbol or design that distinguishes the source of a product.

How powerful can a name really be? Consider the case of a company called Coca-Cola. "Without the Coca-Cola name, you're drinking brown,

See NAME, Page 27A

MAGIC WORDS: Attorney Keith Weltsch says the best names, in terms of securing rights to a trademark, are " coined" words that mean absolutely nothing.

NAME, from Page 1A

fuzzy sugar water," observed Keith Weltsch, a trademark attorney with Scully, Scott, Murphy & Presser.

Though Coke is in a class by itself among trademarks, Long Island companies also wield some powerful names. Atkins Nutritionals and Weight Watchers International, for instance, serve as signposts for dieters nationwide, while cable provider Cablevision Systems is a well-known regional name.

Distinctive designs also can be trademarked, as drug maker Pfizer did with its blue Viagra pills. The advantage: A design patent lasts for a finite amount of time, whereas a trademark can last forever as long as it remains in use.

The U.S. Patent and Trademark Office puts trademarks in five categories, said Weltsch, who worked at that agency as a trademark-examining attorney before joining Scully Scott. Believe it or not, the best names, in terms

of securing rights to a trademark, are "coined" words that mean absolutely nothing, he said. For instance, Exxon and Xerox are inherently distinctive.

The second category is "arbitrary," such as Apple Computer, which has a connection to the product but doesn't fully describe it.

The third category is "suggestive" names, such as Sure for deodorant.

Suggestive, arbitrary and coined trademarks are presumed to be valid in court.

More tedious are "descriptive" names, such as "Long Island Business News." The problem is that

granting trademark status to descriptive names could unjustly hamstring competitors selling a similar product. To gain a trademark, the applicant must take extra steps to show that the name is known in the marketplace.

At the bottom rung of the trademark ladder are generic names. Examiners rou-

THE OTHER SIDE: A longtime trademark-examining attorney for the U.S. Patent and Trademark Office, Keith Weltsch of Scully, Scott, Murphy & Presser now helps people apply for trademarks.



tinely reject requests for generic trademarks. Weltsch recalled that when he was at the USPTO, many applicants would seek to use names that are descriptive because it gives consumers a picture of what the product will be.

In one case, he said, someone filed a trademark for "Smoked Eggs," described as eggs smoked in multi-flavored woods.

The applicant argued that the name aptly described his product. In rejecting the application, however, Weltsch explained that he could not grant the trademark precisely for that reason.

"You've got to think of what that means to the rest of the smoked eggs industry," he said.

There also are instances of successful trademarks that become generic by dint of their ubiquity and the failure of companies to protect them, such as *cellophane*

and zipper.

Xerox has managed to avoid that fate. Though Xerox has become synonymous with photocopy, the company routinely seeks to police those who use it in a generic sense.

Policing can be more difficult for a smaller company. In 1995, a tiny Huntington-based computer parts wholesaler named Big Blue Products Inc. won a trademark battle against giant International Business Machines. Big Blue Products, founded in 1984, prevailed in gaining the trademark for the phrase "Big Blue" as it relates to computer products despite the deep pockets of IBM, which has carried the nickname for decades.

That doesn't mean that Big Blue Products has brought the media to heel, however.

Despite the legal victory, a recent Google (which itself is in danger of becoming a generic verb for conducting a search on the Web) search of IBM and "Big Blue" yielded 438,000 hits.

Symbol's Bernstein said the "care and feeding" of trademarks requires vigilance.

"The Internet became this feeding ground for people making use of others' trademarks," he said. For example, the company monitoring a text-indexing software company named s'nel.

In another sound-alike case, Microsoft Corp. pursued a British Columbia student named Mike Snow who registered a Web site as, you guessed it, www.miketherevent.com. Rather than bring its corporate wrath to bear on a college student, however, Microsoft eventually backed off.

If the Internet has made it easier for people to tread on intellectual property by selling counterfeit handbags on eBay and cyber-squatting, it also has made it much simpler to establish a valid trademark and to search for infringers.

The reach of the Internet could allow a small retailer, for example, to extend a trademark because its goods could be shipped around the nation or the world.

Technology also can hasten the search to discover whether a company faces conflicting trademarks.

Using the Internet, a company potentially could discover whether there are any conflicts with a new trademark within two or three days, Bernstein said. That compares with a month for global regions where databases are unavailable, he said.

And what of Donald Trump, the star of "The Apprentice" TV show who tried to trademark the phrase "You're fired" for a new board game?

The move by The Donald hit a hitch: It was too close to the name of another, more upbeat game, "You're Hired."

LI trademark quiz

1. Which company is "keeping you in the know"?
2. Which bank has "sincerely free checking"?
3. What firm is the "enterprise mobility company"?
4. Which hairstylist franchisee runs a "unisex haircutting establishment"?

Answers: 1. Arco Electronics 2. North Fork Bank 3. Symbol Technologies 4. Larson Top

Five tips for securing your trademark TM

1. Search, search, search. And do your searching before you begin using a trademark.
2. Be consistent. If you use a particular design logo with your product, don't vary it from day to day.
3. Defend. If you become aware of a third party using your trademark, take action immediately.
4. Don't dilute your trademark. That is, don't use it on a generic name. In literature, for instance, products should be identified as Xerox brand copiers or Thomson brand ocean buoys.
5. Register your domain names as soon as you come up with a trademark.