

Understanding Trademark Litigation Strategies

Chris Ryan March 12, 2015



In such cases, the courts have awarded the original holder of the trademark a victory, indicating the scope of the usage falls within the courts understanding of applicable trademark law to justify enforcement of the trademark and for the new usage to stop

([Newswire.net](#) -- March 12, 2015) -- Copyright infringement cases involve proving there has been a threshold reached in terms of the unauthorized reproduction of a creative work, whether of music, art, fashion, or fiction. When a fashion designer brings suit against a company imposing trademark restrictions on a color, e.g. the name of a shade of red, there is an opportunity to explore the line between what is acceptable as a trademark worthy of protection. In the case of *Bowie v. Vanilla Ice*, for example, it is possible that the settlement might allocate some funds to Bowie, but a small amount of future payments to Vanilla Ice, at least partially because his resampling of the music is making money with the new label. In a similar arrangement, the two fashion designers discussing whether it's fair to be able to trademark a color red might come to a mutually satisfactory result.

In many cases involving the use of a [trademark](#) to bring suit, like a corporation's ability to protect their rights by bringing suit, there can be abuses to the system because the strength of unfair, top-weighted, cash rich entities can wield undue weight in the courtroom as well as the ability to bring suit because of financial largesse as compared with the less cash flush defendants. In other words, when a top fashion designer sues a less respected or one in a less strong financial situation, this can result in the protection of a trademark red.

On the other hand, if the company that is being sued for trademark violation can establish even a potential but well documentably secure countersuit, perhaps the countersuit is the best way to proceed if sued. This line of defense is similar to the old football adage, the best defense is a good offense.

In sum, the best part about the [countersuit](#) option is that it provides the court mechanism for establishing credentials effectively against the original trademark suit. If this can result in a possible framework for a mutually beneficial settlement that reflects the award to the original act or creative work that is alleged of value, as well as following works that may be linked, less court time can be achieved through the settlement process.

As some businesses take advantage of their ability to bring suit, and the countersuit is the best, though most expensive legal mechanism against the unfair advantage bestowed by the legal and economic machinery, still, second best is to fight the scope of the trademark at its basis, its power as a trademarked word. For example, if a suit is brought by a business with "stealth" in its name, and this company adopts a strategy of sending threatening letters or even suit when another company wants to use the word stealth in its name, as has been actually the case in several court battles over the use of the word stealth, there are a range of responses the company defending its own usage of "stealth" can adopt.

In such cases, the courts have awarded the original holder of the trademark a victory, indicating the scope of the usage falls within the courts understanding of applicable trademark law to justify enforcement of the trademark and for the new usage to stop its appropriation of the term for their own business usage.

In other cases, however, the scope of the trademark may be seen by the court to overstep its "[trademark jurisdiction](#)," and the court can find that the new usage is acceptable. In the example of the trademarking of the word "stealth," Columbia Pictures was able to fend off threats from the holder of a stealth trademark filed by another company when Columbia was marketing a movie they wanted to call "Stealth" by first writing the appropriate court and requesting they consider the fact that it was a movie title as distinct from another usage, in this trademark's case for a website called stealth that sells computer equipment.

In this particular case, Columbia was able to duck the challenge and make the film appear with the title they preferred. They took the initiative in approaching the court and were successful. Where possible, the message seems again, the best defense is a good offense.

Source: <http://newswire.net/newsroom/news/00087835-trademark.html>