

**Bonus Materials for**

# **Office DEPOT.**

Avoiding Legal Headaches When Branding Your Business



**May 11, 2010**

# Avoiding Legal Headaches When Branding Your Business

## Your Legal Prep Portfolio

So you've listened to the webinar, **Avoiding Legal Headaches When Branding Your Business**—and if your head has stopped spinning with all of the legal issues, you're probably asking yourself this: **what should I be protecting?** What are some of the different elements of my brand? How might the ways I run my business have an impact (and a negative one at that) on my brand and how it's used?

This Legal Prep Portfolio will help you take the next step: identifying the elements of your brand and how they are created. Once you identify the elements, you can take steps to **protect them!** Put another way, if you don't know what you have, you may find you have nothing (left).

When you have collected this information, you'll have taken a **powerful step** in securing your business assets—specifically, **your company's intellectual property**. *Extra bonus:* with this information readily available, you'll also be able to work with an attorney much **more (cost-) effectively!**

## Brand Elements

1. Logo
2. Brand name
3. Tagline(s)
4. Brand personality (e.g., spokesperson or representative--whether human, animal, or object) or signature style
5. Product packaging (color scheme, design)
6. Domain name(s)

## How and Where Is Your Brand Expressed?

### **Print/Tangible Content**

1. Articles
2. Books
3. Brochures/leaflets/flyers
4. letterhead stationery
5. Newsletters
6. Advertising and promotional materials (bags, mugs, pens, mouse pads, etc.)

### **Digital content**

7. Audio interviews
8. CDs/DVDs/videos
9. Blog posts
10. Vlog posts
11. Tweets
12. E-mail signatures
13. Websites
14. Facebook/LinkedIn/Twitter profiles

## Who Has Access to Your Brand or How It's Created?

All of these people/providers may have played a role in the creation, development, and promotion of your brand. What happens if you are no longer working together? Do you have a clear (written) understanding of who will own the elements and expressions of your brand when all is said and done? Are you keeping your eyes open for “poachers” of your brand—people who want to piggyback off of your hard work (and money)?

1. You
2. Business partners (that is, other owners of your business)
3. Employees
4. Freelance designers
5. Website developers
6. Copywriters
7. Videographers
8. Virtual assistants
9. Content collaborators
10. Strategic alliance partners
11. Co-marketing presenters
12. Professional printers
13. Networking colleagues
14. E-newsletter distribution services
15. Third-party storage/database providers (e.g., Audio Acrobat, KickStartCart)
16. Competitors
17. Just about anyone online

## Additional Resources from Nina Kaufman

### Internet Law & You Power Pack

Has this webinar made you curious about cyberspace issues and how they affect your company? Sign up for your free copy of our *Internet, Law & You Power Pack* at <http://bit.ly/ilawpack>. Not only will you get solid information about several of the hot topics involving the Internet today, but you'll also get our free weekly ezine, *Lex Appeal*, and access to our library of business law articles available through [GreatBusinessLawTips.com](http://GreatBusinessLawTips.com). You'll learn valuable tips, tools, and strategies that can **save you thousands of dollars** in botched deals and unnecessary legal fees!



### Is Your Business Legally Healthy?



Has this webinar raised questions about the legal health of your business overall? When was the last time your company went to the “doctor” to make sure you didn’t have any “illnesses” festering? An unseen loophole or ambiguous language is all a savvy attorney needs to turn a sniffle (*a technicality*) into walking pneumonia (*litigation*). **If business isn’t booming, your company could be just one step from a visit to the emergency room (bankruptcy)!** Get your copy of [Is Your Business Legally Healthy?](http://bit.ly/legalhealth) today at <http://bit.ly/legalhealth>!

Q&A Session for Avoiding Legal Headaches When Branding Your Business  
—with Nina L. Kaufman, Esq.

Session Number:

Date: May 11, 2010

Time: 4:00p.m.

Q: How long does it normally take for USPTO to conduct a Trademark Search?

A: **It can take anywhere from 4 to 6 months for the US Patent and Trademark Office to go through an initial review of your trademark application and appoint an examiner. Realize though, that after completing the review, the examiner could find that there are already other trademarks too similar to yours, so yours cannot be registered. That's why it's important for business owners to conduct a full trademark search of existing marks *before* filing the application--so that they don't waste time and money bringing an application that has a strong chance of being rejected.**

Q: I formally copyrighted a website which was a key element of my brand and operated it for several years. Due to illness, I did not renew the hosting service and now am being told that the name has been sold to someone else. Since I own the copyright, how can the name be sold to another party?

A: **You're dealing with two different issues—and one does not have a bearing on the other. The first is your copyright of the website, which may have included the text on your website pages and other images and graphic designs. The second is your ownership of the domain name, which is not protected by copyright. Hosting services are only concerned with whether you have paid the fee to keep using the URL. If you don't pay the fee, you lose the right to the URL. As a result, the URL can be sold to another party. Your content, however, cannot (without your express permission).**

Q: When branding my business can I use my Legal State registered Business Name for all of my online businesses?

A: **Companies have certainly used their names as a brand. Think of Coca-Cola® and Burger King® as examples. But you want to think carefully about whether using your company name for more than one online businesses will, in some way, dilute your brand. If all of your online businesses fall within same (or similar) category, you have a greater likelihood of getting brand traction in the marketplace. But if one online business sells golf clubs and another provides pet care advice, and yet a third offers wellness seminars, the public may not have a strong association with your brand.**

Q: We designed our own logo. What are the chances anyone else will have ours? Do you still believe it needs to be protected?

**A: When you're looking at protecting your logo, you need to consider two things. First, you need to be aware of whether anyone else is already using the same or similar logo in connection with the same or similar products or services. If so, they have a right of prior use which could prevent you from using your own logo-- even if it's original. Second, you will want to prevent others from coming along after the fact from poaching your logo (or knocking it off).**

**Q: If one of my employees publishes on LinkedIn does that expose our company?**

**A: Whether your company is exposed depends on what the employee published. If confidential client information gets uploaded, then yes, you could run into trouble. If the employee is merely touting a seminar that your company is holding, then the employee is simply providing marketing information. With the rise in social media use, employees need guidelines, boundaries, and training to make sure that they are using it in a way that enhances your business.**

**Q: When you trademark your Company Name should you trademark it with USPTO under more than 1 or 2 classes of good/service? Or is the best single class that relates to your goods enough?**

**A: The number of classes you choose depends on exactly how you will be using your trademark. If there is one class that best describes how the trademark will be used, then terrific! You've saved yourself some money and filing fees. However, filing in one class for, say, your diversity workshops (under "education") will not necessarily protect your trademark if you want to branch out into selling T-shirts and coffee mugs that use your trademark. Think carefully about how you will be using the trademark and when you really have a need to branch out into other areas.**

**Q: Regarding using online content, are you "safe" if you cite the source?**

**A: Not necessarily. Citing the source is always a best practice. As I touched on during the webinar, you also need to look at how much content you are taking and how you are using the content you take. If I copy an entire article (without permission), plunk it into my blog, and cite the author, that's not necessarily a "fair use" of the content. However, if something in the article strikes me, and I use it as a launching point for my own commentary (again, with attribution), that's generally considered a "fairer" use. The less you take of someone else's content (without permission), the safer you are.**

**Q: What other way can I search for patents or trademarks without consulting an attorney?**

**A: You can find information about patents or trademarks on the website of the US Patent and Trademark Office at [www.uspto.gov](http://www.uspto.gov). However, the information available through the website may not necessarily give you the full story.**

**Especially with trademarks, it won't tell you whether there are the same or similar marks being used in other states (which could become an obstacle for you).**

Q: Are company names/brands for sole proprietorships/partnerships regulated differently than for LLC's and corporations?

**A: Generally, company names for sole proprietorships/partnerships are filed with the local County Clerk's office; LLCs and corporations are filed with the state Secretary of State. But all that does is provide you with the right to use that company name in that state or county. If you are using your company name as your brand, you have to do more than just file the company name—you'll want to consider filing with the USPTO for trademark protection .**

Q: When filing the application should the owner of the mark be the individual (myself) or the company (LLC that I own)?

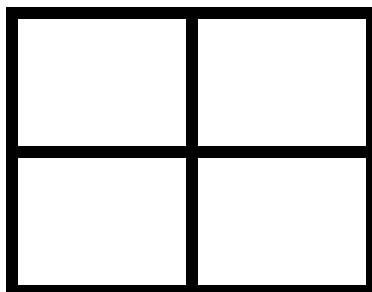
**A: Who the owner of the mark should be is a strategic decision. It can depend on whether you plan have other owners in your business. If you do, you may want to own the mark and license it to the LLC. On the other hand, if you are the sole owner of the LLC (and pretty much intend to stay that way) you may want the LLC to own it so that it will have the right to transfer it along with your other business assets if and when your business is sold.**

Q: how can I monitor my brand easily, nation wide? Are there services?

**A: There certainly are trademark monitoring services, but you want to be careful which ones you choose. The more reputable ones tend to work with law firms and not with consumers directly. If you want your trademark to become a valuable asset of your business, seriously consider outsourcing this monitoring to the legal experts who do it well (and do it often).**

Q: I found a logo on line that I liked, it was 4 squares making one, with an image in each square. I have created my own logo that looks like this one but used different images, could I have issues with ownership or infringement, as it is similar?

**A: There's a fine line between using one person's image as inspiration for another, and "knocking it off." From a copyright perspective, if your "four squares making one" really just serves as a grid or table (see below)**





then it's likely to be a common shape that's not copyrightable. From a trademark perspective though, if someone were to look at it and have an *immediate* association with the other logo, then yes, you could run into problems.

Q: What if we trade name a brand for a certain product, and later on we find that the name is being used for another product. Which is not related to same product.

A: When you file your trademark, you specify which "class" of goods or services you intend to use it with. The US Patent and Trademark Office is only looking at whether there would be a "likelihood of confusion" between two marks. So, for example, if you are using your mark in connection with website design services, and the other company is using it in connection with oil refineries, the likelihood that one company would be engaged in both those activities is pretty slim. As a result, the Trademark Office is more likely to allow both marks to coexist.

Q: Is the IP lawyer the only lawyer type to be utilized in trademarks and brands?

A: Intellectual property law has special nuances, and not all attorneys are familiar with them. Ideally, you want to make sure that you're working with someone who truly understands this area--not only is your likelihood of success greater, but you'll probably spend less money than working with someone who's just getting up to speed on the learning curve.

Q: What is the cheapest way to maintain an existing trademark?

A: if you have already registered your trademark, there are some inexpensive steps you can take in order to monitor it. They include setting up Google Alerts and routinely checking the US Patent and Trademark Office website ([www.uspto.gov](http://www.uspto.gov)) for new (and possibly problematic) trademark filings. That said, the time you spend trying to handle this will probably far exceed what you might pay in out-of-pocket expenses to an attorney to monitor the mark for you. Realize that your time has value and if you spend it on tasks where you have no familiarity, you run the risk of (1) wasting a lot of time, and (2) doing the task improperly . . . which could then result in your losing your trademark.

Q: I bought an avatar logo from iStock Photo. I had the avatar recolored. DO I have any copy write issues?

A: You may well have copyright issues--it depends on the terms of your agreement with iStockPhoto. Generally, stock photo agreements allow you to use the image provided in all different forms of media, and perhaps to make alterations for size. An open question is whether you have the right to alter the look of the image. Make sure you check your purchase order or any other terms of service concerning your avatar logo.

Q: Am I able to put a copywrite logo on my images, blog, etc on my own, or do I have to go through some paperwork process?

A: **Any time you create an image or a blog post, you own the copyright. And you have the right –without paperwork-- to use the © symbol to give people notice that you consider this to be your copyrightable intellectual property. However, if you find that somebody rips off your content, you won't be able to sue them unless you have filed your images and text with the US Copyright Office. For more information about copyright registration, visit [www.copyright.gov](http://www.copyright.gov).**

Q: If someone registers an LLC with their state, is their "brand" protected because they have formed a corporate entity using that name?

A: **No. Registering your business entity with your state does only just that--let people know that the business entity exists. If you want to use your business name so that it becomes your "mark in trade," you also need to take particular steps to protect it as a trademark.**

***Disclaimer(you knew there'd be one, didn't you ☺): The information in these bonus materials—and the accompanying webinar—are for your general education only. They are not meant to provide legal advice about your specific situation. To make sure you get the guidance you need, consult with a local attorney about your particular circumstances.***

## About Nina

**Nina L. Kaufman, Esq.** demystifies legal mumbo-jumbo to save small businesses time, money, and aggravation. She's also an award-winning business attorney, speaker, and columnist/blogger for Entrepreneur Magazine online.

Through both her [NYC-based law practice](#), and her legal information company, [The Legal Edge LLC](#), she has spent over 15 years successfully navigating thousands of entrepreneurs and small businesses through the legal issues that they face in starting and running their own companies. She advises companies and speaks on subjects ranging from creating business partnerships that work, training clients to pay you, and protecting your intellectual capital online.



A regular media resource, she has been an article contributor to *The E-Myth Insider*, *Enterprising Woman*, *WomenandBiz.com*, the American Bar Association's *GP/Solo Magazine*, and the *New York Enterprise Report*, among others. She also serves as an Intellectual Property Law Expert for Forbes.com's Small Business Exchange. She publishes her own blog, [BusinessPartnershipCentral.com](#), and weekly ezine, [Lex Appeal](#), and has recently released *The Entrepreneur's Prenup: How to Choose a Business Partner Who Won't [BLEEP] You*, available through [GreatBusinessLawResources.com](#). and [Amazon.com](#).

To learn more about Nina, and to get a free copy of her [Internet Law & You Power Pack](#), visit <http://bit.ly/ilawpack>.