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## [Trademark Bully Update: IPO Says Not a Problem](#)

Posted on January 12, 2011 by [Steve Baird](#)

The [Intellectual Property Owners Association](#) (IPO) [submitted its comments](#) last Friday in response to the USPTO's recent [invitation for input](#) on whether "[trademark bullying](#)" is a problem.

In response to the USPTO's key question "Do you think trademark 'bullies' are currently a problem for trademark owners, and if so, how significant is the problem?" IPO answered:

IPO does not believe that trademark "bullies" are a problem for trademark owners. The question defines a trademark "bully" as a "trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow." This language is problematic because, *inter alia*, what seems reasonable to one person may not seem reasonable to another. In point of fact, trademarks serve as signs of quality of a particular good or service and play an important role in consumer protection by preventing confusion in the marketplace and building consumer trust. With this deep and expansive market reach, comes the responsibility of maintaining the integrity of the brand. It is in the best interest of companies, large and small, to carefully review potential trademark infringement issues and create a consistent enforcement strategy which, in turn, bolsters brand recognition and reliance.

To this end, trademark owners are permitted to have the courts determine the limits of their rights. It is sometimes difficult to predict when a trademark claim will prevail, particularly in cases where famous marks are used on non-competitive goods and services. The fact that a trademark owner does not ultimately prevail does not mean that the enforcement of its rights was inappropriate.

In addition, the pejorative and emotionally charged term "bullies" suggests that the trademark owner in question is a large organization that is using its greater size and economic power to unjustly "push around" a smaller organization or individual. In the experience of IPO members, this is rare, and most large organizations take action in cases upon careful reflection of the facts and development of a strong business case analysis and justification for the litigation expense.



Indeed, several IPO members noted a trend towards more aggressive assertion and defense of trademark claims by individuals and small organizations, particularly where they represent themselves or have obtained legal representation on a contingency basis. The USPTO has been helpful in certain instances. In a July 14, 2006 Order signed by Chief Judge J. David Sams, the Trademark Trial and Appeal Board (TTAB) sanctioned an individual for his “misuse of the TTAB’s procedures” by filing more than 1,800 requests for extensions of time to oppose the registration of trademark applications within a seven-month period. Large organizations are often the targets of this type of behavior, as they are perceived as having “deep pockets” and the willingness to pay a “nuisance value” to avoid the cost of litigation, despite the lack of merits of a case. Such behavior thwarts the consumer protection mechanisms fundamental to trademark law. These types of cases do not fit the “bullies” label.

Finally, to the extent that “bullying” behavior is grounded in litigation tactics independent of the merits of cases, IPO notes that in trademark case law, one can find examples of both plaintiffs and defendants engaging in objectionable behavior. An infringing defendant determined to delay a finding of liability has as many options available to it as does a plaintiff attempting to vindicate its rights; trademark plaintiffs are themselves at risk of being bullied by more obstructionist opponents.

For those of you unfamiliar with IPO, it describes itself like this:

IPO, established in 1972, is a trade association for companies, inventors, law firms and others who own or are interested in patents, trademarks, copyrights and trade secrets, and the like. IPO is the only association in the United States (U.S.) that serves all intellectual property owners in all industries and in all fields of technology. Governed by a 50-member corporate board of directors, IPO advocates effective and affordable intellectual property (IP) ownership rights in the U.S. and abroad on behalf of its more than 200 corporate members and more than 11,000 individuals involved in the association.

Board members include 50 representatives from significant trademark owners and companies like Google, Microsoft, 3M, IBM, Apple, [Intel](#), Motorola, among many others.

A number of the points IPO raised in its response are consistent with previous points I have made in a DuetsBlog post entitled "[The Mark of a Real Trademark Bully](#)."

I'm thankful that IPO was heard on this issue, especially given the fact that IPO has a much broader intellectual property (IP) focus going well beyond trademarks, but what about INTA, whose sole focus is the trademark part of what is protected under the umbrella we call IP? Hello? The International Trademark Association? I have yet to see any position taken by INTA on this subject, and we are members.

So, I'm left wondering, was INTA too busy [announcing its new website](#) (a day before the USPTO's deadline), introducing the controversial "[My Powerful Network](#)," considering related [accusations of censorship](#), and [choosing to drop](#) the popular [TM Topics email discussion group](#), making it unable to weigh in on this invitation from the U.S. Trademark Office? Or, perhaps, was INTA unable to reach the necessary political consensus to convey a unified position on the subject to the USPTO?



I seriously hope not and that an announcement regarding the position INTA took (assuming it did submit a response) on the subject is forthcoming.

What do you think of IPO's response to the USPTO? Should INTA have submitted a response?



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