

PROTECT YOUR IMAGE

by Victoria Brown, Primmer Piper Eggleston & Cramer PC

A company's intellectual property can be a valuable asset, and smart companies large and small take care to protect it. This column focuses on trademarks and provides practical tips on selecting a trademark, obtaining protection for it through registration, and monitoring its use to prevent loss of trademark rights.

Select a strong mark

A company can get a head start on trademark protection by choosing a strong mark. All trademarks fall on a continuum of distinctiveness; more distinctive marks are generally considered to be stronger. Weak trademarks include what we call "generic words," which simply name things, and "descriptive words," which merely describe some characteristic of the goods or services (e.g., "warm and fuzzy" for socks, or "top quality" for just about anything). Generic words cannot function as trademarks, and descriptive words can function as trademarks only if, through widespread use and promotion, they have become associated in the minds of consumers with a particular company (e.g., "Beer Nuts" for salted nuts).

At the other end of the spectrum are "arbitrary" or "fanciful" marks. Arbitrary marks use common words in an unusual manner – Small Dog for electronics or Apple for computers. Fanciful marks are made up: Kodak or Xerox are two famous examples. These marks are considered "strong" because it is unlikely that someone else will select a similar mark for a competing product or service. However, such marks may not serve the business need to tell the consumer about the product – at least not without extensive marketing efforts.

Thus, the most common trademarks fall into a middle category of distinctiveness: "suggestive" marks. These terms convey something about a product or service but do more than merely describe it. For example, Coppertone for suntan oil suggests something about the product but does not describe it. The closer a mark is to the distinctive end of the spectrum, the stronger it is.

Protect your mark through federal registration

Many people are surprised that registration at the U.S. Patent and Trademark Office is not necessary for one to claim rights in a trademark. The so-called “common law” recognizes trademark rights as soon as a company holds the mark out to the public in connection with particular goods. Federal registration, though, offers procedural advantages, including access to federal court for enforcement. Registration also provides a company with a palpable asset — the registration certificate — which may have more value to a potential buyer than a mere common-law right. Federal registration can be relatively simple and inexpensive, and a company with a mark that is important to its success should register it.

Use your mark properly

A trademark should be used as an adjective to describe the goods or services, not as a noun. If a trademark is used as a noun, it may be considered the generic name for its goods/services. If Band-Aid brand plastic strips are called “band-aids,” over time the term loses its status as a trademark and becomes available for anyone to use.

Whenever possible, use the ® identifier for a mark that has been federally registered. For a mark that is not yet registered, use the designation SM for a service mark (i.e., a mark used to promote services) or TM for a trademark (i.e., a mark used with goods). These designations declare to the world that the mark belongs to you.

Police your mark

Having chosen a strong mark, obtained protection, and ensured its proper use, be vigilant to ensure others do not use a confusingly similar mark and either trade on or erode the good will that you have accrued. “Watch” services are available that, for a fee, will monitor various publications and alert you of possible infringing uses. Short of that, periodic Internet searches and simply being attentive can alert a company to an infringing use.

If you discover an infringing use, a “cease-and-desist” letter from an attorney can be effective. Some cases are better resolved through a low-key contact to the infringing party to announce that you are aware of the use and to ask that the

infringement be stopped. It is important to do sufficient due diligence, however, to be sure that the infringing use occurred after your use. Otherwise, they may simply turn the tables, declare you to be the infringing user, and demand that you cease use. •

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