

# A QUICK GUIDE TO TRADEMARK LAW AND RECENT DEVELOPMENTS IN THE FEDERAL CIRCUIT

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*Executive Summary: Trademark law enables businesses to build brand reputation and recognition by providing legal protection to marks that are distinctive, non-functional, and used in commerce. Federal trademark protection is codified in the Lanham Act, which additionally protects trade dress—features of a product’s design or packaging. Trademark protection exclusively extends to features that are deemed to be non-functional. The value of trademark protection is aimed at removing consumer confusion and upholding a company’s goodwill in the marketplace. Geographic marks also afford the same protection, and they must avoid causing confusion with existing trademarks and vice versa. If a mark is similar to another established mark or suggests a false geographic origin, it might not be registrable or be subject to challenges. The Federal Circuit addresses the Trademark Trial and Appeal Board’s dismissal of the geographic mark ‘cognac’ in Bureau National Interprofessionnel Du Cognac v. Cologne & Cognac Entertainment, summarized below.*

## I. BACKGROUND OF TRADEMARK LAW

Trademark law is the protection and enforcement of brand names used to sell goods and services.<sup>1</sup> Companies like Apple, Nike, and Disney use their brand names to create reputations that have their own value separate from the companies’ products and services. Companies rely on the value of their reputation, or goodwill to compete in the global marketplace. Trademark law ensures that external entities do not exploit or illegally use companies’ goodwill. It also prevents confusion by ensuring that consumers do not purchase goods from one company when they intend to purchase goods from another company.<sup>2</sup>

Unlike copyright law and patent law, which protect intellectual property for a limited duration before forcing it to enter the public domain, trademark rights can last indefinitely—as long as the mark’s owner is continuously using the mark in commerce.<sup>3</sup> This is because United States trademark law is enabled under the Commerce Clause of the U.S. Constitution and confers rights based on a company’s use of a mark; whereas, copyright and patent law—enabled by Article 1, Section 8 of the U.S. Constitution<sup>4</sup>—incentivize creativity and invention by providing a period of exclusive rights.<sup>5</sup>

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<sup>1</sup> Marks used in connection with services are often called “service marks.” This memo will use the term “trademark” to refer to both trademarks and service marks.

<sup>2</sup> See *Museum of Mod. Art v. MOMACHA IP LLC*, 339 F. Supp. 3d 361, 376 (S.D.N.Y. 2018) (discussing how using the name MoMaCha in the same font style as MoMa is likely to confuse consumers into thinking MoMaCha is affiliated with the Museum of Modern Art).

<sup>3</sup> “Use in commerce” refers to a “sale or transportation of the trademarked goods in United States interstate or international commerce. J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:117 (5th ed. 2023).

<sup>4</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>5</sup> MCCARTHY, *supra* note 3, at § 6.8.

As discussed below, the United States Patent and Trademark Office (USPTO) grants federal registrations to parties whose trademarks meet the federal requirements for protectability. Federal registration confers several important rights under the Lanham Act,<sup>6</sup> the federal codification of trademark law. Trademark rights, however, have their basis in common law. Trademark owners may enforce their rights using the federal Lanham Act, state common law, and trademark statutes (often called unfair competition statutes) to sue other mark owners for infringement, dilution, false advertising, right of publicity, and other unfair competition claims.<sup>7</sup> Only parties whose own marks or likenesses have been exploited can sue under the Lanham Act, as the Lanham Act does not give disinterested consumers a right of action.<sup>8</sup> If consumers wish to report a party for false advertising or for using a mark that confuses consumers into thinking it is another party's mark, they may file a complaint with the Federal Trade Commission.<sup>9</sup>

## II. WHAT IS A TRADEMARK?

While trademarks are commonly thought of as words or logos, trademark law also protects “trade dress,”<sup>10</sup> colors, designs, sounds, scents, and textures.<sup>11</sup> In the United States, a trademark is a protectable and enforceable property right only if it is (1) distinctive of source, (2) non-functional, and (3) used in commerce.<sup>12</sup>

To be distinctive of source, a mark must instantly communicate to the consumer the source of a good or service.<sup>13</sup> In a landmark case, the Second Circuit created a spectrum of distinctiveness from least distinctive (generic) to most distinctive (fanciful).<sup>14</sup> At the least

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<sup>6</sup> 15 U.S.C. §§ 1051–1141.

<sup>7</sup> Trademark common law dates back to medieval brandings used by merchants to distinguish their goods from one another. *See* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1849–50 (2007).

<sup>8</sup> 15 U.S.C. § 1125 (stating that the Lanham Act applies to “any person who believes that he or she is or is likely to be damaged by such act”).

<sup>9</sup> *See What We Do*, FED. TRADE COMM’N, <https://www.ftc.gov/about-ftc/what-we-do> (last visited Sept. 12, 2024).

<sup>10</sup> Trade dress is a product’s packaging or configuration, and it must be nonfunctional. MCCARTHY, *supra* note 3, at § 8.4.

<sup>11</sup> For example, NBC’s stylized peacock logo and three-note chime are registered marks, Registration No. 1,931,255, and Registration No. 0,916,522, respectively.

<sup>12</sup> BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 214 (10th ed. 2023).

<sup>13</sup> Note that “source” does not mean the literal factory where goods were manufactured, but rather the entity that provides the goods to consumers. A trademark cannot describe the goods or services—it must designate who a product comes from, and not what the product is. Additionally, a mark may be either inherently distinctive, or may have acquired distinctiveness if consumers have come to recognize the mark as referring to a particular source of goods even though the mark itself merely describes the goods. McCarthy, *supra* note 3, at § 4.14 (“secondary meaning”).

<sup>14</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The Supreme Court endorsed Judge Friendly’s spectrum as the appropriate test for determining whether a mark is sufficiently distinctive in *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 768 (1992). However, this spectrum is difficult to apply to non-word marks. *See generally* *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205

distinctive end of the spectrum are generic marks, which are never enforceable.<sup>15</sup> Generic marks name the actual type of good or service and do not serve any source-identifying function.<sup>16</sup> Recently, the court held the mark “Pretzel Crisps” to be generic and unprotectable for “pretzel crackers” after twelve years of litigation.<sup>17</sup> Next on the distinctiveness spectrum are descriptive marks, which merely describe qualities or characteristics of the good or service without serving as an immediate source identifier.<sup>18</sup> Descriptive marks are not enforceable unless they have acquired secondary meaning.<sup>19</sup> The next category of marks are suggestive marks, which are distinctive enough to be enforceable without a showing of secondary meaning.<sup>20</sup> A suggestive mark “requires imagination, thought and perception to reach a conclusion as to the nature of the goods,” therefore acting as an indicator of source rather than as a description of the goods themselves.<sup>21</sup> Finally, the most distinctive marks—arbitrary and fanciful—are unrelated to the actual goods or services (e.g. Apple for computers), or are completely made-up words (e.g. Pepsi for soda).<sup>22</sup> Arbitrary and fanciful marks instantly refer to the source of the goods or services

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(2000) (discussing the Abercrombie spectrum applicability to trade dress). For a helpful chart depicting the spectrum, see *Is Your Brand “Distinctive” Enough to Be Trademarked?*, PATROLA LAW, <http://patrolalaw.com/is-your-brand-distinctive-enough-to-be-trademarked> (last updated June 29, 2022).

<sup>15</sup> See MCCARTHY, *supra* note 3, at § 12.1 (“[A] generic name of a product can never function as a trademark to indicate origin.”).

<sup>16</sup> Examples include “Hotels.com” for making hotel reservations and “Serial” for an ongoing investigative reporting podcast. See *In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009); *In re Serial Podcast, LLC*, 126 U.S.P.Q.2d 1061, 1072 (T.T.A.B. 2018) (holding that Serial’s logos had acquired distinctiveness and were allowed to be registered).

<sup>17</sup> *Snyder’s Lance, Inc. v. Frito-Lay N. Am., Inc.*, No. 3:17-CV-00652, 2021 WL 2322931 (W.D.N.C. June 7, 2021).

<sup>18</sup> Examples include “Fish-Fry” for batter mixes to fry fish and “Supreme” for vodka. *Zatarains, Inc. v. OakGrove Smokehouse, Inc.*, 698 F.2d 786, 793 (5th Cir. 1983); *Supreme Wine Co. v. Am. Distilling Co.*, 310 F.2d 888, 889 (2d Cir. 1962); see e.g., *In re N.C. Lottery*, 866 F.3d 1363, 1366, 1369 (Fed. Cir. 2017) (holding that the mark “First Tuesday” is merely descriptive because it is less a source-identifier than it is a description of a feature of the goods or service).

<sup>19</sup> See *supra* note 13.

<sup>20</sup> See *Pinterest, Inc. v. Pintrips, Inc.*, 140 F. Supp. 3d 997, 1010 (N.D. Cal. 2015) (explaining that “Pinterest” is a classic suggestive mark because it is a combination of the words “pin” and “interest,” which hints to users that they will be pinning their interests on the website).

<sup>21</sup> *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968). Examples include “Tide” for laundry detergent and “Streetwise” for street marks. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210–11 (2000); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998). A suggestive mark may receive less protection under trademark law than a descriptive mark when it is too closely associated with the products’ attributes. See *RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 122 (2d Cir. 2022) (discussing that the use of the word “rise” to describe coffee is weak under trademark law because it clearly associates with the purposes of drinking coffee).

<sup>22</sup> Examples of arbitrary marks include “Gap” for apparel and “Omega” for watches (these terms have nothing to do with the actual goods and services). See *Gap, Inc. v. G.A.P. Adventures Inc.*, No. 07-cv-9614, 2011 WL 2946384, at \*13 (S.D.N.Y. June 24, 2011); *Omega S.A. v. Omega Eng’g, Inc.*, 228 F. Supp. 2d 112, 123 (D. Conn. 2002). Examples of fanciful marks include “Hobbit” for a character in books and movies and “Viagra” for an erectile dysfunction drug (these terms were coined for the sole purpose of

without describing the characteristics of the goods or services and the strongest marks confer the greatest scope of protection.<sup>23</sup>

Trademarks also cannot be functional. For trade dress in particular, the source-identifying purpose of the good (e.g., Coca-Cola’s recognizable glass bottle shape) must outweigh the functional purpose of the good (e.g., the flat bottom allowing the bottle to remain upright).<sup>24</sup> Finally, trademarks must be used in commerce.<sup>25</sup> This means that the mark must be used to advertise, sell, or otherwise conduct commercial business regarding goods or services in the United States or between the United States and a foreign nation.<sup>26</sup>

### III. HOW TRADEMARKS ARE OBTAINED, CHALLENGED, AND ENFORCED

Trademark owners have several means to enforce their rights, including federal registration, ex parte and inter partes actions at the Trademark Trial and Appeal Board (TTAB), and federal district court litigation.

#### A. Federal Registration

One of the most important steps in securing broad trademark rights is to secure a federal trademark registration. There are numerous benefits to obtaining a federal registration, including nationwide priority beginning on the application date, constructive use and notice to potential competitors, presumption of validity, basis for obtaining registration in foreign countries, right to request the U.S. Customs and Border Patrol to prevent infringing imports, statutory remedies, and right to use ®.<sup>27</sup>

The USPTO, an executive office within the Department of Commerce, is responsible for

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identifying the source of the goods and services). See *Warner Bros. Ent. v. Glob. Asylum, Inc.*, No. CV 12–9547 (CWx), 2012 WL 6951315, at \*5 (C.D. Cal. Dec. 10, 2012), *aff’d*, 544 Fed. App’x 683 (9th Cir. 2013); *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 520 (S.D.N.Y. 2009).

<sup>23</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 786 (Thomas, J., concurring).

<sup>24</sup> See generally *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (creating a four-factor test to determine whether trade dress is functional). The United States Court of Customs and Patent Appeals (C.C.P.A.) has since become the Court of Appeals for the Federal Circuit.

<sup>25</sup> This contrasts with many other countries that grant trademark registrations without evidence that the mark is used in commerce. See MCCARTHY, *supra* note 5, at § 16:1:50; see also Tara M. Aaron & Axel Nordemann, *The Concepts of Use of a Trademark under European Union and United States Trademark Law*, 104 T.M.R. 1186, 1189 (2014) (noting parties seeking trademark registration in the European Union do not have to prove use or intent to use).

<sup>26</sup> See *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1382 (Fed. Cir. 2015) (establishing that a company must actually render service using the mark to constitute use in commerce). For an insightful discussion of the consequences and questions after the Court’s recent decision restricting extraterritoriality in the Lanham Act, see Margaret Chon & Christine Haight Farley, *Trademark Extraterritoriality: Abitron v. Hetronic Doesn’t Go the Distance*, TECH. & MKTG. L. BLOG (July 17, 2023), <https://blog.ericgoldman.org/archives/2023/07/trademark-extraterritoriality-abitron-v-hetronic-doesnt-go-the-distance-guest-blog-post.htm>.

<sup>27</sup> BEEBE, *supra* note 12 at 232–38.

granting or refusing federal registration.<sup>28</sup> Individuals and businesses seeking to register a new trademark may apply through the USPTO’s online portal independently or through a licensed attorney.<sup>29</sup> Once a party submits an application, the USPTO assigns an Examining Attorney to review the application for compliance with USPTO regulations and the Lanham Act.<sup>30</sup>

If a mark is approved by the USPTO, it is published in The Trademark Official Gazette and open to challenge for thirty days by “any person who believes that he would be damaged by the registration of a mark.”<sup>31</sup> The grounds for opposing a mark vary, but usually the petitioner asserts that there is a likelihood of confusion between its mark and the opposed mark.<sup>32</sup> If no opposition (or extension) is filed, the mark proceeds to allowance and ultimately to registration, once use has been demonstrated.<sup>33</sup> The term of registration is ten years, with the ability to renew indefinitely, provided compliance with the USPTO post-registration and maintenance requirements.<sup>34</sup> If the USPTO refuses to register an applicant’s mark, the applicant can appeal the refusal as an ex parte action<sup>35</sup> to the Trademark Trial and Appeal Board (TTAB).<sup>36</sup>

### B. *Trademark Trial and Appeal Board (TTAB) Proceedings and Appeals*

The TTAB is a neutral body of administrative trademark judges responsible for adjudicating trademark disputes in the first instance.<sup>37</sup> The TTAB is not authorized to determine whether applicants may legally use a trademark, but it is allowed to determine whether applicants have the right to register trademarks with the federal government.<sup>38</sup> The TTAB is authorized to handle five types of cases, but the three that it most commonly deals with are (1) ex parte appeals, (2) oppositions, and (3) cancellations.<sup>39</sup> First, in an ex parte appeal, the applicant

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<sup>28</sup> The USPTO may refuse registration on several grounds, including a likelihood of confusion with any third-party mark, being deceptively misdescriptive, and being primarily geographically descriptive. 15 U.S.C. § 1052.

<sup>29</sup> U.S. PAT. & TRADEMARK OFF., TRADEMARK PROCESS, <https://www.uspto.gov/trademarks/basics/trademark-process>.

<sup>30</sup> *Id.*

<sup>31</sup> 15 U.S.C. § 1062(a).

<sup>32</sup> The likelihood of confusion is also the test for whether a party has engaged in trademark infringement against another’s mark and is decided by a multi-factor test. The TTAB and Federal Circuit use the factors set forth in *In re E. I. du Pont de Nemours & Co.*, but each circuit has its own multi-factor test. 476 F.2d 1357 (C.C.P.A. 1973).

<sup>33</sup> BEEBE, *supra* note 12, at 247.

<sup>34</sup> Lanham Act §§ 8–9, 15 U.S.C. §§ 1058–59.

<sup>35</sup> This is an ex parte action because there is no claim of action between opposing parties—just a disagreement between an applicant and the PTO about whether a mark is registrable.

<sup>36</sup> Note that all ex parte TTAB and appellate hearings decide only whether a mark is registrable, not whether a party’s use of a mark infringes upon another party’s mark.

<sup>37</sup> U.S. PAT. & TRADEMARK OFF., *About The Trademark Trial and Appeal Board*, <https://www.uspto.gov/trademarks/laws/trademark-trial-and-appeal-board> (last modified Feb. 21, 2019).

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

may challenge the USPTO Examining Attorney’s decision to refuse trademark registration.<sup>40</sup> Second, a party may initiate an opposition proceeding to challenge the registration of a trademark as published in The Trademark Official Gazette.<sup>41</sup> Finally, a party may initiate a cancellation proceeding with the TTAB in an attempt to invalidate and remove the existing trademark registration of another party from the register.<sup>42</sup>

If a party is unsatisfied with the TTAB’s decision in an appeal, opposition, or cancellation proceeding, the party can either (1) appeal to the Federal Circuit—the Article III court with appellate jurisdiction over TTAB decisions—or (2) appeal to any federal district court.<sup>43</sup> There are two advantages of the district court route. First, the record in the case may be supplemented with additional evidence. Second, the district court’s rulings may be appealed to its reviewing appellate court, thus making it possible to forum shop and avoid the Federal Circuit.<sup>44</sup>

### C. *Federal Litigation*

Parties can also enforce their trademark rights by suing in district court, alleging trademark infringement, dilution, or any other cause of action enabled by the Lanham Act or common law.<sup>45</sup> Parties with a federal trademark registration can bring trademark causes of action in any federal district court with jurisdiction; appeals are heard by the respective circuit court. Famous trademarks are protected from unauthorized uses that are likely to blur their distinctiveness, regardless of whether there is a likelihood of consumer confusion.<sup>46</sup> Dilution by blurring is actionable under federal law where there is an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”<sup>47</sup>

## IV. TRADE DRESS

In addition to protecting traditional trademarks, the Lanham Act also protects trade dress,<sup>48</sup> which is the “appearance of a product when that appearance is used to identify a producer.”<sup>49</sup> Trade dress may include a product’s size, shape, color, graphics, or configuration.<sup>50</sup>

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<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> Lanham Act § 21, 15 U.S.C. § 1071.

<sup>44</sup> BEEBE, *supra* note 12, at 247.

<sup>45</sup> Note that the Lanham Act confers upon both federally registered and unregistered trademarks the right to sue for infringement. 15 U.S.C. §§ 1114, 1125.

<sup>46</sup> ANNE GILSON LALONDE, 1 GILSON ON TRADEMARKS § 1.03 Source Identification and Distinctiveness (Matthew Bender 2022).

<sup>47</sup> 15 U.S.C. § 1125(c)(2)(B).

<sup>48</sup> Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000).

<sup>49</sup> Publ’ns Int’l, LTD. v. Landoll, Inc., 164 F.3d 337 (7th Cir. 1998).

<sup>50</sup> Paula Mays, Trade Dress, 88 J. PAT. & TRADEMARK OFF. SOC’Y 392, 392 (2006).

The purpose of trade dress law is to prevent confusion about the source of a product.<sup>51</sup> There are two principal categories of trade dress: product design and product packaging.<sup>52</sup> Product packaging, like a restaurant layout, may be inherently distinctive and therefore eligible for trade dress protection without a showing of secondary meaning.<sup>53</sup> On the other hand, product design, like the shape of a Coca-Cola bottle, cannot be inherently distinctive, so the applicant or trademark holder must show that the design has acquired a secondary meaning to receive trade dress protection.<sup>54</sup>

## V. FUNCTIONALITY DOCTRINE

Non-functionality is one of three requirements a trademark must satisfy to qualify for protection.<sup>55</sup> The Lanham Act explicitly states that a mark must be refused registration when it “comprises any matter that, as a whole, is functional.”<sup>56</sup> The functionality doctrine maintains separation between patent and trademark protections.<sup>57</sup> Patents are specifically designed to protect useful inventions, whereas trademark law protects non-functional branding features.<sup>58</sup>

“Functionality” within trademark law can refer to either utilitarian functionality or aesthetic functionality.<sup>59</sup> Under the utilitarian approach to functionality, “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>60</sup> The existence of a utility patent for a feature creates a strong presumption of the feature’s utility.<sup>61</sup> The doctrine of aesthetic functionality “looks to whether the [trade] dress makes [a product] more appealing to the public by aesthetic means.”<sup>62</sup> Aesthetic features are functional when they are necessary for a product to compete in its market.<sup>63</sup> Even when a plaintiff successfully presents a prima facie case for trademark infringement, the defendant is not liable if it can prove either utilitarian or aesthetic functionality.<sup>64</sup>

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<sup>51</sup> Jeff Resnick, *Trade Dress Law: The Conflicts Between Product Design and Product Packaging*, 24 WHITTIER L. REV. 253, 256 (2002); *see, e.g.*, *PIM Brands Inc. v. Haribo of America Inc.*, 81 F.4th 317, 323 (3d Cir. 2023) (holding that the shape and color of PIM’s watermelon-flavored candy made it functional because its trade dress resembled a watermelon appearance).

<sup>52</sup> *Id.*

<sup>53</sup> *See Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 767 (1992) (holding that trade dress can be inherently distinctive); *see also Samara Bros.*, 529 U.S. at 215 (explaining that the trade dress examined in *Two Pesos* qualifies as product packaging).

<sup>54</sup> *Samara Bros.*, 529 U.S. at 216.

<sup>55</sup> *See supra* text accompanying note 12.

<sup>56</sup> 15 U.S.C. § 1052(e)(5).

<sup>57</sup> *Ezaki Glico Kabushki Kaisha v. Lotte Int’l Am. Corp.*, 986 F.3d 250, 256 (3d Cir. 2021).

<sup>58</sup> *Id.* at 255.

<sup>59</sup> *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1338 n.1 (1982).

<sup>60</sup> *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 850 n.10 (1981).

<sup>61</sup> *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 29 (2001).

<sup>62</sup> Spencer Davczyk, *Aesthetic Functionality in Trade Dress: Post-Secondary Aesthetic Functionality Proposed*, 105 COM. L.J. 309, 315 (2000).

<sup>63</sup> *Id.*

<sup>64</sup> *Wallace Int’l Silversmith v. Godinger Silver Art Co.*, 916 F.2d 76, 79 (2d Cir. 1990).

## VI. THE TRADEMARK MODERNIZATION ACT OF 2020

Enacted in December 2020,<sup>65</sup> the Trademark Modernization Act of 2020 (TMA) amended the Lanham Act in three important respects.<sup>66</sup> First, the TMA created two new ex parte procedures: expungement and reexamination.<sup>67</sup> There have been 818 petitions filed under these ex parte procedures since April 2023.<sup>68</sup> This includes 401 expungements<sup>69</sup> and 417 reexaminations,<sup>70</sup> 80 of which were brought by the USPTO.<sup>71</sup> Second, the TMA changed the application process by allowing trademark examiners to shorten the response deadlines for applicants.<sup>72</sup> Finally, the TMA clarified the appropriate standard of proof for trademark litigation.<sup>73</sup> For a court to grant injunctive relief in a trademark case, courts must find that a plaintiff would suffer “irreparable injury” if an injunction is not ordered.<sup>74</sup> Historically, federal courts held that the “irreparable injury” element is satisfied when the alleged trademark infringement is likely to cause customer confusion, but federal courts have recently weakened this requirement by holding that customer confusion does not automatically create an assumption of irreparable injury.<sup>75</sup> The TMA addressed this issue by reestablishing the traditional principle that a showing of customer confusion is dispositive of the plaintiff’s irreparable injury.<sup>76</sup>

## VII. GEOGRAPHIC MARKS

Geographic indications are a type of geographical mark that signifies a product’s origin and adherence to specific regional standards.<sup>77</sup> As with any type of certification mark, its owner

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<sup>65</sup> Changes to Implement Provisions of the Trademark Modernization Act of 2020, 86 Fed. Reg. 26,862, 26,863 (May 18, 2021).

<sup>66</sup> David T. Azrin, *The Trademark Modernization Act: New Procedures and Rules That Will Benefit Trademark Owners*, 31 INTELL. PROP. LITIG. 17, 17 (2021).

<sup>67</sup> *Id.* at 17–18.

<sup>68</sup> Mark Lerner, Jennifer M Lantz & Lauren Matturri, *The Trademark Modernization Act One Year On: New Tools and Takeaways*, WORLD TRADEMARK REVIEW (June 30, 2023).

<sup>69</sup> In an expungement proceeding, third parties may challenge a trademark registration by submitting evidence amounting to prima facie showing that the mark has never been used in commerce on or in connection with. Azrin, *supra* note 66, at 18.

<sup>70</sup> In a reexamination proceeding, third parties may challenge a trademark registration by submitting evidence amounting to a prima facie showing that the mark was not in use in commerce on or in connection with some or all the goods or services as of the alleged use date. *Id.*

<sup>71</sup> Lerner, *supra* note 68.

<sup>72</sup> *See id.* (explaining that this change would help weed out fraudulent and improper applications more quickly).

<sup>73</sup> *Id.* at 18–19.

<sup>74</sup> 15 U.S.C. § 1116(d)(4)(B)(iv).

<sup>75</sup> Azrin, *supra* note 66, at 18–19.

<sup>76</sup> *Id.* at 19.

<sup>77</sup> U.S. Patent and Trademark Office, Examination Guide 2-14 Geographic Certification Marks at 1 (July 2014).



does not use a geographic certification mark like a trademark or service mark.<sup>78</sup> The holder of a geographic certification mark regulates how other parties use the mark.<sup>79</sup> Parties then use the mark on their goods or services to signal to consumers that they have been certified as meeting the certifying organization’s standards.<sup>80</sup> The goods or services bearing a geographic certification mark can come from multiple certified producers within the designated region.<sup>81</sup>

VIII. *BUREAU NATIONAL INTERPROFESSIONNEL DU COGNAC V. COLOGNE & COGNAC ENTERTAINMENT*

Most recently, in *Bureau National Interprofessionnel du Cognac v. Cologne & Cognac Entertainment*,<sup>82</sup> the Bureau National Interprofessionnel du Cognac (BNIC), a French organization responsible for regulating the Cognac industry, sued Cologne & Cognac Entertainment for trademark infringement.<sup>83</sup> Cologne & Cognac Entertainment, a company involved in music entertainment and promotional activities, used the term “Cognac” in its branding and marketing.<sup>84</sup> The BNIC contended that this usage could confuse consumers, implying a connection between their products and the legitimate Cognac brand.<sup>85</sup> The BNIC sought to prevent the company from using the term “Cognac” and to claim damages for any harm caused to the reputation of the genuine Cognac brand.<sup>86</sup>

The TTAB dismissed the opposition against Cologne & Cognac Entertainment’s mark.<sup>87</sup> In a split decision, the Board held that that the mark combining the phrase COLOGNE & COGNAC ENTERTAINMENT and a design featuring a bottle of COGNAC, if used for hip-hop music and production services, was not likely to cause confusion or dilution.<sup>88</sup> The Board further explained that the opposition’s evidence of substantial sales and advertising of certified

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<sup>78</sup> *Id.*

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> 110 F.4th 1356 (Fed. Cir. 2024).

<sup>83</sup> *Id.* at 1362.

<sup>84</sup> David Taylor, *Argument Recap – Bureau National Interprofessionnel du Cognac v. Cologne & Cognac Entertainment*, FEDCIRCUITBLOG.COM (May 31, 2024), <https://fedcircuitblog.com/2024/06/17/argument-recap-bureau-national-interprofessionnel-du-cognac-v-cologne-cognac-entertainment/>.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> *Bureau Nat’l Interprofessionnel du Cognac v. Cologne & Cognac Ent.*, 2022 WL 3755301 (T.T.A.B. 2022).

<sup>88</sup> *Id.*; see also Blake Brittain, *US Appeals Court Revives Cognac Trademark Fight with Hip-Hop Label*, REUTERS (Aug. 6, 2024 2:19 PM), <https://www.reuters.com/legal/litigation/us-appeals-court-revives-cognac-trademark-fight-with-hip-hop-label-2024-08-06/> (explaining how TTAB should have considered “whether or not [BNIC’s] mark was famous as an indicator of its geographic origin’ like Florida oranges, Georgia peaches or Darjeeling tea”).

COGNAC products could not establish the fame of the certification mark because those products also prominently bear brand names.<sup>89</sup>

BNIC appealed to the United States Court of Appeals for the Federal Circuit.<sup>90</sup> The appellants challenged the ruling on the likelihood of confusion, arguing that the majority made significant legal and factual errors regarding the relevant factors.<sup>91</sup> BNIC contended that the Board wrongly required proof of fame based on the mark’s “certification status” alone and failed to recognize that both the certification mark and the brand names it certifies can be famous.<sup>92</sup> BNIC also disputed the comparison used for assessing similarity, arguing that the marks should be deemed highly similar due to the incorporation of the famous COGNAC mark as a dominant part of the COLOGNE & COGNAC mark.<sup>93</sup>

Cologne & Cognac Entertainment defended the Board’s decision, arguing that the appellants’ mark did not warrant “famous” status and that the Board correctly assessed the similarity of the marks and the relatedness of the goods and services.<sup>94</sup> On the dilution claim, Cologne and Cognac Entertainment argued that if a mark is not deemed famous, it cannot be diluted.<sup>95</sup>

The Federal Circuit sought to answer whether the Board measured the commercial success of the relevant mark correctly and whether the Board was correct in saying there must be evidence of considerable consumer knowledge of the mode of manufacture or certification.<sup>96</sup> First, the Federal Circuit addressed the likelihood of confusion. The court agreed with the BNIC after analyzing several of the *DuPont* factors.<sup>97</sup> The court focused on the fame of the prior mark, including sales, advertising, and length of use.<sup>98</sup> The court further argued that the Board erred when they deemed COGNAC not famous<sup>99</sup> and “should have considered whether COGNAC was famous for indicating geographic origin,”<sup>100</sup> instead of just famous for certification status.<sup>101</sup>

Next, the Federal Circuit addressed the similarity of the marks. The first *DuPont* factor “assesses the similarity or dissimilarity of the marks in their entireties, considering their

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<sup>89</sup> Brittain, *supra* note 88.

<sup>90</sup> *Bureau Nat’l Interprofessionnel du Cognac v. Cologne & Cognac Ent.*, 110 F.4th 1356 (Fed. Cir. 2024).

<sup>91</sup> Brittain, *supra* note 88.

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> Taylor, *supra* note 84.

<sup>97</sup> See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (1973) (laying out factors to analyze the likelihood of confusion in any comparison of trademarks).

<sup>98</sup> *Bureau Nat’l Interprofessionnel du Cognac v. Cologne & Cognac Ent.*, 110 F.4th 1356 (Fed. Cir. 2024).

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

appearance, sound, connotation and commercial impression.”<sup>102</sup> The court determined that the Board erred in its conclusion that the marks were dissimilar because the applicant’s mark “engenders a different appearance, sound, commercial impression, and connotation”<sup>103</sup> from the certification mark.<sup>104</sup>

*DuPont* factors two and three evaluate the similarity or dissimilarity of the goods or services and the nature of the trade channels.<sup>105</sup> The Federal Circuit determined that the Board made an error by entirely disregarding evidence showing a strong connection between certified COGNAC brands and hip-hop music in the United States.<sup>106</sup> Finally, the Federal Circuit overturned the Board’s dismissal of the dilution by blurring claim because, contrary to the Board’s decision, BNIC had sufficiently demonstrated that the COGNAC mark was in use before the mark alleged to cause dilution.<sup>107</sup>

Thus, the Federal Circuit vacated and remanded the Board’s decision.<sup>108</sup> This ruling is important because it emphasizes the importance of protecting geographical indications and trademarks, which are crucial for maintaining the quality and reputation of specific products.

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<sup>102</sup> Katherine Pappas, *Unbranded Brandy: COGNAC Certification Mark Matters, Even in Hip-Hop*, *IPUPDATE.COM* (Aug. 15, 2024), <https://www.ipupdate.com/2024/08/unbranded-brandy-cognac-certification-mark-matters-even-in-hip-hop/>.

<sup>103</sup> *Cologne & Cognac Ent.*, 110 F.4th at 1370.

<sup>104</sup> Pappas, *supra* note 102.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> *Cologne & Cognac Entertainment*, 110 F.4th 1362 (Fed. Cir. 2024).