

Infringement or Fair Use/Free Speech? Deciding When to Go After Brand Users Is One of Many Issues Facing In-House Trademark Attorneys

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To chase or not to chase? That's often the question in-house trademark lawyers have to ask and then answer. That is, do they chase down someone who is using their company's brand and get them to stop, through various means including litigation or the threat of litigation, or do they determine that the trademark use constitutes fair use or free speech and let it go? And, in today's Internet-crazy world, it's an issue attorneys encounter more and more and with ever-increasing complexity.

"In the last 10 years, with the proliferation of social media, the Internet, and domain names, trying to control your trademark has become quite difficult," says Barbara Bunning-Stevens, associate general counsel for The Monsanto Company. "You have to decide what your

strategy and philosophy is about going after people. We will look at what kind of website [the questionable trademark was posted on] and what exactly they're doing with it. We look at every situation on a case-by-case basis and examine how egregious it is. Is it political speech or harmless satire, or are they making false claims about or false comparisons with our products?"

If the Internet poster pokes mild fun at Monsanto or any of its many subsidiaries without really damaging the brand, Bunning-Stevens and her team will likely look the other way. But even so, they'll continue to monitor the content. "Sometimes we'll just decide to continue to watch a website," she says. "We may not do anything. We may just wait and see."

But when a company copies large sections of one of Monsanto's websites, including the logo, that

Related Bios

Barbara Bunning-Stevens is an associate general counsel at The Monsanto Company, specializing in US and global trademark law, particularly issues related to the Internet and social networking, and copyright law, trademark licensing, and advertising law. Prior to joining Monsanto in 2001, Ms. Bunning-Stevens was a senior counsel at Procter & Gamble from 1990-2001 and a litigation associate at Frost and Jacobs from 1988-90. She earned her JD from the University of Kentucky College of Law.

Donna Frazier Schmitt is a senior trademark counsel at Energizer Holdings, Inc., where she manages attorney and paralegal professionals in IP clearance, prosecution, maintenance, litigation, licensing, acquisitions, commercial contracts and other transactional efforts. Ms. Frazier Schmitt joined Energizer in 1998. She was chairperson of the North American Subcommittee of the INTA Anticounterfeiting Committee from 2012-2013. She earned her JD from Washington University, St. Louis, and her BA in English from the University of Arkansas.

may require action. “If something’s just been lifted and made to appear, even though it might be a site poking fun at us, to be our site, we try to do something about it because it can cause consumer confusion.”

At Energizer Holdings Inc., the company uses one of the most well-known brands in the world to sell its batteries—after all, its famous Energizer Bunny has been hopping across TV screens for decades. And countless consumers seem to really like the little bouncy fellow, invoking his name and referring to his persistent behavior to describe energetic and determined people.

“The Energizer Bunny is very popular,” says Donna Frazier Schmitt, a senior trademark counsel at Energizer. “We want him to have fans, and he does. And if someone makes reference to him or uses him to comment in a satirical way or an educational way, that could be considered fair use. Any time someone refers to another person and their enduring spirit and their tenacity by saying they are ‘like the Energizer Bunny,’ that’s a commentary and something we consider to be fair use.”

But overuse of the bunny by the wrong sources can weaken the brand, and Frazier Schmitt and her group work hard to avoid that, which can be challenging. “We have to make sure that he doesn’t become diluted, meaning not associated with us anymore,” she says. “That keeps me busy.”

Most in-house counsel don’t get concerned about their client’s trademarks, Frazier Schmitt says, as long as the company’s products and brands are talked about truthfully and there’s no false association or endorsement; if parody is involved, it must be obvious and not too over-the-top.

Monitoring Laws and Working with Marketing Staff

While making determinations about how someone is using a trademark and what, if anything, to do about it keeps trademark attorneys active, it’s one

of only several issues they must confront. Another is the sheer volume of information that comes at them, especially for in-house counsel at companies like Monsanto and Energizer, which have such an extensive global reach.

“The laws are always changing and that can be challenging to keep up with,” says Bunning-Stevens. “Canada just changed its laws now with regard to trademark classes. They’ve never had a classification system and now they’re enacting that. So, yes, you have to stay abreast of the laws in the different jurisdictions.”

She notes that while Monsanto lawyers review and monitor a lot of laws around the world, they also rely heavily on their outside law firms to do that. And that also means foreign firms. As Frazier Schmitt puts it, “We work with law firms in every country. So while I get very familiar with the law in a lot of different countries, I’m going to use a local expert to advise me on what exactly the law is there.”

Speaking of the international arena, in-house trademark lawyers sometimes encounter people who find out the name of the brand or its logo that a company registers in one country and then move quickly to file it in another jurisdiction with the intent of forcing the company to buy the mark from them.

Bunning-Stevens explains: “It’s sometimes difficult because you don’t always know initially all the countries in which you’re going to launch the product. So you need to have a robust filing strategy to protect yourself, because in some countries it’s first-to-file, and somebody can get wind of your filing for a mark and then they rush out and try to file for it in India, for example. Then you’re left with no recourse except try to get the mark back from them. That’s done with top level domains, too.”

When asked about other issues they must deal with, both Bunning-Stevens and Frazier Schmitt

talk about the challenge that arises within their companies regarding trademarks, the potential conflict with marketing departments. Essentially, marketing teams sometimes get an idea and want to run with it with little regard to trademark matters. In-house counsel are the ones who often have to rain on their parade and tell them they can't use the proposed brand name or logo because it would or could be infringement.

"There can be some tension because the marketing people will want to use the name and then it comes down to evaluating the potential risk if we go forward with it," Bunning-Stevens says. "If the competitor owns the exact mark, well you better forget it; the mark's in use. Now, you might be able to work something out if it's a smaller company, or maybe it's not the exact mark, or they don't use it on the same goods." She points out that even identical trademarks can coexist on disparate goods. For example, the Bounty brand in the United Kingdom is used for a type of chocolate bar, whereas in the United States it's the well-known paper towel manufactured and sold by Procter & Gamble.

But when the new brand name conflicts with other comparable products problems surface, and they're compounded if the marketing department and the company's decision-makers fall in love with the name and apply pressure on their attorneys to sign off on the brand. "Sometimes when you're doing the initial knockout searches, or even before

you've done that," Bunning-Stevens says, "the marketing group will sell the name up the totem pole, as I call it, to upper management, and people follow up with it before you're even able to clear it."

So in-house attorneys must be sure that management knows what the potential risks are. The company clearly doesn't want to choose a name that will be used on bags and tags and packaging only to find out later that it must be removed because it infringes another trademark. That's an expensive mistake that can cost valuable time and resources and sometimes even jobs.

The key is for attorneys to work closely with the marketing staff and naming strategy group early on in the branding process. "We have really worked hard, and I think we've been successful at being sure that we're not invited late to the party, that we're part of the team from the start," Bunning-Stevens says. "Because we're part of that team, we can head things off at the pass."

Frazier Schmitt agrees and says her group and the marketing department also work closely together. "I'm very lucky because I work with companies and marketing teams that are very familiar with the trademark process," she says. "They're very aware of the importance of trademarks and protection of trademarks. And, they bring us into the loop very early."

– *Steven T. Taylor*

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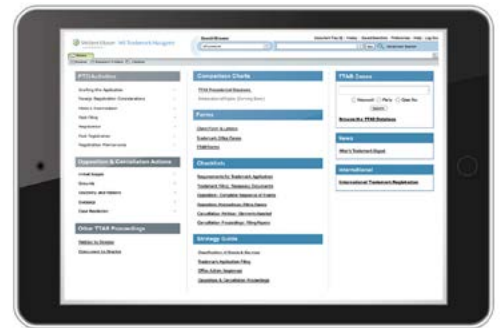
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