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About the Author

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Jonathan W. Brown is a partner in the firm's Intellectual Property and Commercial Litigation departments. Jonathan focuses his practice on the following areas of law:

- Intellectual Property
- Intellectual Property Litigation
- Commercial Litigation
- Copyright Law
- Trademark Registration
- The Rights of Privacy and Publicity

Jonathan has handled numerous matters in both California and New York including contractual disputes, license disputes, trademark infringement claims, copyright infringement claims, and proceedings before the Trademark Trial and Appeals Board and the U.S. International Trade Commission.

In addition, Jonathan helps to manage international trademark portfolios for several global entertainment and novelty companies.

For questions on any Intellectual Property related matter, please contact Jonathan at 716 849 1333 or via e-mail a jbrown@lglaw.com

INFORMATIONAL LEGAL GUIDE ON

Intellectual Property

Guide to Proper Trademark Usage

How to use it (properly) so you don't lose it

Just about any word, phrase, logo or symbol may qualify as a protectable trademark. However, even if you have the most original and distinctive designation, it will not qualify for trademark protection if it isn't being *used* as trademark.

In other words, not every single word, phrase, design or picture that appears on a package or in an advertisement qualifies as a protectable mark. Trademark rights are reserved for only those designations that perform the function of a trademark.

Packaging and Advertising: A Sea of Information

Often times, a designation appears on a label or in an advertisement along with lots of other visual material. In such a case, the individual seeking trademark rights must show that the designation at issue, *as actually used*, will be recognized *in and of itself* as an indication of origin for the particular product or service. Put differently, the designation claimed as a mark must create a commercial impression *separate and distinct* from all the other material appearing on a label. If it doesn't do this, it's merely background design, and not a trademark, regardless of what the producer may have intended.

An Easy Test: If You Have to Ask...

Trademark usage is usually immediately evident. Thus, for a designation to become a trademark, it needs to be used in such a way that its function as a trademark is readily apparent and recognizable without extended analysis or research. This is because in the ordinary course of shopping, customers don't spend long periods of time examining labels with a magnifying glass to find out who made them. Thus, if it isn't immediately obvious that a certain designation is being used to indicate source, then it probably isn't a trademark.

Make it Obvious

Some of the common indicators of whether a word, phrase or picture is being used as a trademark include: 1) larger-sized print; 2) all capital letters or initial capitals; 3) distinctive or different print style and/or color; and 4) prominent position on the label or advertisement. Accordingly, unless the seller or advertiser takes some steps to emphasize and set apart a word, phrase, logo or symbol, the chances are that consumers will see it as just another bit of merchandising embellishment or decoration, and not as an indicator of who made the product.

Use It or Lose It

Finally, it's important to remember that a designation must be used *consistently and repetitively*. If it's used only occasionally or in some other isolated

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way, a designation is not likely to be perceived by consumers as a trademark. Thus, the mark should be used so regularly that it creates a visual impression upon consumers and is instantly recognizable by them as a symbol of the product.

An Example

Below is an example of a product package. As indicated below, not every word, symbol, logo, or picture is protectable as a trademark.

The image shows a box of Sir Angry Pepe's Corn Syrup. The box features a central illustration of a man in a sombrero and poncho, holding a gun, with the initials 'A.P.' on his chest. The text on the box includes 'Tastes better going down!', 'SIR CORN SYRUP™', 'ANGRY PEPE'S™', 'BURNT TORTILLA SCRAPS™', and 'Made with 100% burnt, disgusting corn syrup'. A nutrition facts label is on the left side, and a small illustration of a cactus with a sombrero is at the bottom left. Annotations with dashed arrows point to various elements on the box, providing legal analysis for each.

- Tastes better going down!**: If used consistently with this product, this slogan may qualify for trademark protection despite its placement.
- SIR CORN SYRUP™**: Proper trademark usage.
- ANGRY PEPE'S™**: Proper trademark usage.
- BURNT TORTILLA SCRAPS™**: This is likely not a trademark because it simply describes the product.
- A.P.**: May qualify as proper trademark usage.
- Illustration of the man in a sombrero**: This is likely ornamentation.
- Made with 100% burnt, disgusting corn syrup**: This is not a trademark, but rather, just describes the product.
- Small cactus illustration**: Ornamentation (likely not trademark usage)
- Bottom text and graphics**: These designations have the potential to be protected as a trademark; however, the usage and placement of these designations (i.e., words and picture) is poor.

Obtaining Additional Information

While this guide provides an overview of how to ensure your designation qualifies for trademark protection, there are more in-depth variables to consider. If you have specific questions or would like additional information regarding the protection of your trademark, please contact me at any time by calling **716 849 1333 ext. 371** or via e-mail at jbrown@lglaw.com.