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# Eight Rules for Working Successfully with Trade mark Investigators

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Thorough and accurate market intelligence is essential for brand owners when they are launching new brands, defending their brands against infringement, or considering expanding brands into new business categories or geographies. Very often, those efforts involve the use of outside investigators to uncover and document valuable information. But opportunities for missteps abound.

For investigations to be as fruitful as they can be, trust and clear communication between client and investigator are essential. Keeping these eight best practices in mind will minimize your risk of inadvertently undermining your own investigation and will help to put it on solid footing from the beginning.

### **1. Tell us everything you know.**

Investigations are about uncovering missing information. But doing so effectively requires starting with all the information you have at your disposal. Sometimes clients are reluctant to disclose details because of confidentiality issues, but those concerns should be assuaged by the investigator's professional standards, reinforced by the customary non-disclosure agreements. Some clients intentionally withhold information in the mistaken belief that doing so allows them to test the investigator's capabilities.

But this only results in duplication of effort and a final report full of information the client already knows-often at greater cost to the client.

Understanding what the client knows - and how they know it-provides investigators with a firm foundation from which to start and with essential context for the case. And because investigators can be counted on to independently test the client's assumptions, any weaknesses in those assumptions will be identified, thus refining and improving the client's market awareness.

### **2. Warn us if we're walking into crossfire.**

It's essential for investigators to know if the assignment relates to current or potential litigation. It is common practice in IP-related investigations for investigators to attempt to gather information by contacting the opponent or related parties without revealing the full nature of their inquiry (if permissible and, of course, while complying with the law). If there is an ongoing dispute, however, everyone on the other side will be on the alert-a situation that can have embarrassing consequences, or that requires a different approach. In one case, a call was made to an opposing party under

some guise, and a long conversation provided what seemed to be very useful information. At the end of the call, the party let it be known that they knew they were speaking to investigators representing their opponent, thus calling the validity of the information into question. They had been warned by their lawyers to expect such a call, but the client had not informed their investigators of the legal dispute driving the investigation.

### **3. We need to know the ultimate client.**

We need full disclosure regarding the nature of an assignment even when we are engaged by a law firm rather than by the client directly. Just like lawyers, investigators need to conduct conflict checks before embarking on engagements-something which cannot be done if we don't know for whom we are working. The results of such ignorance can be disastrous: Investigators kept in the dark have ended up working on both sides of the same dispute, or even ended up investigating what turned out to be their own client.

### **4. If you're thinking about a purchase in the end, let us know at the start.**

If you may eventually attempt to buy the mark, we need to factor that into the investigation approach, including if and how we contact the other side. We may well be negotiating a subsequent acquisition with these same people. This caveat applies to domain names as well.

### **5. Don't make a mess of it.**

Clients sometimes attempt to forego the expense of independent investigators and try to do the job themselves. But these efforts almost always backfire when amateurs move beyond internet searches and pick up the phone to try to surreptitiously gather information from the other side. The people being contacted almost always see through inexperienced attempts at obfuscation - sometimes by doing little more than asking for a call-back number or an email address with which to follow up.

Professional investigators have technology, infrastructure, and training to conduct such discreet communications. And once an investigation subject senses that something is up, it can be all-but-impossible for us to undo the damage.

### **6. Keep the goal in mind.**

Trade mark investigations are like any other endeavor: ill-defined goals lead to unfocused results. Setting priorities from the start also allows for the investigation to proceed in a cost-effective manner. Narrow the product classes and jurisdictions to those of the greatest strategic importance. In the same vein, remember that trade mark investigations are about trade marks. While this may seem obvious, there can be

an understandable temptation to use the investigation as a wish list to fill in general business intelligence gaps. Investigators can gather information to estimate sales volumes for a competitor's various brands or to map their supply chains-but the goal of these efforts must be clear at the start, and they will add to the cost and turnaround time of the engagement.

### 7. Be realistic regarding costs and deadlines.

Investigations almost always follow circuitous paths; if gathering the information was straightforward, you wouldn't need an investigator to do it. Yes, business situations and developments sometimes create genuine urgency, and investigators do their best to deliver against those timeframes. But remember that rushed deadlines and shoestring budgets frequently result in information that is uncorroborated and possibly inaccurate. Corroboration-an essential part of the investigation process-effectively means that we're doing our intelligence gathering two or three times. It also helps to be clear about your timing expectations. "Urgent" is ambiguous; "We need results in five working days" is much less so.

### 8. Remember that we're dealing with people.

Internet searches and database queries are important components of investigations but often only provide a foundation. In the end, it's usually people-suppliers, former employees, competitors and others-who give us the insight and knowledge that we need cut to the chase and connect the dots. Cultivating those sources and obtaining that information (while staying within legal constraints and not alerting the other side) is a challenge investigators relish. And there's nothing more rewarding than taking on an "impossible" case and finding the smoking gun or that elusive final piece to the puzzle. But we're still dealing with people and all the limitations inherent in doing so: faulty memories, personal motivations, and sometimes just a straight-out refusal to speak to us. Experienced investigators have many techniques with which to work around these hurdles, but they are not always insurmountable.

Trade mark investigations are full of challenges. Solid communication with your investigator, realistic expectations and a strategic mindset will help prevent the creation of new obstacles and keep the investigation on the path to success.



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**Kelsey Froehlich** is a Partner in the London office and co-heads the Mintz Group's Intellectual Property Investigations practice with **Graham Robinson**. She specializes in investigations related to due diligence and cross-border asset-tracing, and in complex civil litigation matters and commercial disputes. A Certified Fraud Examiner, Kelsey conducts investigations on matters around the world for international law firms, executive search firms, corporations and not-for-profit institutions.

Kelsey's recent work has included: investigating allegations of negligence and fraud at a government security contractor; getting behind an infringing website run by shell companies in Eastern Europe; uncovering efforts by a Chinese company to hide assets related to counterfeit products; investigating self-dealing by executives at large financial firms in Europe and the U.S.; and performing background investigations on executives and potential business partners and litigation opponents.

Prior to joining the Mintz Group, Kelsey worked as a research consultant for Deloitte & Touche and the Centre for Economic and Social Inclusion in London, where she did econometric and qualitative research in infrastructure procurement, employment policy and economic development.

Kelsey has an M.P.A. in public and economic policy from the London School of Economics and a B.A. cum laude in political economy from the University of California, Berkeley.



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