

Top Takeaways

From the 2016 Advanced Trademark Law Seminar

1

Global Updates Affecting Portfolios & Registration Strategies

Alicia Grahn Jones moderated the panel where in-house counsel reviewed recent trademark developments in multiple jurisdictions, including analysis of the European Union trademark reform, the potential implications of Brexit, French language requirements and rule changes in Canada, and proposed rule changes in the United States. She shared:

1. *Brand owners should continue to monitor the impact of Brexit on trademark rights in the UK and EU.*
2. *The Charter of French Language requires that Quebec business names, public signs, packaging, and posters must be in French. Brand owners should be aware of these rules when conducting business in Quebec.*
3. *The USPTO is randomly selecting Section 8 declarations to audit regarding whether the registrant has specimens to support all goods and services listed. This means that you have a one in four chance of being audited.*

This panel explored the scope of the protections afforded by the attorney-client privilege and work product doctrine and provided practical tips for preserving the privilege and shielding attorney work product from discovery.

Ty Lord moderated the panel and shared:

In-house counsel should be careful to understand the full scope of waiver before they decide to disclose a trademark clearance letter to defend a willful infringement allegation. Additionally, in-house counsel should work with their business client to ensure that they understand what is protected by the attorney-client privilege and what actions they can take that may inadvertently waive the privilege.

Ethics

2

3

Fair Use

This session discussed the uncertainty surrounding the nominative fair use doctrine and debated a host of issues that routinely confront the trademark practitioner. **Joe Petersen** moderated the panel and shared:

The circumstances in which it is permissible to use a third-party's trademarks (or an individual's name or likeness) remain quite nebulous and fact-specific despite a number of decisions addressing the issue. The doctrines governing the area are mostly judge-made law, and as a result, standards vary widely. When guiding your business in this thicket, it is important to dig into the facts and latest case law. It is also often necessary to advise your clients that such uses often carry at least a modicum of risk (and in some cases a great deal of risk).

Dennis Wilson and **Allisen Pawlenty-Altman** moderated the panel on risk management and they shared:

For in-house counsel, identifying legal risk is only the first step in risk assessment and risk management. Our panel brought together seasoned in-house counsel, including two GCs, to share stories and explore in detail the many facets of risk assessment — from drilling down on practical risks and business implications, to communicating risks to business stakeholders, to formulating and implementing product launch and risk mitigation strategies.

Risk Management

4

5

Licensing & Other Strategies to Expand Brand Value

Marc Lieberstein moderated the panel on licensing and practical strategies to expand brand value and shared:

The takeaway was about hearing from our clients. It is so important for us to spend this kind of quality time listening to them. I enjoyed the feedback we received during the presentation on licensing, especially the different comments, depending on whether you were a licensor or licensee, about alternative strategies for maintaining brand value. The refreshing honesty and insight from the panelists and our responsive audience was the most valuable takeaway for me and my practice.

Rob Potter moderated an in-house counsel panel that discussed the general approach to enforcement, including best practices for allocating resources under budget. He shared:

My biggest takeaway was that each of the panelists, and many other in-house counsel in the audience, face the same specific challenges in allocating their resources and developing reporting metrics for their successes. The panelists and many audience members were very gratified to learn that they are not alone in facing these difficult issues, and to have an opportunity to share best practices in addressing them.

Effective Brand Enforcement

6

7

Key Trademark & Unfair Competition Opinions

Ted Davis' session surveyed the recent developments in trademark and unfair competition law over the trailing 12 months. The topics examined included inter alia, the constitutionality of Section 2(a) of the Lanham Act's prohibition on the registration of immoral, scandalous, and potentially disparaging marks; initial applications by lower federal courts of *B & B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293 (2015); judicial receptiveness to claims of fraudulent procurement and maintenance of registrations; the Trademark Trial and Appeal Board's renewed hostility to consent agreements; and introduced recently implemented and proposed reforms within the USPTO.