

10 Essentials for Protecting Your Trademarks



Q: What do we need to know about registering our association's logo?

A: Here are 10 important things to know about registering trademarks:

- 1. Trademark is different from copyright.** Trademarks indicate the source of goods or services. The association's name, logo, conference logo and journal name are all trademarks and make the association recognizable as the provider of certain goods and services. Copyright protects the expression of an idea in tangible form, and covers such things as journal articles, conference proceedings, website design and educational materials.
- 2. Not all trademarks can be registered.** The U.S. Patent & Trademark Office won't register trademarks that merely describe goods or services. If a descriptive mark has been used for more than five years, however, or the owner has other proof a mark has become well known (e.g., substantial money spent on promotion), the trademark may be registered because it has become "distinctive" when used in connection with the relevant goods or services.

- 3. The trademark registration process can be complicated and time-consuming.** Registering a trademark usually takes at least a year. After an application and supporting materials are filed with the USPTO, an examiner reviews the application and frequently raises questions that must be addressed through correspondence. The USPTO also publishes the trademark so that anyone with a similar mark can raise an objection before the mark is registered.
- 4. In the United States, a trademark must be used in interstate commerce to be registered.** A trademark must actually be used on goods or services in "interstate commerce," or the owner must have a bona fide intent to use the mark in interstate commerce within approximately two years of filing for it to be registered. The registration will cover only the goods or services on which the trademark is actually used. The USPTO does not allow anyone to "reserve" trademarks indefinitely for future use.
- 5. The USPTO won't enforce your marks for you.** Registration provides important benefits in a lawsuit (e.g., a presumption that the trademark owner has the exclusive, nationwide right to use the mark), but the owner is responsible for pursuing any infringers. If an unauthorized party uses the association's mark or a confusingly similar mark, the organization must send a cease-and-desist letter and, if necessary, pursue a court action to protect its trademark.
- 6. "Naked" licenses are dangerous.** Don't let another person or company use the association's trademark without a clear, written license agreement. The agreement should include standards for use of the trademark, and give the association the right to review and approve all uses of the trademark by the other party.
- 7. Don't let your mark go the way**

of the zipper. A zipper used to be known as a Zipper fastener. When a trademark becomes so popular that people use it generically, the owner loses exclusive rights in the mark. To protect against a mark becoming "genericized," always use trademarks as adjectives together with a common term for the product or service (e.g., Apple® computer).

- 8. Put the world on notice that the mark is yours.** Although trademark notice isn't required by law, using the symbols TM, SM or ® communicates to others that the association claims a trademark as its own. The TM and SM symbols may be used on any unregistered trademark. The ® symbol may be used only after a trademark is registered.
- 9. Registration doesn't last forever.** Between the fifth and sixth years after a trademark is registered, the owner must file proof with the USPTO that the owner is still using the trademark in interstate commerce and that no one else has contested the owner's right to use the mark. Between the ninth and 10th years after registration, and every 10 years thereafter, the owner must file proof of continued use to maintain the registration.
- 10. There is no such thing as "international" registration.** While certain international treaties make it easier to file foreign registrations based on U.S. trademark registrations, there is not a single blanket international registration. A trademark owner has the option to file a Community Trade Mark that covers all the countries of the European Union, but if a mark is used outside the United States, the best protection usually is to file for registration in each country where the trademark is used. ■

The answers provided here should not be construed as legal advice or a legal opinion. Consult a lawyer concerning your specific situation or legal questions.