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RECENT TRENDS IN TRADEMARK PROTECTION

LEADING LAWYERS ON EDUCATING CLIENTS,
UNDERSTANDING THE IMPACT OF TECHNOLOGY,
AND NAVIGATING THE CURRENT MARKETPLACE

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Analyzing Your Client's
Trademark Protection and
Infringement Concerns
in the Global and
Cyberspace Markets

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Introduction

Over the last ten years, the global economy and the manner in which businesses do business have both changed substantially. These changes have had major impacts on the development and protection of intellectual property, especially trademarks. While companies recognize the importance of protecting trademarks due to their widespread use over the Internet, which broadcasts the trademark to millions of people worldwide in an instant, financial constraints due to the economic downturn often make it difficult for companies to decide how and when to protect their trademark rights.

The protection of trademarks is still a vital component of a company's business, as the trademark can create the greatest value of a company. However, attorneys must keep abreast of the latest technologies, trends, and case law to provide their clients with the best advice with regard to the manner in which their trademark should be protected and enforced against third parties.

New Trademark Protection Issues on Social Media Sites

Social media is no longer just about keeping in touch with friends and family. Rather, it has recently become a very important and prominent part of advertising for companies and retailers worldwide. Consequently, websites such as Facebook, Twitter, and other social media outlets on the Internet are commonly used to advertise a variety of goods and services, and therefore are frequently displaying trademarks. Not only are companies using the outlets to advertise, but they are also creating Facebook and Twitter pages to provide further information about their goods and services. In some cases, unauthorized third parties have established accounts on behalf of companies, resulting in trademark infringement.

Many of these social media websites understand that such abuse or trademark infringement can occur, and they have established policies for cases of potential infringement. Unfortunately, not all of these policies are well thought out, and consequently some are not very effective in removing such infringing content from the sites. In cases where a website's trademark infringement policy is not effective in removing the content, companies and individuals have the option of either bringing a lawsuit under traditional trademark infringement statutes or through the filing of a Uniform Domain

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Name Dispute Resolution Policy (UDRP) complaint if appropriate. However, it is uncertain whether either strategy will accomplish the client's goals in a cost-effective manner. For instance, trademark litigation tends to be extremely expensive. Therefore, it may be difficult for a company or individual to spend hundreds of thousands of dollars on litigation only to have content removed from a social media website but where actual damages may be difficult to prove. In the case of a UDRP complaint, the complaint can only be brought if the trademark is used in the domain name itself. In most social media cases, this would not be appropriate, as the domain name would contain the name of the social media outlet (e.g., Facebook, Twitter) but not the name of the company or individual. Therefore, the UDRP route would not be helpful in these instances.

Trademark Application Challenges: Working with the PTO

With regard to trademark protection, applicants have been forced into becoming more conservative in identifying goods and services in trademark applications due to recent developments and cases in the trademark field. Generally speaking, applications are now much more specific than they previously were. For instance, in the past, a statement of use could be filed even if an applicant was using only one item in a long list of goods and/or services. Now, the statement of use can only be filed if the mark is in use in connection with all of the goods or services as identified in the application. Moreover, when Section 8 or 9 applications are filed to confirm continued use of the mark in connection with the identified goods or services, goods or services that may no longer be in use since registration must be deleted. In the case of registration, if an applicant includes goods or services with no bona fide intent to use the mark in connection with such goods or services in interstate commerce (for an intent-to-use application) or without actual use (for a use-based application), the entire registration may be susceptible to cancellation on the basis of fraud. Consequently, the trademark registrations that are on file tend to be more accurate, in that they show trademarks that are actually being used, as opposed to overbroad trademark registrations that include everything but the kitchen sink.

Applicants should be aware that they need to be very careful in identifying goods and services in trademark applications. Identifying goods and

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services in a way that may not be entirely accurate (e.g., identifying goods as non-medicated products when they are actually medicated products) may open up the application or registration to an opposition or cancellation. Unfortunately, there have been some past inconsistencies at the US Patent and Trademark Office (PTO) with regard to the examination and approval of trademark applications. In the past, where one applicant filed multiple applications that had similar identifications of goods and services, one examining attorney would review all of the applications and then take action upon each one to ensure consistency. For instance, if one applicant filed multiple applications for different marks with the same identification of goods, one examining attorney would review all of the applications and amend the identification of goods in the same manner for each application. Currently, multiple applications are either being refused or the examining attorneys are requesting amendments, but they are doing so in an inconsistent manner. Applications for essentially the same mark (where one may include a design and the other does not) may not necessarily be reviewed by the same examining attorney. In such cases, applicants may be asked to amend the identification in different ways, or one may receive a substantive refusal while the other does not.

Fortunately, attorneys who have worked within the trademark field for many years often know how to resolve these issues by contacting the appropriate department within the PTO. Attorneys unfamiliar with the procedures of the PTO often find that it is very difficult to get a consistent result for their clients. Essentially, registrations for marks featuring the same goods and/or services should be identical with regard to the identification of goods and services. Applicants and attorneys can and should contact the Trademark Assistance Center or the Assistant Commissioner's Office to address these types of issues, as individuals in these offices can either correct the action or refer an applicant to the appropriate person to address the issue.

Moreover, the PTO has often encouraged applicants and attorneys to provide their opinions and/or feedback on the office and its services, as the PTO is always looking for ways to improve its processes. The PTO website often solicits comments from the public with respect to their processes, and is a good source of information regarding what is going on at the office with regard to improvements and changes being made.

The Economy's Impact on Trademark Issues for Large and Small Companies

Due to the economic downturn, the number of applications being filed has gone down. Certain industries have been hit harder than others, but at the same time, trademark filings have not stopped entirely. Many smaller companies seem to be implementing a philosophy whereby they want to grow their business to the point where they can sell it to a larger company or competitor. These companies are aware that to market and sell their business, they will at least need to obtain the minimum protection for their trademark. Consequently, many smaller companies are filing trademarks not only in the United States but also abroad, especially if they are manufacturing or selling products overseas—a somewhat surprising trend, considering that many of these companies are cash-strapped and foreign filings can become very expensive.

Larger companies have the same kind of philosophy, but it is implemented at a different level. For example, larger companies, even those that are successful, may have concentrated on their businesses over the years but have not focused on their trademark protection. When these companies are in a position where they want to sell their companies, they often find that they have many gaps in the intellectual property and trademark rights and may not be desirable targets, as other companies do not want to take on the liabilities or risks of not having adequate trademark protection. Consequently, many companies will turn to attorneys to assist them in “fixing” their intellectual property/trademark issues so they will be in a position to market their companies to another party for purchase. In such cases, we often have to implement worldwide filings or enforcement strategies to either fill in gaps in trademark protection or to enforce rights to prevent infringement of the client's trademark rights by third parties. For instance, a US company that is conducting most of its sales in Europe, but has only protected its major trademark, should also consider protecting its other non-major trademarks. Moreover, where Europe is a big market for the company, it should have an enforcement strategy to ensure that third parties are not infringing on its trademark rights and the trademark is not losing value in the marketplace.

Given the current state of the US economy, we have heard many of our more established US-based clients state that their major sales markets are

now overseas, and as such, we are increasingly filing trademarks overseas. In fact, while the United States may have been many of our clients' main market a few years ago, these days their primary markets may be China, Japan, or Australia. Therefore, we are currently filing many foreign applications to protect our clients' trademarks abroad.

Trademark Infringement on the Internet

We are also increasingly involved in trademark enforcement actions on behalf of our clients due to Internet-related issues. As first mentioned above, third parties have now become aware that they can open up Twitter accounts using a company's name. In such case, an individual may open a Twitter account using a company's name and then pretend to send out "tweets" on behalf of a company. If the company takes no action, its customers may believe the individual is sending the tweets on the company's behalf and the company will not be able to control the content being sent out under its trademark. Such activities are a form of infringement, as an individual is pretending to be the "source" or "origin" of the information on the company.

In addition, there is also infringement taking place on the Internet on Facebook (much like Twitter, as explained above), whereby an individual creates a Facebook account pretending to be a company). With regard to Google, the Ninth Circuit recently held that use of another's trademark as an advertising keyword (in the case of Google, an "adword") is not trademark infringement. *Network Automation, Inc. v. Advanced System Concepts, Inc.*, 638 F.3d 1137 (9th Cir. 2011). Companies are becoming more conscious of such infringement and potential infringement issues, as they are aware that consumers looking for information will first turn to the Internet. Therefore, companies want to make sure they can exert at least some control over the use of their trademarks in that arena.

It is important to keep in mind that some sites, such as Google, have changed their adwords policies over the years and that the courts, in reviewing these cases, have implemented different rules and standards as well. For instance, previously one's trademark could not be used as a keyword in Internet advertising. As noted above, the Ninth Circuit recently held that the use of another's trademark as a keyword for advertising, whereby the advertising

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company's link appears on a separate portion of the page under "sponsored listings" or the like, does not constitute trademark infringement.

In addition, if another's trademark is being used for comparative purposes in an advertisement, this may be considered a "nominative fair use" and not infringement, even if used negatively. For instance, if Company A uses the trademark of another company to show that its product is better than that of Company B, this is acceptable, as Company A is using the trademark of Company B to identify Company B's goods. In other words, Company A is not trying to claim that it is the source of Company B's goods. Rather, it is using the trademark of Company B to identify Company B. This is a nominative fair use of the trademark. Due to the complexities of the trademark laws and potential defenses, it is very important to educate clients about what they can and cannot do with respect to trademark usage (their own trademarks and those of their competitors) on the Internet, as well as what their competitors can and cannot do with the client's trademarks.

Trademark Litigation Trends

The recent case of *Louboutin v. Yves Saint Laurent America, Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011), centered on Louboutin's trademark registration for the company's famous red-soled shoes, and it has thrown some uncertainty into the extent of trademark protection. Louboutin has obtained a trademark registration from the Trademark Office for a red-soled shoe. In its decision, the court admitted that the trademark was famous and had acquired secondary meaning in that consumers recognized the red-soled shoes as emanating only from Louboutin. Notwithstanding the court's decision admitting that the design was very well known and acquired such secondary meaning, the court found that the trademark was not protectable and should be cancelled. The issue with the decision is that it goes against the entire theory behind trademark protection. The court basically said that while Louboutin's trademark is famous and acquired secondary meaning (two concepts that, when present, favor an argument that the trademark is strong and entitled to the utmost protection), the court stated that the mark is not protectable and should be cancelled. An appeal has been filed in this case.

Another major case in this area was the 2010 Ninth Circuit case of *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010), which dealt

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with the use of a trademark in a domain name registration and trademark infringement. Under *Tabari*, use of a trademark in a domain name can be considered a nominative fair use. In this instance, the Tabaris were car brokers who assisted in the purchase of Lexus automobiles. For business purposes, the Tabaris used the domains “buy-a-lexus.com” and “buyorleaselexus.com.” Toyota objected to these registrations, stating that such registrations violated its trademark rights, in that Toyota owned the registration and spent hundreds of millions of dollars advertising and promoting its trademark. The Ninth Circuit refused to allow a blanket injunction preventing the Tabaris from using the trademark in a domain, stating that there are instances where such use would be a nominative fair use. For instance, the court stated that a domain such as “lexussucks.com” would be a nominative fair use, as a consumer would not believe Toyota was the source of the website. In other words, use of such a domain would not cause consumer confusion.

The *Tabari* decision opens up a third party’s argument that its use of the trademark of a company in a domain is allowable as a nominative fair use and not trademark infringement. The *Tabari* decision was a departure from the previous understanding that the registered owner of a trademark was the only one allowed to use the trademark in a domain. The *Tabari* decision is also incongruous with UDRP proceedings, which hold a different standard in determining whether use of a trademark in a domain name is a violation of a trademark owner’s rights. While the *Tabari* case is based on the US federal trademark laws, including the Lanham Act, UDRP proceedings are based on the ICANN Rules and Policies relating to domain name registrations, and they are a completely separate body of law. In this regard, when counseling clients, we often have to determine whether a UDRP proceeding is a better avenue to enforce our client’s rights as opposed to a federal case.

There has been an increasing number of cases dealing with infringements of trademarks on the Internet, as previously noted. In fact, it appears that many if not most of the trademark cases that will be brought in the coming years will have some relation to infringement on the Internet, as opposed to other types of infringement.

While the types of trademark infringement cases that are being brought are changing, the client base that has been bringing these cases has basically

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stayed the same. Most of our litigation clients are larger companies. While these companies have been able to survive in this economy, they still only bring trademark litigation cases when absolutely necessary, given the costs of such proceedings.

Informational Resources for Trademark Attorneys and Clients

Internet blogs written by attorneys following current trademark cases and trends are one of the best sources of information on trademark-related issues and cases. Due to the constant flow of information and changes due to laws and cases, we often share this information about trends or changes with our client through "client alerts," which are short articles summarizing the law or the change. If a particular issue applies to only a few of our clients, we will send them an e-mail or call them regarding the new development or information and how the issue may apply to their business. We will also inform the client whether they need to take action in response to a certain trend or change in the law, and offer to help them either draft a new policy or otherwise implement the necessary changes.

Essentially, we always make an effort to alert our clients of new developments we learn about, and our communication/educational strategy changes depending on the information we need to disseminate and the particular needs of our clients.

Financial Considerations and Mistakes to Avoid in Updating Trademark Strategies

The process involved in updating a client's trademark strategies largely depends upon the type of client. For start-up clients who are often cash-strapped and focused on spending money to invest or expand their business, we may suggest that they obtain some trademark protection but hold off on enforcement until they are more established. For such companies, obtaining protection for their core brands is important, at least early on. For middle-tier or established clients, we will use the Internet to research trademark-related trends impacting their particular industries or marketplaces, and make suggestions for them.

For example, we currently represent a client that has been focusing on the US market for the last fifteen years, during which time the company has

grown quite substantially. The company is now at the point where it needs to start considering international trademark protection. Therefore, we plan to conduct some research to determine their major non-US markets so we may then suggest or outline an international protection strategy for this client. We have also advised the client that they should subscribe to a watch service that would provide alerts in the event that a third party files a trademark application for a similar or identical mark or registers a domain name for a similar or identical trademark, so action can be immediately taken to prevent such unauthorized use and registration.

One of the challenges we are currently facing in updating our clients' trademark strategies is the fact that many clients do not want to spend money on trademark protection in this economy. Consequently, we have to help them balance their financial obligations to their company while at the same time informing them of the risks in not enforcing their trademarks. Simply put, if you spend \$1,000 on trademark protection today, that money might buy you a trademark that is worth \$100,000 in brand protection in the years to come. Unfortunately, many clients do not want to spend up to \$4,000 to register a trademark abroad because they do not realize it is necessary to do so.

I believe the best way to avoid mistakes in this area is to sit down with your clients and ask them what their expectations are with regard to their brand and where they want to be in five, ten, or twenty years or more. One should also ask them what they really want to achieve in terms of a trademark strategy. Do they want to protect a very strong brand that they believe is unique? Do they understand the risks of using a trademark that is not very strong or that may potentially infringe the rights of a third party? This type of conversation is much more effective in coming up with a strong strategy as opposed to the attorney just implementing a strategy on their own without the client's input. Coordinating and implementing a strategy is a process an attorney and client should go through together. At the same time, attorneys often forget that most of their clients are not trademark-savvy. Therefore, attorneys really should take a step back and explain the trademark process and enforcement strategies to their clients, including the basics of what a trademark is, what it means to have a trademark, and how it should be protected. Most business owners know what a trademark is, but they do not really understand everything that goes along with it.

Searches and Other Preliminary Considerations When Evaluating Trademark Applications

Prior to filing a trademark application, I always recommend that we conduct a preliminary Internet search regarding the trademark, and then conduct a search of applications and registrations on the Federal Trademark Register. All too often, clients will come up with a trademark without realizing they may have seen a similar or identical mark somewhere else. Upon conducting an Internet search or a preliminary search of the trademark register, we find that someone else has either already filed an application or obtained registration of the same.

Again, many clients do not want to spend the money that is needed for these searches—in which case, I will recommend that they do some research on their own to make sure nobody else is using any mark that is similar, even though this is not the optimal manner in which to proceed. I have found that once a client makes a mistake in this area (e.g., foregoes the search and then receives a cease-and-desist letter because the mark conflicts with that of another), the client typically does not do so again and realizes the importance of the searches. Clients ultimately realize that we do not recommend these searches for our own financial benefit, but because our first priority is the protection of our clients' rights.

Also, because many smaller companies are not familiar with the nuances of trademark law, we will often ask our smaller clients to verify whether they really would like to file the application in their own name due to the liabilities attached in doing so. Often, we will instruct our clients to obtain the advice of their accountants or we will consult with the attorneys performing corporate work on behalf of the client to identify the correct owner of the trademark. Moreover, we have found that even some of our larger clients do not understand that a trademark has to be filed in the name of the individual or company that is actually going to be using or controlling the trademark, as there are both tax and ownership consequences that need to be addressed. For instance, if an individual owns various entities that will be using a trademark, but the entities are all separate, the question becomes who owns the trademark and under whose name should the trademark be filed. The trademark owner must be the one who is controlling the trademark and, as such, can license use of the trademark to other entities.

Therefore, we always ensure that our clients understand exactly what needs to be evaluated when filing a trademark application and whose name it needs to be under.

Finally, in cases where a trademark could be viewed as potentially descriptive and face refusal on this basis, it is important to be sure that nothing in the identification of goods and services of the application would suggest that the trademark is descriptive. While it can be quite challenging to craft an identification that does not signal that such a trademark is descriptive, it does ensure that your client has a better chance of obtaining a trademark registration.

Trademark Infringement Enforcement Strategies

With respect to trademark infringement concerns, it is important to consider the strength of the client's mark and explain the same to the client before implementing an enforcement strategy. Where you may have many third parties using a similar or identical trademark for related goods, the enforcement may not be very aggressive. On the other hand, if the mark is distinctive or has acquired secondary meaning (where use of the mark is widespread and recognized by consumers as emanating from one source), enforcement strategies must be aggressive. Another consideration is the importance of the trademark to the client. If the trademark is only going to be used for a limited time or for very limited goods, enforcement may not need to be widespread.

Where a client may have ignored infringements on its trademark for several years, but now has come to realize that it must implement an enforcement strategy, actual enforcement may be challenging, as third parties who have used the mark or a similar mark will have numerous defenses they will raise in support of their continued use of their marks. In other instances, a client may not have enforced a trademark on the Internet and may find it to be a daunting challenge to "clean up." In these situations, clients need to be counseled in the approach to be taken to combat such infringements, the amount of time it may take to clean up such infringements, and how much should be budgeted for the same. In some cases, where the infringement may have occurred for many years, the best result against long-term infringers may be a license or other agreement with the infringer. There are

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many factors that have to be considered in an infringement enforcement strategy, depending on the circumstances and the client.

Evaluating the Financial Components of a Trademark Strategy

When evaluating the financial components of a trademark strategy, analysis should not be based solely on the amount of cash the client currently has. Rather, clients should be counseled to plan ahead, and not think about where they want to be in one year, but where they want to be in five years. For instance, if the client wants to sell a product in Japan five years from now, that does not necessarily mean they need to file a trademark application in Japan today. Instead, they may consider first securing trademark protection in the United States, but they should factor Japan into their business plan such that they will have the finances to apply for a trademark in Japan before they do business there or if their products should become extremely successful (especially since countries like Japan are “first-to-file” and trademark protection is granted to the first person to file an application, even if not the rightful owner of the trademark).

When dealing with larger and more sophisticated clients, a key consideration is how well their business is performing at the current time in a certain jurisdiction. Depending on that figure, it may not be worth applying for trademark protection for a certain product in certain countries. However, if those sales figures should increase in certain jurisdictions, the client should get an application on file. In the past, many clients would instruct us to file applications worldwide even before their products or services were launched, either because they had venture capital or investor money or huge budgets. Given the current economic state, clients are now much more conservative in how they expend their budgets, and they first evaluate their business plans to determine when and where to file applications.

Similarly, with regard to trademark litigation, when counseling clients, we first try to quantify the monetary damage caused by the infringement, and then compare the cost of litigation to the potential recovery. This must be done keeping in mind the potential consequences of not litigating or recovering damages, and the possibility of not obtaining an injunction. Ultimately, many different components must be evaluated with clients before bringing an infringement lawsuit, because doing so is often very costly. Again, in many

cases, clients are not willing to spend hundreds of thousands of dollars on litigation in this economy. However, at the same time, not bringing a lawsuit could result in higher damages due to continued infringement and potential loss of trademark rights for not enforcing such rights.

Reviewing Trademark Infringement Risks

To minimize trademark infringement risks, third-party services are recommended to monitor and evaluate worldwide trademark usage. Watch notices are an effective tool in monitoring such potential infringements. When facing potential foreign oppositions, it is helpful to first consult with foreign associates to determine the chances of successfully opposing or enforcing the client's trademark rights in their respective jurisdictions, as the rules and laws in other jurisdiction often differ from those in the United States.

In monitoring such potential trademark infringement and reviewing watch notices on a regular basis (one or two or more times per week), one can determine the strength or weakness of a client's trademark and ultimately single out those marks that are problematic. Conversely, if you undertake this process on a biannual basis, for example, you may uncover numerous issues, which makes it extremely difficult to implement an effective enforcement strategy. Moreover, performing a regular review of watch notices makes it easier for clients to evaluate their worldwide trademark protection strategies, as they are in constant communication with their attorneys regarding these issues and develop a better understanding of the risks related to trademark infringement and the trends in their industry. As a result, clients are often in a much better position to instruct on whether action should be taken against potential issues or infringements. Clients should be involved in making decisions regarding their trademark strategies, as opposed to having their attorneys make these decisions on their behalf, as clients know more about their industries and their competitors than their attorneys. As much as attorneys may know about the client's industry, the client obviously knows more. As a result, clients involved in the decision-making process may achieve better results.

Educating Clients about Trademark Usage

All clients need to have some basic knowledge regarding exactly what a trademark is and what it does. Many smaller clients do not understand that

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a trademark's basic function is to identify the source of goods and services. Clients also need to be educated regarding the fact that one can only obtain a trademark registration if they use a trademark in interstate commerce and such use conforms with the statutory laws with regard to trademarks. For instance, a trademark belongs on a product tag or label so it is identified with a product in some way. Clients should also be informed that a trademark is an intangible asset that helps build value in a company. Without a trademark, a company may have a product but no brand recognition, and that recognition is where a company's value comes from.

For all clients, attorneys should counsel their clients on the trademark application process, what is involved, and why it is necessary. For instance, certain clients that sell products in countries where trademark registration is necessary to sell a product should be informed accordingly. In other words, if a client wants to sell its products and grow their business in a particular country, they may need to register and maintain a trademark in that country. Therefore, attorneys must also keep abreast of trademark rules, as they may pertain to certain industries and countries where their clients do business.

Anticipated Changes in Global Trademark Protection

Looking ahead, I believe we are going to see more companies filing trademarks on a worldwide basis, especially in Europe. Again, because the US economy is experiencing a downturn, the biggest market for many clients is now outside the United States. We are also likely to see more retail sales on the Internet, particularly through applications such as iTunes, which means that more of the infringement and trademark cases in the federal courts will be based on those technologies and uses.

With respect to the practice of trademark law, attorneys will need to ensure that they educate themselves on the most current information regarding technology and its effects on their clients' industries. Such information can be obtained from the Internet and blogs. In fact, the best way to obtain information in a condensed and easy-to-read form is often to subscribe to a well-known blog focusing on trademark law. In addition, intellectual property lawyers in California need to keep an eye on the Ninth Circuit, and the same advice applies to attorneys in other jurisdictions. It is always important to know what is going on nationwide, but it is also important to keep current with cases in your particular circuit if you frequently litigate in the same.

Finally, attorneys need to keep up with the current trends in this area, including the manner in which social media websites are being used (i.e., what their functionalities are, how they are treating trademarks, and what mechanisms are available to bring trademark infringement issues to their attention).

Conclusion

As technologies develop and companies look for new and improved avenues for marketing and selling their goods and services, trends in the trademark arena are likely to continue to change. Due to these changes, new issues will arise that will need to be considered by the courts that could result in further changes in the application of trademark law in these contexts.

Attorneys desiring to effectively counsel their clients on trademarks should ensure that they keep current with any case law, trends, or new methods of marketing and retail sales that may be employed by their clients so as to provide the most up-to-date counseling on potential issues for protection and enforcement of trademarks. Attorneys must also be able to provide their clients with the best information possible to allow the client to consider whether protection or enforcement should be immediately undertaken or whether the same can and should be delayed.

Key Takeaways

- Be careful that you are accurately identifying the client's goods and services in trademark applications. Craft an identification that is suggestive, not descriptive.
- Advise clients who are thinking about obtaining international trademark protection to research where their real markets are. Put a watch notice in place in those countries where the client's trademarks are filed.
- Ask the client what they really want to achieve in terms of a trademark strategy. Educate your client about what they can and cannot do with respect to trademark infringement on the Internet.
- Evaluate the client's business plan to decide when and where you should file a trademark application, and how you should budget for it. Quantify how much monetary damage has been caused by

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someone's infringement, and then analyze how much litigation will cost and how much money the client can recover.

- Obtain information from blogs that focus on trademark issues, keep tabs on trademark case law trends in your local circuit courts, and pay attention to how social media sites are treating trademark infringement issues.

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Ms. Bhatti has worked as a trademark examining attorney at the US Patent and Trademark Office, where she examined more than 2,000 trademark applications and represented the Trademark Office before the Trademark Trial and Appeal Board. She frequently writes about and speaks on the topic of trademark protection at seminars, including those geared towards the fashion industry. She currently serves on the Patent and Trademark Office Subcommittee of the International Trademark Association's Trademark Office Practices Committee and previously served on the Middle East, Africa, and South Asia Subcommittee of the International Trademark Association's Anti-Counterfeiting and Enforcement Committee.

Ms. Bhatti earned her J.D. at St. John's University School of Law, her L.L.M. at the University of Houston Law Center, and her B.A. at the State University of New York at Albany.