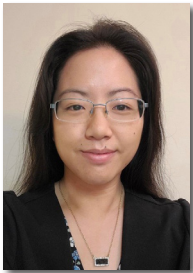


## IP FRONTIERS: Tips for choosing and applying for a strong trademark

By Christina E. Brule



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TRADEMARKS are an essential asset to any business. A trademark identifies the source of the goods or services; it lets

people know that you are providing the goods or services and it can set expectation levels based on your brand's reputation. A strong trademark can immediately distinguish you from competitors and help to build brand recognition, which can protect your efforts to market goods and services.

Choosing the right mark requires careful consideration; a poor choice may fail to register or lead to legal disputes down the road. Here are some tips for choosing and applying for a strong trademark.

### Choose a Strong Mark

A trademark must be distinctive to be protectable but not all trademarks are equally distinctive. The spectrum of distinctiveness ranges from generic marks, which can never be pro-

tected as a trademark, at one end and arbitrary and fanciful marks at the other end.

The strongest marks are arbitrary or fanciful, both of which are inherently distinct. An arbitrary mark has no real connection to the good or service being offered, e.g., Apple for personal computers or Puma for footwear. A fanciful mark is a made-up word and is inherently distinct, e.g., Kodak and Pepsi.

A suggestive mark suggests a quality or characteristic of the good or service and also is a strong mark because it is considered inherently distinct. However, as described below, it is often difficult to distinguish between suggestive marks and merely descriptive marks.

A merely descriptive mark is not strong because it is not inherently distinct, as it describes the good or service, rather than the source of the good or service. Merely descriptive marks may be registered on the Supplemental Register, which is for marks that are not distinctive enough to be registered on the Princi-

pal Register. However, it may be registered on the Principal Register if it has acquired distinctiveness, also known as secondary meaning. In other words, if a merely descriptive mark is recognized by consumers as identifying the source of the good or service, then it can be protected as a trademark.

A generic mark is understood as the common name for a good or service, e.g., cereal is the generic term for breakfast food made from processed cereal grains. Further, if a trademark is not used properly, i.e., to indicate the source of the good or service, it can become generic. For example, escalator was the trademark for a moving stairway but it was used as a generic descriptive term and became genericized; now it is widely used to refer to moving stairways and anyone can use it.

### Avoid Certain Types of Marks

Certain marks are destined to flop; before investing time and money in a mark that is not protectable under U.S. Trademark Law, be sure to avoid marks that have geographic significance,

are misdescriptive or deceptive, or are confusingly similar to existing marks, because they are not protectable under U.S. Trademark Law, even if the applicant is able to show that some consumers recognize the mark as an indicator of the source of the good or service.

Further, some marks may take longer to register on the Principal Register and require an additional showing of secondary meaning. For example, a mark that is “primarily merely a Surname” is not inherently distinct because it is recognized by consumers as a surname rather than the source of the good or service. Nevertheless, a mark that is primarily merely a Surname may be registered on the Supplemental Register, and if it has acquired secondary meaning it may be registered on the Principal Register.

### **Consider Your Budget**

Although arbitrary and fanciful marks are the strongest and most inherently distinctive marks on the spectrum, they may require significantly more investment, of both time and money, in marketing to develop consumer recognition. It is important to consider your budget and how quickly you wish to develop brand recognition when choosing a mark.

### **Perform a Thorough Search**

Choose a few different marks that you would like to use in

connection with your goods and/or services, and then perform a thorough search on your top choice to ensure that the mark is not confusingly similar to an existing mark. Blindly rushing to register a mark, without having first performed a search, may cause you to waste time and money on a mark that is not protectable.

### **Consider How You Will**

#### **Use the Mark**

In addition, consider how you will use your mark. For example: Will you use a mark that is comprised of words only or do you intend to use the words with a design? Will you use the words in a special, stylized font, or do you want to be able to use them in any style? Will you use specific colors or do you want to be able to use any color?

However you choose to use your mark, be sure to use it consistently because the mark that you register is the only mark that is protected. For example, if you specifically register your mark in a stylized font, as/with a design, or claim a specific color, then only that style, design, or color will be protected.

It is especially important to register the exact mark that you plan to use because a specimen of the mark as actually used in connection with the good or service is required for registration. Failure to submit a specimen that matches the applied-for mark can result in an abandoned ap-

plication. Moreover, substantially changing the mark that is being used, as compared to the mark that is registered, means the mark you are using is not protected and the mark that is registered may be forfeited for failure to use in commerce.

### **Enforce Your Rights**

Registering your mark is not the end of the process. To keep your rights, you must be diligent and monitor for infringing uses of your mark. Not everyone performs a thorough search of a mark before they begin using it in connection with their goods and services, thus, you should actively monitor use of your mark to prevent others from copying or using confusingly similar marks.

Failure to monitor and enforce your trademark rights can result in a complete loss of trademark rights.

### **Conclusion**

There are many different things to consider when choosing and applying for a trademark and being unprepared can lead to a waste of time and money. An experienced trademark attorney can provide necessary guidance and support to help you build your brand.

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