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DEVELOPMENT OF A TRADEMARK PROGRAM: A TRUE STORY

If you don't know where you are going, you might wind up someplace else.
Yogi Berra

I have to share a recent experience with you, as it is pertinent to the central focus of this trade journal – the development of trademark programs for newly created brands and properties. As these events did happen, as they use to say on *Dragnet*, "the names have been changed to protect the innocent."

Not long ago my licensing agency commenced the licensing representation of a highly accomplished design firm, which I will dub the Design Group Inc., or simply DGI. Best known for their design work in configuring public spaces to be both functional and artistically pleasing, this highly disciplined design group had some interest in taking a stab at the creation of some brand concepts directed to the consumer market. They understood that to break through the clutter of existing available brand programs, what they needed to create were properties that would integrate unique creative elements with consumer appeal. The company has succeeded in meeting this objective with two concepts. The why and how relating to the creative elements of these brand concepts really do not matter here. The purpose of this article is to recount the problems the company had in establishing trademark programs for these two separate brands.

About two years ago I met one of the principles of DGI on an international flight. It just so happened that we shared the same flights in both directions. On the return leg we struck up a conversation during which I learned of the company's desire to dabble in the brand building business a departure from their bread and butter occupation of designing public spaces, albeit designs that were both practicable and inviting. A subsequent meeting was held months later, at which time it was agreed that once they had more fully flushed out their brand concepts they would contact our company about discussing licensing representation. In the intervening time between our meetings, DGI set upon the task of developing two brand concepts, which I will simply refer to as brand "A" and brand "B."

The principles at DGI were Neophytes in matters concerning the fabrication of trademark programs. Recognizing the need to acquire some sort of legal protection for their creations, the company relied on a consulting working with the company on various business affairs. The consultant introduced DGI to a trademark lawyer we will name Larry. Now you have the background, and now for the meat of the story.

Of the two brands that DGI developed, brand A is a lifestyle concept, as it is based on an actual location used within the brand's name and as the basis for the visual language of the brand's designs. The strength of brand A is derived from its ability to evoke images of an inviting local representative of a casual layback environment – a place most any consumer would happily escaping to if given the opportunity. The core graphics of brand A are drawn from actual images or objects associated with this geographical location.

Brand B is altogether different. This brand is a creative take on well-established images and iconography associated with a popular and common activity that most every consumer (perhaps not those occupying the bottom rungs of the socioeconomic ladder) partakes of. The appeal of this property, which is targeted more to adults rather than kids, stems from the unique interpretation of the core graphics associated with the activity in question.

Both properties are applicable to a reasonably wide range of merchandise from various product categories. However, like most properties, there are several key product groups that are the most logical to initially file in for trademark protection. Well, this didn't seem to be course of action taken. Before I re-appeared on the scene a trademark program initiated by the combined efforts of the previously mentioned consultant and Larry the lawyer, which in my humble non-legal opinion, was dumb boarding on imbecilic; not to mention a total waste of the client's money and valuable time.

Although requested, thankfully no trademarks were as yet been filed for brand A. Regarding brand B, for reasons I totally fail to understand, Larry had filed (domestically) in the following eight (8) categories:

- 16 / Paper
- 24 / Fabrics
- 25 / Apparel
- 28 / Games
- 35 / Advertising & Business services
- 39 / Transportation & Storage services
- 42 / Computer, Scientific & Legal Services
- 45 / Personal Services

Upon seeing the list, my first reaction was to question why anyone would commence a trademark program by filing applications in service categories when the initial efforts to license the brand would be focused on developing products, not services. Let's be kind here and say just maybe filing in either class 35 or 42 might make some sense, as there could possibly be some opportunities down the road where use of the brand might relate to some service falling under either of these classes. My point is that the probability of licensing out such use of the mark is more than likely to occur down the road, not at the outset, and I utterly failed to see *any* justification for filing applications in *four* service categories.

There were several mistakes with the brand B trademark program Larry had begun to develop. The first problem was he had decided to file all his trademark applications with, what was at the time of his filing, the artistic logo (for the lawyers reading this replace logo with the term "expression") for brand B in combination with the name of the brand B property. By filing in this manner DGI was now married to use of that logo treatment – which of course had been refashioned into a complete different design by the time I took an active part in managing the property. Due to the manner in which Larry had filed the trademark applications for brand B the property would have little to no protection if the brand's name was used without the inclusion of the (now defunct) logo design.

To further compound the problem, for some reason known only to Larry, all his filing were made incorporating a narrow specification of the goods in each of the four classes, even though he could (and should) have filed each product class as broadly as possible. The problem this presents is that if we license out the brand B rights in some or all of the four classes, but not for all the specific goods within each class we jeopardize retaining the rights to the remainder of "unused" product categories. It is important to remember that at this juncture no efforts have yet been made to acquire licensees. Therefore, all of the trademark applications are based on intent-to-use. Under the circumstances, the smart practice to obtain registration of the trademark is to encompass within the filing, a very long list of goods in each class. As the licensing program for the property develops, we can then limit the list of goods in each category based upon which of those items are actually made. The results of Larry's efforts were the waste of time and money on the filing of trademark applications that are of no use to DGI.

Since being appointed as DGI's licensing agent for brands A and B, in an effort to correct past mistakes, I sat with the company's principles and after vociferous debate we collectively agreed on a list of those products we were likely to license first. Unless money is no object and filings can be made in every conceivable product category, this should always be step one in developing a trademark program.

The list of key classes for brand B was not consistent with the list of classes Larry had filed. As the primary consumer of brand B is likely to be men and women age 18-55, it was agreed that class 28 (toys and games) should not been on our key class list. Based upon both cost and product considerations it made the most sense to file new applications in four (4) classes: Paper (16), Leather Goods (18), Fabrics (24) and Apparel (25). By this time the route map logo treatment had been replaced with a better and less complicated design. Notwithstanding this fact, we agreed with the newly appointed trademark lawyer, which I shall refer to as Bob, that the all applications would be filed using the brand B name only and in a non-descriptive type. Also, each application would contain the broadest list possible of the goods that could be filed for under each class. Filing in this fashion provides the greatest flexibility as the brand name can be used with or without its descriptive trademark. When and/or if at some later we felt the need to do so, we could file the brand B logo separately.

As no filings had as yet been made for the brand A licensing program, rather than making the arbitrary decision to file the same four (4) trademark classes for this licensing program, a collectively discussion was again held to establish a list of the key trademark classes that needed to be filed for brand A. We reached agreement to the list of core products for brand A, affording us the ability to select the key classes for filing, which totaled three (3) classes:

- 18 / Leather Goods
- 24 / Fabrics
- 25 / Apparel

Once again, the filings were made using the property name only in a non-descriptive type, and each application listed as many products as possible in each application.

The development of a trademark program is a costly undertaking, and should result in providing the property owner the amount of protection that is reasonable and/or affordable. There is no argument with the concept "if in doubt, file." However, those words are most often *not* uttered by the one footing the legal bills. The greatest difficulty in generating an effective trademark program is balancing costs with coverage. Very often the need for protection will be greater than the funds available. Therefore, great care should be given to reconciling the two, establishing protection in the most important classes first. This process must be a collaborative effort involving both property owner and legal counsel. Like it not, the most effective trademark programs are the result of committee effort. My suggestion, have danish available.

Wishing you Happy Licensing,
Danny Simon