

This is your Release #12 (November 2019)

Kane on Trademark Law

A Practitioner's Guide

Sixth Edition

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Release #12

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This release updates the text and provides expert analysis and practical insights regarding a wide range of trademark issues. Highlights of the release include:

Colors as trademarks: In a case involving John Deere's green and yellow, a federal district court in Kentucky granted injunctive relief prohibiting, not the use of either green or yellow alone, but the "use of *any confusingly similar combination* of green and yellow together on a piece of agricultural equipment" (*Deere & Co. v. FIMCO Inc.*). See § 2:10.2[B], at note 134.

Family of marks: The family-of-marks doctrine does not apply in an ex parte trademark application context. An examiner will not reject an applied-for mark on the basis that it is confusingly similar to a family of marks, although an examiner could reject an applied-for mark that is confusingly similar to one or more of the marks in a family. See § 2:14, at note 164.

Genericide: Trademark owners looking to discourage misuse of their marks might note the approach taken by the owner of VELCRO brand fasteners, which released a video, popular on YouTube, depicting company "lawyers" singing "Don't Say Velcro" for non-VELCRO brand products. Also, some misuse may not lead to genericide; as a Ninth Circuit case indicates, the common use of "Google" as a verb meaning to search the Internet does not detract from the public's awareness that GOOGLE is actually a brand name for a particular Internet search engine (*Elliott v. Google, Inc.*). See § 5:2.2, at note 69.6.

Representation of foreign applicants: In an effort to combat an onslaught of fraudulent application submissions from foreign filers, the USPTO now requires all foreign-domiciled trademark applicants, regis-

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trants, and parties to Trademark Trial and Appeal Board proceedings to be represented by an attorney who is licensed to practice law in the United States. See § 6:4, at note 51.1.

Electronic filing—specimens: As of October 5, 2019, with very limited exceptions, all submissions to the USPTO, including specimens, must be filed electronically using the online forms. See § 6:4.5, at note 79. See also § 6:4.11.

False advertising—accurate but misleading statements: In *Miller-Coors, LLC v. Anheuser-Busch Cos.*, a federal district court in Wisconsin issued a preliminary injunction as to advertising statements, such as the statement that Bud Light contains “100% less corn syrup” than Miller Lite, that were accurate but misleading. The scope of the preliminary injunction is an issue on appeal. See § 10:4.1[B], at note 43.

Experts—discovery: If you use the same expert to conduct a pilot survey with poor results and a later full survey used at trial, the original poor results (and the differences in the methodology leading to better results) will be discoverable if the right questions are asked by your opponent. The better course is to keep the pilot survey expert as a consulting expert only, and use another expert to conduct the survey to be used at trial. See § 16:8.5.

Cancellation proceedings—laches: A registrant may have a valid laches defense to a cancellation action brought within the first five years, so it pays to take action quickly upon knowledge of a prior conflicting application. In a Ninth Circuit case involving LUSH for cosmetics and for clothing, laches applied to bar the cosmetics company’s claims for infringement and cancellation of the clothing company’s registration brought within the five-year time frame (*Pinkette Clothing, Inc. v. Cosmetic Warriors Ltd.*). See § 19:4.5[A], at note 224.1.

Immoral or scandalous marks: In *Iancu v. Brunetti*, the Supreme Court held that the statutory prohibition on federal registration of “immoral” or “scandalous” marks is facially invalid under the First Amendment. See § 19:4.5[C][6], at note 228.18.

Licensor bankruptcy—effect on licensee’s rights: In *Mission Product Holdings, Inc. v. Tempnology, LLC*, the Supreme Court held that the debtor-licensor’s rejection of a license agreement contract does not deprive the licensee of its rights to use the trademark, because the rejection breaches the license contract but does not rescind the license contract. “And that means all the rights that would ordinarily survive a contract breach, including those conveyed here [namely, the rights of use conveyed to the licensee], remain in place.” See § 20:10, at note 65.

Trademark fees: Appendix 1 is updated with current fee information.

Color illustrations: Appendix 18 is expanded with a new color illustration of the swan-shaped swimming pool floats at issue in *International Leisure Products, Inc. v. Funboy LLC*.

Dilution statutes: Appendix 21 is updated and expanded to provide statutory citations.

The **Table of Authorities** and the **Index** have also been updated.

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FILING INSTRUCTIONS

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REMOVE OLD PAGES NUMBERED:

- Title page to 12-83
- 14-1 to 17-68
- 19-1 to 20-17
- 22-1 to App. 1-8
- App. 18-1 to App. 18-2
- App. 18-59
- App. 21-1 to I-60

INSERT NEW PAGES NUMBERED:

- Title page to 12-84
- 14-1 to 17-67
- 19-1 to 20-17
- 22-1 to App. 1-4
- App. 18-1 to App. 18-2
- App. 18-59 to App. 18-60
- App. 21-1 to I-61

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