



Trademarks 101: The Basics



by Lawrence Savell

FAMILIARITY WITH THE basics of trademark law (including trade names and service marks) is vital to every editor and publisher. Affirmatively, trademarks protect and identify to readers and advertisers your publication and any related products you produce or services you provide. Moreover, familiarity with trademark law can help you avoid costly litigation brought by the owner of a trademark on which you otherwise might unintentionally infringe — or contribute to infringement by others. (It also will help you avoid upsetting valued advertisers through careless reference to their marks in print.)

While this article reviews some basic trademark law concepts, such information should, of course, be supplemented by appropriate consultation with an attorney knowledgeable in this area.

What Is A Trademark?

A trademark can be any word, name, symbol, or “device” — or any

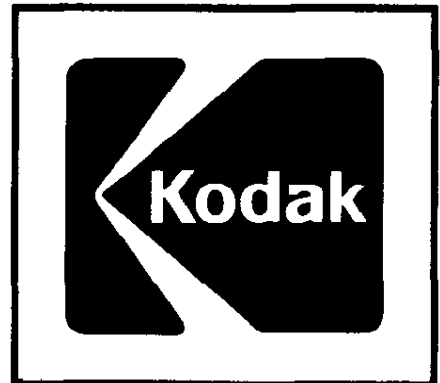
combination of these things — which is (or, in some cases, will be) used to identify and distinguish your products from those manufactured or sold by others. Even a slogan (for example, The New York Times’ “All the News That’s Fit to Print”) or a personal name (such as “Martha Stewart”) can be a trademark. The key to a trademark is its ability to identify the source or origin of a product.

A “service mark” differs from a trademark in that it identifies services instead of products. A “trade name” identifies a business or enterprise. (For convenience, all three concepts will be collectively referred to as “trademarks” in this article.)

Although you might think that a trademark can only be composed of a word (such as “Ford”) or words, trademarks can take other forms. Trademarks may be numbers (such as “747”), visual representations or logos

(for example, an alligator seen on certain knit shirts), or even shapes (including the classic curves of a “Coca-Cola” bottle).

What about a product’s color? While not all courts agree, the most recent decision to address this question ruled that, under certain circumstances, a



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product's color could be trademarked. On February 17, the United States Court of Appeals for the Eighth Circuit ruled in *Master Distributors, Inc. v. Pako Corporation and Pakor, Inc.* that, if a manufacturer complied with certain requirements, the blue shade of its "Blue Max" photoprocessing leader

Making Your Mark

Not all trademarks are entitled to the same degree of legal protection. There are four basic types of trademarks, each with its own degree of protection against infringement.

product's source can they provide real protection.

The least protective trademarks are "generic" marks (such as a newspaper called "The Newspaper"). These usually provide no protection at all.

Once you have come up with a protectible trademark, you next have to make sure that no one else is using that mark or one similar to it in a situation where the two would be in conflict. This usually requires using a lawyer or a company that performs searches of federal and state trademark registries and listings as well as other sources. This can be done relatively quickly and for a reasonable fee. There are also some on-line computer databases providing information about existing trademarks.

Assuming there is no conflict, you probably next want to register your trademark with the appropriate governmental authorities. Under federal trademark law, you can register a trademark if you (1) are actually using it or (2) intend to use it. If you have not yet used the mark, your application must state that you have a "bona fide" (that is, legitimate and firm) intention to use the mark in commerce to identify your product or service.

The government then reviews your application. If that examination is successful, the application is published in the United States Patent and Trademark Office Official Gazette. ("Actual use" applications may skip the review step.) This publication gives anyone who feels your mark infringes



The Document Company

splicing tape could be protected against infringement.

In an earlier case, the Court of Appeals for the Federal Circuit had allowed Owens-Corning to register the color pink as a trademark for its fibrous glass insulation. However, in 1990 the manufacturer of a sugar substitute product packaged in a blue, single-serving packet was unsuccessful in its attempt to stop another manufacturer from packaging its sugar substitute in a similar blue, single-serving packet.

The trademarks affording the most protection are "arbitrary" or "fanciful" marks. These distinctive marks convey no information about the product with which it is used except for identifying the product's source. "Coined words" such as "Kodak" or "Exxon" are examples of fanciful trademarks. Arbitrary marks are recognizable words which have no meaning with respect to the products to which they apply (such as "Pledge" furniture polish).

Somewhat less protective are "suggestive" marks. These in some way suggest a quality or characteristic of the product, although they are not simply descriptive. An example is "The Money Store" for a lending and financial services company.



There's only one company that makes **FIG NEWTONS®** chewy cookies, **CREAM OF WHEAT®** cereal, **PREMIUM®** crackers and **OREO®** cookies.

A distinctive "fanciful" mark can become too strongly identified with a product and thus become generic.

Still less protective are purely "descriptive" marks. These merely describe or characterize the product or its functions. Trademarks based on geographic terms or surnames may come under this category. Only when such marks acquire what is known as "secondary meaning" indicating the

on theirs the opportunity to file a Notice of Opposition. If no such notice is received regarding an "actual use" application, registration will be issued. "Intent-to-use" applications require actual use before registration issues; such actual use must take place within a specified time.



Why Register Your Trademark?

There are many benefits to registering your trademark with the federal government. Most importantly, it provides several advantages should you end up in litigation. A federal trademark registration is evidence of (1) the validity of the registration, (2) your ownership of the mark, and (3) your exclusive right to use the mark with the particular goods.

In addition to this federal protection, you should be aware that many states have established their own independent systems of registration and protection of trademarks.

Trademark protection is not limited to a set time (although you do have to renew your registration periodically). It continues as long as your use of the mark continues. One can, therefore, lose a trademark by abandoning it.

Abandonment was one of the reasons cited by a federal court on April 8 in a decision upholding a Brooklyn sports bar's right to use the name "The Brooklyn Dodger." The court noted that the Los Angeles Dodgers, after abandoning Brooklyn for the West Coast in 1958, had failed to use the "Brooklyn Dodger" name commercially for 23 years (they resumed limited use of the mark in 1981). Moreover, the team had failed to register the mark until shortly before the bar opened in 1988.

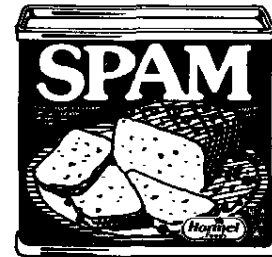
Trademark Litigation

Lawsuits involving trademarks generally focus on whether an allegedly infringing mark is likely to cause confusion as to the source of the products. Thus, if it is likely that a consumer would think that the defendant's product came from the same company as the plaintiff's, there probably would be sufficient "likelihood of confusion."

The courts have identified several factors to consider in determining likelihood of confusion. These include (1) the "strength" of the plaintiff's mark, (2) the degree of similarity between the marks, (3) whether the products compete, (4) the likelihood that the plaintiff may enter the defendant's market, (5) the sophistication of consumers, (6) the quality of the defendant's product, (7) the existence of actual confusion, and (8) the defendant's "bad faith" in adopting the mark. This list, however, is not exhaustive, nor is any one factor determinative.

In its February 25 decision in the case of Nikon Inc. v. Ikon Corp., the United States Court of Appeals for the Second Circuit applied this eight-part test. It concluded that the evidence supported the lower court's finding of deliberate confusion constituting trademark infringement by the Ikon Corp.

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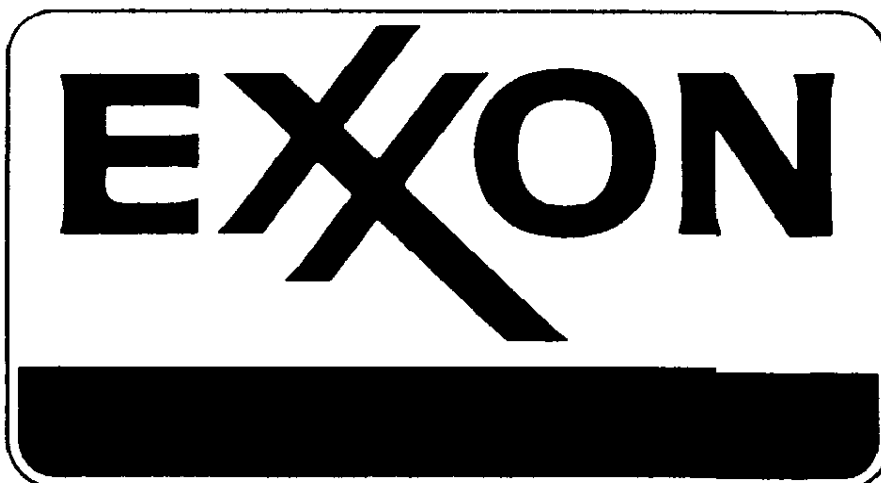


Actually, we don't sense a problem with motherhood and apple pie, but Hormel Foods wants to make sure you know that SPAM is our registered trademark for luncheon meat and should not be used as a generic descriptor for canned luncheon meat. Because a trademark is a proper adjective, the word "SPAM" should always be in capital letters accompanied by the ® symbol and followed by the generic noun "luncheon meat." We're very proud to be the sole source of SPAM® luncheon meat and look forward to people saying (or writing), "I had SPAM® luncheon meat for breakfast."

Thanks,
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Protecting Your Trademark

Maintaining your valuable property right in your trademark takes some effort. In particular, one danger is that a distinctive "fanciful" mark can become too strongly identified with a product and thus become generic. This happened to "Aspirin." If there is danger of this happening to your mark, you may want to advertise and otherwise educate the public that your mark is a trademark and not a generic term.

The advertisements in this section are run by marketers for exactly that reason—the fear that a mark might find its way into the realm of generic usage. This is why, for example, the owners of the "Xerox" trademark might take out an ad to advise people (and journalists)

Kleenex® products

to refer to non-Xerox equipment as "photocopiers."

When referring to your trademark in writing, differentiate it from surrounding words by using capital letters, bold type, quotation marks, or italics. Use it as an adjective modifying the generic term for the product instead of as a noun (thus "Kleenex" tissues, not just "Kleenex"). Do not use the mark in the possessive or plural form; put the following generic term in that form. Use the "circled-R" (®)

symbol if the mark is registered and the "superscript-TM" (™) if it is not.

Following these rules can help you protect one of your company's most important assets: its name — and the quality associated with it. A well-valued and properly protected trademark will serve dividends for many years to come.

Lawrence Savell is a media law attorney who has litigated trademark matters at the law firm of Chadbourne & Parke in New York City.

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