



Essential Legal Strategies for Creators and Brands

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Hi! My name is...

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I'm an attorney and the owner of TMBTQ[®] Law – **we're the geeks who lose sleep protecting your brand!**[™] I have helped hundreds of clients protect their brands and content, and comply with regulations about advertising.



Overview



- ▶ Introduction – Types of IP
- ▶ 4 Strategies to a strong TM
- ▶ Complying with Advertising Regulations
- ▶ Top Trademark Myths
- ▶ Best Practices for Copyright Protection
- ▶ Protecting Works Created with AI Assistance



4 types of IP

- Copyright
 - Patent
- Trademark
- Trade Secret

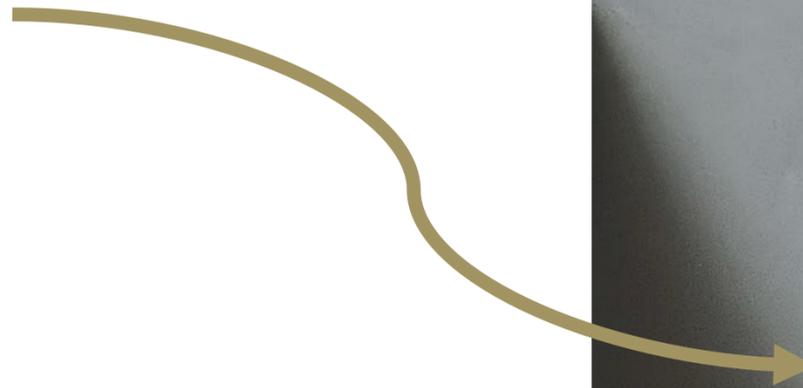


Copyright (entire ad)



*Buy a vacuum today and watch all of your problems
get sucked away!*

Patent?



Trademark



4 Strategies to a STRONG TM



01

Use a weird word
or design

02

Make sure your
mark stands
alone

03

Search, search,
and search
some more

04

Avoid common
mistakes



Strategies

01

Use a weird word or design

A strong mark is “fanciful.” Made-up words, like lululemon or Starbucks, make the strongest trademarks because they do not have any meaning in the English dictionary. So, you’ll never get a rejection from the Patent and Trademark Office because the trademark is “merely descriptive” of the goods and services – that would be impossible! Put on your creative thinking cap and make up some funny crazy words to make your brand stand out.



Strategies

02

Make sure your mark stands alone

Loneliness can be sad, but not for trademarks. You want to avoid a situation where your mark shares common elements (words or designs) with a bunch of trademarks in a particular niche of products or services. If you're not going to make up a "fanciful" mark, at least use some words that not everyone else in your field is using. That will distinguish your brand from the competition and make it stronger and more defensible/enforceable.



Strategies

03

Search, search, and search some more

The third attribute of a strong trademark is that it is clean. Make sure you, or your trademark attorney (I know a good one in Denver!) conducts some searches to see if other marks out there could be considered “confusingly similar” to yours. Even if you’re not using a trademark lawyer to help register your mark with the U.S. Patent and Trademark Office, at least do a google search and use the PTO’s [TESS](#) tool to check for similar marks. Beware, though: a TESS search alone is not enough. Make sure that you are checking Secretary of State records for business names to reveal “common law,” or unregistered users.



Strategies

04

Avoid common mistakes

Don't waste your trademark application fee. Make sure that you are applying for a mark that is registrable. Your trademark should not contain an acronym, someone else's name or registered mark, a geographic place, or a generic term that describes the product or service to which it will be applied.



Advertising & Regulatory Compliance

- **FTC**
- **FDA**
- **NAD**
- **BBB**
- **Transparency, Accuracy,
Supporting Documentation**



Be extra careful with “healing” products

- Structure/Function claims
- This product is not intended to diagnose, treat, cure, or prevent any disease
- On advertising materials: The information on a website is for informational purposes only and should not be used to diagnose or treat a disease. The disclaimer also advises readers to consult a doctor or other health care provider for any health-related matters, especially those that may require diagnosis or medical attention

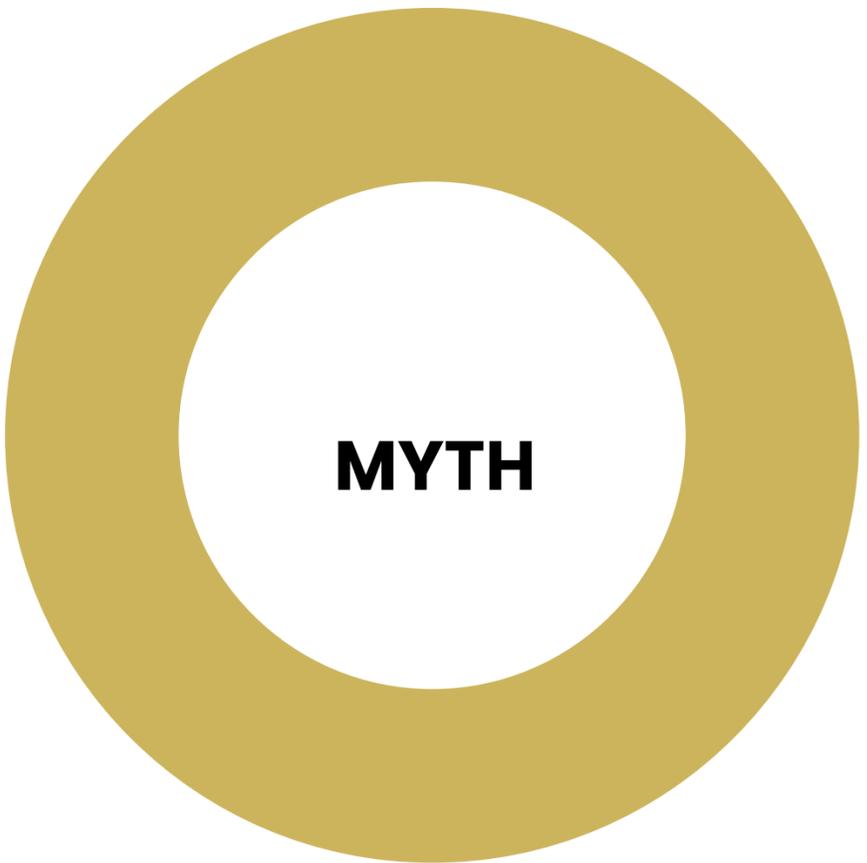


Trademark Myths...

VS

Trademark Facts



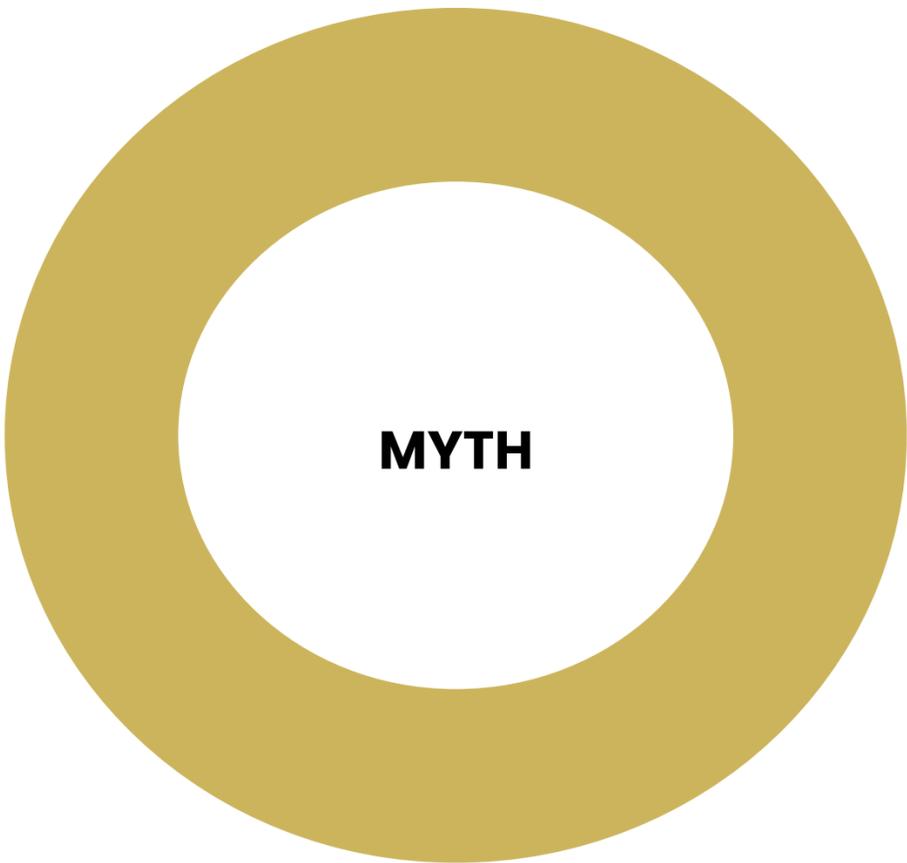


MYTH

Getting a trademark registration with the U.S. Patent and Trademark Office will automatically enforce your trademark

- Narrow universe
- Doesn't prevent misuse, only registration
- Individual owner action vs Examining Attorney





MYTH

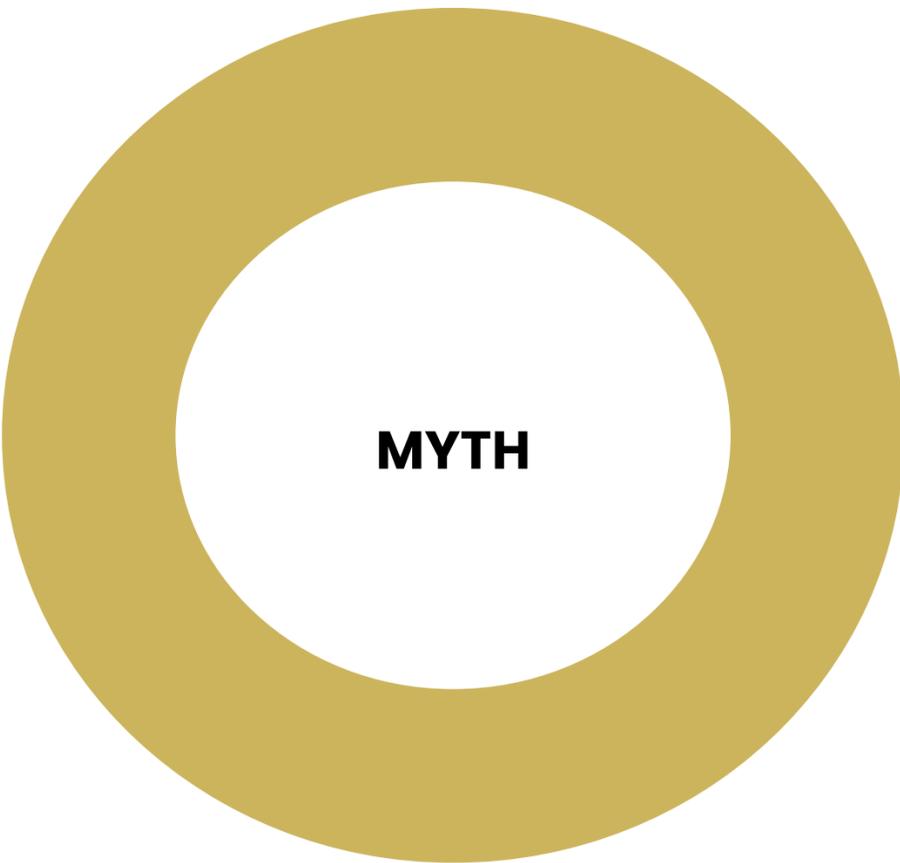
If there are no other pending applications or registrations with the USPTO for the same mark in connection with the same goods or services, we'll be ok!

Swiss cheese analogy

Availability for registration vs use

- Common law rights beginning on the date of first use
- Minor changes don't matter: USPTO considers similarity in sound, sight, and meaning
- Searching: USPTO exact match vs expanded vs common law



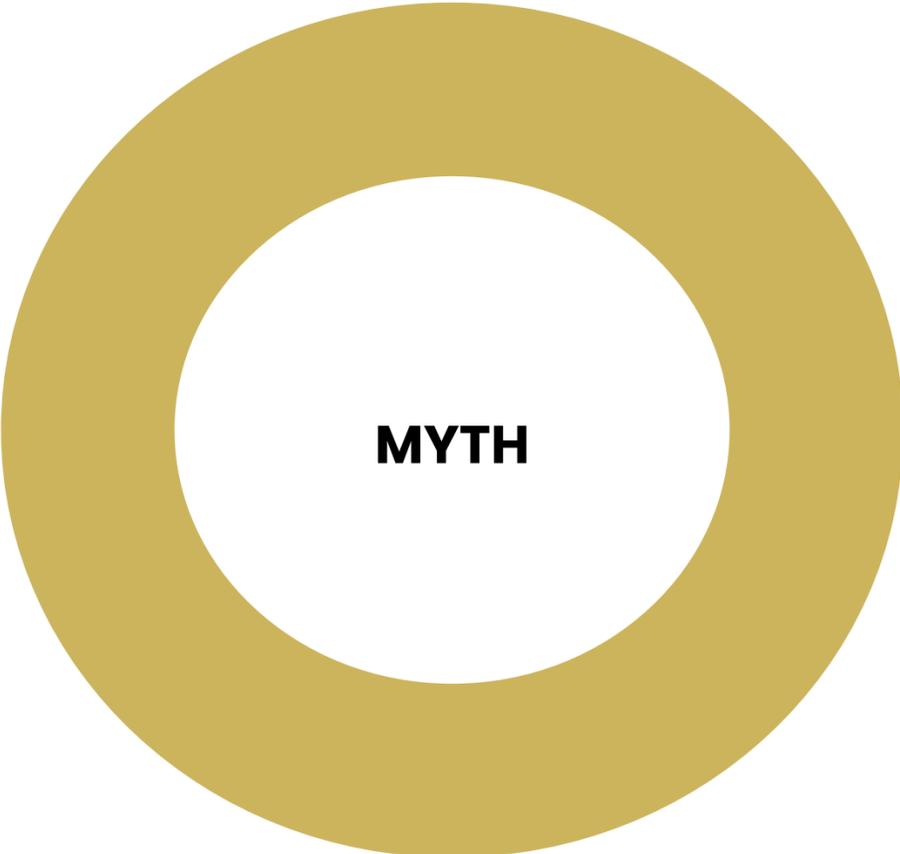


MYTH

Trademark rights can only be enforced in court

- Cease and Desist Letters
- Trademark Trial and Appeal Board Proceedings
- Letters of Protest
- Oppositions & Cancellations





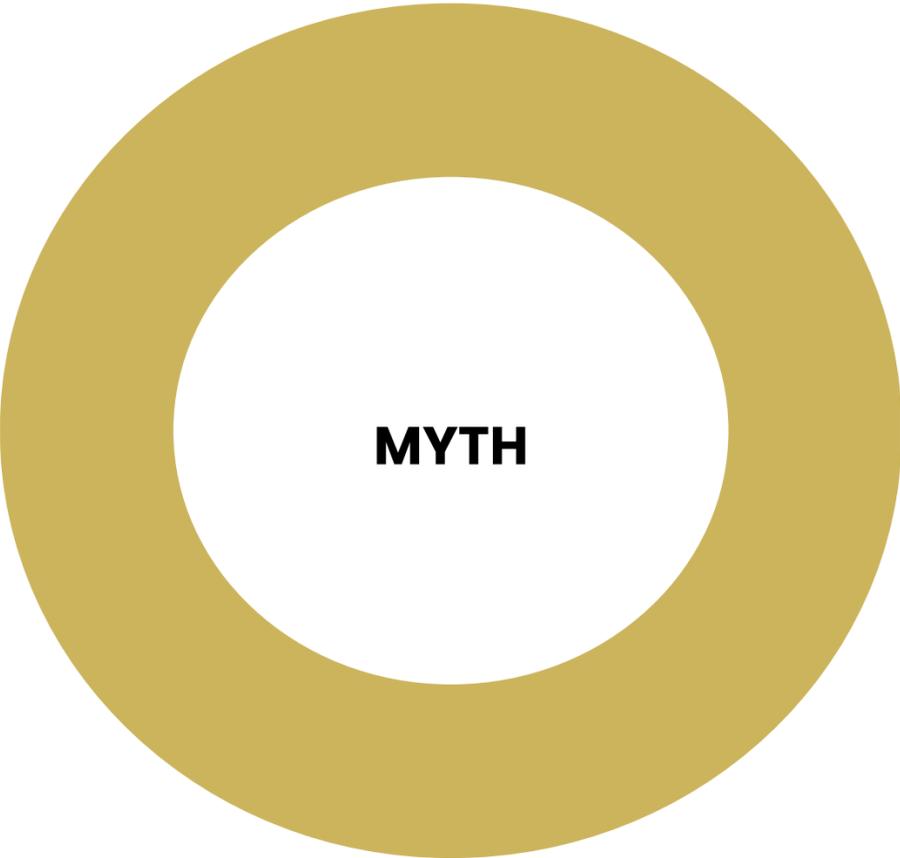
MYTH

Other countries will respect your rights as a U.S. Registrant

Partially True under the Madrid protocol, but . .

- Law firms and big companies are not immune:
 - Squire Patton Boggs' TM was held hostage for \$450,000—eventually settled
 - Amazon Web Services denied right to use AWS trademark in China (Beijing Municipal High People's Court ruled that the trademark for the term "AWS" belonged to ActionSoft Science & Technology Development Co., a Chinese software and data services company, according to a Dec. 30, 2020 verdict)



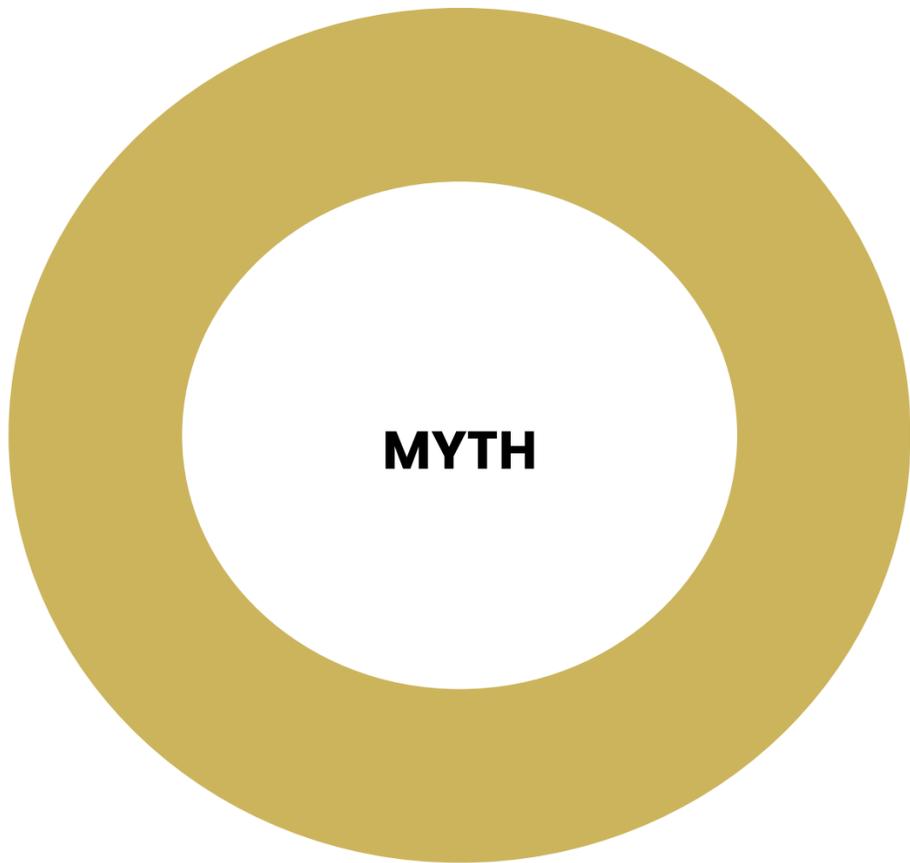


MYTH

It's always a good idea to file an application for USPTO registration

- Common law use
- Crowded field
- Generic marks – Supplemental Register/5 years try again
- Legal in state/illegal outside





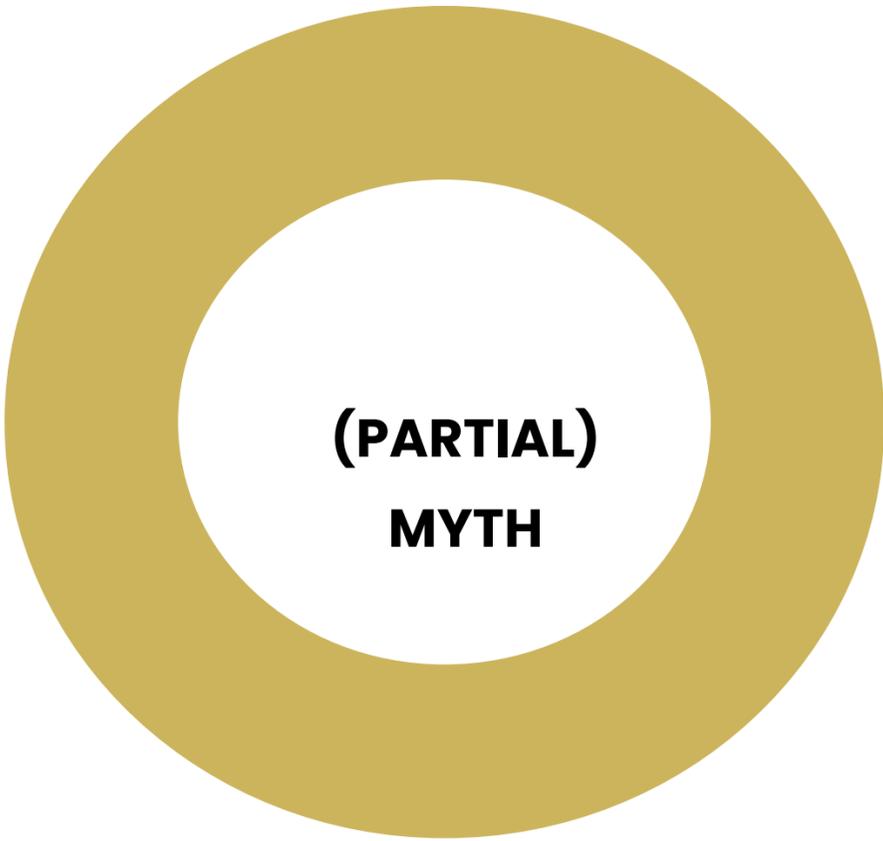
MYTH

A Search of TESS is all I need to confirm that the mark is available to register

State SOS Offices

- Yours, or someone else's
- Internet search engine
- Domain names, social media, company names, knowledge of competitors
- Third party search – most comprehensive
- Make sure someone does it before use and/or application!





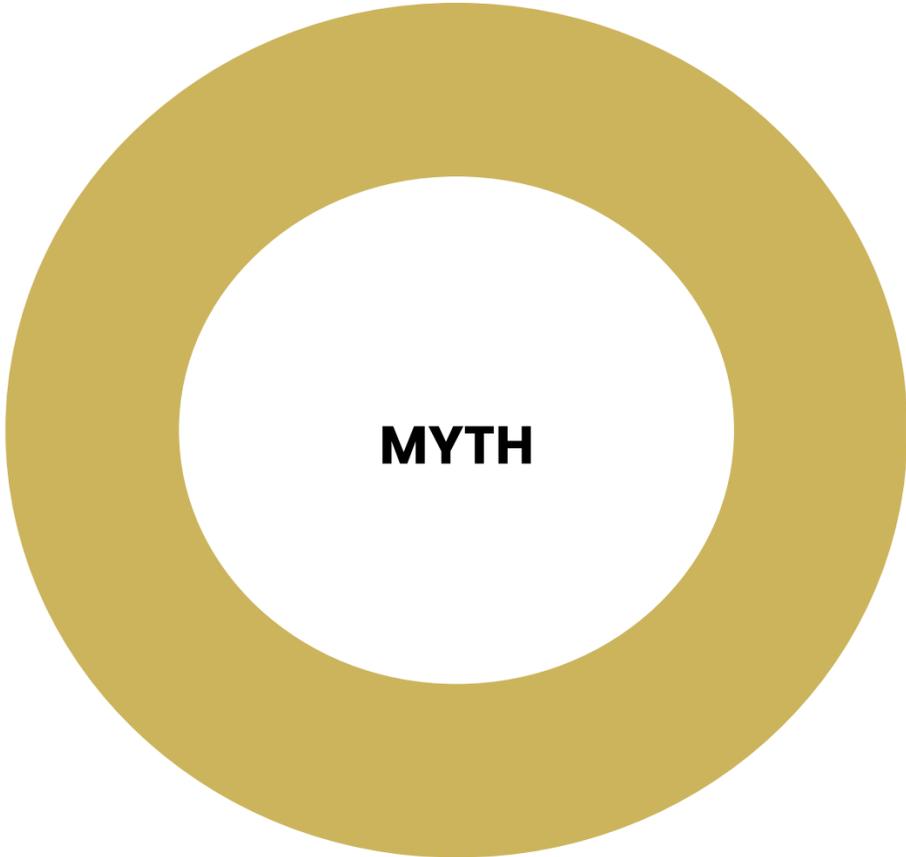
**(PARTIAL)
MYTH**

Trademarks last forever

Term: lasts as long as all post-registration maintenance documents are filed on time

- If application is "Intent to Use," Statement of use or extension request **MUST** be filed!
- Declaration of continued use & incontestability – between 5th and 6th year following registration
- Combined Declaration of Use & Application for Renewal between 9th and 10th year after registration, and every 10 years thereafter
- If documents not timely filed, registration will be cancelled and cannot be revived or reinstated (after grace period/except for extraordinary circumstances)





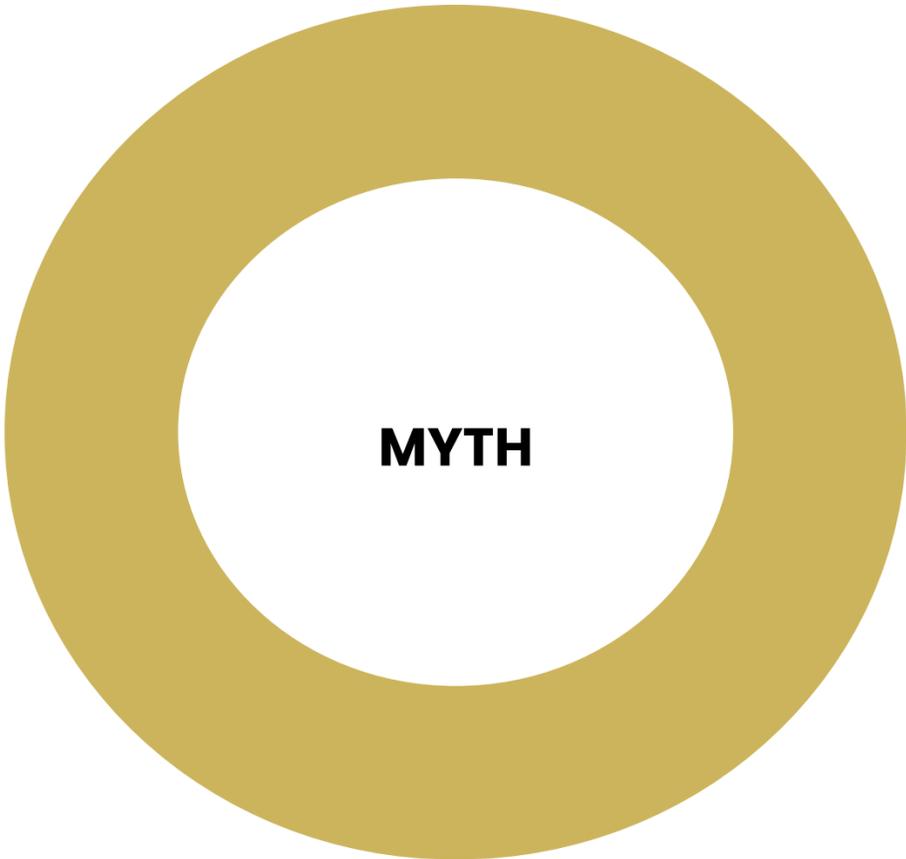
MYTH

Tough luck if you miss the deadlines

Oopsies...

- PTO leniencies: 6 month grace period for declarations of use/renewals
- Petition to make special: if grace period ends, speed your way through the process with a new application for exactly the same G&S
- Petition to revive (abandoned app but usually not cancelled mark): only in extraordinary circumstances





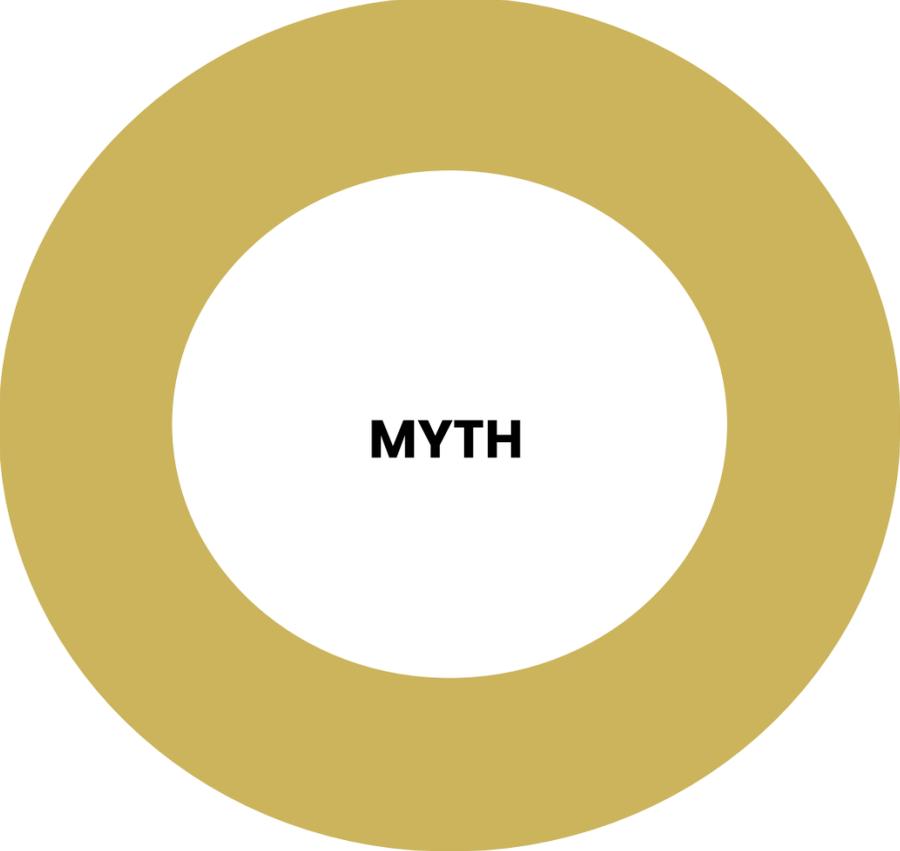
MYTH

It's party time after the registration issues

Ongoing monitoring matters!

- a) Watching services
- b) Confusingly similar?
- c) Cease and desist letters
- d) Social Media reporting mechanisms
- e) Diligence in watching
- f) Laches





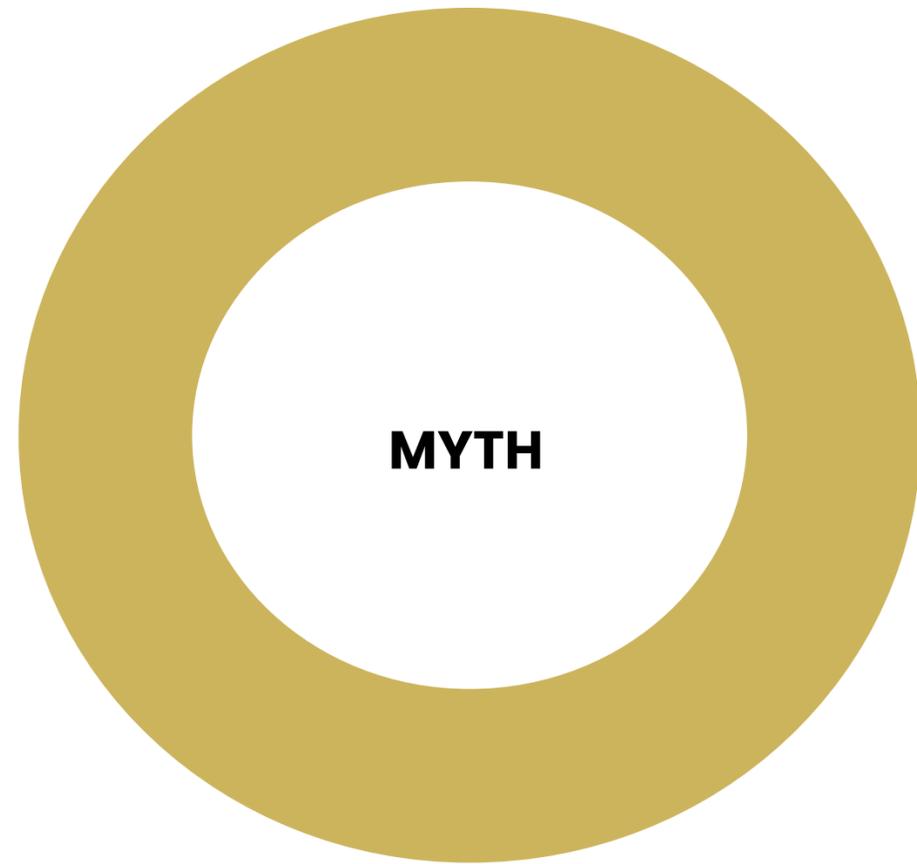
MYTH

The state and federal trademark registration processes are quick and easy

State registrations can be!

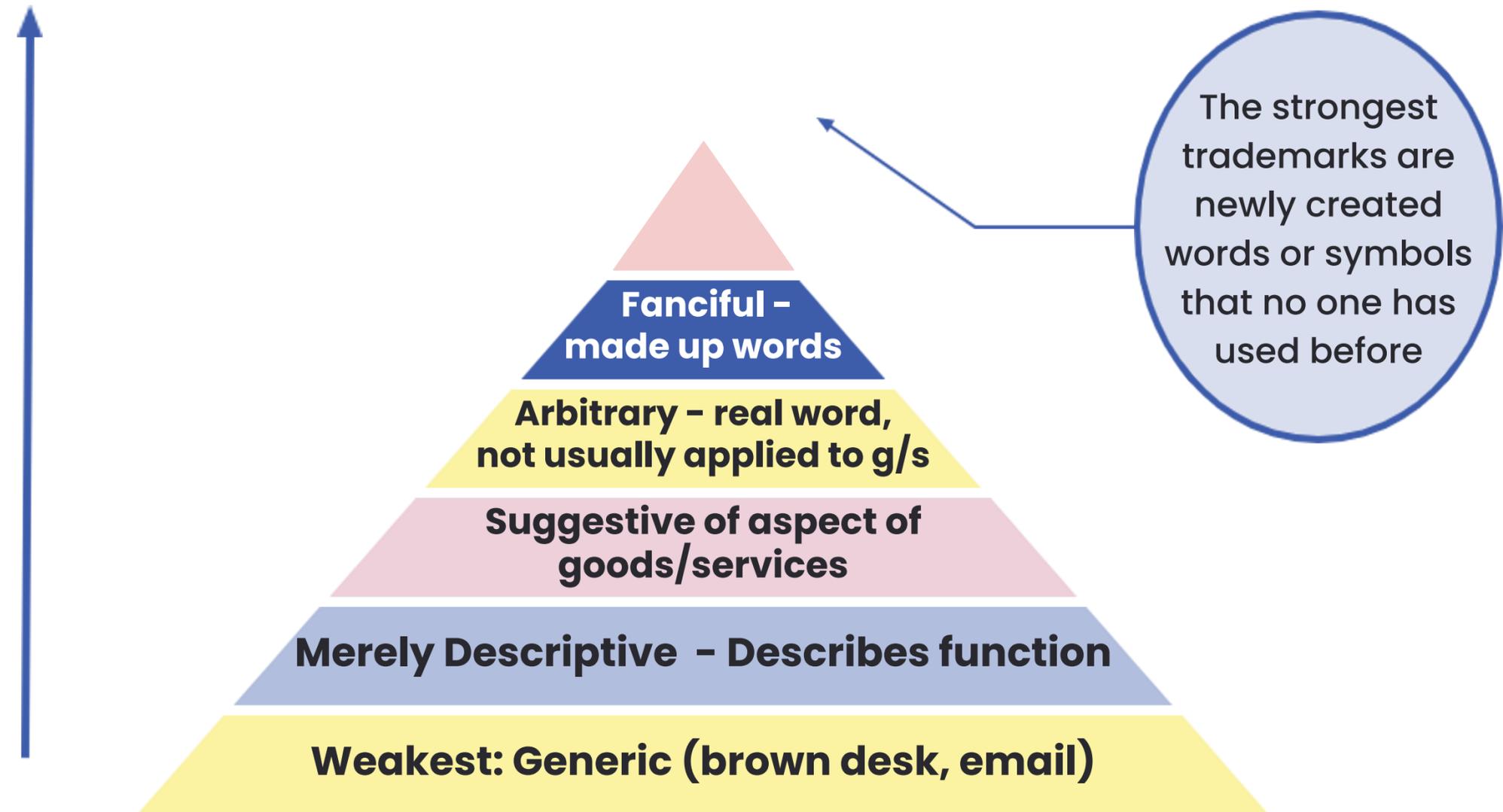
Federal application/registration process: see <https://www.tmbtq.com/trademarkregistration>
Minimum 10 month process, unless expedited (even then, still around 8 months)

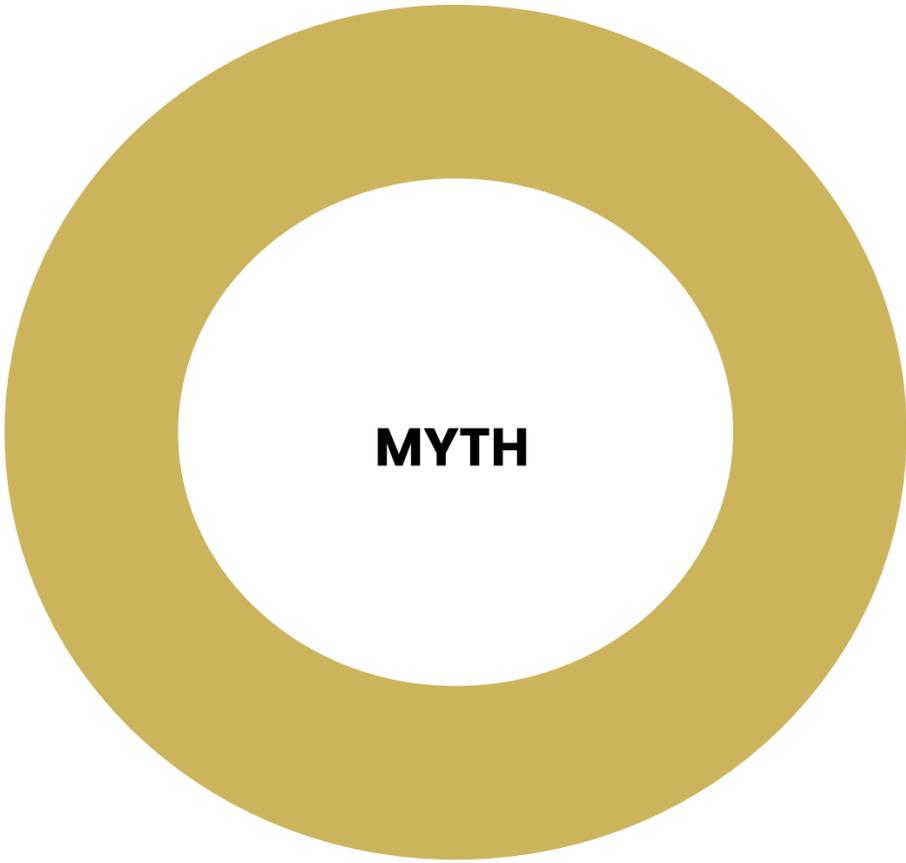




All trademarks are created equal

Types of Trademarks by Strength





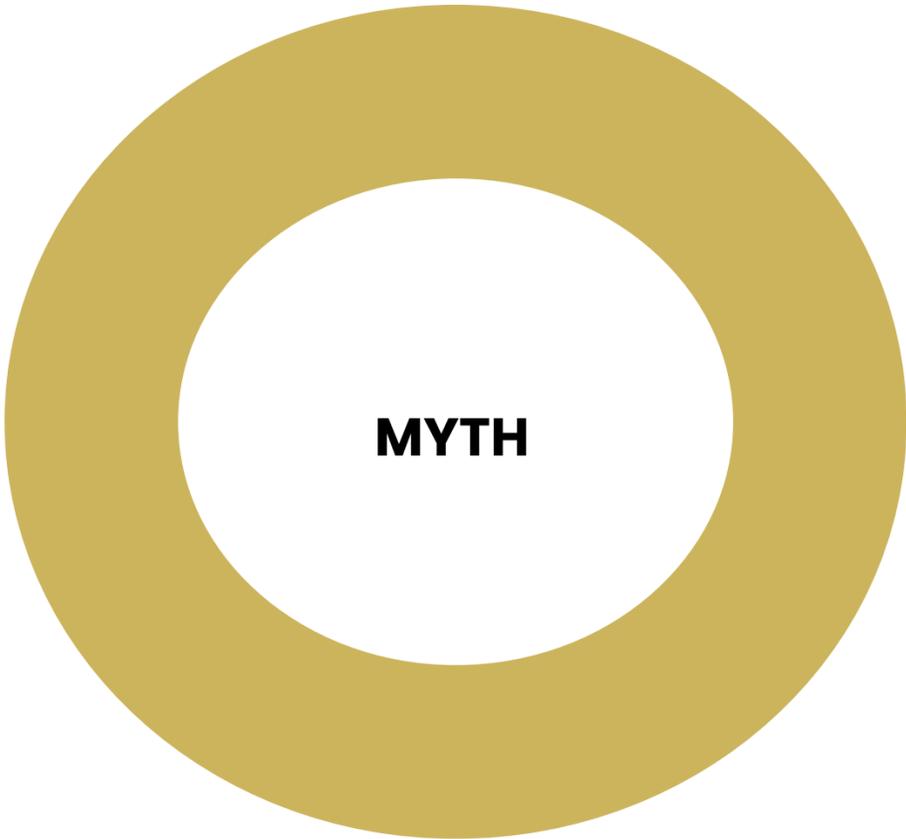
MYTH

Anything can be trademarked!

A trademark is any word or design used in connection with particular goods or services* including colors, sounds, smells:

- Play-doh Reg. Serial No.
- UPS Reg. Serial No. 2901090
- Home Depot Reg. Serial No. 2,276,946
- Tiffany Reg. Serial No. 4,177,892
- NBC's chimes Reg. Serial No. 916522
- MGM's roaring lion Reg. Serial No. 1413137





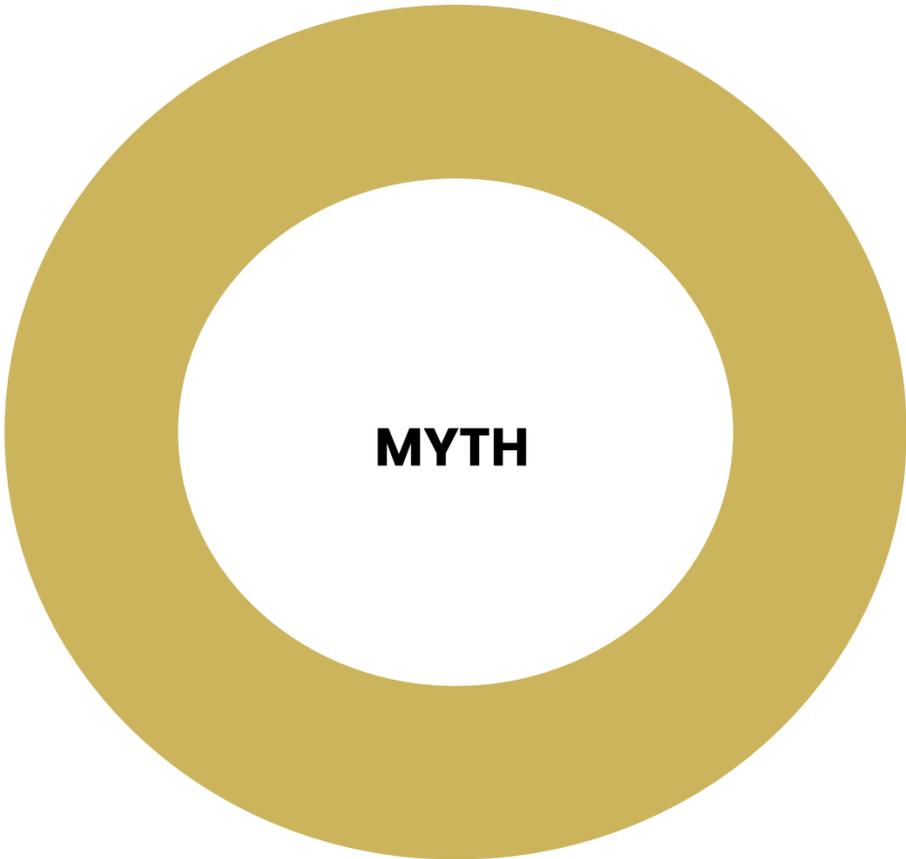
MYTH

This is an example of a mistaken application - USPTO Application Serial No. 88/392,580

What is wrong with this application? It is describing what the results are but does not actually describe the software application which is what needs trademark registration.

Thank you for your service application will provide service providers in the hospitality industry a means to supplement their income by receiving tips for the wonderful service they provide, currently . . . The first component of the process is the method and the system for transferring funds in a mobile phone, based money transfer system comprising receiving a request for an amount of ...





MYTH

Everyone who applies for registration has good intentions

Bad faith registration

- “Stealing” social media accounts of large influencers
- Trying to hijack others' brands
- Prevalent in China; has made its way to US



SHOULD YOU HIRE AN ATTORNEY?

A US-licensed attorney specializing in TM law can:

- Search for availability for use and registration of your proposed mark
- Select an appropriate specimen that shows your mark as used in commerce
- Determine the appropriate filing basis for your application
- Prepare responses to any refusals to register your mark that a USPTO Examining Attorney may issue.
- Accurately identify and classify your goods and services



MUST YOU HIRE AN ATTORNEY?

You need to use a U.S. licensed attorney to apply for Federal trademark registration if:

Your domicile is outside of the U.S.:

- If you are applying as an individual and do not live in the US; or
- If you are applying as a business and the business is headquartered outside of the US.



HOW TO SELECT A TM ATTORNEY?

Make sure the lawyer you hire practices TM law for a significant portion of his or her practice and is legitimate.

Some questions you can ask:

- How long have you been helping people with trademarks?
- How do I maintain my rights after I get the registration?
- How many USPTO applications have you overseen to registration?
- Do you carry professional liability insurance?
- Do you recommend TEAS or TEAS+?



Best Practices for Trademark Protection

1. Conduct a Comprehensive Search:

- Before adopting a new trademark, conduct a thorough search to ensure it is not already in use.
- Use both federal and state trademark databases, and consider common law sources.

1. Register Your Trademark:

- Register your trademark with the USPTO.
- Consider international registration if you plan to expand globally.

1. Maintain and Renew Your Trademark:

- File required maintenance documents and renew your registration as needed.
- Monitor the marketplace for potential infringements and act promptly to address them.



Best Practices for Trademark Protection

4. Use the Trademark Properly:

- Use your trademark consistently in commerce and with the proper ® symbol to avoid dilution.
- Educate employees and partners on correct trademark usage.

5. Monitor and Enforce Your Rights:

- Set up monitoring services to detect unauthorized use of your trademark.
- Take legal action against infringers to protect your brand's integrity.



Best Practices for Copyright Protection

1. Automatic Protection:

- Understand that copyright protection is automatic upon the creation of a work in a tangible form.
- No registration is required, but registration has significant legal advantages.

1. Register Your Copyright:

- Register your works with the U.S. Copyright Office to gain access to statutory damages and attorney's fees in infringement cases.
- Register promptly to ensure protection.



Best Practices for Copyright Protection

3. Mark Your Work:

- Include a copyright notice on your works to inform others of your rights.
- Example: © [Year] [Author/Owner's Name]. All rights reserved.

4. Keep Detailed Records:

- Maintain thorough records of creation dates, drafts, and versions of your works.
- This helps establish ownership and originality if disputes arise.

5. Monitor for Infringements:

- Regularly check for unauthorized use of your works online and offline.
- Use digital rights management (DRM) tools to protect online content.



Protecting Works Created with **AI Assistance**

1. Clarify Ownership:

- Clearly define who owns the copyright of works created with AI, especially in collaborative environments.
- Contracts should specify ownership and rights related to AI-generated content.

1. Understand AI and Copyright Law:

- Stay informed about the evolving legal landscape regarding AI-created works.
- Current law typically requires a “human author” for copyright protection, but this may change.



Protecting Works Created with **AI Assistance**

3. Use Licenses and Agreements:

- Use licensing agreements to outline rights and usage of AI-generated works.
- Ensure agreements address issues like authorship, usage rights, and compensation.

4. Protect Your AI Models and Data:

- Consider copyright and trade secret protection for your AI models and training data.
- Use strong contracts and NDAs to protect proprietary information.



Protecting Works Created with **AI Assistance**

5. Stay Updated:

- Keep up with legal developments in AI and intellectual property.
- Engage with professional organizations and legal resources to stay informed.



THANK YOU!

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Questions? comments? compliments?

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