



Trademark & Copyright 2022 Year in Review

January 25, 2023

FISH.

Meet The Speakers



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Overview

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Post Grant for Practitioners | 2022 Year in Review
Tuesday, January 31, 2023 | 1:30 - 2:30 p.m. ET


The Patent Trial and Appeal Board in 2022 continues to have a significant impact on IP litigation and strategy. Petitioners remain busier than ever, with a total of 1,367 filings in FY 2022. This year saw the impact of newly confirmed USPTO Director Kathi Vidal, who took an active role in issuing guidance refining the Board's approach to several key issues affecting practitioners. The courts were also busy, with decisions touching on standing, serial petitions, abuse of process, and much more.


Join Fish attorneys [Karl Renner](#), [Chad Shear](#), and [Casey Kraning](#), as they take a closer look at these significant developments and examine their impact on practitioners.

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PRESENTED BY:


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Agenda

- **Notable Trademark Cases in 2022**
- **Notable Copyright Cases in 2022**
- **Notable Federal Circuit and TTAB Decisions in 2022**
- **Updates from the USPTO**
- **Updates from the U.S. Copyright Office and Copyright Claims Board**
- **Cases and developments to watch in 2023**



Notable Trademark Cases in 2022

MGFB Properties, Inc. v. Viacom Inc. (11th Cir.)

“Creative works of artistic expression are firmly ensconced within the protections of the First Amendment.”

- MGFB owns the “FLORA-BAMA” trademark and owns and operates the Flora-Bama Lounge on the border of Florida and Alabama. It sued Viacom over MTV’s **Floribama Shore** - a reality TV show that premiered on November 27, 2017 as a successor to MTV’s *Jersey Shore*
- The Eleventh Circuit applied the *Rogers v. Grimaldi* test, which attempts to strike a balance between trademark and First Amendment rights
- This two-part test holds that an artistic title does not violate trademark law if it has “artistic relevance” to the accused work and does not “explicitly mislead” as to source
- The Eleventh Circuit ruled that the title “Floribama Shore” is artistically relevant to the content of the show—which was about the “Floribama” subculture present on the Florida coast near Alabama



Wreal, LLC v. Amazon.com, Inc. (11th Cir.)

- Wreal, the owner of the online pornography streaming service “**FyreTV**,” sued Amazon.com for infringement based on the “**Fire TV**” streaming-only set-top box under a reverse confusion theory.
- **Reverse confusion** occurs when a junior user, typically with a large commercial presence, saturates the market with advertising and use of a confusingly similar mark, which may lead consumers to assume that the senior user’s goods originate from the junior user’s and diminish the value of the senior user’s mark as a source indicator.
- **District court:** Granted summary judgment to Amazon on Wreal’s trademark infringement claims.
- **Eleventh Circuit:** Reversed and remanded for trial. The LOC factors weigh heavily in Wreal’s favor when considering the reverse-confusion theory.



Wreal, LLC v. Amazon.com, Inc. (11th Cir.) cont.

- **Distinctiveness of the Mark:** The court should consider the conceptual strength of the plaintiff's mark and the *relative commercial strength of the defendant's mark*.
- **Similarity of the Marks:** Analyzed the same as in forward-confusion cases, but where the defendant uses a housemark (such as Amazon) alongside the mark at issue, the presence of the housemark is *more* likely to cause confusion.
- **Similarity of the Goods/Services:** It is relevant to ask whether consumers might expect the defendant to “bridge the gap” and enter the plaintiff's market.
- **Defendant's Intent:** Unlike in forward-confusion cases, evidence of a specific intent to deceive is not a prerequisite to establish intent. A more generalized intent to obtain market saturation or to proceed with the adoption of a mark despite having constructive knowledge of the plaintiff's mark may be sufficient.
- **Actual Confusion:** Direct evidence that the plaintiff's consumers became confused after the defendant's launch of the junior mark is the most relevant, though evidence of forward confusion will usually be probative.
- **Similarity of Sales Outlets** and **Similarity of Advertising** are analyzed the same in forward-confusion and reverse-confusion cases.

RiseandShine Corp. v. PepsiCo, Inc. (2d Cir.)

- RISE for nitro-brewed coffee versus MTN DEW RISE ENERGY for fruit-flavored energy drinks
- SDNY found a likelihood of confusion based on a reverse confusion theory and granted Plaintiff Rise Brewing a preliminary injunction against Pepsi
- Second Circuit vacated the preliminary injunction
- While “RISE” is a suggestive mark, it is on the lower end of the suggestive spectrum since the term is generally associated with waking up in the morning or rising energy levels
- Pepsi presented over 100 similar uses of “rise” to allude to increased energy in the morning on other beverage and food products
- Because “RISE” is not a strong mark in the context of coffee, the parties’ shared use of the term does not establish confusing similarity absent other visual similarities
- The Second Circuit noted dissimilarities in the presentation of the marks including font, size of the cans, and Pepsi’s use of the house mark “Mtn DEW”





Notable Copyright Cases in 2022

Unicolors, Inc. v. H&M Hennes & Mauritz L.P.

- Copyright registration is required to sue (with an exception for foreign works), but what happens when the registration is inaccurate?

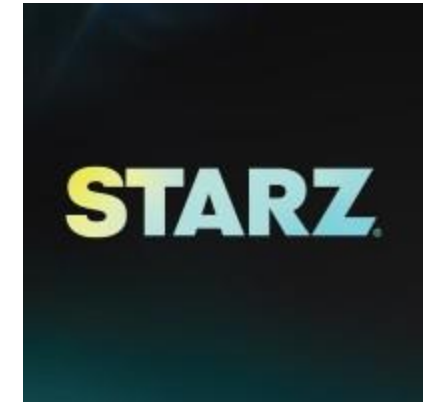


- Section 411(b) of Copyright Act: **(1)** A certificate of registration satisfies the requirements of this section. . . regardless of whether the certificate contains any inaccurate information, unless—**(A)** the inaccurate information was included on the application for copyright registration *with knowledge that it was inaccurate*; and **(B)** the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.
- Lack of either factual or legal knowledge *can excuse an inaccuracy* in a copyright registration.

Starz Entertainment v. MGM (9th Cir.)

- The Copyright Act has a three year statute of limitations period—but what does this mean exactly?
- Starz and MGM were parties to exclusive licensing agreements that provided Starz with the exclusive right to exhibit MGM-owned movies and shows. Starz later noticed that certain movies and shows were available from other content providers. Starz sued in 2020.
- General rule - a copyright infringement claim is timely so long as it is commenced within three years after the claim accrued, and a claim generally accrues when infringement occurs.

Exception: The “discovery rule”— a claim can alternatively accrue when the copyright holder knows or reasonably should know that an infringement occurred, thereby allowing copyright holders to recover damages for infringing acts that happened before they discovered the infringement.



hiQ Labs, Inc. v. LinkedIn Corp. (9th Cir. and C.D. Cal.)

- Does scraping data from public LinkedIn profiles constitute access of a protected computer “without authorization” in violation of the Computer Fraud and Abuse Act (CFAA)?
- What about after LinkedIn sent HiQ a cease-and-desist letter?
- Ninth Circuit applies the Supreme Court’s “gates-up-or-down inquiry” established in *Van Buren v. United States* to interpret “without authorization”
- **Scraping of publicly available information (i.e., information that can be accessed openly without payment, or logging into a password protected account, etc.) likely does not violate the CFAA**

“Entities that view themselves as victims of data scraping are not without resort, even if the CFAA does not apply: state law trespass to chattels claims may still be available. And other causes of action, such as copyright infringement, misappropriation, unjust enrichment, conversion, breach of contract, or breach of privacy, may also lie.”

- Case settled with a consent judgment against HiQ





Notable Federal Circuit and TTAB Decisions in 2022

Meenaxi Enterprise v. Coca-Cola (Fed. Cir.)



- Coca-Cola owns “well known” marks THUMS UP and LIMA in India
- Meenaxi registered and used these marks in the US for the same products
- The TTAB cancelled Meenaxi’s registrations based on misrepresentation of source
- The Federal Circuit reversed the cancellation of Meenaxi’s registrations finding Coca-Cola did not prove the threshold requirement of a statutory entitlement to bring a claim under Section 14(3), 15 U.S.C. § 1064;
 - No substantial evidence of reputation of Coca-Cola’s THUMS UP and LIMCA marks in the US;
 - No evidence of lost sales in the US;
 - No evidence of sales of LIMCA in the US by authorized distributors (sales on Amazon or by importers not authorized)
 - Sales of THUMS Up only as part of “tasting tray” at World of Coca-Cola and Coca Cola Store locations in Atlanta and Orlando

In re Elster (Fed. Cir.)

- TTAB refused registration of TRUMP TOO SMALL for t-shirts under Section 2(c), 15 U.S.C. § 1052(c) because it was the name of a living individual without his consent
- The Federal Circuit reversed the refusal on the basis that applying Section 2(c) to bar registration of this mark unconstitutionally restricts free speech in violation of the First Amendment
 - “The government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster’s mark.”
- Decision continues the trend of finding Lanham Act provisions violate the First Amendment
 - *In re Tam* – struck down Section 2(a) provision permitting denial of registrations that disparage or bring into disrepute any persons living or dead;
 - *In re Brunetti* – struck down Section 2(a) provision permitting denial of marks that consist of immoral or scandalous matter

In re Vox Populi (Fed. Cir.)

- The TTAB refused registrations of .SUCKS and .SUCKS (stylized) on the basis they failed to function as a mark
- Appeal only as to .SUCKS (stylized)
- Federal Circuit affirmed the TTAB's refusal of registration of .SUCKS (stylized)
 - Stylized lettering does not create a separate commercial impression and is not sufficiently distinctive to 'carry' the overall mark into registrability

.SUCKS

In re Jasmin Larian, LLC (TTAB)

- **A generic product design cannot be registered. Further, courts exercise particular caution when extending protection to product designs because such claims present an acute risk of stifling competition.**
 - In the context of product design, genericness may be found where the design is so common in the industry that it cannot be said to identify a particular source.
- **Distinctiveness is acquired by “substantially exclusive and continuous use” of the mark in commerce. The lesser the degree of inherent distinctiveness, the heavier the burden to prove that a mark has acquired distinctiveness.**



Applicant's Mark



Example of Third-Party Product

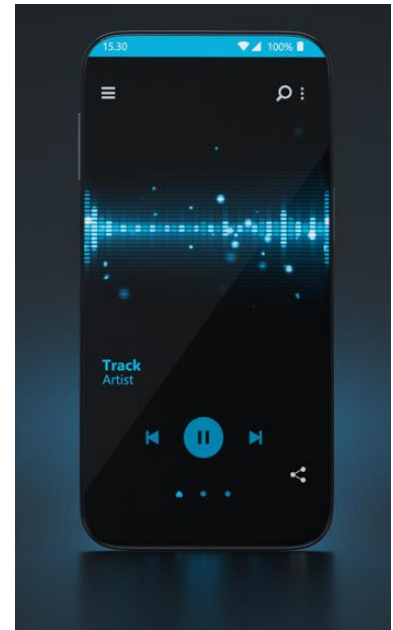
Empresa Cubana Del Tabaco dba Cubatabaco v. General Cigar Co. (TTAB)

- **General Inter-American Convention for Trade Mark and Commercial Protection of Washington, 1929. Also known as the Pan American Convention, the Inter-American Convention, and the Washington Convention.**
 - Contracting States: Colombia, Cuba, Guatemala, Haiti, Honduras, Nicaragua, Panama, Paraguay, Peru, and the United States.
 - Beneficiaries: (i) Nationals of contracting state, and (ii) domiciled foreigners who own a manufacturing or commercial establishment or an agricultural development in any of the contracting states.
- **Article 8 of the Pan American Convention: A trademark owner may seek to cancel a registration if (i) the owner enjoys legal protection for the mark in one of the contracting states that predates the interfering filing and (ii) the owner of the interfering filing had knowledge of the owner's prior trademark rights prior to filing the interfering filing OR the owner used the mark in the U.S. prior to the filing date of the interfering filing.**



Spotify AB v. U.S. Software, Inc. (TTAB)

- Spotify opposed U.S. Software's applications for the marks POTIFY and POTIFY & Design for *inter alia* software and services related to medical marijuana.
- To prevail on a claim of dilution, an opposer must show that:
 1. It owns a famous mark that is distinctive;
 2. Applicant is using a mark in commerce that allegedly dilutes the opposer's famous mark;
 3. Applicant's use of its mark began after opposer's trademark became famous; and
 4. Applicant's use of its mark is likely to cause dilution by blurring or tarnishment.
- A mark is sufficiently "famous" if it is widely recognized by the general consuming public as a designation of source of the goods or services of the mark's owner.
- Dilution by blurring occurs when a substantial percentage of consumers are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner.



PepsiCo, Inc. v. Arriera Foods LLC (TTAB)

- PepsiCo opposed Arriera Foods' application for TORTRIX covering "corn-based snack foods" in Class 30.
- The Trademark Act does not expressly provide that misrepresentation of source is an available claim in an opposition. Rather, misrepresentation of source is identified in Section 14(3) of the Trademark Act as a claim that may be brought against a registered mark "at any time." 15 U.S.C. § 1064(3).
- Misrepresentation of source refers to the blatant misuse of a mark, or conduct amounting to the deliberate passing-off of one's goods as those of another. There is nothing in the nature of this claim that would limit it to registered marks.
 - Moreover, other claims expressly identified only in Section 14(3) – fraud, abandonment, and genericness – may be asserted in an opposition proceeding.
- Board finds that a plaintiff should be permitted to assert misrepresentation of source in an opposition, but notes that the claim arises from the blatant misuse of another's mark.



Revolution Jewelry Works v. Stonebrook Jewelry (TTAB)

- Under Trademark Rule 2.120(h), if a party fails to comply with an order of the Board relating to discovery, including a protective order, the Board may order appropriate sanctions.
 - Sanctions may include: Prohibiting the offending party from supporting or opposing designated claims or defenses, striking pleadings, or entering judgment against the party.
- Entry of judgment is a harsh sanction, typically only warranted in cases of repeated failure to comply the orders of the Board.





Updates from the USPTO

2022 USPTO Trademark Examination Guides

- <https://www.uspto.gov/trademarks/guides-and-manuals/trademark-examination-guides>
 - [Examination Guide 1-22](#): Clarification of Examination Evidentiary Standard for Marks Refused as Generic (May 2022)
 - [Examination Guide 2-22](#): Change in Office Action Response Periods for Section 1 and/or Section 44 Applications (December 2022)



Expungement and Reexamination Proceedings

- **Trademark Modernization Act (TMA)**
 - **Reexamination Proceedings**
 - **Any party may request cancellation of some or all of the goods/services in a use-based application if not in use on or before a particular date.**
 - **Must be requested within the first five years after registration.**
 - **Expungement Proceedings**
 - **Any party may request cancellation of some or all of the goods/services in a registration because the registrant never used the mark in commerce with those goods/service.**
 - **Must be requested between 3-10 years after the registration date; but until December 27, 2023 a proceeding may be requested for any registration at least 3 years old.**
 - **<https://www.uspto.gov/trademarks/apply/expungement-and-reexamination-petitions-received>**



Updates from the U.S. Copyright Office

Copyright Claims Board

- In June 2022, the new Copyright Claims Board (CCB) began accepting cases as a voluntary, lower-cost alternative to district court litigation for “small claims.”
- Claims cannot seek more than \$30,000 in total damages, and any statutory damages are limited to \$15,000 per work infringed of \$30,000 or less.
- Claims available:
 - Infringement of an exclusive right under 17 U.S.C. § 106
 - Declaration of non-infringement
 - Misrepresentation in a DMCA notice and take-down or counter-notice procedure under 17 U.S.C. § 512(f)
- Most CCB claims to date involve works of visual art.

As of January 25, 2023, there are:
• 149 open cases pending
• 167 closed cases
• 22 cases dismissed based on the Respondent’s Opt-Out
• 17 Scheduling Orders issued
• No cases dismissed for unsuitability
• No final decisions yet
https://dockets.ccb.gov/

Artificial Intelligence



*A Recent Entrance to Paradise (above)
and Zarya Of The Dawn (right)*





Notable Cases and Developments to Watch in 2023

Cases on the Supreme Court's Docket in 2023

- ***Andy Warhol Foundation v. Goldsmith***: Whether a work of art is "transformative" when it conveys a different meaning or message from its source material, or whether a court is forbidden from considering the meaning of the accused work where it "recognizably deriv[es] from" its source material (as the Second Circuit has held).
- ***Jack Daniel's v. VIP Products***: (1) Whether humorous use of another's trademark on a commercial project is subject to the traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims; and (2) whether humorous use of another's mark on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.
- ***Abitron Austria GmbH v. Hetronic International***: Whether the court of appeals erred in applying the Lanham Act extraterritorially to petitioners' foreign sales, including purely foreign sales that never reached the United States or confused U.S. consumers.



More Cases to Watch in 2023

- ***Genius v. Google***: Does the Copyright Act's preemption clause allow a business to invoke traditional state-law contract remedies to enforce a promise not to copy and use its content?
- ***Great Concepts, LLC v. Chutter, Inc.*** (Fed. Cir): Does reckless disregard for the truth satisfy the "intent to deceive" requirement for fraud on the USPTO?
- ***Red Bubble***: Contributory infringement requires knowledge of specific instances of infringement or specific infringing customers [right?]. Where is the line between such specific knowledge and general knowledge that some customers may infringe?



NFTs and Trademark Infringement

- Pending cases may shed light on how the *Rogers* test, nominative fair use, and the first sale doctrine will apply in cases involving the metaverse
 - ***Hermes Int’l v. Rothschild*** (S.D.N.Y.): Trial over “MetaBirkin” NFTs to begin January 30, 2023
 - ***Nike, Inc. v. StockX LLC*** (S.D.N.Y.): NFTs linked to images depicting Nike shoes sold by StockX on the secondary market
 - ***Yuga Labs, Inc. v. Ryder Ripps*** (C.D. Cal.): “Re-minted” NFTs based on the “Bored Ape” collection of NFTs
- The USPTO and U.S. Copyright Office are conducting a [joint study](#) to consider IP and policy issues associated with NFTs.



Thank You!

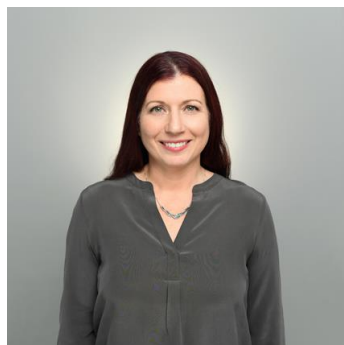
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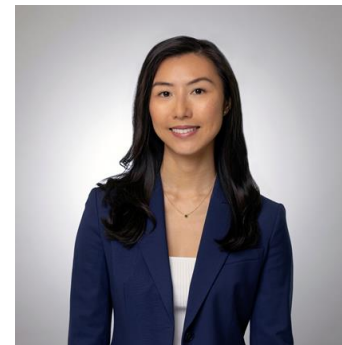
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