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Choosing a Trademark or Servicemark

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**What's in a name? that which we call a rose
By any other name would smell as sweet.**

—Shakespeare, Romeo and Juliet

So, you've decided to open a new business, or your current business is set to begin offering a new product line or set of services. Now you need to decide what you are going to call this new business, product or service. In other words, what trademark or servicemark (collectively referred to herein as "mark") are you going to adopt to identify your product? This was a question my father faced when he opened his first photo studio in 1942. He chose the name Rembrandt Portrait Studio. As will be explained in this article, this was a good choice.

A company wanting protection for a mark that it will use in interstate commerce will generally want to register it with the United States Patent and Trademark Office ("USPTO"). If the mark is only used in one state or a limited number of localities, a company may choose to register with a state trademark registry, or rely on common law protection (even unregistered marks may be entitled to some protection). A mark may not be registered if it (or a similar mark) is already in use to describe a competing product or service.

A company's goal in selecting a mark is to choose one that is memorable, so that it is capable of distinguishing a company's offerings in what may be a virtual sea of

similar products or services. Once a company selects a mark, it often expends significant capital on advertising and marketing, hoping to build brand recognition based on the trademark. However, not all marks are created equal. Some types of words and phrases can be protected; i.e., a company can use the mark to the exclusion of its competitors; while others cannot.

In explaining what protection is available for different types of marks, courts have defined a continuum of marks, based upon their distinctiveness, and described as weak to strong, with the weakest marks entitled to no protection, while strong marks are presumptively entitled to protection. The weakest marks are those described by the courts as generic marks, which can never be protected. The continuum then progresses from descriptive marks, to suggestive marks, and finally to the strongest marks, fanciful or arbitrary marks.

Generic Marks

A generic mark is one which refers to the common name or nature of an article. Such names are not entitled to any trademark protection. Generic words are considered to be in the public domain and available for anyone to use. Examples of generic marks include: "Frosty Treats," "Diet Chocolate Fudge Soda," "Ivory,"

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when used to refer to products made from an elephant's tusk (but not when used to refer to soap); and "Lite Beer." Courts held these marks to be generic because they state or identify the very nature of the product being sold.

A registered mark, even though it qualified for protection when registered, may be canceled at any time on the grounds it has become generic. "Escalator" is a mark which was canceled as having become generic, because its owners allowed it to be used to describe moving staircases, generally.

Descriptive Marks

A "descriptive" trademark is one which immediately conveys or describes the nature or function of a product, its ingredients, qualities or characteristics, rather than constituting a name for the good or service to which it is attached. The phrase "Duluth News-Tribune" was held to be descriptive because it informs readers that the product is a Duluth newspaper, but is too specific to refer to the genus of newspapers (i.e., it does not describe all newspapers), or even all newspapers published in Duluth.

Other examples of descriptive marks include: "Park 'N Fly"; "Deep Bowl" when used to apply to a "Deep Bowl Spoon" (although the word "spoon" as used in this example is generic); and "Security Center." A descriptive mark is only entitled to protection if it has developed secondary meaning (i.e., if through advertising and marketing the consuming public has come to associate the mark with goods or services offered by a particular company). A descriptive mark may only be accepted for registration on the principal trademark registry by the USPTO when its proponent can prove it has acquired secondary meaning.

Suggestive Marks

It is not always easy to distinguish between suggestive and descriptive marks. A term is suggestive if it requires some imagination to reach a conclusion as to the nature of goods offered under the mark, as opposed to a descriptive mark, which forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods. However, courts have had a great deal of trouble in practice in applying the distinction between descriptive and suggestive marks. For instance, a 2007 decision by the U.S. Court of Appeals for the 7th Circuit held the mark "Work 'N Play," as applied to a conversion van, to be a merely descriptive mark. Since this mark does not describe any feature of the van, but merely the uses to which a potential purchaser might put it, this mark should have been found to be suggestive.

Examples of marks which have been held to be suggestive include: "safari," as used to describe luggage, portable grills, swimtrunks, raincoats, and belts (however, "safari" was held to be descriptive with regard to clothing of the type typically worn on an African hunting trip); "roach motel" (in that case the Court noted that "while roaches may live in some motels against the will of the owners, motels are surely not built for roaches"); "Coppertone"; "MovieBuff," to refer to a searchable database with entertainment industry information; and "Miraclesuit" as used to describe a woman's swimsuit which supposedly made its wearer look thinner.

Fanciful or Arbitrary Marks

Arbitrary or fanciful marks use terms that neither describe nor suggest anything about the product. Such marks bear no logical or suggestive relation to the actual characteristics of the goods or services they are used to market. A fanciful mark is one which was invented solely to be used to market a particular good or service;

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i.e., it is a made up term. An arbitrary mark is a known word used in an unexpected or uncommon way.

Examples of fanciful marks include: “Kodak”; “Exxon”; “Xerox”; and “Kleenex”. These were all terms coined by their owners solely to market products offered by them, and which have no independent meaning. Examples of arbitrary marks include: “Starbucks,” “Camel” cigarettes, “Domino” sugar, “Dove” soap, “Apple” computers, and “Dawn” dishwashing detergent.

Suggestive, fanciful, and arbitrary marks are entitled to protection from their first use in commerce, and can be registered on the USPTO’s principal trademark registry. Fanciful and arbitrary marks are, generally, considered to be the ‘strongest’ or most distinctive marks. For this reason, lawyers advising clients concerning adoption of a new mark will suggest that they adopt either an arbitrary or fanciful mark. Even though suggestive marks are entitled to the same protection, lawyers will often suggest that clients avoid such marks given the trouble Courts have in determining whether a mark is suggestive or merely descriptive.

Thus, when my father chose the word “Rembrandt” to pair with the words “Photo Studios” to describe his business, he made a good choice in that Rembrandt is an arbitrary mark (i.e., it is a surname of a famous painter). It neither described nor suggested what his business did (although the words Portrait Studio did). It is important to note that in registering a mark, you may pair arbitrary, fanciful or suggestive words with descriptive or generic words, provided that you disclaim any ownership of the descriptive or generic words.

Choosing a name or phrase which you will use to market a product or services is important. Your entire investment in advertising a mark can be lost if words are chosen which cannot be protected, or which infringe upon an existing mark. Further, trademark litigation is expensive. For these reasons, small businessmen should always consult with experienced trademark counsel before choosing and using a mark.

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