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Dunner Law PLLC, 3243 P Street, N.W., Washington, D.C. 20007
202-298-6002, www.dunnerlaw.com

Dunner Law PLLC

Small IP Practice specializing in trademark and copyright law; IP counseling, domestic and international protection of IP portfolios; internet-issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

Lisa A. Dunner, Esq.
Founder
ldunner@dunderlaw.com

Adam W. Sikich, Esq.
Associate
asikich@dunderlaw.com

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How Vigorously Should You Protect Your Brands?

Did you know that, as a trademark owner, you have a “duty” to enforce your trademark? This means that if you want to maintain the strength of your trademark, and you find that somebody else is misusing your mark or something confusingly similar, then you need to inform the unauthorized user (e.g., “infringer”) that they must stop. If you let the infringer continue, the infringer’s use (or misuse) will likely weaken the strength of your trademark.

The law does not require one to act against everyone that is using a confusingly similar mark. One must first ask to what extent does the unauthorized use affect one’s trademark. Next, one must ask whether enforcing one’s mark against others might have the potential to backfire – either by affecting one’s public image during the enforcement or by harming the public good in using the mark at issue.

By way of example, the Susan G. Komen Foundation (“Komen”) has recently struggled with enforcing its trademark rights while trying to maintain its reputation as one of the country’s most respected charities. In connection with its efforts to raise millions of dollars each year for breast cancer research, Komen has amassed an impressive portfolio of trademarks anchored by its RACE FOR THE CURE[®] mark and dozens of other marks utilizing the words “FOR THE CURE.” Komen has made it a practice to oppose other parties’ use and federal registration of trademarks which Komen believes are

confusingly similar to its own marks, and for this it has received some negative publicity.

Balancing Enforcement with the Public Good

Komen’s actions are typical for savvy trademark owners concerned about the potential negative effects that an unauthorized use of a trademark can have on a brand or business. But the problem for Komen is that many of the parties that Komen has accused of trademark infringement are small charities seeking to serve the public good. These small charities often adopt the wording “FOR THE CURE” or “FOR A CURE,” because they believe that wording is necessary for the purpose and mission that they strive to promote. They do not understand (and many do not agree) that Komen claims to have exclusive rights to these words by virtue of its federal trademark registrations and longstanding use. Despite Komen’s potential legitimate claims to these words, to the small charities that are being accused by Komen, they feel bullied.

The Komen example demonstrates the difficulty in striking the right balance between responsible enforcement of a trademark and mere trademark “bullying.” Komen’s attorneys argue that its trademark enforcement efforts are necessary in order to prevent confusion with other charities and ensure that donors clearly know that the money they contribute is being sent to its

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intended recipient rather than a scam artist. The charities targeted by Komen, however, insist that the wording "FOR THE CURE" is necessary to describe their efforts to cure diseases such as cancer, so they believe that Komen's enforcement attempts are overreaching. The smaller charities also believe that Komen is inappropriately diverting valuable donations to legal fees rather than breast cancer research.

Importance of Enforcing Trademark Rights

There are many legitimate reasons why trademark owners like Komen protect and enforce their trademark rights against others. First, there is a legal duty to enforce, which means that one must be proactive in stopping other unauthorized uses of one's trademark in order to maintain the mark's strength (the duty is not a requirement, but only necessary to maintain the mark's strength). Second, enforcement helps protect consumers by eliminating similar trademark uses that could create confusion as to the source of goods and services offered under each mark. Third, as noted above, enforcement helps to maintain a mark's strength and validity by eliminating unauthorized uses that, if left untouched, could weaken the mark and make it more difficult for a trademark owner to preclude subsequent uses. Fourth, trademark enforcement helps maintain brand integrity by ensuring that all uses of a mark adhere to the owner's standards of quality.

Trademark Enforcement in Other Contexts

It is important to note that responsible enforcement entails more than combating confusingly similar uses. It also includes preventing trademark misuse. Enforcement may be warranted when others use a trademark inconsistently, too descriptively, or, in the worst cases, generically. Generic use (also known as "genericization") occurs when the pub-

lic uses a brand as a noun or a verb so that what was once a brand is now an "action" or a "thing." The GOOGLE[®] brand is a good recent example of this. For example, "Google it" is an improper use, whereas "run a search in the Google search engine," is a proper use. If the trademark owner does not take corrective action, trademark rights will be lost. The Xerox Corporation had to spend a lot of money in corrective advertising to prevent the public from using the brand XEROX[®] as a verb (i.e., "can you XEROX this") as opposed to properly using the brand as an adjective (i.e., "use the XEROX copier").

How Far is Too Far?

While it is usually wise and necessary to enforce one's trademark rights, there are times when a trademark owner should proceed with caution. The Komen situation shows that sometimes efforts to maintain the strength and integrity of a brand can be perceived by the public as overzealous. What has hurt Komen is the fact that many of Komen's targets are well-meaning small charities that aim to raise awareness and money to help in the fight to cure diseases like cancer. They are not businesses that are attempting to take advantage of Komen in their efforts to raise money. As a result, many see Komen's steps to disrupt the small charities' efforts as counterproductive to "the Cause."

Conclusion

In light of the legal reasons for enforcing one's trademark rights and considering the substantial investment of time and resources that is typically required to build a recognizable and protectable brand, trademark enforcement is prudent. But, as the Komen situation demonstrates, just be sure to consider all ramifications before sending a letter of notice to a potential infringer. In other words, before you implement an aggressive enforcement strategy, pay careful attention to all relevant factors including the benefit to the public in using a portion of your trademark or, in Komen's case, in using necessary and possibly descriptive wording to carry out an important cause.