



## Trademark and Service Mark Usage

Did you know that trademark or service mark rights can be lost through non-use or misuse? This is an important reason for trademark and service mark owners to be familiar with best practices for proper use of their marks. Below we discuss some important guidelines to help prevent the loss and diminishment of rights.

### Use and Protection of Marks:

A mark is any word, name, symbol, device, or combination of these that identify a brand of goods or services. The key feature of a mark is that it distinguishes the goods and services of the mark's owner from the goods and services of others. Trademarks are used in connection with goods, and service marks are used in connection with services. However, both are commonly referred to as marks.

In the United States, trademark and service mark rights arise from use of the mark in commerce. A company may apply for a registration of a mark it is currently using or that it intends to use. A company that applies for registration of a mark it intends to use reserves the mark in essence but will not obtain the registration until the mark has actually been used in commerce.

Legal protection given to marks prevents other companies from using the same or confusingly similar marks for similar products or services. Trademark and service mark rights can also be lost. If a mark becomes "generic," rights in the mark are lost. A mark becomes generic if it has become the ordinary and commonly used name for the product or service itself. If the mark becomes generic, the owner cannot prevent other companies from using the mark. Examples of trademarks that became generic include "aspirin," "thermos" and "escalator."

Non-use or misuse of a mark can also cause a company to lose rights. Failure to enforce a mark or failure to strictly control the quality of a licensee's goods bearing the mark can likewise result in loss of rights. Because trademark and service mark rights may be lost in a number of ways, the manner in which owners use their marks is extremely important. We have provided some guidelines below using our favorite fictitious sausage-slinging establishment HOPPIN' BRATS.

### **Always use a mark along with the generic name for the product, and only as an adjective, not as a noun or a verb.**

A mark should always be followed by the generic name for the product or service. For example, in the phrase "HOPPIN' BRATS® bar and grill," HOPPIN' BRATS is the mark, in this case a service mark, and "bar and grill" is the generic name for the service. If a brand of sausages were sold under the HOPPIN' BRATS mark, then the mark is a trademark as opposed to a service mark. Adhering to this usage will prevent the HOPPIN' BRATS marks from becoming generic.

In short, marks must be used as adjectives, and not nouns, verbs, or in the plural.

Wrong: Customers love HOPPIN' BRATS.

Correct trademark usage: Customers love HOPPIN' BRATS® sausages

Correct service mark usage: We love going to the HOPPIN BRATS® bar and grill.

### **Use the ® symbol if the mark is registered, the ™ (if a trademark) or ℠ (if a service mark) symbol if the mark is not registered, and never use the ® symbol if the mark is not federally registered.**

The ® symbol gives the public notice that a mark is federally registered and that no one may use a confusingly similar mark for similar goods or services. In addition, owners of federally registered marks who use the ®

symbol get enhanced rights in any enforcement action. Accordingly, marks that have been registered should be followed by the ® symbol. Marks that have not yet been federally registered may not be followed by the ® symbol; they may be followed by the ™ or ℠ symbol until they are federally registered. Once the mark has been federally registered, the ® symbol should be used with the mark when placed on advertising materials, in promotional displays, on the goods or on packaging for the goods.

It is not necessary that the appropriate symbol (®, ™, or ℠) be used every time the mark appears. For example, in an advertisement or print ad or on a label, the appropriate symbol need only appear with the first and/or most prominent use of the mark. However, a symbol should be used with the first use of a mark in any text, even if the symbol was previously used with another prominent use.

### Always “set off” the mark.

Marks must be set off from surrounding words by *italics*, **bold print**, ALL CAPITAL LETTERS, Initial Caps, or **letters in a different color**. For example, the mark should be set forth more conspicuously than the generic term appearing after the mark. Marks can also be distinguished by using the appropriate symbol (®, ™, or ℠).

Wrong: Hoppin’ brats are very popular with foodies.

Correct: *Hoppin’ Brats*® bar and grill is very popular with foodies.

Correct: The **Hoppin’ Brats**® bar and grill is very popular with foodies.

Correct: The HOPPIN’ BRATS® bar and grill is very popular with foodies.

Correct: Our Hoppin’ Brats® bar and grill is very popular with foodies.

Correct: Our **Hoppin’ Brats**® bar and grill is very popular with foodies.

In contrast, trade names should not be set off from surrounding words in the manner of trademarks. For example, in the following sentence—“Hoppin’ Brats LLC includes the HOPPIN’ BRATS® bistro, along with the soon-to-open DETROIT BRAT BAR™ bistro,”—the trade name, “Hoppin’ Brats LLC” is not set off.

### Where marks also form trade names.

Where a designation forms both a trade name as well as a mark and the designation is to be used as trade name, it should be used as a noun. Thus, proper use of “Hoppin’ Brats” in a sentence as a trade name would be: “We at Hoppin’ Brats do our very best to service you.”

However, when the designation is to be used as mark, it should be used as an adjective followed by the generic term for the product, e.g., HOPPIN’ BRATS® sausages.

### Always use marks consistently.

The spelling of marks must not be modified or even shortened for convenience. Where a mark includes a logo or a design, the design or logo must likewise not be altered. The key is that the form of use is consistent.

Wrong: Hoppin-Brats

Wrong: H-B

Correct: HOPPIN’ BRATS

Marks should not be linked with other words, by punctuation or by design.

Wrong: HOPPIN’ BRATS-bistro

Correct: HOPPIN’ BRATS bistro (no hyphen)

## Monitor all uses of a mark.

Mark owners are responsible for monitoring and controlling the nature and quality of any products or services bearing its marks and that obligation extends to everyone in privity with the owner. For example, licenses with quality control provisions are one way that a mark owner can permit a third party to use its marks. Failure to do so or to allow third parties to use a mark in a way that causes a likelihood of confusion with your usage may result in the loss of trademark or service mark rights.

## Maintain use of the mark.

Trademark and service mark rights may be lost through non-use, which is often called “abandonment.” In other words, if you don’t use it, you lose it! For federally registered marks, this means that mark owners must submit proof of continued use of its mark between the fifth and sixth years after registration, between the ninth and tenth years after registration, and every ten years after that. Additionally, non-use of a mark for three consecutive years is considered abandonment unless proved otherwise.

## Conclusion:

To maximize the value of both trademark and service mark rights, a mark owner should:

- Use its marks properly:
  - use the marks as adjectives along with the generic name for the product or service;
  - use the ®, ™, and ™ symbols where appropriate;
  - always set off the marks; and
  - use the marks consistently and in the manner shown and described in this white paper.
- Monitor third-party uses to make sure that there is no likelihood of confusion.
- Promptly address improper trademark or service mark usage.

Appreciate obligations associated with a federally registered mark and docket all deadlines to avoid loss of a registration. 📅

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