

# Legal 500

## Country Comparative Guides 2025

### United States

### Trademark Disputes

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This country-specific Q&A provides an overview of trademark disputes laws and regulations applicable in United States.

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## United States: Trademark Disputes

### 1. To represent a client before Court in respect of a potential trademark infringement matter, do you require a Power of Attorney – and if so, what are the execution formalities required by your courts?

No. A specific power of attorney is not required. Lawyers typically formalize their relationships with clients in the form of engagement letters which set forth the terms of engagement. Such engagement letters are not, however, required by or filed with the courts.

In order to appear before a court, attorneys must either be (a) a member of the bar of the court or jurisdiction where the litigation is brought, such that attorneys can file a notice of appearance outright or (b) a member of the bar of any jurisdiction in the United States, who then applies for pro hac vice status in the court where the litigation is pending. "Pro hac vice" status permits an attorney to appear in the applied-for Court only in connection with the associated litigation. None of these filings require a power of attorney from the client, and courts will accept a lawyer's attestation that they represent their client.

### 2. Is it a requirement in your jurisdiction to send a cease and desist letter to a potential infringer before commencing proceedings for infringement? What are the consequences for a trademark owner who chooses not to send a pre-action letter?

No. While not a requirement, it is common to send a cease and desist letter prior to initiating litigation, in many circumstances. Of course, if the infringement is resulting in irreparable or imminent harm, or other timing related considerations militate in favor of immediate filing, parties may elect to forego correspondence prior to doing so or may send such correspondence simultaneously with the filing of a complaint.

In the absence of a contractual requirement, there is generally no specific legal requirement to send a pre-action letter prior to filing. That said, the decision to send such letter will be an intensively factual and strategic decision, and, depending on the particular circumstances, there may be various strategic reasons to send or not send such letter, including the possibility of early

resolution and declaratory judgment risk, discussed below. However, disputes can, and often do, resolve even after litigation has been initiated, and the filing of litigation can itself facilitate such resolution.

### 3. In your jurisdiction, is there a risk that a pre-action letter could give rise to claim against the trademark owner for unjustified threats? What steps should a trademark owner take to ensure any cease and desist letter does not expose the trademark owner to any liability.

Yes. If a cease and desist letter rises to the level of creating a case or controversy between the parties, for example by accusing the recipient of trademark infringement or other claims, such cease and desist letter can give rise to what is referred to as "declaratory judgment jurisdiction." Declaratory judgment jurisdiction permits the recipient of such letter to file a type of lawsuit known as a declaratory judgment action, whereby the recipient seeks a judgment from a court that they are not liable for the claims asserted in the letter. It effectively inverts the normal litigation posture, placing the would-be plaintiff on the defensive, and requiring them to litigate the allegations in their letter, often in the recipient's forum of choice. The defendant trademark owner may then bring counterclaims, including for trademark infringement, when responding to a declaratory judgment complaint.

To reduce declaratory judgment risk, trademark owners may elect to avoid explicit allegations of infringement or wrongdoing, in an attempt to avoid creation of declaratory judgment jurisdiction. Trademark owners should also be reasonably assured of their chances of success on the merits of any claim they include in a cease and desist letter, and should not include claims that are frivolous or harassing.

### 4. Is it mandatory for the parties to have attempted mediation or other alternative dispute resolution proceedings prior to commencing infringement proceedings?

No. Absent contractual obligations between the parties, mediation or other alternative dispute resolution is not

required prior to commencing infringement proceedings. Many courts will, however, require the parties to attempt mediation or other alternative dispute resolution at some point in the proceedings, and which timing and requirement varies by jurisdiction.

**5. Are claims for trademark infringements heard before a general commercial Court or a specialist Court focused on Intellectual Property disputes? Are trademark infringement claims decided by a judge or by a jury?**

In the United States, trademark infringement claims are typically heard by federal district courts, which are general and non-specialized. They may be decided by a judge or a jury depending on the relief sought, other claims alleged and the preference of the parties. Under certain circumstances, trademark infringement claims may also be heard by specialized federal government agencies such as the International Trade Commission, which is focused on preventing the importation of infringing goods. The Trademark Trial and Appeal Board of the United States Patent & Trademark Office also decides trademark disputes, but related solely to registration—not infringement.

**6. Is there a time limit for commencing trademark infringement proceedings once the facts giving rise to the infringement are known to the trademark owner. After how long would such a claim be time-barred?**

The Lanham Act, which is the U.S. federal trademark statute, does not impose a time limit or statute of limitations for trademark claims. For this reason, courts look to the limitations period in analogous state laws, such as unfair competition or fraud, in deciding whether a defense of laches arises based on the plaintiff's delay in bringing suit. These analogous state laws vary by jurisdiction, but typically apply a 3-6 year time frame for laches, starting from when the trademark owner knew or should have known of the infringing activity.

**7. In your jurisdiction does the law protect unregistered trademarks of any kind, including by way of unfair competition or protection of trade dress. What are the criteria for their subsistence?**

Yes. In the United States, enforceable trademark rights derive from use; federal registration is not required. As a result, trademark owners can bring trademark

infringement and dilution as well as unfair competition claims based on their prior use of unregistered, or common law, trademarks. Unlike federally-registered marks which enjoy nationwide priority, however, common law trademark rights are limited to the geographic areas in which they are used. They also do not enjoy the same presumptions, including of validity, distinctiveness, and non-functionality as registered marks.

**8. In your jurisdiction will the Court hear claims for registered trademark infringement in parallel with claims for unfair competition, infringement of trade dress or other misleading advertising, or does a claimant need to bring such claims in a separate cause of action?**

Claims for registered trademark infringement are frequently brought in parallel with claims for unfair competition, common law trademark infringement, and/or false advertising; claimants do not (and generally should not) bring such claims in separate causes of action. Under U.S. law, there is a general requirement that all claims relating to a common set of operative facts be brought at once, or they may be considered waived (e.g., if the same advertisement contains trademark infringement and false advertising, courts will disfavor the bringing of two separate actions for each of these claims – especially if one is filed long after the other). As such, parties should bring all such claims together.

**9. In your jurisdiction, do your Courts share jurisdiction with your Trade Mark Office, such that parties need to seek to seize the forum they prefer first in time, or does the Court take precedence and intervene to stay or transfer any live Registry proceedings (for example relating to invalidity or revocation of registered trade mark) which may overlap with an issued infringement claim and related counterclaim?**

In general, U.S. courts have concurrent jurisdiction with the United States Patent & Trademark Office, and proceedings before both may proceed simultaneously. Neither tribunal can "seize" jurisdiction from the other. As a practical matter, however, one or both parties will often—though not always—seek to stay the proceedings in one forum pending conclusion of the other.

**10. Where the defendant has a counterclaim for**

invalidity or cancellation of the registered trademark being asserted against it (either on the basis of earlier rights or as a result of non-use by the trademark proprietor), does the counterclaim become part of the infringement action, so that both issues are heard by the same Court within a single action, with the Court making a determination at its conclusion, or are the validity issues bifurcated and heard in separate parallel proceedings? If in your jurisdiction validity issues are bifurcated, what are the practical consequences of this from a timing perspective? For example, does this mean that a Court will stay the infringement claim and proceed with the validity attack first to avoid finding a trademark infringed, only to have a separate Court find the trademark invalid at a later date?

Counterclaims for cancellation or invalidity of an asserted trademark are part of the infringement action; they are heard by the same court, in the same proceeding as the infringement claims. One exception to this is Section 337 proceedings before the International Trade Commission, where counterclaims are generally removed to a federal district court. Separate from or in addition to counterclaims, a defendant may also elect to pursue a parallel cancellation proceeding against the asserted trademarks before the Trademark Trial and Appeal Board. Such proceedings are often, though not always, stayed pending resolution of the court proceedings.

**11. If the main objective in commencing infringement proceedings is to secure an injunction, is a claimant required to state how much their claim is worth at the point their claim is issued?**

A plaintiff is not required to seek monetary damages in connection with infringement claims, and need not specify the amount of any damages demand at the outset of litigation. Where monetary damages are sought, however, even if injunctive relief is the primary objective, a general damages demand should be made in the complaint. The specific amount sought, however, is often not determined until later in the litigation, and often in connection with expert disclosures.

**12. Is it possible to seek a preliminary injunction in your jurisdiction? If so, what is the criteria a trademark owner needs to establish and is there a bond or other undertaking in damages payable to compensate the defendant if the Court finds no infringement following a substantive hearing?**

Yes. It is possible to seek a preliminary injunction in the United States. A party seeking a preliminary injunction must establish that (1) it is likely to succeed on the merits, (2) it is likely to suffer irreparable harm in the absence of preliminary relief, (3) the balance of equities tips in its favor, and (4) an injunction is in the public interest. This is a high burden, as a preliminary injunction is an "extraordinary" equitable remedy that is never awarded as of right. A party that obtains a preliminary injunction may often, but not always, be required to post a bond to compensate the enjoined party should a contrary judgment ultimately issue.

**13. Is a licensee (whether exclusive or non-exclusive) of a registered trademark entitled to commence proceedings for trademark infringement? Does the trademark proprietor need to be joined as a party to the proceedings, and does it have an effect whether the licensee is registered before the local Trademark Registry?**

The question of standing to bring trademark infringement claims is highly fact-dependant, and will vary across jurisdictions. In some instances, only the registrant – that is, the owner of the trademark registration for the mark – may have standing to sue for infringement of that registration. In other instances, an exclusive licensee may have standing to sue under the Lanham Act, but non-exclusive licensees may not. In still other circumstances, even a non-exclusive licensee may be able to bring an infringement claim. The law also varies as to the implications of contractual provisions surrounding the right to bring suit, with some courts requiring such right to be affirmatively granted, and others finding such right in the absence of explicit restrictions to the contrary.

**14. Where the claim for trademark infringement is premised on similarity between the defendant's mark and the trademark owner's registered mark, does the proprietor need to demonstrate that confusion has occurred or simply that there is a risk of confusion? What is**

## the minimum standard required to secure a finding of infringement?

The standard for trademark infringement in the United States is likelihood of confusion. While evidence of actual confusion is not required, it is widely considered to be the best evidence of likelihood of confusion, and even few instances of actual confusion can weigh heavily in a trademark owner's favor. Likelihood of confusion is also often measured through the use of consumer surveys conducted by expert witnesses. While there is no universally-applied minimum survey result required, some courts consider net findings above 15% to be probative of a likelihood of confusion.

## 15. In your jurisdiction what type of disclosure or discovery is typically ordered by the Court in respect of trademark infringement actions from both parties?

Disclosures and discovery are not "ordered" by a court, per se.

The parties are required to exchange initial disclosures under the rules of civil procedure, which itemize: (i) names and contact information of individuals likely to have discoverable information that the disclosing party may use to support its claims or defenses; (ii) copies and/or descriptions of documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses; (iii) a computation of each category of damages claimed by the disclosing party; and (iv) any insurance agreement under which an insurance business may be liable to satisfy all or part of a possible judgment in the action or to indemnify or reimburse for payments made to satisfy the judgment.

Beyond initial disclosures, the parties serve discovery requests and these requests impose an obligation to respond. In trademark cases, these discovery requests generally include: (i) requests for the production of documents, electronically stored information, and tangible things, or for entering onto land, for inspection and other purposes; (ii) interrogatories (i.e., written questions answered under oath); (iii) requests for admissions; and (iv) depositions – both oral and/or on written questions – of corporate witnesses and/or individual fact witnesses. ESI discovery, which typically involves the collection, search and production of email and other electronic files is also common. Discovery may be served on parties to the case as well as third parties.

In addition to the above factual discovery, expert discovery is also commonplace in the United States, and encompasses the exchange of opening and rebuttal expert reports and disclosures as well as associated depositions.

## 16. What type of expert evidence is permitted by the Court in your jurisdiction? Does the Court accept consumer surveys and are there specific rules about how consumer surveys are conducted. Do the parties need to request prior permission from the Court to adduce survey evidence?

Expert testimony is permitted in the United States to the extent the expert is deemed qualified, her opinion is based on reliable principles and methods, and her testimony is helpful to the trier of fact. Common expert evidence admitted in trademark infringement cases includes testimony by damages experts as well as consumer survey experts. Consumer surveys may be conducted on a variety of issues relevant to trademark and unfair competition claims, including likelihood of confusion, secondary meaning, genericness, fame and false advertising, and parties may engage more than one survey expert in any given case. The specific requirements for the proper design of consumer surveys depend on the type of survey employed and the question the survey seeks to test.

## 17. Does evidence submitted by your client in trademark infringement proceedings have to accompanied with a statement of truth or other similar declaration?

To be admitted for consideration by the court at trial, and while some categories of evidence are deemed self-authenticating or otherwise authenticated by alternate means, evidence must generally be authenticated by the witness through whom it is introduced. Evidence submitted prior to trial, including in connection with briefing, is often authenticated through declarations. Evidence in the form of declarations must contain a statement that the declaration is made under penalty of perjury pursuant to 27 U.S.C. § 1746. Further, declarations should contain statements to the effect that the witness is over the age of eighteen, he or she is competent to make the declaration, and that the witness has knowledge of the facts asserted therein and would be competent to testify to them under oath.

Under Federal Rule of Civil Procedure 33(b)(5), certain



discovery responses, namely interrogatory responses, must also be verified by the party.

**18. In your jurisdiction is it possible for a claimant to seek summary judgment of an infringement claim? What are the legal criteria for a Court to grant summary judgment?**

Yes. It is possible to seek summary judgment on a trademark infringement claim. To prevail, the movant must show that there is no genuine dispute as to any material fact such that the movant is entitled to judgment as a matter of law. It is possible to move for summary judgment both on trademark claims in their entirety, as well as for partial summary judgment on specific issues and which may narrow the issues to be decided at trial.

**19. How long does it typically take to reach judgment in a trademark infringement action from issue of the claim, through to first instance decision? What is the lower and upper range of legal costs for such an action?**

The length and costs associated with a trademark infringement suit can vary greatly depending on a number of factors, including the number of claims, the choice of forum, the breadth of discovery and the nature and extent of the parties' motion practice. Further, the majority of trademark infringement actions settle prior to trial. However, on average from filing, including trial, through to first decision, a trademark infringement suit in the United States may cost several million dollars, and takes 2-3 years. Early resolution, whether by settlement or a dispositive motion can significantly compress time frames and lower costs.

**20. Following a first instance decision, is it possible for either party to appeal the decision? What are the grounds upon which an appeal can be lodged? Is it necessary to request permission to appeal, or are appeals automatically permissible? If either party file an appeal, is the enforcement of the first instance decision stayed pending the outcome of the appeal?**

Yes, it is possible for either party to appeal a final judgment of the court, provided that it has grounds to do so. Interlocutory appeals of intermediate decisions – for example preliminary injunctions, may also be available. While grounds for appeal may vary depending on the

jurisdiction, the most common grounds for appeal in trademark infringement actions include errors of law and abuse of discretion by the trial court.

In federal court, an appeal is instituted by filing a notice of appeal, which, in civil cases, must be filed with the district court clerk within thirty (30) days of the entry of judgment or order being appealed. In a civil case, the filing of an appeal does not automatically stay or prevent the enforcement of the lower court's judgment. However, the appealing party can seek such stay through the proposal of a supersedeas bond. This bond, if approved, may stay further action on the judgment until the appeal is over by guaranteeing that the appealing party will pay or perform the judgment if it is not reversed on appeal.

**21. If the parties have been involved in a dispute before the local Trademark Office, what relevance does this have on later infringement proceedings? For example where trademark owner (A) may have already sought to oppose the registration of a third party (B's) mark in proceedings before the local Trade Mark Office, is the trademark owner estopped from seeking invalidity of a registered trade mark where its opposition failed where the invalidity action is based on the same grounds as the unsuccessful opposition?**

A prior decision of the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office can, but does not always or automatically, have preclusive effect in a later suit in federal court. The U.S. Supreme Court has explained that TTAB decisions are entitled to such preclusive effect only where 1) other elements of issue preclusion are met; 2) the TTAB considered the actual marketplace use of the mark (and did not, for example, limit its inquiry to the registration or application at issue); and 3) the actual marketplace use is "materially the same" as that covered by the relevant registration / application.

With respect to issue preclusion, courts generally require that 1) the TTAB decision be final and not subject to appeal; 2) the issue before the court be identical to that decided by the TTAB; 3) such issue was actually litigated and contested in the TTAB proceeding, and necessary to the decision of the TTAB; and 4) applying a preclusive effect to that decision would not result in unfairness. Further, the standard for material similarity between use and registration is not fully settled, and is often the subject of dispute.

**22. In your jurisdiction, does the Court consider both liability and quantum within the same proceeding, or will any damages be assessed after the Court has reached a decision on liability? How are damages for trademark infringement proceedings typically assessed in your jurisdiction?**

Both liability and the measure of damages are generally decided by the Court in the same proceeding, although the Court may, in certain circumstances, bifurcate these issues. Potential measures of damages for trademark infringement may include:

- Disgorgement of the infringer's profits attributable to the infringing activities;
- An award of the trademark owner's actual commercial damages and losses caused by the infringement, including for example lost profits;
- The cost of corrective advertising needed to counteract the confusion and deception caused by the infringement; and/or
- Possible punitive damages in the form of treble damages or attorneys' fees in the event of bad faith, wilful infringement, or especially egregious litigation conduct by the defendant.

Damages are not automatically awarded upon a finding of trademark infringement. While each of the above categories of damages are potentially recoverable, the most commonly pursued theory is disgorgement of profits, with treble damages and attorneys' fees only available in exceptional cases.

**23. In addition to an injunction and damages, what other remedies are available in your jurisdiction?**

In addition to injunctive relief and monetary damages, courts can also award a prevailing party its costs, including costs with respect to service of process, printing and photocopying fees, phone bills, clerk and docket fees, fees for printed or electronically recorded transcripts necessarily obtained for use in the case, compensation for interpreters, compensation for court-appointed experts, and compensation for translation fees. A court can, under certain circumstances, also award prejudgment interest which is intended to compensate the plaintiff for the loss of the use of the funds it would have otherwise had, but for the wrongful conduct of the defendant. In exceptional cases, courts can award the prevailing party attorneys' fees.

**24. Following a decision on the merits, is the winner entitled to recover all or a portion of its legal costs incurred in bringing or defending the proceedings. If legal costs are recoverable, what is the procedure involved and how does the Court assess the level of legal costs which should be reimbursed by the losing party.**

In most proceedings, each party will bear its own attorneys' fees. However, attorneys' fees are available in "exceptional cases" involving trademark infringement claims. See *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 134 S. Ct. 1749, 1756, 188 L. Ed. 2d 816, 110 U.S.P.Q.2d 1337 (2014). The Octane rule permits a case to be deemed "exceptional" if it "stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated." In that case, the U.S. Supreme Court held that the statutory language authorizing discretionary attorney fees to the prevailing party in "exceptional cases" allows a district court to determine if a case is "exceptional" on a case-by-case basis, not by use of a rigid set of criteria. Thus, what qualifies as "exceptional" also varies from federal circuit to federal circuit.

In order to obtain an award of attorneys' fees, and while procedure may vary somewhat by Court, the prevailing party must typically file a Motion for Attorneys' Fees and Costs no later than 14 days after the entry of judgment. The Motion must typically specify the judgment and the statute, rule or ground entitling the movant to the award, as well as the amount sought or a fair estimate thereof. The Court will then analyze whether the case should be considered "exceptional" so as to justify an award of attorneys' fees, and if so, whether the requested attorneys' fees are "reasonable." The party seeking attorneys' fees bears the burden of proving the request is reasonable and must submit evidence to support the hours worked and rates claimed. Expert testimony on the subject of reasonableness may also be submitted. The starting point for determining what attorneys' fees are reasonable in any case is to calculate a "lodestar" amount; "that is, the number of hours reasonably expended multiplied by a reasonable hourly rate." The lodestar formula is presumed to yield a reasonable attorneys' fee which is adequate to attract competent counsel, but which does not produce a windfall to attorneys. Courts, however, have great discretion in deciding what reasonable attorneys' fees are in a given case, and which may vary by jurisdiction and claims implicated.

25. Once the Court has issued a judgment, how long typically does the losing party have to comply with the Court's judgment including any final injunction issued? What are the consequences for failing to comply and how would the winning party seek enforcement of its judgement.

The deadline for compliance with judgment entered in

trademark infringement proceedings, including injunctive relief or payment of damages, is typically set by Court order or otherwise governed by local rules.

If a party fails to comply with the terms of a judgment there can be severe legal repercussions, including contempt of court, which may entail fines or other court-mandated sanctions. To enforce a judgment in the face of non-compliance, the enforcing party will generally need to file a motion for such enforcement with the issuing court.

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