

Trademarks and Service Marks

Trademarks (which identify products) and service marks (which identify services) are often not easily protectable, or are not properly protected. Commonly used marks are words, phrases, and logos.

Uniqueness: First, a unique mark is more likely to have greater value because it is granted more protection. Unique marks are also referred to as “fanciful” or “coined” and are “made up” words. Who ever put together the letters X, E, R, O and X before it became Xerox®? It may take a lot of money and effort to develop a truly unique mark into a well known one, but once it is known it is highly protectable.

Words that are common, but used to brand something that is not obviously related to that word are called “arbitrary” marks. Examples are Tide®, Apple®, Hard Rock® Café. The protection for these is not quite as high as for a unique mark, but arbitrary marks do have a good degree of available protection.

Words that suggest the product or service are less protectable, but can be protected in the right circumstance; an example of this is Coppertone®. However, a descriptive mark is less protectable and perhaps will not even qualify for federal registration if wanted. An example of a descriptive mark is Spray ‘n Wash®.

Finally, generic terms are not protectable. Bleach is an example of this.

Use of Marks: You care about how the mark is used because you want to keep others from claiming that the mark has been diluted and thus is no longer protectable.

Many people use a mark as a noun. Trademarks are ADJECTIVES and should always be used that way. It is not Crest ---- it is Crest® toothpaste. It is Kleenex® tissues.

People also use marks as verbs and that is also incorrect. Google Inc. (the company) is very happy when you use the Google® search engine. They are NOT happy when you “google it” because that can dilute their mark. However, doing a Google® web search is great!

Similarly, if a mark is singular, do not use it in the plural, and if it is plural then don’t use it in the singular. Also, possessive’s matter. It is not Kleenex’s brand of tissues. It is the Kleenex® brand of tissues.

Registering Marks v. Just Using Them: Anyone can create a mark and protect it just by using it. You may not have quite as many rights, but for many people this is enough.

If you are the first to use that mark, for that product or service, in a specific geographic location, then you have first rights ... for that product or service and where you use it. You can also use the TM or SM symbol even if you never file with any state or federal agency.

States also allow filings to protect marks. These are often fairly inexpensive and easily done. State filing gives more notice to the world than simple use does, but it does not offer the protection that filing federally gives. However, if you are using the mark in one state, then you cannot file federally.

Federal filing is done with the U.S. Patent and Trademark Office. It is allowed for marks that are used in more than one state, and an “intent to use” filing is available for a short period of time. A mark that is filed with the US Patent and Trademark office is noted by the symbol ® and carries greater protection, including nationwide protection even if you are only using it in a few states, and including the right to attorneys’ fees. When you file for a federal registration of a mark you have to pick which classes apply and each class is a separate filing fee. If you do not file in a class, then you may not have prior rights under federal law for that mark with respect to that usage.

Finally, the U.S. Patent and Trademark Office, plus many states, require further filings to maintain that mark as being registered.

Mark Usage and Policing: After all the work to develop a mark and the money to develop the brand, far too many people do not use the mark correctly or they allow infringing uses, and then lose rights. This is the reason why companies who have marks that they want to protect send “cease and desist” letters. Failure to handle this properly results in the loss of mark rights ... just ask Otis Elevator Company about “escalators.”

Always use a mark in the same way and for the same product or service. Using a mark in different ways can dilute the mark and possibly allow others to claim that you do not have sole rights to use it. Also, use the mark as an adjective, not a noun or verb, and follow the other guidelines noted above.

Finally, if you want to protect your mark, you must monitor it for possible infringements. That means either hiring a service to monitor it for you, or taking action personally. Preferably, this should be done weekly or at least monthly.

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