



The Abercrombie Formulation: Generic, Descriptive, Suggestive, Arbitrary and Fanciful Marks

The Lanham Act, the federal trademark statute, protects marks that perform source-identifying functions. Specifically, under the Lanham Act, a person must use or intend to use a mark to "*identify and distinguish* [his or her goods]...from those manufactured or sold by others and to *indicate the source* [of the goods]." In essence, trademark law places a premium on marks that are distinctive.

The Abercrombie Test

Following the "classic formulation" set forth by a federal appeals court in *Abercrombie & Fitch Co. vs. Hunting World, Inc.*, courts frequently classify marks into five different categories. In order of generally increasing distinctiveness, these categories of marks are: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful.

Generic Marks: Ineligible for Protection

According to the *Abercrombie* court, "a generic term is one that refers, or has come to be understood as referring, to the genus [or class] of which the particular product is a species." To cite the court's example, "Ivory" would be generic when used to describe a product made from the tusks of elephants. Generic marks can never be protected as trademarks.

Descriptive Marks: Eligible for Protection Only if Accompanied by Secondary Meaning

"A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." Descriptive marks are not inherently distinctive; i.e., they do not identify a particular source. As such, they can only be protected if they have acquired "secondary meaning." According to the U.S. Supreme Court, "secondary meaning is acquired when in the minds of the public, the primary significance of a product feature...is to identify the source of the product rather than the product itself."

Various courts have cited the following examples of descriptive marks: "Tasty" bread; "Trim" nail clippers; and "Car Freshener" deodorizer.

Suggestive Marks: Automatically Eligible for Trademark Protection

The *Abercrombie* court described a suggestive mark as one that "requires imagination, thought and perception to reach a conclusion as to the nature of the goods." In other words, a suggestive mark will tend to connote a characteristic of a product, and thereby enable a consumer to infer something about the product from the mark. Because a suggestive term is deemed inherently distinctive, it is automatically entitled to protection

(i.e., without secondary meaning). "Chicken of the Sea" and "Coppertone" are examples of suggestive marks.

Arbitrary or Fanciful Marks: Automatically Eligible for Trademark Protection

According to the *Abercrombie* formulation, fanciful marks typically consist of "words invented solely for their use as trademarks." For example, "Kodak" and "Clorox" are fanciful marks. However, "when the same legal consequences attach to a common word, i.e., when it is applied in an unfamiliar way, the use is called 'arbitrary.'" An example of an arbitrary mark is "Apple" for computers.

Both arbitrary and fanciful marks are completely unrelated to the goods they adorn. However, while an "arbitrary" mark is typically well-known in a different context, a "fanciful" mark is newly invented. Like suggestive marks, arbitrary and fanciful marks are deemed inherently distinctive, and are automatically entitled to trademark protection.

Illustration

A federal appeals court set forth the following example to illustrate these legal concepts: "The trade name 'Pet Store' for a shop that sold pets would be generic. The word 'penguin,' by contrast, would be descriptive when used in the name of a shop that specialized in items relating to a certain polar species; suggestive when denominating an air conditioning company; and arbitrary when the name of a book publishing company. (If the book publisher wanted a fanciful mark, it could use a made-up word, like 'Penquell.')