

THE C & D NEWSLETTER



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A LAW CORPORATION

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PROTECTING TRADEMARKS, SERVICE MARKS AND TRADE NAMES

A trademark, service mark or a trade name is often a valuable asset of a business. This Newsletter shall discuss the methods of protecting these valuable assets.

Trademarks. A trademark is a word, name, slogan, picture or symbol adopted and used by a person to identify goods made or sold by that person and to distinguish them from goods made or sold by others. A trademark may be protected throughout the United States by registration of the mark with the U.S. Patent and Trademark Office, or in California by registration with the California Secretary of State. Registration of a trademark is prima facie evidence of the registrant's ownership of the mark and of the exclusive right to use the mark. After registration of a trademark, it is advisable to use the statutory notice (R in a circle) whenever the trademark is used; prior to registration the designated TM may be used. A federal trademark registration is valid for ten years, and may be renewed for another ten year period; however, the trademark registration is subject to cancellation if an affidavit of continued use is not filed during the sixth year of use. In California, a trademark is effective for ten years, and may be renewed for successive ten year periods. The owner of a registered trademark may sue anyone who uses any imitation of the trademark in connection with the sale or advertising of goods or services if the use is likely to cause confusion or deception. The remedies available for infringement of a trademark include monetary damages, an injunction against future use, and the destruction of infringing products.

Service Marks. A service mark is similar to a trademark, except that a service mark identifies a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others. Service marks are registered in the same manner as trademarks and are entitled to the same legal protection.

Trade Names. A trade name is a word or symbol used to identify a business. A trade name cannot be protected as such under federal law, although a trade name may be registered if it is used as a trademark or a service mark. In California, a trade name is protected by filing a fictitious business name statement in the counties in which the user is doing business. Once the statement is on file with the county clerk, it must be published in a newspaper of general circulation in the same county once a week for four consecutive weeks. A California corporation that conducts business under a name other than the name in its articles of incorporation is required to file a fictitious business name statement in the county in which its principal place of business is located.

Conclusion. If a company is using a name, symbol, or slogan that has or will become identified with the company's products or services, it is important for the company to register the name, symbol, or slogan as a trademark or service mark, and to take appropriate action to protect the mark from infringing uses. Trademarks and service marks are protected by registering the mark with the California Secretary of State (if the mark is used only in California), or with the U.S. Patent and Trademark Office (if the mark is used nationally). Registration of the mark protects the owner of the mark against other people using the same or a similar name or symbol. A fictitious business name statement should be filed whenever a business is being conducted under a trade name.

This complimentary newsletter is intended to provide general information. Because of the complexities and constant changes in the law, it is important to seek professional advice before acting on any of the matters covered herein.