

Facebook Was Born A Lousy Trademark

Authored by Jess Collen for Forbes.com

Article

2.15.13

First and most importantly, why would this have been a bad trademark at the time Facebook started? A “facebook” is a name that had been used, either formally or informally, by students for a long time. When my oldest daughter started college in 2002, the freshman students, like generations before them, clung to the freshman register. You remember these. The freshman register was like a yearbook in reverse. It was filled with pictures of strangers who were your new classmates, not your departing friends. The book allowed you to put a name (and maybe a hometown and major) to a face. We had them when I was in college. Some people never looked at them, while others seemed obsessed. In my daughter’s college, they called it the “stalker book.” This was literally an “off-line” facebook.

As everyone who has seen “The Social Network” remembers, they originally called it “The Facebook.” When you decide what to call your company or product, your trademark lawyer is going to try to persuade you not to come up with a descriptive word. Descriptive words are tempting because they give you a jump start, telling the customer or user what your product is all about. But when you settle upon an ordinary descriptive term out of the everyday language, you are not going to be able to legally stop others from using the same name. There is a very good chance that some other entity calling itself “The College Facebook” could have happily used that name back in the day, and there’s nothing that Zuckerberg and Co. could have done about it.

Contrast this with an arbitrary word like “APPLE” to sell computers. Now we’re talking. Use a name like APPLE, which has nothing to do with the product or its user, and you are on the road to developing a very strong trademark that no one else can use in your market segment.

What Facebook has going for it now is the benefit of time. No place does time heal all wounds better than in trademark law. The longer a word has been in use, the stronger the owner’s rights. So, over time (there’s a typical presumption of five years in the law, but that

Key Contact

Jess M. Collen

Related Areas of Practice

Trademark Prosecution

is just a benchmark), an owner can have acquired exclusive rights even in a descriptive term. When Facebook launched in 2004, the word Facebook was a bad name. If you said Facebook to someone, they would have thought of one of those freshman directories. Today, of course, the word Facebook means the colossal global social networking (and much more) site. Over time, the company has earned rights to its name.

Maybe if it wasn't called Facebook, enough people wouldn't have known what it was, and the concept never would have taken off. But, that's doubtful. Look at examples all over the Internet. Google and Yahoo seem to do okay.

How many times have I told a client not to use a name, and they ignored me, and the product went on to be a hit? It would be a safe bet to say I am usually the big loser in the weekly office football pool, so gambling does not usually work so well for me. But winning with a descriptive trademark is a gamble. If you survive those early years, all is good. But, those early years are always the hardest to survive. Don't fall in love with your name and don't take a name that you can't stop other people from using.

Sure, today we can't imagine Facebook not being Facebook. Does that mean it was a good name? I don't think so. Even today, there are trademark disputes going on between Facebook and other companies. Facebook has even given up one of its earliest trademark registrations, which described its services as "providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community, and social networking." (U.S. Trademark Registration No. 3,122,052.) And of course, by now, Facebook has just a few extra bucks they can spend on lawyers that may not have been so easy for them to spare in 2004.

If you're developing a product or a service that you expect within, say, the next decade or so, to yield you 845 million (and growing) consumers, then go for it. I don't know what the discussions were when they selected the name Facebook. It does appear that they filed a trademark application fairly soon after the site launched in full. For most companies, big, small and medium, it's a really good idea to take a name that won't bog you down in challenges, litigation, and disputes. Descriptive names are the easy way out, and things don't always end up quite as well as they have for Facebook.

What does that say about the trademark lawyer? Well, in my own defense, I think I would have been right. Facebook has become a phenomenon of unmatched scope. There used to be an old saying: "Do the clothes make the man or does the man make the clothes?" It's the same with trademarks. Does a good name make a product? By the way, even though, personally, I recoil at the whole "my-everything" name trend, I would have been much happier approving the MYSPACE trademark for a social network.

Partner Jess Collen published "Facebook Was Born a Lousy Trademark" on Forbes.com. Jess is a contributor on the site and regularly writes on trademarks, branding, copyright, advertising, and patent law.

You can read the full article on the Forbes website.