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The Feasibility of Trademark Registration: An Analysis Based on the Recordability Thermometer

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ABSTRACT

This article presents a detailed analysis of the feasibility of registering trademarks based on a visual tool called 'Registration Thermometer'. This tool categorizes brands into five distinct levels: fantasy, random, evocative, descriptive, and product or service, to assess their potential for registrability at the National Institute of Industrial Property (INPI) in Brazil. The study discusses the importance of each category and provides guidance on how companies and individuals can use this tool to increase their chances of success in registering trademarks.

Keywords: Trademark Registration; Intellectual Property; Registration Thermometer.

INTRODUCTION

Trademark registration is an essential component of intellectual property, protecting the exclusive rights to use a brand and ensuring its distinction in the market. However, not all trademarks are registrable. The registrability of a trademark depends on several factors, including its originality, distinctiveness, and the relationship it has with the product or service it represents. This article proposes a practical approach to evaluate the feasibility of trademark registration using the 'Registration Thermometer,' a visual tool that classifies trademarks based on their distinctive characteristics.

The study was based on a wide range of sources that address the fundamentals of trademark law, trademark distinctiveness, and registration practices at the National Institute of Industrial Property (INPI) in Brazil.

The distinctiveness of a trademark is one of the key criteria for its registrability and is widely discussed in academic literature and in the guidelines of registration authorities. According to Drescher (2022), distinctiveness is crucial for a trademark's ability to be registered and protected. Highly inventive or arbitrary trademarks tend to have a higher probability of registration because they are better able to distinguish themselves in the market. McFadden (2021) also emphasizes the importance of distinctiveness, noting that a lack of originality can lead to the rejection of a registration application, especially if the trademark is considered descriptive or generic.

The National Institute of Industrial Property (INPI, 2023) provides detailed guidelines on the criteria that determine the registrability of a trademark in Brazil. These guidelines are fundamental to understanding how trademarks are evaluated in terms of distinctiveness and how to avoid rejection during the registration process. INPI emphasizes the importance of choosing trademarks that not only identify a product or service but are also capable of differentiating them from competitors.

The World Intellectual Property Organization (WIPO, 2023) also offers an international perspective on trademark laws, addressing how different jurisdictions treat the issue of distinctiveness. WIPO's guide is particularly useful for companies operating in multiple markets, offering guidance on how to protect their trademarks in different countries.

According to Oliveira (2024), there is significant importance in conducting a detailed analysis of distinctiveness before submitting a trademark for registration to eliminate the chances of rejection during the substantive examination. Oliveira (2024)

further argues that preventing problems during registration can be achieved through the use of tools such as the Registration Thermometer, which helps identify trademarks with a higher potential for success.

The Registration Thermometer emerged as an innovative methodological tool that serves to assess a trademark's registration potential based on its distinctiveness and originality. Just as a regular thermometer measures temperature, indicating whether it is at a low, medium, or high level, the Registration Thermometer measures the "temperature" of a trademark's registrability, that is, its ability to be recognized as distinctive and original in the market.

FEASIBILITY ANALYSIS

Before the actual filing of the registration application, it is necessary for professionals working with industrial property or trademark holders to conduct a preliminary feasibility analysis. This analysis consists of an early evaluation of the likelihood of success in registering a trademark, considering various factors such as distinctiveness, originality, and potential conflicts with already registered trademarks.

The feasibility analysis is not formally required by the INPI, but it is a recommended practice to avoid the time and costs involved in a registration process that may result in rejection.

STAGES OF FEASIBILITY ANALYSIS

The feasibility analysis serves as a preventive measure, allowing companies and entrepreneurs to assess, in a practical and strategic way, whether the trademark they wish to register has a good chance of being approved by the INPI. This analysis generally involves the following steps:

- **Existing Trademark Search:** Verification of the existence of similar or identical trademarks that may pose an obstacle to registration.

- **Distinctiveness Evaluation:** Analysis of the trademark’s ability to distinguish itself from the products or services it identifies. Descriptive or generic trademarks

tend to have low chances of registration, while fanciful and arbitrary trademarks have a greater chance of success.

- **Conflict Analysis:** Identification of potential conflicts with previously registered or applied-for trademarks, which may lead to opposition or rejection of the application.

- **Consultation with Specialists:** This may include consulting intellectual property lawyers or trademark consulting firms for a more detailed evaluation.

HOW FEASIBILITY ANALYSIS FITS INTO THE REGISTRATION PROCESS

The feasibility analysis is carried out before the filing of the registration application and can be seen as a preparatory step. If the analysis indicates that the trademark has a high probability of being registered, the entrepreneur can proceed with greater confidence to the application filing phase. Otherwise, they may choose to adjust the trademark or select an alternative name, thus avoiding the cost and effort of an application that has a high chance of being rejected during the substantive examination.

In this way, the feasibility analysis serves as a strategic tool that helps maximize the chances of success in trademark registration, saving time and resources by avoiding common mistakes that could result in the rejection of the application by the INPI.

REGISTRATION PROCESS AT INPI

The trademark registration process at the INPI consists of several stages, starting with the filing of the application and culminating in the registration of the trademark, if approved. The main stages include:

- **Filing of the Application:** The registration application is formally submitted to the INPI, with all necessary information, such as the trademark name, the class of goods or services it will identify, and the applicant's details.

- **Formal Examination:** The INPI conducts a preliminary examination to verify whether the application meets the formal requirements, such as the correct

classification of goods or services and the payment of fees. If the application is formally correct, it is published in the Industrial Property Journal (RPI).

- **Opposition Period:** After publication, third parties have a period of 60 days to oppose the trademark registration if they believe it infringes their intellectual property rights.

- **Substantive Examination:** At this stage, the INPI examines the merits of the application, evaluating whether the trademark can be registered based on legal and regulatory criteria. The substantive examination includes verifying the distinctiveness of the trademark, whether it is not generic or descriptive concerning the goods or services it intends to identify, and whether there are no conflicts with previously registered or applied-for trademarks.

  The substantive examination is a fundamental stage in the trademark registration process at the National Institute of Industrial Property (INPI). It involves the detailed evaluation of a trademark application to determine whether the proposed trademark meets all necessary legal and regulatory requirements for registration. During the substantive examination, the INPI checks, among other things, the distinctiveness of the trademark, whether it is not generic or descriptive concerning the products or services it intends to identify, and whether there are no conflicts with previously registered or applied-for trademarks.

- **Decision:** Based on the substantive examination, the INPI decides whether the registration application should be granted (approved) or rejected (denied). If the application is granted, the applicant must pay the final registration fees for the trademark to be officially registered. If denied, the applicant may appeal the decision.

- **Grant and Publication:** After payment of the final fees, the trademark registration is granted and published in the RPI. The registered trademark is valid for 10 years and may be renewed for successive 10-year periods.

REGISTRABILITY THERMOMETER

The Registrability Thermometer is a tool developed by the author to help companies and entrepreneurs assess the likelihood of success in trademark registration, that is, whether a trademark is registrable or not. This tool serves as a strategic guide that allows for the identification and adjustment of brand elements before submitting the registration application to the competent authorities, such as the National Institute of Industrial Property (INPI).

In addition, the Thermometer serves as an educational tool for lawyers, industrial property agents, entrepreneurs, and other professionals, helping them better understand the principles of distinctiveness and the importance of creating trademarks that not only meet legal requirements but also have strong market potential.

COMPARISON WITH A COMMON THERMOMETER

To fully understand the utility and functioning of the Registrability Thermometer, it is helpful to compare it to an everyday instrument that we are all familiar with: the common thermometer. Just as a traditional thermometer measures temperature and provides a clear visual indication of the state of an environment or organism (Buclkey & Craig, 2006), the Registrability Thermometer measures the "temperature" or feasibility of a trademark being successfully registered.

This analogy is not merely illustrative; it reflects the essential functionalities of both instruments (Harrison, 2015). While a common thermometer assesses the physical condition of a body (Morris, 2012), allowing corrective actions based on the reading (such as cooling a room or treating a fever) (NIST, 2010), the Registrability Thermometer evaluates the legal and market condition of a trademark, suggesting adjustments that may be necessary to increase its chances of registration and commercial success.

By comparing the Registrability Thermometer with a common thermometer, we can explore the similarities and differences in their functions, scales, and practical impacts, providing a deeper understanding of how this tool can be used in the strategic development of trademarks.

- **Measurement Function:** A common thermometer measures the physical temperature of an environment, body, or substance, providing a direct reading of

a numerical value indicating heat or cold. Similarly, the Registrability Thermometer measures the "temperature" of a trademark's distinctiveness, providing a qualitative reading that indicates the likelihood of success in the registration process.

- **Measurement Scale:** Just as a common thermometer can have different scales (Celsius, Fahrenheit, Kelvin), the Registrability Thermometer has its own scale, divided into five categories: fanciful, arbitrary, suggestive, descriptive, and product or service. Each category represents a level of "temperature" regarding the possibility of registration, ranging from high (fanciful marks) to very low (marks that use the product or service name).

- **Risk Indicator:** In a common thermometer, extreme temperatures (very high or very low) may indicate a risk to health or the integrity of materials. In the Registrability Thermometer, trademarks with low temperature (descriptive or using the product name) indicate a high risk of rejection in the registration process, suggesting that the mark lacks sufficient distinctiveness. On the other hand, trademarks with high temperature (fanciful and arbitrary) indicate low risk, with a high probability of successful registration.

- **Practical Utility:** A common thermometer is used to make immediate decisions, such as seeking medical treatment in case of fever or adjusting the temperature of a room. Similarly, the Registrability Thermometer is a practical tool for making strategic decisions in brand creation. It helps companies and entrepreneurs adjust their branding strategies before submitting a trademark for registration, avoiding futile efforts and saving resources.

- **Prevention and Adjustment:** Just as a thermometer can alert to the need for preventive interventions (such as reducing fever or warming up a room), the Registrability Thermometer alerts to the need for adjustments to the trademark before proceeding with registration. If a trademark is classified as descriptive or generic, the thermometer suggests that the entrepreneur should reconsider the name, perhaps opting for something more original or suggestive that could improve the chances of registration.

TEMPERATURE IN THE REGISTRABILITY THERMOMETER

In the context of the Registrability Thermometer, "temperature" is a metaphor used to represent the probability of success in the trademark registration process. Just like in a conventional thermometer, where temperature indicates a physical state (hot or cold), in the Registrability Thermometer, the temperature indicates the degree of viability for a trademark to be registered, based on its distinctiveness and originality.

- **High Temperature:** Trademark categories classified with a "high" temperature have a high probability of registration. This is because these trademarks are highly distinctive and original, characteristics that are highly valued by registration authorities, such as the INPI.

- **Medium Temperature:** "Medium" temperature is attributed to trademarks that indirectly suggest a quality or characteristic of the product or service.

- **Low Temperature:** Low temperature indicates a reduced probability of registration, usually applied to descriptive trademarks.

- **Very Low Temperature:** At the lower end of the thermometer, we find trademarks classified as having "very low" temperature. These are the trademarks that use the actual name of the product or service, which generally prevents them from being registered.

THE IMPORTANCE OF FANCIFUL OR ARBITRARY TRADEMARKS

Fanciful or arbitrary trademarks are those that have no direct connection to the products or services they represent. Classic examples include "Kodak" for cameras and "Apple" for computers. These trademarks are highly original and distinctive, placing them at the top of the Registrability Thermometer. Investing in trademarks of this nature is an effective strategy because:

- **High Distinctiveness:** Fanciful or arbitrary trademarks are inherently distinctive, meaning they are less likely to be confused with other existing trademarks in the

market. This significantly reduces the risk of third-party opposition during the registration process.

- **Greater Protection:** Due to their distinctiveness, these trademarks have stronger legal protection, making it more difficult for other companies to use similar trademarks, thereby strengthening the exclusivity of the registered trademark.

- **Ease of Registration:** Trademarks that are clearly original have a higher probability of passing the substantive examination without issues, resulting in a faster registration process with fewer obstacles.

- **Challenges of Descriptive or Generic Trademarks:** On the other hand, descriptive trademarks or those that use the actual name of the product or service face significant challenges in the registration process. Examples of descriptive trademarks would be "Rápido" (Fast) for delivery services or "Fresco" (Fresh) for food products.

These trademarks tend to occupy the lowest positions on the Registrability Thermometer for several reasons:

- **Low Distinctiveness:** Trademarks that directly describe a characteristic of the product or service are less able to stand out in the market. As a result, they offer less value in terms of branding and are more difficult to protect legally.

- **High Chances of Rejection:** During the substantive examination, the INPI may determine that the trademark does not meet the distinctiveness requirement, leading to the rejection of the registration application. This happens because descriptive trademarks do not provide the exclusivity necessary to differentiate a product or service from its competitors.

- **Conflict Risks:** Descriptive or generic trademarks are more likely to conflict with existing trademarks, which can lead to legal disputes or the need for rebranding, generating additional costs for the company.

METHODOLOGY

To evaluate the feasibility of trademark registration using the Registrability Thermometer, a set of methodological procedures was developed that encompass the stages of categorization, analysis, and application of the tool. These stages are designed to provide a clear and structured evaluation of trademarks, helping companies and entrepreneurs make informed decisions in the process of creating and registering trademarks.

CATEGORIZATION STAGE (USING THE THERMOMETER)

A The first stage of the methodological process consists of categorizing trademarks based on their level of distinctiveness. At this stage, trademarks are classified into one of the five categories of the Registrability Thermometer:

- **Fanciful:** Completely invented trademarks, with no connection to the product or service they identify. Example: "Kodak" for cameras.

  Temperature: High

- **Arbitrary:** Common words but with no direct connection to the product or service. Example: "Apple" for computers.

  Temperature: High

- **Suggestive:** Trademarks that indirectly suggest a quality or characteristic of the product or service. Example: "Greyhound" for transportation services.

  Temperature: Medium

- **Descriptive:** Trademarks that directly describe a characteristic or quality of the product or service. Example: "Rápido" (Fast) for delivery services.

  Temperature: Low

- **Product or Service:** Trademarks that use the actual name of the product or service. Example: "Computer" for computers.

Temperature: Very Low

The categorization establishes the basis upon which the subsequent analysis will be conducted, based on the temperature. Each category has specific temperatures that directly influence the probability of success in registration. To facilitate understanding, **Table 1** was created to represent these categories through a three-color system.

Table 1 - Categories, Description, and Temperature

Fanciful	Trademarks that are invented, with no relation to the product/service.	**High**
Arbitrary	Common words, with no direct connection to the product/service.	**High**
Suggestive	Trademarks that suggest a characteristic of the product/service.	**Medium**
Descriptive	Trademarks that directly describe a characteristic of the product/service.	**Low**
Product or service	The name of the actual product or service.	**Very Low**

Source: Oliveira (2024).

Colors were used as a visual representation of the categories. Each color indicates a specific level of viability, making it easier to interpret the analysis results and helping companies and entrepreneurs quickly understand the position of their trademarks on the registrability scale.

- **Green - High Temperatures:** The green sections of the thermometer represent high temperatures, associated with a high probability of success in trademark registration. Trademarks classified in this range are highly distinctive and original, meaning they have a strong chance of being approved during the substantive examination.

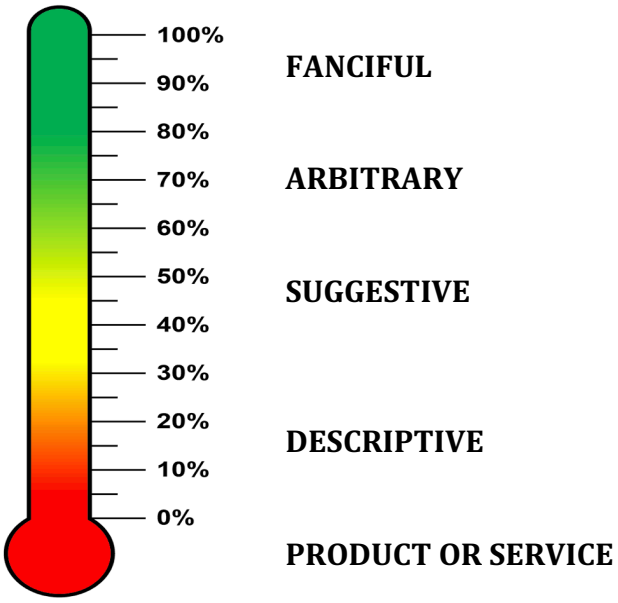
- **Yellow - Medium Temperature:** Yellow on the thermometer indicates a medium temperature, associated with a moderate probability of success in registration. Trademarks in this category have a reasonable level of distinctiveness but may still face some challenges in the registration process.

- **Amber - Low Temperature:** The faint amber color represents low temperature, as trademarks in this category are usually descriptive.
- **Red - Very Low Temperature:** The red section is a critical area of the thermometer, indicating that the trademark may be considered generic, making it less likely to be approved by the registration authorities as it directly describes the product or service.

These colors in the Registrability Thermometer work like a traffic light system, where green indicates confidence to proceed, yellow suggests caution and the need for adjustments, and red warns of a high risk of rejection. By using this color-coding system, the tool not only facilitates immediate understanding of the results but also guides users in making more effective strategic decisions during the trademark registration process.

In this sense, the first design and the initial version of the thermometer were created, as shown in **Figure 1**, representing the color system and the categories for classifying the analyzed trademark.

Figure 2 - Registrability Thermometer



Source: Oliveira (2024).

The presented figure was created using Excel, a tool widely used for data visualization and chart creation. To illustrate the Registrability Thermometer, representative data in the form of percentages were inserted, which reflect the colors, and the data only serve to change the colors of the thermometer.

ANALYSIS STAGE

After categorization, the analysis stage involves a detailed evaluation of trademarks within each category, focusing on the following aspects:

- **Distinctiveness:** Assessment of the trademark's ability to stand out from others in the market. Highly distinctive trademarks, such as fanciful ones, receive a more favorable analysis.

- **Originality:** Verification of the originality of the trademark in relation to other registered or applied-for trademarks. Trademarks with a high degree of originality are less likely to face opposition.

- **Potential Conflict:** Identification of possible conflicts with existing trademarks. This involves a thorough search in the trademark database to check for the existence of similar trademarks that could hinder registration.

During this stage, the use of research tools and consultation with intellectual property specialists may be necessary to ensure the analysis is comprehensive and accurate.

APPLICATION STAGE

The application stage of the Registrability Thermometer is where the analysis results are used to guide decision-making. At this stage, companies and entrepreneurs are advised on best practices and strategies to increase the chances of success in trademark registration:

- **Trademark Adjustments:** If the analysis indicates a low probability of registration (such as in the case of descriptive trademarks), it is recommended to adjust or modify the trademark to make it more distinctive.

- **Consulting Specialists:** For trademarks in high-risk categories, such as descriptive or product/service marks, it may be helpful to seek specialized legal advice before proceeding with the registration application.

- **Submission Strategy:** Based on the analysis, a submission strategy is recommended, which may include filing applications in multiple classes or preparing for potential oppositions.

STRATEGIES TO MAXIMIZE PROCESS EFFECTIVENESS

To maximize the effectiveness of the registration process, some complementary strategies are recommended:

- **Conduct a Comprehensive Preliminary Search:** Before submitting the registration application, it is crucial to conduct a detailed preliminary search to identify similar trademarks that may cause conflicts.

- **Focus on Highly Distinctive Trademarks:** Invest in fanciful or arbitrary trademarks, which have a higher probability of registration and offer better long-term protection.

- **Prepare Complete Documentation:** Ensure that all necessary documentation is correct and complete before submission to avoid delays or rejections due to formal issues.

- **Consider International Protection:** For trademarks with global potential, evaluate the possibility of international registration to protect the trademark in multiple markets.

When followed diligently, these methodological procedures can significantly increase the chances of successfully registering a trademark, while also strengthening the company's position in the market and protecting its intellectual property assets.

CONCLUSION AND FUTURE PERSPECTIVES

The use of the Registrability Thermometer provides a clear and systematic approach for evaluating the feasibility of trademark registration. By identifying which category their brand falls into, entrepreneurs can make more informed and strategic decisions, increasing their chances of success in registration and, consequently, strengthening the protection of their intellectual property.

Looking ahead, the Registrability Thermometer can evolve and expand in several directions. One of the main prospects is the incorporation of artificial intelligence and machine learning technologies to automate the categorization and analysis of trademarks. With the advancement of these technologies, it would be possible to develop algorithms that analyze large volumes of registered trademark data, identifying patterns and providing more precise and personalized recommendations for users.

Another important prospect is adapting the tool for emerging markets, where trademark registration is on the rise. Expanding into these markets will require a deep understanding of local peculiarities and intellectual property regulations, enabling the Registrability Thermometer to be effective in a global context.

Moreover, there is a significant opportunity to integrate the tool with online trademark registration platforms. This would allow entrepreneurs and companies to use the Registrability Thermometer as an initial step in their registration processes, receiving immediate feedback on the viability of their trademarks before proceeding with the formal application.

The evolution of the Registrability Thermometer could also include the creation of training and education modules aimed at equipping marketing professionals, lawyers, and entrepreneurs with the fundamental concepts of trademark distinctiveness and originality. These modules could be offered as online courses, workshops, or webinars, helping disseminate knowledge about best practices in trademark registration.

Therefore, the Registrability Thermometer has the potential to continue evolving as an essential tool for trademark protection in the global market. As new technologies and markets emerge, the tool can be adapted and improved to meet the ever-changing needs of its users, further strengthening the effectiveness of the trademark registration process.

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