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Insights: Perspectives

5 Key Takeaways | 2023 Trademark Seminar: Anatomy of a Rebrand

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KILPATRICK TOWNSEND

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KEY TAKEAWAYS

2023 Trademark Seminar: *Anatomy of a Rebrand*

This panel will examine the process of a corporate rebrand, and walk through some of the trials, tribulations, and triumphs you can expect with a rebrand. With the following key considerations, you'll be equipped to support your business in its next rebrand initiative.

1

The Catalyst: Business Objectives

There are many different types of catalysts that drive a corporate rebrand. In some instances, a rebrand may be the result of a business' evolution, a driving factor to enter a new market, or a powerful tool to communicate to the world the company is going to begin offering something substantially more (or different) from what it originally introduced to market. Some businesses seek to break from their pasts, while others strive to maintain a connection to brand heritage.

There are many forces that can be the driving factors behind a corporate rebrand and knowing what those interests are will help the legal team frame its opinions and identify risks.

The Stakeholders & Decision-makers

Every legal team working through a rebrand will need to identify the stakeholders and decision-makers, both internally and with outside counsel and/or vendors. These figures will drive the internal processes and communication. Knowing the audience (legal vs. non-legal) will allow the legal team to tailor its advice to ensure the appropriate risk levels are being conveyed with practical implications. By knowing who the stakeholders and decision-makers are, the legal team can share the *why*, and not just the *what*, in an effective manner.

2

The Rebrand: The Structural Makeup

Once the decision to rebrand manifests itself, there are five steps to consider:

1. **Mark Selection:** In-house creatives, outside brand agencies, and existing trademarks in a business' portfolio are three exemplary tools in the legal team's "toolbox" to select potential candidate marks. There are legal considerations for each method. For example, contracts must be in place if a business is engaging third-party agencies, and existing trademark portfolios may be narrow and restricted from further expansion due to existing third-party rights. And further, some brand agencies will prepare "pre-clearance diligence," which may cause some buzz with the stakeholders, but may not have been properly vetted before being proposed

3

example, contracts must be in place if a business is engaging third-party agencies, and existing trademark portfolios may be narrow and restricted from further expansion due to existing third-party rights. And further, some brand agencies will prepare "pre-clearance diligence," which may cause some buzz with the stakeholders, but may not have been properly vetted before being proposed.

2. **Clearance & Diligence:** Exhaustive trademark searches and investigations will be necessary to ensure any risks associated with the use and/or registration of the new mark are relayed and acceptable for the business. The legal team will also need to consider its priorities during the early stages of searching as to whether it will prioritize the registrability of a trademark versus its use (and understanding why the reason for registrability (or non-registrability) is important to the business).
3. **Acquisitions:** During the clearance process, there may be trademarks the business wants to acquire to achieve its desired outcome. Not every acquisition will be seamless, and several may be difficult. Learning how to navigate those conversations will help further the business' goals.
4. **Secure Related Intellectual Properties:** A rebrand involves more than a trademark. The business should, for example, consider a number of related IP properties as part of the overall rebrand:
   - Domains / URLS
   - Stock symbols
   - Mobile app names
   - Websites (intranet v. internet)
   - Building signage
   - Product packaging and product branding
   - Serial plates for consumer goods
   - Business badges
   - Business cards
   - Letterhead
   - Uniforms
   - Company vehicles
   - ERP systems
5. **Filings:** Once the business has selected its finalist mark, new trademark filings will be necessary. Critical to moving forward is having a strong filing strategy. Determining what trademark(s) need to be filed, when and where will depend on one question: What is mission critical for day one of announcement?

   Depending on business needs, the legal team will need to consider stealth filings, with the goal to expand protection through priority foreign filings, or extensive day-one filings on the morning of announcement. The new filings will also depend on the type of rebrand. For example, an umbrella or holding company may require fewer classes and filings, whereas a full corporate rebrand will need to address the company's full portfolio of goods and services– and in every jurisdiction the company does business (and potentially more).

The Corporate Identity

4

If a company is rebranding its corporate identity, it is important to understand whether the rebrand is merely a name change or if there is a change in corporate structure. This will undoubtedly impact existing agreements and trademark licenses. Trademark licenses, for example, cannot be assigned without an express provision providing for assignment. These are considerations that must be addressed *before* the name change is complete and the former company ceases to exist. There may be tax implications with the new identity.

Upon completion of the rebrand, there are also several things to consider with respect to the brand's existing trademark portfolio and updating ownership information. For example, assignments may need to be filed and recorded in every jurisdiction where the business has acquired trademark rights. The business will also likely need to record its name change through the proper channels.

5

The Big Reveal: Institutional Challenges

Maintaining consumer loyalty is paramount with any rebrand. Consumer loyalty, however, may be to the company's flagship products and consumers may not even be aware of the actual company name behind it. In these instances, a rebrand may be a unifying act around a new business plan, or a statement to Wall Street. In other instances, a rebrand may be a very pivotal shift in corporate identity, and there may be third parties (competitors or consumers) that voice objections to a selected mark. A rebrand can be accepted with excitement and delight in some instances, and skepticism or objections in others.

Feeling confident that the business has made an informed decision with the necessary

be third parties (competitors or consumers) that voice objections to a selected mark. A rebrand can be accepted with excitement and delight in some instances, and skepticism or objections in others.

Feeling confident that the business has made an informed decision with the necessary knowledge and risks will help the team navigate these types of challenges after announcement.

Guest Speaker Biographies



Paul Sousa
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Paul Sousa is Associate General Counsel, Brands & Marketing Legal at Meta (f/k/a Facebook), where he manages the Meta and Facebook global trademark portfolios. This includes global portfolio strategy, naming due diligence and brand counseling, enforcement and dispute resolution, and cross-functional litigation support.

Paul was recently recognized as one of the 40 Best LGBTQ+ Lawyers under 40 by the National LGBTQ+ Bar Association.

Before joining Meta, he worked at AmLaw 100 law firms, including Reed Smith and Kilpatrick Townsend & Stockton, where he counseled a variety of Fortune 500 and startup clients on trademark protection matters.

Outside of the legal sphere, Paul volunteers for LGBT civil rights, enjoys playing pickleball, and going camping with his husband and their Bernedoodle.

Paul received his JD from Boston College Law School, and Bachelor's from Northeastern University.



Matt Stratton
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Matt Stratton is Director & Associate General Counsel, IP at Snap Inc. (f/k/a Snapchat). He leads the legal team responsible for trademark, copyright, domain and right of publicity matters for Snap. This includes enforcement, prosecution, clearance, product counseling, and platform IP reporting issues. Previously, he was Associate General Counsel, IP at Facebook, where he handled trademark matters for the Facebook, Instagram, and WhatsApp portfolios, as well as IP clearance for consumer-facing marketing.

Before going in-house, Matt was an associate at Hanson Bridgett LLP and Harvey Siskind LLP. Matt received his JD from UC Hastings and bachelor's from Harvard. He lives in Manhattan Beach with his wife and two daughters.



Jeff Michel
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Jeff is Deputy General Counsel and Senior Vice President, Licensing and Intellectual Property at Light & Wonder, Inc. (f/k/a Scientific Games, Inc. f/k/a Bally Gaming, Inc., f/k/a WMS Gaming, Inc.), a global leader in the casino slot machine and table gaming, social gaming, and online wagering. Jeff and has been with L&W since 2004. He is responsible for developing the strategy for and executing L&W's third-party brand licensing for all of L&W's business channels, as well as is responsible for all aspects of its global trademark portfolio (a portfolio of over 5,000 marks in 65+ countries).

Prior to joining L&W, he was the Senior Corporate Counsel at Enesco Group, Inc., a leading designer and manufacturer of giftware and collectibles and was the Associate General Counsel at True North Communications Inc., the holding company for several global advertising agencies and before that was an associate at two major law firms where his practice focused on intellectual property.

Jeff received his undergraduate degree in Economics (B.A. *Magna Cum Laude*) from Tufts University in Medford, Massachusetts and his J.D. from the Loyola University of Chicago School of Law (J.D., *Magna Cum Laude*), worked for The Honorable Ann C. Williams, Federal District Court, Northern District of Illinois (now retired from the Seventh Circuit Court of Appeals).

Outside of the legal sphere, Jeff is a Dive Master, cyclist, sailor and ceramicist.

Kilpatrick Townsend Speaker Biography

Calla Yee focuses her practice on global portfolio management, including

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Calla Yee focuses her practice on global portfolio management, including domestic and foreign trademark clearance, global trademark prosecution, international and domestic trademark protection strategies, global portfolio audits, and comprehensive re-branding initiatives. In addition to her prosecution and global portfolio management practice, Calla handles global registry disputes and enforcement efforts. Calla works with clients of all sizes and in a broad range of businesses, including social media and technology, fintech, luxury beauty products, the wine and alcohol industry, and entertainment and content production, among others.

Outside the firm, Calla sits on the Board of Governors at the University of San Francisco School of Law, and the Advisory Board as the Trademark Chair for the San Francisco School of Law Intellectual Property Association.

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