

LEGAL AND PRIVACY

Altering famous logos for social distancing: What does it do to your trademark rights?

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Many brands played with the spacing in their logos to denote social distancing in the COVID-19

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During the last several months to encourage the policy of enforced social distancing, several famous brands have altered their logos in a playful way.

Volkswagen altered its logo to separate the V and W; McDonald's in Brazil separated their two golden arches; Audi separated its four rings; Mercedes separated its three-point design from the circle.

These playful uses of the brands' logos to make a timely statement about an important social issue were likely thought to give positive public relations to the brand, keeping it current with the issues of the day.

But what do these alterations mean for these company's trademark rights? How far can a company alter its trademarks without losing rights in the old mark? Are the altered marks considered a new trademark?

Trademark rights flow from use

As stated in many of our prior articles, under U.S. law, trademark rights flow from *use* of the mark in commerce. When a company uses a word, logo or other symbol to identify the brand of the goods, then it gains trademark rights.

The first business to use a trademark is said to get "priority," meaning that it has superior rights over others who use the same mark later. So, if a second business uses the same mark, even innocently, then it can be stopped from using it, because the first user has priority, and thus has superior rights.

Conversely, just as a business gains trademark rights through use, if a business *stops* using a trademark, it can lose its rights. This is deemed abandonment. In trademark law, the rule is, "use it, or lose it." This is different from other IP rights, like patents and copyrights, which have no requirement that the owner use them in any way.

Under the Trademark Act, any time a business discontinues use of a mark with intent not to resume use, the mark is deemed abandoned, and rights are lost. Nonuse for three years creates a presumption that the mark has been abandoned.

So, will the companies who altered their logos to affirm social distancing be deemed to have abandoned their

trademarks? Likely not.

For one thing, some of them still continue to use their old marks.

Audi, for example, created a short video that showed its four interlocking rings moving apart, as a kind of affirmation of social distancing. The beginning of the video still used Audi's long-standing mark of four linked rings, so it has never stopped using the old mark, and thus maintained its rights.

And, most of these companies altered their marks only temporarily, to make a statement about social distancing. If they indeed resume use within a few months, then they will have a strong argument that they did not stop using their prior mark with intent not to resume, and hence there was no abandonment.

Altered marks and "tacking"

What happens if the trademark owner, in fact, wants to alter, or update, its trademark? The Morton Salt Girl, Mr. Peanut, and the Gerber baby are all well-known, longstanding marks that have been updated from time to time.

If a trademark owner modernizes its mark, does that mean that it is deemed to have abandoned the original mark, and adopted a new one with a new, later priority date?

Generally, the answer is yes.

There is a narrow exception, however, called "tacking" which says the owner can "tack" on the time when it used a prior version to the later version, and thus get an earlier (often much earlier) priority date.

The test for "tacking," however, is strict. The marks have to project the same commercial impression to consumers, such that they consider them the same. This often requires survey evidence to prove that consumers indeed view the marks as the same.

This standard is stricter than the usual trademark infringement standard that the infringer's use creates confusion. For tacking, unlike for infringement, the second mark has to be considered the same, not merely confusingly similar, by consumers.

Most claims of "tacking" fail, and even seemingly close marks are often deemed too different to permit tacking. But there are exceptions. The Morton Salt Girl is a famous example.



The Morton Salt Girl

So, are the companies who altered their marks to affirm social distancing able to "tack on" their prior uses?

Probably not the new "socially distanced" marks are likely different enough from the prior marks to be considered the same. The whole point of these altered marks is both to conjure up the prior famous mark *and* to show that there has been some temporary change due to social distancing; if the marks are viewed as the same, then the social commentary would be missed.

That said, assuming these companies maintain their old marks, they can still stop use by others of these altered marks. If another company were to use, say, four separate rings for luxury automobiles, Audi would likely convincingly argue that this is confusingly similar to its four-linked-rings marks, even if the marks are not identical.

Fluid marks

Some trademark owners have adopted a strategy called "fluid marks." They use one basic trademark, and then present it in continually altered format, but always conjuring up the base mark.

Probably the best-know example of this is Google. The term "Google," of course, is one of the most famous trademarks today. Google's home page frequently presents variations of this name with various drawings and visuals that allude to current events a holiday, a political or social message, or some other idea the company is promoting.

Absolut Vodka does similar things with its ABSOLUT mark, often shown in variations in different advertisements.

Using fluid trademarks can be a powerful marketing tool, but trademark owners who do this are advised to take several precautions to ensure their rights continue and are not deemed abandoned.

First, fluid marks should only generally be used where the mark is already commercially strong. Using a fluid-mark strategy for a weak mark would likely create confusion among consumers, who will not associate all the variations as one single mark.

Second, it is important that each variation still strongly reference the base mark. Google's logo always has the term "Google" easily noticeable as the base of the logo, so its rights in that term cover the design variation.

While most trademark owners do not employ the "fluid trademark" strategy, relying instead on the traditional strategy of using the same, consistent mark to maintain brand identification, for those who do, it can have a powerful branding message.

Use of the registered symbol

A trademark owner who has registered a mark with the United States Patent and Trademark Office is entitled, by the Trademark Act, to give notice of this, usually by using the designation. This is generally advisable, as without such notice, the trademark owner may not be able to obtain damages in an infringement suit.

On the other hand, using the for marks that are not registered or for goods and services not included in the registration if done deliberately, can be considered a fraud, and may lead to loss of trademark rights or inability to enforce the trademark.

What about altered marks? If the marks are indeed the same not merely similar so as to allow "tacking," then the prior registration covers the mark, and the can be used. Otherwise the should be left out, and, if the owner wants, use the designation TM instead.

PROPERLY HANDLED, a temporary alteration of one's trademark for social commentary should not affect trademark rights.

The best strategy is to continue using the old mark in some fashion, thus maintaining continued use. Barring that, a trademark owner would be well advised to document that the change is only temporary, and the intent to resume use of the original mark within a short time.



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