

#TRADEMARKBULLY... WHO ME? A PRACTICAL GUIDE FOR ATTORNEYS ON HOW TO AVOID THE LABEL

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Being called a #trademarkbully on social media happens and can be very problematic for trademark owners. However, certain cease and desist letters are effective at avoiding the #trademarkbully label and others are not. This article advises trademark attorneys on how to draft cease and desist letters that may avoid the #trademarkbully label. The following nine elements are common among some of some of the more notable trademark cease and desist letters that are praised by the media as being excessively kind: (1) informal or funny salutations; (2) generous lead time to cease the infringing activity; (3) offers something of value; (4) compliments the target; (5) flexible response date; (6) written in brand voice; (7) no legalese, no citation to caselaw or statutes, and no threat of legal action; (8) no boasting about client's prominence; and (9) no USPTO registration information.

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INTRODUCTION

A trademark owner must walk a fine line between being too zealous in enforcing its rights and not being zealous enough. The stronger a mark and the more goodwill that attaches to it, the more

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aggressive an owner is expected and entitled to be in asserting its rights against others.¹

The above quote has some truth to it, but larger trademark owners must be cautious in light of recent trends where smaller businesses defend themselves by appealing to public sentiment and shaming the larger business on social media. This article is written from the perspective of the corporate attorney who represents the larger corporation in a trademark dispute and assumes that the reader has at least a general understanding of trademark rights and some awareness of the “trademark bully” smear tactic being used by *pro se* trademark infringers. This article contains original research in the form of interviews with managers of businesses that have been threatened by large companies for using their trademarks, as well as with an attorney who wrote one of the most successful cease and desist letters in the public domain. In that way, this article brings something completely unique to legal scholarship.

Crying #trademarkbully is one way that small businesses can defend against trademark owners seeking to police the misuse of their trademark rights. The #trademarkbully label on social media can be embarrassing to attorneys and can prevent trademark owners from seeking preliminary enforcement action against infringement targets. In turn, this can prevent trademark owners from policing their trademark rights and can therefore increase the likelihood of trademarks becoming generic.

To date, most scholarly articles on the trademark bullying issue illustrate how shaming trademark owners can be an effective means to defend against trademark infringement. This existing body of work has likely increased the number of small organizations that cry #trademarkbully on social media. While these strategies may be beneficial to smaller organizations, little scholarly work exists to assist trademark owners in mitigating the likelihood that a #trademarkcrier labels them a #trademarkbully on social media.

This article has two interrelated goals: (1) to suggest and compile ways that trademark owners, and their attorneys, can draft cease and desist letters that will avoid the #trademarkbully hashtag on social media; and (2) to present effective means of responding to the #trademarkbully accusation over the phone or email. For illustrative purposes, Part I begins with the story of the TACO TUESDAY® registration mark that demonstrates the transformation of an every-day cease and desist letter into a 2019 fashionable trademark bully smear campaign that made national news.² Part II summarizes previous scholarly work regarding the

¹ U.S. DEPT. OF COMMERCE, REPORT TO CONGRESS ON TRADEMARK LITIGATION TACTICS AND FEDERAL GOVERNMENT SERVICES TO PROTECT TRADEMARKS AND PREVENT COUNTERFEITING (2011).

² See *infra* notes 9–18 and accompanying text.

effectiveness of the #trademarkbully hashtag on social media.³ Part III explains why cease and desist letters do not need to contain legal statements and also suggests factors that may lead to the #trademarkbully label.⁴ Part IV analyzes the section-by-section differences in cease and desist letters labeled #trademarkbully by small businesses and the media vs. cease and desist letters that are praised⁵ by small businesses and the media.⁶ Part V offers advice on how to respond when an infringer uses the “trademark bully” label over the phone or email.⁷

I. BACKGROUND ON HOW AND WHY TRADEMARK OWNERS ARE LABELED #TRADEMARKBULLY USING THE TACO TUESDAY® EXAMPLE.

A trademark may be cancelled if the trademark owner “does not control, or is not able legitimately to exercise control over, the use of such mark.”⁸ For example, the TACO TUESDAY® registration mark was awarded to Taco John’s Seasonings Limited Partnership (“Taco John’s”) on December 19, 1989.⁹ Taco John’s is a Mexican quick-service restaurant brand based in Wyoming that has been in operation since 1969.¹⁰ As of 2019, Taco John’s operates and franchises nearly 400 restaurants in 23 states¹¹ and is listed as the 183rd largest franchise in America, ahead of household name franchise restaurants like Sizzler and Weinerschnitzel.¹²

Taco John’s has garnered negative publicity because it was labeled a #trademarkbully on social media as a result of policing its TACO TUESDAY® trademark.¹³ A summary of the situation goes like this: Taco John’s becomes aware of another company (most likely a restaurant or bar) using the phrase “Taco Tuesday” to promote discounted tacos for sale on Tuesday. Taco John’s sends the following cease and desist letter to the infringing company, which appears to be written in a professional tone:

³ See *infra* notes 29–35 and accompanying text.

⁴ See *infra* notes 36–45 and accompanying text.

⁵ Certain cease and desist letters are effective at avoiding the #trademarkbully label and others are not. Letters that received positive media attention for being excessively kind are referred to as “praised” letters.

⁶ See *infra* notes 45–70 and accompanying text.

⁷ See *infra* notes 72–82 and accompanying text.

⁸ Lanham Trade-Mark Act, 15 U.S.C. § 1064(5) (2016).

⁹ TACO TUESDAY, Registration No. 1,572,589.

¹⁰ TACO JOHN’S, <https://tacojohnsfranchise.com> (last visited Oct. 21, 2019).

¹¹ TACO JOHN’S, <https://tacojohns.com/company/history> (last visited Oct. 21, 2019).

¹² Franchise Times, Top 200+, THE LARGEST FRANCHISE SYSTEMS BASED IN THE UNITED STATES ACCORDING TO GLOBAL SYSTEMWIDE SALES, <https://www.franchisetimes.com/Top200-2019>. October 21, 2019 (follow hyperlink).

¹³ Jenny G. Zhang, *Your Community Taco Tuesday Could Come with a Cease-and-Desist from Taco John’s*, EATER (Aug. 14, 2019, 4:40 PM), <https://www.eater.com/2019/8/14/20806047/taco-tuesday-taco-johns-trademark-controversy>.

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Dear Sir or Madam:

Recently I became aware that Freedom's Edge Brewing Company is using the phrase "Taco Tuesday" to advertise a daily facebook [sic] special.

The purpose of my letter is to let you know that Taco Tuesday® has been a federally registered service mark of our affiliate, Taco John's Seasonings Limited Partnership, since 1989. We certainly appreciate our fellow community member's enthusiasm for tacos on Tuesday and the term is often used inadvertently. However, it is still extremely important to us to protect our rights in this mark because it is a distinctive and important representation of the origin of our products and services and also of the goodwill of our company.¹⁴

Thereafter, the target takes a picture of only the first half of the cease and desist letter and posts it to their company's social media page.¹⁵ The target then has some disparaging words to say about Taco John's in an effort to persuade sympathetic followers to engage with the post.¹⁶ A media frenzy ensues, the cease and desist letter goes viral, and Taco John's is shamed as a corporate #trademarkbully.¹⁷

This scenario raises a legal and social conundrum for Taco John's and their franchisees—either stop policing TACO TUESDAY® and run the risk of losing the mark due to it becoming generic, and thus joining the ranks of former brands like Escalator,¹⁸ or send a seemingly professional cease and desist letter and suffer the effects of negative publicity by being shamed on social media. No doubt this is punishment for registering a great trademark. Although the Taco John's attorney likely intended to draft the letter in a professional tone and with good intentions, the letter contains several elements that might have led the target to shame it on social media. Those elements are described below in Section III and IV(C)(2). This also why it is beneficial for attorneys to consider the nine common elements of the Fab Four Letters analyzed below in Section IV.

¹⁴ Freedom's Edge Brewing Company (@FreedomsEdgeBrewing), FACEBOOK (July 30, 2019, 12:09 PM), <https://www.facebook.com/FreedomsEdgeBrewing/photos/a.541274939292094/2335567686529468>.

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Haughton Elevator Co. v. Seeberger (Otis Elevator Co. Substituted)*, 85 U.S.P.Q. 80 (Dec. Comm'r Pat. 1950).

A. *Interview with a Manager from Freedom's Edge Brewing Company*

During an interview with a manager from Freedom's Edge Brewing Company (one of the small businesses that received the above mentioned Taco John's cease and desist letter),¹⁹ the manager explained the action that prompted their advertisement for "TACO TUESDAY" was a taco truck that sat out in front of the brewery.²⁰ Freedom's Edge is a small brewery with only a handful of employees and does not sell food,²¹ let alone tacos.²² When the Taco John's letter arrived, the manager observed that the Freedom's Edge employees were intimidated and scared.²³ The employees were worried about being taken to court over something they felt was "silly and trivial."²⁴ The manager thought that people who work in big businesses are accustomed to receiving letters from attorneys, but the small Freedom's Edge operation is not.²⁵

The manager said that Freedom's Edge posted the Taco John's letter on their Facebook page merely in jest.²⁶ The manager also said that after posting the letter, she and the employees were comforted to see all the support for the brewery and that helped them to feel that the "TACO TUESDAY" mistake was not as big of a deal as they initially thought.²⁷ The manager also felt that posting the letter was a double edge sword, because some people posted negative comments thinking it was petty for Freedom's Edge to post the letter.²⁸

¹⁹ Telephone Interview with Anonymous Manager, Freedom's Edge Brewing Company (Oct. 24, 2019). The source's name is kept anonymous for personal reasons.

²⁰ Mead Gruver, *Taking the Fun Out of 'Taco Tuesday'*, VALLEY NEWS (Aug. 20, 2019, 10:00 PM), <https://www.vnews.com/Company-stirs-debate-with-defense-of-Taco-Tuesday-trademark-27863793>. ("Taco John's last month sent a warning to a brewery five blocks from its national headquarters for using the term to advertise a taco truck that parks outside its establishment once a week.").

²¹ *Id.*

²² Bill Bostock, *'Taco Tuesday' is Actually Trademarked, and Harshly Policed with Legal Threats from a Taco Chain Based in Wyoming*, BUSINESS INSIDER (Aug. 14, 2019, 5:13 AM), <https://www.businessinsider.com/taco-tuesday-trademark-taco-johns-legal-woes-2019-8>. ("We have nothing against Taco John's but do find it comical that some person in their corporate office would choose to send a cease and desist to a brewery that doesn't sell or profit from the sales of tacos.").

²³ Telephone Interview with Anonymous Manager, *supra* note 19.

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.*

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II. THE PROBLEM: SHAMING A TRADEMARK OWNER CAN BE AN EFFECTIVE MEANS TO DEFEND AGAINST INFRINGEMENT

A. *Why Infringing Businesses Cry #Trademarkbully*

To understand trademark bullying, one must first understand why an infringing business is more likely to cry #trademarkbully on social media than to respond in a professional manner. Previous scholarly work indicates that small businesses lack the funds to afford legal counsel to respond to cease and desist letters, let alone to litigate.²⁹ The motivation likely runs much deeper than avoiding litigation expenses. Attorneys who represent large corporations need to understand that for every small business they are opposing, there likely exists an entrepreneur behind the scenes. The entrepreneur may feel that they have risked “everything” to build their business. A standard cease and desist letter typically sent to other attorneys may put the entrepreneur in a perceived position of weakness and vulnerability.

The entrepreneur probably lacks the financial resources to seek legal advice, so they may be placed in reaction mode upon receipt of a cease and desist letter and be forced to strike back. There is no case law that definitively states what is and what is not trademark bullying. However, when at war in a trademark dispute, each side is entitled to use all the ammunition it has.³⁰ Ammunition may very well include shaming a cease and desist letter on social media.

B. *Even if They Could Afford it, Small Businesses Should Not Litigate Trademark Disputes*

According to scholar Leah Chan Grinvald, who specializes in trademark law, the structure of trademark law favors large businesses and disfavors small businesses³¹ for the following three reasons: (1) there is little precedent in trademark infringement cases for smaller businesses to use because the ‘likelihood of confusion’ test is considered an issue of fact at the trial level, and trademark infringement cases are typically fact-specific;³² (2) few statutory defenses are available for small businesses to claim that their use of the mark is appropriate;³³

²⁹ Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 653 [hereinafter *Shaming*].

³⁰ “[I]nvocation of the minor brands rights is justifiable on the grounds that in going to war for Sure anti-perspirant, P&G was entitled to use all the ammunition it had.” *Procter & Gamble Co. v. Johnson & Johnson Inc.*, 485 F. Supp. 1185, 1207 (S.D.N.Y. 1979), *aff’d sub nom.*, 636 F.2d 1203 (2d Cir. 1980).

³¹ *Shaming*, *supra* note 29, at 657–58.

³² *Id.* at 658.

³³ *Id.* at 661.

and (3) there are virtually no material consequences for a large business to over-police its trademark rights.³⁴

Indeed, small business owners are typically powerless against a trademark infringement claim from a larger trademark owner. The power disparity is likely the triggering event that causes a small business or individual to cry #trademarkbully. Without reasonable options, what else is a small business owner to do except shame the larger business in an attempt to avoid litigation by appealing to public sentiment? It would be rare to find large companies with large legal budgets shaming each other on social media, likely because a personal livelihood is not at stake and the balance of power is equal.

C. Shaming is Effective

Ms. Grinvald also wrote the following excerpt regarding the effectiveness of shaming:

In September 2009, Hansen Beverage Company [owner of Monster Energy drinks] sent Rock Art Brewery a letter demanding that Rock Art cease and desist its use of “VERMONSTER” as a trademark for beer. The letter stated, in part, “[t]o protect [Hansen’s] rights, we must insist that you . . . [i]mmediately cease and desist from any distribution, sale or other use of VERMONSTER in connection with beverages, including the use of any advertising, promotional and point-of-sale materials that include the infringing mark” Hansen is a multi-million-dollar beverage corporation and Rock Art Brewery is a small brewing company owned by a husband-and-wife team based in Vermont. Hansen’s gravamen was that Rock Art’s “VERMONSTER” beer allegedly infringed on Hansen’s “MONSTER ENERGY” trademarks. Instead of capitulating, Rock Art Brewery fought back, taking to the virtual streets of the Internet and galvanizing public sentiment against Hansen. Rock Art Brewery’s YouTube video garnered over fifty thousand viewers within the first couple of days of its posting, and over ten thousand members in the Facebook group, “Vermonters and Craft Beer Drinkers Against Monster.” The end result was an amicable settlement agreement that allowed Rock Art to continue its use of “VERMONSTER” as it had before.³⁵

³⁴ *Id.*

³⁵ *Id.* at 627.

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Ms. Grinvald's illustration of the Vermonster case shows what most small businesses hope to achieve by crying #trademarkbully.

III. THE PERFECT STORM FOR BEING LABELED A #TRADEMARKBULLY

A. Cease and Desist Letters Do Not Need to Contain Legal Statements

Cease and desist letters do not need to contain legal statements. In fact, cease and desist letters carry little legal weight and are not required to contain a declaration of a trademark owner's rights. Therefore, if the point of the letter is to persuade a small business to stop using a certain mark, then the letter need not contain any legalese... at all. As Ms. Grinvald explains, "[t]here is no reason to use legalese other than as an intimidation tactic, and a cease-and-desist letter can easily convey its seriousness in plain English."³⁶

B. Five Factors That Could Lead to Being Labeled #Trademarkbully

Scholar William T. Gallagher, a specialist in trademark law, previously conducted a qualitative empirical study³⁷ on the use of cease and desist letters to police trademark infringement. Mr. Gallagher's research indicates that the following factors may indicate that a cease and desist letter could be venturing into #trademarkbully territory:

1. The Enforcement Cost is High for Either Side³⁸

The cost of enforcement is probably high in every infringement matter. The client is likely being billed for communications leading up to sending the letter, and there may be pressure to end the matter with one letter. However, it may not be worth it. In such a situation, there is the temptation to be overly aggressive, which in turn could lead to the #trademarkbully label. It is equally important to consider the estimated cost to the target when determining if the letter is in #trademarkbully territory. For example, consider a small business with an annual gross revenue of \$100,000. If seeking legal advice and responding to the letter costs the small business \$1,000, then the small business will have to spend approximately one percent of its annual gross revenue. Many small business owners faced with a similar decision may decide to shame the sender first and seek legal advice second.

³⁶ Leah Chan Grinvald, *Policing the Cease-and-Desist Letter*, 49 U.S.F. L. REV. 411, 420–21 (2015).

³⁷ William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 453, 454 (2012).

³⁸ *Id.* at 475–76.

2. The Alleged Trademark Infringement Involves the Trademark Owner's "Core" Intellectual Property³⁹

As Mr. Gallagher states, "enforcement efforts were much more likely to be undertaken against potential targets when the alleged infringement involved the client's 'core' IP, or 'crown jewels[.]'"⁴⁰ It therefore appears that if the stakes are higher for the client, the pressure to be overly aggressive may be higher.

3. The Target is a Competitor⁴¹

Enforcing trademark rights against a competitor is a high priority for most trademark owners.⁴² The reasons for the heightened priority include enraging the competitor, avoiding unfair competition, and forcing the competitor to spend money, thereby increasing the competitor's cost of doing business.⁴³ If the target of the cease and desist letter is a competitor, it will understand the unstated reasons for the letter. The competitor will therefore be placed into reaction mode.

4. The Target is Smaller and Less Sophisticated Than the Trademark Owner⁴⁴

Trademark owners are more likely to target smaller and less sophisticated targets because it is easier and the target is less likely to have the resources to push back.⁴⁵ Schoolyard rules apply here: picking on the little guy is more likely to make the client look like a bully. The smaller business can quickly and easily stand up for themselves by posting the letter online and labeling the client a bully. If the target is smaller and less sophisticated than the trademark owner, then the attorney may need to take a step back and consider if they are in #trademarkbully territory.

5. The Target is Active on Social Media

Taking Mr. Gallagher's research one step further, it follows that if the target has a social media presence, then the target at least has an avenue to use social media to its advantage. Professional organizations, such as engineering firms or accounting firms, are less likely to be active on social media than say a brewery, realtor, or author. The difference is that the brewery, realtor, and author are consumer-facing businesses that depend on social media to attract business,

³⁹ *Id.* at 476.

⁴⁰ *Id.*

⁴¹ *Id.* at 476–77.

⁴² *Id.*

⁴³ *Id.* at 477.

⁴⁴ *Id.* at 478–79.

⁴⁵ *Id.*

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whereas the professional firms are business-to-business organizations with less of a need to interact with consumers. Therefore, if a small business relies on social media for marketing and advertising, then social media attacks are in its wheelhouse.

IV. THE SOLUTION: SECTION-BY-SECTION COMPARISON BETWEEN PRAISED LETTERS AND SHAMED LETTERS⁴⁶

There is no real way to prevent someone from posting a cease and desist letter on social media. In the event that someone does post a letter, efforts should be taken to ensure that there is less of a chance it is accompanied by a caustic hashtag. It would be helpful to consider four trademark cease and desist letters (“Fab Four Letters”) sent from large companies to small businesses that are praised as being exceedingly kind. The Fab Four Letters showed up in my research more often than recent letters and appear to me to be classics. Therefore, my research is based on the commonalities present among these four letters. The Fab Four Letters are all applauded by the media and by the small businesses and individuals who received them. Moreover, the Fab Four Letters have another silver lining. They appear to be valuable marketing pieces for the trademark owners.

A. *The Fab Four Letters*

1. Bud Light

In 2017, Bud Light ran a television commercial marketing campaign that featured people in medieval times sitting at a large formal dinner offering Bud Light to the king as a gift.⁴⁷ Upon receipt of the Bud Light, the king would say from the throne, “you are a true friend of the crown, Dilly Dilly” and hold up the Bud Light beer bottle to salute the gift bearer.⁴⁸ The crowd would then all hold up their Bud Light beer bottles and say “Dilly Dilly” in unison.⁴⁹ Someone then approached the king and offered a bottle of wine as a gift and the king was displeased.⁵⁰ The king said to the man offering wine, “please follow Sir Brad, he’s going to give you a private tour of the pit of misery.”⁵¹ Other Bud Light commercials in the same

⁴⁶ Letters that were posted on social media with the intention of shaming the trademark owner are referred to as “shamed” letters. “Shaming” refers the use of social media to attack an attorney or organization by posting the attorney’s cease and desist letter online. The purpose of the attack is to embarrass the attorney or organization, as retribution for the attorney’s initial letter.

⁴⁷ Bud Light Commercial, *Bud Light TV Commercial, ‘Banquet’*, ISPOT.TV, <https://www.ispot.tv/ad/wTA8/bud-light-banquet> [hereinafter *Banquet*].

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

campaign offered viewers the chance to win Super Bowl tickets for life.⁵² Anheuser-Busch, LLC previously registered the tagline, “Dilly Dilly.”⁵³

Later in 2017, Bud Light caught wind of a brewery in Minneapolis marketing a beer called “Dilly Dilly Mosaic Double IPA.” Instead of sending a cease and desist letter, Bud Light sent an actor dressed as a town crier from medieval times to read a hilarious script to the brewery that asked the brewery to discontinue marketing Dilly Dilly Mosaic Double IPA. The actor dressed, spoke, and acted exactly like the characters in the above mentioned “Dilly Dilly” TV campaign. The effect of the statement is best understood by watching the video,⁵⁴ but this is what the actor read aloud in what appears to be the lobby of Modist Brewing Company:

Dear friend of the Crown, Modist Brewing Company. Congratulations on the launch of your new beer, Dilly Dilly Mosaic Double IPA! Let it be known that we believe any beer shared between friends is a fine beer indeed. And we are duly flattered by your loyal tribute. However, “Dilly Dilly” is the motto of our realm, so we humbly ask that you keep this to a limited-edition, one-time-only run. This is by order of the king. Disobedience shall be met with additional scrolls, then a formal warning, and finally, a private tour of the pit of misery. Please send a raven, letter or electronic mail to let us know that you agree to this request. Also, we will be in your fair citadel of Minneapolis for the Super Bowl, and would love to offer two thrones to said game for two of your finest employees to watch the festivities and enjoy a few Bud Lights. On us. Yours truthfully, Bud Light.⁵⁵

Bud Light’s letter was met with positive fanfare and made national news as being a praised cease and desist letter.⁵⁶ Bud Light’s letter was praised because it did not put the owners or employees of Modist Brewing Company into a perceived position of weakness and vulnerability. Note that Bud Light’s letter is informal, does not demand that Modist immediately cease its infringing activity, compliments Modist’s success, offers something of value to Modist in the form of Super Bowl tickets, and does not use legalese.

⁵² Bud Light Commercial, *Bud Light Super Bowl Tickets for Life Sweepstakes TV Commercial, ‘Handouts’*, ISPOT.TV, <https://www.ispot.tv/ad/wuFy/bud-light-super-bowl-tickets-for-life-sweepstakes-generous-king>.

⁵³ DILLY DILLY, Registration No. 5,450,256.

⁵⁴ *Banquet*, *supra* note 47.

⁵⁵ Joe Patrice, *Bud Light Lawyers Send Town Crier to Deliver Cease and Desist Letter*, ABOVE THE LAW (Dec. 4, 2017, 12:51 PM), <https://abovethelaw.com/2017/12/bud-light-lawyers-send-town-crier-to-deliver-cease-and-desist-letter>.

⁵⁶ *Id.*

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2. Netflix

In 2017, Netflix sent a cease and desist letter to protect its trademark rights regarding the hit series *Stranger Things*. Netflix wrote the letter entirely in the *Stranger Things* brand voice. Anyone who has seen the show would agree that the language appears to have been written by one of the child characters featured in the show. The media loved this cease and desist letter and many articles were written that praised Netflix's sense of humor.⁵⁷ Here is the letter in its entirety:

Dear [target's first name],

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 Season 2!) But unless I'm living in the Upside-Down, I don't think we did a deal with you for this pop-up. You're obviously creative types, so I'm sure you can appreciate that it's important to us to have a say in how our fans encounter the worlds we build.

We're not going to go full Dr. Brenner on you, but we ask that you please (1) not extent 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. Let me know as soon as possible that you agree to these requests.

We love our fans more than anything, but you should know that the demogorgon is not always as forgiving. So please don't make us call your mom.

Thanks,
[Signature]⁵⁸

Netflix's letter was praised because it does not put the infringing small business into a perceived position of weakness or vulnerability. Similar to Bud Light's letter, Netflix's letter is funny, informal, addresses the target by first name, does not use legalese, and does not demand that the target immediately cease its infringing activity. However, rather than offering something of additional value, Netflix allowed the target to continue their campaign through the end of their

⁵⁷ Tim Nudd, *Netflix Sent the Best Cease-and-Desist Letter to This Unauthorized Stranger Things Bar*, ADWEEK (Sep. 20, 2017, 5:13 AM), <https://www.adweek.com/creativity/netflix-sent-the-best-cease-and-desist-letter-to-this-unauthorized-stranger-things-bar/>.

⁵⁸ *Id.*

planned six-week run date. Netflix's tactic did not have the effect of scaring the target and the letter turned a negative situation into a positive marketing piece for both companies.

3. TGI Fridays

In 2017, the media praised the following TGI Fridays cease and desist letter that asked a Chicago bar to not dress up as TGI Fridays for Halloween:

Dear [target's first name]:

As the trademark counsel at TGI Fridays, I wanted to reach out regarding Moneygun's plan to dress up as TGI Fridays for Halloween.

It's certainly a rite of passage to dress up as your personal hero for Halloween. After all – TGI Fridays is renowned for being the country's first singles bar and has been credited for creating loaded potato skins and popularizing the Long Island Iced Tea. (You're welcome, by the way.)

Fortunately, we have a number of things you can take off our hands to party like it's always Friday. Please see enclosed gift.

All is yours to keep...we don't need it anymore.

UNfortunately (for you – not us), trademark law requires us to protect our brands and to take action against any use that might cause confusion or diminish the value of our trademarks. I'm concerned that your event – featuring "TGI" branding, our logo, a variation of our IN HERE, IT'S ALWAYS FRIDAY slogan, and so on – would cross that line.

As such, we must ask that you avoid using TGI Fridays' trademarks, logos, and other property in your event.

Seriously. Don't. Thanks. Happy Halloween.⁵⁹

⁵⁹ Ashok Selvam, *TGI Fridays Won't Sue MONEYGUN Over Pop-Up, Sends Them Flair*, EATER CHICAGO (Oct. 27, 2017, 1:07 PM), <https://chicago.eater.com/2017/10/27/16560494/tgifridays-chicago-pop-up-halloween-moneygun-west-loop-cease-desist-letter>.

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The media and the target praised⁶⁰ the TGI Fridays letter. The letter is informal and addresses the target as if they are a friend. The most striking informal element of the TGI Fridays letter is that it closes with “Seriously. Don’t. Thanks. Happy Halloween.” The letter does not allow the target to continue with the Halloween costume plan, but the letter was sent one week prior to Halloween, so the small business could still have time to plan a different costume for the bar. TGI Fridays’ letter and Netflix’s letter are similar in that they both allow the target plenty of time to cease the infringing activity. Next, TGI Fridays’ letter is funny and offers a gift of flair to the bar.⁶¹ The letter goes on to state TGI Fridays’ position without using legalese and does not boast about the prominence of the TGI Fridays brand. The combination of these elements appears to give the letter a praiseworthy status that turned into a positive public relations piece for TGI Fridays.

4. Jack Daniel’s

The final Fab Four Letter is regarded as the “world’s nicest cease and desist letter ever.”⁶² The letter is not humorous like the previous letters, but it contains many of the same elements as the Bud Light, Netflix, and TGI Fridays letters.

Dear [target’s last name]:

I am an attorney at Jack Daniel’s Properties, Inc. (“JDPI”) in California. JDPI is the owner of the JACK DANIEL’S trademarks (the “Marks”) which have been used extensively for many years in connection with our well-known Tennessee whisky product and a wide variety of consumer merchandise.

It has recently come to our attention that the cover of your book *Broken Piano for President*, bears a design that closely mimics the style and distinctive elements of the JACK DANIEL’S trademarks. An image of the cover is set forth below for ease of reference.

We are certainly flattered by your affection for the brand, but while we can appreciate the pop culture appeal of Jack Daniel’s, we also have to be diligent to ensure that the Jack Daniel’s trademarks are used correctly. Given the brand’s popularity, it will probably come

⁶⁰ *Id.*

⁶¹ *Id.* “Flair” refers to the small items Fridays employees wear on their uniforms such as buttons. The term “flair” was popularized in Mike Judge’s 1999 film Office Space.

⁶² Avi Dan, *The World’s Nicest Cease-and-Desist Letter Ever Goes Viral, Sells Books*, FORBES (Jul. 26, 2012, 12:38 AM), <https://www.forbes.com/sites/avidan/2012/07/26/the-worlds-nicest-cease-and-desist-letter-ever-goes-viral-sells-books/#394233e86c11>.

as no surprise that we come across designs like this on a regular basis. What may not be so apparent, however, 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 or would want to see happen.

As an author, you can certainly understand our position and the need to contact you. You may even have run into similar problems with your own intellectual property.

In order to resolve this matter, because you are both a Louisville "neighbor" and a fan of the brand, we simply request that you change the cover design when the book is re-printed. If you would be willing to change the design sooner than that (including on the digital version), we would be willing to contribute a reasonable amount towards the costs of doing so. By taking this step, you will help us to ensure that the Jack Daniel's brand will mean as much to future generations as it does today.

We wish you continued success with your writing and we look forward to hearing from you at your earliest convenience. A response by [eleven days after the letter was sent] would be appreciated, if possible. In the meantime, if you have any questions or concerns, please do not hesitate to contact me.⁶³

The Jack Daniel's letter also shares a few elements with the Bud Light, Netflix, and TGI Fridays letters. First, the letter is somewhat informal and very polite. The attorney does not use overly technical legalese and does not illustrate the prominence of the Jack Daniel's brand. The attorney does not demand that the target immediately cease the infringing activity, but instead allows the author to sell through his existing inventory. Then, the attorney offers something of value to the target by offering to pay for part of the cost to reprint the books if the author wishes to replace the inventory now. The combination of praised elements in the Jack Daniel's letter likely helped the target to maintain his perceived perception of power and therefore, not shame Jack Daniel's as a trademark bully.

B. Analysis of the Nine Common Elements Among the Fab Four Letters

The Fab Four Letters contain the following nine elements:

⁶³ *Id.*

1. Informal or Funny Salutations

The openings and closings are typically informal, humorous, and contain soft statements. Some of the Fab Four Letters also address the target by first name. This is important because the target is more likely to be put at ease and read the letter with a positive frame of mind.

2. Generous Lead Time to Cease Infringing Activity

There is no directive to immediately cease the alleged infringement. Instead, the attorney politely requests that the target discontinue the activity past the pre-determined run date already established. It follows that a small business owner is less likely to feel threatened when there is no threat of a financial penalty or future legal action from the opposing attorney.

Consider a small business owner who unintentionally creates a building sign that infringes on a client's trademark. In order to take down the building sign, the small business owner will need to spend a few thousand dollars and hire a third-party company to perform the removal. It takes time for the small business owner to both reallocate the required capital and wait in queue for the third-party sign company to remove the sign. Placing a stringent deadline for removal may put the small business owner in a position of perceived weakness and increase the likelihood that it will then become #trademarkbully time.

Instead, trademark owners should consider working with the small business owner to find a more appropriate time for them to cease their infringing activity. In the building sign hypothetical, maybe the building is due for renovation in a few months and the target would have to take the sign down anyway. The point is to avoid stringent temporal demands when possible.

3. Offers Something of Value

In most of the Fab Four Letters, the attorney typically offers something of value to the target. Bud Light offered Super Bowl tickets, TGI Fridays offered flair, and Jack Daniel's offered to cover some of the expense of reprinting. It may sound odd to offer a gift to an infringing business, but the gesture alone can pay itself back as a positive marketing piece.

While it is not always feasible for a trademark owner to offer something of value to an infringing business, consider other corporate assets at the client's disposal. For example, if the target is using infringing design elements in their advertising, would it be possible to offer that the client's in-house marketing department create new design elements for the target? In this scenario, the trademark owner is not incurring a direct expense and the target may not take the client up on the offer anyway. It is likely the gesture alone that will ensure the target

remains in a perceived position of power, which will reduce the chances the trademark owner is labeled a #trademarkbully.

4. Compliments the Target

There is no better way to defuse a situation than to issue a genuine compliment. The Fab Four Letters did this by congratulating the target on their success or thanking them for being a fan of the trademark owner's brand.

5. Flexible Response Date

The Fab Four letters do not demand that the target respond by a certain date. The Bud Light and Netflix letters do not provide a response date, the TGI Fridays letter does not ask for a response at all, and the Jack Daniel's letter gives an eleven-day lead time for a response, but contains the language, "[a] response by [date] would be appreciated, if possible." Therefore, it appears that it is best to employ a flexible response date in order to stay off the #trademarkbully radar. Giving the target a flexible response date alleviates much of the stress associated with a stringent temporal demand. The target will likely feel more at ease and may be less likely to post the letter online.

6. Written in Brand Voice

The Fab Four Letters are written in the brand's voice. The letters almost seem to be written by the trademark owner's marketing department with the intention that the letter will be posted on social media. If possible for the brand, the trademark owner's marketing department should review the letter to safeguard that the letter reflects positively on the brand's image.

7. No Legalese, no Citation to Caselaw or Statutes, and no Threat of Legal Action

The Fab Four Letters do not use legalese, do not cite to caselaw or statutes, and do not threaten legal action. A target might be confused by legalese, might be scared by citations to caselaw or statutes, and will likely take a defensive position to threats of legal action. The scared and confused targets are the ones who have a greater propensity to cry bully.

8. No Boasting About the Client's Prominence

The Fab Four Letters do not state the size of the trademark owner's company nor do they highlight the prominence of the trademark. Statements of prominence are, however, present in the shamed letters discussed below.

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Statements of prominence may have a negative effect if they are used to bolster the size of the client. The target will likely already know who the trademark owner is and can Google further information. There is no need to further state that the client is bigger and has a superior bargaining position. Such a statement can have an intimidation effect and lead the target to feel as if they are being bullied by a larger company.

9. No USPTO Registration Information

Providing USPTO registration information is reasonable when communicating with other attorneys, but there is no need to use this tactic when communicating with a small business owner. None of the Fab Four Letters use the USPTO registration tactic. Omitting registration information makes sense because registration information may frighten the small business owner into believing that legal action is imminent. Enclosing USPTO registration information is also unnecessary and does not give a cease and desist letter greater legal weight.

To summarize this section, when the perfect storm is present as discussed in Section III, think of the cease and desist letter as a marketing piece that will be published on the front page of tomorrow's newspaper. If written properly, the cease and desist letter can act as a valuable marketing piece for the trademark owner and add value to the brand. A properly written letter will protect the brand reputation from the harms of being labeled a #trademarkbully.

C. #Trademarkbully: The Shamed Letters

1. Louis Vuitton

The case of Louis Vuitton and the University of Pennsylvania is an example of what is viewed as trademark bullying. In 2012, Louis Vuitton sent a letter to the dean of the University of Pennsylvania Law School asking the school to stop using elements of a trademark registered by Louis Vuitton in a poster that advertised "IP issues in fashion law."⁶⁴

I am the Director of Civil Enforcement, North America, for Louis Vuitton Malletier ("Louis Vuitton"). I write to express our concerns over the unauthorized use of our trademarks to promote the March 20, 2012 Penn Intellectual Property Group event, "IP Issues in Fashion Law."

⁶⁴ Staci Zaretsky, *A Top Law School Tells a High-End Fashion House Where to Stick Its Cease and Desist Letter*, ABOVE THE LAW (Mar. 5, 2012, 2:05 PM), <https://abovethelaw.com/2012/03/a-top-law-school-tells-a-high-end-fashion-house-where-to-stick-its-cease-and-desist-letter/>; see also Letter from Michael Pantalony, Dir. of Civil Enf't, N. Am., Louis Vuitton Malletier, to Michael A. Fitts, Dean of University of Pa. Law Sch. (February 29, 2012) (on file with author).

Louis Vuitton is the owner of world famous registered and common law trademarks, including the following trademarks as shown below (the “LV Trademarks”):

[Images]

[Paragraph regarding the history of the trademark.]

[Paragraph regarding the prominence of the Louis Vuitton brand.]

While every day Louis Vuitton knowingly faces the stark reality of battling and interdicting the proliferation of infringements of the LV Trademarks, I was dismayed to learn that the University of Pennsylvania Law School’s Penn Intellectual Property Group had misappropriated and modified the LV Trademarks and Toile Monogram as the background for its invitation and poster for the March 20, 2012 Annual Symposium on “IP Issues in Fashion Law.” A copy of the invitation/poster is attached as Exhibit A.

This egregious action is not only a serious willful infringement and knowingly dilutes the LV Trademarks, but also may mislead others into thinking that this type of unlawful activity is somehow “legal” or constitutes “fair use” because the Penn Intellectual Property Group is sponsoring a seminar on fashion law and “must be experts.” People seeing the invitation/poster may believe that Louis Vuitton either sponsored the seminar or was otherwise involved, and approved the misuse of its trademarks in this manner. I would have thought the Penn Intellectual Property Group, and its faculty advisors, would understand the basics of intellectual property law and know better than to infringe and dilute the famous trademarks of fashion brands, including the LV Trademarks, for a symposium on fashion law. (Louis Vuitton believes that education of the public about intellectual property issues is important and has sponsored such activities in the past. In fact, Louis Vuitton is a corporate sponsor of Fordham Law School’s Fashion Law Institute).

Louis Vuitton is proud of its reputation for protecting intellectual property and creativity. We hope, and expect now that this action has been brought to your attention, that immediate steps will be taken to stop all use of this invitation/poster that violates the LV Trademarks. Please contact me within five days to assure me that

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steps have been taken to avoid confusion and dilution of the LV Trademarks. Your understanding and anticipated cooperation is appreciated.⁶⁵

The Louis Vuitton letter contains several elements that differ from the Fab Four Letters including a formal and combative introduction, paragraphs that boast about Louis Vuitton's prominence, and statements that put the target in a perceived position of weakness. The letter appears combative because it uses phrases such as, "I am the Director of Civil Enforcement," "I was dismayed to learn," and "[t]his egregious action."⁶⁶ The letter then uses two paragraphs to boast about the history and prominence of Louis Vuitton's trademarks. The letter further puts the target in a perceived position of weakness by threatening legal action, demanding that the alleged infringement cease immediately, and requiring an inflexible response date. Combine those elements with the fact that the university setting is mostly younger students who are active on social media, there is a greater propensity to label an organization as a #trademarkbully.

Consider how this outcome may have been different if Louis Vuitton followed the nine common elements of the Fab Four Letters. To offer something of value, Louis Vuitton could have sent a free handbag with a suggestion that the handbag be raffled off at the University of Pennsylvania event in order to further promote the event. Louis Vuitton could have written off the expense of the handbag as a marketing sample, foregone the litigation expense, and possibly furthered its brand image (if, of course, such a gesture falls within Louis Vuitton's brand image).

2. Taco John's

The Taco John's letter is included again to highlight the elements that make this letter a risk for trademark bully shaming.⁶⁷ The target posted only the first half of the letter, so it is unknown what the second half said.

Dear Sir or Madam:

Recently I became aware that Freedom's Edge Brewing Company is using the phrase "Taco Tuesday" to advertise a daily facebook [sic] special.

The purpose of my letter is to let you know that Taco Tuesday® has been a federally registered service mark of our affiliate, Taco

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ Zhang, *supra* note 13.

John's Seasonings Limited Partnership, since 1989. We certainly appreciate our fellow community member's enthusiasm for tacos on Tuesday and the term is often used inadvertently. However, it is still extremely important to us to protect our rights in this mark because it is a distinctive and important representation of the origin of our products and services and also of the goodwill of our company.⁶⁸

Contrast the Taco John's salutation of "Dear Sir or Madam" with the friendlier salutation of the Fab Four Letters that begin with the target's first name. Taco John's, unfortunately, did not address the letter to an individual person.⁶⁹ The Taco John's letter then goes on to bolster the prominence of the TACO TUESDAY® mark.⁷⁰ Although it is unknown what the rest of the letter said, the first two elements were at least enough to garner public sentiment against Taco John's. The fact that "Taco Tuesday is so well known ensured the letter go viral as a shamed letter."⁷¹

V. HOW TO RESPOND WHEN TARGETS USE THE "TRADEMARK BULLY" LABEL OVER THE PHONE OR EMAIL

A. *Interview with the Attorney Who Wrote the Jack Daniel's Letter, AKA "The World's Nicest Cease and Desist Letter Ever"*

The following points come from an interview with Christy Susman,⁷² one of the in-house attorneys who worked on the Jack Daniel's letter. At the time, the letter was praised by the media as the "world's nicest cease and desist letter ever."⁷³ To preemptively avoid the #trademarkbully label, Ms. Susman indicated there are two factors that may be most important: (1) knowing the audience and (2) staying true to the brand being protected.⁷⁴ The legal team's goal should be to ensure that the target does not have the #trademarkbully response, and if the target does have

⁶⁸ FACEBOOK, *supra* note 14.

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ Gruver, *supra* note 20; Bostock, *supra* note 22.

⁷² E-mail from Christy Susman, to Paul Martello (Nov. 12, 2019, 2:18 PM MST) (on file with author). Christy Susman was interviewed over seven years after the Jack Daniel's letter went viral. Ms. Susman stated that drafting the letter was a team effort. Brown-Forman, the company that owns the Jack Daniel's brand, was a very collaborative workplace with many employees who took an ownership stake in protecting the Jack Daniel's brand. Working together, the legal department and the Jack Daniel's brand team crafted an approach for handling the matter that was entirely authentic to the brand and its "voice."

⁷³ Dan, *supra* note 62.

⁷⁴ *See* E-mail from Christy Susman to Paul Martello, *supra* note 72.

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the #trademarkbully response, that the legal team can stand behind the letter's tone and contents if it were posted online.⁷⁵

If the target responds negatively, either the attorney or someone from the brand team can call the target to explain the trademark owner's position.⁷⁶ The explanation can include why the attorney needed to write the target, why the attorney needs the target's help in complying, and ask for the target's help in protecting the trademark owner's brand.⁷⁷ No two situations are alike, and the situation can be better defused if the target believes that the company wants to hear the target's story and work with the target.⁷⁸ There is no need to over-lawyer the situation, and an informal conversation is probably best.⁷⁹

Sometimes, paralegals may take the brunt of a target's anger. Paralegals can be instructed to first apologize, explain, and provide context regarding how the goal of the letter was to avoid making the target feel that they were bullied.⁸⁰ Next, it may be best for paralegals to pass the target to someone higher up the chain.⁸¹ Depending on the situation, listening to the target to understand the target's side of the story is what is really needed.⁸²

CONCLUSION

Crying #trademarkbully on social media is an effective tactic that small businesses can use to defend themselves against trademark owners seeking to police the misuse of their trademark rights.⁸³ The #trademarkbully label typically occurs when the recipient of an overly aggressive cease and desist letter posts the letter to social media with the intention of shaming the trademark owner. The following five factors may indicate that a cease and desist letter could be venturing into #trademarkbully territory: (1) the enforcement cost is high for either side,⁸⁴ (2) the alleged infringement involves the trademark owner's "core" intellectual property,⁸⁵ (3) the target is a competitor,⁸⁶ (4) the target is smaller and less sophisticated than the trademark owner,⁸⁷ and (5) the target is active on social media.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*

⁸³ *Shaming*, *supra* note 29, at 627.

⁸⁴ *Gallagher*, *supra* note 37, at 475.

⁸⁵ *Id.* at 476.

⁸⁶ *Id.* at 476–77.

⁸⁷ *Id.* at 478–79.

Four cease and desist letters sent from large companies to small businesses successfully avoided the #trademarkbully label and have been praised by the media as being exceedingly kind.⁸⁸ These four letters contain the following nine elements: (1) informal or funny salutations; (2) generous lead time to cease the infringing activity; (3) offers something of value; (4) compliments the target; (5) flexible response date; (6) written in brand voice; (7) no legalese, no citation to caselaw or statutes, and no threat of legal action; (8) no boasting about client's prominence; and (9) no USPTO registration information. Given this information, it is clear that trademark owners should take these steps to avoid being labeled a #trademarkbully.

⁸⁸ Patrice, *supra* note 55; Nudd, *supra* note 57; Selvam, *supra* note 59; Dan, *supra* note 62.