

## **TRADEMARKS**

### **When is a Designation a Trademark?**

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Trademarks can take many forms, including words, designs, slogans, scents, names, sounds, colors, etc. However, not every such designation is entitled to the status of a trademark and the rights appurtenant to such status. Such designations, to be entitled to the status of a trademark, must be used in connection with goods or services, must be capable of distinguishing one person's or company's goods from another's, and must be used in such a manner that they indicate that such "branded" goods come from a single source - even if that source is unknown.

Certain types of designations are assumed by law to be trademarks when used properly. These types of designations are called inherently distinctive marks. Inherently distinctive marks are assumed to be valid trademarks and owned by the user. There are three types of inherently distinctive marks: Arbitrary, Fanciful, and Suggestive. A fanciful mark is a word made up to serve as the mark or a word no longer in common usage. An arbitrary mark is a word or symbol commonly used and known but used in an unusual way. A suggestive mark is a word, slogan, or symbol that hints at some quality, feature, or ingredient of the goods or services associated with it. Examples of the three types of inherently distinctive marks are:

- ❖ **Fanciful mark:**
  - KODAK for photographic supplies
  
- ❖ **Arbitrary mark:**
  - MOUNTAIN for computer data storage
  
- ❖ **Suggestive mark:**
  - FRIENDLY for shoes

If a term does not meet the criteria for an inherently distinctive mark then it is either a descriptive term or a generic term. Generic terms, the common name of a product or service, can never become a trademark or service mark (*e.g.*, WATER for bottled water). A descriptive term is one that immediately conveys some quality, function, feature, characteristic or ingredient of the goods or services. Two examples of descriptive marks are OATNUT for bread containing oats and nuts and BED & BATH for retail stores featuring items for bedrooms and bathrooms.

To establish trademark rights in a descriptive term the user must be able to prove that in addition to its normal meaning, consumers have come to also recognize the term as a designation of source (*i.e.*, the term has acquired secondary meaning). Details on how secondary meaning is developed and established will be provided in the next issue.