

# The Trademark Reporter®



## The Law Journal of the International Trademark Association

Lanham Act “False Advertising” Claims: What Is a Plaintiff to Do?  
*Vincent N. Palladino*

Defensive Aesthetic Functionality: Deconstructing the Zombie  
*Anthony L. Fletcher*

Anti-Dilution/Anti-Free-Riding Laws in the United States, Canada, and the EU:  
Bridges Too Far?  
*Daniel R. Bereskin, Q.C.*

The New Generic Top-Level Domain Program: A New Era of Risk for Trademark  
Owners and the Internet  
*Dennis S. Prahll and Eric Null*

A Century of Trademark Law—Looking Back and Looking Forward  
Moderator: *J. Thomas McCarthy*  
Speakers: *Miles J. Alexander, Eric Goldman, and The Rt. Hon. Professor  
Sir Robin Jacob*

Amicus Brief of the International Trademark Association in *International Hair  
Cosmetics Ltd v. International Hair Cosmetics Group Pty*

Amicus Brief of the International Trademark Association in *PT Bintang Pesona  
Jagat v. PT Karya Tajinan Prima*

Amicus Brief of the International Trademark Association in *Christian Louboutin  
S.A. et al. v. Yves Saint Laurent America Holding, Inc. et al.*

## BOOK REVIEWS

**Intellectual Property Strategies for the 21st Century Corporation: A Shift in Strategic and Financial Management.** By Lanning G. Bryer, Scott J. Lebson, and Matthew D. Asbell (Editors). 2011. Pp. 322. (Hardcover). \$125.00 U.S.A., \$150.00 Canada. John Wiley & Sons, Inc., Hoboken, New Jersey. Published simultaneously in Canada.

Editors Lanning Bryer, Scott Lebson, and Matthew Asbell have orchestrated an excellent overview of the current state of intellectual property (IP), with practical approaches to aid corporations in addressing issues arising from an IP environment that has transformed over the last decade. Consisting of seventeen individual chapters, each written by an experienced practitioner, the book covers a wide variety of IP topics including:

- Ownership structures and considerations
- Mergers and acquisition, including evaluating potential targets
- Penetrating new markets
- Intellectual property as an asset class
- Patent portfolio building and management strategies
- Global piracy
- Non-practicing entities (or “patent trolls”)
- Insurance
- Alternate dispute resolution
- Outsourcing and off shoring
- Web-related issues
- Green IP
- Accounting and tax policies
- Valuation techniques

Each individual chapter is a stand-alone article, with contributions by industry stalwarts from such entities as IBM, Canon, Limited Brands, Scientific American, PPG Industries, NYU Stern School, Duff and Phelps, NERA, Ocean Tomo, Pangea3, IPMetrics, ThinkRisk Underwriting Agency, and others. The volume is edited by a trio of experienced attorneys from Ladas & Parry LLP: Lanning Bryer, Scott Lebson, and Matthew Asbell.

The chapters vary in length, depth, and tone, some being relatively short and high level while others are more detailed, even scholarly. Each is well-written, and offers interesting and useful information on its topic. Although there is some overlap (for

example, three separate chapters on outsourcing), the chapters generally complement, rather than repeat or contradict, each other. Particularly thoughtful treatment is given to real-world challenges faced by corporations in today's economic environment: ways in which IP can be held and leveraged; best practices in mergers and acquisitions, from identifying and assessing targets through post-acquisition considerations; using IP to open new markets; the need for and availability of insurance products to manage IP risks; reassessing patent acquisition and management programs; and positioning a company to understand and participate in online environments. Several chapters are forward thinking, predicting trends, such as a challenging and thought-provoking piece addressing the future of IP as an asset class in and of itself.

Taken as a whole, the volume is well-organized and contains an abundance of timely information written from the individual perspectives of a diverse group of industry leaders. The chapters need not be read in order, but may be perused as needed or desired. The volume contains a Table of Contents as well as an index to help in looking up specific topics. The often numerous footnotes to the individual chapters facilitate further research. The authors' biographical details are contained at the back of the volume in alphabetical order, however, and without reference to their topics. Given that the chapters are indelibly stamped with the point of view of the authors, a more convenient way to access those details would aid readers in understanding whose point of view they are reading.

While many of the chapters are pertinent to all types of IP and IP-related challenges, considerable emphasis is given to patents. This book is of most use in explaining the complex and rapidly changing landscape pertaining to the ownership, acquisition, leveraging and protection of patent and other IP rights. Anyone with an interest in IP is bound to learn something—and likely quite a bit—from this valuable volume.

Maria K. Nelson

**Trademark and Copyright Litigation.** By Mark V.B. Partridge and Phillip Barengolts. 2011. Pp. 540 (plus CD-ROM containing forms). \$250. Oxford University Press, Inc., 198 Madison Avenue, New York, NY 10016.

This unique form book contains documents from actual trademark and copyright court cases and provides commentary on the strengths and weaknesses of the positions advanced in these documents. The authors developed this treatise as a result of an LLM course they teach at John Marshall School of Law in Chicago. In the preface, they state that their purpose is “in our course, and

in this book, to give those real world examples, supported with the kind of commentary and advice you get from discussing your case with an experienced litigator.”

The authors necessarily assume some level of familiarity with motions practice and discovery in trademark and copyright cases. It would have been helpful for non-litigators if they provided additional general introductory comments or overviews of these topics for non-litigators. While the book covers both trademark and copyright litigation, more content is devoted to trademark cases. It also ventures into online issues by addressing topics such as keyword advertising, the use of trademarks in sponsored links and cybersquatting.

This first volume of a two-volume series covers case assessment; cease and desist letters; forum selection; complaints, answers, and counterclaims; preliminary injunctions and temporary restraining orders; motions to dismiss; written discovery; depositions; discovery disputes; and electronic discovery. Volume II, to be published later this year or next year, will cover surveys, pretrial conference, motions in limine, trial preparation, jury instructions, post-trial motions, injunctions, settlement agreements, alternative dispute resolution, and appeals.

While the publication is intended for litigators, this first volume is useful for transaction lawyers, whether or not experienced in trademark and copyright law, who are interested in gaining litigation insights and case assessment techniques. It should prove to be useful for novice and experienced practitioners.

While this book is based on real life examples, it provides criticisms of faulty logic or erroneous authority in footnotes in the form documents. Detailed explanatory case law is included for interpreting the various circuit courts' interpretation of the advertising or promotion necessary to sustain a lawsuit under Section 43(a). This discussion was helpful and it would have been helpful to include similar analysis to accompany more forms in the book. On balance, this book presents a novel approach for a form book covering trademark and copyright litigation. In large part, the authors were successful in achieving their purpose to dispense advice a practitioner could expect from an experienced colleague.

Susan D. Rector

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