Why What We Call Our Business Is So Critical

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A trademark protects a company’s goodwill and reputation. The owner of a legitimate trademark may prevent others from using a similar mark that is likely to cause confusion among consumers as to the relationship or affiliation of the two entities or their products or services. A company cannot, however, monopolize a generic term under the auspices of trademark law. This concept will be tested in a recently filed matter pending in the Southern District of New York.

Best-selling author and consultant Dov Seidman has built an international consulting practice around the term “How.” His book, “How: Why How We Do Anything Means Everything,” and his 10-year-old company, LRN, are dedicated to helping companies achieve more ethical cultures.

When Chobani, America’s largest producer of Greek yogurt, launched a campaign based on the phrase “How Matters” to promote its own social responsibility program, Mr. Seidman took exception. He filed a trademark infringement suit seeking a court order to prevent Chobani from further use of the term because LRN uses that same phrase in some of its marketing materials.

The response of Chobani and its ad agency was that, not only had they never heard of LRN, but the trademark highlighted the term “How” and therefore should be voided because the term is generic and thus not entitled to trademark protection.

Chobani’s claim that it was not aware of LRN or its use of the term “How” seems to be rebutted by the company’s own Twitter account. It featured a post acknowledging Mr. Seidman and his firm just a few days before launching its campaign with an ad during the 2014 Super Bowl.

The larger issue, however, will be whether LRN can demonstrate that there is likely to be any consumer confusion between an ethics consulting firm and yogurt, and whether the term “How” is entitled to protection under the trademark laws. That may be a steep hill to climb as, generally speaking, terms used in trademarks in their ordinary sense (e.g., naming an establishment that primarily serves crabs the “Crab House” or a store that sells lighting fixtures the “Light Store”) are not entitled to trademark protection. Also, one of the most important factors in determining whether confusion is likely is the similarity (or dissimilarity) of the products or services marketed under the
respective marks. Yogurt and consulting services don’t appear closely related, thus reducing the likelihood of any confusion.

Despite Mr. Seidman’s claim that he views the suit as more an ethical issue than a legal one, the law will determine how it turns out in the end.
Questions about intellectual property and your business? Contact the attorneys at Whiteford Taylor Preston.