

Choosing a Trademark

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What is a Trademark?

- *A word, symbol or device* used in connection with goods for services to indicate the source of those goods or services. The owner of the mark has the right to exclude others from using subsequently adopted marks in such a way that they are likely to cause confusion, mistake or deception.

The Trademark Spectrum

- Arbitrary or Fanciful
- Suggestive
- Descriptive
- Generic

Strongest (good)



Weakest (bad)

Fanciful Marks

“Fanciful” marks consist of “coined” words that have been invented or selected for the sole purpose of functioning as a trademark. Such marks comprise words that are either totally unknown in the language or are completely out of common usage at the time, as with obsolete or scientific terms.

Examples: EXXON, XEROX

Arbitrary Marks

Arbitrary marks comprise those words, symbols, pictures, etc., that are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.

Examples: OMEGA for watches, TEA ROSE for flour

Suggestive Marks

A mark which merely suggests some quality or ingredient of goods is labeled as “suggestive,” distinguishing it from descriptive marks. Once determined to be suggestive and nondescriptive, a mark is entitled to the same protection accorded arbitrary and fanciful marks. That is, a suggestive mark is protected without any necessity for proving secondary meaning

Examples: FRIENDLY for shoes, FASHIONKNIT for clothes

Descriptive Marks

A "descriptive" term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.

A mark is "descriptive" if it is descriptive of:

- the intended purpose, function or use of the goods.
- the size of the goods.
- the provider of the goods or services.
- the class of users of the goods or services.
- a desirable characteristic of the goods or services.
- the nature of the goods or services.
- the end effect upon the user.

Examples: OATNUT for a bread that contains oats and nuts; E-FASHION for a fashion related website

Generic Terms

A generic name of a product can never function as a trademark to indicate origin. The terms “generic” and “trademark” are mutually exclusive.

Examples: APPLE is a generic name for the edible fruit of the apple tree; SANDALS is a generic name for warm-weather footwear

Generic-Descriptive-Suggestive Example

DEEP BOWL SPOON: “Deep Bowl” is descriptive of a type of spoon deep in the bowl portion. It is not “generic” but descriptive, since the implement is not a “Deep Bowl,” but a “spoon.” “Spoon” is the generic name of the eating tool. But for another article—a deep bowl—its name is “deep bowl” and would be generic. And, to add to this example, “Deep Bowl” as a trademark for canned soup would probably be only suggestive of quantity.

Now What?

- Make a list of candidate terms
- Give list to trademark attorney to search
- Initial elimination search
- Follow-up comprehensive search
- File trademark application for best candidate

- **TM** Unregistered trademark for goods
- **SM** Unregistered service mark for service
- **®** Registered service mark or trademark

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