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In Memoriam

This newsletter is dedicated to the memory of Julianna Hammond, one of our dedicated YLD IP Committee members who passed away in December. The YLD and the IP Committee extend sincere condolences to Julianna’s family; we are all deeply sorry for your loss.

Ben Hodges, Christopher Suarez
YLD IP Committee Co-Chairs

Dana Hrelic
YLD Chair

MESSAGE FROM THE COMMITTEE

Happy New Year and welcome to the second quarterly installment of the YLD Intellectual Property and Internet Law Committee Newsletter for the 2017-2018 bar year! Our Committee is dedicated to providing resources, opportunities, and knowledge to help young lawyers build their IP and Internet Law practices.

The leadership of the Committee is here to serve you and your fellow committee members!

Co-Chairs: Christopher Suarez and Ben Hodges
Vice-Chairs: Joe Conti, Ava Miller, Michelle Miu, Nicole O’Hara, and Rachel Smoot

Visit our webpage to take advantage of the Committee’s resources. If you are interested in writing a practice article, creating or presenting a CLE program, or becoming more involved with the Committee, please contact Chris Suarez at CSuarez@wc.com or Ben Hodges at ben.hodges@foster.com.

NEWS AND ANNOUNCEMENTS

Committee Calls

Please feel free to join one of our upcoming committee calls, where you can learn more about what the committee is doing and some of our current initiatives. (Dial-in: 888-759-6037; Passcode: 202 4345279)

- January 30th, 1 PM
- February 27th, 1 PM
- March 27th, 1 PM
Committee Volunteering Opportunities

**IP and Video Games Webinar:** If you are interested in getting involved, please contact Rachel Smoot at rsmoot@rmmslegal.com or Michelle Miu at michelle@mybelaw.com.

**Newsletter:** Our Spring newsletter will be published in April with submissions due by April 16. If you are interested in contributing, please contact Ava Miller at armiller@wsgr.com.

**Midyear Meeting in Vancouver:** Join us for the CLE program *Navigating Venue and Jurisdiction in IP Litigation* on February 1 at 5:30, including a free happy hour (sponsored by Gowlings).

**Connect with Us!**

If you would like us to notify you of official committee business through social media, tag you in relevant content, and/or help you connect with Committee members and the ABA YLD leadership, email Nicole O’Hara at nohara@grossmcginley.com with as much of the following information as you deem relevant:

- Name
- City/State
- Firm
- Practice Area(s)
- Email
- Role in ABA/YLD
- Any other IP law bar groups/organizations/committees in which you participate
- If you read and/or write for any IP law publications or blogs
- Username for Facebook, LinkedIn, Twitter, YouTube, and/or Google+

Lastly, please let us know if you post anything relevant to the Committee, IP Law, Internet Law, or young lawyers. Feel free to tag any or all of the Committee chairs and vice-chairs, as well as #ABAYLDIP, @ABAYLD, @ABAEsq, or @ABAIPL.

**ARTICLES**

**Friendly Cease-and-Desist Letters: Effective Policing or Simply a Marketing Stunt?**

By: Giselle Girones

When you think of traditional cease-and-desist letters, you usually envision strongly worded letters that, as the title says, request the infringer to immediately cease all action and almost always threaten to sue if the matter is not remedied. Larger companies, however, have recently begun to take a different, more light-hearted approach to cease-and-desist letters.

A series of companies have taken to the idea of presenting their cease-and-desist letters in a more care-free and comedic form, not only to stop infringing actions, but perhaps also in the hopes of boosting their reputations. Netflix seems to have started the trend
for 2017 after sending a cease-and-desist letter regarding its viral show *Stranger Things* to Emporium Arcade, a Chicago bar. Emporium Arcade had begun to market a pop-up bar that was called the “Upside Down” and designed around one of the sets of the show. The pop-up bar began operating around the time the show’s second season premiered and was set to end in September of 2017. The letter sent by Netflix’s counsel was filled with *Stranger Things* references and was less threatening than your typical cease-and-desist, allowing the pop-up to remain open for its previously scheduled time but warning against further unauthorized use and threatening to call their “mom.” The letter was highly publicized and seems to have only boosted the popularity of both Netflix and *Stranger Things*. Many praised Netflix for its softer approach, which seemed to be effective with the bar owner ceasing all use after September. While certainly entertaining and admirable, it remains to be seen whether the approach will be effective long-term or merely encourage others to infringe in the hopes of receiving a similarly amusing and generous letter from Netflix.

Dole and TGI Fridays followed this approach in October of 2017. Dole’s counsel also took a softer stance when it sent a letter based on a branding agency’s use of their image, allowing the image to remain online but warning against future unauthorized use. Similarly, when a Chicago bar began using TGI Friday’s name and slogan during Halloween, the restaurant responded in a comedic fashion and even sent them accessories to use.

Most recently, BudLight decided to take this approach to a whole new level. In December, after discovering that a Minnesota brewery was using its “Dilly Dilly” trademark on a new beer, the company hired an actor—dressed as a town crier—to read a cease-and-desist letter that had been handwritten on a scroll. The approach was modeled after BudLight’s popular “Dilly Dilly” commercials, which are set in the Middle Ages. BudLight allowed the brewery to sell through its current inventory of the beer but warned that repeated action would result in additional letters, a warning, and finally “a private tour of the pit of misery,” which presumably is court. The brewery agreed to cease further use after it sold through its inventory, and BudLight was praised not only for its softer approach, but also for the comedic manner in which it handled the issue.

While the public in general has responded well to these approaches, it is unclear whether companies are behaving this way due to the realization that it is more effective at preventing infringement or if it is simply another marketing ploy. Either way, this approach seems to be working for larger companies so far given the positive press and cooperation from the infringing parties. In the past, companies have been slammed for more aggressive letters to small businesses and individuals when attempting to protect their marks. However, it remains to be seen whether these friendlier approaches will actually prevent future infringement or if they will simply encourage it. In any event, they certainly are entertaining!

*Giselle Girones is an associate at Shullman Fugate PLLC in Jacksonville, Florida. Giselle focuses on intellectual property, content, and business litigation. She represents content providers from at home bloggers to major international media organizations and start-ups to*

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1 In 2011, Chick-Fil-A was criticized for sending a letter to a Vermont artist who wanted to register “Eat More Kale.” In 2013, Starbucks received bad press for a letter it sent to a Mississippi brewery over an online review of a “Frappuccino” beer. Olive Garden was also criticized for sending a letter to a blogger who blogged about attempts to eat their “Never Ending” pasta.
Fortune 500 companies. Aside from copyright and trademark litigation, Giselle provides advice on intellectual property management and enforcement. She also handles content gathering and publication advice as well as defending content providers in complex defamation, privacy, and other publication-related claims. Giselle graduated from Stetson University College of Law where she was heavily involved in various organizations both on and off campus. Giselle is a member of the YLD Committee as well as other ABA-IPL committees and is a former Law Student Reporter for the ABA-IPL Trademark Day. Giselle is also a member of the ABA Forum on Communications Law and participates with other IP organizations. Contact Giselle Girones at ggirones@shullmanfugate.com.

Trademarks 101: What Every Entrepreneur and Business Owner Should Know

By: Heather Bowen

WHAT IS A TRADEMARK AND WHAT DOES IT PROTECT?

A trademark protects any word, phrase, symbol, slogan, and/or design that identifies and distinguishes the source of the goods and/or services of one owner from the goods and/or services of others in the same industry. A common law trademark lasts for as long as it is in use; however, it is possible to lose that common law protection if the owner fails to enforce his/her rights. A federal trademark lasts for ten years and can be renewed at ten-year increments with the payment of additional fees.

A trademark is not a copyright, nor is it a patent. A copyright protects original artistic or literary works likes books, photos, music, fine art, videos, films, and architecture. A copyright gets registered with the U.S. Copyright Office and lasts for the life of the author plus seventy years. A patent protects inventions and ornamental designs like prototypes and technologies. Utility patents last twenty years from the date of filing the application, and design patents last for fourteen years.

A trademark allows the owner to have the exclusive right to use the mark in connection with his/her goods and/or services while simultaneously excluding others from using a similar mark in commerce. The main goal of owning a federally registered trademark is to prevent the likelihood of confusion among consumers in the marketplace. Likelihood of confusion occurs when two or more marks are similar or substantially similar and the goods and/or services with which they are affiliated are related in a way that may lead consumers to believe that they come from the same source. Courts consider a number of factors to determine if likelihood of confusion exists including, but not limited to, the similarity of the marks in sound and appearance, the relatedness of the marks, and the strength of the marks, which is measured by classifying the marks into one of five categories of distinctiveness (generic, descriptive, suggestive, arbitrary, or fanciful).

The USPTO offers the Trademark Electronic Search System database to search through registered marks and pending applications; however, it is also important to search through state trademark databases and business name databases to see whether superior rights exist for another mark holder via common law rights. Therefore, it is important to have an experienced trademark attorney conduct a comprehensive trademark search in order to determine the likelihood of confusion of a proposed mark.
Completing a thorough search prior to filing an application can help the applicant determine if the mark is strong enough to protect and can save the expense of filing an application only to have it later rejected by the USPTO.

**HOW DO YOU REGISTER A TRADEMARK AND PROTECT IT FROM INFRINGEMENT?**

The owner of a mark for goods and/or services can protect a mark in two ways. The first is by using the mark in a commercial or business setting. He/she can use “TM” (for a trademark) or “SM” (for a service mark) in connection with the goods and/or services to claim rights to a particular mark. The second way to protect a mark is to receive federal registration with the USPTO. This process can be completed online via the USPTO’s Trademark Electronic Application System. The non-refundable application will need to include the applicant’s name and address, a depiction or drawing of the mark, the accompanying filing fees (depending on the number of classes selected), the basis for the filing (e.g. “use-in-commerce” or “intent-to-use”), a specimen for use-based applications (e.g. labeling or packaging as it appears on actual goods), and the applicant’s signature.

Once registration is approved, it creates a legal presumption that the registrant is in fact the trademark owner and allows the owner to sue and recover damages in the federal court system if someone infringes on the mark. In addition, once the USPTO registers a trademark, the owner may use the symbol “®” in connection with his/her goods and/or services. To receive trademark protection at the international level, the owner may either file a trademark application with the trademark office of each respective country or file an application using the World Intellectual Property Organization Madrid System, whereby the owner may modify and renew his/her trademark portfolio via one centralized system.

Heather Bowen is a Northwestern Pritzker School of Law Post-Graduate Fellow at Start Small Think Big in New York City. She is a member of the ABA Young Lawyers Division Intellectual Property Committee and is Chair of the Publications Development Subcommittee of the ABA Trademark Litigation Committee. In addition, she is a member of the Academic Committee of the International Trademark Association. Heather Bowen can be reached at heather@startsmallthinkbig.org.

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By: Tiffany Johnson

**What is fashion law?**

Fashion law is an ever-burgeoning area of law, closely intertwined with intellectual property (“IP”) law, that demands the attention of IP attorneys. Encompassing legal issues that involve clothing, shoes, jewelry, apparel, and other wearables, fashion law is here to stay. In fact, some of the fashion industry’s top designers are now incorporating technology into their designs and have come to appreciate the expertise that IP attorneys can offer to ensure their IP rights are protected.
The fashion industry grosses billions of dollars a year in the United States and over a trillion dollars a year globally, and fashion law is at the forefront. In January 2018, Amazon was granted U.S. Patent No. 9,858,719 for a “Blended Reality System” directed at blending or combining images displayed in a mirror with images transmitted from a screen behind the mirror. This patent appears to be directed at utilizing a smart mirror to try on different outfits without actually changing into different outfits. With the emergence of fashion technology, Amazon is not alone in protecting their fashion-related technology. Other technology companies and startups that are developing high-tech approaches to shopping, creating fabrics and wearables, and even creating platforms for consumer-to-consumer interaction have also embraced the power of IP.

FIG. 1A
U.S. Patent No. 9,858,719

How does fashion and IP law intersect?

Regardless of the design or technology incorporated into fashion, nearly every concept falls under the umbrella of IP law and can benefit from the protection afforded by patents, trademarks (including trade dress), and copyrights. In an era of copying, counterfeiting, and fierce competition, the dawn of fashion law needs IP to ensure adequate protection. Additionally, attorneys with a keen understanding of IP are needed to prepare agreements between technology companies and fashion designers/retailers.

More than ever, the fashion industry is pushing for better laws and procedures to help safeguard their products and designs. Toward the conclusion of the infamous Apple Inc.

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v. Samsung Electronics Co. case, in which Samsung was ultimately found to have infringed upon Apple’s patents (including some design patents), fashion designers and executives felt compelled to comment on the importance and outcome of the case. Some of these companies included Calvin Klein, Louis Vuitton, and Tiffany & Co., just to name a few. Representatives from these companies, and many others in the fashion industry, took the position that form and function are inseparable and equally define a particular brand. In other words, the aesthetic appearance and use of fashion articles go hand-in-hand. For example, under this rationale, the aesthetic appearance of Christian Louboutin’s red bottom sole is inseparable from the function of the shoe and defines a Christian Louboutin product.

The connection of fashion and IP law has even been explored by the Supreme Court. In 2017, Star Athletica, L.L.C. v. Varsity Brands, Inc. made significant gains in defining how to apply copyright law to fashion when the High Court analyzed whether stripes applied to cheerleading uniforms should be afforded copyright protection. The Court held that “[a] feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article, and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” The Court held that the test had been satisfied.

Many designers, retailers, and others in the fashion industry certainly hope to see more momentum in creating effective fashion law related legislation. Additionally, organizations like the International Anti-Counterfeiting Coalition and the Fashion Law Institute at Fordham Law School are advocates of stronger protection in the fashion industry, which undoubtedly centers around IP related legislation.

What steps should fashion designers and retailers utilize for IP protection?

Fashion designers and retailers seem to increasingly understand the importance of talking with attorneys knowledgeable in fashion law from the outset of generating designs and ideas. Individuals involved in developing fashion technology also seem to take a similar approach and actively call upon IP attorneys to ensure appropriate steps are taken to protect their IP and enter into agreements with fashion designers and retailers. IP attorneys can advise as to the best form of IP protection for designs and products by conducting clearance and infringement searches, considering the best form of protection based on the life of the designs and products, and exploring other ways of ensuring designers and retailers have effective IP protection.

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5 Id. at 1007.
6 Id. at 1017.
Copyright’s Small Claims Court May Be Arriving Soon: An Introduction to the CASE Act of 2017

By: Ford W. Harmon

Background

Last October, a bi-partisan coalition made up of six members of the House of Representatives introduced the Copyright Alternative in Small-Claims Enforcement Act of 2017, also known as the CASE Act of 2017 (the “Act”), a bill calling for the creation of a copyright small claims court. The principal concepts behind the Act are not ideas that appeared overnight or even over the course of the last several years. Rather, the idea of creating some form of small claims courts for copyright infringement is something that was first brought up in the House of Representative at least as far back as 2006. Eventually, further momentum led to the Copyright Office formally launching a comprehensive review of the concept in 2011, which concluded when the Copyright Office released an extensive report on the matter in 2013.

This concept has long been supported by artists, photographers, and other creators as well as related trade associations. The main reason that so many independent creators seem to support this type of legislation is because of the extremely high costs of litigating copyright infringement matters (estimated to be as high as $350,000 for litigating through the appeals process). Creators believe that the Act will reduce legal fees associated with infringement actions and enable them to more economically protect their work. The Act still has many hurdles to clear if it is to become law, but its potential impact—coupled with the fact that it has bi-partisan support, over a decade of buildup, and a large community actively supporting it—makes the Act worth paying attention to now.

2 Id.
3 Chris Reed, Is a Copyright Small Claims Court Finally in the Works?, ART LAW JOURNAL (July 17, 2016), https://alj.orangenius.com/copyright-small-claims-court.
4 Id.
7 Id.
8 The CASE ACT was referred to the House Committee on the Judiciary on the day it was introduced, and no updates about it have been provided by the House since. See CONGRESS.GOV, https://www.congress.gov/bill/115th-congress/house-bill/3945/text#toc-id5DF3F4883CF74369ABD7BDD679DCDE57 (last visited Jan. 13, 2018).
The Content of the Act

The Act would create a three-member Copyrights Claims Board (the “CCB”), which would be the decision-making body (each member serving as a “Judge”). The CCB would not have exclusive jurisdiction over small claims related to copyright, and potential defendants not wanting to participate in a CCB proceeding could opt out.

Some additional provisions of note about the CCB include the fact that it makes no determinations as to the willfulness of an infringement; it will take into account, when applicable, if an allegedly infringing party removed the copyrighted work upon being notified of infringement; and CCB’s proceedings will take place at the office of the CCB without the need for personal appearances by the parties. Written documents and Internet or phone based communication would generally facilitate all of the necessary communications between the CCB and the parties.

As the Act seeks to create a copyright small claims court, an obvious but key aspect of the CCB’s authority is the limit on monetary damages it can award. The claimant can elect to receive actual damages and profits or “special statutory damages,” but in either case, a party pursuing any action before the CCB may not recover more than a maximum of $30,000 in any single proceeding. For claims regarding a work that was not timely registered, statutory special damages cannot exceed $7,500 per work infringed and cannot exceed $15,000 in a single proceeding. It is important to note that attorney’s fees are generally not recoverable for actions that go through the CCB. This stands in stark contrast to actions brought in federal district court where attorney’s fees may be recovered. While this seems counterintuitive to the idea of reducing the legal costs for bringing smaller infringement claims, the idea is that individuals will be able to adequately represent themselves in proceedings before the CCB, which is obviously much more difficult in a federal district court case. Therefore, individuals should, apparently, not have to spend much money on attorneys for CCB proceedings.

Additional key aspects of the CCB are the limitations on the types of claims and defenses on which it may make determinations. While the Act allows for the CCB to make determinations on claims or defenses in several more specific situations, the main two determinations that it may make are resolving claims for copyright infringement and claims seeking a declaration of noninfringement when there is written evidence of an actual controversy indicating that imminent legal action may be taken due to alleged infringing activity.

It remains to be seen if the Act will become law, but it is clear that it has a lot of parties supporting a proposal, which attempts to reduce the costs of enforcing one’s copyright. While the voluntary nature of proceedings, lack of enhanced damages for willful infringement, and inability to recover attorney’s fees seem like features that are not helpful to independent creators, they may be outweighed by the general ease of use of

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9 H.R. 3945 § 1401.
10 H.R. 3945 § 1403(a).
11 Id.
12 Id. at § 1405(c).
13 Id. at § 1403(e)(d).
14 Id. at § 1403(e)(1)(A).
15 Id. at § 1403(e).
16 Id. at § 1403(c)(1),(2).
the system implemented under the Act if it truly allows pro-se plaintiffs to effectively manage CCB proceedings and can avoid having the other party opt out.

Ford W. Harmon is an associate at Maddrey PLLC, a law firm in Dallas, Texas. Ford holds a B.S. from LSU and a J.D. from SMU Dedman School of Law. He primarily works with entrepreneurs, startups, artists, and non-profits. Contact Ford at ford@maddreypllc.com.