What is the primary legislation governing trademarks in your jurisdiction?

Both federal and state law govern the protection and registration of trademarks in the United States. On the federal level, the Trademark (Lanham) Act 1946 (15 USC § 1051 et seq) is the primary legislation. Each state has its own trademark laws.

Which international trademark agreements has your jurisdiction signed?

The United States is a signatory to the following key international trademark agreements:

- the Madrid Protocol;
- the Paris Convention for the Protection of Industrial Property;
- the North American Free Trade Agreement;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and

Which government bodies regulate trademark law?

The US Patent and Trademark Office (USPTO) is the federal body responsible for examining and registering trademarks. A USPTO decision may be appealed to the Trademark Trial and Appeal Board (TTAB), which is a part of the USPTO. TTAB decisions may be appealed to a federal court. State offices – usually those of secretaries of state – examine and register marks at the state level.
Is ownership of a trademark in your jurisdiction determined on a first-to-file or first-to-use basis?

Subject to certain exceptions – especially the ability of an applicant to secure priority through the filing of an intent-to-use application – ownership of a trademark is determined on a first-to-use basis.

Unregistered trademarks

What legal protections are available to unregistered trademarks?

An unregistered trademark (also known as a common law trademark) is protectable under Section 43 of the Trademark (Lanham) Act (15 USC §1125). However, except in certain circumstances, unregistered trademark rights are limited in scope and enforceable only within the geographic region in which the trademark is used or is known by consumers. A significant difference between a registered trademark and an unregistered trademark is that the latter is not presumptively valid. Therefore, to sue for infringement of an unregistered trademark, the rights holder must prove that it owns a valid trademark.

How are rights in unregistered marks established?

The owner of a distinctive and non-functional mark can establish common law rights by using the mark in commerce. Common law trademark rights are enforceable in state and federal courts based on the Lanham Act. The owner of an unregistered trademark can use the mark with the designation 'TM' (trademark) or 'SM' (service mark), which serves as notice to the public of the trademark owner’s claim of rights.

Are any special rights and protections afforded to owners of well-known and famous marks?

A famous mark enjoys broader protection than a mark that is not famous. In addition to a trademark infringement claim, the owner of a famous mark can sue for likely dilution under Section 43(c) of the Lanham Act and can stop use of a junior trademark even if this is used in connection with unrelated goods and services. However, US law generally does not protect famous and well-known marks (as that phrase is used in the World Intellectual Property Organisation’s Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks).

To what extent are foreign trademark registrations recognised in your jurisdiction?

As a member of the Paris Convention, the United States provides under Section 44 of the Lanham Act for the registration of marks which have been applied for or registered in a convention member’s country of origin. A foreign registration or pending application can also serve as the basis for extending protection to the United States through the
Madrid Protocol. Generally, ownership of a foreign trademark registration is insufficient to overcome a preliminary refusal of registration of a mark in the United States or to prevail in an enforcement action against an infringing use in the United States.

### Registered trademarks

#### What legal rights and protections are accorded to registered trademarks?

Registration is not a prerequisite for trademark rights; rights are established through use of a mark. Nevertheless, registration affords a legal presumption of the registered mark’s validity and nationwide priority of rights dating to the filing date of the registrant’s application. It also serves as constructive notice of the registrant’s claim of ownership.

Owners of registered marks may:

- use the ‘®’ symbol;
- protect their marks in federal court;
- obtain certain remedies not otherwise available; and
- use the US registration as basis for applications abroad.

#### Who may register trademarks?

Any natural person or entity that uses a mark or has a *bona fide* intention to use a mark may apply to register its mark.

#### What marks are registrable (including any non-traditional marks)?

Subject to certain exceptions, any distinctive and non-functional word, symbol, drawing or combination thereof may be registered. In addition, certain product shapes, packaging, slogans, colours, sounds, fragrances, flavours and other non-visual matter can be registrable.

#### Can a mark acquire distinctiveness through use?

Yes. Non-inherently distinctive marks can be registered on the Principal Register on proof of acquired distinctiveness.

#### On what grounds will a mark be refused registration (ie, absolute and relative grounds)?

A mark may be refused registration if:
• the application does not comply with the filing requirements;
• the mark lacks acquired distinctiveness and is:
  • merely descriptive;
  • primarily geographically descriptive;
  • primarily merely a surname; or
  • deceptively mis-descriptive;
• the mark is likely to be confused with a prior registered mark;
• the mark is deceptive;
• the mark is primarily geographically deceptively mis-descriptive;
• the mark may disparage a person, institution, belief or national symbol;
• the mark falsely suggests a connection with a person, institution, belief or national symbol;
• the mark consists of or comprises the flag or coat of arms or other insignia of the United States or any state or municipality, or any foreign nation;
• the mark consists of or comprises a name, portrait or signature identifying a particular living individual (except by his or her written consent) or the name, signature or portrait of a deceased president of the United States during the life of his widow, if any (except with the widow’s written consent; or
• the mark is functional.

Are collective and certification marks registrable? If so, under what conditions?

Yes.

Applications for collective and collective membership marks must specify how the applicant regulates and controls the use of the mark by its members. Collective membership mark applications must also include information on the nature of the membership organisation.

Certification mark applications must identify what the applicant is or will be certifying, a copy of the certification standards used in that process and the applicant’s confirmation that it is not and will not engage in the manufacture or promotion of goods or services under the mark, but will only advertise or promote the certification programme under the mark.

Filing and registration

Filing procedure

Do agents filing for registration of a mark on behalf of the owner require power of attorney? If so, is notarisation or legalisation required?

Yes, although documentation of the power of attorney need not be submitted to the US Patent and Trademark Office (USPTO).

What information and documentation must be submitted in a trademark registration application?

Each application requires the following:

• the applicant’s name, address and entity type;
the applicant’s signature or verification;
identification of the relevant goods or services;
the filing basis;
a drawing of the mark;
a description of the mark; and
payment of the filing fee.

However, there are additional requirements depending on the filing basis. For example, if the applicant is filing based on use in commerce, the application must include:

- a verified statement that the mark is in use in commerce;
- the date of first use;
- the date of first use in commerce; and
- specimens showing use of the mark for at least one good or service in each class.

If the applicant is filing based on a *bona fide* intention to use the mark in US commerce, the application must include a verified statement to this effect. Applications based on foreign filing priority under the Paris Convention must supply details concerning the home country application or registration and a verified statement confirming the applicant’s *bona fide* intention to use the mark in US commerce. Registration sought through the Madrid Protocol must meet the requirements set out by the World Intellectual Property Organisation, including submission of Form MM 18 (Declaration of Intention to Use the Mark: United States of America), and also include a verified statement confirming the applicant’s *bona fide* intention to use the mark in US commerce.

**What rules govern the representation of the mark in the application?**

For any mark not in standard characters, the USPTO requires an image of the mark and a concise and accurate description of the features of the mark. The Trademark Manual of Examining Procedure sets out submission guidelines and is available on the USPTO website at [https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html](https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html).

**Are multi-class applications allowed?**

Yes.

**Is electronic filing available?**

Yes.

**What are the application fees?**

The normal application fee is $400 per class, although two reduced fee options are available if the application meets certain requirements. A Trademark Electronic Application System (TEAS) Reduced Fee filing costs $275 per class and requires the applicant to agree to:

- receive solely email correspondence from the USPTO; and
file certain required submissions electronically.

A TEAS Plus filing costs $225 per class, but requires the applicant to agree to:

- file a complete application (i.e., with no application form fields left incomplete);
- use approved USPTO Identification Manual language for the description of goods and services;
- pay fees for all classes at the time of submission;
- file electronically; and
- receive email communications only.

### Priority

**How are priority rights claimed?**

To claim Paris Convention priority rights based on a previously filed application or registration, the applicant must:

- file a claim of priority within six months of the filing date of the foreign application;
- identify the foreign application or registration; and
- if filing solely on the basis of priority and not combining it with a use or intent-to-use filing basis, verify the applicant’s *bona fide* intention to use the mark in commerce in the United States.

### Searches

**Are trademark searches available or required before filing? If so, what procedures and fees apply?**

Trademark searches are not required before filing; however, they are highly recommended to ensure that a proposed mark is not likely to be confused with another mark already on the register. Applicants may search the USPTO database at [www.uspto.gov](http://www.uspto.gov) at no cost. It is recommended that an applicant consult with a US trademark attorney regarding whether to conduct more in-depth searches.

### Examination

**What factors does the authority consider in its examination of the application?**

A USPTO examining attorney will review the application for completeness and compliance with the main registrability requirements.

**Does the authority check for relative grounds for refusal (e.g., through searches)?**

Yes.
If the authority raises objections to the application, can the applicant take measures to rectify the application? If so, what rules and procedures apply?

Yes. The applicant may respond to and resolve any objections. Most likely, the examining attorney will issue a communication known as an office action, to which the applicant will have six months to respond. If the objection is relatively minor, the examining attorney may contact the applicant (or its counsel) by telephone or email.

Can rejected applications be appealed? If so, what procedures apply?

Yes. Unsuccessful applicants may appeal to the Trademark Trial and Appeal Board by filing a notice of appeal and paying the requisite fee within six months of the date of final rejection. Notices of appeal must be filed through the Electronic System for Trademark Trials and Appeals. The applicant must then file an appeal brief within 60 days of the date of the appeal. The examining attorney will then have an opportunity to respond and the board will subsequently issue its decision.

Registration

When does a trademark registration formally come into effect?

A trademark registration formally takes effect on the registration date; however, once registration issues, the rights provided by registration will date back to the filing date of the application.

What is the term of protection and how can a registration be renewed?

A trademark registration can be maintained indefinitely if the owner submits the proper maintenance and renewal documents. To maintain a registration, the owner must file both a statement of use and a specimen showing current use of the mark in US commerce between the fifth and sixth anniversaries of the registration date. The registration must be renewed in the one-year period before the 10th anniversary of the registration date and can be renewed every 10 years thereafter, if the owner files an accompanying statement of use and specimen showing current use of the mark in commerce.

What registration fees apply?
The USPTO does not impose registration fees in addition to the application fees. In addition to the application fees, however, intent-to-use applications require payment of an additional $100 per class fee upon filing a required statement of use, which shows the mark in use in commerce for the subject goods or services. A limited number of extensions for filing a statement of use are available; each extension involves a $125 per class fee. Additional fees may be charged in certain circumstances throughout the process; the full list of fees can be found at www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#TM%20Process%20Fee.

What is the usual timeframe from filing to registration?

If no substantive issues arise during the examination process, registration may be granted within six to nine months of the application’s filing date.

Opposition

Can third parties formally oppose an application? If so, on what grounds and what rules and procedures apply?

Yes. US law allows "any person who believes it is or will be damaged by registration of a mark" to oppose an application. The only requirement is the allegation of facts sufficient to show a real interest (ie, a real and personal stake) in the outcome of the proceeding.

Applications can be challenged on a number of grounds, including:

- non-compliance with the main registrability requirements; and
- if registration of the applied-for mark is likely to dilute the distinctiveness of the plaintiff’s famous mark.

On publication, would-be opposers have 30 days to file a formal opposition or request an extension of time to do so. The deadline can be extended for up to 90 days without the applicant’s consent and an additional 60 days with the applicant’s consent. Oppositions are governed by the Lanham Act, the Trademark Rules (Parts 2 and 7 of the Code of Federal Regulations) and the Trademark Trial and Appeal Board (TTAB) Manual of Procedure.

What is the usual timeframe for opposition proceedings?

The Trademark Rules outline a standard timeframe for the discovery period, testimony periods and briefing schedules. The standard schedule has the opposer’s reply brief on the merits due 550 days (one-and-a-half years) after the filing of the notice of opposition. The TTAB usually issues a decision within eight months of submission of the briefs. The parties can agree to an accelerated case resolution schedule, which can shorten that timeframe considerably.

Are opposition decisions subject to appeal? If so, what procedures apply?

Yes. The losing party in an opposition can appeal to either the US Court of Appeals for the Federal Circuit or a federal district court with jurisdiction over the parties. An appellant to a district court must reimburse the USPTO for its expenses, even if the appeal succeeds. Appeals to the Federal Circuit are governed by the Federal Circuit Rules, while
Removal from register

Non-use cancellation

Can a mark be cancelled for non-use? If so, what term of non-use applies and what is the procedure for cancellation?

Yes, a registration can be cancelled for non-use at any time. The challenger must show that use of the registered mark has been discontinued with intent not to resume use. Non-use for three consecutive years constitutes *prima facie* evidence of abandonment. The procedure for cancellation (revocation) on the basis of non-use is the same as the procedure for cancellation (revocation) on the basis of other grounds.

Revocation

On what grounds can a trademark registration be revoked (eg, loss of distinctiveness, incorrect registration)?

The grounds on which a registration can be cancelled vary depending on whether the registration has passed its fifth anniversary.

If the registration has not passed its fifth anniversary, it can be cancelled:

- for any of the reasons that would have prevented its issuance in the first place; or
- on the ground that the continued registration of the mark is likely to dilute the distinctiveness of a prior user’s famous mark.

If the registration has passed its fifth anniversary, the grounds on which it can be cancelled are automatically narrowed to the following:

- the registration was procured or maintained through a fraudulent filing;
- the registered mark has become generic;
- the registered mark is functional;
- the registered mark has been abandoned (non-use);
- as of the registration date, the registered mark:
  - is deceptive;
  - is immoral, scandalous or potentially disparaging;
  - falsely suggests a connection with a person, institution, belief or national symbol;
  - comprises the flag or coat of arms or other insignia of the United States, any state or municipality or any foreign nation; or
  - comprises a name, portrait or signature identifying a particular living individual (except by his or her written consent) or the name, signature or portrait of a deceased president of the United States during the life of his widow, if any;
- the registered mark has been used to misrepresent the source of the goods or services on or in connection with which it is used; or
- if a certification mark, the registered mark has been used as a trademark or service mark.

Who may file a request for revocation and what is the statute of limitations for filing a request?
Any person who believes that he or she will be damaged by a trademark registration may file a cancellation action.

What are the evidentiary and procedural requirements for revocation proceedings?

A cancellation action is commenced by filing a petition for cancellation before the Trademark Trial and Appeal Board (TTAB) along with the required fee. The petition must be filed electronically and signed by the petitioner or the petitioner's attorney. It need not be verified.

A petition generally must include:

- a short and plain statement of the reasons why the petitioner believes that it is or will be damaged by the challenged registration; and
- the grounds for cancellation.

The petition generally need only give the defendant fair notice of the basis for each claim. However, if the petition asserts fraud as a ground for cancellation, this ground must be pleaded with particularity. Evidence should not be filed with the complaint.

The TTAB will then serve the registrant with the petition and set deadlines for the registrant’s answer, discovery, initial and expert disclosures and trial and rebuttal period.

What is the appeal procedure for cancellations or revocations?

A final TTAB decision on a cancellation or revocation may be appealed to either the US Court of Appeals for the Federal Circuit or a federal district court with jurisdiction over the parties. Appeals to the Federal Circuit are governed by the Federal Circuit Rules, while appeals to a federal district court are governed by the Federal Rules of Civil Procedure. The notice requirements and deadlines for filing an appeal are set forth in the TTAB Manual of Procedure. Parties generally have 60 days from the date of the decision in which to appeal the TTAB’s decision. If a party appeals to the Federal Circuit, the non-filing party has 20 days to file a notice of election to have the decision reviewed by civil action. If appealed through a new civil action, the district court may adjudge whether a registration should be cancelled.

What is the procedure for surrendering a trademark registration?

A registration may be voluntarily surrendered for cancellation. There is no fee to do so and the request may be submitted electronically. Unless the registration is the subject of a cancellation proceeding before the TTAB, a request for surrender is handled by the Post-registration Division of the US Patent and Trademark Office. If the registration being surrendered is the subject of a cancellation proceeding before the TTAB, the TTAB will process the surrender.
Which courts are empowered to hear trademark disputes?

Trademark disputes alleging violations of federal law can be heard in federal or state court. Federal courts have original jurisdiction over federal trademark disputes. However, state courts also have jurisdiction over federal trademark disputes.

Trademark disputes alleging violations of state law can be heard in state court in every instance and in federal courts in only some instances. For a federal court to exercise jurisdiction over a trademark dispute based on state law, there must be some other jurisdictional basis for it to do so. Usually, a trademark plaintiff will assert claims under federal and state law. In these instances, the federal court can hear the state law claims by exercising supplemental jurisdiction. If no federal cause of action can be attached to a state trademark claim, diversity between the parties is necessary for a federal court to hear it. Without supplemental or diversity jurisdiction, a trademark dispute based on state law can be heard only in state court.

Regardless of the court in which the claims are heard, federal law will apply to the federal claims and state law will apply to the state claims.

What actions can be taken against trademark infringement (eg, civil, criminal, administrative), and what are the key features and requirements of each?

The primary action against trademark infringement is a civil suit for trademark infringement in federal or state court. To bring suit, a plaintiff must have standing (see "Who can file a trademark infringement action?" below), prepare a complaint making out a *prima facie* case for infringement and file the complaint with the requisite filing fee. The complaint should allege the following:

- The plaintiff owns valid and protectable trademark rights;
- The defendant’s mark is used in connection with the sale, offering for sale, distribution or advertising of goods or services;
- Consumers are likely to be confused by the parties’ marks; and
- The confusion caused by the defendant’s mark harms or is likely to harm to the plaintiff.

To prevail on the merits, the plaintiff must establish that there is a likelihood of confusion. Different courts have different – but substantially similar – multi-factor tests for evaluating whether confusion is likely. For example, the Second Circuit refers to the ‘Polaroid factors’ first articulated in *Polaroid v Polarad Elecs Corp* (287 F2d 492 (2d Cir 1961)). These include:

- the strength of the plaintiff’s mark;
- the degree of similarity between the plaintiff’s and defendant’s marks;
- the competitive proximity of the products sold under the marks;
- the likelihood that the plaintiff will bridge the gap;
- actual confusion;
- the defendant’s good faith, or lack thereof, in adopting its mark;
- the quality of the defendant’s product; and
- the sophistication of the plaintiff’s customers.

Not all factors must be met in a given case and some may have more weight than others, depending on the circumstances.

Remedies typically sought for trademark infringement include injunctive and monetary relief, with injunctive relief being the most common. Monetary relief can take many forms, including (but not limited to) the plaintiff’s actual losses, the defendant’s profits and corrective advertising. Once infringement has been proven, monetary relief may also be trebled by the court under the Trademark (Lanham) Act. Punitive damages may also be available under state law. Reasonable attorneys’ fees are also available in exceptional cases.

There are no criminal statutes protecting against trademark infringement in the United States, but counterfeiting has
been criminalised at the state and federal level. Addressing counterfeiters at the criminal level requires the involvement of law enforcement.

For some forms of online trademark infringement, administrative action is available through the Uniform Domain Name Dispute Resolution Policy.

### Who can file a trademark infringement action?

There are two statutory bases for trademark infringement claims under the Lanham Act: Section 32 and Section 43(a).

A plaintiff has standing to sue for trademark infringement under the act when:
- the person is within the ‘zone of interest’; and
- the person can show that the alleged infringement was the proximate cause of the plaintiff’s injury.

Only the registrant of a federally registered mark has standing to sue for infringement under Section 32. The same is true for a counterfeiting claim. The term ‘registrant’ includes legal representatives, predecessors, successors and assignees, but generally not licensees.

Unlike the limitation to registrants found in Section 32(1), Section 43(a) stipulates that a suit can be brought “by any person who believes that he or she is or is likely to be damaged” by the infringement. The general rule is that only an owner of a mark has standing to sue for infringement.

### What is the statute of limitations for filing infringement actions?

Infringement actions based on state law are subject to the relevant state statute of limitations. Federal law does not provide a statute of limitations, but courts typically refer to state statutes of limitations when determining whether a plaintiff’s delay in bringing suit has prejudiced the defendant for purposes of the equitable defences of laches and acquiescence.

### What is the usual timeframe for infringement actions?

The timeframe for an infringement action through trial can take anywhere from six months to several years. Nonetheless, judicial relief can be afforded much faster by obtaining a preliminary injunction. Preliminary injunctions move on a much faster track and can be obtained within a matter of weeks or months. In more extreme cases involving urgent situations, a temporary restraining order can be obtained extremely quickly, with hearings often being scheduled within days of filing the papers.

### Injunctions

What rules and procedures govern the issuance of injunctions to prevent imminent or further infringement?

Injunctions
Remedies sought for trademark infringement typically include injunctive and monetary relief, with injunctive relief being the most common. Permanent injunctions are awarded after a plaintiff successfully proves its case on the merits. A plaintiff seeking permanent injunctive relief therefore must establish that:

- it has suffered an irreparable injury;
- remedies such as monetary damages are inadequate to compensate for that injury;
- a balancing of the parties’ respective hardships favours the plaintiff; and
- a permanent injunction will not be contrary to the public interest.

A plaintiff also can seek a preliminary injunction simultaneously while filing the complaint or very shortly thereafter. To obtain preliminary injunctive relief, a plaintiff must satisfy the same four-factor test provided above for permanent injunctions and also establish a likelihood of success on the merits. A plaintiff pursuing a preliminary injunction should be prepared to post a bond to make the defendant whole for its damages if the defendant ultimately prevails on the merits of the case.

A plaintiff may also seek an _ex parte_ temporary restraining order, which can issue without allowing the defendant to be heard. Temporary restraining orders are awarded only in the most urgent circumstances and expire within 14 days, unless they are converted into preliminary injunctions.

Injunctive relief can take many forms, depending on the circumstances of the case. A court may order:

- the sale of infringing goods to cease immediately or after some reasonable sell-off period;
- recall of the infringing goods;
- some form of corrective advertising by the defendant; or
- any number of other things as equity may require.

Preliminary injunctive relief is usually limited to cessation of the infringing activity, with more extreme forms – such as recalls – being reserved until after a full trial.

What remedies are available to owners of infringed marks? Are punitive damages allowed?

In addition to injunctive relief, remedies available to prevailing plaintiffs include certain forms of monetary relief. The court has broad discretion to determine the availability and amount of the relief. If the court decides to grant a trademark owner monetary relief, federal law also permits the doubling or trebling of the relief and, in exceptional cases, attorneys’ fees.

In the case of a non-competing trademark owner and accused infringer, the court may deny a successful plaintiff actual damages if there is no evidence that the infringement diverted trade or caused economic injury to the plaintiff. However, a court may grant a successful plaintiff an accounting of the defendant’s profits if:

- the defendant was unjustly enriched;
- the trademark owner sustained damage from the infringement; or
- the accounting is necessary as a deterrent to future infringement.

If the trademark owner and the accused infringer are competitors, the court may award actual damages in the form of its lost revenue as a result of the infringement. A successful plaintiff also may pursue an accounting of the defendant’s profits. In such an accounting, the plaintiff must demonstrate the defendant’s gross revenues. The burden then shifts to the defendant to apportion those revenues between infringing and non-infringing sources and to prove any deductible expenses.

The Lanham Act also allows for the _ex parte_ seizure of goods bearing counterfeit imitations of registered marks. Trebled awards of damages and accountings of profits are mandatory in counterfeiting cases, except in extenuating circumstances.

The Lanham Act does not permit the award of punitive damages, but these are often available under state law.

A court may also grant attorneys’ fees to a prevailing party, but only in exceptional cases. Courts are increasingly holding that an exceptional case is simply one that stands out from others with respect to the substantive strength of a party’s litigating position or the unreasonable manner in which the case was litigated.

What customs enforcement measures are available to halt the import or export of infringing
Customs enforcement is available to owners of registered marks. Generally, Customs will seize or detain goods that copy or simulate a trademark only if the mark is registered and the registration has been recorded with US Customs and Border Protection. If Customs declines to act, trademark owners can bring a private action of trademark infringement against the importer or bring a proceeding before the International Trade Commission. If infringement is found, the remedial action is submitted to the president, who has 60 days to veto the action. If a veto is not submitted, the defendant importer may appeal the decision to the Federal Court of Appeals.

Although Customs generally focuses on issues of infringing imported goods, it has similar authority for the purpose of preventing the export of infringing goods.

What defences are available to infringers?

Laches
Laches is an equitable defence to injunctive relief, as well as to monetary relief. A defendant claiming laches must prove an unreasonable delay by the plaintiff in bringing the suit and that such delay caused prejudice (evidentiary or economic). If laches is found, it can bar the plaintiff from bringing the claim altogether or, alternatively, prevent awards of monetary relief.

For injunctive relief, a plaintiff’s delay in moving for a preliminary injunction can negate the need to grant an injunction. Similarly, acquiescence occurs if a plaintiff affirmatively communicated its consent to the defendant’s conduct and then unreasonably delayed in challenging that conduct. As with laches, a showing of acquiescence requires proof that the plaintiff’s delay prejudiced the defendant’s interests in some way.

Unclean hands
Unclean hands is an equitable defence that may bar relief. It also may bar other equitable defences, such as laches and acquiescence. To prove unclean hands, a defendant must demonstrate that the plaintiff intentionally acted inequitably or illegally. The underlying claim of an unclean hands defence must directly relate to the trademark at issue in the suit. A plaintiff’s general misconduct will generally not suffice for an unclean hands claim. Unclean hands is infrequently pleaded and succeeds only in the most egregious circumstances.

Fair use
There are two types of fair use that a defendant may assert: classic fair use and nominative fair use.

Classic fair use is an affirmative defence that may be asserted if the use of words making up a plaintiff’s trademark is non-trademark in nature and merely for purposes of describing the defendant’s goods or services, the source of the defendant’s goods or services, or individuals involved with the defendant’s business.

The nominative fair use doctrine applies if the defendant uses a trademark owner’s trademark to identify the plaintiff’s goods or services rather than the defendant’s goods or services. To assert this defence, the defendant must demonstrate that:

- the goods or services cannot be identified without the use of the plaintiff’s mark;
- the use of the plaintiff’s mark is limited to what is necessary; and
- the defendant’s use does not suggest the plaintiff’s sponsorship or endorsement of the defendant’s goods or services.

Courts are currently split on whether nominative fair use is an affirmative defence to be proven by the defendant or, alternatively, whether it is something to be overcome by the plaintiff.

First Amendment free speech
The constitutional guarantee of free speech is not an affirmative defence, but rather serves as an alternative argument against a finding of a likelihood of confusion. Free speech defences include parody and expressive works with any measure of artistic relevance.
What is the appeal procedure for infringement decisions?

If a trademark owner appeals a grant of motion for summary judgment, the appellate court will review the decision de novo, assessing all facts and inferences in a light most favourable to the non-moving party.

In an appeal following the trial of an infringement action, most US appellate courts will apply a deferential standard of review. Specifically, they will affirm the finding below, unless it is unsupported by substantial evidence.

What rules and procedures govern the assignment of trademark rights? Must an assignment be recorded to have legal effect?

An assignment must be in writing and assign the goodwill of the business associated with the mark. An assignment without the mark's goodwill is considered in gross and is deemed invalid. With respect to intent-to-use trademark applications, the legal requirements of the assignment depend on whether the applicant has filed an allegation of use of the mark and/or whether the transfer of the intent-to-use application is in connection with the sale of the portion of the ongoing business associated with the mark.

Recordation of an assignment with the US Patent and Trademark Office (USPTO) is recommended and provides certain advantages, including 'constructive notice' to the public as to trademark ownership and priority between conflicting and subsequent assignments.

What rules and procedures govern trademark licensing? Must a licensing agreement be recorded to have legal effect?

A trademark owner must exercise quality control over the licensed goods or services bearing its mark or risk. Failure to exercise quality control may result in an abandonment of the owner’s trademark rights. A trademark licence need not be recorded to be effective against other parties.

What provisions are typically included in a licensing agreement (eg, quality control clauses)?

A trademark licence can vary depending on the parties and the goods or services involved, but typically includes the following information:

- the parties;
- the effective date;
Can a security interest be registered over a trademark? If so, what rules and procedure apply?

Yes. A lender may perfect a security interest by recording it under Article 9 of the Uniform Commercial Code, as adopted by the states. Although not legally required, a lender should record its trademark security interests with the USPTO in addition to making state filings to protect its interests against later bona fide purchasers. The security agreement should define the trademarks to include the goodwill of the business to which the trademarks are associated. Taking a security interest in a trademark without the associated goodwill could result in the trademark being voided on foreclosure.

Can trademarks be protected under other IP rights (eg, copyright, designs)?

Yes.

Designs, words and sounds used as trademarks may, under certain circumstances, be protected under copyright law as well as trademark law. While trademark law protects marks used in association with goods or services, copyright law protects original works of authorship fixed in a tangible medium. A mark owner generally can claim copyright as well as trademark protection in an original design that is used in association with goods and services. While a single word can be protected under trademark law, it is unlikely to be protected under copyright law. A slogan or sentence may be protected under both copyright and trademark law. A musical composition may be protected under both copyright and trademark law if the music is used in connection with goods or services, although trademark law would not apply if the product associated with the composition is the composition itself. Thus, depending on the circumstances, a mark owner can protect its trademark under both copyright and trademark law.

A mark owner also can secure trade dress protection for the design and shape of a product, its packaging or its overall appearance. The aspect of a product claimed as trade dress may be protected only if it is non-functional (ie, the feature at issue does not serve a utilitarian purpose).

A mark satisfying the requirements for trade dress protection also may receive protection under a design patent if it is a novel and ornamental design. Design patents protect the non-functional, non-obvious, ornamental features of a product or container. A design patent may be particularly useful in protecting a design against use by others of a similar design used for unrelated goods where confusion is unlikely.

Publicity rights also may be available in very specific instances. An individual whose likeness is used in association with goods and services and has acquired secondary meaning as a trademark may be protected under the laws of publicity rights.
What regime governs the protection of trademarks online and domain names?

The use of trademarks in domain names is protected by the Anti-cybersquatting Consumer Protection Act 1999 (15 USC § 1125(d)). This act provides a federal cause of action against a person that:

- has a bad-faith intent to profit from another party’s trademark; and
- registers, traffics in or uses a domain name that is identical or confusingly similar to that trademark (or, in the case of a famous trademark, is likely to dilute the distinctiveness of that mark).

The statute precludes liability if the registrant had reasonable grounds to believe and did in fact believe that the use was a fair use or otherwise lawful. Remedies under the act include the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

Please state the date of which the law stated here is accurate.

March 15 2017.