

REBRANDING AND TRADEMARK PROTECTION: KEYS TO A SUCCESSFUL TRANSITION

Reyes García / Yahel Contreras

Rebranding is a common phenomenon in the business world, a process that trademarks undertake to revitalise their image in order to adapt to changes in the marketplace, reach new audiences or correct negative perceptions. Sometimes the process is gradual and subtle, barely noticeable as the company evolves towards its desired goals. In other cases, it involves more radical changes that completely transform the company's image to highlight its products or services.

However, during this period of change, companies need to pay close attention to how their trademarks are registered and work closely with their intellectual property attorneys. This will ensure that they have adequate protection, while at the same time implementing a well-thought-out strategy that allows them to change their distinctive signs without risking the loss of their trademark rights.

Therefore, if you are a business owner, it is essential that you review the brand image you are using, analyse your registered trademark/s and consult with your intellectual property agent for the best advice on protection. If, while reading this article, you realise that you have not registered the trademark you are using, it is crucial that you seek the advice of an intellectual property agent.

Examples of real brands.

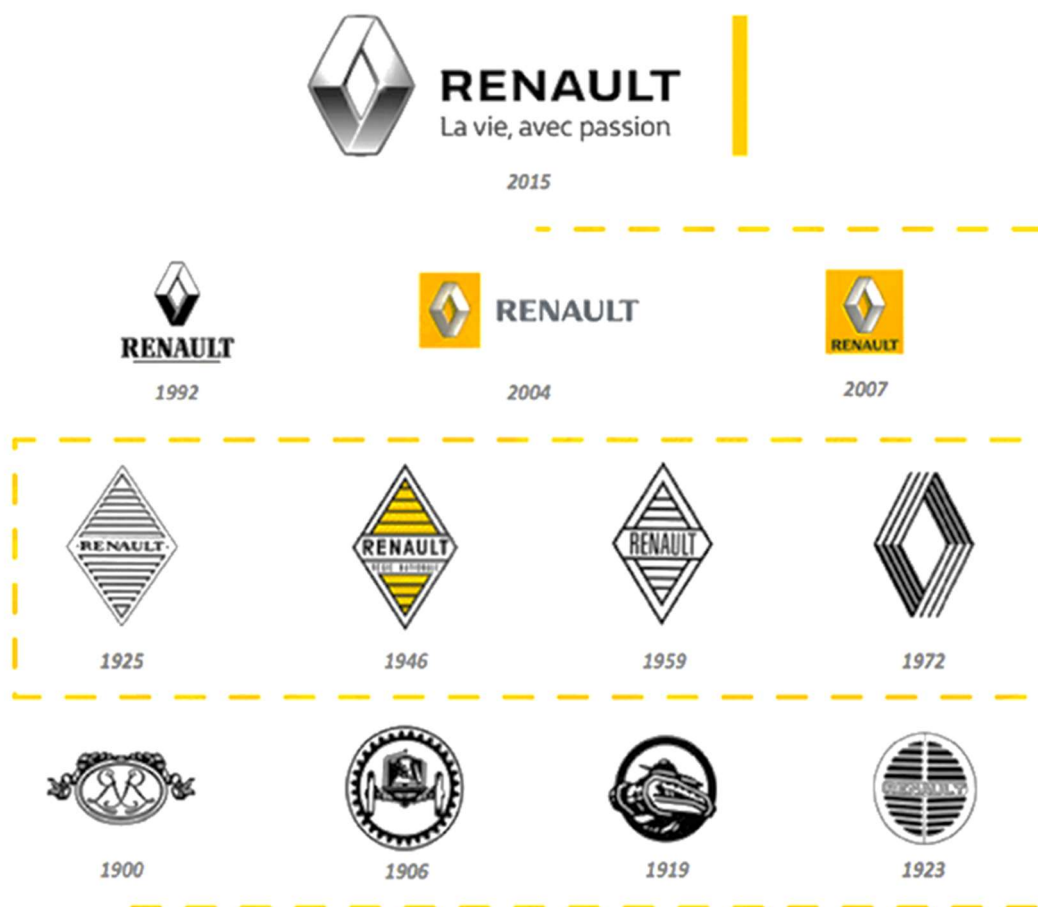
Rebranding is an important strategy for maintaining relevance in an ever-changing marketplace. However, it must be done with care as it can have a significant impact on consumers' perception of the brand. These real-life pair of examples illustrate how brands can successfully adapt and evolve over time:



1971

2011

Source: Starbucks ® [website](#)



Source: Renault @ [website](#)

Rebranding and its relationship with trademark law: ensuring a proper use and avoiding non-use cancellation.

As mentioned above, rebranding is an important strategy for trademarks to remain competitive and adapt to market trends and consumer demands from the marketing point of view. However, this process must be carried out with caution, especially with regard to trademark law. Trademark registration and protection are fundamental to any business, and a change in brand identity must comply with certain legal obligations and risks. Here are some of the key issues:

Trademark registration.

In Europe, and in many other countries, the trademark shall be obtained by registration. This registration grants certain exclusive rights to the trademark within a particular jurisdiction. The registered trademark becomes a valuable and distinctive asset that helps consumers distinguish one company's products and services from those of another.

However, these trademark rights also come with significant responsibilities. The trademark owner must use the mark as registered, or with insignificant changes that do not alter its distinctive character, maintaining consistency in the design and appearance of the mark and for the goods or services specified in the registration. If the mark is used inconsistently or you stop using it for all or part of the goods and services for which it is registered, there is a risk of losing its protection.

Risk of cancellation for non-use.

Besides specific cases like those countries where it is mandatory to declare and/evidence use before the Trademark Offices to keep it alive, as it is the case of USA or Mexico, a third party can ask the trademark Offices to cancel a registered trademark if the owner does not use it in accordance with the registration. This is done to prevent companies from maintaining exclusive rights to trademarks that are not actively used. Cancellation for non-use can also be requested, for example, by a third party as a defence against an opposition filed by the owner of the opposing registered trademark.

The requirements for use of registered trademarks vary from country to country. While there are common general principles, such as the need for genuine and commercial use, specific details and interpretations can vary significantly from country to country.

Rebranding becomes a delicate moment in this respect. When rebranding, it is necessary to assess the trademark risks and develop a protection strategy for the new distinctive sign intended for the company's products or services. The company may also decide to retain the previously registered signs in order to maintain a portfolio of rights that can potentially be reclaimed or retained until the company decides to define that portfolio, or for historical reasons.

In summary, rebranding is a valuable strategy for brand evolution, but it must be done with due regard to trademark obligations. It is essential that companies continue to use the trademark as registered to avoid the risk of cancellation for non-use and to maintain the right protection of their trademark assets. Consultation with intellectual property experts during the rebranding process is essential to ensure compliance with all legal requirements and to maintain the brand as a valuable and distinctive asset in the marketplace.