

Q&A With Day Pitney's Carrie Olson

Law360, New York (May 09, 2013, 1:10 PM ET) -- [Carrie Webb Olson](#) is a partner in [Day Pitney LLP's Boston](#) office and head of the firm's trademark copyright and advertising practice group. Her focus is domestic and international trademarks — from selection and adoption, to prosecution, policing and enforcement. She works as quasi in-house trademark counsel to large global companies, and educates startups about trademark basics.

Q: What is the most challenging case you have worked on and what made it challenging?

A: A post-closing global patent and trademark assignment recordation project involving hundreds of marks in hundreds of jurisdictions. When we received the documents, the short form assignments (hundreds of them, at least one for every territory) had been prepared, signed and notarized for purposes of recording the transfer in various countries. When we attempted to record the documents in the various countries, most offices rejected the forms on the basis that the assignor did not match the owner of record. In many cases, we needed to go back two or more “jumps,” i.e., in order to record the current transfer, it was necessary to obtain and record transfer documents from past assignors/assignees, many of which had been dissolved and/or proper signatories were not available. Where the assignor did match the record owner, there were often mismatched addresses, which created complications at every turn.

The project involved numerous moving parts, including the need to correct chains of title in advance of imminent maintenance deadlines for marks of major importance to the client. From this, I learned the importance of (1) including intellectual property counsel to the deal team from the beginning; (2) the diligence that is required to ensure a smooth transition of IP assets post-closing; (3) basic IP ownership hygiene, particularly before the acquisition and/or divestiture of assets; and (4) excellent IP paralegal.

Q: What aspects of your practice area are in need of reform and why?

A: Continued work toward the harmonization of international trademark laws would significantly reduce the costs associated with clearing and protecting marks in important and emerging markets. Trademark owners doing business in countries governed by different legal systems are challenged in developing global marketing initiatives suitable for most jurisdictions. I spend a lot of time explaining the importance of protecting trademarks in countries of primary business significance. However, I am always apologetic when discussing the differences in the laws, policies and procedures and, in particular, the significant costs associated with obtaining international protection for company marks.

While the globalization of business and the increased economic interdependence of various countries has been a catalyst for significant work in this area, there is more that can be done to assist trademark owners develop a consistent and cost-effective international brand management strategy.

Q: What is an important issue or case relevant to your practice area and why?

A: The issue of fraud on the Trademark Office and the [U.S. Patent and Trademark Office](#)'s “reign of terror”

affecting trademark owners' registered rights during the Medinol years, from 2003 to 2009. In *Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205, 1209 (T.T.A.B. 2003), the Trademark Trial and Appeal Board held that a simple negligence standard is sufficient to support a finding of fraud before the board, which finding resulted in the cancellation of the entire trademark registration at issue.

This came into play when a trademark declaration was signed in connection with an affidavit of use. Although the rules require the submission of a single specimen, which shows use of the mark with any one item in the class, the declaration language attests to use of the mark with all the items in the class. To the extent that the declaration was signed when some but not all goods/services listed in the class were in use, the registration was deemed fatally flawed. The board reasoned that the declarant either "knew or should have known" that the mark was not in use with certain items.

And then came Bose. Trademark owners owe a world of gratitude to Bose Corporation for taking this matter to the Federal Circuit. In *In re Bose Corp.*, No. 2008-1448, slip op. (Fed. Cir. August 31, 2009), the Bose court ruled that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO, applying a stricter standard for trademark fraud cases. Accordingly, innocent mistakes as to statements of use will not result in the cancellation of a U.S. registration, absent a showing of an intent to deceive.

Although things are back as they should be, in my view, the Medinol years changed the way trademark attorneys manage U.S. trademark portfolios and provide client service in this area of the law. There is no such thing as a "routine filing" when it comes to U.S. trademark practice. In my view, the USPTO's line of cases on this subject was in an effort to call out the importance of the documents filed with the office. Practitioners and clients should sharpen their pencils and ensure the accuracy of all facts asserted in U.S. trademark applications and registrations, particularly before asserting the subject registration in any enforcement action.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: Barry Kramer of [Edwards Wildman](#) (Stamford, Conn.) is part of a small but elite group of intellectual property attorneys that can be considered "ambidextrous" when it comes to patents and trademarks. Barry's deep knowledge of and experience in the laws copyright, trademark, patent and trade secret, combined with his ability to build and manage a high-volume, document-intensive, yet cost-effective, intellectual property practice group, make him a terrific role model for more junior lawyers evolving in this area.

Q: What is a mistake you made early in your career and what did you learn from it?

A: I approved a document with a typographical error for filing with the USPTO, which became a permanent fixture in the company's assignment history. Although the problem was fixed without prejudice to the client, it was incredibly embarrassing. I learned that "the buck stops with me" and that I am responsible for the work of junior lawyers and paralegals, regardless of their level of experience. Accordingly, I place strong emphasis on attention to detail in all aspects of my practice. It doesn't matter how good and knowledgeable you are from a substantive and/or practical standpoint, if your work product (whether emails, letters, memos or otherwise) contains careless errors, your credibility will be called into question.

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