

BZ/Brief

TRADEMARKS

They Aren't Copyrighted — They Are Protected

People call our office all the time about using particular names, short phrases, expressions, symbols or images. Often they want to use such commercial identification marks and don't know if they can. These "marks" generate much confusion which could use some clarification.

Different Laws, Different Results

The U.S. Copyright Office is very blunt about having nothing to do with these commercial IDs. It says, "Copyright registration cannot be made for names, titles, and other short phrases or expressions."

All of the above and more, except titles for single works (a book or a song), *can* be protected under the Federal trademark statutes of 1946 and 1989, and by international agreement (the Paris Convention). For information about registering a "mark," check the Patent and Trademark website at www.uspto.gov or write the Commissioner of Patents and Trademarks, Washington, D.C. 20231, not the Copyright Office.

Federal registration does not create protection for a "mark," however. Commercial *use* does; and "marks" of all sorts from slogans to golden arches can be protected even if they are not federally registered, although registration provides good evidence of ownership in case of a dispute. Furthermore, this protection does not lapse after a specified time like a copyright; as long as the "mark" is being actively used, it can be protected. This protection can be lost, however, if the mark is used improperly.

What's in a "Mark"

A "trademark" is any name, symbol or device used by a manufacturer or dealer to identify its goods and distinguish them from goods manufactured or sold by others. Trademarks can be a word (Pepsi); letters (CBS); numbers (Chanel No. 5); slogans (Only her hairdresser knows for sure); distinctive symbols (McDonald's golden arches); container shapes (the Coca Cola bottle); even sounds (NBC's 3-note chime). When the superscript initials TM appear with the mark, it has been claimed; when the superscript ® appears, the mark is also registered.

Companies can own both a "house mark" (Kodak, Xerox) and specific "brand marks" (Kodachrome film, Beautyrest mattresses). Companies can own many marks; and some marks are owned by an association (SUNKIST is the trademark of a marketing combination of independent companies).

"Service marks" (superscript initials SM) identify services provided by particular companies such as insurance (the Prudential's rock). "Certification marks" usually represent an endorsement by the mark-owner of someone else's goods or services (The Good Housekeeping "Seal of Approval").

Taken together, all these commercial IDs are known as "marks."

Using Someone Else's Mark

These commercial marks are so prevalent in our society that they can become part of a presentation without anyone's noticing. Since the marks are owned by someone else, the smart way out is to notice and avoid them.

When inclusion of a trademark is unavoidable for some reason, the mark-owner's permission should be sought.

Mark-owners are particularly sensitive to any use that would turn their brand names into "generic" identifications that are no longer protected. Aspirin, escalator, thermos and yo-yo are examples of trade-marks that have become generic, unprotected, names.

Companies will not approve uses that could expose their marks to such a fate, but may not mind some free publicity. So, if a video character says, "Xerox this," permission will not be granted, while "Get me a Xerox copy" might pass (the Xerox Corporation is fighting a social trend to use its very strong trademark name generically). In texts, they want their trademarks capitalized and used *with* a generic term (Cuisinart food processor, for example). Otherwise, using a trademark *exactly* as its owner does—same type, same look, same identification purpose—with the appropriate superscript character, is more likely to be approved.

"Comparative advertising" is one place where a trademark on a product can be used without permission. But, this kind of advertising is so legally tricky that the active assistance of an advertising lawyer is essential.

Creating Marks

Any new product or service will want to go to market with its own mark. Doing a "trademark search" is absolutely essential before investing in the creation of a new mark. Some firms (not BZ/Rights) specialize in providing this service. One very well known trademark firm (and helpful in creating this *Brief*) is Thomson & Thomson of North Quincy, MA, 1-800-692-8833.

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