

APPROPRIATE USE OF TRADEMARKS

Trademark rights gain value through proper use and, conversely, can be lost through improper use. A few guidelines relating to proper use are set out below. We encourage you to discuss these guidelines along with any questions with us, since each client's situation can be different and specific advice must be geared to the facts and circumstances of each case.

1. Give Notice that the Mark Is a Trademark

When printed, trademarks should be accompanied by a symbol indicating that the mark is claimed as a trademark. In fact, failure to give notice that a Federally registered mark is a registered trademark can reduce or even eliminate the opportunity to obtain damages in cases of infringement.

2. Use the Special Federal Registration Symbol or Abbreviations to Give Notice of Federally Registered Marks

For Federally registered marks, the registration symbol or other specific words indicating the Federally registered status should be used in close association with the mark. Most commonly, the registration symbol ® is used and is placed immediately adjacent the mark itself. The usual placement for such a symbol is on the right "shoulder" of the mark, i.e. immediately following, and slightly above, the last letter of the mark. Nevertheless, the symbol may be placed in any position close to the mark and need not be obtrusive or detract from the appearance of the mark or its surroundings in any way, as long as it is legible. The longer formal notices, "Registered U.S. Patent and Trademark Office" and "Reg. U.S. Pat. & Tm. Off." may be used instead, and typically appear as footnotes but again may appear in any position that clearly is associated with the mark and that is legible.

3. Different Language Must Be Used for Marks that Are Not Federally Registered

It is unlawful to use the Federal registration symbol or words claiming Federal registration status unless the mark actually has been issued a Federal trademark registration covering the goods or services in connection with which the mark is presently being used. (Merely filing an application for Federal registration does not constitute registration.) As a result, different language must be used to give notice of marks that are not Federally registered. For unregistered marks and for marks registered only at the state level, either the symbol TM or, for service marks, SM may be used. The word "brand" also can be used immediately following the mark to indicate that a name is considered a trademark. Depending on the design or purpose of a communication, other means of designating a trademark may be appropriate. Wording such as "XYZ is a trademark of ABC, Inc." is appropriate

where space permits, most commonly positioned like a footnote and linked to the mark with an asterisk. Other appropriate statements of similar effect also may appear as footnotes. For a line of products, a phrase such as “Part of the ABCTM Family of Products” may be used. Various other creative treatments may be acceptable, as long as they convey the message that the mark is considered a trademark of its owner, and if appropriate, that it has been registered.

4. Consult Counsel Before Using Trademark Notices on Products and Literature Shipped into Foreign Countries

In many foreign countries, it is illegal to include trademark notices on products and advertising literature unless the mark is registered in that country. Consult us for details if your products will be shipped outside the United States.

5. Distinguish the Mark from Surrounding Text

A trademark’s distinctiveness should be emphasized not only by the use of appropriate notices when permissible, but also by setting the mark apart from the material around it. This can be accomplished either by capitalizing its letters, setting it in a different typeface or color or otherwise changing its appearance to distinguish it from the surrounding text. To maximize a mark’s distinctive identity, a particular style should be adopted and used consistently.

6. Treat the Mark As a Trademark, Not As a Noun

A trademark identifies a particular *brand* of a certain type of product. Thus, trademarks ordinarily should be treated grammatically as proper adjectives. Preferably, the generic term for the product or service will be used in addition to the trademark (e.g., “CHOCOHOLICTM Cookies”) to demonstrate that the trademark is not the generic description of the product and to show the public how to describe the type of product when reference to the trademarked brand is not intended. At any rate, a trademark should not be used as a noun, or in a plural or possessive form, or abbreviated, or with a different spelling or punctuation, or changed in any way that might suggest that it is a generic term susceptible of grammatical adjustment. This is especially important when the mark is used for a new type of product, since the public does not yet know a generic term to use and may think the mark serves that function.

7. Be Careful: Allowing Generic Use Of A Mark Can Result In Loss Of Rights

If a trademark is used generically, then the public may come to regard the mark as aptly descriptive of the entire class of similar products. In that case, the mark loses its ability to distinguish one brand from another and no longer is capable of functioning as a trademark. *Aspirin* was once a trademark of the Bayer Company; *cellophane* and *elevator* were also once trademarks. In each case, they were used generically and lost their trademark significance; their former owners saw competitors adopt the same words to describe their competitive products, and were unable to prevent that use. For this reason the maker of Xerox products adopted an extensive ad campaign for XEROX® photocopiers that focused exclusively on telling the public that XEROX is a trademark and not a substitute term for “photocopier.” Proper, consistent trademark usage from the beginning can help avoid the need to conduct such corrective campaigns later on, and avoid loss of trademark rights.

8. Retain Quality Control When Licensing The Trademark

A strong trademark is frequently a marketable trademark. The owner of a valid trademark not only can use the mark, but also can license others to use it. Because the trademark is a quality symbol, its owner *must* maintain control over the quality of the goods or services with which the mark is used. If quality control is not retained, the trademark rights may be deemed abandoned. It is important that license agreements be in writing; and that they include appropriate language covering quality control aspects of the relationship. If you are considering licensing your mark, consult us for advice.