

I've got my trademark registered.

HOW DO I PROTECT AND MAINTAIN IT?

Asha Allam

June 17, 2021



**ADDUCI MASTRIANI
& SCHAUMBERG LLP**



KNOW YOUR USPTO RESOURCES.

- Why register your trademark?
<https://www.uspto.gov/trademarks/basics/why-register-your-trademark>
- Protecting Your Trademark
<https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf>
- Registration Maintenance/Renewal/Correction
<https://www.uspto.gov/trademarks/maintain>
- About Trademark Infringement
<https://www.uspto.gov/page/about-trademark-infringement>

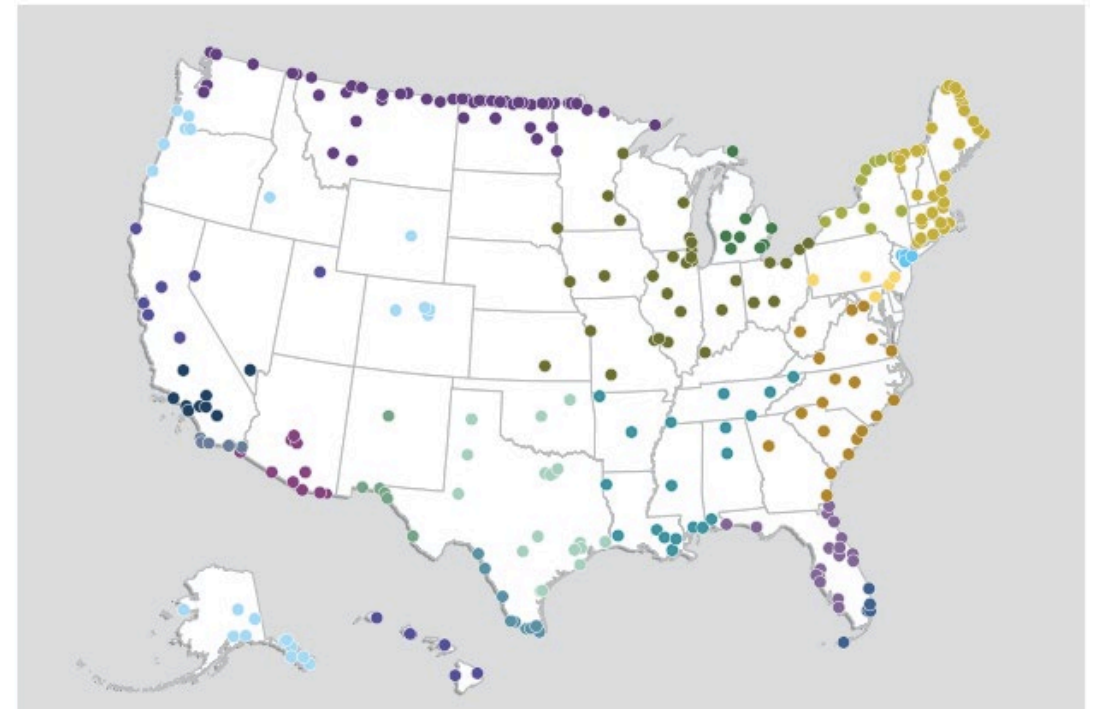


PROTECT WITH A VIEW TO LITIGATION

- Import volumes are increasing
- Volume and value of e-commerce are increasing
- Slip-ups are expensive (infringement, dilution, false representations)
- Section 337 litigation before the U.S. International Trade Commission tackles it all

Every State Has at Least 1 Port of Entry

314 ports of entry categorized by the 19 Field Operations offices to which they report



<https://www.vox.com/2015/2/7/7993273/border-port-map>

FOCUS ON 3 ACTIONS:



MAINTAIN

Maintain protection by continuing qualifying use and renewing registration



MONITOR

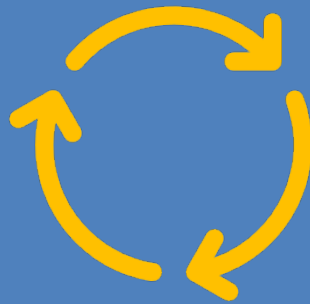
Monitor others' trademark registrations and goods/services in the market



ENFORCE

Preserve protection through legal action to enforce right to exclusive use

MAINTAIN YOUR MARK



Rights in a federally registered trademark can last indefinitely if you continue to use the mark and file all necessary maintenance documents with the required fee(s)...

[USPTO Trademark Basics](#) at 29

USE YOUR MARK



Use

In interstate, territorial, or foreign commerce
On registered class of goods or services



Timing

Use continuously
ITU - use within 6 months or seek extension
Avoid gaps in use



Documentation

When
Where (geographically)
How (specimen)
Extent (sales)
Pre-registration use



MARKING

- Mark goods with trademark
- Signals source of goods, increases association
- Improves distinctiveness
- Bolsters position for future legal action



USPTO FILINGS TO MAINTAIN MARK



Declaration of Use/Excusable Nonuse

- First filing between year 5 and 6 after registration
- File Declaration of Use/Excusable Nonuse every 10 years after registration



Incontestable marks

- Harder to cancel (15 U.S.C. § 1065)
- Affidavit showing
 - continuous use for five consecutive years
 - right to use (ownership)
 - No pending legal action concerning mark
- Can file with first declaration of use

MONITOR THE MARKET



PROBLEMS TO WATCH FOR

“Throughout the life of the registration, you must police and enforce your rights.”

[USPTO Trademark Basics](#) at 29

Cancellation of registration, 15 U.S. Code § 1064

- By any person who believes is or will be damaged
- Or if generic, functional, abandoned, obtained fraudulently, or contrary to law

Market Use

- Mark loses protection if no longer signifier of source (e.g., non-use or loss of exclusivity)

WATCH FOR MARKS “LIKE” YOURS

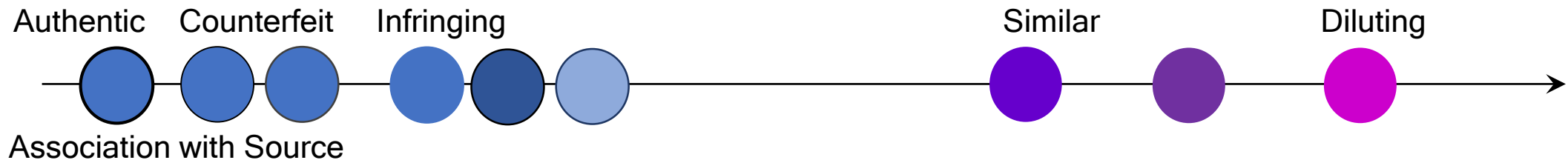
Counterfeiting

Infringement

Similar registrations

Dilution

Mislabeling/False Advertising



COUNTERFEITING & INFRINGEMENT

Counterfeit mark

- “spurious mark which is identical with, or substantially indistinguishable from, a registered mark,” also reproduction or copy
- 15 U.S.C § 1127

Infringing mark

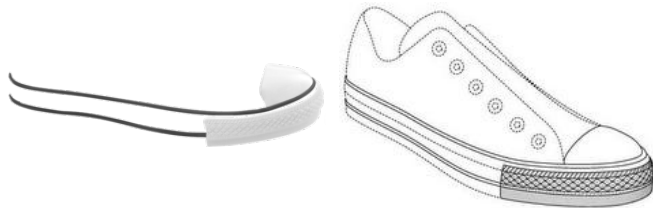
- “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive
- 15 U.S.C §§ 1114(1), 1127

COUNTERFEITING & INFRINGEMENT

Authentic

Counterfeit

Infringing



CERTAIN FOOTWEAR PRODUCTS, Inv. No. 337-TA-936 (U.S.I.T.C.)

COUNTERFEITING & INFRINGEMENT: ELEMENTS

Elements to Prove (§ 1114(1))	Counterfeiting	Infringement
Ownership of valid mark (registration)	✓	✓
Unauthorized use of mark on goods/services	✓ (same class as registered mark)	✓
“in commerce”	✓	✓
with sale, offer for sale, advertising, etc. of goods/services	✓	✓
likely to cause confusion, or to cause mistake, or to deceive	(typically presumed)	✓

COUNTERFEITING & INFRINGEMENT : RELIEF

Relief for Successful Trademark Owner	Counterfeiting	Infringement
Injunction (15 U.S.C § 1116(a))	✓	✓
Seizure (15 U.S.C § 1116(d))	✓	
Damages and costs (15 U.S.C § 1117(a))	✓	✓
Treble damages (15 U.S.C § 1117(b))	✓	
Statutory damages: \$1,000-200,000 (15 U.S.C § 1117(c))	✓	
Destruction of violating goods/materials and means of making more (15 U.S.C. §1118)	✓	✓

DILUTION

- Use that affects inherent value of the trademark
 - less unique or exclusive (blurring)
 - negative association (tarnishment)
- Trademark owner can enjoin use of mark “likely to cause dilution . . . regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury” 15 U.S.C § 1125(c)(1)

DILUTION

ROLEX



Dilution by blurring

- “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C § 1125(c)(2)(B)
- *ROLEX WATCH U.S.A., INC., v. ROLEX HEALTH, INC.*, 2:18-cv-00538-JRG (E.D.T.X.)

Dilution by tarnishment

- “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C § 1125(c)(2)(C)
- *NIKE, INC. v. MSCHF PRODUCT STUDIO, INC.*, 1:21-cv-01679-EK-PK (E.D.N.Y.)

DILUTION: ELEMENTS

Elements to Prove (§ 1125(c)(2))	Blurring	Tarnishment
Famous mark	✓	✓
Similarity between offending mark and famous mark	✓	✓
Distinctive (inherent or acquired distinctiveness, substantially exclusive use, degree of recognition)	✓	
Association with famous mark (intent, actual)	✓	
Harm to reputation of famous mark		✓

DILUTION: RELIEF

Relief for Successful Trademark Owner	Blurring	Tarnishment
Injunction (15 U.S.C §§ 1116, 1125(c)(1))	✓	✓
Seizure (15 U.S.C § 1116(d))		
Damages and costs (15 U.S.C § 1117(a))	✓	✓
Treble damages (15 U.S.C § 1117(b))		
Statutory damages (15 U.S.C § 1117(c))		
If willful, destruction of violating goods/ materials and means of making more (15 U.S.C. §1118)	✓	✓

FALSE OR MISLEADING REPRESENTATIONS

- §1125(a)(1) catch-all to remedy deception in consumer-facing messaging for goods/services
 - False designation of origin
 - False advertising
 - Misrepresentations
- Any communication “likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association”
- Misrepresentations about “the nature, characteristics, qualities, or geographic origin” of goods/services

FALSE OR MISLEADING REPRESENTATIONS: ELEMENTS

False/Misleading Representations	Trademark Infringement
False or misleading statement	Unauthorized use of valid trademark
In connection with goods/services	With sale, offer for sale, advertising, etc. of goods/services
In commerce	In commerce
Materiality (likely to influence purchase decision)	
Actual deception or tendency to deceive substantial segment of audience	Likelihood of confusion or mistake
Causation of injury to plaintiff	Damages

FALSE OR MISLEADING REPRESENTATIONS: USE

- When infringement and dilution don't fit
- False endorsement (e.g., false UL labeling)
 - no confusion as to source
 - false impression that trademark owner approves association with the goods/services
- Infringement and false advertising or misrepresentation can be complimentary causes of action

ENFORCE YOUR RIGHTS



WHERE TO ENFORCE

Least expensive/aggressive

- ⑩ Mark goods with trademark
- ⑩ Mark trademark with ®
- ⑩ Record trademark with U.S. Customs and Border Protection

Moderately expensive/aggressive

- ⑩ Trademark Gazette
- ⑩ Trademark Trial & Appeals Board
- ⑩ Online marketplace takedowns

Most expensive/aggressive

- ⑩ District Court/State litigation
- ⑩ U.S. International Trade Commission litigation



MARKING

- Mark trademark with ®
- Not required, but no damages without notice of registration (15 U.S.C. § 1111)
- May deter violation of rights

CBP RECORDATION

- U.S. Customs & Border Protection (CBP) will enforce your mark at the border
 - 19 CFR §§ 133.21, 133.27: detention, exclusion, seizure, and civil fines for counterfeits
 - 19 C.F.R. § 133.22: detention and exclusion if marks on goods “resemble” recorded mark and are “likely to cause the public to associate the copying or simulating mark or name with the recorded mark or name.”
- CBP notifies mark owners of seizures based on recorded marks
- Cheap, easy, passive: \$190 to record; \$80 to renew with USPTO renewals:
<https://iprr.cbp.gov/>

TRADEMARK GAZETTE

- Monitor for similar applications and registrations
- Evaluate damage by other mark
- Consider taking action:
 - Object to registration within 30 days of publication asking TTAB to commence opposition proceeding (37 C.F.R. §§ 2.101-§2.107)
 - Petition at any time asking TTAB to commence cancellation proceeding (37 C.F.R. §§ 2.111-2.115) (limited for incontestable marks)

USPTO will prevent another pending application for a similar mark used on related goods or in connection with related services from proceeding to registration based on a finding of likelihood of confusion . . .

[USPTO Trademark Basics](#) at 29

ONLINE MARKETPLACE TAKEDOWNS

- Liability
 - Difficult, if not unprecedented, to impose direct liability on marketplaces
 - Indirect liability attaches if notified of infringement and marketplace takes no remediating steps
- Platforms have their takedown practices, so register and report on each, e.g.:
 - Amazon Brand registry (<https://brandservices.amazon.com/>) and reporting platform (<https://www.amazon.com/report/infringement>)
 - eBay Verified Rights Owner Program (<https://pages.ebay.com/seller-center/listing-and-marketing/verified-rights-owner-program.html>)
 - Alibaba IP Protection Platform (<https://ipp.alibabagroup.com/>)
- Monitoring, requesting takedown, and following up can be tedious and time-consuming

LITIGATION

Forums

- ⑩ District Court
- ⑩ U.S. International Trade Commission (ITC) under 19 U.S.C. § 1337
- ⑩ State court

Same causes of action

- ⑩ Infringement
- ⑩ Dilution
- ⑩ Other Lanham Act violation

Timing

- ⑩ Most trademark cases decided on summary judgment
- ⑩ District Court can take 1.5-4 years (median)
- ⑩ ITC can take 12-18 months (average)

DISTRICT COURT VS. ITC LITIGATION

	District Court	ITC
Length	Average of 3 years	Typically less than 18 months
Parties	In personam jurisdiction AIA Joinder Provision rules apply	In rem jurisdiction Seek relief against multiple parties Government may participate
Complaint	Notice pleading	Fact pleading
Judges	600+ judges with diverse caseload	6 ALJs handling only unfair competition and IP cases Review by the full Commission
Appeals	Circuit Courts of Appeal	Federal Circuit

DISTRICT COURT VS. ITC LITIGATION

	District Court	ITC
Elements	Trademark allegations Remedy	Trademark allegations Importation Domestic Industry Remedy
Discovery	Federal Rules apply Limited subpoena power	Broad scope Nationwide subpoena power Short deadlines (10 days)
Remedy	Damages Costs Injunction potential, but must satisfy <i>eBay</i> factors	Automatic injunction, limited or general exclusion order barring category of imports Nationwide cease and desist order with steep civil penalties

ITC LITIGATION

- Efficient: one shot to tackle multiple claims and parties
- Combines power of Customs and District Courts
- Quick
 - Summary judgment typically at 5-7 months
 - Bench trial around 11-13 months
 - Final decision on the merits typically in 8-30 months (average 13 months)

QUESTIONS?



AMS **ADDUCI MASTRIANI
& SCHAUMBERG LLP**
1133 Connecticut Avenue NW
Washington, DC 20036

ASHA ALLAM



allam@adduci.com



(202) 407-8634



www.adduci.com



linkedin.com/in/asha-allam/