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## TRADEMARK USAGE

As appeared in the May 2005 issue of *Pikes Peak Writers NewsMagazine*.

**QUESTION:** I'm writing about a woman who develops a relationship with her refrigerator (it can talk), which I identify as an Amana<sup>®</sup>. Is this okay?

**ANSWER:** You may use brand names or trademarks in fiction or non-fiction works; provided you use them properly. Before I explain proper usage and to help you better understand the same, I'll digress and give you a brief primer on trademark law.

The purpose of a trademark is to indicate the source or origin of a good or service. A trademark may be a word, symbol, name, device or any combination thereof. A trademark owner has the exclusive right to use his trademark in conjunction with his particular goods and services.

Only trademarks which are descriptive, suggestive, arbitrary or fanciful (in order of increasing legal strength of a trademark) are entitled to legal protection. Generic terms (the word for the good or service itself) are not entitled to trademark protection, because these terms must remain available for all to use in identifying their goods or services. Examples of generic terms are telephone, car, dry-cleaning, etc.

A descriptive trademark describes the nature or quality of the goods or services and is subject to limited legal protection; provided the owner can demonstrate the trademark has secondary meaning, because the public has come to identify the descriptive trademark with a particular source. An example of a descriptive trademark is Half Price Books<sup>®</sup> for retail store services featuring books.

A suggestive trademark suggests the nature or quality of the goods or services. Examples of suggestive trademarks are Coppertone<sup>®</sup> suntan

oil, Edge<sup>®</sup> shaving cream and Amana appliances. Relevant trivia: Amana is an Old Testament word meaning to remain faithful.

An arbitrary trademark applies a term with intrinsic meaning in a different context. Examples are Apple<sup>®</sup> computers and Palm<sup>®</sup> PDAs.

A fanciful trademark is coined for use as a trademark. Examples are Exxon<sup>®</sup> gasoline and Kodak<sup>®</sup> film.

It is the responsibility of the trademark owner to maintain and enforce his trademark rights. If he doesn't, he risks losing those rights. As a result, owners are particular as to how their trademarks are used, which is why proper use is important in your writing.

There are several factors for proper usage. First, a trademark should always be used as an adjective, never as a noun, verb, plural or possessive. Trademarks are properly recited as: (Trademark) brand (good or service). In common parlance, the word "brand" may be dropped, but the trademark should still be paired with a noun. For example, you blow your nose into a Kleenex<sup>®</sup> brand tissue or wear a pair of Levi's<sup>®</sup> jeans. Conversely, you don't Rollerblade<sup>®</sup> in the park (misuse as a verb; proper use would be skating with a pair of Rollerblade in-line skates), and you don't make a Xerox<sup>®</sup> of a document (misuse as a noun; proper use would be making a copy with a Xerox photocopier).

Why do trademark owners care whether you use their trademark as an adjective? For an owner to allow otherwise creates the risk of the trademark becoming generic. The classic example of a trademark that became generic is aspirin. Although trademark misuse is common (such as the "No Rollerblading On Sidewalk"

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## TRADEMARK USAGE – *continued*

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sign posted in front of a local building), it's still not correct and not an excuse for you to use a trademark improperly. Trademark owners do public relations campaigns to educate consumers on proper use of their trademarks to combat genericide. Both Xerox Corporation and Kimberly-Clark Corporation (Kleenex) have conducted such campaigns.

Second, trademarks should be appropriately marked with notice of ownership with either ® (federal trademark registration), or with TM (common law use or state registration). It is acceptable to mark with notice upon the first use of the trademark in a work and to dispense with notice thereafter.

Third, proper acknowledgement of the owner of a trademark used in a work should also be given. This is usually done with a brief attribution and disclaimer statement in the work.

If it's not necessary to use a trademark, it is better to use the generic name. Simply let your heroine cry into a tissue. However, sometimes use of a brand name conveys important character information. Readers have a different perception of Colin Dexter's character Inspector

Morse who drives a pristine, vintage Jaguar® sports car, than they do of Sue Grafton's private detective character Kinsey Millhone who drives an old, well-worn Volkswagen® economy car.

Now, to answer your particular question. Yes, you may indicate the refrigerator in question is an Amana, provided you use the trademark properly. If you mean to name the refrigerator character Amana (use as a proper noun), then this would not be proper, acceptable use and may be called into question by the trademark owner, Amana Company. Misuse as a proper noun would expose Amana Company to possible loss of trademark rights by genericide. However, if you were to obtain permission from Amana Company to use its trademark as the refrigerator character's name, then it would be retaining control over the use of its trademark, which is critical in the eyes of the law in deciding whether genericide has occurred.

A word to the wise, if it's crucial to the story to use a trademark, then prior to publication, a final, legal review is recommended to ensure proper and acceptable use of the trademark.

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