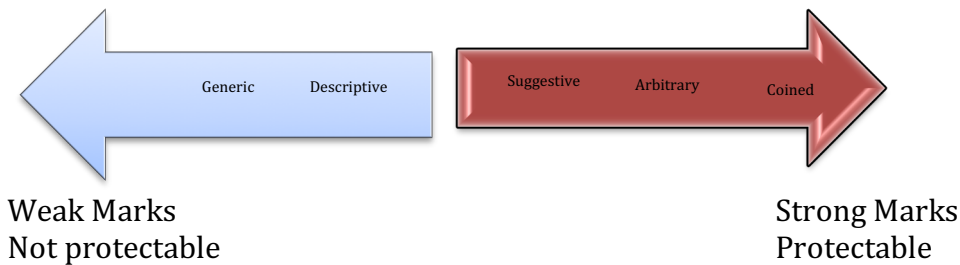


What's In a Name? How to Select a Strong and Protectable Trademark

Selecting a trademark such as the name of a product or service or even the name for a business can be an essential step on the path to success. As a marketing professional, you have undoubtedly been involved with the selection of trademarks. And of course, you will want to create or select something catchy! But there is one other factor that you should consider. A trademark should be protectable. Ideally, you should strive to create a trademark that is not only memorable but is also strong.

There is a natural tendency to select a trademark that describes the product or an element of the product (or service). But you may be surprised to learn that descriptive trademarks are not usually protectable and are also every difficult to enforce.

Trademarks are generally measured on a continuum from weak to strong.



We will explore some examples and discuss each category--from the weakest and least protectable (generic and descriptive) trademarks to the strongest (coined) trademarks.

Generic. Generic marks are the weakest category of trademarks. These are words that can never function as trademarks even after extensive use over a long period of time. For example, MILK for a milk-based product. Some marks can become generic either over time or through misuse. For example, escalator was once a trademark, but it is now considered “generic” or not protectable.

Descriptive. The second weakest trademarks are descriptive marks. It is tempting to select a trademark that describes a product or service or a feature of a product or service. And sometimes that does work well as a strategy. But it is usually best to steer away from adopting descriptive words as trademarks however tempting as it might be.

The reason is that descriptive words are not protectable trademarks unless they are used for an extended period of time. The United States Patent and Trademark



Office will reject descriptive trademarks in most instances, and it will be very difficult to enforce trademark rights against third parties.

An example of a descriptive mark is VISION CENTER for an optics store. But descriptive marks are not always obvious. For example, COLD AND CREAMY for ice cream is descriptive.

Suggestive. If you do want to capitalize on conveying some element of your product or service, you want to aim for is a suggestive mark. A suggestive mark does not describe the goods or services at issue but merely suggests or hints at what the goods and services might be. A suggestive mark requires some imagination as to what the services or goods might be.

Some examples of suggestive marks include, COPPERTONE for suntan oil, AIRBUS for airplanes, PLAYBOY for a gentlemen's magazine, CITIBANK for financial services. These can be very tricky because the line between descriptive marks, which are not protectable and suggestive marks, which ARE protectable can be hard to discern.

Arbitrary. Among the strongest trademarks are arbitrary marks are. Arbitrary marks are known words that have no connection to the goods sold or services offered. Arbitrary trademarks are strong and inherently distinctive. If you select an arbitrary mark, you will usually be on safe ground when it comes to distinctiveness.

Some examples of arbitrary brands are, ROCKSTARR for energy drinks, DOVE for body soap, and DELTA for airlines. In this case the words rockstar, dove, and delta, are common words that are well known in the English language. But when they are appended to goods and services that are unrelated to their original meaning, they make fantastic trademarks.

Fanciful or Coined. Finally, we come to the strongest trademarks of all-fanciful or coined marks. These are words that are entirely made up and did not exist before they were applied to a particular trademark owner's goods or services. Three well known coined marks are EXXON, KODAK, and XEROX. These types of trademarks are generally given the broadest protection of all.

It is very tempting to select a descriptive mark because you believe that adopting a mark (or even a company name) that immediately conveys what your company does or sells is the best route. But I would urge you to re-assess that strategy, while at the same time being true to your brand image. Adopting a trademark that is immediately protectable will assist you with enforcing your rights and may ultimately be better for your company in the long run.