

Trademark Selection

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It is important to select a mark that can be registered as a Federal Trademark prior to introducing a new product or service into the marketplace. Businesses should be very careful in selecting a mark so that they retain the ability to obtain registration and can prevent others from using the mark.

Trademarks are classified into following four categories:

- 1) Generic
- 2) Descriptive
- 3) Suggestive
- 4) Arbitrary

Let's take a look at these categories in more detail:

GENERIC MARKS

Trademark rights cannot exist in marks that are considered generic. A generic term is the common ordinary name of a good or service and can never be a trademark. Examples of generic terms include "corn flakes", "automobile" and "basketball".

DESCRIPTIVE MARKS

Descriptive marks *describe* some aspect of the product or service with which the mark is used. Descriptive marks are usually not very good choices for your mark. Trademark protection is only extended to descriptive marks where they have attained a *secondary meaning*. Secondary meaning is attained when a mark has been used for so long or so exclusively that they do not convey simply their literal meaning in the public mind, but are instantly associated with one source.

SUGGESTIVE MARKS

Unlike descriptive marks, suggestive marks merely *suggest or hint* at some quality, aspect, or component of the goods or services with which they are used. A suggestive mark is stronger than a descriptive mark because it does not require the showing of a secondary meaning.

FANCIFUL OR ARBITRARY MARKS

Fanciful or Arbitrary marks are the most distinctive of all marks and receive the strongest level of protection. Such marks are typically unknown before they become associated with a product. A well-known example of an arbitrary mark is the mark KODAK® for photographic supplies.

TRADEMARK SEARCHES

A trademark search should be conducted before use of a new mark. Depending upon the results of the search, it may be advisable to seek federal registration for your mark. Federal registration provides constructive notice to all potential users of similar marks whether or not they are aware of your mark. Additionally, a federally registered mark enjoys the presumption that the owner of the mark is the registrant and that the owner is entitled to use of the mark nationwide. Trademark rights are valuable intellectual property rights. An attorney knowledgeable and experienced in practicing before the U.S. Patent and Trademark Office should be consulted for particular assistance with your situation.

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