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Trademark enforcement outside the courtroom: four underrated tools your clients may be overlooking



Michelle Ciotola and Ali Caless of Cantor Colburn LLP, explain how the United States Customs and Border Protection, trademark watch services, online infringement and modern trademark clearance can be utilized to amplify the strength of a brand and protect against infringement.

A graphic featuring a black and white comic-style speech bubble with the text 'F@*#!' inside. Below the speech bubble is a halftone dot pattern.

Immoral trademarks
Page 14

A graphic showing a person's face and hands holding a camera, peering through a hole in a yellow surface.

Publicity rights posthumously
Page 20

A graphic showing a map of the Indian Ocean region with a red pushpin on the island of Mauritius.

Mauritius for holding IPR
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Trademark enforcement outside the courtroom: four underrated tools your clients may be overlooking

Michelle Ciotola and Ali Caless of Cantor Colburn LLP, explain how the United States Customs and Border Protection, trademark watch services, online infringement and modern trademark clearance can be utilized to amplify the strength of a brand and protect against infringement.

Developing a comprehensive enforcement strategy is vital to building and maintaining a strong brand. The ever-increasing prevalence of online marketplaces and social media platforms create heightened challenges for brand owners. Approaching enforcement pragmatically and utilizing all available resources can stretch an enforcement budget further. It is oftentimes assumed that enforcement involves costly and protracted litigation, but as practitioners know, this is not necessarily the case. We have compiled an enforcement toolkit, summarizing underrated enforcement tools to broaden your discussion with clients and other decision makers.

1. United States Customs and Border Protection

The United States Customs and Border Protection (CBP) can be a powerful ally for brand owners, if utilized correctly. The CBP dedicates substantial resources to blocking the import of infringing and counterfeit goods. However, the CBP requires brand owners to have a U.S. trademark registration on the Principal Register. A pending trademark application number is not acceptable; instead, proof of a Certificate of Registration from the United States Patent and Trademark Office (USPTO) is required.



Résumés

Michelle Ciotola, Vice Chair of Cantor Colburn's Trademark & Copyright Department

Michelle counsels clients on protecting and enforcing their trademark, trade dress, copyright, and related IP rights, including unfair competition, internet, advertising, and promotions law. She counsels clients in developing and exploiting their trademark portfolios, including clearance; prosecution; and identifying important overseas jurisdiction and filing or coordinating with local counsel overseas. Michelle develops strategies for the enforcement of her clients' IP rights, including preparing demand letters, negotiating settlement agreements, handling opposition and cancellation actions before the U.S. Trademark Trial and Appeal Board, and coordinating and overseeing litigation with local counsel around the world. She also develops strategies for enforcement of her clients' intellectual property rights online, including handling Uniform Domain Name Dispute Resolution Policy proceedings. Michelle attends and speaks at International Trademark Association (INTA), MARQUES, European Communities Trade Mark Association (ECTA) and the Asociacion InterAmericana de la Propiedad Intelectual (ASIPI).

Ali Caless, Counsel

Ali assists clients with trademark clearance, prosecution, monitoring, and enforcement. She advises clients in both U.S. and foreign portfolio development and management. Ali is involved in drafting settlement agreements to resolve trademark disputes. She also provides assistance with other intellectual property agreements including assignments, licenses, and consent agreements. Ali also has experience in copyright matters and domain name disputes, including arbitrations under the Uniform Domain Name Dispute Resolution Policy. Ali is a MARQUES Education Team Member, a Connecticut Bar Association Intellectual Property Law Section Executive Committee Member, and an active member of International Trademark Association (INTA).



Michelle Ciotola



Ali Caless

“**This database is utilized at all U.S. ports of entry to actively monitor shipments and prevent the import or export of infringing, counterfeit, or grey market goods.**”

“Recordation” is the process where CBP enters details about a brand in the CBP’s electronic database. The information in this database is utilized at all U.S. ports of entry to actively monitor shipments and prevent the import or export of infringing, counterfeit, or grey market goods that violate trademark rights. Once rights are properly recorded, CBP officers will contact the rights owner or their representative when shipments are seized.

Trademark attorneys can record a trademark registration with the CBP. The CBP recordation will remain active, provided it is renewed once the underlying U.S. trademark registration is renewed. The government fee for recordation is \$190 per category of goods or services, per trademark registration. The CBP does not continuously charge the brand owner when monitoring ports, seizing items, or correspondence with the rights owner or their representative, making CBP recordation a cost effective and efficient option for brand enforcement.

To enhance the value of the CBP recordation, brand owners or their counsel can offer training sessions with CBP personnel at key ports of entry, as well as make themselves available to answer questions from CBP personnel when suspected infringing or counterfeit goods are seized.

2. Trademark watch services

“Trademark watch” is a common phrase in the vocabulary of trademark practitioners. A watch service can help monitor the trademark registry for potentially conflicting applications. When a potentially conflicting mark is revealed, a watch notice issues, providing the trademark practitioner or brand owner with relevant information about the trademark filing to evaluate and determine whether to take action against that application.

A watch service can be set up to report pending applications at the time they are published for opposition, or at the time of filing. The benefit of setting up a watch service to monitor marks at publication is that it will naturally weed out applications that do not make it through the prosecution phase, making the time to review and assess watch notices more manageable. However, there are important benefits to setting up a watch service to monitor applications at the time of filing.

The advanced notice of a potentially problematic application will give brand owners more options to pursue enforcement, and may ultimately increase the chances of success, while minimizing the budget. For example, if a problematic filing is caught early enough, and the applicant has not yet invested in marketing, packaging, or other branding, they may be more amenable to changing the name and agree to withdraw the

application or make other requested changes to limit the filing. It may be possible for a brand owner or trademark practitioner to resolve the issue without the need to file a notice of opposition.

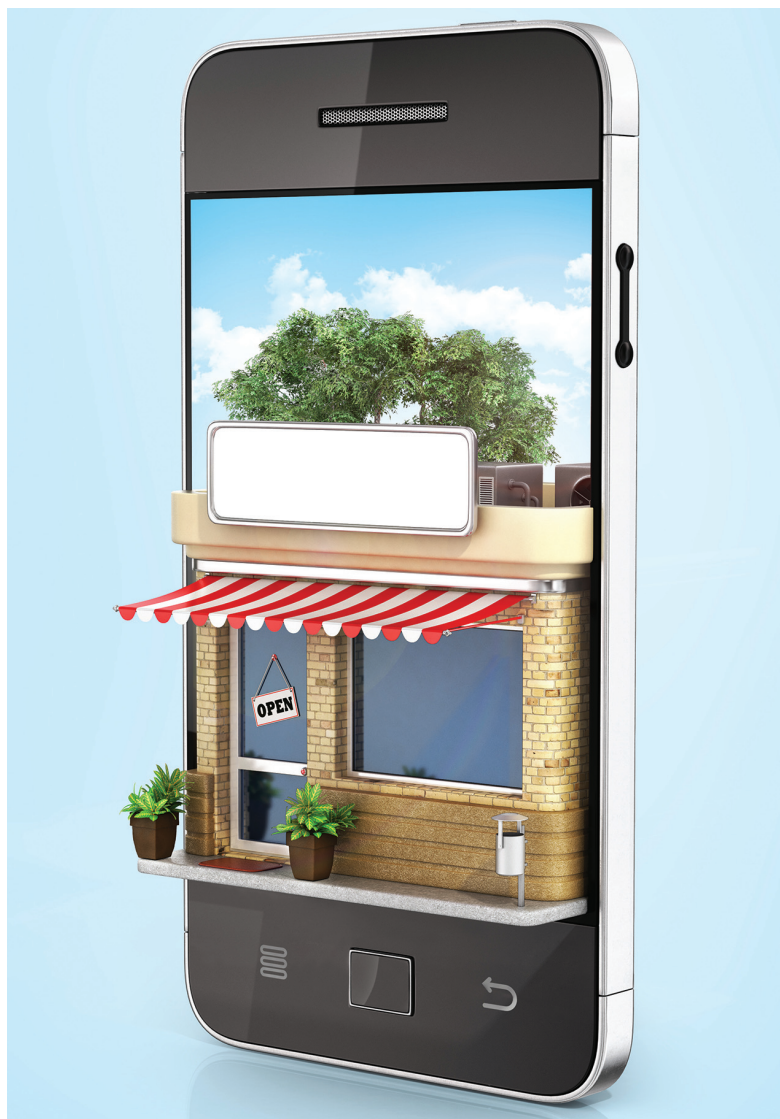
Another important benefit in setting up a watch service to monitor applications at the time of filing is it opens the potential to utilize the Letter of Protest as an enforcement mechanism. The letter of protest practice allows third parties to protest a *pending application* on "any reasonable ground" for refusal in *ex parte* examination by submitting evidence to the USPTO about a pending application's registrability. While the practice was available prior, the Trademark Modernization Act ("TMA") which was signed into law on December 27, 2020, provides statutory authority for these third-party submissions during examination. The TMA establishes a time frame of two months from receipt for the Director of the USPTO to decide whether to include the evidence from the letter of protest in the record of the application. If the evidence is entered into the record, the applicant will have the opportunity to address the grounds for refusal. But this increases the chances that an application will not make it to the publication phase – an applicant may choose not to proceed with a response especially when faced with a substantive refusal.

Finally, an often overlooked benefit of trademark watch services is that they can be useful to keep a pulse check on what competitors are filing, for informational purposes. In addition to the name of the new product, trademark applications can tell you a lot about the type of products that a company might be launching, providing insight into where a competitor or even the market might be headed.

3. Online infringement

According to a 2020 survey conducted by trademark search and watch provider Clarivate, 85% of brands experienced trademark infringement in 2019.¹ For most clients, developing an online brand enforcement strategy is integral to protecting their mark and earned goodwill. Further, brand owners in the U.S. have an affirmative duty to safeguard their brands against unauthorized uses.

Most online third-party retailers have developed straightforward mechanisms to report infringing third-party posts. They provide online forms that allow users to submit complaints about trademark (and copyright) infringement. These site-specific support tools are typically free and fast, in contrast to litigation. Examples of online retailer platforms with fairly robust takedown mechanisms include Amazon, Etsy, eBay, and Society6. When budgets are tight, these platforms can be efficient and effective to remove infringing online content



¹ <https://clarivate.com/computark/campaigns/trademark-ecosystem-report-2020-short/>

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and listings. While the format of these forms can vary, they generally request the following information:

- Rights owner name and contact information.
- Description of rights allegedly being infringed.
- Proof of ownership of rights claimed.
- Declaration of accuracy of claims made.

Amazon has taken the takedown procedures further and implemented the Amazon Brand Registry, with the goal of assisting brand owners with managing the sale of their products on Amazon.com. Amazon's first brand registry program launched in 2015. In 2017, the program underwent a massive overhaul and added improved counterfeit reporting methods, along with exclusive features for registered brand owners. Currently, the Amazon Brand Registry requires an applicant to have an active trademark registration or application on the Principal Register with the USPTO. Amazon is

the first online retailer to require confirmation and approval from a trademark attorney listed in the USPTO's database. The process to register with the Amazon Brand Registry can be frustrating for those who are not fluent in "trademark-speak," particularly when snags arise such as "your trademark doesn't match your registration drawing" or "please provide the verification code" or "we did not receive confirmation from your attorney of record." But if you can successfully register, the Amazon Brand Registry offers certain benefits to give registrants a leg up: control over new product listings with the trademark, enhanced marketing features for the Amazon storefront, access to data on how consumers reach the products and buying behaviors, along with faster support from Amazon on infringing listings.

Online enforcement can feel like you're in a never-ending game of Whac-A-Mole®. But a well-reasoned and targeted approach can help direct resources to where companies can get the biggest return. For online takedown forms, this could include: (i) monitoring and submitting forms on the biggest platform, (ii) direct contact with third-party platforms for assistance in stemming infringing content; (iii) focusing efforts on main, central brands, or those that are most likely to be copied by infringers, and those that will have the biggest impact on a company's bottom line through lost revenue.

4. Modern trademark clearance

Trademark clearance is a vital step in developing a strong new brand or expanding an existing brand. Trademark clearance will not only assess the availability of a mark for use in connection with the intended goods or services but will also provide valuable insight into the potential strength of that brand. Conducting a clearance search prior to adopting a mark or filing a trademark application can save considerable expense and headaches. It provides insight into the risks of use and registration, but also information into the strength of that mark and the potential for future expansion.

A typical clearance search in the U.S. will include a review of relevant federal trademark applications and registrations, and state registrations, as well as common law sources. Since trademark rights in the U.S. are based on use in commerce or common law rights, it is important that clearance also considers third party use. For this reason, clearance searches will generally include a snapshot of website content, business name records, and domain name URLs.

This type of clearance has been standard in the industry for decades. However, the increasing prevalence and importance of social

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media require a more robust online search to avoid snags or avert potential limitations for a new brand. Brand owners and trademark practitioners should be mindful of the changing landscape of clearance. Where at one point trademark practitioners may not have routinely checked the availability of a domain name and ensured that it was purchased or secured prior to filing a publicly viewable trademark application, this step can be imperative for new brands or companies. Today, trademark practitioners should consider social media platforms and applications for potential landmines to brand use and expansion. Key considerations should include: (i) Are consistent handles on Twitter, Instagram, Facebook, and TikTok available? (ii) Is there a relevant hashtag campaign not already flooded with popular posts? (iii) Is there a mobile app with a similar name on Google Play Store or Apple App Store? (iv) Will that app block the company from developing and launching their own app on these platforms? The answers to these questions can have a big impact on the ability to market and build a new brand.

Conclusion

Attacking brand enforcement from all angles is vital to enhancing the strength of a brand. Consider this toolkit in developing a comprehensive strategy. And remember, perhaps one of the most useful tools is to think outside the box.

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