



AIMING FOR A MARK YOU CAN PROTECT

TRADEMARK PRO JASON ZEDECK ('98) ADVISES CLIENTS ON WHAT'S IN A NAME

When you search the Internet for a word or phrase, do you just “google it,” or do you use the search engine owned by Google? Why shouldn't a manufacturer of brown chairs call itself The Brown Chair Company? These are the kinds of issues trademark law expert Jason Zedeck ('98) navigates every day at his eponymous Los Angeles-based firm. “The name's the thing,” as he says.

The former IP counsel for Fox Entertainment Group, Zedeck opened his own practice three-and-a-half years ago as an established authority on selecting, protecting and expanding trademarks and domain names. “I love almost every minute of it,” he says.

His interest in the field began shortly after law school while working at an entertainment law firm as a litigator. He began volunteering for extra trademark cases on top of his regular workload because “it helped me distinguish myself and was something I enjoyed doing.” After hours of extra work and learning on the fly, Zedeck had established himself as the “go-to” trademark lawyer in his office.

During his third year at the firm, he emailed Fox Entertainment Group in response to a job posting to ask if they might be interested in someone with his experience. They immediately invited him for an interview and, shortly thereafter, hired Zedeck into trademark enforcement and opposition.

During his eight years at Fox, he oversaw various IP issues across the studio, including film, television, merchandising and social networking channels. “I loved working at Fox,” Zedeck says. “You're working with creative people, and you're also working with marketing and corporate, and trying to combine all the interests.”

Zedeck's trademark savvy proved essential throughout his time at Fox. “Someone would have a vision, and the challenge was trying to facilitate that vision, especially with a trademark,” he says.

Marketing teams often proposed literal show titles to describe a new program, suggesting generic names like “Doctors,” that a target audience could grasp effortlessly. “But from a trademark standpoint... you can't register and protect that,” Zedeck explains. “You can't stop another series from talking about doctors, or using “Doctors” as part of the title any more than you could register that generic name with the Patent and Trademark Office. Descriptive marks don't usually stand,” he says. “You want to make sure that you have a mark you can protect.” By the time Zedeck had risen to senior IP counsel, he was well versed in this argument.

As the resident expert, Zedeck was frequently asked throughout his time at Fox if he knew any lawyers that could help with trademark-related issues. Recognizing a need for such counsel outside big firms and specialized boutiques, he opened his own shop in 2009.

He now crafts customized, comprehensive trademark strategies for not only entertainment organizations, but also restaurants, clothing companies, ski resorts and more. The first order of business? Selecting a good name.

“I think the nature of the law is that a keyword may not constitute trademark infringement, but I think there's more pressure on trademark owners to select a good name.” He advises clients to choose a distinctive word that does not mean anything, like Google or Xerox, over a descriptive name (think The Brown Chair Company). Invariably, most clients want to start with a name that simply describes what they are selling.

It's interesting work in a day and age when consumers are constantly bombarded with branding and messaging — and when competitors, cyber-squatters and third-party entities can buy keywords and domain names to keep from, or sell to, a company that is not vigilant.

“I think the nature of the law is that a keyword may not constitute trademark infringement, but I think there's more pressure on trademark owners to select a good name.”

Zedeck helps his clients navigate these pitfalls with the old adage, “An ounce of prevention is worth a pound of cure.” He says it is crucial to be proactive and register a trademark and domain name — even a Twitter and Facebook handle — prior to announcing a company name. After all, “it's much cheaper to get them from the outset rather than trying to buy it from somebody else.”

In addition to providing outside counsel, Zedeck also serves as “in-house” trademark counsel for several of his largest clients. “It combines the best of what I loved about my prior positions at a law firm and in-house at Fox,” he says. “And I control my own hours.”

That means he is able to keep his booming business running and still be home to have dinner with the kids and his wife, whom he met during his first year at BU Law.

“Every step I took to get here was the right step,” he says. “I don't think I would be where I am doing what I love doing without taking each of those steps.” ■