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## Considerations in Choosing a Brand Name

Choosing a brand name (a.k.a. “trademark”) that is both marketable and legally protectable requires balancing the competing concerns of marketing ease with protectability under the law.

A company wants a name that is memorable, that conveys what it has to offer, and that cannot be copied or imitated. These goals are not always complementary and can require the company to make different levels of investments in marketing and policing the desired brand name.

Not all brand names can be legally protected and some require significantly more effort to protect than do others. United States trademark law recognizes a sliding scale of protectability. The more distinctive and unique the term (or unrelated to the goods or services with which it is going to be used), the easier it is for the owner to secure exclusive rights to use that term in connection with its business.

The following descriptions provide additional detail regarding the categories of trademarks. Significantly, many other countries do not rely on these categories in evaluating brand names, and require local registration efforts before affording a brand name any level of protection.

### Fanciful Marks

A fanciful trademark is created for the sole purpose of functioning as a trademark. Examples of fanciful trademarks include invented terms like XEROX, KODAK and GOOGLE, and incongruous word combinations. Fanciful trademarks are considered the strongest, since it is unlikely that a competitor could claim that it accidentally adopted the same trademark. Fanciful marks are usually the most challenging to create because they require a measure of imagination that many would rather avoid; on the other hand, with a successful marketing campaign, a fanciful trademark can enjoy widespread fame and protection from infringement.

### Arbitrary Marks

Slightly less strong than fanciful marks are arbitrary marks, which are terms that may have significance in certain contexts but no immediate significance with respect to the company’s products or services. Examples of arbitrary marks include YAHOO, APPLE, and GAP. An arbitrary mark will be a strong trademark unless a number of other parties have adopted the same or similar mark in other fields.

### Suggestive Marks

Suggestive marks, which are weaker than fanciful or arbitrary marks, but still generally protectable, hint at some quality or character of the products without actually describing the product. Examples of suggestive marks include COPPERTONE, GREYHOUND and 7-11. Suggestive marks border on the dangerous trademark territory called descriptive marks.

## Descriptive Marks

In contrast to distinctive trademarks, descriptive trademarks are those which describe some aspect, characteristic or quality of the products or services with which they are used, like color, odor, function, dimensions, properties, or ingredients are classified as descriptive trademarks.

Further, as a rule, surnames and terms that reflect the geographic origin of goods or services are typically considered descriptive. If a trademark is descriptive, the owner may not be able to prevent others, even competitors, from using the same or similar terms, at least without a significant investment and effort.

Notwithstanding the legal risk, many companies use descriptive trademarks because they can quickly convey to consumers information about the company and its products.

While descriptive trademarks have an initial marketing ease, using them has many disadvantages, including the increased costs of trying to register descriptive trademarks, which are routinely rejected by trademark offices worldwide. Moreover, a descriptive mark is not protectable unless it develops acquired distinctiveness, which often is referred to as secondary meaning.

When a mark becomes recognized by consumers as indicating a single source of the relevant goods or services, it is considered to have obtained secondary meaning. From the legal perspective, secondary meaning requires that consumers must use the word “in a new and secondary sense of indicating only one source and quality of goods or services.” More practically, a trademark with secondary meaning is one that consumers recognize as serving as a trademark, meaning that it is associated with a single source.

Mere misspellings of descriptive trademarks will not make them distinctive. In addition, translations of a descriptive word into another language will not rescue a word from being considered descriptive. Geographic terms and personal names are two popular types of terms that are deemed descriptive:

**Geographic Marks.** Geographically descriptive designations are geographical locations that

consumers would think described the geographic origin of the goods or services.

In the United States, geographically descriptive designations cannot be protected without a showing that they have acquired secondary meaning. For example, the name CALIFORNIA SOLAR would not be protectable unless its owners were able to show that consumers associated the words CALIFORNIA SOLAR only with their particular company.

A deceptively misdescriptive geographic term cannot be protected as a trademark either. Therefore, a Sacramento-based solar power company called SANTA MONICA SOLAR would probably be denied protection for the name because it misdescribes the origin of the company’s products.

**Personal Names.** Personal names are also considered descriptive. As a result, using one’s personal name, either first name, last name or combination, does not automatically give rise to trademark protection. Once a name takes on trademark or service mark significance, junior users may be enjoined from using the same name in respect to similar products, even if it is their own name. Therefore, a budding performer who has the misfortune of being named Michael Jackson should probably adopt a variation or a pseudonym if he wishes to perform or produce music.

**Generic Names.** The name of a product or service itself can never function as a trademark. Generic terms result when a name used to identify a single product is also used to identify a whole class of similar products. Examples include the term “Milk” to identify milk or “Banana” to identify a banana.

Trademarks that become so well known that they become used by society to describe that term become generic and lose their trademark rights in a process called “genericide.” Prime examples of former trademarks that became the generic name for a whole class of products include ASPIRIN, THERMOS, TRAMPOLINE, ESCALATOR, and CELLOPHANE.

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