

# The Advisor

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## What's the Use? Give Your Trade-Mark's Life Some Meaning

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The most important, and most often overlooked, aspect of giving validity and value to your company's trade-marks is how they are "used." Unlike copyright works or patented inventions, that remain protected even if never exposed to the public, trade-mark protection only exists if your product or service is actually being sold to the public under the "brand" that is your trade-mark.

This is because trade-mark law arose as consumer protection law in industrial revolution England – so that your average upwardly-mobile peasant could differentiate between the beer from Stoke-on-Trent and that from Wiggles-on-Thames. Unless consumers are seeing trade-marks in the marketplace, to help them choose the products they prefer, a trade-mark has no point.

This is also why, when you wish to file a trade-mark application to protect your current or proposed brand, you may be driven to distraction by your trade-mark lawyer's seeming obsession with the details of your "use" of your trade-mark. This is merely our superpower, which we are using for good - one wrong move in asserting and recording the details of your trade-mark's use can result in invalidity of your registration, and loss of the protection of your valuable brand.

These heroics are very important at the time your trade-mark application is filed. In the trade-mark application, you irrevocably commit to either a specific historical date when "use" of the trade-mark commenced in the marketplace, or the assertion that you have not yet "used" the trade-mark at the filing date. Getting "use" versus "proposed use" wrong happens surprisingly frequently, because companies confuse "creating the brand" with actually selling products under the brand. Also, a company will often apply to protect a trade-mark many years after it started selling under that brand, but will have no accurate records of when the first sale, or "use" occurred, making the assertion of an historical first use date inaccurate.

The importance of "use" continues after a trade-mark is registered – ask any corpulent penguin. The "corpulent penguin" case is a well-known Canadian trade-mark decision, where the Stanfield's clothing company had for many years sold clothing bearing a registered trade-mark logo of a typical, though trim, penguin. At some point, the Stanfield's marketers decided to fatten up the ol' fish-eater in the logo. This more corpulent bird eventually became the one exclusively used on the clothing products. A competitor then successfully had Stanfield's long-standing trade-mark registration declared invalid, on the basis the change of the logo was use of a different trade-mark, and therefore an abandonment of the "use" of the registered slim penguin logo.

So, let your brand find marketplace enlightenment by making your company's policies one with the rules of trade-mark use. If you have any questions regarding use of your trade-mark in the marketplace, or to discuss trade-mark registration generally, please contact our [Intellectual Property and Technology Group](#).

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