

# Leaving Your Mark

## Trademark Tips for Writers & Publishers

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### How do you protect your writing investment? One word: Trademark. And these four simple steps.

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You've created a new website, brand and/or publication that's gaining traction. So how can you prevent some malevolent (or even innocent) intruder from adopting a similar brand and wooing away — or confusing — your growing audience? Trademark it. Use these four steps to guide you.

#### 1. Select a protectable mark.

First, a quick note: Generally, courts refuse to recognize the titles of single works — books, movies, etc. — as trademarks because the titles identify the works themselves rather than the source (a mark, like the Nike swoosh, enables buyers to recognize that similar products or services sold under that mark come from the same creator). However, once a title is used on a series of goods or services (e.g., the books in the Twilight series), buyers know that these related works derive from the same source, so the title can now be recognized and protected as a trademark.

Too often, people looking to brand a new product or service choose a name closely connected to what they do. But if you call your website "A Writer's Blog" when it's just that, a writer's blog, you'll never be able to prevent third parties from using the same words for their own writers' blogs. So-called generic terms simply can't be protected by law.

Similarly, a name that merely describes what you do — say, "The Musings of a Writer" — is also hard to protect. The law does allow such descriptive terms to acquire trademark status if and when their owner can prove that people have begun to recognize the titles as brands, but until that time arrives, you can't stop others from using your moniker, and even afterward you remain subject to the public's right to use descriptive words descriptively.

Your smartest move is to find a mark that is at worst suggestive of the product or service you provide (say, "Roach Motel" for a cockroach trap), and is at best arbitrary (as in "Apple" for computers) or fanciful ("Kodak" for cameras).

#### 2. Clear the mark.

Wouldn't you hate it if, four months after launching your publication, you were to receive a nastygram from a lawyer in Sheboygan warning you that you're infringing the mark of his client, an author or publisher who a year before you created a brand with a similar purpose and similar name?

Before you invest time and energy in your mark, conduct a trademark search — first through the **U.S. Patent and Trademark Office database**, then via a search engine and any other available means — to confirm that your use of the mark won't infringe upon the rights of anyone else. Better yet, get help from a professional (e.g., a trademark lawyer) who knows what to look for.

### 3. Register the mark.

U.S. law protects trademarks from the moment they're used in commerce, whether or not they're registered. But the best way to secure your legal right to a mark is to formally register it with the Trademark Office. Note: If your use is entirely local and confined to a single state — e.g., a small print publication distributed in a particular locale — you may not be able to get federal registration. But each state has its own process for registering such local uses. Although state registration provides fewer benefits than federal registration, it's quicker and cheaper ... and may be your only option. The federal process often takes a year or more, but what matters most is the date you apply, so filing quickly is wisest. Although it's not cheap (expect legal fees if you use professional assistance, plus about \$300 for each mark you want to register), it's a small, necessary sum if the mark has real value.

### 4. Mark smartly!

Even if you've done everything by the book, your mark can be in jeopardy if you fail to use it properly — for example, if you use it generically (you will never hear the Xerox Corporation talk about “xeroxing” a work) — or grant permission to use it without formal controls, or allow others to use confusingly similar marks for related goods or services. This is where a trademark professional can keep you on the straight and narrow, and your mark as strong and valuable as your work.

For more information, please contact **Howard G. Zaharoff**.