

Trademark Case Law Updates

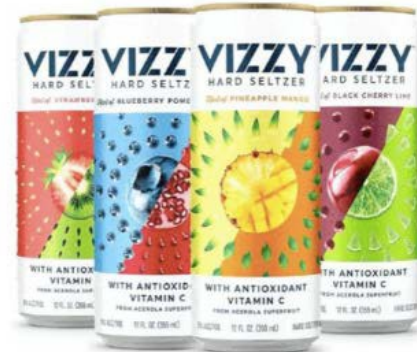
Tiffany Shimada

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A Year for Hard Seltzers

- *Future Proof Brands, L.L.C. v. Molson Coors Beverage Co.*, 982 F.3d 280 (5th Cir. 2020)
 - Findings: (1) neither company was the first to brand a carbonated product with a variant of “fizzy,” (2) the cans differed in appearance, including their shapes, designs, and texts.
 - Future Proof’s motion for a preliminary injunction denied by lower court; Fifth Circuit affirmed:
 - Consumers must “exercise the imagination” to infer that “Brizzy” is a play on the word “fizzy.”
 - Because “Brizzy” shares the common “izzy” root with not only Coors’ Vizzy but also with several third parties’ products, “Brizzy” has a weak standing in the marketplace.
 - No actual confusion because the only evidence Future Proof provided was a fleeting mix-up of names between the two products by a wholesaler.



...and chocolate...

- *Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp.*, 986 F.3d 250 (3d Cir. 2021)
 - Summary judgment in favor of Lotte due to trade dress being functional.
 - “Functional” need not be essential; may be “merely useful.”
 - Marketing the “no mess handle” of the Pocky stick did not help.



...and cheese...

- *International Dairy Foods Assoc. v. Interprofession du Gruyère*, 2020 U.S.P.Q.2d 10892 (T.T.A.B. 2020)
 - Interprofession applied to register **Le Gruyère** certification mark for “cheese,” opposed as generic.
 - Opposers’ evidence included uses of the term “gruyere” in dictionary definitions, articles and excerpts from articles, government regulations, statistics, webpages, witness testimony, and promotional materials.
 - The Board determined consuming public would not primarily understand “gruyere” to refer to a type of cheese regardless of its country of origin or any particular certification standards.
 - The Board relied on 21 C.F.R. § 133.149, the FDA standard of identity for “gruyere cheese,” which identifies the ingredients and production standards but does not limit the cheese to a particular geographic source.
 - Opposition sustained; the term “gruyere” could not be registered as a mark that confines “gruyere cheese” products to specific countries of origin.

...and Tiger King (oh my)!

- *Jackson v. Netflix, Inc.*, 506 F. Supp. 3d 1007 (C.D. Cal. 2020)
 - Netflix’s motion to dismiss granted when Jackson, the founder and publisher of *Hollywood Weekly Magazine*, alleged infringement of the marks “Tiger King” and “Hollywood Weekly”.
 - Netflix’s First Amendment rights outweighed the public interest in avoiding consumer confusion under the *Rogers* test.
 - The *Rogers* test applied to most of plaintiffs’ claims, and Netflix’s use is protected because plaintiffs failed to allege facts other than mere legal conclusions that the use of the marks was explicitly misleading.



A Colorful Holding

- *In re. Forney Indus., Inc.*, 955 F.3d 940 (Fed. Cir. 2020)
 - Forney’s hombre packaging denied registration with no acquired distinctiveness.
 - The Board affirmed and added a color mark cannot be inherently distinctive without a peripheral shape or border.
 - Federal Circuit Court reversed, finding “a distinct color-based product packaging mark” may be inherently distinctive and therefore registrable without showing acquired distinctiveness.
 - Mark description: “[t]he mark consists of a solid black stripe at the top. Below the solid black stripe is the color yellow which fades into the color red. These colors are located on the packaging and or labels.”



“Generic.com”

- *U.S. Patent and Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020)
 - SCOTUS ruled 8-1 that BOOKING.COM could register its trademark.
 - USPTO’s proposed *per se* rule: generic term plus .com top level domain is generic and therefore ineligible for trademark protection.
 - SCOTUS: whether a term is generic or capable of protection is determined by consumer perception. Here, survey evidence showed consumers perceive BOOKING.COM to be a source indicator or brand name—not a generic term.
 - USPTO has issued Examination Guide 3-20:
 - “To establish that a generic.com term is generic and incapable of serving as a source indicator, the examining attorney must show that the relevant consumers would understand the primary significance of the term, as a whole, to be the name of the class or category of the goods and/or services identified in the application.”

“Zero” Chance

- *Royal Crown Co. v. Coca-Cola Co.*, 823 Fed. Appx. 960, 2020 U.S.P.Q.2d 10881 (Fed. Cir. 2020)
 - On appeal, RC’s opposition to Coca-Cola’s applications for “Zero” marks associated with its zero calorie products dismissed again.
 - TTAB found Coca-Cola could register the marks even without a disclaimer of the term “Zero.” RC appealed and the Federal Circuit Court vacated and remanded the case to the Board for failing to make a finding on the term’s descriptiveness before addressing acquired distinctiveness.
 - On remand, Coca-Cola filed a motion to amend its applications to disclaim the term “Zero.”
 - RC protested the motion, arguing it was procedurally improper. The Board granted the motion because the disclaimer was the only relief requested by RC. RC then appealed.
 - Federal Circuit Court found the case moot because the Board’s entry of Coca-Cola’s disclaimers granted RC all the relief it had requested.

“Thums Up”

- *Coca-Cola Co. v. Meenaxi Enter.*, 2021 U.S.P.Q.2d 709 (T.T.A.B. 2021)
 - Coca-Cola’s products sold in India under the marks “THUMS UP” and “LIMCA.” Meenaxi registered these marks in the U.S. as colas and other soft drink products.
 - Coca-Cola petitioned to cancel Meenaxi’s U.S. registrations under claim that Meenaxi was attempting to deceive U.S. customers.

| Coca-Cola Products | Meenaxi Products |
|---|---|
|  |  |
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“Thumbs Up”, part “Duh”

- Meenaxi could not establish a laches defense, in part, due to no evidentiary support for alleged prejudice from the three-and-a-half year delay.
- Evidence established that Meenaxi had knowledge of Coca-Cola’s marks.
- Board found “Respondent’s marks and logos effectively speak for themselves”; that, “Respondent deliberately misrepresented the source of these goods to consumers.”
- Meenaxi’s primary source of distribution was “to Indian grocers in the United States.”

Hard Diamond Life

- *Tiffany & Co. v. Costco Wholesale Corp.*, 971 F.3d 74 (2d Cir. 2020)
 - Costco used point-of-sale signs with the word “Tiffany” in connection with its sale of diamond engagement rings, and Tiffany sued Costco for trademark infringement.
 - Tiffany & Co. awarded \$21 million in 2017.
 - Costco’s evidence created genuine question as to likelihood of confusion:
 - “Tiffany setting” widely used in the marketplace.
 - Costco asserted “fair use” affirmative defense that even if its use of the word “Tiffany” was likely to confuse, Costco was entitled under the Lanham Act to use it “in good faith only to describe” the style of its ring products.
 - Court vacated the District Court’s judgment and remanded the case for trial.

“Satan Shoes”

- *Nike, Inc. v. MSCHF Product Studio, Inc.*, Case No. 21-cv-1679 (S.D.N.Y., March 29, 2021)
 - MSCHF sells altered Nike Air Max 97 shoes as “Satan Shoes”
 - Claims: Trademark Infringement, False Designation of Origin / Unfair Competition, Trademark Dilution, Common Law Infringement
 - Conclusion: Temporary restraining order; settlement and recall



It's a Dog-Eat-Dog World

- *VIP Products v. Jack Daniel's*, 953 F.3d 1170 (9th Cir. Mar. 31, 2020)
 - VIP sold “Bad Spaniels Silly Squeaker” dog toy
 - Jack Daniel’s bottle design is registered
 - VIP sued for a declaratory judgment; JD counterclaimed for trademark infringement and dilution by tarnishment
 - Conclusion: Reversed – No dilution as a matter of law



Willfulness not Required

- *Romag Fasteners, Inc. v. Fossil Group, Inc.*, 140 S. Ct. 1492 (2020)
 - Romag sued Fossil for using counterfeit Romag fasteners on watches made in China.
 - Circuit Split: Is willfulness required for an award of profits under the Lanham Act?
 - Willfulness required: First, Second, Eighth, Ninth, Tenth and D.C.
 - Willfulness not required: Third, Fourth, Fifth, Sixth, Seventh, and Eleventh
 - **Held: *A plaintiff in a trademark infringement suit is not required to show that a defendant willfully infringed the plaintiff's trademark as a precondition to a profits award.***
 - SCOTUS notes, however, that willfulness or intent will be a “highly important consideration in determining whether an award of profits is appropriate.”

Backyard Beef

- *Variety Stores, Inc. v. Walmart Inc.*, 852 Fed. Appx. 711, 2021 U.S.P.Q.2d 378 (4th Cir. 2021)
 - Variety registered “**The Backyard**” for lawn and garden equipment and began using “Backyard” and “Backyard BBQ” on grilling products without registering them. Variety opposed Walmart’s application for “Backyard Grill,” and filed a lawsuit in the district court in 2014.
 - During jury trial, the district court simply instructed the jury to “find [whether] defendant Walmart’s infringement was willful,” without defining “willful” in the trademark context.
 - The Court agreed with Walmart: Infringement must be more than “merely volitional” to be willful, and the district court did not instruct the jury accordingly. The case was remanded to determine willfulness and settled in June.

Fry Sauce Frenzy

- *Perry v. H. J. Heinz Co. Brands, L.L.C.*, Case No. 2:19-cv-280 (5th Cir. 2021)
 - Perry objected to Heinz’s mock advertisement of “Metchup” (actual use as “Mayochup”).
 - Fifth Circuit Court noted the disparate markets served by the parties, the lack of overlapping advertising media, and the absence of actual confusion in finding no material dispute as to confusion being unlikely.
 - Heinz’s counterclaim for trademark abandonment overturned for not meeting burden of proof.

Perry’s “Metchup”



Heinz Co.'s “Mayochup”



Questions?

Thank You!

shimada.tiffany@dorsey.com