



KALAMARAS
— LAW OFFICE

Trademarks as a Living Organism

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Who Am I?

RATED BY

Super Lawyers®

Stacey C. Kalamaras

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- Founder and managing partner of Kalamaras Law Office LLC in Chicago, IL
- Seasoned trademark, copyright, and advertising Attorney
- Big law and in-house experience
- Prior marketing and advertising experience working for consumer-packaged goods companies
- Managed global trademark portfolios in 150+ countries
- Educated nearly 3,000 attorneys on trademark and IP since 2018
- Founder of [Trademarkabilities](#), a trademark academy for lawyers



AGENDA

Why Companies Change Their Names



How IP/Trademark Factors into Branding



Brands Changing Due to the Social/Racial Justice Reforms



Rebranding Considerations in LatAm



In Summary



Q&A





Why Companies Change Names

Why Companies Change Names

- 1 Merger or Acquisition
- 2 Trademark Infringement Action
- 3 Current name outdated or out of the company's scope
- 4 Geographic Expansion
- 5 Business Spin-off
- 6 Cultural/Translation Issues
- 7 Negative Impression



Why Companies Change Names

1

Merger or Acquisition

- BB&T Corp. and SunTrust banks merged and chose the name TRUIST
- Led to big lawsuit with TRULIANT regional bank in NC, SC, and VA
- Resulted in settlement, but I expect there will be lots of confusion
- One of the reasons the merged BB&T/SunTrust entity gave for not changing their name, once they realized there was a problem, was the fact that they had spent \$125M to date and the regulatory hurdles



Why Companies Change Names

2

Trademark Infringement Action

- Many examples, from threatened action to litigated
 - You can often negotiate a transition period
- IMPOSSIBLE Burger v. INCREDIBLE Burger
 - Nestle changed its name in the US to AWESOME Burger, but recently lost the rights in the EU and announced it will change its name to SENSATIONAL Burger. It plans to appeal the EU decision
- World Wildlife Fund (WWF) v. World Wrestling Federation (WWF)
 - The World Wildlife Fund was founded in 1961 and had an agreement with the now-infamous wrestling entertainment company
 - The WWE was re-branded in 2002 because it breached its agreement



Why Companies Change Names

3

Current Name Outdated or Out of Scope

- DELTA Airlines started as a dust-cropping company in the 1920s
 - The company was called Huff Daland Dusters
- GOOGLE, one of the world's best known and largest valued brands, was originally called BackRub
 - From a trademark perspective, it was a pretty good name, too, since the search engine referred to all the backlinks
 - Of course, GOOGLE is a play on "googol" which means 10^{100}
 - Legend has it that the word was misspelled

BackRub | Google



Why Companies Change Names

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Geographic Expansion

- One of the best examples of this is the birth of Panera Bread
- Do you remember The St. Louis Bread Company?
- As Panera was preparing for expansion, it needed a name that better reflected the fact that it was no longer only based in St. Louis
 - The new name could have also been due to the fact that Au Bon Pain purchased the chain in 1992, but didn't rebrand it to Panera until 1997
- Contrast that with California Pizza Kitchen, which stayed true to its name even once it expanded outside of California



Why Companies Change Names

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Business Spin-off

- DuPont spins off CORTEVA AgriScience in June 2019
- VF Corporation (Vanity Fair) spins off KONTLOOR Brands in May 2019
 - KONTLOOR owns WRANGLER, LEE, among other clothing brands
- Honeywell spins off RESIDEO Technologies in October 2018
 - Smart home products and technologies

KONTLOORTM

DUPONTTM
 **CORTEVA**TM
agriscience


resideo



Why Companies Change Names

6

Cultural/Translation Issues

- When adopting marks globally, it's critical to consider the local meaning



- IKEA had a workbench they named FARTFULL, which didn't do well with the American audience
 - In Swedish, the word Färd means to travel in a vehicle with wheels
- In China, Kentucky Fried Chicken's slogan, "Finger Lickin' Good" translated literally to "Eat Your Fingers Off" (Not very appetizing)
- Recently, a Canadian brewery unwittingly apologized for naming its beer HURUHURU, which in Maori means "pubic hair"
 - The Maori are an aboriginal people of New Zealand
 - The company publicly announced they would rebrand



Why Companies Change Names

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Negative Impression

- ISIS Mobile Wallet
 - In 2014, this platform backed by AT&T, T-Mobile, and Verizon rebranded to Softcard due to the negative connotations with the terrorist group
- The Washington Redskins
- Cleveland Indians
- Lady Antebellum
- Uncle Ben's
- Eskimo Pie
- Land O Lakes
- Aunt Jemima
- Mrs. Butterworth's

ISIS
Mobile Wallet®





IP/Trademark Factors into Branding

IP/Trademark Counsel's Role

Many companies will work with a branding or naming company



Trademark Counsel should be involved early to run searches

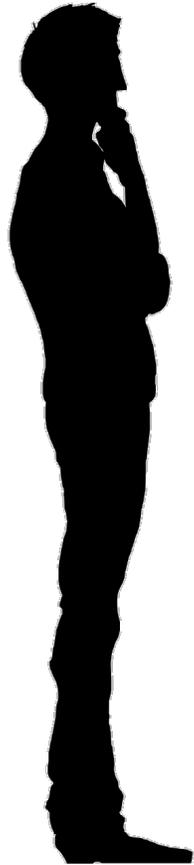
If your client is not working with a branding agency



You must insert yourself into the process



IP/Trademark Counsel's Role



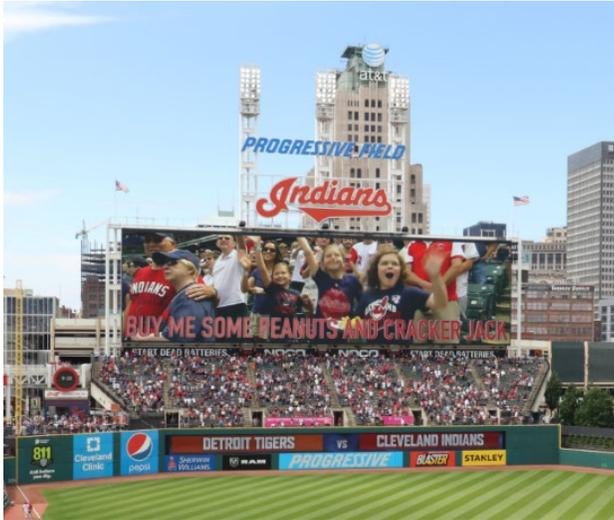
- SEARCHING IS CRITICAL
- Ask the client how they thought up the name
 - Does it mean anything to them?
- Where do they intend to sell the goods/services, now and in the next 3-5 years?
 - If there are global expansion plans, do NOT make any public announcements about the name until the mark is filed in the U.S. and each of those countries
 - Work with local counsel and/or linguistic experts to make sure the name translates well everywhere





Brands Changing Due to Social/Racial Justice Reforms

Cleveland Indians: Rebrand



- On Dec 14, the Cleveland Indians announced it was dropping the Indians name
- It had previously retired the Chief Wahoo logo in 2019
- The club announced it will keep the name through the 2021 season
- So far, there are no speculators who have filed
- The club owns registrations for CLEVELAND BLUES and CLEVELAND NAPS, both for clothing and historical nods



The “Lady A” Fight



- In the wake of George Floyd’s death, Lady Antebellum decided to shorten its name to LADY A and rely on its 3 prior trademark registrations filed in 2010
- The problem? There is a 61-year-old blues singer who has been using the LADY A moniker at common law for nearly 30 years
- Lady A(ntebellum) could have easily discovered Anita White aka Lady A had they conducted a proper search
- The parties tried to reach a settlement, but discussions broke down



The “Lady A” Fight



- Lady A(ntebellum) filed a declaratory judgment action in early July.
- The original Lady A filed a countersuit for trademark infringement on September 15
- The parties are arguing over where the case will be heard – with the Dec action scheduled to be heard in TN and the countersuit scheduled to be heard in Seattle
- This likely won't reach a full resolution (short of settlement) until 2022
- For an interesting article on the topic see [here](#)



Mars: Uncle Ben's Brand Identity

**Mars Food Announces the
Uncle Ben's® Brand Will
Change its Name to Ben's
Original™**

**Rebrand includes new purpose: create
opportunities that offer everyone a seat at the
table**

LONDON (September 23, 2020) -



Mars: Uncle Ben's Brand Identity



- On June 17, Mars announced it would review the Uncle Ben's "visual brand identity"
- On Sept 23, Mars unveiled its new brand **BEN'S ORIGINAL**
 - We will change our name to Ben's Original™, as well as remove the image on our packaging to create more inclusive branding. This change signals our ambition to create a more inclusive future while maintaining our commitment to producing the world's best rice.
- Regardless, Retrobrands, LLC filed UNCLE BEN'S as an ITU application for "instant rice" on August 12



Nestle: Eskimo Pie



- On June 19, the Dreyer's division of Nestle announced the name change and new packaging
- In comparison to Ben's Original, how did they do?
- Do you think they captured the essence of the brand?
- In the days following this unveiling, Leo Stoller and Retrobrands filed new applications for ESKIMO PIE for ice cream and t-shirts



Quaker: Aunt Jemima



- On June 17, Quaker announced the brand will get a new name and image
- The image has changed over time to remove the “mammy” kerchief imagery
- On February 9, Quaker announced PEARL MILLING COMPANY as an homage to the milling company in MN that gave birth to self-rising pancakes
- AUNT JEMIMA products will be available in-store thru June
- Three speculators all filed for AUNT JEMIMA back in June for various breakfast foods including RETROBRANDS



Land O Lakes: New Packaging



Land O Lakes removed the Native American woman from their package

In advance of their 100th anniversary



ConAgra: Mrs. Butterworth's



- On June 18, ConAgra announced it began a complete packaging and brand review
- According to ConAgra, the imagery of the brand is to “evoke a loving grandmother”
- No indication that the name will change, but the bottle shape is iconic and a registered trademark in use since 1966
- No further announcements on its website



B&G Foods: Cream of Wheat



- Also, on June 18, B&G announced that its packaging is under review
- B&G is looking at the black chef image
- CREAM OF WHEAT has been registered since the 1920s
- No new announcements on its website





Rebranding Considerations in LatAm

Mr. Muscle and Mr. Clean



- SC Johnson & Sons owns the brand Mr. Muscle, a household cleaning product
 - In LatAm, the brand is known as “Mr. Musculo” because it sounds more familiar to Spanish speakers
- P&G owns Mr. Clean, another well-known household cleaning product
 - In LatAm, the brand is known as “Don Limpio” which is more familiar in the region



Odebrecht Changes to Novonor



- In December 2020, Odebrecht announced a name change to Novonor amid scandal
- Brazilian engineering conglomerate operates throughout LatAm
- The Operation Car Wash investigation was launched in 2014 to uncover a network of bribes paid out by large construction companies to politicians to obtain lucrative contracts with Brazilian state oil company Petrobras
- Odebrecht was at the center of the scandal and admitted to paying bribes



P&G: Spic & Span



Say adios to Senior Sleepy

- On June 18, 2020, P&G announced they would review the brand name and the product mascot
- It's an 87-year-old brand
- Brand rooted in racial bias and hatred of Latinx people
- Ordered expedited recall of packaging with "Senior Sleepy" on the package
- P&G hopes to roll out new packages by year end



Nestle: Beso de Negra & Chicos



- On June 2020, Nestle announced it would rebrand 3 Australian confections, two of which have implications for the LatinX market
- Chicos was rebranded to CHEEKIES and Nestle announced the new packaging would be available in early 2021
- Nestle is also in the process of renaming Beso de Negra marshmallow confections which are sold in Colombia
- No word yet on the new name or details on when the new packaging will be available



What Happens When Brands Evolve?

Brands naturally evolve and change over time

- Trademark registrations can be kept alive
- When a logo or stylization is modernized, the older mark can usually be used somewhere, like on the back of the package or on a marketing piece
- With some brands, it may not be possible (AUNT JEMIMA may need to be retired, or ODEBRECHT due to scandal)
- The conversation must be driven by the business
- Legal/IP Counsel should be involved to protect the assets whenever possible





In Summary

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- There are many reasons companies rebrand
- It's important to have a plan
- If you sense your client is in a situation that will involve a rebrand, get involved
- SEARCH, SEARCH, SEARCH
- Consider translation issues and foreign expansion plans
- Be strategic with the implementation and announcement





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- ✓ How to handle office actions
- ✓ An overview of TTAB actions
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Questions?

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