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7 Attorneys for Plaintiff,  
FISH IP LAW, LLP.

8  
9 **UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
10 **SAN FRANCISCO DIVISION**

11 FISH IP LAW, LLP, a California limited liability  
partnership,,  
12

13 Plaintiff,

14 v.

15 FISH & RICHARDSON, P.C., a Massachusetts  
corporation,,  
16

17 Defendant.

Case No. 3:17-cv-5361

**COMPLAINT FOR DECLARATORY  
JUDGMENT OF NON-INFRINGEMENT  
PURSUANT TO 15 U.S.C. §1125**

**DEMAND FOR JURY TRIAL**

1 Plaintiff Fish IP Law, LLP (“Fish IP Law”) hereby brings the following Complaint against  
2 Fish & Richardson, P.C. (“F&R”) and alleges the following:

3 **PARTIES**

4 1. Fish IP Law is a limited liability partnership with its principal place of business in Irvine,  
5 California. Fish IP Law is a small firm with 10 lawyers in two offices in California. Fish IP Law  
6 has been using its name in commerce for over 10 years.

7 2. Plaintiff is informed and believes, and based thereon alleges that Defendant Fish &  
8 Richardson is a partnership company with its principal place of business in Boston, Massachusetts,  
9 and is registered to do business in California. F&R is one of the largest law firms in the world;  
10 and on information and belief F&R currently employs over 354 lawyers in 12 offices around the  
11 United States.

12  
13 **VENUE**

14 3. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) through (d), because  
15 Defendant resides and conducts business in this District, and a substantial portion of the facts and  
16 circumstances giving rise to the claims in this case took place in this District.

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18  
19 **JURISDICTION**

20 4. Defendant is subject to personal jurisdiction in this judicial district, because it conducts  
21 business in this district and has purposefully directed its activities at the State of California, and  
22 this action arises out of and relates to those activities. Defendant has two offices in the State of  
23 California, one in Southern California and another in this District. Defendant has an office in this  
24 District located at 500 Arguello Street, Suite 500, Redwood City, CA 94063.

25 5. This Court has subject matter jurisdiction over Plaintiff’s causes of action asserted herein  
26 pursuant to 28 U.S.C. §§ 1331 and 1338(a), because the claims arise under the Federal Declaratory  
27 Judgment Act, 28 U.S.C. §§ 2201 and 2202, and the Lanham Act, 15 U.S.C. §§1125 (a) and (c).

28 6. As alleged more fully below, there is an actual, immediate dispute existing between

1 Plaintiff and Defendant regarding the non-infringement of the FISH Mark.

2  
3 **NATURE OF THE ACTION**

4 7. Plaintiff seeks a declaratory judgment of non-infringement of the trademarks asserted  
5 against Fish IP Law by Defendant F&R.

6 8. F&R has asserted that Fish IP Law is infringing F&R's trademark "FISH" by using its  
7 law firm name "Fish IP Law LLP," and that Fish IP Law made changes to the firm logo and online  
8 advertising that mimic F&R. Fish IP Law denies that it has infringed any trademarks owned by  
9 F&R.

10 **FACTUAL BACKGROUND**

11 9. Robert D. Fish is Fish IP Law's Founding Partner. Mr. Fish used his surname as part of  
12 the firm name when he founded the firm in 2007.

13 10. In addition, Mr. Fish has continuously used the name Fish as part of the name of various  
14 law firms in which he was sole owner or a partner, ever since 1995.

15 11. Mr. Fish started using the name Fish as a law firm name when he was co-founder of  
16 Crocket & Fish, LLP in 1995. He then switched over to Fish & Associates LLP in 2000.

17 12. Mr. Fish joined Rutan & Tucker as a partner in 2002, but despite that move, Mr. Fish  
18 retained the name Fish & Associates LLP as an ongoing entity. Fish & Associates LLP continued  
19 with relatively minor usage until Mr. Fish left Rutan & Tucker in 2007.

20 13. In 2007, Mr. Fish hired additional attorneys and began working full time in a new firm  
21 called Fish & Associates PC.

22 14. In 2014 the assets and liabilities of Fish & Associates PC were merged into Fish &  
23 Tsang, LLP, however with Fish & Associates PC continuing to exist.

24 15. In July 2017, with departure of Mei Tsang from the firm, Fish & Tsang LLP was  
25 renamed to Fish IP Law.

26 16. As in each of the other incarnations of the law firm, the firm's name has always include  
27 the word "Fish" in reference to the firm's founding partner, Mr. Robert Fish.

28 17. Fish IP Law has offices in Orange County and Silicon Valley.

1 18. "IP Law" is descriptive of the services Fish IP Law offers. Fish IP Law offers legal  
2 services in the area of intellectual property law "IP Law", and also offers legal services in general  
3 and commercial litigation.

4 19. Fish IP Law was never a large firm. At its height, the firm employed a total of  
5 approximately 19 attorneys and patent agents in its offices.

6 20. Fish IP Law is a boutique law firm and emphasizes cost-effectiveness, personal attention  
7 to client needs, and other benefits, relative to other large AMLaw 100 firms.

8 21. Fish IP Law has been using the name "Fish," including use of [www.fishiplaw.com](http://www.fishiplaw.com) as its  
9 website, and in numerous firm email address for over ten (10) years. Fish IP recently acquired the  
10 domain name fish-ip.com.

11 22. Plaintiff is informed and believes F&R's website domain is [www.fr.com](http://www.fr.com).

12 23. Plaintiff is informed and believes F&R has 12 offices, including but not limited to those  
13 located in Atlanta, Austin, Boston, Dallas, Delaware, Houston, Munich, New York, Redwood  
14 City, San Diego, Minneapolis, and Washington, D.C.

15 24. Plaintiff is informed and believes that F&R employs approximately 354 attorneys.

16 25. Plaintiff is informed and believes F&R has registered several Marks containing the word  
17 Fish such as "FISHLINK," "FISH & RICHARDSON," "FISHLINK," "GO FISH," and also other  
18 Marks including "WHO'S YOUR DADDY", collectively "FISH Marks".

19 26. Plaintiff is informed and believes that F&R is the owner of the Word Mark and design  
20 for FISH, FISH & RICHARDSON, U.S. Reg. No. 4,792,956. *See* Exhibit A.

21 27. Plaintiff is informed and believes F&R uses the term FISH in conjunction with a colored  
22 diamond.

23 28. Plaintiff is informed and believes that F&R purchased ad words from Bing.com and  
24 Google.com for the search terms "Fish IP Law" and "Fish Intellectual Property" Plaintiff is  
25 unaware of any other use in commerce F&R made or attempted to make of the term "Fish IP Law"  
26 or "Fish Intellectual Property". The term "Fish IP Law" appears nowhere on the F&R website.

27 29. Plaintiff is informed and believes F&R has not registered a Mark for "Fish IP Law" or  
28 "Fish Intellectual Property," or anything similar to it.

1        30. Plaintiff is informed and believes F&R currently does not have a partner listed on its  
2 website with the last name Fish.

3        31. Plaintiff is also informed and believes that F&R was not the first United States law firm  
4 with “Fish” in its name to practice intellectual property law.

5        32. Plaintiff is informed and believes that the law firm Fish & Neave (which has now since  
6 merged with Ropes & Gray) was an intellectual property law firm.

7        33. Plaintiff is informed and believes the legal industry is currently changing because of  
8 client demand. Clients are more sophisticated consumers of legal services. Consumers of legal  
9 services will generally research a law firm before retaining a particular firm.

10                                    **PLAINTIFF’S REASONABLE APPREHENSION OF SUIT**

11        34. On or about August 15, 2017, F&R sent a threatening cease and desist letter to Fish IP  
12 Law. A true and correct copy of the letter is attached hereto as Exhibit B. The letter threatens  
13 litigation as it states the following:

14                    [Y]our firm has mimicked the format of Fish’s registered logo with a logo that emphasizes  
15 the term FISH in white font on top of the term IP Law, shown in smaller font, and  
16 displayed with a geometric shape...We insist that your firm immediately cease and desist  
17 from using FISH as shown above and in the attached exhibits, and that your firm revise its  
18 name and current use of FISH and FISH IP LAW in a manner that is sufficiently distinct  
19 from our firm’s use of the FISH Marks to avoid confusing...Please provide us with your  
written assurances no later than August 28, 2017 that you will comply with this request  
and advise us what steps you propose taking, including what the new proposed name of  
your firm will be.

20                    See Exhibit B at 3, 6.

21        35. On or about August 16, 2017, Fish IP sent a response email to F&R’s August 15, 2017  
22 letter. A true and correct copy of the email is attached hereto as Exhibit C.

23        36. On or about September 1, 2017, F&R sent another letter to Fish IP threatening litigation,  
24 accusing Fish IP of trademark infringement in connection with its firm name change. A true and  
25 correct copy of the letter is attached hereto as Exhibit D. The letter again threatens litigation as it  
26 states the following:

27                    Fish [F&R] would like to resolve this matter amicably, if that is possible. We are hopeful  
28 that you share this sentiment and would prefer to proceed on that basis incurring

substantial expenses in connection with a dispute. However, given the irreparable damage to our firm and its reputation, Fish is prepared to *enforce its rights vigorously*.

See Exhibit D at 2 (emphasis added).

37. Based on the combination of the two letters from F&R, it is reasonable for Plaintiff to develop a real and reasonable apprehension that it would be subject to a claim for liability for trademark infringement.

**COUNT ONE  
DECLARATORY JUDGMENT OF NONINFRINGEMENT OF THE FISH MARK  
UNDER 15 U.S.C. §1125**

38. Plaintiff re-alleges and incorporates by reference each and every allegation in the paragraphs above.

39. F&R does not have an ownership interest in the word “Fish” itself. F&R’s referenced service marks incorporating the word “FISH” appear only in the context of design marks that incorporate additional shapes and words. For example, F&R’s service mark, U.S. Trademark Registration no. 4,802,053 specifically “consists of the word “FISH” next to a completely shaded diamond.” Despite the inclusion of the word “FISH” in its service mark, F&R owns no right to the word “Fish” alone or when placed alongside a description of the services provided by Fish IP Law or any other entity for that matter. Furthermore, F&R owns no trademark for “Fish IP Law,” or anything close to it.

40. F&R does not have evidence of its use or registration of “Fish IP Law” or anything close to it.

41. Furthermore, Fish IP Law’s use of “IP Law” and “Intellectual Property Group” on its website and in conjunction with its name is highly descriptive of the services provided by Fish IP Law and constitutes matter that does not function as a service mark. TMEP §1301.02(a). “Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use.” *Id*; As such, F&R’s attempt to assert its ownership over a description of a practice area of legal services and demand that Fish IP Law rename its law firm to remove the description of its primary practice area is baseless.

1 Whatever Fish Marks exist, such registrations do not give F&R a right to demand Fish IP Law  
2 change its name in such a way.

3 42. Plaintiff has not directly infringed, contributorily infringed, and has not induced  
4 infringement of the Fish Marks by the use of its firm name, "Fish IP Law." Nor does the use of  
5 the firm name "Fish IP Law" infringe upon any of the Fish Marks.

6 43. There is no reasonable likelihood of confusion, mistake, or error in the legal marketplace  
7 for a consumer who is seeking legal services for F&R to consider Fish IP Law instead.

8 44. Plaintiff is informed and believes that even if there is confusion, it can be easily  
9 dispelled.

10 45. An actual, present, and justiciable controversy has arisen between Fish IP Law and F&R  
11 concerning Fish IP Law's alleged infringement of the Fish Marks.

12 46. Fish IP Law seeks declaratory judgment from this Court that its use of its firm name,  
13 Fish IP Law, does not constitute trademark infringement.

14  
15 **COUNT TWO**  
16 **DECLARATORY JUDGMENT OF NONINFRINGEMENT OF THE FISH MARK**  
17 **UNDER COMMON LAW TRADEMARK**

18 47. Plaintiff re-alleges and incorporates by reference each and every allegation in the  
19 paragraphs above.

20 48. F&R cannot establish an ownership interest or exclusive use of the term "Fish."  
21 Moreover, F&R owns no common law trademark for "Fish IP Law," or anything close to it.

22 49. There is no reasonable likelihood of confusion, mistake, or error in the legal marketplace  
23 for a consumer who is seeking legal services for F&R to consider Fish IP Law instead.

24 50. An actual, present and justiciable controversy has arisen between Fish IP Law and F&R  
25 concerning Fish IP Law's alleged use of F&R's common law trademark rights.

26 51. Fish IP seeks declaratory judgment from this Court that its use of its firm name, Fish IP  
27 Law, does not infringe any common law trademark rights of F&R in the word "FISH."

28 **PRAYER FOR RELIEF**

WHEREFORE, Plaintiff prays for relief and judgment as follows:

- 1 a) A judgment declaring that F&R does not have exclusive use of the word FISH;  
2 b) A judgment declaring that Fish IP Law does not infringe upon any of F&R's trademark  
3 rights;  
4 and  
5 c) Any other and further relief that this Court may deem just and proper.

6 **DEMAND FOR JURY TRIAL**

7 Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a jury trial.

8 FISH IP LAW, LLP  
9

10 By John van Loben Sels

11 John D. van Loben Sels

12 Attorneys for Plaintiff, FISH IP LAW, LLP  
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