

## **Legal planning for 2019 - Trademarks (S3E66)**

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**00:06 Autumn Witt Boyd:** Welcome to The Legal Road Map® podcast for online and e-commerce entrepreneurs. I'm your host, lawyer Autumn Witt Boyd. I'm an experienced copyright and trademark lawyer. With my team at the AWB Firm, I leverage, grow and protect multi-million dollar online businesses.

**00:22 AB:** My goal in every episode is to teach you about the sophisticated legal and business strategies to build your own seven or eight-figure business. If you're a new business owner, go back and listen to episodes one through 12. You'll learn the basics to set up a strong legal foundation.

**00:36 AB:** The Legal Road Map® podcast is sponsored by the AWB Firm. You can find show notes for every episode, and learn more about how we help our clients achieve their next level goals at awbfirm.com.

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**00:52 AB:** Hi everybody, lawyer Autumn Witt Boyd here, glad you are joining me in today's Facebook Live and Legal Road Map® podcast, we are going to do our second installment in legal planning for 2019, and today we are going to talk all about trademarks. So if you have a business name, a product name, a logo, a slogan, anything that identifies your business for your customers, you are going to want to listen to today's episode. And I'm going to point out first, you'll see a link on the screen and we'll include it in the show notes to get the worksheet that I'm going to be working through today. Here is the visual of it. If you are watching the video, you can get that at awbfirm.com/podcast. So that's our podcast page on our website and it is our five-minute copyright, trademark, and trade secret audit, we call it our IP Audit. And that may sound scary if you have never done anything like that. Looking into your business and trying to figure out what assets you actually have that could be protected by intellectual property.

**01:51 AB:** But I promise, it is not scary. And I'm gonna go through part of it today and then part of it next week, we are going to go into... We're gonna talk more about copyrights in your business, and what kind of legal planning you need to be doing depending on what big goals you have for 2019.

**02:04 AB:** So let's dig right in. I get probably more questions about trademarks, than anything else with our law firm. So I wanna give just a really brief overview if you are not familiar with how trademark law works.

**02:15 AB:** And unless you went to law school, you probably are not or have worked in a big business that had a trademark portfolio. So it can be confusing and overwhelming. So I'm here to break it down and make it really, really simple. So I'm making my standard disclaimer before I hop in. I am Autumn Witt Boyd, I am a lawyer, I'm licensed to practice in Tennessee. I'm not your

lawyer, unless we decide to work together one-on-one. So please take everything that I'm talking about today, as information, not legal advice. If you have questions that are specific to your situation, please check with your own lawyer.

**02:45 AB:** Okay, let's jump into trademarks. So a lot of people get trademarks and copyrights confused and it's totally understandable because there are a lot of things about them that are very similar, but there are some things that are really different. So when we think about a copyright, and again, this is all under United States law it's a little different in other countries, but in the US copyrights are going to be those things that we think of as creative works. So, looking around my office you can't see them, but I have some beautiful artwork on my walls, I have books behind me. If you go to see a movie if you're listening to music, all of those things, those are the typical things we think of as creative works. Those are all protected by copyright.

**03:21 AB:** But there's also things in your business that could be protected by copyright and we don't always think about those. So if you have... Let's say, for example, this five-minute IP audit that I was just showing you, this is protected by copyright. It is out of my brain. That's one of the rules. It can't be just an idea or a thought that you have, it has to be on paper, or in a computer file, it doesn't have to be physical, it can be digital, but it can't just be an idea or a thought. It has to be something that you have put into what we call a tangible form of expression. So it could be things you're using in your business like intake forms, there is a very famous copyright case that is all about an insurance manual. So it doesn't have to be sexy and exciting and what we think of as super creative to be protected by copyright. It could just be some of the things that you use day-to-day in your business.

**04:06 AB:** For a lot of my clients, their website copy and any blog post, images, so photographs, or graphics that you have on your website, all of that is going to be protected by copyright. If you are an online course creator, all of your course content is going to be protected by copyright. So all those videos, any worksheets or workbook or resources that you create, checklists, all of those kinds of things, any exercises that you have your students go through, that's all going to be protected by copyright.

**04:32 AB:** Now again, it can't just be in your brain, it has to be actually in a document or some sort of thing that you could actually put your hands on or submit to the copyright office, if you were wanting to register it.

**04:42 AB:** So those are the things that we're thinking about as copyrights. Now, switching over to trademarks, these are the things that identify your business for your customers. So, I think that makes it really clear when we think about it through that frame. The way trademark law is intended to work. Is it supposed to help consumers figure out what the sources of the goods and services that they're buying? So if you walk into a convenience store and you want a Coke, you see the bottle in the cooler, you recognize the label, you grab it, you open it, it tastes exactly like you expect it to taste. That is all a function of trademark law because the bottle shape, is protected by trademark law. It's actually, a registered trademark.

**05:18 AB:** The label, the design, you see it and you know exactly what you're going to get. So that is what trademark law is intended to help people do. You know you're not gonna get Pepsi because

the Pepsi label looks different. It has a different name, a totally different image that is being portrayed to the consumer. So all of those things that I just mentioned, could be trademarks, so bottle shape, packaging, product names, company names, logos, slogans, all the things that we use to identify who produced this thing or who is selling me this service, I wanna know what I'm gonna get.

**05:50 AB:** So when you think about trademarks, think about the source of a product or service. So looking at the screen right now, if you're watching this on video, you can see my firm logo. So this is an area that there could be some crossover between copyright and trademark if you do have a more creative logo that has some visual elements that are kind of a cool design or maybe hand drawn or something that could also be protected by copyright law.

**06:13 AB:** So one of my favorite examples of this is Micky Mouse. So he's a drawn character that is totally protected by copyright. It's a creative work to drawing, but it also signifies the Disney company, so also protected by trademark law.

**06:25 AB:** So we've got a lot of overlap here sometimes, but again, think about trademarks as protecting consumers from being able to figure out what they are getting when they are looking for a product or service and keeping them from being confused.

**06:38 AB:** That's the real problem that happens when you have two businesses with really similar names, and you're looking for one, you can't tell which one is which. And so we see that a lot when we have issues about website domains, or the names of online courses, things like that, people wanna make sure, that if they're looking for your thing they're finding your thing and not your competitor's thing, that is labelled similarly.

**06:58 AB:** So those are our goals with trademark law. So as you're thinking about legal planning for 2019, I'm gonna walk you through this worksheet, and the exercises about trademarks, because I want you to be thinking about what new things are you doing or what things were really successful in 2018 in your business that you're now going to scale or grow, or kind of double down on.

**07:19 AB:** So either way, I want you to figure out what are the brands that you're working with, what are the visuals that are really working for your business, or what new things do you have coming out that you... Maybe it's a new program, but you're really investing in it, you're gonna hire a professional designer and a copywriter and you're gonna really... Make it nice and it's gonna be an investment, when you have something like that you wanna protect that investment or if you have something, a program or an e-book or anything in your business that you've been selling that's been really profitable and now you're gonna grow it or increase your investment in that, that's another good time to think about. Okay, I wanna really protect this because I do not want my customers getting confused because my competitor sees that I've done something really smart here, and now they're going to name their thing, the same thing. Are there gonna be adopt a slogan that's really similar to mine? So these are the things I want you to be thinking about as we're going through this IP audit.

**08:09 AB:** So here's the first step in this worksheet and again you can download it at

awbfirm.com/podcast. Go get your own copy. It's only... Let's see, I think it's three pages long, four pages. Yeah, three pages. It's not very long at all.

**08:22 AB:** And a lot of it is kind of my instructions which I'm gonna be going through here today. So the first question is what we've just been talking about, how do your customers identify your brand and know that it's yours?

**08:32 AB:** So I want you to just jot down, what is your company name, any kind of service lines that you have, what are your different product names, or service names?

**08:41 AB:** Do you use different logos for different things or any of those particularly creative?

**08:46 AB:** What about any kind of digital products or if you have a signature service that you offer one-on-one any of those things, if you have something catchy or it's not going to be a trademark if it just describes the thing you do. So let's say you are a website copywriter, and you have a copywriting service and that's what you call it.

**09:03 AB:** That just describes the thing you do. So that's not gonna be protectable as a trademark. And the rule for that is if it just describes the thing you're doing or the thing you're selling, that's not protected because the trademark office doesn't want the other people who are just trying to describe the thing they're doing to not be able to use those words. So you're never going to be able to register things that are just totally descriptive, like the computer shop or a pizza place, [chuckle] things like that are not gonna be protectable. But think of things that are unique or that you have come up with that are maybe a little distinctive in your business. And I want you to jot all of those down so you can start thinking about that. It could also be your domain name.

**09:39 AB:** So if you have a website URL that's really catchy or interesting, and that people associate with you. It's funny, we did kind of a gentle rebrand here at my law firm about six months or a year ago.

**09:51 AB:** And I went back and forth because it's just been my name but now we've really grown and we're a staff of six, and we have two other attorneys. It's not just me anymore. And I looked at maybe choosing a different name, that was a little bit more unique, descriptive, that wasn't just the law office of Autumn Witt Boyd, which is what it is now and it feels very long.

**10:08 AB:** And when I chose my website in the very beginning, I used my initials just because a lot of people can't spell Autumn. It's a funny word, it's hard to spell. And so I wanted it to be easy and I wanted it to be short to be able to direct people to my website. So we've been using AWB Firm since day one. But I had never really thought of that as a name for the firm and my friend, I think it was Kathleen Shannon who is a branding expert. It's no wonder that she... With Braid Creative that she came up with this, but she's like, "What about the AWB Firm, why are you over-thinking this? That's what people call you anyway."

**10:39 AB:** So there could be some things that you're not even thinking about. Again, website URL, may be one thing that people identify you with that you haven't really thought about in your

business. Go ahead and think about all those things, all those different assets in your business, that could be a trademark that people use to identify you. And then I want you to also think about, are you aware or do you know for sure that someone else might have used them first? So this is especially true if it's a common phrase or something that's not that unusual. But you're not gonna be able to protect these as trademarks, if you know someone else was using them first. And that's because in the United States, all of our trademark rights in the US, are based on that date of first use.

**11:18 AB:** So you obviously want to be the first one to use it so that no one else can come after you and say, that they knew you were using it before them. So this is also a great time when you're thinking about your 2019 plans, if you haven't already, hopefully you did this in the very beginning of your business, but if you haven't already, this is a great time to run a quick trademark search. See what else is out there.

**11:38 AB:** Especially if you're thinking of registering a trademark in 2019, you're budgeting for that, you're planning for that. You wanna take your level of trademark protection to that next level and get those extra benefits that you get from a federal trademark registration with the US Patent and Trademark Office, if someone else has already registered your same business or product name or something very similar, you're not gonna be able to register, the USPTO will deny it. So again, before you're making these big investments, before you're launching a new brand, or a new program or maybe up-leveling your branding on an existing brand, it's a great time to do a quick search and see what else is out there.

**12:13 AB:** I recommend that people do a Google search first. It's easy, it's free, but definitely go to that third or fourth page [chuckle] of Google. Don't just stop on the first one. And see if anyone else is already using the same words that you're using. The second search that I would recommend is the USPTO website. Now, the USPTO website is what a lot of people do, and because of what I mentioned we have this first use rule in the United States. People can have what we call common law trademark rights. So they're not registered, but they're automatic. You get them from your state, just by using a trademark in your business with certain products or services.

**12:49 AB:** So, if you just search the USPTO database you're going to miss all of those common law trademarks, 'cause they're not registered, but you can still file a lawsuit, even if you have common law rights. You still can send a cease and desist letter, you can send a take down notice to Facebook or Etsy, or a lot of these online platforms and social media platforms. So you definitely don't wanna just check the USPTO website, it's an important place to check, but it is not going to capture everything. So I recommend Google, the USPTO website.

**13:17 AB:** I also recommend checking your state's Secretary of State or business wherever the business database lives for people from LLCs and corporations. Because again, with a Google search and the USPTO search, you're gonna catch things that are on the internet and things that are registered with the USPTO but there could be a business that you don't even know about because it doesn't really have an online presence and you might catch that with your state's business database. So you wanna check those three things at least. And then I like to add in another one which is called NameCheckr, it doesn't have the second E. So it's N-A-M-E-C-H-E-K-R. So it's spelled funny which is a great trademark tip, because spelling things funny, is a great way to create stronger

trademark rights. But if you go to NameCheckr, it will check the top domain registry. So for the most common websites, it doesn't check everything, but it gets the dot com and a couple of others, it will check all the major social media platforms so you can see if someone else is using your business name or your product name, as a username on one of those platforms.

**14:15 AB:** And again, you're just kind of trying to see what else is out there. If you find that there's a bunch of other people already using it, and then you can check and see were they there before you did they come after you? If you find that it's a really common phrase, it may not be protectable. So this is all just kind of information gathering as you're planning for 2019, and you're thinking about making these investments and putting time and energy into new things, or growing existing things. You wanna make sure that you've got a brand that's actually protectable and that you can really make your own because the goal with a brand is you don't want your customers to be confused, so you want to be able to send out a cease and desist letter or tell people gently.

**14:52 AB:** The first step is always a gentle... "Hey, I noticed your product name is really similar to mine. I think this could be confusing. Would you mind changing it?" Something like that. If you know that something super common that tons of people are using it or that it's become generic or that there's another well-known business that was using it before you, you can make the choice now, you can make an informed decision and you can have a lot more peace of mind and calm going into making those investments and doing those big exciting things that you've got planned for 2019. So after you've done this inventory, doing a quick search. And this doesn't take a long time, it may take a little time to sort through what comes up and think about it. Figure out how close is too close. That's a whole another podcast, and I do have a podcast, I'll drop that episode number in the show notes and in our Facebook page. I did have a whole episode where I went through... If you get a list of search results, how do you figure out whether one is too similar to yours, 'cause it's not just exact matches. You wanna look at things that are similar as well.

**15:48 AB:** So running that search, seeing what comes back, will help you make the best decision you can as you're planning for 2019. So this first step, identify how your customers identify your brand and know that it's yours, and then taking that one step further, and doing that quick search to see what else is out there. This is another thing to really think about what are you selling? And I think when you think about brands in a vague sense it's hard to sometimes land on what exactly do you have in your business that could be a trademark? But I want you to write down all the things yourself. [chuckle] Is it an online program, is it an e-book, is it an online course, is it one-on-one services, is it a retreat or an in-person event. I want you to write down all the things that you sell and then I want you to go back and again think about what you call them, are there words that you use really frequently within them.

**16:37 AB:** I find that some of my clients have catch phrases that they use over and over when they're talking about certain concepts or that they use to sell a program or to talk about their services. And so those could be potentially protectable trademarks. So I want you to go through all your products and services. It may be a long list, maybe 2019 is a year of simplifying. That's what we're doing here at the AWB Firm. So go ahead and write all of that down and I think that will help get your juices flowing for figuring out what trademarks could be in your business. And then, the next thing I want you to think about is, do you have a signature program? Do you have a method or a protocol that you are using in your business?

**17:14 AB:** This is often something that after you've done it for a while, maybe you've turned it into an e-course or maybe you've written a book that contains it, it can take a lot of different forms. But I mentioned my friend Kathleen and the Braid Creative, the branding agency, that she and her sister, Tara run. They have what's called the Braid Method and it is how they do branding projects, they walk their clients through this same process every single time, and so that has become a trademark in their business. The Braid Method. So it may not be... That's not a service they sell, it's just a way they do things.

**17:46 AB:** So this might be something to think about, if you have a signature service process method. Any of those kinds of things, if any of that rings a bell for you, I would either think about, what are you calling it, how are you talking about it? Do you have a logo that you use with it or a tagline that you use? Again, these could all be trademarks in your business. The other thing I want you to think about if you do have one of these signature programs, methods, processes this could be an opportunity for you in 2019 to think about a licensing program. And I had a whole series, about licensing programs, earlier in the podcast so I'll drop those episode numbers as well. If you wanna learn more about the nuts and bolts and how those are, can be put together. It's kind of like trademark 301. It is an advanced strategy but it can be really beneficial to your business if you have grown and you are really burned out actually providing all the services yourself.

**18:36 AB:** It's especially popular with service providers, life coaches, business coaches, business strategists, branding agencies like I mentioned, because it's a way, if you put together a licensing program you can package it up, and sell it to other people, you're not really selling it to them, you're just licensing it to them, you're giving them permission to use your intellectual property and part of that is going to be your trademark. So if that is something you've thought about or if you haven't thought about it, I wanna go ahead and plant that seed because I find it's really powerful in helping service providers, especially scale their business in a way that is sustainable.

**19:08 AB:** It doesn't burn them out, it doesn't make them crazy because you can have other people out there providing similar services to what you're doing, you don't have to do it all yourself, and you can... By creating this licensing program sometimes we hear them called certification programs for training programs. You have all these people out there kind of like acolytes, now spreading the word about you, but you wanna have definitely a strong brand, a strong name for whatever that certification program is gonna be.

**19:35 AB:** So great examples of this would be Danielle LaPorte. She has the Desire Map. She wrote that book. It helps people identify what she calls their core desired feelings. I'm almost sure that core desired feelings phrase is a registered trademark. She now has a certification program where you can pay her a flat fee and she will... I don't know if it's a workshop, or I'm not sure exactly how it's set up, but you can go through a training program where she teaches you how to work her method, how to teach it to other people or take other people through it. And then at the end, you become a licensed or certified Desire Map coach or consultant. I'm not sure exactly what she calls them.

**20:14 AB:** But you now have permission to use her trademark. Because Desire Map is a trademark. So part of that licensing program is giving people permission to use your trademarks, in their

business. And again, now you've got tons of people out there spreading the word about your program, your way of doing things, but having that trademark, making sure you have a good name for your program. And part of a licensing program is always going to be registering those core trademarks. When you have a licensing and certification program, you're getting bigger, you've got other people using your trademarks, and probably your copyright of materials as part of their work.

**20:46 AB:** And you wanna be able to make sure you've got those protected and locked down so that if you do have to send a cease and desist letter, go after someone, ask them to stop doing what they're doing, that you have got the right legal protections in place on the front-end so that you can take whatever actions you need to do later. So, if that is something, if this is like, it's ringing a bell in your brain, I hope you will think about this. And this is one of my favorite projects to work on one-on-one with our clients, we take this off their plate, we set up a licensing and certification program, all the documents they need so that it can run really, really smoothly. But definitely one of those first steps is registering that trademark. So again, if you are thinking about this and you haven't run a search, before you spend all the money with the branding agency, before you put together a bunch of information and start teaching you wanna go ahead and do a search and make sure that that name of that program or whatever the catch phrases are gonna be that are gonna really identify your trained people that you can protect those is super-duper important.

**21:45 AB:** So that's gonna be my last thing to think about is if you have a signature program method or protocol that you might wanna teach to others, go ahead and write down any kind of pieces of that, any names, any slogans, any logos that you're using with that and make sure that those are clear to use. This search that I've been talking about is really what we call a clearance search. So you just wanna make sure nobody else is already using it who could cause you trouble down the road. So that's what we call a clearance search. Later on if you want to actually register the trademark, we do a deeper search and you definitely wanna work with a lawyer for that to make sure that there's nothing that could pop up during the USPTO registration process that could cause you trouble. We call that a knock-out search. [chuckle] So it's just the deeper search, you're bringing in an expert who is used to doing this analysis and figuring out how close is too close and they can help you make that decision of whether it makes sense to register. But doing this initial clearance search yourself is not expensive, you can do it yourself, it's not time consuming, and that is really gonna set you up for success in 2019. If you've got this signature program, method or protocol that you are wanting to teach and maybe set up your own licensing or certification program.

**22:52 AB:** So I hope this has been helpful, I would love to hear what your 2019 big goals are and we've got some stretch goals, we're working on our goals here at the AWB Firm as well. Please, if you haven't already, I would love to see you in our Facebook group. It's called The Legal Road Map®, the Facebook group, same name as the podcast. So we're easy to find. It's full of business owners, just like you who are overwhelmed, confused by legal and trying to figure it out as they are running their business. So come join us.

**23:16 AB:** And we've got people asking smart questions and I chime in there every now and then, and we've got other people who are answering and sharing their own experiences as well. So it's a wonderfully supportive group. It's a happy nice place on the internet, which it can be hard to find these days. But I would love for people to post their 2019 goals in that group. And let us know what you're working on, maybe what your brainstorming and what you could use some support on as

you're figuring out your next steps. I hope this has helped you think about some trademark issues and the questions that you should be asking as you're setting up those 2019 goals. So next week, as I mentioned we are going to dig into planning for copyrights in 2019 and again, it's going to be the same worksheet that I've been referencing. The link is right there, if you're watching on video [awbfirm.com/podcast](http://awbfirm.com/podcast), is where you can download this worksheet. It is not difficult. And I'll walk you through the rest of it next week. Thanks so much. Look forward to talking to you then.

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**24:13 AB:** Did you know that you could be making more money from your copyrights and trademarks? Intellectual property is probably the most valuable asset in your creative business. But most entrepreneurs don't know how to identify it and you can't monetize what you can't find. Download my free five-minute IP Audit Worksheet at [awbfirm.com/podcast](http://awbfirm.com/podcast). You'll find out what parts of your brand, logo, images, website, courses, digital downloads, or other content could be protected by intellectual property laws and you'll create an inventory of your most valuable trademarks, copyrights, patents, or trade secrets so you'll know what's worth protecting as you build a more profitable and sustainable business. Get your five-minute IP Audit Worksheet now at [awbfirm.com/podcast](http://awbfirm.com/podcast).

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