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## [Trademark Bully Baloney?](#)

Posted on April 18, 2011 by [Steve Baird](#)

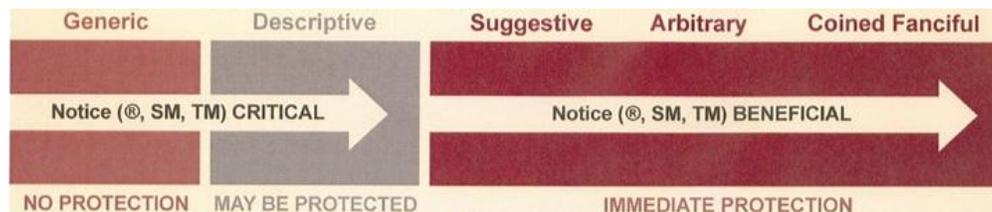
In the wake of all the discussion and debate over "[trademark bullying](#)," [NFIB](#) (National Federation of Independent Businesses), the self-proclaimed [Voice of Small Business](#), recently offered its members and followers "[5 Steps to Avoid Corporate Trademark Bullying](#)":

1. Do Your Homework;
2. Choose a Descriptive Business Name;
3. Use Common Sense;
4. Consider Buying Intellectual Property Insurance; and
5. When in Doubt, Consult an Attorney.

I suppose it's kind of hard to argue, in general, with doing your homework, using common sense, buying insurance, and when in doubt, consulting an attorney, but choosing a descriptive business name to avoid a trademark conflict? That's taking it a bit too far, don't you think?

Actually, when you drill down below each step, there is much more to say about each of them, and I'll make sure to do so later, but for today, I'll focus on what I call, "dreadful Step Number 2."

As you know, we don't like [the D-word](#) here, and as you will recall from a couple of years ago in my prior posts, "[A Legal Perspective on the Pros and Cons of Name Styles](#)," and "[Staying on the Right Side of the Line: Suggestive v. Descriptive](#)," we established the strong preference for suggestive as opposed to merely descriptive names and marks, and we addressed the all-important [Spectrum of Distinctiveness](#) for trademarks:



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Nevertheless, NFIB, in support of mere descriptiveness, indicates:

*"If you're deciding what to name your business, you're more likely to prevent a trademark infringement lawsuit if you pick a general name that describes your business' services—Plumbing Contractors Inc. or Accounting Services LLC, for example—instead of something more specific. While your business name may overlap with another's, there is less chance for them to stake a claim on those terms. Just make sure that your business name still stands out."*

Putting aside the unanswered question of how a small business may hope to "stand out" if it follows "dreadful Step Number 2," let us not forget, [Subway recently convinced the U.S. Trademark Office it has exclusive rights in the term "footlong" for submarine sandwiches](#), claiming that it has acquired distinctiveness in the "merely descriptive" term, and is [asserting those claimed rights against Casey's General Store](#), among others.

If a small business really wants to have a hope for avoiding any and all possible trademark conflicts, [it needs to live in the generic category](#) (Dan's take, [here](#)), not the descriptive one (where there is the real potential for the acquisition of exclusive rights by others and where there are naturally more legal claims that actually surprise their targets), but who wants to be generic?

I can't and don't embrace the message of waving the white surrender flag, conceding any hope of naming creativity or any hope of clearing and adopting a truly distinctive name or mark. Even small businesses with limited budgets can and should do better.

If a small business uses common sense, does its homework, and consults a [competent and experienced trademark attorney](#), there is no reason to limit itself or place false hope in pursuing "dreadful Step Number 2."

If nothing else, I think we may have found another D-word.

Hat tip to [Mark Prus](#) who flagged this topic for me and even offered up a portion of the title, minus the question mark.

