

I Found An “I-Dentical” (or Similar) Trademark! What Now?

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“I-dentical.” With a clap for emphasis and a wave of two hands, this phrase became one of the more memorable quotes from a trial. Although, in this case, it was a trial made for Hollywood, where Joe Pesci, a New York attorney, represents his cousin and a friend in their defense against murder charges in rural Alabama. It’s the beloved movie, *My Cousin Vinny*.

The film is notable for many reasons, but the prosecutor’s hilarious use of “i-dentical” to compare the skid marks at the scene of the crime and the tires on the cousin’s vehicle is especially memorable. While protection and enforcement of trademark rights have little to do with the expert comparison of tires and their *skid marks* as it did in *My Cousin Vinny*, they do involve “i-dentical” *trademarks*, and even trademarks that are simply *similar*.

When the U.S. Patent and Trademark Office (USPTO) considers an application for federal registration of a trademark, or when a court reviews whether one trademark infringes upon another, the central consideration is whether consumers are likely to be confused. This likelihood of confusion test involves several factors, including the similarities of the appearance of the trademarks, the goods and/or services, the consumers, and the trade channels.

Clients often identify unauthorized use of their trademark that is likely to cause consumer confusion. However, our team can also assist with engaging third-party services that monitor U.S. and international trademark offices, as well as the internet, for similar (or identical) trademarks that may infringe a client’s prior trademark rights.

Once a confusingly similar trademark is identified, there are several channels to enforce prior rights in a trademark as part of a comprehensive trademark enforcement plan, including:

Cease-and-Desist Letters and Federal Court Actions. A cease-and-desist letter is often the first step in asserting prior trademark rights. Such letters put the newcomer on notice of your rights in the trademark and threaten legal action if the infringer does not comply with the letter’s demands. Cease-and-desist letters can be effective at quickly ending the unauthorized use of a trademark.

If an unauthorized user ignores the demands or refuses to cooperate, it may be necessary to escalate the matter and file a trademark infringement action in federal court. A successful trademark infringement action can result in injunctive relief that prohibits the infringer from using the trademark and may include a damages award and costs. In certain circumstances, the award may include attorneys’ fees and treble damages.

Letters of Protest and Trademark Trial and Appeal Board Proceedings. If the unauthorized use is the subject of a federal trademark application or registration, the USPTO also offers mechanisms to challenge the registration of the trademark. For an application under review by the USPTO, there is an option to submit a letter of protest. This action brings the application to the USPTO's attention, and the USPTO may issue a refusal to register the trademark if it agrees with the evidence set forth in the letter of protest.

In some situations, however, it is preferable to wait until the application publishes, at which time an opposition proceeding may be filed with the Trademark Trial and Appeal Board (TTAB). If, however, an infringing trademark is identified at the USPTO following registration, the required proceeding is a cancellation proceeding, rather than an opposition proceeding. Opposition and cancellation proceedings include similar procedural aspects to federal court litigation but are often more efficient and cost-effective. If an opposition or cancellation proceeding moves forward to completion and is successful, the application will be denied registration in an opposition proceeding, and the registration will be canceled in a cancellation proceeding.

Notwithstanding, TTAB proceedings can also be an invaluable tool to initiate discussions with the unauthorized user regarding parameters for the unauthorized user's use of a trademark to avoid consumer confusion. In certain circumstances, this approach may offer a preferable business resolution.

Social Media Takedowns. Major social media platforms, such as Facebook, Instagram, and X, as well as many minor social media sites, provide a process to submit a takedown notice to remove an unauthorized use of a trademark from the social media site. While some of these platforms, such as Facebook and Instagram, generally require a federal trademark registration to review a takedown notice, clients who identify an unauthorized use of their trademark on a social media site should consider this option. The form for submitting the takedown notice is often short, making this an efficient means to eradicate infringing trademarks on social media sites. Furthermore, representation by an attorney can assist clients in navigating any pushback that may be received from such social media platforms.

Customs Enforcement. Clients who are concerned about the importation of goods bearing an infringing trademark and have registered the trademark with the USPTO may record the federal trademark registration with the U.S. Customs and Border Protection (CBP). Through this program, the CBP may detain, seize, forfeit, and destroy products entering the U.S. that bear an infringing trademark. The costs to join this program are minimal and can serve as a key defense against the sales of goods bearing an infringing or counterfeit trademark in the U.S.

Identification of an "i-dentical" or similar trademark often results in the same type of lightbulb moment that the attorney in *My Cousin Vinny* hoped to evoke in the jury. Oftentimes, the realization that the brand and its reputation are being diminished by the unauthorized use can result in annoyance and even panic. Although certainly frustrating to a trademark owner, there are numerous options, as outlined, to enforce one's prior rights in its trademark to protect consumers from confusion. Each approach is part of a comprehensive trademark enforcement plan that can strengthen the brand and its reputation.

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