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The Name Game: Practical Branding Tips for Robotics Companies

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In this article, the authors identify common trademark pitfalls that robotics companies face and provide practical tips for avoiding them.

As robotics and artificial intelligence ("AI") technologies continue to grow, businesses in this field face the challenge of how they should name their new technologies.

Moreover, as part of this naming process, these businesses must decide whether the name that they have chosen will be (a) their exclusive brand/trademark, or (b) a generic term for their new technology that will enter the public's vocabulary. Failure to distinguish between trademarks and generic names can lead to significant branding problems later making it impossible to distinguish a business's product or service from that of its competitors.

This article identifies common trademark pitfalls that robotics companies face and provides practical tips for avoiding them.

Differentiating Your Technology Name from Your Brand Name

A common problem among companies developing new technologies is failure to adopt a branding strategy early on. Often, in the excitement of introducing a new technology, the name that the company uses for its new proprietary invention becomes synonymous with the technology itself rather than functioning as a proprietary name for the product of that company. Indeed, many assume that the same name can identify both the technology generically and also function as a brand/trademark. However, this assumption will ultimately lead to major headaches.

If the technology is patentable, conflating the generic technology name and the trademark will not cause immediate problems since the technology is not available to competitors. However, once

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the patent expires, and others can make competing products, those businesses are legally allowed to accurately describe their products.

If the original innovator has conflated the name of the technology with the trademark, the new competitors can argue that the "name" cannot possibly operate as a trademark since there is no other name that consumers will recognize when trying to identify the particular technology. When that occurs, all the goodwill and consumer recognition the innovator has built up will be lost because the "name" that it used has, by default, become the generic term of the technology that all competitors must be able to use.

This difficult situation can be avoided if the innovator makes a concerted effort from its first commercial launch of the technology to use different names for the technology itself and for its particular "branded" line of products. The "generic" name for the technology can be wording that immediately informs the relevant purchasers of a significant quality, ingredient, or characteristic of the new technology.

In contrast, the proprietary trademark, as discussed in greater detail below, should convey only very limited information about the technology and instead should be viewed by consumers solely as identifying the innovator's specific, proprietary product. Once the trademark has been adopted, the innovating company must take care to consistently use it separately from the generic name of the technology. Improper use of the trademark that causes consumers to confuse it with the generic name risks loss of exclusive ownership of the trademark.

The sad saga of the ULTRA VIOLET DEVICES trademark application provides an excellent example of how an innovator of new technology can fail to gain exclusive rights to its purported brand through failure to implement an effective branding strategy.[1]

In that case, the inventor of new air and water purifier technology utilizing ultraviolet light attempted to register ULTRA VIOLET DEVICES as a trademark with the U.S. Patent and Trademark Office ("USPTO"). The USPTO examining attorney refused registration on the ground that ULTRA VIOLET DEVICES functioned merely as a generic term for the technology rather than as a trademark for the inventor's specific product. The inventor appealed the refusal to the Trademark Trial and Appeal Board (the "Board").

The Board agreed with the examining attorney that the term ULTRA VIOLET DEVICES merely identified a category of air or water purification unit. Specifically, the Board found that the refusal

was appropriate given the large volume of internet evidence showing that consumers and competitors used "ultraviolet" to describe similar purification technologies. The evidence included pages from www.excelwater.com, referring to "ultraviolet purification" as "[d]isinfecting your drinking water with ultraviolet light (UV)" and "Ultraviolet" as "a UV light source, which is enclosed in a transparent protective sleeve." Adding the generic word "devices" was not sufficient to transform the phrase as a whole into a proprietary brand name.

Furthermore, the innovator's long-standing 14-year use and promotion of ULTRA VIOLET DEVICES could not overcome the fact that the term was widely used in the field. The record also failed to show any evidence that the innovator had taken steps to try to stop competitors from using "ultraviolet" or "ultraviolet devices" during that time. Had this innovator tried to secure a trademark that was not synonymous with his technology, his 14 years of promotional activities would have created a strong brand rather than leaving him without a protectable trademark asset.

With the proper precautions, an innovating company need not lose its proprietary trademark when its patent expires or when its technology has become ubiquitous in the field. The key is to consistently use different names for the technology itself versus the actual trademark that the innovating company uses to identify its own products and distinguish them from competing products.

Selecting Trademarks That Are Protectable

Once an innovating company has taken the first step to develop separate names for its generic technology and its own specific proprietary trademark, it must ensure that the trademark it has chosen can function as the exclusive name for its product.

Do Not Chose a Trademark That Immediately Describes the Qualities or Characteristics of Your Technology

Selecting a trademark is no easy task because all trademarks are not created equal. Rather, the more distinctive a mark, the easier it is to protect. Only trademarks that are distinctive can be registered with the USPTO.[2]

Strong, highly distinctive trademarks are usually "fanciful" words coined solely to function as a trademark, and have no other meaning than that, such as KODAK and TRIFO. Distinctive trademarks can also include "arbitrary" terms with a common dictionary meaning but that meaning has no relation to the goods or services being sold, such as APPLE for computers, GALAXY for phones, and ROOT for robots.

Trademarks that convey information about the qualities and characteristics of your technology can be trickier. A trademark that merely *suggests* some aspect of your technology and requires consumers to use their imagination to understand that meaning can be treated as distinctive, and thus registrable with the USPTO. Examples of such "suggestive" trademarks include COMPUGRAPHIC for computerized typesetting equipment[3] and WIRELESS NOW! for online information services.[4]

Trademarks that literally describe the technological aspects of a product are not immediately registrable with the USPTO and cannot be protected against infringement unless they have been used and promoted to a sufficient degree that consumers recognize them as trademarks. Examples of such "descriptive" trademarks include CONTINUOUS PROCESSING for computers;[5] INSTANT MESSENGER for real-time online communications;[6] AUTOPROBE for self-powered, mobile soil sampling machines;[7] and FLUID INTELLIGENCE for computer software and artificial intelligence systems.[8]

In selecting trademarks, there is often a tension between marketing personnel and legal personnel. From a marketing perspective, there is a natural tendency to choose a "descriptive" trademark that immediately conveys an important characteristic of a product or service to make the advertising easier and less costly. Trademark lawyers, on the other hand, prefer fanciful, arbitrary, or suggestive marks because they are immediately protectable against infringement and can be registered with the USPTO.

It can sometimes be difficult to determine whether a given proposed mark is a "descriptive" term or falls into one of the distinctive categories of trademarks. The USPTO has provided an excellent example of how to analyze this question relating to robotics products when it found the term ORTHOROBOTICS to be merely descriptive of medical surgery services and refused registration of the trademark.[9] The USPTO examining attorney reasoned that the mark directly describes orthopedic surgery featuring the use

of robots because "ortho" is a nickname for "orthopedic" and the term "robotics" identifies the tools used during the surgery.

The applicant, Dorr, responded by arguing that the term "ORTHOROBOTICS" is suggestive rather than descriptive and should be registrable. Specifically, Dorr asserted that robotics could suggest any "use of computer-controlled robots to perform manual tasks" and "ORTHO" had a variety of meanings outside the surgical setting, so consumers would need to use their imaginations to determine the meaning being conveyed by "ORTHOROBOTICS." Dorr's arguments failed to persuade the examining attorney to withdraw the descriptiveness refusal. Dorr's arguments did not persuade the Board either. On appeal, the Board found that the uses of "ORTHO" on the webpages submitted by the examining attorney *in the context of surgery* demonstrated a clear and immediate association of "ortho" with "orthopedic," and in the same way that "orthopedic" was used on Dorr's webpage in connection with medical surgery services.

Do Not Fall into the Trap of Misdescriptive or Deceptive Trademarks

Another temptation when naming a product is to select a trademark that puffs up or highly extols the capability of the product. Such laudatory marks can be dangerous. If the trademark solely signifies that the product is "the best," then it will likely be categorized as laudatory[10] and non-distinctive, just like descriptive trademarks. If the trademark exaggerates the virtues of the product, making claims that the trademark owner cannot justify, then the trademark may be rejected as misdescriptive under Trademark Act Section 2(e)(1)[11] or deceptive under Section 2(a).[12]

For example, the mark "BIOSILK" has been found deceptive of clothing, when the Applicant refused to clarify in its application whether the materials of its clothing items contain any silk, because it "simply does not know of what materials its clothing line will be made of."[13]

Another example relates to the "greenwashing," which is the practice of making disingenuous environmental marketing claims. In 2013, the Board affirmed a refusal to register the mark "GREEN SEAL" for adhesive and packaging tapes that were not eco-friendly, despite that the applicant argued that the word "GREEN" referred to

the color of the tapes as in its line of other colorful tapes (BLACK SEAL, BLUE SEAL, etc.).[14] Similarly, COPPER-TEN has been refused for pre-painted sheet steel that is not copper.[15]

Case Study for Selecting a Mark That Is Impossible to Protect

In re Neurobotics, L.L.C.,[16] is an excellent illustration of how a new business can fall into the trap of selecting a mark that was impossible to register with the USPTO.

Neurobotics, L.L.C. ("Neurobotics") created a new surgical tool that uses robotic controllers to assist surgeons by enhancing their human senses. Neurobotics viewed its invention as leading the field of robotic and computer-assisted neurosurgery. However, instead of developing a separate, generic name for its new technology, Neurobotics conflated the generic technology name and the trademark NEUROBOTICS, an obvious reference to the words, "neurology" and "robotics." Neurobotics then applied to register the mark with the USPTO for surgical interface control systems and their design and development services. The USPTO refused the registration on the grounds that the mark NEUROBOTICS is:

1. Merely descriptive;
2. Misdescriptive; or
3. Deceptive of its goods and services.

Neurobotics appealed but the Board affirmed the refusals.

The examining attorney argued that the term "neurobotics" merely describes the fusion of neuroscience and robotics for augmenting human capabilities, which is exactly what Neurobotics identified as goods and services in its trademark application. To support the refusal, the examining attorney submitted dictionary definitions of the words "neurosurgery," "robot," and "robotics." She also submitted excerpted articles discussing the use of robots in surgery, including a newspaper article from the *Indianapolis Star*, reporting research by Purdue University; a blog post by the *Robotic Nation Evidence* stating that "Neurobotics is a new field that lies at the intersection of Robotics and Neurosicence"; the official website of University of South California commenting that "neurobotics will consolidate the area of 'human augmentation' and 'hybrid

bionic systems'"; as well as a screenshot from the website www .neurobotics.org offering services such as "neurobotics workshops."

The examining attorney pointed to Neurobotics' own utility patent filings that described its medical products as follows:

> The present invention relates to the field of *robotic* and computer assisted *surgery* . . . for example, *neurosurgery*. . . .[17]

Neurobotics tried to avoid the descriptiveness refusal by arguing that its equipment "does not utilize artificial intelligence as a substitute for a human operator, and accordingly not 'robotic.'" However, this argument triggered the alternative refusals, namely deceptiveness and misdescriptiveness refusals.

In response to the misdescriptiveness refusal, Neurobotics pointed out that it adopted the mark in 2002, a time that preceded any evidence of record, where NEUROBOTICS had no meaning beyond a coined term. But the Board held that the timing of adopting the mark was irrelevant.[18] The Board determined that at least some potential purchasers would be familiar with this term as it is used now, understand its value regarding Neurobotics' products and, thus, be deceived.

Ultimately, the Board affirmed all three refusals to register the mark NEUROBOTICS for augmented surgical interface control systems on the grounds of descriptiveness, misdescriptiveness, and deceptiveness, making it the impossible mark to protect.

Conclusion

It goes without saying that branding is indispensable following the development of your new products and technologies. Striking a balance between the legal and marketing needs is critical. Conflating the generic name for your new technology with the trademark is the worst, yet most common mistake that many robotics and AI companies make. On the other end of the spectrum, misrepresentation can destroy a brand, devalue a product and hurts sales. Learning from these recent decisions can help prevent your business from making the same mistakes.

Innovators can greatly reduce their risks of repeating these mistakes by implement these three branding practices:

- Develop separate, generic names for groundbreaking technology, independent of the desired new brand/trademark.
- Remove improper use of the trademark that conflate the trademark with the technology itself. This should include policing internet commentary, media statements, patent filings, competitors' materials, and even one's own materials.
- Timely consult an experienced trademark counsel to make sure that the selected brand/trademark is protectable and will not be considered a generic or descriptive term.

Notes

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1. *In re Ultra Violet Devices, Inc.*, Serial No. 78589646 (TTAB 2008).
2. Fanciful, arbitrary, and suggestive marks, often referred to as "inherently distinctive" marks, are registrable on the Principal Register without proof of acquired distinctiveness. *See* TMEP §1209.01(a).
3. *Compugraphic Corp. v. Compu-Graphic Corp.*, 167 USPQ 459 (S.D.N.Y. 1970).
4. *Malarkey-Taylor Assoc. v. Cellular Telecom. Indus. Ass'n*, 929 F. Supp. 473 (D. D.C. 1996).
5. *Stratus Computers Inc. v. NCR Corp.*, 2 USPQ2d 1375 (D. Mass. 1987).
6. *In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2016).
7. *In re AgRobotics, LLC*, 2009 WL 1719380 (TTAB 2009).
8. *In re Kevin W. Goldstein*, 2017 WL 6939342 (TTAB 2017).
9. *In re Dorr Arthritis Institute Medical Associates, Inc.*, 2012 WL 504688 (TTAB 2012).
10. Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1). *See* TMEP Section 1209.03(k); Cf. *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012).
11. 15 U.S.C. §1052(e)(1).
12. 15 U.S.C. §1052(a).
13. *In re Farouk Systems, Inc.*, 2008 WL2619504 (TTAB 2008).
14. *In re Kitaru Innovations Inc.*, Serial No. 85211019 (TTAB 2013).
15. *In re United States Steel Corporation*, Serial No. 86174180 (April 8, 2016).
16. *In re Neurobotics, L.L.C.*, 2008 WL 3873413 (TTAB 2008).
17. Emphasis added.
18. The Board cited *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566, that it must decide each case on its own merits.