Preface

I. The Cases and Analysis
by Jane Coleman

This book, not unlike its subject matter, evolved on the Internet. It began as a research project almost ten years ago, when there was very little treatment of secondary trademark infringement in any of the major treatises, let alone an actual monograph. When I finished the project, the work was still the only one I knew of that had treated it comprehensively. To test my premise—and with the hope of eventually publishing it in print—I decided to make it available online. In 2009, with the assistance of my husband, IP lawyer and blogger Ron Coleman, I published it on the Internet.

The reception of the online treatise confirmed that there really was no other such treatment of secondary trademark infringement. The positive feedback in the form of blog reviews, links, tweets, and citations, as well as the daily traffic to the Web site, all suggested that the online book filled a void in the legal literature.

In retrospect, though, the online treatise was just the beginning. Each year for the first three years, I spent several summer weeks updating it with an expanding number of secondary liability cases. The virtual "pocket parts" were accumulating, and the law was changing. As in so many other areas of the law, the Internet drove that change. In the age of online commerce, secondary trademark infringement doctrine had evolved well past the classic "passing off" paradigm the Court addressed in *Inwood Labs.* when it formulated the "supplying a product" rule. It was time to re-examine early assumptions about the law and revise the original treatise.

I could not have hoped for a better opportunity to develop the online treatise into a full-fledged hardcover book than the one Jim Fattibene of Bloomberg BNA offered me last year. Jim introduced me to Griff Price, Senior Counsel at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, whose Practice Notes, along with the above-mentioned revision, have transformed the work into a truly comprehensive treatise by providing expert, practical insight on how to litigate secondary liability cases.

Working as a team with Bloomberg BNA's Wendy Leibowitz, Griff and I developed the online version into the present volume.

The new work addresses emerging issues that the online treatise had only touched on. They include the following:

- Corporate officers' liability for the trademark infringement of their companies (Chapter 3)
- The question of whether each "species" of trademark infringement should be governed by the same secondary liability standard (Chapter 4)
- The relationship between secondary trademark and secondary copyright infringement (Chapter 5)
- Secondary liability for trademark infringement on the Internet, including the keyword advertising cases (Griff's Practice Note explains Google's litigation strategy in these cases and is alone worth the price of the book.) (Chapter 9)
- Damages for contributory trademark infringement (Chapter 12)

Just as this book in more senses than one is an outgrowth of the Internet, its future course is likely to follow that medium's growth as well.

II. The Practice Notes
by Griffith B. Price, Jr.

While Jane Coleman's direct involvement in, and contributions to, the work that has evolved into this book stretch back over almost a decade, mine have been much more recent. Like many intellectual property attorneys in the trademark and unfair competition fields, my first contacts with the doctrine of secondary trademark infringement in the 1980's involved what now would be considered garden-variety cases under the "supplying a product" rule of *Inwood Labs.* But by the time I met Jane through the good offices of Jim Fattibene of Bloomberg BNA in 2011, that doctrine had evolved in ways that could not have been imagined when *Inwood Labs.* was decided—making her online treatise and her then-nascent work on this published volume not just timely, but essential to a full understanding of the still-expanding parameters of the doctrine. Like so many other areas of intellectual property law that have been affected by changes in communications, the development of new media, and especially the growth of the Internet, the scope and reach of the law of secondary trademark infringement has exploded in recent years and will surely continue to do so.

In our first discussions about the possibility that I might contribute "practice notes" to Jane's planned treatise, Jane and Jim suggested that the notes could add practical suggestions and guidance, based on real-world litigation experience, about the "ins" and "outs" of secondary infringement cases. In response to my questions about the intended audience, Jim told me that not only lawyers, but also business people and other non-lawyers, might find such information useful, and I have tried

to prepare the notes with that in mind. As a result, some lawyers may find the notes overly simplistic and some lay readers overly legalistic, but I hope they nevertheless contribute to both groups' understanding of the complexities of such litigation in some useful way. Any shortcomings in that regard (as well as any errors or omissions) should be laid at my door, not Jane's or Jim's, as their intent was pure and they are in no way to blame for failures in execution, which are mine alone.

Likewise, the practice notes should be regarded as commentaries and, in a sense, short-form essays about the issues they address, not as comprehensive research sources or exhaustive discussions of relevant case law. We hope they will provide thought-provoking starting points for such research as well as tactical as well as strategic planning in litigation. Many other treatises, both hard copy and online, are available for in-depth research and planning on those issues, which require analysis and citations going far beyond the purpose of—not to speak of space available in—this work.

In short, the reader should regard these practice notes as suggestive, hopefully thought-provoking, but essentially top-level discussions of issues, strategies, and other considerations that are likely to arise in connection with secondary infringement litigation. To the extent the notes express opinions or conclusions about the cases or issues they discuss, they are mine only and do not represent or reflect the positions of my firm or any of its clients. I have prepared the notes based entirely on publicly available information, and I have neither had access to nor made use of any non-public information of my firm or its clients in connection with my work on them.

With Jane's foresight and vision, Jim's support and encouragement, and Wendy's first-rate editorial assistance, I believe we have produced a volume that attorneys and others interested in secondary infringement litigation will find a useful contribution to the literature. That has been our purpose, and we hope readers will find we have succeeded.

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