



## Protecting an Association's Trademarks

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An association's trademarks are usually among its most important assets. Nonetheless, in our practice we often find that associations are not doing everything they can to protect those valuable assets, particularly in light of the enhanced risks that arise with social media. This article briefly discusses the basics of trademark law and sets forth the benefits of registering an association's trademarks.

Many people confuse trademarks with other intellectual property rights. A trademark can be a word, slogan, phrase, logo or design that is used by a person or entity to identify a product or service. It is intended to help ensure that consumers are able to obtain goods or services with a particular standard of quality. "M&Ms", "Pepsi" and "AARP" are examples of well-established trademarks.

One does not need to register a trademark in order to gain ownership of the mark. Instead, ownership can be established by actual use in commerce. In most instances, the entity that first used the mark will be given priority. In order to maintain ownership, one must use the mark continuously in United States commerce.

However, although not required, it is usually strongly recommended that an association register its trademarks with the United States Patent and Trademark Office (the "USPTO"). An association's trademarks can include its: 1) name; 2) acronym; 3) slogan; 4) logo; 5) tagline; 6) magazines or other publications; and 7) tradeshow name.

Among the benefits associated with federal registration of a mark are: 1) it provides formal notice "to the world" that the association is using the mark; 2) it constitutes *prima facie* evidence that the association owns the mark; 3) it allows for the association to bring suit in federal court in cases of trademark infringement, and affords the possibility of increased damages; 4) after a certain amount of time it becomes extremely difficult for a third party to claim it has ownership rights in the mark; and 5) it is much easier to protect a registered trademark.

It is important to note that not all trademarks may be registerable. The level of protection afforded a mark, or indeed, whether a mark is entitled to any protection whatsoever, depends upon its distinctiveness. Generally speaking, the more distinctive the mark, the stronger the protection available. The strongest marks are ones that do not suggest

or describe the services they provide. Marks such as “Apple” or “Kleenex” are examples of “strong” marks. However, associations by nature usually use weaker marks. For instance, the name of an association usually describes what type of organization or industry it promotes, therefore making the mark inherently descriptive.

This does not mean that the association cannot register its name with the USPTO. If an association has been using its name for a long period of time (at least five years) it can claim that the mark, through its use in commerce, has “acquired distinctiveness.” Additionally, newer marks can be filed on the Supplemental Register where, through continuous use in commerce, they may acquire secondary meaning and be granted full trademark protection.

Finally, proper registration of an association’s mark is crucial. In order to maximize the protection afforded to the mark, one must ensure that the mark is registered in the proper category and the proper class, the registration accurately describes all goods and services associated with the trademark, and that one has submitted the proper design or logo. Therefore we recommend that you review your trademark applications with legal counsel prior to filing to ensure they will be properly registered.

### **Conclusion**

While registering an association’s trademarks requires a certain amount of cost and effort, these efforts are important in protecting what may be the association’s most valuable assets. Please feel free to contact us if you want to discuss specific steps your association should take in protecting its trademarks. Brendan Collins can be reached by telephone at 202.342.6793 or by email at [bcollins@gkglaw.com](mailto:bcollins@gkglaw.com).