Allowing Third-Party Use of Marks Without Risking Abandonment

North Carolina Bar Association
2014 IP Law Section
Annual Meeting
Why am I qualified to stand up here? Because in open source we all share the trademarks – right?
“To be able to step away from a maximal enforcement position, we have to better understand the risks of reduced enforcement and more carefully balance the risk against the advantage of having customers as brand ambassadors on social media.”

Pamela S. Chestek, today.
Assumptions for today:
• They’re using your client’s exact mark without permission
• Over-enforcement is generally bad for business (they can talk back now)
Which begs the question ...

What’s “over” enforcement?
The makers of *Candy Crush Saga*, who have filed for a trademark on video games with the name "candy," and are opposing the trademark application of *The Banner Saga*, (pictured) say they are "not trying to stop *Banner Saga* from using its name," but are compelled to defend their position under trademark law.

"We do not have any concerns that *Banner Saga* is trying build on our brand or our content," a spokesperson for King, the makers of *Candy Crush Saga*, told Kotaku. "However, like any prudent company, we need to take all appropriate steps to protect our IP, both now and in the future."

THE TRADEMARK ENFORCEMENT CONTINUUM

Abandonment

What you HAVE to stop

What you can enforce/duty to enforce

What you SHOULDN'T stop

Parody Commentary
Resale Nominative
fair use
Is there an infringement?
What? No

What? 0
Why not?
There's just no confusion
Nominative fair use
1st Amendment or parody
Resale
Is there an infringement?

• No, because
  – Resale
  – First Amendment/parody
  – Nominative fair use

Then the law is no help to you here, nor do you have a duty to enforce
Is there an infringement?
Does the client care?
Yes
Go for it!
Does the client care?

No
Is there a **significant** risk of:
Genericism, weakening, abandonment or laches?
Potential long-term harm

• Where’s the harm if you don’t do anything?
  – Genericide
    • Evidence: (1) dictionary definitions; (2) generic use of the term by competitors and other persons in the trade; (3) plaintiff's own generic use; (4) generic use in the media; and (5) consumer surveys

None of these can be stopped with an infringement theory
ice, occurring in permafrost areas.
- ORIGIN 1920s: from Inuit pinguq ‘nunatak’.

**ping-pong** (also US trademark Ping-Pong) ➔ n. informal table tennis.
- ORIGIN early 20th cent.: imitative of the sound of a bat striking a ball.

**pinguid** /ˈpɪŋɡwɪd/ ➔ adj. formal of the nature of or resembling fat; oily or greasy.
- ORIGIN C17: from L. pinguis ‘fat’ + -id-.

**pinhead** ➔ n. 1 the flattened head of a pin. 2 informal a stupid person.
Potential long-term harm

• Where’s the harm if you don’t do anything?
  – Genericide
  – Loss of distinctiveness, up to and including abandonment
    • But is that what’s happening in most of these cases?
Potential long-term harm

- Where’s the harm if you don’t do anything?
  - Genericide
  - Loss of distinctiveness, up to and including abandonment
  - Laches/acquiescence
    - Risk is loss of rights against only one user
    - Risk may be lessened if you can show a progressive encroachment
Is there a **significant** risk of:
Genericism, weakening, abandonment or laches?
Yes
Go for it!
No
Just let it go.
Text the code to 22333
Go to PollEV.com/chestek
Are we ready to answer some questions???
This image is a poll’s place holder. Enter slide show mode (F5) to view your live poll.

You can resize this image to resize where your poll will load in slide show mode.

Make sure you’ve installed the PollEv Presenter app (pollev.com/app) and are connected to the internet!

If you need to duplicate this poll make sure to copy/paste the entire slide (not just the place holder image).
Is there an infringement?
I hate McDonald's

Community
The biggest collection of anti McDonald's pictures and links on the internet! Thank you all for helping to build this page, please share!

Write something...
Now let’s assume that the client doesn’t care because there’s no financial or reputational harm
In LVoe with Louis Vuitton

Spreading the LVoe since May 31, 2007. Email me at 4dluovfly@gmail.com

Sunday, March 9, 2014

Louis Vuitton Fall Winter 2014 2015: THE BAGS
Budweiser Beer Fans
@BudweiserFans

The Unofficial Budweiser fan site! You must be of legal drinking age to follow. Show your love for the best American beer!
Los Angeles, CA • twitter.com/BudweiserFans

Tweets

Budweiser Beer Fans @BudweiserFans • 6 Feb 2011
How about them Bud Super Bowl commercials? Loved the Old Western spot!

Budweiser Beer Fans @BudweiserFans • 26 Aug 2010
RT @FrICTIONmove - 5 hours left to help get Friction released to the world! Show your love & become a "backer" here: http://wong.to/r2ibd

Budweiser Beer Fans @BudweiserFans • 8 Jul 2010
Listen to LeBron's decision here at ESPN Radio: http://wong.to/j0w2u via @rlvandfivel
Can of Beer
@BudweiserCan
Best pour of the day.
Your Cooler.
What if you put on your website “you may use ‘Budweiser’ in your Twitter handle so long as you also state ‘not an official Budweiser Twitter feed’”? 
Thanks!