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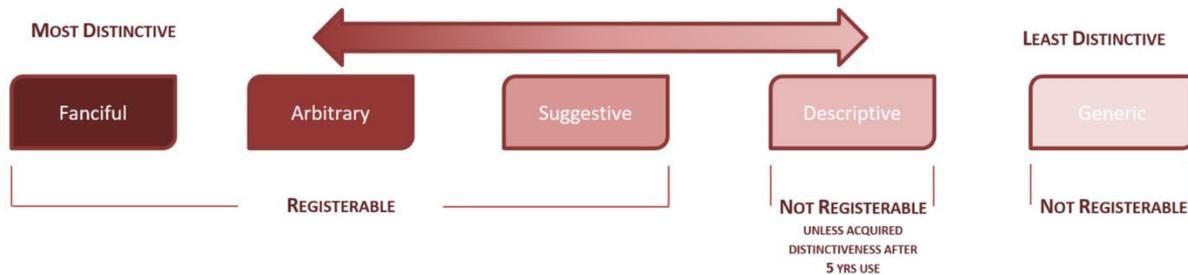
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CONSIDERATIONS FOR ADOPTING TRADEMARKS

I. DISTINCTIVENESS

Terms, designs, etc which lack distinctiveness are not eligible for federal trademark registration. Under US Trademark Law, distinctiveness is measured by the five categories discussed below.



REGISTERABILITY

Under US Trademark Law, trademarks are considered “source identifiers” and as such should identify the source of the goods/services but not the nature of the goods/services. Terms which identify the nature of the goods/services by describing the goods/services or are generic and immediately name the goods/services are not eligible for registration. Trademarks should be unique and creative in nature, at most suggesting the nature of the goods/services but ideally be imaginative and unrelated to the goods/services entirely.

CATEGORIES OF DISTINCTIVENESS

Fanciful

We strongly urge clients to invest the time and creativity in developing fanciful marks. Being the gold standard of trademarks, these fanciful marks are the most distinctive, most easily registered and most easily protected from infringement. Fanciful marks are marks incorporating invented words and terms. Examples include Xerox, Kleenex, Microsoft, Kodak, Google, Exxon, Tesla, etc.

Arbitrary

Also preferable are arbitrary marks which use existing words and terms for branding unrelated products/service. Examples include, Apple(for computers), Ivory(for personal hygiene products), Amazon(for an e-commerce store), Dove(for personal hygiene products), Walmart(for a general merchandise store), Secret, Samsung, etc.

Suggestive

Least desirable and most difficult to successfully register and protect from infringement post registration are suggestive marks which use existing words and terms implying association with the goods/services. These marks are more difficult to have registered and often face office action. Examples include 7-Eleven(for a store open 7am to 11pm, 7 days a week),

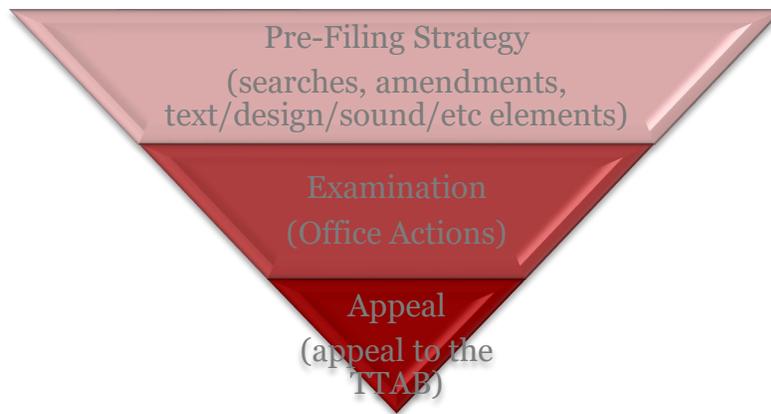
Coppertone(for sun block implying skin tone after sun exposure), Degree(for deodorant that works as the temperate rises), etc.

II. STRATEGY

Adopting a trademark requires strategy and planning. Ideally businesses should seek to adopt marks that are fanciful and in a limited field thereby being most easily registered and defended for the long term.

FUNNEL OF SUCCESS

Level of control over outcome diminishes significantly throughout the process. Trademark knockout searches, comprehensive searches, amendments to terms, amendments to the description of goods and services, considerations of plain text or design mark elements, etc at the outset BEFORE FILING can make an enormous difference in whether a mark becomes registered.



PYRAMID OF EXPENSE

Nominal upfront spending can save significant money in the long run. The costs for trademark searches and strategy sessions are significantly lower than the costs of responding to office actions and filing appeals.

