



Insights: Publications

5 Key Takeaways | Recent Developments in United States Trademark and Unfair Competition Law

June 3, 2024

Written by Theodore H. Davis Jr.

5 KEY TAKEAWAYS

Recent Developments in United States Trademark and Unfair Competition Law

Kilpatrick partner [Ted Davis](#) spoke recently at the **American Intellectual Property Law Association's** spring meeting and at the **International Trademark Association's** annual meeting on recent developments in United States trademark and unfair competition law over the trailing twelve months.

Those presentations addressed, inter alia, the following topics:

1

The Supreme Court accepted trademark cases for review at an uncommonly high rate, a development encompassing:

- 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;
- the abrogation in *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 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.

The possible invalidation of the likely-dilution-by-tarnishment cause of action as impermissibly viewpoint discriminatory reared its head in *Jack Daniel's* on remand.

2

3

An opinion from a Pennsylvania federal district court signaled the possible unavailability to trademark licensors of the federal cause of action for counterfeiting.

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

4

5

Unusually, in light of the trend in its case law over the past ten years, the Trademark Trial and Appeal Board placed at least some limits on the extrastatutory failure-to-function ground for the refusal of applications; the Federal Circuit, however, did not follow suit.

For more information, please contact:
Ted Davis, tdavis@ktslaw.com

www.ktslaw.com

Related People



Theodore H. Davis Jr.

t 404.815.6534

tdavis@ktslaw.com