

Branding for Fun and Profit



By David R. Ellis

The most famous and valuable brand in the world is considered to be Coca-Cola, which has been making soft drinks for more than 125 years. General Electric and General Motors have been selling light bulbs and cars with their GE and GM logos for over a century.

Newer brands like Apple and Macintosh also have appeal, as do Nike with its Swoosh, McDonald's with its Golden Arches, and Google with its rainbow lettering. Popular sports teams like the Rays and Buccaneers attract millions of fans to attend their games, buy hot dogs and beer, and wear merchandise adorned with the teams' distinctive logos.

Brands – what we lawyers call trademarks – can be worth billions of dollars to businesses seeking to entice consumers to buy and use their products and services. For a company, choosing good trademarks and logos is imperative for establishing brand identification and customer loyalty in an often-crowded marketplace.

Branding is a matter of selecting the names, logos, symbols and designs that identify a business's goods and services and distinguish them from those of its competitors. Trademarks and service marks are the legal vehicles to protect these branding devices and insignia.

When a trademark is used in connection with services, it is called a service mark. When a company adopts, uses and registers a trademark or service mark, it secures the right to prevent others from using the same or similar mark in a manner that could confuse, deceive or mislead the public.

If a firm provides goods or services in more than one state, it may secure a federal trademark registration from the U.S. Patent and Trademark Office (USPTO) in Washington. The federal law is the Trademark Act of 1946 (Lanham Act), 15 U.S.C. §§1051 et seq.



A federal registration lasts for ten years and may be renewed for as long as the owner continues to use it. The registration gives the owner the exclusive right to prevent others from using the trademark in a manner that would create a likelihood of confusion to consumers throughout the United States, and to enforce its right by suing in either federal or state court.



Before a business attempts to register a trademark, the company or its attorney should conduct a clearance and availability search to determine whether anyone else has adopted, registered or applied for the same or similar mark for similar or related goods or services. The search should include the records of the USPTO, state trademark offices, trade directories, and the Internet in order to reduce the chance of adopting a trademark that conflicts with marks already in use by other firms.



If a business is selling its products or services only in Florida, it may register the trademark with the Department of State in Tallahassee. A Florida registration is good for five years and may be renewed for subsequent terms of five years as long as the company continues to use it.

Once a trademark is registered, either at the federal or state level, the registrant may bring suit against infringers. Infringement is the unauthorized use of the trademark for any product, service or advertising where the use is likely to cause confusion or mistake or to deceive the user as to the source of the goods or services.

When that happens, a court may order the violator to cease its unauthorized use of the trademark, order infringing products destroyed, and award money damages to the trademark owner, which may be trebled in certain instances. In determining the amount of damages, the court can order the infringer to pay the trademark owner all profits derived from its wrongful use, plus court costs.

In cases of infringement under the federal statute, the court may award attorney's fees in "exceptional cases." Under the Florida statute, however, an award of attorney's fees may be ordered without a showing that the case is exceptional, so in some instances it is advisable for the trademark owner to register its marks under the state law in addition to the federal act.

David Ellis is a Largo attorney practicing trademarks, copyrights, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and Board Certified in Intellectual Property Law by the Florida Bar. He is the author of the book, A Computer Law Primer, and has taught Intellectual Property and Computer Law as an Adjunct Professor at the law schools of the University of Florida and Stetson University. For more information, see www.davidellislaw.com, or email ellislaw@alum.mit.edu.