

ANSI Guidelines on Embedded Trademark

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About the American National Standards Institute

ANSI is a nonprofit, privately funded membership organization that coordinates the development of U.S. voluntary national standards and is the U.S. member body to the International Organization for Standardization (ISO) and, via the United States National Committee (USNC), the International Electrotechnical Commission (IEC).

The Institute was founded in 1918, prompted by the need for an “umbrella” organization to coordinate the activities of the U.S. voluntary standards system and eliminate conflict and duplication in the development process. For over seventy years, this system has been successfully administered by the private sector, via ANSI, with the cooperation of federal, state and local governments. The Institute serves a diverse membership of over 1300 companies, 250 professional, technical, trade, labor and consumer organizations and some 30 government agencies. Standards exist in all industries, including safety and health, telecommunications, information processing, petroleum, medical devices, etc.

Some of the Institute's key functions include:

- Coordinating the self-regulating, due process consensus based U.S. voluntary standards system;
- Administering the development of standards and approving them as American National Standards;
- Providing the means for the U.S. to influence development of international and regional standards;
- Promoting awareness of the growing strategic significance of standards technology to U.S. global competitiveness.

Guidelines

I. ANSI Embedded Trademark Guidelines

A. Background – Trademarks, Service Marks and Certification Marks as Forms of Intellectual Property

These types of marks serve as a very different kind of intellectual property from patents and copyrights. Generally, a “trademark” is any word, name or symbol (or any combination thereof) that is used to distinguish the trademark’s owner’s products from competing ones, in large measure by serving as an indication of the source of those products. A “service mark” is virtually the same except that it is used to identify the source of services and distinguish the service provider’s services from those of its competitors. A “certification mark” is a mark used by a person or entity other than the owner of the mark. Usually such person or entity seeks to use the mark to indicate that its product or service meets the necessary criteria for which the mark stands.

There are occasions when marks can be legally referenced without a license or prior permission from the mark’s owner. For example, a designation of a standard may include the name or mark of the relevant standards-setting body. In addition, such use is allowable if it meets the requirements for “fair use” set forth below. If referenced properly, marks rarely (if ever) will constitute an essential intellectual property right vis-à-vis a Recommendation that would require a standards developer or those seeking to implement the Recommendation to obtain a license from the mark’s owner. However, certain non-referential uses of a mark may require permission or a license from the mark’s owner.

A trademark license is generally required when Party B uses Party A’s mark or otherwise indicates sponsorship, authorization, certification, approval, or some other quality assurance of Party B’s product or service. For example, a license is required if Party B’s product displays Party A’s compatibility logo, or if Party B’s product name includes Party A’s trademark.

However, if Party B is using Party A’s mark merely to refer descriptively to Party A’s technologies — not Party B’s — then a trademark license is generally not required in connection with such a referential use of the mark. For example, a license is generally not required for Party B to say in advertising text that its product is compatible with Party A’s Widget® software, so long as Party B does not use Party A’s Widget Compatible Logo® to make that statement.

The primary concern relating to the use of a mark in a standard is whether it would appear as if the standard is endorsing one particular proprietary product or service over competing ones.

B. General Guidance

As a general rule, standards should provide a description of features from which competing and interoperable implementations can be developed. The appearance that a standard endorses any particular products, services or companies should be avoided. Therefore, proper names, trademarks, service marks or certification marks of specific companies, products or services should not be included in the text of a standard or in an appendix (or the equivalent) if it appears that they might cause this effect.

C. Exceptions to the General Rule

1. Non-Endorsement Uses of Marks

There are situations when it may be permissible to include trademarks, service marks or certification marks in a standard. Typically these situations arise when the mark in question is a reference to a standard or standardized technology, and its inclusion in the standard would not create the appearance of endorsing a particular proprietary product or service. While it is not possible to delineate all such situations, the following are some examples when the inclusion of a mark may be appropriate:

- a. The mark or proper name serves as a reference to a particular facility that is widely recognized as a sole authorized source. For example, a standard may reference a specific, allocated network identifier.
- b. The mark is contained in the designation of a referenced standard.
- c. The mark is a well-known reference to a certain standardized approach. For example, it may be appropriate to reference WiFi, cdma2000, Bluetooth, GSM, 3GPP, etc.

If a standards developer wishes to reference such a mark in a standard, it should either reference it pursuant to the fair use guidelines set forth below or it should seek permission or a license from the mark's owner.

2. Exceptions for Fair Use References to Third-Party Marks

If there are justifiable reasons for referencing one or more marks owned outside the standards developer in a standard, standards developers are encouraged to do so in an acceptable manner. Generally it is permissible to make "fair use" references to marks as part of accurate, factual statements or to reference a mark as a means to identify (but not to endorse) a particular object (such as the designations of referenced standards in the text of a standard). Usually this can be done without the express permission of the standards body or other mark's owner, or explicit identification of any related marks. This type of use would not be perceived as a vehicle for deceiving customers as to the source of any particular goods or services. In order to be considered a "fair use" reference to a mark, a standards developer should make the reference in good faith and as a means of describing something as opposed to using it in a manner that arguably would impair the mark's owner's goodwill in its related products or services.

When making fair use references to marks in the text of a standard, standards developers should consider the following:

- a. Marks are adjectives that describe a specific person, place or thing. Accordingly, a mark should be used as an adjective followed by a generic name or noun. Do not use a mark as a verb or noun.
- b. Do not use a mark in a plural or possessive form unless it refers to the name of a company.

- c. Do not combine marks in a single reference.
- d. Do not shorten or abbreviate a mark.