

Drawing the Line Between Descriptive and Suggestive Trademarks

BY EDWARD J. HEATH AND JOHN M. TANSKI

Imitation may be the sincerest form of flattery, but that is little consolation to a business that has invested heavily in a trademark only to see a competitor subsequently use that same mark. If the business has chosen the mark because of its ability to emphasize a key characteristic of the product or service that the business offers, it may be in for even more bad news—the mark may be a “descriptive” one and therefore not sufficiently distinctive to warrant legal protection. On the other hand, if the mark is merely “suggestive” such that a mental leap is needed to connect the mark with the product or service, protection may be available. In theory, the distinction between “descriptive” and “suggestive” marks is clear. In practice, however, the line is a blurry one.

The Trademark Spectrum

The purpose of a trademark is to identify the source of a product. See *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). A competing mark that confuses consumers about the product’s origin is bad for business—and against the law. Section 43(a) of the Lanham Act protects even unregistered marks from trademark infringement. See 15 U.S.C. § 1125(a) (creating action in favor of person damaged, or likely to be damaged, by the use in commerce of “any word, term, name, symbol, or device, or any combination thereof” which “is likely to cause confusion”). Registration simply shifts the burden of persuasion from the party claiming infringement to the party opposing the claim. See *Two Pesos*, 505 U.S. at 768.

A trademark is supposed to distinguish a product and its source from other products in the marketplace. See, e.g., *Leelanau Wine Cellars v. Black & Red, Inc.*, 502 F.3d 504, 512 (6th Cir. 2007) (“Only those marks that are ‘distinctive’ as a matter of law are accorded trademark protection.”); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 226 (5th Cir. 2009) (“In a trademark infringement action, the paramount question is whether one mark is likely to cause confusion with another.”). For that reason, federal courts have created a sliding scale under which the degree of protection a mark receives depends on its distinctiveness. The five

categories are (1) generic marks, (2) descriptive marks, (3) suggestive marks, (4) arbitrary marks, and (5) fanciful marks. *Two Pesos*, 505 U.S. at 768 (1992).

At one end of the spectrum are generic marks, which receive no trademark protection. See, e.g., *E.T. Browne Drug Co. v. Cococare Prods.*, 538 F.3d 185, 191 (3d Cir. 2009) (“The Lanham Act . . . provides no protection for generic terms because a first-user of a term ‘cannot deprive competing manufacturers of the product of the right to call an article by its name.’”); *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 340 (4th Cir. 2009) (“‘Generic’ words . . . can never be valid marks under any circumstances.”). A generic mark is simply the common name of the product or the genus of which the product is a species. See *OBX-Stock*, 558 F.3d at 340. Examples of generic marks include “lite beer” for light beer, “Convenient Store” for convenience stores, and “Polo” shirts for polo shirts. See *id.* Such marks are unprotected because they cannot serve to identify the source of the product. As the Third Circuit has explained:

The jurisprudence of genericness revolves around the primary significance test, which inquires whether the primary significance of a term in the minds of the consuming public is the product or the producer. We ask whether consumers think the term represents the generic name of the product or service or a mark indicating merely one source of that product or service. If the term refers to the product (i.e., the genus), the term is generic. If, on the other hand, it refers to one source or producer of that product, the term is not generic (i.e., it is descriptive, suggestive, or arbitrary or fanciful). (*E.T. Browne Drug Co.*, 538 F.3d at 192 (internal alterations and quotation marks omitted); see also *Rudolph Int’l, Inc. v. Realys, Inc.*, 482 F.3d 1195, 1198 (9th Cir. 1997) (“The question of genericness is often answered by reference to the ‘who-are-you/what-are-you’ test: a valid trademark answers the former question, whereas a generic product name or adjective answers the latter.”))

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At the other end of the spectrum are arbitrary and fanciful marks, which are always subject to trademark protection. *Two Pesos*, 505 U.S. at 768. An arbitrary mark has a meaning that is recognized in everyday life, but that meaning is unrelated to the product or service with which the trademark is attached. See *Leelanau Wine Cellars*, 502 F.3d at 513 n.3. For example, “Camel” cigarettes, “Apple” computers, and “Shell” gasoline are arbitrary marks. See *id.*; *OBX-Stock*, 558 F.3d at 340. Fanciful marks are letters or numbers that have no significance other than to identify the product or service. See *OBX-Stock*, 558 F.3d at 340. Examples of fanciful marks include “Kodak” film and “Exxon” oil. See *id.* at 340. The only function of

these terms is to distinguish the source of the products with which they are associated.

In between these two extremes lie descriptive marks and suggestive marks, and the often blurry distinctions separating them are vital to understand. A great deal of trademark litigation revolves around whether a particular mark belongs in one of these two categories because the answer may dispositively affect the outcome of the case.

Establishing that a mark is suggestive means it is inherently distinctive and therefore subject to trademark protection. See *Two Pesos*, 505 U.S. at 768. Conversely, proving that the mark is descriptive may spell victory for the party opposing the claim of infringement because a descriptive mark is not protected unless it has acquired secondary meaning. See *id.* at 769. Secondary meaning can be difficult and expensive to demonstrate, as is discussed in the final section of this article.

It is no help that the categorization of a mark is a question of fact. See, e.g., *E.T. Browne Drug Co.*, 538 F.3d at 192; *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 118 (1st Cir. 2006). As a result, borderline questions are often resolved by a jury rather than by a court. Moreover, the outcome of a case can be affected by the burden of proof, which depends, in turn, on whether the mark is registered. Compare *Leelanau Wine Cellars*, 502 F.3d at 513 (“Registration of a mark on the Principal Register of the USPTO creates a rebuttable presumption that a trademark is valid, that is, either inherently distinctive or descriptive with secondary meaning, and therefore, protectable under federal trademark law.”), with *Rudolph International*, 482 F.3d at 1198 (“Where . . . an allegedly valid trademark has not been registered with the PTO, the plaintiff bears the burden of persuasion that the mark is [protectable].”).

Descriptive vs. Suggestive, by Definition

A descriptive mark “describes a function, use, characteristic, size or intended purpose of the product.” See *Two Pesos*, 505

U.S. at 769; see also *H-D Mich., Inc. v. Top Quality Serv., Inc.*, 496 F.3d 755, 759 (7th Cir. 2007) (“A descriptive term, by contrast, is one that names a characteristic of a particular product or service.”). Notably, “[a] descriptive mark is not a complete description, obviously, but it picks out a product characteristic that figures prominently in the consumer’s decision whether to buy the product or service in question.” *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 483 (7th Cir. 2007). A mark is likely to be found descriptive when “the mark’s dictionary definition corresponds with its meaning and context.” *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 232 (5th Cir. 2009). Other indicia include that “upon hearing the mark, one need not use imagination, thought and perception to reach a conclusion as to the nature of goods,” that “competitors would be likely to need the terms used in the trademark in describing their products,” and that “others have used the term in marketing a similar service or product.” *Id.* (internal quotation marks omitted). In that regard, a descriptive mark “is very similar to an adjective.” *Leelanau Wine Cellars*, 502 F.3d at 513 n.5 (quoting *Tumblebus, Inc. v. Cranmer*, 399 F.3d 754, 761 n.8 (6th Cir. 2005)) (internal alteration omitted).

Some the most obvious examples of descriptive marks use a geographic location to identify the product. For example, “Washington Talent Agency,” “OBX” (to designate North Carolina’s Outer Banks), and “Bank of America” are descriptive marks. See, e.g., *B&J Enters. v. Giordano*, 329 F. App’x 411, 417 (4th Cir. 2009); *OBX-Stock*, 558 F.3d at 340. Other familiar examples of descriptive marks include “Holiday Inn” to describe hotels, “All Bran” to describe cereal, and “American Girl” to describe dolls. *Custom Vehicles, Inc.*, 476 F.3d at 483.

A suggestive mark also employs terms that relate to the product’s characteristics or intended use. The difference, at least in theory, is that a consumer must make a mental leap to understand the relationship between a suggestive mark and the product. Courts have explained that “[s]uggestive marks connote, without describing, some quality, ingredient, or characteristic of the product.” *OBX-Stock*, 558 F.3d at 340; see also *Xtreme Lashes, LLC*, 576 F.3d at 233 (“A suggestive term suggests, but does not describe, an attribute of the good; it requires the consumer to exercise his imagination to apply the trademark to the good.”). A suggestive mark thus “requires the observer or listener to use imagination and perception to determine the nature of the goods.” *Leelanau Wine Cellars*, 502 F.3d at 513 n.3 (emphasis added).

Employing this understanding, the Fifth Circuit held that the mark “Extend Your Beauty” used in connection with synthetic eyelash extensions could qualify as a suggestive mark:

“Extend” describes a function of the product, but nothing in the dictionary definitions of “extend,” “your,” or “beauty” relates to eyelash enhancements. Beauty is an

abstract concept. One cannot literally extend it. . . . The mark's meaning and context have little to do with the dictionary definitions of its parts. The three-word mark, viewed as a whole, has no dictionary meaning or idiomatic resonance. Additionally, consumers must use imagination, thought and perception to conclude that an exhortation to extend your beauty markets eyelash extensions, as opposed to another cosmetically enhanced feature. (*Xtreme Lashes*, 576 F.3d 223)

The court remanded the case for a jury determination on this issue. *Id.* at 221. Other examples of suggestive marks include "Leggs" pantyhose and "Glass Doctor" window repair. *OBX-Stock*, 558 F.3d at 340.

But How Much of a Mental Leap Is Required?

In *Playtex Products v. Georgia-Pacific Corp.*, 390 F.3d 158 (2d Cir. 2004), then-Judge Sotomayor held that the mark "Wet Ones" was suggestive when used in the context of a moist towelette. Although she acknowledged that "Wet Ones is descriptive in the sense that each of the words describes an attribute of the product—it is wet and it is dispensed one by one," she explained that "the term 'Wet Ones,' without more, does not itself conjure up the image of a towelette. . . . Wet Ones . . . could plausibly describe a wide variety of products." *Id.* at 164; see also *BIC Corp. v. Far Eastern Source Corp.*, No. 99 Civ. 11385, 2000 U.S. Dist. LEXIS 18226, at *8 (S.D.N.Y. Dec. 19, 2000) (holding that "Wite-Out" is suggestive and explaining, "The name WITE-OUT could be descriptive of correction products in that most of the WITE-OUT products are white in color and used to take 'out' a mistake. However, although the name WITE-OUT is logically related to its use, the phrase without more does not imply a correction product.").

It is difficult to reconcile the result in *Playtex* with the conclusions reached by other courts. The Seventh Circuit, for example, categorized the mark "Work-n-Play" as descriptive when it was used for a van that could be used as a mobile office and for recreational purposes. *Custom Vehicles, Inc.*, 476 F.3d at 483. The Eighth Circuit held that the mark "Earth Protector" was descriptive "when used in conjunction with the products and services of an environmental organization." *Davis v. Walt Disney Co.*, 430 F.3d 901, 903 (8th Cir. 2005). And, according to the Fourth Circuit, "5 Minute" is a descriptive mark when used for glue products. *OBX-Stock*, 558 F.3d at 340. All of these marks identify a function, use, characteristic, or intended purpose of a product, but none by itself conjures up the image of the product it describes.

An argument can be made that the *Playtex* holding is an outlier because the categorization of the mark was "not seriously dispute[d]," perhaps because numerous "studies and surveys support [the] claim that Wet Ones is a well-established—indeed, famous—mark." *Playtex Products*, 390 F.3d at

164. The parties and the court may have recognized that "Wet Ones" was protectable regardless of whether it was an inherently distinct suggestive mark or a descriptive mark that had acquired secondary meaning, and therefore the true dispute in the case involved other issues. Still, the fact that a unanimous panel of the Second Circuit held that "Wet Ones" is a suggestive mark illustrates the difficulty of drawing the line between descriptive and suggestive.

And, although the categorization of "Wet Ones" was not dispositive in the *Playtex* case, the secondary meaning question is not so easily resolved in most other trademark litigation. Secondary meaning "occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself." *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (internal alterations and quotation marks omitted). For example, "Kentucky" fried chicken and "American" airlines are descriptive marks that have established secondary meanings in consumers' minds, causing consumers to recognize a brand or source of fried chicken or air travel, rather than the places, Kentucky and America. *OBX-Stock*, 558 F.3d at 340.

Courts examine a multitude of factors in determining whether a mark has acquired secondary meaning, including the following:

- (1) the extent of sales and advertising leading to buyer association;
 - (2) length of use;
 - (3) exclusivity of use;
 - (4) the fact of copying;
 - (5) customer surveys;
 - (6) customer testimony;
 - (7) the use of the mark in trade journals;
 - (8) the size of the company;
 - (9) the number of sales;
 - (10) the number of customers; and,
 - (11) actual confusion.
- (*E.T. Browne Drug Co.*, 538 F.3d at 199)

Establishing that a mark has acquired secondary meaning is therefore a laborious task that often involves expensive consumer surveys, extensive discovery, and expert testimony. The challenge of carrying this burden can dramatically affect the settlement value of a case.

As a result, the adjudication of whether a trademark falls on the descriptive or suggestive side of the distinctiveness scale is a critical moment in many trademark infringement cases. While it is easy to understand the difference conceptually, applying these definitions is often tricky at the margins, and predicting how a court will resolve the issue is similarly difficult. This built-in uncertainty may make clients whose trademarks fall in the gray area between descriptive and suggestive hesitant about mounting a defense of their marks. The best strategy is to counsel the client about these issues before the investment is made in a weak mark. ■

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