



Selecting Distinctive, Registerable & “Ownable” Brand Names

Hinckley Allen Trademarks & Copyrights

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Selecting a brand name for a company or its products or services is often one of the most challenging and complex initiatives that a company can undertake. At the heart of the issue is the desire to create a name that is distinctive and “ownable,” while also providing the potential for consumers to easily recognize and remember the brand name. As creative minds are at work, however, it is important to consider the legal implications of a proposed brand. Ideally, a company should strive to achieve a balance between meeting the marketing and performance goals of a brand name, while obtaining the broadest legal protection available and sustainable over time.

Brand names can be registered as trademarks (for tangible products) or as service marks (for services) at the federal level, which provides their owners with rights across all U.S. states. Federal registration is highly recommended and trademark and service mark registrations are among a company’s most valuable assets. The ability to obtain federal registration and the scope of rights provided under such registration depend upon the distinctiveness of the brand name, and the distinctiveness of a brand translates into the extent to which the brand name is “ownable.”

What is an “ownable” brand name?

While it is important to select a brand name that is creative, recognizable, and easy to remember, as well as conveys a strategic idea or compelling message to consumers, the brand also needs to be “ownable” and enforceable as a trademark or service mark. In other words, the brand name should be creative and convey the desired messaging, while at the same time it should be sufficiently original, distinctive and capable of distinguishing a company and its products or services from those of its competitors. Federal registration

of distinctive brand names can secure robust, enforceable trademark rights. This is what is meant by an “ownable” brand name – one that not only conveys a desired message or idea to the market, but also is sufficiently distinctive to garner a broad scope of enforceable legal rights.

Companies often desire brand names that tell consumers what their company does or what their products or services are. Brand names that describe certain characteristics or the nature of a company’s products or services are descriptive trademarks or service marks. Descriptive marks often can attain only a very narrow scope of legal protection even when federally registered. The greater a brand name’s ability to describe, for example, some feature, function, purpose, ingredient or characteristic of the underlying products or services, the less distinctive the brand name is relative to the market in which it resides. As a result, the more limited the legal rights in such brand name and the more difficult to enforce such rights against competitors and infringers.

A brand name’s distinctiveness is also directly related to its strength in the relevant market, such that, the more descriptive a brand name, the weaker it is and the greater the chances a company’s competitors are using terms similar to the brand name to describe their own products or services. Weak brand names are also less effective in distinguishing a company and its products and services from those of others.

The function of a brand name as a trademark or service mark is to symbolize or identify the company from which the products or services originate. In other words, a trademark or service mark serves as a source identifier, indicating the company from which the products or services originate. Therefore, brand names comprised of descriptive terms may exist in a field in which there are a number of third parties using the same or similar terms, not necessarily as brand names, but to describe their own company or their products or services. Brand names existing in such a “crowded” field are “weak” source identifiers because they have less strength in identifying and distinguishing a company and its products or services, especially from its competitors. In contrast, distinctive brand names do not exist in such crowded fields and would have greater strength in identifying and distinguishing a company and its products or services from others.

So, how do you measure distinctiveness of a brand name?

The degree of distinctiveness of a brand name can be represented along a continuum, wherein at one end are highly distinctive brand names that command a broad scope of protection and are “ownable,” and at the opposite end are descriptive names and generic terms with a narrow scope of or no legal protection. The distinctiveness continuum

illustrated below includes examples of brand names ranging from highly distinctive trademarks (deemed “arbitrary” or “fanciful”) to descriptive names and generic terms.

Highly Distinctive→	Suggestive→	Descriptive→	Generic→
APPLE® (arbitrary)	AIRBUS®	COOL & CREAMY	ESCALATOR
ADIDAS® (fanciful)	Q-TIPS®	FRENCH VANILLA	LINOLEUM

The famous brand name APPLE® is highly distinctive of the company and the products it symbolizes and considered an “arbitrary” trademark, meaning that it is a known word that has been arbitrarily used to market laptops, smart phones, and smart watches. ADIDAS® is equally distinctive and considered a “fanciful” trademark because it is a made-up or coined word used to represent the company and its footwear products. Such highly distinctive trademarks are the strongest trademarks on the continuum and thereby command a broad scope of legal protection due to their distinctiveness or strength. Such brand names are examples of “ownable” trademarks whereby they are strong symbols of the companies and their products and services and can be readily enforced against a wide range of confusingly similar variations and third party uses.

In contrast, COOL & CREAMY as a brand name for an ice cream variety, and FRENCH VANILLA as a variety name for flavored coffee, are highly descriptive names because they describe a characteristic (ice cream texture) or a feature (flavor) of their respective products. Such names are relatively weak in their respective markets and consequently have only a very narrow scope of protection and, in some cases, no legal protection at all. Because such names lack sufficient distinctiveness to serve as a trademark or service mark, in many cases (such as in these cases) they are not eligible for federal registration. Such descriptive names are also difficult for a company to enforce against third parties, especially against its competitors, because exclusive rights to use of such descriptive words, even as a brand name, cannot be granted to a single party, in part, because others need to use such words to describe their own products and services.

Generic terms provide no legal rights and include words that do not identify any particular company as the source of their respective products or services. Rather, generic terms simply refer to, or are names for, the actual products or services themselves. Such names may have evolved over time from distinctive brands into generic terms, having lost their distinctiveness and ability to serve as a trademark or service mark. This is the case for the names “Escalator” and “Linoleum,” which were once distinctive trademarks for innovative

products, but through their actual use over time became generic terms for their respective products and are no longer subject to any legal protection.

Suggestive trademarks lie somewhere between distinctive marks and descriptive names, and are less distinctive than arbitrary and fanciful marks, but do not immediately or directly convey information about some particular function, feature, purpose, characteristic or the nature of the underlying products or services as do descriptive names. Rather, suggestive trademarks suggest to consumers something about the products or services or their characteristics. Suggestive marks are eligible for federal registration and can command a relatively broad scope of legal protection. For example, the brand names “Airbus®” and “Q-Tips®” are suggestive trademarks because they suggest the nature or some feature of their respective products, namely, airplanes that serve as “buses in the air” and cotton swabs that have a useable tip. Often there is a fine line between the suggestiveness and descriptiveness of a brand name.

In sum, the degree of distinctiveness of a brand name has a direct bearing on the strength of the brand as a trademark or service mark in symbolizing a company as the source of its products or services. The degree of distinctiveness of a brand also distinguishes the company and its products or services from the company’s competitors, such that, upon perceiving the brand name consumers will easily differentiate the company’s products or services from others. The degree of distinctiveness also has a direct bearing on the scope of legal protection that can be obtained and the robustness of legal rights that can be asserted against third parties. As a result, such enforceable trademark rights help to maintain the brand name’s distinctiveness, strength, and performance in the marketplace. Therefore, brand names that are distinctive and strong, eligible for federal registration, and garner a broad scope of legal protection are highly desirable and “ownable” trademarks or service marks.

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