



Tell a Colleague:

## Trademarking and Copyrighting: The Beginner's Guide

By Steve Smith

An established health care consulting practice had been in business for several years. As part of its growth and development, it had a logo designed by a veteran graphic artist and developed a tagline (a slogan that appeared below its logo). Earlier this year, as part of its routine due diligence, the company's staff visited the Web sites of its top competitors. On the home page of the first competing site that was visited, the researcher read the company's own tagline.



Marc Misthal

This story illustrates the need for every business to protect itself by using existing trademark and registration processes to prevent others from duplicating its creative efforts. As defined by the US Patent and Trademark Office, a trademark "includes any word, name, symbol, or device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods. In short, a trademark is a brand name." You know it by the ™ or ® that appears next to a name.

According to Marc Misthal, a partner in the New York law firm of Gottlieb, Rackman & Reisman, PC, trademarking is a frequently overlooked process in the development of many businesses. In health care, specifically medical imaging, this is particularly true. Because they are focused on improving the health of their patients, many physicians neglect the routine business functions that are second nature in other professions or industries. This includes filing for registrations for their own names.

Misthal has been handling trademark and registration cases for clients in a wide variety of industries and professions for many years. "When most small businesses start out, they are not including this in their budgets and are focusing on other things, such as making the business grow," Misthal says, "but the time to [trademark] is when they are adopting the mark."

### Unraveling the Mysteries

One of the common misconceptions about trademarks and registrations is that they are available to, or meant only for, big businesses. In fact, the protection is available to anyone and recommended for everyone.

Another misconception is that trademarking or copyrighting a slogan or other creative work is expensive because it requires an attorney. Though in many trademarking cases, an attorney is recommended, in some cases, it is not required. According to the Patent and Trademark Office, "It may be desirable to employ an attorney who is familiar with trademark matters. An applicant must comply with all substantive and procedural requirements of the Trademark Act and Trademark Rules of Practice, even if he or she is not represented by an attorney." Misthal says, "Business owners should contact an attorney because it can be a complicated process."

### Who's on First?

In the United States, ownership of intellectual property that is eligible to be trademarked—for example, a practice name—is determined by one simple rule. "In the United States, it is called the rule of first use, and it says that the rights go to the first person to use the trademark," Misthal says. "That means actual use, not the intent to use."

The Patent and Trademark Office makes it clear that first use is not only usually the determining factor in trademark disputes, but that often, little has to be done to claim ownership beyond just using the item. These are known as common-law rights. "Federal registration is not required to establish rights in a trademark," the office's Web site states. "Common law rights arise from actual use of a mark. Generally, the first to either use a mark in commerce or file an intent to use application with the Patent and Trademark Office has the ultimate right to use and registration."

### Benefits Aplenty

If the mere use of a name or other intellectual-property product is the stake in the ground that determines ownership, why register at all? "Every person or company who has an interest in protecting intellectual property should use the registration process," Misthal says. "The registration certificate removes the need to produce all the documents proving that the person or company was the first to use the intellectual property."

Other registration benefits include:

- evidence of ownership of the trademark,
- ability to invoke the jurisdiction of federal courts,
- use of registration as a basis for obtaining registration in foreign countries,
- ability to file registration with the US Customs Service to prevent importation of infringing foreign goods, and
- constructive nationwide notice of the trademark owner's claim.

Misthal expands on the benefit of nationwide notice: "Common-law rights can be limited to particular geographic areas." He notes, "It's harder now, with the Internet, but it still happens. Once you get the registration [which turns the ™ into the ®], you have put the United States on notice that you are using the mark."

He continues, "Registration has other benefits, too. If you come across someone infringing on your trademark, you can issue a cease-and-desist letter and include the registration certificate. This carries a lot more weight than just saying, 'We've been using this for 10 or 20 years,' and then forcing your attorney to prove it. The mark takes away the need to prove."

### A Case in Point

Consider a scenario in which company A began using a slogan in 1980, but never had it registered. Along comes company B, a competitor, which began to use the same slogan in 2009 and went as far as having it registered. Who has the right to use the slogan?

According to Misthal, company A owns the right to use the slogan, but because it never had the slogan registered, it will now have to prove first use, and it will have to initiate cancellation proceedings with the Patent and Trademark Office to reverse the decision to grant company B the trademark.

All of this could have been avoided, had the slogan been registered at the time it was first used. Instead, this reversal process will become time consuming, and it will almost certainly require an attorney to resolve.

"Unfortunately, many companies don't register until it's too late," Misthal says.

### Searching Everywhere

The first step in registering a mark is to search the records of the Patent and Trademark Office. "A search should be conducted so you know if anyone is using it," Misthal says. "The search should be done even before you print materials such as a letterhead, so that you don't waste money on something that someone else may own."

According to Misthal, one slogan does not have to be exactly like another to have its registration application rejected. "The search will tell you whether anyone has applied to the office and whether the application for a mark is likely to cause confusion [in the marketplace]," he says. "If so, the office won't issue the registration."

For more information, visit <http://www.uspto.gov/main/trademarks.htm>.

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