KILPATRICK TOWNSEND

5 KEY TAKEAWAYS

Review of U.S. Federal Case Law and TTAB Developments

At the recent INTA 2020 Annual Meeting, Kilpatrick Townsend's Ted Davis delivered an analysis of major decisions rendered by the U.S. courts and the Trademark Trial and Appeal Board (TTAB) over the past 12 months.

Key takeaways from the presentation include the following:

1. 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. 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;

3. In *VIP Prods. LLC v. Jack Daniel's Props., Inc.,* 953 F.3d 1170 (9th Cir. 2020), *petition for certiorari filed*, No. 20-365 (U.S. Sept. 15, 2020), the Ninth Circuit expanded the pro-defendant Rogers 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 docketed,* No. 20-1208 (10th Cir. June 5, 2020), rejected the Rogers test altogether in favor of an alternative one;

4. The federal circuit courts of appeal remained split on the evidentiary significance of federal registrations on the Principal Register; and

5. The federal circuit courts remained equally split on the test for distinguishing between claimed nonfunctional and functional trade dress.

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