

ENGLISH 101

By Jeff English

What's in a Name?

What's in a name? Actually, quite a bit. Especially if it's trademarked.

When I first joined the Kentucky Derby Festival as its General Counsel, I'd never done any work with intellectual property ("IP"). Most notably in the area of trademarks. Yeah, I may have glossed over a few pages in law school that referenced it; but nothing was tested on the bar exam, so anything related to IP was purged from my memory banks to make room for Torts, Contracts, Con Law, etc.. My field of practice after law school was mostly in criminal law. While I may have plenty of cocktail party stories about the amazing ways people get themselves in trouble, I gained no experience learning the true value of this symbol: ®. When I started this job, that all changed. IP is now a legal issue where I spend a great deal of my time.

Now, let's go over the basics.

A trademark is a distinctive sign or indicator used by individuals or businesses to identify products or services. Consider these marks:

Each of the marks above have the ® next to them. That symbol basically says to the world, "Hey, we own this, don't use it without our permission." In order for a mark to gain status as an official trademark, it must be registered with the US Patent and Trademark office (national) or with your local Secretary of State's office (state/regional). The application requires approximately 6 months of prior use. This prevents someone from thinking up a trademark, registering it and then never using it within the stream of commerce. You can't use ® until it has been approved by the trademark office. In order to maintain rights to a trademark, you must continue to use it. Three years of non-use usually constitutes abandonment.

So what's the practical application of this in the festival and event industry? THUNDER OVER LOUISVILLE® is one of the most valuable trademarks owned by the Kentucky Derby Festival. It's our largest event and there are plenty of businesses that want to be associated with it. Sometimes a business will take creative license with the mark and advertise their company as, "The place to watch Thunder

Over Louisville," or "Avoid the crowds, stay at our hotel after Thunder Over Louisville." In order to protect the sponsors who pay for the right to use our mark and to avoid diluting the mark's value, I write letters and follow up with phone calls asking that all non-approved use of the mark cease and desist. More often than not, the non-profits or business who are using the mark innocently believe they can do so. I help them understand that's not the case. Here's a copy of the letter I usually send:

This usually does the trick and the unauthorized use stops. If they ignore us, a nastier letter is sent threatening litigation and all that kind of fun stuff. KDF has never had a company not stop unauthorized use after they were notified of their infraction.

If you have a mark that you believe needs to be protected with official trademark status, I highly recommend engaging local counsel to determine whether Federal or State registration is appropriate. The attorney will also guide you through the process of properly filing the registration.

"Dear _____:

It has come to our attention during this year's Kentucky Derby Festival's Opening Ceremonies, your company placed advertisements which made reference to THUNDER OVER LOUISVILLE. Please be aware that THUNDER OVER LOUISVILLE is a proprietary trademark owned by the Festival. Your use of this term implies, incorrectly, that your company is somehow associated with or a sponsor of the Kentucky Derby Festival. There are many businesses in the community which do use our trademarks, under license from the Festival, precisely because they are sponsors of the Festival. As such, consumers are likely to be deceived by your use and falsely believe that you are indeed a sponsor.

We know that the Kentucky Derby Festival is an integral part of the community and can appreciate your desire to use our trademark in your advertising. However, we ask that you do not continue such use. If you would like to speak further about sponsoring the Festival so that you may use our mark, I would be happy to place you in contact with our Sponsorship Team."

Jeff English is the Sr. Vice President of Administration/General Counsel of the Kentucky Derby Festival. After graduating from Washburn University School of Law (Topeka, KS) in 2004, Jeff worked in politics and practiced law before joining the KDF staff. As General Counsel for KDF, he is charged with overseeing all of the Festival's legal issues, along with serving as its risk management officer.