

How to Choose a Strong Mark to Discourage Infringement

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Put some thought into protecting your intellectual property

Your company has just come up with an exciting new product that enables someone to walk and chew gum at the same time! Just imagine all of the potential buyers out there who have been suffering for years from “Can’t Walk and Chew Gum Syndrome.” It’s the first product of its kind and the marketing folks want to call it...the “Walk ‘N Chew.” Why? Because it tells a potential customer what the product does. Perfect, right? Wrong! In terms of strength of infringement protection and enforceability, there are basically four types of marks. The stronger the mark, the more likely it will be enforceable against others and the easier it will be to stop them from using the same or similar mark on the same or similar goods. The weaker the mark, the less protectable and enforceable it is, and the more difficult it is to stop subsequent users, raising the likelihood that it will be used by others in one form or another. **Strongest – Most Enforceable Against Infringers**

- Fanciful Marks.* Fanciful marks are made-up words. They have no meaning other than as a trademark for the owner’s particular goods or services. Fanciful marks tell you nothing about the product, but they are memorable precisely because they don’t. This is what you want – if consumers remember your mark, they remember your product, no matter how many competitors you may have. Fanciful marks have the strongest protection, and in some cases are so well-known, or “famous” that they can be enforced against use of the same or a similar mark on unrelated goods and services:

- **GOOGLE** computer search engine
- **VERIZON** telecommunication services
- **ROLEX** watches
- **STARBUCKS** coffee

- Arbitrary Marks.* These are real words or images (logos) used for completely different and unrelated goods or services. As with fanciful marks, arbitrary marks tell you nothing about the product, but stand out as more memorable among the same type of goods or services of the competition. This is really the whole point of having a trademark. Arbitrary marks have strong

protection, but unless they are “famous” marks, they generally don’t have quite the scope of enforceability as do fanciful marks. On the one hand, the word mark APPLE might not be enforceable against someone using the term APPLE CAFÉ for a restaurant in NYC. But if that same restaurant substituted the Apple Logo for the word APPLE, the Logo would be enforceable against the restaurant.

- **APPLE** computers
- **GEICO** insurance services
- **BANANA REPUBLIC** clothes
- **HARD ROCK** restaurants
- **QUAKER** cereal

3. Suggestive Marks. Suggestive marks are the weakest of the marks. They “suggest” something about the goods or services; they give you a hint as to what it is or what it does, without going so far as to describe it. You have to think about it before you can figure out what the product or service is. Suggestive marks are usually existing words or combinations of words, or the equivalent graphic logos. Suggestive marks are generally enforceable only against the same or similar mark on the same or similar goods because they are only one step away from “descriptive” marks (explained below). In fact, the line between descriptive marks and suggestive marks is often very thin and subjective.

- **7-11** convenience stores (open from 7 to 11)
- **FRESH ‘N CLEAN** pet shampoo
- **CITIBANK** financial services
- **TOTAL** cereal

4. Descriptive Marks. A mark that describes a quality or function or feature or tells the customer what the product is or does is called a “descriptive” mark. And descriptive marks are generally not protectable precisely because they are descriptive. If the mark is deemed descriptive, anyone in the industry is free to use the mark in whole or in part, either in the name of their own similar product or as a descriptive term in text. While no one can stop you from using a descriptive mark, in turn, you can’t stop anyone else from using the same or similar mark. In fact, the term “descriptive trademark” is a misnomer. A non-descriptive trademark is a proprietary right; a “descriptive trademark” has no proprietary rights and is therefore not a trademark. It is the name you call your product, but it is not protectable and not enforceable. There is a way to get a descriptive mark registered, but we’ll

discuss that in a later article.

- **PARK 'N FLY** airport parking service
- **RAISIN BRAN** cereal
- **COMPUTERLAND** computer stores

5. *Generic Terms.* Generic terms aren't trademarks. They are the products themselves such as table, chair, chewing gum, automobile, computers. Generic terms can never be trademarks. They are the nouns which are modified by the trademarks.

- **APPLE computers**
- **GEICO insurance services**
- **STARBUCKS coffee**

Think of it this way – strong marks give you strong ownership rights, strong protection, and are easier to enforce in the comparative sense. Weak marks give you weak ownership rights, weak protection, and are difficult to enforce by comparison to stronger marks. Economically, strong marks cost less to protect and enforce than weak marks, and give a broader scope of protection. Strong marks are less likely to run into problems during the application/registration process and are more likely to be successfully enforced against a subsequent user of the same or similar mark, for the same or similar goods and services, or even related ones. Weak marks, on the other hand, can cost far more to protect and enforce, and provide only a narrow scope of protection. Weak marks almost always have problems during the application/registration process, making it harder to get them through to registration (resulting in greatly increased legal fees); they usually have to contend with marks already in use that, while perhaps not identical, have definite similarities; and weak marks are likely to be successfully enforced only against someone who later uses the same or substantially similar mark for the same or substantially similar goods and services. So back to **WALK 'N CHEW**. You've put extensive time, money and resources into research and development, designing the product, getting it ready for commercial production, developing marketing strategy and, in this case, being first to market. Still think **WALK 'N CHEW** is the best trademark? Yeah, didn't think so. Now if it were up to me, I'd call it ... a miracle! *Originally published on I-sight.com*

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