TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY

Seventh Edition

FALL 2026 Update

Graeme B. Dinwoodie
University Distinguished Professor &
Global Professor of Intellectual Property Law
IIT Chicago-Kent College of Law

Mark D. Janis
Robert A. Lucas Chair of Law
Indiana University Maurer School of Law

Mark P. McKenna
Professor of Law
UCLA School of Law
Faculty Co-Director, UCLA Institute for
Technology, Law & Policy

Contents

Preface

This Update contains excerpts from, and notes about, cases and other materials that have been published in the very short time since the Seventh edition of the casebook was published.

We have discontinued our past practice of providing a separate set of statutory materials. All of these are readily available online at sites that are continually updated.

As always, we welcome your comments on the wisdom of these editorial choices, as well as on any other aspect of the casebook or the Update.

G.B.D.
M.D.J.
M.P.McK

FOUNDATIONS AND PURPOSES OF TRADEMARK AND UNFAIR COMPETITION LAW

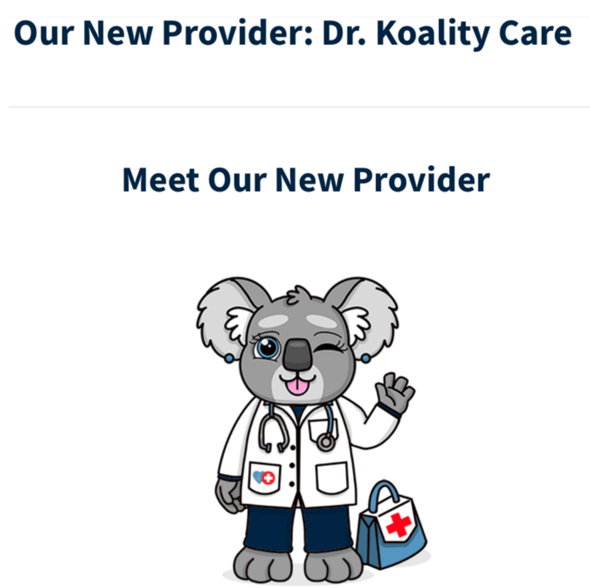
I

1

INTRODUCTION TO TRADEMARK AND UNFAIR COMPETITION LAW

At page 38, add to Note 11:

- In early 2026, Midwest Express Healthcare, a Chicago-based immediate care provider, started using the following slogan on it building façade: “COME IN FOR KOALITY CARE”. It has also started using the following image on its web page and in online advertisements:



A rival healthcare provider, Hush Medical Services, has long advertised its immediate care services with radio advertisements that end with the tag line “Come in for Quality Care.” In light of the principles discussed in this first Chapter, can you identify any trademark issues that might be implicated by the parties’ respective uses?

CREATION OF TRADEMARK RIGHTS

II

DISTINCTIVENESS

2

At page 108, add a new note as Note 8A:

8A. *Quantifying "primary significance"*. In *Illinois Tamale Co., Inc. v. LC Trademarks, Inc.*, 164 F.4th 648 (7th Cir. 2026), the plaintiff sought to defend its trademark registration for PIZZA PUFF for a food product consisting of a flour tortilla wrapped around pizza toppings (which could be fried or baked). The defendant argued the mark was generic and introduced a *Teflon* survey to support that argument. The Seventh Circuit articulated how to assess such surveys in light of the statutory standard.

> Little Caesars presented extensive evidence to show that the primary significance of Iltaco's incontestable "Pizza Puff" mark to consumers is as a generic term. First, Little Caesars presented the results of a *Teflon* survey, showing 83.3% of consumers of dough-based, pizza-ingredient-filled foods perceive "pizza puff" as a common (i.e., generic) term, while only 12.7% perceive the term as a brand name. The district court dismissed this strong evidence of genericness by finding it was "not conclusive" because in *Ty* we said, in dicta, that as few as ten percent of consumers associating a mark with an owner's brand could result in consumer confusion. We cannot accept that ten percent of consumers is a relevant percentage for the genericness test, which focuses on the "primary significance" of a product to consumers. "[I]f a survey showed that 75 percent of the public regard the word as generic, then that is its majority usage and its 'principal significance.'" McCarthy § 12:6. Primary significance requires far more than ten percent. The court thus erred when it found Little Caesars' evidence inconclusive based on this inapplicable statement of the law. Viewed properly, survey data showing over 80 percent of relevant consumers perceive "pizza puff" as a generic term presents strong evidence of its genericness. See McCarthy § 12:6.

Id. at 658. Do you agree with the Seventh Circuit? Where do you think the line lies between generic terms and marks? Is there a numerical line? In the section of his treatise cited by the court, Professor McCarthy says that "majority usage" controls. Does that suggest a numerical threshold?

At page 108, add at the end of Note 9:

What weight would you give to the fact that alternative terms *were* available to for competitors to describe products? In *Illinois Tamale*, the district court found the mark PIZZA PUFFS not to be generic because other brands selling similar products were "able to compete effectively without using the plaintiff's 'PIZZA PUFFS' mark." The Seventh Circuit found this to be an error, noting that although one rationale for not protecting generic terms is that it "would stymie competition from sellers of similar products unable to sufficiently describe their product" that "is not the correct test for genericness. The plain language of the Lanham Act [and] Supreme Court precedent . . . explain that we assess the mark's primary significance to determine whether it has become generic . . . A term need not be the exclusive descriptor of a product to become generic. [A] trademark plaintiff 'may not prevent [the] defendant from using [a mark] simply because there are other titles defendant could use.'" . . . A generic term is not made less generic by the availability of other terms." Is the approach of the Seventh Circuit consistent with case law you have read to date? What *is* the relevance of alternative terms? What is the role of ability to compete?

At page 130, add a new note as Note 6:

6. *Distinctiveness as a question of fact*. Courts repeatedly state that the categorization of a claimed mark along the *Abercrombie* spectrum is a question of fact. Why might this be so? Does it create any problems or difficulties given the purposes of the distinctiveness assessment? Is THE CHEERLEADING WORLDS generic for competitive cheerleading competitions? How would you assess that question in light of the case law you have read? In *U.S. All Star Fed'n, Inc. v. Open Cheer & Dance Championship Series,* LLC, the Eleventh Circuit reversed summary judgment for defendant on that question because a reasonable jury could find that the mark was descriptive rather than generic "since [plaintiff's] evidence suggests that the relevant consuming public associates the mark[] with [plaintiff's] event." *See U.S. All Star Fed'n, Inc. v. Open Cheer & Dance Championship Series, LLC*, 179 F.4th 883, 904 (11th Cir. 2026). Do you see any problems with the reasoning or the conclusion? *See also Danone US, LLC v. Chobani, LLC*, 2026 WL 2149765 (S.D.N.Y. July 27, 2026) (denying Chobani's motion to dismiss Danone's claim that Chobani infringed Danone's rights in its "BRIGHT & MELLOW" mark for an unsweetened, light roast ready-to-drink coffee product, concluding that the mark was plausibly not generic and that Danone had plausibly alleged secondary meaning).

At page 201, add the following to Note 1:

If the description provided to the PTO differs from the drawing in the application, what should be the result? Consider this description and drawing:

> "The mark consists of a repeating pattern of alternating blue and white vertical stripes, which are of equal width and proportion. The repeating pattern appears on a portion of the surface of the goods, on a portion of the packaging for the goods, on a portion of the building facades in which the services are offered, and on displays, marketing and advertising materials associated with the services."

See In re Ralph's Famous Italian Ices Franchise Corp., 2026 U.S.P.Q.2d 553 (TTAB 2026).

At page 207 add the following as Problem 2-5A:

PROBLEM 2-5A: THE MONEY OF (PASTEL) COLOR

Van Leeuwen sells pints of ice cream in monochrome, pastel cardboard packages with minimalist designs and black cursive script, as shown below:

Van Leeuwen defines its trade dress, claimed for ice cream products, as comprised of "(a) cardboard monochromatic pints with matching monochromatic lids; (b) use of a primarily pastel color palette and/or pastel tinted hues; (c) black script typeface lettering with an exaggerated capital letter appearing across the front of the ice cream pint with additional descriptive writing in black lettering; and (d) an overall minimalistic design aesthetic."

Van Leeuwen sells a variety of flavors of ice cream, each in package using a different pastel color. Here is an example as its different flavors appear on the shelf:

Van Leeuwen used non-pastel and non-monochrome color schemes in its limited-edition flavors.

After Van Leeuwen redesigned its ice cream packaging to that shown above, its annual growth rate, which had averaged 35.8% between 2014 and 2016, more than doubled, averaging 91.6% between 2017 and 2018. Wholesale sales doubled (in absolute terms) between 2016 and 2017. Distribution expanded significantly. Design publications, design agencies, and consumer packaged goods professionals opined on the innovative new packaging.

Is Van Leeuwen's claimed trade dress valid? On what basis? What concerns might you have about conferring trademark rights as requested by Van Leeuwen? If the trade dress is valid, what is its scope?

At page 224, Note 1, add the following before the *Dinwoodie* cite:

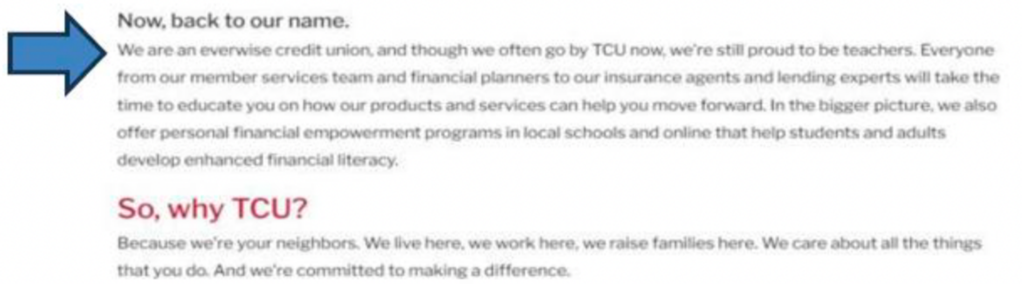
The Supreme Court explicitly recognized that its decision in *Dastar* would not preclude all false advertising claims under Section 43(a)(1)(B). When does *Dastar* bar false advertising claims? In *Vericool World, LLC v. Igloo Prods. Corp.*, 175 F.4th 1045 (9th Cir. 2026), a cooler manufacturer filed a false advertising claim alleging that a competitor falsely asserted its biodegradable cooler was the "world's first" even though the plaintiff manufacturer had marketed a biodegradable cooler earlier. Should *Dastar* preclude that action? *See also* Casebook, Chapter 10, Problem 10-2.

USE

4

On page 341, add the following before "Trademark Modernization Act of 2020"

On June 20, 2019, Everwise Credit Union applied to register the standard character mark EVERWISE CREDIT UNION for financial services. Everwise, formerly known as Teachers Credit Union, had adopted the new name as part of a rebranding effort. After receiving a notice of allowance, Everwise sought and received five extensions of time to file its Statement of Use. On the final deadline, Everwise filed its statement of use with an accompanying specimen of use. After a third party filed a petition for reexamination, arguing that EVERWISE CREDIT UNION was not in use in commerce for any of the listed services as of the statement of use deadline, Everwise submitted the following evidence of use of the mark, contending that the mark was used on its website and in a prominent tagline in association with the listed services.



The TTAB rejected this evidence, concluding that it was not evidence of bona fide use of EVERWISE CREDIT UNION in the ordinary course of trade, not merely to reserve rights in a mark. Do you agree with that assessment? Why is the use not sufficient? What would make it better?

SCOPE AND ENFORCEMENT OF TRADEMARK RIGHTS

III

GEOGRAPHIC LIMITS ON TRADEMARK RIGHTS

6

At page 584, add the following as new Note 2A:

2A. *Other applications of* Abitron. In *dmarcian, Inc. v. DMARC Advisor BV*, __ F.4th __ (4th Cir. July 10, 2026), the Fourth Circuit affirmed the application of the Lanham Act where a North Carolina software company (dInc) brought action against its Dutch partner (dBV) for, inter alia, trademark infringement. Prior to *Abitron*, the court had decided that federal question jurisdiction existed because regardless of where the defendant had acted, effects in the United States brought it within the reach of U.S. law. The defendant argued that *Abitron* should change the outcome. The Fourth Circuit rejected that argument and explained the effect of *Abitron.*

> *Abitron* shifts our focus from effects to conduct, but dBV's alleged [conduct] involved significant conduct in the United States too. The new rules in *Abitron* do not allow dBV to escape liability.
>
> In the modern world, intellectual property theft often cannot be confined to a single sovereign. An actor in the Netherlands may traffic in American trademarks and trade secrets as if there were no national borders or ocean between them. Whether the effects of its conduct are under scrutiny, as before *Abitron*, or the conduct itself is under scrutiny, as now, the fundamental question remains whether the actor has sufficient interrelationships with the United States to make it an appropriate subject of our law. . .
>
> A.
>
> The extraterritoriality rules in *Abitron* are new in several ways.
>
> The old rules came from *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952). Under *Steele,* the Lanham Act's prohibitions on trademark infringement and unfair competition usually applied if a defendant's conduct had "effects" in the United States, even if that conduct occurred abroad. . . .
>
> In the decades after *Steele,* the Supreme Court developed a more comprehensive two-step extraterritoriality inquiry. . . [In] *Abitron*, the Court "put aside" *Steele* and applied the two-step inquiry to the Lanham Act too.
>
> Pursuant to *Abitron*, two provisions of the Lanham Act—15 U.S.C. § 1114(1)(a) and § 1125(a)(1)—no longer apply extraterritorially. The conduct relevant to the focus of these

provisions, which must occur domestically before the Act may apply, is "infringing use in commerce" of a trademark. [cit]. Finally, *Steele*'s effects-focused test is no longer good law.

B.

Although *Abitron* is new, the tensions it reconciles are longstanding. . .

[I]f United States intellectual property law sought to rule the world, it would quickly bump up against other regimes.

At the same time, businesses today operate seamlessly across national borders. There are few more attractive markets than the United States, which promises a large consumer base and a judicial system that affords stability to commercial transactions. If foreign companies could operate in the United States and escape the reach of American intellectual property law by virtue of their national origin—or by virtue of their intermingled domestic and foreign operations—American companies would be left defenseless against even the most blatant acts of theft. This vulnerability would violate the fundamental promise of our laws "that the courthouse door is open to [American companies] when their intellectual property is misused." *dmarcian*, 60 F.4th at 147.

Abitron carefully balances these competing interests. While purely foreign conduct is now shielded from the Lanham Act, foreign actors who enter American markets and steal American intellectual property are not. "[D]ue regard" is given "both to international duty and convenience, and to the rights of [our] own citizens." Hilton v. Guyot, 159 U.S. 113, 164 (1895).

The balance struck by *Abitron* echoes that struck by the law of personal jurisdiction. When a defendant has "minimum contacts" with a forum, he may be haled into its courts. [cit]. A corporate defendant establishes such minimum contacts by "purposefully avail[ing] itself of the privilege of conducting" business there. [cit]. In a similar way, a business based abroad that purposefully avails itself of American markets opens itself up to liability under American intellectual property law.

C.

dInc's trademark infringement claim was brought under 15 U.S.C. § 1114(1)(a), one of the same provisions of the Lanham Act at issue in *Abitron*. *Abitron* made clear that this provision only reaches a defendant if he has committed an "infringing use in commerce, as the Act defines it," in the United States.

The Act defines an infringing use as a "use in commerce ... in connection with the sale, offering for sale, distribution, or advertising of any goods or services" in a manner "likely to cause confusion." 15 U.S.C. § 1114(1)(a). This definition contains three components. The first, "use in commerce," means that "the mark is being used in commerce in the constitutional

> sense." *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 323 (4th Cir. 2015).[2] The second and third, "in connection with ..." and "likely to cause confusion," are well established by our case law. [cit].
>
> This definition plainly encompasses not just "direct sales," but also "marketing, advertising, and distributing activities." *Hetronic Int'l, Inc. v. Hetronic Ger. GmbH*, 99 F.4th 1150, 1163, 1167 (10th Cir. 2024). When direct sales are at issue, they occur in the United States if the customers are in the United States. *Id.* at 1163. When marketing, advertising, and distribution are at issue, they occur in the United States if the intended recipients are in the United States.
>
> We readily conclude that dBV's conduct meets this standard. As we noted in our prior opinion, dBV maintained a website that used dInc's trademark as its domain name and was "virtually identical" to dInc's website, all in an effort to sell "essentially the same" services as dInc. The website was accessible in the United States and featured a button for customers in "the Americas," and dBV affirmatively sent a message to customers in the United States highlighting its software product. These facts are sufficient to demonstrate marketing or advertising in the United States. dBV also succeeded in luring at least one company based in the United States, Clarizen, to switch providers, which is sufficient to demonstrate a direct sale in the United States. Although our prior opinion applied *Steele*'s effects-focused test, the bottom line remains the same under *Abitron*'s conduct-focused test.
>
> If dBV had passively operated a website that was accessible in the United States, and there was no additional evidence that it had targeted or interacted with customers in the United States, the Lanham Act might well not reach it. Since most businesses around the world have websites that are accessible in the United States, a rule that hinged on web access alone would turn the presumption against extraterritoriality into "a craven watchdog." [cit]. But on the facts here, which go beyond mere web access, it is likely that dBV used dInc's trademark or its imitation "in commerce ... in connection with the sale, offering for sale, distribution, or advertising of ... services" in the United States. 15 U.S.C. § 1114(1)(a). We need not rehash the "likely to cause confusion" analysis, which remains the same in the wake of *Abitron*.

Do you agree with the Fourth Circuit's interpretation of *Abitron*?

[2] In the context of trademark registration under 15 U.S.C. § 1051, "use in commerce" carries the somewhat stricter definition found in 15 U.S.C. § 1127. *See, e.g., VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, 921 F.3d 1364, 1368–70 (Fed. Cir. 2019). Since *Abitron* refers to an "infringing use in commerce," the § 1114(1)(a) definition rather than the § 1127 definition applies here. 600 U.S. at 422–23; accord *Hetronic Int'l, Inc. v. Hetronic Ger. GmbH*, 99 F.4th 1150, 1162, 1167 (10th Cir. 2024).

CONFUSION-BASED TRADEMARK LIABILITY THEORIES

7

At page 620, add the following as new Note 7A:

7A. *Applying* Rescuecom: *discount codes*. Nike, Inc. owns a federal registration for the mark NIKE for various products, including sneakers. Bob's Cheap Shoes (BCS) is a low-end seller of footwear, including a particularly low-quality line that BCS calls "SPEEDBOOST". BCS advertises its SPEEDBOOST shoes on television with a 30 second advertisement that concludes in the last few seconds with the following spoken text: "And if you want 30% savings, use the code NIKE at checkout." Is this actionable use within Section 32 or Section 43(a)? Would your answer change if BCS added the sentence "Just do it!" to the end of its advertisement? (Nike, Inc. owns a federal registration in the mark JUST DO IT for use in connection with shoes.)

At page 657, add the following as new Note 9:

9. *Supreme Court intervention.* Is the determination of inherent strength an issue for the trier of fact? In summer 2026, the Supreme Court granted certiorari in *RiseandShine Corp. v. PepsiCo, Inc.* to address the issue. Might the Court speak to additional issues? Recall that circuits are split over whether the ultimate determination of likelihood of confusion should be treated as a question of fact or a mixed question of law and fact. And cases such as *Libman* show that differing conceptions about the appellate role in reviewing likelihood-of-confusion decisions may influence case outcomes. Would the Supreme Court's decision regarding who should decide the inherent strength factor affect the outcome in *RiseandShine*? Might the Court also be tempted to speak on the merits of the inherent strength analysis—for example, addressing Judge Leval's assertion that some suggestive marks might be inherently weaker than some descriptive marks?

At page 662, add the following after "implies?" in Note 1:

For an example involving minimal anecdotal evidence of actual confusion, see *Trojan Battery Co., L.L.C. v. Golf Carts of Cypress, L.L.C.*, 175 F.4th 582 (5th Cir. 2026) (ruling that the trial court's finding of actual confusion was clearly erroneous, but upholding the determination of likely confusion based on the other factors, in a case involving a claim that defendant's use of TROJAN EV for golf carts infringed plaintiff's mark TROJAN for golf cart batteries.

At page 666, after Note 5, add the following new Problem 7-4A:

PROBLEM 7-4A: THE MONEY OF (PASTEL) COLOR CONTINUED

You may find the following useful as an exercise to practice analyzing the individual confusion factors and weighing the factors to draw conclusions as to likely confusion. You may recall that we discussed the relevant facts and the distinctiveness issue in Problem 2-5A in this Update.

Van Leeuwen sells pints of ice cream in monochrome, pastel cardboard packages with minimalist designs and black cursive script, as shown below:

Van Leeuwen defines its trade dress as comprised of "(a) cardboard monochromatic pints with matching monochromatic lids; (b) use of a primarily pastel color palette and/or pastel tinted hues; (c) black script typeface lettering with an exaggerated capital letter appearing across the front of the ice cream pint with additional descriptive writing in black lettering; and (d) an overall minimalistic design aesthetic."

Rebel's packaging is shown below:

Rebel's founders claimed that they had never seen Van Leeuwen ice cream when creating Rebel's packaging, although a few months later, in discussions with a buyer for a grocery store chain, the buyer expressed the view that Rebel's packaging was similar to Van Leeuwen's. The Rebel founders have retained no documents reflecting their work product in creating the packaging.

Van Leeuwen advertised its trade dress on social media, in its shops, and in grocery stores, and received extensive unsolicited media coverage when it introduced the packaging at issue. After introducing that packaging, Van Leeuwen had significant sales success, with the company's growth rate increasing and gross wholesale sales doubling.

A Van Leeuwen executive testified that no industry professional has ever identified any competitor's ice cream packaging for ice cream that is similar to Van Leeuwen's, other than Rebel's.

Van Leeuwen's ice cream is considered a premium brand, while Rebel's is a keto-friendly "better-for-you" brand. A market study shows that "indulgent customers" alternate between premium and better-for-you ice cream brands and that around twenty percent of Rebel's customers have no dietary restrictions (keto-related or otherwise, evidently).

Van Leeuwen and Rebel products are distributed through the same grocery stores, and were displayed in one store as shown below:

Van Leeuwen has evidence of a single report from a confused consumer, and evidence that grocery store employees mistakenly applied Rebel price tags to Van Leeuwen cartons and intermingled the cartons on shelves. Van Leeuwen also retained an expert to conduct a "*Squirt*" survey, which showed a confusion rate of over 34%. In the survey, likely purchasers of premium ice cream were shown the Rebel packaging, followed by four samples of premium brand packages (one of which was Van Leeuwen), then were shown a "test cell" including only one of the premium brands. Participants were asked whether they perceived a connection between Rebel and the test cell, and if they did, were asked an open-ended question ("What makes you say that?").

The mark owner evidently did not offer an *Eveready* survey. Can you think of a reason why the mark owner would have been reluctant to do so?

Analyze likelihood of confusion, explaining your findings with regard to each factor, and your conclusion upon balancing the factors.

NON-CONFUSION-BASED TRADEMARK LIABILITY THEORIES

8

At pp. 803-04, add the following to the end of Note 6:

In *Scotts Co. LLC v. Procter & Gamble Co.*, 2026 WL 1601797 (6th Cir. June 4, 2026) (non-precedential), the trial court denied the trade dress owner's motion for a preliminary injunction on trade dress infringement and dilution claims. On appeal, the Sixth Circuit upheld the trial court's infringement determination. The trial court's determination had been based in part on the finding that parties' respective trade dresses were "highly dissimilar," and the Sixth Circuit found no clear error with respect to this finding. How should the finding affect the similarity-of-marks analysis for a dilution by blurring claim? According to the Sixth Circuit, the finding was sufficient to hold that the trade dress owner was unlikely to succeed on a blurring claim. The Sixth Circuit reasoned that "[s]ince dilution definitionally requires similarity and some similarity is 'the necessary predicate' for dilution analysis, a finding of a complete *lack* of similarity should strongly influence the dilution analysis." *Id.* at *6. Even if the similarity-of-marks standard is not more stringent for blurring than it is for likelihood-of-confusion, "it is still stringent enough to defeat the [blurring] claim," the Sixth Circuit concluded. The court distinguished *Levi Strauss* on the ground that, there, the trial court's use of a standard of "identical or nearly identical" had permeated the trial court's blurring analysis, leading to prejudicial error. Are you persuaded?

PERMISSIBLE USES OF ANOTHER'S TRADEMARK

9

At page 898, add the following to Note 5:

Compare Illinois Tamale Co., Inc. v. LC Trademarks, Inc., 164 F.4th 648 (7th. Cir. 2026) (finding that the district court erred in rejecting defendant Little Ceasars' fair use defense regarding its use of "pizza puff" to describe its Crazy Puffs products; the district court mistakenly required Little Caesars' product to *be* a pizza puff for the term to apply descriptively, when the term need only refer to a *characteristic* of the product).

10

FALSE ADVERTISING

At page 1009, add the following to Problem 10-2 after the *Angie's List* citation:

See also KetoNatural Pet Foods, Inc. v. Hill's Pet Nutrition, Inc., 2026 WL 2024498 (10th Cir. July 14, 2026) (applying First Amendment commercial speech caselaw to assess the commercial speech factor).

At page 1009, add the following to the end of Problem 10-2:

Relatedly, Section 43(a)(1)(B) specifies that the alleged false advertiser's statement in "commercial advertising or promotion" must misrepresent "the nature, characteristics, qualities, or geographic origin of his or another person's goods, services, or commercial activities." Is a cooler manufacturer's statement in advertising that its product was "the world's first eco sensitive cooler" an actionable statement under Section 43(a)(1)(B)? Should courts apply *Dastar* (see Chapter 2) in making this determination? *Vericool World, LLC v. Igloo Prods. Corp.*, 175 F.4th 1045 (9th Cir. 2026) (applying *Dastar*, over a dissent).