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Kane on Trademark Law

A Practitioner's Guide

Sixth Edition

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In this release, Siegrun D. Kane updates the text and provides her expert analysis and practical insights regarding a wide range of evolving trademark issues. Highlights of this release include:

Phantom marks: The TTAB affirmed refusal of SHAPE XXXX for educational publications and services (*In re Society of Health & Physical Educators*). The public could not predict what marks would be covered by any resulting registrations. See § 6:5.2, at note 145.2.

Incontestability: In *La Bamba Licensing, LLC v. La Bamba Authentic Mexican Cuisine, Inc.*, a federal court in Kentucky noted that ownership of incontestable registration on the Principal Register shifts the burden of proof regarding validity of the mark to any challenger of that validity. See § 7:3.4[B], at note 44.

Expressive works: In *Gordon v. Drape Creative Inc.*, the Ninth Circuit found that although defendant Drape's greeting cards were expressive works, there was a triable issue of material fact as to whether Drape added its own artistic expression to the greeting cards at issue, as opposed to just copying plaintiff Gordon's YouTube catchphrases "Honey Badger Don't Care" and "Honey Badger Don't Give a Shit." See § 12:1.3[E], at note 42.

Ex parte seizures: Various steps should be taken before requesting an ex parte seizure. See new § 8:3.2[B], at note 161.1. Illustrating the pitfalls of such seizures is *Prince of Peace Enterprises, Inc. v. Top Quality Food Market, LLC*. There, the plaintiff seized ninety-six boxes of allegedly infringing products from defendant's premises, but the Southern District of New York found all the seized goods were noninfringing and ordered them returned. The court awarded the defendant \$192,000 for products seized but not returned, plus \$22,343 in attorneys' fees. See new § 8:6.

Genericness: In the latest development in the long-running COKE ZERO case, the Federal Circuit has remanded to the TTAB, which had, in the court's view, misunderstood genericness (*Royal Crown Co. v. Coca-Cola Co.*). Professor McCarthy, in turn, argues that the CAFC has judicially rewritten the statute, smudging the line between descriptive and generic. See § 5:2.2, at note 69.2.

Dilution: In *Ducks Unlimited, Inc. v. Boondux, LLC*, a federal court in Tennessee held that plaintiff's stylized mallard duck head mark—while entitled to

(continued on reverse)

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protection against infringement and other forms of unfair competition—was not a famous mark protected under the Trademark Dilution Revision Act. See § 9:6.4, at note 50.1. Several recent cases illustrate dilution claims that fail because of a mark that was insufficiently distinctive and famous. See new § 9:6.6.

Fictional characters: Rapunzel, a fairy tale character, is under TTAB scrutiny; the question is whether her name belongs in the public domain or can be registered for a line of dolls (*Curtin v. United Trademark Holdings, Inc.*). See § 6:5.2, at note 155.1.

Smells as trademarks: Hasbro has registered PLAY-DOH for “a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough.” See § 1:1.1, at note 1.

TTAB’s evolving position on Internet evidence: The TTAB has made it clear that both applicants and examining attorneys must include the URL (Uniform Resource Locator) and the date the website material was printed when submitting Internet evidence. See § 6:5.2, at note 155.2.

Aesthetic functionality: Louboutin’s red sole shoe was accorded protection by the European Court of Justice. In a June 2018 opinion, the ECJ reversed the European Advocate General, who had refused trademark protection for the combination of color and shape. The case will be referred back to The Hague Court, which is expected to confirm the validity of the red sole trademark. See § 3:2.1[B], at note 45.

WHOIS: Overseen by the Internet Corporation for Assigned Names and Numbers, WHOIS is a system for gathering and managing information as to “who is” responsible for a given domain name or IP address. See § 11:1.1.

Third-party use: In *Sterling Jewelers Inc. v. Artistry Ltd.*, the Sixth Circuit notes that the risk of confusion is remote where nearly two dozen jewelry companies use the word “artistry.” Jewelry retailers are savvy consumers and if they are confused about the difference between Artistry and Sterling’s Artistry Diamond Collection, they know enough to ask and can be given clarification. See § 12:1.2, at note 4.

Marijuana products: In analyzing whether POWERED BY JUJU and JUJU JOINTS for cannabis vaporizing and delivery services are registerable, the TTAB said that to be eligible for federal registration, use of the mark “must not be illegal under federal law.” If the goods or services to be used are illegal under federal law, “‘it is a legal impossibility’ for applicant to have the requisite bona fide intent to use the mark” (*In re JJ206, LLC*). See § 17:4.2, at note 177.1.

ITC Rules of Practice: In May 2018, changes in the rules of the International Trade Commission took effect, with an impact on electronic service, pre-institution motions, privileges, and subpoenas. See § 17:5.3[G].

Interference proceedings abolished: Pursuant to Executive Order 13777, the PTO has amended its Rules of Practice to delete reference to trademark interferences. The interference determined which, if any, owners of conflicting applications or registrations was entitled to registration. The PTO has found the practice outdated and unnecessary. See § 19:6, at note 264.

Termination of licensee’s rights in bankruptcy: On June 11, 2018, Mission Product filed a petition for certiorari from the First Circuit’s decision in *Mission Product Holdings Inc. v. Tempnology LLC (In re Tempnology)*, asking the Supreme Court to determine whether “a debtor-licensor’s rejection of an intellectual property agreement under § 365 of the Bankruptcy Code . . . terminates the licensee’s rights under the agreement.” If the Court takes the case, it will presumably resolve a circuit split. See § 20:10, at note 63.2.

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

FILING INSTRUCTIONS

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REMOVE OLD PAGES NUMBERED:

- Title page to 3-33
- 5-1 to 12-83
- 14-1 to 17-66
- 19-1 to 21-12
- App. 18-1 to App. 18-2
- App. 18-57
- T-1 to I-60

INSERT NEW PAGES NUMBERED:

- Title page to 3-33
- 5-1 to 12-83
- 14-1 to 17-67
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