

## Proper Use of Trademarks

Your organization has created a brilliant new trademark to identify its products or services. Now how do you use that trademark? Proper trademark use is important for protecting your organization's rights in the mark. Improper use of a mark can result in the weakening, and potentially even in a complete loss, of your rights in the mark. Below are guidelines for proper use of registered and unregistered trademarks.

1. **Identify the mark with proper notices.** The proper trademark notice symbol designating ownership should be used when a mark appears in print or in any other media, including websites.



Unregistered *trademarks* (i.e., marks used for products) should be tagged with the "TM" symbol (<sup>TM</sup>). Unregistered *service marks* (i.e., marks used for services) can be tagged with the "SM" symbol (<sup>SM</sup>)<sup>1</sup>. The <sup>TM</sup> and <sup>SM</sup> symbols should also be placed on trademarks and service marks: (1) while an application for registration of the mark is still pending, and (2)

when used in conjunction with products or services for which the mark is not registered. Use of the "TM" and "SM" symbols merely indicate the owner's claim to a trademark; use of the symbol alone does not mean the term is a valid trademark.

Trademarks and service marks that have been *registered* with the U.S. Patent & Trademark Office ("PTO") for use with certain goods and services should be tagged with the encircled "R" symbol (®) to indicate that the mark is federally registered *as to those specifically protected goods or services*. Thus, if a mark is registered for Class 16 "publications," the ® symbol should be placed with the mark when used on publications.

Failure to appropriately place notices in conjunction with registered marks could undermine the ability to recover profits and other monetary damages from an infringer who lacks actual notice of the trademark registration (and also reduces the leverage for obtaining compliance without litigation).

Although there is no prescribed placement of the <sup>TM</sup>, <sup>SM</sup>, or ® symbols, they are generally placed above the upper right-hand shoulder of a mark (e.g., Kleenex®).



Although the proper trademark symbol need not appear on every individual instance a mark is used within a document, it should be used sufficiently so that a reader of the document is clearly placed on notice of your organization's claim to ownership of the mark. Generally, this means the symbol should be placed on each prominent use of the mark within a document, e.g., in titles, headings, captions, credits, etc., as well as with the first instance in which the mark is used in the main body of the text.

Generally, the trademark symbols should be used on all materials that will be seen by the public, including websites, brochures, newsletters, advertisements, reports, etc.

<sup>1</sup> The "TM" symbol can be used for service marks as well. Because many people do not know what the "SM" symbol means, many entities use "TM" for both trademarks identifying products as well as service marks identifying services.

2. **The mark should appear prominently by itself.** A trademark should be clearly visible by itself on all products, publications, websites, and other items on which it is used. It should appear prominently in a manner that stands out from surrounding text. For instance, on a printed publication, the mark should not merely appear in small print on the bottom of the document, or combined with the organization's address, but should be prominently placed somewhere on the front of the document. The mark should also be printed in a different manner from surrounding text, *e.g.*, in **bold**, ALL CAPS, a distinctive *font*, or in a different **color**<sup>2</sup>. At a minimum, a mark should at least be used with initial Capital Letters. Use of a mark in all lowercase letters suggests that it is a generic term rather than a trademark.

3. **The mark should identify a product or service.** A trademark should be used in a manner that clearly identifies a product or service. If it identifies a *product* (such as printed publications, CDs, DVDs, etc.), the mark should appear prominently on the front of the item and/or on its packaging. If it identifies a *service* (such as consulting or charitable services), it should appear prominently on brochures, advertisements, or a website in conjunction with a description of the specific services identified by the mark.

4. **The mark should be used consistently in one format.** A trademark should not be altered nor be used in different formats or versions. If the mark is a word, do not combine it with other words or abbreviate it, and do not alter the spelling or other features of the word. For instance, if the mark is registered in the singular, it should not be used in the plural. If the mark is a design, it should always be printed with the same shapes, features, colors, and placement of the same elements. Do not combine it with other elements or move the elements of the design. Inconsistent use can dilute the strength of the trademark. Also, if a mark is "materially altered," the altered mark would likely constitute a new and separate mark. If the altered use supplants the original use, it could result in the loss of rights in the original mark (this is especially true if the mark has been federally registered). What constitutes a material alteration is not always easy to define, so it is a good idea to consult with an experienced trademark attorney prior to making modifications to a mark.

5. **The mark should be used as an adjective, not as a noun or in a generic sense.** When a trademark is used in a sentence, it should be used as an adjective (*i.e.*, as a "brand" name). Unless a mark is also an organizational name, the mark should generally *not* be used as a noun. Use of a mark as a noun subjects it to a claim that the mark does not actually serve a trademark function and is generic, thus depriving the owner of trademark rights. For example:

Improper use: "We sell Kleenex at our store."

Proper use: "We sell *Kleenex*® tissues at our store."

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<sup>2</sup> The name of your organization (trade name) can also serve as a trademark, but you should keep the distinction in mind when using it as a name or as a trademark. When the name is used as a trademark, it should be used according to the guidelines in this memo. When it is used solely as a trade name, it need not be used according to these guidelines.

For instance, when printing the name of your organization on a newsletter, it can appear in small print on the inside table of contents page or the back with an address. But this does not constitute trademark use. To use the name as a trademark to identify the newsletter, the mark must appear prominently on the front cover so it is clearly visible as identifying the newsletter, perhaps above or below the title of the newsletter. Of course, the title of the newsletter itself can also separately be a trademark.