

Protect Your Logo

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Think of an elegant woman in a side-view silhouette wrapped in an oval—a nice logo for a line of linens or fancy greeting cards or other items. How would you prevent other vendors from stealing it?

There are actually three separate ways under federal law, one of which many intellectual property lawyers wouldn't think of. One is in the middle and often thought of. One is expensive and almost useless. One is effective and inexpensive.

Most people would think first of registering a *trademark* with the US Trademark Office in the Commerce Department, and that is good protection, but expensive. Trademark protection by law began in England in 1266, when bakers were allowed to mark their breads to protect the public against one baker illegally passing off his goods as that of another. The descendant of that law allows one to mark goods and services in the US and register the mark. Generally, if someone tries to use the same mark as an earlier registered one, and the later is likely to be confused with the first or dilute the value of the first, the later will be prohibited from use.

You cannot register a trademark unless you are actually using it in commerce or plan to within six months. If you stop using it for three years, you abandon the registration. Registration is by category of goods or services, and there is a fee (now \$325) for each category, plus whatever your lawyer may charge for writing and advocating for the application. Once you obtain it, if you continue to use the mark in commerce and pay the maintenance fee you can keep the registration forever. A registered mark is indicated with a ®, and it is a crime to falsely use it. Until you register, you can indicate your intent to defend your mark with a ™ or ℠. TM is for goods while SM is for services.

A trademark registration is useful. An infringer can be made to pay damages, and one can get an injunction in certain circumstances. But you must prove your infringer is or potentially is causing confusion with your products or diluting your good name. Registration applies only to those product categories you apply for, and only if the official examiner finds no one else claiming your mark. It applies only in the country where registration is made.

Registration of a trademark, like a design or other patent, carries no right to use—if your use of the trademark would infringe someone else's mark. So, do factual research on other, similar trademarks. Also, if you authorize someone in the US to make and sell goods with your trademark on them, any further sale is beyond your control. You can control your logo by not authorizing anyone to do that or by limiting resale by contract.

What other protections are there? A bit more obscure is the “design patent.” A design *patent* is a property right that allows you to control the use of a particular non-functional ornamentation of a functional item. That means the ornament cannot help make the item work, only decorate it. Unlike a trademark, you do not need to use a design patent in commerce to get or keep it. It lasts only 14 years from issuance, with no renewals. It only protects your logo when it is part of a product, not in an ad. Long ago the Coca-Cola bottle shape had a design patent. It costs more than a design *copyright*, it must be novel and non-obvious, and is short lived. It protects your logo only when that logo is placed on some object as an ornament, not for example in an ad. Like a trademark, it is country by country. I rarely advise people to seek a design patent.

The most obscure protection is a design *copyright*. But if you qualify, it is cheap and effective. Generally, a logo—*if a work of visual art, not a mere string of letters*—can be registered for copyright. Think of Target Stores' target.

For details on how to register, which can be done with a drawing on paper or a digital photo, see Copyright Office circulars 40 and 40A at the Office's website, <http://www.copyright.gov/>. Registration promptly gives advantages, such as easier proof of damages for infringement, and is required for an infringement suit. Registration online using an electronic file costs \$35. Copyrights on works created and first published after 1/1/1978 last for the author's life plus 70 years.

A copyright registration carries with it the *right* to make copies and distribute them. Anyone in the US who makes copies with your permission, such as placing the logo on a package with your OK, can sell them to anyone else. But by controlling that permission, you can control your logo.

No official examines whether there is a prior such creative work. In general, a US copyright is honored throughout the world via reciprocal treaties. The chink is that someone might claim independent creation without access to yours. The solution is to do something imaginative and complex so no jury will think it was created twice by different people. A design copyright allows for damages against infringers and destruction of infringing products.

You can get a measure of control over your logo or similar 'trade dress' by careful use of copyright, trademark and patent law. Copyright is inexpensive and effective. Trademark is more expensive but covers typographic logos. A design patent is expensive, brief and of little use.

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