

ACC Charlotte: Why and How to Police your Intellectual Property

Brought to you by Shumaker's Intellectual Property Team

Moderated by: Patrick B. Horne

Panelists: Christina Davidson Trimmer, Katie Gromlovits, Tom BenGera, with
guest Burgin Hardin from Boy Scouts of America

Why should trademark owners police their marks?

Katie Gromlovits

- Duty to enforce
- Retain brand value
- Prevent loss of rights
- Prevent consumer confusion

How should trademark owners police their marks?

*Katie Gromlovits
Burgin Hardin*

- Search engine/internet searching
- USPTO TESS searching
- Domain name searching (Whois information)
- Being knowledgeable about the field and competitors/competitors' marks
- Google[®] alerts
- Making employees aware of trademarks and how to spot confusion issues
- Watch Services

Choose your language

English ▼

IP Theft Form

Welcome to CrossFit, LLC's IP Theft reporting form, where you can assist us in protecting our intellectual property rights around the world. Here, you can submit confidential reports to CrossFit, LLC's legal department if you suspect an individual or entity is using CrossFit's intellectual property (e.g., trademarks or copyrights) without a license. Our goal is to timely address each and every report made so that we can protect the community that we've worked so hard to create.

Please provide all the information requested below, in detail, to help us determine the nature and extent of the infringement and whether we can pursue the claim.

Please keep in mind the following:

- Information is kept confidential to the extent allowable by law.
- We investigate every report submitted. However, due to the high volume of reports we receive, we do not necessarily respond to every reporter with an update or status report. If you wish to receive an update, please email legalintake@crossfit.com and provide your report number.
- We cannot provide a timeline for when a case will get resolved due to several variables, including but not limited to, the severity of infringement, resources available, the country in which the allegation is made, and other deadlines required by law.

<https://www.crossfit.com/iptheft>

How should counsel assess the risk of a potential infringement?

Christy Trimmer

Additional Business Considerations:

- What is the scope and extent of the infringing use?
- Is it a fair use (descriptive use)?
- Is it negatively affecting your business or your sales?
- What is the geographic scope of their use?
- Who is the infringer?

How do I assess the risk of a potential infringement?

Christy Trimmer

The Likelihood of Confusion Factors:

- (1) The strength or distinctiveness of the plaintiff's mark as actually used in the marketplace;
- (2) The similarity of the two marks to consumers;
- (3) The similarity of the goods/services that the marks identify;
- (4) The similarity of the facilities used;
- (5) The similarity of advertising used;
- (6) The defendant's intent;
- (7) Actual confusion;
- (8) The quality of the defendant's product; and
- (9) The sophistication of the consuming public.

As in-house counsel, how do you set your company's enforcement priorities?

Burgin Hardin

Business Considerations:

- Company budget
- Company's tolerance for disputes and litigation
- Relative value of the mark-at-issue to the overall business
- Reputational risk/harm to brand value
- Identity of the "infringer" and type of "infringement"
- The "optics" of enforcement

If I discover a potential infringer, what should I consider before sending a cease and desist letter?

Christy Trimmer

- Make sure you have priority!
- Be aware of the possible declaratory judgment action.
- Be prepared to follow-through.
- Be aware of timing as it relates to potential defenses of laches or acquiescence down the road.
- Consider your tone.

NETFLIX

August 23, 2017

Emporium Arcade Bar
% Danny and Doug Marks
2363 N. Milwaukee Ave
Chicago, IL 60647

Via email (dkmarks@gmail.com, info@emporiumchicago.com)

Danny and Doug,

My walkie talkie is busted so I had to write this note instead. I heard you launched a *Stranger Things* pop-up bar at your Logan Square location. Look, I don't want you to think I'm a total wastoid, and I love how much you guys love the show. (Just wait until you see Season 2!) But unless I'm living in the Upside Down, I don't think we did a deal with you for this pop-up. You're obviously creative types, so I'm sure you can appreciate that it's important to us to have a say in how our fans encounter the worlds we build.

We're not going to go full Dr. Brenner on you, but we ask that you please (1) not extend the pop-up beyond its 6 week run ending in September, and (2) reach out to us for permission if you plan to do something like this again. Let me know as soon as possible that you agree to these requests.

We love our fans more than anything, but you should know that the demogorgon is not always as forgiving. So please don't make us call your mom.

Thanks,



Director/Senior Counsel - Content & Brand IP

Cease and Desist Letters

Christy Trimmer

[Dilly Dilly Video](#)

What are some different options for dealing with a potential infringement concern?

Christy Trimmer

- Cease and Desist Letter
- Informal or third party approaches (take down procedures)
- If federal trademark application is pending – TTAB
- If involving a web domain – UDRP
- If involving importation of infringing goods – ITC
- Litigation

What You Can do in Preparation for Policing Your Patents

Tom BenGera

- Develop, maintain an accurate database of all patents in order to:
 - Pay maintenance fees
 - Keep track of inventors
 - Prevent abandoned applications
- Mark your products (35 U.S.C. § 287)
 - Puts infringers notice
 - Failure to mark can limit potential damages

Policing for Infringers using Internal Resources

Tom BenGera

- Sales personnel are often in the best position to identify new products
 - But they are often not the ones thinking about patent enforcement
- Benefits of a healthy communication between sales and IP counsel:
 - Notice – IP counsel should know what sales reps are aware of
 - Curating what sales reps are saying about the competition
 - Potential to file a continuation to read on new products

What To Do Once You Identify A Potential Infringer

Tom BenGera

- Long term strategy
 - Willing to license or prefer exclusivity?
 - How many other competitors are there?
 - When does the patent expire?
 - Assume any license will be discovered in future litigation
- Put the alleged infringer on notice
 - Starts the clock for certain damages
 - Careful not to create declaratory judgment jurisdiction

(BONUS QUESTIONS) Why should counsel focus early and often on its trademark portfolio?

Katie Gromlovits

Burgin Hardin

Christy Trimmer

- As early as possible
- As part of trademark portfolio management
- Could affect filing strategies
- Better outcome likely if problematic marks found early
- Stronger case for trademark owner if timely policing

Thank you

- [Patrick B. Horne](#)- Partner, Intellectual Property Practice Co-Administrator
- [Christina \(Christy\) Davidson Trimmer](#) - Partner, Innovation Lab Chair
- [Katie Gromlovits](#) – Partner, Certified Trademark Specialist by the North Carolina Bar Board of Legal Specialization
- [Tom BenGera](#) – Intellectual Property Litigation
- Burgin Hardin - Associate General Counsel, Boy Scouts of America