

Selecting a Trademark

This newsletter discusses the guidelines used to classify trademarks. These guidelines should give a feel for the protectability of a proposed trademark and how it will fare in a court battle. Some trademarks are stronger and easier to protect from the outset than others. Some terms claimed as trademarks turn out to be not protectable at all. Some terms not protectable at first gain protection after some period of use and advertising. In assessing trademark strength, courts recognize four basic categories: generic, descriptive, suggestive and arbitrary and fanciful.

Generic Trademarks

A generic term is the common name for a type of product made by many companies, for example, automobile, cat food. A generic term cannot be a trademark. To bestow a monopoly on a generic term would be contrary to the public interest in promoting competition. Terms or symbols that are needed by competitors to describe their goods should be freely available for use: To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.

A term that is generic for one product can be "arbitrary" and hence a strong mark when applied to a different product. Spoon is generic for an eating utensil, but "Spoon" has no meaning (is arbitrary) as applied to cigarettes. Terms that are not initially generic can become generic. A trademark that comes to be understood by the public as the generic or common name for a type of product will no longer be protected. "Cellophane," "aspirin," and "Murphy bed" are prime examples of trademarks that became generic and freely available for use. A combination of generic terms is not necessarily generic.

Descriptive Trademarks

A descriptive trademark tells something about the product. It describes some characteristic, quality, purpose, component, or other property of the product. A frequently cited test for descriptiveness is this: A mark is descriptive if it conveys an immediate idea of the ingredients, qualities or characteristics of the goods.

Secondary Meaning

Since descriptive trademarks initially describe a product rather than identify its source, they are not protectable until the consumer learns to associate them with a single source. That learned association is called "secondary meaning." A descriptive mark is protected

only when secondary meaning is shown. The term "secondary" comes from the fact that the meaning of source association occurs second in time to the primary descriptive meaning. The primary meaning is the ordinary English language meaning conveyed by the term. For example, the primary meaning of "EXTRA STRENGTH PAIN RELIEVER" is a strong analgesic. The secondary meaning of "EXTRA STRENGTH PAIN RELIEVER," which developed second in time to the primary meaning, is the EXCEDRIN product made by Bristol-Myers. Secondary meaning is usually developed over some period of use, sales, and advertising. It is not necessary that purchasers know the name of the manufacturer to establish secondary meaning. The true inquiry is whether purchasers associate the mark with a single source.

Deceptive/Misdescriptive

A deceptive term is not registrable under section the Trademarks Act. The test for deceptiveness has been set forth as follows: (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe that the misdescription actually applies to the goods? (3) If so, is the misdescription likely to affect the decision to purchase? For example, "Super Silk" for shirts made from "silk-like fabric" deceptively misdescriptive, since term signifies excellent, first-rate, or superior grade of silk fabric.

Suggestive Trademarks

Suggestive marks are protected without secondary meaning. They identify source immediately upon use. Suggestive marks suggest something about the goods, but "require imagination, thought, and perception to reach a conclusion as to the nature of the goods."

Arbitrary and Fanciful Trademarks

Arbitrary marks are common words applied in an unfamiliar way. Examples of arbitrary marks are CAMELS for cigarettes, IVORY for soap, JEL-LIBEANS for a roller skating rink, and HORIZON for banking services. Fanciful marks are coined (made-up) terms with no dictionary meaning. EXXON, KODAK, and ROLEX are fanciful marks. These marks were coined to identify the trademark owner's goods. Arbitrary and fanciful marks, like suggestive marks, are protected without the need for proving secondary meaning. The trademark owner who selects an arbitrary or fanciful mark is at a distinct advantage. He is much less likely to encounter conflicts in the searching process and will find it a lot easier to protect his mark after adoption. Arbitrary and fanciful marks are typically seen as strong marks.