

WHITEPAPER

A Guide to Trademarks and Brand Protection

Everything you need to know to safeguard your brand.



THE LAW OFFICE OF
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— AN INTELLECTUAL PROPERTY LAW FIRM —

Introduction

You are not alone!

Most business owners and entrepreneurs struggle with trademarks and how to protect their brands. They want to make the right decisions, but they either don't have the information needed or the time to consume the information. The result is stress and worry.

That's where this guide comes in.

I want you to have this information about Federal trademarks so that you'll be empowered - quickly - to make the best trademarking decisions for your brand and business.

Savvy businesses know that brands matter. They know that people don't have relationships with products; they are loyal to brands. After all, it's WHO you are, WHAT you do, WHY you do it, and who you do it FOR. That's why your brand is important.

The single best way to ensure your exclusive ownership of your brand is a Federal trademark. It is insurance against ever having to rebrand, and that's why the big brands invest so much in their trademarks.

For over two decades, I have helped businesses large and small get the peace of mind that comes with a Federal trademark. I want you to feel that peace of mind, too, by taking the right first steps to identify the trademarkable elements of your brand and understanding why Federal trademark protection is so powerful.

Ready to get started? **Let's go!**

A stylized, cursive signature in blue ink that reads "Mike".

Michael E. Kondoudis

U.S. Patent and Trademark Office Registration No. 42,758

WHAT IS A TRADEMARK?

Trademarks represent brands. Trademarks identify your products and services and help you build your brand. They also differentiate you from your competitors. When you protect your trademark, you protect your brand and all of the hard work that goes into it.

WHAT CAN I TRADEMARK?

Every element of your brand can be trademarkable. The possibilities are almost limitless, but the four most common elements are:



BRAND NAMES

usually, your
company name



LOGOS

your company logo or other
graphic used to brand your
products



SLOGANS

the catchphrase used to sell
your products



PRODUCT NAMES

the name of your
product, if it's unique

In most cases, company names, product names and logos are the cornerstones of most brands. The McDonald's Corp. protects its brand with a combination of its name MCDONALD'S, its "golden arches" logo, the slogan I'M LOVIN' IT, and product names like BIG MAC and MCNUGGETS.

WHAT ELSE CAN I TRADEMARK?

Technology is changing the business landscape, and trademarks have evolved to protect brands in new marketplaces. Some of the most exciting examples include:

Podcast Names

If your podcast has a unique name that distinguishes it from the competition, it is trademarkable.

Blog Names

If your blog has a unique name that distinguishes it from the competition, it is trademarkable.

Fonts

If you present a name in distinctive typography, like Disney or Coca-Cola, your name is trademarkable.

Product Shapes

If you sell a product in distinctive packaging, like a fluted Coke bottle, the shape is trademarkable.

Webinar Names

If your webinar has a unique name that distinguishes it from the competition, it is trademarkable.

YouTube Channels

If your channel has a name or graphic that separates it from the competition, it is trademarkable.

WHAT CANNOT BE TRADEMARKED?

There are some limits to what is trademarkable.

Everyday Phrases

Trademarks must be unique so that they are recognized as a brand.

Generic Names

The names of a category of product (e.g., milk, escalator) are not recognized as brands

Elements Not Used in Commerce

Trademarks are used in commerce. If you aren't selling a product or service, you may not have a trademarkable brand element.

NOTE: *This is not an exhaustive list of what is not trademarkable.*

THE TRADEMARK PROCESS

The path to a Federal trademark is not easy or short. The average timeline is nine months. Also, the paths for any two trademarks can be very different. Still, the registration of every trademark includes the same five steps.



1: THE SEARCH

Applying for a Federal trademark starts a Federal legal proceeding that requires an investment of time and resources. Before you spend time and money applying for a Federal trademark, a professional trademark search can help us find out if anyone else has registered your mark or something similar. Based on the search results, we can adjust your application to avoid most obstacles. This type of search normally takes just a few days.



2: THE APPLICATION

The submission of a Federal trademark application is the easy part. Here, accuracy and a deep understanding of what makes up an application are essential. There is little room for even honest mistakes or misunderstandings because the USPTO's rules are strict and limit changes to a filed application. So, knowing what to put into your application - and what to leave out - is critical.

Some examples of the tactical decisions every applicant must make include: (1) the format of their mark; (2) the correct filing basis for their application; (3) the products and services that should be included or excluded in the application.



3: USPTO REVIEW ("EXAMINATION")

About four to six months after your application is filed, it will be reviewed by a USPTO attorney ("Examiner"). This process is commonly referred to as "examination." In this step, the Examiner determines whether your trademark poses a potential conflict with any other registered trademark or pending trademark application and if it meets all USPTO standards for trademark registration. If the Examiner finds no issues with your application, your application will be approved for publication (step 4).

What if the Examiner finds a conflict or issue with the application?

If the Examiner finds a conflict or any other issue, the Examiner will issue a letter called an **Office Action**, to which you must respond.

The USPTO gives you 6 months to respond to the Office Action, but the longer you wait, the longer your application will take.

Importantly, keep in mind that the USPTO Examiner is prohibited from offering anything that comes close to legal advice. This is one of the reasons that the USPTO strongly encourages all applicants to get a trademark attorney.



4: PUBLICATION

The USPTO publishes all approved trademark applications in its Official Gazette. This publication begins a 30-day window in which anyone that believes they would be harmed if your trademark is registered can "oppose" registration of your trademark. This is rare. If there is no opposition, then your application passes to the next stage.

What happens if someone files an opposition against my trademark?

If an opposition is filed against your trademark application, a special branch of the USPTO will start an "opposition proceeding" and review the matter. An opposition proceeding is essentially a streamlined trial to determine whether there are valid grounds to deny your application.

If you prevail, your application will move on to registration (Stage 5).
If you do not prevail, your trademark would be denied.





5: REGISTRATION

If your application successfully passes steps 1-4, the USPTO will register your trademark and mail you an official **Certificate of Registration**. With that registration, you can use Federal law to stop infringers while your brand enjoys exclusive use of your mark, in your industry, in all 50 States.

THE BENEFITS OF FEDERAL TRADEMARKS

Federal trademarks come with nationwide protections along with important legal presumptions that will make protecting your brand easier. Here are just a few ways a Federal trademark can safeguard your brand.

They Put the Federal Government to Work for You. The U.S. Patent and Trademark Office will immediately begin rejecting applications for trademarks that are similar to yours. In fact, the USPTO is legally required to refuse them!

They Come with a Legal Presumption of Ownership in All 50 States. A Federal trademark comes with a nationwide legal presumption of ownership of your trademark, along with an exclusive right to use it and access to Federal courts to protect it.

They Provide Enhanced Protection on Social Media. Social media services like Facebook, Instagram, and Twitter have policies in place to protect brands against abuse - provided that you can establish ownership. A Federal trademark makes establishing ownership a mere formality.

They Provide Enhanced Protection on the Web. When you secure a domain that includes your trademark, all of the legal protections and presumptions that accompany Federal trademarks apply to your web address.

They are Required to Access Amazon's Brand Registry. The Amazon Brand Registry is an important and powerful brand protection tool. When you enroll, Amazon will look for and stop trademark violations. Amazon's Brand Registry is limited to Federal trademarks, however.

They Make You Stand Out in a Crowd With the ®. Only owners of Federally registered trademarks are legally permitted to use the ® sign. This symbol is an attention grabber in both the offline and online worlds.

They Reduce Future Trademark Problems. Registration adds your mark to the Federal trademark database, where it will be found by competitors searching for new names. They will have strong incentives to steer far clear of your Federally registered mark or face Federal litigation and money damages.

About Mike



Michael Kondoudis is the founder of a national law firm and the creator of the YNAT® trademark application system. Over the last 20+ years, he's become a "go-to" trademarking expert for small business owners, start-ups, and entrepreneurs, with over 2500 trademarks and patents secured for his clients.

Mike is a USPTO-licensed trademark and patent attorney, educator, speaker, and nationally published author of the Amazon® best-seller: ***Going from Business Owner to Brand Owner.***

A rarity in the legal profession, Mike can serve clients in all 50 States and has represented clients from over 20 countries.

Learn more at <https://mekiplaw.com>.



Your brand deserves protection.

Take the first step toward true brand ownership today.
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