



BUYNAK LAW FIRM

523 BRINKERHOFF AVE.
SANTA BARBARA, CA 93101

(805)963-1950

433 ALISAL RD.
SOLVANG, CA 93463

(805)688-8090

Intellectual Property

Intellectual property lies at the heart, at the core, of your business. Its protection allows you to function in an environment where your business' essential tools for success are protected. These "tools for success" are protected through registrations with governmental authorities. After registration, it is important to "police" your intellectual property (IP) to restrict others from using (or interfering) with it. In working with our business clients, the Buynak law Firm regularly registers IP and then protects it for your benefit. IP development agreements and licensing of IP is also part of our representations as many times for tax or profit motives, the use or co-use of a mark, patent, etc. are appropriate. For us, it's a joy for us to see our clients thrive through their initiative and diligence. If you put in the effort and are creative, you should be rewarded.

Intellectual Property. IP entails those essential elements of your business that are unique and allow it to function effectively. "Unique" means different from others and secret to your operation. IP generally includes

- Fictitious business names
- Trade dress
- Trade names
- Trademarks
- Trade secrets
- Service marks
- Domain names
- Copyrights
- Social media handles
- Email Address (that's protectable)
- Patents – Utility, Design, and Plant
- Business Process Patents

Sometimes, a single item has multiple types of intellectual property within it that can be protected. We'll leave you with the law school basic inquiry – how many types of intellectual property are protectable for a Coke bottle?



Costs may be prohibitive but all avenues should be considered. If you have a certain logo or shape within your trademark, which IP protection should you accomplish or should everything be blended together. How many categories for a trademark should you protect with your trade or service mark?

We look forward to assisting you through the process. Investigations and searches are performed; these give you a glimpse of what's available to be registered; what other registrations exist – you do not want to use someone's else's mark. You want to start out your business with your IP protection in place and not infringing on anyone else. It's really unfortunate if you have to change all of your marketing because you have a logo/mark that infringes on another mark.

Registration. The United States Patent and Trademark Office (USPTO) is the primary center for IP registrations, although individual states like California offer the same protections. It is best to do a federal registration as that covers the entire United States. A California trademark, for example, only gives you protection in California. There's no real benefit to a state registration & the cost for a federal trademark (about \$2000 after initial consultation fees) is comparable. You can visit the USPTO website and gain a lot of information.

There is a portal to check out other marks (trade or service). Usually, you start thinking of your name & think of 3 names, talk with your marketing consultant, and then check them against the USPTO site. We are happy to do the same thing for you. From that point, we work with you and have a worksheet to gain the necessary information for a registration. The application is filed and if it goes smoothly, about 9 months later, you will receive a registration. Along the way, we respond to “office actions” by the USPTO and outside third parties objecting to the mark. All of this is taken into consideration when picking a mark – will it go through the system smoothly.

Many times we are asked about trademark registrations in other countries. A USPTO registration does not protect you in China, France, etc. What's necessary is to do a Madrid Protocol registration. 90+ countries have signed up to this treaty so that there can be one registration and then you have a trademark in other countries. Now, this is expensive & you have to be selective in the countries in which you want registration. The greater the number of countries, the greater the cost; it is substantial.

The USPTO also covers copyrights and patents. There's a registration process for each. Copyrights are easy; patents are more intense with drawings and claims. A patent application requires the avoidance of claims that would interfere with other patent claims, so deep study and investigation is important before filing; drawings of each aspect are necessary. We have access to drafts-people at a reasonable cost and specialized patent attorneys. This is an expensive process involving a lengthy review.

As stated, you cannot afford to register every word, slogan, character names, or other source identifier associated with your business. Directing resources to trademarks and copyrights central to your brand as well as those that are the subject of elevated publicity even if not economically central, is a good starting point. From this perspective, a “key” asset may not only be a best-selling product but also a phrase, slogan, or even a hashtag that is associated with your brand. Businesses change, they move, their products change, and sometimes, it is only the trademark that is important. I had the occasion to sell a trademark of a local group of skateboarders to a major company, for which they gained \$1,000,000 per letter. Just their luck that they picked a great name & we trademarked it initially.



When To Register. The answer is as soon as possible. Do not start up your business, its marketing, its naming, its product naming, etc until your IP is clear. Most times you cannot wait 9 months on a name, patent, etc. to clear, so most people work with us to assess the risks and then decide on what will be registered. There are various approaches after the investigations come in. It is best to work with us a year in advance when you start developing a product and we then gain an “intent to use” registration. When the product or service is then put into use, the use is declared to the USPTO and it converts to a regular trademark. The actual use cannot be 5 years off, there is a limited amount of time within which the use has to be shown, with the use being in interstate commerce (i.e. your website).

We enjoy working with creative individuals and companies. Our clients should thrive from the inventiveness they have. We look forward to registering and protecting your intellectual property.

Best!

S. Timothy Buynak, Principal



BUYNAK LAW FIRM

805.963.1950

TBuynak@BuynakLaw.com

[Guide Posts](#) | [Website](#) | [Offices](#)

© 2021 Buynak Law Rev. March 11, 2021