KAHN TO PRESENT REBRANDING TRADEMARKS WEBINAR

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On January 12, 2021, Michael A. Kahn, senior counsel, and Elizabeth A. Patton, a Partner at Fox Rothschild, will co-present a live 90-minute CLE video webinar titled, "Rebranding Trademarks: Challenges of Walking Away and Choosing a New Mark". The webinar, hosted by Strafford Publication, will guide trademark counsel and companies facing the decision to rebrand trademarks.

The panel will address the legal and business issues that arise when companies consider dropping or changing a mark, including when dropping a potentially offensive or insensitive trademark. The panel will also discuss considerations companies face in selecting new marks.

Aunt Jemima pancake mix, Uncle Ben's rice, and Eskimo Pie ice cream sandwiches are some of the brand names that companies are reconsidering or abandoning to avoid cultural insensitivity. After a long fight to keep its federally registered trademarks, the Washington Redskins are now the Washington Football Team, a temporary name while they rebrand.

When a brand owner stops using its mark in commerce, it can lose its trademark rights. Nonuse for three consecutive years is evidence of abandonment. But to maintain the mark, the use of it must be bona fide. Abandoning a mark is not without its challenges. Among those are logistics and the cost of removing any use in the marketplace, which can be daunting. Additionally, when a company abandons a brand, it allows another company to claim it, but with any residual negative connotations sticking with the original brand owner.

In Iancu v. Brunetti the Supreme Court held the Lanham Act's prohibition on registering immoral or scandalous trademarks violates the First Amendment. That decision came two years after it ruled in Matal v. Tam that the Lanham Act's disparaging trademark ban was unconstitutional. Despite these rulings, there has been a wave of companies contemplating or ceasing use of certain trademarks.

Companies dropping a trademark due to offensiveness or cultural insensitivity should ensure the new brand meets legal requirements and does not infringe. For example, the music group Lady Antebellum is in litigation after it chose to shorten its name to Lady A, which was already in use by another musical artist.

The choice of a lawyer is an important decision and should not be based solely upon advertisements.

For additional information and to register for the program, please visit: Rebranding Trademarks: Challenges of Walking Away and Choosing a New Mark

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