

TRADEMARKS: LITIGATION

OVERVIEW

BCLP understands the value of brands and the importance of protecting them. For over 150 years leading companies have turned to BCLP's award-winning team to deliver practical and effective solutions for the clearance, enforcement, and litigation of disputes involving trademarks. Our top-notch trademark litigators hold a winning track record of handling matters for some of the most trusted brands, entrepreneurial companies, and leading global companies as they apply their skills in trademark, trade dress, dilution, and unfair competition matters. Our team often handles matters related to Lanham Act claims, federal and state advertising statutes, sponsorship and commercial agreements, false advertising claims, and domains.

Supported by a trial team that works seamlessly to develop sound strategies and anticipate tactics, our trademark team is not afraid to go to trial, but they never lose sight of practical considerations and work tirelessly to provide early resolutions and creative settlements that can be both cost-effective and efficient. We are there with you through every phase of pre-litigation or litigation, trying cases with one goal in mind: to get the best results for our clients. Our team frequently litigates in federal courts and at the U.S. Trademark Trial and Appeal Board.

As markets change, we are staying on top of trends in the registration, use, and enforcement of marks associated with such fields as artificial intelligence, Web 3.0 and the Metaverse; with social media influencers as they rise in popularity with brands; and with the food and beverage sector as they establish new claims and certifications around consumer products. We provide proactive arrangements where we inform clients of changing market conditions, new regulations, and other developments that must be considered in best practices for managing intellectual property assets.

BRAND ENFORCEMENT

BCLP is often set apart by developing personalized and close relationships with clients to serve as a valuable member of their brand teams. We work proactively to prevent infringements and tackle counterfeits. Most actions in a well-run enforcement program never make the news. When problems are recognized early, nipping them in the bud is easier. But BCLP's trademark litigation team will do what it takes to solve a problem that is not so easily resolved, from Temporary Restraining Orders (TROs), through trial and appeal. Where necessary, BCLP will also work with U.S. Customs or the International Trade Commission (ITC) to stem the importation of infringing and counterfeit merchandise into the U.S.

When clients find themselves on the other end of an enforcement claim, they also turn to BCLP. Our team will evaluate your goals in light of what is at stake and work tirelessly to help you achieve those goals. Sometimes that means a quick and practical settlement. Sometimes it means winning at all reasonable costs. BCLP does not take a cookie-cutter, one-size-fits-all approach to any litigation matter.

Our robust team also prosecutes and defends Internet domain name disputes before the appropriate panels under the Uniform Domain Name Dispute Resolution Policy (UDRP), and we represent clients in court in connection with domain name disputes under the U.S. Anti-Cybersquatting Consumer Protection Act.

MEET THE TEAM



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RELATED CAPABILITIES

- Intellectual Property and Technology
- Trademarks: Counseling, Prosecution & Practical Business Services
- Copyrights
- Marketing & Advertising
- Food & Agribusiness
- Sports, Media & Entertainment
- Restaurants, Pubs & Clubs
- Retail & Consumer Products

EXPERIENCE

- Representing one of the largest global luxury brands in the multi-jurisdictional Lanham Act, unfair competition, dilution and cybersquatting claims for multiple manufacturing, sale, and distribution of popular handbags, watches, shoes, and clothing
- Representing one of the largest U.S.-based financial institutions to take down and protect against misleading and false advertising websites
- Representing one of the top five online advertising and internet companies in the Northern District of Georgia regarding trademark infringement claims regarding dietary and health products sold across the world
- Defending a home warranty company regarding trademark infringement claims related to potential cybersquatting, brand dilution, and unfair competition
- Representing a publisher in an enforcement suit against an e-commerce company regarding the counterfeit sales of books, seeking claims for personality rights, false advertising, and consumer protection laws.
- Representing a global dairy products manufacturer and distributor in multiple suits regarding the enforcement and defense against competitors
- Represented one of the largest U.S. telecommunication and internet companies in defense of trademark claims associated with new product marks in the Central District of California. We achieved a favorable resolution based on strategic wins in early litigation
- Represented a leading digital payments company in a TTAB opposition against an application that provided the likelihood of confusion with the client's family of registered trademarks

- Represented one of the largest U.S. furniture retailers to develop and implement a cybersquatting enforcement strategy for trademarks designed to optimize the efficiency of UDRP filings, resulting in the transfer of 24 domain names in 7 cases before WIPO
- Represented a global footwear manufacturer in an action against a party that had copied its famous trade dress. The action was resolved through a favorable, worldwide settlement agreement, which provided for, among other relief, entry of a consent judgment enjoining future infringement
- Represented a famous manufacturer of disposable razors in a successful opposition before the U.S. Trademark Trial and Appeal Board concerning the registration of a competitor's confusingly similar mark for razors. In its precedential ruling, the Board specifically recognized that our client's mark is famous and, therefore, entitled to broad protection
- Regularly developing enforcement and dispute resolution programs for producers of luxury goods such as watches, handbags, and writing instruments. These programs are tailored to the industry and involve court litigation and other enforcement action, including interdiction of infringing and counterfeit goods by U.S. Customs
- Defended one of the world's largest food companies against allegations of trademark infringement brought by a leading restaurant chain. We obtained a favorable settlement for our client
- Defended a high-quality beef producer in a trademark infringement action brought by another leading beef supplier. The judge granted our motion for summary judgment for non-infringement, allowing our client to continue using the trademark on its products
- On behalf of a ball bearing manufacturer, we obtained an ITC Section 337 investigation victory and a Federal Circuit affirmance in a trademark gray market goods case
- Represented a large discount retailer against charges including trademark infringement, false designation of origin, and deceptive trade practices. The Court, in granting summary judgment, found that the plaintiff's asserted trademark was invalid and that our client did not commit any of the alleged wrongful acts
- Defended an organic baby food manufacturer against allegations of trademark infringement brought by a competitor and obtained a favorable settlement for our client

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BCLP partner weighs in on trademark infringement

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