



Brands from the frontline

Why don't they understand?

The tendency to use descriptive terms to designate new products is something all in-house counsel must work against, but the problem is particularly acute in the food industry where marketers justify such use by saying that consumers want to know where their food comes from

To trademark experts one word is essential: distinctiveness. This is one of the most important things in our professional life. We struggle everyday to understand exactly where the borders lie, as shown by the many hours that have been devoted in Europe in the past 10 year to analyzing, dissecting and discussing decisions such as *BABY DRY* and *DOUBLEMINT*.

Any real trademark devotee waits for these decisions like children await Christmas – in anxious anticipation. And every time one of these potentially groundbreaking decisions comes out, there is a surge of articles, essays and conference sessions discussing the decision.

I am a member of this group of people who consider themselves true trademark lovers and plead guilty to spending many hours wondering whether one sign could become a first class trademark. But I have always wondered why something is so interesting for some people and so utterly uninteresting to those who are really dependent on trademarks – the business people within our companies. Why is it apparently so difficult for us experts to explain to the latter group why they must pay attention? And why is it that they never seem to understand?

The question has become increasingly relevant over the years. The number of requests from marketing departments to use descriptive words as trademarks seems to increase, despite our best efforts to stop that trend, and, as the value of IP rights is growing, the selection of non-distinctive trademarks has a greater potential negative impact on the business. The problem is particularly acute in the food industry, in which I worked for a number of years; in order to find a solution, one must fully grasp the motives of the other party, who in this case usually is a marketing colleague.

The first time I noticed this trend of

using descriptive words for foodstuff, I was working on a name for a new cheese and I was trying to dissuade a colleague from using name that was worse than descriptive – it was a convent's name that our company did not own and did not have a license to use. It was clear, however, that it was very important to my colleague to use that name; he explained that the name enabled him to tell the product's story. I had never before heard that a story needed to be told in relation to a product. He explained that the story was that herbs were to be added to the cheese and that these herbs would be grown at the convent. With this in mind, together we worked out a trademark that combined part of the herb's name and the word 'convent', which resulted in a distinctive trademark that still evokes the origin of the product.

Being distinctive is important to us trademark practitioners, but the priority for marketers is to strike consumers' imagination and stand out on the shelf. The number of different products available in one food category can be staggering, for example yogurt in large supermarket stores. If your product does not stand out, it will simply disappear. Ideally, it should be in the mind of consumers before they even enter the store or else they might never find or even look for your product. The only way you can have a place in consumers' minds today is by building a brand – that is, a set of elements that together form a story or universe that consumers relate to or feel members of. And the best stories about foodstuff are the ones about geographical origin or production methods, which leads to descriptiveness.

Understanding the reasoning behind your marketing colleagues' urge to use a descriptive term is crucial if you want to be able to change their approach. Before they do, *you* must change perspective. It is not helpful to entrench yourself behind the barriers of your profession and use legal language when you try to explain to colleagues or clients the blessings of distinctiveness. Nor is it helpful secretly to consider them unprofessional or lacking in understanding of the real values in life. Their priorities are simply different from

yours. If you wish to communicate effectively with this other group, which you should be serving at the end of the day, you must move inside their world, open up your mind and try to understand their problems and requirements.

The trick is to work closely with marketing colleagues and persuade them to let you participate in the project early enough for you to have some influence on the selection of trademark. Then you would have a much better chance of making them understand that you are not being difficult, you are trying to protect their own best interest. Don't talk about distinctiveness in legal terms. Talk about protection of their own efforts and that it is their job on the line, not yours. Describe to them the horrors of being copied and not being able to stop it. Show them examples of the company's past mistakes. Help them understand that they can use all the descriptive words and images they like as long as they also have a word that you can protect as a trademark. And most importantly, help them create that mark. Then they will start listening and maybe one day they will understand.