

## 6 KEY TAKEAWAYS

# Annual Review of Key Trademark & Unfair Competition Opinions

At the recent [Kilpatrick Townsend](#) annual Trademark Seminar, [Ted Davis](#) discussed recent Supreme Court activity in cases bearing on trademark rights, including the Court's opinions on the availability of accountings of defendants' profits and the protectability of so-called "generic.com" marks. Other topics included the lawfulness of marks used in connection with cannabis-related products, the relationship between trademark law and the First Amendment, differences in the federal circuits as to the proper definition of functionality, and the effect of the COVID-19 pandemic on the likelihood-of-confusion inquiry.

Key takeaways from the presentation, include:

1

In passing the Trademark Modernization Act, Congress enacted the most substantive revisions to United States trademark law since the Trademark Law Revision Act in 1988;

In *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020), the Supreme Court resolved the most significant split in the federal circuits over the past twenty years by holding that a prevailing plaintiff need not demonstrate willful misconduct to receive an accounting of the defendant's profits under Section 35(a) of the Lanham Act;

2

3

The Court also issued a significant opinion in *United States Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020), in which it confirmed that the combination of an arguably generic word and a generic top-level domain can qualify as descriptive and therefore a potentially registrable mark;

In *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, No. 20-365, 2021 WL 78111 (U.S. Jan. 11, 2021), the Ninth Circuit expanded the pro-defendant *Rogers v. Grimaldi* test for liability in challenges to the titles or contents of creative works to trademark uses by defendants, while the court in *Stouffer v. Nat'l Geographic Partners, LLC*, 460 F. Supp. 3d 1133 (D. Colo. 2020), *appeal dismissed*, No. 20-1208 (10th Cir. Feb. 24, 2021), rejected the *Rogers* test altogether in favor of an alternative one;

4

5

Two pending appeals to the Federal Circuit have attacked the constitutionality of the long-standing practice by the Director of the Patent and Trademark Office of making appointments to the Trademark Trial and Appeal Board; and

The Office's equally long-standing practice of refusing registrations to claimed marks for failure to function as marks accelerated.

6

For more information, please contact:  
Ted Davis, [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

[www.kilpatricktownsend.com](http://www.kilpatricktownsend.com)