

## Frequently Asked Questions

### What is a Trademark?

A trademark is a word, phrase, symbol or device used to identify the goods and/or services of one party and distinguish them from those of another. A service mark is the same as a trademark, except that it denotes a service, rather than a product. Trademarks are valuable assets that embody the good will that results from the significant resources that businesses invest in building brand equity (e.g., through quality, customer service, marketing and advertising). Trademarks must be carefully protected and never allowed to be misused, or the value may be lost. The responsibility for proper trademark use occurs every time your company, its employees, spokespersons, testifiers, licensees, partners, etc., use the trademark regardless of the manner of use, e.g., on goods, in presentations, websites, marketing materials, etc.

### Do I Have to Use My Trademark to Maintain My Rights?

Yes. A U.S. registered trademark can be maintained only if there is continuous use of the mark in commerce across state lines. If use is solely within a single state, you may wish to consider registration under state law.

### What Constitutes Use for Trademark Purposes?

A trademark is used on goods if it is displayed on packaging and the goods are then sold or distributed to customers. A trademark is used with services when it is displayed during the performance of the services, or in advertising or promotional materials for the services.

### How Long Can My Trademark Registration Last?

U.S. Trademark registrations are valid for ten-year periods, and if renewed, can last for as long as they are used. Between the 5<sup>th</sup> and 6<sup>th</sup> year after U.S. registration, certain affidavits must be filed indicating continuous use in commerce or the U.S. registration may be cancelled. After that, renewal documents must be filed indicating current use every ten years, by the anniversary date of the original registration.

### What Does it Mean When a Trademark is Incontestable?

After the 5<sup>th</sup> year following U.S. registration, an owner may file an affidavit with the Trademark Office, seeking "Incontestable" status. This means the trademark cannot be challenged on the grounds of descriptiveness and is conclusive evidence of ownership and of the exclusive right to use the mark. However, it can still be challenged based on claims of fraud, genericness, abandonment, antitrust violations and functionality.

### Can I Make Changes to My Trademark?

It is important that the owner of a registered trademark use it in a manner consistent with what was registered. If you desire to make variations in the trademark, check with your trademark attorney first.

### Are There Marking Requirements?

There is no specific legal requirement for trademark notice, but the use of symbols next to a trademark is recommended. A ® should be put by registered U.S. trademarks, ™ should be put by unregistered trademarks, and ℠ should be put by unregistered service marks. Alternatively, you may use a small type legend to give notice that trademark rights are claimed (whether registered or unregistered), to identify the owner, and to indicate, if applicable, that the mark is used under license.

## Frequently Asked Questions (cont.)

### What is a Trademark License?

It may make business sense to allow another company to use your trademark on goods or services that your company does not offer. Trademark license agreements should be in writing and drafted with the assistance of an attorney. A poorly drafted license can result in the loss of the trademark rights, e.g., if the owner of the mark allows it to be used without exerting sufficient control over the quality of the licensee's goods or services with which the mark is associated. Trademark use by a licensee will qualify as "use" by the trademark owner for the particular categories of goods or services provided by the licensee in order to meet the "continuous use" requirement.

### How Do I Avoid Generic Use?

If a trademark is used generically, then it may be made non-distinctive, putting it in danger of losing its enforceability, e.g. cellophane and escalator. Once a trademark becomes generic, it is lost because the word or symbol no longer represents to the public that the goods were made, sold or supplied by a single entity. Proper use of a trademark can help prevent such losses. A trademark should always be used in text as an adjective, not a noun or verb, and it should always modify the goods or services for which the mark is registered. For example, one could correctly advertise "Buy Wingding® widgets," but not "Buy Wingding®" or "Buy Wingding's® widgets." Although it seems counterintuitive, a trademark should not be used as the name of the goods, or put in the plural or possessive form.

### What If I Want to Start Using the Mark on Goods or Services That Are Not in My Registration?

If the trademark is going to be used with goods or services beyond those in the current registration, a new application should be filed to include the new goods or services. Doing so with the help of an attorney will help ensure full protection for the trademark.

### How Do I Know When There is Infringement?

There is potentially infringement whenever a similar trademark is used by an unauthorized party. Monitoring of advertisements and trade literature is one way to learn of possible infringements. Additionally, an attorney can set up a formal watch service, which examines applications filed in the U.S. and elsewhere for potentially confusing trademarks. It is important to evaluate infringements and take steps to stop them where appropriate, or your valuable trademark rights may be diluted or disappear. Minor variations in spelling, punctuation or typography will not defeat infringement claims where the similarity (including phonetic pronunciation) is confusing.

### Do I Have Any Rights Outside the United States?

U.S. trademark registrations do not have any power in foreign countries. To obtain protection, a trademark must be registered in each country in which the trademark is used. An attorney can help you determine the availability of a certain trademarks in various countries, and what you need to do to apply for registration.

If you have additional questions about trademarks, do not hesitate to call us at Sachnoff & Weaver, 312-207-1000.

Greg Berenstein 312-207-6493  
Loletta Darden 312-207-2415  
John Hines 312-207-3876  
Len Rubin 312-207-6464  
Angela Washelesky 312-207-3854  
George Vinyard 312-207-6406