

Ohm's Law: Notice Me - the ® Symbol

By Hun Ohm*

You're an eyewear designer on the rise, known for your unique blend of camp and haute couture. And your skills don't end with your ability to blend quirky colors with sleek quarter-rimmed designs. Your latest line is branded with a catchy term that becomes immediately emblazoned in the consumer's mind. Word of mouth and a steady Twitter feed have increased the number of visitors to your website each week. People are noticing, and unsolicited comments on your blog confirm that you are on the cusp of something big.

But you are also a start-up and need to watch your budget, and you've made the decision not to seek federal registration of your brand at this time. Still, ever resourceful, you have decided to take some steps on your own to stake a claim to your marketing genius. You've reviewed some of the established brands in your field and see that they have adopted a clever shorthand to make clear that their brand is a trademark that no one should mess with - they use the classic ® symbol with their brands.

And so you've found your quick solution. Each time your brand appears on your website and marketing collateral, you've inserted the ® symbol to likewise make clear that this is your brand, and not free for the taking. Everything looks quite official and good, and you pat yourself on the back. Additional protection and gravitas without the additional expense. Voila!

But there's a little problem with your solution. It's not permitted. In the United States, the ® symbol, sometimes referred to as a registration symbol or statutory notice, can only be used in association with federally registered marks, and only then in association with the goods/services listed in the registration (other forms of statutory notice include "Registered in U.S. Patent and Trademark Office" and "Reg. U.S. Pat. & Tm. Off."). Among other things, the ® symbol provides notice to the public that your mark is federally registered (and thus is entitled to all of the benefits resulting from a federal registration); in other words, infringers beware.

However, if you have not in fact registered your mark but nevertheless use the ® symbol, there could potentially be serious consequences. Misuse of a statutory notice with the intent to deceive the public into believing your mark is registered can be grounds for denying the registration of an otherwise registrable mark. Furthermore, if you engage in such intentional and deceptive misuse, you might find yourself facing false advertising and unfair competition claims, which is likely not the kind of notice you were looking for. Simply put, your misuse could needlessly disrupt your business and undermine your ability to protect your trademark.

On the flipside, if you have gone ahead and federally registered your trademark, but fail to utilize the ® symbol in connection with your mark as used in relation to the goods listed in your registration, there could be negative ramifications. While such failure does not create a defense to infringement, it could limit your ability to recover profits and damages from the infringer. The easy lesson here is that if you go through the effort and expense of securing a federal registration for your mark, it makes sense to conscientiously and properly use the ® symbol in order to maximize the benefits your federal registration provides.

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So back to our eyewear designer. While your first step should be to immediately stop misusing the ® symbol in connection with your unregistered mark, you are not left without some options moving forward. For example, you can utilize a ™ symbol in connection with your mark which will at least provide some notice to the public that you are claiming trademark rights in your brand. And although your original solution for notice might not have worked out the way you planned, you might still consider filing a federal trademark application for your mark which, if a registration ultimately issues, will get you the statutory notice you desired in the first place.

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