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Legally Speaking / The Same Only Trademark

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Legally Speaking

The Same Only Trademark

Column Editor: Glen Secor (YBP, Inc.)

Over the past couple of years in this column, we have taken up numerous aspects of copyright law. This issue and next, I thought it might be worthwhile to examine a not-too-distant cousin of copyright, namely trademark law.

As consumers, we are all familiar with company and product names as trademarks. This article is being written on word processing software from the Microsoft Corporation. "Microsoft" is a registered trademark of the Microsoft Corporation. My computer sports one of those little blue and white stickers which says "intel inside." The phrase "intel inside" is trademarked, perhaps along with the actual design of the sticker. My bookshelf, probably like yours, contains *The Bowker Annual*. The word "Bowker" in the title is followed by the registered trademark insignia (the circled "R"), as is "R. R. Bowker" as printed on the front cover and the title page.

Trademark is a rich and complicated area of law, though, extending to more than product names and logos. Some of the most interesting applications of trademark law are found in publishing and related industries. In this column, I will discuss some of the basics of trademark, saving some of the more interesting publishing-related applications for the September issue of *ATG*.

Trademark is generally considered to be one of the three primary areas of intellectual property law, the other two of course being copyright and patent. The genesis of trademark law, though, is very different from that of copyright or patent law. Copyright and patent protection, if you recall, is rooted in the Constitution and is intended to promote progress in the arts and sciences. Trademark, on the other hand, has grown up from common law ("judge-made" law) of the states and is grounded primarily in the law of unfair competition.

Copyright and patent are matters of federal law: states are not allowed to expand or restrict the monopoly granted by federal copyright and patent protection. There is no such thing as state copyright or patent protection, and even other state laws, such as those for unfair competition or misappropriation of trade se-

crets, cannot be used to circumvent federal copyright and patent law. In contrast, both federal and state law protect trademarks. State trademark law, whether common law or statutory, protects trademarks within a given state. Federal trademark law, as set forth in the Lanham Act, 15 U.S.C. sec. 1051, et seq., provides national protection. Thus, if a trademark is not registered nationally, it is possible for that mark to be used by different parties in different states or regions, although a party may have exclusive use of a mark within a given state based upon state trademark law.

As noted above, trademarks encompass more than product names and logos. The federal statute defines trademark as "any word, name, symbol, or device, or any combination thereof — used by a person, or which a person has a bona fide intention to use . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." (U.S.C. sec. 1127) The same section sets forth a similar definition for service marks, which are used to distinguish services rather than goods.

This is a loaded definition which cannot be fully fleshed out here. It is worth noting certain highlights, though. One such highlight is the breadth of the phrase "any word, name, symbol, or device." It has been interpreted to include art work and other distinctive packaging features, as well as the overall image or impression created by the product or service (the "trade dress"). In other words, virtually any distinctive feature of the product or service, subject to certain restrictions discussed below, which serve to distinguish one product from another can be trademarked. This raises some interesting possibilities concerning book and journal titles, literary characters, etc., which will be taken up in the next issue.

Note that use or intent to use, not mere creation, is required. This underscores some of the legal and conceptual differences between trademark and copyright. Copyright, if you recall, attaches at the time a work is created, ie. when it is put down on paper (or on computer).



In this sense, the copyrighted work truly is the intellectual property of the author or his/her successors in interest. Trademarks, on the other hand, which are rooted primarily in unfair competition law, only come into being when the possibility for misappropriation arises, ie. when the mark is put into use or is intended to be put into use. Further, trademarks, unlike copyrights, are sustained only so long as they remain in use. Your copyright in that short story you wrote remains in force for the statutory period even if you tucked the only copy of it away in your desk drawer. A trademark or service mark must be in fairly continuous use in order to remain valid.

The most important requirements for trademarks are that they distinguish one person's goods from another's and that they indicate the source of the goods. Distinctiveness is the key. There are various types of marks and levels of distinctiveness which federal and state authorities consider when registering trademarks and which courts evaluate when enforcing them. I will not go into those details here, but will note that the interests of three parties or groups are weighed when evaluating or enforcing a mark: the applicant (ie. the user of the mark), the competitors and potential competitors of the applicant, and consumers.

Again, keep in mind that unfair competition is the foundation of trademark. The applicant seeks protection for the goodwill which (s)he has gained or hopes to gain through the use of the mark. It would not be fair if others could steal or eliminate this goodwill simply by copying trade names, logos, etc.. The mark, though, cannot be so generic or descriptive as to preclude others from marketing competing products. That would be uncompetitive. This is why *Software News* was found to be not protectable as the mark for a software magazine (citation omitted). Finally, and perhaps most importantly, consumers must be able to regard a mark without being confused or misled. It does not matter whether the consumer knows exactly where Snickers candy bars come from (ie. who manu-

On the Road

A glimpse at "Life in the Trenches"

Column Editor: **Don Jaeger** (Alfred Jaeger, Inc.)

All stories, all anecdotes, all shared experiences are welcomed. Fax them to 516-543-1537, or mail to Don's attention at Alfred Jaeger, Inc., 66 Austin Blvd., Commack, NY 11725-9009. — DJ

I am pleased to include the stories submitted by a fellow editor of *Against the Grain*, **Nat Bodian**. He recently wrote to me as follows —

"Dear Don: I enjoyed your 'On the Road' pieces in the April issue of *ATG*. I've had similar experiences in many years of exhibiting on the road for various book publishers, and earlier in my capacity as head of sales and promotion for The Baker & Taylor Company."

Nat also writes, "I was intrigued by your 'This Trick Was No Treat' article about the vendor who set up his exhibit in a convention booth, only to find his 'friendly' competitors had

transferred it to the men's room. In my several decades in publishing, I had my own share of problems with exhibit set-ups at various conventions. But one stands out particularly in my memory because it was done with the best of intentions."

So — here are two stories! How about some stories from the recent ALA Midwinter Meeting held in February in Los Angeles (flights canceled due to a snow storm on the east coast, tremors and aftershocks)? Also, stories from our international librarians about the recent UKSG Meeting, or other regional travel episodes. We would like to hear from you!

Cards, Anybody? or What To Do For a Competitor's Pyramid by Nat Bodian

I remember one national library meeting when I, as head of B&T sales, had visited the exhibit of one of my competitors a day before the opening of the meeting. My salesman, Frank Short, was with me and he was admiring a book pyramid floor display of a currently hot title. In his admiring touch, the entire pyramid collapsed like a house of cards. My first instinct was to rebuild the pyramid. But then I thought, how would it look for the sales manager of Baker & Taylor to be found rebuilding a competitor's book display in a hotel ballroom? Frank and I, seeing no one in view, fled, leaving the collapsed house of cards where it fell.



Thanks But No Thanks! The Road to Exhibits is Paved With Good Intentions by Nat Bodian

It had been my practice, in attending scientific meetings and conventions, to arrange my book displays in specific interest groupings. At a chemistry meeting, for example, all books on analytical chemistry would be grouped, all books on biochemistry would be grouped, and so on. In this way when a visitor came into the booth (often a multiple booth display of 20 to 40 feet width) he or she would be able to find all titles of special interest in a single location.

At one meeting, the company I was employed by had

decided to give new staff some working experience at company exhibits, and dispatched one to this meeting. He arrived at the booth several hours before I did on set-up day, and by the time I came on the scene he proudly told me he had already opened the cartons of books and set them up on the tables and shelves provided. "I did it very scientifically." What he had done was to arrange all the books by their jacket colors and he pointed out — "Look, I have all the reds here, all the blues there, and all the greens over there." ☛

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factures them), so long as (s)he is assured that today's Snickers bar is the same product from the same place as yesterday's Snickers bar.

Assuming that a mark meets all of these requirements and is eligible for

trademark or service mark protection, the user of the mark must decide whether or not to register it. State law protection can be obtained by usage or by registration at the state level. Federal protection requires federal registration. Federal registration provides nationwide constructive notice of the mark, meaning that subsequent users of the mark cannot re-

quire any rights in it and could in fact be infringing upon it. Federal registration also allows access to federal courts for infringement suits. ☛

**NEXT ISSUE: Infringement,
publishing-related topics**