6 KEY TAKEAWAYS

Recent Developments in United States Trademark and Unfair Competition Law

Kilpatrick partner Ted Davis spoke recently at the New York State Bar Association IP Section Annual Meeting on recent developments in United States trademark and unfair competition law.

The following are highlights from the trailing 12 months:

1

The Supreme Court accepted and resolved trademark cases at a frequency not seen since 1919, a development that encompasses:

- The Court's attention to the intersection of trademark rights and the right to Free Speech guaranteed by the First Amendment to the United States Constitution;
- Abrogation of the pro-defendant Rogers v. Grimaldi test for liability in cases in which defendants use their alleged imitations of plaintiffs' marks as marks for their own goods and services;
- Clarification of the noncommercial use "exclusion" from liability for likely dilution under Section 43(c)(3)(C) of the Lanham Act; and
- The strengthening of the presumption against extraterritorial applications of United States law, including extraterritorial applications of the federal Lanham Act.

2

The Third Circuit remained the graveyard of trade dress claims with its highly restrictive test for nonfunctionality.

3

Alternative designs continued their comeback as evidence of nonfunctionality.

4

Claims of consumer standing fell flat in both false advertising litigation and in inter partes litigation before the Trademark Trial and Appeal Board.

5

Unusually, in light of the trend in its case law over the past ten years, the Board placed at least some limits on the extrastatutory failure-to-function ground for the refusal of applications.

6

The Board also confirmed that building exteriors can qualify as inherently distinctive service marks (although not all exteriors so qualify).

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