

PROTECTING YOUR POSSIBILITIES PODCAST WITH LUKE FEDLAM

Episode 58: It's your name and your brand: Protect it | Nov. 3, 2021

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Luke: I'm sports attorney Luke Fedlam, and welcome to the Protecting Your Possibilities podcast. Each conversation we focus on sharing information and having conversations around how athletes can best educate and protect themselves or their life outside of their sports.

Thank you so much for tuning in to the Protecting Your Possibilities podcast. I'm your host, Luke Fedlam. And, you know, I always say that I'm excited to have these conversations. And I am. Let me just tell you authentically, I'm so excited when we get to have these kinds of conversations on what needs to happen in order to protect athletes, tips for entrepreneurs and the like. What a great place to be where we can, you know, really help others be protected, so that they can be successful and make a positive impact on themselves, their families and their communities.

And I'm really excited for today's conversation. I've got one of my colleagues, Liane Rousseau with us today. Liane, how are you?

Liane: Doing great, Luke. Thanks for having me today.

Luke: Absolutely. Thank you for being here. And the reason Liane is on the call with us today, and this episode is because we're going to be talking about intellectual property. Now I know we've talked about intellectual property in the past, I wanted to bring Liane on because Liane is an attorney of Porter Wright, and she is my go to person on the intellectual property side for all of the athletes that we work with. And she does that same work for businesses and corporations and the like, across the country. And so she is one of those kind of subject matter experts, if you will. And so we're gonna have a good conversation. I know, Liane might be a little bit nervous, because this is the first beat on that Protecting Your Possibilities podcast, but I promised her that it will be fantastic.

Because there really is so much work in the intellectual property space, that comes up with athletes. And so that's what I wanted to kick things off with. Liane, one of the first things that I hear from a lot of athletes, and especially, you know, now that name, image and likeness at the college level has been authorized. One of the things that comes up quite a bit is, you know, how do I protect myself? Right, and, and there are a lot of different ways and, and we talk about different structures and different things that we can do on the legal side to help protect athletes.

But one of the things that comes up is, should I get a trademark? Or should I get, you know, some type of intellectual property protections usually people don't say intellectual property protections, but that's what they're really getting at. And so, trademarks, an interesting one, athletes oftentimes will look at trademarks, because they have an idea for something that they want to protect, and maybe either stop someone else from using or potentially use to

merchandise, you know, or commercialize a brand that they've created. When it comes to athletes and trademarks, can you just share a little bit about what is it that athletes should be thinking about when possibly looking for trademark protection? And you know, some of the ways in which trademarks can protect athletes?

Liane: Sure, so I guess the first thing you want to think about is what exactly the brand is that you're creating? Is it your name? Is it a catchphrase? Is it maybe a symbol that you use in your athletic performance in your games, whatever it might be? You know, for example, I think one of the classes that you always see is Michael Jordan's jump, man, something like that. And so the first thing that I would recommend athletes think about is what exactly you want to protect. And then once you get to that, the next question is, why do you want to protect it for exactly what you just said? Do you want to protect it to stop somebody else from using it? Or do you want to protect it to merchandise, your own brand, and to maybe eventually sell things. And so once you kind of get those ideas down and have a basic understanding of what you want to do, the next step is really just to nail down the finer details, things that you want to sell, maybe services that you want to provide. But really, the first step is just kind of deciding exactly what you want to be known as.

And what trademarks, how trademarks, work is, really is a source identifier. So you want to be able to look at a product on a shelf and say, I know that this comes from a certain business, a certain trademark owner. And so when you're trying to pick a brand, it's really important to sit down and think about what, either slogan, word image, even a color, you know, some sounds are trademarked are going to be used as your source identifier. And that can be a really tricky decision to make. There are a lot of things that are registered out there a lot of trademarks. And so it's important to sit down and think those things through so that you put yourself in the best position for success moving forward whenever you decide to commercialize your brand.

Luke: Yeah, so use the phrase called source identifier, what exactly does that mean in the kind of trademark world?

Liane: So exactly kind of what I said, you know, if I'm a consumer, and I'm standing, I'm looking at a shelf full of goods, you know, if we're in the sports world, let's say we're talking about basketballs, you know, you're looking at you're in Dick's Sporting Goods, you're looking at a bunch of basketballs on the shelf, and I should be able to look and see, I know that this is Spalding. And I know that basketball comes from this company because of you know the word that's on the basketball on the packaging, the color scheme on the packaging. So what you're really looking talking about in a source identifier is just giving the consumer something to latch on to so that they know where the good or if it's a service where they know that it's coming from.

Luke: Absolutely, no, that's, that's good. This is see this is good. I told y'all this is gonna be good. So we got a lot of good information here, and a lot more to come. So I want to talk you mentioned, which was interesting, kind of one of the first things you said, when you talked about trademark protections, you said, whether you want it to protect your name. Now, let's talk about that for a second, right? Because on the one hand, you could say the name of something, if you were creating a particular company and wanted to trademark the name, because of the brand that you wanted to protect, that's one thing, but when it comes to an individual's name, especially because of name, image and likeness, you know, a lot of times people wonder, like, do I have to do something proactively to protect my name? And I think that there's a good it's important to understand the difference between, I want to turn, I want to start a brand, right with my names, I want to turn my name into a brand, a merchandise brand, versus someone is up, you know, putting my name, like my actual name on something else that they don't have that

they're not authorized to do, right. I think there's a distinction between the two. Can you kind of shed some light on that? And just this idea of, if someone did want to protect their name, what does that look like?

Liane: So I think you're really talking about two different concepts. And the first is the name image and likeness, which I would describe, you know, wholesale as the right to publicity. So that's the right to commercialize your personal identity. So the right to license your name to, be on a TV commercial, be on some kind of sports equipment, whatever it might be, to license your name so that a different company can sell their goods kind of with your endorsement. It's really what that comes down to.

On the other hand, if you're looking at trademark protection, if your name is going to be the source identifier – so my name is Liane, if the company I'm starting is going to be called Liane and Liane is going to be on all the goods that I'm selling, then that's something that's going to be used as a source identifier, even though it's my name. On the other hand, we might pick a totally random word, that's not my name, and that's given me my source identifier. You know, I'm an attorney, maybe I pick attorney, and that's the name that I'm going to use to brand all of my products, then I wouldn't be so concerned as protected my name as I would be as protecting the word attorney as my brand identifier. So it really depends on how you're planning on using your name. But if you're going to use it as your source identifier, as your brand, your name, your nickname even, then those are things that you should consider trademarking.

Luke: So just to make that clear, then, you know, my last name is I don't know, Fedlam. Right. So if I wanted to create Fedlam's Footwear, right, and I wanted to protect that it's my name, but I still would want to file a trademark to potentially protect it in the in the area of footwear, right? Would that be accurate?

Liane: Sure. Yeah, that would definitely be something I mean, you might run into some other things that you'd want to talk about whether or not it's distinctive enough, all those kinds of things, but for the actual purpose of just, you know, the baseline, is this maybe a good idea to protect? Yeah, that might be something that you want to try to protect.

Luke: So you know, you bring up this word, you know, protection, and hey, this is protecting your possibilities. Right? So this is a perfect place to talk about protection. So let's think about this for a second. Can you explain to people kind of the process that you go through when actually filing a trademark, right? Kind of talking about the upfront knockout searches, the clearance searches? All that goes into it, because one of the things that I come across quite a bit with, with athletes is that, you know, people will target athletes to do their trademark filing and say, Oh, well, it's, you know, it only costs \$275, you know, to file a trademark. Right. And that's, that's accurate, but completely misleading. It's accurate in the sense that, yes, the filing fee for the US Patent and Trademark Office is \$275. But there needs to be work done on the front end. And I know you do a lot of that work. We talk about it regularly with a multitude of clients. What does that work look like that you do on the front end before you get to the point of actually filing the trademark application?

Liane: So the work that we do in the front end, you know, one of the things that's important to understand is that when you have a trademark, you are protecting your mark in connection with certain goods and services. So what I mean by that is there's different categories that you can file with the USPTO or the United States Patent and Trademark Office that have different goods and services listed out. One of the ones that you and I work with commonly is apparel, you know, so let's say I want to protect the, you know my name Liane is my brand in connection with

the word apparel. Well, the first thing that, you know, we would do on our end in the, you know, on the legal side is search the USPTO database, we have a third party search platform that we use that searches, state trademark registrations, common law marks that might be in use, even, you know, federal or federal and international marks to, but we would search first to see if there are any other registrations already out there for Liane in connection with apparel. Because if there are that registration is going to block my application. What you can't have are two trademark registrations that are so confusingly similar that a consumer is not going to be able to distinguish between the two.

So the front end work that we do is searching, you know, the USPTO database, mainly just to make sure that there's nothing out there that's going to be confusingly similar, because what you don't want to do is file a trademark application, while the USPTO is considering it start, you know, developing products, start marketing efforts, all these things only to then have in six to 12 months, the USPTO turn around and say you can't use this mark, because it's too similar to you know, your neighbors down the road. So the work that we do in the front end, really is about trying to figure out if the mark is even available.

And then from there, it's working with clients to make sure that that they know what they want to protect. So apparel, like I said, is one that we commonly see, but there are a whole host of things out there, you know, especially for athletes, if they want to get into kind of a coaching or athletic development service. That's something that we've seen before, if you want to get to nutritional supplements, maybe you want to get into sporting equipment. So there's a lot of different things. So once you find out that something's available, generally, taking a look at that, taking a look at what exactly you want to use this for, and really combining the two to make sure that we can put you in the best position to have a successful application with the USPTO and not face rejection issues down the road.

Luke: Yeah, absolutely. You know, you use the phrase confusingly similar and help to help make that clear. A good example would be, you know, Liane spells her name L-I-A-N-E. And so if she were to say, you know, start, you know, a clothing line called Liane, you know, and let's say she got a trademark and that if you happen to have the same name, but spelled differently, but it's Liane spelled, I don't know, like L-E-I-G-H A-N-N-E and said, I want to get, you know, trademark protection, no one would ever think that that would be the same name, because, you know, they're spelled so wildly different. However, phonetically, they sound the same. And so the US Patent and Trademark Office would come back and still say that that's confusingly similar, because they're both Liane even though they're spelled completely differently.

Liane: Yeah, that's right. What the USPTO is looking for is the overall commercial impression. And it's such a vague term, but it does give them a lot of wiggle room to say that something is either confusingly similar or not confusingly similar, similar. So what you said, the example you gave right there, phonetically sounds the same. So that would be a problem. Let's say it was a designed logo, and it was Liane and Diane, you know, those are spelled similarly, or at least with my spelling. And so that might be something that's confusingly similar, maybe we use the same font, or the same color in a brand. That can also be considered confusingly similar. So there are a lot of different factors to take into consideration. And those are all things that we would review in that front end work that I talked about.

Luke: Yeah. And that's why this is so important. And the reason I wanted to bring this part of the conversation up, because you might have people you know, that are around athletes who say, hey, we'll do this search for you, we just went to the US Patent and Trademark Office, we did a quick search. Nobody has that particular name out there. And so we're gonna go ahead

and we'll file this application for you, we'll do all this work. But there has to be more than that. And so, you know, just looking for that's what we kind of call a knockout search, right? Is there something that's exact to what we're looking for, you know, and looking to protect. And even though it's not exact, if something is confusingly similar, then you can be prevented or prohibited from using that or at least, getting protection for that mark down the road. So we always want to make sure that there's a lot of work on the front end to save you on the back end. Because think about it, if you're creating a brand if you're creating a lot of kind of commercial activity around a particular mark phrase, or what have you been ultimately, like you're investing time and money in that and you don't want six months later to find out like, oh, not only are you not protected, but this company is now coming after you to say hey, if you continue down this path, you're going to be infringing on our mark, and you need to cease and desist. So it's definitely something that that we want to talk about and understand on that front end. So you put in that work so you don't get in that situation down the road.

How Liane, does that differ when it comes to actual logos? All right, what's the what's the difference in terms of the process now of logos because it's not easy for someone to just go on to the trademark. You know website and search for a logo. What does that process look like on your end.

Liane: So when you file a trademark application for a logo, or what we would call a design Mark versus a word mark, the USPTO will assign specific design codes to your logo. So for example, a circle has a certain design code. And so when you know the USPTO, is examining your application, they'll look for other marks that have the same design code in the same class of goods. Those two linking together is really important, because you could have the exact same logo, but in a totally different class of goods, it's unrelated. And those two can move forward together. So, what we do on our end is really just replicate that search, you know, through use of a third party service that we do in direct, and make sure that you aren't using marks that have similar design codes assigned to them. You're absolutely right, if you go on the USPTO, just general search bar, you're not going to get a comprehensive search, and you're not going to flag everything that's out there. It's just not set up that way. It's not I mean, it's a little bit user friendly, but not in a way that's really meaningful. And so you want to make sure the designs are much trickier to search for. And if you're trying to live benefits and costs, designs are ones that we would really recommend investing that time and a little bit of extra money into to make sure that you're not going to run into problems down the road.

Luke: Absolutely. Great advice there. I love it. It's all about protecting your possibilities. Leon, thank you so much for spending some time with us today. This was really good conversation.

Liane: Sure. Like I said, happy to be here. And yeah, thanks again for having me.

Luke: Absolutely. We're gonna have Liane come back another time because I want to get into intellectual property more specifically as it relates to name image and likeness. And some of the issues that are arising there in terms of athletes wanting to you know, put marks out there and put, you know, create logos and some of the challenges that we've seen that exist in that space. So continue to subscribe to the podcast, to make sure that you're up to date when we have that next episode together. But again, to all our listeners out there, thank you so much for taking the time to check out the podcast episode this week. Please do continue to share the podcast, subscribe to the podcast, give us five stars wherever you listen to the Protecting your Possibilities podcast. We appreciate it. And I always appreciate the feedback that I get from listeners on various topics and we always want to meet, meet you where you are and provides

you the information that you want to hear. Again, I'm Luke Fedlam. Thank you so much for tuning in. Have a great day.

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