

Letter From the Editor



Welcome to the Spring 2019 issue of Kattwalk.

In this issue, we are pleased to introduce you to Shasterin Gonzales, our high school intern from Cristo Rey High School in New York. Shasterin is in her second year interning with the Intellectual Property department at Katten.

Also in this issue, we address the recent US Supreme Court case, *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, which resolved a circuit split and held that, with limited statutory exceptions, the issuance of registration from the Copyright Office is a prerequisite to filing a claim for infringement. We also explore the Trademark Trial and Appeal Board's (TTAB) issuance of a second precedential decision involving genericness this year in *In re Hikari Sales, USA*. Another article discusses TTAB's decision issued in *Cards Against Humanity v. Vampire Squid Cards*, as well as their ruling that sales to single customers are sufficient to avoid abandonment in *Mombacho Cigars SA v. Tropical Tobacco, Inc.* Finally, we look at their precedential opinion clarifying requirements for consent agreements in *In re American Cruise Lines, Inc.*

We hope you enjoy this edition and will check in with us in the summer for more.

Karen Artz Ash

In This Issue

*Through the Lens: Q&A With Shasterin Gonzales*

*Karen Artz Ash Comments on Cases Fashion Attorneys are Watching*

*Supreme Court Confirms Registration is Prerequisite to Claim for Infringement*

*TTAB Continues to Rule on Genericness*

*TTAB Provides Guidelines on Acquiescence*

*TTAB Rules Sales to Single Customer Sufficient to Avoid Abandonment*

*TTAB Clarifies Requirements for Consent Agreements*

*Karen Artz Ash Honored With Lifetime Achievement Award*

*Katten Lawyers Recognized for Exemplary Client Service*

Through  
the Lens



Shasterin  
Gonzal

-----[ passion ]-----

Tell us a little about yourself

I am the first one in my family to ever attend a private school and do internship in a law firm at a high school level. Besides that, I love sports. I am very good at basketball, soccer and softball. In my family, I am the oldest out of four sisters, therefore I try my best to be a good example for my siblings. In the future, I want become an obstetrician.





## Through the Lens: Q&A With Shasterin Gonzales

-----{ inspiration }-----

### ▶ ▶ ▶ **What attracted you to the internship at Katten?**

At Katten, the people I work with make me feel like I am part of the team! They trust me with important tasks, and I am comfortable asking questions whenever I need clarification.

-----{ motivation }-----

### **What interesting things have you learned about working at a law firm and with the Intellectual Property practice at Katten?**

Working at a law firm, I have learned all about trademarks, the symbols and products they have. Another thing I have enjoyed learning about is copyright information and how to make personal projects like a song, book or image have copyright.

-----{ enhancement }-----

### **What is the most important skill you have learned during your time at Katten?**

While working at Katten, the most important skill I have learned is to be patient, balance my time management for every project and be organized.

-----{ lifestyle }-----

### **What do you do for fun when you're not in school or at Katten?**

In my free time I like to practice basketball or go outside to the basketball court to shoot around. I also like to write music or listen to beat. When I'm relaxing at home, I do homework or watch Netflix.



# Supreme Court Confirms Registration is Prerequisite to Claim for Infringement

by **Karen Artz Ash, David Halberstadter, Floyd Mandell and Jeffrey Wakolbinger**

On March 4, the US Supreme Court resolved a circuit split and held that, with limited statutory exceptions, the issuance of a registration from the Copyright Office is a prerequisite to filing a claim for infringement. See *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, No. 17-571, slip op. (US Mar. 4, 2019).

Copyrights exist independent of government registration. An author of an original work acquires exclusive rights (e.g., to reproduce, distribute, and perform or display the work) as soon as the work is fixed in a tangible medium of expression. 17 USC § 102(a). But registration confers important benefits. These benefits include the ability to recover statutory damages and attorneys' fees, which generally are not available for acts of infringement that began before the work was registered, see 17 USC § 412, and the right to file a claim for infringement.

The statutory provision at issue in *Fourth Estate* was 17 USC 411(a), which provides, in part, that "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." Circuit courts were split as to what Congress meant by the phrase, "registration of the copyright claim has been made."

**The Tenth Circuit strictly construed the statutory registration requirement and held that a copyright claim based on an unregistered work was subject to dismissal.**

The Fifth, Seventh and Ninth Circuits, on the other hand, had adopted a more lenient approach, allowing suits to proceed, so long as the applicant had filed a proper application, paid its fee and submitted a deposit copy of the work prior to filing suit. Copyright claimants in those circuits, and in various district courts in other circuits, were thus able to file a claim for infringement of an unregistered work, so long as they submitted an application immediately ahead of their complaint. The Eleventh

Circuit recently joined the Tenth Circuit when it affirmed a district court's dismissal of *Fourth Estate Public Benefit Corp.*'s complaint against *WallStreet.com* on the basis that the plaintiff's copyright application was pending, but unregistered, at the time of suit.

The Supreme Court granted *certiorari* to resolve the circuit split and rejected the more lenient approach of finding a completed application sufficient to file suit. The unanimous court relied primarily on the language of the statute, itself, as well as its legislative history. In explaining its reasoning, the court noted that the owner of a registration, ultimately, can recover damages and profits for pre-registration acts of infringement (within the three-year statute of limitations); that pre-registration procedures exist for live broadcasts and works that are commonly infringed (e.g., movie releases); and that a suit may also be maintained on an application that was properly submitted, but refused by the Copyright Office.

**The Supreme Court's decision means that, barring limited exceptions, a copyright claim will now be subject to dismissal in any circuit, if the complaint was filed before a registration is actually issued (or refused) by the Copyright Office.**

With the processing time for applications currently averaging seven months, it becomes even more important for copyright owners to consider registration of their works as part of their overall intellectual property strategies. If that timeline proves unworkable, the copyright owner will need to seek expedited processing of its application (for a fee). The mere act of filing an application will no longer suffice in any court.



## Karen Artz Ash Honored With Lifetime Achievement Award

Karen Artz Ash received the Global Lifetime Achievement Award from *Managing Intellectual Property* magazine.

As national co-chair of Katten's Intellectual Property department and co-head of the Trademarks and Trademark Litigation practice, Karen was presented with the award at the *Managing Intellectual Property's* Americas Awards ceremony held at the Essex House in New York.

"Karen has long been greatly admired and respected by leaders in the fashion industry and elsewhere, having carved out a niche as a thought leader, shaping fashion law," said Katten Chairman Roger P. Furey. "Because of her extraordinary skills and experience in all aspects of intellectual property, she is known as the best in the business, and rightly so. We are all very proud of her."

[Read more](#)

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## Karen Artz Ash Joins Fordham Law School for a Discussion on Women in Intellectual Property

Karen Artz Ash was joined by three other panelists at Fordham Law School for a panel discussion about Women in Intellectual Property on March 26, 2019. The panel was hosted by the Intellectual Property Affinity Group and co-sponsored by The Copyright Society of the USA.

## More NEWS to KNOW

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### TTAB Continues to Rule on Genericness

by Karen Artz Ash and Jerry Jakubovic

In *In re Hikari Sales USA, Inc.*, the Trademark Trial and Appeal Board (TTAB) issued a second precedential decision involving genericness, this year, just two days after issuing its first one. In doing so, the TTAB sent a strong message to brand owners hoping to obtain exclusive rights in highly descriptive or otherwise common terms.

[Read more](#)

### TTAB Provides Guidelines on Acquiescence

by Karen Artz Ash and Bret Danow

In *Cards Against Humanity v. Vampire Squid Cards*, the Trademark Trial and Appeal Board (TTAB) in February addressed the issue of the availability of acquiescence as a defense in an opposition proceeding.

[Read more](#)

### TTAB Rules Sales to Single Customer Sufficient to Avoid Abandonment

by Karen Artz Ash and Bret Danow

In *Mombacho Cigars SA v. Tropical Tobacco, Inc.*, the Trademark Trial and Appeal Board (TTAB) addressed the issue of whether a small amount of sales of products bearing a particular mark made to a single customer was sufficient to rebut a claim that such a mark was abandoned.

[Read more](#)

### TTAB Clarifies Requirements for Consent Agreements

by Karen Artz Ash and Bret Danow

The Trademark Trial and Appeal Board (TTAB) issued a precedential opinion in *In re American Cruise Lines, Inc.* regarding the necessary provisions for an acceptable consent to registration. In doing so, the TTAB provided clarification and guidance to trade mark owners who are negotiating and drafting consent agreements.

[Read more](#)

## Karen Artz Ash Comments on Cases Fashion Attorneys are Watching

Katten's Intellectual Property department national co-chair [Karen Artz Ash](#) was recently interviewed by *Women's Wear Daily* regarding the five appellate cases considering some of the most pressing fashion law questions of 2019. In it, Karen comments on *Mission Product Holdings Inc. v. Tempnology LLC* in the dispute over licensing rights following Tempnology's filing for Chapter 11 protection in 2015. The case was argued before the US Supreme Court in February 2019. This case has particular significance for fashion companies, as they increasingly conduct business under license agreements, even companies that have developed businesses under their own labels.

"If the court here comes out in favor of a licensee being able to retain those rights," said Karen, "it eliminates some of those concerns or minimizes it. If the court comes out in the other direction and finds that the licensor has the right to reject," she continued, "then you have a lot more uncertainty, and you will have licensees wanting to assert different sorts of protections."



### Katten Sponsors the WWD Men's Wear and Retail 2030 Summits

Katten was a proud sponsor of the March 28 WWD Men's Style 2019, which looked at the dynamic world of men's fashion and explored topics like capitalizing on the rise of streetwear, how entertainment, sports, the wellness movement and digital media are impacting men's styles, and the art of smart collaborations. Katten also sponsored the WWD Retail 2030 Summit in New York City, which explored ways to attract and engage consumers and inspire their loyalty across channels. Topics included rewriting the rules of multi-brand retail and moving digital-first brands offline.

## Katten Lawyers Recognized for Exemplary Client Service

**Karen Artz Ash** was named to the BTI Client Service All-Stars 2019 list. This recognition honors “the individuals able to stand out in the sea of legal services providers to represent the cream of the crop.” Additionally, **Devon Downs**, an associate in Katten’s Houston office, was one of only two associates honored by BTI Consulting.

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**Kristin Achterhof**, **Karen Artz Ash**, **Floyd Mandell** and **Jan Tamulewicz** were recognized for trademark services in the 2019 edition of World Trademark Review 1000 — The World’s Leading Trademark Professionals (WTR 1000). Floyd, national co-chair of Katten’s Intellectual Property department and co-head of the Trademarks and Trademark Litigation practice, also received the highest national distinction for his work in enforcement and litigation.

Floyd, who was praised as a tireless client advocate and “veteran who brings a wealth of practical experience to complicated matters.” He is known as a “leading litigator who looks inside and outside the box for solutions” and is “very sensitive to the needs of his clients and understands their business vision.”

Kristin, who serves as both national co-chair of Katten’s Intellectual Property Litigation practice and co-chair of

the firm’s Advertising, Marketing and Promotions practice, was hailed as “brilliant in litigation and counselling.”

Karen, who is the national co-chair of the firm’s Intellectual Property department and co-head of the Trademarks and Trademark Litigation practice, was lauded for setting the standard for the advancement of industry practice in the fashion world. “While never letting the quality dip, she comes through with cost-effective strategies that bring about desired outcomes in double-quick time,” according to WTR 1000.

Similarly, Jan was touted for his international work and his handling of matters before the World Intellectual Property Organization (WIPO), particularly Uniform Domain Name Dispute Resolution Policy (UDRP) proceedings and Madrid Protocol filings.

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Also on the East Coast, **Roger Furey**, in Washington, DC, was described as “knowledgeable and reliable.” WTR 1000 highlighted Katten’s chairman as a stand out in both prosecution and litigation, and “when it comes to trial he sticks to his guns — something that his adversaries respect.”

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