

ORANGE COUNTY REGISTER

+ ON THE LAW TRADEMARK MARKING - WHAT'S ALL THE FUSS ABOUT?

Trademarks are words, logos, slogans or designs that are used to indicate the source of a product or service. Providing proper trademark notice or "marking" is the practice of using a symbol to announce to the world that a word, logo, slogan or design is a trademark or service mark. The symbols that are used for marking are TM, SM and ®.

1. The TM symbol is used with unregistered trademarks used in conjunction with goods or products.
2. The SM symbol is used with unregistered marks that are used in conjunction with services rather than products.
3. The ® symbol is used to indicate that the mark is a federally-registered mark and it can only be used when the mark is used in conjunction with the specific goods or services listed in the registration certificate.

Why does Trademark Marking matter? Marking a trademark provides its owner with the following benefits:

1. It provides notice of its owner's claim of ownership;
2. It helps to educate consumers that the mark is a trademark, and not a generic term for a product or service;
3. It distinguishes the mark from surrounding text or graphics and helps to make it distinguishable;
4. It distinguishes the mark from another owner's mark when the two marks appear together on products, packaging, and advertising;
5. If it is registered and the registration symbol is used, it announces to the public that the mark is registered which serves as a deterrent to would-be infringers or copycats; and
6. It provides for additional potential monetary remedies in a trademark infringement lawsuit.

"Trademark marking is a beneficial tool to help trademark owners protect their brand and educate consumers."

What if your company does not use a trademark marking notice? Though it is not required, if your trademark is registered, but you do not use

the registration symbol, your company's potential monetary damages against an infringer will be limited, the infringer must have actual notice of the registration before your company can recover profits or damages from the infringement.

Must your company always use a marking symbol when a mark is used repeatedly in an advertisement, press release, or on a website? No, as long as you use the appropriate symbol at least once, either the first time it is used, or with the most prominent use of the mark. When in doubt, your company should err on the side of over-marking when repeatedly using a mark in written material.

How should your company's trademarks be displayed? Trademarks and service marks should always be displayed in a distinctive manner, by utilizing different fonts, sizes, colors, etc. from surrounding text. Further, always use your company's trademarks as proper adjectives, not nouns or verbs, because a mark is a brand name, not the name for the actual product or service.



Lindsay Hulley is a partner in [Rutan & Tucker's Corporate Section](#) and Intellectual Property Group where her practice focuses on trademark and copyright prosecution, and advising clients on the adoption and use of trademarks. She regularly represents clients in trademark applications at the United States Patent and Trademark Office and in opposition and cancellation proceedings before the Trademark Trial and Appeal Board. Lindsay also advises clients on the protection, enforcement, licensing and transfer of intellectual property. Her clients are varied and conduct business in the apparel, alcohol, food and beverage, vitamin supplement, gaming, automotive, e-commerce, real estate, hospital administration, dental, construction, cosmetics, marketing, software, fitness, financial, and communications industries. Lindsay can be reached at 714.641.3446 or lhulley@rutan.com.



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