

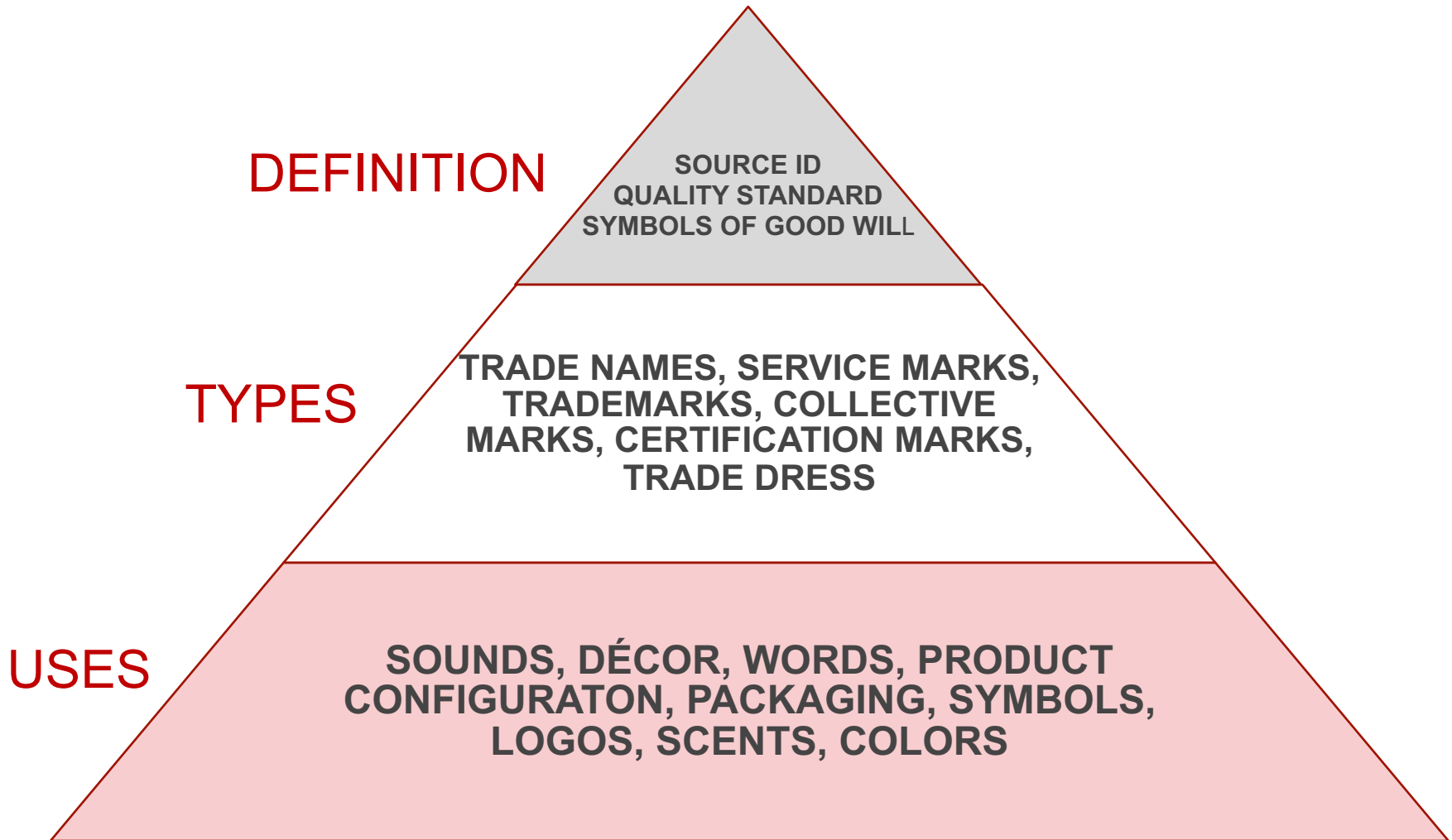
# **TRADEMARK LAW** **PROTECTION,** **ENFORCEMENT** **AND LICENSING**

August 14, 2020

Adam Brookman, Shareholder, Boyle Fredrickson

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# TRADEMARKS



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# TRADEMARK RIGHTS



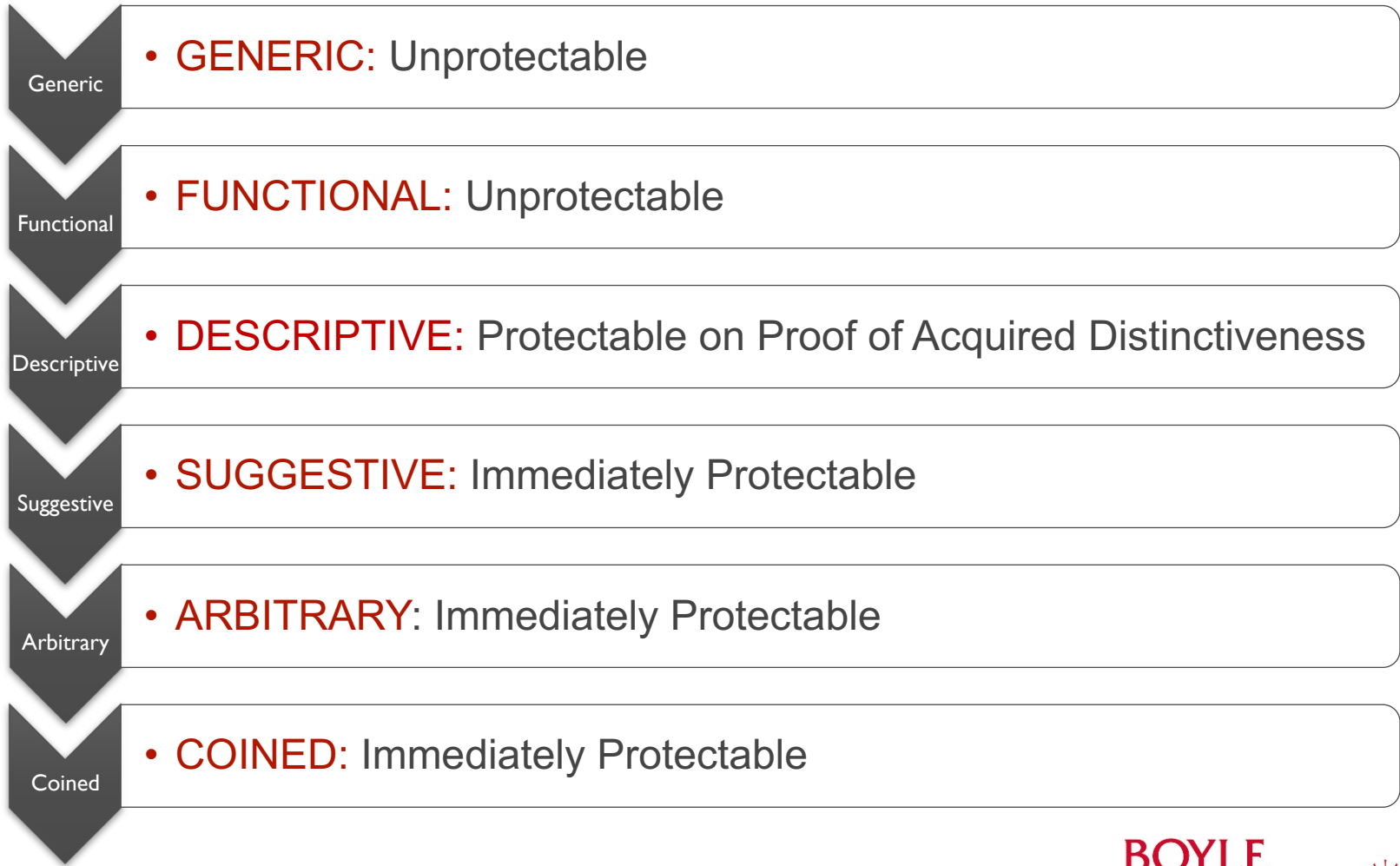
- **In the U.S., rights are acquired through use not registration**
  - This means that the first USER has superior rights
    - Proof of use is required for registration and renewal
- **Outside the U.S., rights are more commonly acquired through registration NOT use**
  - This means that the first FILER has superior rights
    - Proof of use is generally not required for registration or renewal
- **Owner has the right to prevent others from using the same or a confusingly similar other mark**



# TRADEMARK PROTECTION

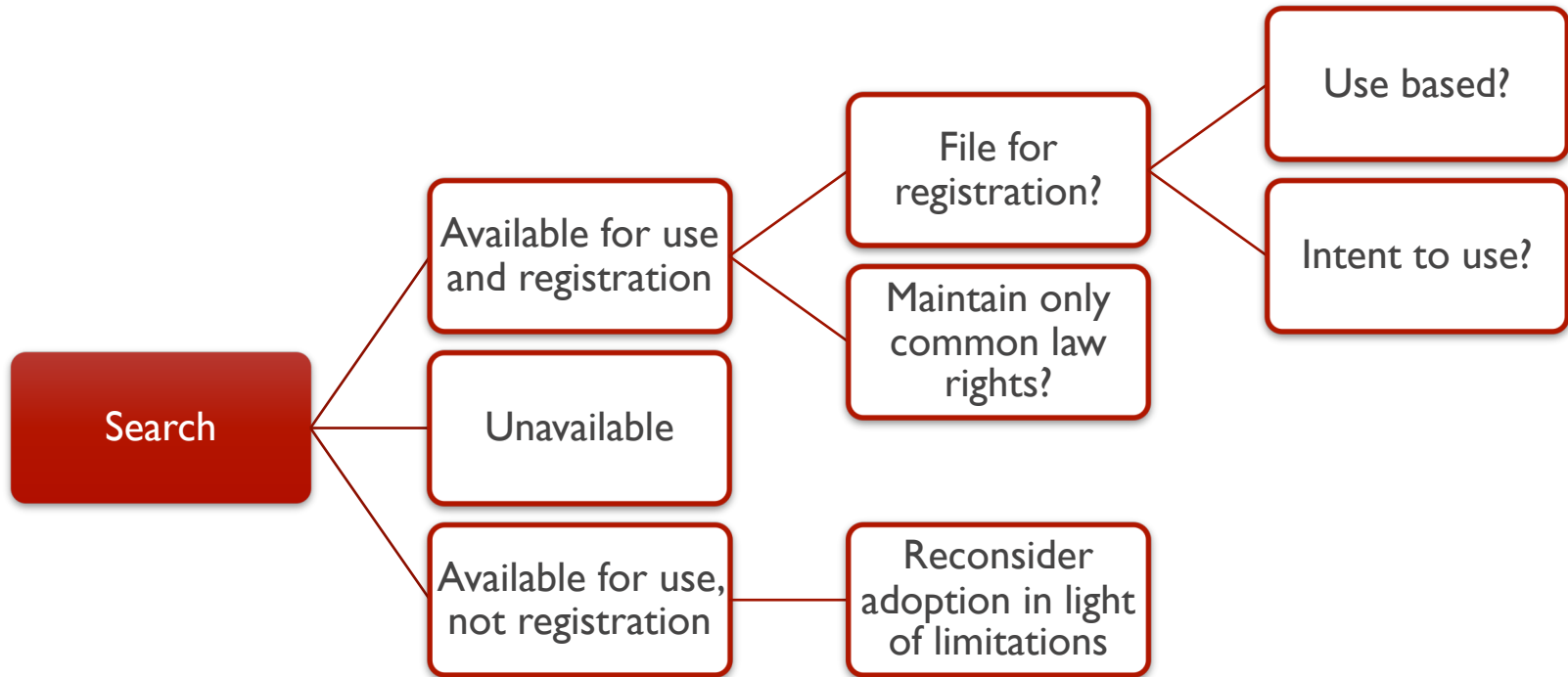
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# DISTINCTIVENESS SPECTRUM



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# TRADEMARK CLEARANCE



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# PROVING USE



## GOODS

- Pictures showing use of the mark on the goods
  - Labels or tags on the goods
  - Etching, printing or molding on or into the goods
- Pictures of point of sale signs displayed with the goods
- Catalogs (online or paper) showing the goods and the mark
  - Must have pricing and ordering information
- Materials shipped with the goods (e.g., manuals)

## SERVICES

- Materials showing use of the mark in the sale or performance of the services
  - The nature of the services should be clear from the materials (e.g., describing the services being offered)
  - Brochures, advertisements, web pages, or solicitations
  - Web pages must include the URL and print date

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# U.S. REGISTRATION: PROS & CONS

PROS

Block third party registrations  
Presumptive nationwide use  
Increased visibility of mark  
Can use ®  
Incontestability after 5 years  
Can sue for infringement of registered mark  
Potential increased damages  
Can file foreign based on US filing

Cost  
Time and effort to maintain  
Increased visibility of mark

CONS





# FOREIGN REGISTRATION

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# GAMES PEOPLE PLAY



- Since most countries do not require use, third parties can register marks to sell them or gain leverage
  - Local distributors and local manufacturers often file on marks of the entities with whom they work to preclude termination of their relationships
  - Competitors can file on and then use or preclude the original trademark owner from using the mark to sell its goods or services
  - Employees who wish to set up competing businesses or who wish to have leverage in the event of termination can file for trademarks

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# FOREIGN FILING CONSIDERATIONS

## GOODS

- Where are the product sold?
- What are the key markets for the product?
- What are the costs to file in each relevant country?
- What are sales of the product in each country?
- Where is the product manufactured?
- Where would a third party manufacture the product?

## SERVICES

- Where are the services being sold?
- What are the key markets for the services?
- What are the costs to file in each relevant country?
- What are sales of the services in each country?
- Where are the people located who are providing the services?

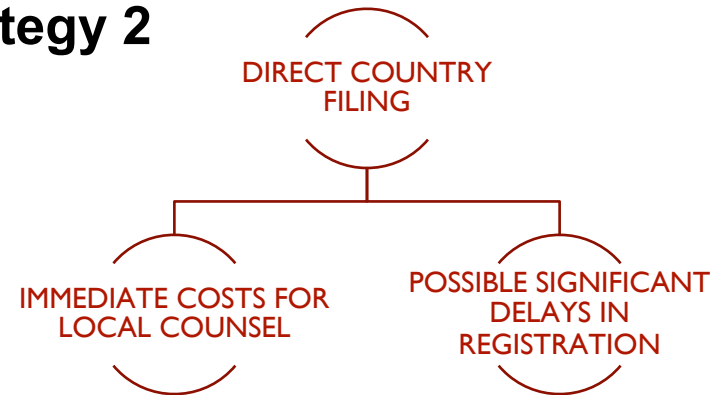
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# FOREIGN FILING STRATEGIES

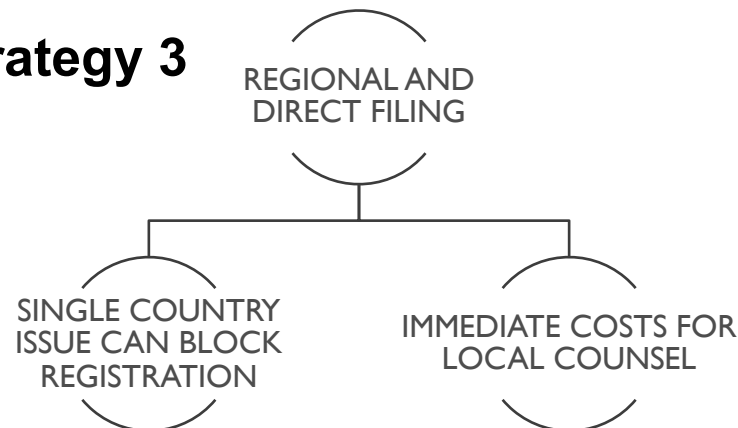
## Strategy 1



## Strategy 2



## Strategy 3





# TRADEMARK ENFORCEMENT

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# CLAIMS AND VENUES

## FEDERAL COURT

TRADEMARK  
INFRINGEMENT OF A  
REGISTERED MARK

INFRINGEMENT OF AN  
UNREGISTERED  
MARK

FEDERAL UNFAIR  
COMPETITION (§43(A)  
OF THE LANHAM ACT)

FEDERAL DILUTION

## STATE COURT

STATE/COMMON LAW  
TRADEMARK  
INFRINGEMENT

STATE/COMMON LAW  
UNFAIR  
COMPETITION

STATE DILUTION  
(WHERE AVAILABLE)

## USPTO

OPPOSITION TO  
REGISTRATION

PETITION TO CANCEL  
REGISTERED MARK

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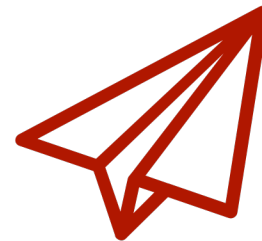
# DEFENSES TO INFRINGEMENT AND UNFAIR COMPETITION CLAIMS

- Fair Use
    - Comparative Advertising
    - Authorized Sales
    - Truthful Identification of Source
    - Not Trademark Use
  - Prior Use
- No Likelihood of Confusion
  - Genericness
  - No Acquired Distinctiveness
  - Functionality
  - Naked Licensing
  - Abandonment

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# REMEDIES

- Injunction Against Future Use
- Corrective Advertising
- Seizure/Destruction
- Lost Profit Damages
- Defendants' Profits (Unjust Enrichment)
- Punitive/Enhanced Damages
- Attorneys Fees







# TRADEMARKS IN CONTRACTS

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# CONTRACT SITUATIONS

- Licensing
  - Use by suppliers, distributors and end users for Licensor's benefit
  - Use by third party for its own benefit
- Bankruptcy
- Litigation
  - Settlement
- Mergers and Acquisitions



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# QUESTIONS?



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