

Strength of Trademarks and Service Marks

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1. What exactly is a Trademark?

- a. A trademark is any:
 - Word, **letter**, phrase, **symbol** or **design** or combination thereof,
 - that identifies and distinguishes the source of the goods or services of one entity from those of another entity.
- b. A trademark is therefore something that designates the **exclusive** source of goods or services.

2. Examples of the types of marks

- a. Word marks:

Nestle Busch Oracle Nabisco McDonald's

- b. Words and design:



- c. Symbols



- d. Slogans:

- Don't Leave Home Without It
- Just Do It

- Be All That You Can Be
- Think Outside the Bun

4. **All marks are not created equal!**

- a. Marks that are considered strong marks receive the highest degree of protection from courts. Marks that are considered weak receive the lowest degree of protection, which means that a court will permit some usage of the mark by a competitor.
- b. Fanciful Marks: The strongest marks are *fanciful*. Fanciful marks are often made-up terms that do not exist before being adopted as a mark. An example of a fanciful word mark is XEROX. A fanciful mark receives the highest degree of protection from a court because, being a made up word, there is no reason to use the mark other than to refer specifically to the mark owner or its goods or services.
- c. Arbitrary Marks: The next strongest marks are *arbitrary* marks. Arbitrary marks are made from real words, however, the words having nothing to do with the goods or services being sold under the mark. An example of an arbitrary mark is APPLE for computers and electronic devices.
- d. Suggestive Marks: The next strongest marks are *suggestive* marks. Suggestive marks suggest the goods or services sold under the mark, but do not directly describe those goods or services. An example of a suggestive mark is BURGER KING for restaurant services.
- e. Descriptive Marks: A *descriptive* marks receive the lowest form of protection because the mark, though associated by some consumers, with the mark owner, effectively only describes the goods and services sold by the mark owner. An example of a descriptive mark is STEAK 'N SHAKE.
- f. Generic Marks: Generic marks are never protectable because they only identify a category of goods or services sold. An example of a generic mark is CAR WASH for car wash services and CHINESE RESTAURANT for a restaurant.

5. **Protectability**

Fanciful, arbitrary and suggestive marks are automatically protectable and registrable. The highest level of protection is for “fanciful” aka “coined” marks.

Surnames are considered descriptive marks. Descriptive marks and geographically descriptive marks may acquire distinctiveness over time. McDonald's is an example of such a descriptive mark.

Descriptive marks may be protected and registered only upon a showing of "secondary meaning."

6. Best Business Practices

To the extent your company can, always pick the strongest mark!

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