

TRADEMARKS
How to Establish Secondary Meaning For a Descriptive Term
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To establish trademark rights in a descriptive term the user must be able to prove that in addition to its normal meaning, consumers have come to also recognize the term as a designation of source (i.e., the term has acquired secondary meaning or distinctiveness). Specifically, it must be shown that the consuming public primarily thinks of the term in association with a single source of the product.

The amount and type of evidence necessary to prove secondary meaning varies. The less descriptive the term, the less evidence needed. There are three basic types of evidence that can be used individually or in combination to prove secondary meaning.

- ❖ A claim of ownership of one or more prior federal registrations for substantially the same mark for similar goods and services
- ❖ 5 years of substantially exclusive and continuous use
- ❖ Actual evidence

The evidence of ownership of one or more prior federal registration may be sufficient where the prior registration is for a design mark with words and the new application is for the words only. For example the registration for the design mark  [®] was one prior registration used as the basis for acquired distinctiveness for the word mark SEARS [®].

The evidence of five years of substantially exclusive and continuous use works best for marks that are not considered highly descriptive or misdescriptive of the goods or services in the application. This type of evidence works well for marks found to be descriptive because the mark is mainly known as a surname. An example is  [®] for the goods of door hardware.

For a mark considered highly descriptive actual evidence of secondary meaning will be required. An example is 7-KETO[®] for an ingredient in the manufacture of dietary supplements. The type of actual evidence that may be submitted includes consumer testimony, consumer surveys, proof of exclusive use, length and manner of use, amount and manner of advertising, amount of sales and number of customers, established place in the market, and proof of intentional copying.