

I Am ... Other — How Trademark Owners Can Avoid Declaratory Judgment Actions

Article By:

Nathaniel W. Edwards

Singer-songwriter Pharrell Williams recently filed a declaratory judgment suit in the Southern District of New York against will.i.am of the music group The Black Eyed Peas. will.i.am owns the trademarks I AM and WILL.I.AM for clothing and entertainment and philanthropic services. The two artists have been in a dispute since will.i.am sent a cease and desist letter to Pharrell in December 2012 regarding Pharrell's use of the mark I AM OTHER for clothing and entertainment production. In April 2013, will.i.am filed oppositions against Pharrell's eight pending federal trademark applications for the I AM OTHER mark. Apparently fed up with will.i.am's trademark enforcement tactics, Pharrell filed suit seeking a ruling that his I AM OTHER mark does not infringe the I AM and WILL.I.AM trademarks.

The case raises an issue many trademark owners face when policing their trademarks. When do enforcement actions cross over the imaginary "actual controversy" line and subject mark owners to potential declaratory judgment suits? Under Article III of the U.S. Constitution and the Declaratory Judgment Act (DCA) of 1948, federal courts have subject matter jurisdiction to hear declaratory judgment suits only when an "actual controversy" exists. In the trademark context, there is no set rule for when an "actual controversy" exists. Courts consistently hold that determining whether there is an actual controversy depends on the "matter of degree" of the mark owner's enforcement actions, which must be determined on a case-by-case basis. See, e.g., *Kidder, Peabody & Co. v. Maxus Energy Corp.*, 925 F.2d 556, 562 (2d Cir. 1991). In making the determination, courts employ a two-part test. First, the alleged infringer plaintiff must have a "real and reasonable apprehension of litigation;" and second, the plaintiff must have "engaged in a course of conduct which brought it into actual conflict" with the trademark owner defendant. See *id.*

Decisions regarding whether an actual controversy exists are all over the map. Enforcement actions sufficient to warrant jurisdiction in one case are held insufficient to create an actual controversy in another. Because the courts are unpredictable when it comes to determining whether there is an actual controversy, the truth of the matter is that mark owners risk declaratory judgment actions every time cease and desist letters are sent. This is a scary proposition for trademark owners because alleged infringers can file declaratory judgment suits in jurisdictions that are inconvenient or unfavorable for mark owners.

There are, however, precautions mark owners can take to try to insulate themselves from declaratory

judgment actions. Avoid attaching a draft complaint to a cease and desist letter or threatening imminent suit because doing so almost surely puts mark owners in danger of a declaratory judgment suit. Even mentioning litigation in a cease and desist letter is a risky proposition for mark owners hoping to avoid litigation. If litigation is mentioned (or even if it is not), mark owners should state that they desire to resolve the matter amicably. If a mark owner desires to avoid litigation at all costs, cease and desist letters can be drafted in a “soft” tone. However, such a tone may indicate to the alleged infringer that the mark owner does not believe it has strong rights in the mark and/or that the mark owner will not escalate enforcement actions beyond the initial cease and desist letter. Mark owners should also be careful about sending a second (or third or fourth) cease and desist letter if the first letter does not have the desired effect.

Finally, filing or threatening to file opposition or cancellation proceedings against an alleged infringer’s federal trademark application or registration can easily vault a trademark dispute into actual controversy territory. It remains to be seen whether will.i.am will challenge the court’s jurisdiction to hear Pharrell’s suit, but will.i.am’s cease and desist letter combined with what appear to be multiple other cease and desist demands and the opposition filings against Pharrell’s I AM OTHER applications effectively concede jurisdiction in Pharrell’s declaratory judgment suit.

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