

# The IP Law Book Review

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**TRADEMARK AND COPYRIGHT LITIGATION: FORMS AND ANALYSIS–VOLUME I: CEASE-AND-DESIST DEMANDS THROUGH ELECTRONIC DISCOVERY**, by **Mark V.B. Partridge and Phillip Barengolts**. Oxford University Press, 2011. 544 pp. Paperback \$250.

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Demonstrating that some “who do” also can teach, author-practitioners Mark V.B. Partridge and Phillip Barengolts have created an informative resource consisting of “actual and recommended sample documents for federal court trademark and copyright litigation”<sup>1</sup> along with commentary on related issues of law, procedure, and tactics. TRADEMARK AND COPYRIGHT LITIGATION: FORMS AND ANALYSIS is a recent addition to Oxford University Press’ practitioner law publishing program, a series that has featured attorney-written works on patent prosecution, internet crimes, software licensing, and other timely and interesting areas of legal practice. As advertised, the focus in TRADEMARK AND COPYRIGHT LITIGATION is on presenting a wide variety of sample pleadings, motions, and discovery materials used in trademark or copyright litigation. Indeed, fully more than 400 pages of the text (and an accompanying disc) consist of these examples, while fewer than 100 pages contain the authors’ commentary or analysis. For better or worse, there is far more by way of “forms” than “analysis” here.

The authors are Chicago-area attorneys who bring a wealth of expertise honed over several decades litigating trademark and copyright disputes. They also teach an LL.M. course at the John Marshall Law School in Chicago, and an educator’s focus on pedagogy is evident throughout the organization and presentation of the materials in TRADEMARK AND COPYRIGHT LITIGATION. The authors hope that their work, by providing actual samples of materials filed in trademark and copyright cases, will fill a void in the field of “how-to” books on litigation. They do

not intend the forms to be “perfect examples of how things are done” but only real ones (p.xiii). Ultimately, the authors hope that the samples and commentary will be “useful to both novice and experienced litigators in preparing and litigating cases in this field” (p.xiii).

The organization of TRADEMARK AND COPYRIGHT LITIGATION is logically sound and easy to follow. It proceeds chronologically from prefiling case assessment, cease-and-desist demands, and jurisdiction and venue considerations, through Complaints, Answers and Counterclaims, preliminary injunctions, motions to dismiss, and concluding with written discovery, depositions, discovery disputes, and electronic discovery. Most chapters begin with a brief, one or two-page introduction in which the authors highlight issues relevant to the phase of litigation under consideration. On the whole, the authors succeed in covering a significant portion of the types of pleadings and motions most commonly recurring in trademark or copyright litigation.

Much of this resource’s value to practitioners and professors alike stems from the authors’ well-informed selection of the exemplars included. The pleadings, motions, and other documents included in TRADEMARK AND COPYRIGHT LITIGATION are high quality, well-researched, and carefully drafted litigation materials. They apparently were prepared (not always by the authors themselves) by attorneys knowledgeable of the finer points of trademark or copyright law who are able to express themselves effectively as litigators. Reading the sample Motions to Dismiss or Motions for Temporary Restraining Order, for example, affords one the opportunity to be instructed (or, in the case of an experienced practitioner, to be reminded) about important areas of law, practice, and strategy common to trademark or copyright litigation. Indeed, much of the substance of copyright or trademark law contained within TRADEMARK AND COPYRIGHT LITIGATION will be gleaned from close reading of the fine examples chosen by the authors. The reader must take into account, of course, that most of the exemplars are works of advocacy, and their representation of the law cannot be accepted fully without taking into account the original purpose of these documents: to persuade a judge to the advocate’s point of view. The forms, it must be said, are starting points, not ending points, for reviewing the law represented there.

In addition to the points of law discussed within the forms themselves, the authors provide their own commentary and analysis, not only on the substance of copyright or trademark law, but often with respect to litigation procedure and strategy as well. These analyses, however, are distributed unevenly over the course of the work. The early chapters on case and

forum assessment and the latter ones on discovery procedures, for example, include considerably more analysis than the middle chapters on pleadings and motions, some of which include in total only a few paragraphs of commentary. In this reviewer's opinion, TRADEMARK AND COPYRIGHT LITIGATION succeeds best when the authors supplement the form examples with their own substantive commentary on them.

The first chapter on "Case Assessment" crisply introduces the topic and showcases the authors' evident expertise. The authors begin appropriately where a seasoned litigator advising a commercial client should start: identifying the client's objectives in potentially initiating trademark or copyright litigation. In a brief but substantive section, the authors cogently discuss a wide array of strategic considerations while underscoring the importance of the client's adoption of a proactive strategy to enforcement of its rights, rather than merely responding *ad hoc* to infringement concerns as they arise. The authors balance the risks of filing litigation against the risks to the client of not taking action in the face of encroaching infringement. They pose crucial strategic questions about what type of cases the brand owning client should consider initiating. They observe that "[o]ne approach is to take on the easy cases first, building a record of successful enforcement through publicly available consent judgments and settlements. Another approach is to pursue a prominent test case where a solid victory will create precedent to deter other infringers" (p.2). The authors' incisive chapter on case assessment alone justifies the book's \$250 purchase price.

One might have hoped that the authors would have included a similar discussion of strategic *defensive* considerations for clients who are presented with the claim that they infringe another's rights and who need to decide quickly whether, and how hard, to fight. But the authors' excellent and detailed review of the early investigation a client should undertake when contemplating litigation—e.g., types of witnesses to interview, documents to review, sources of useful public records—applies equally to the defendant in receipt of an infringement notice as to the plaintiff contemplating bringing a lawsuit.

Case assessment naturally requires an understanding of the fundamentals of law, and the authors deliver in Chapter 1 a helpful summary of key governing trademark and copyright principles. What sets this summary of trademark law apart from the myriad others is that its focus is through the lens of litigation. Thus, we encounter not only discussion, for example, of the levels of trademark distinctiveness, the importance of secondary meaning, and the kinds of consumer confusion that invite infringement, but the authors also continually focus their subject matter back to the

practicalities of litigation, e.g., the relevance of surveys, the possible impact of a defendant’s insurance coverage, the availability or not of a jury, and much more. With any summary work of this nature, there will be important topics not addressed. For this reviewer, the most glaring omission in the summary of trademark law and types of actionable confusion is any mention of the increasingly-important theory of *reverse* trademark confusion. Indeed, two of the forms included by the authors, Form 5.5 and 5.7, rely prominently on the reverse confusion theory of infringement, making its omission from the discussion all the more perplexing.

The section on copyright law is briefer, and one senses that the authors have more expertise to share when it comes to trademark cases. This section highlights several copyright law issues—e.g., the importance of using the correct test for “substantial similarity,” scope of protection, and fair use—that experience shows time and again are featured in copyright litigation.

The second and third chapters address other important pre-filing issues: (1) cease-and-desist (or “demand”) letters and (2) forum considerations. Even the newcomer to trademark and copyright litigation quickly must learn to understand the function, risks, and strategies related to cease-and-desist correspondence. Because most trademark and copyright disputes resolve at the cease-and-desist stage before litigation is ever filed, a large portion of the practitioner’s career likely will be devoted to evaluating, preparing, sending, and negotiating demand letters. The authors’ chapter on demand letters introduces two relevant issues, and includes three fine examples of such letters, but leaves the reader wanting more.

The chapter opens by raising the concern that demand letters might provoke counterclaims (e.g., trade libel), followed by a cogent presentation of the broad protections for litigation-related demand letters found in the case law developed under *Noer-Pennington*. The authors correctly leave the impression that clients who send demand letters in good faith likely will be safe from tort liability.

The authors also highlight the risk of declaratory actions, but, in this reviewer’s opinion, the subject deserves more than a single paragraph of commentary. As a result of the Supreme Court’s having expanded declaratory judgment jurisdiction in *MedImmune*<sup>2</sup>, putative infringers who receive demand letters now have an easier time successfully filing a declaratory judgment (“DJ”) action in their home venues and making it stick under first-to-file rules. Thus, the brand-owning client must carefully review not only *whether* to send a demand letter, but also *how* to word the

demand to potentially avoid being “DJ-ed” in an unfavorable forum. The authors present three examples of demand letters, but give no indication whether or not the particular wording used is more, or less, likely to present substantial risk of provoking a DJ action for non-infringement.

The third chapter on choosing a forum for copyright and trademark disputes helpfully recognizes that federal civil courts are not the only alternative for a client with a trademark or copyright infringement problem. The International Trade Commission (“ITC”), the Trademark Trial and Appeal Board (“TTAB”), arbitrations, the U.S. Customs and Border Protection (“CBP”), and even foreign tribunals all may have advantages that an informed client should consider. The authors are at their best succinctly discussing the various procedures and available remedies that may make one type of forum more or less advantageous than another. Their experience as litigators shines through in this chapter. Further, they ably summarize the law relating to personal jurisdiction, highlighting jurisdiction as it relates to internet activities and the *Calder*<sup>3</sup> effects test. This reviewer appreciates too the inclusion of less familiar types of jurisdiction, such as *in rem* jurisdiction and *in personam* jurisdiction obtained pursuant to the whole-contacts doctrine of FRCP 4(k)(2).

Chapters 4 through 6 feature a significant variety of sample pleadings, injunction motions, and motions to dismiss. There is little separate commentary or analysis here, but nonetheless the exemplars themselves will be highly educational for those willing to work with them. Indeed, much of TRADEMARK AND COPYRIGHT LITIGATION proceeds based on a show, not tell, method and leaves much for the reader to investigate for him or herself. For example, the final 38 pages of Chapter 4 consist of a Complaint and Answer & Counterclaim in a trademark infringement matter, introduced simply by the comment that this involved a “complicated dispute” where both parties “take a detailed narrative approach to pleading, attempting to tell a persuasive story about the dispute” (p.119). With only this general point about narration, the reader is left to determine what potential lessons of strategy, procedure, and drafting are illustrated by these 38 pages of pleadings. The authors might have used the form pleadings in Chapter 4, for example, to explain the appropriate uses of “information and belief” pleading in trademark cases, the strategies for pleading use of a mark that is often found in conjunction with a geographical designation, the tactic of pleading general and specific forms of relief, the risks and benefits of narrative-type pleading, and much more. But, then TRADEMARK AND COPYRIGHT LITIGATION would either have had to focus more narrowly or would have been a more voluminous work. I cannot fault the authors’ choice to be comprehensive in scope but compact in execution by leaving

much of the analytic detail to be investigated by the reader. For those with the patience and fortitude to examine the forms and tease out their finer points with reference to other works, there are many helpful illustrations compiled here.

The authors' selection of examples is especially valuable because they have included both basic complaints and motions that cover all the requirements standard to trademark and copyright pleadings and motions, as well as more complex pleadings and motions that introduce a substantial variety of legal issues. The basic pleadings can be adapted by practitioners for use in many straightforward trademark infringement matters. (One wonders why the authors did not include a basic copyright infringement complaint, however. Indeed, on the whole, copyright law is not as well represented in this resource as trademark law.) As for the more "exotic" pleadings and motions, they introduce a great variety of legal issues that go beyond mere infringement matters, including "John Doe" seizure orders in anti-counterfeiting matters, alleging proper ownership of trademarks and copyrights, the unavailability of "niche market" fame in trademark dilution matters, fraud on the PTO, cybersquatting, relevance of Rule 9(b) heightened pleading standards, copyright infringement based on unauthorized "deep linking" between web sites, and much more. These sample motions make for interesting and informative reading on some of the most current substantive areas of copyright and trademark litigation.

The final four chapters all deal with discovery: written discovery, depositions, discovery disputes, and electronic discovery. In Chapter 7 on written discovery, the authors provide well-formulated examples of the types of interrogatories, production requests, and requests for admission that cover the basic factual discovery needed for some types of copyright and trademark litigation, as well as sample responses and objections. The authors begin by urging the reader to be familiar with the uses for and rules governing each type of written discovery, and by offering a few general introductory observations. The authors' commentary, though, is likely too cursory and general to be very helpful. More helpful would have been more directed commentary concerning strategy for the particular discovery issues common to trademark and copyright litigation related to, for example, ownership, use, protectability, compliance with registration requirements, and damages. There also is no mention of contention interrogatories to flesh out and narrow an opponent's theory of the case or defense.

The authors redeem themselves with their insightful discussion included in the remaining chapters on discovery and deposition practice. They cogently explain preparing a deposition outline and offer insights, such as the

authors' five "Deposition Gets": "Get the facts," "Get the names," "Get the admissions," "Get ready for trial," and "Get to know the witness" (p.414). They include pithy advice on preparing one's own witnesses for deposition and a germane overview of the rules governing depositions generally, including objections at depositions. This chapter would have been even more useful had the authors included a sample 30(b)(6) deposition notice used in trademark or copyright litigation.

Chapter 9 on discovery disputes also contains helpful insights and forms appropriate to all types of litigation, including copyright and trademark litigation. The authors contrast the temptation to be needlessly contentious in discovery and thus driving up litigation costs with the benefits gained from seeking rapport with opposing counsel. The authors helpfully remind the reader that "[e]very communication with opposing counsel should be written with the understanding that it may come before the court" (p.426). The sample discovery objections, deficiency letters (also called "meet and confer" letters), and motion documents illustrate good litigation form. The forms avoid the all-too-common practice of issuing boilerplate objections and demonstrate discovery objections that are appropriately explained and tailored. They model the practice of seeking principled compromise through exchange of correspondence directed at supposed deficiencies in discovery responses. Further, the authors helpfully highlight how to deal with discovery issues that recur in many types of commercial litigation, including, for example, the tactic of seeking to force the deposition of senior company executives to effect settlement leverage and the use of protective orders. In the final chapter devoted to electronic discovery, the authors provide extensive practical advice for dealing with electronically stored documents in light of clients' obligations to identify and preserve their reasonably accessible electronic documents.

TRADEMARK AND COPYRIGHT LITIGATION succeeds as a work of reference that compiles a diverse and relevant sampling of litigation documents commonly used in trademark and copyright cases. Some of the forms will be instructive simply for the trenchant synopses of law contained therein. Some—especially the more basic trademark pleadings and discovery materials—could be adapted and used by practitioners where appropriate. But in this reviewer's opinion, TRADEMARK AND COPYRIGHT LITIGATION likely will find its highest and best use as a supplemental pedagogical resource for law professors and experienced practitioners seeking to educate students in the class or associates in the conference room about the practice of trademark and copyright litigation. Though it will not replace texts or casebooks covering the substance of trademark or copyright law or litigation procedures, this treasure trove of

litigation examples can serve to guide, stimulate, and educate those who would seek to become copyright and trademark litigators themselves.

## **ENDNOTES**

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<sup>1</sup> This text is from the book's back cover.

<sup>2</sup> MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 131-32, note 11 (2007) (rejecting "reasonable apprehension of imminent suit" as prerequisite to declaratory judgment action).

<sup>3</sup> Calder v. Jones, 465 U.S. 783, 788-89 (1984).

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