

When Is A Coke A Coke™?

This article focuses on the protection given to the name of an item and the particular color, shape and design associated with that name.

If you are a collector of antiques, you know that certain antiquities are both identified and valued by the mark of the maker placed somewhere on the item. Just as artists marked their paintings by affixing a signature, so the early metal, leather and wood craftsmen would affix a mark to their goods to identify the producer. The concept behind these "trade" marks has been carried into current times.

Trademark protection is not guaranteed under the Constitution, as are patent and copyright protection, but is supervised by the federal government as part of its power over interstate commerce. Originally, a trademark could not be registered until it had been used in interstate commerce. In 1988, however, the Lanham Act was amended to allow a producer to "pre-register" a trademark. The pre-registration period is limited, and, except in special circumstances, cannot be extended. To maintain the benefits of pre-registration, therefore, the holder of the mark must use the mark in interstate commerce during the pre-registration period.

The trademark registration process benefits three groups. First, it protects the holder of the registered mark. The date of registration establishes priority of use by the holder. The holder of a registered mark can not only enforce that mark in the federal courts, but also has greater statutory rights than would be available at common law. Moreover, registration of the mark is considered nationwide notice to prevent anyone else, even innocently, from using the same or a similar mark.

Second, the registration process protects competitors, who can object to registration of a particular mark for various reasons. Competitors can object to registration of marks which contain surnames, geographic areas as part of the name, or marks which are not distinctive, but merely descriptive of the item to which they are attached.

Surnames and geographic areas are not initially registrable as trademarks because everyone with the same surname, and every producer from a certain geographic area should be able to use his or her name, or that particular geographic area as part of the trademark for their product, even if the goods and producers will be in direct competition. Marks which are merely descriptive of the product on which they will be used likewise should not be registered. To be registrable, the mark must be distinctive. A fanciful or arbitrary name (Apple Computers, Camel Cigarettes) is distinctive. "Lite

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Beer", however, only describes the caloric or alcohol content of the product and is not distinctive. Initially, therefore, it was not registrable because it would be unfair to preclude other producers of that same type of product from using the same descriptive term.

Marks which cannot be initially registered, however, can become registrable at a later date, if the mark or name of the product becomes so well known to the consumer that it no longer is merely descriptive, but actually has achieved a "secondary meaning" in the eyes of the consuming public. Kentucky Fried Chicken and Bob Evans Restaurants are those types of products which, while they could not be registered marks initially, are now protected from competition because of their recognition by the consuming public. Any mark which has been exclusively and continually used in commerce for five consecutive years is presumed to have achieved a secondary meaning, and can then be registered.

Consumers are the third group who benefit from the trademark registration process. The focus of the registration process often is on the similarity between a registered mark, and one seeking to be registered. In those instances, the focus of the Trademark Office is whether the marks would be confusingly similar to the consuming public. Thus, an attempt to register a clay product for children under the name "Fun Dough" was refused because the mark was so confusingly similar to "PlayDoh". The intent is that you come to associate a certain quality to goods of a certain producer, and should be able to rely on that mark as an assurance that the goods will be of the same quality.

Mere registration of a mark is not a lifelong license to use that mark unhampered, as is the case in a copyright. Rather, a registered mark may lose its distinctiveness, especially if its producer does not protect its rights. Aspirin was originally a registered mark of the Bayer company. In the eyes and mind of the consuming public, however, aspirin came to represent any number of analgesic pain relievers, regardless of the manufacturer. Because consumers no longer associate aspirin solely with Bayer, Bayer can no longer prevent other manufacturers from using the name aspirin.

One producer who assiduously protects its mark is the Coca-Cola Company, which has a staff of personnel who travel nationwide ordering Coke in restaurants and then testing the chemical content of the drink delivered to determine that it is in fact a Coke™. If the product served is not a Coke™, the restaurant is notified and directed to serve only the product requested. Have you been in a restaurant and asked for a Coke and been asked if Pepsi is "OK". That could well be the result of Coca-Cola's efforts to protect its mark, and explains when a Coke is a Coke™.

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