

TRADEMARKS, DISTINGUISHING GUISES and TRADE NAMES

Any device that identifies the origin of goods or services, whether it is a mark, distinguishing guise (called trade dress in the U.S.), or trade name, may be protected. Not all distinguishing guises or trade names, however, rise to the level of a trademark. This newsletter describes the differences between trademarks, distinguishing guises, trade names, and between different types of trademarks.

1. Marks – Trademarks, Service Marks, Certificate Marks and Collective Marks

Under Canadian and U.S. federal intellectual property law, a mark can be any word, name, symbol or any combination thereof used in commerce. There are four types of marks – **'trademark'** or **'service mark'** is used by a manufacturer or retailer to distinguish its product (trademark) or service (service mark) from its competitors' products and services. Trademarks and service marks indicate that a product originates from a particular source. A **'certification mark'** is used by a party other than the owner to certify origin, material, mode of manufacture, quality, accuracy, or other characteristics of goods or services. Examples of certification marks are 'CSA' (Canadian Standard Association) and 'TRUSTe' (Internet privacy program). A **'collective mark'** is used by the members of a collective group to indicate a membership in a union, an association, or organization, such as 'Phi Beta Kappa' (academic honour society).

2. Trademark Categories

Trademarks may be classified into five categories: (1) **fanciful**; (2) **arbitrary**; (3) **suggestive**; (4) **descriptive**; and (5) **generic**. The strength of a trademark varies with its distinctiveness, that is, the degree to which it indicates the source of a product. A mark is strongest if it is inherently distinctive or has acquired distinctiveness through secondary meaning, i.e., through consumer association of the mark with the source of the goods. Fanciful, arbitrary or suggestive marks are inherently distinctive because their intrinsic nature serves to identify a particular source of a product. Descriptive marks are not inherently distinctive, but are protectable if secondary meaning can be established. Generic marks are never protectable.

Fanciful and Arbitrary Marks

Fanciful marks are 'coined' terms which did not exist before they were adopted as trademarks, and which were created to function as marks. Examples of fanciful marks are – ROLEX® for watches and KODAK® for photographic supplies. Arbitrary marks are terms in common usage which have no apparent relationship to the product with which they are used. Example of arbitrary mark is APPLE for computers. Fanciful and arbitrary marks are afforded the highest level of protection under trademark law.

Suggestive Marks

Suggestive marks are marks that, although not completely unrelated to the goods with which they are used, require some imagination, thought or perception to directly associate the mark to the goods. Examples are – SPORTSTICK® for lip balm and GUNG-HO for a marine action figure.

Descriptive Marks

Descriptive marks are terms that immediately convey an ingredient, quality, characteristic, function, feature, purpose, or use of the goods to which they are applied. Examples of descriptive marks include HEALTHY CHOICE for nutritious food products and SOAKER for a water gun. Descriptive marks are entitled to protection only if they have obtained 'secondary meaning' – when the public's reaction to a mark is to immediately link the mark with a single source or producer of the product, not just with the product itself.

Generic Marks

Generic marks are the names of the goods or services themselves. Such marks are not protectable under trademark law, and are not registrable. An example of a generic mark is America Online's 'You Have Mail' and 'IM,' which it used with its e-mail and instant messaging services.

3. Characteristics Subject to Protection

A trademark can protect: (1) **abbreviations**; (2) **nicknames**; (3) **slogans**; (4) **titles**; (5) **characters**, and (6) **distinguishing guises**. **Abbreviations and Nicknames** are protected if they are distinctive. Abbreviations and slogans are not protected if they are merely descriptive and have not acquired any secondary meaning. Abbreviations, such as VW, and nicknames, such as COKE, are entitled to the same legal protection as full trademarks. **Slogans** such as YOU'RE IN GOOD HANDS WITH ALLSTATE® are protected as trademarks if they are used to identify and distinguish the source of marked goods. Generally, slogans are stronger as marks if they are short, if they appear on the goods apart from the other textual material, and if they do not merely impart advertising or promotional information about the product. **Titles** of books, television and radio programs, and movies are generally descriptive of the contents of the work and are not afforded trademark protection. However, a mark used to identify a series of books or movies can serve as a mark if it is not descriptive of the contents of the works.. **Characters**. Certain aspects of characters appearing in books, television, or movies are protectable under trademark law. These aspects include names and nicknames, physical appearances, and costumes. **Distinguishing Guises** (called **Trade Dress** in the U.S.) or combination of design features of a product is protectable as a trademark. Distinguishing guises protection rests in the overall features of a product, including its size, colour or colour combinations, texture, graphics, packaging, or other visual features. As with other types of marks, distinguishing guise must serve as a mark, that is, it must serve as an indication of the source of the product, either by being inherently distinctive or by having acquired secondary meaning.

4. Trade Names

A '**trade name**' or '**commercial name**' is any name used by a person or legal entity to identify its business or vocation. A trade name is distinct from a trademark in that the trade name is used to identify a business rather than to identify particular goods or services. However, the use of trade names and trademarks are necessarily linked: a trade name may also be a trademark or a service mark, if it is used to identify the source of products or services as well as to identify the business