Trademark and Distinctiveness

The term "trademark" includes "any word, name, symbol, or device..." used to identify a specific manufacturer's or seller's products"...from those manufactured or sold by others...." 15 U.S.C. § 1127 A trademark does not need to be registered to be valid. A valid trademark can be established through "legitimate use." However, a trademark must be distinctive because a distinctive trademark ensures the following:

- competitors can use non-distinctive terms and symbols to describe their goods and services; and
- the trademark identifies the source of the product.

To test "distinctiveness," courts will use the "Abercrombie Formulation."

Abercrombie Formulation

The Abercrombie Formulation, developed by the 2nd Circuit Court of Appeals in Abercrombie & Fitch Co. v. Hunting World, Inc., tests for distinctiveness by creating four categories:

- generic—does not qualify for protection
- descriptive—sometimes qualifies for protection
- suggestive—qualifies for protection
- arbitrary or fanciful—qualifies for protection

The determination of whether a mark qualifies for protection is based, in part, on which category the mark belongs to.

Generic

By their nature, generic marks are not distinctive. They do not warrant protection because if one seller could trademark a generic name, other sellers would be unable to describe their products and would thus be at a great disadvantage. For example, it is not permissible to trademark "Milk" brand milk or "Hiking Boots" brand boots.

Suggestive

A suggestive mark does not describe the product; it suggests its nature or characteristics. Although an inference must be made about the product, the product must still bear some relationship to the mark. For example, a Pathfinder suggests something that is at home off-road, but it has no inherent relationship to a four-wheel-
drive SUV made by Nissan. Similarly, "Titleist" has no inherent relationship to a golf ball, but it does suggest championship sports equipment.

**Descriptive**

Descriptive terms and symbols generally identify anything about the product: purpose, size, color, ingredients, origin, and so forth. Merely descriptive, general marks do not qualify for protection. To qualify for protection, a mark must acquire a secondary meaning. To acquire a secondary meaning, the mark must be associated by the public with the manufacturer or seller rather than the underlying product itself. For example, "Jiffy Lube" describes a speedy lube and oil but has acquired a secondary meaning in the public mind.

A surname incorporated into a mark is treated as a descriptive mark—it does not qualify for protection until it acquires a secondary meaning. Examples include McDonald's and Hilton Hotels.

**Secondary Meaning**

There is no bright line rule for determining whether a descriptive mark or surname has acquired a secondary meaning. The Second Circuit Court of Appeals, in *Thompson Medical Co., Inc. v. Pfizer Inc* 753 F.2d 208 (C.A.N.Y., 1985), collected a list of factors to be considered from previous cases and stressed that no single factor is determinative. These factors include the following:

- advertising expenditures
- consumer studies linking the name to a source
- sales success of the product
- unsolicited media coverage of the product
- attempts to plagiarize the mark
- the length and exclusivity of the mark’s use

Courts will also consider the how others have used the terms or symbols, whether they are likely to use them in the future, and the extent they have used them in the past. *Zatarian's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

**Arbitrary and Fanciful**

Marks that are arbitrary and fanciful do not describe or suggest any characteristic of the product. The symbol's meaning is not inherently related to the product, so the product is more likely to be associated with the symbol. Examples include Yamaha, Chevron, and Maytag. These words have no inherent relationship with their products—motorcycles, gasoline, and appliances.
Some Illustrative Cases

_in re owens-corning fiberglass corp., 774 f.2d 1116 (fed. cir. 1985)_

Owens-Corning sought to register the color "pink" as it is used with the fiberglass they manufactured. Owens-Corning claimed that the pink color of their fiberglass was an arbitrary design decision (fiberglass need not be pink). They further claimed that through prior commercial use, the color pink had acquired a secondary meaning, and was, thus, distinctive.

The court used the following factors to determine whether "pink" had a secondary meaning in this case:

• "pink" was connected with Owens-Corning's product in the minds of "a significant part of the purchasing public"
• television commercials and other advertising that associated pink with the fiberglass including: "Pink of Perfection"; "The Pink Cooler"; "Big Pink"; "Love that Pink"; "Pink Power"; "America's Favorite Pink Product"; "Tickled Pink"; "Put your House in the Pink"; "Up with Pink"; "Prime Time Pink"; "Think Pink"; "Think More Pink"; "Beat the Cold with Pink"; "All that Pink"; and "Plant some Pink Insulation in your Attic".
• $42,000,000 in advertising expenditures

The court held that the descriptive term "pink" acquired a secondary meaning when associated with Owens-Corning fiberglass. Thus it was distinctive and could be protected by trademark.

_genesee brewing co. v. stroh brewing co., 124 f.3d 137 (2d cir. 1997)_

Genesee Brewing Co. had been marketing and selling a product called, "JW Dundee's Honey Brown Lager." A competitor, Stroh Brewing Co., later began marketing their own product called, "Red River Valley Honey Brown Ale." Genesee sought to restrain Stroh from marketing Red River Honey Brown Ale, claiming that the phrase "honey brown" should be protected and would tend to cause confusion as to the origin of the product if used by Stroh. The court, however, held that the term "honey brown" was generic and descriptive because those words were necessary to describe that particular type of ale. Thus "honey brown" did not warrant protection.

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