

Follow these Simple Guidelines to Strengthen your Trademark Rights  
by Jonathan Richards

In this day and age of heightened brand awareness, here are some basic principles to consider to help establish and maintain your trademark rights.

The fundamental purpose of a trademark or service mark is to exclusively identify you or your business as the source of the goods and/or services to which your marks are affixed. In other words, a key touchstone for establishing exclusive rights in a trademark is the mark's distinctiveness in the minds of the consuming public (i.e., its ability to function as an indication of a single source or origin and/or an indication of quality of the goods/services on or in connection with which a mark is used).

An issue I encounter all too often is a client's natural desire to adopt a trademark that directly describes advantages or features of the product. While this can be useful from a marketing standpoint, it can make it difficult to register the mark and, even if registration is obtained, to preclude competitors from using the same or similar terms in a nominative or non-trademark manner to accurately describe the competitor's products (and/or inherent characteristics, qualities or features thereof). Consequently, it is advisable to avoid marks that are highly descriptive, and instead to select marks that require some thought or imagination to convey a desired connotation and/or to draw a connection between the mark and the associated goods/services, their advantages or features. Another challenge is where a client is so successful in the marketplace that the client's mark becomes the de facto name for a class or category of products or services. These challenges can be compounded by the client's own ill-advised or improper use of a mark in the client's own packaging, advertising and/or other promotional materials.

To avoid these potential difficulties, I offer the following guidelines and principles for proper trademark usage. These, of course, are general guidelines that should be adapted to the specific facts and circumstances of a particular situation, but routine adherence to these basic principles will generally help enhance the strength of a trademark owner's exclusive rights. In addition, the reader is hereby advised that the following is provided for informational purposes only and does not constitute legal advice. Those requiring legal advice concerning a trademark/branding issue are advised to seek specific counsel tailored to

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the specific facts and circumstances from competent legal counsel, preferably one who is experienced in trademark matters.

- Be consistent in the presentation of your mark. CONSISTENCY and REPETITION in the use of a mark are the keys to establishing a trademark/brand.
- A **trademark** is applied to goods. A trademark should be directly affixed to the goods by directly applying labels, tags, decals and the like or directly printing the mark on the goods themselves or on packaging or containers for the goods.
- A **service mark** is applied to services. A service mark is commonly used on materials describing or promoting the services performed by the owner of the mark.
- Where possible, the mark should be used as an adjective, and use as a noun or a verb should be avoided.
- Avoid using the mark in plural form.
- Avoid using the mark in possessive form.
- Where possible, follow the mark with a generic term (noun) that refers only to the associated products or services; avoid using the mark to refer to a general class or category of products or services.

Correct: JACUZZI® Spa

Incorrect: The Jacuzzi experience

- Use all capital letters, italics, boldface type and/or quotation marks to set the mark apart from surrounding text, designs or marks.
- Avoid frequent changes or embellishments to the characteristic font/typeface used for the

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mark (in order to promote consistency and repetition of use of the mark).

- Improper use of a mark can contribute to the mark becoming generic (i.e., a common name rather than a trademark or service mark). Some examples of former trademarks which are now merely generic terms are cellophane; corn flakes, escalator; kerosene; linoleum; milk of magnesia; and aspirin.

- Use the proper trademark and service mark symbols. The following superscripts may be placed immediately adjacent your trademark or service mark:

- o The federal registration symbol (“®”) may only be used after the mark has actually been registered with the U.S. Patent and Trademark Office (“USPTO”). This symbol is not required but is recommended as a means of providing notice to others that the mark is registered and that you claim certain exclusive rights in and to the mark.

- o Use of the symbol “TM” immediately following the mark is recommended until the mark is registered with the USPTO, as a means of providing notice to other parties that you claim common law rights in the mark.

- Permission for others to use your MARK should be given only pursuant to a written license agreement that clearly delineates the specific terms and conditions under which the other party is permitted to use the mark, preferably prepared with the assistance of legal counsel.