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GLOBAL LEADERS

Russell C Pangborn

Partner | Seed Intellectual Property Law Group LLP

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INTERVIEWS WITH THE
PINNACLE OF THE
TRADEMARK PROFESSION

Russell C Pangborn

WTR says: As brilliant in private practice as he was serving in top in-house roles, Russell Pangborn is a leading light on issues at the intersection of trademark law and technology. As a strategic counsellor and all-round brand guardian, he is virtually unmatched.

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Biography

Russell Pangborn is a partner at Seed IP Law Group in Seattle WA. He specialises in trademarks and internet policy and is the chair of the firm's trademark practice. He was previously global head of trademarks at Microsoft and a senior trademark attorney at Intel. Mr Pangborn served on the INTA board of directors and its executive committee, and is now on the internet committee. He is also a member of ICANN's Intellectual Property Constituency.



What has been one of your biggest achievements over the past year?

I have been blessed to make it through this pandemic and still be thriving. I am vaccinated and healthy, and am still working full tilt to help meet my clients' IP needs. I consider this the best achievement of all.

Our ability to work remotely and still be as effective as ever was a surprise to many. But with technological advances geared towards allowing people to be connected from anywhere, it should not be too shocking that we (IP attorneys) have been able to continue the seamless IP work that is so important to the success of our clients.

Which technologies/technological tools do you rely on most for your day-to-day role?

I rely on so many aspects of technology to get by in my day-to-day role. On the daily connected level, I rely on the Cloud, WiFi, Bluetooth, the Internet, my Microsoft Surface laptop, my iPhone, my Apple watch and too many apps to name. With virtual meetings a necessity, I have regularly used Microsoft Teams and Zoom for group calls. There are times when email, text, Skype, Facebook Messenger, Zoom chat and Cisco Jabber are all going simultaneously.

Similarly, scanning the Internet through Google and Bing searches, while browsing through Chrome, Edge and Safari browsers helps me to find vital information instantly. And if my hands are occupied and unable to type, asking Alexa or Siri for assistance usually gets me what I need.

As you might have noticed, I am a tech junky.

What does effective leadership look like to you?

Effective leadership provides vision, inspiration and direction. Effective leadership also involves being prudent, fiscally responsible and focused. It enables individuals to thrive and provides autonomy to team members, allowing them to succeed, while helping to right the course when folks drift.

I am fortunate to have had the opportunity to work at companies such as Microsoft and Intel, as well as a firm like Seed IP, where truly visionary leaders have inspired me and shown me not only how difficult it is to be an effective leader, but also how important effective leadership is.

You were part of the Implementation Recommendation Team (IRT) that led the process to define rights protection mechanisms (RPMs) for the new gTLD space. What key skills did your involvement in that process help to develop and how can policy advocacy work benefit practice development?

It was an honour to be part of a group of such incredible and accomplished internet and IP experts who made up the IRT. At the time I did not realise what an impact participation on that team would have on my career and my personal life, as so many members became friends in addition to professional colleagues. I became involved in ICANN in the lead-up to the new gTLD programme simply to voice concerns about the levels of trademark abuse in the domain name space. Little did I know that this would lead to me being selected as one of the 18 members of the IRT asked to come together as representatives from various continents and with various interests charged with developing RPMs for new gTLDs in a very short amount of time. This monstrous task galvanised the members of the IRT and many of those colleagues remain close friends and confidantes to this day.

Of course, the ICANN policy development process somewhat watered down the RPMs proposed by the IRT, but the effort resulted in the inclusion of the Trademark Clearinghouse, the URS system, a post-delegation dispute resolution process and a significant WHOIS requirement (pre-EU General Data Protection Regulation (GDPR)) in the final system.

My involvement in this process helped me to develop more effective negotiation skills, patience and coalition-building techniques. So much of internet policy development requires problem solving and collaboration with varying perspectives, including opposing parties as well as like-minded participants. In the heated debates that take place in addressing policy problems, I constantly have to remind myself that it is more important to influence a party a little in the direction sought than to 'win' the argument. Often, winning an argument simply causes hard feelings on the other side and creates a longer-term opponent.

Policy advocacy is essential for online businesses to thrive. Rules for how business is carried out on the Internet are literally being written as we speak. Being able to understand issues and influence outcomes on

topics such as domain name system abuse, trademark infringement, platform protections and safe harbours, personal privacy and so many other uniquely online issues can really differentiate your practice. The future of the practice runs through the Internet, now more than ever in the pandemic (and post-pandemic) environment.

How soon are we likely to see the next new gTLD application round open and what significant changes could there be from a rights protection perspective (compared to round one) that trademark owners need to be aware of?

Any statements about when the next round will open are simply guesswork. That said, the New gTLD Subsequent Procedures Working Group has issued its final report and there is hope – or frustration, depending on your perspective – that a new round could commence within one to two years. Of course, this still means that new gTLDs will not finish the application through implementation to delegation phases of the process for three to five years. During that time, discussions will continue about the RPMs in place from the latest round, while a review of the pre-existing UDRP is kicking off. From a trademark owner and practitioner perspective, the UDRP process has been a successful tool for addressing trademark infringement in domain names, cybersquatting, typo squatting and the like for more than a decade. There is a healthy concern that too much tinkering with the UDRP could have dire consequences.

How can brand owners work with external parties such as online platforms and regulatory authorities to better protect their rights online?

Many online platforms have policies and tools that help trademark and content owners to find and address abuse on the given platform. Working directly with platforms is often a more effective way of addressing issues on online marketplaces than direct threats of litigation. Similarly, government agencies focused on IP abuses are extremely willing to cooperate and even assist in pursuing bad actors for online scams. Outreach and close collaboration with these government assets increase the chances of success.

What impact would the the Integrity, Notification and Fairness in Online Retail Marketplaces for Consumers Act (INFORM Consumers Act) have on your clients' brand protection strategies and how likely is this to pass?

The INFORM Consumers Act is directed to online retail marketplaces. It would require these marketplaces to authenticate high-volume third-party sellers of consumer products, with the aim of deterring the sale of counterfeit goods by anonymous sellers. Crucially, the bill would enable consumers to access base-level identification and contact information for these sellers – namely, the seller's name, business address, email address and phone number.

This stands in stark contrast to the current masking of registrant data that is happening in the domain name space as a result of an over-application of the GDPR by many registrars and registries. If passed, the INFORM Consumers Act should improve marketplace verification processes and provide greater transparency to end users of online marketplaces, furthering consumer trust in online shopping.

Which recent US court decisions are likely to have the biggest long-term impact on IP enforcement in the country?

First, *Booking.com*. The US Supreme Court weighed in on a trademark case in 2020, so this is an obvious choice for its long-term impact in the United States. In short, rather than follow the USPTO's *per se* rule that a generic term is not registrable, the court held that whether a term is generic or a protectable trademark must be determined by reference to consumer perception. In this case, even the addition of a gTLD extension like '.com' to the end of a category term was sufficient to create a term that may be perceived and thus protectable as a trademark. Consumer perception carries the day.

Second, First Amendment expression still prevails over alleged trademark infringement. We have seen this play out in case after case. Most recently, in *VIP Prods, LLC v Jack Daniel's Prop, Inc*, the Ninth Circuit, in overturning a district court ruling of infringement, held that even where the goods involved were commercially sold products, the parody aspects of the product line were dubbed an expressive work and

thus warranted First Amendment protection (ie, no trademark infringement). In this case, VIP sold a Jack Daniel's bottle lookalike dog toy called the Bad Spaniel, which conveyed a "humorous message". This made the product an expressive work – even though it was sold commercially. Because it was an expressive work, the *Rogers v Grimaldi* test applied. Jack Daniel's also alleged trademark dilution in this case. Again, the court sided with the defendant, noting that because the dog toy conveyed an expressive message, it fell within a non-commercial use exception of the Trademark Dilution Revision Act.

Many other cases of importance are certain to be impactful going forward, but these two, to me, are certain to have an impact for years to come.

How do you work with clients to establish the most cost-effective solution for their IP needs?

Working with clients to understand their business and helping to prioritise the importance of their primary brands and the impact of those brands on target

consumers are key factors in coming up with cost-effective solutions for their IP needs. I have the benefit of having been on the inside of major corporations that required close budgeting and accountability to those budgets in building and maintaining trademark and domain name portfolios. This experience enables me to help companies, big or small, to be selective in trademark adoption, international expansion and how to utilise tools and systems to provide the broadest protection for the cost, as well as having a network of top regional counsel to effectively secure or protect their brands beyond borders.

What long-lasting impact do you expect the covid-19 pandemic to have on global IP practice?

The covid-19 pandemic has had a profound impact on all of us and how we do business. However, in forcing people to isolate and work from home, it has shown businesses and their counsel that much of IP practice can be done from anywhere – but all of that is enabled by the Internet.