

## [Updates](#)

September 01, 2020

Brand Sustainability: Practical Considerations for Creating IP Enforcement Programs



This summer, we have provided information on [supply chain and forced labor risks](#), [proper substantiation of green advertising claims](#), [alternative corporate forms to promote sustainability efforts](#), [understanding a public company's sustainability disclosure drivers, obligations, and options](#), and [developing and registering trademarks that communicate business commitments](#). Now, it is time to protect the company's goodwill by policing and enforcing trademarks and other intellectual property.

In this final issue of the Summer Sustainability Series, we address important considerations in designing and implementing an enforcement program.

### **Combatting Trademark Infringement and Counterfeiting**

A trademark is any word, symbol, or design used in commerce that identifies the trademark owner as the single source of goods and/or services. Trademark infringement occurs when others use a word, symbol, or design that is confusingly similar to the owner's trademark, causing consumers to think that the other's goods or services are associated or affiliated with or sponsored by the trademark owner. Trademark counterfeiting involves the use of a word, symbol, or design that is identical to the owner's trademark. If the trademark is federally registered, counterfeiting carries more serious penalties, including enhanced statutory damages.

When designing an enforcement program, it is important to think about answers to each of these key questions:

1. **What Are the Goals?** While stopping the infringement and/or counterfeiting is the most obvious and immediate objective, consider what else the business hopes to achieve. For example, it may be important to identify the source and manufacturer of the counterfeit goods, particularly where the counterfeit goods do not meet the brand's sustainability standards. Other goals may include generating positive press around the brand, dissuading other infringers, and recovering monetary damages. Having clear goals is critical not

only to designing the program and prioritizing targets but also measuring success.

2. **Is the Company Prepared?** Take stock of all brand assets including common law and registered trademarks, copyrightable materials (for example, videos, product photos, etc.), and other intellectual property that bad actors may attempt to leverage. Are the necessary registrations and rights in place? If not, get the house in order before beginning the enforcement program. Next, take stock of enforcement resources and needs and determine what, if any, additional resources are needed. Will someone on the team be primarily responsible for identifying potential infringement/counterfeiters? Or will an outside service identify and take down infringers? If there is an escalation for noncompliance, it is important to know who takes responsibility and what that path will look like. Will the trademarks be registered with U.S. Customs and Border Protection? And, for those refining an already existing strategy, are there key areas outside the United States where enforcement should be considered?
3. **What Are the Enforcement Priorities?** To combat counterfeiters, determine what causes the most pain for the brand as well as where you think you can have the biggest impact (keeping in mind the goals) and prioritize those targets. Counterfeiters are always out there. The goal is to cause them enough pain that they move on to easier targets, while, at the same time protecting the brand's goodwill. For infringement that does not rise to the level of counterfeiting it is important to ensure that new entrants are not adopting brands or marks that cause confusion or that attempt to ride on the coattails of the business's success and investment. Developing an enforcement matrix building on the goals identified in response to Question 1 is often an effective strategy.
4. **Are the Enforcement Tools Appropriate?** There are numerous brand enforcement tools, from classic cease and desist letters directly to infringers, to more indirect methods. For example, consider indirect attacks including sending takedowns to the hosts of websites where infringing/counterfeit goods are sold, as well as to platforms that allow sales by third-party sellers. Also, consider leveraging other intellectual property assets, such as copyrighted product photos, by submitting a takedown request under the Digital Millennium Copyright Act. If the infringer is using your trademark in their domain name, consider a complaint filed under the Uniform Domain Name Dispute Resolution Policy. If all else fails, litigation is an option.

## Keep Values Top of Mind When Designing an Enforcement Program

The business worked hard to create a brand that reflects the company's values: sustainable and socially conscious. In crafting an enforcement strategy, it is important to keep these values top of mind. One-size-fits-all, aggressive strategies are frequently ill-advised. At Perkins Coie, we work with our clients to devise programs and strategies that not only protect the brand but seek to minimize controversy in the market.

Below are some considerations to keep in mind while working through designing and implementing an enforcement program:

- **Speak With One Voice.** Educate employees on who to talk to internally regarding potential infringement and who will take ownership of these issues. Avoid situations where, for example, customer relations tells a customer his or her activities are acceptable and then legal sends that customer a cease and desist letter. Be consistent in outside communications and use the business's goals as a guide.
- **Choose Targets Wisely.** Infringement and infringers are not all the same. Careful and thoughtful investigation can separate the truly bad actors who are seeking to profit from a company's investment or who pose the highest risk to brand goodwill from those whose infringement may be less nefarious. Using the goals can help in sifting through and prioritizing targets.
- **Curate the Response.** Once the target has been chosen, search the arsenal of enforcement tactics to choose effective tools. Filing a lawsuit against a mom-and-pop shop inadvertently infringing a company's green brand may garner negative PR and customer blowback. Consider a lighter touch, like a business outreach in the form of a phone call or email. Finally, reserve legal action for repeat offenders and truly

bad actors.

- **Know Before Choosing to Go.** Businesses should do their homework to understand how enforcement efforts have been perceived in popular press and trade media as well as their community. Has a competitor tried a similar strategy and received bad press? Consider this before choosing to proceed.
- **Write Every Communication as Though It Will Go Viral.** Every external email and letter should be thoroughly vetted so it maintains the brand's image and values, even if published widely. Do not be surprised if a cease and desist letter or other communication is posted online by its recipient.

Finally, consider the budget. Overzealous enforcement may lead to a strain on resources. Prioritize key targets in jurisdictions where actions are likely to be effective. This will help maximize efforts and efficiently use resources, which is what sustainability is all about!

© 2020 Perkins Coie LLP

## Authors

## Explore more in

[Trademark, Copyright, Internet & Advertising](#) [Outdoor](#) [Retail & Consumer Products](#)

## Related insights

Update

[\*\*California Court of Appeal Casts Doubt on Legality of Municipality's Voter ID Law\*\*](#)

Update

[\*\*February Tip of the Month: Federal Court Issues Nationwide Injunction Against Trump Executive Orders on DEI Initiatives\*\*](#)