

NEWSLETTERS

Importance Of Trademarks For Greek Organizations

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Trademarks are especially important to Greek organizations, as they help distinguish your organization and services from those of other organizations. It may be surprising to learn what you can trademark, beyond your fraternity's or sorority's name. Let's review what a trademark is, how to go about strategically choosing a trademark, and how to protect the trademark.

What is a Trademark?

A trademark is any word, slogan, symbol, sound, color, shape, smell, design, or look and feel of an establishment which consumers and the public use to identify and distinguish one's products or services from those of another organization. This is especially important for Greek organizations, because fraternities and sororities often have many trademarks associated with their houses other than their name or letters, such as distinctive designs, slogans, etc. A trademark identifies and shapes your brand and is an extremely valuable asset, as it allows you to build goodwill in your organization and prevent others from trading off of that goodwill.

Not only do trademarks serve as a way of differentiating organizations and Greek houses from one another, they help protect the public from being confused as to the source of services because consumers will recognize trademarks as source identifiers. Furthermore, trademarks can help convey information about your organization, its goals and priorities, and other relevant information.

Choosing a Trademark

Fraternities and sororities should follow a careful procedure for adopting and protecting new trademarks. Spending the time and money before adopting a trademark will help ensure you are choosing a strong, protectable mark.

The first step is to prepare a list of potential marks that you are considering adopting. A common mistake is choosing one mark and falling in love with it before taking proper steps to make sure the mark is a good choice. Having several options will help make sure you are choosing the best mark for your organization. The next step is to rule out marks that are not registrable or protectable as a trademark. Registration of a trademark is generally the easiest way to obtain protection; if a mark

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is not registrable, it will be more difficult to protect.

When selecting a potential mark, organizations often choose a term that is “catchy” and describes a characteristic of the products or services. However, the more descriptive the mark, the less protection it provides. This means that other organizations may be free to use descriptive words to advertise similar services. Conversely, the less descriptive the mark, the greater the chances of obtaining exclusive protection for the mark.

Once you have chosen several options for potential trademarks, it is important to take steps to “clear your mark” and make sure your chosen mark is not confusingly similar to a prior mark used in connection with similar products or services. This step should include conducting a search to make sure the proposed mark is available for use and registration and does not infringe someone else’s rights.

The test for trademark infringement is likelihood of confusion in the minds of the public and the test for determining whether a likelihood of confusion exists takes into consideration numerous factors, including the similarity between the marks in appearance, sound, and meaning; the similarity of the products/services; and the area and manner of concurrent use.

Failing to research a mark before adoption can lead to denial of registration by the United States Patent and Trademark Office (USPTO), or a cease and desist letter from another organization or brand owner. Spending the resources up front to determine whether a mark is available will help avoid the very high costs of a dispute or litigation. Conducting an internet search and a search of the trademark office database for each of your potential marks are vital steps. You will want to take special care to check and see whether other fraternities and sororities are using similar marks, as this could increase the risk of conflict. Accordingly, it is important to make sure that no one else, including other houses, claims rights in a confusingly similar trademark before you use a mark in connection with apparel, signs, etc.

Once you have narrowed down your list of potential marks, we recommend contacting trademark counsel to conduct additional searching to help determine the risk of conflict associated with a certain mark.

Protecting Your Trademark

Once you have chosen a strong mark and taken steps to clear the mark, you will want to take the steps to protect your mark.

As a first step, you will want to begin using your trademark as soon as possible, as this will help establish your trademark rights. You should also put others on notice that you consider the mark yours by using the “TM” symbol, or the “®” symbol once the mark has registered.

In the United States, you do not have to file a trademark application to claim rights in a mark. Instead, you have some rights based solely on your use of the mark. However, there are numerous advantages of registering your trademark, including the fact that it provides nationwide constructive notice to other parties that the mark is yours and serves as evidence that you own the mark.

Trademark owners would benefit from taking steps to monitor their

trademark and police it against others who try to use the mark or a similar mark; otherwise, they risk losing rights in the mark.

Kathleen S. Fennessy is an associate in the Intellectual Property Department at Barnes & Thornburg. She can be reached at 317-231-7706 or Kathleen.Fennessy@btlaw.com.

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