

A Brand Apart

How to select, protect, and inspect your trademark.

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There are four types of trademarks: fanciful/arbitrary, suggestive, descriptive, and generic. From the point of view of the U.S. Patent and Trademark Office, or PTO, the first two types are green lights (easy to approve and you are given strong rights), the third is a yellow light (difficult to approve and you are given weaker rights), and the fourth is a red light (will never be approved and you are given no rights). As a non-specialist, what do you need to know about trademarks? Select, protect, and inspect.

Selecting a Mark

From your point of view, the above means that you should select a mark from the first two types in order to save money. Only select a mark from the third type if you “fall in love” with it. In other words, if the expense of a difficult approval process is worth the marketing value the mark will provide. Avoid selecting a mark from the fourth type because you will waste your money.

A fanciful mark is a word, phrase, or design that has no other meaning—it is “made up.” Examples are Exxon, Clorox, and Polaroid. These words are not part of any language. An arbitrary mark is a common word, phrase, or design that does not describe or suggest the good or service sold under the mark—it is a “real” word, phrase, or design that has no relation to the good or service. Examples are Shell (gasoline), Ice Cream (chewing gum), and GUESS? (fashion brand). The word “shell” can be found in an English dictionary, but the definitions listed do not describe or suggest gasoline, making it an arbitrary mark for that good.

A suggestive mark is a word, phrase, or design that suggests, but does not

describe, characteristics or functions of the good or service sold under the mark. If the characteristics or functions of the good or service are not explicit from the mark, but with an exercise of imagination could be conveyed by the mark, the mark is suggestive. Examples are Stronghold (nails), Coppertone (tanning goods), and Rapid Shave (shaving cream).

A descriptive mark is a word, phrase, or design that immediately identifies the characteristics, functions, ingredients, or purpose of the good or service sold under the mark. Examples are ChapStick (chapped lip treatment), International Business Machines (computers), and Sharp (televisions). Descriptive marks straddle the border of what is protectable.

Generic marks are the common name of a class of things such as books, water, and phones. They are not protectable for the good or service named—the word “phone” cannot be protected by itself in order to sell phones.

Protecting Your Mark

After you have selected your mark, registering your mark with the PTO puts others on notice of your rights to the mark and affords additional protections. The registration application may be filed before or after you begin using the mark.

The registration application includes the mark itself and a listing of the goods or services offered under the mark. If the mark is in use, it is necessary to provide a specimen showing how the mark is used. If the mark is not in use, a specimen can be provided at a later date.

After a registration application is filed, an examiner at the PTO examines the application. Upon approval, the

mark is published by the PTO. After publication, others will have a limited time to oppose the application; if no opposition occurs, the registration is issued by the PTO.

A trademark registration can remain valid as long as the mark is being used and the registration is periodically renewed at the PTO.

Inspecting Competitors’ Marks as Well as Your Own Mark

It is vital to inspect your competitors’ websites, advertising, and other branding for marks confusingly similar to your mark. Additionally, such inspection allows you to discern their strategy regarding their own marks. Consider setting up a monitoring schedule, such as a quarterly review, to keep tabs on trends in the industry.

It is also vital to inspect your website, advertising, and other branding for quality assurance and to avoid loss of rights. This inspection may be part of the quarterly review described above. A checklist of items for such an inspection may include:

- Are we using trademark registration symbols appropriately—the “®” symbol?
- Are our marks featured prominently and appropriately—not as nouns or verbs?
- Are there words, phrases, or designs important to our marketing that we have not registered?
- Have we expanded our goods or services into new markets (requiring updating our listing with the PTO)?

Remember to select, protect, and inspect. **TBJ**



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