

# The Trademark Reporter®



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**COMMENTARY****CO-BRANDING WITH INFLUENCERS IS IN FASHION  
AND NO LONGER A TRADEMARK FAUX PAS**

*By Jessica Elliott Cardon\**

**I. INTRODUCTION**

Co-branding, a type of double-trademarking, is “the use and affiliation of the marks of two different entities on a single product.”<sup>1</sup> The esteemed Saul Lefkowitz described four situations that represented double-trademarking in his 1983 article in *The Trademark Reporter* (“TMR”), including a situation involving the appearance of the trademarks of both a manufacturer and a distributor on a single product.<sup>2</sup> His discussion of this type of double-trademarking cautioned against any pairing of the trademarks in a manner that failed to clearly indicate the manufacturer as the source of the goods. For instance, he argued that a double-trademarking use that placed the manufacturer’s trademark in first position to the distributor, as in MAYTAG BY SEARS, could lead consumers to believe that Sears was the manufacturing source of the goods as opposed to Maytag.<sup>3</sup> Interestingly, in the years that have passed since the publication of Lefkowitz’s TMR article, many co-branded fashion products have adopted variations of this type of side-by-side presentation that Lefkowitz cautioned against using, such as the recent “Erdem x H&M” capsule fashion collection, which pairs the mark of a fashion house with the mark of a retailer. In this example, the retailer is in the second position in the co-branding presentation, signifying the source of the goods both at retail and for the manufacturing process, with Erdem contributing creative design input to the collection only.<sup>4</sup> This evolution in co-branding appears to be indicative of consumer awareness with respect to double-trademarking and consumer exposure to this practice by brands.

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<sup>1</sup> Saul Lefkowitz, *Double Trademarking—We’ve Come a Long Way*, 73 TMR 11 (1983).

<sup>2</sup> *Id.* at 17-20.

<sup>3</sup> *Id.* at 19.

<sup>4</sup> WWD Staff, *Erdem x H&M Collection Arrives in Stores*, Women’s Wear Daily Nov. 2, 2017, <http://wwd.com/fashion-news/fashion-scoops/erdem-x-hm-collection-arrives-stores-11041196/>.

Clearly, while co-branding was initially resisted by the courts as a viable means of communicating the source of a good to the public,<sup>5</sup> the practice has evolved in the past several decades into an acceptable means for two established brands, each with distinct but potentially compatible consumer audiences, to jointly launch a product or collection of products under their brand names to generate cross-over appeal from the two consumer populations.<sup>6</sup> More recently, as this commentary discusses, the notion of co-branding has expanded to include the joinder of an untested fashion and celebrity social media influencer name with an established fashion house to cross-promote a product or collection of products in the hope of attracting the influencer's digital audience. While the influencer herself<sup>7</sup> may benefit from exposure to the loyal consumers of the established fashion house, in truth, the promotional intent of this type of arrangement is for the established brand to tap into the influencer's digital audience and sales capabilities.<sup>8</sup> Even if the promotional focus of this type of partnership appears lopsided, the influencer can benefit from the relationship, as it provides her with an opportunity to test the greater commercial appeal of her name as a potential product brand name without taking on financial risk for the development, manufacturing, sales, and distribution of the product line. As this commentary discusses below, the increasing prevalence of co-branding in recent years, particularly these types of co-branding arrangements coupling the brand of an influencer with an established fashion house brand, have shaped consumer impressions such that consumers have a more sophisticated understanding as to the underlying source of the co-branded fashion products. In turn, these co-branding arrangements, in the fashion industry and beyond, have expanded the boundaries of co-branding

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<sup>5</sup> Lefkowitz, *supra* note 1, at 12-13 (citing to the U.S. Court of Customs and Patent Appeals case, *In re Walker Process Equip., Inc.*, 233 F.2d 329, 332, 110 U.S.P.Q. 41, 43 (C.C.P.A. 1956)).

<sup>6</sup> *Id.* at 13. ("It is now established that one may use more than one mark in connection with a particular product or service and establish protectible rights in each mark under the common law and by federal registration. The only restriction placed on such use is that each mark must create a separate and distinct impression, in and of itself, from the other marks and that each, in fact, serves purchasers as a means to identify and distinguish the product or service from other products in commerce.")

<sup>7</sup> For convenience, and as the majority of fashion influencers are female, the pronoun "her" will be used to reference back to influencers, but it should be viewed as inclusive of both genders and gender-fluid individuals.

<sup>8</sup> Rachel Strugatz, *Influencers: Holiday Season's Biggest Sales Drivers?*, Women's Wear Daily (Nov. 27, 2017), <http://wwd.com/business-news/technology/influencers-drive-clicks-sales-conversion-for-early-black-friday-sales-11056681/> (noting that prominent influencer, "Christine Andrew of Hello Fashion told WWD that her conversion rates, sales and traffic for the seven days ending Nov. 25 were markedly higher than the seven-day period one month prior. With final sales data for the holiday weekend still coming in, the 31-year-old blogger was able to confirm that during this period, so far, her conversion increased by 66 percent, sales by 104 percent and clicks by 25 percent.").

with respect to the acceptable presentation of the two trademarks such that a particular side-by-side presentation emphasizing the placement of the manufacturer's trademark is no longer warranted.

## II. WHO ARE SOCIAL MEDIA INFLUENCERS?

It is important to first understand the answer to the question, "Who are social media influencers?" Generally, they include two types of individuals: influencers who use social media accounts to build their profile and followings without accompanying written posts, and bloggers who create written and visual content on websites, many of whom have added social media accounts to build their following and to evolve into a hybrid blogger-influencer role.<sup>9</sup> Put simply, "[a]lmost all bloggers are influencers. Not all influencers are bloggers."<sup>10</sup> The first category of influencers, the non-bloggers, includes celebrities with substantial social media followings, such as fashion models, reality television stars, actors, musicians, and athletes. The second category of influencers generally comprises private or non-public individuals who have built substantial social media followings across digital platforms, including blogs and social media channels, through which these individuals develop, create, and post curated written and visual content in support of various personal interests, such as lifestyle and fashion trends, interior design, travel, family life management, cooking, and home renovation. Both types of influencers generate personal income by accepting paid endorsements and advertising dollars from brands to promote consumer products and services to their social media followers.<sup>11</sup>

The incentive for brands to engage influencers as brand endorsers, more so even than to engage celebrity endorsers, is to gain access to audiences of potential consumers with a targeted interest such as fashion, often for a fraction of the cost of a short-term billboard rental or a print advertisement in a fashion magazine with dwindling circulation numbers. Certainly, an entire roster of high-profile social media influencers could be engaged for less than the cost of a television advertisement, after accounting for film production costs, model or celebrity engagement fees, and the purchase of air-time during demographically attractive television

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<sup>9</sup> Tyler McCall, *Hey, Quick Question: What is the Difference between a Blogger and an Influencer?*, Fashionista (Sept. 30, 2016) <https://fashionista.com/2016/09/influencer-versus-blogger>.

<sup>10</sup> *Id.*

<sup>11</sup> Olivia Petter, *How Much Influencers Really Earn on Instagram*, Independent (Sept. 18, 2017), <http://www.independent.co.uk/life-style/instagram-influencers-how-much-money-earn-income-commission-a7952701.html> (noting that to earn compensation for individual Instagram posts, an influencer must have at least 3,000 followers, and as an influencer's following expands, her rates for each post will also trend upward.)

programming.<sup>12</sup> In addition, influencer posts enable brands to direct consumer purchasing activity by requiring influencers to embed product links to brand-controlled e-commerce channels. These advantages over traditional advertising methods, namely, lower individual costs for influencer programs and the ability to link consumer interest to the brand e-commerce site, allow brands to generate brand awareness and convert some social media activity to sales with fewer advertising dollars. In contrast to print media, brands can also use influencer programs to generate data showing the actual conversion rates for consumer purchases directed from the influencer posts, providing specific evidence as to the return on the investment in the influencer-created advertising.<sup>13</sup>

For brand influencers in the fashion and beauty categories, the advantage from brand-endorsement activities is clear. These endorsement opportunities do not merely generate a source of income—they enable an influencer to promote and establish a personal brand, leading to higher endorsement fees, global brand ambassadorships, product design collaborations, and co-branded product collections, and, perhaps eventually, a personally branded collection of products.

### III. SOLIDIFYING THE SOCIAL MEDIA INFLUENCER'S INDEPENDENT BRAND POWER

In recent years, several brands across a wide range of industries have chosen to engage paid influencers as brand ambassadors, partnering with these influencers to secure their endorsements and testimonials for an extended duration.<sup>14</sup> Some of these global ambassador programs have resulted in co-branding ventures, enabling the established brand to partner with the influencer and directly market to her social media audience. This type of partnership validates the influencer's position as a "taste maker" and can provide her with a platform to test if her digital marketing skills are transferable to a product design context. Recent examples of influencers who have found some success as design collaborators include former model and Music Television Network ("MTV") veejay Alexa Chung and former reality star and now top-model Gigi

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<sup>12</sup> Jeanine Poggi, *TV Ad Pricing Chart: A Show in Its 13th Season Returns to the Top 10 Most Expensive Ad Buys*, Ad Age, <http://adage.com/article/news/tv-ad-pricing-chart/305899/> (last visited Aug. 21, 2018) (stating that advertising rates during United States prime time hours range from more than \$50,000 to \$300,000 for 30-second spots, with National Football League games commanding premium rates beyond the entertainment programming rates).

<sup>13</sup> Sarah Ware, *Nine Ways to Measure and Receive ROI from Influencer Marketing*, AdWeek (Oct. 11, 2016), <http://www.adweek.com/digital/sarah-ware-markerly-guest-post-roi-influencer-marketing/>.

<sup>14</sup> Pia Velasco, *CoverGirl Taps Celeb Trainer Massy Arias to be New Brand Ambassador*, People (Oct. 5, 2017), <http://people.com/chica/massy-arias-covergirl-brand-ambassador/>.

Hadid. While these women fall more in the category of “celebrity” influencer, there are bloggers and fashion influencers who have also been able to expand their online presence and audience through co-branding partnerships with success,<sup>15</sup> as have Michelle Phan and Zoella.<sup>16</sup>

Alexa Chung gained some renown as a “style” trendsetter during her time as a vee-jay and host for MTV. After leaving MTV, she capitalized on the audience and following that she had built for herself by pursuing a number of brand collaborations.<sup>17</sup> These collaborations allowed her to test her design capabilities, but also strengthened her online presence and following without the backing power of MTV.

Ms. Chung was in demand as an influencer and design collaborator, with 2.8 million followers on Instagram, and partnered with AG Jeans, Mulberry, Longchamp, UGG, and Madewell, among others.<sup>18</sup> After numerous partnerships with fashion brands, Ms. Chung believed it was time to self-brand and develop an independent, eponymous fashion collection.<sup>19</sup> After securing financial investors, Ms. Chung designed and developed her 2017 debut ALEXA CHUNG apparel and curated-footwear collection, launching with a variety of premium and luxury retailers, including Bergdorf Goodman, Matches Fashion, Net-a-Porter and Selfridges, and the alexachung.com e-commerce site.<sup>20</sup> Fittingly, the brand-aware Chung has pursued trademark filings to protect both her name in potential product categories for the collection<sup>21</sup> and the associated stylized “A” logo:<sup>22</sup>

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<sup>15</sup> Mosha Lundstrom Halbert, *Exclusive: Alexa Chung on How She Plans to Prove Herself as a Designer*, Footwear News (Sept. 5, 2017), <http://footwearnews.com/2017/fashion/designers/alexa-chung-style-alexachung-clothes-shoes-414822/>; Kristina Rodulfo, *Gigi Hadid Is Now Designing Shoes for Stuart Weitzman*, Elle (Oct. 25, 2016), <http://www.elle.com/fashion/news/a40255/gigi-hadid-stuart-weitzman-boots/>; Lisa Lockwood, *Gigi Hadid Renews Contract with Tommy Hilfiger for 2 More Seasons*, L.A. Times (May 11, 2017), <http://www.latimes.com/fashion/la-ig-wwd-gigi-hadid-tommy-hilfiger-renews-contract-20170511-story.html>.

<sup>16</sup> Deborah Weinswig, *Influencers Are the New Brands*, Forbes (Oct. 5, 2016), <https://www.forbes.com/sites/deborahweinswig/2016/10/05/influencers-are-the-new-brands/#41461a577919>.

<sup>17</sup> Halbert, *supra* note 15.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> ALEXA CHUNG, U.S. Trademark Reg. No. 5,320,502, [http://tsdr.uspto.gov/#caseNumber=87144311&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=87144311&caseType=SERIAL_NO&searchType=statusSearch).

<sup>22</sup> A Stylized, U.S. Trademark Application Ser. No. 87/462,767, [http://tsdr.uspto.gov/#caseNumber=87462767&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=87462767&caseType=SERIAL_NO&searchType=statusSearch).



As touched upon above in the brief discussion of the concept of double-trademarking, it is important to consider the display, position, and use of each unitary mark in a co-branding situation.<sup>23</sup> To aid in preserving the goodwill associated with each independent trademark, the two marks should each appear on the underlying goods in the same manner as if each mark were used as the sole brand on the goods, with the result being that each mark “create[s] a separate and distinct impression, in and of itself, from the other marks and that each, in fact, serves purchasers as a means to identify and distinguish the product or service from other products in commerce.”<sup>24</sup> Such use should operate to reinforce the rights the brand owner has in the mark based on existing trademark registrations applicable to the use of the singular brand trademark on goods in a traditional manner, and can help in establishing goodwill in the brand if it is being applied on goods in a new or related product category.<sup>25</sup> While traditionally co-branded partnerships have presented the individual party trademarks in a sequential approach, not unlike the format discussed by Saul Lefkowitz in his TMR article,<sup>26</sup> recent approaches to co-branding have shown a more fluid interpretation of “side-by-side” brand presentation and have displayed the two brands both in a top-to-bottom display and in the more traditional left-to-right display. Ultimately, so long as the presentation of the two brands functions to aid consumers in determining the two separate sources for the underlying co-branded product, as well as the separate contributions and functions of the source entities, it appears that consumers have been willing to accept more creative presentations of the two brands.<sup>27</sup>

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<sup>23</sup> Lefkowitz, *supra* note 1, at 13.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.* at 27 (noting that “[n]either mark should be used in any manner . . . to cause it to lose its function as an indication of origin. The marks should not be used in a manner likely to cause purchaser confusion as to any source of the finished product, manufacturer, merchant, supplier or competitor.”)

<sup>26</sup> *Id.* at 19.

<sup>27</sup> John R. Morrissey, *Double Trademarking in Canada*, 73 TMR 28, 44 (1983) (Morrissey argued that trademark owners should not use a format such as Brand 1 for Brand 2 or



One influencer who has partnered with multiple brands and has adopted co-branding presentations that are less traditional is the model Gigi Hadid. Ms. Hadid, with more than 35 million Instagram followers<sup>28</sup> and a successful modeling career including runway work for the top fashion houses, has recently co-branded with two American fashion brands, as explained below, in very different and less traditional ways. In so doing, she has tested the trademark use of both her full name, Gigi Hadid, and the use of her nickname, “Gigi,” without attaching her surname, despite having only filed a pending application for trademark rights in multiple fashion classes of goods for the pairing of the two names, GIGI HADID.<sup>29</sup>

Her involvement with Stuart Weitzman elevated her role with the Stuart Weitzman brand beyond an exclusive modeling engagement as the face of the brand to a near co-branded relationship, whereby Ms. Hadid has collaborated on footwear designs for limited-edition products. The first collaboration was a limited-edition boot style released in 2016, which bore her nickname, “GiGi,” as the product style name.<sup>30</sup> The product packaging featured Ms. Hadid’s initials, “GH,” in handwritten script overlaying the Stuart Weitzman brand name on the product packaging.<sup>31</sup> Were the “GH” initials and “XO” to be removed from this packaging, it would otherwise resemble the standard Stuart Weitzman product packaging.

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Brand 1 by Brand 2, arguing that consumers might perceive such composite marks as “being a single mark.”)

<sup>28</sup> Gigi Hadid’s Instagram account, <https://www.instagram.com/gigihadid/?hl=en> (last visited Aug. 21, 2018).

<sup>29</sup> U.S. Application Serial Number 87/171,410. Ms. Hadid originally filed in Classes 3, 9, 14, 18, and 25, which represent the most common goods sold as fashion articles, namely, fragrances, eyewear, jewelry, handbags and small leather goods, apparel, footwear, and related fashion accessories. This application also seeks to register the trademark in connection with online retail store services and retail store services in Class 35. Following an opposition filed by Graphic Image, Inc., Ms. Hadid elected to voluntarily remove Class 18 from her application. The United States Patent and Trademark Office published a Notice of Allowance for all other classes of goods and the Class 35 services class in Ms. Hadid’s application on March 6, 2018. Ms. Hadid is also the listed applicant to register the trademark HOUSE OF G in connection with the same types of fashion articles in Classes 3, 9, 14, 18, and 25, as well as for services in Class 35. The Notice of Allowance issued March 28, 2017, and the application has a 1B filing basis.

<sup>30</sup> Stephanie Chan, *See the Boots Gigi Hadid Designed with Stuart Weitzman*, Hollywood Reporter (Oct. 25, 2016), <https://www.hollywoodreporter.com/news/gigi-hadid-partners-stuart-weitzman-gigi-boot-941014>.

<sup>31</sup> Kristina Rodulfo, *Gigi Hadid Is Now Designing Shoes for Stuart Weitzman*, Elle (Oct. 25, 2016), <http://www.elle.com/fashion/news/a40255/gigi-hadid-stuart-weitzman-boots/>.



*The Stuart Weitzman “Gigi” Boot and packaging*

Ms. Hadid’s second limited-edition collaboration with Stuart Weitzman debuted for the 2017 fall season.<sup>32</sup> The “Eyelove” and “Eyelove More” mule styles shown below provide better images of the sock linings used for these product offerings and show that the brand partners have chosen to display their trademarks in a traditional co-branding manner, whereby the individual trademarks are shown separately, but in sequence with the other brand. In this instance, Ms. Hadid’s nickname, “Gigi,” appears above a heart icon and the “Stuart Weitzman” logo appears below the same heart icon.



*The Stuart Weitzman “Eyelove” and “Eyelove More” Mule Styles*

<sup>32</sup> Chrissy Rutherford, *Gigi Hadid’s New Shoe Collab with Stuart Weitzman Is Here*, Harper’s Bazaar (Nov. 15, 2017), <http://www.harpersbazaar.com/fashion/models/a13143625/gigi-hadid-stuart-weitzman-mule/>.

Testing the use of “Gigi” in the context of a co-branding relationship with Stuart Weitzman for limited-edition products has presumably been a valuable exercise for Ms. Hadid, likely reinforcing that there is some brand strength and brand recognition in her nickname, with potential as a stand-alone trademark. However, she faces registration obstacles in pursuing this brand for all fashion classes of goods, due to the prior rights held by Graphic Image, Inc. (“GII”), in the registered trademark GIGI NEW YORK for key cases; leather and imitation leather bags; leather bags and wallets; leather bags, suitcases, and wallets; and leather cases.<sup>33</sup> GII has held these Class 18 rights based on use since at least November 15, 2010, and filed a 2016 application for the stand-alone trademark GIGI for identical goods, which matured to registration in 2018.<sup>34</sup> After GII filed a Notice of Opposition<sup>35</sup> challenging the registration of the trademark GIGI HADID in Class 18 for use in connection with handbags and related products, Ms. Hadid voluntarily elected to remove Class 18 from her application to register GIGI HADID for handbags and other related bags and small, leather-good types of fashion accessories.<sup>36</sup>

This pre-existing use of GIGI NEW YORK by GII in Class 18 proved to be an obstacle that required re-branding of the co-branding relationship that Ms. Hadid developed with designer Tommy Hilfiger. In contrast to the Stuart Weitzman limited-edition co-branded product, which retains much of the core Stuart Weitzman branding, the co-branding by Ms. Hadid and Tommy Hilfiger positions the GIGI HADID trademark in equal, if not greater, prominence with the established Tommy Hilfiger fashion-brand trademark. The below early advertisement for the co-branded collection shows use of GIGI as a stand-alone mark, which use was challenged by GII for its GIGI NEW YORK trademark. GII sent Tommy Hilfiger a cease-and-desist letter regarding the prominent and stylized use of Ms. Hadid’s first name, GiGi, as a separate and additional legal challenge to GII’s opposition of her GIGI HADID trademark application in Class 18.

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<sup>33</sup> GIGI NEW YORK, U.S. Trademark Reg. No. 4120920, [http://tsdr.uspto.gov/#caseNumber=85336707&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=85336707&caseType=SERIAL_NO&searchType=statusSearch).

<sup>34</sup> GIGI, U.S. Trademark Reg. No. 5489228, [http://tsdr.uspto.gov/#caseNumber=87159781&CaseType=SERIAL\\_No&SearchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=87159781&CaseType=SERIAL_No&SearchType=statusSearch) (suspension of this application was lifted after Opposition No. 87159781 terminated, involving an unrelated registration dispute with Xcel Design Group, LLC for their GIGI PARKER trademark).

<sup>35</sup> Notice of Opposition, Graphic Image, Inc. v. Jelena Hadid, Opposition No. 91237010, <http://ttabvue.uspto.gov/ttabvue/v?pno=91237010&pty=OPP&eno=1> (T.T.A.B. Jan. 19, 2018).

<sup>36</sup> GIGI HADID, U.S. Trademark Application Ser. No. 87/171,410, [http://tsdr.uspto.gov/#caseNumber=87171410&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=87171410&caseType=SERIAL_NO&searchType=statusSearch).



Following receipt of this cease-and-desist letter, and the likely discussions among the parties, the GIGI HADID and TOMMY HILFINGER co-branding presentation has been redesigned and the brands have been combined to form a co-branded logo or composite trademark, which is applied to the products in the limited collections both on hangtags and labels. This redesigned presentation of the co-branded collection debuted with the second collection of co-branded goods and makes use of Ms. Hadid's surname and the TOMMY HILFINGER stylized trademark in the re-branding.<sup>37</sup> After two successful limited-edition collections, Tommy Hilfiger's parent company, PVH Corp., renewed the partnership with Gigi Hadid for another two collections.<sup>38</sup>



Interestingly, the co-branded goods have been dubbed in text or print as the “TommyxGigi” collection,<sup>39</sup> which presents the first name and nicknames of the personalities involved in the co-branded goods in a more traditional side-by-side approach. This approach in written press and other consumer messaging perhaps helps to

<sup>37</sup> Steve Brachmann, *Tommy Hilfiger's Gigi Hadid fashion line targeted by GiGi New York in cease and desist letter*, IPWatchdog (Sept. 22, 2016), <http://www.ipwatchdog.com/2016/09/22/tommy-hilfiger-gigi-hadid-fashion-cess-desist-letter/id=73055/>.

<sup>38</sup> Lisa Lockwood, *Gigi Hadid renews contract with Tommy Hilfiger for 2 more seasons*, L.A. Times (May 11, 2017), <http://www.latimes.com/fashion/la-ig-wwd-gigi-hadid-tommy-hilfiger-renews-contract-20170511-story.html>.

<sup>39</sup> *Id.*

reinforce the identities and sources for the co-branded articles in the minds of the consumers, while enabling the two brands to take a more creative approach in the presentation of their brands as affixed to the co-branded fashion articles in the collection.

This discussion of Ms. Hadid's growing brand expansion, through her co-branding efforts with Stuart Weitzman and Tommy Hilfiger, brings to the foreground some risks involved for established brands in partnering with influencers who have yet to establish goodwill in their own brand and have not secured trademark rights and registrations for their brand. While Stuart Weitzman did not have to respond to a challenge by GII, Tommy Hilfiger likely had to use corporate resources to respond to GII, which further resulted in Hilfiger suspending its use of already developed marketing materials and creating a new composite mark with Ms. Hadid for their co-branded collection.

Consider as well the composite or co-branding trademark representation adopted by Ms. Hadid and Tommy Hilfiger for their second collection of co-branded products. Arguably, the trademark use for the Tommy Hilfiger brand is consistent with the filed trademark registrations owned by Tommy Hilfiger Licensing LLC, as shown below in the multi-class United States Trademark Registration 4,745,262:<sup>40</sup>

### T O M M Y H I L F I G E R

However, contrary to traditional thought, the composite presentation of the two brands in the revised GIGI HADID and TOMMY HILFIGER co-branding logo seems to convey to the consumer that Ms. Hadid is the predominant source for the co-branded products, even though the products are manufactured by Tommy Hilfiger. Also, the composite presentation splits or divides Ms. Hadid's name so that "Gigi" appears above the Tommy Hilfiger mark and "Hadid" appears below it. This use is not consistent with the GIGI HADID trademark application that Ms. Hadid has on file to secure rights in her name across multiple product classes and may not have sufficed to provide her with appropriate specimens of use to convert her intent-to-use trademark application into a use-based application.<sup>41</sup> However, trademark counsel for Ms. Hadid has avoided any examiner rebuke with respect to the trademark use by submitting evidence of trademark use that presents the GIGI HADID and TOMMY HILFIGER collection products on ASOS.com

<sup>40</sup> TOMMY HILFIGER and Design, U.S. Trademark Reg. No. 4,745,262, [http://tsdr.uspto.gov/#caseNumber=86976094&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=86976094&caseType=SERIAL_NO&searchType=statusSearch).

<sup>41</sup> GIGI HADID, U.S. Trademark Application Ser. No. 87/171,410, [http://tsdr.uspto.gov/#caseNumber=87171410&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=87171410&caseType=SERIAL_NO&searchType=statusSearch).

as only GIGI HADID-branded products.<sup>42</sup> Even if the recent approach to segment the GIGI HADID trademark with the TOMMY HILFIGER trademark was adopted after negotiations with the owners of the GIGI NEW YORK brand to avoid potential consumer confusion, the resulting co-branded logo may not provide the best protection for each of the individual brands involved, as such use may not suffice to reinforce the registered use of the individual trademarks in the long term. However, considering the consumer response to this co-branded presentation, it adds further credence to the changing approach within the fashion industry to co-branding, and seems to indicate that consumers may look to the influencer as the creative driving force behind such a brand partnership and the more important “brand source,” akin in the past to the manufacturer as the more important brand source for the co-branded product. So, does this mean the consumer will turn to Ms. Hadid for product liability claims? No, but it does seem to indicate that the consumer has a stronger interest in believing Ms. Hadid “influenced,” designed, or originated the creative aspects of the collection and that consumers are generally more sophisticated with respect to modern approaches to co-branding and the respective contributions of the paired brands and source entities for those brands.

#### IV. CONCLUSION

Fashion companies will continue to use licensing opportunities as a means to expand their branded-product offering and reach new consumer segments using traditional arrangements, including co-branding, or double-trademarking, with other established brands. While traditional co-branding created cross-over audiences and product-category partnerships, such as Apple and Hermes producing compatible leather watch bands for the APPLE WATCH and a special Hermes-branded APPLE WATCH edition, the newer co-branding approach between established brands and influencers aims more often to elevate the existing products of an established brand by partnering with an influencer to target that influencer’s digital audience.<sup>43</sup>

As discussed in this commentary, these newer types of co-branding partnerships between established brands and social media influencers range from minor design collaborations for limited-edition products to a fully integrated co-branding relationship for

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<sup>42</sup> <http://tsdr.uspto.gov/documentviewer?caseId=sn87978477&docId=SPE20180907154818#docIndex=5&page=17> (referencing <https://us.asos.com/hilfiger-denim/tommy-hilfiger-gigi-hadid-crop-roll-neck-sweater/prd/10217806>).

<sup>43</sup> Lisa Lockwood, *Gigi Hadid renews contract with Tommy Hilfiger for 2 more seasons*, L.A. Times (May 11, 2017), <http://www.latimes.com/fashion/la-ig-wwd-gigi-hadid-tommy-hilfiger-renews-contract-20170511-story.html>.

entire fashion collections. Such collaborations and co-branded use of trademarks should operate to reinforce the individual rights each brand owner has in its mark based on existing trademark registrations, which can help establish goodwill in the brand if it is being applied on goods in a new or related product category.<sup>44</sup> The majority of these newer co-branding relationships between brands and influencers appear to preserve the trademark goodwill for each party, such as Alexa Chung for AG,<sup>45</sup> if not enabling most of the goodwill to inure to the benefit of the established fashion brand, consistent with traditional double-trademarking approaches that emphasized placement of the manufacturer's trademark before the distributor's trademark when displayed side-by-side.<sup>46</sup> However, some co-branding ventures between fashion brands and influencers, including the Gigi Hadid and Tommy Hilfiger relationship, have co-mingled their individual trademarks, resulting in a further expansion of the established notions of double-trademarking as well as calling into question whether the modern consumer deems it more important to identify the creative source or the manufacturing source behind a co-branded product line.

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<sup>44</sup> *Id.* at 27 (noting that “[n]either mark should be used in any manner . . . to cause it to lose its function as an indication of origin. The marks should not be used in a manner likely to cause purchaser confusion as to any source of the finished product, manufacturer, merchant, supplier or competitor.”)

<sup>45</sup> Lauren Cochrane, *How to wear denim like Alexa Chung*, *The Guardian* (Jan. 16, 2015), <https://www.theguardian.com/fashion/fashion-blog/2015/jan/16/-sp-alexa-chung-ag-five-great-ways-to-wear-denim>.

<sup>46</sup> Lefkowitz, *supra* note 1, at 19.