



New insight on the pillars of US trademark practice

Prosecution and litigation are two central columns supporting the business of protecting trademark rights in the United States. The first of those pillars has undergone a significant change in recent months, while the second remains as complex as ever. In this three-part special, *WTR* examines and provides guidance on the latest developments at the US Patent and Trademark Office (USPTO) and the federal courts.

At the end of August the US Court of Appeals for the Federal Circuit issued the landmark *In re Bose Corporation* decision. The ruling, which overturned the controversial *Medinol* doctrine on fraud on the USPTO, has received a cautious welcome from rights holders as it appears to reduce significantly the threat of cancellation of a mark on the grounds of fraud. However, in the first article in this special feature, Joseph Dreitler from US firm Bricker & Eckler argues that the decision is ill-conceived and in clear breach of principles established in the Trademark Law Revision Act.

US trademark rights can stem from registration or use. But such rights are meaningless unless they can be enforced. This is the focus of the second and third articles in this special feature. A mark owner should not launch litigation action in the United States without a clear strategy. As Roberta Horton from Arnold & Porter LLP explains, the first step is to determine whether the case should be heard by a judge or a jury. Choosing the right venue and finder of fact can make all the difference. The brand owner must also take a tactical approach to the type of relief sought. Although most litigation is aimed at obtaining an injunction, US damages awards can run into millions of dollars and should be considered when developing litigation strategy. However, as Michele Riley and Marylee P Robinson of Invotex Group make clear, the criteria for obtaining an award vary from circuit to circuit.

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

To avoid CANCELLATION of the registration, the owner of the registration must submit a declaration of continued use or excusable non-use between the fifth and sixth years after the registration date. (See next page for more information.) Assuming such a declaration is properly filed, the registration will remain in force for ten (10) years, unless terminated by an order of the Commissioner for Trademarks or a federal court. (See next page for information on maintenance requirements for successive ten-year periods.)



A handwritten signature in black ink that reads "Jon W. I. Dudas".

Director of the United States Patent and Trademark Office