

Bradley

A photograph of a modern building facade with large windows. The word "Bradley" is mounted on the building in a large, white, sans-serif font with a red underline, matching the logo in the top left. The sky is clear and blue.

Bradley

“Because You’re Worth It” How to Build, Protect, and Enforce Your Brand Through Trademark

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Presented by: Tim Capria and Matt DeAntonio

Meet the Speakers



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Selecting your Trademark

- Goals:
 - Distinguish goods or services
 - Build consumer recognition
 - Avoid conflicts with other marks
 - Over 2.7 mil active federally registered U.S. marks
 - Over 800,000 pending applications


What is a Trademark?

How many trademarks do you see?



What is a Trademark?

It is a:

- Word REESE'S (U.S. Reg. No. 5,100,407)
- Symbol 
(U.S. Reg. No. 2,990,202)
- Slogan THERE'S NO WRONG WAY TO EAT A REESE'S (U.S. Reg. No. 1,900,044)

What is a Trademark Cont.?

- Product or packaging shape



(U.S. Reg. No. 186,828 – packaging shape)

- Color



(U.S. Reg. No. 2,256,226 – Pantone 165C)

- Sound

NBC chimes; lion's roar of MGM

(U.S. Reg. No. 916,522; U.S. Reg. No. 1,395,550)

- Or anything else that can be a source indicator (fragrance, design of business, motion, personal name, number); *also* Collective and Certification marks

What is a Trademark?

How many trademarks do you see?



Distinctiveness Spectrum

- Generic
 - APPLE for apples; Aspirin for pain relief drugs
- Descriptive
 - AMERICAN AIRLINES for air transport of passengers
 - U.S. Reg. No. 514,294
- Suggestive
 - BURGER KING for restaurant services
 - U.S. Reg. No. 3,355,280
- Arbitrary
 - APPLE for *computers*
 - U.S. Reg. No. 1,078,312
- Fanciful
 - GOOGLE (for anything!)
 - U.S. Reg. No. 2,884,502

Selecting your Trademark

- Evaluating use or future use
 - Goods, services, or both
 - Geographic scope
 - Timing
- Clearance searching

Building your Brand

- Territorial
 - File for registration
 - Where to file and how to file?
- Use the mark
 - Internationally, some jurisdictions primarily create rights through filing and registration. A junior filer can displace a senior user!

Building your Brand - Registration

- Registrability
 - Not generic, not misdescriptive, etc.
- Availability
 - The “2(d)” refusal
 - 13 *DuPont* factors, but primary focus is typically on two of the 13.
 - File for registration
 - Where to file and how to file?
- With whom to register?

Building your Brand - Registration

- Must a mark be in use to file a trademark application?
- To obtain a registration?
- Providing “use in commerce”
- Consider recordation of registered trademarks with CBP and enrolling in brand registers of online marketplaces (e.g., Amazon.com)
- Consistent and proper trademark use

Policing Trademarks



Three Reasons to Police

1. Trademark Confusion is BAD!

- Point of Sale Confusion
 - As to Product
 - As to Source
- Forward vs. Reverse Confusion
- Initial Interest Confusion
- Non-customer Confusion
- Post-sale Confusion

Three Reasons to Police

1. Trademark Confusion is BAD!

- Point of Sale Confusion
 - As to Product

Advicor or Altacor?



Kos Pharms., Inc. v. Andrx Corp., 369 F.3d 700 (3d Cir. 2004).

Three Reasons to Police

1. Trademark Confusion is BAD!

- Point of Sale Confusion
 - As to Source



Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149 (9th Cir. 1963).

Three Reasons to Police

1. Trademark Confusion is BAD!

- Forward v. Reverse Confusion

BUNNING
CHANGES
EVERY
THING.



Fleet Feet, Inc. v. Nike Inc., 419 F. Supp. 3d 919 (M.D.N.C. 2019)
(vacated pursuant to settlement).

Three Reasons to Police

1. Trademark Confusion is BAD!

- Initial Interest Confusion

Steinway



Grotrian-Steinweg

Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 365 F. Supp. 707 (S.D.N.Y. 1973), *modified*, 523 F.2d 1331 (2d Cir. 1975).

Three Reasons to Police

1. Trademark Confusion is BAD!

- Non-customer Confusion

Arrowpoint CAPITAL



Arrowpoint Cap. Corp. v. Arrowpoint Asset Mgmt., LLC, 793 F.3d 313 (3d Cir. 2015).

Three Reasons to Police

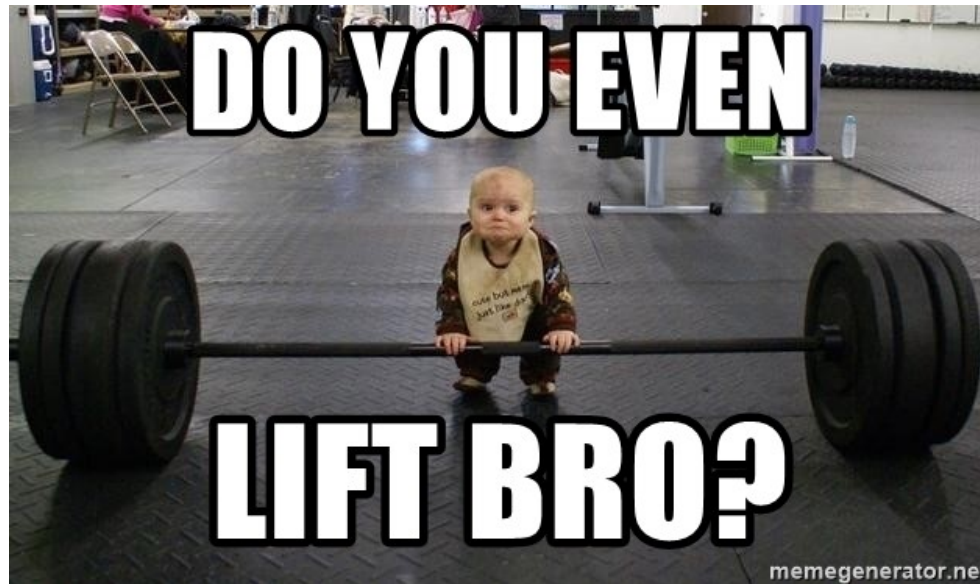
1. Trademark Confusion is BAD!

- Post-sale Confusion

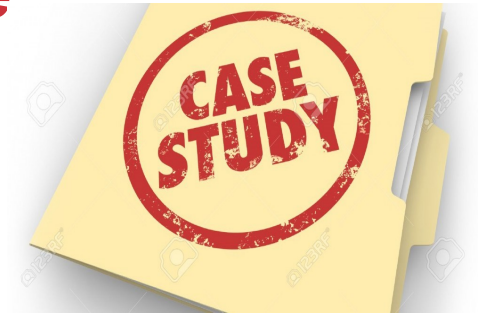


Three Reasons to Police

2. Strengthen Your Marks



Three Reasons to Police



Who won?

- A. Sugar High
- B. Pizza Party

Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252 (5th Cir. 1980).

Three Reasons to Police

3. Build Value for Licensing



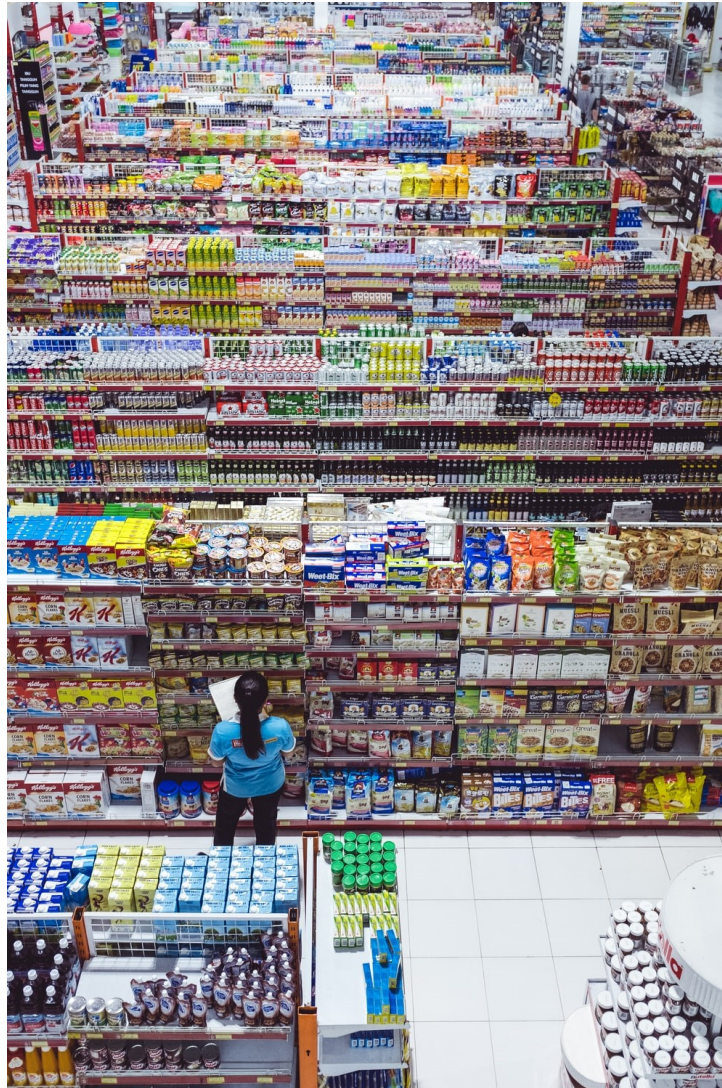
“I don't care how much money you have, free stuff is always a good thing.”

(licensees will not want to pay for a trademark that others are using for free)

How to Find Infringers?



How to Find Infringers?



How to Find Infringers?



What interesting methods have you used to find infringers?

(Drop your answers in the Zoom chat feature!)

How to Find Infringers?

1. Rely on the USPTO?



How to Find Infringers?

2. Internet and Social Media Searches (e.g., Google Alerts)



How to Find Infringers?

3. Trademark Watch Notices



How to Find Infringers?

4. Using the Boots on the Ground



Is It Infringement?



Elements of Infringement

1. **Validity**
2. **Ownership**
3. Unauthorized use in commerce
4. Use in connection with the sale, offering for sale, distribution, or advertising of goods and services
5. **Likelihood of confusion**

Is It Infringement?



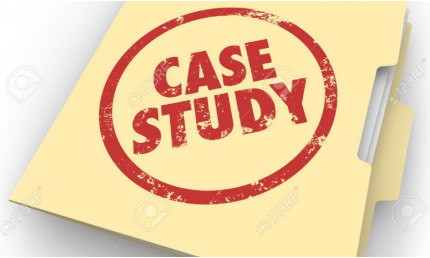
Test for Likelihood of Confusion

- Strength of the marks (conceptual and commercial)
- Similarity between the marks (sight, sound, meaning)
- Similarity of the products
- Similarity of the customers, advertising, and channels of trade
- Actual confusion
- Intent
- Customer sophistication
- Literally anything else

Is It Infringement?



Is It Infringement?



v.

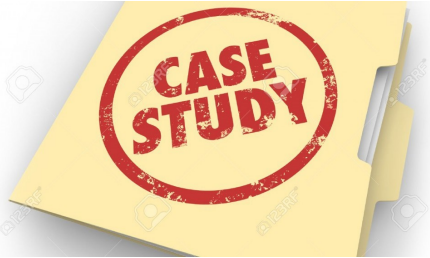


Who won?

- A. 7 Eleven
- B. Super 7

7-Eleven, Inc. v. Super 7 Food Mart, LLC et al., No. 1:15-cv-1038 (M.D. Pa. June 22, 2015).

Is It Infringement



V.

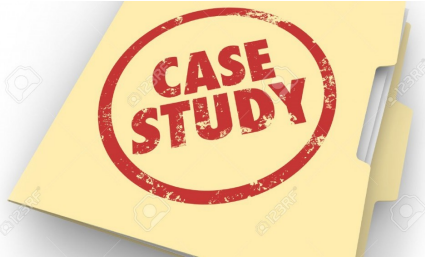


Who won?

- A. Pizzeria Uno
- B. Taco Uno

Pizzeria Uno Corp. v. Temple, 747 F.2d 1522 (4th Cir. 1984).

Is It Infringement?



842,555

LITTLE CAESARS

v.



PIZZA CAESAR

Who won?

- A. Little Caesars
- B. Pizza Caesar

Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc., 834 F.2d 568 (6th Cir. 1987).

Enforcement Tools



Enforcement Tools

What is your goal?



Enforcement Tools

1. Cease and Desist



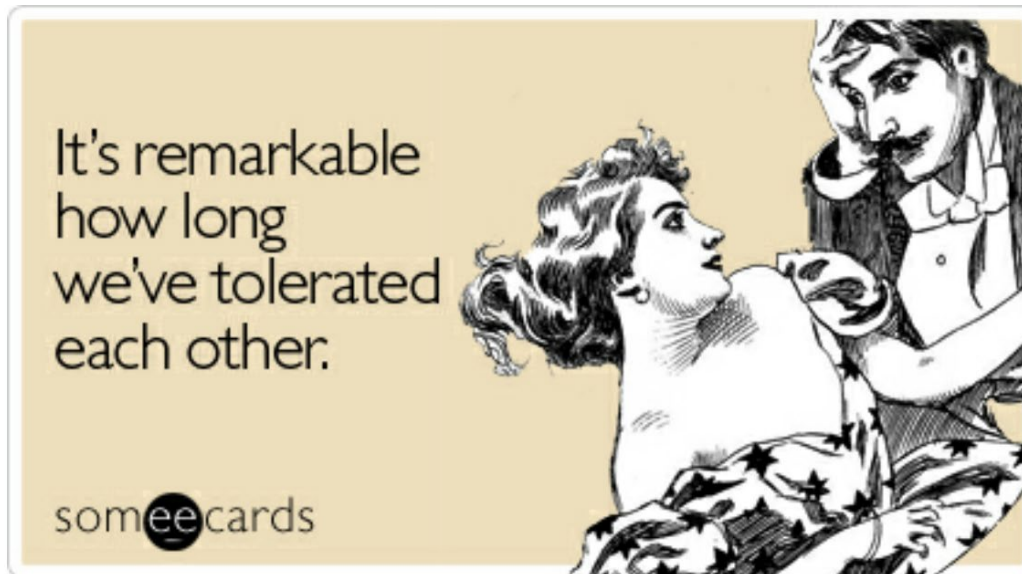
Enforcement Tools

2. License Agreements



Enforcement Tools

3. Coexistence Agreements



Enforcement Tools

4. Consent to Use Agreements



Enforcement Tools

Responding to Cease and Desist Letters



Litigation Considerations

Taking the Plunge



Litigation Considerations

Is there a Remedy?
(Beware the *Dawn Donut* Rule)



Litigation Considerations

Is there a Remedy?

Actual Damages	Disgorgement of Profits	Adjusted Damages	Fees and Costs
<p>Types of damages:</p> <ul style="list-style-type: none">• License fees• Plaintiff's lost profits• Infringer's profits• Reasonable royalty• Damage to goodwill• Cost of corrective advertising	<p>Factors:</p> <ul style="list-style-type: none">• Intent to confuse• Diversion of sales• Availability of other remedies• Any unreasonable delay• Public interest• Palming off	<p>Trial court has wide discretion to award up to treble damages based on the "circumstances of the case"</p>	<p>Theories:</p> <ul style="list-style-type: none">• FRCP 54(d)• "Exceptional case" under the Lanham Act• State unfair trade practices act statutes

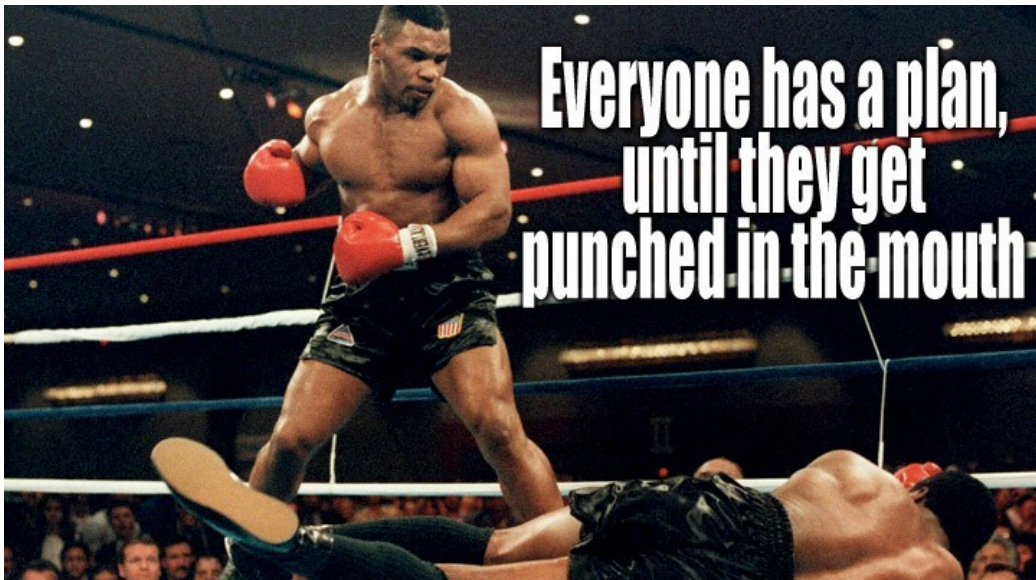
Litigation Considerations

Avoiding Delay



Litigation Considerations

Risk Factors



- Counterclaims
 - Cancellation
 - Declaratory Judgment
 - Infringement
- USPTO Proceedings
 - Cancellations
 - Oppositions
- Costs

Questions



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