



## VVM Trademark Updates

### Autumn 2017

*VVM Trademark Updates is a newsletter issued by the Trademark Group at Vanek, Vickers & Masini, P.C. The purpose of this newsletter is to keep in touch with our clients, colleagues and friends, as well as to provide relevant information regarding recent developments in Trademark and Intellectual Property law.*

*Please share this newsletter with anyone who may be interested.*

### Trademark News

#### **PLAYING NICE**

The topic of this issue of *VVM Trademark Updates* may sound like an oxymoron. A **nice lawyer**? Yes, lawyers are not generally known as “Nice Guys,” but at VVM, we have been on the hunt for stories of kindness amidst the sea of hostile and tragic stories plaguing our headlines today. And we suspect you are too. So, it was a pleasant surprise to find the following stories about niceness in the legal world.

#### **A NICE LAYWER? I’VE SEEN STRANGER THINGS.**

In August of this year, Emporium Arcade Bar opened a *Stranger Things* themed pop up bar in Chicago’s Logan Square neighborhood that drew a lot of attention and huge crowds. The bar, called “The Upside Down,” featured décor, props and cocktails inspired by the hit Netflix series, *Stranger Things*.

However, since Emporium did not secure a licensing agreement from Netflix prior to launching the concept bar, the Chicago attraction also drew the attention of a less desired patron...Netflix’s IP lawyer. The streaming service’s lawyers, however, put an “Upside Down” spin on the typical cease and desist letter, which usually begins with phrases such as “It has come to our attention that you have used our client’s intellectual property without permission, which constitutes a violation of...”

Rather, Netflix’s cease and desist begins:

*My walkie talkie is busted so I had to write this note instead. I heard you launched a Stranger Things pop-up bar at your Logan Square location. Look, I don’t want you to think I’m a total wastoid, and I love how much you guys love the show. (Just wait until you see Season2!) But unless I’m living in the Upside Down, I don’t think we did a deal with you for this pop-up.*

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#### **VVM Intellectual Property Services**

Trademark Prescreens (US and Int’l)

Design Prescreens (US and Int’l)

Search & Clearance (US and Int’l)

Trademark Registration (US and Int’l)

Trademark Maintenance (US and Int’l)

Trademark Litigation (US and Int’l)

Trademark Watch Services (US and Int’l)

Copyright Registration

Domain Acquisition

Licensing Services

Contract Services

Corporate Services

The letter continues:

*We're not going to go full Dr. Brenner on you, but we ask that you please (1) not extend the pop-up beyond its 6 week run ending in September, and (2) reach out to us for permission if you plan to do something like this again.*

The letter ends with one singular threat:

*So please don't make us call your mom.*

In nearly 20 years of practice, I haven't read or penned an intention to tattle as a remedy for IP infringement, but guess what? In this case, it worked. Emporium acquiesced to Netflix's demands and Netflix also garnered some complimentary press in response to their reaction to this clear violation of IP rights.

While a violation of copyright or trademark rights frequently requires a legal warning backed by the strength of the Demogorgon, there are occasions when a firmly worded but polite correspondence can also do the trick. It makes sense. After all, didn't mom teach us to say *please*?

## I'VE ALWAYS RELIED ON THE KINDNESS OF STRANGERS.

While we aren't certain which brand of whiskey Blanche DuBois favored most, one of our favorite brands may have originated the non-traditional cease and desist letter. Jack Daniel's is well known for its attorneys' polite, complimentary and even empathetic cease and desist letters.

The JACK DANIEL'S brand and iconic saloon-style black and white label are frequent targets for impersonation by parties attempting to benefit from the notoriety of the JACK DANIEL'S name, as well as fans who want to pay homage to the famous label. Jack Daniel's IP attorneys have gained attention in the legal community for going to great lengths to determine the intent of these infringers. As a result, in the situation where a fan or unintentional infringer has violated the company's IP rights, Jack Daniel's lawyers frequently utilize a "polite" cease and desist letter. Below is a sample of notable phrases Jack Daniel's lawyers turned in favor of civility.

*We are certainly flattered by your affection for the brand...*

*...while we can appreciate the pop culture appeal of Jack Daniel's, we also have to be diligent to ensure that Jack Daniel's trademarks are used correctly.*

*What may not be so apparent...is that if we allow uses like this one, we run the very real risk that our trademark will be weakened.*

*As a fan of the brand, I'm sure that is not something you intended...*

Jack Daniel's attorneys have also been known to allow a reasonable time to change an infringing product's name or design and, in some cases, even offer to contribute a reasonable monetary amount to assist in the rebrand. While not all infringements of the JACK DANIEL'S brand are addressed in this manner, we commend the company's foresight in knowing that 1) it is good marketing to not alienate fans of a brand and 2) it is good professional practice to assume that anything written may reappear on one or more social media outlets. Such polite cease and desist letters can actually serve as good publicity...as well as exemplify good southern manners.

## WHAT A NICE SONG.

*Trademark Genericide.* The name itself sounds as scary as the lawyers who try to defend against it. Despite how it sounds, *Genericide* is not the name of a new Halloween slasher movie. Rather, *Genericide* is used to describe a trademark that, due to its popularity or significance, has become the generic name for the product. Some examples include ASPIRIN, THERMOS, ESCALATOR, TRAMPOLINE and CELLOPHANE. All of these terms were once trademarks, but are now the common, generic names to describe these products. Once a trademark is deemed generic in this way, it is legally considered abandoned. So for brand owners, the name is actually as scary as it sounds.

As a result, IP lawyers will sometimes go to drastic measures to ensure their company's trademark does not suffer the fate of *genericide*. In a unique legal move, the attorneys for VELCRO® moved beyond written legal notices against *genericide*, and instead brought their message to song. While this may not be the most genteel of notices we have come across (they *do* repeatedly sing (and bleep) the "F" bomb), it is definitely one of the most entertaining. I mean, in legal humor, this registers a 10. Take a look/listen: <https://www.youtube.com/watch?v=rRi8LptvFZY>.

While the success of this campaign is yet to be seen, it is *so nice* to see attorneys trying something so new...and catchy.

## I GUESS THEY CAN'T ALL BE NICE.

Let's be honest. Clients do not want a lawyer who is always nice. So, we end this issue of the VVM Trademark Newsletter with an anecdote that goes even beyond that. In June of 2016, a trademark lawsuit was brought to stop a defendant...from saying THANKS.

Citigroup, which owns a number of federal trademark registrations that include the term THANKYOU, filed a trademark infringement lawsuit in federal court against AT&T due to its use of the term THANKS in AT&T's loyalty rewards programs. See *Citigroup, Inc. v AT&T, Inc. et al, US Dist. SDNY, No. 16-04333*. AT&T promptly counter-claimed that Citigroup did not have exclusive trademark rights to the THANKS term.

The lawsuit spurred not only scholarly debate as to the rational of the US Trademark Office's registration of the THANKYOU term in the first place, but also a host of negative publicity for Citigroup with headlines such as "No Thanks, Citigroup," "Citigroup Sues AT&T for Having Good Manners" and "Who Knew? I can't say Thank You!" In August, 11 days after Citigroup's request for a preliminary injunction was denied, Citigroup voluntarily dismissed its complaint with prejudice. Maybe this resolution was made 1) to offset negative public reaction to the suit, 2) to preserve Citigroup and AT&T's partnership of providing co-branded credit cards, or 3) as an understanding that the world just works better when we all play nice.

It was probably 1 or 2.

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