

The Global Economy, Information Overload, and Internet Postings All Raise Issues for Trademark Lawyers

Author

Steven T. Taylor is a professor at Oregon College of Art and Craft, where he teaches non-fiction writing and public presentation. He's an award-winning freelance journalist with more than 750 published articles, editorials, essays and other works for more than 60 organizations and publications, including *The Nation*, *The Washington Post*, *Public Citizen*, *Of Counsel* and *Law Practice Magazine*.

When Brian Wheelock first began working as an attorney in the trademark area nearly 30 years ago and a corporate client would ask him to try to clear a proposed brand name and logo, he'd conduct the trademark search by perusing a thick, hard-covered, government-issued compendium. That's right, an actual book; it was, after all, way back in the quaint, old-school 20th century.

"When I first started off, we'd do a search by looking it up in a book—it was like a dictionary—that was published once a year because things didn't change that much back then," says Wheelock, a partner at the St. Louis-based law firm *Harness Dickey*, who's also a patent attorney. "Obviously you can't do things that way anymore. Now when you do a search, the first thing you do is screen it at the Trademark Office [the US Patent and Trademark Office] website and then you Google the mark."

Of course, the methods of trademark searching aren't the only things that have changed in the practice area over the last three decades. What was once a respectable but not exactly titillating field of law has grown increasingly fast-paced and exciting, attracting more and more young attorneys, and while a majority of the trademark practice was once chiefly centered within US borders, now it's as global as it gets. More often than not, if a company needs a brand, it needs a worldwide brand.

"Globalization is making much more work for trademark attorneys, making it harder for us to do our jobs," Wheelock says when asked about what issues are driving the practice. "You can't just clear a mark for the United States anymore.

Related Bios

Bryan K. Wheelock is a principal at *Harness Dickey* in St. Louis, MO. His practice includes preparation and prosecution of patent and trademark applications and drafting of intellectual property agreements, including non-compete agreements. In addition to his practice at *Harness Dickey*, he is an Adjunct Professor at Washington University School of Law and Washington University School of Engineering.

Theodore Lienesch is a registered patent attorney and a partner in Thompson Hine's Intellectual Property practice group in Dayton, OH. He focuses his practice in domestic and foreign patent and trademark prosecution; copyright prosecution; intellectual property licensing, including technology transfers, joint venture agreements and trade secret licensing; patent and trademark validity and right-to-use studies; and copyright, trademark and patent infringement litigation.

You have to search in other jurisdictions, which increases costs. So you might clear your first group of countries and the second group but, uh-oh, there's a problem in the third group, and it sends you back to the start. Everyone in the trademark area has the issue of finding a mark that you can use everywhere because no one's satisfied anymore with just using a mark in the United States."

The complicated and often exhaustive act of clearing words, phrases, or logos—and sometimes even sounds and smells—that identify the company providing the products or services isn't the only aspect of trademark law that globalization has made more complex.

"With the international economy comes other issues such as counterfeiting," Wheelock adds. "Once you have a good brand, people in smaller economies say, 'We can make money because this trademark has so much value.' So they decide to add value to an otherwise nondescript product by, for example, stitching a polo guy onto a shirt and changing a \$2 shirt into a \$40 one."

Naturally, as the trademark practice goes global it also requires lawyers to expand their intellectual reach to learn about laws in different jurisdictions, while staying abreast of the changes in US federal and state laws. Simply put, it's a document-heavy practice area. "There's an overwhelming amount of information that you have to sift through," Wheelock says succinctly.

Stopping the Internet Infringers

Ask Theodore Lienesch to name the top trend in trademark law, and he doesn't hesitate to answer. "Today, the hot issue can be summed up in two words: social media," says the partner from his Dayton office at Cleveland-headquartered Thompson Hine. "Social media and its interplay with branding are operating at Internet speed. It's creating problems

for trademark practitioners both on the enforcement side and on the advertising side."

On the enforcement end of this issue, companies track activity on the Internet to keep up with their competitors and, increasingly, to see what people are saying about them. One consequence of social media, of course, is that consumers become part of the branding process. They are out there commenting on products, services, and brands. "So it's incumbent on brand owners to monitor social media to see what's happening to their brands and how their brands are being treated," Lienesch says. "It's become an active rather than a passive exercise. These days you're at the mercy of your customers. So you have to stay on top of that."

When Lienesch's clients discover someone using their company name or logo in a disparaging manner, copying their ad and using it, or otherwise infringing their brand on, say, Facebook, YouTube, Twitter, Instagram, or other social media outlets, they contact Lienesch. The first thing he has to do is to be sure that he's up to speed on each particular site—and it seems new social media avenues pop up all the time—and then take action to stop the offending party.

"The knee-jerk answer might be to sue the person," Lienesch says. "Of course, most of the time my clients are not eager to sue somebody because of the cost involved. Litigation is always the last resort for me and, frankly, for my clients, too."

Fortunately, most of the social media outlets have methods and procedures in place for lodging complaints. Often Lienesch, and other trademark attorneys, will contact the social media site and file an objection. But sometimes that's not an option or it isn't effective in shutting down the transgressor. And that's when he needs to do some detective work by using the Internet to find the identity of the

poster. Once he does and gets a mailing address, he sends them a cease-and-desist letter.

“I like to go very old-fashioned,” he explains, “and send a certified letter, saying, ‘Here’s a copy of what you’re doing and here’s a copy of my client’s trademark registration that you’re infringing and we want you to stop.’ One effect of the letter is that you’re essentially saying, ‘I know where you live’ in a very polite and legal way. Since it’s certified, they actually have to sign for it. Because it’s rare to get a certified letter, I think it’s effective.”

Usually that does the trick, but sometimes Lienesch has to take other measures, again always looking to avoid litigation.

Tension Among Teammates

On the marketing front, social media also poses immediate but unintended problems that outside counsel, and for that matter inside counsel, must deal with. The marketing people at a company often want to launch a new ad campaign and roll it out on YouTube and other online outlets, which they like because it allows them to jump on a new, creative idea and roll it out to the consuming public quickly. Often too quickly for their attorneys.

“Marketing departments see nothing but the upsides [to this fast roll out], but the downside is that the in-house or the outside counsel has an extremely short period of time to vet the ad campaign,” Lienesch says. “I have a client that wanted to quickly roll out a Facebook video for its services—a domain name registry—that was a parody of Go Daddy.”

Lienesch and the other lawyers had to slow down the eager ad campaign people at this company to ensure that there was no, or at least little, risk of infringement; if there were risks, the video needed to

be edited. “The issue became what can the company do without getting sued by Go Daddy,” he says. “It raised issues of parody and consumer confusion and disparagement. It was quite a drill.”

As a result of this push and pull between the marketing and legal teams, tension often arises. “That can be an issue,” Lienesch says. “It’s a balancing game because the marketing people are saying, ‘All these legal people are no fun. They’re telling us we can’t do all the cute things we’re doing because it might hurt the brand of the company we’re making a parody of.’ So the challenge for lawyers is to be able to react quickly and stay on top of the marketing department.”

Lienesch agrees with Wheelock’s assessment that globalization has complicated trademark law and tells of a situation where his client got tripped up at the intersection of globalization and social media.

Recently one of Lienesch’s clients discovered that a Canadian-based company was infringing the client’s trademark on social media, forcing him to send a letter to all the US sales offices and the company’s headquarters. “I didn’t hear anything back,” he says. “My client agreed to let me retain Canadian counsel because I thought it would be more effective to have some boots on the ground in their home country. Then they know you mean business. Another benefit is that the Canadian lawyers could write a letter that would carry greater impact on the Canadian business better than I could.”

In the end, the lawyers were successful and the infringers took down their social media posting of the offending terms. But it wasn’t easy. Then again, it seems practicing trademark law in the 21st century rarely is.

– *Steven T. Taylor*

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