

Trademark Bullying

Catchy Phrase or Valid Concern?

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The Trademark Technical and Conforming Amendment Act of 2010



Study and report to Congress on:
“[T]he 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

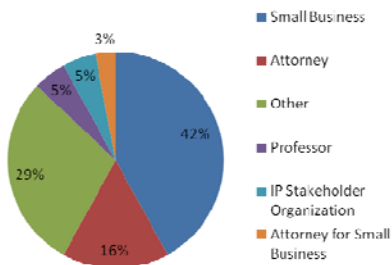
Sponsor: Sen Leahy, Patrick J. [VT]



United States Patent and Trademark Office
An Agency of the Department of Commerce

Report To Congress

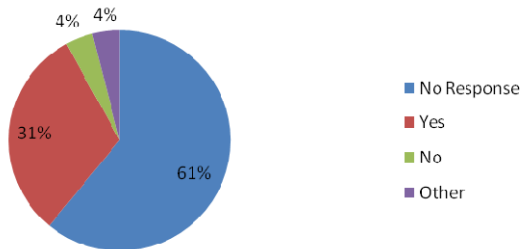
Submitting Organizations



United States Patent and Trademark Office
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Report To Congress

Are Aggressive Trademark Litigation Tactics a Problem?

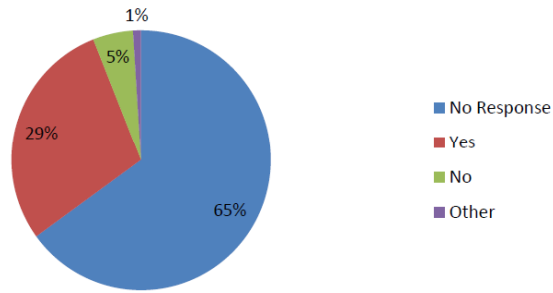




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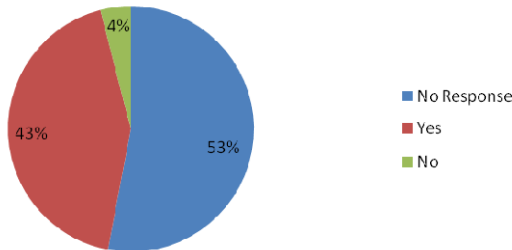
Congress Responsibility




United States Patent and Trademark Office
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Report To Congress

USPTO Responsibility





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Conclusion:
Is there a problem?
“After careful review....”
“it is unclear”



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Reaction

“Well-written” *“Worthless”*
“Thoughtful analysis” *“Useless”*
“Applauds”
“Unsatisfying” A *“complete whiff”*

So....is there a problem?



163

(That's a TTAB filing every 1.75 days)

From January 1, 2009 through October 12, 2009





Kellogg's™

MAG 0047 03110001
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Kellogg North America Company Opposer.	Opposition No. 91196938 Serial No. 77955195
Malt-O-Meal Company Applicant.	

ANSWER TO NOTICE OF OPPOSITION

COMES NOW the Applicant, Malt-O-Meal Company to answer the Notice of Opposition. Any allegation not specifically admitted herein is denied. Applicant specifically denies any confusing similarity or damage to Opposer. The numbered allegations are answered as follows:


1. Admitted.
2. It is admitted that Opposer now uses the terms FROSTED MINI-WHEATS and MINI-WHEATS as a trademark. The length of time used and the extent of such use is unknown by the Applicant and those allegations are denied.
3. It is admitted that Opposer claims ownership of the three-named registrations but Opposer has not made copies of those Certificates of Record in an appropriate way, therefore Applicant denies the remaining allegations and will leave Opposer to its proofs.

*Kellogg North America Company v.
Malt-O-Meal Company,
Opposition No. 91196938*

“The longstanding and habitual practice of trademark bullying engaged in by the Opposer gives the opposer unclean hands and bars relief to Opposer.”



“...disturbs the Court”



Case 8:11-cv-00228-ACC-DAB Document 32 Filed 06/13/11 Page 1 of 9 PageID 1028

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

BEANER BEVERAGE COMPANY, d/b/a
MONSTER BEVERAGE COMPANY, et al.
Plaintiff,

vs.

Case No. 11-cv-00228-ACC

EVOLVE ENERGY SERVICES, INC.,
NORTHSTAR ENERGY, INC., and
BEANER, THE BEER & SODA, and
YUM! BRAND, INC., d/b/a
YUM! BRAND,

Defendants.

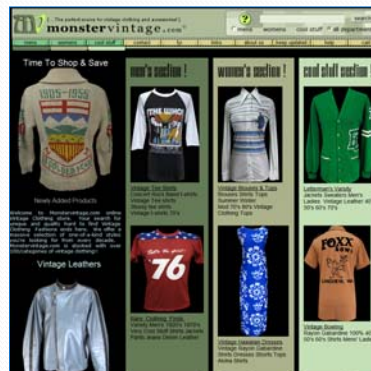
ORDER

This case comes before the Court for consideration of Plaintiff Beaneer Beverage Company's Motion for Reconsideration of the Order of Preliminary Injunction (Doc. No. 10), filed on March 11, 2011. Plaintiff has also filed a supplemental declaration in support of the motion (Doc. No. 31). Plaintiff contends that Defendants' motion to reconsider Plaintiff's motion for preliminary injunction (Doc. No. 10) "set forth a clearly erroneous legal standard governing the issuance of a motion such as preliminary injunction." (Doc. No. 31 at 1.) Plaintiff asserts that its motion for reconsideration and preliminary injunction was based not only on unrebutted fact but also on trademark infringement. Plaintiff contends that various re-organized facts when re-examined show that the facts of unrebutted fact that Plaintiff did not have to prove that the motion was ill-founded. Plaintiff also alleges Defendants' claim of error was

“Even in the short course of this litigation a **pattern has emerged**. ... Upon closer examination, however, the Court realizes that the most revealing or important aspect of Plaintiff's documents was ignored or **misrepresented by Plaintiff**. This pattern **especially disturbs the Court** considering the nature of Plaintiff's requested relief.”

“Plaintiff, through its misrepresentations, effectively **abused this legal process**.”

“Shaming”





The New York Times Business JANUARY 20, 2011

Using publicity to fight trademark cases

WORLD U.S. N.Y. / REGION BUSINESS TECHNOLOGY SCIENCE HEALTH SPORTS OPINION
MEDIA & ADVERTISING WORLD BUSINESS YOUR MONEY DEALBOOK MARKETS COMPANY RESEARCH

Levi's Turns to Suing Its Rivals

Levi's designers worked on jeans at the company's headquarters. More Photo by MICHAEL BARBARO and JULIE GRESWELL Published January 29, 2007

Levi's designers worked on jeans at the company's headquarters. More Photo by MICHAEL BARBARO and JULIE GRESWELL Published January 29, 2007

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Shaming Trademark Bullies

What is Trademark Bullying?

- Unreasonable interpretation of trademark rights (violation of legal norms);
- By large corporation, brought against small business or individual (violation of social norms against bullying); and
- Using intimidation tactics.

Trademark bullying of small businesses has become a serious problem.

- Recognized by Congress earlier this year when Trademark Technical and Confirming Act was passed.

Trademark Bullying is a Serious Problem

The United States Congress is the Standard Bearer of Justice

Shaming Trademark Bullies can be Effective

- All conditions of successful public shaming are met in consumer products market
- consumer community;
- shared norms;
- large corporations are vulnerable to shaming; and
- small businesses and individuals are believable.

Proposals

- Understand conditions of successful public shaming and provide practical guidelines
- Legal Reforms:
 - Provide protected space for shaming; and
 - Adopt groundbreaking reforms of trademark infringement cause of action

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their case to the public – often using social media. For example, see South Butt, Vermont State v. South Butt, 2010 VT 101, 185 A.3d 1111 (2010).

Assistant Professor Leah Chan Grinvald, who has written extensively on trademark bullying, using publicity as part of a defense strategy, have noted before, social media makes it easier to bring a case, and this may be useful in certain circumstances.

Trademark Extortion: The End of Trademark Law¹

Kenneth L. Port*

Abstract

Trademark law in America today is undergoing a profound change. One of all trademark cases reported since the Lanham Act took effect in 1945 is the case of a small business owner who was sued for trademark infringement. The case was reported in the trademark law section of the trademark law journal. The case was reported in the trademark law section of the trademark law journal. The case was reported in the trademark law section of the trademark law journal.

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So....is there a **perception**
of a problem?

*“The perspective among
consumers that we are
big brands bullying
consumers is growing...”*

The McCarthy Institute-Microsoft
Symposium “Trademark Law and its
Challenges in 2011” (Feb. 3, 2011)

So....is there a **perception**
of a problem?



Tips

Tips


Look Before You Leap

*Investigate & Analyze the
Claim Before Sending the
Letter*

Tips

Avoid the "One Size
Fits All" Mindset

*Tailor Your Enforcement
Efforts to the Situation*



The image shows two logos side-by-side. On the left is the 'Mount Olivet' logo, which is green with white and red text. On the right is the 'Mountain Dew' logo, which is green and red with white text. The 'Mount Olivet' logo is smaller and less stylized than the 'Mountain Dew' logo.

“The MOUNT OLIVET logo closely resembles PepsiCo, Inc.’s registered MOUNTAIN DEW trademarks in both stylization and color. Such use wrongly trades on the goodwill of our brand and could lead to consumer confusion by creating the impression of a sponsorship or association with MOUNTAIN DEW soft drinks. In addition, by mimicking our famous MOUNTAIN DEW logo and federally-registered DO THE DEW advertising slogan, the distinctiveness of our trademarks are diluted.

“I trust you will not proceed with producing and selling the t-shirts.”



The image shows a spiral notebook with a white cover and a silver spiral binding. The notebook is open to a page with lined paper. The word 'Tips' is written in a large, blue, sans-serif font at the top. Below it, the text 'Follow The Goldilocks Rule' is written in a smaller, blue, sans-serif font. At the bottom, the quote “Not too easy, not too hard” is written in a blue, italicized, sans-serif font.

Tips

Follow The Goldilocks Rule

“Not too easy, not too hard”



Trademark Bullying

Catchy Phrase or Valid Concern?

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