

Strength of Trademarks

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When it comes to identifying trademarks, there are a number of categories to consider. Often, trademarks fall within one of the below categories, fanciful and arbitrary marks being the strongest, suggestive trademarks falling somewhere in the middle, descriptive trademarks being weaker but sometimes protectable, and generic trademarks being unprotectable under the trademark law.

Fanciful trademarks

A fanciful trademark is made-up, invented for the sole purpose of functioning as a trademark; it can also be referred to as a coined term. Words in such marks are entirely invented and do not refer to anything else. By way of example, a trademark such as Kodak is a good example of a fanciful trademark.

Arbitrary Trademarks

Arbitrary trademarks are words that have a common meaning and are part of everyday language, but the meaning of the words is unrelated to the goods or services offered for sale under the mark. By way of example, the word Apple is common and part of everyday language, clearly describing a fruit in the literal sense; however the word Apple used in connection with computers and communication devices, renders the trademark as an arbitrary one.

Suggestive Trademarks

Suggestive marks are marks that suggest a quality or characteristic of the goods and services. Despite the fact that suggestive marks are not as strong as fanciful or arbitrary marks, suggestive marks are common due to the fact that, in the mind of consumers, they create a link to a product/services. Suggestive marks are often difficult to distinguish from descriptive marks (described below), since both are intended to refer to the goods and services in question. Suggestive trademarks require some imagination, in that they require a subtle leap in thought and perception, thereby allowing the consumer to reach a conclusion as to the exact nature of the goods/services. An example of a suggestive trademark would be the word Penguin as a brand for refrigerators, or Microsoft which is suggestive of software for microcomputers.

Descriptive Trademarks

Descriptive trademarks are words that merely describe some portion of the goods or services to be sold under the trademark. Through Court precedents, it has been established that trademarks that simply describe the ingredients, shapes, qualities or characteristics of the goods/services, are identified as descriptive trademarks. As a rule of thumb, descriptive marks are not inherently distinctive and therefore cannot be protected because they use every day words to describe products and services. By way of example a trader in the business of operating a pizza restaurant, cannot register a trademark called "PIAZZZZ" since it is merely descriptive of the intended goods/services.

However, some trademarks, although being identified as descriptive, can nevertheless be considered as trademarks and therefore protectable. In order for a descriptive trademark to be protectable it is required to establish that it has acquired a secondary meaning. Secondary meaning indicates that although the mark is on its face descriptive of the goods or services, consumers recognise the mark as having a source-

indicating function. The threshold of recognising a secondary meaning requires that the brand owner establishes widespread, long term and exclusive use. The acquisition of secondary meaning is often proven through the use of consumer surveys that show that consumers recognise the mark as a brand.

Generic Trademarks

Generic trademarks are identified as the actual names of the goods/services and therefore are incapable of functioning as a trademark. Unlike descriptive marks, generic trademarks will not be recognized as trademarks even with longstanding and exclusive use, as generic trademarks are considered as part of the public domain and therefore one trader cannot claim exclusivity on such common terms. As such, the rationale for creating the category of generic marks is that no manufacturer or service provider should be given the exclusive right to use words that generically identify the product/services. By way of example, a trader operating a hair salon cannot seek protection over the name "Hair Salon".

In addition, a valid trademark can become generic over the years if the consuming public misuses the mark sufficiently for the mark to become the generic name for the product. Examples of trademarks that have become generic names for products are Kleenex, Aspirin and Jacuzzi.

Trademarks are an important asset, serving to distinguish a business' products and services from those of other trademarks. Given the potential value of trademarks to almost any business and the cost of building brand awareness in the marketplace, the selection of an enforceable trademark is crucial.