

# Mark Sommers



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## Biography

Mark Sommers practises exclusively in the fields of trademarks, domain names, dilution, unfair competition, false advertising, cybersquatting, counterfeiting and other IP-related areas. He provides the full range of services in those areas, including US federal court and TTAB litigation and appeals, strategic counselling, infringement and clearance opinions, portfolio management and prosecution, empirical research, intermediary liability and damages.



### **Can you tell us a little about your career to date?**

I was studying the LLM programme at the University of London and realised early on that I would not have enough money to make it through the year. So, I began interviewing at firms. One asked what I knew about intellectual property and I responded that, ironically, intellectual property was my major. They said that I had the job and should show up on Monday morning. The interview was on Friday afternoon, so I ran back to the school registrar just before it closed at 5:00pm, said that I wanted to change my major to intellectual property and immediately got the course books. I studied all weekend and showed up on Monday morning, having righted my white lie. I was asked to look at one trademark, weigh it against another and determine whether it was likely to cause confusion. I thought to myself "I can do that". Those were the humble beginnings of a life's practice in trademark law, which eventually brought me to Finnegan in 1989 via London, New York and Chicago.

### **Your expertise spans trademarks, domain names, dilution, unfair competition, false advertising, cybersquatting, counterfeiting and other IP-related areas. What tips can you share about how to remain at the forefront of industry developments when you have such a broad practice?**

My practice includes a wide range of source indicators, be they words, logos, shapes, sounds, phrases, colours or trade dress. My practice also involves the full spectrum of acts and actions that can cause consumer mistake, confusion and deception or false and misleading representation of facts – whether they are monikers of any type, marketing claims, digital postings, look-alikes or the overall thematic product or company visual positioning. To stay at the forefront of industry developments, I look at trends in the marketplace and the law. Every morning I review relevant legal and industry news blurbs and cases, as knowing where litigants and the courts are driving the law and where marketers are driving products and product marketing and positioning allows me not only to stay apprised of what is happening, but also to anticipate and develop new strategies in enforcing and defending the interests of my clients.

### **One area of specialism is intermediary liability. Do you feel that the legal situation in this area is relatively settled now, and what changes would you make?**

The area of intermediary liability in the digital marketplace is far from settled and will see continuing

challenges and developments in the future, as the competing interests are real, well funded and politically charged. Add in the global nature of commerce, and intermediary liability becomes a key component to any successful enforcement strategy. Today, Amazon's take-down procedures accomplish what previously required preliminary injunctive relief. Moreover, the courts must provide guidance on the use of prominent and conspicuous notices by intermediaries that truthfully and accurately disclose the nature of the goods that they sell (eg, second-sale goods, warranty-voided sales, grey goods or not new goods), as purchasers do not have the ability to inspect such products before purchase.

### **The online world is another focus for you and the UDRP is due for review. In terms of the range of available online rights protection mechanisms, are there any changes that you would like to see?**

In general, the UDRP is working as it was originally envisioned. Compared to litigation, it serves as an efficient, low-cost solution for rights holders to enforce their trademark rights against a wide variety of infringing and fraudulent online activity through infringing domain names.

One change that seems appropriate in practice concerns Section 4(a)(iii), which should be amended to allow UDRP complainants to prove either bad-faith registration or bad-faith use. Brand owners must currently show both. This creates a loophole, as a domain name registrant that registered a domain name in good faith can later create infringing content on its website that creates confusion over a subsequently adopted brand. Clearly, such opportunistic use constitutes bad faith, but the brand owner would be unable to establish that the domain was registered in bad faith. This results in having the dispute litigated before a court of law.

### **In terms of the law firm environment, Finnegan is an IP powerhouse. What are the advantages of working in such an environment versus a full-service firm?**

There is no question that the advantages are real and substantial, as Finnegan is built on a support system specifically designed for our singularly dedicated IP-only practice. Being an IP-only firm means that everything is created internally to deliver the full range of IP services that we offer. Because of Finnegan's deep bench of talent across the full scope of intellectual property, attorneys can specialise in certain fields, meaning that everyone is an expert in something. This results in

better counselling, rights capture, enforcement and defence of all things IP-related.

### **How are client demands changing, and what effect has this had on your practice?**

Clients expect more for less money. This is the field of play and I am comfortable with it. Like everyone else, we have alternative fee arrangements, but that is just the 'payment for services rendered' component. My time is mostly spent on the deliverables side. Over the decades, I have learned that even the most sophisticated clients need external eyes to find untapped or new rights. I spend time learning and studying a client's products, services, cultural, marketing and competitor landscape and ask myself "what makes Company A Company A?" I jot the answers down, isolate the core elements, find potentially protectible elements and talk to the client. Never has a client been unappreciative of this exercise. I strive hard to be viewed not only as a legal service provider, but also as a trusted legal adviser who takes the client's business and rights to heart.

### **What qualities make for an elite-level litigator in the IP field, and how can these be honed?**

First and foremost, you must keep your ego in check and be brutally unbiased and honest. You must also think like a consumer, rather than a lawyer, as answers to questions in trademark and related areas of law come from the marketplace. Second, you must master the ability to strategically adapt your case as it proceeds and anticipate your opponent's moves through their eyes, not yours. You must be fully dedicated to the client's overall best interests, which may mean shifting case directions or challenging client expectations or viewpoints. Finally, you must obtain steadfast positions from your opponent at those critical fork-in-the-road decision points, as they set the boundaries of a case.

### **What is the key to maximising success in trademark litigation disputes?**

Painstaking due diligence and preparation of the facts, surgical use of experts and a healthy dose of doubt, both in your case and in the prevailing law, especially knowing through experience that the law can always be shoehorned or adapted to a case. No place is that more apparent when scorching adverse facts come to light that unfavourably colour your case (and everything else that you or your witnesses say or do). You always need to think a few steps ahead and adjust your case as the situation presents itself. You should always challenge, doubt and revisit the strengths and weaknesses of

your case. Finally, settlement is not a weakness, it is a commercial solution, so treat it as such.

### **Do you think it is becoming easier or harder to attain trademark registrations in the United States and why?**

It is not necessarily becoming harder, but it is more challenging. I view that as a positive, as the current state of the registration process in the United States greatly favours those practitioners who closely examine the realities of the marketplace and re-position the registration process to reflect such realities and facts.

### **What are the key qualities that you look for in law firm counsel when building and maintaining a global network and sending work overseas?**

Quality, timeliness, practical solutions and creative suggestions are paramount. Clients hate to hear "no" unless it is truly a "no". It is easy to say "no" and send across an invoice, but difficult to say "maybe, given certain problems but here are a couple of possible solutions".

### **Looking ahead, what do you see as the major upcoming challenges for trademark owners in the coming years?**

Trademark owners will need to better leverage and enforce the many diverse parts of their source-indicating identities beyond mere words alone, as consumers have come to associate a variety of cues and messages with a given company. The challenge for a trademark owner is to identify, define and capture those rights. This takes close collaboration with a company's marketing and social media groups. Without a strategic vision, trademark owners are simply inviting competitors to freeride the brand experience that they have laboured to create and maintain.

### **Finally, how different do you think the future trademark practice will be – and how can law firm practitioners prepare now?**

Firm practitioners will find long-term success by delivering real, tangible value to their clients through strategic vision and the enforcement of rights that fundamentally matter to their businesses. As most clients have tight cost controls in place, the answer is not to provide slim-margin services, as by doing so, you are positioning your practice as a mass-market provider, which will require substantial volume to succeed and the ability to weather cut-throat competition. Instead, there are plenty of companies that want and need top-tier counselling, rights acquisitions and enforcement.