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TRADEMARK LAW

Protection, Enforcement and Licensing

Adam L. Brookman

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TRADEMARK LAW: PROTECTION, ENFORCEMENT AND LICENSING

Adam L. Brookman

Boyle Fredrickson, S.C.



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Trademark Law: Protection, Enforcement and Licensing

by Adam Brookman
Boyle Fredrickson, S.C.

Trademark Law: Protection, Enforcement and Licensing is a one-volume handbook that covers the major areas of trademark practice: selecting and adopting trademarks; perfecting, exploiting, and maintaining trademark rights; asserting and defending against trademark claims; and business issues in trademark ownership. *Trademark Law* approaches matters from the practical side, providing clear and concise explanations of every key topic, including trademark selection and registration, trade dress, conducting due diligence, and trademark infringement.

Highlights of the 2009 Supplement

The important matters covered by the 2009 Supplement are:

- A new section discussing “domaineering,” the practice designed to monetize domain names by purchasing common misspellings or variants of well-known marks, often on a large scale, then setting up semi-relevant Web sites that encourage an accidental visitor to the site to click on one or more advertising links.
- Updated appendix information on the Madrid Protocol participating countries.
- A new Appendix on Model State Trademark Bills.



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- Up-to-date discussions on the likelihood of confusion tests in each Circuit.
- Increased discussion on the advantages of Madrid Protocol filings.

The Table of Cases and Index have also been updated for the 2009 Supplement.

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ABOUT THE AUTHOR

Adam Brookman has been actively involved in the practice of trademark law for more than twenty years. During that time, he has filed and prosecuted hundreds of trademark applications to registration, been responsible for innumerable trademark transactions, and litigated many trademark and unfair competition cases. He is a former adjunct professor of trademark law at Marquette University Law School and a frequent speaker on trademark and other intellectual property issues. He is also listed in *Who's Who in America*. Mr. Brookman graduated from the Georgia Institute of Technology (Georgia Tech) with a degree in industrial engineering and obtained his law degree from George Washington University. He is a partner in the law firm of Boyle Fredrickson, S.C., in Milwaukee, Wisconsin.

INTRODUCTION

Before us on this appeal is a trademark infringement case. Review in this area of the law is similar to when those old-time radio comedians, Fibber McGee and Molly, opened their closet and out would pour a welter of miscellany from hub caps and baby carriages to broken umbrellas. The equivalent outpour in trademark law reveals complex statutory provisions, numerous factors that trial judges must consider and an appellate court review, definitions of the various kinds of marks, which overlap and shade into one another, and a jumble of adjectives describing the trademark review process.

— Judge Cardamone of the Second Circuit Court of Appeals in *Gruner & Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 26 USPQ2d 1583 (2d Cir. 1993).

As part of my practice, I spend a large portion of my time prosecuting, litigating, and giving advice on trademarks. I have always enjoyed the facial simplicity of trademark practice with its underlying nuances and complexity. The uninitiated see an apparently simplistic registration process (you don't even have to be an attorney to file and prosecute a trademark application), while those who have had occasion to test the breadth of a mark know the difficulties lying below the surface.

It was with this realization in mind that I wrote this book. I have done my best to present the complex in simple terms, ever mindful of the advice given to me when I first started practicing law, "Keep It Simple, Stupid" (KISS). My goal was to address the basic issues encountered in the practice of trademark law in the most practical terms. I have eschewed the lengthy history of the law in favor of what I hope are useful explanations of the state of the law today, the likely progression of the law tomorrow, and realistic advice based on my and others' experiences over the years.

The preparation of this book required the help of many others to whom I wish to offer my most sincere thanks. In particular,

John Vitek, of Wille, Gregory and Lundeen, is the principal author of the entire chapter on tax and trademarks. Without John's expertise, I would not have been able to address this topic appropriately. Similarly, my former partner Paul Lucey, now a shareholder at Michael, Best & Friedrich, shared his expertise by providing the bankruptcy chapter. I believe both chapters address complex areas of the law, rarely dealt with in the trademark context, in a useful and understandable manner.

Brian Gilpin, of Godfrey & Kahn, contributed substantially to the trademark adoption and new media chapters. His efforts saved me countless hours and provided welcome organization. Brenda Haskins and Bill McIntyre acted as my research assistants on several chapters. Cheryl Yeko made corrections, typed inserts, and provided invaluable editorial advice, while Lana Fleishman, whose writing I admire, allowed me to steal some of her prose in my efforts to thoroughly address the evolving issue of inevitable confusion. Jennifer Racine provided valuable assistance in the drafting of the section on foreign filing. And Dennis Cavanaugh, my former partner now with D H Cavanaugh Associates in New York, schooled me in the fundamentals of gray market goods which formed the basis for that section of this book.

This year, for the first time, I have been joined in my effort by Mollie Newcomb, a compatriot of mine at Boyle Fredrickson. Mollie deserves the credit for the bulk of the heavy lifting in this year's update. She provided valuable insight and a fresh take on many of the topics that are addressed in this book. Without her contribution, this update would not have had the degree of breadth and depth that it does.

Finally, and most importantly, I want to thank my family. While I was writing this book, my two oldest children, Anne and Steven, tolerated my days and nights spent in my lonely writer's garret, with good humor and only periodic recitation of my favorite question, "Aren't you done with that book yet?!" Occasionally, they even came to visit me to say "Goodnight." My then youngest son, David, f/k/a "Train Boy," provided enormous help by playing with his trains in front of my desk and offering me a steady stream of useful legal and writing advice. While I was working on the current update, my now youngest son, Joshua, a/k/a "The New Train Boy," gave me all kinds of support in words that I'm sure I'll understand someday. All of them, including my wife, Krista, have continued to encourage me to complete my updates on time, at the very least, to get back to the various activities ("chores") that they each have planned for me.

In closing, I would simply like to say, "Yes, I'm done with that update now!"

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