

THAT ELUSIVE TRADEMARK

By Attorney Michael H. Wald

I'm sure you can name all sorts of products that have names which are used as the generic term for other manufacturer's similar products -- like "Coke", "Xerox" and "Band-Aid."

All these, and other, similar names of products, are registered trademarks -- symbols, names and devices that are used by one manufacturer to separate his products from other manufacturers' products.

Trademarks are frequently considered a business' most valuable asset, because a good name means a loyal consumer following. But when a name becomes too big, and becomes the generally-accepted term for a class of goods, then there is a risk that ownership of the trademark will be taken away from the company.

Trademark owners always must be aware of the things they need to do to protect their trademarks, if they feel that they are worthwhile. First, trademarks must be used to be protected. A company cannot reserve a drawer full of trademarks to use at a later date -- they all must be used continually. It is always a good idea to conduct a trademark search to see if another company or individual is using your intended name. An attorney can be of good use to you in this area and while trying to protect the name you settle on. If the attorney reports that the mark is not being used, and you still want to use it, do it immediately -- his search is only good for the day he conducts it -- someone may begin using the same mark before you do, but after the search!

A trademark does not have to be registered to be valid. You can claim a common law right if you can prove you were the first to use the trademark. Registration of trademarks is possible and assists

in verifying one's first use claim. Until registration occurs whenever a trademark is used, it should be designated with the familiar TM superscript.

Federal trademark protection begins from the date of the first sale of the product interstate. Federal registration of trademarks is handled through the U.S. Patent and Trademark office in Washington. To do this make sure you use the mark in interstate commerce -- send a package to a customer across state lines, using the mark.

Registration of the mark with the U.S. Patent and Trademark Office, after it has been used across state lines virtually "locks-in" the mark for the user for 20 years. It also allows the user to use an R in a circle after the trademark, indicating it is registered.

Even after registration the mark must be kept continually in use. Using the trademark is the key to protecting and strengthening your rights to it. Proper use includes:

- not using the trademark in the plural or possessive form
- using it only for products made by the owner, not by unauthorized people
- using the trademark along with the generic name for the product
- using the trademark as an adjective
- when printed, setting it off from the other words by capitalizing, italics, underlining, etc.
- using the correct TM or R designation, depending on the status of the mark's registration

You can also license the mark to others, but take all proper precautions to make sure the other person's product will be up to your standards and won't hurt the mark in any way. Include an agreement to be held free from responsibility if a user wants to sue you if the licensee's product causes any injury or is defective.

Keep a lookout for unauthorized uses of the mark and of marks that are so similar that they may

cause confusion and hurt your product's sales. You can have the matter decided on in a trademark case and possibly have the infringer stop using the similar mark.

A trademark, then, is a much-envied possession, if it has a good consumer following. It may be worth a pretty penny to develop a good one. Once you do, protect it.

Copyright (c) 1986 by M. Wald & Co.