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DON'T MESS WITH TESLA?

How My Crazy Trademark Strategy Revealed Tesla's Woke Lawyers.

I believe in covering your bases, and leaving yourself a backup. When filing a trademark application for my own business I've been known to file two in advance, and let the trademark examiners make my final choice. That's how I ended up with "Hybrid" as the brand that conveys my patent-pending InchMetric® hex wrench set with the combined and intermingled metric and fractional element – for when you don't know or care which format that fastener is – you just want the right size tool without wasting time. The alternative was "Integrated" (the opposite of segregated) but that trademark examiner put up too much resistance so I let that go. Hybrid it is.

"Bookshelf Brands"

A variation on this file-twice-to-get-one backup strategy is to file to register good brands you know you might want for future products. Come up with good ideas for products you have yet to develop. We file applications now, and get past the examination, get an approval, and even get past the period in which other trademark owners can oppose the registration. We then only need to file proof of use. There are six months to do that with extensions up to three years. I think of this as "idling at the finish line." Just blip the throttle and you win, because you got started so early.

The only downside to this is that it cuts against my advice to tailor your brand to the exact benefits of the product, which you probably don't know before you created it. But in many cases you can find good solid brands, perhaps as part of a coherent family of product brands. Your brand family might pre-apply for popular songbird species, or XQ-1, XQ-2, XQ-3, etc. Don't get your hopes up expecting to find available trademarks for guns in the categories of snakes, birds of prey, historic warships, and other strong but obvious choices.

The big benefit is that you know you have a registrable brand, even before you release the product or start producing packaging. Even if our legal predictions of trademarks being registrable are good, there's always the risk of an unexpected rejection. A bird in the hand reduces the risks to near zero.

Which leads me to my own "bookshelf brand" project. You see, I'm an inventor with a few side hustles, including in our industry. I've mentioned them now and then. So, like you, I'm one of those guys who knows he might need a good brand sometime soon. And in my years of trademark searching I've developed some good instincts about what kids of brands might be available, and what might not. The hot ones (Stealth, Viper, Terminator, Eagle) I assume are unavailable – and may be client brands I know about. Our searches will usually confirm my assumptions. But now and then I'll be surprised that something good is available. Like my client Trailblazer™ Firearms. Great brand (to go with great products), surprisingly not taken in the industry.

Over the years I started noticing these. Then I started a list of "strong" brands for firearms products that I didn't already associate with firearms. Then I did some searching and found as expected most were unavailable. BUT… Some were surprisingly available. So I looked at my own side business needs, and started filing applications (Intent-to-Use) for these. Based on my actual intention to adopt the registrable ones eventually for firearms-related products (or to apply to an existing product to brand a feature or benefit) I filed a bunch of these.

Some were rejected, and some were not. Which helped me to fill my bookshelf with good brands. This is verified when I sometimes see companies adopt a related trademark that I already have approved. An Intent-to-Use application is treated like nationwide first use at time of filing. I can ask the newcomer to drop their plans, or I can offer to change my plans and yield the rights to them as a fair price. If it's a client I'll bend over backwards to make it a "good news" opportunity to reduce costs and risk.

Below is a list of registered, or allowed, or pending trademarks on my bookshelf, and if any reader wanted one, I'd probably let it go for a good price. While my legal intention wasn't to reserve these for your benefit, that can turn out to be a side benefit if you need a strong trademark now without the risk of rejection.

CONSTITUTION	**LIBERATOR**	**BOXER**	**WILDCARD**	**JUPITER**
MERCURY	**VICTORIA**	**HURRICANE**	**GIBRALTAR**	**EVEREST**
CONCORD	**COLUMBIA**	**ANTHEM**	**CAPTAIN**	**ENSIGN**
ADMIRAL	**VETERAN**	**JACKPOT**	**BONANZA**	**DESTROYER**
MARATHON	**PALISADE**	**COLOSSUS**	**CORPORAL**	**NIFTY**
CORONA	**SPRINT**	**CUTLASS**	**BACKLASH**	**DYNAMO**

TRIPOLI **JUNO** **YORKTOWN** **CARDINAL** **PACIFIC**

CONTINENTAL **ENDURANCE** **NAVIGATOR** **ELECTRA**

The Tesla Tale

On my list was TESLA. One of my personal favorite brands outside of our industry. But when I found that there were other companies with prior rights to that brand for unrelated goods, I concluded that this was not a "famous" trademark (like Rolex and Coca-Cola) that gives rights against others from using it even for *UNrelated* goods. So knowing I might get a letter or an objection, I added that to one of my lists, because it could nicely convey modern electronic technology for electronic firearm ignition, or any of a range of electronic features on firearms goods.

The trademark examiner agreed with me. Tesla Inc. does not have the right to their brand on unrelated goods. So the application was approved and published for opposition. Now, you can guess what happened next. Letter from Tesla.

Actually, letter from law firm. And it was interesting. Big DC firm with 685 attorneys on the roster. The letter had this key paragraph:

> *Due to Tesla's widespread use, **advertising**, and extensive marketing, the Tesla IP has become well-known and consumers recognize the Tesla IP as distinctive symbols of Tesla's goodwill.*
>
> *Tesla is very concerned by Applicant's intended use and attempted registration of the Applicant's Mark. **These concerns are heightened** given the Applicant's Mark is identical to Tesla's TESLA Marks and **given the polarizing nature of Applicant's applied-for goods** [firearms]. Due to the close similarities between the parties' marks, consumers are likely to be confused falsely that Applicant's offerings are Tesla products or are sponsored by, related to, or affiliated with Tesla, when such is not the case. Our client is also concerned that the Applicant's intended use and attempted registration of the Applicant's Mark in connection with the applied-for goods is likely to dilute the distinctive qualities of the Tesla IP and is likely to **tarnish** Tesla's brand.*

It turns out that the lawyer who sent the email had "She/They" in her signature, so she must have had to bite

her virtue-signaling lip at Elon Musk's comments a few weeks ago.

But what stuck in my craw is that these lawyers apparently considered that firearms-related goods serve to heighten concerns about harm. "Polarizing?" Have they never talked to a rural gun-guy who hauls a trailer on the subject of whether Tesla's (awesome IMHO) vehicles are polarizing? Guns would tarnish the brand? Legally, these areas are entirely irrelevant, and simply suggest a big law firm letting a woke young fry write a letter without much supervision (not unusual). It doesn't matter whether the goods are rosary beads or sex toys, whether they cast good repute or ill repute. It only matters whether there is a likelihood of confusion because the goods are related.

Unless the mark is "famous" and applies to unrelated goods – like you'd understand why a "Rolex Muffler Shop" might actually tarnish the watchmaker's brand, even if no one were confused. But they never alleged that, because they knew as I did when I first researched it that they can't. So here's what I write back to the woke lawyers of my favorite automaker:

> *We question the appropriateness of your objections for several reasons:*
>
> 1. *Our client's firearms and other goods are unrelated to your clients' automotive goods, and your letter notably does not allege any relatedness of the goods. This means that worries about likelihood of confusion are unfounded.*
> 2. *Your client's asserted trademark does not meet the threshold of famousness needed to support your assertion of dilution. We see scores of TESLA trademarks by others that coexist with your client's in the marketplace and on the trademark register, including some registrations that predate your client's own priority. Trademark examiners are repeatedly granting registrations for unrelated goods under the same brand. Many or most of these are for goods (e.g. motors, magnets, electronics) that would seem to be more closely related to electric vehicles than are firearms.*
> 3. *"Tesla does not advertise* (https://urldefense.proofpoint.com/v2/url?u=https-3A__urldefense.com_v3_-5F-5Fhttps-3A__twitter.com_elonmusk_status_1129924410339495937-5F-5F-3B-21-21K7bXOScpug-

21hppvfQgZIJX97jqATl-2DFFTb0bAPRMaRcgoeHhXNNQGQ0jPZ0wvrXlLXZa9JRm2qfT10vfHqPTtV5IQRhoU3H7Q-24&d=DwMF-g&c=euGZstcaTDllvimEN8b7jXrwqOf-v5A_CdpgnVfiiMM&r=E4NWgAyAaxkFi1TqaVFrwZk8uaLsjnqMKX8tKB2O9ac&m=080XyEmsx6V-7cUI-Bv7J-j8Gu5tyrhsO8Vhy8uB9xk&s=r98ThsThcGbdvVHKJor9kHQVmBVjOI9xgvsnbuR_bhA&e=) *" – Elon Musk. Your letter seems to overstate the facts that might support an assertion of dilution.*

Your "heightened concerns" over the "polarizing nature" and "tarnishing" effect of firearms and suggest an underlying political position that would be deeply objectionable to perhaps half the nation. Alienating a broad swath of potential consumers who have a positive view of lawfully-sold firearms might be harmful to your client's mission to accelerate the world's transition to sustainable energy. Therefore, before you press this matter we encourage you first to verify whether this apparent political stand is in fact the position of your client's management and ownership.

Now, secretly I hoped they'd press, and I'd offer to settle the matter with a note from Elon saying "Thanks, Ben, for helping to support our mission. If your kids ever want to be considered for an internship at any of my companies, just have them show this letter." But alas, they surrendered instead, with what is a common sight when a weak case is called out. They take a stern position but don't dispute any of the legal matters.

As an initial matter, Tesla does not take any particular political stance with respect to Class 13 [firearm] goods and respects the choices of its consumers. Any assertion to the contrary is ill-conceived.

Reverting to the heart of this matter, and as previously stated, Tesla's intellectual property is one of our client's most valuable assets and Tesla takes steps to vigorously protect the same from misuse by third-parties. As Tesla has clearly communicated its concerns to you, our client believes that your client has sufficient information to refrain from any infringing use and expects that your client will make efforts to cease any ongoing or intended infringing uses of Tesla's intellectual property, including without limitation any uses which create an affiliation with Tesla or put Tesla in a bad light.

We trust this correspondence adequately places your client on notice of Tesla's rights and expectations. That said, we note that Tesla will be monitoring your client's activities and expressly retains the right to protect its valuable intellectual property as necessary and in its sole discretion. This correspondence in no way limits the rights and remedies available to Tesla, all of which are hereby expressly reserved.

So, they'll be watching me.

By Ben Langlotz | May 5, 2023 | Business (https://gunpatent.com/category/business/), Intellectual Property Advice (https://gunpatent.com/category/intellectual-property-advice/), Trademark (https://gunpatent.com/category/trademark/) | *0 Comments*

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