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Redefining a Trademark Bully?

By Steve Baird on January 26th, 2012

We've spilled a lot of digital ink discussing the [trademark bullying](#) topic, going all the way back to my original blog post from 2010: "[The Mark of a Real Trademark Bully](#)."

Within the last several days, there has been quite a bit of [online media coverage](#) about [Trademarkia's](#) new features that tout an ability to "[Find a Trademark Bully](#)" or rank the "[Biggest Bullies](#)".

Maybe I'm missing something, but it appears that the only investigative skill required to apply the label is one's ability to count the total number of oppositions *filed* by a trademark owner.

So, never mind the size of a trademark owner's portfolio, never mind the strength or possible fame of the trademarks within a trademark owner's portfolio, never mind the number of conflicting applications filed by third parties who don't search or [aren't well-advised about likely conflicts](#), never mind the reasonableness of the trademark owner in working to resolve and settle those concerns, never mind the trademark owner's appropriate litigation conduct during the opposition proceeding, and perhaps most importantly, never mind a qualitative analysis of the actual facts and claims asserted by the trademark owner — ignoring all this, we're led to believe that if a brand owner *files* a lot of trademark oppositions, it automatically earns the [pejorative label](#) "Biggest Bullies".

If all it takes to make Trademarkia's Top Ten Biggest Trademark Bullies Listing is *filing* more trademark oppositions than anyone else, does it really have *any* value for the stated purpose?

The last time I checked, every week of every year the USPTO issues scores and scores of Section 2(d) refusals (based on a perceived likelihood of confusion) ([hat tip to Towergate Software](#)) – refusals that are eventually withdrawn and resolved through the USPTO's consideration of apparently valid argument, evidence, and/or amendment (or a combination of these).

Does that make the USPTO a surrogate trademark bully because it issues a lot of registration refusals and throws up a lot of registration road blocks based on likelihood of confusion, especially



since many of the refusals end up being withdrawn upon further consideration, after hearing only one side of the argument — the Applicant’s side (and without any required notification of the trademark owner whose registrations were cited)?

When those initial USPTO refusals are withdrawn based on a one-sided limited record, is there no surprise that oppositions will be filed? Is there no surprise that oppositions will be filed when the USPTO doesn’t see a valid conflict for whatever reason? That’s why [serious trademark owners watch](#) their marks — the process doesn’t purport to be perfect. After all, the purpose of an opposition is to provide a second backstop before registration, so that the USPTO can consider both sides, on a more complete record, making it an essential part of keeping the federal trademark register intact.

From my perspective, boiling the question down to a numbers game might gain headlines, spark some drama, fan the flame, generate more web traffic, but it doesn’t add to the conversation.

In the end, I’m left wondering whether Trademarkia has purchased insurance coverage for “[advertising injury](#)” claims, and I’m also left wondering how long it will take for a brand owner on the infamous list to take issue with the labels as false and/or misleading.

What do you think about the labels Trademarkia is applying to brand owners?

