

Why should I register a trademark anyway (S3E68)

## **Why should I register a trademark anyway (S3E68)**

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**00:07 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. 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 1 through 12. You'll learn the basics to set up a strong legal foundation. 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, friends. Happy 2019. This is lawyer Autumn Witt Boyd, I am so glad to be back with you on Facebook Live and the Legal Road Map® podcast. Today, we are going to dive into what will be several weeks of all about trademarks. So, if you have been wondering, "Why should I register a trademark? Do I need to register a trademark? Are there specific times when it's best to register a trademark?", if you've heard about things like common law trademarks, if you've heard about trademark searches but you're just not sure what that means, we are going to cover all of these topics one by one over the next couple of weeks. So, you are definitely not going to want to miss a single episode.

**01:33 AB:** Today, we are going to dive into the first question that I get, which is, "Why should I register a trademark? Do I need to? What are the benefits of registering a trademark?" I'm gonna give you seven reasons why you might want to think about registering your trademark with the US Patent and Trademark Office. But first, I want to give a little introduction. My name is Autumn Witt Boyd, I am a lawyer, I am licensed to practice in Tennessee, I live in beautiful Chattanooga, Tennessee. Everything that I'm gonna be talking about today is not legal advice; this is just information, so, it's meant to get your wheels turning, help you think about things that either you're facing in your business right now or you might be facing in the near future.

**02:13 AB:** So a little bit about me, I have been a lawyer for 14 years, primarily working in the areas of copyright and trademark law. Almost four years ago, I started my own law firm, which is the law office of Autumn Witt Boyd. We call it "the AWB Firm" for short because that is quite a mouthful, and we are now a full-service law firm for online business owners. We like to really work one-on-one and help support business owners that are already successful and that are really building their online empire. But we also have a lot of resources and lower price offerings, like our contract templates, this podcast, lots of things on our website at awbfirm.com, if you are not quite that far along in your business yet so as to need your own lawyer to work with one-on-one.

**02:55 AB:** So we are going to dive in on why you might want to register your trademark. Again, I said I'm gonna give you seven benefits that you might wanna think about whether this makes sense

for you and your business. But before I dive into those seven benefits, just a really quick primer on what the heck is a trademark. So, if you've been listening to the Legal Road Map® podcast for a while, you have probably already heard me give this explanation, but if not, go back and listen to episodes 5 and 6. Those are from the first season of the podcast. I really created that first season to be a primer for every new creative business owner to set up their business the right way with a really strong foundation. So, it is 12 episodes that goes through most of the legal issues you are going to deal with and you might need to think about, copyrights and trademarks are a big one. If you are operating a website, doing e-commerce, if you're doing online marketing, email marketing, social media, all of those topics are touched on in season one. So go back and listen to episodes 5 and 6. I'm gonna give a very high-level, brief overview of what is a trademark. But if you want to learn more about just the basics of what is the trademark, how is it different from copyright, go back and listen to episodes 5 and 6.

**04:03 AB:** But just so this episode makes sense, if you want to keep listening, a trademark is basically the indicator of a source of a product or service. So if we think about it like that, it helps everything that I'm gonna be talking about today make more sense. So what do I mean by that? We often talk about trademarks as protecting a brand. So, let's say you have a great name for your company or a name for your product. Think about Coca-Cola or McDonalds. As soon as you hear that name, you immediately start thinking about the products that they sell: The softdrink, the hamburgers. You think about what the restaurant looks like. It is not only words, though; it can also be things like packaging. So, if you see the Coca-Cola bottle on the shelf, you know what's going to be inside it because you recognize what that package looks like, you've seen it before. It immediately connotes in your brain a certain type of quality. You know what you're getting.

**04:58 AB:** So that is really the whole premise of trademark law, is to help consumers figure out whether they're buying the right thing. So again, you see that red and white Coca-Cola emblem, you know what you're getting in that bottle; you see the Golden Arches at McDonalds, you know what the hamburger is going to taste like. You are not gonna be confused if there is another McDonalds restaurant next door that is selling different things. Maybe it's not selling hamburgers at all; maybe it's selling something totally different. So trademark law is meant to protect consumers and help us make easy, quick decisions about things that we are purchasing.

**05:33 AB:** So, I mentioned it could be a name, it could be a logo or packaging; it could also be things like slogans. So Nike is another one of my favorite examples. The word "Nike" is a registered trademark. The image of the all-capital NIKE letters is also a registered trademark, and the swoosh is a registered trademark. So, it's an image, but when we see it, we think of the Nike brand, and if we see it on a pair of shoes or a pair of shorts or a jacket, we know where those came from, we know what that company's quality is like, we know what to expect. So all of those things can be trademarks. It also can be some things that might surprise you, like a sound can be a registered trademark. Actually, Zippo just got a registered trademark for the sound of flipping open a Zippo lighter. So, it can be all kinds of things, it could be colors, Tiffany & Co, that beautiful blue that they use on their boxes is also a registered trademark. So it could be all kinds of things, but the thing to keep in mind when we're talking about trademarks is this is indicating the source of a product or service. So, we often think of names, slogans, taglines, and logos as being our primary brand indicators, but it can also be other things.

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**06:39 AB:** Alright, so here's seven reasons why, if you have a strong product name, company name, slogan, or logo, you might want to protect it with a federal trademark registration. And you can also register trademarks with a state. I'll be talking about that in a few weeks, but today, I'm talking about the benefits of registering with the United States Patent and Trademark Office. This is mostly what we think about when we're talking about protecting a brand with a trademark registration. So the biggest benefit is what I kind of mentioned, that you're getting nationwide protection for your trademark. So, if you're registering your trademark with a state or if you're relying on what we call "common law rights," that's another concept that I'll dig into in a couple of weeks, those are different levels of protection, they are only going to protect you either in the area that you are actually selling your products and services, for common law trademarks. If you're... Let's say I live in Chattanooga and I am practicing law, I have clients just in Chattanooga and maybe two other counties in Tennessee, so my trademark rights are only going to extend to those areas where I'm actually selling my services.

**07:45 AB:** If somebody starts another law firm named the AWB Firm across the state line in Georgia, I cannot go after them. I don't have any trademark rights in Georgia because I'm not practicing law, I'm not marketing my services, I'm not telling people about what I do, and I'm not serving clients, in Georgia. So my trademark rights are going to be restricted to the area where I'm actually using them. With a federal trademark registration, now, I get nationwide protection, even if I'm still only practicing in Tennessee or maybe I have a couple of states that I practice in. There is one requirement for a USPTO registration: You are supposed to be using your products and services in what they call "interstate commerce." It's a pretty loose definition, but there does have to be some crossing of state lines, that could be I have a client in Georgia who comes to my office in Tennessee. It's a pretty loose, low bar, but you do have to have some sort of interstate element to get this nationwide protection. But now, I have rights across the entire United States, in California, in Connecticut, in New York City, in places that I am not visiting or selling my products at all, but it gives you that nationwide protection because you may expand into those areas at some point. So, you don't have to be selling across the entire United States to get that nationwide protection.

**09:05 AB:** So now, if a law firm in California starts up called "the AWB Firm," I can take action to stop them from using my trademarks. I can send them a cease and desist letter and tell them that I have these rights. I can file a lawsuit if I have to. I can file takedown notices on social media sites or other platforms where they may be marketing their law firm using my same name. So it gives me this whole world of rights and the ability to enforce those rights nationwide, so it's not limited to the territory where I'm actually selling. It now is going nationwide. And this is an exclusive right. So when I mentioned I can stop other people from using the same name or a similar name with the same or similar services, the exclusivity, that's really what you want because now you can stop other people from using a similar name to yours. So, again, as I mentioned, this is gonna be nationwide protection, it's an exclusive right, so you now have the ability to stop people from using either the same name, a similar name, the same logo, similar logos. It doesn't have to be exact. That's our number one benefit: Nationwide protection; nationwide, exclusive rights.

**10:19 AB:** The second benefit or advantage to registering with the USPTO is that now you have given public notice to other people that you have these rights and that you are willing to enforce them. So, if someone is considering starting a business or naming a new product or a business, they might do a trademark search in the USPTO database, which I highly recommend. We'll talk more in

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detail about trademark searches soon. So now when they do that search, before they choose a new brand name or a new logo, you are gonna pop up. You are now in the database. They can see that you have taken the time and trouble, you have put your money where your mouth is. You have shown that you own this trademark and that you are willing to enforce it. So, public notice to others: That is gonna be our second benefit, that you're gonna show up in that USPTO search. And we now have a lot of databases that are pulling from the USPTO, so even if someone runs a Google search, it is likely that your trademark file with the USPTO is going to pop up in their Google search. So it's not just if someone goes to the trouble of going directly to the USPTO website; it probably will also show up in other searches and it will again give them notice that you have registered with the USPTO.

**11:30 AB:** The third benefit, and I'm not gonna get too deep into this because this is very boring legal stuff, but you get some legal presumptions. And all a presumption means in lawyer talk is that instead of having to prove a fact... So let's say I sue someone who is using my trademark and I go to court, there are certain facts, there are certain elements that I have to prove to be able to win my case. I have to prove that I own the trademark, I have to prove when I started first using it, to show that I was in fact the first person using it. There's several other things that I have to prove. There's just kind of a checklist of things, and the other side then has the chance to challenge those or to say those are not true. So, all that a presumption means is that I don't have to actually bring evidence into court to prove those things; the court will just presume that the statements in my trademark registration are true. So, the court will presume that I do in fact own the trademark, the court will presume that the data first used that I included in my trademark application is correct.

**12:30 AB:** So there's a couple of other presumptions that... It just is kind of a shortcut, it just saves you a little time, energy, trouble, money. You don't have to prove those things; the court will presume them. Now these are what are called "rebuttable presumptions," that means the other side can bring evidence to show that that's not correct. But again, it's just a little shortcut, it just makes it a little bit easier. If you do end up having to file a lawsuit, you get to take a little shortcut. So that's number three: You get some legal presumptions.

**12:57 AB:** Number four: If you are selling products or services in other countries outside the US, you are gonna get some benefits from your US trademark registration. It makes it easier to register your trademark in those foreign countries, so you can kind of piggyback on your US registration. Now this is complicated, I would not recommend that you try and do this on your own. You're definitely gonna wanna work with an experienced trademark attorney if you are considering doing this because there are very strict time requirements for when you can do this. But there is the ability to use your US trademark registration as a jumpstart to registering in other countries. So that is a definite advantage if you are selling internationally.

**13:36 AB:** Number five. This is especially important. I was just talking about a client who is a product-based business today. If you are selling products and you are worried about counterfeiting, there's a huge advantage to registering your trademark with the USPTO, and that is that you can then record your trademark registration with Customs and Border Protection, and they will take steps to stop counterfeit shipments at the border. So, let's say you are Louis Vuitton and you sell very popular handbags, and they are highly recognizable, they're also very easy to counterfeit if you don't know what you're looking for. The style of the purse is iconic, that you have an LV, the letter

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logo, and the colors are very recognizable. So they're very easy to counterfeit because they have a kind of standard look to a lot of their handbags. What they can do once they have a trademark registration on that logo, on those colors, you can even register a trademark for a color combination, they can now record those trademark registrations with Customs and Border Protection, and if there is a shipment coming in that they suspect has counterfeit goods, they can stop those at the border. So before they hit the streets in New York with the street vendors selling counterfeit handbags, you are able to stop those.

**14:54 AB:** There's a great episode of the podcast How I Built This talking about the TRX trainer, if you guys are familiar, it's kind of these nylon rope kind of things that you use to all kinds of body weight exercises. And they had a real issue with counterfeiting coming in from overseas, and they were able to use their trademark rights to stop some of those counterfeits from coming into the US. So it's a definite advantage if you are making actual, physical products and you're putting a trademark on the products. That gives you a remedy, it gives you a way to stop some of those what we call "infringements." In copyright and trademark and patent law, if someone is using something that you own without your permission, we call that an "infringement." So number five is the ability to stop counterfeit goods from coming into the United States from other countries by recording your trademark rights with Customs and Border Protection.

**15:42 AB:** So, number six, this is one of my very favorite benefits to having a federal trademark registration, is it makes your business more valuable. So, I am a big fan of... Even if you have a personal brand, even if you feel like you are the driving force behind your business, I'm a big fan of people thinking about what it might look like to sell a business down the road or to bring on a partner, take on an investor, have some sort of third party coming into the business, whether you're leaving or whether you're just bringing on someone new. And if you have registered trademarks, you now have more valuable assets in your business. It really is something that has a monetary value, and that if you are taking on an investment or if you are taking on a partner who is maybe gonna buy part of the business from you or if you're selling the business altogether, now, if you have a stable of registered trademarks, and you should be registering your other IPs, so, registering your copyrights and if you have any patents, any other kinds of intellectual property that is really key to your business, but we're just talking about trademarks here, if your brand is a registered trademark, that makes it much more valuable for taking on investment. And the same is true if you have considered setting up a licensing or a certification program within your business.

**16:58 AB:** Now with my clients who are mostly online business owners in the education space, this usually looks like maybe certifying people to teach what you're teaching, or to coach people in a certain way, or to use a special process, or walk people through a particular way of doing things. That is one way to have a certification program or a licensing program. But you also see these with physical products, so, if you are, let's say a designer, and you have a really... [chuckle] This is corny, but if you have a trademark way of designing something so that it's very recognizable, and you are licensing that to someone else, let's say you do a collaboration with Target and you create a line of cookware or a line of stationary cards, there's all kinds of ways that you can collaborate and license your intellectual property to other people, if you have registered your trademark, that is going to be a more profitable collaboration for you because again, that is just a more valuable asset. If someone else is collaborating with you, they are gonna wanna be able to stop other people from infringing on your products that you create together.

**18:04 AB:** And if you have a registered trademark, they know that now you are more easily able to stop infringers. So, again, it just makes it more valuable. If you are taking on an investor or a partner, if you're thinking about selling your business, and if you're collaborating or licensing your intellectual property, a registered trademark is going to be far, far more valuable. It's going to bring you money down the road when you get there.

**18:27 AB:** And then the seventh thing, the seventh benefit or reason you might want to register your trademark, and I've been hinting at this all along, is that it just makes it much, much easier to stop infringers. So, all of the things that I've mentioned before really lead up to this one. You have those nationwide, exclusive rights. You are able to file a lawsuit in federal court. Versus state court, it is an easier place for most people to file an intellectual property lawsuit. They are more familiar with our intellectual property laws. You have the ability to sue someone maybe where you live, instead of having to go into the state where they are. You have the ability to get better damages if you have to file a lawsuit. And all of these things really add up to leverage. So, if you find that someone is using your trademark without your permission, you're probably not going to file a lawsuit on the first day; you are probably going to take certain steps incrementally to get them to stop. So you might start by asking nicely, you might send them a cease and desist letter on your own, you might get a lawyer involved so they know that you are willing to protect your rights. And then at the very end of the road, your last option or your last step that you might take is actually filing that lawsuit and trying to get a court to make them do what they refuse to do voluntarily.

**19:47 S2:** So, at every step along the way as you are negotiating and trying to get them to stop infringing your copyrights or trademarks, we're talking about trademarks today, if you have a registration, they know that you are serious, they know that you have put your money where your mouth is. They know that you are willing to take steps to enforce your rights. So, it just gives you a lot more ways to stop people from using your trademarks. And that is really, again, I mentioned at the outset, the whole reason that we have trademark law, is to prevent customer confusion. But the reason most businesses want to register a trademark is... I mean, they don't want their customers to be confused, of course, but they don't want their competitors to be confusing their customers. You don't want a competitor to come in and have a bottle on the shelf next to Coca-Cola that looks just like Coca-Cola, because now they could be stealing your customers. So that is really why most businesses will want to register a trademark. And the only way there's really any benefit to registering that trademark is if you have that ability to stop someone else from using your trademark without your permission, either by negotiation or at the end of the day, if you have to, by filing a lawsuit in a US federal court.

**21:00 AB:** So, all of these benefits to having a US federal trademark registration just make it easier. It gives you more leverage. In all of these situations, you have kind of a bigger hammer to threaten people with. 'Cause at the end of the day, all negotiations, you're trying to either offer them something they want or threaten them with something they don't. And most people really do not want to be sued. It's expensive, it's time-consuming, it's not fun for anyone involved, except the lawyers, we love it, but most people do not enjoy being sued, especially for trademark infringement. If you have put time and energy and money into developing your own brand, the last thing you want to do is have to change it. So, this is why we have trademark law.

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**21:42 AB:** I hope that these seven benefits of trademark registration have been helpful for you, and I want you to subscribe to this podcast wherever you're listening to it. Just hit that Subscribe button so that you will get all of our series on trademark protection, and you can tune in next week when we talk about when is the right time to register your trademark with the US Patent and Trademark office. This is probably the most common question I get, is people asking, "Is now the time, or should I wait, or should I have done it six months ago?" And we can't go back in time and do it, but next week, we will be talking about some things to think about as you are deciding when is the right time to register your trademark. If you are trying to figure out if you have trademarks that might be worth protecting in your business, click on... In the show notes, I'll have a link, [awbfirm.com/podcast](http://awbfirm.com/podcast), that is going to get you my free five-minute IP Audit Worksheet. It really is just five minutes, it's very quick. It will help you look at the different intellectual property in your business and figure out, are there things hiding that you might need to protect with a copyright or a trademark registration? So, until next time. I will talk to you soon.

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**22:58 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 of 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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