

# TRADEMARK LIKE A BOSS

## TOOLS & RESOURCES

*Legal Disclaimer: These documents are a resource for educational and informational purposes, do not constitute legal advice, and should not replace hiring an attorney. These documents also do not create an attorney-client relationship between you and Radiance Harris or Radiance IP Law.*

## IMPORTANT TRADEMARK LINKS

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U.S. Patent and Trademark website: <https://www.uspto.gov/>

Search pending and registered marks: <http://tmsearch.uspto.gov/>

File applications and other documents online:  
<https://www.uspto.gov/trademarks-application-process/filing-online>

Check application status/view or download trademark records: <http://tsdr.uspto.gov/>

Check U.S. Trademark Trial and Appeal Board records:  
<http://ttabvue.uspto.gov/ttabvue/>

Check trademark fees: <https://www.uspto.gov/trademark/trademark-fee-information>

# TRADEMARK LIKE A BOSS WORKSHEET

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Use this worksheet to take notes and reference as your step-by-step guide during the U.S. trademark registration process.

## CHAPTER ONE – THE ANATOMY OF A FIREPROOF NAME

For trademark protection, your name must be distinctive. There is a spectrum of distinctiveness, which determines the degree of protection for a certain name. The distinctiveness spectrum includes (in order of most to least distinctive):

- 1) Fanciful names consist of invented or made-up words that do not exist in any dictionary and are inherently distinctive, making them excellent for trademark protection.
- 2) Arbitrary names consist of real words applied to unrelated goods or services and are registrable as trademarks.
- 3) Suggestive names suggest a quality or characteristic of the goods or services and are registrable as trademarks.
- 4) Descriptive names describe the product or service, use the owner's name, or indicate the geographic location of a product or service. These names aren't registrable as trademarks without a showing of acquired distinctiveness or secondary meaning.
- 5) Generic names are the actual name of the products or services and are not registrable as trademarks.

Where does your name fall on the distinctiveness spectrum?

If you have not chosen a name yet, do the 5-minute brain dump exercise to develop fireproof name ideas.

### NOTES

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## CHAPTER TWO – RESEARCH LIKE YOUR BUSINESS DEPENDS ON IT... BECAUSE IT DOES

- ❑ Identify your trademark(s)
- ❑ Identify your offerings (goods and services)
- ❑ Use the Trademark ID Manual to determine the trademark classes and appropriate descriptions of goods and services for your offerings.

Conduct the trademark search:

- ❑ USPTO Search
- ❑ Internet Search
- ❑ Domain Name Search
- ❑ Write down any red flags
- ❑ Review the trademark search results
- ❑ Determine whether your trademark is available for use and registration in the United States



## CHAPTER THREE - PREPARE THE APPLICATION

- ❑ Determine the type of mark you are filing for: (1) standard characters (word mark in block letters); or (2) special form (stylized and/or design mark)
- ❑ Determine your filing basis for the trademark application: (1) current use; or (2) intent to use

### FILING BASED ON CURRENT USE – Requirements:

- ❑ Trademark applicant/owner's name
- ❑ Mailing address and email address for correspondence
- ❑ For a special form filing, a clear image of the stylized or design mark and a written description of the mark
- ❑ A description of the goods and services
- ❑ The date of first use of the mark anywhere and the date of first use of the mark in interstate commerce in connection with the applied-for goods and services
- ❑ Evidence showing use of the mark in connection with the applied-for goods or services (also known as a specimen of use)
- ❑ USPTO filing fees (the fee is per application per class)

### FILING BASED ON INTENT TO USE – Requirements:

- ❑ Trademark applicant/owner's name
- ❑ Mailing address and email address for correspondence
- ❑ For a special form filing, a clear image of the stylized or design mark and a written description of the mark
- ❑ A description of the goods and services
- ❑ USPTO filing fees (the fee is per application per class)

### ACCEPTABLE TRADEMARK EVIDENCE

#### Goods

- A photograph of the product showing the mark directly on the product
- Product labels and tags showing the mark
- Product packaging showing the mark
- Signage used in a product display at a store
- A website screenshot showing or describing the product(s) near the mark and with purchasing information

- For downloadable software, copies of the instruction manual and screen printouts from (1) webpages showing the mark in connection with ordering or purchasing information or information sufficient to download the software, (2) the actual program that shows the mark in the title bar, or (3) launch screens that show the mark in an introductory message box that appears after opening the program.

Services

- Print or internet advertising
- Brochures and leaflets
- Menus for restaurants
- Business cards and letterhead
- Marketing and promotional materials
- Photograph of business signage or billboards
- Photograph of a musical band performing with the band’s name displayed during the performance
- A website screenshot showing or describing the service(s) near the mark

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## CHAPTER FOUR - FILE THE APPLICATION

1. Go to [teas.uspto.gov](https://teas.uspto.gov)
2. Click on the initial application forms and start your trademark application in TEAS PLUS
3. Follow the instructions on the online form
4. Complete and submit online form
5. Submit payment for filing fees
6. Receive confirmation from USPTO via email

### HOW TO HANDLE OFFICE ACTIONS

(Deadline to Respond: 3 Months)

For the procedural issues, you can probably address them on your own. If anything is unclear, pick up the phone and call your assigned examining attorney to gather more information about what you need to respond to the Office Action.

For more complex substantive refusals, however, you should absolutely consult with and hire an experienced trademark attorney (wink, wink - her name is Radiance) before responding. You should not try to respond to these refusals on your own.

### HOW TO HANDLE AN OPPOSITION

A trademark opposition is an administrative proceeding that challenges your ability to register a trademark. It does not, however, affect your ability to use a trademark. If your trademark application is opposed, this is another part of the application process where you should consult with and hire an experienced trademark attorney.

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## CHAPTER FIVE – YOU'RE A TRADEMARK BOSS

- Use the ® designation
- Calendar your post-registration maintenance filing deadlines
- Make proper and consistent trademark use
- Monitor for infringement
- Enforce your trademark rights against infringers

### NOTES

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**BONUS – FILING TRADEMARKS INTERNATIONALLY**

Trademark rights are jurisdictional. Some countries are first-to-use; other countries are first-to-file. There are two ways to file internationally: (1) Madrid Protocol; or (2) file directly in the countries of interest using local counsel. Contact an experienced trademark attorney for assistance with international filings.

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## TRADEMARK CEASE & DESIST LETTER TEMPLATE

Date

VIA EXPRESS MAIL/EMAIL

Infringer's Name  
Company Name (if applicable)  
Mailing Address  
City, State Zip Code  
Email Address

Re: Trademark Infringement of RADIANCE IP LAW

Dear First Name:

We own the RADIANCE IP LAW<sup>1</sup> trademark, including U.S. Trademark Registration No. 5260168 for the same. Since October 2015, we have used the RADIANCE IP LAW trademark in connection with legal services.

It has recently come to our attention that, despite our exclusive rights in the RADIANCE IP LAW mark, your business is using RADIENCE for legal consulting and training services. We believe your use infringes on our ownership of the RADIANCE IP LAW mark. As owner of the RADIANCE IP LAW mark, we have an obligation to prevent infringement. Because you are using the identical or similar mark on the identical or similar products and/or services, we believe your use of RADIENCE has caused confusion or is likely to cause customer confusion.

While the purpose of this letter is to open a dialogue between us, we are prepared to take any and all legal action necessary to protect our trademark rights. You have infringed on our registered trademark. You must immediately cease and desist any and all use of RADIENCE, including similar variations, and confirm that you have ceased all use and will not use RADIENCE, or anything similar, in the future by responding in writing to this letter by **deadline**.

If you have any questions about this letter, please contact me.

Sincerely,

[Signature]

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First Name and Last Name  
Title  
Company Name

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<sup>1</sup> Include your registered trademark here and throughout the letter. Also reference the other party's infringing trademark.

**INTELLECTUAL PROPERTY COMPARISON CHART**

Type	Trademark	Copyright	Patent	Trade Secret
Scope of Protection	A trademark protects your brand. It also identifies and distinguishes the source of the goods and services of one party from others.	A copyright protects original works of authorship.	A patent protects inventions.	A trade secret protects business information that has value in secrecy.
Examples	Business names  Product or service names  Slogans  Logos	Written materials  Music  Artwork  Videos  Books  Photographs  Software coding	Products  Processes	Recipes  Formulas  Compilations  Methods  Techniques  Processes
Method of Protection	Actual commercial use and federal registration with the U.S. Patent and Trademark Office	Automatically upon creation, but a federal registration from the U.S. Copyright Office is required to file a lawsuit	Federal registration with the U.S. Patent and Trademark Office	Secrecy and a nondisclosure and confidentiality agreement

## INTELLECTUAL PROPERTY (IP) AUDIT

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You're probably sitting on an IP goldmine, and you don't even realize it. There is so much money you're leaving on the table by *not* identifying and capitalizing on your IP. This audit is a roadmap to your hidden treasures. Let's get started!

### **Step 1: Identify Your IP**

Start digging through your business for all the intellectual property assets you have—both obvious and subtle. Compile a comprehensive list so that you know exactly what's there. Don't worry—you can determine its value at a later date.

Trademark - protects your brand (e.g., business name, product/service name(s), course name(s), book series name(s), podcast name, slogan, logo, app icon)

Identify your trademarks: \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

Copyright - protects your content (e.g., songs, artwork, designs, blog posts, courses, movies, photos, software coding, books, guides, manuals, recipes, worksheets, infographics, guides, templates, videos, training materials, presentations, strategy plans, frameworks)

Identify your copyrights: \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

Patent - protects your inventions (e.g., products, processes)

Identify your patents: \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

Trade Secret - protects your secret business information (e.g., recipes, formulas, compilations, methods, techniques, processes)

Identify your trade secrets: \_\_\_\_\_  
 \_\_\_\_\_  
 \_\_\_\_\_

## **Step 2: Prioritize Your IP**

You're going to prioritize your list of items from Step 1. Identify your top 5 assets that you can capitalize on quickly.

Consider these questions when evaluating:

- Which do you love and treasure the most?
- What jumps out as having the most profit potential?
- What jumps out as being the most marketable?
- What jumps out as something you've been asked for over and over again?

Consider potential joint venture, licensing, and/or strategic partnership opportunities. Think about providing an additional way for people to benefit from your knowledge at various price points. Developing your IP allows you to extend your reach to different segments of people who need your expertise but maybe can't afford to work with you one-on-one or people who want a technical or physical solution (like an app, journal, or course).

List Your Top Five Assets:

1. \_\_\_\_\_
2. \_\_\_\_\_
3. \_\_\_\_\_
4. \_\_\_\_\_
5. \_\_\_\_\_

## **Step 3: Protect Your IP**

You must protect your IP *before* you can monetize and profit from it.

BONUS:

Identify Your Biggest Liabilities (*check the box only if the answer is YES*)

- I have previously worked with or spoken to an attorney regarding my intellectual property.
- Before choosing a new company name, product/service name, slogan, and/or logo, I perform research and due diligence on the U.S. trademark databases and

search engines to ensure that I am not violating or infringing third-party trademark rights.

- Before using any third-party photographs or content, I first obtain permission from the owner.
- I have federally registered all trademarks with the U.S. Patent and Trademark Office.
- I have federally registered all valuable copyrights, such as music, books, poems, designs, etc. with the U.S. Copyright Office.
- I have federally registered all patents with the U.S. Patent and Trademark Office.
- I use trademarks and trademark designations (TM or ®) appropriately on all products and materials.
- I include copyright © notices on all company-owned content, including but not limited to websites, publications, artwork, software, etc.
- I have procedures in place to ensure that my company, including its employees and contractors, does not infringe on third-party intellectual property rights.
- I have procedures and agreements in place to protect company trade secrets.
- I have appropriate IP ownership, indemnification, and confidentiality language in all company contracts, and I have all employees, contractors, and consultants sign those contracts.
- I have thoroughly reviewed opportunities for licensing IP to third parties.

Each unchecked box is a business liability.

**Schedule a Brand Strategy Session at [www.radianceiplaw.com/bookonline](http://www.radianceiplaw.com/bookonline) to discuss your intellectual property needs.**

**Learn about our trademark services at [www.radianceiplaw.com/trademarks](http://www.radianceiplaw.com/trademarks).**