

INTRODUCTION TO TRADEMARK LAW: PROTECT YOUR BRAND IDENTITY AND REPUTATION

Our world is a trademarked world. Trademarks are all around us. In newspapers and magazines, on the Internet, in radio and television broadcasts - trademarks can be found virtually in every commercial medium. The business purpose of trademarks is to help customers differentiate one particular company's goods or services from similar or even identical ones offered by competitors, and thereby enable the consumer to choose one product or service from among the many in the marketplace. Very often customers will choose goods or services based on brand recognition alone. This may be because it is the "tried-and-true" - trusted - item, because it comes highly recommended, often just because the brand is fashionable. The result is that certain brands can quickly become more popular than others.

First, what exactly are trademarks? A "mark" may be a word, symbol, design or any combination thereof which serves as a unique source identifier of a particular good or service. The success of a mark is directly related to its recognizability in the market place. As suggested above, the most successful marks of all have become frequently used in conversation and easily recognized in the marketplace.

The ownership and identification of a mark should be indicated by specific symbols. The ® indicates a mark that has been registered with the United States Patent and Trademark Office. Superscripted capitals TM or SM indicate that an entity is claiming common law ownership of the device as a

trademark or service mark and may have a pending application for registration.

Second, what is the legal purpose of marks? The primary right is exclusive use thereof to identify the source of a good or service. It is a right to stand out from the competition, to build a reputation, market and customer goodwill based on the mark and everything it represents (e.g., quality, reliability, trust, etc.). If the mark is registered, it confers the right to prevent others from using the same or confusingly similar mark in connection with specific goods or services across the entire United States. These rights may last as long as the mark is used in commerce.

As powerful and long-lasting the rights conferred by trademarks are, they must be used properly and protected or they can be weakened or lost entirely.

Before a company adopts and starts using a trademark, a trademark attorney should do a preliminary on-line search to investigate whether the selected mark is infringing on anyone else's common law, state or U.S. federal registration(s). The attorney should then report the findings and give an opinion regarding each mark.

If the desired mark is clear after the preliminary search, a full search in at least the U.S. should definitely be performed for each mark. A full search covers federal and state registration and possible use and appearance of the mark, including common law rights and pending federal applications. Assuming that the search clears the way for use and registration of the mark, an application either for an existing use or an "intent-to-use" should be filed with the United States Patent and Trademark Office. If appropriate, applications can also be filed at state and international levels. Registration does not follow automatically upon

application; the trademark attorney may need to amend the application and negotiate with the appropriate trademark office handling the application.

Finally, the trademark attorney will help protect the mark by policing third party uses of the mark. He will keep watch on other pending applications for registration to ensure that the marks are not confusingly similar—and will take steps to prevent the registration if they are. The trademark attorney may register the mark with the Customs Service to prevent third party goods from entering the United States that contain infringing uses of the mark.

The trademark owner can also take steps to protect the trademark. The first important step is to make everyone aware that the mark is indeed a mark, and should be treated as such. This is accomplished by using the appropriate symbol (e.g., TM, SM or ®) when the mark is used in print, on Internet websites, in banners, in advertisements, etc. Further, the owner must ensure that the mark is used correctly. For example, the mark should always be used as an adjective that modifies a noun, never as a noun or a verb. The mark should always clearly stand out, whether through use of capitals, a different font or color than surrounding text, etc.

Are there disadvantages to not registering the mark? Absolutely! If a company does not register, it may lose priority rights of use. It may also lose valuable time that should have been spent strengthening the trademark rights. Limitations may occur on the expansion of the use of the mark geographically. There may even be limitations on the goods or services that the mark may be used in connection with. So don't restrict your business or endanger your business reputation: call your trademark attorney today!

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