STINSON

Trademark, Trade Dress, False Advertising & Unfair Competition Litigation

For many companies, their brand is their most valuable intellectual property. At Stinson, we appreciate brand value and enjoy working with our clients to develop and protect meaningful trademarks. We provide the legal context our clients need to make informed business decisions on how best to protect and enforce these important assets. When it's time to take action, our attorneys bring significant trademark litigation experience to the table.

CAPABILITIES

Stinson intellectual property and technology attorneys have successfully litigated trademark issues in federal and state courts, as well as proceedings before the Trademark Trial and Appeal Board, an administrative tribunal that resolves disputes concerning the registration of trademarks by the U.S. Patent and Trademark Office.

The Courts

In the courtroom, our attorneys know when to pursue and how to defend claims for federal trademark infringement, common law trademark infringement, dilution, trade dress, false advertising, and unfair competition. Our attorneys have obtained critical temporary restraining orders (TROs), preliminary and permanent injunctions, and pursued damages against trademark infringers.

Oppositions

Our clients use opposition proceedings to prevent others from registering trademarks with the USPTO that might harm their brands. Occasionally, they also have to defend their applications for registration against oppositions initiated by third parties. In the last few years alone, Stinson attorneys have successfully initiated and defended more than 50 trademark opposition proceedings. An opposition is similar to civil litigation in that there is a discovery period, an opportunity to move for summary judgment, and a trial period. Clients can count on our attorneys to bring attention to detail, a thorough understanding of the law, and persuasive writing skills to the process.

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Cancellations

Our attorneys have also handled a number of trademark cancellation proceedings before the Trademark Trial and Appeal Board. Our clients use these proceedings to cancel the registration of rival marks that have been improperly registered or abandoned. Like oppositions, cancellations are adversarial in nature and require our intellectual property attorneys to be well-versed in cost-efficient and effective litigation tactics.

Domain Name Disputes

We also assist our clients in domain name disputes and with issues involving infringing uses of trademarks, copyrights and other intellectual property online. Our experience in this area pre-dates the original internet technology boom of the 1990s. This work includes prosecution of Anticybersquatting Consumer Protection Act (ACPA) cases in federal court and arbitration proceedings under ICANN's Uniform Domain-Name Dispute-Resolution Policy. We carefully consult with our clients to determine the best approach.

EXPERIENCE

- Won two-week false advertising jury trial in Los Angeles that resulted in a $13.5 million verdict in favor of our client and a defense verdict in favor of our client on all counterclaims. At the time, this was the fifth highest false advertising verdict in U.S. history.
- Obtained a preliminary injunction to stop a competitor from using an infringing mark in the same city as our client and on identical services. At the summary judgment stage, the district court judge entered a permanent injunction and awarded our client its attorney's fees, which was affirmed by the Eighth Circuit on appeal.
- Successfully defended nationally-known company in 18 defendant complex copyright and trademark case in the Southern District of California. Obtained early dismissal.
- Creatively resolved a trademark infringement and dilution matter after three rounds of mediation. This saved our client the expense of protracted litigation and preserving the strength and distinctive nature of the marks.
- Enabled our client to fulfill its holiday orders by preventing entry of a potentially crippling preliminary injunction aimed at our client's use of product packaging that was not properly protectable as trade dress.
- Initiated a cancellation proceeding against the competitor's registration for the mark after receiving a threat of trademark infringement litigation. By other parties agreeing to fast-track the proceedings, we obtained a final decision in our client's favor without the time and expense of an administrative hearing. No litigation ensued.

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- Wrestled a number of domain names incorporating our clients' marks away from cybersquatters before panelists from the National Arbitration Forum, World Intellectual Property Organization, and British Columbia International Commercial Arbitration Centre.

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RELATED CAPABILITIES

Intellectual Property & Technology

Business Litigation

Trademark, Trade Dress, False Advertising & Unfair Competition Litigation

Copyright Litigation

Copyright Protection

Patent Litigation

Patent Preparation & Prosecution

Trade Secret Litigation

Trademark Prosecution & Brand Management

NEWS

Leadership Council on Legal Diversity Names Glasnovich a 2024 Fellow, Araujo and Williams as Pathfinders
02.28.2024

Stinson's IP Attorneys Examine USPTO Guidance on AI, Patentability and Inventorship in *IPWatchdog* Article
02.23.2024

World Trademark Review Recognizes Stinson's IP Practice, Three Attorneys in *WTR* 1000 Rankings
02.12.2024

Chavez, Rivard Examine Scope of Copyright Protection for Creative Content Use in *Bloomberg Law*
11.30.2023

Stinson IP&T Attorneys Secure Injunction and Settlement for American Outdoor Brands
09.28.2023

Chavez, Barnard Examine Social Media's Legal Risk for Companies, Third Parties in *Bloomberg Law*
08.04.2023

ACC STL July Newsletter Features Schroeder's Considerations for Companies to Protect Trade Secrets
07.21.2023

Stinson IP&T Attorneys Assist in Protecting American Outdoor Brands' Intellectual Property, Secure Agreement to End Litigation
04.21.2023

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Stinson Associate Selected for U.S. Bank Law Division Spotlight on Talent Program
04.06.2023

Stinson Attorneys, Minneapolis Office Earn Recognition in *World Trademark Review*'s WTR 1000 Rankings
03.09.2023

Schroeder Details How the FTC Ban on Non-Competes Impact Trade Secret Protection in *IPWatchdog* Column
02.17.2023

Stinson's 2022 IP&T Year-in-Review Includes Strategic Creativity, Continued Innovation
02.10.2023

World Trademark Review Recognizes Stinson Attorneys, Minneapolis Office in *WTR 1000* Rankings
03.14.2022

Stinson's IP&T Team Supports Innovation: 2021 Year In Review
02.11.2022

Stinson Advised on Thousands of Patent and Trademark Matters in 2020
02.25.2021

World Trademark Review Recognizes Stinson's Trademark Leadership
03.04.2020

PUBLICATIONS

Supreme Court Holds "Generic.com" Marks are Not Per Se Generic
07.01.2020

Supreme Court Confirms Trademark Defendants' Profits are in Play Even Without Willfulness Showing
04.24.2020