

Trademark & Copyright Webinar: 2018 Year in Review

January 23, 2019



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Overview

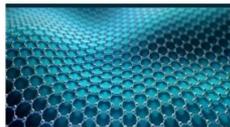
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January 23rd, 2019 | 1:00 pm EST
2018 Trademark & Copyright
Year in Review Webinar



January 17th, 2019 | 1:00 pm EST
Webinar | 2018 Biosimilars – A
Year in Review



January 9th, 2019 | 1:00 pm EST
Post-Grant for Practitioners
Webinar: 2018 Post-Grant Year
in Review



December 18th, 2018 | 1:00 pm EST
Post-Grant for Practitioners
Webinar: Recent Developments
in RPI/Privacy



July 19th, 2018 | 1:00 pm EDT



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Trademark & Copyright 2018 Year in Review

From eatery and brewery disputes to music piracy and social media posts, 2018 was another busy year for trademark and copyright law. In our annual year-in-review webinar, Fish's [Cindy Walden](#), [Kristen McCallion](#), and [Nancy Ly](#) will look back on a number of the more notable cases from 2018, and discuss their significance and potential impact on your business and IP strategy.

Our discussion will cover the following (and more):

- *Goldman v. Breitbart News Network, LLC*
- *BMG Rights Management (US) LLC, and Round Hill Music LP v. Cox Communications, Inc.*
- *Viacom International, Inc. v. JVR Capital Investments, LLC*
- *NantKwest Inc. v. Iancu*
- *Mission Product Holdings Inc. v. Tempnology, LLC*
- Notable issues to watch for in 2019

We hope you will join us!

Wednesday, January 23, 2019
1:00 PM - 2:00 PM EST
via the web

[Register](#) now for this complimentary webinar.



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If you have questions, please contact [Lauren McGovern](#).

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Agenda

- **Notable Trademark Cases & Developments in 2018**
 - *NantKwest Inc. v. lancu*
 - *Mission Product Holdings Inc. v. Tempnology, LLC*
 - *Bodum USA Inc. v. A Top New Casting Inc.*
 - *Viacom International, Inc. v. IJR Capital Investments, LLC*
 - *Schlafly v. The Saint Louis Brewery, LLC*
 - *Beyonce Giselle Knowles-Carter, et al., v. Feyonece, Inc. et al.*
 - *Royal Crown Company, Inc., Dr Pepper/Seven Up, Inc. v. The Coca-Cola Company*
 - *In re Serial Podcast, LLC*
- **Notable Copyright Cases & Developments in 2018**
 - *Fox News Network, LLC v. TVEyes, Inc.*
 - *Goldman v. Breitbart News Network*
 - *BMG Rights Management (US) LLC, and Round Hill Music LP v. Cox Communications, Inc.*
 - *Rentmeester v. Nike, Inc.*
- **Notable Cases To Watch For in 2019**



Notable Trademark Cases in 2018

NantKwest v. Iancu

- **Does the American Rule that each party bears its own attorney fees apply to cases brought under §145 of the Patent Act?**
- The Federal Circuit affirmed the District Court's ruling that fee shifting is not permitted under §145.
- The American Rule requires that each litigant bear its own attorney fees (win or lose) unless a statute has "specific and explicit" language that departs from this rule.
- The "all expenses of the proceeding" language of §145 falls short of this stringent standard.
- 7 Amicus Briefs were filed.
- None in favor of the USPTO's position.

Though a patent case, it would have had implications for trademark cases if decided differently.



Mission Product Holdings v. Tempnology

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INTA Files Amicus Brief in United States Supreme Court Case on Licensee Rights After Licensor Bankruptcy

Case on Licensee Rights After Licensor Bankruptcy
INTA Files Amicus Brief in United States Supreme Court

Bodum USA v. A Top New Casting

BODUM



A TOP / STERLINGPRO



Bodum USA v. A Top New Casting

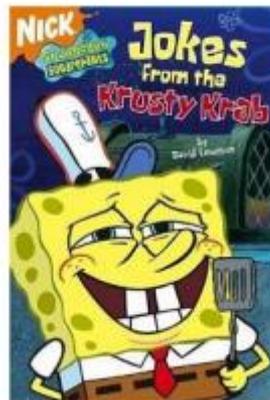
- A Top moved for summary judgment on its affirmative defense that Bodum **abandoned** its trade dress rights because of **naked licensing**.
- **Naked License** = “allow[ing] others to use the mark without exercising reasonable control over the nature and quality of the goods, services, or business on which the mark is used by the licensee.” (*Eva’s Bridal Ltd. v. Halanick Enters., Inc.*, 639 F.3d 788, 789 (7th Cir. 2011)).
- The Seventh Circuit is of the view that “if the trademark owner has good reason to **rely on the licensee’s reputation and expertise**, the existence of contractual obligations undertaken by the licensee may be sufficient in itself to constitute reasonable quality control At least in the absence of evidence indicating significant deviations from the agreed standards or procedures.”
- The Court denied A Top’s motion for summary judgment.

Bodum USA v. A Top New Casting

After a jury trial:

Did Bodum Abandon its Trade Dress?	No
Did A Top Infringe Bodum's Trade Dress?	Yes
Did A Top Willfully Infringe?	Yes
Were A Top's Profits Disgorged?	Yes—\$2,000,000. The court doubled the award to \$4,000,000.
Attorneys' Fees?	No
Permanent Injunction?	Yes

Viacom International v. IJR Capital Investments



Viacom International v. IJR Capital Investments

- **Can specific fictional elements from within a TV show qualify for trademark protection?**
- Yes, if the movant can establish:
 - (1) Ownership of the mark through sales and licensing; and
 - (2) The mark creates a distinctive commercial impression that is source identifying.
- IJR claimed there were material questions of fact about whether Viacom owned a legally protectable mark and whether there was likelihood of confusion.
- The Fifth Circuit disagreed, affirming the District Court's ruling on summary judgment in favor of Viacom on trademark and unfair competition claims based on compelling evidence of secondary meaning and licensing of the mark for merchandise.

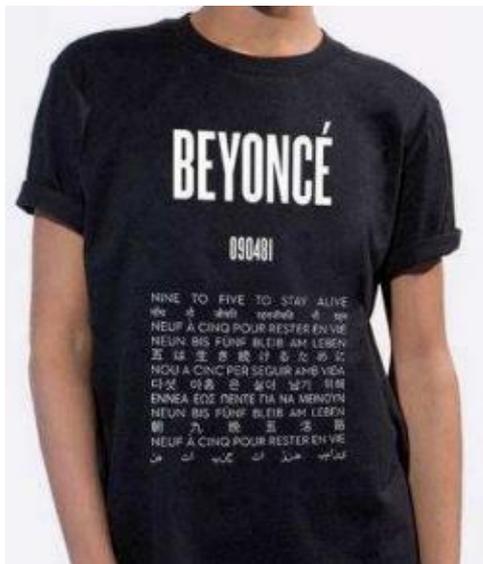
Schlafly v. The Saint Louis Brewery



Schlafly v. The Saint Louis Brewery

- Opposition of SCHLAFLY for beer by two relatives (Revocable Trust of Phyllis Schlafly and Dr. Bruce Schlafly) was denied.
- On appeal, Opposers argued the TTAB erred by not recognizing the SCHLAFLY mark was primarily merely a surname and that it had improperly accepted evidence of secondary meaning.
- The Federal Circuit affirmed the denial of the opposition.
- **What evidence can be considered to show secondary meaning in a surname?**
 - Ownership of prior registration(s);
 - Five years substantially exclusive and continuous use;
 - Other evidence (circumstantial evidence can be sufficient; survey evidence not required)
 - 60 types of beer sold with the SCHLAFLY mark in 15 states, at 14,000 retail locations and several national restaurant chains

Beyoncé Giselle Knowles-Carter v. Feyoncé



Beyoncé Giselle Knowles-Carter v. Feyonce

- “There can be no dispute that in marketing to fiancé purchasers, defendants chose the formation ‘FEYONCÉ’ in order to capitalize off of the exceedingly famous BEYONCÉ mark. ***But that alone does not establish likelihood of confusion. Rather, a critical question is whether a rational consumer would mistakenly believe FEYONCÉ products are sponsored by or affiliated with BEYONCÉ products.***”
- The PTO refused to register FEYONCÉ due to a likelihood of confusion with the BEYONCÉ mark. While the court assigns “substantial weight” to the refusal in assessing likelihood of confusion, it is “***not conclusive.***”

Royal Crown Company v. The Coca-Cola Company



Royal Crown Company v. The Coca-Cola Company

- TTAB denied opposition of various ZERO marks for soft drinks by Applicant.
- Appellants argued Board erred in framing question of genericness and failed to determine whether, if not generic, the marks were highly descriptive.
- The test for genericness is:
 - What is the genus of goods/services at issue?
 - Is the term understood by relevant public primarily to refer to that genus of goods/services?
- Federal Circuit vacated and remanded on the basis that the TTAB failed to examine (1) if ZERO identified a key aspect of the genus at issue, and (2) how the relevant public understood the brand name.

The image shows the Coca-Cola logo in its signature red script font, with the word "zero" in a bold, black, sans-serif font underneath it. A small trademark symbol (TM) is located to the upper right of the word "zero".

In re Serial Podcast

SERIAL

SERIAL

SERIAL

“Entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling”
in Class 41

In re Serial Podcast

“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.”

In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567 (Fed. Cir. 1987).

Determining whether a mark is generic is a two-step inquiry:

- 1. What is the genus of goods or services at issue?**
- 2. Is the term to be registered understood by the relevant public primarily to refer to that genus of goods or services?**

H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc., 782 F.2d 987, 530 (Fed. Cir. 1986).

In re Serial Podcast

- 1. What is the genus of goods or services at issue?**
 - “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling.”

- 2. Is the term to be registered understood by the relevant public primarily to refer to that genus of goods or services?**
 - Who are the relevant public?
 - Evidence of the relevant public’s understanding can be gathered from testimony, surveys, ***dictionaries***, trade journals, newspapers, and other publications.

In re Serial Podcast

SERIAL SERIAL

“These national parodies making prominent use of the design aspects of the marks—especially that of *Saturday Night Live*—evinced the distinctiveness of the composite logos, as a mark has to be well known in the first place to be parodied.”





Notable Copyright Cases in 2018

Fox News Network v. TVEyes

- What are the boundaries of the fair use defense?
- In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
 - (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
 - (2) the nature of the copyrighted work;
 - (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
 - (4) the effect of the use upon the potential market for or value of the copyrighted work.

The Second Circuit held that all of TVEyes' services, with the exception of their text-searchable database of broadcast closed captions, did not constitute fair use because, although the use was somewhat transformative, the effect on Fox's prospective revenue was too significant.



Goldman v. Breitbart News Network

- Does *in-line linking* lead to copyright infringement?
- Seventh and Ninth Circuits -- inline linking does **not** violate US copyright law --
- The “server test” holds that in-line linking constitutes a public display *only* when the defendant hosts the photo on its server.
- Not so, says the SDNY, explaining that the server test “is neither appropriate to the specific facts of this case, nor. . . adequately grounded in the text of the Copyright Act.”

BMG v. Cox

The logo for BMG, consisting of the letters "BMG" in white, bold, sans-serif font, centered within a solid red rectangular background.The logo for COX, consisting of the letters "COX" in a bold, sans-serif font. The "C" is blue, the "O" is green, and the "X" is a darker green.

Key Takeaways:

- To fall within that safe harbor, Cox must show that it meets the threshold requirement, common to all § 512 safe harbors, that it has “*adopted and reasonably implemented . . . a policy that provides for the termination in appropriate circumstances of subscribers . . . who are repeat infringers.*” 17 U.S.C. § 512(i)(1)(A).
- “repeat infringers” in § 512(i) does **not** equal “adjudicated infringers”
- contributory infringement requires proof of at least willful blindness; negligence is insufficient.
- contributory infringement requires knowledge of, or willful blindness to, *specific instances* of infringement.

Rentmeester v. Nike



RENTMEESTER



NIKE

Rentmeester v. Nike



To state a claim for copyright infringement, a plaintiff must allege:

1. Ownership of a valid copyright; and
2. Defendant copied protected aspects of the copyright.
 - Two subcomponents:
 - a. Copying
 - No proof of copying = no liability for infringement
 - b. Unlawful appropriation
 - Only copies “ideas” or “concepts” in P’s work = no liability

Rentmeester v. Nike

Whether Rentmeester has plausibly alleged that Nike copied enough of the protected expression from the photograph to establish *unlawful appropriation*

- Rentmeester has to show that Nike copied enough to render their works *substantially similar*.
- The Ninth Circuit has a *two-part test* to determine substantial similarity:
 1. “Extrinsic Test”
 - » Compares the objective similarities of the works—focusing **ONLY** on the protectable elements of plaintiff’s expression.
 2. “Intrinsic Test”
 - » A holistic, subjective comparison of the works to determine whether they are substantially similar in “total concept and feel.”
- Plaintiff must prove substantial similarity under *both tests*.

Rentmeester v. Nike



“What Rentmeester’s photo and the Nike photo share are *similarities in general ideas or concepts*: Michael Jordan attempting to dunk in a pose inspired by ballet’s *grand jeté*; an outdoor setting stripped of most of the traditional trappings of basketball; a camera angle that captures the subject silhouetted against the sky.”

Rentmeester v. Nike

“Rentmeester cannot claim an exclusive right to ideas or concepts at that level of generality, even in combination.”





Notable Cases To Watch For in 2019

What To Watch For In 2019

- *Rimini Street v. Oracle USA*
- *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*
- *Nirvana LLC v. Mark Jacobs Int'l LLC*
- *In re Brunetti*
- *Monster Energy Company v. Integrated Supply Network, LLC*

Thank You!

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