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THIS MONTH:

ABOUT "BRANDMARKING"

The word is a combination of "branding" and "trademark." It reflects a conviction that marketing and legal professionals share a common goal, and that they need to learn to speak each other's language in order to reach it. That goal is simple: to develop powerful, durable brand identities and capture them in names, slogans, and designs that customers will associate with their products -- and with no one else's.

If you like what you find here, feel free to pass it along to others.

ABOUT THE AUTHOR

Attorney John Blattner helps businesses develop and protect brand identities. He does trademark counseling, clearance, prosecution, enforcement, and litigation, in the fashion, health and beauty, financial services, technology, retailing, publishing and media, automotive, sporting goods, and other industries. John also teaches Trademarks and Unfair Competition at Michigan State University College of Law.

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DICKINSON WRIGHT'S

Brandmarking

THOUGHTS ON THE CREATION, PROTECTION, AND ENFORCEMENT OF BRAND IDENTITY

IS THIS REALLY A JOB FOR THE TRADEMARK OFFICE?

Legal proceedings involving mass murders and lurid sexual escapades get lots of media attention.

Trademark cases? Not so much.

That's part of what makes the case of *Blackhorse v. Pro Football, Inc.*, fascinating. It's a trademark cancellation proceeding seeking to **revoke six federal service mark registrations that include the word "Redskins" with reference Washington, D.C.'s professional football team**. The issue has attracted a lot of attention; you might even say it has become something of a political football (sorry, couldn't help myself).

Whatever your views may be on the underlying issue of whether the use of "Redskins" as a team name and mascot is inappropriate and should be outlawed – and I will keep my own views to myself – there are at least two aspects of the case that are worth noting.

One is the fact that the case is pending, not in a federal court, but in the Trademark Trial and Appeal Board, the administrative tribunal of the U.S. Patent and Trademark Office. The TTAB hears appeals from trademark owners whose applications to register their marks have been denied. It also adjudicates pre-registration "opposition" proceedings against applications that the Trademark Office has approved, as well as "cancellation" proceedings against registrations that have already issued.

Losing an opposition or cancellation proceeding does *not* mean that a trademark owner has to stop using its mark; the TTAB has no authority to issue injunctions (or, for that matter, to award money damages). Losing in the TTAB only denies *registration* of the marks – which can be a significant penalty, especially for marks, like those at issue in the *Blackhorse* case, that are exploited for licensing purposes. **I sometimes recommend a TTAB proceeding as a relatively inexpensive enforcement option for clients wary of the angst and expense of a federal lawsuit.**

This leads to the second noteworthy aspect of the case, which is that **the federal Trademark Act is the only intellectual property statute that includes what amounts to a censorship clause.** It provides for denial of registration to material that

> …consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute…

15 U.S.C. § 1052(a). (Note that this statute was enacted in 1945, long before anyone had ever heard of political correctness.)

Of course, books and movies that contain rank obscenity and vile hate speech are routinely granted registration by the Copyright Office, and no one seems to think a thing about it. And the Patent Office routinely grants patents for devices whose uses may strike at least some people as objectionable.

Every year I ask my law school students **whether they think a J.D. degree and a single course in trademark law qualifies them to render an official judgment on what is, and is not, "immoral" or "scandalous."** They find the very idea preposterous. But those are the only credentials that the examining attorneys in the Trademark Office have, and they perform this function as part of their regular job description.

The TTAB's decision in *Blackhorse* won't resolve the issue of whether the Washington Redskins need to change their name. But it will impact the commercial value of the Redskin trademarks, at least to some extent; and it will no doubt have more than a little public relations impact. Final trial briefs were filed more than a year ago, and oral arguments were heard way back in March; a decision is expected – oh, any old time now (this is an agency of the federal government we're talking about, after all). Stay tuned…

BOSTON STRONG, REVISITED

In a recent issue of *Brandmarking* I reported that numerous individuals had applied to register BOSTON STRONG as a trademark, and that this had caused an outcry from people who, in deference to those injured in the Boston Marathon bombing, didn't want to see the slogan commercially exploited.

Apparently the Trademark Office agrees.

There are eight different applications to register BOSTON STRONG. All of them found their way to the same examining attorney, who has preliminarily refused all of them on grounds that **"Boston Strong" is "incapable of serving as a trademark" because it has become so closely associated with the bombing.**

It will be interesting to see if any of the applicants can persuade the examining attorney to change his mind (the smart money is betting against it).

THE KING IS DEAD…

It was bound to happen sooner or later.

For thirteen years, COCA-COLA stood atop the prestigious Interbrand annual list of Best Global Brands. But this year it was passed by not one but two others. Here's the new top ten:

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These annual rankings provide an interesting indicator of trends both in popular culture and in the global economy. So it should come as no surprise that the two new leaders are tech companies. Actually, five of the top ten (seven if you include General Electric and Samsung) are techs.

Although only Toyota made the top ten, **automotive was the leading sector with 14 of the top 100 brands.** It was followed by technology and "fast-moving consumer goods" (12 each) and financial services (11). In what may be a sign of economic recovery, "luxury" brands experienced significant gains, including Cartier (which jumped from 68th to 60th), Porsche (72nd to 64th) and Prada (84th to 72nd). You can study all the results here.

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