

# TRADEMARK

## MARKING REQUIREMENTS (U.S.)

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### 1. What is trademark marking?

Trademark marking is the use of symbols or text to either identify a word, logo, slogan, design or other source indicator as a trademark, or to describe some aspect of the mark (e.g., its ownership). For instance, certain symbols, when used in conjunction with a mark, give notice to the public that the owner is claiming trademark rights in the material preceding the symbol. One common example of trademark marking is the use of the ® symbol, which conveys to the public that the mark is registered in the U. S. Patent and Trademark Office (USPTO).

### 2. What is the purpose of trademark marking?

Marking of a trademark may serve a number of purposes:

- Providing notice of the owner's claim to ownership of the mark.
- Distinguishing the mark from surrounding text or graphics.
- Distinguishing the mark from another owner's trademark when the two marks appear together on products, packaging or promotional materials.
- Directing the consumer to a notice that identifies the trademark owner, thereby reinforcing the public's association of mark with the owner.

### 3. What do the initials TM and SM mean, and when can I use them?

As stated above, the ® symbol indicates that a mark is federally registered. If a mark is not federally registered, the symbol "TM" for "trademark" or "SM" for "service mark" can be used to indicate that, although a mark is not registered, the owner is nevertheless claiming rights in it. The TM symbol is the recognized abbreviation for "trademark" and is usually placed after and above the mark, for example: ASTEROID™ athletic wear.

The SM symbol is the recognized abbreviation for the term "service mark." It is used in the same manner as TM, but in connection with services rather than goods. (A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. The words "trademarks" or "marks" are commonly used to refer to both trademarks and service marks.)

The use of the TM and SM designations inform the public that a word, logo, slogan, design, etc., is being used as a mark and reflects the owner's intent to claim trademark rights in the mark. However, using one of these symbols does not guarantee that the owner can claim protection of the trademark laws.

### 4. How do I let others know when the mark is federally registered?

If a federal registration issues on a trademark or service mark, then, and only then, should one of the following statutory notices be used:

- the words "Registered in U.S. Patent and Trademark Office";
- the abbreviation "Reg. U.S. Pat. & Tm. Off.;" or
- the ® symbol.

These notices are appropriate when the mark is used in commerce with the goods and/or services specified in the Certificate of Registration. They should be placed after the mark. For example: ASTEROID® athletic wear. However, it is improper to use these notices — or other words to this effect — if the mark is not federally registered.

### 5. What if I do not use a statutory notice?

Use of the registration symbol or other statutory notice is not mandatory, but it is important not only because it provides notice of the owner's registration of the mark, but entitles the owner to claim certain types of damages in lawsuits against infringers. Failure to use a registration notice limits the remedies available to a trademark owner in a lawsuit and is required for plaintiff to recover damages and profits in a suit for infringement under the Lanham Act, unless the defendant had actual notice of the registration.

### 6. Is there any other way that I can properly mark a trademark or a service mark?

Yes, by using an asterisk (\*) or similar symbol to direct the purchaser to a footnote indicating that the mark is either "Reg. U.S. Patent and Trademark Office" or, if the mark is not registered, "\_\_\_\_\_ is a trademark [or service mark] of [company name]."

### 7. Do I need to include a marking symbol when a trademark or service mark is repeated in an advertisement?

No. Generally, it is not necessary to mark every occurrence of a trademark in an advertisement or other promotional materials but, at a minimum, this identification should occur at least once in each piece of printed matter, either the first time the mark is used or with the most prominent use of the mark. When in doubt, err on the side of "over-marking." Remember that apart from marking, a trademark should also be properly used (e.g., used as an adjective and distinguished from surrounding text by capitalization, distinct typeface, color and/or size).

### 8. What marking issues arise in countries other than the United States?

- Remember that trademark rights vary from country to country. So, before using a mark or asserting rights in any country, take steps to verify these rights.
- Marking should conform to any requirements of local trademark law. For example, many countries use the term "trademark" to identify marks used with goods or services, and do not recognize the term "service mark." Logically, marking should be in the local language(s) or otherwise meaningful to the people in the country in which the products or services are advertised and sold. Many countries also recognize the use of the ® symbol to indicate a registered mark.
- Marking (including footnotes) may be necessary when the mark is imprinted on products or packaging by a licensee; the products are distributed by a person other than the mark owner and the distributor's name appears on the product or packaging; or the marks of more than one owner appear together.