



COVERING YOUR ASSETS

Trademarks are among an association's most important assets, but is it really that important to protect them? Here's what you need to know.

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1 Trademark is different from copyright.

Trademarks identify the source of products or services. The association's name, logo, tagline, conference logo, and publication name are all trademarks (or service marks—see #2). Trademarks make the association recognizable as the provider of certain products and services. Trademarks also create goodwill and brand awareness. In comparison, copyright protects the expression of ideas in tangible form, and applies to such things as publication articles, conference proceedings, website design, and educational materials.

2 Service marks, collective membership marks, and certification marks are all types of trademarks.

Service marks are almost identical to trademarks, except that they indicate the source of services, rather than products. For example, Association Media & Publishing has a service mark—Lunch & Learn—for its lunchtime educational events (a “service”), and it also has a trademark—*Signature*—for its monthly publication (a “product”).

A collective mark (also called a collective membership mark) is a trademark or service mark used by the members of an association to indicate affiliation. A collective mark is owned by the association, not by the individual members.

Finally, a certification mark signifies that products or services meet certain standards. The mark's owner controls who may use the certification mark, based on meeting quality, accuracy, or other characteristics. A certification mark differs from a trademark in that (1) its purpose is to certify, not to indicate source, and (2) it is not used by its owner but by authorized third parties. Examples are a professional credential or product seal. It is important to note that the mark used as a certification mark may not be the same as the organization's other trademarks or service marks.



3 Registering your mark is a good idea.

Registering a trademark provides benefits not available to someone who is merely the first to use a mark. For example, registration entitles the owner to seek statutory damages and attorneys' fees in an infringement action and also creates presumptions of ownership, nationwide use, and the exclusive right to use the mark. Registration also makes it easier for someone to enforce its trademark rights against an infringer. Remember: Registration will cover only the products or services on which the trademark is actually used.

4 But not all trademarks can be registered. The U.S. Patent & Trademark Office won't register trademarks that merely describe products or services. To gain the benefits of registration, marks must be distinctive when used with products or services. Arbitrary, fanciful, or suggestive marks are subject to the best protection (think Apple® for computers). If a descriptive mark has been used for more than five years, however, or the owner has other proof a mark has become well-known (e.g., substantial money spent on promotion), the trademark may be registered because it has become distinctive when used in connection with the relevant products or services.

5 The trademark registration process can be complicated and time consuming. Registering a trademark usually takes at least a year. After an application and supporting materials are filed with the USPTO, an examiner reviews the application and frequently raises questions, which must be addressed through correspondence. The USPTO also publishes the trademark so that anyone with a similar mark can raise an objection before the mark is registered.

The USPTO does not allow anyone to reserve trademarks indefinitely for future use or to keep registered marks that they are no longer using.

6 In the U.S., a trademark must be used in interstate commerce to be registered.

To be registered, a trademark must actually be used on goods or services in interstate commerce, or the owner must have a bona fide intent to use the mark in interstate commerce within approximately two years of filing. In fact, it's not enough just to advertise the availability of products or services for sale under a certain mark—someone must have bought the products or services (e.g., registered for the Lunch & Learn event or received a copy of *Signature* magazine) for use to be bona fide. The USPTO does not allow anyone to reserve trademarks indefinitely for future use or to keep registered marks that they are no longer using (see #12).

7 The USPTO won't enforce your marks for you. Registration provides important benefits in a lawsuit (see #3), but the owner is responsible for pursuing any infringers. If an unauthorized party uses the association's mark or a confusingly similar mark, the organization must send a cease-and-desist letter and, if necessary, pursue a court action to protect its trademark.

8 Keep an eye out for others' use of your organization's marks. Associations sometimes are lucky enough to learn about misuse of their marks from vigilant members or vendors. Monitoring your organization's registered trademark, name, or logo is a good idea. A monitoring service can tell you when another party has filed an application to federally register a mark that conflicts with your organization's registered marks, or when someone is using a conflicting mark in the marketplace. Active monitoring of registered marks is not necessary, however, to maintain the registration.

9 Avoid “naked” licenses. Don’t let another person or company use the association’s trademarks without a clear, written license agreement. The license should include standards for how and where to use the trademark, and give the association the right to review and approve all uses of the trademarks by the other party.

10 Put the world on notice the mark is yours. Although trademark notice isn’t required by law, using the symbols TM, SM, or ® communicates to others that the association claims a trademark as its own. The TM and SM symbols may be used on any unregistered trademark. The ® symbol may only be used after a trademark is registered.

11 Don’t let your mark go the way of the zipper. A “zipper” used to be known as a “Zipper fastener.” When a trademark becomes so popular that people use it generically, the owner loses exclusive rights in the mark. To protect against a mark becoming “genericized,” always use trademarks as adjectives together with a common term for the product or service (e.g., WidgetworldTM conference).

12 Registration doesn’t last forever. Between the fifth and sixth years after a trademark is registered, the owner must file proof with the USPTO that the owner is still using

the trademark in interstate commerce and that no one else has contested the owner’s right to use the mark. Between the ninth and tenth years after registration, and every 10 years thereafter, the owner must file proof of continued use to maintain the registration.

13 Don’t be fooled by trademark protection companies. Several companies recently have sent out urgent notices to owners of federally registered marks in the U.S. The notices appear official and imply that the targeted trademark owner must pay significant sums of money to the notifying company to protect their registered marks. Private companies send the notices in an effort to convince trademark owners to use their trademark monitoring or filing services. Don’t be fooled into paying money for something without understanding exactly what you’re getting in return. ■



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