



What is a Protectable Mark?—A Focused Primer

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Introduction

There are a number of defenses in trademark infringement litigation. One of the more often litigated issues is the entitlement to trademark protection in the first instance. This article discusses the classifications of marks to determine if the mark in question is afforded protection under the law. It is the author's hope that by reviewing this Article, the reader will come away with a basic understanding of the different classifications of marks under the law and have a rudimentary ability to evaluate whether a mark at issue is entitled to protection.

Trademarks, among other types of marks, are afforded protection under 15 U.S.C. § 1051 *et seq.*, also known as the Lanham Act.¹ The Lanham Act, *inter alia*, prohibits, without consent of the registrant, the

use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive....²

The Act also prohibits

reproduc[tion], counterfeit[ing], copy[ing], or colorably imitat[ing] a registered mark and apply[ing] such

reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive....³

Violation of the Act can render the violator liable in a civil action.⁴

As noted from the language, these two statutory provisions allow only the registrant to seek legal redress. However, the Act also provides protection for those who have not registered their trademarks. 15 U.S.C. § 1125 provides a remedy against

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which ... is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin,

sponsorship, or approval of his or her goods, services, or commercial activities by another person, or [] in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities....⁵

This statutory provision specifically permits the commencement of a civil action by anyone “who believes that he or she *is likely to be damaged*,” as opposed to only the registrant of a registered trademark.⁶ This statutory provision thus provides for greater relief.

The penalties for a violation of the Lanham Act can be significant. This statutory scheme provides for, among other damages, the recovery of the violator's profits, “any damages sustained by the plaintiff,” and the costs of the action. Interestingly, the damage awards are subject to “the principals of equity.”⁷ Regardless of which statutory provision is invoked, in order to prevail on or defeat such a claim, it is critical to have a protected mark, as without it, there is no claim.

So what is a protectable mark? It is a trademark. A trademark is “any word, symbol, or device, or combination thereof—used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁸ The Lanham Act only protects those marks that are distinctive.⁹ After all, as noted below, given the underlying goal of the Act, if the mark is not distinctive, it is not worth protection.

The Lanham Act provides protection of trademarks as Congress has determined that “national protection of trademarks is desirable ... because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.”¹⁰ The objectives of trademark law are twofold: (1) to prevent confusion among consumers

as to the source of goods or services; and (2) to indicate ownership and permit the trademark owner to control the product's reputation.¹¹ As noted by the United States Supreme Court in a 1942 decision, trademark protection is “the law's recognition of the psychological function of symbols.”¹²

Under the Lanham Act, marks qualifying for protection can be registered on the federal register.¹³ If a trademark is so registered, a rebuttable presumption of its validity is established.¹⁴ However, that presumption “evaporates as soon as evidence of invalidity is established.”¹⁵ On the other hand, if a trademark is not federally registered, then it is incumbent upon the party seeking trademark protection to prove that the mark is entitled to protection.¹⁶

Regardless of the registration status of the mark, in order to prove a Lanham Act violation, a plaintiff must prove three items: (1) there must be a valid and legally protectable mark; (2) “that the plaintiff owns the mark”; and (3) “that the defendant's use of the mark to identify goods or services causes a likelihood of confusion.”¹⁷ In order for an unregistered mark to be protectable, it must fall within one of the classifications of protectable marks. It is this requirement that is the focus of this Article.

Identifying Protectable Marks

Courts have identified five different mark classifications: (1) generic; (b) descriptive; (c) suggestive; (d) arbitrary; and (e) fanciful.¹⁸ How the mark is classified determines whether it is afforded protection under the Lanham Act. Presuming that the trademark has not been federally registered, the first defense to a claim of trademark infringement is to show that the mark is not a protectable mark, and thus not entitled to the protections afforded under the Lanham Act. If the mark is not a protectable mark, then the claim of infringement will be vulnerable to dismissal via motion practice.¹⁹ The more distinctive the mark, the more likely it is to receive protection.²⁰

As will be discussed *infra*, marks that are characterized as suggestive, fanciful, or arbitrary are automatically granted trademark protections. The reason the law provides this automatic protection is that such marks are very distinctive, and thus “almost automatically tell a customer that they refer to a brand.”²¹ Trademark law is a tool to protect that connection.

A. Generic Marks

Generic marks are not afforded protection. A generic mark is one that simply identifies the type of a particular product.²² It is not distinctive. Since there is nothing unusual or identifiable about the mark, it is unworthy of protection. For example, “Multistate Bar Examination” for the dreaded multiple choice bar examination used in many states, “light beer,” or “decaffeinated coffee” are not sufficiently distinctive to warrant protection. The former example is simply a commonplace description of a type of exam and the latter examples are categories of beer²³ and coffee.

Use of these common terms does not afford protection under the Lanham Act, even if those terms acquire a secondary meaning in the minds of the public.²⁴ That is, there is no protection even if the public tends to associate that product with a particular manufacturer. “[S]uch a circumstance cannot take the *common descriptive* name of an article out of the public domain and give the temporary exclusive user of it exclusive rights to it no matter how much money or effort it pours into promoting the sale of the merchandise.”²⁵ In fact, the widespread use of a generic term by an industry is indicative of its generic status.²⁶

B. Descriptive Marks

A descriptive mark is the least distinctive type of mark that can warrant trademark protection. A descriptive mark “describes the ingredients, qualities, or characteristics of an article of trade or a service.”²⁷ It “defines a particular characteristic of a product in a way that does not require any exercise of the imagination.”²⁸ In other words, if the mark

simply communicates information regarding the product or good, it is likely descriptive.

Examples of descriptive marks include “Work-N-Play,” “Holiday Inn,” “All Bran,” and “American Girl.”²⁹ It is important to note that, to qualify as a descriptive mark, the mark need not depict the actual product. It is enough that the mark refer to a characteristic or ingredient of a product in order to be considered descriptive.³⁰

Merely showing that the mark is descriptive will not win the war. Rather, it is but a step in the right direction. A descriptive mark, without more, is not entitled to protection. For a descriptive mark to be entitled to trademark protection, it must be shown that the mark has acquired a “secondary meaning.” That is, the public must be able to connect the mark to the source of the product.³¹

The Need to Acquire a Secondary Meaning. In order to prove that a descriptive mark has acquired a secondary meaning (a connection with the public), courts will consider such information as the amount of the sales of the product, the extent of the advertising, and the type of the advertising utilized. Courts will also consider customer information, including customer testimony and surveys. Courts can also consider the use of the mark in trade journals and how long the mark has been in use.

The purpose of these inquiries is to show that prospective customers have associated the mark with the provider of product.³² Without significant sales of the product, it is unlikely that a descriptive mark has acquired a secondary meaning.³³ After all, if the product has not sold much, it is unlikely to have been accepted or recognized by prospective purchasers as associated with the product or the seller, which is the purpose of the secondary meaning inquiry.³⁴

C. Suggestive Marks

A suggestive mark is one that “calls to mind some attribute of the product[.]”³⁵ That is, unlike the descriptive mark that simply describes a product,

a suggestive mark is one that suggests the features of a product.³⁶ A suggestive mark is entitled to protection simply because it is suggestive. Stated otherwise, if a mark is classified as suggestive, rather than just descriptive, there is no need to prove secondary meaning for the mark to gain trademark protection.

An example of a suggestive mark is “Air Care” for a service that maintains medical equipment for administering oxygen.³⁷ Another example comes from *American Homes Products v. Johnson Chemical Co.*, in which the Second Circuit concluded that the phrase “Roach Motel” for an insect trap was suggestive. This phrase certainly does not describe the product, but rather requires the purchasing public to imagine the connection between the purpose of the product and the mark.³⁸ In another example, “Penguin” was held to be a suggestive mark for refrigerators.³⁹ Finally, the term “Rejuvaskin” was found to be suggestive as it required the consumer’s imagination to connect the mark with the product—an anti-wrinkle cream.⁴⁰

The Tests to Determine if a Mark Is Descriptive Versus Suggestive. As one might imagine, sometimes the line between a descriptive mark and a suggestive mark is difficult to draw, but the distinction is important because it is the difference between having to prove secondary meaning and not. In order to help differentiate between the two, courts have employed different tests to determine whether a mark is descriptive or suggestive. Perhaps one of the more widely known and utilized tests is the “degree of imagination” test. This test provides that “if the mark imparts information directly it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive.”⁴¹ In other words, a mark is suggestive, as opposed to just descriptive, if imagination is needed to link the mark with the product.

Some circuits have relied on a different test to determine if a mark is merely descriptive as opposed to suggestive. Referred to as the “competitor’s needs test,” this test “focuses on the extent to which

the mark is actually needed by competitors to identify their goods or services.”⁴² Under this test, if a competitor has a great need to use the mark, then it is probably a descriptive mark. However, if “the suggestion made by the mark is so remote and subtle that it is really not likely to be needed by competitive sellers to describe their goods or services[,] this tends to indicate that the mark is ... suggestive.”⁴³

Finally, some courts have employed yet a third test to differentiate between descriptive and suggestive marks. This test has been referred as the “extent of use” test.⁴⁴ This test actually examines the use of the mark in the industry in question. In “determining whether a word has a descriptive or suggestive significance as applied to a commercial service, it is proper to take notice of the extent to which others in a similar commercial context use the word.”⁴⁵ Under such a test, it is entirely appropriate to introduce the actual other uses of the word, phrase, or description. For example, Google searches have been deemed appropriate evidence under this test.⁴⁶ The greater the extent to which the words that make up the mark are used in the industry, the more likely the mark will be considered descriptive rather than suggestive.

D. Arbitrary Marks

Like suggestive marks, arbitrary marks are afforded protection without the necessity of acquiring a secondary meaning. However, arbitrary marks go one step further; they do not suggest the goods or services at all, and typically use common words that have no logical relationship to the product or service they represent.⁴⁷ Examples of arbitrary marks are “Kodak”⁴⁸ for photography products, “Dutch Boy” for paint, or “Dreamwerks” for a “business of organizing conventions in the Northeast and Midwest, mostly with a Star Trek theme.”⁴⁹ These marks, like suggestive and fanciful marks (discussed below), receive the greatest protection under the Lanham Act. If arbitrary marks are recognized by the public, it is because they serve as “ready-made designators of the good or service’s origin.”⁵⁰ It is this very purpose that trademark law seeks to protect.

E. Fanciful Marks

Finally, fanciful marks, like suggestive and arbitrary marks, are also afforded protection without the necessity of establishing a secondary meaning. Fanciful marks are coined phrases with no known connection to the product yet provide for an immediate connection to the product in the minds of the public.⁵¹ Such marks are “completely fabricated by the trademark holder[.]”⁵²

Examples of fanciful marks are “Aveda” for skin care products,⁵³ “Exxon” for oil,⁵⁴ and “Clorox”⁵⁵ for bleach. The fanciful trademark category is often designated for those marks that consist of coined terms. They “conjure up nothing less than images of the respective products associated with each mark.”⁵⁶ Given this type of strong correlation, these marks are afforded the greatest protection available under the Lanham Act.

Conclusion

The goal of manufacturers and other providers of goods and services is to have their products and services be easily identified by the consuming public. Trademarks help in this effort. They allow the consuming public to easily correlate the product or service with the mark. The marks are accorded varying levels of protection depending on the distinctiveness of the mark. Thus, in defending against a claim of trademark infringement, the first line of defense is to determine whether the mark is even entitled to protection. If it is not, then the war can be won early on.

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Mr. Weiss has argued his clients’ cases before the Wisconsin Court of Appeals as well as the Wisconsin Supreme Court. He is the author of a number of articles regarding insurance coverage and other insurance industry-related topics and is a regular speaker on insurance issues.

References

- 1 While this article highlights and focuses on federal law and the Lanham Act in particular, there are usually state law components to any trademark litigation that must also be considered. See, e.g., Wis. Stat. § 132 *et seq.* The Lanham Act has also been referred to as the Trademark Act of 1946.
- 2 15 U.S.C. § 1114(1)(a).
- 3 15 U.S.C. § 1114(1)(b).
- 4 *Id.*
- 5 15 U.S.C. § 1125(a)(1)A-B.
- 6 *Id.* (emphasis added).
- 7 15 U.S.C. § 1117(a).
- 8 15 U.S.C. § 1127.
- 9 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition*, § 11:2 (4th Ed. 2010).
- 10 *S.F. Arts & Ath. v. United States Olympic Comm.*, 483 U.S. 522, 531 (1987) (citing *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985)).
- 11 *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 644 (8th Cir. 1984) (Bright, J., dissenting) (citing *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976); *Sweetarts v. Sunline, Inc.*, 380 F.2d 923, 927 (8th Cir. 1967); 3 R. Callmann, *The Law of Unfair Competition Trademarks and Monopolies*, §§ 7.01, at 2, 17.13, at 58 (4th ed. 1983)).
- 12 *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).
- 13 15 U.S.C. § 1502.
- 14 *Georgia-Pacific Consumer Products, LP v. Kimberly-Clark, Corp.*, 647 F.3d 723, 727 (7th Cir. 2011).
- 15 *Id.* (quoting *Door Systems, Inc. v. Pro-Line Door Systems, Inc.*, 83 F.3d 169, 172 (7th Cir. 1996)).
- 16 *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1156 (7th Cir. 1996) (citing *Technical Publishing Co. v. Lebharr-Friedman, Inc.*, 729 F.2d 1136, 1139 (7th Cir. 1984)).
- 17 *A & H Sportwear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000).
- 18 *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).
- 19 *Aero-Stream, LLC v. Septicairaid, LLC*, 2015 U.S. Dist. LEXIS 26999 (E.D. Wis. 2015) (unpublished).

- 20 *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010).
- 21 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-163 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976)).
- 22 *S. Cal. Darts Ass'n. v. Zaffina*, 762 F.3d 921, 929 (9th Cir. 2014).
- 23 *National Conference of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478 (7th Cir. 1982); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th Cir. 1977); *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 992 n.5 (7th Cir. 1989).
- 24 *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437 (Cust. & Pat. App. 1960).
- 25 *Id.* at 440 (emphasis in original).
- 26 *Miller Brewing*, 561 F.2d at 80.
- 27 *Mil-Mar Shoe Co.*, 75 F.3d at 1157.
- 28 *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 630 (9th Cir. 2005).
- 29 *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 483 (7th Cir. 2007).
- 30 *G. Heileman Brewing Co.*, 873 F.2d at 992.
- 31 *Two Pesos, Inc.*, 505 U.S. at 766 n.4.
- 32 *Educ. Dev. Corp. v. Econ. Co.*, 562 F.2d 26, 28 (10th Cir. 1977).
- 33 *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 486 (7th Cir. 2007).
- 34 In this day and age, the Internet is a viable medium to sell products. There are typically lower overhead costs than a traditional brick and mortar store. That said, the law does not recognize a high visitor count on a web site as indicative of a product acquiring a secondary meaning in the eyes of the public. See *555-1212.com, Inc. v. Commc'n House Int'l, Inc.*, 157 F. Supp. 2d 1084, 1091 (N.D. Cal. 2001). Rather, it simply means that the web site has had a large number of visits by Internet users.
- 35 *Survivor*, 406 F.3d at 630.
- 36 *Id.*
- 37 *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042 (9th Cir. 1998).
- 38 *Am. Homes Products v. Johnson Chemical Co.*, 589 F.2d 103 (2d Cir. 1978).
- 39 *Frehling Enters., Inc. v. Int'l. Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999).
- 40 *Scar Heal, Inc. v. JJR Media, Inc.*, 2014 U.S. Dist. LEXIS 104137 (M.D. Fla. 2014) (unpublished).
- 41 *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 952 (7th Cir. 1992), *aff'd. in part and rev'd in part*, 34 F.3d 1340 (7th Cir. 1994).
- 42 *Treemo, Inc. v. Flipboard, Inc.*, 53 F. Supp. 3d 1342, 1353 (W.D. Wash. 2014) (citing *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987)).
- 43 *Id.*
- 44 *555-1212.com, Inc.*, 157 F. Supp. 2d at 1089.
- 45 *Id.*
- 46 *Zobmondo Entertainment, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1118 (9th Cir. 2010).
- 47 *Survivor*, 406 F.3d at 630.
- 48 *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980) ("Kodak" is an arbitrary or fanciful mark.).
- 49 *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1130 n.7 (9th Cir. 1998).
- 50 *Janet Travis, Inc. v. Preka Holdings, LLC*, 306 Mich. App. 266, 282, 856 N.W.2d 206 (Mich. Ct. App. 2014).
- 51 *Survivor*, 406 F.3d at 630.
- 52 *Kellogg Co. v. Toucan Gold, Inc.*, 337 F.3d 616, 624 (6th Cir. 2003).
- 53 *Aveda Corporation v. Evita Mktg., Inc.*, 706 F. Supp. 1419 (D. Minn. 1989).
- 54 *Exxon Corp. v. XOIL Energy Resources, Inc.*, 552 F. Supp. 1008, 1014 (S.D.N.Y. 1981).
- 55 *Clorox Chem. Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702, 705 (E.D.N.Y. 1938).
- 56 *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 947 (N.D. Ill. 2002).

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