

## TRADEMARK CORNER

### Selecting a Protectable and Marketable Trademark

A trademark should serve the twin goals of being both protectable and marketable. This involves balancing the competing concerns of adopting an unique or sufficiently distinguishing mark with cost-effective and efficient marketing.

Under U.S. law, trademarks are categorized into five different types: fanciful, arbitrary, suggestive, descriptive, and generic.

**Fanciful** marks are generally completely made up or imagined and have no meaning before their use as a trademark. Examples include:



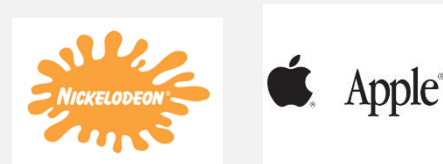
Fanciful marks are considered **inherently distinctive** and can immediately function as a trademark or service mark. Consequently, they are afforded the greatest amount of trademark protection under U.S. law. However, because there is no accepted meaning, they also present the greatest marketing challenge in establishing a brand.

**Arbitrary** marks are common English words that are used in such a way that their normal meaning bears no relationship to the goods/services to which they are applied. For example, AMAZON can be defined to be a river in South America, a race of mythological female warriors,

and even more generally as a tall, powerful, or aggressive woman. But none of these definitions has any direct relation to a retail e-commerce company.



Other examples are NICKELODEON for a children's cable TV network and APPLE for computer and other high-tech products.



Whether a mark qualifies as arbitrary depends upon its use in context. For example, while WINDOWS as applied to computers is arbitrary, it would be descriptive if applied to a hardware store.



Arbitrary marks are generally distinctive – and, thus, easy to register – because there is no apparent connection between the mark and the goods/services. However, they may also present a significant marketing challenge to overcome the accepted definition.

**Suggestive** marks allude in some way to a quality, characteristic, or trait of the good/service. But the consumer must exert some degree of imagination to determine the exact nature of the good/service. For example, GREYHOUND for bus services and JAGUAR for automobiles both suggest speed in transportation.



Other examples include 7-ELEVEN for a convenience store originally open from 7:00 a.m. to 11:00 p.m.; COPPERTONE for sunscreen products; and LEAPFROG for children's educational toys.



Suggestive marks are not as distinctive as fanciful or arbitrary marks, but are nonetheless still entitled to trademark protection and also present less of a marketing challenge.

**Descriptive** marks, as the name suggests, describe the goods/services. Examples include COMPUTERLAND for a computer store; CROWN VISION CENTER for an optical retailer; and HOLIDAY INN for a hotel chain. Descriptive marks are not initially entitled to registration because they generally describe all other competing goods/services and, thus, are not that distinctive. Upon a showing of “secondary meaning” – that

consumers identify that term with a single brand or company – the mark may be permitted registration. If secondary meaning cannot be established, the mark is not protectable, and others, including competitors, will be able to use the same or similar mark. Businesses may nonetheless choose a descriptive mark because of the relative marketing ease with which a brand can be developed.

Finally, a **generic** mark is when the trademark used to identify a good/service also identifies a class of similar goods/services. Examples include ORANGE to identify oranges or CHAIR to identify chairs. Generic marks are not afforded any protection. Moreover, marks that become so well known that they become used to generally describe that class of goods/services also lose their trademark rights. This phenomenon is called **genericide** and some examples include ASPIRIN, THERMOS, TRAMPOLINE, ESCALATOR, CELLOPHANE, ZIPPER, and BAND-AID.

<b>Fanciful</b>	Distinctive	Highly protected
<b>Arbitrary</b>	↓	↓
<b>Suggestive</b>	↓	↓
<b>Descriptive</b>	↓	↓
<b>Generic</b>	Not distinctive	No protection

In sum, while fanciful, arbitrary, and suggestive marks have the benefit of receiving trademark protection, these marks often require large marketing expenditures to convey the unique qualities of the company and its goods/services in order to establish strong brand messaging. In another *Trademark Corner*, we will explore the importance of performing a trademark clearance search so as to increase the likelihood that the proposed mark will be successful and avoid prematurely investing resources into a mark that might be precluded by a competitor.

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