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6 Key Takeaways | Annual Review of Key Trademark & Unfair Competition Opinions

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Kilpatrick

6 KEY TAKEAWAYS

Annual Review of Key Trademark & Unfair Competition Opinions

Kilpatrick partner **Ted Davis** recently presented his "Annual Review of Key Trademark & Unfair Competition Opinions" at the firm's **2024 Advanced Trademark Law Seminar** in New York.

Key takeaways from the presentation include:

1

The Supreme Court has accepted trademark cases for review at an uncommonly high rate, 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

Outside of the Third Circuit, aternative designs continued their comeback as evidence of nonfunctionality.

4

Claims of consumer standing fell flat in both false advertising litigation and 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.

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

6

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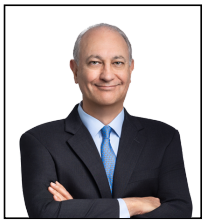

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