

A Generic Mark Generic "marks" are devices which actually name a product and are incapable of functioning as a trademark Unlike descriptive marks, generic devices will not become a trademark even if they are advertised so heavily that secondary meaning can be proven in the mind of consumers

The rationale for creating the category of generic marks is that no manufacturer or service provider should be given exclusive right to use words that generically identify a product A valid trademark can become generic if the consuming public misuses the mark sufficiently for the mark to become the generic name for the product The prime examples of former trademarks that became the generic name for a product are ASPIRIN, XEROX and CELLOPHANE

A Descriptive mark (or more properly, "merely descriptive marks") are devices which merely describe the services or goods on which the mark is used If a device is merely descriptive, it is not a mark at all, since it does not serve to identify the source of the goods or services

No trademark rights are granted to merely descriptive marks Misdescriptive marks are equally weak As explained in connection with suggestive marks above, descriptive marks are often difficult to distinguish from suggestive marks Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods

Descriptive marks allow one to reach that conclusion without such imagination, thought or perception Putting this distinction into practice can be very difficult Merely descriptive marks can be registered federally on the Supplemental Register (see the Bit Law discussion on federal registration of trademarks for more information) The descriptive mark will not register in PTO until the consumer links the mark with a single source

That learned association is called **Secondary meaning** or acquired distinctiveness The PTO assumes that secondary meaning has been acquired after five years of consecutive and exclusive use of a mark Secondary meaning can be demonstrated by a significant level of advertising, sales and consumer survey evidence, to prove that when consumer encounter a mark

For Example: The following imaginary marks could be considered merely descriptive for computer peripherals:

- FAST BAUD for modems (describing the quickness of the modem);
- 104 KEY for computer keyboards (describing the number of keys on a keyboard);
- LIGHT for portable computers (describing the computer's weight);
and
- TUBELESS for computer monitors (even if misdescriptive for a monitor that contains tubes)

A Suggestive mark are marks that suggest a quality or characteristic of the goods and services

Despite the fact that suggestive marks are not as strong as fanciful or arbitrary marks, suggestive marks are far more common due to the inherent marketing advantage of tying a mark to the product in a customer's mind. Suggestive marks are often difficult to distinguish from descriptive marks (described below), since both are intended to refer to the goods and services in question.

Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice clearly is one of the most difficult and disputed areas of trademark law.

The following marks can be considered suggestive:

MICROSOFT (suggestive of software for microcomputers)

NETSCAPE (suggestive of software which allows traversing the "landscape" of the

Internet)

SILICON GRAPHICS (suggestive of graphic oriented computers)

Arbitrary Marks An arbitrary mark utilizes a device having a common meaning that has no relation to the goods or services being sold

Examples of arbitrary marks include:

APPLE (for computers)

LOTUS (for software)

SUN (for computers)

CROWN (For Television)

Fanciful Marks are devices which have been invented for the sole purpose of functioning as a trademark and have no other meaning than acting as a mark Fanciful marks are considered to be the strongest type of mark Examples of fanciful marks are:

EXXON, KODAK and XEROX

PROTECTABLE MATTER

Slogans, Letters and Numbers

A word or other groupings of letters is the most common type of mark **For Examples:** APPLE, SILICON, GRAPHICS, NETSCAPE, IBM, NBC Slogans from advertising campaigns are also used as trademarks Example slogans which have strong trademark rights attached

For Example: Alphanumeric symbols (letters and numbers) may be protectable as long as they are not merely descriptive If the numbers or letters describe something about the product or service offered under the mark, however, they will not be registrable unless proof of secondary meaning is shown Thus, the mark "VT220" for computer hardware peripherals was held merely descriptive and unregistrable because "VT" Video Terminal and 220 was a mere model number

Logos and Symbols

Logos are probably the next most common form of mark A logo can be described as a design which becomes a mark when used in close association with the goods or services being marketed The logo mark does not need to be elaborate; it need only distinguish goods and services sold under the mark from other goods and services Examples of logo marks are:

McDonald's double arches:

NBC's peacock style design:

Apple Computer's Apple:

Names of performing Artists

A mark that merely serves to identify an artist or entertainer is not registrable However, if the owner of the mark has controlled the quality of the goods or services, and the name of the artist or group has been used numerous times on different records (thereby representing an assurance of quality to the public), the name may be registered as a trademark, Thus, GOO GOO DOLLS and BOB DYLAN have been registered for musical sound recordings

Domain Names

Domain names, for example, *www.ibm.com*, are registrable as trademark or service marks only if they function as an identification of the source of goods and service. Thus, *www.oakwood.com* has been registered for real estate leasing service and *www.weilberg.com* was refused registration because the mark merely indicated the location on the Internet where the applicant's web site appeared and it did not separately identify the applicant's legal services.

Another complication with domain name registration is that the PTO has held that businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. Thus, *www.amazon.com* is registered for providing online chat rooms and bulletin boards. It is not registered in connection with offering books or other goods for sale.

Shapes and Containers

A product or container shape can also serve a source identifying function and therefore can be an enforceable trademark. A product or container shape may also be subject to a design patent (see the BitLaw discussion of design patents to see an analysis of the similarities and differences between design patents and trademark protection for product shapes).

Historically, trademark protection was not granted to product shapes until the consuming public recognized the shape as indicating the source of the product. In other words, the product shape was required to obtain secondary meaning.

However, recent court decisions may mean that an inherently distinctive product shape can be a protectable trademark even before secondary meaning is obtained. Examples of product shapes and configurations that likely enjoy trademark status include:

Coca-cola Bottle

Apple's Ipod

Trade Dress

Trade dress is the overall commercial image (look and feel) of a product or service that indicates or identifies the source of the product or service and distinguishes it from those of others. It may include the design or configuration of a product; the labeling and packaging of goods; and/or the décor or environment in which services are provided.

Trade dress can consist of such elements as size, shape, color and texture to the extent such elements are not functional. In many countries, trade dress is referred to as "get-up" or "product design." Only nonfunctional trade dress can be protected. Because trade dress is often protected through the law of unfair competition.

Color

The color of an item can also function as a trademark. The Supreme Court held in the 1995 case of *Qualitex Co v Jacobson Products Co*, 115 SCt 1300 (1995) that the green-gold color of a dry cleaning press pad can function as a trademark. Before this decision, the argument was often made that color alone could not be considered a trademark, since granting trademark status to colors would soon lead to the depletion of the number of colors available for an object.

The Court in *Qualitex* rejected arguments based on this depletion theory, reasoning that alternative colors would usually be available for competitors. In those cases where alternative colors were not available, courts could deny trademark protection in those circumstances where color depletion may actually occur.

Fragrances, Sounds, and Moving Images

A sound can also be a trademark or a service mark. The three tone chime of NBC has been registered as a service mark. Sound trademarks recently were in the news when Harley-Davidson announced that it was attempting to register the exhaust sound of a Harley-Davidson motorcycle with the US Patent and Trademark Office (USPTO).

Harley-Davidson was reacting to moves by competitors to duplicate the Harley sound in competing motorcycles Hearings in front of the USPTO have been scheduled to determine whether Harley-Davidson can register the sound A fragrance can function as trademark if it is distinctive and not functional

For example: in *In re Clarke*, 17 USPQ2d 1238 (TTAB1990), a floral fragrance was allowed as a trademark for sewing thread and embroidery yarn and was not functional when used in connection with those goods The roar of the MGM lion and Woody Woodpecker's distinctive laugh are also registered Finally, the Internet has given rise to applications for marks that consist of moving images, such as Microsoft company's spinning EXPLORER GLOBE

Design and Ornamentation

A design can function as a trademark as long as it is distinctive rather than merely functional or ornamental Some designs are protected on their own, such as Nike's famous "swoosh" design, the alligator that appears on shirts, and Betty Crocker's spoon If the design is merely background material, however, and does not create a separate commercial impression, or if it consists solely of some simple geometric shape, such as an oval or square, it cannot be protected without proof of secondary meaning

For example, the PTO refused registration of two parallel colored bands placed at the top of socks as pure ornamentation Merely decorative subject matter and pure ornamentation cannot be registered because they do not identify and distinguish goods or services and thus cannot function as trademark

Serialized Literary and Movie Titles

The title of a single book or movie title is generally not protectable The title of a serialized work, such as THE BRADY BUNCH or NEWSWEEK, however, can be protected as a trademark or service mark

Insignia

Flags, coats of arms, and other insignia of the United States or any state or any foreign nation cannot be registered

Picture and Drawings

Pictures or drawings of a character or scene are often used as trademarks or service marks

SELECTING AND EVALUATING A TRADEMARK

Selecting a Mark

The selection of mark occurs in a variety of ways

companies hold contests and encourages employees to create a mark for a new product line or service

Companies engage sophisticated research

Branding firms that will conduct surveys and create a mark and a logo or design for the company

There are name creation software programs that help individuals and companies create marks

Once the mark is selected, it must be screened and evaluated for use and registrability, if failed then it leads to wastage in expenditure of time and money in advertising, using, and applying for a mark that is rejected for registration by the PTO or, in the worst case scenario, might subject the owner to damages for trademark infringement and unfair competition

Reviewing a Proposed Mark

Once a mark is selected, it should be carefully scrutinized to ensure that it will not be excluded from protection under the Lanham Act

Firstly they have check whether the mark contains scandalous (giving offence to moral sensibilities and injurious to reputation)

Whether consent from a living person will be required,

Whether the mark is generic,

Whether it is statutorily protected

Whether the mark is descriptive of some feature of the goods and services offered under the mark,

It also see that the mark includes foreign terms

Many law firms specializing in trademark work use a questionnaire form or data sheet to gather questionnaire form or data sheet to gather basic information from clients about their marks

THE TRADEMARK SEARCH

Scope of search

There are a variety of sources that can be reviewed to locate potentially conflicting marks

There are literally millions of marks registered or applied for at the PTO, and thousands of journals, trade magazines, directories, telephone books, Internet sources, state records, and state trademark registrations that might contain other marks or business names, a computer assisted or online search is the most effective method of searching

Both LEXIS and WESTLAW, the computer-assisted legal research system, offer access to vast databases that may point out conflicts

One of the best known databases is TRADEMARKSCAN product OF Thomson & Thomson

Conducting the trademark search

The trademark searching is a two-step process:

a preliminary search is conducted of the records of the PTO to make a quick determination as to whether the mark may be available or whether there is conflict that would preclude use of the mark It is also called a **knockout search**

If the results of the preliminary or knockout search indicate a mark may be available, a comprehensive search of other sources (including state trademark records, telephone directories, Internet records, and trade journals) is then conducted

Step One: The Preliminary Search

There are a variety of sources that can be used to conduct an initial trademark search, including online subscription services, CD-ROM, the Patent and Trademark Depository Libraries, and the PTO website search services Following are some resources commonly used for conducting a preliminary search:

Electronic Database and CD-ROM

TRADEMARKSCAN is a database owned by Thomson & Thomson, a renowned trademark search firm, which provides information on all active registered trademarks and service marks The TRADEAMRKSCAN database is primarily used as a quick screening tool to determine the availability of a new mark

DIALOG is another database offered by Thomson & Thomson Its database includes trademarks from the United States plus numerous foreign countries as well as patent and copyright information

It provides online training and practice and free practice searching at the following web site:
<http://trainingdialogcom/onlinecourses/trademarks/>