

Proper Use of a Federally Registered Trademark

Now that you have a U.S. federal trademark registration it is critical that you use it properly.

Give Notice of the Registration

To recover lost profits and damages from an infringement of your federal registration you must “give notice” of your registration by one of two methods:

A. **Statutory Notice** which including any of the following:

- Registered in U.S. Patent and Trademark Office;
- Reg. U.S. Pat. & Tm. Off.; or
- ®

B. **Actual Notice** to the prospective defendant. This usually takes the form of a *cease and desist* letter enclosing a copy of the federal trademark registration.

Consequences on Damages: Failure to use the statutory symbol does not create a defense: it is merely a limitation on remedies. The trademark registration marking law is similar to that of patent law. The Federal Circuit has observed that the purpose of the patent marking statute is threefold: (1) to help avoid innocent infringement; (2) to encourage patentees to give notice to the public that the article is patented; and (3) to aid the public to identify whether an article is patented (*Nike, Inc. v. Wal-Mart Stores, Inc.*).

When to Give Notice

A company that purports to have a serious program of trademark protection will use the familiar ® or its statutory alternatives in connection with the use of all federally registered marks. It makes good sense before initiating an expensive marketing campaign to have your advertising agency send our office a proof. We can examine the use of your registered brand and determine whether it is properly displayed.

When not to Give Notice

Using the federal registration symbol ® adjacent a mark *not* federally registered is a misuse of the federal notice and a form of false advertising which may result in serious repercussions.

Such a misuse may constitute false advertising, a form of inequitable “unclean hands” so as to bar registration, the maintenance of an infringement case, or the assertion of trademark rights in an *inter partes* action in the Patent and Trademark Office. Pending federal applications or state registrations do not justify use of the federal statutory notice.

Associate the Trademark with Your Product

The ideal use of a brand connotes at least two points: (1) the product description; and (2) the trademark. For example: Toyota® automobiles; Xerox® photocopying machines; and Starbucks® coffee.



Do Not Use with Your Corporate Entity

Microsoft Corporation is a corporate entity based in Redmond, Washington. Microsoft® is a federally registered brand covering a wide range of computer and software-related products. Do not use the federal registration symbol when identifying your company name. For example, XYZ®, Inc. is almost certainly improper.

Use Caution when Licensing

Licensing your trademark is permissible only if you exercise ongoing oversight and quality control. Failure to do so will result in the abandonment of the mark. See us for agreements.

Use the Trademark as Registered

If you register a trademark then decide to make some changes to it please contact us immediately. Changing the way you present the trademark may result in the abandonment of your federal registration.

Keep your Contact Information Updated

A properly maintained trademark may last forever. Renewals are due every ten years. Furthermore, there is a declaration of continued use due between the fifth and sixth year from registration. Keep your contact information updated with our office so that we may provide you with the necessary requirements for maintaining your federal registration.