

Homeschool CEO Podcast Episode 52

Protecting Your Brand with a Registered Trademark with Kailey Jacomet

40:32

SPEAKERS

Kailey Jacomet, Jen Myers

Kailey Jacomet 00:03

So, it's really important to, you know, make sure that your name is available when you start using it. Go through the registration process because that does give you - it's a tool in your legal toolbox. And all of these things are really important when you're building a brand because the marketing is fun to spend money on. But essentially, it's going to be useless if down the line, you need to rebrand and you just spent all of this time and money and you pour your heart into building a brand and brand awareness so people recognize your business name, and then you need to go and change it down the line. You want to avoid that situation as much as possible.

Jen Myers 00:41

Welcome to the Homeschool CEO podcast, the podcast dedicated to entrepreneurs who want to successfully homeschool their kids while running a profitable business. In this podcast, we'll reveal the truth of what it really looks like behind the scenes of an entrepreneur who homeschools and how to make it all work. If you're an entrepreneur who currently homeschools or you want to start, you are in the right place, my friend. With 16 years experience combining entrepreneurship with homeschooling, I'm your host, Jen Myers, and this is the Homeschool CEO podcast.

Jen Myers 01:24

Welcome back to another episode of the Homeschool CEO Podcast. Today is our one-year podcast anniversary. That is right. We are at episode number 52. So, Happy Anniversary to our entire Homeschool CEO family. Now, if you've been with us since the beginning, can you do me a favor and reach out and let me know, send me a DM on Instagram or Facebook. I want to just personally thank you and then spotlight you and your business here on the podcast.

Jen Myers 01:53

Alright today, like I said, is a special episode because not only are we celebrating our one year in the podcasting business, we're also celebrating something super special for the Homeschool CEO milestones. But a little more on that later. First, let's talk all about trademarks. Like, is it really necessary to trademark your business or a product? You hear this talked about all the time and today, we're going to unravel the mystery behind trademark law. Is it important? Can every name be trademarked? Or does it even need to be? It is all so confusing. That is exactly why we have my favorite trademark attorney to join us today.

Jen Myers 02:39

Miss Kailey Jacomet is a wife, mom of two, and business attorney. In her law firm, Brand Law Boutique. Kailey helps entrepreneurs protect their most valuable business asset, their brand. So, today we are talking all about trademark, why it's important, and what you need to know about it. So, let's dive in.

Jen Myers 03:02

Alright, everyone, welcome back to another episode of the Homeschool CEO podcast. This is a really, really, really special episode because 1) it's our one-year anniversary for the Homeschool CEO podcast. And two, you all get to meet my attorney and we're gonna share some exciting information with you. We're celebrating, but first I want to welcome you to the show today, Kailey.

Kailey Jacomet 03:26

Thank you, Jen. Thank you so much for having me.

Jen Myers 03:29

All right, before we get started very quickly, because I like, tell people about you always. I'm like, "Oh, you got to go find Kailey". Tell our audience who you are and how you help people.

Kailey Jacomet 03:38

Yeah, sure. So, my name is Kailey Jacomet. I'm a business attorney and I help business owners protect their most valuable business asset which is their brand. So, my private practice, I practice trademark law exclusively. And then I also have a contract template shop called Contractista.

Jen Myers 03:55

Oh, I didn't know about that. So, I'm excited to - I'll have to ask you more about that and when we're done off the call today. All right, so first, we're gonna make our exciting announcement. Kailey and I just got the news last week that Homeschool CEO is officially a registered trademark. And that's pretty exciting, because for any of you who don't know my backstory, my husband and my second business together - the first business we had was an automotive shop and automotive shops are kind of like chiropractic places, you know. You just use your last name. You don't trademark that. Nobody cares. But our second business was a really successful power sports business. And we thought of a phenomenal name. But we didn't understand things like trademark. And we didn't understand the difference between a common trademark and a registered trademark and what all of those things meant.

Jen Myers 04:44

Long story short, we had a very successful business that a, another person had a similar name to. They watched us grow. Then, they sued us. Our attorney at the time, we secured excellent representation. He laughed at the other guy and said, "There's no way he'll win." Filed for dismissal. The judge said, you know, "Hey, actually, I think it's pretty similar. I'm gonna let this go to a discovery." For those of you who don't know what discovery is, that's like the next step that drags on, and on, and on. Two years later, we were \$40,000 in the hole, paying all these attorney fees. We ended up changing our business name, because at the end of the day, we're gonna lose,

and then we're gonna end up with paying damages. And so, we learned a really important lesson about trademarking a business name and logo and figuring out why it is so important to protect your brand. So, Kailey, can you tell us a little bit more about trademarking and why it's important?

Kailey Jacomet 05:47

Yeah, Jen. So, you know, first of all, it's not the most exciting thing, I realized, to spend your money on. You know, people are excited about getting a new website or maybe hiring a marketing specialist. But not only do people not realize that this is something that they need to do and is important to do but even if they do kind of know that, it's just not, you know, it's not a sexy thing to spend your money on. Well, I think it is, but you know. So, the reason that it's so important is 1) to avoid problems, like you were in. And I would say that, you know, that was, that was a very serious situation obviously.

Kailey Jacomet 06:24

For most people, if they get a cease and desist letter, it ends there, you know. Obviously, you had a very motivated opposing party against you. It sounds like they were very motivated to, you know, go through that long, litigious process. And litigious means going through a lawsuit with you. Oftentimes, when someone gets into a trademark dispute, you'll receive what's called a cease and desist letter, which means, you know, this is our name, you need to stop using it. And generally, as long as you comply with that, if you believe that they're correct in that, in their assertions, you know, then it won't lead to a lawsuit. But obviously, you thought you had rights to the name, they had rights to the name. And so, this became a very expensive process.

Kailey Jacomet 07:08

So, many people don't realize, as you mentioned, there's a difference between common law trademarks and registered trademarks. So, just to briefly go over both - in the United States, trademark rights are conferred by use, which means the first person to use a name in commerce, connected to particular goods or particular services, they have superior rights to the name. And even if you go and register a mark, there's a certain period of time where someone actually can come out of the woodwork. And if they say, even if they didn't have a registered name, if they can show proof that they were using the name in commerce before you, and the examining trademark attorney in the government office just didn't find their name, but they have sufficient proof of that, they can potentially cancel even a registered mark.

Kailey Jacomet 08:00

So, it's really important to, you know, make sure that your name is available when you start using it. Go through the registration process because that does give you - it's a tool in your legal toolbox. And all of these things are really important when you're building a brand. Because like I said, you know, the marketing is fun to spend money on. But essentially, it's going to be useless if down the line, you need to rebrand, and you just spent all of this time and money, you know, and you pour your heart into building a brand and brand awareness so people recognize your business name, and then you need to go and change it down the line, you want to avoid that situation as much as possible.

Jen Myers 08:40

Absolutely. And that is exactly what happened to us. Where we were already, we already had national recognition. And so, we had poured our heart and soul and so much money into signs and business cards and promotional things all over the United States. And then, we got sent the cease and desist letter from the itty bitty company that literally didn't even make any money, but then tried to assert that because we had a similar name, we were the one taking all of his business. It was crazy. Like, the whole thing was crazy. But, but it is important. And that's what I tell people all the time.

Jen Myers 09:16

In fact, literally Kailey, just had this conversation with somebody two days ago. She has a really great name for a business that they're going to start online and I said, "Have you searched if somebody has already trademarked that?" And she's like, "What? What is it? Really? Why would I need to trademark a name?" When I share the story just like what you said, yeah, it may not seem sexy, but especially, especially when you're building a brand. It is so, so, so important. So, what is the difference, Kailey, between filing your own trademark or going to like LegalZoom versus what I did having you do it as an attorney?

Kailey Jacomet 09:50

Well, Jen, don't even get me started on LegalZoom. But um, so essentially, LegalZoom is not a law firm. They are a paperwork service. If you go to their website at the bottom of the website, it says they are not a law firm, you're not hiring a lawyer, when you file your trademark through LegalZoom, you're hiring a paperwork service. And essentially you are providing all the information to them that they're going to use to file it. And so, if your name is not available, because someone else is using the same or similar name, or that's registered, they're not going to tell you that. You can pay a fee for a trademark search through Legal Zoom. And they just give you - I've seen clients bring me these, these trademark searches from LegalZoom. They're just giving you have print off of what they pulled up, as you know, potentially similar names. And then they're leaving it to you to make the legal analysis of if any of these would result in what's called likelihood of confusion.

Kailey Jacomet 10:49

So, with that rant on Legal Zoom, let me back up a little bit. And mention that if you are conducting your own trademark search, so you, you know, advise your friend, as was very good advice that they should make sure the name isn't registered, what's important to keep in mind is that trademark law in the United States does not just protect identical names, but confusingly similar ones. So, we're talking about spelling variations, phonetically similar words, synonyms, different combinations of those words. So, the government database that allows you to do a search is a good place to start. But the problem is, the technology is very old, when you do a search on your own with that, it's going to give you identical or near identical results. And it's not going to potentially pull up all of the names that could be conflicts.

Kailey Jacomet 11:14

Very often, it seems ridiculous, to be honest with you. It's like you would think if you, you know, if you don't practice trademark law, if you don't kind of know these nuances of what they are going to think is too similar. A common sense person would say, "These names aren't similar at all, like, no reasonable person is going to confuse these two names, are you kidding me?" But they, you know, I can look at it and say, "Oh, you know, this

reminds me of this case, and this case, and this case." And so, I am not going to be surprised if we received what's called an office action or, you know, a refusal based on this.

Kailey Jacomet 11:14

So, in a nutshell, it is, you know, if you want to make sure that your application is successful, and save those government fees, you know, start building a brand that you have confidence in that you're not going to have to rebrand later, it is very advantageous to work with an attorney who can do a comprehensive search. So, trademark attorneys use special software that, you know, uses its AI magic to cross reference all of those things that I mentioned. So, you're really getting a good idea of what's out there. And then they're using their legal knowledge and experience to analyze those names so they can warn you about what is likely to be a conflict, even if it seems ridiculous.

Kailey Jacomet 11:20

And so, the problem with that is twofold. First, it could give you a false sense of security that this name is available, and I can go ahead and launch my brand, because nothing came up on the government website, but not so fast. And then the other problem is if you are going to file an application on your own, as you mentioned, or use LegalZoom, and you went through this quick search, nothing came up for this business name, and you proceed with the application, like I said, because the standard is whether a consumer is likely to be confused by these two names, the government technology and their database just doesn't cut it when it comes to, you know, pulling up all of those names, that could be conflicts. And then, if you, you know, if you don't know enough about trademark law, then you might not have a proper analysis of very oftentimes, the names that are close calls. So, it's it receives a refusal from the trademark office, when you file your application, you get a refusal, because they say there's this similar name, there's a likelihood of confusion.

Jen Myers 14:07

Well, I think even we had three pages that came back with potential issues. And we talked it through and I think we changed something in the application to make sure that it didn't conflict with something. I don't remember now, because it's been a year because this is not something that happens overnight.

Kailey Jacomet 14:22

Right.

Jen Myers 14:23

It takes a while. So, Kailey, who, who needs to file a trademark? And who, like what kind of business names need a trademark versus, you know, it's not necessary to spend all the extra money?

Kailey Jacomet 14:34

So, I think it begins with is your name trademark-able. You know, there are names that you just are not going to be able to register as a trademark. And so, some people think that that sounds like a bad idea, like a bad thing. Like, I'm not going to be able to register this but, in a way, if it's because it's not trademark-able that could be an advantage, you know, in the sense that you don't need to worry about trademark infringement. So, let's say you say, you call your business Jen Myers Consulting. You're not going to be able to trademark that. So, you don't

need to worry about whether you're infringing on someone else, you know, because you can't infringe on someone else's trademark, if your name is not trademark-able to begin with.

Kailey Jacomet 15:17

But, you know, if you if your intention is to build a distinct brand, then generally it is beneficial to have a distinct name that people recognize. Another refusal that you can get is that your name is merely descriptive or generic. So, that would be, an example of that would be, let's see, like, let's say someone's a VA, and their business name is Virtual Assistant Solutions. That would very likely get a merely descriptive refusal because anything that where the words are literally describing what you do in your business, you can't trademark that because someone else needs to be able to use those words too - virtual assistant solutions. And so that, you know, in that example, I don't know that it would be worthwhile trademarking it.

Kailey Jacomet 16:11

So, that's the first step like is your name, even trademark-able. And then when you ask who should be thinking about trademarking their name, it's you know, it doesn't matter if you have a good or if you have a service. Some people say you should make a certain amount of money before you think about registering your trademark. It's really not about all of that. It's really about, are you committed to this name first of all. I would say definitely don't go through the process if you, you know, don't love the name. If you think that you might be rebranding next year. As you said, we've been doing this, we've been working on yours for a year now. So, it's not a flippin' thing. But at the same time, if you really do, you know, love your brand name, you should go through that process to make sure that you do have the rights to protect it, to protect someone else from using it.

Kailey Jacomet 16:56

So, a little tagline I use in my own business name is, "If you love your business name, then put a ring on it." And so, you're really committing, you know, you're committing to this name. And so, thinking of it that way, am I going to be using this name in the long run? Is it trademark-able? If you're unsure about it, or if it's not trademark-able don't worry about it. But it definitely doesn't have anything to do with how much money you're making now. At the same time, you know, it is an investment. So, you need to prioritize things. The most important thing to do, if you're in the position where you know, you do love your business name, you do plan on using it for a long time, but there's no way that you can afford to go through the process of trademark registration right now, I would say that the most important thing to do is the trademark search.

Kailey Jacomet 17:42

You know, ideally, if you can afford the fees to hire an attorney to do the trademark search that is going to benefit you from, for all the reasons that we mentioned. But at least, you know, do your own search before you launch a new program, before you launch a new brand. So that you don't end up in the position later on where you're having to rebrand. If you're going to do it yourself because you can't afford the legal fees to do a trademark search, then you should try to be you know, do your research and be as thorough as possible. So, I mentioned that I use special software that helps me you know, cross reference synonyms and phonetically similar words and spelling variations. Well, if you're not hiring a lawyer, and you don't have access to that kind of software, then get out a pad of paper, you know, write down your business name and get out a dictionary. I

mean, I guess, you know, you can just pull up a dictionary on your computer, and write down all the synonyms. And also, be careful, you know, if your business name has the letter C. You know a word starting with the letter C. Search that word but with a K, because that's the same sound. You know, you really need a need to be careful of those things. Try different, you know, combinations of the words, and be as thorough as you can.

Jen Myers 18:53

That totally makes sense. So, you kind of alluded to a couple of different points throughout the conversation here. What are the benefits of having a trademark? So, I know one for me to not get sued. Two, to protect your brand so that other people don't copy. Because right now I know for a fact that - that's something else we got to talk about. There's somebody else who has used the name Homeschool CEO. I'm like, how bold do you have to be, like this is the most unique name in this whole niche where I am right now. But because I didn't have the registered trademark I didn't even know if I could reach out to this person and say no, you need to stop. Like I don't know where that those rights start and stop yet I'm still figuring this all out since this is all just brand new. But what else are the benefits to finally to actually filing and then receiving the registered trademark?

Kailey Jacomet 19:40

Yeah, so there are a few and you touched on some of them. So, in not, not in any order of priority or significance. You know, you think of trademark infringement as being intentional. Usually, you know, someone's like ripping off your brand to copycat. But then, and then that may be the case of many times and it may be the case with the story you haven't yet told me, but then in many other situations, you know, someone can be in the shower, and they can think of a name, and it happens to be the same or similar to someone else. So, in many areas of the law, I would say most even, there's a requirement of intent. So, you intended to do this, even with copyright infringement, which we won't get too deep into. But that's like, you know, copying a photo or something that someone wrote, you know, that is more lengthy than just a trademark. There is, there, there's an intent requirement there that they intended, you know, they, they copied you, they had an opportunity to do it.

Kailey Jacomet 20:36

But with trademark law, you can, like I said, have dreamed it up in the shower. And if it's the same, it's all comes down to is a consumer likely to confuse these two names. Because really, trademark law is actually more concerned with protecting the consumer than even the trademark owner. It's about, it's about protecting consumers from being confused by two brands, where they intended to buy one thing and they got another thing. And of course, it's intended to protect rights owners too, but that's the standard of trademark infringement. So, that's one thing is that people may, you know, accidentally steal your business name, and they're not doing so with any malice. So, by registering your name, you put people on notice that this is your business name. And, you know, this is your trademark that's associated with these services or these goods. So that when someone else, you know, thinks up this name in the shower, and they go to do their due diligence, because they aren't a terrible person. And they really do, you know, want to find out what's out there, that you are searchable, you know.

Kailey Jacomet 21:42

And you should also when you're doing that, you should be consulting the search engines. Put it in there, put those different combinations in there. So, you can find the names that aren't registered as well. But if you know,

if they're doing a quick search on that government database, you will come up if you're registered. And so, you're going to protect against these disagreements with otherwise well-intentioned people. So, that's one thing. The other thing is, let's say, you know, whether someone is well-intentioned or they intentionally ripped off your name, they are using the same name, and you find out that someone else is using a similar name. So, you want to get them to stop doing that. And what you, the first step in doing that is to send a cease and desist letter. And like I mentioned previously, that means, you know, I have superior rights to this name, and I'm asking you, or demanding that you stop using it.

Kailey Jacomet 22:33

And a cease and desist letter can be worded friendly, or it can be worded harshly, but really, it's a legal threat letter. And the threat, you know, of the letter is that I am going to sue you if you don't stop using this name. And so, a threat doesn't have any power if it doesn't have teeth to it right. And so, your rights to a name are conferred by you using it in the marketplace first. But your trademark registration is a tool in your legal toolbox that enables you to be able to do something about it. Now, while you can still sue someone with only your common law rights, your hands are tied in many ways. It's much more difficult. And people know that. And they that's taken into consideration when they are weighing whether it's worth fighting you on this or whether it's worth complying with your request. So, I know this is a lot of information. So, I'll try to make it a little bit more concise.

Kailey Jacomet 23:32

But usually in most areas of the law, when you sue someone, you have the burden of proving your case. So, that's true in criminal law, the prosecutor has the burden of proving their case. And it's also true in civil law, that the plaintiff has the burden of proving their case. But when you have a federally registered trademark certificate, one of the huge benefits of that is that there's what's called burden shifting. So, the burden shifts over to the defendant, when you're able to produce that federal trademark certificate, that burden of proving that you shouldn't have been issued that certificate and actually you don't have superior rights, all of that shifts over to the defendant to defend themselves first, essentially. And that's a huge, huge, huge benefit in terms of you know, legal fees, effort, and also when the other person is calculating how to handle this situation. You know, when someone else has a federally registered trademark, that's very significant in you know, weighing these factors of is it going to be worthwhile going down this road, getting involved in expensive litigation, etc. So that's, that's another big thing. And I would say, you know, those are the, those are the main ones. So, it's about protecting yourself, also putting people on notice and really having this powerful legal tool in your toolbox when you discover infringers or potential infringers.

Jen Myers 25:00

Okay, got it. That makes so much sense, mostly because of the world that we're in, how important it is that we're protecting our name. One thing that I've heard, and I don't know, and I could be completely way off, do we lose our rights? So, let's say, okay, Homeschool CEO is now a registered trademark. And, but somebody else starts using the name next year, and I miss it somehow, because I'm busy doing something else. And they go on to use it for a year before I catch it. Can I still send a cease and desist letter a year into that and say, you have to stop using this? And are they required to comply? Or is there a period of time that I lose that right to exercise that?

Kailey Jacomet 25:37

Yeah, absolutely. And because especially, you know, you have a federally registered trademark now. Yeah, no, there's not a one-year period. And I mean, essentially, in this hypothetical, you know, we're assuming that you were using it before them. So, you're always, it's the date of first use. So, date of first use, and you're going to have, you know, a prior date of first use, and that's what's important. So there, there's not a one one-year timeframe there. No. And actually, Jen, I wanted to circle back to something that you mentioned. And we didn't, we didn't discuss it. And we don't need to discuss your situation specifically. But just generally speaking, if you are in the process of going through the trademark application process, and you see another name come up that you think is the same or similar. And you're wondering, "Should I send a cease and desist letter to them when I don't have my certificate yet?" It really depends. But I would say, and so this is not an answer that is going to fit everyone's circumstances. But generally, you know, you want to be a little weary of that, because at the end of the trademark application process, there's this period called the opposition period.

Kailey Jacomet 26:44

So, it's published for opposition. And that is after the government attorney has already gone through their own review. And they have decided that your trademark can be registered, that there are no conflicts. But then they publish it. They issue a notice of publication, where they basically give the world an opportunity to oppose your mark being registered. And it can be for a number of reasons that they think that, you know, the mark is inappropriate, like extremely inappropriate. But generally, it's because of this likelihood of confusion that they're saying that it's a conflict with one of their trademarks. So, while you can send a cease and desist letter to someone, while you're going through that trademark application, you also want to be very sure that you were using the mark before them. Because if they're not, if they don't have a registered mark, and they are not monitoring all of the notices of publication, then you're, kind of, you know, putting yourself on the radar. You're giving them a heads up, while they can still file that, you know, that petition to oppose your trademark, when if you wait it out a little bit, you know, then you'll have your certificate. You'll have stronger standing. They will have missed their opposition period. And it's just, you know, generally better all around. But again, that depends on the specific circumstances.

Jen Myers 28:09

I actually have a good friend of mine who - I don't want to go into the details of her situation. But a very, very large company and international company waited until the last 24 hours and then challenged her trademark, and then turned around and they won. And they ended up taking not just her name. They took her website. They took her everything. Everything she had built over the last year. Took it all. And it was a case where a big fish was just eating up a little fish. And it was a bully situation. It was, it was horrible. It was like the last 12 hours of the opposition. And then they walked in and scooped it up and said nope. How do you monitor for that?

Kailey Jacomet 28:47

So yeah, a couple of thoughts. And when you say monitor, do you mean avoiding the bully? Like avoiding the big fish? Or do you mean like, how do you track all of the names that are being published so you know when to oppose it?

Jen Myers 29:01

Yep, that one. So, like, for example, for me, I there's no way that I could sit around and watch every single day, who's publishing "homeschool" and who's publishing "CEO". Like to figure out, is there a conflict? Is there somebody publishing something that could be confusing?

Kailey Jacomet 29:15

Yeah, so that's a service that you can retain for me. I can do that for you, Jen. We won't talk about that right now. But um, basically, the software that I mentioned, that does the, the trademark searches, it can also monitor all those applications coming through. And so, it will monitor the same names in the similar, and similar ones. So, they, yeah, it gives us a heads up. And so, that's really the only way that anyone is aware of those. There are actually two ways that this comes up that someone files an opposition. First, they are monitoring all of the applications that are published for opposition, and that's why they're paying a fee for that. They're paying a fee, you know, annually probably for a law firm or another service to monitor all these applications. And when is - a one that is similar or identical comes up, an alert is sent to their lawyer, who will then look at it and see if it's worthwhile to oppose it or not.

Kailey Jacomet 30:09

The other way that this comes up is when someone finally gets around to wanting to apply for their own trademark, they do a trademark search. And they're like, oops, looks like there's a pending application on a really similar name. And, you know, either they could have been using it first or not, but if they, if the person thinks they were using the name first, and it's really by coincidence that, you know, during this, you know, as you know, it's like about seven months to a year that you could be going through this process. It was just by coincidence that they decided to file an application at that time, and then it gave them a heads up when they did the search. Because when you do a search, it will also show pending applications. And then actually, I lied, there's a third way that I see this come up. And that's when, and I think this is a miscalculation, when an applicant files or not file, sorry, when an applicant sends a cease and desist letter to someone, while they're still going through the process. And like I mentioned, just in that, you know, hypothetical we're discussing, now you're on their radar when they otherwise we're not paying for monitoring services with some, you know, software company. Oh, now you gave them a heads up, so now they can go ahead and oppose it.

Jen Myers 31:23

You just learn so much walking through this journey. Like I, after our last experience, that was you know, 10, 12 years ago, I remember saying to my husband, when it was all said and done, and we ended up shutting down the business after we changed the name. And we're just we were so disgusted. We're like, we're just, we're just done. I remember saying, "You know what. This is just preparing me for something bigger later. That I'll be wiser and older and more experienced. And I will know to immediately trademark whatever that name is." And so, when Homeschool CEO came to be, I immediately knew. And one of the things that we kind of glossed over that I just quickly - as we close down our conversation, I want to mention, there's two different trademarks that you can file. It's the first use and the intent to use. Correct?

Kailey Jacomet 32:11

Correct. So, essentially, it's all going to come down to the first to use. But yeah, one is use based means you're already using it in commerce, and one is an intent to use. And with the intent to use, it's still not going to be registered until you file proof that you are using it. So, you can't ever get a registration for something that you intend to use. But you can essentially, you can start the process earlier. And the, there are advantages to that. And then there are some extra filing fees as well. But yeah, so it's always, rights are always going to be based on the first to use. So, even if you get that intent to use application in, if someone else has a superior date, you're still going to deal with the problems, you know, that we've already discussed in this podcast episode.

Jen Myers 32:57

Yes. And that's one thing with Homeschool CEO. Like I remember, I just had to sell something. Sell something with the Homeschool CEO name on it. I don't care if it's \$1. Something to prove this is our receipt. This is the first day we actually used it in commerce. And I think a lot of people don't realize that. They think they just get a name. And then it's their name. And they were using it first. I'm like, actually, you have to prove that you made money with it. Right?

Kailey Jacomet 33:20

You have to be offering, offering a good or service in commerce, and you need to be able to prove that. So, I mean, prove that it's connected to a good or service. So, you don't actually need to show proof that you made money. But you do need to show proof that you're in, that you've brought it to market.

Jen Myers 33:37

Gotcha. All right. Is there anything - like, what is the one thing that you deal with all the time that you're like, "Man, I just wish people really got this. They understood this about trademark?"

Kailey Jacomet 33:47

Oh, well, I think that they think it's so easy. And I will say, you know, sometimes I wonder, did they need to make it so difficult? You know, it seems like such a simple thing, right? Like file a, file a registration for a name. You know, it seems like registering your LLC name with your state. You know, it seems like it should be simple. And obviously, I think, you know, if anyone has learned just one thing from this conversation, it's that it is not simple. And, you know, maybe ultimately, at the end of the day, it's all to protect, you know, the rights holder and US Trademark Law does a good job at that. I don't know, but I will admit that it really almost is more difficult than it should be. And there are all these pitfalls that you can fall in.

Kailey Jacomet 34:30

And so, I think that's the thing that frustrates me the most is people are like, you know, I'll see in Facebook groups. Oh, just file it yourself. And, and, you know, I just laugh to myself because, like you've mentioned in this conversation, you - it cost you \$40,000 to defend just a dispute, you know, just a dispute with one person. So yeah, it's not as easy as it seems, or maybe as it should be. And when people you know, some people will hire a lawyer to help them form an LLC. For example. And that's great. I think actually many people can form their own LLC. That actually is a simple process. And I don't know that it's intuitive. You know, I don't know that it's intuitive that forming an LLC is so much more simple than filing a trademark. But sometimes, you know, someone asked me, I'll say, you know, you probably don't need a lawyer for that. You might want one, you

might want that advice, but it is a very simple process to go on your Secretary of State's website, and you know, get that done within 15 to 20 minutes. Not so with a trademark.

Jen Myers 35:31

No, it's, it's complicated. I told somebody that, you know, because I thought, I actually, truth be told, just to be totally honest. I thought, "You know, what, I can file the trademark for Homeschool CEO." And then I started seeing all of these numbers and categories. And I know we even had to switch a category when we were going through the process. So, I don't remember. Something about a second tier, because it was an offer instead of a product?

Kailey Jacomet 35:54

We can talk about that as well. Yeah, so the supplemental register. So, that's it, really quick, another thing. So, there's a, there's the principal register and the supplemental register. And so, I mentioned that sometimes a trademark application can be refused, if it's merely descriptive. But if it's not merely descriptive, but it has, you know, it is somewhat descriptive, then it may not be entitled to registration on the principal register, but it's entitled to registration on the supplemental register, which they share most of the same benefits with just a few differences. So, it's kind of like the A list and the B list of trademarks. But you still have a federal trademark. No one else can use that name. No one else can register it. It's just that the main difference is when it comes to that burden shifting during litigation that we talked about, it doesn't have as strong of burden shifting. So.

Jen Myers 36:44

Awesome. Yes, I remember when you explained that to me, I was like, "What are you talking about?" And I remember thinking, I am so glad that I hired you. And I didn't try to do it myself. Because that would have come back. And I just know, I would have been like, "Okay, I give up. I quit. I can't do this. I don't know what to do." Last question. If you file a trademark yourself, let's say I did that. And it came back and I said, Forget it. And then the trademark application becomes dead, because I just let it go. And I don't follow up. Do I lose the rights to that? If I'm still using the name.

Kailey Jacomet 37:13

Well, I'm - you don't necessarily use - lose the common law rights to it, but you can't register it. So, you know, I've seen people say, you know, that they, I don't know, you know, it, just the situation that you just described that they had a refusal, and then they waited a year and they never did anything about it, and they're going to file for it again. And you can't do that. It is, it's a one-shot deal when it comes to trademarks. You do have an opportunity when you get your first letter, which is called an office action, that will list out any of the refusals that were issued to you, you have an opportunity to respond to that. But that's it, you don't, if it becomes dead, as you mentioned, you can't just go reapply for it.

Jen Myers 37:55

Alright, well that is good for everybody to know. So, if you need help filing a trademark, please Kailey tell them where they can connect with you online.

Kailey Jacomet 38:03

Oh, sure. Yeah. So, my website is the best place to find me, get more information, and book a complimentary consultation, if you're interested. And that's www.BrandLawBoutique.com.

Jen Myers 38:16

Perfect. And we'll make sure to link all of that up in the show notes as well. All right, thank you so much for being here today. I've learned a lot. I know our audience has learned a ton. You know, I know you said earlier that trademark law isn't sexy. But I'm here to tell our audience, it is. And it's important. And if you love your name, and you love your brand, this is a really important thing.

Kailey Jacomet 38:34

Well, thank you so much, Jen. It's been a pleasure talking to you tonight.

Jen Myers 38:38

I hope you learned a lot about trademark law today, why it's important, and how you can protect yourself because I don't want anybody to go through what I did. And I hope that you can celebrate with me today because you are part of the Homeschool CEO family. And us celebrating our registered trademark is a win for all of us. So, so, so excited that you're here with us for that.

Jen Myers 39:01

And one thing that Kailey forgot to mention on the podcast, but that we chatted about once we were done recording, was that social media giants like Facebook, Instagram, YouTube, you know, all of the places, will only take down another copycat page if you have a registered trademark, that you can prove your rights to the name. They won't take your word for it. They won't take evidence that you use it first. You actually have to have that registered trademark in order for any of the social media giants to take you seriously and protect your name on social media, which we all know is so, so, so important. All right. I highly recommend that if you are interested in trademarking your business or product name or anything with your business, reach out to Kailey and file your trademark today. I'll see you next week.

Jen Myers 39:57

Hey, friend, I just want to say thank you so much for tuning today. If you loved what you heard, please be sure to head over to Apple podcast and leave a review. I really appreciate it. And for more information on connecting with other homeschool CEOs just like you, be sure to check out our website at www.HomeschoolCEO.com. And as always Team Homeschool CEO, you ladies inspire me. Thank you for always showing others what is possible. You guys are awesome. See you next week.