

HOW to choose a good trademark (S3E70)

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00:05 Autumn Witt Boyd: So welcome to the Legal Road Map podcast for online and e-commerce entrepreneurs. I'm your host, lawyer Autumn Witt Boyd, I am an experienced copyright and trademark lawyer. With my team at the AWB firm I leverage, grow, and protect multimillion 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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00:50 AB: Everybody lawyer Autumn Witt Boyd here with another episode of the Legal Road Map podcast about trademarks. We are going to be continuing our series today, this is our third episode in 2019 talking about trademarks and today we are focusing on how to make sure that when you are choosing your business name or a product name, or anything else in your business that you might want to consider protecting with the trademark registration, how can you make sure that you are choosing a trademark that actually is protectable. And I'll go into why not all trade marks can be registered in the United States.

01:27 AB: A little background about me. If this is your first time here, I'm so glad. Welcome to The Legal Roadmap podcast. I am Autumn Witt Boyd, I am a lawyer, I focus on copyright and trademark work. My law firm located in Chattanooga, Tennessee, works with online businesses, particularly those who are creating online courses and selling digital products, so mostly downloads and education and training type products. Today, as I mentioned, we're going to be digging into how to choose the right trademark for your business and something that can be protected. Now, before I get started, I'll give my standard disclaimer which is that I am a lawyer, but I am not your lawyer, unless you hire our law firm to work with you one-on-one.

02:06 AB: So please take everything that I'm talking about today as information. This is going to be based on US law. Trademark and copyright law is a little different in other countries. So you wanna make sure if you are not in the United States, that you are getting the right advice for your own business.

02:20 AB: Now, when we talk about how to choose a strong trademark I wanna start by just reiterating once again, sorry, if you have heard this several times 'cause you've listened to every episode in this series, but it just bears repeating, that the reason we have trademark law in the United States is really to protect consumers. So when you're listening to this, when you're learning about trademarks, if you keep that in mind, it is really helpful in understanding these concepts. So the point of trademark law is to make sure that when a customer goes to grab a bottle off the shelf, or they're searching for a product or service that they're not going to get confused because there

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aren't too many companies using the same name or the same logo, the same packaging, the same slogans. So when we think of trademarks I want you to remember that the point of trademark law is to protect consumers, and your trademark should indicate the source of a product or service. So I'm gonna say that again, cause it's not necessarily intuitive. The point of trademark law is to protect consumers and help them find the right product, so a trademark should really be functioning as something that will help a customer know where a product or service came from.

03:29 AB: So what company it came from, it tells them what kind of quality to expect if there were repeat customer they know what they want, if they're a new customer maybe they've seen advertising and they've come to expect a certain level of quality and trademark law ensures that they are getting what they expect. So when we are thinking about how to choose a strong trademark that can be protected in the United States, there is a spectrum. So I like to think of it as kind of a ruler or you can even think if it is a rainbow with two ends at one end of the spectrum, you are going to have the trademarks, that are most protectable that are most highly valued that are definitely going to be able to be registered with the US Patent and Trademark Office, which is generally the goal if you wanna protect your trademark rights in the United States, the gold standard is going to be registering them with the US Patent and Trademark Office. If you're watching this on Facebook Live you can see behind me over here, a peak at my own trademark certificate for the legal road map podcast.

04:28 AB: I do own a trademark registration for the words, "legal road map." So on our spectrum of really really great protectable trademarks, to trademarks that are never going to be able to be registered with the US Patent and Trademark Office. It is not black and white, it is a spectrum. So the best end the end that you want to be closer towards is going to start with a couple of categories. I'm gonna go through a bunch of different categories. The one that you wanna be the closest too, as you are choosing your trademark is what we call fanciful marks. So there are pros and cons to choosing a fanciful trademark in your business. The pro is highly protective almost certainly going to be able to be registered with the US Patent and Trademark Office. The downside is they don't mean anything. So these are basically made up words. When you think about fanciful trademark, you think of something like Exxon or Pepsi, they really don't have any regular meaning. The only meaning they have, is what the company has built through brand recognition, through advertising and marketing campaigns, through a lot of hard work. So back before anyone knew the Exxon meant a gas station or a source of gasoline that word didn't mean anything.

05:40 AB: So if you had seen it on the side of a truck or on a billboard, it would mean nothing to you. So that is gonna be the challenge with choosing a fanciful trademark. Yes, they are the most highly protected. It's unlikely that someone else is going to come up with the same word since it's totally made up, but the downside is, you have to put all of the time and energy into building that brand awareness and connecting whatever the products and services are that you sell with that word. And I should have mentioned today's episode we're not gonna talk about visuals at all, so we're not gonna talk about logos or packaging the different kinds of trademarks that you might be aware of. We're only talking about what are called word marks. So everything today is all about word marks, which is most of what our registered most of what people come to me wanting to protect are word marks. So fanciful is going to be at the furthest end of the spectrum that's the most highly protectable but also the hardest to build awareness of. So if we're creeping a little bit closer to the other end of the spectrum, still very protectable, still a great choice when you are deciding what to

call your company or a product are going to be what we call arbitrary trademarks.

06:49 AB: So these are real words but they are used in a way that does not tie to the meanings. So a classic example of this is Apple for computers. So when Apple is... It is a thing, it is a word that has a meaning it's not made up, but it has nothing to do with computers. Another example of this is Deltas. So you might have Delta Faucets, Delta Air Lines. Delta is a thing. It is used in mathematics, it is a geographical term, but again, it has nothing to do with faucets. It has nothing to do with airlines. So you have a word that has a meaning but the meaning has nothing to do with the products or services that are being sold.

07:27 AB: And another key concept in trademark law is you are only going to have protection for your trademark in connection with the products and services that you're actually selling or you get a little wiggle room for things that you might expand into or related products or services, but typically when you're considering what you want to name your business or a product you wanna think about that in connection with what are you actually selling, and if you... We're not gonna talk about this today, we'll talk about this next week, but if you are evaluating the landscape and doing a search to see if someone else is already using a similar word for another company, you really only need to worry about competitors who are selling similar goods and services to what you are selling.

08:10 AB: So really important when you're making this evaluation, you have to keep in mind what are you actually selling when you're choosing your name. Because that is going to matter with the next category we're talking about. So again, we started at one end with fanciful, that's the most protectable. We moved a little bit down the line to arbitraries, these are "apple", "delta". These words have a meaning but they have no connection with the products or services that you're selling. And we're gonna move a little bit further down.

08:35 AB: Now we're at what a lot of, especially in the online world, what a lot of us are using, what kinds of names we are choosing, and these are suggestive. So again, they don't describe the goods and services that you're selling. It's not like you're just saying the thing that you're doing, which I'll talk about in a minute, that is what you want to avoid. But they do give some indication of the types of goods and services, so that's why they're called suggestive.

09:00 AB: So, a couple examples of this. Some old school companies. Jaguar is one of my favorite examples of this, the car company because Jaguar has nothing to do with cars but when you think of a Jaguar, where are you thinking of something very sleek and fast and even luxurious, a jaguar is a very beautiful animal, it's very sleek, and smooth in its movements. So when you think about the Jaguar car company, those are the kinds of elements that they want to be suggesting by choosing that as their name.

09:29 AB: Another great example of this is Playboy for a magazine. Now, obviously, playboy is not, it's a person, not a magazine. So you have a little bit of a separation there. Now, I think playboys are the intended audience of that magazine. But again, it gives a sense of what the magazine is going to be about without saying, "magazine for single men of a certain age who are out and about on the town and interested in these things." Again, it's suggestive of what you're going to find if you purchase that magazine without coming right out and saying it.

10:04 AB: So in the online sphere a couple of examples that I wanted to share, 'cause I think a really good example of a suggestive trademark that's very effective would be The Desire Map, which is Danielle La Porte's very popular book, she has planners she has a course she has certified instructors. It is kind of an overarching program. And the goal of that is to help you learn how to plan your goals and figure out what you want to do with your life based on your core desired feelings. But again, none of that is exactly spelled out in that name which is a registered trademark. So when you think of desire map again, it gives you a sense of what you're going to get if you purchase some of those products, but it doesn't come right out and say, "This is a planning tool for your life," which is what we want to avoid.

10:57 AB: Some other examples that I pulled, Pat Flynn has a program called, "Smart from scratch." So it's not start from scratched smart, and he has registered that trademark with US Patent and Trademark Office, and that is a course, an online course for people who are starting a business. So it's a bit of a play on words. You find that a lot with suggestive trademark is plays on words, and again, it kind of gives you a sense of what you're going to learn without saying "This is a course for people who want to start a business." So smart from scratch is another great example of that. And then one of my favorites, which is a client of mine and I did help them work on their trademark. Is the podcast, "Being Boss." So it is all about entrepreneurship and becoming your own boss. But again, it's more suggestive. It doesn't come right out and say, "This is a podcast for creative entrepreneurs." Which again, that would be probably not register-able but it gives you a sense of who it's for and what kinds of topics you're gonna hear about. So those are a couple of examples of suggestive trade marks.

12:00 AB: I think those are a great choice. It's a nice balance of getting across to your audience, what you are selling, what they're going to get from you, what your brand stands for without being quite so far out there as an arbitrary trademark, where you're really having to build all of the awareness on your own because it doesn't mean anything. So it's a nice middle ground. Now moving down the spectrum towards the end, that is not protectable, we have what are called descriptive trade marks, and this is what you want to start trying to avoid, because these sometimes will be denied by the US Patent and Trademark Office, if you try to register them. So these would be something like, Quickstop for a convenience store, again it doesn't exactly say what the thing is, but it's pretty darn close. It basically describes either the intended purchaser or the types of products and services that you're selling. So another example, it could also describe some of the attributes of your products or services. So, "Sweet and creamy" for an ice cream store. Yeah, that's not a great choice that describes what you're selling it is probably going to be rejected. Now, this is not necessarily at the end of the road, if you're rejected for having a descriptive trademark there, are some workarounds here, so there's an option that you could get a lower level of protection with the US Patent and Trademark Office on something called the supplemental register.

13:24 AB: So I don't want you to think that a descriptive trademark can never be registered because we do see these a lot. These are probably the most common kind of company and product names, that I see because they say what you do, they're very easy to come up with, but they're not as highly protectable. So with that lower level of protection from the US Patent and Trademark Office, you do lose some of the benefits and rights if you had the higher level protection on what we call the principal register of trademarks. So what we call surnames, someone last name. I get this question a lot. Can I registered the trademark to my name or if my company has a last name and it is a register-

able.

14:03 AB: The answer is, sometimes it is, sometimes it isn't. Something like Jones Autosupply or Autumn's flower shop, things like that. Those are typically, if it's something like that, where it pretty much is just someone's name plus what they're selling, that's gonna be very hard to protect. If it is a little bit more on a suggestive realm, you might have better luck with that. But typically what the US Patent Trademark Office is going to require is something called acquired distinctiveness. So this means that you've been using it for long enough that even though it is something that typically wouldn't be allowed to be registered on the principal register, you have built up brand awareness through using it, and it's typically for five years at least that now it's become kind of a well-known brand. And at that point, you can now move up to the principal register because you kind of proven that you're going to stick with this, that you have an audience, that people know what would have just been descriptive or not register-able as a surname. Now, you are able to get on to that principal register.

15:04 AB: So like I said, there can be a work around, but it just depends on how long you've been using it, and how you've been using it. So, we're almost at the end of the spectrum here at the other end and at the very end is what we call generic trademarks, and these are never going to be register-able not on the supplemental, not on the principle. And these are things that literally just say what you're doing, like the word clock or a computer they're often just the name of the thing or tire store or pizza shop or even just the words life coach. If it just says what you're doing, if it just is the name of the thing, those are basically not ever going to be protectable.

15:44 AB: Now, you might be able to combine other words with those words. And then what the US Patent and Trademark Office may do is require what's called a disclaimer. And so, that means basically you're gonna carve out that part of the trademark. That part that is generic or descriptive can't be protected, you can protect the other part, and you can protect the overall trademark. So I do see this sometimes, I have some life coach clients, and maybe they have a particular style of life coaching or a particular way that they do things, and so they might have the word "life coach" or "life coaching" as part of their brand, but they've got some other words connected with it. So it might be innovative life coaching or something else that is not so descriptive or generic.

16:27 AB: And so you can kind of register the whole thing, but you can't stop... The reason that the US Patent Trademark Office and our federal laws have this rule in is because they don't wanna stop or they don't want to allow you to stop someone from just saying what they're doing. So, you can't own the word "life coach" because it just, it's a whole profession. It's like saying, "I can't stop someone else from calling themselves a lawyer." It's too generic, it's too descriptive. There's too many people doing it. Basically, when we think back to why we have trademark law, we're trying to help consumers. It doesn't help consumers to give one person a monopoly on a word that is used by a whole industry. So that's why that is typically not going to be allowed.

17:10 AB: Alright, so I've spent now a bit, talking about our spectrum of trademarks. So when you're choosing a name for a product or a service or your company name, or a slogan, I want you to keep all of these things in mind. And you don't have to use an arbitrary trademark. I think especially in the online world, where SEO is really important, you want people to be able to find you, and so you want to maybe include some of those search terms in your name or a product name, so that if

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someone is looking for a particular service or a type of product they can find you, but this does I hope help you with some ideas of how you can add some distinctive words to your product names or your shop name or a slogan, or a tagline so that you can have something that really is protectable. The other thing that I see is that when you have a trademark that's not very strong so let's say something like Girlboss is a good example of this. So, Sophia, I think Amoruso owns that trademark. She wrote a book by that title I think she's on a podcast and a TV series, so all kinds of other things.

18:17 AB: But at the end of the day, it's not a super strong trademark because if you think about our spectrum, it is pretty... It's maybe suggested but it's awfully close to just being descriptive. So she's been using it for a while. I haven't pulled up that registration so I can't tell you if it's on the supplemental or the principle, but I can tell you if you look in the marketplace, you will find tons of merchandise, tons of other businesses using that word using that combination of words and because it is kind of inherently a weak trademark it makes it very difficult to enforce those rights. So when you are choosing your trademark, I want you to try and shy away from things that could be very common, whether they're common in the beginning, or whether you just think like, this is kind of an obvious combination of words for this thing that I'm doing, I want you to shy away from those they are harder to protect. You're gonna spend more time and money chasing down infringers, if you have a less strong trademark and if you do have to send cease and desist letters, and that's what trademark rights are all about, is stopping other people from having a business or company name, that's too close to yours.

19:25 AB: You're gonna get a lot of responses back from lawyers on the other side saying, "Yeah I know, you may own this, trademark but it's a weak trademark and I don't think that you could actually defend it." And basically say, "Come on and sue me." I think you'd lose. So you can sometimes get a registration from the US Patent and Trademark Office that then is very difficult to enforce if it's for a weak trademark. So things to keep in mind as you're choosing business and product names. Again, we wanna be closer to that arbitrary line. We don't have to go all the way there, but think about things that are suggestive rather than descriptive. We want to avoid things that just describe our products and services or our audience, for our products and services.

20:06 AB: So the second thing I wanna talk about when you're choosing a strong trademark is that you need to remember that it needs to be an indicator of source. So what I see a lot of times is people have things they think are a trademark in their business but they're not actually using them as a trademark. And then they will contact me to register the trademark with the US Patent and Trademark Office. We'll talk about it and I'll say, "Show me where you're using it," and I'll pull up their website and maybe it's a tagline or maybe it's something they just say all the time, but they're not actually using it to promote their products or services, they're not using it in connection with selling anything. And so I want you to remember that trademarks are really intended to be used as a promotional tool. They are part of your marketing strategy, they're part of your brand, and so if you have something that maybe you say all the time or you just like it, it's a phrase or it's a combination of words, that's fine. But it may be difficult to protect and you may not be able to register until you make some pretty big changes to your marketing.

21:09 AB: So as you are thinking about what might be a good trademark for your business whether that's... I see this most often not with company names or product names with kind of slogans and

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taglines, is people are not actually using them as trademarks, so I'm not going to get into all the rules and regulations of what evidence we have to file with the US Patent and Trademark Office. I don't wanna put you to sleep today, but I want you to remember if you're thinking about something you might wanna protect as a trademark you need to be actually using it as part of your sales process. So as an example, a tagline, it needs to be used on your sales pages, it needs to be probably in a different color font, or it needs to be set apart somehow, from the rest of the copy on your website. If it's just something you use in a sentence as part of a it's something you talk about it's a concept that you use that's not typically going to be used as a trademark. It needs to be part of your branding, it needs to be an indicator of the source of a product or service, it needs to stand apart from the rest of your messaging.

22:11 AB: So, a couple of examples of really clear cases of use as a trademark are going to be, any time you pull up an e-commerce website, typically either at the top in the middle or at the top left you'll see the name of the shop or you'll see a logo that has the name of the shop or maybe just their branding, their imaging. So that is going to be pretty clear use as a trademark. On physical products often the trademark will be on a tag or the label. So again, it's not necessarily just printing something across the t-shirt and now it's a trademark. That may just be a phrase to be used as a trademark it has to have some connection with the source of the product or service. So, typically, that's gonna be shown by a tag not just printing across the front of a t-shirt. T-shirts are really tricky to register with trademarks, because the US Patent and Trademark Office has very specific rules.

23:02 AB: But again, I want you to think about that trademarks are meant to help customers figure out, have they got the right thing. And lots of people could print a phrase on a shirt and it doesn't have anything to do with the company or the source of the products or services. But if you think of Nike, if you buy a Nike shirt. Nike is the brand Nike is the trademark. You might see it just in the little corner of the breast pocket and you would definitely see it on the tag. If you go to the Nike website you're definitely gonna see it right there at the top, it's probably gonna be in the name of the product as well. So just some things to think about. Whether something that you're thinking about that you might want to register it may not even be a trademark or you may not be using it as a trademark and if you want to register it you might need to start thinking about how you're using it in a little bit of a different way.

23:47 AB: So, I hope this was helpful. If you have questions about how you're using a trademark or you're thinking about choosing a trademark for your business either product-name, a company name, I would love to chat with you. Hop on over to our legal roadmap Facebook group. That is the best way to interact with me. And we are up to several hundred other business owners, mostly online business owners who are very helpful and share their own experiences and help answer questions. I pop in there several times a week to answer questions as well. So it's a great way to interact with me, if you're not quite ready to hire our law firm for a one-on-one product or service. And if you have your own trademark registration questions, if you're ready to pull the trigger, we would love to talk with you about how that process works with our law firm. We really take over the whole process, it's very streamlined, we have a very long checklist. I can't even tell you how many things are on the checklist, but we handle that, we make sure all the deadlines are met, it is about a year-long process to register a trademark. So we wanna make sure that that whole process was very smoothly for you.

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24:47 AB: If you have questions about that the best way is just to go over to our website awbfirm.com and click that contact button and send us an inquiry and we'll be glad to share how that whole process works and give you some information. If you are looking for our 5 Minute IP Audit Worksheet that is my other favorite resource that I'm talking about in this trademark series, head on over to our podcast page that's awbfirm.com/podcast, you'll find show notes and then you can download that worksheet right there. If you have no idea what kinds of things may be hiding in your business that could be trademarks, or copyrights, that worksheet it'll just take you a few minutes, I help you brainstorm what might be lurking in your business that you need to be protecting with a copyright or trademark. Alright, I am going to sign off for today, join us next week where I'm going to go through what is a trademark search. You may have heard this is in our process at the AWB firm always the first step that we go through with a new trademark client. But I get a lot of questions do I need to do a trademark search before I file an application to register my trademark?

25:50 AB: I will give you a spoiler. The answer is yes, I think you do, but I'll go into what it is, why it's important, and what could happen if you don't do a trademark search. Dud dun dun, we'll go into all of that. So I hope to see you here again next week have a great rest of your week.

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26:10 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 5 Minute IP Audit Worksheet at 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 5 Minute IP Audit Worksheet now at awbfirm.com/podcast.

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