

PROPER USE OF TRADEMARKS & TRADEMARK SYMBOLS

A trademark is a word, phrase, symbol, design, color, sound, or a combination thereof, that serves to identify the source of goods or services from those of another. Questions frequently arise about how trademarks should be used and about when and how trademark symbols should be used.

AVOID “GENERICIDE” AND “MUTILATION” OF YOUR MARKS

Your incorrect use of your marks, or unchecked third party use (including licensee use) of your trademarks, can undermine the source-identifying significance of your trademarks and even result in loss of rights. Do not, and do not allow third parties to, use your trademark as a noun—instead it should be used as an adjective modifying a generic word. There are exceptions where well-known brand owners “get away with” noun usage, e.g., “buy an iPhone” or “buy a Ford” without adding the generic word “device” or “car.” For most brand owners, however, there is risk that noun usage will cause consumers to view the word as indicating a product category as opposed to a product emanating from one specific source. Trademarks can be victims of their own success if not properly managed. When your product or service name is viewed as a generic type of product or technology, you may have lost your trademark rights. Other rules: Don’t allow others to use your mark as a verb, or to combine the mark with other elements to create a hybrid mark that includes your mark.

WHY DO TRADEMARK SYMBOLS EXIST?

Trademark symbols exist to serve as notice to the public that the mark preceding the symbol is a trademark. Notice may serve to deter others from using the mark, but can also provide evidentiary benefits in any potential infringement suits.¹

CHOOSING THE RIGHT SYMBOL—TM, SM, OR ®?

The TM symbol is used for common law marks that represent goods or services that are not federally registered with the USPTO, including marks whose registration is pending. The TM symbol, and the word “trademark,” is interpreted as broadly covering both product marks and service marks. So the in the case of unregistered marks, the TM symbol always is correct.

The SM symbol is used for common law trademarks that represent services. This symbol is less common (in part because the designation TM is broader and more recognized), and should be used in a manner similar to the TM symbol.

The ® symbol is used for marks registered with the USPTO. This symbol can only be used once federal registration is granted (applying for a trademark isn’t enough), and can only be used in connection with goods and services listed in the federal registration.

A Note on Registration

While you will receive common law protection without federally registering your trademark, registration carries multiple benefits including enhanced rights and evidentiary benefits at trial. You can learn more about registering your trademark at www.uspto.gov.

¹If a plaintiff establishes use of the registered trademark symbol ®, the defendant will be deemed to have constructive notice that the mark is registered without the plaintiff having to prove actual knowledge.

WHEN SHOULD THE SYMBOLS BE USED?

Use of trademark symbols is not actually required by law, but doing so is beneficial. In fact, the ™ and ℠ symbols do not have any legal significance, but instead are informal ways of telling the world that you are claiming ownership of trademark rights in a word, phrase, and/or logo. The following are some general guidelines for using the trademark symbols.

Placement

The designation should be placed immediately following the mark that is registered. The norm is to place the symbol in superscript in the upper-right-hand corner, or in some cases, in subscript in the lower right-hand corner.



Frequency

Use of a trademark symbol in the first prominent mention of a trademark (e.g., in a heading) is more important than repeated use throughout a brochure or web page. The symbol does not have to be used every time the mark is used. Instead, use the symbol in the first instance the mark is used, in the most prominent use of the mark, or both. Repeated use of trademark symbols can become cluttered.



Print Materials: If the print materials consist of 1–2 pages, designation in the first instance of the mark is sufficient. For longer materials, it is recommended (but not a hard and fast rule) that the designation be used at least once per page in which the mark appears. A good way to achieve this is to place the designation anywhere there is a static representation of the mark that is duplicated on each page, such as in a header or footer.



Electronic Materials: Use the designation at least once per web page in which the mark is used. Placing the designation in any static representation that is repeated on every page is also a good idea.



Social Media: The guidelines for marks appearing on social media can be more relaxed. Most companies only use the designation in their username/bio portion of a social media account, while some companies do not use the designation at all. The majority of companies will not use the designation following their mark in every blog post, status, or tweet, although some may try to do so in an effort to fight against their mark from being considered generic.

THIRD PARTY USE

When you permit a third party to use your trademarks, it is important to ensure your marks are used with proper designations. It is also important you monitor the licensee's activities to ensure the quality of the products or services offered under the marks is consistent with the quality of your products or services so the marks do not lose their meaning in the minds of consumers as signaling a certain level of quality (which can result in loss of trademark rights). You should consider providing the third party with guidelines for using the marks (for example, how the marks should appear, when designation should be used, and whether an attribution statement must be made). In the case of licensees, you should also ask them to periodically send you samples of use (e.g., once a year) so you can confirm proper use. Finally, you should include reviews of third-party uses of your marks in the marketplace with an eye to appropriate, non-generic usage as part of your general policing activities.

STAYING UPDATED

It is your responsibility to maintain your mark's registration with the USPTO. This can be done using the USPTO's Trademark Electronic Application System. Further, it is your responsibility to police and continue use of your marks. The length of trademark protection is potentially infinite, but failure to continue use of the mark, or failure to stop others from using your marks, without consent and/or improperly may result in a loss of federal protection.

See the following resources for more information:

- <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf>
- https://www.uspto.gov/sites/default/files/trademarks/law/Trademark_Statutes.pdf
- <https://tmep.uspto.gov/RDMS/TMEP/current>

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