

# POTTER GROUP

*MOVING INNOVATION FORWARD<sup>SM</sup>*

Columbia Center  
701 Fifth Avenue  
Suite 4200  
Seattle, WA 98104 USA  
Tel: +1-425-351-6113  
Fax: +1-206-374-2749

Potter Group – KACG  
4-13-7 Minami Azabu  
Suite 601  
Minato-ku  
Tokyo, Japan 106-0047  
Phone: +81-50-5809-9691

Three First National Plaza  
70 West Madison Street  
Suite 1400  
Chicago, IL 60602 USA  
Tel: +1-312-498-4932  
Fax: +1-312-873-3793

*Privileged & Confidential*

*Intended for the exclusive use of the client  
and its attorneys. Do not disclose to any third party  
without specific approval of the client and its attorneys.*

Potter Group Trademark Infringement Report  
for  
[client]

**INVESTIGATION OF POSSIBLE CLAIMS  
AGAINST [potential infringer]**

R. Clifford Potter  
POTTER GROUP

# POTTER GROUP

*MOVING INNOVATION FORWARD<sup>SM</sup>*

*Privileged & Confidential*

Chicago | Seattle | Tokyo

\_\_\_\_\_, 200\_

## Table of Contents

Table of Contents .....	ii
I. Executive Summary.....	1
A. Certain Findings .....	2
B. Potential Violations of Law .....	5
C. Potential Claims Against [Client] .....	6
D. Recommendations .....	6
1. Take some affirmative actions.....	6
2. Keep the Agreement in place at present .....	6
3. Negotiate .....	6
4. Investigate and make damage calculations.....	7
5. Choose arbitration first, and then litigation if necessary .....	7
6. Apply for trademark registrations .....	8
II. Claims Against _____ .....	8
A. Venue.....	8
B. Contract Claims.....	9
1. Applicable law.....	9

# POTTER GROUP

*MOVING INNOVATION FORWARD<sup>SM</sup>*

*Privileged & Confidential*

2.	The relevant facts .....	10
a.	The Agreement .....	10
b.	The draft versions of the Agreement.....	11
c.	Post-Agreement discussions .....	12
d.	Recent ____ trademark registrations and applications.....	16
3.	Breaches of Agreement .....	17
a.	The ability to use [Mark] with unlisted formatives .....	17
b.	____'s use of [Client Mark] with [product or service] .....	18
C.	Shape Trade Dress And Related Trademark Claims .....	18
1.	The relevant facts .....	19
2.	Trade dress and trademark rights in [product or service] .....	20
3.	Distinctiveness .....	21
4.	Likelihood of confusion .....	28
5.	Functionality .....	30
D.	Unfair Competition, False Advertising, Passing Off, Fraud, False Designation Of Origin .....	31
1.	False advertising .....	31
2.	Passing off .....	33
3.	False designation of origin .....	33
E.	State Deceptive Trade Practices .....	34
F.	State Trademark Dilution .....	34
G.	Corporate Usurpation .....	35
III.	Possible Claims Against [client] .....	35
A.	Breach Of Contract .....	35
B.	Trademark Claims .....	35
IV.	Registration Of [client] Trademarks .....	36
A.	Applications for [client] Marks.....	36

# POTTER GROUP

*MOVING INNOVATION FORWARD<sup>SM</sup>*

*Privileged & Confidential*

B.	Registration Of [client mark] .....	36
1.	The relevant facts .....	37
2.	The first examiner’s opinion can be successfully attacked.....	38
3.	Registration of personal name .....	39
C.	Registration Of Shape Trademark .....	44