

HOW TO USE TRADEMARKS PROPERLY

Owning a trademark comes with some responsibility. In exchange for the right to exclude others from using a mark, the owner must ensure that the mark will indicate to the consuming public consistent quality and source of the goods/services with which a mark is associated. Once rights in a mark are established, either through obtaining a federal registration or through use of the mark in commerce, the owner must KEEP those rights. Failure to use a mark properly or to prevent others from using a mark improperly or in an infringing manner can result in a mark owner's loss of rights.

Proper use of your trademark (or service mark) is necessary to both establish and maintain your trademark rights. Sometimes a trademark can become less distinctive through misuse. It can even become generic if others begin using the mark as if it were the proper name for the type of good or service sold, as was the case with the formerly valuable marks, ESCALATOR, ASPRIN, and CELLOPHANE. Your management and control over how the mark is used will determine to a large extent whether or not you will be able to preserve your rights in a mark. Proper use of your mark will clarify that the mark is a brand and not a type of product. What's more, failure to use your mark properly can be used against you in court, in the event your challenger claims the mark is not distinctive. This can happen when the court views your own misuse of your mark as an admission that you did not consider the mark your proprietary property in the first place.

The following rules will help you establish trademark rights, and prevent problems that can erode the enforceability of your trademark rights, once established.

What is a trademark

Before discussing how to use a trademark, we should probably talk about what a trademark is. A trademark can be a word, name, symbol, color, smell, sound, device, or any combination thereof which is used to identify and distinguish the goods or services of one company from the goods or services of another. In order to qualify as a trademark, the mark must be used in federally regulated commerce, and the mark must be distinctive. Fanciful, arbitrary, and suggestive marks are inherently distinctive, while descriptive marks are not distinctive unless used extensively enough to develop a certain level of market awareness, called secondary meaning or acquired distinctiveness. In a nutshell, the distinctiveness requirement means that a mark cannot describe the underlying product, or if it does describe the product, the mark must have developed secondary meaning in the marketplace. Moreover, some marks will not be protected as trademarks, even if they are well recognized by consumers as trademarks. Such "forbidden marks" include: (1) generic marks; (2) immoral, disparaging or scandalous marks; (3) marks which are primarily functional; (4) marks that are merely surnames; and (5) deceptive marks.

"Affix" the trademark to the goods or services provided

Affixing your trademark to goods and services is necessary in order to demonstrate that a mark is used in commerce, which is a fundamental requirement for trademark ownership in the United States. For a trademark to be "affixed" to goods, the mark should ideally be either placed on the goods themselves, or on their containers or attached tags or labels. The affixation requirement for goods may also be satisfied if the mark is prominently featured on a conspicuous display associated with the goods. If none of the above is possible, the mark may be used on documents associated with the sale of the goods, as a last resort. For services, a trademark is "affixed" if it is used in the sale or advertising of the services, as long as it is used in direct and explicit reference to the services provided.

Always use the mark as an adjective

It is very important to always use the mark as if it were an adjective, and never use it as a noun or a verb. For example, do not allow marketing material to read, “AURORA is the best cat litter on the market.” Instead say, “AURORA brand cat litter is the best on the market,” or even “AURORA cat litter is the best...” Similarly, makers of the XEROX brand copier probably cringe when they hear people say they are XEROXING instead of saying they’re making copies on the XEROX copier. These tips may seem like ridiculous distinctions to some; however, the consequences for dismissing this advice are great. If your mark is challenged on the basis that it is generic, you will have a much harder time arguing that your mark is not generic when you have treated your mark as if it were a class of goods, rather than a single brand in a class of goods.

Set the mark apart from surrounding text

You should italicize, underline, capitalize and/or bold the mark when it appears in text (at least the first time) in order to set it out from the generic word for the product. This helps maintain the distinctive nature of a mark in the minds of consumers.

Provide notice next to your mark whenever possible

The symbols ®, TM and SM provide notice to the world that you are claiming trademark rights in any mark using these symbols. You may use the TM on marks identifying goods, and the SM on marks identifying services. You need not have a federal or state registration to use the TM or SM symbols. However, the ® symbol, which provides “statutory notice” can only be used if your mark is federally registered on either the Principal or Supplemental Registers maintained by the USPTO. Again, if you fail to notify the public that a particular word, phrase or symbol is your proprietary property, you will have a very hard time convincing a court of the same. More importantly, perhaps, by providing notice next to your mark, you’re alerting the world to your claim of right, and will deter others from innocently adopting similar symbols for their products.

Avoid plural or possessive forms of the mark

Never use a mark in the plural form, for instance NIKES or REEBOKS. In these examples, the plural form encourages the public to view these marks as if they were synonyms for shoes. A possessive form, such as NIKE’s or REEBOK’s is similarly problematic.

Don’t dissect the mark by abbreviating

If your mark contains more than one lingual or graphic component such as TOY HAVEN, use both words instead of referring to the company as the HAVEN. Dissecting trademarks can cause them to lose their distinctive quality in the minds of consumers.

License and assign the mark properly

Improper licensing and assignment of trademark rights can result in loss of rights associated with that mark. Even through licensing and assignment, the mark must indicate to the consuming public a consistent quality and source of goods/services.

Use the mark

Trademark rights can be forfeited through a mark owner’s failure to use the mark without the intent to resume use of the mark. Three consecutive years of non-use establishes the presumption that the

owner did not intend to resume use. Token or nominal use is not sufficient to ward off abandonment through non-use.

Watch how others use the mark

The manner in which third parties use the trademark owned by another can affect the mark owner's rights. The most glaring example is the generic use of a mark by third parties resulting in the owner's loss of rights in the mark. Mark owners should keep a watch on use of their mark in industry. Mark owners can even launch corrective advertising campaigns to re-educate the consumers that the term is a trademark and not the generic term for a particular good or service.

In order to ensure that a mark continues to indicate the owner ONLY as the source of the goods/services with which a mark is associated, mark owners should "police" their marks. At a minimum, a mark owner should periodically check the records of the United States Patent and Trademark Office for applicants seeking to register similar marks and watch for common law uses of similar marks (e.g., review trade magazines)..