

Ohm's Law: What's in a Name?

By Hun Ohm*

Say you're a small boutique with big plans and an iconoclastic line of candle products, the equivalent of sliced bread for the home décor world. Everyone will want one of your candles. They will ask for the line by name. And now you're stuck. What's that name going to be, and why?

Take a brief look around at the mindboggling number of brands permeating popular culture. It should come as no surprise that not all marks are created equal; however, each kind of mark has its purpose and was selected for a reason. Some may be lackluster but informative; others are unique but nonsensical. Often the best names capture that elusive combination of being unique and distinctive, and yet somehow suggest just enough to entice you to remember. Thoughtful selection is the first step to fashioning a brand that will be memorable and protectable. It's useful to recall the spectrum of marks when making this selection.

As a refresher, the following sets forth the pecking order of marks from strongest to weakest in terms of legal strength:

Fanciful

These marks are coined or made up words that have no meaning. Think: EXXON for petroleum products.

Arbitrary

These are actual words in common use but which are used in an arbitrary manner that is neither descriptive nor suggestive of any qualities or characteristics of the goods or services offered under the mark. Think: APPLE for computers.

Suggestive

These marks suggest, but do not immediately describe or convey information about, an attribute or quality of the applicable goods or services. Think: GREYHOUND for bus transportation services.

Descriptive

These marks merely and immediately describe an aspect, trait or characteristic of the goods or services in question. Think: OATNUT for bread containing oats and nuts.

Generic

Generic terms are terms that have become the common name for a good or service. These terms are not registrable and not capable of being source identifiers. Think: APPLE for apples.

Generally speaking, the stronger, *i.e.*, more distinctive, a mark is, the broader its scope of protection. Fanciful, arbitrary, and suggestive marks are considered to be inherently distinctive and thus can be federally registered without a showing of secondary meaning. On the other hand, descriptive marks are "weak" and are generally accorded a narrower scope of protection than inherently strong marks, and cannot be federally registered on the Principal Register without a showing of secondary meaning, *i.e.*, a showing that the mark has acquired distinctiveness through

substantially exclusive use of the mark over a long period of time, which is difficult to establish (especially if you are just starting out).

So if some marks are strong, and some marks are weak, then why does anyone select a weak, descriptive mark? The most common reason is ease of communication with the consumer. The consumer hears the brand, and it immediately conveys information about a feature or characteristic of the applicable product. So when I market my new roller skate line under SMOOTH WHEELS, consumers have an immediate sense of some of the features or advantages that might be provided by my roller skates – a great built-in selling point! However, I might face considerable difficulty stopping competitors from using the phrase “smooth wheels” to describe the wheels that are part of their roller skate products.

On the other hand, if I market my roller skate brand under MHONUH (my name in reverse), while I may have come up with a fanciful mark that no one else uses (or would even want to use), it will likely take a large amount of ingenuity, marketing and resources before consumers come to associate MHONUH with my roller skate line, and I might arguably be better served deploying those resources elsewhere.

Generic marks are the third rail of trademarks, and from a branding perspective you will be well served to steer clear of these terms as they relate to your product when you are considering brand names. Interestingly, if your product is unique (*e.g.*, the first of its kind) and quite successful, but you are not careful about monitoring how you use your brand (and how others might be referring to your product), you might find yourself in a counterintuitive dilemma in which your success leads to your brand’s demise. For example, ESCALATOR and ZIPPER were both brand names at one time. However, over time, in the absence of careful brand protection practices, these brands have come to be the very name of the class of product itself – a zipper is a zipper, and an escalator is an escalator. Their distinctiveness has been lost.

But we are getting ahead of ourselves. It’s not all fire and brimstone if you are careful and thoughtful from the onset of your brand development activities. Properly selected and cultivated, a brand can lead to great rewards for your business. And who knows, maybe we will be asking for that deliciously indescribable scented candle one of these days, by which name...you decide.

*Hun Ohm is a partner in the Entertainment/Intellectual Property Group at Fierst, Kane & Bloomberg LLP in Northampton, Massachusetts.

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