

Attention Business Owners: Are Your Marks Protected?

Article

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One of its most obvious, but often overlooked, assets that a business has is the very name that the business uses to hold itself out to the public. That name, including the names of various products and services it may market, are valuable assets of that business and need to be treated as such. Most business owners do not realize it, but the names ASPIRIN, CELLOPHANE and ZIPPER each started out as a name associated with a business that marketed a very successful product. The products were so successful, however, that the unique name given to each of the products eventually became associated as the product itself. In the world of trademarks and service marks (collectively referred to here as “marks”), this is affectionately known as “genericide.” Generic marks are not protectable in the marketplace.

So, what should you do with your business name which has, through use, become a mark for your products or services? Keeping in mind that your mark may be a name, a logo, a logo with a name, a phrase, a slogan, or a myriad of other visually and verbally perceptible items, you need to step up and take measures to protect that mark.

One of the first steps is to make sure that you are using the mark properly. Never use your mark as a noun. Always use it as an adjective. For example, Xerox Corporation is very protective of the XEROX® mark and never, ever, wants to see the public referencing its copiers or the copies that the machine makes as a “Xerox.” It should always appear as a “Xerox® brand copier” or as a “Xerox® copier.” To do otherwise is the death knell for a mark, the first step towards genericide of that mark. In this regard, be diligent about reviewing company advertisements and brochures. And make sure that your marketing department understands and carefully adheres to these rules.

Another way to properly use your mark is to associate the notations “TM” or “SM” with your mark. Though not required, use of such notations is recommended and puts the purchasing public on notice that your business claims trademark or service mark rights, respectively, in the mark. If your mark has been federally registered, and we’ll talk about that later, you can also associate the notation “®” with your mark. You should also protect your mark by “policing” it. That is, you should police the marketplace from time to time, keeping your eyes and ears vigilant for marks that are “confusingly similar” to yours. In the age of the internet, this can be a relatively easy task. If you come across a potentially

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conflicting use, consider notifying the potential infringer of a problem by using a “cease and desist” letter. If such a letter does not bring about the desired result, prompt legal action may be taken, including injunctive relief to stop the infringing activity.

Lastly, you should seriously consider federal registration of your mark with the United States Patent and Trademark Office (the “PTO”). The process is relatively painless and well worth the time, effort and resources to pursue. A duly registered mark is given a presumption of validity in court and affords certain legal remedies to the owner that are not available for marks that are not registered. As mentioned earlier, a federally registered mark also enjoys the privilege of associating use of the “®” notation with the mark, which use can only be made with permission of the PTO. The process, which starts with the preparation of the application paperwork is rather straight forward but is fraught with pitfalls for the unwary. For example, in attempting to register the mark FREEWAY LEATHER for a line of clothing for motorcyclists, one would want to avoid use of the word “leather” in the identification of goods. Use of that word could render the mark “merely descriptive” of the goods to which the mark applies. In processing the registration application, it is recommended that you consult with someone who works with the PTO on a regular basis.

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