



**Trademarking
gone wrong
– don't do this!**

podcast episode 33 tip sheet

One of the most complicated areas of the law that impacts entrepreneurs, coaches and holistic professionals is Trademarking. It's such an important area that in this episode you're going to hear an impactful story of Trademarking Gone Wrong – and what can happen to even well-intentioned entrepreneurs if a Trademark Application doesn't have a thorough Trademark description.

Listen in, learn from this example, and use the lesson to protect your own unique brand.

Obtaining a Trademark is the crown jewel for a small business owner or entrepreneur.

Receiving a Trademark is a legal way to protect your brand recognition and to keep two unrelated brands from being confused by consumers in the marketplace. It's also designed to prevent other business owners from financially benefitting from your hard-earned brand identity and value.

What can you Trademark and why should you do it?

Simply put, Trademarks are used for words, phrases, symbols, designs, or graphics. They're used for shorter phrases or word combinations or for symbols or graphics like a logo. For information about WHAT types of items you can trademark, you'll want to have a listen to Episode 7 – What You Should Trademark.

The US Patent and Trademark Office (also called the USPTO), which is the government office which oversees the Trademarking process. A Trademark is granted under federal law to give you the exclusive right to use your words or logo in a particular Trademark class.



There are two steps to Trademarking:

1. The Trademark Search

2. The Trademark Application



To get details about each of these two steps, you'll want to listen to the easy legal tips that I share in Episode 25 – How to Trademark in 2 Steps: The Search & The Application.

When it comes to the Trademark Application, there two critical elements that can make or break the Application. There are other parts too, but:

The 2 key elements of the Trademark Application are:

1. The Trademark description which needs to be thorough and accurate and written in a way that prevents others with similar services from filing a similar Trademark.

2. The Trademark classes, of which there are 45, are the categories into which you want your Trademark to fall. Strategically determining which classes are appropriate for your Application is key.

As with the Trademark Search, preparing and filing the Trademark Application is a critical step where you'll want to get legal help.

Let's dive into a painful story of a Trademark experience gone wrong so you can see why getting legal help is so important right from the start—and, boy, did it go wrong!

Oprah, an entrepreneur, and a Trademark walk into a courtroom

Simone is a coach and owner of Own Your Power Communications, Inc. Back in 2007, Simone Trademarked the words "Own Your Power®" as a part of her business. It was a wise move by a smart entrepreneur to invest in her work and protect the heart of her brand.

Then along comes Oprah. Oprah puts the words "Own Your Power" smack on the October 2010 cover of Oprah magazine. It's not surprising that Simone believed that Oprah's use of the words violated her Trademark rights. After all, Oprah used the EXACT words that she had trademarked over three years prior to that.

Simone sues Oprah for violating her registered Trademark ... and Oprah wins.

Wait - WHAT?! How did that happen? I mean, we all know she's Oprah - and she's amazing! But seriously, how did she win?

There are three basic reasons why the judge ruled for Oprah and not for Simone (and I am generously summarizing here just for the interest of simplicity and time) :¹

Reason #1: The judge said that Simone's trademark description of "Own Your Power®" wasn't "distinctive" enough.

Basically, the description that Simone used in her Trademark Application wasn't written in a way that was descriptive enough to prevent someone else - like Oprah - from also using it in a similar field. The exact words you use in your Trademark Application are critically important. You want to be sure your choice of words are precise and descriptive. This is where the help of a lawyer comes in.

Reason #2: The judge said that Simone hadn't provided enough proof to show that "Own Your Power®" was widely recognizable as a part of her brand.

Again, I'm paraphrasing here, but the judge basically said that Simone had not included enough evidence of advertising, media coverage or other support showing that "Own Your Power®" was indispensable and recognizable as the basis of Simone's brand.

Reason #3: The judge ruled that there was no "likelihood of confusion" between the two brands.



¹ The original case was tried in federal district court in the state of New York as Kelly-Brown et al. v. Winfrey et al., US District Court (S.D. New York, No. 1:11-cv-07875. After a long legal process, in September 2016, the decision was upheld on appeal in favor of Oprah by the Second Circuit Court in Kelly-Brown et al. v. Winfrey et al., 2nd US Circuit Court of Appeals, No. 15-697.

In general, when you file a Trademark infringement case saying that someone is stepping on your Trademark, you're basically saying that someone violated your Trademark in a way that causes a "likelihood of confusion" between your brand and another, and that people will mix up your brands, which devalues your intellectual property. The judge ruled in this case that it wasn't super-likely that people would confuse Simone and her brand with Oprah and her brand.

That's why Oprah won.

But you know what's MOST interesting of all? The case was over the words "Own Your Power®." For certain, Simone sure owned her power when she stood up to Oprah. Not many people would have the courage or gumption to sue Oprah for a Trademark infringement. She was incredibly courageous as a business owner.

Simone endured four rounds of court battles to fight for her rights. Four rounds! Simone CERTAINLY owned every ounce of her power and I respect her strength to endure that kind of litigation and to take one of the most powerful business owners in the world.

Is it even worth it to Trademark?

The answer is a resounding YES. Despite the risks, like in the situation with Simone and Oprah, it's worth every dollar. Trademarks protect you immensely. Your brand has tremendous value. You want to protect your brand.

Trademark disputes depend on multiple factors, just like you saw here in this case. But they often hinge on Trademark Application descriptions – which is Reason #1 that the judge gave in Simone's case. So, if you remember NOTHING else about Trademarks, remember this:

Your Trademark description needs to be spot-on and really specific, or it may have holes that can be left open and challenged.

What you can learn from this example – this heartbreaking story for Simone - is that working with a lawyer on Trademarking is highly recommended. You want an experienced Trademark lawyer to help you. As I've mentioned, the Trademarking process looks easy and straightforward at first glance, but it can really be tricky, just like in Simone's case.

I align Trademarking with the crown chakra.



Trademarking is such a high-frequency legal protection that I align it with your **crown chakra** which correlates with your highest potential. Trademarks are one of the ways that you connect your brand to something bigger than you—the greater marketplace—and you create a legacy associated with your business.

What I love about helping dozens of my clients with Trademark Searches and Applications is that it helps them wear the crown as the king or queen of their business by owning the intellectual property rights to their tagline, their logo, their business or their program name.

You can protect your brand, safeguard your intellectual property, and create a business asset that you can actually sell with a federal Trademark.

Do you have questions about Trademarking or about the lessons learned from Simone's case? Please feel free to reach out to me and to my team at clientlove@lisafraley.com. We'd love to hear from you and we're happy to help you with your Trademarking questions.

Thanks for being part of the Legal Love tribe. Here's to getting legally enlightened!

With Legal Love,



Own Your Power® is a registered trademark of Simone Kelly-Brown.

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Lisa Fraley, JD, CHHC, AADP, is an acclaimed attorney, Legal Coach®, speaker and #1 Best Selling Author of "Easy Legal Steps...That are Also Good for Your Soul." With her unique blend of coaching, legal expertise, and spirituality, Lisa has supported thousands of heart-centered entrepreneurs and small business owners to protect themselves, their businesses and their brands through DIY legal templates, online legal courses and one-on-one services.

From sharing international stages with thought leaders like Kris Carr and Gabrielle Bernstein to being featured on hundreds of podcasts, webinars, radio shows and bonus calls, Lisa has made it her mission to help every single small business owner understand that the law can be accessible, empowering, loving, and even spiritual. When she's not saving the world (with Legal Love) one contract at a time, she's posting free legal tips and connecting with her tribe at lisafraley.com.