Tucker Ellis LLP

Trademarks

Overview

At Tucker Ellis, we counsel our clients to help them make informed business decisions in the adoption, protection, and enforcement of their brands. We develop well-formulated trademark strategies that further enhance our clients' intellectual property portfolios and bring added value to their companies.

Trademarks can be words, names, scents, sounds, symbols, or even devices as long as they identify and distinguish a company's goods and services by indicating the source. Because consumers readily identify a certain level of quality with purchased goods and services, trademarks are vital to a company's brand and business to distinguish its product offerings from those of its competitors. While our clients often seek trademark protection for their brand names and logos, our trademark team also assists them with nontraditional marks such as trade dress, including product packaging, product configuration, and color marks – providing protection for a potentially infinite amount of time.

We listen closely to our clients to glean information about their marks and use so that we can develop a trademark protection strategy tailored for a specific geographic region and facilitate filings and protection. Before adopting a new brand or pursing protection on a mark, our experienced team performs trademark screening and clearance to determine whether a mark or brand can be used as desired or if a new direction should be pursued to avoid other established trademarks. We have extensive experience with filing and prosecuting federal trademark applications with the U.S. Trademark Office, securing trademark rights at the state level, and evaluating common law trademark rights in geographic areas where unregistered marks are used.

The Tucker Ellis team is experienced in all of the various stages of enforcement – from sending cease and desist letters, to opposition filings with the U.S. Trademark Office, to preparing and filing complaints with state or federal courts. Our trademark enforcement strategies have successfully precluded third parties from using, infringing, and misappropriating trademarks. Our clients can choose from a variety of avenues of enforcement so that our legal strategy aligns with their business goals and cost concerns. Our team also has pioneered successful techniques to enforce trademark rights in third-party marketplaces – including Amazon® and eBay® – where stopping illegal activity is often daunting. In addition to our proprietary techniques used to stop illegal trademark activity, our team can thwart trademark infringers through requests made to web hosts or website platforms of third-party marketplaces.

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The depth of experience brought by our experienced team of IP attorneys helps clients understand the complexities of the trademark process and provides peace of mind in protecting their valuable brands.

WTR 1000 – the World's Leading Trademark Professionals ranks Tucker Ellis in United States: California in the categories of "Firms: Prosecution and Strategy and Firms: Enforcement and Litigation." The firm is also ranked in Ohio. *WTR 1000* notes, "Tucker Ellis enjoys a prominent reputation for its trademark expertise, built on a foundation of robust enforcement strategies and the maintenance of prominent brands across the country. With a keen business perspective at its core, the ensemble prioritizes understanding business goals and clients' marketplaces, providing effective counsel and a competitive edge."

Experience

- In an action alleging infringement of purported trade dress in an ultraviolet lamp, obtained summary judgment by establishing lack of trade dress protection
- Successfully represented the manufacturer of a famous hot sauce in a trademark infringement and breach of contract action
- Represented a jewelry designer in a counterfeiting action against a jewelry retailer for the sale of one ring; obtained judgment for $200,000 and permanent injunction
- Represented an eyeglasses manufacturer in a trademark and copyright infringement action against a direct competitor; successfully resolved the matter through settlement
- Represented a professional sports team in a trademark infringement lawsuit in the Eastern District of Missouri resulting in consent judgment against defendant
- Represented a restaurant franchise in connection with a trademark and trade dress action against a competitor; obtained both preliminary and permanent injunctions against the competitor's use of the trademarks and trade dress
- Represented a frozen dessert franchise in a trademark and service mark action; obtained stipulated judgment and permanent injunction
- Successfully defeated a request for a temporary restraining order against a sporting goods manufacturer based upon alleged trademark infringement resulting in dismissal of all asserted claims for infringement
- Obtained summary judgment in favor of a custom motorcycle manufacturer in a trademark infringement action related to its branded clothing and logo; decision affirmed on appeal
- Defended a bank in a trademark infringement action in the U.S. District Court of the Middle District of Tennessee; the matter settled favorably for client with the ability to continue using the name
- Represented a charitable organization for families in crisis against claims of trademark infringement; matter resolved favorably for client with the ability to continue using the brand

- Represented an international toy company in a claim of trade dress violation; case settled quickly after asserting the claim
- Represented an international toy company in a claim of infringement by a web-based seller that was allowing counterfeit goods to be sold; obtained a crucial ruling on the issue of jurisdiction and seller's liability for allowing the sale of infringing articles, leading to a favorable settlement for client
- Represented a healthcare company in defense of its trademark; judgment entered in favor of client that allowed for continued use of mark
- Represented a shoe manufacturer in a trade dress infringement, dilution, and unfair competition action; obtained favorable judgment for client stating that client owns distinctive trade dress in its footwear and packaging