



How to Protect Your Company's Most Valuable Asset

By April Besl of Dinsmore & Shohl LLP. Reprinted with permission.

Most companies, especially those starting out, do not realize that from the start they already have and own a trademark. A trademark is defined as any word, symbol, phrase, device, or combination thereof used to identify a source of a good or service. Trademark rights do not depend on registration with the US Trademark Office, but arise as soon as use of the mark is made in commerce. These are known as “common law” rights. Thus, your company name, the names of your products and services, any marketing tag lines, or logos are trademarks already owned by your organization and enforceable against third parties.

Protect Your Trademark

Trademark protection is not just limited to words and designs. There are numerous other ways companies can differentiate themselves from competitors and gain a competitive advantage in the eyes of consumers. A trademark can consist of a color, sound, smell, motion, hologram, or even lights. For example, a “citrus” scent has been registered for biofuel; the motion of the Columbia pictures movie title page has been registered for

movies; the flavor of “apple cider” has been registered for office supplies; and NBC has registered its distinctive three tones for its entertainment services. It’s thinking outside of the box like these entities that can pay dividends to an innovative company in the long run.

Your Trademark is Your Most Valuable Asset

Your trademark, for example your company name, identifies everything about your organization: your employees, products, services, officers, successes, failures, public representatives, and more. Without a trademark to serve as a source identifier your organizations customers won’t know who you are, what you stand for, what you do, and most importantly, who to buy from or contract with.

The Power of a Trademark

Think of everything that comes to mind when you see the trademark Procter & Gamble. You may have thought of the quality of its products, the nature of its product lines, experi

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Hamilton County Law Library

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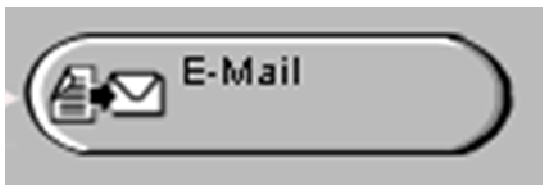
[www.http://www.hamilton-co.org/cinlawlib/](http://www.hamilton-co.org/cinlawlib/)

Tech Tip: Create PDFs from paper documents and email them from our Law Library computer lab for FREE!

By Julie Koehne

Step 1:

Load your document into the top feeder of printer.

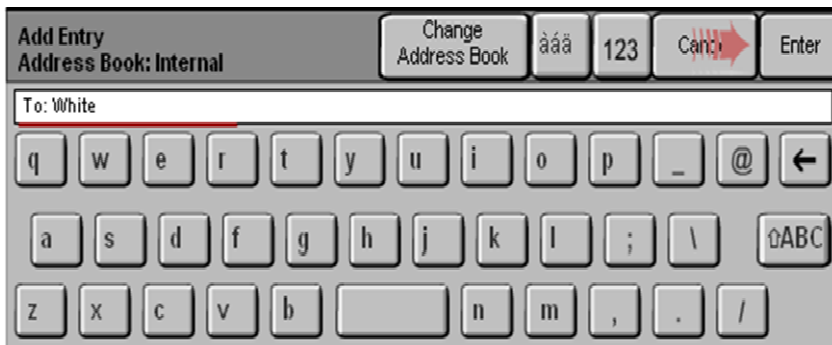
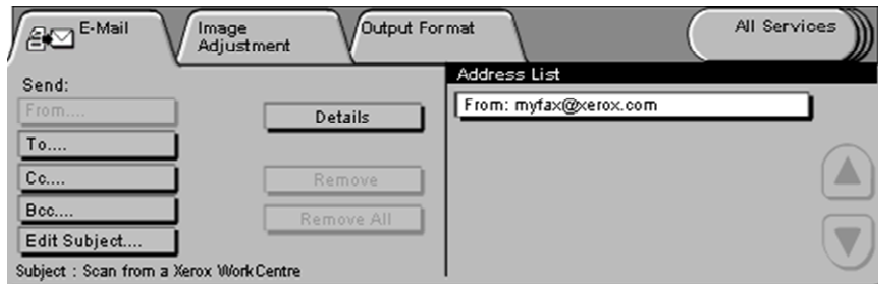


Step 2:

Select Email by touching the screen.

Step 3:

Select To: in the Send: field on the left of the screen.

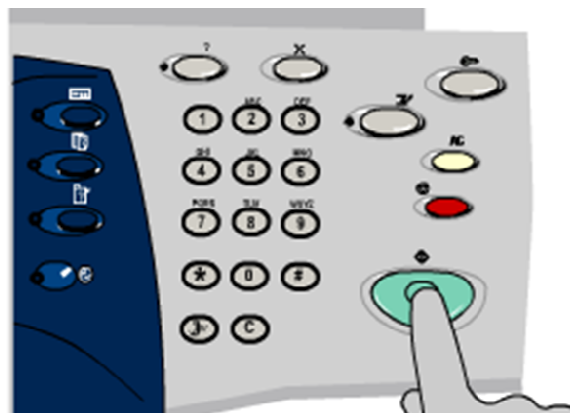


Step 4:

Input full Email address of the recipient using the keyboard, then select Enter in the upper right hand corner of screen.

Step 5:

Press the green start button and your document will be sent as a PDF attachment.



New Law Library Director

The Law Library Board and staff invites you to join us in welcoming our new Director and Law Librarian Steve Miller, who begins work on Feb. 1. Steve comes to us from Indianapolis after a distinguished career of progressive library and research technology roles at Indiana University, Northwestern and Ohio Northern. His savvy awareness of legal tech plus his orientation to patron service were impressive during the December interviews. Please drop in during February and help us to make Steve Miller feel at home as a part of our community's legal leadership.

Hamilton County Court of Common Pleas E-Filing Changes

Some changes are coming to the Hamilton County Court of Common Pleas.

Beginning on January 1, 2012, the Hamilton County Court of Common Pleas Assignment Commissioner's Office will no longer send postcards to counsel with future court dates via U.S. mail. All attorneys must register for email notifications to receive future court dates via the form posted on the Court's website here.

http://www.hamilton-co.org/common_pleas/common_%20pleas_forms.htm

Beginning January 3, 2012 most civil suits must be filed electronically with the Clerk of Court in accordance with the newly revised Local Rules 10, 11, and 34 of the Rules of Civil Procedure. This requirement applies to all cases in which a case number beginning with "A" is assigned.

In order to e-file, attorneys must register by

logging on to <http://www.courtclerk.org/efiling.asp>

Court Rules

You will find court rules for many jurisdictions on the Law Library's website at

<http://www.hamilton-co.org/cinlawlib/resources/courtrules.html>.

In addition to federal and state courts, we provide rules for most counties in Ohio. A collaborative effort of law librarians around the state, we either link to the court's website or we acquire paper copies, scan, and upload them. Periodically, librarians verify links and currency of the rules. If you come across rules that we don't have or if you see that an update is available, please contact Law Library staff.

Subscriber Renewals

All current subscribers should have received an invoice in December for 2012 subscriber fees. If you haven't seen yours or cannot find it, please contact Mary Ann Sweeney, library assistant, at 513.946.5300 or masweeney@cms.hamilton-co.org for another copy. Your timely payment will ensure your continued access to legal information resources and services including newsletters and news updates, borrowing privileges, CLE attendance, document delivery, and more. We'll send out second notices in late January. Privileges are revoked if payment is not received by late February.

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ences you've had with its products and services in the past, articles you've read in the press about the company, commercials you have seen, the fact that it is an international company based in Cincinnati, or a myriad of other possibilities. All of this information is conveyed by two simple words and a symbol. That is the power and value of a trademark. If you are still not convinced, think of everything that comes to mind when you see the names Enron or Lehman Brothers?

Registration Has Its Benefits

While trademark rights are not dependent on registration, actually registering your trademark with the US Trademark Office can carry extremely valuable benefits. "Common law" rights, as discussed above, are limited to the geography in which you are actually using the mark. That means if you are not using the mark in California, someone else can begin using the mark for similar services in that state and you cannot stop them based on your use in Ohio. A federal registration though, grants you that right.

Registration with the US Trademark Office grants the owner nationwide priority and protection, even if the owner is not actually using the mark in every state. Moreover, registration allows the owner the right to use the R (®) symbol next to the mark. This symbol can only be used when the mark is registered with the US Trademark Office. Unregistered marks are limited to the TM (™) symbol alone.

Registration also grants the owner a presumption of validity of the mark and ownership, which can be very beneficial if litigation ever arises. A trademark that has been registered for five years on the Principle Register can also become incontestable, meaning that there are fewer grounds upon which a third party can cancel the registration. Additionally, a registered mark can also be registered with the US Customs Service for protection against counterfeit or gray-market goods bearing the trademark from being shipped into the country. Thus, the benefits of regis-

tration can be substantial and worth the relatively low costs of filing and prosecution.

Trademarks Have Different Strengths

One trademark is not the same as another. Trademarks actually have different strengths that are determined by the connection of the words or design in the mark to the goods and services being offered. The differences in strengths can affect not only the enforceability of the mark against third parties, but whether it is even protectable as a trademark. In fact, some words or phrases do not and cannot function as a trademark for certain goods and services. This is because these marks have become "generic," or put another way, they have become the actual name for that product or service. For example, the words escalator, aspirin, raisin bran and modem were once protectable trademarks until the public came to associate those words not with the source of the respective goods, but with the items themselves. Since marks can become "generic" over time, companies need to make sure they do not turn their marks into nouns or verbs in marketing and other interactions with the public.

Both the strongest and weakest trademarks available require "training" of the public to associate the mark with the company offering the goods or services. This "training" often consists of specifically designed marketing campaigns featuring catchy slogans or jingles to connect the mark and the company in the mind of the consumer. Examples of different trademarks include:

"Arbitrary" and "Fanciful" Trademarks

For the strongest marks, called "arbitrary" or "fanciful" trademarks, the words or symbols used either have no connection to the goods or services being offered or are entirely made up words. Examples of such marks include APPLE for computers, CLOROX for bleach, and IVORY for soap. Because these marks have absolutely no connection to what they are identifying or are made up entirely

the “training” of the public becomes necessary to create the connection.

“Suggestive” Trademarks

Trademarks that are neutral and convey a happy medium are known as “suggestive” trademarks. These marks still convey a message about the products or services being offered, but do not do so directly. Instead, they require a bit of imagination or thought to understand the message being conveyed. The best example of a suggestive mark is GREYHOUND for buses. The owners of the GREYHOUND mark are not stating that their buses are as fast as greyhound dogs. Rather, they are stating that just as greyhounds are the fastest dogs, their buses are the fastest buses. These marks are often popular with companies because they allow the company to communicate with consumers, but do so in a protectable way. Thus, the strength of the mark you choose for your company, your products, and your services really matters.

“Descriptive” Trademarks

The weakest marks, called “descriptive” trademarks are faulty because they immediately describe a characteristic, feature, or desired outcome of the good or service being offered. Examples of such marks include CHAP STICK for skin preparations in a stick and CONSUMER TESTING LABORATORIES for consumer testing services. Because these marks are immediately descriptive, it is harder for them to function as a source identifier. That is the reason why companies have to engage in such “training” of the public. However, unlike with the stronger “arbitrary” or “fanciful” marks, once the “training” is complete, the outcome is entirely different. Companies that have descriptive marks must work harder to enforce these marks and often have to prove their marks are “distinctive” (i.e. a source identifier, before a court or the Trademark Office). A company with the strongest marks though, have inherently distinctive marks that are easier to enforce and protect.

Enforce Your Trademarks Rights

Once a company has a trademark, it has a duty to enforce its trademark rights against infringing third parties. This requirement is designed to protect the public from potential harmful effects from infringing, counterfeit, or sub-par goods and services being offered under another mark. Failure to properly enforce a trademark can dilute its protectability and enforceability.

Proper enforcement is generally a mix of cease and desist letters, the occasional lawsuit, takedown notices filed with social media sites, and even the use of “watch services.” “Watch services” are typically offered by law firms who use a combination of in-house searching and third-party vendors to perform regular searches of the Trademark Office register and common law databases. The best “watch service” though often comes via a company’s employees, customers, and vendors who will alert the company to infringing activity they see in their daily lives.

Simply paying attention to the eyes and ears of your organization and taking action when necessary will ensure that your mark remains strong and enforceable for years to come.

For more information, contact April Besl (april.besl@dinsmore.com.)

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You and the Legal System: Divorce Law Basics

Susan Ahlrichs of Ahlrichs & Ahlrichs is our next speaker in the *You and the Legal System Series* for the public. Ms. Ahlrichs will address divorce law in Ohio, focusing on the steps that need to be taken to end a marriage on Friday, February 17, 2012 at 12:00 noon at the Law Library. The program is free to the public. To register, call 513.946.5300.

Please note that this is not a CLE event; it is intended for the general public. However, attorneys are welcome to attend and may want to pass along the program announcement to clients, staff and community organizations. If you would like more information, please contact Laura Dixon-Caldwell at 513-946-5302.

You and the Legal System is brought to you as a public service by the Hamilton County Law Library, in conjunction with the Cincinnati Bar Association's Lawyer Referral Service.

Library Board Meeting

The next regularly scheduled meeting of the Hamilton County Law Library Resources Board will be held at 1:00 p.m. on January 5, 2012 in the Robert E. Kraft Board Room. Meetings of the board are open to the public. Minutes of past meetings are available at

<http://www.hamilton-co.org/cinlawlib/about/trustees.html>

Intellectual Property Resources

Law Library patrons have access to a variety of resources on intellectual property. If you would like to use one of the resources listed, just call and we'll hold it for you. If you have questions about access to the Law Library's online resources, just ask a librarian for guidance.

Books

14th Annual Institute on Intellectual Property Law/
Co-chairs David Bender and Robert P. Taylor
KF2979.A2
2008

Chisum on patents : a treatise on the law of patentability, validity, and infringement /
Donald S. Chisum
KF3114 .C47
2011

Corporate Counsel's Guide to Intellectual Property: Patents, Copyrights, Trademarks & Trade Secrets
KF2979.C671
2008

Drafting license agreements /
Michael A. Epstein, Frank L. Politano, editors
KF2979.D692
2011

Drafting Patents for Litigation and Licensing/
Bradley C. Wright, editor
KF3145.D72
2011

How to Write a Patent Application/
Jeffrey G. Sheldon
KF3125.C5 S47
2011

Intellectual Property
KF0230.I544
2008

Intellectual Property Law for Business Lawyers
KF2979.I58
2010

Patry on Copyright/
William F. Patry
KF2991.5 P382
2010

Patent, Copyright & Trademark/
Richard Stim
KF2980.E44
2009

Online Resources

Aspen:

Computer & Internet Lawyer Journal
Internet & Technology Law Desk Reference
Law of the Internet
Scott on Multimedia Law

CCH:

Computer & Internet Advance Release Documents
Copyright News Alerts
Copyright Law Newsletters
Copyright Law Reporter
Guide to Computer Law
Trademark Law Guide
Trademark Law Report Letter

Lexis:

Federal Copyright Cases
Federal Patent Cases
Federal Trademark, Unfair Competition and Trade Secret Cases
State Trademark, Unfair Competition and Trade Secret Cases

Upcoming Events

January 5: Hamilton County Law Library Resources Board Meeting

February 17: You and the Legal System-Divorce Law Basics

January Holidays

The Law Library will be closed:

Monday, January 2 in observance of New Year's Day.

Monday, January 16 in honor of Martin Luther King Jr, Day.



January 2012 Law Library Newsletter

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ADDRESS CORRECTION REQUESTED

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