

AMAZON BRAND REGISTRY

Why We Are Advising Our Clients to Do It

TotalTSMM
Trademark**Services**
— FOR **AMAZON** SELLERS —

by


EmergeCounselSM
FOCUSED ON ENTREPRENEURS
AND EMERGING BUSINESSES

AMAZON BRAND REGISTRY 2.0
Why We Are Advising Our Clients Do It
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Amazon Brand Registry 2.0 Provides Free Sophisticated Brand Protection

Amazon just changed its brand registry to Amazon Brand Registry 2.0 (BR 2.0). 2.0 is a free and incredibly powerful brand protection platform, built and supported by Amazon, a \$450 billion-dollar company. Is it worth the hassle for Amazon seller to register their brands on this new platform?

From a brand protection perspective, we see huge value in the 2.0 platform. Here is why: Amazon allows 2.0 brand registrants exclusive access to their 2.0 software platform to report and police relevant trademark and copyright infringement. In 2.0, Amazon will even investigate and take action including taking down any infringing marks within four hours.

“Every experienced Amazon seller knows that Brand Registry is a must. Besides the protection against hijackers, BR gives you access to important Seller Central capabilities for managing your listing. Trademarking is now required for BR, but I was trademarking my brands even before that, for all the benefits trademarking brings.

-Bruce Levin, Experienced Amazon Seller and EmergeCounsel Client

We are not aware of a similar non-Amazon option for this type of protection. Traditionally, attorneys make a lot of money off brand policing because it is hugely resource intensive to research infringement, write cease and desist letters, and file actions in court to remedy the infringement.

“Brand Registry is a common best practice for selling on Amazon, that seller should take advantage of.”
Marshall Hayes, Amazon Seller Growth Specialist, CEO & Co-founder of Amplio Digital”

Why Amazon Is Requiring A Trademark For BR 2.0 (and Why Registration is a Good Idea Anyway)

The Amazon Brand Registry 2.0 Trademark Requirement

In exchange for the significant protection BR 2.0 affords, Amazon requires BR 2.0 registrants to obtain a federally registered trademark. A trademark is a symbol or word that represents a company or a product. Trademarks protect brands. Famous examples include Apple (for computers) and Google (for a search engine).

The reason for Amazon's trademark requirements is logical: if Amazon is going to step up to the plate and use its significant resources to protect a registrant's brand, Amazon needs to make sure the Registrant has exclusive rights to the brand.



Brand and Trademark Protection In Business and Law

Independent of the BR 2.0 trademark requirement, we believe federally registered trademarks are essential assets for business growth.

Trademarks Create Revenue Opportunities

When Amazon sellers build up their brand, they are able to create more products with less marketing headaches, price higher and create more organic demand. The most successful examples include Amazon who made \$144 Billion just on its brand alone in 2016; and NIKE who realizes most of its revenue on its brand (NIKE doesn't make its own products but instead licenses to manufacturers). We live in a world an almost infinite amount of goods and limited marketing budgets. Building and protecting a brand is the fastest way to accelerate revenue growth.



2) Acquirers Look For Trademark Protection

We can attest that any sophisticated acquirer assumes that the company it is buying has protected their brand through trademark. If not, the price offered usually goes down, sometimes substantially.



Trademark Protection Provides Significant Legal Benefits

There are protection benefits that only registered trademarks receive:

- 1) Federal recognition of ownership and rights on the mark,
- 2) Only registered marks can use the ® symbol benefits,
- 3) The ability to use the United States Patent and Trademark Office (USPTO) as a gateway to protect the mark in almost every foreign country,
- 4) Official notice to any potential infringers/inquirers that the mark is taken/owned, and
- 5) Greater ability to seek damages in US District Court

It is very difficult to build and protect your business without these legal protections.

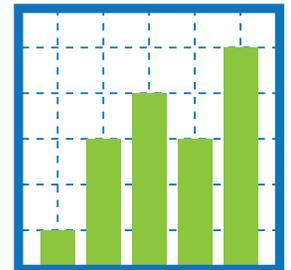
The USPTO Trademark Registry

The Application Requirements

Before the mark can be registered, on BR 2.0, Amazon requires an actual USPTO registration. The application and filing instructions are available at the USPTO TEAS website

(1) Trademark Process,” USPTO, <https://www.uspto.gov/trademarks-getting-started/trademark-process#step3> (Nov. 10, 2014).

Remember, you need to obtain the maximum amount of protection, avoid infringing on other marks, and pay the least possible amount of filing fees. Always make sure they are adhering to the numerous other filing requirements mandated by the USPTO. This is all doable; however, any rejection equals a time delay or bar for potential BR 2.0 registrants.



Why Do So Many Trademark Applications Get Rejected?

Trademark law is arcane and confusing. A perfectly filed trademark application takes 6-12 months to process, but only 20% of applications are perfectly filed on the first go around. It can take years to fix a faulty application, and sometimes a problematic application that is filed incorrectly can permanently bar the applicant.

Average Response Time: 9-12 months

Number of Pages in an Application: 50

Number of Categories to Choose From: 45

Applications Rejected on Their First Try: 80%

The Most Common Trademark Issues

The most common trademark issues included

- a. Likelihood of Confusion
- b. Mark is Descriptive or Generic
- c. Non-Substantive issues

Likelihood of Confusion

The most common stumbling block, is the “likelihood of confusion” rejection. The USPTO compares applications to the 250,000,000 trademarks to make sure there is no overlap, which would cause confusion to the consumer.

Descriptive or Generic Marks

Descriptive or generic marks are not considered by the USPTO to be distinctive enough to receive trademark protection. For example, “Folder Producers” may not be a good idea for a folder production company where an arbitrary name like ZIOCOS would be. Of course, ZIOCOS is going to be more difficult to initially market, but over time, creative non-descriptive brands create exponential value (APPLE, EXXON, LINKEDIN, AMAZON).



Non- Substantive Marks

There are over a hundred non-substantive issues the USPTO flags. Some examples are:

- Wrong image format,
- Image includes additional non-trademark items (background, styles, words),
- Brand name is too descriptive,
- Wrong category selected for product or services (there are 45 to choose from),
- Information is inconsistent, and
- Using personal name on applications or specimens.

In summary, an application is going to be reviewed by a USPTO examining attorney. If there are any factual or legal issues, the examining attorney is going to reject the application.

OBTAINING A TRADEMARK QUICKLY

BR 2.0 saves entrepreneurs time and money by providing a gold standard platform to protect registrants from brand piracy. One of the only requirements is registering the brand trademark with the USPTO. Here are three options to consider to file your trademark application:

DO IT YOURSELF

Filing your own trademark is doable. We provided instructions on how to do so (include section here). The USPTO Trademark office is very helpful and have a toll-free number to call for assistance [1-800-786-9199]. As a reminder 80% of applications are initially rejected for one reason or another.

“You can do it yourself but you may find out the hard way that you’ve wasted lots of time and money trying to trademark something that will fail. I highly recommend using an intellectual property attorney, like EmergeCounsel”

— Bruce Levin, Experienced Amazon Seller and EmergeCounsel Client

USE AN ONLINE REGISTRATION SERVICE

There are plenty of services like LegalZoom that help applicants register trademarks for a few hundred to one thousand dollars plus USPTO fees. These services do not usually provide: full attorney involvement, strategic advice, comprehensive trademark searches utilizing state of the art search data bases, opinion letters or help navigating the brand. These services usually collect and process the data provided by the applicant. Sometimes, this is all the potential BR 2.0 applicants need, but we usually see this approach cause more harm than good.

RETAIN A TRADEMARK ATTORNEY

Attorneys focused on trademark law generally study international, Federal court, Trademark Trial and Appeal Board precedent, and are well versed in the USPTO Trademark Manual of Examining Procedure. Ideally, they should have some branding background and be closely connected to the branding world. All trademark attorneys should be active members of the International Trademark Association. Finally, they should assure you that any strategic advice will only come from the trademark attorney and never from a paralegal or a filing clerk.

Our clients usually see the value in using experienced trademark counsel almost immediately.

Our clients like an all-inclusive flat fee package. EmergeCounsel provides an entire suite of trademark consultation, including:

EmergeCounsel's number-one mission is to offer you the maximum amount of trademark protection at a minimum cost. As a TotalTM client, you will benefit from comprehensive services usually provided to major corporations by the large (and very expensive) law firms. We are your partners in securing and protecting your trademark.

TOTALTM'S COMPLETE TRADEMARK PACKAGE

The TotalTM Complete Trademark Package has everything you'll need to plan for, register, and protect your trademark, including:

1. Strategic discussions about your branding and trademark needs.
2. A comprehensive trademark search using multiple sources.
3. Suggestions for proper trademark categorization to minimize cost and maximize your trademark's protection.
4. Phone or in-person consultations as needed.
5. USPTO trademark application preparation.
6. Responding to technical Office actions issued by the USPTO.
7. Filing all forms and paperwork throughout the process.
8. One year of defensive monitoring alerting you to any possible threats to your trademark.
9. Discounted rates for EmergeCounsel's other customized legal services.

The TotalTM Complete Trademark Package is available to EmergeCounsel clients at the low rate of \$850 plus the USPTO filing fee, which ranges from \$225 to \$325. There are discounts for multiple marks—contact us for pricing.

CONCLUSION

In summary, there are many perils in preparing a trademark application but it is doable. For a BR 2.0 applicant, our recommendation is to use a professional trademark attorney.

Contact us at 1-888-EMERGE0 or emergecounsel.com to learn more about Total™ and our other trademark services. Start protecting your intellectual property today!

ABOUT EMERGE COUNSEL

Emergence Counsel focuses on intellectual property (IP) protection and general counsel services for businesses across the U.S. The founder of Emergence Counsel, Steven Weigler, has over a decade of branding and marketing experience and is a specialist in all areas of trademark law. We are located in Denver, Colorado, and we are available to help you strategize your intellectual property protection and overall business needs. Give us a call or visit our website for more information.



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