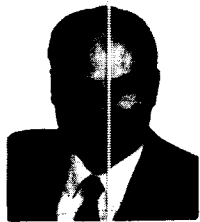


ADVERTISING & THE LAW



Surname Trademark?

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Outside Counsel™ with Roy S. Gordet

Do you remember when we discussed descriptive marks in this column? We said that if a trademark is "merely descriptive" it could not be a protectable mark unless the trademark owner could show substantial consumer recognition in his mark. If a trademark is primarily a surname, then courts treat that mark as though it were "merely descriptive." Thus, the trademark BROOKS is obviously a surname. This is true even if the company chose that name because the factory is located near a babbling brook and no one at the company has the name "Brooks." Because the trademark examiner will recognize the mark as a common surname (and if he is unsure he might even look in a telephone directory of some major city), the trademark examiner will reject this application to register. At that point it will be necessary to show the examiner that many people think of your company when they hear the mark "BROOKS." As we discussed in earlier columns, you would tell the examiner about your company's extensive advertising expenditures, phenomenal sales, etc. and hope that you can convince him that your BROOKS mark deserves to be registered. I am almost sure that the company that sells running shoes under the mark BROOKS has by now successfully registered their mark BROOKS despite the fact that it is merely a surname.

...it is not fair to allow one person named "Smith" to monopolize that name

Part of the reason for this is that it is not fair to allow one person named "Smith" to monopolize that name. Before the law will allow that, they will force our Mr. Smith to prove that he has already invested significant resources in that mark. Mr. Smith improves his chances when he makes his mark "SMITH SOFTWARE 1500," even if the word "SOFTWARE" and the model number "1500" do not add much in the way of distinctiveness. They

do serve to make the mark something more than just a "surname." Indeed, in the case of "Smith," it is a very heavy burden. "Brooks" probably less so. If you're lucky enough to have a surname like "Walesa" or "Tennbaum" you probably will succeed by adding words to your surname in creating your mark.

Reebok no doubt would be able to stop someone from calling their little shoe store The Reebok Store

It should be clear that surname trademarks are not looked upon with much favor. In one sense they are considered weak marks because it can be very difficult to stop another from using that same mark especially when that mark is indeed that person's surname. To continue with our BROOKS example, if my name was really Bob Brooks, and I wanted to open a store called "The Brooks Shoe Store," the BROOKS running shoe company would have a devil of a time convincing a judge that I should not be permitted to call my shoe store by my own name. They might succeed, but I don't think I would bet more than a dollar on the BROOKS company. The BROOKS company would probably succeed in forcing Bob Brooks to put up a small sign "Not affiliated with the BROOKS running shoe company." By the same token, I don't think that same judge would or should allow Bob Brooks to start a running shoe manufacturing company under the name of BROOKS. It would not be fair to the first running shoe company that has invested all the time and money in that name. I might point out that a company with a name like REEBOK no doubt would be able to stop someone from calling their little shoe store THE REEBOK SHOE STORE if in fact the store had no connection to the manufacturer. Surname marks have their problems. You are better off with a fanciful mark that is considered a strong trademark.

Part of the reason I decided on this topic for this month's column is that so many of you use your own name(s) for the name of your ad agency. As I hope I have pointed out, there are some definite disadvantages, from a legal standpoint, to this practice.

Roy S. Gordet specializes in trademarks and copyrights and related aspects of advertising law at the Palo Alto firm of Wilson, Sonsini, Goodrich & Rosati. Any suggestions for topics to be treated in this column could be directed to him in care of the newspaper.

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Column Awaiting a Name...continued from page 7

charm and élan, yet mature in knowledge of each menu offering and you shall find that you have "discovered" a memorable dining place. Here is that rare one, that possesses everything: food, a choice wine list, full bar, water views, service, ambiance, setting, a beguiling natural water show and owners who care about you. **Domenico's-on-the-Wharf, 50 Fisherman's Wharf** (right side half-way down), **Monterey. Call (408) 372-3655.** Do reserve (surely you always do, everywhere?) Daily. Moderately-costly and worth much more. Several pleasant, good restaurants are also on the wharf, but this is the place for you.

Reviewing the near-florid words and sentences of praise that you've just read, I can only add that much the same has been written previously by a number of respected food and restaurant writers.

No doubt, if you enjoy Chinese cooking in its various cuisines, and, in all China there are at least five well-defined food classifications, (some claim there are seven such), you already have several favorites for Cantonese or Szechuan meals. We'll not quibble with whatever dining place you admire but will now describe one of my "must" recommendations for the visitor and newcomer, in the very heart of San Francisco's Chinatown: **The Empress of China.** This superlative, near-palatial roof garden pavilion opened in mid-August of 1966 to instant success that has never dimmed but has

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