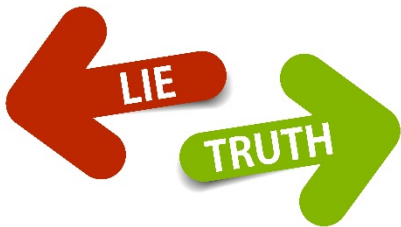


ON MY MIND BLOG

You may not Realize that your Trademark is Deceptive

11.18.2021 By [William M. Borchard](#)



Choosing a trademark with an appealing connotation normally is desirable. But if the mark conveys a plausible but false idea about some aspect of the goods or services, it may be considered to be deceptive. The dividing line is not always obvious.

Background

A trademark signifies the source of a product or service. Generally, the most protectable mark is a **coined term** (a made-up word), an **arbitrary term** (a word for something that has no relationship to the product or service), or a **suggestive term** (a word that makes the product or service seem desirable). These types of mark are immediately registrable.

Even a **merely descriptive term** (a word that conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the product or service) may be registered if the applicant disclaims the exclusive right to use that term apart from the mark as a whole or if consumers come to recognize a “secondary meaning” in that term as an identification of the source of the product or service in addition to its descriptive connotation.

What if the term misdescribes some aspect of the product or service? If the **misdescriptive term** is obviously so, it will be registrable as if it were an arbitrary word as applied to that product or service. However, if the falsity of the misdescription is not obvious, the term is considered to be a **deceptively misdescriptive term**, which still will be registrable if it acquires a secondary meaning as a source identification.

However, a totally different category is a **deceptive term** (a deceptively misdescriptive term for which the falsity will materially affect the consumer's purchasing decision). Such a term is completely precluded from registration under any circumstances, even if it is disclaimed or is claimed to have acquired secondary meaning. Its use also may run afoul of the Federal Trade Commission rules against deceptive or misleading advertising.

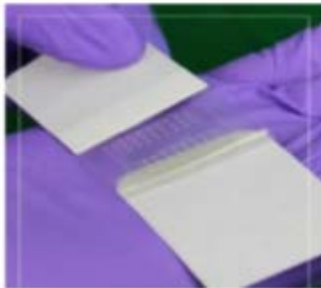
The Issue

How do you decide whether a term is deceptively misdescriptive (registrable with secondary meaning) or deceptive (unregistrable)?

To do so, you must get into the mindset of the proverbial ordinary consumer to decide whether the deception will be a motivating factor in the decision to purchase the product or service. Ironically, the more persuasive a deceptively misdescriptive mark may be, the less registrable it may be.

Example

BandGrip, Inc. filed an intent to use application to register SMART SUTURE for “bandages for surgical use for skin wounds having mechanical hooks that penetrate the skin on either side of the wound for attachment to the skin.” A photo of the proposed product showed that this product would indeed be a type of bandage.



The Examining Attorney refused registration on the ground that the mark was deceptive in relation to bandages. BandGrip appealed to the Trademark Trial and Appeal Board (TTAB). The TTAB affirmed the refusal.

The evidence established that sutures and bandages are separate and distinct products. A dictionary defined a “bandage” as “a strip of fabric used especially to cover, dress and bind up wounds.” Another dictionary defined a “suture” as “the fine thread or other material used surgically to close a wound or join tissue.” BandGrip itself distinguished its bandage from a suture in its advertising materials:

“Unlike the raised surfaces of staples and zippers, and the “whiskers” associated with sutures, the smooth surface of BandGrip Micro-Anchor Skin Closures doesn’t catch on dressings or clothing.”

So the TTAB found that the term SMART SUTURE was misdescriptive for bandages.

The next question was whether purchasers would believe that goods bearing the mark SMART SUTURE were sutures rather than bandages causing the mark to be considered deceptively misdescriptive? Although one might think that a picture on the product's packaging would remove the deceptiveness aspect by clarifying that the product is a bandage and not a suture, the TTAB generally does not consider marketing materials, and limits its analysis to the mark itself and the goods or services specified in the application. The TTAB found that the false description was believable since sutures and bandages serve a similar purpose (to close a wound) and may be used together,

The final issue was whether the believable falsity of this deceptively misdescriptive mark would be material to the purchasing decision. Although the record lacked direct evidence of consumer preference and motivation, indirect evidence convinced the TTAB that doctors, nurses, and other caregivers prefer sutures out of habit, need, and training. Therefore, the TTAB concluded that this falsely descriptive mark would affect the purchasing decision.

BandGrip undoubtedly believed that SMART SUTURE was a cleverly suggestive mark for bandages. But the TTAB affirmed the refusal to register SMART SUTURE on the ground that this mark was deceptive as applied to bandages.

[BandGrip, Inc.](#), Application No. 88265665 (October 21, 2021)

Author's Note: In 1808, Walter Scott wrote, "O, what a tangled web we weave when first we practice to deceive!"

In the trademark world, however, deception focuses on the purchaser's mindset regardless of the intention of the marketing party.

If you select a mark consisting of or containing a clever term that might misdescribe your product or service, you need to consider whether that term's cleverness, rather than its misdescriptiveness, will be apparent to a consumer. If not, and if that term may be important to the consumer's purchasing decision, you probably should rethink your mark.

These fuzzy distinctions can make predictions difficult, but the consequences may be important.

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