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Kane on Trademark Law
A Practitioner’s Guide
Sixth Edition

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In this release, Siegrun D. Kane updates the text and provides her expert analysis and practical insights regarding a wide range of crucial topics. Highlights of this release include:

**Disparagement:** Section 2(a) of the Lanham Act denies registration to disparaging marks. Is section 2(a) an unconstitutional restriction on free speech, or are such denials government speech exempt from First Amendment scrutiny? These and other arguments are laid out in cases dealing with the Washington Redskins and an Asian-American rock band named the Slants, with input from the TTAB, the Federal Circuit, the Justice Department, and the ACLU. Will the Supreme Court have something to say? See new § 19:4.5[C][1]–[3].

**Judge versus jury:** The Supreme Court in *Hana Financial, Inc. v. Hana Bank* held that juries are better equipped than judges to decide the issue of tacking by a trademark assignee. As Justice Sotomayor put it: “Application of a test that relies upon an ordinary consumer’s understanding of the impression that a mark conveys falls comfortably within the ken of a jury.” Will the same reasoning apply to likely confusion, an issue that three circuits treat as a matter of law for the court? See § 21:4, at note 27.1.

**Res judicata—issue preclusion:** The Supreme Court in *B&B Hardware v. Hargis Industries* held that a TTAB decision finding likely confusion precludes relitigation of the issue in the district court, as long as the TTAB has taken into account marketplace usage of the parties’ marks. Concurring with Justice Alito’s opinion, Justice Ginsburg noted that preclusion would not apply to “a great many registration decisions.” Will *B&B* impact typical TTAB proceedings? See § 12:2.2[E], at note 133.4.

**Res judicata and post-settlement conduct:** In *TechnoMarine v. Giftports*, the Second Circuit made it clear that liability based on new post-settlement conduct is not barred by res judicata, even though the new claims are premised on continuance of the same conduct. See new § 12:2.2[F].

**Injunctions—irreparable harm:** The Supreme Court’s refused to apply the presumption of irreparable harm in the *eBay* patent case. The Third Circuit in *Ferring* took the view that *eBay* applies to trademark cases as well, and
injunctive relief requires proof of irreparable harm. However, in *SEB v. Euro-Pro*, the Third Circuit found irreparable harm based on defendant’s literally false statements impugning the goodwill and reputation of plaintiff’s brand. The debate will continue until the Supreme Court decides to address the subject. See § 15:2.1[A], at note 24.4.

**Counterfeiting—damages:** Parties who deliberately duplicate plaintiff’s mark to trade on plaintiff’s goodwill can expect severe penalties. In *Coach v. Allen*, Judge McMahon of the Southern District of New York awarded the maximum statutory damages of $44 million ($2 million per mark for twenty-two acts of willful infringement). See § 17:3.4[C], at note 112.1.

**Trademark protection for book titles:** Although titles of single books (as opposed to a series) have not generally been protected, the TTAB announced that the title ROCK YOUR BODY should be registrable if consumers view the title “as a trademark indicating source.” See § 2:8, at note 108.1.

**Services—use in commerce:** Advertising a service under the mark without actually rendering the service does not amount to a use in commerce sufficient to support an “actual use” application, according to the Federal Circuit in *Couture v. Playdom, Inc*. See § 5:1.2, at note 29.1.

**Genericness:** In *Princeton Vanguard v. Frito-Lay North America*, the Federal Circuit held that the TTAB must consider evidence of the relevant public’s understanding of the term in its entirety. There is no difference between compound words and phrases when assessing genericness. The court vacated the TTAB’s finding that “Pretzel Crisp” is generic, and remanded. See § 5:2.2, at note 69.

**Section 8 affidavit of use:** The Trademark Office’s 2012-2014 pilot program to “discourage inaccuracies” in section 8 affidavits demonstrated that a fair number of registrations needed to be cancelled in whole or in part. The Trademark Office is likely to consider additional rule making. See § 7:2.5.

**Using investigators:** Where a private investigator is hired to make purchases of alleged counterfeit goods, documents the investigator creates “in anticipation of litigation” are likely protected trial preparation materials under Rule 26(b)(3) of the Federal Rules of Civil Procedure; also, if the investigator is hired by an attorney, certain communications may be protected by the attorney-client privilege. See § 8:3.6, at 202.1.

**Surveys—dilution:** Using faulty procedures can lead to rejection of a survey, as illustrated by *ProMark v. GFA*. There, the TTAB disregarded the survey for several reasons, including use of leading questions, failure to independently validate the results, and failure to control for noise. See § 9:6.11, at note 106.1.

**False advertising—support for claims:** The FTC determined that POM Wonderful’s ads touting the health benefits of its juice products were deceptive and ordered that any future disease-related ads be supported by two randomized controlled clinical trials. The D.C. Circuit upheld the Commission’s finding of deceptiveness but struck the requirement of two controlled trials as too broad a restriction on commercial speech; one study was enough. See § 10:6.2, at note 79.2.

**Experts and the work product doctrine:** Written communications between testifying experts and nonattorneys engaged by consultants and agents are not protected under the work product doctrine. And personal notes and email communications of experts are not protected under that doctrine. See § 16:8.5, at note 139.

The Table of Authorities and the Index have also been updated.
FILING INSTRUCTIONS

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