

## Use of trademarks in the U.S.



**Nicholas A. Kees**

414.287.9223  
[nkees@gklaw.com](mailto:nkees@gklaw.com)



**Alexander C. Lemke**

414.287.9313  
[alemke@gklaw.com](mailto:alemke@gklaw.com)

As North America brings its intellectual property laws in line with the United States-Mexico-Canada Agreement (USMCA), the way trademarks are handled in Mexico and Canada has recently changed. While [Mexico now requires a business to use its mark](#) to obtain a Mexican trademark registration, [Canada no longer requires the use of a mark](#) in order to obtain a Canadian trademark registration.

A business may spend significant resources attempting to use a trademark in the U.S., but ultimately fail to satisfy legal and technical requirements. Not only are such attempts wasteful, but they may also pose an obstacle to pursuing an otherwise legitimate trademark registration. To successfully register a trademark in the U.S., a business is required to use the trademark on or in connection with its products and/or services, but the law has different requirements for each.

### U.S. trademarks for products

For a trademark associated with *products*, advertising alone, such as use in a brochure or on a website, is not normally enough. The mark must be placed in any manner *on the products* or *on the containers* of the products, or on *tags* or *labels* affixed to the products. If the nature of the products makes such placement impracticable, then it may be acceptable for the mark to be used on *displays* associated with the sales of the products. Additionally, the products must be sold or transported in interstate commerce.

The simplest way to satisfy this requirement is to put the trademark directly on the products, such as by incorporating the mark into the mold of molded products, stamping or printing the mark onto the products, or applying a tag or label to the products carrying the mark. The mark could also be applied to the packaging or container of the products.

For an example of *displays* associated with the sales of a product, the mark can appear with the product in a catalog or on a website, but there are specific requirements for those uses. If used in a catalog, the mark must be accompanied by a description or picture of the product, and the same catalog page generally must include ordering information such as a phone number or a web address. If used on a website, the mark must still be accompanied by a description or picture of the product, and the webpage must include the direct ability to order the product, such as a “Buy Now” or “Add to Cart” button on the webpage.

### U.S. trademarks for services

For a trademark associated with *services*, the mark must be used or displayed in the *sale* or *advertising of the services*, and the services must be rendered in interstate commerce. That is, the services must be rendered in more than one state, or in some other way in interstate commerce, or in the U.S. and a foreign country, and the company rendering the services is engaged in commerce in connection with the services.

*The information contained herein is based on a summary of legal principles. It is not to be construed as legal advice and does not create an attorney-client relationship. Individuals should consult with legal counsel before taking any action based on these principles to ensure their applicability in a given situation.*

## Ensuring correct U.S. trademark use: The ABCD test

To ensure that your trademarks, aside from being placed on the products or used in connection with the sale of services, are being used correctly, use this ABCD test:

- 1. Adjective:** Use the trademark in the position of an adjective describing the product, followed by the common descriptive noun for the product. For example, use “KLEENEX tissue” not simply “a KLEENEX,” or “XEROX photocopier” rather than simply “the XEROX.”
- 2. Brand identification:** Properly identify the status of the trademark as a brand with the appropriate trademark symbol e.g., ® for a registered mark and ™ for a mark not yet registered.
- 3. Consistency:** Be strictly consistent in displaying the mark. If the trademark is punctuated, capitalized or colored in a certain way, it is critical to maintain the same formatting. Any change of any of those properties could be considered a change to the mark, that is, adopting a different mark. Such consistency will also help ensure that others recognize that this is a trademark and not just another word. While it makes sense for a company to adopt a different mark from time-to-time, such changes should only be done intentionally, after careful thought and transition planning, rather than by accident or in a casual attempt at creativity.
- 4. Distinctive:** Use the mark in a way that is distinctive, that sets it off from surrounding text, such as in a different typeface, color or capitalization.

**For more information on this topic, or to learn how Godfrey & Kahn can help, contact a member of our Intellectual Property Practice Group.**