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Nastygrams Can Backfire on Trademark Owners

Brand owners should consider benefits, consequences, and alternatives of trademark enforcement cease-and-desist letters.

Trademark owners have a duty to monitor and enforce their trademark rights by identifying and stopping unauthorized uses. Cease-and-desist letters (commonly referred to as “nastygrams”) can be an inexpensive way to resolve many trademark issues, but recent reactions to publicized letters illustrate that they may not be a “one size fits all” enforcement tool.

For example, this spring Louis Vuitton sent a nastygram to the University of Pennsylvania Law School’s Intellectual Property Group for parodying Louis Vuitton trademarks in a flyer publicizing the group’s fashion law symposium. [The flyer](#) modified Vuitton’s famous monogram pattern to include “TM” for trademark instead of “LV.” Vuitton’s attorney alleged the use constituted infringement and dilution of Vuitton marks and demanded the school group to cease use of the Vuitton mark in the flyer. Penn Law School rejected Vuitton’s demands and continued to promote the symposium, and the spectacle ultimately brought more attention to the flyer than it would have received otherwise and brought negative publicity to Louis Vuitton, reinforcing Vuitton’s reputation as a trademark bully.

Louis Vuitton is not the only brand owner to be tried in the court of public opinion after sending a cease-and-desist letter. Chic-fil-A’s nastygram to a Vermont business that alleged the slogan “Eat More Kale” infringed on the fast food chain’s “Eat Mor Chikin” trademark has resulted in public backlash, with thousands of people signing petitions against Chic-fil-A and the Vermont governor promoting the “Eat More Kale” trademark owner’s legal defense fund.

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To the extent that trademarks are designed to further a brand's goodwill, negative publicity resulting from a trademark row can undermine a brand owner's goals. In a [Wall Street Journal blog article](#) on the Chic-fil-A spat, Wendy Seltzer, the founder of Chillingeffects.org—a site that posts cease-and-desist letters online—seized on this point: "Trademarks are meant to protect your image, so it doesn't really help to look like you're coming down hard on the little guy."

Takeaways for Trademark Owners

Negative publicity is just one consideration that trademark owners should discuss with legal counsel before selecting an infringement strategy. Good legal counsel will evaluate the owner's scope of trademark rights, the nature of the unauthorized use, as well as practical concerns, such as publicity. Where there is a high probability of confusion between a trademark and an unauthorized use, any risk of negative publicity may be outweighed by the potential benefit of sending a well-tailored letter that ends the unauthorized use.

Trademark owners should not send a cease-and-desist letter unless they are prepared to take the threatened action, because if they do not take timely action after sending a letter, they may become vulnerable to laches and acquiescence defenses. Further, trademark owners should be aware that cease-and-desist letters have the potential to trigger immediate litigation in an inconvenient venue. For example, an accused infringer that has grounds to believe that the trademark owner's mark is unenforceable can initiate a declaratory judgment action in a venue that is disadvantageous to the trademark owner.

In some situations, trademark owners should consider alternatives to cease-and-desist letters. For example, in situations where the strength of a trademark infringement allegation is not clear, litigation is not desirable, or the owner does not want to face the possibility of negative publicity, sending a letter or placing a phone call that simply seeks information on how the alleged infringer is using the mark and when the

use began—without making bold infringement accusations or threats of legal action—can be an effective way of gauging the strength of a claim and opening communication lines for an amicable resolution.

These are just a few considerations that trademark owners should discuss with legal counsel before proceeding with an enforcement strategy.

For more information about monitoring and enforcing your trademark rights, or for any questions about your intellectual property, contact [John C. Rake](#) (pictured below) or Randy Duncan at 503.242.0000.

