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Trademark Enforcement In Distinct Geographic Territories: Is the Infringement Case "Ripe"?

The Franchise Lawyer, Vol. 22, No. 3

October 7, 2019

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The following scenario is a common one when it comes to trademark enforcement. Butter Udder Franchising is an emerging ice cream franchise concept. Since its inception two years ago, it has grown to fifteen franchise locations in Georgia, Alabama, and South Carolina. The principals of Butter Udder have been well schooled on the benefits of protecting the concept's intellectual property rights and, to that end, Butter Udder has recently obtained a federal trademark registration for its BUTTER UDDER house mark. One of the benefits Butter Udder has been advised flows from federal registration is "nationwide priority" against subsequent users of confusingly similar marks.

While on vacation in Jackson Hole, Wyoming, one of Butter Udder's franchisees discovers that an ice cream/dessert purveyor has just opened there under the name Butter Udder's Dessert Emporium ("Butter Udder's Wyoming"). The franchisee contacts Butter Udder about this third party and asks what Butter Udder is going to do about Butter Udder's Wyoming's use. After verifying that the nationwide priority date of its federal trademark registration predates Butter Udder's Wyoming's date of first use, Butter Udder is weighing whether to institute immediate legal action to address Butter Udder's Wyoming's activities. Should it do so? Will it be successful?

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