



Selecting the Right Trademark

Businesses regularly file trademark applications without a clear understanding of how trademark law controls the selection of brand names. Applicants who rely on filing services or generic online resources will receive little, if any, guidance on trademark selection. As a result, applications are frequently refused, filing fees are lost, and brand protection is delayed. Does this sound familiar?

This Circular sets out a practical, step-by-step framework for selecting a trademark that is registrable and enforceable under U.S. trademark law.

STEP 1 - UNDERSTAND WHAT A TRADEMARK IS

Trademark selection must begin with an informed understanding of what a trademark actually is. A trademark is not a buzzword, a slogan, or a decorative phrase placed on merchandise for aesthetic appeal. Under [U.S. law](#), a trademark is “any word, name, symbol, or device, or any combination thereof” **that identifies the source of goods or services.**

A trademark serves as a source identifier. When consumers see a properly used trademark, they associate it with a particular business and with a consistent level of quality. By contrast, wording that merely decorates a product does not identify its source. The United States Patent and Trademark Office (“USPTO”) refers to that type of use as “ornamentation,” not trademark use. Here is an example of ornamentation provided by the USPTO:

A quote prominently displayed across the front of a T-shirt, such as “The Pen is Mightier than the Sword.” Most purchasers would perceive the quote as a decoration and would not think that it identifies the manufacturer of the T-shirts (the source of the T-shirts could be Hanes® or Champion®, for example, as shown by the neck label).

So, T-shirt creators, [beware](#).

The value of a trademark lies in its accumulated goodwill. As trademarks become recognized by the consuming public, they [accumulate goodwill](#). That goodwill can become extremely valuable. Well-known marks such as NIKE or MCDONALDS demonstrate how consistent use as a source identifier can create significant economic value. This is one reason careful trademark selection is critical at the outset.

STEP 2 - RECOGNIZE THAT NOT ALL TRADEMARKS ARE CREATED EQUAL

A common mistake made by trademark applicants is assuming that the best trademark is one that describes the goods or services. From a trademark law perspective, this approach is often incorrect. To be registrable, a trademark must be distinctive. Distinctiveness exists on a spectrum. Trademarks are generally classified into five categories, listed from strongest to weakest: fanciful, arbitrary, suggestive, descriptive, and generic.

Fanciful marks are the strongest and easiest to protect. They are invented terms created solely to function as trademarks. KODAK or XEROX are classic examples. The terms had no meaning before they were adopted as brands.

Arbitrary marks are existing words applied in an unrelated context. APPLE for computers is a familiar illustration. The word has meaning, but not in connection with the goods it identifies.

Suggestive marks imply a quality or characteristic of the goods or services and require imagination to make the connection. These marks can be registrable, but they often invite closer scrutiny. NETFLIX (streaming films), COPPERTONE (sunscreen), and AIRBUS (airplanes) are examples of suggestive trademarks.

Descriptive marks directly describe a feature, quality, or characteristic of the goods or services identified by the mark. These marks are ordinarily refused registration unless they acquire “secondary meaning.” Secondary meaning arises when consumers have come to associate the descriptive term with a single source through extensive use or exposure. AMERICAN AIRLINES and SPORTS ILLUSTRATED are examples of descriptive trademarks that have acquired secondary meaning. Some descriptive trademarks are “registrable” in the USPTO [Supplemental Register](#), which is a listing of in-use descriptive trademarks. Once a trademark listed in the Supplemental Register has acquired secondary meaning, it may qualify for registration in the USPTO’s Principle Register. How to determine when that occurs will be the subject of another Trademark Circular.

Generic terms are never registrable. A generic term is simply the common name of the product or service itself. Trademark law does not permit exclusive rights in language that others must use to describe what they sell. Even valid trademarks can lose protection if the public comes to treat them as product names rather than brand identifiers. This is what happened to “escalator” and “aspirin”. Having your trademark become “[genericized](#)” is a death blow to an owner’s trademark rights.

Once these categories are understood, trademark selection becomes more disciplined. Potential marks can be evaluated realistically before any filing decision is made. And best of all, you are less likely to lose your application fee by filing a trademark application for a mark that is not really a trademark.

STEP 3 - CONDUCT A TRADEMARK SEARCH BEFORE FILING

After identifying one or more potential trademarks, the next critical step is determining whether those marks are already in use by others. Trademark rights do not arise solely from registration. In the United States, businesses can acquire enforceable trademark rights simply by using a mark in commerce, often referred to as common law trademark rights. As a result, a mark may be legally protected even if it never appears in the USPTO database.

For that reason, a proper trademark search typically proceeds in stages. First, a **USPTO database search** is conducted to identify conflicting registered marks and pending applications that could block registration. Second, an **Internet search** is performed to uncover unregistered uses—such as business names, websites, or online branding—that may have priority based on earlier use. Finally, a **Comprehensive Clearance Search** may be conducted, reviewing federal, state, business, and digital sources. While no search is perfect, this multi-layered approach usually provides the best available measure of whether a proposed trademark is likely registrable.

When performing a trademark search it is necessary to understand that trademark similarity is not limited to identical spelling. Marks that look alike, sound alike, or create a similar overall commercial impression may be considered confusingly similar under trademark law. The “similarity analysis” is performed from the perspective of an ordinary consumer under real world conditions, not from the applicant’s point of view. For example, a company seeks to register the mark KWIK KLEAN for cleaning products while QUICK CLEAN is already in use. Although the spelling differs, the marks sound nearly identical and convey the same idea of fast, effective cleaning. From the perspective of an ordinary consumer encountering the marks in real-world condition, hearing them in advertising or seeing them briefly on packaging, the differences are likely to go unnoticed, creating a similar overall commercial impression and a likelihood of confusion.

The similarity analysis must also take into account the nature of the goods or services associated with the trademark. If the goods or services are the same and the marks are confusingly similar, there is a significant risk the your trademark application may be refused by the USPTO. The analysis becomes even more nuanced when the goods or services are not identical but are related in a way that consumers might reasonably assume they originate from the same source. Evaluating these issues often requires informed legal judgment rather than a simple side-by-side comparison.

Following these steps improves the likelihood that your trademark application is worth filing and will provide meaningful, enforceable protection. That said, no clearance process is foolproof. Trademark law is inherently fact-specific, and outcomes can turn on differences in judgment and interpretation. Even so, a thorough and informed approach puts your application in the strongest possible position for success.

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