Kilpatrick

5 KEY TAKEAWAYS

Recent Developments in United States Trademark and Unfair Competition Law

Kilpatrick partner Ted Davis spoke recently at the **American Intellectual Property Law Association's** spring meeting and at the **International Trademark Association's** annual meeting on recent developments in United States trademark and unfair competition law over the trailing twelve months.

Those presentations addressed, inter alia, the following topics:

1

The Supreme Court accepted trademark cases for review at an uncommonly high rate, a development encompassing:

- the Court's attention to the intersection of trademark rights and the right to Free Speech guaranteed by the First Amendment to the United States Constitution;
- the abrogation in *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, of the pro-defendant *Rogers v. Grimaldi* test for liability in cases in which defendants use their alleged imitations of plaintiffs' marks as marks for their own goods and services;
- clarification of the noncommercial use "exclusion" from liability for likely dilution under Section 43(c)(3)(C) of the Lanham Act; and
- the strengthening of the presumption against extraterritorial applications of United States law, including extraterritorial applications of the federal Lanham Act.

2

The possible invalidation of the likely-dilution-by-tarnishment cause of action as impermissibly viewpoint discriminatory reared its head in *Jack Daniel's* on remand.

3

An opinion from a Pennsylvania federal district court signaled the possible unavailability to trademark licensors of the federal cause of action for counterfeiting.

4

The Third Circuit remained the graveyard of trade dress claims with its highly restrictive test for nonfunctionality.

5

Unusually, in light of the trend in its case law over the past ten years, the Trademark Trial and Appeal Board placed at least some limits on the extrastatutory failure-to-function ground for the refusal of applications; the Federal Circuit, however, did not follow suit.

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