

# Brand Protection Strategies



April 4, 2019

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## Agenda

- Introductions
- What Is a Brand?
- Preparing to Protect the Brand
- Strategies to Protect the Brand
- Implementing Protections for the Brand
- Q&A

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- Introductions
- What Is a Brand?
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## What Is a Brand?

To *protect* anything you must understand it.

- So let's understand a "brand"... Sounds simple enough
  - But is it...?
- The definition will provide the framework for what we are protecting in the first place.
- Of course the ultimate goal is protect a particular brand
  - Not all brands, just *your/my/our* brand

## What Is a Brand?

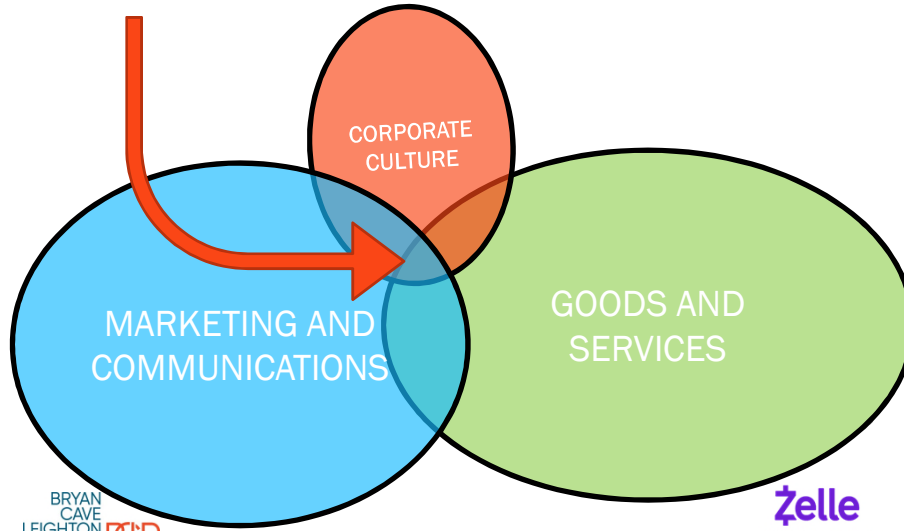
- A “Brand” in general – the good and the bad
  - Is a subjective impression that lives in the mind of consumers
  - Is *portrayed, communicated, and established* by the goods and services originating from a source (“Providers”) , **but...**
  - Is **actually created**, often unknowingly, in the mind of consumers who:
    - see the portrayals,
    - hear the communications, and
    - receive goods and services from the Providers. (arguably most important)
- THE BRAND IS IN THE EYE OF THE BEHOLDER

## “My” Brand

- To a **Brand Owner** the **Brand Identity** is:
  - a promise to a Consumer
    - the insurance policy for when that promise is broken.
  - something protected over time through differentiation and consistent use by the Brand Owner.
  - the first chance at getting a consumer to identify and chose the Brand’s service/product over others.
  - The physical and mental availability of the Consumer while shopping –

Branding is the experience made to win a piece of the Consumer’s limited mental availability – Zero Sum Game if you will

## What You Think Your Brand is...



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## “Their” Brand

- To a **Consumer**, the **Brand** is:
  - an identifier and source of loyalty.
  - the indicator of a strong bond the supersedes the customer merchant relationship.
  - the differentiator of one Source of goods and services from others.
  - the first impression of the quality or desirability of a product or service.
  - fairly static and requires great interaction and contemplation to build and/or change
  - a shortcut to predicting how an offered good or service will perform.

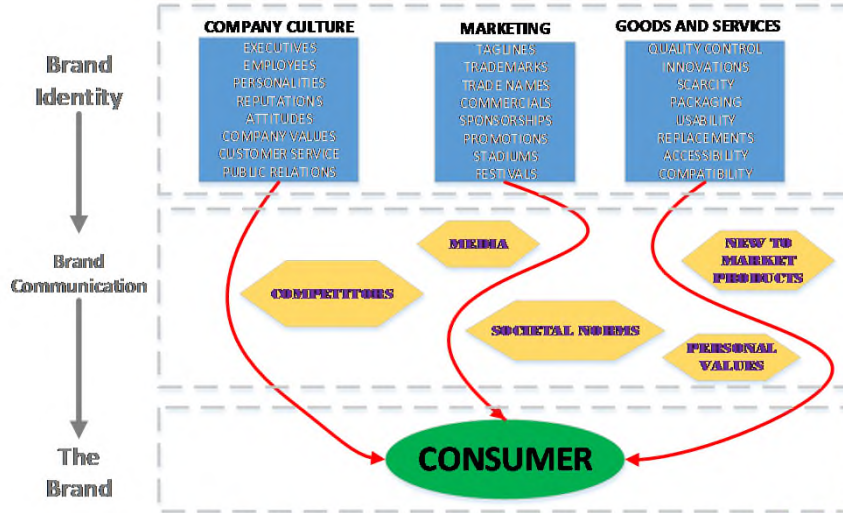
WHERE A SATISFIED CUSTOMER MAY LEAVE, A LOYAL CUSTOMER WILL  
STAY AND REMAIN INTO THE FUTURE

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# What Your Brand Really is...



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## Brand $\neq$ Trademark

- While a trademark is not a brand, it can represent one
- A trademark creates efficacy for Providers to identify a Brand
- A trademark tells a consumer the source of a good or service
- If you learn nothing else, learn this:

or more specific to our purpose

TRADEMARKS EXIST TO PROVIDE CONSUMERS A "SHORT CUT" FOR LINKING A BRAND TO A PROVIDER OF GOODS AND SERVICES

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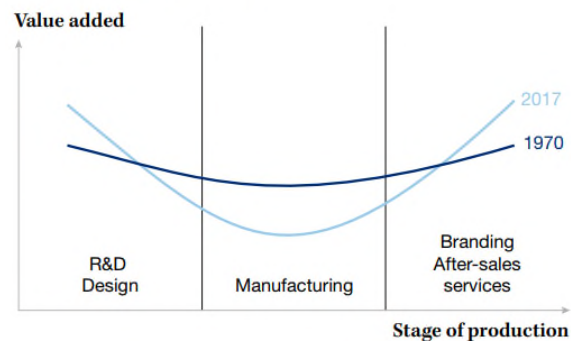
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## Why Protect the Brand at All?

### Production in the 21<sup>st</sup> century – a growing smile



## Country of Brands



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## Preparing to Protect

- The life a Brand begins before any product or service is provided.
  - AND SO SHOULD THE PROTECTION
- To Protect a Brand is to Protect the Consumer...
- Brand protection *must* include: (normally from in-house)
  - TRAINING EMPLOYEES
  - RESEARCHING THE MARKET AND COMMERCE CHANNELS
  - PRIORITIZING MARKS TO BEST PROTECT THE BRAND

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## Preparing to Protect – “Best Practice”

Note: In reality in-house counsel may not be at the front line when it comes to releasing new Brand planning

- **Nevertheless a Brand will need protection**

Best Practice: (the easy way, the fairy tale way, the Disney® way [literally?])

- Trademarks – have a supply of allowed 1(b) trademark applications to chose a Brand identifier.
- Agreed upon and strategic name, logo, tagline, look and feel (Brand Identity).
- Trade Dress vs Design Patent protection decided.

## Preparing to Protect – “Best Practice”

- Best Practice: (*Let's keep this fantasy going*)
  - Clearance on the name is completed and the name is clear
  - Domain Names have been registered
  - Social Media handles secured
  - Whether licensing will take place has been addressed
  - Marketing portal w/ pre-designed material available for public
  - Will brand be a conglomerate or become a standard

## Prioritizing to Protect – REAL Practice

**NEVERMIND ALL  
THAT NOW..**

**IT'S OKAY TO LAUGH AT  
THE "BEST PRACTICES"  
SLIDES... IT CAN BE FUN TO  
DREAM...**

## Prioritize to Protect – REAL Practice

**WE INTERRUPT YOUR FANTASY TO BRING YOU THIS  
FROM REALITY**

WHISPERS -> "Best Practice" may as well be a law school course  
Oh wait, it is!!!

TRUTH- There are constraints on our abilities such as time and space.

- Best Practice is the practice of PRIORITIZING.
  - Choice of mark is top priority
  - Counsel is needed to understand:
    - How the trademark will be used proper trademark use
    - Always get multiple name options from marketing (6 is good number)
    - Run searches, clearance, and register as quickly as good judgement allows

## Prioritize to Protect – REAL Practice

- BACK TO REALITY

Best Practice is the practice of *prioritizing*.

- Next priority is channels.... All of them: INTERNAL AND EXTERNAL
  - Channels/mediums of commerce for Branded good/service
    - Internet, geographic regions, store shelves, third parties, subscriptions, etc.
  - Channel of communication w/ consumers
  - Channels of inter-company communication
    - Marketing
    - Product teams
    - Communications

## Prioritize to Protect – REAL Practice

TRUTH - Best Practice is the practice of *prioritizing*.

- Overall Brand Protection Strategy
  - After the bare necessities of communication and identification take a step back and get organized
  - Decide on
    - House Marks being used or Sub-Marks
    - Jurisdictions to file in outside home country
    - Tagline protection
    - Domains, domains, domains, domains - MUST HAVE A STRATEGY
    - Copyright Registrations

**BRING IT ALL TOGETHER**

## Training to Protect – At Least 2

- There should be two mandatory trainings for any major Brand

### New Employee Training

- Introduce the Brand(s), their value, and the protections used.
- Give basic Branding Guidelines and summarize why.
  - Company Values, Trademark Law, Marketing Strategy
- The Brand is sacred.
- Last but not least: the golden rule of branding.
  - TREAT OTHER'S BRANDS AS YOU WOULD WANT YOURS TREATED

## Training to Protect - At Least 2

- There should be two mandatory trainings for any major Brand

### Heavy Training as these are the vessels through which consumers will receive the Brand Identity

- Strict guidelines on trademark usage
- Trademark clearance and the process of registration
- Trademarks are to protect consumers and the brand they maintain
- Licensing of Marks, Quality control, Approved Public facing materials
- Exceptions are a dangerous path. Stick to the Guidelines
- CULTURE OF CONFIDENTIALITY

## Research to Protect

Knowledge is your best friend for *Prioritizing*, so research

- **EXTERNAL RESEARCH**
  - The product/service tied to the Brand
  - Sales geography
  - Top Level Domains
  - Competing Brands
    - Copying is the most flattering... whatever. Take ideas where you can get them.
  - Technology, patents, innovation maps, current patent litigation.

## Research to Protect

Knowledge is your best friend for *Prioritizing*, so research

- **INTERNAL RESEARCH** is just as important if not more so.
  - Understand the overall scheme from all departments to the best of your abilities.
  - Become a liaison between technology, sales, marketing, communications, executives, and accounting.
  - Have representation in as many meetings as possible.

**\*\*THIS IS WHERE YOUR TRAINING PAYS OFF. COWORKERS CAN'T CALL UPON YOU IF THEY DON'T KNOW WHEN OR HOW.\*\***

## Preparing to Protect

- Brand vs. Trademark
- Trademark
  - Anything that (1) identifies a source of products or services and (2) distinguishes the source from another source
  - Does not identify a product or service
  - Does not protect a business itself
  - Does not protect against all uses of the trademark

## Preparing to Protect

- Examples of trademarks
  - Words
  - Tag lines
  - Logos / designs
  - Colors
  - Sounds
  - Smells

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## Strategies to Protect

BEFORE WE GET STARTED:  
NEVER FORGET, AND DO NOT LET OTHERS  
THAT YOU COUNSEL FORGET:

TO PROTECT YOUR BRAND IS  
TO PROTECT YOUR CONSUMERS...  
**ALWAYS**

## Strategies to Protect

- Referencing the *Prioritizing* section:
  - Corporate/**Primary Brand** Identity = House Mark/**Primary Mark**
    - Not necessary, different than a corporate/legal name
    - Most important in some cases
    - May be somewhere inbetween
  - Product/**Secondary Brand** Identity = Sub Brand/**Secondary Mark**
    - May be more important than the Parent

## Strategies to Protect - BRANDS

- Referencing the *Primary versus Secondary Brands*:
  - **Maximum Protection**
    - Every channel addressed
    - Every Protection Mechanism Used
    - Every Jurisdiction Goods and Services are Offered.
  - **Secondary Protection**
    - Most popular Channels
    - Strongest Mechanisms – lockups with Primary Brand Identifiers
    - Incorporated, Manufacturing, some sales areas



## Strategies to Protect - MARKS

- Primary Mark
  - Branding Guidelines
    - Created Clear and Enforced internally and externally
    - **LET THE LEGAL REQUIREMENTS OF UNFAIR COMPETITION LAW BE THE BASELINE**
    - MARKETING AND PRODUCT GROUPS CAN START WITH THAT AS A MINIMUM
  - Any License granted to use a Primary Mark is a lending of your Primary Brand and *consumer protection* must be accounted for... ALWAYS.
    - *must* include adherence to the Branding Guidelines
    - *must* include quality controls and oversight – review of any public facing collateral
    - *must* have consideration/value in return – don't allow use for free
- Secondary Mark

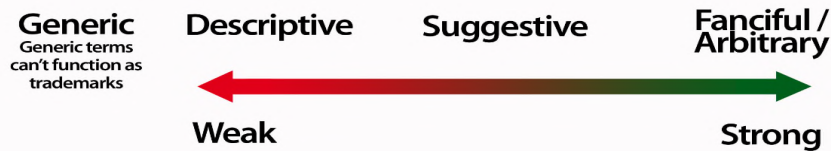
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## Implementing Protections

- Trademark
  - Anything that (1) identifies a source of products or services and (2) distinguishes the source from another source

### The Trademark Spectrum



## Implementing Protections

- Trademark
  - Anything that (1) identifies a source of products or services and (2) distinguishes the source from another source
- Avoid
  - Confusion with a 3<sup>rd</sup> party trademark
  - Dilution of a 3<sup>rd</sup> party trademark
  - Suggestion of a false affiliation with a 3<sup>rd</sup> party
- Trademark searches

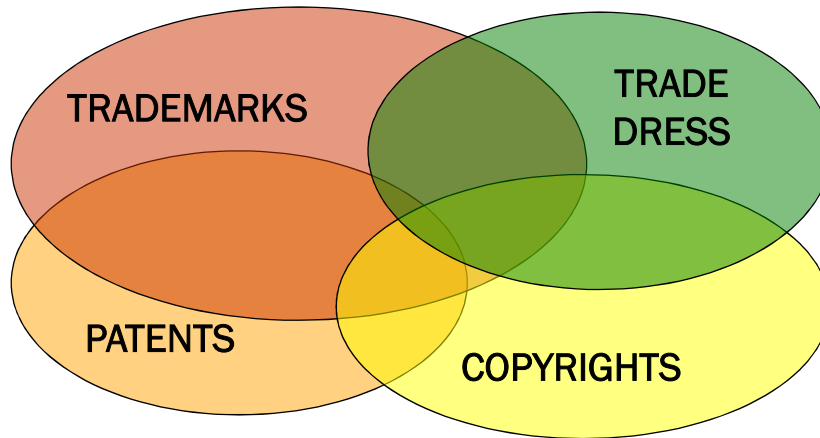
## Implementing Protections

- Federal trademark registrations
  - 15 U.S.C. § 1051 et. seq.
- State trademark registrations
  - A.R.S. § 44-1441 et. seq.
- Foreign trademark registrations
- Trademark classifications
- Trademark families

## Implementing Protections

- Design patents
  - Protects ornamental appearance of a product
  - 35 U.S.C. § 171 et. seq.
- Copyrights
  - Protects an original work of authorship
  - 15 U.S.C. § 101 et. seq.
- Trade dress
  - Protects the “look and feel”
  - *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

## Implementing Protections



## Implementing Protections

- Domain name registrations
  - New top level domains
    - BannerHealth.info
    - ASM.biz
    - ASU.university
  - Typosquatting
    - BestWestrn.hotels
    - Carvanna.cars
  - Country codes
  - XYZsucks.com

## Implementing Protections

- Social media



## Implementing Protections

- Policing
  - Watch notices
  - Online search engine key words
- Licensing
  - Brand guidelines
  - Naked licensing
- Enforcing
  - Trademark oppositions
  - UDRP (Uniform Domain-Name Dispute-Resolution Policy)
  - U.S. Customs registrations
  - Litigation

## Implementing Protections

- Minimum advertised prices (MAP)
- Authorized dealer programs

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## Questions?

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