

## The Origin of Marks

Trademarks have been used by humans for thousands of years. Egyptian wall paintings show cattle being branded, quarry marks and stonecutter signs have been found on Egyptian structures dating back to 4,000 BC, and sword makers in 15th century England were required to identify their products with marks so defective weapons could be traced back to the maker.

## The Spectrum of Distinctiveness

Over the years, trademark law has developed to recognize that some marks are stronger than others and some marks are simply not protectable. The more distinctive a mark, the more deserving of protection, likewise, the less distinctive, the harder it becomes to obtain "exclusive" use of that mark. Below is the Spectrum of Distinctiveness of Marks. "Generic" marks can never be protected, "Geographic, Personal Names, and Descriptive" marks can only be protected if they acquire secondary meaning, "Suggestive" marks can be protected but are weak, and "Arbitrary and Fanciful" marks can be protected and are the strongest marks possible.



### Generic Marks

A mark is generic when it names the thing or service provided. Public policy dictates that generic terms can never obtain trademark status, because allowing an applicant to register (and gain exclusive use) of a word that is used to describe the product or service would allow an applicant to remove a word from the language that was used to describe the product or service.

For example, you cannot register the mark "apple," if you are selling apples. Likewise, you cannot register "toothbrush" for a brand of toothbrushes.

The key to determining whether a mark is "generic" is: what does the public think the word connotes - the generic name of the product or a mark indicating merely one source of that product? If the answer is merely the generic name of the product, then the mark is not registrable.

## Geographic, Personal Names and Descriptive Marks

A geographic mark states where the product/service originates from, a personal name adopts the name of the proprietor into the mark (e.g. Michael W. Newcomb, Attorney at Law), and a descriptive mark describes the thing/services (whereas a generic mark names the services/product).

For similar reasons as discussed above, geographic, personal names and descriptive marks are also not registrable (but an exception does exist). Public policy states that businesses should not be able to exclude other businesses from using geographic names, personal names (if their own) and descriptive marks, because we don't want to prevent business from describing their services, using the proprietors name and or identifying their origin.

The exception is when a mark becomes so famous that it acquires secondary meaning. For example, "McDonalds" is a personal name, but has acquired a secondary meaning, which occurs when an "association in the minds of a substantial portion of the consuming public of the trademark with the product of the alleged proprietor" is created.

Whether a proprietor can establish secondary meaning, in order to obtain registration of the mark, is dependent upon a number of factors, including length of use and consumer acceptance/association of the mark.

### **Suggestive**

Suggestive marks are registrable, but generally considered weak marks because they typically include concepts or root/suffixes of words that are either generic or descriptive. A mark is suggestive when it no longer describes the product or service, but the consumer can somewhat guess as to the product/service associated with the mark. For example, "Coppertone" (sunscreen), "Moviebuff" (database of movie information), and "Spray N' Vac" (aerosol rug cleaner) have all been held to be suggestive and deserving of registration.

Suggestive marks tend, however, to be weak because they often include generic or descriptive terms in the mark. Thus, others could adopt similar marks or use similar terms on their products. For example, a sun tan maker could arguably use the phrase "XYZ product, gives you a rich copper tan."

### **Arbitrary and Fanciful**

The strongest marks are arbitrary and fanciful. These marks are deserving of significant protection.

Generally, arbitrary marks, which are marks that are used in a non-generic or descriptive sense, are not as strong as fanciful marks, which tend to be made-up words or symbols.

For example, the mark "Apple" as associated with the sale of personal computers is arbitrary. Personal computers have no relationship to the fruit, thus, the use of apple is arbitrary. However, because its a real word, other companies have also adopted the use of the mark "Apple," such as, AppleOne Employment, Apple Vacations, etc.

Fanciful marks are the strongest because consumers only associate the proprietor with selling that service or goods. "Exxon" is a good example of a fanciful mark in that Exxon is a made up word and is not associated with any other word or concept.

### **Choosing a Trademark or Service Mark**

A trade off occurs when selecting a mark. Expediency in helping consumers know what the product/service is, tends to cause proprietors to choose suggestive (or descriptive marks). The best marks, however, are those marks that are "made-up" and contain no connotation other than that which is built by the proprietor in the mark. Fanciful marks tend to allow the owner of the mark to exclude all others from using the mark, regardless of whether the third party users of the mark sell competitive goods.

My advice is choose an arbitrary or fanciful mark.