



## What Should I Call My Underwear? A “Brief” Analysis of the Strength of Trademarks

A recent, clever [commercial for Fruit of the Loom “Breathable Underwear”](#) (click on the link to view video) concisely illustrates a common problem encountered by the marketing departments of many companies when it comes to selecting a new trademark. The commercial begins with two men who appear to be marketing employees in an office standing next to a wind tunnel containing the company’s “Breathable Underwear” product. One man comments that the new “Breathable Underwear” product is perfect, and the other responds that it needs a name just as perfect. The two then begin tossing around a number of creative suggestions for product names for the underwear, including:

- Cool’s Gold
- The Pants Snorkle
- Brrrr-iefs
- House of ‘Mesh’representatives
- Shiver Me Trousers
- Pant’arctica
- Fruit of the Luge
- Mr. Meshy goes to Windington
- Breezy Fo’ Sheezy

The two marketing guys appear to settle on the last name, “Breezy Fo’ Sheezy,” but then a voiceover

cuts them off, saying, “No, we’re going to call them “Breathable Underwear.”

In reviewing this commercial and evaluating which of the proposed names would be the best trademark under U.S. law, it is remarkable that every other potential name for the product that was floated is likely better than the one that was eventually selected. This is so because the name “Breathable Underwear” probably cannot function as a trademark at all. It is just not distinctive in any way. Moreover, trademarks usually cannot consist of a word or words that describe an aspect or characteristic of the product. Thus, it would be difficult for Fruit of the Loom ever to stop another underwear manufacturer from using the same words, “Breathable Underwear,” as a name for a competing product.

It’s a very common scenario that often confronts both in-house and outside trademark counsel. The problem stems from the obvious fact that the more unusual and distinctive a trademark is, the less likely it is that it will immediately convey information about the product or service to consumers. And very often, the folks in the marketing department of a company or its outside ad agency will come up with potential trademarks that do just that—convey too much information and

describe an obvious and desirable aspect or characteristic of the product. In doing so, they have probably doomed these trademarks because they forever will be inherently weak and difficult to enforce.

Courts today in trademark cases routinely use the distinctiveness spectrum developed by the United States Court of Appeals for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) to determine the degree of protection that should be afforded to a trademark. In order of increasing distinctiveness, the five categories on the *Abercrombie* spectrum are: (i) generic; (ii) descriptive; (iii) suggestive; (iv) arbitrary; and (v) fanciful.

A generic word can never, ever function as a trademark. *Abercrombie*, 537 F.2d at 9. Some examples of generic marks are “Wood” for lumber or “Aspirin” for acetylsalicylic acid. A descriptive term is one that “conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *Id.* at 10-11. Some examples of descriptive marks include “Tasty” for bread, or “Shatterproof” for glass. Descriptive marks are not inherently distinctive; that is, they do not identify a particular source. Therefore, they can receive protection only if they have acquired something trademark lawyers call “secondary meaning.” A mark owner establishes this secondary meaning by showing that people identify the mark with a particular source. Of course, it can take many years and require millions of ad dollars to establish secondary meaning for a descriptive trademark in the minds of the public. Indeed, it may never happen.

Despite the inevitable problems with protecting such trademarks, the marketing departments of many companies tend to propose trademarks that are very descriptive. The reason for this tendency is that because the trademark immediately conveys a great deal of information about the product, it makes it much easier to craft advertisements and marketing campaigns. Like generic terms, however, descriptive terms are often in wide use by others on similar goods, and it would be unfair to allow any one company the exclusive use of words that describe products or services. In the Fruit of the Loom commercial, the name “Breathable Underwear” is highly descriptive because it conveys an immediate idea of the most desirable characteristics of the product. Why shouldn’t a

company that develops a product with similar characteristics be able to use those same words to accurately describe a characteristic of its competing product? The answer is they probably can, because “Breathable Underwear” is very weak and unlikely to receive much protection as a trademark.

In contrast, suggestive, arbitrary, and fanciful marks start out strong from the start. A suggestive mark “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” *Abercrombie*, 537 F.2d at 10-11 (quoting 3 Callmann, *Unfair Competition, Trademarks and Monopolies* § 71.2 (3d ed.)). Examples of suggestive marks are “Coppertone” for suntan lotion and “Chicken of the Sea” for seafood. Because a suggestive mark is deemed inherently distinctive, it is automatically entitled to protection without proof of secondary meaning. A business selecting a new trademark would do well to aim for coining *at least* a suggestive mark.

The greatest level of protection is afforded to arbitrary and fanciful marks. Arbitrary marks typically consist of a common word applied in an unfamiliar way. *Abercrombie*, 537 F.2d at n. 12. Examples of arbitrary marks include “Apple” for computers and “Amazon” for online retail services. Fanciful marks typically consist of “words invented solely for their use as trademarks.” *Id.* Examples of fanciful marks include “Kodak,” “Ginsu,” and “Exxon.”

Below are a few guidelines to help you avoid selecting weak trademarks:

## **Don’t Pick Words or Phrases that Cannot Be Registered**

There is no point in investing in a trademark that you can’t register. Registering the trademark protects it from competitors, ensures your ownership rights in the mark, and makes it easier to enforce your rights in court.

## **Avoid Purely Descriptive Words**

As discussed above, words that describe the characteristics or aspects of the goods or services sold with the trademark are usually weak and unregistrable.

## Avoid Surnames

Surnames usually cannot be registered as trademarks, and if they are, they are often extraordinarily weak. A good rule of thumb is that if there are three dozen instances of it in the phone book, pick another trademark.

## Avoid Confusing Trademarks

A trademark that is confusingly similar to a registered trademark cannot be registered. Hence, the mark “Sunscreen” for use in connection with a newspaper could not be registered if the trademark “Sun-Screen” has already been registered in connection with a magazine, or other periodical, because of the inevitable consumer confusion that would result.

## Avoid Laudatory Words

The goal is to select a trademark that is as distinctive as possible. Thus, avoid laudatory words. Examples include “Best,” “American,” “Gold,” and any number of others. These words are quite commonly used when trying to sell products and services, and if incorporated into a trademark, they ensure that your company will blend into the crowd, not stand out in front of it.

## Avoid Three- and Four-Letter Acronyms and All Numbers as Trademarks

IBM, CNN, and ATT are distinctive trademarks because their respective owners spent tens of millions of dollars into making the marks famous. But acronyms are intrinsically difficult to remember, while words, especially colorful words, are easily remembered. Hence “OVS Software Solutions” is not as memorable as “Adobe Acrobat.” Likewise, avoid using numbers in a trademark as they tend to be less memorable. Furthermore, there are a limited number of unused acronyms available, so there is an excellent chance that a company’s ABC trademark will be confused with someone else’s.

## Do Use Invented Words

Invented words are words that do not exist in any language, apart from your trademark. Examples include “Ginsu,” “Exxon,” “Kodak,” and “Viagra.” Invented words are a good choice for use as trademarks because they are not descriptive and they tend to be quite distinctive. It is even possible to create an invented word by simply combining parts of other words—for example, “Microsoft.”

## Try Animal or Plant Names

Animal and plant names tend to be quite memorable and, if used appropriately, can convey a positive image while still being distinctive. “Apple” Computers, “BlackBerry,” and Ford “Mustang” are good examples.

In sum, don’t get caught with your pants—or worse, your “breathable underwear”—down. Spend the necessary time and effort at the start to choose a trademark that will work for, not against, your company. Choosing a distinctive trademark may mean more work and creativity at the outset, but doing so will pay great dividends for years to come. On the other hand, choosing a descriptive trademark almost certainly will bring on headaches for you in protecting and enforcing your trademark.

## Lawyer Contacts

For further information, please contact your principal Firm representative or one of the lawyers listed below. General email messages may be sent using our “Contact Us” form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

### Timothy P. Fraelich

Cleveland  
+1.216.586.1247  
[tfraclich@jonesday.com](mailto:tfraclich@jonesday.com)

### Mary A. Hyde

Chicago  
+1.312.269.1556  
[malexanderhyde@jonesday.com](mailto:malexanderhyde@jonesday.com)

### Carrie L. Kiedrowski

Cleveland  
+1.216.586.7129  
[clkiedrowski@jonesday.com](mailto:clkiedrowski@jonesday.com)

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