



What Every Trademark Owner Should Know About Using TM and [®] Correctly

The use of the [®] and TM symbols is frequently misunderstood, and misuse is common. It is so widespread that examples can be found on websites, on packaging, in advertisements, and on social media. The [Trademark Manual of Examining Procedure](#), indeed, states that:

improper use of the federal registration symbol that is deliberate and intended to deceive or mislead the public is fraud. See TMEP 906.04. However, misunderstandings about use of federal registration symbols are more frequent than occurrences of actual fraudulent intent.

One might dismiss the misuse of trademark symbols as trivial; however, it can have legal implications. Take, for example, the case of [Copelands' Enterprises, Inc. v. CNV, Inc.](#), in which CNV, a sunglasses distributor, was accused by Copelands of using the [®] symbol to identify trademarks — VUARNET and VUARNET FRANCE — that were not actually registered, even though there were pending U.S. trademark applications. CNV went to court to attempt to bar registration of the marks on grounds that CNV misused the trademark registration symbol. CNV prevailed because it persuaded the Trademark Trial and Appeal Board, and the Court of Appeals agreed, that it did not misuse the marks with fraudulent intent. Nevertheless, the company had to bear the expense and inconvenience of the lawsuit, which could have been avoided had it exercised some care in using the [®] symbol.

In **Trademark Circular No. 8**, we will discuss the common trademark symbols and their proper use.

TRADEMARK SYMBOLS: THE BASICS

™ Symbol

Use of the TM symbol suggests that the owner of a mark claims trademark rights in the word, phrase, or image. It does not mean that a mark is federally registered. The origins of the ™ symbol are obscure. [One source](#) states that it originates from common-law practice in the United States and the United Kingdom. One thing is certain, though: there is no statutory authority that controls the use or placement of the symbol. In other words, ™ has no legal significance. We tell clients to use it before a trademark registration issues because it gives notice to the world that an applicant is claiming trademark rights in the mark. It does not guarantee any protections or provide any rights. This practice is consistent with the [International Trademark Association Guidelines](#) on ™ usage.

SM Symbol

The SM symbol means service mark and functions in a similar fashion to that of the ™ symbol. It has no legal significance other than serving as notice of a claim to trademark rights in a service mark.

“REGISTERED IN U.S. PATENT AND TRADEMARK OFFICE” OR “REG. U.S. PAT. & TM. OFF.” OR ®

Authorized by law, the phrases “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or ® are the heavy hitters. For simplicity, we will just refer to the use of the ® symbol, but whichever form is used, it means that the mark is *registered* with the United States Patent and Trademark Office (USPTO). Title [15 U.S. Code § 1111](#) provides:

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words Registered in U.S. Patent and Trademark Office or Reg. U.S. Pat. & Tm. Off. or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.

Let's break that down. First, the provision states that a Registrant may give notice by displaying the appropriate words. In other words, displaying the ® symbol is not mandatory. Yet the provision goes on to say that if a registrant fails to give notice of registration, it will not be entitled to profits or damages if it files an infringement suit against another party, unless it can prove that the other party had actual notice of the registration. That may be a heavy burden and can be avoided by simply displaying the appropriate words or the ® symbol. So, it may not be mandatory, but you should display it anyway.

There are also other benefits to using the ® symbol. Not only does it provide notice of the registration, but it may also discourage infringement by indicating that the company is treating the designation as a trademark. Use of the ® symbol also reinforces brand identity. Certainly, the presence of the ® symbol gives a certain credibility to a brand that consumers understand.

WHERE TO PLACE THE SYMBOLS

You will want to place the trademark symbols immediately after the mark, usually in superscript; however, they may appear in subscript or baseline form, depending on your preference. There is no right or wrong way. It is usually sufficient to use the symbol on the first or most prominent use of the mark. You do not have to place it on every instance of the mark so long as you are consistent, and the placement provides adequate notice to the reader. Do not place the symbol after descriptive or generic words. For example, RUBY® software, *not* RUBY software®.

WHAT ABOUT PENDING TRADEMARK APPLICATIONS?

You may have already deduced the answer. Pending trademark applications are not registered trademarks, so you cannot use the ® symbol. You can use the TM symbol for goods or SM for services. Both are optional.

WHAT ABOUT FOREIGN REGISTRATIONS?

Trademark rights are territorial. A foreign trademark registration may protect the mark in the country where it was issued, but it does not authorize use of the ® symbol in the United States. In the U.S., the ® symbol should be used only after the mark is registered with the USPTO.

FRAUDULENT INTENT

Improper use of the ® symbol, as we discussed in the opening paragraphs, may become an issue in litigation. The central issue is typically whether there is fraudulent intent, that is, whether one of the parties intentionally marked a non-registered trademark with the ® symbol. If so, misuse of the ® symbol can invalidate a trademark and any chance of registering it.

Courts and the USPTO generally distinguish between a careless or mistaken use of the registration symbol and a deliberate misuse intended to deceive consumers, competitors, or the Trademark Office. That was the issue in [Copelands' Enterprises, Inc. v. CNV, Inc.](#) discussed above. In that case, the Trademark Trial and Appeal Board found that CNV's conduct was not intentional. That kind of mistake can still create unnecessary risk and expense, but by itself it does not necessarily amount to fraud. On the other hand, knowingly using ® to make it appear that a mark is federally registered when it is not, especially to mislead the public or gain an unfair advantage, can lead to more serious consequences such as denial of registration, cancellation of a registration, or refusal to enforce trademark rights. Even when those arguments ultimately fail, i.e., they can complicate the case, increase litigation costs, and damage the credibility of the trademark owner.

LEARN THIS

Symbol use is not a minor design decision. A litigant may point to misuse of the ® symbol as evidence of overreaching, bad faith, or an intent to mislead, but properly using trademark symbols is a simple, low-cost way to reduce avoidable legal risk.

— Adam G. Garson, Esq.