

## Trademark 101 Part 2:

### 2. How to Choose a Good, Strong Trademark

The following is meant as an introduction to the issues you should consider before choosing a trademark. Trademark analyses are very fact-specific, so we strongly encourage you to consult with us or another law firm before taking on the risk and expense of using a trademark or filing a trademark application.

#### What is a strong trademark?

Trademarks vary in “strength,” depending on how distinctive they are, that is, the ability to which they are able to distinguish your product from products offered by someone else. The stronger the trademark, the stronger your rights.

Trademark law recognizes the following categories of distinctiveness, listed from strongest to weakest:

- **Fanciful** marks are coined words, invented to serve as a trademark, such as:
  - XEROX
  - EXXON
- **Arbitrary** marks are real words but arbitrary in relation to the goods/services with which they are used, such as:
  - APPLE for computers
  - DELTA for an airline
- **Suggestive** marks suggest a quality or aspect of the good/service on which they are used, such as:
  - COPPERTONE for sunscreen
  - GREYHOUND for bus service
- **Descriptive** marks describe the good/service. A descriptive mark cannot be fully protected until the mark acquires distinctiveness through extensive use, usually a minimum of five years:
  - CREAMY for yogurt
  - GENERAL MOTORS for cars (after decades of use, consumers now associate the mark with goods/services provided by one company; it has thus acquired “distinctiveness” and serves as a trademark)
- **Generic** “marks” are every-day names for the good/service with which they are used and can never be protected as a trademark:
  - APPLE for apples
  - GREYHOUND RACE for greyhound dog racing
  - ASPIRIN and ESCALATOR (both began as distinctive marks but became “genericized” through common usage to refer to the good itself rather than the brand of good)

For more information about trademark strength, see [Trademark Strength](#) (INTA).

## What should I avoid in choosing a strong trademark?

### Do not choose a mark that describes your product!

We just said it, but because so many businesses want to do this, we're going to repeat: A name describing your goods/services may seem like a good idea from a marketing perspective, but it is not a strong brand (unless and until you use it extensively for several years such that consumers associate it with your company and product rather than the type of product), and you may not even be able to protect it as a trademark at all. Additional examples:

- 104 KEY for a keyboard
- LIGHT for portable computers
- WINDOWS for windowing software (after many years of widespread use, this mark acquired "distinctiveness" and was able to serve as a trademark)

## What is trademark infringement?

Trademark infringement occurs when, regardless of their intentions, someone uses a mark in a way that is likely to cause consumers to mistakenly believe that their good/service comes from or is somehow associated with those of an owner of another mark. Determining whether a "likelihood of confusion" exists is based on both the similarity of the marks and the similarity of the goods. The more similar the two marks, the less similar the goods/services need to be in order to find a likelihood of confusion and thus infringement, and vice versa.

The following factors are used in determining similarity of marks. The examples given are considered to be very similar; thus, if used in conjunction with related goods/services, the junior user's mark infringes the senior user's mark.

### Sound

T. MARKEY and TEA MARQEE  
MADE RIGHT and MADE RITE

### Appearance



**Meaning and/or connotation (including translations)**

LUPO and WOLF

APPLE and GOLDEN DELICIOUS

**Overall commercial impression**

DUTCH MASTERS and LITTLE DUTCHMAN

MONEY and \$\$\$

## How do I determine whether my mark might infringe someone else's rights?

Many people search google for the trademark they wish to use and when they don't find an exact match, assume they can legally use the mark. Unfortunately, assessing the risk that your trademark might infringe someone else's is not that simple. For one thing, a trademark that is similar to **but not the same as** another could infringe that other trademark.

Our law firm conducts "availability" (or "clearance") searches to determine whether any trademarks currently in use are likely to conflict with your trademark (although they cannot guarantee availability).

We strongly recommend ordering a search **before you begin using a trademark**, or, if you're already using it, before you file an application to register. This can avoid wasting a lot of money, time, and energy on developing and building a reputation around a mark that you'll ultimately have to change.

## Additional Information

For additional information about selecting a trademark, see the following the U.S. Patent & Trademark Office's [Trademark Basics](#). This resource provides a great introduction to trademarks, including how to select a mark and information about the registration process and includes a series of instructional videos titled *Basic Facts About Trademarks: What Every Small Business Should Know Now, Not Later*.