



The Dos and Don'ts of Trademark Registration

John Boger, Esq.

Heslin Rothenberg Farley & Mesiti P.C.

Companies invest heavily to obtain trademarks that are to be used with their products or services. The investment of time and money into a comprehensive branding strategy to build goodwill may take a significant hit if the respective trademarks are not properly used and noted. Unfortunately, this behavior of misuse may only be discovered when the time comes to file appropriate documents with the trademark office at the five-year use declaration date, upon the ten-year renewal anniversary or worse, if your mark is challenged post-registration. This article serves to suggest best practices regarding a company's use of its trademarks.

Congratulations! Your company just received the Registration Certificate for your new trademark. Now what do you do? A best practice would be to create an instructional guideline on its proper use and share this with marketing, sales and communications departments. Here are points to be discussed:

1. Always use the trademark as an adjective, e.g., KODAK film, KLEENEX tissues
2. Never use the trademark as a noun, e.g., "Tic tacs" in place of TIC TAC candies
3. Never use the trade mark as a verb, e.g., "Googling" rather than performing a GOOGLE website search
4. Never change the trademark to plural form, e.g., "Fig Newtons" instead of FIG NEWTON cookies
5. Never use the trademark in possessive form, e.g., "Wrangler's" jeans instead of WRANGLER jeans

Additional tips to include in the "use" guideline are:

1. Always distinguish the trademark from the surrounding text. Techniques for distinguishing the mark include use of the ® or ™ super script symbols; use all capital letters for the mark; use a bold or italic font or place the mark between double quotation mark.
2. Use the mark consistently. For example, always include with a space or without a space, establish consistent use of hyphens. An example of this is COCA-COLA beverages, not COCACOLA beverages.

The guideline should provide directions on proper trademark marking. Marking is the acceptable or legally allowed designation to identify a word, logo, slogan or design as a

trademark. How is this accomplished? If the mark has been registered with the U.S. Trademark Office, the ® symbol should be placed to the upper right of the word or design. Please remember, the ® symbol can only be used after a Federal Registration Certificate has been issued. Alternative markings for registered marks may include using the words "Registered, U.S. Patent and Trademark Office" or the abbreviated "Reg. U.S. Pat. and Tm Off" next to the mark or noted as a footnote. If the trademark has not gained registration, one should use either the super script ™ (for use with trademarks associated with goods offered for sale by a certain source) or ℠ (for use with service marks that are associated with services being offered for sale by a certain source).

These two designations should be used when a company begins to use the trademark or service mark in commerce, but before it is registered. It is good practice to use these notations immediately, as this provides notice to the public that the owner is using these marks as a trademark and intends to claim trademark rights to the respective word, symbol or logo. It is very important in the U.S. to utilize the ® symbol when permitted, because this will be deemed as providing proper notice to third parties of the existence of your registered trademark. Failure to provide this notice may limit one's ability to collect any money damages or recover legal costs, if a lawsuit for infringement has been commenced.

Additional reasons exist for marking a company's trademark. These include: 1) Identifying the mark as being registered; 2) directing the consumer to the identity of the owner and reinforcing the consumer's associate of the mark with the supplier/owner of the goods or services; 3) distinguishing the trademark from adjacent text or graphics; and 4) distinguishing the trademark from other marks, if used together on packaging, products or collateral marketing/sales materials.

The most critical element to getting a trademark registered is the step of actual use of the mark in commerce. If a company never uses the mark to sell the goods or advertise for its services, then the mark can never be registered.

How does one accomplish this? They must "affix" the trademark to goods. This is done by placing the mark on the goods themselves, on packaging, tags or labels on the goods. The affixation requirement may also be met if the mark is used prominently on a display or sales booth that is associated with the goods. With the rampant growth of e-commerce, the affixation requirement has had to evolve to accommodate this way of selling of goods and services. Web pages, if constructed in a

certain matter, may now qualify as an acceptable specimen for evidencing the affixation requirement. As for services, a trademark is affixed if it is used in direct and explicit connection with the sale or advertising of the services.

Typically, it is permissible to use another company's trademark when directly referring to a product or service of that company. One must make it absolutely clear that the use of the trademark is to refer to that specific good or service. The use by you of another's mark cannot in any way mislead the public or another party to interpret that the used trademark and source

The most critical element in getting a trademark registered with the Trademark Office is the step of actual use of the mark in commerce.

of the corresponding product or service is you. Companies attempt to address the issue of others using their respective marks for legitimate (non-infringing) reasons by publishing and distributing specific guidelines for use of their respective trademarks. A best practice is to create such a guideline and post it on your company website. In addition, hard copies should be distributed to your sales force and distributors for future reference. This guideline will outline many of the topics discussed above regarding the proper usage of the mark and notice requirements. A GOOGLE Search using "Trademark use Guidelines" will return links to several companies' policies.

As briefly discussed above, once a trademark is registered, there are two post-registration submission events that are critical to pay attention to or one may inadvertently abandon their trademark. The first submission event occurs between the fifth and sixth year after the registration date. The owner of the trademark must file a "Declaration of use or Excusable Non-Use under Section 8 of the Trademark Law." The declaration must be filed between years five and six or within a six-month grace period after the expiration of the sixth year.

Accompanying the filing, one must also submit a "specimen." A specimen is a sample of how the company is actually using the mark with the goods or services that were identified in the original trademark application. Essentially, a specimen is what the consumer will see when they are trying to purchase the goods or services. The specimen is the evidence for meeting the affixation requirement. If one is unable to provide a legally sufficient specimen with the Section 8 declaration, the trademark may become abandoned.

Examples of proper specimens for goods include: 1) A photograph showing the mark directly on the good; (2) product labels or tags showing the mark; (3) product packaging showing the mark; 4) a label on the packaging showing the mark; and (5) signage used in a product display at a sales convention.

As noted above, the Trademark Office accepts web pages as specimens if certain specific standards are met. Generally, a web page will be acceptable if it shows or describes the good

in close proximity to the mark, with purchasing information or information necessary to order the corresponding goods.

Proper specimens for services are different in comparison to goods, in that the specimen must show the mark in the sale, rendering or advertising of the services. Examples of proper specimens include: 1) print/website advertising pages; 2) brochures and other sales collateral; 3) business cards or letterhead that reference the services; 4) marketing materials; and 5) photographs of signage and billboards advertising the services.

At the five-year mark, in addition to filing the Section 8 declaration, the owner may also file a Section 15 "Declaration of Incontestability." This declaration is optional; however, most owners do file this at the five-year mark. The Section 15 declaration can only be filed if the mark has been registered on the Principal Register and there has been continuous use for a five-year period after the date of registration. In addition, one must attest that there are no adverse decisions or pending proceedings involving the rights of the trademark. Gaining incontestability status of a trademark is very important and enhances many of the legal presumptions that a registration receives (e.g., ownership).

The second post-registration submission event occurs between the ninth and tenth year following the registration date and every ten years thereafter. This submission is the filing of a combined Section 8 declaration (Declaration of Use or Excusable Non-Use) and Section 9 Renewal Application. Failure to file this combined declaration will result in cancellation of the trademark. In support of the combined Sections 8 and 15 declaration, the owner must also submit a proper specimen that again evidences the continued use in commerce of the mark. This is why it is important for a company to continually monitor its trademark use policy to ensure it will be able to produce a specimen at the time of the renewal anniversary.

The best practices discussed above will go a long way to establishing a comprehensive trademark use policy for internal and external users. In addition, if these best practices are implemented and religiously followed, the generation and use of improper specimens will be mitigated and specimen rejections at the time of any post-registration filing with the Trademark Office will be eliminated.

This article was written for informational purposes only and should not be interpreted as legal advice. Please consult with a licensed attorney, if you have any questions.

John W. Boger is a partner with the boutique Intellectual Property Law Firm of Heslin Rothenberg Farley & Mesiti P.C. and is the Chairman of the firm's Medical Products and Technology Practice Group. Before attending law school, Mr. Boger worked for eight years with a large orthopedic device manufacturer in various product development and marketing positions. He can be reached at 518-452-5600 or at jwb@hrfmlaw.com.

Heslin Rothenberg Farley & Mesiti P.C.
hrfmlaw.com