

# Guidance on the correct use of trade marks in a business—checklist

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It is important for the proprietors of trade mark registrations to ensure that they are used correctly, so as to ensure that they are recognised by the public as badges of origin for the goods and/or services in respect of which they are used, and to minimise the risk of challenges by third parties on the basis that the marks have become generic or misleading, or that they lack distinctiveness.

For more information, see:

- [Trade mark transactions and management—overview](#)
- [Managing a trade mark portfolio](#)
- [Removal of trade marks from the register](#)
- [EU trade marks \(EUTMs\)](#)

To assist, clear 'guidelines on trade mark usage' should be created, and training provided to internal teams, as well as to third-party users of trade marks such as distributors, advertising agencies and retailers, as to the correct usage of trade marks. A checklist of points to include in such guidance is set out below:

## **Only use the trade mark as registered, without variations and abbreviations**

This applies to both the written and oral use of the trade mark.

### **Distinguish the trade mark from the surrounding text**

A trade mark should be used in such a way that it is distinguished from the surrounding text. This can be done, for example, by capitalising trade marks completely, by the use of different font, lettering-size, and by the use of an initial capital letter with quote marks. Acceptable examples include:

- COLGATE TOTAL
- *Colgate Total*
- **Colgate Total**
- 'Colgate Total'
- the words COLGATE TOTAL are a trade mark of Colgate-Palmolive Company (in the case of an unregistered mark)

## **Use the trade mark as an adjective, not as a noun**

The trade mark should be used as an adjective, rather than as a noun. For example, the following should be avoided:

- Buy our new COLGATE TOTAL
- AJAX for cleaning the floor
- COCA COLA for quenching thirst

Each of the above uses encourages others in the trade to use the trade marks as product names themselves, rather than as trade marks to distinguish one proprietor's product from that of another.

The trade mark should therefore be followed by the common descriptive name (noun) of the product or service it modifies:

- Buy our new COLGATE TOTAL toothpaste
- AJAX products: No 1 as cleaning agent
- KENCO coffee hits your taste buds

In short, as a minimum requirement, use the product/service generic term in addition to the trade mark at least once in every written communication and preferably the first time the mark appears, eg KLEENEX tissues, VASELINE petroleum jelly, PAMPERS nappies.

### Other formats to avoid

The following formats should also be avoided if possible:

a) Plurals	COLGATE TOTALs go straight to the target
b) Verb use	For floor protection needs—AJAX it!
c) Possessive	COCA COLA's qualities are well-known
d) Qualifications	Avoid using qualifications such as 'size', 'kind', 'type', 'genuine', 'original' or 'real' in conjunction with a trade mark

The use of plurals, verbs and the possessive encourage genericism.

If qualifications such as 'size', 'kind' and 'type' are used in conjunction with a trade mark, there is a risk that the distinctiveness of the mark will be weakened. In addition, qualifications such as 'genuine', 'original' and 'real' should be avoided as they acknowledge the presence of imitators.

### Maintain a consistent style

Do not deviate from an agreed typeface or style; it will help both to reinforce the brand image and to identify to third parties that you are aware of the importance of trade mark protection.

If any updating of image is undertaken, the change should be made consistent throughout the mark's use; no variations on the agreed new format should be accepted.

### Advertise your trade mark rights to the world in general

a) Use of ®	This is for registered trade mark rights only and must not be used alongside an unregistered mark or a mark which is the subject of a pending application.  In the UK, pursuant to <a href="#">section 95</a> of the Trade Marks Act 1994, it is a criminal offence to falsely represent that a mark is registered, if you know or have reason to believe that the representation is false.
b) Use of ™	This symbol is commonly used to denote the existence of an unregistered trade mark. It has no legal effect, but it is sensible to use it as a deterrent. Marking unregistered trade marks in this way can also be helpful when it comes to demonstrating that goodwill or reputation have been accrued in a mark, if it is necessary to assert it in a passing off action.
c) Use of 'brand'	It is advisable to use this in conjunction with the trade mark on some occasions to reinforce its function as a trade mark, ie the MARS brand.

For maximum protection, use the symbols ® and ™ as appropriate, on all printed matter relating to the trade mark, from packaging, to invoices, to job advertisements, and in trade announcements.

Where possible, indicate at the foot of the text, and definitely somewhere in the body of the document incorporating the trade mark, that the mark belongs to you, with sentences such as 'COLGATE TOTAL is the registered trade mark of Colgate-Palmolive Company'.

On a website, it may be more appropriate to create a 'Terms of Use' section, instructing users that any trade marks on the website, whether marked or unmarked, might be your registered or unregistered trade marks and that they cannot be used without written permission from you. You can include an email address if you are willing to accept requests regarding use of your marks.

## Do not allow your trade mark to become generic

It is crucial that trade marks retain their function as badges of origin and are not perceived by consumers as a mere description of the nature of the goods or services in respect of which they are used, or become generic. If your mark becomes generic, it becomes free for others to use—including competitors. Examples of marks that have become generic include TRAMPOLINE, ESCALATOR, YO-YO and BAND-AID.

You therefore need to take every opportunity to vigilantly protect your trade mark by reminding the public of the distinctive character of your trade marks as indicators of the origin of your goods and services, for example, by:

- placing advertisements periodically in trade journals, which refer to your ownership of the trade marks and their use by licensees
- checking the internet discussion fora, influencer blogs and popular media etc for incorrect usage and taking steps to encourage correct usage
- notifying major wholesalers and retailers of your trade mark rights and encouraging them to take the necessary steps to obtain end users adoption of correct usage
- encouraging all within the vertical distribution chain to be alert and report blatant misuse