

Ep #269: Why You Need a Trademark with Kelli Jones



Full Episode Transcript

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Tobi Fairley

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You are listening to *The Design You Podcast* with Tobi Fairley, episode number 269.

Welcome to *The Design You Podcast*. A show where interior designers and creatives learn to say no to busy and say yes to more health, wealth and joy, here's your host, Tobi Fairley.

Hey, friends, I am hard at work today with my daughter getting all of the final touches put on our little temporary space that we're opening for our boutique in just one week from when this episode goes live. So on June 1st we'll be open and I'm going to be telling you more on June 1st in an episode that I promised, that was coming your way about the whole process of the ecommerce shop and building it. And what we're doing with the little in person boutique and why it's a temporary shop and where we're going next and all of the things. And that'll be coming for you one week from today.

But while we're busy working and getting everything ready, today I'm bringing you an episode with trademark lawyer, Kelli Jones. So if you have a business or you're dreaming up an amazing one, have some big ideas but you haven't planned to trademark or you haven't already started that process for your current business then this episode is really important.

Because as we talk about in the episode there are so many reasons that you want to protect yourself, your business name. You want to really even search trademarks before you name your business to make sure that you have everything that you need in place. And so I'm going to be quiet and let you listen to this amazing episode. But if you're a creative like me, which most of you are, and you have a big thing you've already created or you're dreaming up new ones, this has to be part of the process. It has to be part of the plan.

And yes, it can be a little expensive but worth every penny because it's really like insurance to make sure that you are protecting those beautiful assets that you're building. Okay, so enjoy this show, this interview with Kelli Jones.

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Tobi: Hey, Kelli, welcome to *The Design You Podcast*. I'm really glad you're here.

Kelli: Thanks so much for having me.

Tobi: So we're going to talk about something that a lot of creatives could think was boring but my husband's a lawyer, don't worry. I talk to lawyers all the time and sometimes he is boring, I'll give you that. But this is a really important topic and so we want all the creatives to stay with us today. We're not going to make it boring. But why don't you tell everybody who you are and what it is we're going to talk about. And then we'll get into it because it's something that every business owner really needs to hear.

Kelli: Yes. So I am a lawyer. I live in New York and I practice primarily in trademarks which is basically what you would get to secure your brand, to own your brand name or some other part of your brand. And yes, we're going to try to make it as not boring as possible.

Tobi: Okay, good. So just tell us first of all, what is a trademark? We've heard that before in our life, we've seen the little TMs on things. What's a trademark? Is it different than copyrighting? What is this thing that we're going to talk about today?

Kelli: Yeah, so a trademark is basically something that is an identifier for your brand. So it identifies your goods or services. So it could be your business name. It could be the name of your podcast name, a product line name or a product name, pretty much anything that you use as part of your brand to essentially just identify goods or services that you sell.

Tobi: Yeah. And can it also be a mark or a logo, it doesn't just have to be a name or words?

Kelli: Yeah, it could be a word or words or even a design or sometimes even a color like tiffany blue.

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Tobi: Interesting, yeah. I hadn't even really thought about that. Okay, cool. So why do we need trademarks?

Kelli: So if you want to own your brand, so a lot of people think that when they get their LLC, they have secured that name and no one else can use it. But that's actually not the case, the LLC is just to protect your personal assets should anything go wrong in your business. But the trademark is where you really get protection over the name itself from other people being able to use either that same name or even something similar that maybe looks similar or sounds similar or even has a similar meaning than someone else. As long as it's in the same type of realm of goods or services.

And the point here really is to prevent other people from being confused between if they see two types of shampoo, they don't want the names to be so similar that people think they must be from the same brand. So both can't have that, only one. And then the other one would have to be something that's not going to confuse consumers.

Tobi: Yeah, okay, makes a lot of sense. Yeah, because as I'm sure we can immediately start to think of so many problems with that, not just confusing the consumer but if one brand's reputable and one's not or one's doing things that you don't want associated with your brand. You want to be able to protect that, right?

Kelli: That's exactly.

Tobi: So does everybody need a trademark? Do we need to trademark all of the things? How do we start this process of nailing, we have taglines and podcasts and business names and logos, do we have to trademark all of that? What's this process that we're going to go through to decide, do we need trademarks and what do we need to trademark?

Kelli: Yeah. So you don't necessarily have to trademark everything. Usually I ask people three questions. So the first is, do you have something in your brand that you see yourself using for at least the foreseeable future? So it's

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not just some temporary name that you're not sure of or you're only going to run it for a year and then change it. Something that you really see yourself using because you don't want to spend the time and money on trademarking if you're just going to change it in a year or two.

That's something that is really a solid part of your brand and then if you have something like that, then would you be upset if someone else had something that was either the same or very similar to you? And you kind of should be if you're building something in your brand because you don't want, again, you don't want people to be confused. So if you're coming up with a business name and then someone else comes up with something very similar but they just throw an S on the end then if people are Googling things they might find the wrong one on accident and you don't want that.

And then would you be upset if you were forced to rebrand? And this could happen if someone else files first and then essentially sends you a cease and desist and tries to get you to rebrand or if you try to file after them and get blocked because of them. So would you want to change your name? Some people, they're not really set on their name. They're like, "If I had to rebrand it wouldn't be the end of the world, I would just do it."

Some people, a lot of businesses, they choose their name for a reason, they don't want to have to rebrand it plus changing their website, maybe any products or signs or business cards, all these other costs. So if it's something that you don't want to get stuck having to rebrand, then it might be time to trademark that.

Tobi: And is it more important to trademark something like your own name even than the business name you came up with? What's the kind of rule of thumb there because I trademarked my name years ago for my business. But I always thought how weird that would be if somebody else trademarked my name and I couldn't even use my own name.

Kelli: Yeah. It kind of depends on how you're using it, if you're using your own name as part of your brand or if it's not associated with your business. If it's not associated with your business then you wouldn't really have a way

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to trademark it because you have to apply with the types of goods or services that you are selling.

But if you are using it then maybe it is something that you might want to trademark especially depending on how unique it is because the less unique that your name is the higher the chances that someone else might file a trademark for something that's the same or similar. Katy Perry, I haven't looked into it very much but I did see recent articles that she, I think was in Australia but she lost a trademark battle with, I think it was a fashion designer who's also named Katy Perry. So now she can't trademark her name there but it's happened with Haley Paige in the wedding industry.

She had her name trademarked and now the company that she worked for owns that trademark. So now she had to change her name so she can sell things because she can't sell things under the Haley Paige name. So it really depends on what the name is and how you're using it.

Tobi: Yeah. So I might be wrong about this but there are some things that are too general that you might still use. I have one that I'm going to use. I'm not going to tell you what it is yet. But I have a thing that I'm going to use for a part of my business but it's kind of general. And I think I'm still going to go with it.

But I mean I've been going back and forth about that because I don't think I can even get a trademark on it because it is a little more of a general thing. I like it because it'll be something that is very marketable but talk to me about that. What am I not thinking about? How does that work? Yeah, tell us a little more.

Kelli: So there is essentially a spectrum when it comes to the strength of trademark names. So on one end we have made up words, those are the strongest trademarks because obviously it's going to be harder for other people to think of the same exact made up word as you. Things like Xerox and Exxon, those just made up terms. Then we have terms that you're using that are actual words but they have nothing to do with the goods or services like Apple sells computers, not apples, so that's pretty strong.

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But then you get into the area where there is a little bit less strength and that's why when sometimes it goes a little too far and they're actually more descriptive of the goods or services. And then that's where, you know, if it's too generic like coffee shop for an actual coffee shop you couldn't trademark that because you can't have ownership and prevent other people from using something so generic. But if it's a little bit more descriptive like Designer Shoe Warehouse or Triple-A, the name of the [crosstalk].

Tobi: Pepper.

Kelli: Yeah, pepper, but also the...

Tobi: The Mexican chain.

Kelli: Yeah, that is more descriptive. And when it comes to descriptive names you sometimes can get a trademark for it but sometimes you will have the same strength in trying to protect your trademark in the future if you have to sue someone or something. But also a lot of times those types of marks will go on a secondary trademark registry. So it's the supplemental register. So you're still getting registered but you have a little bit less protection on names that aren't as descriptive.

And you can get to the principal register after using it for five years because they have this complicated process. So things like Best Buy, DSW, Triple-A, they're now on the principal register because they have essentially established themselves as brands. They've been around for more than five years. But it can still kind of be a little bit difficult. There was a recent case with Triple-A versus Sweetgreen because Sweetgreen tried to name their new chicken bowl Triple-A something, Triple-A Chicken Bowl or whatever. And Triple-A was like, "No, you can't use our name."

But it's really hard then because Triple "A" is also a pepper so how can you prevent people from using that. So Sweetgreen ended up settling because Triple-A is a bigger company. But if they had been on more of the same financial level, it might have been a different story. Triple-A might not have

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been able to win the suit if they proceeded that way because it's not super strong of a trademark.

Tobi: Yeah. Okay, so you recommend that people file their trademarks earlier in the process instead of waiting. Can you tell us what that's about?

Kelli: Yeah. So the best way is to do it earlier because it can be costly and the process takes a really long time right now. It takes over a year.

Tobi: Why is it taking so long? I just filed a couple, I don't know, two months ago. And my lawyer was like, "Just settle in girl, it's going to be a minute."

Kelli: Yeah. Right now it's taking nine to ten months just for them to review it, to get assigned to someone. So it just sits there. And that's because it's the federal government and they're slow and just getting slower. So it's just sitting there for all that time. So you don't want to, one, the process itself takes a long time. So the longer you wait to file the longer it takes to get reviewed and everything. But there is also, if you wait a couple of years into your business before you trademark, someone else might have gotten there already first with either the same thing or something similar.

Because a lot of people think no one's going to have the same name as me but they don't realize that when it comes to trademarks it's also about something that might be too similar. So even things that might spell something differently like aesthetics with an A in the front versus just the E in the front of it. Or things with a similar name like maybe woman versus lady and the name of a podcast or something. Those could potentially be issues to block your trademark that people don't necessarily think of.

And just the later you are in business the harder it's going to get to rebrand. So it's better to spend that money upfront and then kind of lock in that name rather than having to go through the process and then realize that you have to change something or you're not going to be able to get it.

Tobi: Yeah. So are there some other scary stories that we're not thinking about? Because obviously we're like, somebody could get my name before

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I could use it. But what are the other risks of starting with a business name and not having it trademarked?

Kelli: Yeah. So essentially if someone else gets there, so essentially the law is that who is using it first has more rights to it. But when it comes down to it, it really kind of turns into who actually files first because if you're not the first one to file then for example, this happened to a friend of mine. She built her business up, she has a brick and mortar, she ranked on the first page of Google, she built this big business. And then a couple of years in goes to file a trademark and realized that someone else already had something too similar to her.

And they had actually not been using it as long as her but they already had the trademark, she didn't. For her to get the trademark she would have to then essentially enter into some type of litigation to try to prove that no, she should have the trademark because she was using it first. That can cost, the average I think that the Trademark Office said at one time recently was about 96,000. So at that point for her, rebranding was easier to do, cheaper than that. So that's kind of where I say sometimes the difference between trademarking can be the difference between 3,000 and 100,000 later on.

So trademark early, spend a couple of thousand, trademark, go to trademark later on, you might realize that either you have to spend the 100,000 to try to fight for your name or just entirely rebrand which can be costly as well.

Tobi: Yeah. So one of the trademarks I filed that's in the queue right now is a perfect name for something that I'm building. And there is a similar thing, it's not the exact same thing but it's in China or something, it's not in the US. So what happens when we bump up against something like that, is it okay to go ahead and move forward with it? Do we just immediately have to change our name? Because hasn't everybody thought of something close to a lot of things you're going to come up with? And does that mean you're just out of luck?

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Or what do you do when you do a search and find that there's something out there?

Kelli: Yeah. So I really try to look into what they're doing and where they're doing it. And see what I can find out about them because if it's a company that I see they've expanded in a bunch of different countries, maybe not the US yet but they're all over Europe and stuff. And they seem like a bigger brand then maybe I would think, they're not in the US yet. Do they think they're going to be in the US? Do I think this could pose a potential future problem? And there is kind of the risk there. Really there's always a risk that anyone can expand in the US.

But kind of what would be the risk of that? If they're only in one country then maybe they're not going to expand. Maybe they're not going to expand in the US. It's kind of a risk that you always pretty much have to weigh of what do I think they're going to do. Sometimes you can kind of tell that they're probably a much smaller business.

Tobi: Yeah. I don't even think there was a presence for this company. They just happened to have this name that was similar to the thing I want. It's like they just grabbed it and have it out there or something. But it doesn't even look like they're really doing anything with it.

Kelli: Right. So sometimes you can kind of see, okay, it doesn't really look like they're doing much. They don't have this huge presence everywhere online. Then maybe it's okay because they're not in the US, so I'm going to use it in the US because we're in different markets so I'm going to establish my use here and start building my rights to it here.

Tobi: Yeah, so interesting. There's so much to think about. Okay, so say we decide that we're ready and we're like, "Okay, I'm going to do this." We've kind of talked a little bit about what you have to do. But what does it look like to start to file a trademark? Is it one step? Is it 20 steps? Because you said nine months, what does this look like?

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Kelli: Yeah. So typically the first thing that we do once we have a consultation and you decide, okay, let's file is I do a full search. This is before we even file the application. And this is really to assess the risk level of your mark because again, we don't want to waste the time applying for something that maybe is so high risk that we already know now that it's not going to go through and there's going to be problems. So we do the search, look for anything that is identical, similar, similar meaning.

And we kind of assess, okay, it's either low risk, moderate risk or maybe it's high risk for actually getting through to a trademark. And then we decide, okay, that looks good, we're going to actually file the application. And sometimes that can be dependent on those search results. Maybe there's something we can do to tweak to try to lower the risk a little bit. So we do the search then we actually file the application. Then we wait for about nine to ten months just really, it's just waiting there.

Then finally gets assigned to someone and they either approve your mark for the next stage or they issue what's called an office action which is essentially an initial refusal. A lot of people get these. Some of them are for super easy reasons that we can fix in a week or two and some are more complex like your mark's too similar to so and so's mark, who filed earlier than you. Or maybe they already have their full trademark and then you kind of have to try to differentiate your brand from theirs.

So that can sometimes take up a little bit more time just you've got a couple of months to respond. And then after that it goes to publication, it gets published for 30 days, this is where anyone else can oppose your brand. Usually only happens if you try to file something that is very similar to a big brand like Disney or Nike or something else, something infringing on someone else. And then finally it reaches registration.

So that's why the process takes a little over a year, but the majority of that portion is really that nine to ten months where you're just waiting and you have no idea what's going on.

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Tobi: So do you have to wait to do business in those nine or ten months or can you just go? I mean I can't imagine that people can just sit around for 10 months if they have an idea and not move forward. What does that part look like?

Kelli: Yeah. So you can definitely do business during that time, you should be if you're ready to because you can't get the actual trademark until you are actually using your goods or services in the market. So after we do that search, that first step of the process before we file, that's really where you have a somewhat decent idea of your chances at the process. So once we do that, you've got a little bit peace of mind of okay, even if something gets cited in a refusal, I think we can overcome it because it's really, I think we can differentiate our names or our goods and services.

Tobi: Yes. So you could have the same name but say well they're in automotive and I'm in children's clothing or something. That's okay if you both have the same thing, yeah?

Kelli: Yes, because they don't think a consumer's going to be confused between that kind of thing. If the off chance it gets cited, you just argue, "Listen, a consumer's not going to be confused by those two things. They're in different places that cost different amounts, different things go into that when you're going to do one versus the other." So you have all these arguments. So pretty much once we do the search portion, you kind of have a decent idea of what the rest of the process is going to come out like.

There might be an office action but if you're not filing something that you know is super high risk then you probably will be able to get it through. So that's why I always say also that the search is the most important part of the process because then it kind of gives you the clarity to like, okay, you can move forward. Or okay, maybe we need to change something or tweak something and then move forward and start selling.

Tobi: Okay. So you mentioned the number \$3,000, is that on average what it costs to get a full trademark when you go through this whole process and

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do people sometimes just start the search and that's a certain amount and then they have to stop because there was too much stuff in the way? Kind of break it down for us, what can we be expecting especially as a small business, things can get expensive, so how do we think about that?

Kelli: So I say 3,000 because that's about the average of what lawyers typically charge, I, and I know a bunch of others, I charge 2500 plus filing fees. And the Trademark Office charges 250 per class of goods or services for your filing the fees. So the 3,000 is an estimate of if you have two classes of goods and services. All goods and services are broken down into 45 classes. So things like a podcast is one class, jewelry is another. So it really depends on what stuff you are selling.

But most people have one to three classes is typically what I file in. And then the way that works is pretty much that's if we do a search and the results aren't that great, I typically do another courtesy search for you. And I know, I think this is pretty much how most lawyers operate. That way you can try to come up with a name that is something that we can trademark that's maybe not as high risk.

And then I offer payment plans and I know a lot of other lawyers now do as well just because small businesses, I know it's a big expense especially when I'm telling you, "It's really important to do it early in your business." But 3,000 is a lot to a business that's not very old.

Tobi: A brand new business, yeah. Good. Okay, so anything else people should know as they're thinking about this? Did we cover it all? Are there any other big things that you want to share on this topic?

Kelli: I think the only other thing is that you can do your own basic free search on the US PTO website. If you Google US PTO TESS – T-E-S-S. That'll bring you to the trademark search engine. And this isn't the same as the search that we do. It's not nearly as in depth but it can help you identify if there's something already there that's maybe the exact same name. And then you can kind of know right away, okay, I'm not going to pick that name. I'm going to pick something else. So that can be pretty helpful.

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Tobi: Okay, good. So where do people find you? I know you and I, we became friends on the internet as I have so many internet friends, mostly in Instagram I think because we had some common friends. But where should people find you, search for you, follow along? Do you talk about this stuff on your Instagram? Tell us the things, yeah.

Kelli: Yes. So I mostly talk about it on Instagram so you can find me @lawyerkelli, Kelli with an I_ and then also on my website lawyerkelli.com.

Tobi: Okay. Awesome. And did I see in the little notes that you filled out that you have a podcast coming. Is that something? I mean I don't know, tell me what's next for you?

Kelli: No, not yet. But if you go to lawyerkelli.com/podcast, that's where you can find.

Tobi: Where you've been on other people's podcast, is that it?

Kelli: No, it's actually where you can find some free information [crosstalk]. You can either sign up for my newsletter or grab some free resources that I have.

Tobi: Okay. So I have it confused, I see that. Well, that's even better. So what you're saying is, you have a freebie for everybody listening if they want to get some details. And tell us again, how do they get that, lawyerkelli?

Kelli: Yeah. So lawyerkelli.com/podcast.

Tobi: Ah, got it, okay. Well when you do have a podcast let us know because I know there's plenty to talk about in the world of trademarks. I bet you could have some really fun or interesting stories of what happens to people out in the world. But thank you for sharing this with us. It really is important and as much as I'm like, "I've got to think about the trademark." It's just like insurance or anything else. It seems frustrating that you have to do it but if you find yourself without it, it's such a nightmare.

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Kelli: Exactly.

Tobi: Yeah, awesome. Well, thanks so much for being here today. It was really helpful. It helped me even clarify a few things I'm working on. I'm always building new things and new businesses and yeah, I know, of course like I said, being married to a lawyer. My husband's not my attorney, one of his colleagues is. But yeah, he always keeps it top of mind for me as much as I don't want to think about some of this stuff but having you break it down for us was really helpful so thanks so much for that.

Kelli: Yeah, thanks so much for having me.

Okay, friends, so as I said, one week from today I'll be back, our shop will be launched. I'll be telling you all about what we've been going through to build it, where it's going next, all the fun things we have coming for you. But in the meantime check Kelli out, check out her website, find her on Instagram and really think hard about your trademarks. And if you have your own attorney like I do, that's fine. But you need someone's eyes on your business name and protecting those beautiful assets that you've built.

Okay friends, I'm back to work, getting Fairley Fancy ready for you. I'll see you a week from today. Bye for now.

Thanks for listening to *The Design You Podcast*, and if you're an interior designer or creative looking to uplevel your business, I have something for you. It's my Build a Better Business guide, because burnout, rampant undercharging and the feast and famine cycle are epidemic in the design industry. And there's a better way to run your business.

So head to tobifairley.com/betterbusiness and get my manifesto and guide that will have you on your way to a business with more ease, more joy and more money. That's tobifairley.com/betterbusiness.