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### TRADEMARKS

An attorney and a private investigator use a mock-interview format to discuss their use of trademark investigations in the practice of trademark law.

## Interview With an Investigator



BY PETER SLOANE AND TONY YARBOROUGH

**T**rademark investigations are integral to the practice of trademark law. They allow trademark practitioners to learn information perhaps not otherwise publicly available about third party activities.

Typical investigations include inquiries into whether a mark is still in use for purposes of abandonment, when a mark was first used in order to determine priority, and the nature and extent of use to help evaluate likelihood of confusion. But trademark investigators do much more, from staking out counterfeit operations to purchasing internet domain names.

In this piece, trademark attorney Peter S. Sloane interviews investigator Tony Yarborough.

*Peter S. Sloane is a trademark attorney with Leason Ellis, White Plains, N.Y. Tony Yarborough is an investigator with Robert Jackson and Associates Inc., a private investigative firm in New York.*

### Trademark Investigations in General

**PETER:** Hi, Tony. We have been working for many years together on trademark investigations, but I have always wondered whether your firm handles any non-intellectual property-related investigations. Does it?

**TONY:** Yes, we are a full-service investigative firm and we handle such non-IP cases as background investigations, asset searches, locate cases, surveillances, fraud, stalkers, due-diligence—pretty much anything. We also have some celebrity clients and have handled various issues on their behalf.

**PETER:** The most common reasons we ask for investigations are to determine abandonment and priority. Do you have any sense as to which type of investigation is more common?

**TONY:** I'm not really sure, possibly 50/50, but it tends to fluctuate. Plus, we also have cases where we are looking to see how many entities are using a mark, or a similar mark, to see if there is a possibility for coexistence. We have had cases where we have looked into as many as 75 different entities.

**PETER:** Interesting. I never thought of using an outside investigator to look into issues of coexistence. Do you approach investigations about priority and abandonment differently?

**TONY:** Not really, since we approach each case individually and look to obtain the facts. In both instances, we would try to get as specific a date of either first use and/or abandonment as possible. However, if we get confirmation that a mark has not been used for “at least five years,” then it is usually not as necessary to get as specific a date as when the client and subject both started using a mark at about the same time. In the latter case, we would try to get the exact day when the subject began use.

### Computer Database Searching

**PETER:** What kind of computer searching do you do as part of your investigations?

**TONY:** We use a number of proprietary databases which are obtained by an application that requires a copy of our license—some of these require periodic auditing to make sure that we’re using them for the specific reasons listed in our subscription. We also use a number of other more publicly available databases such as those provided by various state departments. And we use that little thing called the internet.

**PETER:** How reliable are most computer databases?

**TONY:** That will always be a good question. In most cases, databases are really only as good as the person inputting the information. With credit-related databases, we often see credit records mixed up between spouses or between a parent and child, especially if it is a junior and senior.

Also, if a Social Security number is put in wrong when someone has their credit checked, they may be mixed up with an entirely unrelated person. Then there are the identity theft issues, which is another matter entirely.

As for the internet, I loved the headline from *The Onion* that read, “Mistake Found on the Internet!” Too many people believe too much of what they read on the internet and it can sometimes be quite difficult to tell the source, timeliness, and, of course, the accuracy of the information.

What looks like an amazing website for an incredible company may simply be a site created by a teenager in his or her parent’s basement, and a dinky little site may be that of someone who has a very successful company, but has not had the time or inclination to update their site.

### Investigation Methods

**PETER:** I am always reading in your reports about the use of a “suitable pretext” as a means to acquire information. What does that mean exactly?

**TONY:** Because of the big Hewlett-Packard fiasco several years ago, I think the word “pretext” is now in great disfavor even though when used legally and prudently it is not really a negative word or concept. Basically, what we do is try to get the most truthful, accurate information possible and will craft a strategy for each investigation to help us accomplish that.

Our inquiry must strike the target we’re investigating as genuine and will consist of a number questions, only

some of which touch on the matter under investigation. This helps insure that the information we obtain is as accurate as possible.

Ideally, our inquiry should be seen by the target as routine, one of many such inquiries they have answered about their business operations or product. There are certain constraints, legal and otherwise, in how we can proceed in these inquiries—the emphasis is always on what is “suitable” in every sense of the word.

**PETER:** That certainly makes sense. Are there any rules of thumb that you use with trademark investigations such as contacting multiple sources?

**TONY:** If at all possible we try to speak with at least two or three people at a company, at different levels, in different departments, if feasible, to make sure the information we are being told is correct. If there are inconsistencies, we continue to speak with people until we feel confident that we have enough information to make an assessment of how the mark is used.

When dealing with an individual or a very small company, of course, this may not be possible. We also try to confirm facts through outside sources as well.

For instance, if a company is selling a product, we will contact a distributor and/or a retailer to make sure that the product is actually in the store and on the shelves. There have certainly been instances when we have been told a product is available, but it is nowhere to be found at the retail level.

### Ethical Issues in Trademark Investigations

**PETER:** Trademark practitioners face ethical issues all the time. What kind of particular ethical issues come up in trademark investigations?

**TONY:** Sometimes a client may have questions about how we get information, but we are licensed by New York State and there are guidelines and regulations that we must, and do, follow, so we definitely don’t cross any ethical boundaries.

The issue mainly comes up because of various news stories where some other investigator has crossed a line. We know that, in the long run, crossing a boundary won’t do any favors for us and, most importantly, for our client.

**PETER:** Have there been any specific example of where you were faced with an ethical dilemma in trademark investigations?

**TONY:** Once, we had an attorney try to get us to alter our statement in an affidavit to make it more favorable to their client. Of course, we would not change our statement and we no longer work with this attorney. We’ve been in business for 18 years and safeguarding our reputation is paramount to that longevity.

### Other Kinds of Trademark Investigations

**PETER:** One of the more pervasive problems for brand owners these days is fighting counterfeit goods. Do you handle any anti-counterfeiting work?

**TONY:** Oh, yes, we’ve handled a lot of anti-counterfeiting matters. In addition to our buying and locating counterfeiters nationwide, here in New York City, we have a relationship with the “peddler task force” of the New York Police Department and meet with them to show them how to identify counterfeit goods that are sold by street peddlers.

On behalf of the client, we usually have to file an affidavit with the NYPD certifying the brand is active. Then, we work with the department identifying locations where knockoffs are being sold.

**PETER:** Investigators sometimes have the image of gumshoe detectives conducting overnight stakeouts out of their cars. Do any of your trademark investigations involve work outside the office such as surveillances?

**TONY:** We often have trademark cases that require out-of-the-office work such as making purchases, going to locations to acquire information, checking out an address, and conducting surveillances, especially relating to counterfeit goods in an effort to determine the ultimate source of the goods.

**PETER:** Trademark owners may also have patents to enforce and defend. Do you do any investigations in connection with patent matters?

**TONY:** Yes. Not as many patent cases as trademark cases, but we do know our way around a patent investigation. We have looked for “prior art” and on one case in particular even visited a factory to see how accessible it was in an effort to show that it would have been possible for someone to visit the factory and see the product before it was released to the market.

**PETER:** Maybe the only issue bigger than anti-counterfeiting for trademark owners nowadays is dealing with internet domain names. I have had you purchase domain names on behalf of many of my clients. How long have you been handling domain name acquisition work?

**TONY:** We have been making anonymous domain buys since the dawn of the internet era. Remember when Network Solutions was the only registrar, and a domain transfer was done by paper through the mail and might take weeks? Half the cases currently on my desk are domain name or trademark acquisitions.

**PETER:** Some of those are probably mine. Are domain name matters still increasing in volume and what changes do you see in the future?

**TONY:** Yes, of course, but certain types of domain name matters have leveled off. However, with ICANN’s new generic TLDs on the horizon, there may be a return of many of the issues from the early days.

A lot will depend on how well ICANN handles the process and controls the registrars, which is always the big question. I think there will definitely be some bumps in the road.

### Foreign Trademark Investigations

**PETER:** Trademark practice is so much about international issues these days. Do you handle any investigations outside the U.S.?

**TONY:** Absolutely. We are involved in quite a number of international investigations and typically always have cases with some international references. We have

investigators that speak other languages and have a wide range of contacts as well.

**PETER:** How do foreign investigations differ from domestic?

**TONY:** I would say the main difference is the interaction with the people and that things in different countries are handled in various ways. However, in the end, it is still about getting accurate and specific information.

### Working With Clients

**PETER:** Do you have any advice for trademark practitioners as far as best practices when dealing with investigators?

**TONY:** Communicate. Also, make sure the investigator has all of the information the attorney has. Trust is a two-way street.

**PETER:** What makes an investigator good at his or her job?

**TONY:** For any investigation, trademark or otherwise, you want an investigator who is diligent, thorough, intelligent, and subtle. Being a good investigator requires a high level of innate curiosity and a real ability to quickly assess a situation and make a decision.

**PETER:** I often feel pressure from clients to instruct investigations and report the results on an urgent basis. How long do investigations usually take from instruction until report?

**TONY:** “When does the client need the report?” is our usual answer to that question. Our standard turnaround time is five to seven days, but if a client has a deadline, we will make every effort to meet that deadline, even if it is the same day, with as much information as we can get in that period.

Sadly, not everyone in the world is in their office all the time waiting for our inquiry.

**PETER:** How have trademark investigations changed over the years?

**TONY:** The old cliché is pretty true: the more things change, the more they stay the same. The internet has made it seem like all information is online, but it isn’t—the trick is to know where to look, how to look, and how to analyze the information that is there.

Also, quite often you have to dig a long, long way to get even just a lead, but this lead, if you have the patience to find it, may be the key to the entire investigation.

### Conclusion

**PETER:** Thanks for your insight into the investigative process. It was very interesting to hear how things work behind the scenes.

**TONY:** And thank you for taking the time to speak with me. I am always interested to learn about what clients think of our work and how our findings are used in the trademark process.