



IP Briefing

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Does exactly what it says on the tin

When choosing a brand name many businesses choose a trademark that says something about their products or the business itself.

Whilst there is nothing wrong with this approach it exposes the difference between what may be a great brand from a marketing perspective and one that can be protected by trademark law.

Many businesses fall into the trap of investing heavily in developing brands that are inherently weak as trademarks and where it is difficult to build up any significant brand equity.

What makes a good trademark?

First and foremost a trademark must be a sign of origin that is capable of distinguishing one undertaking from others.

A trademark must therefore be distinctive and not descriptive of the goods and services for which it used, otherwise it will prove difficult to register and protect.



The more descriptive your trademark is the greater the likelihood that someone else can legitimately use something similar to it to describe his or her own products.

Key recommendations

- Choose a mark that is distinctive and not connected to or describes the features or qualities of your products.
- Be creative, try to use unusual combinations or made up words and avoid descriptive words, names of people and places, industry terms and offensive words.
- Ensure that no one else is using your mark and that it is free to register.
- Register trademarks, trade names, brands and logos for the widest protection.

If your brand is lacking in distinctive character then it may be refused registration on “Absolute Grounds” because it does not meet the statutory requirements necessary to qualify as a trademark.

Recent examples of applications which have been refused on such grounds in the UK during the last month include:

- LIQUID VITAMINS – for mineral water and fruit drinks.
-  – for printed matter relating to pet animals.
- Booty Buster – for exercise equipment.
- SAUSAGE WELLINGTON – for sausages, pies and sausage wellington.
- FUGLY – for jewellery and watches.
-  – for visits to Lapland.
- Nosh! – for food, drink and restaurant services.

If you are already using a fairly descriptive trademark then it may still be possible to secure a trademark registration, provided that the mark has been used for a number of years and it can be shown that it has acquired a level of distinctiveness through such use. Alternatively, it may be possible to register such marks by combining them with another distinctive element or represented in a distinctive style (for example as part of a logo). However, these marks may still be inherently weak and are unlikely to provide protection for the descriptive elements comprised in them unless they can be shown to have acquired a secondary meaning.

Other things to avoid are offensive terms, suggestive words, laudatory terms, names of people or places, industry terms, numbers and one, two or three letter marks.

Berg Legal provides a full range of intellectual property services including: licensing, enforcement of IP rights, trademark and design registrations and brand management. For further information please contact Paul Tomlinson at pault@berg.co.uk or on 0161 833 9211.

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