

THE TRADEMARK CONTINUUM

Trademark strength runs along a "spectrum of distinctiveness," a sliding scale of protectability, where the more distinct and unique the term, the easier it is for the owner to claim and be granted exclusive trademark rights for it.

MARKS THAT CAN BE REGISTERED

FANCIFUL MARKS have a marker or sign that was invented just to set the product or service apart – there is no association to anything in the dictionary. They don't describe the product, but indicate the source of the product. Examples: EXXON (oil) and KODAK (cameras).

ARBITRARY MARKS have a common meaning that has no relation to the product or service it is used with. Examples: APPLE (computers) and SUN (computers).

SUGGESTIVE MARKS have a marker or sign that has an element that reflects or suggests a quality or attribute of the product; as a result, some imagination, thought, or perception leads you to comprehend the nature of the goods. Examples: COPPERTONE (suntan oil) and CHICKEN OF THE SEA (tuna).

Inherently distinctive

MARKS WITH SECONDARY MEANING are marks that consumers recognize as a source for a product, have acquired a "secondary meaning" and can get registered even though they are generic or descriptive. This is an exception to the rule against registering generic or descriptive marks. It is intended to protect very famous or very valuable marks. Secondary meaning is earned through long term use or lots of publicity and ads. You have to be able to prove secondary meaning (e.g. through consumer surveys). Examples: SHARP (televisions), WINDOWS (windowing software), and INTERNATIONAL BUSINESS MACHINES (computers and other business machines).

MARKS THAT CANNOT BE REGISTERED

DESCRIPTIVE MARKS literally describe the product or something about the product. Many people think that they get more protection by picking a mark that perfectly describes their product, but the opposite is true. The use of an obvious and common place mark is not eligible for exclusive registration because it describes all other competing products too, unless the mark has obtained secondary meaning. Examples: PARK N FLY (airport parking lot) and COMPUTERLAND (computer store).

GENERIC MARKS either describe the category of goods or services (instead of their source) or become common ways to identify something. If a mark becomes generic, it can lose its protection. And, no generic mark can be registered. Examples: CELLOPHANE, ASPIRIN and ESCALATOR.

SURNAMES, on their own, are not eligible for registration, unless they obtain secondary meaning. Examples: JIM BEAM (whiskey), CALVIN KLEIN (jeans), and LOUIS VUITTON (luggage).

GEOGRAPHIC MARKS have some geographic location in them. A geographic mark cannot be registered, unless it obtains secondary meaning. Example: PHILADELPHIA (cream cheese).

MISDESCRIPTIVE MARKS that disparage or falsely suggest a relationship with a person, an institution, a belief, or a national symbol are not registrable.

CONFUSINGLY SIMILAR MARKS that are likely to cause confusion, mistake or deception with someone else's mark cannot get registered. Marks can cause confusion if they sound, look or "feel" the same as a preexisting mark. Note that because common law marks have limited geographic scope, it is possible that the existence of a common law mark may prevent the federal registration of a mark without prohibiting its use.

NOT YOUR MARK - a government's flag, a name, portrait or signature identifying a particular living person without their consent cannot be registered; a name, portrait, or signature of a U.S. President during the life of the President or the President's widow, without her/his consent, cannot be registered.

STRONG

WEAK