

Hot Topics in Trademark Law Panel Discussion

2023 New Legal Risks Symposium

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Today's Panelists



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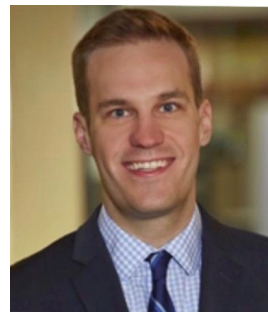
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What We Will Cover

- Generative Artificial Intelligence
- Managing Client Expectations
- Non-Traditional Trademark Rights
- Mitigating Risk of False Advertising Claims
- Cease and Desist Letter Strategies
- Online Infringement Strategies
- First Amendment and Trademark Law
- Who Should Sign USPTO Declarations?

The Intersection of Generative Artificial Intelligence and IP Law and Practice

- Trademarks, Copyrights, Patents, Other Possible Issues?

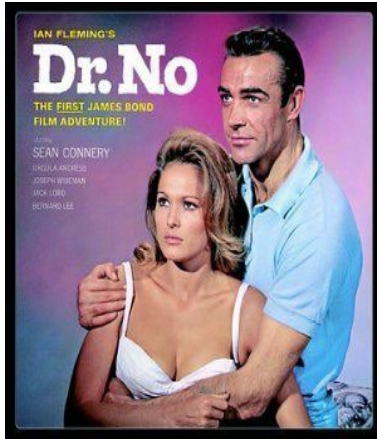


Best Practices for Managing Client Expectations

- Given unprecedented delays to receive examination from the USPTO?
- Given inconsistencies and varied level of talent of USPTO Examiners?
- Given the subjective nature of descriptive/suggestiveness refusals?
- Given the subjective nature of failure to function registration refusals?
- Given the subjective nature of likelihood of confusion registration refusals?
- How important is it to obtain federal registration, always mission critical?
- When might it be satisfactory or acceptable to not achieve registration?
- What steps might be worth taking to mitigate the risk of no registration?

The Critical Need for Early Collaboration Between Marketing and Legal Teams

- Perspective of some designers/marketers





Tips and Best Practices for Developing and Defending Against Non-Traditional Trademark Rights

Incredible Range of Trademark Subject Matter

- **Identify**
- **Distinguish**
- **Indicate Source**
- Color/Color Combinations
- Texture
- Product Shape/Features
- Product Packaging
- Product Containers
- Motions
- Scents/Taste
- Attention-Getting Devices

Incredible Range of Trademark Subject Matter



UnitedHealth Group Secures Three Motion Service Mark Registrations from USPTO

VEED.IO



Best Practices for Mitigating the Risk of False Advertising Claims

The background of the slide features a stylized, low-angle view of a city skyline. The buildings are represented by a series of parallel lines that create a sense of depth and perspective, converging towards the center. The sky is a solid, warm yellowish-brown color, with some faint, wispy clouds visible in the upper and lower portions. The overall aesthetic is modern and architectural.

Strategies for Sending and Responding to Cease-and- Desist Letters

A Trademark's Scope of Rights: Evaluating Trademark Targets/Claims

- Likelihood of Confusion
 - Strength of the Mark
 - Similarity of Marks (Sight, Sound, Meaning)
 - Similarity of Goods/Services
 - Channels of Trade
 - Actual Confusion
 - Intent
 - Sophistication of Consumers



Likelihood of Confusion is Subjective

- Parties Typically See Things From Their Own Perspective (Shoe on Other Foot?)
- Trademark Rights Are Not like Real Estate Property Lines (Gray, Not Black/White)
- Decision Makers Balance Complex Multi-Factor Tests (Making Precedent Difficult)
- Actual Confusion Not Required, Is there a Media Misunderstanding on Confusion?
- Trademark Rights Are Dynamic, Owners May Grow or Shrink Them Over Time
- Trademark Counsel Must Zealously Advocate for Clients, Can it Lead to Overreach?
- Intent Is a Highly Emotional Factor; Innocent Intent Is Not a Defense
- Confusion Is Actionable in More Ways than Simply Source



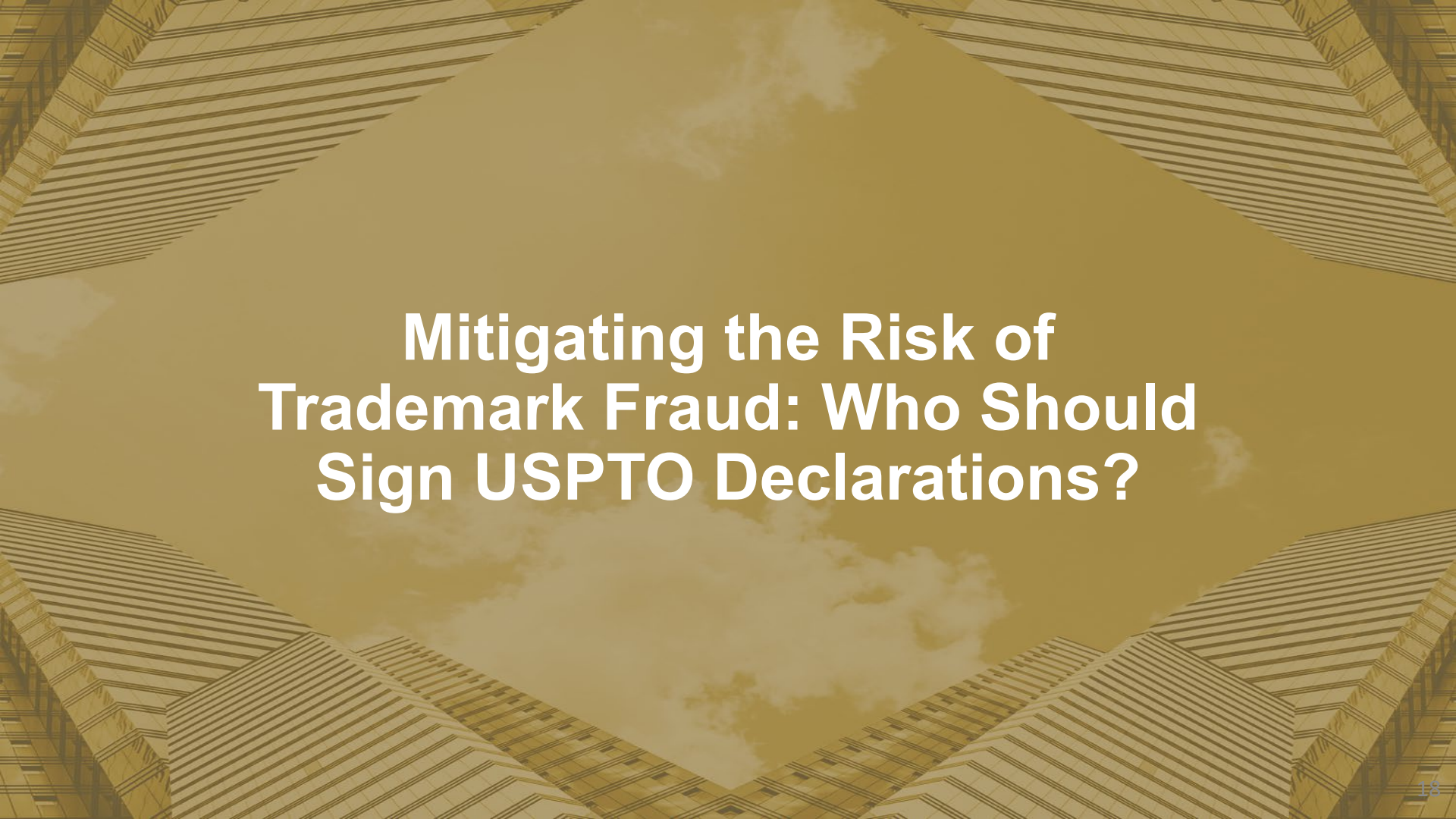
Best Practices for Successfully Pursuing Online Infringements

Best Practices for Pursuing Online Infringements

- Online retail platform takedown successes/failures
- Social media account takedown successes/failures
- Domain name disputes/UDRP Proceedings/Cybersquatting Claims

What About When the First Amendment Collides with Trademark Law?

- Classic Fair Use?
- Nominative Fair Use?
- Use of Third-Party Logos Without Permission?
- Comparative Advertising?
- Gripe Sites?
- Parody?



Mitigating the Risk of Trademark Fraud: Who Should Sign USPTO Declarations?

Looking Ahead After *Chutter*?

- Will the Federal Circuit agree with the TTAB in *Chutter* that reckless disregard for the truth satisfies the strict *Bose* standard?
- There are many possible signatories to verified statements filed with the USPTO, who is the best to mitigate the risk of a successful fraud challenge?
- Will *pro se* applicants receive more lenient treatment at the USPTO?
- Will more be expected of legal counsel who sign for applicants at the USPTO?
- How much due diligence is necessary to avoid a successful fraud challenge?
- How will corporate applicants strike the proper balance between appropriate diligence and a commodity mindset for “routine” filings?

Thank You!

Questions?