

**Proper Trademark Selection to Create a Strong Brand**

**I. What a Trademark is and What it Does.**

A *trademark* is any word, name, symbol, or device, or combination thereof, used to identify and distinguish the goods (i.e., products) of one supplier from those of others. A *service mark* is the same as a trademark, but is used in connection with services rather than goods.

**Examples of Trademarks and Service Marks**

<b><u>Trademarks</u></b>		<b><u>Service Marks</u></b>	
<b><u>Mark</u></b>	<b><u>Goods</u></b>	<b><u>Mark</u></b>	<b><u>Services</u></b>
Xerox®	photocopiers	McDonald’s®	restaurant services
Kodak®	photographic products	FedEx®	delivery services
Chevrolet®	automobiles	Costco®	retail store services

Virtually all of the rules that apply to trademarks apply equally to service marks and further references to “trademark” or “mark” herein include both trademarks and service marks.

Contrary to what many believe there is no protection for a mark just because you were the first to think of it. Similarly, filing a state “doing business as” form, organizing a corporation using the mark as a company name, or registering the name with a city or county authority confers no trademark rights. Trademark protection arises only when a mark is *used in connection with goods or services*.

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Trademark protection is also not absolute. For example, a mark used for one type of service, such as landscaping, does not grant a monopoly on the mark for all uses, but only for confusingly-similar uses. For example, use of the same mark for lawn mowers might be considered confusingly similar to landscaping services, but use of the same mark for dental

supplies likely would not.

A mark can be used both as a trademark and a service mark. For example, “Costco” is known for providing retail store services and *also* for providing its own goods branded under the “Costco” mark. Additionally, goods or services can be, and frequently are, branded with multiple marks. An example is the Chevrolet Camaro, which includes the marks “Chevrolet,” “Camaro” and the Chevrolet cross logo on the car’s front grill.

## **II. Types of Marks.**

Words, logos, “tag lines,” sounds, scents, colors and devices, can potentially be protected as marks. Examples of word marks are “Nike,” “Microsoft,” “DuPont,” “Ford,” “Apple” and “Samsung.” Examples of logo marks are the “Windows” design for Microsoft® software, the double “R” logo used by Rolls Royce, the Nike “swoosh,” the NBA’s silhouette of a player (Jerry West) dribbling a basketball, the Chevrolet “cross,” and the various designs, such as wings, animals and pirates, used by professional sports teams. Examples of tagline marks are BMW’s “The Ultimate Driving Machine,” Nike’s “Just Do It,” and UPS’s “Synchronizing The World of Commerce.” Examples of sound marks are NBC’s three chimes, a duck exclaiming “AFLAC,” Homer Simpson saying “D’OH,” and the Pillsbury Doughboy’s giggle. Examples of scent marks are cherry scent for automotive lubricants, bubble gum scent for metal-cutting fluids, and lemon scent for laser printers. Examples of color marks are pink for Owens-Corning® fiberglass insulation and canary yellow for Post-It® notes. Examples of device marks are the Oscar® statue and the ribbed Coca-Cola® bottle.

## **III. Proper Trademark Selection is the Cornerstone of a Strong Brand.**

Creating a strong brand begins with selecting an *inherently strong* mark. An inherently strong mark provides the broadest scope of legal protection, and is usually less expensive to register and enforce. Selecting an inherently strong mark is conceptually simple – choose one that is unrelated to the attributes of your goods or services.

**An inherently strong mark is one that is unrelated to the attributes of your goods or services.**

What is an *attribute*? It is any use, function, purpose, characteristic, ingredient, or group of users of the goods or services with which the mark is used. In the United States, there is a doctrine

called the *spectrum of marks*. Determining the *inherent strength* of a mark depends on which of the five categories within the spectrum the mark falls. Marks falling into the first two categories, called *fanciful* and *arbitrary*, are the strongest:

### **Inherently Fanciful Marks**

A fanciful mark has no meaning. It is completely coined or invented and its only purpose is to function as a trademark. Examples are Clorox® for bleach, Exxon® for petroleum products and Kodak® for photographic products.

### **Inherently Arbitrary Marks**

An arbitrary mark has a meaning, but the meaning is unrelated to the goods or services with which it is used. Examples are Blue Bonnet® for margarine, Shell® for petroleum products and Sprite® for soda.

### **Inherently Suggestive Marks**

A suggestive mark *suggests*, but does not *immediately* bring to mind, an attribute of the goods or services with which the mark is used. Examples are Penguin® for freezers, Sampson® for weight-lifting equipment, Sparkle® for window cleaner and Season-All® for windows. These marks do not *immediately* bring to mind an attribute of the goods or services with which they are used, but with some reflection and imagination you can mentally make the connection.

### **Inherently Descriptive Marks**

A descriptive mark *immediately* brings to mind an attribute of the goods or services with which it is used. Examples are “1-800-DIAMOND” for a diamond ordering service, “Titanium” for ski bindings made of titanium steel and “Beef and Brew” for a restaurant that sells steak and beer.

An inherently descriptive mark cannot be protected *unless* you can show that the mark, although inherently descriptive, has attained *acquired distinctiveness* (which is also called *secondary meaning*) among relevant consumers. Acquired distinctiveness is usually shown by some period of (a) continuous, and (b) substantially exclusive use of the mark. A presumption of acquired distinctiveness is created in the United States Patent and Trademark Office if there has been a five-year period of continuous and substantially exclusive use. Even though acquired distinctiveness provides some protection for an inherently descriptive mark, the protection is limited, and an inherently descriptive mark is usually weak.

Despite the fact that inherently descriptive marks are usually weak, many people gravitate towards them. They have the misconception that a strong mark should tell consumers what their product or service is, what it does, what it provides, or what it includes – which is wrong on all counts. That may be a good strategy to generate short-term sales, but long term, to create a strong brand, stay away from descriptive marks.

## **Inherently Generic Marks**

A generic mark describes the *category* of the product or service with which it is used. An example of a generic mark is “software” for computer programs, or “fence” for a fence. A generic mark can never be protected as a trademark.

## **A Mark Must Always Be Evaluated Considering the Goods or Services With Which it Is Used**

Remember, the strength of a mark is always considered in connection with the goods or services with which it is used. For example, “Apple” for computers is an arbitrary mark, whereas “Apple” for apples is generic and unprotectable.

## **IV. Summary.**

A trademark is a tool to distinguish your products or services from those of your competitors. A key to creating a strong brand is choosing an inherently strong mark, which if properly used and enforced can be a strong, long-term brand.



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