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J.D. Waffler: The Art of Taking a Position

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Would it surprise you to learn that not all trademark types are created equal? I didn't think so. Like any profession, some of the professionals are better and more gifted than others. A few are much better. And, if bell curves have any application here, a few are much worse too.

In the inaugural post for DuetsBlog, last March, we introduced a type of trademark attorney known as "Dr. No," and we discussed how he or she likes to focus on the "Parade of Horribles" instead of creative solutions to difficult and important problems:

The underlying personal brand promise for this lawyer is to say “no,” early and often, believing an enormous hourly rate is still justified by citing a multitude of technical and valid legal reasons in support of the unhelpful answer. He is obsessed with saluting to the Parade of Horribles. He is typically part of the problem, not the solution. Perhaps repeated frustration with this kind of Dr. No is what motivated one cartoonist to brand (uh, jab) the “trademark attorney” as “the most basic figure," at least in the world of Art.

Avoiding the "Dr. No" moniker and mindset should not be the only goal of trademark types. There is clearly room for improvement in our profession in other areas too.

Gather 'round, it's time to meet J.D. Waffler.

Waffler's initials are J.D. because he or she has earned the coveted Juris Doctor degree. One of the valuable skills J.D. learned in law school is how to spot all the possible legal issues in any given fact scenario -- no matter how remote the risk of each might be. Another important learned skill is to be able to identify the strongest legal arguments on each side of an issue. Who wins? Well, you might be surprised to know, that's not as important in law school, so long as you can make the arguments on both sides of the issue. But, who wins is important in the business world, so good trademark lawyers must learn to adapt and evolve, in order to become useful members of any multidisciplinary team.

In short, J.D. Waffler's problem is, well, a proclivity for waffling.

He or she doesn't practice the art of taking a position, at least on a regular basis. Perhaps fearful of choosing the wrong side makes sitting on the fence the preferred course of action for J.D. Waffler. He or she is much more comfortable telling you both sides of the story and ends up providing this kind of invaluable advice: "It could go either way," "you could really flip a coin on this one," "it's six of one and a half a dozen of the other," or "it's no better than a 50/50 shot." Let's just say, that is pretty safe advice, assuming the clients don't demand more.

Taking a legal position and providing valuable advice -- in the trademark world -- is definitely an art, not a science. Trademark decisions are highly subjective, fact intensive, and they often involve balancing and weighing multiple factors and keeping track of all the unknowns. In many instances, these are not the easiest of legal risk assessments. Moreover, unlike going to your favorite M.D. who is able to tell you with complete confidence there is a 2% chance of x, y, or z happening, when they perform a particular surgical procedure, your favorite J.D. doesn't have access to those kinds of reliable statistical resources. Nevertheless, this legal deficit doesn't excuse failing to pick a side.

Yet, lawyers are smart, especially trademark types. Some of them have learned they do need to pick sides, take and defend a position, at least barely, even when it comes to their communications with clients. I'm hoping we can agree, however, that phrases like "better than even chance of winning" aren't a huge improvement from the flip-of-the-coin mindset. It still begs the question of how much the lawyer really likes or dislikes your argument, defense, case, or proposed trademark.

We don't make this stuff up. In a trademark litigation where we were arguing for our adversary's bad faith adoption and use of a confusingly similar mark, opposing counsel provided a copy of the search report and opinion in the hope of refuting the bad faith allegation. What the documents revealed, however, was the trademark attorney's opinion that the client had "a better than 50% chance" of success. Taken literally, the flip side also means the attorney believed the client had a 49.999% chance of losing, so how valuable is that opinion, really?

Trademark Types: We can and should do better.

Marketing Types: You can and should expect more.

So, given all that, in your opinion, what are the attributes that move a trademark type from being good to great? And, where does the quality of "taking a position" rank for you in the mix of those attributes?