

Duff on Hospitality Law

## **“I know it when I see it”: Considerations for Soft Branding**

By Claire Hawkins on 11.20.14 | Posted in Brands and Trademarks, Trade Dress Protections

*What is soft branding? Is it better to be a soft brand or a hard brand? [Claire Hawkins](#), Chair of Garvey Schubert Barer’s Intellectual Property Practice and member of Garvey Schubert Barer’s Hospitality, Travel and Tourism Practice, gives serious consideration to the outer edges of soft branding and offers her insights on the intellectual property components hoteliers and restaurateurs need to consider. Thank you for today’s post, Claire! – Greg*

### **“I know it when I see it”: Considerations for Soft Branding**

Independent hospitality businesses can benefit from the appeal of freedom, individuality, and uniqueness, but over time may also struggle with the lack of convenience and efficiency that established, consistent, and defined brands have. One-of-a-kind hotels, restaurants, or the like are great at capturing customers preferring “hidden gem,” “independent,” “boutique,” “local,” or “customized” venues, but by not going so far as to define the scope or consistent aspects of their brand, may not have the resources necessary to adequately protect the time and effort it took to develop and implement the unique aspects of the brand. A sign of success is surely competition, and it takes real cash and resources to stay ahead of trends. How then is it possible to have the flexibility of a unique and undefined brand, but also to prevent brand infringement and consumer confusion from copycats?

The décor or trademarks of major brands such as [Marriott](#), [Applebee’s](#), or even [Motel 6](#) and [Olive Garden](#) are easy to define and identify. Recognition is one benefit of defined branding, along with the ability to set and meet customer expectations. The counterpart to these hard brands is of course the soft brand. Soft brands essentially define what a brand is supposed to do, rather than what elements make up that brand. Is it better to be a hard or a soft brand? Hard brands have the perception of strength and solidity, and soft brands communicate of grace and fluidity. With either, consistency is key, but consistency is much harder to achieve with soft brands.

If it is at all possible, building a more defined brand portfolio is helpful when trying to keep hold of your good idea, and to stop others from appropriating efforts or styles you worked so hard to establish. One way to protect and be better able to police a brand is to have definitions, uniformity, and registrations.

Not just logos or words can be registered and protected with the US Trademark Office, but décor, product packaging, and color schemes as well in the category of “trade dress.” Trade dress protection is intended to protect consumers from packaging or appearance of products that are designed to imitate other products and to prevent a consumer from buying one product or service under the belief that it is another. For example, an arrangement of a children’s clothing line, the design of a magazine cover, the appearance and décor of a chain of restaurants, and a way of displaying wine bottles in a wine shop can all be protectable trade dress.

To register trade dress with the [U.S. Trademark Office](#), the trade dress must be defined and consistently used, but also be distinctive and not simply functional. These requirements serve the purpose of trademark or trade dress protection generally, which is to allow customers to identify the source of a product or service by creating recognition in the consumer’s mind.

Given these seemingly strict requirements, before dismissing trade dress registration out-of-hand as too restrictive to your one-of-a-kind brand, consider whether you might still be able to meet the minimum threshold to register some aspects of your brand, which could go some distance to both building a portfolio of intellectual property assets that can be leveraged, but also allow you to stop infringers and copy-cats:

*1. The US Trademark Office requires a clear statement of the goods or services offered in connection with the trade dress, e.g., “retail store services featuring communication products and services,” “hotel and motel services,” “casino services,” “resort hotel, restaurant, bar, and lounge services,” or the like.*

*2. You must also submit an image and description of the trade dress to be protected:*

- Color is not claimed as a feature of the mark. The mark consists of trade dress consisting of a three-dimensional building with concave facade, a curved roofline sweeping up toward the left top corner when viewed from the front and the word "WYNN" in a stylized script in the top left corner. The horizontal lining does not indicate color, but is a feature of the trade dress.
- Color is not claimed as a feature of the mark. The mark consists of trade dress of a hotel's exterior. At one corner of the building is a tower featuring several windows beneath a ledge, above which is a pedestal featuring the stylized text "MOTEL 6". The elements in the drawing shown in broken lines show the position of the mark as applied to the building in which the services are provided and are not claimed as features of the mark.

- The color(s) white, orange, gray, dark orange, and beige is/are claimed as a feature of the mark. The mark consists of trade dress consisting of the interior of a hotel room. The walls in the room are white except for two walls that are colored orange: the wall behind the combination TV stand/hanger rod and the wall behind the bed. The bed features a gray blanket with a dark orange sash. Above the bed are two white rectangular wall lights. On one side of the bed is a built-in luggage rack that spans the distance to the wall featuring the window and on the other side is a built-in nightstand that spans the distance to a beige seat, which conforms to the wall. The seat is immediately adjacent to a writing desk, beneath which is a four legged chair, and above which is a mirror with a small ledge beneath it and below a rectangular white light. At the far end of the room is a window covered by a dark orange curtain that matches the bed sash. The elements in the drawing shown in broken lines show the position of the mark as applied to the room in which the services are provided and are not claimed as features of the mark.
  
- The color(s) green is/are claimed as a feature of the mark. The mark consists of a three-dimensional trade dress depicting two exterior doors. Each door has a green frame, a green bottom portion, and a glass panel in the upper portion. The wording "ROCCO'S TACOS AND TEQUILA BAR" appears on the glass panel. Door elements shown in dashed lines are not part of the mark. The colors black and white represent background, outlining, shading and/or transparent areas and are not part of the mark.
  
- The color(s) blue and white is/are claimed as a feature of the mark. The trade dress consists of repetitive wording in blue on a white box, the wording consists of the following, all in blue and in no particular order; hot burgers, pop, cool and frosty soda, luscious frosty soda, creamy shakes, luscious mouth watering warm buns, firm fries, warm buns. The words POP BURGER are in blue and appear at the center of the top of the box, which logo consists of the word POP with the image of a burger in place of the letter O, and the word BURGER written across the patty of the burger.

*3. To secure US registration of trade dress you must submit a date of first use and to maintain the registration, consistently use the mark as shown on the registration.*

The benefits of federal registration include formal, public notice of your claim of ownership of the trade dress; a legal presumption of your ownership of the trade dress and your exclusive right to use the trade dress nationwide on or in connection with the goods/services listed in the registration; the ability to bring an action concerning the trade dress in federal court; the use of the U.S. registration as a basis to obtain registration in foreign countries; the ability to more easily stop competitors from engaging in behavior that is likely to cause consumer confusion; and the inclusion of the asset in your intellectual property portfolio.

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If a definitive brand is not your thing, here are some additional options to help protect your investment in a soft brand:

- Agreements – consider non-compete language in agreements with employees, franchisees, licensees, and the like with respect to specific or general brand aspects.
- Remaining fluid – put time and energy into staying ahead of the trends to minimize mimicking, and be willing to jettison aspects that become trendy or are appropriated by others.
- Distinguish yourself – stay aware of competitors or similar businesses and avoid any similarities so that any copying of your own style is easily identified.
- Selective registration – choose one aspect in a softer brand that is key, use it consistently, and obtain registration for that aspect.

It is a great time to be an independent business in the hospitality industry, but be aware of both the limitations of an intentionally un-defined brand and the benefits of identifying, registering, or otherwise adding some protection to the business you are building.

If you have any questions about brand or trade dress protection, please feel free to contact [me](#).

***Photo credits: images are from the US Trademark Office’s website and are used as examples of successful trade dress registrations.***

**Tags:** employees, franchisees, general brand aspects, licensees, soft branding, trade dress