

Litigators of the Week: Wilmer Wins Big ‘Simply Prepaid’ Trademark Fight for T-Mobile

Joseph Mueller and Brittany Amadi of Wilmer Cutler Pickering Hale and Dorr won summary judgment that Simply Wireless abandoned its unregistered trademark for “Simply Prepaid.” Their client T-Mobile has generated more than \$1 billion in revenues from its “Simply Prepaid” services.

By Ross Todd
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The trademark scrum over “Simply Prepaid” hasn’t been so simple.

Simply Wireless, which from 2002 through 2008 sold pre-paid airtime for cell phones at www.simplyprepaid.com, claims it has common law ownership of the “Simply Prepaid” mark.

T-Mobile’s retail dealers, meanwhile, began operating stores under the “Simply Prepaid” name in June 2014. The company so far has made more than \$1 billion in revenues from wireless services using the “Simply Prepaid” mark, which it’s sought to register.

This simply had to end up in court.

With both sides filing dueling motions for summary judgment on the ownership question, Senior U.S. District Judge Anthony Trenga in Alexandria, Virginia, held in-person arguments in February, and a round of supplement arguments via Zoom in April. In a 30-page opinion made public this week, Trenga sided with T-Mobile and its counsel, **Joseph Mueller** and **Brittany Amadi** of **Wilmer Cutler Pickering Hale and Dorr**, this week’s Litigators of the Week.

Trenga found that Simply Wireless had abandoned its mark as of 2012 by not using the “Simply Prepaid” mark for three-plus years. The judge further found the company’s “sporadic” use of the



(L-R) Joseph Mueller and Brittany Amadi of Wilmer Cutler Pickering Hale and Dorr.

Courtesy photos

mark since hadn’t re-established common law ownership.

Who is your client and what was at stake?

Joe Mueller: Our client is T-Mobile, which is one of the three largest mobile network providers in the United States. T-Mobile sells wireless mobile service in both the post-paid category, meaning that a customer signs up for a mobile plan that includes a monthly service charge, and the pre-paid category, where a customer purchases service as they go.

At stake in this case was T-Mobile’s right to market one of its pre-paid service plans under the

name “Simply Prepaid.” The plaintiff in the case, Simply Wireless, alleged that T-Mobile’s use of the name “Simply Prepaid” on certain pre-paid rate plans infringed common law trademark rights that Simply Wireless claimed to have in that name, and Simply Wireless sought—among other things—disgorgement of T-Mobile’s profits associated with the accused services.

Who was on your team and how did you divide the work?

Brittany Amadi: We had an amazing team on this case. Our WilmerHale team joined relatively late in the proceedings, and immediately began the task of getting our arms around the facts in the case on a very tight timeline—the case was filed in May 2021, with the final pretrial conference set for December 2021, just seven months later. It was truly a rocket docket! From the moment our WilmerHale team joined the case, it was all hands on deck in every aspect of the case. Two of the key ingredients to the team’s approach were collaboration and collegiality with each other, and with our co-counsel and the T-Mobile in-house team.

We had a terrific collaboration with our co-counsel from the **Polsinelli** firm—including **Russ Jones** and **Jay Heidrick**—who worked seamlessly with our team. The WilmerHale contingent included **Joss Berteaud**, **Lanta Chase**, **Will Conlon**, **Vinita Ferrera**, **Gideon Hanft**, **Colleen Jackson**, **Rauvin Johl**, **Hallie Levin**, **Becky Middleton**, **Chip O’Neill**, **Jim Quarles**, **Emily Scherker** and **Michaela Sewall**. And of course, we worked hand-in-hand with T-Mobile’s fabulous in-house counsel—such as **Melissa Scanlan** and **Jon Putman**—who provided critical support and wise judgment at every step. The summary judgment decision was in every sense a team effort.

We’re talking about an unregistered trademark. How does that affect your approach to defending an accused infringer?

Mueller: It required taking an extremely close look at both the law and the facts, and bringing a

high degree of analytical intensity to identifying the best arguments and the best ways to present them. These types of trademark cases do not have a rote, paint-by-numbers playbook. Our stellar team stepped up to the challenge and marshaled all the right legal and factual arguments.

Amadi: One of the interesting aspects of the case was its lengthy factual and procedural history, which meant piecing together the facts and related proceedings that had occurred over a fairly extended time period. The parties were initially involved in litigation arising from the same facts in 2015, which was ultimately dismissed. When the claims were re-filed in 2021, six years had passed and that meant not only changes and developments in key facts that bear on whether a party owns rights in a common law mark, but also additional decisions that bore on the relevant doctrine.

How did you piece together when and how Simply Wireless used the “Simply Prepaid” mark?

Amadi: As we started to dig deeper into the facts, it became clear that there were key (and lengthy) gaps in the public record related to Simply Wireless’s use of the term “Simply Prepaid.” While the complaint claimed that Simply Wireless began using the term in 2002, there was essentially nothing in the public domain to back up those claims. So discovery was critical here.

Mueller: We had to pore over the documentary record—and also conduct depositions of key witnesses—to nail down the full chronology. This meant pressing for specific details on how, where, and, importantly, when Simply Wireless was using “Simply Prepaid” before T-Mobile first began using it. The more we pressed, the more confident we became that this was an issue ripe for summary judgment.

There was a big debate about what “continuous” means when it comes to an owner of a common law mark showing “deliberate and continuous use.” I gather you thought you would

win on that issue. Were you surprised at where the court landed on that question?

Mueller: Well, we certainly thought we had strong legal arguments on that issue, and we believe the court would have been on firm ground in ruling in our favor on the legal question. That said, the court also was on very firm ground for the separate issue of abandonment on which the court based its holding. And we're highly appreciative of the obvious energy and diligence with which the court approached this case.

After you had fully briefed the cross-motions for summary judgment and argued them in person in February, the judge ordered a supplemental Zoom hearing in April on some additional questions. How did the judge's move affect your arguments on the second go-round? Did the judge's questions prompt you to focus any more on the abandonment issues you ultimately won on?

Amadi: Heading into the supplemental hearing, we had the benefit of the court having identified specific questions on which it was seeking argument. That was invaluable—it allowed us to sharpen our focus and hone in on the key issues. The questions also made clear that the court was drilling down into both the law and the facts, and devoting considerable time and attention to both. That was extremely encouraging to us, because we believed that the closer the court looked at this case, the clearer the legal and factual problems with the plaintiff's case would be. The supplemental briefing and hearing also gave us the opportunity to more fully ventilate additional arguments—like abandonment.

What's important in this decision for companies that find themselves in T-Mobile's position?

Mueller: Because of the forms of damages that are theoretically possible under the statute—including

disgorgement of profits—trademark cases can present scenarios that, however unlikely, could be high-delta events if they actually occur. The best way to ensure those high-delta events do not occur is to devote the resources necessary to litigate the cases with great care on both the law and the facts. It may require greater investment of time and money on the front end, but that investment will help ensure the right legal and factual arguments are made—and hopefully prevent the worst-case scenarios from coming to pass.

What will you remember most about this matter?

Amadi: What stands out the most is not necessarily the factual or legal intricacies of the case, but how our WilmerHale team, our co-counsel, and our in-house colleagues worked so seamlessly together, with every member of the larger team contributing to such a phenomenal result for our client. As I noted earlier, we had truly wonderful colleagues with whom we collaborated, both within WilmerHale, our co-counsel from Polsinelli, and the T-Mobile in-house team.

Mueller: One thing that stands out about our WilmerHale team in this case is that it was drawn from multiple practice groups within the firm. As a firm, we have been focusing on promoting interdisciplinary collaboration on high-stakes matters. That is one of the key objectives of the firm's trial practice, for which Hallie Levin and I serve as co-chairs: to bring together our incredible trial talent from all corners of the firm, and offer an integrated trial platform that can compete—and win—against any firm in the country. Although we prevailed before trial in this case, we had structured our team on this case with that objective in mind. It was a great example of folks from different practices coming together to collaborate and achieve a victory for our client—and having fun doing it!