



**KOMBUCHA™**  
organic & raw

**LAVENDER  
LOVE™**

redefine · rediscover

**enzymes**

reclaim · recapture



restart · regain

**probiotics**

rebirth · renew

16 fl oz

**ENLIGHTENED™**  
For Everyone, Everywhere.

473 mL

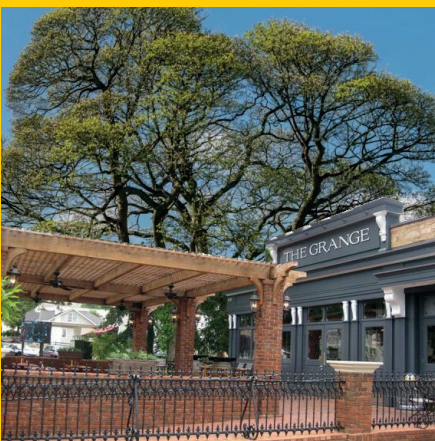
# ON YOUR MARKS, TRADEMARK!

Whether you prefer *Coke*® or *Frappucino*® or love your *Lavender Love*™ *Kombucha*™ *Enlightened*™ *For Everyone, Everywhere*, these superscript marks tell you the brand is legit — well, sorta.

Yes, the ® symbol signifies a federally registered trademark, but the TM symbol has no legal meaning. You can slap a TM on any name your company uses because it 1) suggests you own the name, or 2) signals your intent to register the name.

Cool. For that reason, we sprinkled TM's like M&Ms on our client projects (examples: *Fuel IQ*™ and *PriceQuery*™) because the marks suggested proprietary, innovative solutions. Yes, you can add a TM, but this chapter encourages you to make the effort to register the real deal and obtain the ® symbol.

Most small businesses don't register their trademark, and if you're operating in a small geographic area, it's not critical. But if you sell products on the Web, or plan to expand to other states, regions, or countries, trademark protection is important. You may remember how Ivanka Trump was granted sixteen trademarks from the Chinese government after her dad lifted the ban on the Chinese company ZTE for violating US sanctions. This little bit of political intrigue underscores the strategic and financial value of holding an international trademark.



The Grange Irish pub

Even for our young lawn guy, Donnie, trademark registration protects his future plans — and also future unknowns. Here's why:

Suppose Donnie abandoned *Carbon Free Lawns* and instead named his business *Green Planet Lawn Care*. In this *Green Planet* scenario, Donnie continues to cut lawns during college, and over time, his business grows. After taking courses in horticulture and landscape design, Donnie decides to scale up his business after graduation — two crews, then three, and so on.

**Scenario** – Joe Jones, the owner of *Green Planet Lawn Care* in Allentown, PA, is getting ready to retire. He's got a hot-shot son with an MBA looking for an investment niche. The son studied *CertaPro Painters®* — the largest residential and commercial painting company in North America — which sells franchises for \$57,500 – and decided to apply the *CertaPro* franchise model to lawn care. Hot Shot Son trademarked the *Green Planet* franchise name, assembled a franchise package, and started selling. He sold one of his first franchises in Donnie's town which caused an immediate conflict when the franchise owner noticed Donnie's truck at a job site.

*Boom.* Donnie receives a strongly-worded letter to cease and desist using the *Green Planet* name — a name Donnie has used since high school.

Donnie may have a common law right to use the name in his geographic area, yet the retiring Joe Jones has been using *Green Planet* in Allentown before Donnie was even born and now Joe and his son own a federal trademark. It doesn't matter who's in the right. If you don't trademark your name, it can become a legal liability.

A similar story played out in my neighborhood when some locals opened an authentic Irish pub, *The Grange Public House*. After a few years of business, the *National Grange of the Order of Patrons of Husbandry* (aka *The Grange*) took



notice and demanded that our sweet little pub change its name. A sensible person would ask, “Who would confuse a fraternal farming organization with our hip Irish pub?” It doesn’t matter. If you don’t have the resources for a legal fight, you will be forced to buy new signage, print new menus, and restart your business. Our little pub is now *The Marley*.

My mother’s Los Angeles public relations agency, *Nann Miller Enterprises*, also got into a trademark fight when an upstart PR person named Nan Miller (with a trademark) challenged my mom’s use of her un-trademarked business name.

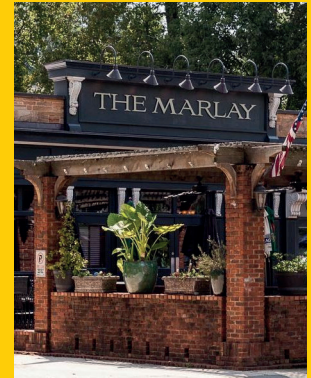
Most people don’t trademark their name because they think it’s expensive, not necessary, or too complicated. The shoestring approach below helps protect against future damages — and only costs \$225.

**Full disclaimer** – I am not a lawyer. I am an advocate for shoestring startups getting trademark protection at a price they can afford. I offer no guarantee that your trademark will be granted or that you will avoid legal wrangling regarding your name. I recommend a lawyer if you can afford one, but I’ve always applied for trademarks on my own.

**Trademark Procedure** — Most of what’s written about trademarks is confusing. A brief overview exists at NOLO.com: “How Do I Register a Trademark?” which I invite you to read, then follow this step-by-step:

**1. Name Lookup** — Visit the US Patent and Trademark site’s Trademark Electronic Search System (TESS) to find out if other businesses use your chosen name.

- Click on “Basic Word Search” and enter your full business name. In our scenario, we will use “*Green Planet Lawn Care*.” Submit Query. Likely, no records will be returned.
- Search again, entering just the keywords in your



Overview of Initial Application Options	
Questions	TEAS Plus
What is the filing fee per class of goods/services?	\$225



### Trademark Electronic Search System (TESS)

Updated on Fri Oct 4 05:36:29 EDT 2019

[FREE FORM](#) [Browse Dict](#) [SEARCH LOG](#) [BOTTOM](#) [HELP](#)

**SEARCHING** THE USPTO DATABASE, EVEN IF YOU THINK YOUR MARK IS NOT REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, YOU MIGHT **REFUSE TO REGISTER** YOUR MARK.

Search Term:

Number of Results:

Display Results:  Singular  Live  Dead

Search Type:

Search Options:

Start List At:  OR Jump to record:  **51 Records(s) found**

Refine Search (live)[LD] AND (Green Planet)[COMB]

Current Search: S1: (live)[LD] AND (Green Planet)[COMB] docs: 51 occ: 277

	Serial Number	Reg. Number	Word Mark
1	88611700		GREEN PLANET
2	88472806		ECOGREENFEET WALK GENTLY ON OUR PLANET
3	88586891		G GREEN PLANET STRAWS
4	88580680		KEEP OUR OCEANS CLEAN AND OUR PLANET GREEN
5	88366188		VERDE PLANET
6	88364801		GREEN POWER PLANET
7	88289522		GREEN PLANET HERBAL MOUTHWASH
8	88156752		GREENPLANET PHARMA.
9	88034032		PLANET GREEN SLEEVES
10	87403478	5323204	GREEN PLANET PRODUCTS
11	87570076	5386732	PLANET + ALL GREEN, ALL THE TIME
12	87506640	5495647	SUSTAINABLE SOURCING S HIMALASALT THE PUREST SALT ON EARTH SU GARLIC HIMALAYAN SEA SALT NET WT. 6 OZ (170G)
13	87459316	5431468	GREEN PLANET

name, i.e. “Green Planet.” (select “Live,” “Combined word mark,” and “All search terms”). In this example, 51 records are returned.

Review each record. You can ignore “Green Planet Paints,” but for listings that aren’t obvious, click the link, review the *Goods and Services* description, and see if they are in a similar line of business. If you find a *Green Planet* plant nursery, tree service, or landscape designer, study

the *Goods and Services* description. If you discover that they are in the same class as your business (scenario: IC 044), you will be out of luck.

- If you find *Green Planet Landscape Architecture*, it would be in IC 042 — a different class. According to the rules, if you are in a different class (see ID Manual discussion below) you should be okay. But, the USPTO might decide *Landscape Architecture* is too close to *Lawn Care* and reject your request — a \$225 roll of the dice.
- Sound-alike words must also be searched. If your t-shirt company is *Marquee Tees*, and a fashion line has trademarked *T.Markey*, your request might be rejected. These are judgment calls by the examiner.
- Don’t assume that an attorney will get better results than you. I own the trademark to Brand Story® (IC 035 - *Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others...*). Recently, I was approached by a trademark attorney hoping to register BrandStory for a client (IC 035 - *Advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others...*). I can’t imagine that it will be granted, but who knows?



**BRAND STORY®**

Term ID	Class	Description
035-2155	035	Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means
035-2126	035	public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means

- I have also screwed up many times. I tried to help my friend Sara trademark *Après Wear* for her after-yoga line of kimonos. During our initial search on TESS, I queried *Après* without the accented *Après*. “You seem good to go,” I told Sara, blowing through \$225 of Sara’s shoestring funds.
- Remember: You are applying for federal protection — for the entire United States.

**2. Search the Trademark ID Manual** — Your \$225 trademark will protect one business class. The “class” refers to the international class number assigned to the goods/services. There are 45 classes - 11 for services and 34 for goods.

- Trademark classes explain how *Dove* (Class 3 - *Cosmetics and Cleaning Products*) doesn’t conflict with *Dove* (Class 30 - *Staple Food Products*). Each brand stays in its lane, so customers don’t get confused. If the second *Dove* tried to jump classes and introduce a chocolate-scented shampoo, the soap-maker *Dove* could sue the chocolate *Dove* for trademark infringement.
- Some brands, like *Arm & Hammer*, extend their brand into many classes (baking soda, toothpaste, laundry detergent, cat litter). The *GE* brand pops up in countless industries (light bulbs, appliances, financial services, jet engines, medical imaging, etc.).
- Like *Arm & Hammer*, you can apply for a trademark in multiple classes, but they will cost \$225 for each class. For example, if you want to trademark *Kentucky Lucky Whiskey* in Class 33, but also want to trademark a fashion line to go with your whiskey - *Kentucky Lucky* hoodies in Class 25 - filing fees for two classes are required.





Class 25

- An application for “pants, shirts, shoes, jackets, hats,” although five separate items, would require a fee for only one class since all of these products fall within Class 25 for clothing, footwear, or headgear.

- To expedite the \$225 process, you will be choosing *Goods and Services* descriptions that have been approved in the past. You will search the Master ID List and copy the description into your application.

To get started, Google search USPTO Trademark ID Manual.”

Submit several search terms into the Master List until you find a description that fits your business. For Donnie’s lawn business, he first searched on *Landscaping*

and reviewed all 28 results. He also searched on *Gardening*. The closest description for Donnie is *044-119 Landscape gardening*.

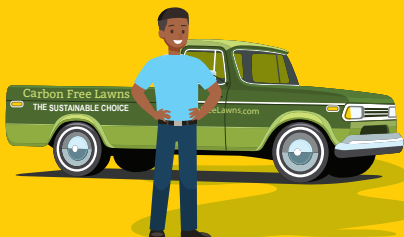
- Donnie searched a second time on *lawn* which produced 61 results, including *044-2571 Lawn care* and *044-2572 Lawn mowing services*. Donnie decided on *044-119 Gardening* and *044-2571 Lawn care* for his trademark. Both are in class 44.

- Click on the ID Link (i.e. 044-2571) and copy each description you will use.

- If you can’t find an appropriate listing (for example *Marijuana*

*Edibles*), you must use the TEAS RF application (\$275) and create a customized description of your goods and services. Since marijuana is illegal under federal law, good luck with your trademark.

044-182	044	<b>Garden</b> tree planting
044-181	044	<b>Garden</b> or flower bed care
044-120	044	Landscape <b>gardening</b> design for others
044-119	044	Landscape <b>gardening</b>
044-247	044	<b>Garden</b> care services
044-659	044	<b>Garden</b> design, installation and maintenance of interior botanical displays, streetscape container plantings and rooftop <b>gardens</b> for others
044-2331	044	Rental of <b>gardening</b> implements
044-2268	044	Providing information about <b>gardening</b>
044-183	044	<b>Gardener</b> and <b>gardening</b> services
044-2747	044	Rental of animals for <b>gardening</b> purposes



044-2572	044	<b>Lawn</b> mowing services
044-2571	044	<b>Lawn</b> care



**3. The specimen** — The Trademark agency (USPTO) will ask for a specimen of your mark used in *actual* commerce. The rules state:

- “*Use in commerce*” must be a *bona fide* use of the mark in the ordinary course of trade, and not use simply made to reserve rights in the mark.”
- This is a Catch-22 situation because you want to trademark your name *before* you invest significant dollars into a brand and then discover it can’t be trademarked. The USPTO insists on the opposite — start your business, then trademark the name.
- The USPTO recognizes this dilemma, so they offer an “*Intent to Use*” set of forms. This entails additional fees and forms to hold the trademark for six months while you get ready to launch.
- If you are a hungry startup and ready to accept your first sale *today*, you are technically *in commerce*. Go ahead and apply. The USPTO will ask for the date you were first in business.
- According to the rules for acceptable specimens, if you are a *Service* business, you can show a Website (but you may not be ready to build one), or a press release, or show some marketing materials. Since you are *in commerce*, one option is to print an initial set of business cards for your specimen:
- An easy method is to go to [Fedex.com](https://www.fedex.com) and select Printing Services. Choose a relevant design and include your business name/address. Add descriptive bullets for your services (should match your *Goods and Services* description), pay \$25, and submit. A few hours later, *voila* — 250 business cards. Take a close-up photo of an actual card so it’s clear that this is an actual card and not a design file.



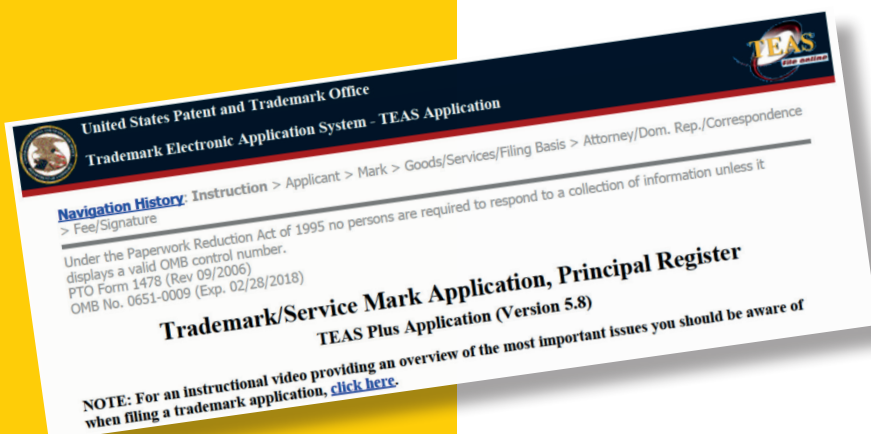




- If you are producing *Goods*, for example, ceramics, T-shirts, software, or cookies, it's more complicated. You will need a photo showing the trademark on the bottom of a mug, a garment label on a shirt, the packaging, a software start-up screen, etc. All of these will require a convincing prototype — but to be legal, it needs to be a salable product. If you trademark t-shirts, you must show a t-shirt. If ceramics, photograph a mug. And yes, I made this mistake with Sara's kimonos.
- I recommend studying the instructions for the USPTO Specimen closely. It's one of three places where it's easy to screw up in the process:
  - a. Existing Applicants and Registrants (searching the TESS database),
  - b. The ID Class/Description (the ID Manual), and
  - c. The Acceptable Specimen.

**4. Fill out the form** — The trademark application asks for simple information (warning: the insanely confusing form keeps lawyers in business).

- Because you have selected your *Goods and Services* listing from the ID Manual, use the TEAS Plus application.
- Search on “*USPTO TEAS Plus Application*” to locate the form. Then click “Fill out TEAS Plus online.”



- Go slow and focus on the information requested. Double-check each page; it's a merciless, poorly written form. Your trademark submission is for the words only (not a design or stylized font).
- Because you already have your specimen photo and your *Goods and Services* description, filling out the form should be straightforward.

Once you're done, celebrate your deep dive into bureaucracy. Importantly, your baby has a name, and with trademark protection, your business name is in a class of its own.

**One final bit of business:** If your trademark is accepted, open your calendar app, count five years ahead of your registration date, and write, "Declaration of Use of Mark in Commerce Under Section 8." The USPTO will not remind you, there will be no email reminder, and no letter (although you might get solicitations from trademark lawyers).

Remember: *Between years five and six after the initial trademark registration, you must fill out a Section 8 form, which currently costs \$100.*

While you're at it, count nine years ahead. You'll have to pay a significant fee between years 9 and 10, as well as every 10th year onward, for the rest of your trademark's life — a small price compared to receiving a cease and desist letter someday in the future.

*Between years five and six after the initial trademark registration, you must fill out a Section 8 form.*



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 PTD Form 1583 (Rev. 05/2008)  
 OMB No. 1625-0055 (Exp. 07/31/2018)

**Combined Declaration of Use and Incontestability Under Sections 8 and 15**  
 (15 U.S.C. §§ 1058 & 1065)

TEAS - Version 5.8 : 01/14/2017

Each hyperlinked term links to relevant information that will appear in a pop-up window.

Important: ONCE THIS FORM IS SUBMITTED ELECTRONICALLY, THE USPTO WILL IMMEDIATELY PROVIDE THE SENDER WITH AN ELECTRONIC ACKNOWLEDGMENT OF RECEIPT. Please contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov) if you do not receive this acknowledgment within 24 hours of transmission (or by the next business day).

Contact Points:  
 For general trademark information, please e-mail [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), or telephone 1-800-786-9199. If you need help in resolving technical glitches, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). Please include your telephone number in your e-mail, so we can talk to you directly, if necessary. For status information, use <https://tadr.uspto.gov>.

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