

Trademark law 101, Part 1: Make sure a mark is clear for use before you invest in it.

## Is your studio name really yours?

In 2002, when Liz Vance, CPP, of Arlington, Va., adopted “Oh Baby Photography” as the name of her maternity and infant photography business, she knew the importance of branding. So she was shocked this year when another photographer opened a business with the same name, or “mark,” copied the opening page of her Web site, and used a nearly identical Internet domain name. “It was the first time I felt I had something to protect,” says Vance.

Most people don’t realize how much impact trademarks have on our daily life, and how they subliminally guide our buying habits. We often select established product brands—such as Coke, Tylenol, Tide—because we expect the product to be consistent with our prior experiences. Trademarks are no less powerful in the photography business. As people become familiar with the quality of your work and your reputation grows, the goodwill you’ve built with your customers becomes associated with the trademark you’ve used, even if you haven’t consciously used a trademark.

When customers come to associate trademarks you’ve used, such as the name of your studio or a phrase you’ve used in your advertising, with consistent high-quality, creative photographic work, the trademark becomes a tremendously valuable asset.

Trademarks and service marks are often referred to as simply “marks.” From a legal perspective, they’re more or less the same—any word, name, slogan, symbol, color or combination of elements used to identify the source or origin of goods or services. Almost anything that identifies a source can be a trademark. The key, however, is that the

mark is capable of identifying a single source.

Unlike copyrights, which protect the expression of ideas, or patents, which protect useful ideas and inventions, trademarks and service marks protect something more ephemeral and intangible: goodwill. It’s goodwill that assures consumers that the products or services they select on the basis of a mark will be of a certain quality and consistency.

To better understand trademarks, it might be helpful to look at what cannot be a trademark, such as titles of single creative works (in general) and certain types of national symbols and insignias. For a period of time, Internet domain names could be registered as trademarks, but now, the general rule is that top-level domain names, e.g., .com, are generic (although there are still certain rare instances where an Internet domain name could be a mark).

There’s a common misconception that trademarks are trade names—essentially, business names—or vice versa. This misconception arises, in part, because some businesses are more readily identified by their trademarks than by their corporate name. The appropriate way to think of a

trademark is as an adjective—hence, describing the source of something, e.g., a Walden’s Photography portrait—while trade names or business names are used as nouns, e.g., “this week at Walden’s Photography ...”

### SELECTING A TRADEMARK

The best time to research and select a trademark is when you’re beginning to create a marketing identity for your business. Now that we’re thinking of trademarks as adjectives, there’s another key concept to understand: It is a fundamental tenet of trademark law that the more creative the trademark, the more deserving it is of protection. The converse rule also applies: The more descriptive the trademark, the less likely it is to be identified with a particular source, and therefore, less protectable.

With these two rules in mind, you can see why generic terms—which are incapable of describing anything more than the goods themselves—are not entitled to protection. Trademarks can even cease to be trademarks through a process commonly called genericide, where a trademark is used as a noun rather than an adjective, like thermos, cellophane and aspirin; when trademarks become generic, they cease to function as marks.

Clearly, “Portrait Studio” would not be entitled to trademark protection, but with some additional terms, it could be. For example, Walgreen Co. filed an application to register “W Photo Studio.” The pitfall

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associated with this sort of trademark—adding a name or terms to an otherwise descriptive set of terms—is that the applicant will almost certainly be required to disclaim any interest in the descriptive terms. Ultimately, Walgreen was required to disclaim any rights in the term “photo studio,” except when those terms appear together with the “W.” Such a disclaimer narrows the scope of protection afforded, and opens the door for others to use similar terms.

Liz Vance encountered this pitfall when registering her trademark, “Oh Baby Photography. Bellies. Babies. Beautiful.” In order to obtain a federal trademark registration, Vance was required to disclaim any interest in the descriptive terms “baby photography” if they do not appear with her complete trademark.

The best approach when adopting a trademark is to select a completely fanciful or arbitrary term, such “Apple” for computers. The next best choice is selecting a suggestive term combining simple, photography-related terms. For example, a motorcycle racing photographer in California registered the trademark “Automotophoto” (arguably a fanciful mark, the word might be more appropriately described as a portmanteau word

because it did not exist in the English lexicon). Mascot Metropolitan of San Francisco selected “Camera on Wheels” as a trademark for a rolling camera bag, and since the term is suggestive, a trademark registration was granted.

Of course, numerous photographers have registered trademarks that include their names. Names of people can serve as a trademark provided the mark is being used in commerce, and provided the person whose name is used has granted permission. When you come up with a trademark for your business, you should attempt to clear it for use before you start using it. Vance learned the importance of clearing a mark the hard way. “After I ordered business cards and created letterhead, I found that a big company was already using [the mark I wanted to use],” she reports. The next time around Vance performed a series of searches—an effort to clear the trademark—before she selected “Oh Baby Photography” as a mark.

Clearing a trademark involves assessing the risk that it might be associated with someone else’s trademark, and determining whether it’s worth making the investment in that trademark. But even if a trademark appears clear, there’s no guarantee that it will be. Since trademark rights in the United States are acquired through use rather than mere registration, whoever first acquires rights in a trademark—whether registered or not—has the superior rights to it.

There are two key steps to clearing a trademark for use. The first is to perform a “knock-out” search, so called because it can easily rule out the use of the trademark you selected. A knock-out search is performed on the database at the U.S. Patent & Trademark Office Web site ([www.uspto.gov](http://www.uspto.gov)). In the section under Trademarks, choose Search TM database (TESS), to find any registered trademarks or pending trademark applications identical or similar to the one you’re considering.

If you find that another business is using the mark or has already filed an application for the same trademark, don’t despair. It may be possible to use the same mark if the current usage is unlikely to be confused with your intended use, since the fundamental purpose of trademark law is to prevent consumer confusion. However, it’s best to check with your local intellectual property law attorney before using the mark, or go back to the drawing board.

Even if your knock-out search is clear, you’re not entirely home free. The second step is to be *certain* that no other business is using a confusingly similar trademark by ordering a comprehensive trademark search from companies such as Thomson Compumark ([compumark.thomson.com](http://compumark.thomson.com)). The company will search not only the database of the U.S. Patent & Trademark Office, but also various states’ corporation databases, databases of Internet domain names, and more wide and readily available sources, such as the Internet and telephone directories. The results of this kind of search can be daunting, even for attorneys who are unfamiliar with them.

I’ve seen more than a few instances where businesses selected a trademark based only on a knock-out search, only to find out after starting a major advertising campaign that another business had acquired superior rights to use the same trademark. Ensuring that no other businesses are using the trademark you want to use can help legally protect you from claims of trademark infringement.

After clearing the trademark, register it and begin using it. We’ll cover that procedure in the next installment. ■

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