

On Your Terms Episode 109:  
All Your Trademark Questions: Answered

**Sam Vander Wielen:** Hey there, and welcome back to On Your Terms. I'm so excited to chat all things trademarks with you today. I got so many good questions about trademarking, about how long the process takes, what the process looks like, if you're allowed to have other people in other industries use your trademark, all kinds of stuff that we're going to get into today. So, if you've wanted to learn more about trademarks, this is a good episode for you.

So, you also have to know that my next live training called What To Do If Copycats Steal Your Content and How To Make Sure That You Don't Accidentally Steal Too is just two weeks away, on April 25th. I'm so excited about it. Registration opens next week on April 17th.

And in the training, I'm going to teach you how to react right from the first moment that you ever see a copycat steal your content or mimic you online so you don't lose any of your rights or remedies. I'll teach you how to get copycats to take down your stolen content, how to register your content, the basic steps if you want to go forward so you actually have more rights, how to take your own legal action if that's a good idea.

And as a bonus to you, you'll get a Copycat Guide so you can put what you learn from the training into action immediately following the workshop. So, it includes an overview of the copycat training plus resources for creating a 90-day game plan for how to successfully respond to copycats. The training will be \$99, but you can save \$25 as an On Your Terms listener. So, if you already know you want to attend, click the link in the show notes. We'll send you the link to join this training. There are going to be limited spots available as soon as the doors open on April 17th, so I cannot wait to see you there.

All right. So, let's get into this week's episode. So, one of the issues with trademarks that I see is that people tend to focus too much on them. On the one hand, people don't focus on them at all. On the other hand, I also see people just get a little tripped up as to what is trademarkable versus what falls under copyright. So, I thought that it might be

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helpful if I answered a bunch of trademark questions that I got yesterday, and I was hoping that these are questions that you might have too.

Okay. So, the first question I got was someone asking, What are the documents that you need for trademarking? So, I would say that trademarking requires more information, what I would say information versus a lot of documentation. Really, the only document that you're going to need is that you're going to have to prepare and file the trademark application, the application on the USPTO website.

And then, in that application you have to provide what's called a specimen of your mark. So, depending on what it is, if it's a logo, you would upload a PNG file of it; or if it was a word or a phrase, you would upload something with it on it. So, you have to essentially provide an example. So, that's really the only documentation you need.

Otherwise, you have to gather a lot of information. So, a lot of information about you and the description of your mark. And you have to pick a class under the goods and services categories, that kind of stuff. So, that's really all you need for filing a trademark as well as a fee. You have to pay a fee.

Okay. Someone else asked, How long does it take for a trademark to be processed and approved with the USPTO? I would say, at least 12 to 18 months. So, essentially, what happens is that you file your trademark within a few days. It will appear on the website where you go to search. It will appear there just as pending, so it's not like it's approved or anything, but it appears there. And then, from there, I would say it's a good six to nine months before you ever hear from an examining attorney.

Once the examining attorney takes it, they'll kind of give it an initial approval, which still doesn't mean it's registered. And then, they might issue what's called an office action, which is where you hear back from them and they say like, you have to change this or what about this, they have some questions, or they object to something that you did. You respond to that. You have a certain period of time to respond to that. You go back

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and forth. This is if that even happens. Sometimes they just accept it. They have to put it out for publication for a certain period of time. And then, if anyone doesn't oppose, then eventually it gets registered. So, that 12 to 18 month mark, I'm talking about that's when it's finally fully registered.

Someone asked, Does the company name have to be trademarked in every state or just the state that you originate from? This was such a good question because states actually have registration processes for trademarks as well. It's not just a federal process. But the reason that we have state trademark registration is for people who only want protection within their own state.

So, maybe that makes sense for a single brick and mortar store that has no plans of expansion and doesn't sell online or something like that. But if you have an online business, you wouldn't register in your state. You would register a federal trademark with the United States Patent and Trademark Office. That's what's going to give you coverage everywhere.

Someone else asked, How do you police your trademark work? So, this came up because I had shared about the fact that you really should only consider registering something that you're then willing to enforce. Because if you get a registered trademark, you actually have to enforce it. If somebody's using your mark, if they're using your words, whatever it is that you've registered, then you have to advise them that you have a trademark for it and tell them to take it down. Otherwise, it's considered abandonment, and it makes it possible that you could lose your registered trademark if you don't police it.

So, this person asked then, How do you police it? Well, there are a number of ways. There are some services that you can sign up for who will kind of police it for you. You obviously can do searches and stuff yourself, but that's not very economical or feasible, I don't think. And then, if you use an attorney to register your trademark for you, some of them will offer some of that as well. So, that's probably what I would explore.

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Someone else asked, If I didn't file for a trademark and later someone else files for that same name, would I then have to change the name I wanted to trademark? So, it sort of depends, but, yes, it's possible that you would. So, you do have common law trademark rights in something when you've been using it longer. It's just an issue of enforceability. So, you might be able to say like, "Hey, look. I've been using it longer," and you could actually prove that.

If you find, too, that somebody goes and files for a trademark for something you've been using for a long time, you might want to consult with a trademark attorney to see if you want to object to their trademark filing and prove that you've actually been using it longer. So, that's an option. It's also a good reminder as to why not to sit on something if something really, really means something to you. So, if you would be willing to intervene in somebody else's trademark application, then I would probably ask you then, "Why aren't you doing it for yourself?"

So, that's something to think about. It's a mistake that I've made in the past. It's very normal. There's a lot going on when you're building an online business and living a life in general. It's normal and so I just want you to know it does happen, even to people like me, where you're just like, "Whoops. I didn't really even think about that." And I guess I also thought I'd become known for it and somebody else goes and files it.

I was sharing with my customers yesterday in the Ultimate Bundle, I did a live trademark walkthrough for them, and I was sharing with them yesterday that I think I'm a weird kind of attorney for many different reasons. I'm feeling like I'm not super litigious. I just have never been a litigious person. And I don't know how I feel about this idea of people in our space owning certain words and phrases that are, in my opinion, kind of generic. I mean, they clear the bar for getting trademark applications because they can't be generic to be registered trademarks.

But, you know, I guess I just feel like I have bigger things I'm focused on. And that's me.

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I'm a lawyer. I'm being honest with you. I'm always honest with you. But I even make these calculations of I don't go around registering all trademarks and stuff like that. I take copyrighting much more seriously because I want to make sure that my actual work is protected. The name stuff just feels like it's a distraction sometimes. I don't know, that's just like my two cents. Or maybe I'm having an existential crisis, I don't know. But I'm just being honest about how I feel about it.

And, also, just to tell you it's also okay if you've had your head down in your life or in your business and you're like, "Whoops. I forgot to do that." It's not the end of the world.

Last but definitely not least, someone asked, If someone has the same trademark in a different industry, can you both use the same phrase? So, yeah, it's possible. It really depends because it's not always just that it's a different industry. It's the way that the goods and services are used within the class that you get protection from for your trademark. So, it really, really depends.

But it's possible that you could use a phrase in one industry and somebody else could be using it in a different industry for a different good and service, and that would be okay. That's the kind of thing that if you are trying to register a trademark and you already see a similar phrase or word that's registered for a different industry, that's when you would want to go hire a trademark attorney and ask them to do a trademark search for you, give you an official opinion on their part as to what's the viability of this trademark actually getting approved.

As I shared with my customers yesterday, there are no guarantees. Even attorneys can't offer you guarantees because it's a very subjective process. We also don't know how much of a legal fight the other person will put up. So, if they come back with a team of lawyers, you might want to say, "I don't want to fight that." And so, it really, really depends on a lot of different factors. So, you can go get that opinion from an attorney.

But I also just want to be honest about the fact that whoever, whatever attorney you go

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to, they're not a future seer. They're not able to tell you guaranteed language. You should be very cautious of anybody who guarantees you or uses any sort of language like that because they really don't know. It's a very subjective process. It's not supposed to be, but I find that you can get one examiner who's a little bit trickier and then another one who's a little bit easier with it, and it just kind of depends.

So, that's what I think about some of the trademark questions. I hope that these were helpful. I just wanted to give you a little taste. If you think that this has been helpful and you want to learn more about it, I certainly hope you'll keep your eyes peeled for my upcoming training, What To Do If Copycats Steal Your Content and How To Make Sure That You Don't Accidentally Steal Too. You'll have the link down below to get on the wait list to make sure you can register for it. Make sure that you'll use that coupon that we'll have available for you for being an On Your Terms listener.

But I hope to see you on April 25th at my training, What To Do If Copycats Steal Your Content.

Thank you so much for listening. I'll see you over on Instagram, @samvanderwielen. And let me know if this episode was helpful. I can't wait to chat with you next week.

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from your own lawyer. And please keep in mind that I can't offer you legal advice. I don't ever offer any legal services. But I think I offer some pretty good information.