

## WHAT AND WHO ARE “TRADEMARK BULLIES?” THE USPTO WANTS TO KNOW...

By Alex H. Buttermann

In mid-October, the U.S. Patent and Trademark Office (USPTO) posted the following notice and request for comments about “**Trademark Litigation Tactics**”:

The Trademark Technical and Conforming Amendment Act of 2010 became effective on March 17, 2010. Pub. L. No. 111-146, 124 Stat. 66 (2010). The Act includes a provision that the Secretary of Commerce, in consultation with the Intellectual Property Enforcement Coordinator, shall conduct a study and report to the Committees on the Judiciary of the House and Senate on “(1) the extent to which small businesses may be harmed by litigation tactics by corporations attempting to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner; and (2) the best use of Federal Government services to protect trademarks and prevent counterfeiting.” Trademark Technical and Conforming Amendment Act § 4. The study and report shall also include any policy recommendations deemed appropriate ([http://www.uspto.gov/trademarks/bullies\\_survey.jsp](http://www.uspto.gov/trademarks/bullies_survey.jsp)).

The notice also listed a dozen questions which the commentators – trademark owners, practitioners, etc. – should address, such as the role of the commentator (practitioner or owner); any awareness of instances in the last five years in which a small company was threatened with trademark infringement by a larger company that arguably was broadly interpreting its trademark rights; the commentator’s own experience with receiving cease and desist letters, Trademark Trial and Appeal Board (TTAB) litigation and federal litigation; the outcomes of said litigation or cease and desist correspondence; any opinions on whether these aggressive litigation tactics are more prevalent in trademark law than other areas of law; and if the USPTO, U.S. courts, Congress, or U.S. agencies should be responsible for addressing this problem. Question 6 asked whether “trademark bullies” are a problem and defined bullies in a footnote as “a trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow.”

Needless to say, this notice has generated a fair amount of speculation and informal commentary from the U.S. trademark bar. Specifically, the *TTABlog* – a blog about TTAB litigation hosted by John Welch, an IP practitioner in the Boston area – has received a number of comments from trademark practitioners referencing specific companies that they consider to be trademark bullies.

- The following companies were among those mentioned as possible trademark bullies: Kellogg Company (cereal), Monster cable, Intel, Pinkberry (frozen yogurt), Apple, Tacori (jewelry, engagement rings), Trek Bicycle Company, and Clear Channel Communications (media, radio stations).
- A couple of sports leagues were mentioned, namely Major League Baseball (MLB) and the National Football League (NFL). Major League Baseball, and all of its individual teams, often files oppositions against any application for a mark that resembles the team name, nickname, or logo – almost regardless of the goods or services recited. Examples include opposing applications for a stylized letter “B” for children’s books, a design of a baseball cap with a blank label centered on the back, the mark BROOKLYN BURGER and Design for hamburger patties that allegedly resembles the stylization of the letters on the Dodgers’ uniforms, and the mark BUILD-A-TIGER by Build-A-Bear for plush stuffed toys that are stuffed tigers. The NFL is challenging the registration of the mark SOUPER BOWLS SOUPS SALADS SANDWICH WRAPS and design for those foods and combination meals.
- In our Fall 2009 Newsletter, it was reported that the NFL had filed 80 oppositions, cancellations, and extension requests to oppose between January and October 2009, which was the fifth highest of all TTAB filers at that time. MLB was in the top 20 of TTAB filers with 11 separate opposition or cancellation proceedings actually instituted.

- A news report recently noted that Facebook, Inc. is seeking a registration for the mark FACE for their “online chat rooms and electronic bulletin boards...” Facebook is expected to use these services to prevent the use of the word “face” by any of its competitors, despite the fact that there presently are thirty-four other trademark applications pending at the USPTO and 53,000 domain names in the GoDaddy.com database that contain the word “face.”

Around 95% of these cases settle, often with the defendants conceding and abandoning their marks. Yet, such an outcome costs the defendants thousands of dollars, as well as months or years of delay if they make any effort to defend their cases or negotiate settlements. One possible solution that has been mentioned is to compel a losing plaintiff to pay defendant legal fees, a practice which is already common in many other countries.