

# The Trademark Reporter®



**The Law Journal of the International Trademark Association**

Delay in Filing Preliminary Injunction Motions: 2023 Edition  
*Fara Sunderji and Sandra Edelman*

Commentary: Fifty Years of *McCarthy on Trademarks*  
*J. Thomas McCarthy*

Book Review: *Artificial Intelligence and Intellectual Property*.  
Jyh-An Lee, Reto M. Hilty, and Kung-Chung Liu, eds.  
*Elisabeth Kasznar Fekete*

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**DELAY IN FILING  
PRELIMINARY INJUNCTION MOTIONS:  
2023 EDITION**

*By Fara Sunderji\* and Sandra Edelman\*\**

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## I. INTRODUCTION

This is the sixth article in a series that began in 1990<sup>1</sup> that examines the impact of delay in filing a motion for a preliminary injunction in a trademark infringement suit in the various federal circuits. A chart arranged by the federal circuit is set out in an appendix, including all of the cases from the earlier articles, supplemented by cases decided since the last article was published in 2015, with appellate court decisions preceding district court cases (“Updated Appendix” or the “Appendix”). The decisions in the Appendix include only those in which the subject of delay was substantively raised by the parties and/or the court, with reported decisions through December 2022.<sup>2</sup>

Two noteworthy developments have occurred since 2015. First, the COVID-19 pandemic, which began spreading through the United States in various geographic regions in early 2020, resulted in office shutdowns, court closures, and other impediments to litigating trademark infringement cases promptly. Not surprisingly, the pandemic surfaced as an excuse for delay in seeking expedited relief in several cases. Second, after many years of uncertainty among circuit courts about whether a showing of likelihood of success on the merits of a trademark claim should result in a presumption of irreparable harm on a motion for a preliminary injunction, Congress finally enacted into law the Trademark Modernization Act of 2020 (the “TMA”).<sup>3</sup> The TMA now clarifies once and for all, and for all federal circuits, that irreparable harm should be presumed upon a finding of likelihood of success in proving infringement for purposes of imposing preliminary injunctive relief.<sup>4</sup> This legislative change resolved the circuit split that followed the Supreme Court’s opinion in *eBay, Inc. v.*

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<sup>1</sup> See Sandra Edelman & Fara Sunderji, *Delay in Filing Preliminary Injunction Motions: 2015 Edition*, 105 TMR 1012 (2015); Sandra Edelman, *Delay in Filing Preliminary Injunction Motions: 2009 Edition*, 99 TMR 1074 (2009); Sandra Edelman, *Delay in Filing Preliminary Injunction Motions: Update 2002*, 92 TMR 647 (2002); Sandra Edelman, *Delay in Filing Preliminary Injunction Motions: A Five Year Update*, 85 TMR 1 (1995); Robert L. Raskopf & Sandra Edelman, *Delay in Filing Preliminary Injunction Motions: How Long Is Too Long?*, 80 TMR 36 (1996).

<sup>2</sup> Compare *E.B. Horn Co. v. Horn’s Jeweler, Inc.*, Civ. No. 16-10618, 2016 U.S. Dist. LEXIS 194733 (D. Mass. June 7, 2016) (plaintiff “may be able to demonstrate a substantial likelihood of success on the merits” but its “nearly two year delay in bringing this action... rebuts any presumption of irreparable harm”), and *Schweitzz Dist., Inc. v. LA Tax Free Shop*, Civ. No. 16-6865, 2017 U.S. Dist. LEXIS 231808 (E.D.N.Y. Mar. 23, 2017) (court’s opinion denies motion for a temporary restraining order and preliminary injunction based on plaintiff’s sixteen-month delay in seeking relief without further analysis of likelihood of success on the merits), with *Solmetex, LLC v. Dentalez, Inc.*, 150 F. Supp. 3d 100 (D. Mass. 2015) (plaintiff’s delay asserted by defendant but court finds no irreparable harm “[c]onsidering the significant dissimilarity between the marks and the overall low likelihood of confusion”).

<sup>3</sup> Pub. L. 116-260, § 226, 134 Stat. 2208 (2020).

<sup>4</sup> 15 U.S.C. 1116(a).

*MercExchange*,<sup>5</sup> and has now (mostly) percolated through various district court decisions on motions for a preliminary injunction in trademark cases.

What hasn't changed during the many years in which this series has been published is the differing assessments among the circuit courts about what length of time constitutes unreasonable delay in seeking preliminary injunctive relief. Further, as in the past, the two predominant excuses offered by plaintiffs to explain why they waited to file a motion are (1) ongoing settlement discussions and (2) progressive encroachment on the plaintiff's rights. Over the years, the relevant case law consistently shows that the effort to resolve a dispute without judicial intervention will be accepted as a justification for delay so long as the plaintiff can establish that it diligently pursued settlement negotiations, there was a credible basis for believing that a settlement was possible, and the plaintiff moved promptly for an injunction once settlement talks broke down. A defendant's progressive encroachment can also justify a delay in seeking relief, but the plaintiff must generally demonstrate that a material change has occurred in the scope or nature of the defendant's infringement and the change could not reasonably have been anticipated at an earlier date.

## II. THE COVID-19 PANDEMIC

No retrospective of the past few years is complete without a discussion of the COVID-19 pandemic. On March 13, 2020, the United States government declared a nationwide state of emergency.<sup>6</sup> State governments, in turn, implemented shelter-in-place orders and various other restrictions impacting all facets of daily life in order to prevent the spread of COVID-19. Federal courts also issued orders restricting access to courthouses and authorizing video and audio conferencing for hearings and trials. In addition, individual judges cancelled preliminary injunction hearings and instead chose to rule on the papers.<sup>7</sup>

The cases from this time period show that some courts were sympathetic to delays resulting from the pandemic, citing its unprecedented impact, but plaintiffs still needed to be otherwise diligent to obtain a preliminary injunction. For example, in *Storage*

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<sup>5</sup> 547 U.S. 388 (2006).

<sup>6</sup> 85 Fed. Reg. 15337 (2020).

<sup>7</sup> See, e.g., *Great Star Indus. USA, LLC v. Apex Brands, Inc.*, No. 3:20-CV-00042-FDW-DSC, 2020 U.S. Dist. LEXIS 66123, at \*2-3 (W.D.N.C. Apr. 13, 2020) ("in light of the rapid spread of the COVID-19 novel coronavirus, the Court vacated the hearing . . . [and] determined it could rule on Apex's motion based on the briefs").

*Concepts, Inc. v. Incontro Holdings, LLC*,<sup>8</sup> the court excused a two-month delay between the filing of the complaint and a motion for preliminary injunction because that “delay corresponds with the height of the COVID-19 pandemic, which is one of the greatest crises our world has seen in recent history.”<sup>9</sup> In *Data Management Ass’n International v. Enterprise Warehousing Solutions*,<sup>10</sup> an even longer delay of ten months was excused due to the pandemic.<sup>11</sup> In that case, the court commended the plaintiff for filing its motion for a preliminary injunction at the same time as its complaint.<sup>12</sup>

A few cases also showed that defendants were sympathetic to COVID-19-related delays, which impacted both health and business. The parties in *Modern Point, LLC v. ACU Development, LLC*,<sup>13</sup> both acupuncture providers, agreed to a one-month stay for this reason.<sup>14</sup> Similarly, the parties in *Goat Fashion Ltd. v. 1661, Inc.*<sup>15</sup> “agreed that the delay attributable to COVID-19 should not be held against Goat Fashion.”<sup>16</sup> Goat Fashion, in fact, contacted the court on March 17, 2020, to inquire about the procedure for seeking a temporary restraining order (“TRO”), but “agreed to forgo the TRO in light of the public health crisis, and instead to move for a preliminary injunction, and 1661 agreed that Goat Fashion’s forbearance from seeking emergency relief given the pandemic would not be held against Goat Fashion.”<sup>17</sup>

On the other hand, certain other courts rejected arguments related to COVID-19 where the pandemic had little to no impact on the behavior in question or plaintiff’s delay began well before the pandemic. The parties in *Park Ridge Sports, Inc. v. Park Ridge*

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<sup>8</sup> No. 8:20-CV-447, 2021 U.S. Dist. LEXIS 86284, at \*9 (D. Neb. May 5, 2021). This portion of the delay was a little more than two months, the complaint having been filed on October 26, 2020, and the motion having been filed on January 11, 2021. *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> No. 20-C-04711, 2020 U.S. Dist. LEXIS 242699, at \*16 (N.D. Ill. Dec. 28, 2020).

<sup>11</sup> *Id.*

<sup>12</sup> *Id.*

<sup>13</sup> No. 19-CV-668 (NEB/HB), 2020 U.S. Dist. LEXIS 200735 (D. Minn. Oct. 28, 2020).

<sup>14</sup> *Id.* at \*32. Notably, the court explained that “due to COVID-19 health concerns, the states of Minnesota and Colorado placed restrictions that reduced acupuncture services in the spring of 2020.” *Id.*

<sup>15</sup> Civ. No. 19-11045, 2020 U.S. Dist. LEXIS 178636 (S.D.N.Y. Sept. 28, 2020).

<sup>16</sup> *Id.* at \*14-15 (“the Court treats the relevant period of delay as the four months between October 21, 2019 and February 27, 2020”).

<sup>17</sup> *Id.* at \*8-9.

*Travel Falcons*<sup>18</sup> operated competing youth football programs.<sup>19</sup> The plaintiff argued that it delayed filing its motion by three months after filing its complaint in part because “a worldwide pandemic [ ] called into question whether any sporting activities . . . would even happen in 2020.”<sup>20</sup> In rejecting this excuse, the court found that “the argument is in tension with plaintiff’s assertion that defendants’ uncontrolled use of plaintiff’s mark is causing reputational harm to plaintiff.”<sup>21</sup> A seventeen-month delay between filing a complaint in January 2020, which requested preliminary injunctive relief, and a motion for preliminary injunction in June 2021 was also held inexcusable despite the plaintiffs’ argument that the pandemic assuaged their concerns about the defendants’ behavior, namely opening a restaurant with an allegedly infringing name, during that same time period.<sup>22</sup> The plaintiff in *Diversified Solutions, Inc. v. Ohwook! Products*<sup>23</sup> also tried and failed to argue that its delay was excusable due to the pandemic. The plaintiff specifically argued that COVID-19 necessitated the cancellation of most festivals in 2021 and therefore it was not reasonable to expect that the defendant’s festival would be held that year.<sup>24</sup> Considering that the plaintiff’s delay from when it knew about the defendant’s use of the mark amounted to more than four years, the court easily rejected this argument.<sup>25</sup>

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<sup>18</sup> No. 20-C-2244, 2020 U.S. Dist. LEXIS 197095 (N.D. Ill. Oct. 23, 2020) (*preliminary injunction denied; Report and Recommendation adopted in large part*). The motion in this case was referred to Magistrate Judge Cole, who issued an entertaining, and at times harsh, Report and Recommendation written for all the sports fans out there. Park Ridge Sports v. Park Ridge Travel Falcons, No. 20-C-2244, 2020 U.S. Dist. LEXIS 200094 (N.D. Ill. Aug. 20, 2020). Judge Cole set the tone at the start of the opinion with a little bit of sarcasm: “As though a pandemic, looting, and civil unrest were not enough, battle has broken out among the youth football fathers of the Chicago suburb of Park Ridge.” *Id.* at 2. In discussing plaintiff’s delay and COVID-19, he noted “ordinarily the party seeking a preliminary injunction is in a hurry; they are claiming they will be irreparably harmed without one, after all. And, of course, the hulking defensive tackle in the room is the coronavirus. Is it necessary to have a hearing with multiple witnesses in the midst of a pandemic which, by last reckoning, appears to be getting worse in this area? All over the name and logo of a youth football program? A name and logo that is not original to plaintiff or defendants? The clear answer is no, so this little squabble among the football fathers will be taken care of in responsible fashion.” *Id.* at \*4-5.

<sup>19</sup> 2020 U.S. Dist. LEXIS 197095, at \*2-3.

<sup>20</sup> *Id.* at \*15.

<sup>21</sup> *Id.* at \*16.

<sup>22</sup> Tuna Family Mgmt., Inc. v. All Tr. Mgmt., Inc., No. 20-14017-CIV-SMM, 2021 U.S. Dist. LEXIS 197358, at \*26 (S.D. Fla. Oct. 13, 2021).

<sup>23</sup> Diversified Sols., Inc. v. Ohwook! Prods., No. 21-10039-CIV-MARTINEZ, 2021 U.S. Dist. LEXIS 78233 (S.D. Fla. Apr. 23, 2021).

<sup>24</sup> *Id.* at \*6.

<sup>25</sup> *Id.*



### III. THE TRADEMARK MODERNIZATION ACT OF 2020

The TMA<sup>26</sup> was signed into law on December 27, 2020. Among other important provisions, it includes an amendment to Section 34 of the Trademark Act of 1946<sup>27</sup> as follows:

A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection in the case of a motion for a permanent injunction or upon a finding of likelihood of success on the merits for a violation identified in this subsection in the case of a motion for a preliminary injunction or temporary restraining order.<sup>28</sup>

This amendment once and for all settles the circuit split that occurred following the Supreme Court's 2006 decision in *eBay Inc. v. MercExchange LLC*<sup>29</sup> about whether or not trademark plaintiffs enjoy a presumption of irreparable harm upon showing a likelihood of success on the merits. Under *eBay*, the presumption of irreparable harm became unavailable for patent owners,<sup>30</sup> but courts across the country struggled to decide whether *eBay* applied to trademark cases.<sup>31</sup> In the years following *eBay*, a circuit split developed among those circuits that applied *eBay* to trademark cases, thus removing any presumption of irreparable harm,<sup>32</sup> those that steadfastly preserved the presumption,<sup>33</sup> and those where there was disagreement among the district courts within the circuit without any guidance from the Court of Appeals.<sup>34</sup>

The TMA was surely designed to bring clarity and consistency across the circuits when deciding motions for preliminary injunction in trademark cases, but to date that has not quite been achieved. As an initial matter, there has been some disagreement as to when this provision of the TMA became effective. Courts in the Ninth Circuit mostly seem to agree that the rebuttable presumption of irreparable

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<sup>26</sup> Pub. L. 116-260, § 226, 134 Stat. 2208 (2020).

<sup>27</sup> 15 U.S.C. § 1116(a).

<sup>28</sup> *Id.*

<sup>29</sup> 547 U.S. 388 (2006).

<sup>30</sup> *Id.* at 390-91.

<sup>31</sup> See Edelman & Sunderji, *supra* note 1, 105 TMR 1016-9.

<sup>32</sup> *Ferring Pharm., Inc. v. Watson Pharm., Inc.*, 765 F.3d 205, 214 (3d Cir. 2014); *Herb Reed Enters., LLC v. Fla. Entm't Mgmt.*, 736 F.3d 1239, 1249 (9th Cir. 2013); *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1228 (11th Cir. 2008).

<sup>33</sup> See, e.g., *Rebel Dubutane LLC v. Forsythe Cosmetic Grp., Ltd.*, 799 F. Supp. 2d 558, 579 (M.D.N.C. 2011).

<sup>34</sup> See, e.g., *Salinger v. Colting*, 607 F.3d 68, 77 (2d Cir. 2010) ("district courts in our Circuit have split on eBay's reach."); *Park Ridge Sports v. Park Ridge Travel Falcons*, No. 20-C-2244, 2020 U.S. Dist. LEXIS 200094, at \*32 n.2 (N.D. Ill. Aug. 20, 2020) ("The Seventh Circuit has not addressed whether *eBay* applies to Lanham Act cases").

harm became the law of the land on December 27, 2020,<sup>35</sup> when the TMA was signed into law. One district court in the Third Circuit explicitly stated that the provision was “effective December 18, 2021.”<sup>36</sup> Consistent with this later date, another district court in the Third Circuit plainly did not apply the presumption to a motion filed in January 2021.<sup>37</sup> A number of other courts, including in the Eighth Circuit,<sup>38</sup> Ninth Circuit,<sup>39</sup> Tenth Circuit,<sup>40</sup> and Eleventh Circuit,<sup>41</sup> failed to apply the presumption to motions for a preliminary injunction filed after 2020. In cases where delay was a factor, however, the outcomes may not have been much different, but the analysis itself would have likely been altered.

While not a case discussing delay, the Third Circuit’s decision in *Nichino America Inc. v. Valent U.S.A. LLC*<sup>42</sup> is instructive of how the TMA’s presumption of irreparable harm should be applied:

**Step 1.** The TMA’s rebuttable presumption requires courts considering a trademark injunction to assess the plaintiff’s evidence only as it relates to a likelihood of success on the merits . . . but only to determine whether the infringement claim is likely to succeed. Anything more, including commenting on whether the proffered evidence of consumer confusion could show irreparable harm, veers impermissibly into the burden of persuasion controlled by Rule 301 [of the Federal Rules of Evidence]. . . .

**Step 2.** If the plaintiff’s evidence does establish likely trademark infringement, the TMA is triggered, and the

<sup>35</sup> See, e.g., *Pharms. v. PhD Mktg.*, No. CV 20-6745-RSWL-JC x, 2021 U.S. Dist. LEXIS 254038, at \*12-13 (C.D. Cal. Mar. 12, 2021); *Suzie’s Brewery Co. v. Anheuser-Busch Cos.*, 519 F. Supp. 3d 839, 854 n.12 (D. Or. 2021); *Home Carpet Inv. v. Lopez*, No. 20CV1583-GPC(DEB), 2021 U.S. Dist. LEXIS 232292, at \*18 n.4 (S.D. Cal. Mar. 16, 2021).

<sup>36</sup> *Spark DSO, LLC v. Ormco Corp.*, No. 21-2841, 2022 U.S. Dist. LEXIS 36382, at \*5-6 (E.D. Pa. Mar. 2, 2022). The court likely believed this to be the effective date because certain other provisions in the TMA regarding United States Patent and Trademark Office procedures were explicitly made effective December 18, 2021. See 86 Fed. Reg. 64300.

<sup>37</sup> *Logic Tech. Dev. LLC v. Levy*, Civil Action No. 17-04630 (MAS) (TJB), 2021 U.S. Dist. LEXIS 165203, at \*5 (D.N.J. Aug. 31, 2021) (“Plaintiff has not met its burden of establishing this extraordinary remedy because it cannot show that it has been irreparably harmed.”).

<sup>38</sup> *Stone Strong, LLC v. Stone Strong of Tex., LLC*, No. 4:21-CV-3160, 2021 U.S. Dist. LEXIS 195329, at \*15 (D. Neb. Oct. 8, 2021) (“But there is reason to question that authority” supporting that “irreparable harm can be presumed if the plaintiff has shown a likelihood of consumer confusion.”).

<sup>39</sup> See, e.g., *Desirous Parties Unlimited Inc. v. Right Connection Inc.*, No. 2:21-CV-01838-GMN-BNW, 2022 U.S. Dist. LEXIS 162000, at \*20-22 (D. Nev. Sept. 7, 2022).

<sup>40</sup> *Route App, Inc. v. Heuberger*, No. 2:22-CV-291-TS-JCB, 2022 U.S. Dist. LEXIS 133506 (D. Utah July 26, 2022).

<sup>41</sup> See, e.g., *Romanick v. Mitchell*, No. 2:21-CV-0065-SCJ, 2021 U.S. Dist. LEXIS 215758 (N.D. Ga. July 13, 2021).

<sup>42</sup> *Nichino Am., Inc. v. Valent U.S.A. LLC*, 44 F.4th 180 (3d Cir. 2022).

burden of production shifts to the defendant to introduce evidence sufficient for a reasonable factfinder to conclude that the consumer confusion is unlikely to cause irreparable harm. But note again the sequence. So far, the court has not assessed any of the evidence for likely irreparable harm. Rather, the TMA's presumption means the court assumes irreparable harm, even if the plaintiff has proffered nothing in support. The focus trains on the defendant's evidence, and whether it is sufficient to rebut the TMA's presumption. A meaningful consideration of the facts, not a box-checking review of the [likelihood of confusion] factors, is key, aimed at determining whether the defendant's offering allows a reasonable conclusion that the consumer confusion shown by the plaintiff will not cause irreparable harm.

**Step 3.** If a defendant successfully rebuts the TMA's presumption by making this slight evidentiary showing, the presumption has no further effect. It has done its work and simply disappears like a bursting bubble. So the burden of production returns to the plaintiff to point to evidence that irreparable harm is likely absent an injunction. . . .<sup>43</sup>

Motions for preliminary injunction decided post-2020 in which the rebuttable presumption of irreparable harm was applied reaffirm that delay continues to be a key factor in the analysis. As the court in *Nitto Tire U.S.A. v. Gigatires*<sup>44</sup> confirmed, "a defendant may rebut a presumption of irreparable harm by demonstrating that the plaintiff unduly delayed in bringing its motion for preliminary injunction."<sup>45</sup> In that case, the plaintiff's twenty-month delay proved fatal to its motion.<sup>46</sup> Similarly, in *Harley's Hope Foundation v. Harley's Dream*,<sup>47</sup> the court found that the plaintiff's delay of nearly three years rebutted any presumption it would have gained by demonstrating a likelihood of success on the merits, and without any affirmative evidence supporting irreparable harm, the court denied the motion for a preliminary injunction.<sup>48</sup> The cases also show that numerous defendants were unsuccessful at rebutting the presumption of harm based on the plaintiff's delay when such

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<sup>43</sup> *Id.* at 185-6.

<sup>44</sup> No. 8:21-CV-00797-JVS-JDEx, 2021 U.S. Dist. LEXIS 202589 (C.D. Cal. Aug. 12, 2021).

<sup>45</sup> *Id.* at \*6.

<sup>46</sup> *Id.* at \*7.

<sup>47</sup> Civil Action No. 22-CV-0136-WJM-STV, 2022 U.S. Dist. LEXIS 71750 (D. Colo. Apr. 19, 2022).

<sup>48</sup> *Id.* at \*7-8; *see also* Spark DSO, LLC v. Ormco Corp., No. 21-2841, 2022 U.S. Dist. LEXIS 36382, at \*9-11 (E.D. Pa. Mar. 2, 2022) (finding that defendant "wholly rebutted the presumption of irreparable harm" by pointing to plaintiff's delay and other evidence while plaintiff did not put forth any support for irreparable harm).

delay was found to be excusable based on rationales such as settlement<sup>49</sup> and progressive encroachment.<sup>50</sup>

#### IV. MEASURING THE PERIOD OF DELAY

Calculating how long a plaintiff waited before filing a motion for a preliminary injunction should be a straightforward exercise but often is not. Sometimes the published opinion on a motion makes it difficult to measure the time period because the court's factual recitation is incomplete or imprecise about when the plaintiff learned of a defendant's allegedly infringing use or exactly when the motion was filed. Although docket sheets can provide clarity on the latter.

Beyond ambiguity in a published opinion, there can be differences in how the court or the parties pick the starting points and endpoints for assessing the length of the period of delay. The proper measurement is from the date the plaintiff actually knew or should have known of the defendant's infringing conduct to the date the motion was filed—a standard that includes both actual and constructive knowledge.<sup>51</sup>

There have been instances where a court will identify the dates only between the filing of the complaint and a subsequent motion for a preliminary injunction,<sup>52</sup> ignoring the (sometimes quite long) pre-complaint time period when the plaintiff actually knew or should have known of the defendant's infringement. Perhaps in

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<sup>49</sup> *Hydrojug, Inc. v. Five Below, Inc.*, No. 1:22-CV-00728-PAB, 2022 U.S. Dist. LEXIS 159588 (N.D. Ohio Sept. 2, 2022), *UV RML NL Assets v. Coulter Ventures*, No. 2:21-CV-04913, 2021 U.S. Dist. LEXIS 233260 (C.D. Cal. Oct. 22, 2021).

<sup>50</sup> *Vans, Inc. v. Walmart, Inc.*, No. 8:21-CV-01876-DOC-KES, 2022 U.S. Dist. LEXIS 95244 (C.D. Cal. Mar. 31, 2022); *Zest Anchors v. Geryon Ventures*, No. 22-CV-230 TWR (NLS), 2022 U.S. Dist. LEXIS 127319 (S.D. Cal. July 18, 2022); *Kohler Co. v. Whistling Oak Apts. LLC*, No. 20-CV-1563, 2021 U.S. Dist. LEXIS 111642 (E.D. Wis. June 14, 2021).

<sup>51</sup> *See Raskopf & Edelman, supra* note 1, 80 TMR at 45-47; *Edelman, supra* note 1, 99 TMR at 1082-83; *see also Logic Tech, Dev. LLC v. Levy*, Civ. No. 17-04630, 2021 U.S. Dist. LEXIS 165203 at \*6 (D.N.J. Aug. 31, 2021) (“The period of delay begins to run ‘once the plaintiff has actual or constructive knowledge of the [d]efendant’s use of infringing marks.”); *Alcon Vision, LLC v. Lens.com*, Civ. No. 18-407, 2020 U.S. Dist. LEXIS 186403 at \*34 (E.D.N.Y. Feb. 28, 2020) (“[W]hether Alcon unreasonably delayed in asserting its rights in this case requires an inquiry into whether Alcon knew or should have known of Lens.com’s infringement”); *Great Star Indus. USA, LLC v. Apex Brands, Inc.*, No. 3:20-CV-00042-FDW-DSC, U.S. Dist. LEXIS 66123 at \*19-20 (W.D.N.C. Apr. 13, 2020) (preliminary injunction denied where there was a delay of four years from when plaintiff should have known of defendant’s infringement vs. three months of claimed actual knowledge); *cf. Two Hands IP LLC v. Two Hands Am., Inc.*, 563 F. Supp. 3d 290, 301 (S.D.N.Y. 2021) (“the length of delay is measured from the time the plaintiff originally learned of the alleged violation or is put on notice thereof, not when the irreparable injury allegedly begins”) (citation omitted).

<sup>52</sup> *Park Ridge Sports, Inc. v. Park Ridge Travel Falcons*, No. 20-C-2244, 2020 U.S. Dist. LEXIS 197095 (N.D. Ill. Oct. 23, 2020); *Morisky v. MMAS Rsch. LLC*, No. 2:21-CV-1301-RSM-DWC, 2022 U.S. Dist. LEXIS 75136 (W.D. Wash. Apr. 15, 2022).

light of precedents in this category, the plaintiff in *Menudo International v. In Miami Production, LLC*<sup>53</sup> argued that it did not unreasonably delay in moving for a preliminary injunction motion forty-five days after filing the complaint. The defendant correctly contended that the plaintiff, in fact, waited almost two years from when it first learned of the infringing conduct. The court held that the plaintiff's argument of counting only the post-complaint time period was "misplaced":<sup>54</sup>

[The plaintiff] fails to account for any amount of time that occurred between the time of learning that Defendants were allegedly committing trademark infringement to the filing of the complaint. Stated differently, Plaintiff's position would allow a party—despite being aware of an unabashed infringer—to wait a lengthy amount of time before filing a complaint since the only time period that mattered was the time between the complaint and the motion for a preliminary injunction. This cannot be the law because "preliminary injunctions are generally granted under the theory that there is an urgent need for speedy action to protect the plaintiff's rights.... As such, two time periods are relevant in determining whether a plaintiff acts promptly in seeking judicial relief: (1) a plaintiff cannot delay in filing a complaint after discovering a potential infringer; and (2) a plaintiff must move quickly in filing a motion for a preliminary injunction once a complaint has been filed."<sup>55</sup>

Two cases in the Fifth Circuit also involved an issue of determining the proper period for measuring the alleged delay. In *Scrum All, Inc. v. Scrum, Inc.*,<sup>56</sup> the plaintiff had filed an initial motion for preliminary injunction and then a first amended motion two months later. The court rejected the defendant's argument that the total period of delay encompassed the time period through the first amended motion, holding that "the date [the defendant] should have counted back from is the date Plaintiff filed its original application for a preliminary injunction....."<sup>57</sup>

An unusual fact pattern was present in *Fletcher's Original State Fair Corny Dogs, LLC v. Fletcher-Warner Holdings LLC*,<sup>58</sup> where

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<sup>53</sup> No. 17-21559-Civ., 2017 U.S. Dist. LEXIS 179777 (S.D. Fla. Oct. 31, 2017).

<sup>54</sup> *Id.* at \* 13.

<sup>55</sup> *Id.* (citing *Citibank, N.A. v. Citytrust*, 756 F.2d 273, 276 (2d Cir. 1985).

<sup>56</sup> Civil Action No. 4:20-CV-00227, 2020 U.S. Dist. LEXIS 125002 n.12 (E.D. Tex. July 16, 2020).

<sup>57</sup> The court determined that, properly calculated, plaintiff's delay in filing the motion was seven months (not nine months as asserted by defendant) and that plaintiff had sufficiently demonstrated irreparable harm, as the delay was not unreasonable. *Id.* at \*\*44-46.

<sup>58</sup> 434 F. Supp. 3d 473 (Jan. 17, E.D. Tex. 2020).

the plaintiff had been a long-standing owner of the FLETCHER'S mark for corn dogs, but through a series of financial difficulties, bankruptcy, and acquisition of the plaintiff's rights by third parties, the plaintiff was no longer the legal owner of the FLETCHER'S mark at the time the defendant's infringement began.<sup>59</sup> The plaintiff reacquired rights in the mark and then filed its motion for a preliminary injunction just about four months later. The defendant tried to argue that the total delay was seven months, but the court counted only the time period in which the plaintiff owned the mark at issue.<sup>60</sup>

## V. HOW LONG IS TOO LONG?

Once the time period of alleged delay is correctly measured, the next question is how long is too long for the delay to be deemed unreasonable and thus undermine other evidence or a presumption of irreparable harm. As with many legal questions, the answer is "it depends"—on the relevant facts, the excuse given for delay, and the federal circuit in which the motion is filed.

Judge Jesse Furman of the Southern District New York federal court perhaps summed it up best in *Monowise Ltd. v. Ozy Media, Inc.*,<sup>61</sup> stating: "There is no bright-line rule for how much delay is too much."<sup>62</sup> Judge Furman then stated a general rule in the Second Circuit: "[C]ourts in this Circuit 'typically decline to grant preliminary injunctions in the face of unexplained delays of more than two months.'"<sup>63</sup> This general observation confirms what has been discussed in previous iterations of this article: in the home of the "New York minute"<sup>64</sup> preliminary injunction motions should be filed quite promptly—within the two-month benchmark time period referred to by Judge Furman—or risk a finding of lack of irreparable injury.

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<sup>59</sup> *Id.* at \*\*4-6.

<sup>60</sup> *Id.* at \*\*41-42 & n.16 (the court found that even if the plaintiff's total delay was counted as seven months, it would still not constitute unreasonable delay).

<sup>61</sup> Civ. No. 17-8028, 2018 U.S. Dist. LEXIS 75312 (S.D.N.Y. May 3, 2018).

<sup>62</sup> *Id.* at \*4.

<sup>63</sup> Ultimately, Judge Furman held that the plaintiff's almost nine-month delay in seeking relief defeated any possible showing of irreparable harm. Taking a nuanced approach, the court found that even if it attributed some of the nine-month time period to settlement efforts, there was more than five months of "unjustified delay." *Id.* at \*7. Accordingly, the court concluded that "Whatever the line distinguishing between acceptable and unacceptable delay may be, that delay plainly falls on the unacceptable side." *Id.* at \*5.

<sup>64</sup> See William Safire, *On Language; In A New York Minute*, N.Y. Times, Oct. 19, 1986, offering various definitions of a "New York minute" to convey something happening "instantly" or in one example "the time it takes for the light in front of you to turn green and the guy behind you to honk his horn."

A very recent case in the Eastern District of New York, decided in December 2022, *Christmas House United States Inc. v. Christmasland Experience, LLC*,<sup>65</sup> denied a motion for a preliminary injunction where the delay was only “a little over a month.”<sup>66</sup> However, because the dispute involved competing but very time-sensitive “Christmas experience” services and the plaintiff waited from early November to December 17 to request expedited relief, the court held that the delay “proved critical” and thus declined to “shut down defendants’ operation days before Christmas.”<sup>67</sup>

However, when it comes to how long is too long in the Second Circuit, attention should be paid to the word “typically” in the general rule set forth by Judge Furman in *Monowise*. Indeed, in the new cases covered by this article, there were instances in the Southern District in which preliminary injunction motions were granted notwithstanding alleged delays of four months in *Goat Fashion v. 1661, Inc.*,<sup>68</sup> five months in *Hope Organics LLC v. Preggo Leggings LLC*,<sup>69</sup> and more than a year in *Sulzer Mixpac AG v. DXM Co.*<sup>70</sup> An examination of these cases show factual circumstances that were by no means “typical.”

As noted above, the outbreak of the pandemic in early 2020, described by the court as a “public health crisis,” play a major factor in *Goat Fashion*,<sup>71</sup> along with an argument of progressive encroachment and good faith efforts to settle during the period of delay.<sup>72</sup> All of this added up to a finding that the plaintiff had not unreasonably delayed in waiting four months to seek expedited relief.<sup>73</sup> The five-month delay in *Hope Organics* was also found reasonable.<sup>74</sup> Three of the months were occupied by settlement efforts, but more significantly, the defendant agreed to a “Standstill Agreement” in which it agreed “not to argue that Hope Organics delayed” in seeking preliminary injunctive relief during the

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<sup>65</sup> No. 22 CV 7691 (GRB), 2022 U.S. Dist. Lexis 231799 (E.D.N.Y. Dec. 22, 2022).

<sup>66</sup> *Id.* at \*\*3-4.

<sup>67</sup> *Id.* Notably, the court in *Christmas House*, in a “nod to the season” began its opinion with a long poem in the style of Clement Clark Moore’s “’Twas the Night Before Christmas” including the stanza: “To seek an injunction/ One must fast beg redress/ Showing irreparable harm/ And Likely success.” *Id.* at \*2 and fn.1, also stating that the poem was not “intended to undermine the seriousness of the parties’ rights and claims” but rather “to “lighten the mood, and perhaps encourage voluntary resolution of the dispute by the parties.”

<sup>68</sup> Civ. No. 19-11045, 2020 WL 5758917 (S.D.N.Y. Sept. 28, 2020).

<sup>69</sup> No. 1:21-CV-02416 (S.D.N.Y. Dec. 15, 2021).

<sup>70</sup> No. 21-CV-2416 (TMR), 2020 U.S. Dist. LEXIS 116915 (S.D.N.Y. July 2, 2020).

<sup>71</sup> 2020 U.S. Dist. LEXIS 178636, at \*8.

<sup>72</sup> *Id.* at \*14-16.

<sup>73</sup> *Id.* at \*16.

<sup>74</sup> 2021 U.S. Dist. LEXIS 239779, at \*29 n.14.

pendency of the Agreement.<sup>75</sup> As it would be quite unfair to allow a party to succeed on an argument of unreasonable delay once it agrees not to raise the issue of delay while settlement discussions are ongoing, the court concluded that “Defendant’s argument is without merit.”<sup>76</sup> Finally, in *Sulzer Mixpac*, there was a delay of almost two years, but the plaintiff moved promptly for preliminary injunctive relief following the escalation of infringing activities,<sup>77</sup> and, significantly, there was an alleged breach of a prior settlement agreement in which the defendant “explicitly” agreed that a breach “would cause irreparable harm” and that Mixpac shall be entitled to injunctive relief.<sup>78</sup>

In another atypical case in the Second Circuit, *Abbott Laboratories v. Adelpia Supply USA*,<sup>79</sup> the Eastern District of New York court held that a different standard for evaluating delay and irreparable harm should be applied in the context of claims involving gray market goods. The Abbott plaintiffs brought suit against multiple pharmacies, distributors, and individuals for selling gray market diabetes test strips; one of the defendants claimed sales of such products for over ten years and another defendant’s infringement had been discovered about eighteen months prior to the motion.<sup>80</sup> The court rejected the argument of delay raised by these defendants:

Although Abbott might be expected to immediately sue to enforce its rights upon discovering a counterfeit product, the reasonableness of delay in the context of a gray-goods case is different. Gray-goods distribution often comes from business partners, not business competitors. Much of it occurs on a small or even individual scale. And absent material differences or quality-control interference, reselling even international genuine goods is not infringement at all. In light of these considerations, the Court finds it reasonable that Abbott would seek to curtail gray marketing as a whole by pursuing less expensive and intrusive—but potentially effective—options before turning to litigation.<sup>81</sup>

In contrast to these cases involving special circumstances, the accompanying Appendix shows cases in the Second Circuit where a

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<sup>75</sup> *Id.*

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

<sup>77</sup> 2020 U.S. Dist. LEXIS 116915 at \*11.

<sup>78</sup> *Id.* at \*12.

<sup>79</sup> Civ. No. 15-5826, 2015 U.S. Dist. LEXIS 189555 (E.D.N.Y. Nov. 6, 2015).

<sup>80</sup> *Id.* at \*61-62.

<sup>81</sup> *Id.* at \*62-63.



delay of three-to-four months<sup>82</sup> and five months<sup>83</sup> was found to be unreasonable, undercutting the showing of irreparable harm necessary to obtain preliminary injunctive relief.<sup>84</sup>

Outside of the Second Circuit, it is unusual to encounter a denial of a motion for preliminary injunction on the ground of lack of irreparable harm where the alleged delay was a relatively brief period of less than six months. For example, in the Ninth Circuit, motions for preliminary relief were granted when the period of delay was four months<sup>85</sup> and five months.<sup>86</sup>

The six-to-twelve-month period in cases outside of the Second Circuit can be harder to predict. There were a number of cases where the motion was granted notwithstanding delays ranging from six months to a year in the Third Circuit,<sup>87</sup> ten months in the Fourth Circuit,<sup>88</sup> seven months in the Fifth Circuit,<sup>89</sup> eleven months in the Sixth Circuit,<sup>90</sup> ten months in the Seventh Circuit,<sup>91</sup> eight months in the Eighth Circuit,<sup>92</sup> and thirteen months in the Ninth Circuit.<sup>93</sup> But there were also denials of preliminary injunction motions in the six- to twelve-month period as well, such as an up-to-seven-month delay in the Third Circuit,<sup>94</sup> an eight-month delay in the First

<sup>82</sup> Citigroup Inc. v. AT&T Servs., No. 16-CV-4333 (KBF), 2016 U.S. Dist. LEXIS 106435 (S.D.N.Y. Aug. 11, 2016).

<sup>83</sup> 27-24 Tavern Corp. v. Dutch Kills Centraal, Civ. No. 14-1625, 2015 U.S. Dist. LEXIS 133648 (E.D.N.Y. Sept. 14, 2015).

<sup>84</sup> *Id.* at \*53-55.

<sup>85</sup> 2die4kourt v. Hillair Capital Mgmt., LLC, No. SACV 16-0134 JUS (DFMx), 2016 U.S. Dist. LEXIS 118211 at \*22 (C.D. Cal. Aug. 23, 2016).

<sup>86</sup> AECOM Energy & Constr., Inc. v. Ripley, No. 2:17-CV-05398-RSWL-SS, 2017 U.S. Dist. LEXIS 160180 at \*18-19 (C.D. Cal. Sept. 27, 2017).

<sup>87</sup> Shakespeare Globe Trust v. Kultur Int'l Films, Inc., Civ. No. 18-16297, 2019 U.S. Dist. LEXIS 67503 (D.N.J. Apr. 22, 2019).

<sup>88</sup> Mayson-Dixon Strategic Consulting, LLC v. Mason-Dixon Polling & Strategic Consulting, Inc., 324 F. Supp. 3d 569 (D. Md. 2018).

<sup>89</sup> Scrum All, Inc. v. Scrum, Inc., No. 4:20-CV-00227, 2020 U.S. Dist. LEXIS 125002, at \*44-46 (E.D. Tex. July 16, 2020).

<sup>90</sup> JTH Tax, Inc. v. Freedom Tax, Inc., Civil Action No. 3:19-CV-00085-RGJ, 2019 U.S. Dist. LEXIS 78532, at \*36 (W.D. Ky. May 9, 2019).

<sup>91</sup> Data Mgmt. Ass'n Int'l v. Enter. Warehousing Sols., No. 20-C-04711, 2020 U.S. Dist. LEXIS 242699 at \*15-16 (N.D. Ill. Dec. 28, 2020).

<sup>92</sup> Storage Concepts, Inc. v. Incontro Holdings, LLC, No. 8:20-CV-447, 2021 U.S. Dist. LEXIS 86284 at \*9-10 (D. Neb. May 5, 2021).

<sup>93</sup> Desirous Parties Unlimited Inc. v. Right Connection Inc., No. 2:21-CV-01838-GMN-BNW, 2022 U.S. Dist. LEXIS 162000, at \*20 (D. Nev. Sept. 7, 2022).

<sup>94</sup> Smart Vent Prods. v. Crawl Space Door Sys., 2016 U.S. Dist. LEXIS 108052 at \*34-36 (D.N.J. Aug. 15, 2016) (plaintiff "sought the extraordinary relief it now seeks at best two months and at worst seven months after the events that form the linchpin of its request of an injunction. A delay of that magnitude ... 'knocks the bottom out of any claim of immediate and irreparable harm.'")

Circuit,<sup>95</sup> and a nine-month delay in the Ninth Circuit.<sup>96</sup> On the far side of the time spectrum, there are many cases denying preliminary injunctive relief when the delay in filing the motion is alleged to be years in length.<sup>97</sup>

## VI. SETTLEMENT EFFORTS AS JUSTIFICATION FOR DELAY

A good faith attempt to resolve a dispute without resorting to litigation is a frequently offered reason to explain a gap in time between when a plaintiff first learned of the defendant's infringement and the filing of the motion for preliminary relief. Understandably, many courts want to encourage dispute resolution efforts that will conserve judicial resources.<sup>98</sup> But in order for this excuse to be accepted as a reasonable explanation for delay, many courts demand that settlement efforts be pursued diligently, persistently, and credibly and that a plaintiff seek expedited relief promptly after settlement talks break down. This standard was met in *Shakespeare Globe Trust v. Kultur International Films, Inc.*,<sup>99</sup> in which the court in the District Court of New Jersey held that a six-to-twelve-month delay was excusable because "Plaintiff spent this long time period in near-constant correspondence with Defendants, attempting to arrange a resolution without resorting to a court order."<sup>100</sup> Similarly, in *2die4kourt v. Hillair Capital Management*,<sup>101</sup> the court in the Central District of California found that the "bulk" of the five-month period of delay was spent "diligently attempting to informally settle their claims for breach, which would obviate the need for an injunction."<sup>102</sup> There are also cases (not surprisingly, outside of the Second Circuit) in which long periods of time discussing settlement have been found to be excusable, including

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<sup>95</sup> *Solmetex, LLC v. Dentalez, Inc.*, 150 F. Supp. 3d 100, 108, 116-17 (D. Mass. 2015).

<sup>96</sup> *Real USFL, LLC v. Fox Sports, Inc.*, No. CV-22-1350 JFW(MARx), 2022 U.S. Dist. LEXIS 72857, at \*31-32 (C.D. Cal. Apr. 14, 2022).

<sup>97</sup> See Appendix.

<sup>98</sup> See, e.g., *Fleet Feet, Inc. v. Nike, Inc.*, 419 F. Supp. 3d 919, 947 (M.D.N.C. 2019) (finding that part of plaintiff's alleged delay was occasioned by efforts to settle the matter and holding that "the goal of voluntary resolution of disputes" balances against a finding of undue delay), *appeal dismissed as moot*, 986 F.3d 458 (4th Cir. 2021); *Tempo Comm'ns v. King Tech. of Mo.*, No. 21-CV-80-AJB-WVG, 2021 U.S. Dist. LEXIS 206387, at \*6-7 (S.D. Cal. July 19, 2021) (motion denied, but delay excused because "The Ninth Circuit has held that delays in bringing preliminary injunction motions may be found excusable if it was caused by the plaintiff's efforts to investigate the case or to engage in settlement negotiations or other attempts to handle the dispute without the need for litigation.").

<sup>99</sup> *Shakespeare Globe Tr. v. Kultur Int'l Films, Inc.*, No. 18-16297, 2019 U.S. Dist. LEXIS 67503 (D.N.J. Apr. 22, 2019).

<sup>100</sup> *Id.* at \*11.

<sup>101</sup> No. SACV 16-01304, 2016 U.S. Dist. LEXIS 118211 (C.D. Cal. Aug. 23, 2016).

<sup>102</sup> *Id.* at \*22.

three cases in the Central District of California where settlement efforts occupied a year,<sup>103</sup> fifteen months,<sup>104</sup> and two years.<sup>105</sup>

In many cases, however, particularly in the Second Circuit, desultory efforts to resolve a dispute or a failure to file the motion for preliminary relief promptly when it has become apparent that the defendant is not going to accommodate the plaintiff's demands can often result in a finding of unreasonable delay. A four-month delay was found unreasonable in *Citigroup Inc. v. AT&T Services*,<sup>106</sup> even though the court characterized the plaintiff as having engaged in "good faith" settlement efforts<sup>107</sup> because AT&T never gave Citigroup "any comfort that it would not use the name" in dispute.<sup>108</sup> A lack of detailed evidence about what settlement efforts were made (and a very long delay) undercut the showing of irreparable harm in *Hello I Am Elliot, Inc. v. Sine*.<sup>109</sup> As the court there commented, "Plaintiffs do passingly assert that they had sought to resolve the issues through private negotiation, but they do not allege facts to show that, throughout the two and one-half-year period of delay, they were diligently pursuing settlement...They do not quantify how long they were actively pursuing settlement.... And even if the parties had pursued settlement negotiations for some brief—or even extended—period of time, the years-long delay here is still so significant as to preclude relief."<sup>110</sup> In *FC Online Marketing, Inc. v.*

<sup>103</sup> *Kolay v. Milliken*, No. 2:19-CV-00640-SVW (KSx), 2018 U.S. Dist. LEXIS 238107 at \*\*10-11 (C.D. Cal. Mar. 22, 2018).

<sup>104</sup> *Suja Life, LLC v. Pines Int'l, Inc.*, 16 CV 985-6PC (WV6), 2016 U.S. Dist. LEXIS 147014 at \*\*44-45 (S.D. Cal. Oct. 24, 2016).

<sup>105</sup> *UV RML NL Assets v. Coulter Ventures*, No. 2:21-CV-04913-VAP-ASx, 2021 U.S. Dist. LEXIS 233260 at \*\*32-33 (C.D. Cal. Oct. 22, 2021) (two years of "extensive settlement negotiations" found to be a "good reason" for the delay in filing suit "[e]ven if Defendant is correct that Plaintiff held too optimistic a view" of those negotiations... that does not change the fact that the purported delay in filing was not a period of mere 'inaction' from Plaintiff."

<sup>106</sup> No. 16-CV-4333 (KBF), 2016 U.S. Dist. LEXIS 106435 (S.D.N.Y. Aug. 16, 2016).

<sup>107</sup> *Id.* at \*14.

<sup>108</sup> *Id.* at \*\*14-15; *see also* *Fashion Week v. Council of Fashion Designers of Am., Inc.*, 2016 U.S. Dist. LEXIS 107358 at \*12 ("the plaintiff has not adduced any evidence" that the defendant suggested it would change its name); *see also* *Real USFL, LLC v. Fox Sports, Inc.*, 2022 U.S. Dist. LEXIS 72857, at \*32 (rejecting settlement as an excuse for the delay because "the evidence is undisputed that Defendants were clear from the outset—they were adamant in their belief that they had the absolute and unfettered rights to use the Marks, and they were not interested in any further meetings or conversations with Plaintiff, or interested in a resolution of the matter that might have benefitted both parties").

<sup>109</sup> Civ. No. 19-6905, 2020 U.S. Dist. LEXIS 116681 (S.D.N.Y. July 2, 2020).

<sup>110</sup> *Id.* at \*37-39; *see also* *Spark DSO, LLC v. Ormco Corp.*, 2022 U.S. Dist. LEXIS 36382 at \*8 (E.D. Pa. Mar. 2, 2022) (court rejected excuse of settlement efforts where plaintiff "had not provided any documentation of any global settlement discussions" and a magistrate judge to whom the case was referred to for settlement reported to the court after one settlement conference that the "parties were so far apart it did not make any sense for him to be involved any further"); *Two Hands IP LLC v. Two Hands Am., Inc.*, 563 F.

*Burke's Martial Arts, LLC*,<sup>111</sup> the court found that “Even assuming, *arguendo*, that some delay was initially justified while the parties attempted to settle the matter,” the plaintiff “still failed to seek injunctive relief for approximately eight (8) months after their settlement negotiations broke down, thereby undermining their claim of irreparable harm.”<sup>112</sup>

And in one case in the Northern District of Mississippi, *Ronaldo Designer Jewelry v. Cox*,<sup>113</sup> the court made the point that a plaintiff can do two things at the same time—move promptly while continuing to engage in settlement discussions.<sup>114</sup> The plaintiff in that case attributed a six-month delay to its settlement efforts.<sup>115</sup> But the court held that “a party suffering irreparable harm would and should seek injunctive relief rather than, or in addition to, engaging in negotiations. This is particularly true here where the defendants strongly signaled from the outset that any discussions would be fruitless.”<sup>116</sup>

## VII. INVESTIGATORY EFFORTS AND MOTION PREPARATION TIME

As with judicial recognition that a plaintiff's good faith settlement efforts should be encouraged and not penalized, a party may be able to excuse its alleged delay in filing a preliminary injunction motion on the ground that it needed time to investigate the nature and scope of the defendant's infringement. For example, the court in *Fleet Feet, Inc. v. Nike Inc.* stated that “[I]t is reasonable for a litigant to get its ducks in a row before coming to court, and a litigant should not be punished for giving itself time to investigate and prepare its case, so long as it does so expeditiously.”<sup>117</sup> In

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Supp. 3d 260, 301 (S.D.N.Y. 2021) (“Attempts to settle can provide a buffer only when there is a prospect of resolution, and there has been no such showing here.”)

<sup>111</sup> 2:14-CV-03685, 2015 WL 4162757 (E.D.N.Y. July 8, 2015).

<sup>112</sup> *Id.* at \*33; *see also* Smart Vent Prods. v. Crawl Space Door Sys., Civ. No. 13-5691, 2016 U.S. Dist. LEXIS 108052 n.16 (D.N.J. Aug. 15, 2016) (“even if the Court credited Smart Vent's effort to attribute its delay to the pendency of settlement discussions, it still waited over four months after those discussions collapsed to seek injunctive relief.”); Fashion Week, Inc. v. Council of Fashion Designers of Am., Inc., 2016 U.S. Dist. LEXIS 107358 (S.D.N.Y. Aug. 12, 2016) (“the alleged lapse between settlement discussions ending in January 2016 and the filing of the preliminary injunction in late June 2016 is completely unexplained. This six month delay is wholly unaccounted for and further counsels against a finding of irreparable injury.”)

<sup>113</sup> *Ronaldo Designer Jewelry, Inc. v. Cox*, No. 1:17-CV-2-DMB-DAS, 2017 U.S. Dist. LEXIS 143047 (N.D. Miss. Sept. 5, 2017).

<sup>114</sup> *Id.* at 28.

<sup>115</sup> *Id.*

<sup>116</sup> *Id.*

<sup>117</sup> 419 F. Supp. 3d at 947.

contrast, in *Dentsply Sirona Inc. v. Net32, Inc.*,<sup>118</sup> the court held that while a plaintiff's "good faith investigative efforts" would not preclude a finding of irreparable harm, the plaintiff "conceded" that its delay was "a litigation strategy"<sup>119</sup> and thus was held to be unreasonable.<sup>120</sup> On a similar level, the court in *CSI Entertainment, Inc. v. Anthem Media Group, Inc.*<sup>121</sup> held that the plaintiff's "wait-and-see approach was not reasonable. The lengthy delay was not the result of a bona fide effort to resolve the dispute without litigation." Rather, the delay "was more likely motivated by Defendants' sudden emergence as a viable commercial competitor."<sup>122</sup>

### VIII. PROGRESSIVE ENCROACHMENT

In the context of filing a complaint, "the doctrine of progressive encroachment allows a plaintiff some latitude in the timing of its bringing suit, permitting it to wait[] until the likelihood of confusion looms large."<sup>123</sup> As the Second Circuit further explained, "the primary rationale is that a plaintiff should not be obligated to sue until its right to protection has ripened such that the plaintiff knew or should have known, not simply that defendant was using the potentially offending mark, but that the plaintiff had a provable infringement claim against defendant."<sup>124</sup> In prior versions of this article, we have discussed how courts have been reluctant to apply this doctrine to the delay analysis for preliminary injunction motions unless the new infringement is "qualitatively different"<sup>125</sup> and/or unforeseeable.<sup>126</sup> More recent cases continue to show a limited application of the doctrine.

In a 2016 opinion issued by Judge Koeltl in the Southern District of New York, the court refused the plaintiff's progressive encroachment argument out of hand to excuse a twelve-to-fifteen-

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<sup>118</sup> Civ. No. 17-1530, 2018 U.S. Dist. LEXIS 5044 (M.D. Pa. Jan. 11, 2018).

<sup>119</sup> *Id.* at \*\*16-17; *see also* *Violet Crown Cinemas, LLC v. Int'l Dev. Mgmt., LLC*, No. 1:21-CV-1142-RP, 2022 U.S. Dist. LEXIS 166518 (W.D. Tex. Sept. 15, 2022) (court rejected plaintiff's argument that defendant's "dilatatory litigation tactics" should excuse its delay, holding that the filing of a motion to dismiss in lieu of answering the complaint "were nothing other than run-of-the-mill steps in litigation, and had not "unreasonably prevented" the plaintiff from seeking preliminary relief.")

<sup>120</sup> *Id.* at \*16.

<sup>121</sup> Civ. No. 15-3508, 2016 U.S. Dist. LEXIS 180749 (E.D.N.Y. Dec. 20, 2016).

<sup>122</sup> *Id.* at \*20.

<sup>123</sup> *Profitness Physical Therapy Ctr. v. Pro-Fit Orthopedic & Sports Physical Therapy P.C.*, 314 F.3d 62, 70 (2d Cir. 2002) (internal quotations and citations omitted).

<sup>124</sup> *Id.*

<sup>125</sup> *See* Raskopf & Edelman, *supra* note 1, 80 TMR at 85-56; Edelman, *supra* note 1, 92 TMR at 53-56; Edelman, *supra* note 1, 92 TMR at 658-59; Edelman, *supra* note 1, 99 TMR at 1087-88; Edelman & Sunderji, *supra* note 1, 105 TMR at 1023-25.

<sup>126</sup> *See* Edelman & Sunderji, *supra* note 1, 105 TMR at 1023-25.

month delay, noting that the plaintiff cites “no cases extending the doctrine of progressive encroachment to justify a preliminary injunction.”<sup>127</sup> Four years later, another plaintiff in the Southern District fared only slightly better because the court was at least willing to consider application of progressive encroachment in the preliminary injunction context.<sup>128</sup> In the end, the progressive encroachment excuse was rejected because the plaintiff could not show that the likelihood of confusion had grown from the initial limited use to the time the motion was filed.<sup>129</sup>

Similar to the Central District of California case *Athleta, Inc. v. Pitbull Clothing Co., Inc.*,<sup>130</sup> discussed in the 2015 edition of this article,<sup>131</sup> the court in *Vans, Inc. v. Walmart, Inc.*,<sup>132</sup> took a more lenient position on progressive encroachment. Vans first became aware of a single women’s shoe in March 2021 that it alleged infringed its rights.<sup>133</sup> After sending a cease and desist letter and following up in March 2021, Vans learned of additional allegedly infringing shoes in June, then six more in July and/or August, and ten more in September.<sup>134</sup> The complaint was filed in mid-November 2021 and the motion for preliminary injunction was filed on December 27, 2021.<sup>135</sup> That same month an additional five allegedly infringing styles were discovered. In response to Walmart’s argument that Vans’ eight-and-a-half-month delay rebuts the presumption of irreparable harm,<sup>136</sup> “Vans argued it had not unreasonably delayed seeking injunctive relief but rather ‘sought a preliminary injunction at exactly the right time, when the magnitude, breadth, and seriousness of Walmart’s potential harm had become clear.’”<sup>137</sup> The court found the delay excusable on the basis that “‘tardiness is not particularly probative in the context of ongoing, worsening injuries,’” where “‘the magnitude of the potential harm becomes apparent gradually[.]’”<sup>138</sup> The case of *Zest Anchors v.*

<sup>127</sup> *Fashion Week, Inc. v. Council of Fashion Designers of Am., Inc.*, No. 16-CV-5079 (JGK), 2016 U.S. Dist. LEXIS 107358, at \*14 (S.D.N.Y. Aug. 12, 2016).

<sup>128</sup> *Algood Casters, Ltd. v. Caster Concepts, Inc.*, No. 20-CV-4623 (LJL), 2020 U.S. Dist. LEXIS 162532, at \*9 (S.D.N.Y. Sept. 4, 2020).

<sup>129</sup> *Id.* at \*10 (“To determine whether the doctrine of progressive encroachment excuses a delay, the court compares the likelihood of confusion from the earlier use of the mark of which the plaintiff was aware from the use of the mark at the time the plaintiff brings suit.”)

<sup>130</sup> CV 12-10499, 2013 WL 142877 (C.D. Cal. Jan. 7, 2013).

<sup>131</sup> See Edelman & Sunderji, *supra* note 1, 105 TMR at 1024-25.

<sup>132</sup> No. 8:21-CV-01876-DOC-KES, 2022 U.S. Dist. LEXIS 95244 (C.D. Cal. Mar. 31, 2022).

<sup>133</sup> *Id.* at \*6.

<sup>134</sup> *Id.* at \*6-7.

<sup>135</sup> *Id.* at \*10-\*11.

<sup>136</sup> *Id.* at \*36.

<sup>137</sup> *Id.* (quoting Van’s).

<sup>138</sup> *Id.* at \*37 (quoting *Arc of California v. Douglas*, 757 F.3d 975, 990-91 (9th Cir. 2014)).

*Geryon Ventures*<sup>139</sup> in the Southern District of California is another example of this same lenient standard in the Ninth Circuit.<sup>140</sup>

The case of *Kohler v. Whistling Oak Apartments*<sup>141</sup> presents another example of a court completely excusing a plaintiff's delay, but in the end, the plaintiff's motion was denied for having only a slight chance of success on the merits with minimal harm.<sup>142</sup> The defendant began using the name "Whistling Oak" around May 2020 in connection with an apartment complex that was in development at the time.<sup>143</sup> The complaint was filed in October 2020, but the plaintiff waited until May 2021 to file its motion for a preliminary injunction.<sup>144</sup> The parties began negotiating shortly after the complaint was filed, and agreed to a *détente* to conduct a mediation. The plaintiff nevertheless filed its motion because the defendant chose to use "Whistling Oak" in advertising and planned to begin leasing apartments in July 2021. The court concluded that the plaintiff "did not delay."<sup>145</sup> "To hold that this reasonable course of action rebuts the presumption of irreparable harm would force plaintiffs to pursue potentially unnecessary motions when simpler and less-costly alternatives may promptly resolve the dispute."<sup>146</sup>

## IX. CONCLUSION

Despite major changes in trademark law and the world in general, delay continues to play a significant role in the preliminary injunction analysis for trademark litigants. While the state of the law regarding the rebuttable presumption of harm was restored to its pre-2006 status by the Trademark Modernization Act of 2020, unreasonable delay continues to prevent plaintiffs from obtaining preliminary injunctive relief. The cases show that settlement efforts are encouraged, but plaintiffs must pursue negotiations diligently and credibly. Progressive encroachment may excuse a plaintiff from not acting more promptly, but a qualitative change in the scope and/or nature of the infringement must be demonstrated.

With regard to the question of "how long is too long" before unreasonable delay will be found, cases decided over the past eight

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<sup>139</sup> No. 22-CV-230 TWR (NLS), 2022 U.S. Dist. LEXIS 127319 (S.D. Cal. July 18, 2022).

<sup>140</sup> *Id.* at \*49 ("It is therefore reasonable that Plaintiffs only considered Defendants' alleged infringement to pose a legitimate 'threat' when they learned that Defendants had partnered with [plaintiff's former partner].")

<sup>141</sup> *Kohler Co. v. Whistling Oak Apts. LLC*, No. 20-CV-1563, 2021 U.S. Dist. LEXIS 111642 (E.D. Wis. June 14, 2021).

<sup>142</sup> *Id.* at 37.

<sup>143</sup> *Id.* at \*2.

<sup>144</sup> *Id.* at \*3.

<sup>145</sup> *Id.* at \*23.

<sup>146</sup> *Id.*

years show that courts in the Second Circuit can be particularly demanding, applying a general rule of two months. But both within and outside the Second Circuit, unique facts and circumstances or egregious conduct by a defendant can result in the grant of preliminary injunction motions notwithstanding many months of delay. Rather than taking a chance, however, plaintiffs seeking to obtain an expedited injunction in trademark infringement actions should move as quickly as possible to avoid compromising the strength of its claims for relief.



## UPDATED APPENDIX

FIRST CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Voices of the Arab World, Inc. v. MDTV Medical News Now, Inc., 645 F.3d 26 (1st Cir. 2011)	Approximately 10 years; 3 months after change in website that allegedly expanded scope of infringement	Vacated district court's grant of injunction and remanded
A. Simon & Sons v. Simonfurniture Int'l, Civ. No. 21-CV-11254-PBS, 2021 U.S. Dist. LEXIS 248630 (D. Mass. Nov. 19, 2021)	Approximately 15 months	Granted in part
Channing Bete Co. v. Greenberg, Civ. No. 3.19-CV-30032-MGM, 2021 U.S. Dist. LEXIS 195652 (D. Mass. July 21, 2021), <i>adopted by</i> No. 119 (July 27, 2021)	1½ years	Denied
Baystate Health, Inc. v. Bay State Physical, P.C., Civ. No. 20-30042, 2020 U.S. Dist. LEXIS 248267 (D. Mass. Dec. 15, 2020)	12 years after notice of infringement 4 months after alleged geographic expansion	Denied
Am. Consumer Credit Counseling, Inc. v. Am. Consumer Credit, LLC, Civ. No. 16-12170, 2017 U.S. Dist. LEXIS 63917 (D. Mass. Apr. 27, 2017)	At least 2 years	Denied
Health New England, Inc. v. Trinity Health—New England, Inc., Civ. No. 15-30206, 2016 U.S. Dist. LEXIS 124946 (D. Mass. Sept. 14, 2016)	10 months (suit filed after 2 months and motion filed 8 months later)	Denied

<b>FIRST CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
E.B. Horn Co. v. Horn's Jeweler, Inc., Civ. No. 16-10618, 2016 U.S. Dist. LEXIS 194733 (D. Mass. June 7, 2016)	Almost 2 years	Denied
Solmetex, LLC v. Dentalez, Inc., 150 F. Supp. 3d 100 (D. Mass. 2015)	8 months	Denied
Granite State Trade Sch., LLC v. N.H. Sch. of Mech. Trades, Inc., 120 F. Supp. 3d 56 (D.N.H. 2015)	Approximately 3 years 2 months after notice of infringement	Denied
Concordia Partners, LLC v. Pick, Civ. No. 2:14-009, 2015 U.S. Dist. LEXIS 86214 (D. Me. July 2, 2015)	15 months after notice of infringement	Denied
Women, Action and the Media Corp. v. Women in the Arts & Media Coalition, Inc., Civ. No. 13-10089, 2013 WL 3728414 (D. Mass. July 12, 2013)	11 months (suit filed after 9 months)	Granted
Interactive Media Corp. v. Imation Corp., Civ. No. 12-11364, 2012 WL 4058064 (D. Mass. Sept. 13, 2012)	2-2½ years	Denied
Boathouse Group, Inc. v. TigerLogic Corp., 777 F. Supp. 2d 243 (D. Mass. 2011)	6 weeks (suit filed within one week of product launch)	Granted
Polar Corp. v. PepsiCo, Inc., 789 F. Supp. 2d 219 (D. Mass. 2011)	7 months after notice of intended future sales; 2½ months after notice of actual distribution	Granted
Jagex Limited v. Impulse Software, 750 F. Supp. 2d 228 (D. Mass. 2010)	Approximately 2½ years	Denied

<b>FIRST CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Operation Able of Greater Boston, Inc., 2009 WL 2407753 (D. Mass. Aug. 3, 2009)	6 weeks after alleged expansion of infringement	Granted in part
Oliva v. Ramirez, 2007 U.S. Dist. LEXIS 62011 (D.P.R. Aug. 21, 2007)	6 months	Granted
Boston Duck Tours, LP v. Super Duck Tours, LLC, 514 F. Supp. 2d 119 (D. Mass. 2007)	6 years after initial knowledge of use in other geographic market 2 years after initial knowledge of intent to expand into plaintiff's market 5 weeks after alleged expansion of infringement	Granted (as to trademark claims)
MJM Prods. v. Kelley Prods., Inc., 68 U.S.P.Q.2d 1131 (D.N.H. 2003)	6–7 months	Denied
Montblanc-Simplo GMBH v. Staples, Inc., 172 F. Supp. 2d 231 (D. Mass. 2001)	2 months	Granted
Media3 Tech., LLC v. Mail Abuse Prevention Sys., LLC, 2001 WL 92389 (D. Mass. 2001)	6 months	Denied
Boustany v. Boston Dental Group, Inc., 42 F. Supp. 2d 100 (D. Mass. 1999)	8 months	Granted
Fritz v. Arthur D. Little, Inc., 944 F. Supp. 95, 41 U.S.P.Q.2d 1352 (D. Mass. 1996)	At least 2 years constructive notice	Denied

<b>FIRST CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Supercuts, Inc. v. Super Clips, 18 U.S.P.Q.2d 1378 (D. Mass. 1990)	10 months: suit brought after 1 month; motion filed 9 months later	Granted
Calamari Fisheries, Inc. v. The Village Catch, Inc., 698 F. Supp. 994, 8 U.S.P.Q.2d 1953 (D. Mass. 1988)	21 months after first use; 1 month after expansion caused increased level of confusion	Granted
Salt Water Sportsman, Inc. v. B.A.S.S. Inc., 685 F. Supp. 12, 4 U.S.P.Q.2d 1407 (D. Mass. 1987), <i>as amended</i> , 5 U.S.P.Q.2d 1620 (D. Mass. 1987)	Less than 6 months	Granted
Jordan K. Rand, Ltd. v. Lazoff Bros., Inc., 537 F. Supp. 587, 217 U.S.P.Q. 795 (D.P.R. 1982)	3 months	Granted
<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Weight Watchers Int'l, Inc. v. Luigino's, Inc., 423 F.3d 137 (2d Cir. 2005)	4–6 months	Denial vacated, with remand for entry of modified injunction
Virgin Enters. Ltd. v. Nawab, 335 F.3d 141 (2d Cir. 2003)	19 months after initial knowledge of ITU applications 2 days after initial knowledge of actual infringement	Denial reversed

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
W.B. Marvin Mfg. Co. v. Howard Berger Co., 33 Fed. Appx. 588 (2d Cir. 2002)	6 months (motion filed 3 months after lawsuit commenced)	Denial affirmed
Tough Traveler, Ltd. v. Outbound Prods., 60 F.3d 964, 35 U.S.P.Q.2d 1617 (2d Cir. 1995)	13 months (complaint filed after 9 months)	Vacating district court's grant
Tom Doherty Assoc., Inc. v. Saban Entm't, Inc., 60 F.3d 27, 35 U.S.P.Q.2d 1537 (2d Cir. 1995)	4 months	Affirming district court's grant
King v. Innovation Books, 976 F.2d 824, 24 U.S.P.Q.2d 1435 (2d Cir. 1992)	11 months after initial knowledge of intended use, including 3 months after initial knowledge of actual use	Granted
Majorica, S.A. v. R.H. Macy & Co., 762 F.2d 7, 226 U.S.P.Q. 624 (2d Cir. 1985)	Several years	Denied
Citibank, N.A. v. Citytrust, 756 F.2d 273, 225 U.S.P.Q. 708 (2d Cir. 1985)	10 weeks after direct notice of actual use; 9 months after notice of intended use in press; years after notice of use in another state	Denied
Harlequin Enters. Ltd. v. Gulf & Western Corp., 644 F.2d 946, 210 U.S.P.Q. 1 (2d Cir. 1981)	6 months after notice of intended use; 3 months after notice of actual use	Granted

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
My-T-Fine Corp. v. Samuels, 69 F.2d 76, 21 U.S.P.Q. 94 (2d Cir. 1934)	2 years	Granted
Christmas House United States Inc. v. Christmasland Experience LLC, No. 22 CV 7691 (GRB), 2022 U.S. Dist. LEXIS 231799 (E.D.N.Y. Dec. 22, 2022)	“Little more than” 1 month	Denied
Guru Teg Holding, Inc. v. Maharaja Farmers Mkt., Inc., 22-CV-1375, 2022 U.S. Dist. LEXIS 137221 (E.D.N.Y. Aug. 22, 2022)	2 months	Granted
Hope Organics LLC v. Preggo Leggings LLC, No. 21-CV-2416 (TMR), 2021 U.S. Dist. LEXIS 239779 (S.D.N.Y. Dec. 15, 2021)	5 months	Granted
Two Hands IP LLC v. Two Hands Am., Inc., 21-CV-3855, 563 F. Supp. 3d 290 (S.D.N.Y. Sept. 29, 2021)	3 months	Denied
Goat Fashion Ltd. v. 1661, Inc., Civ. No. 19-11045, 2020 WL 5758917 (S.D.N.Y. Sept. 28, 2020)	4 months	Granted
Algood Casters, Ltd. v. Caster Concepts, Inc., Civ. No. 20-4623, 2020 WL 5274172 (S.D.N.Y. Sept. 4, 2020)	5 years	Denied
Hello I Am Elliot, Inc. v. Sine, Civ. No. 19-6905, 2020 WL 3619505 (S.D.N.Y. July 2, 2020)	2½ years	Denied
Sulzer Mixpac AG v. DXM Co., Civ. No. 19-9404, 2020 WL 3619047 (S.D.N.Y. July 2, 2020)	1–2 years	Granted
Alcon Vision LLC v. Lens.com, Civ. No. 18-407, 2020 WL 5899879 (E.D.N.Y. Feb. 28, 2020)	15 months to 2 years (14 months after filing complaint)	Denied

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Khan v. Addy's BBQ LLC, 419 F. Supp. 3d 538 (E.D.N.Y. 2019)	13 months	Denied
Woodstock Ventures LC v. Woodstock Roots, LLC, 387 F. Supp. 3d 306 (S.D.N.Y. 2019)	13 months	Denied
199 Del. Ave., Inc. v. Lake Effect Artisan Ice Cream, Civ. No. 19-00224, 2019 WL 1723588 (W.D.N.Y. Apr. 18, 2019)	10 years	Denied
Monowise Ltd. v. Ozy Media, Inc., Civ. No. 17-8028, 2018 WL 2089342 (S.D.N.Y. May 3, 2018)	Almost 9 months	Denied
Schweitzz Dist., Inc. v. LA Tax Free Shop, Civ. No. 16-6865, 2017 U.S. Dist. LEXIS 231808 (E.D.N.Y. Mar. 23, 2017)	16 months	Denied
Fashion Week, Inc. v. Council of Fashion Designers of Am., Inc., No. 16-CV-5079 (JGK), 2016 U.S. Dist. LEXIS 107358 (S.D.N.Y. Aug. 12, 2016)	12–18 months	Denied
Citigroup Inc. v. AT&T Servs., No. 16-CV-4333 (KBF), 2016 U.S. Dist. LEXIS 106435 (S.D.N.Y. Aug. 11, 2016)	3–4 months	Denied
CSI Entm't v. Anthem Media Grp., Inc., Civ. No. 15-3508, 2016 U.S. Dist. LEXIS 180749 (E.D.N.Y. Dec. 30, 2016), <i>adopted by</i> 2017 U.S. Dist. LEXIS 99568 (June 27, 2017)	1 year	Denied
Gym Door Repairs, Inc. v. Young Equip. Sales, Inc., Civ. No. 15-4244, 2016 WL 4742317 (S.D.N.Y. Sept. 9, 2016)	7 years	Denied

SECOND CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Abbott Labs v. Adelphia Supply USA, Civ. No. 15-5826, 2015 WL 10906060 (E.D.N.Y. Nov. 6, 2015)	1–2 years from notice of infringement 4 months from alleged expanded scope of infringement	Granted
27-24 Tavern Corp. v. Dutch Kills Centraal, Civ. No. 14-1625, 2015 U.S. Dist. LEXIS 133648 (E.D.N.Y. Sept. 14, 2015), <i>adopted by</i> 2015 U.S. Dist. LEXIS 132049 (E.D.N.Y. Sept. 29, 2015)	5 months	Denied
FC Online Marketing, Inc. v. Burke’s Martial Arts, LLC, 2015 WL 4162757 (E.D.N.Y. July 8, 2015)	10 months (complaint filed within 2 weeks of infringement)	Denied
Alzheimer’s Found. of Am., Inc. v. Alzheimer’s Disease and Related Disorders Ass’n, Inc., Civ. No. 10-3314, 2015 WL 4033019 (S.D.N.Y. June 26, 2015)	At least 4 years	Denied
Vantone Grp. LLC v. Yangpu NGT Indus. Co., Civ. No. 13-7639, 2015 WL 1055933 (S.D.N.Y. Mar. 11, 2015)	4 years	Denied
Saint Laurie Ltd. v. Yves Saint Laurent America, Inc., 13 Civ. 6857, 2014 U.S. Dist. LEXIS 143441 (S.D.N.Y. Sept. 30, 2014), <i>later opinion</i> , 2015 U.S. Dist. LEXIS 42621 (S.D.N.Y. Mar. 26, 2015)	4 months	Denied (on grounds other than delay; motion based on breach of trademark settlement claims)



<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Berkley Networks Corp. v. InMarket Media, LLC, 14-cv-5145, 2014 WL 8332290 (S.D.N.Y. Dec. 30, 2014)	More than 2 years; 11 months after alleged expansion of activities	Denied
Alpha Media Group, Inc. v. Corad Healthcare, Inc., 13 Civ. 5438, 2013 WL 5912227 (S.D.N.Y. Nov. 4, 2013)	12 years; 7 years after change in trade dress	Denied
Juicy Couture, Inc. v. Bella Int'l Ltd., 930 F. Supp. 2d 489 (S.D.N.Y. 2013)	At least 1 month and possibly up to 4 months	Granted as to U.S.-based conduct (extra-territorial injunction denied)
Bulman v. 2BKCO, Inc., 882 F. Supp. 2d 551 (S.D.N.Y. 2012)	Several months; protest letters sent within two days	Granted
CJ Products LLC v. Snuggly Plushez LLC, 809 F. Supp. 2d 127 (E.D.N.Y. 2011)	6 months; immediately after increase in scope of infringement (suit filed after three months)	Granted
Grout Shield Distributors, LLC v. Elio E. Salvo, Inc., 824 F. Supp. 2d 389 (E.D.N.Y. 2011)	More than 18 months	Denied
Life Technologies Corp. v. AB Sciex Pte. Ltd., 99 U.S.P.Q.2d 1785 (S.D.N.Y. 2011)	More than 9 months	Denied
The Marks Organization, Inc. v. Joles, 784 F. Supp. 2d 322 (S.D.N.Y. 2011)	Approximately 16 months	Granted

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Two Kids From Queens, Inc. v. J & S Kidswear, Inc., Civ. No. 09-3690, 2009 WL 5214497 (S.D.N.Y. Dec. 30, 2009)	5 months (suit filed after 2 months)	Denied
Kuklachev v. Gelfman, 2008 WL 5411641 (E.D.N.Y. Dec. 22, 2008)	15–20 months after first acts of infringing performance name that later ceased  Within 1 month of resumed infringement	Granted
Dudley, D.C. v. Healthsource Chiropractic, Inc., 585 F. Supp. 2d 433 (W.D.N.Y. 2008)	Almost 1 year after initial knowledge of anticipated infringement  6 months after initial knowledge of actual infringing use	Denied (but note that delay was found reasonable)
Lapham v. Porach, 2007 WL 1224924 (S.D.N.Y. Apr. 25, 2007)	Approximately 2 years after first use (actual knowledge unclear)	Denied
Richard A. Leslie Co., Inc. v. Birdie, LLC, 2007 WL 4245847 (S.D.N.Y. Nov. 26, 2007)	More than a year after first use  5 months after initial knowledge of infringement (motion filed 3 months after lawsuit commenced)	Denied

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Air Cargo News, Inc. v. Tabmag Publ'g, Ltd., 2007 WL 1101183 (E.D.N.Y. Apr. 11, 2007)	Approximately 24 years after initial use of infringing mark Several months after initial knowledge of alleged expansion of infringement	Denied
Total Control Apparel, Inc. v. DMD Int'l Imports, LLC, 409 F. Supp. 2d 403 (S.D.N.Y. 2006)	More than 19 months	Denied
Metlife, Inc. v. Metro. Nat'l Bank, 388 F. Supp. 2d 223 (S.D.N.Y. 2005)	3½ years after first knowledge of defendant's mark 3½ months after initial knowledge of alleged expansion of infringement	Granted
The Deal, LLC v. Korangy Publ'g, Inc., 309 F. Supp. 2d 512 (S.D.N.Y. 2004)	4 months after first knowledge of infringement (7 months after first use)	Denied
Christian v. Alloy, Inc., 72 U.S.P.Q.2d 1697 (S.D.N.Y. 2004)	Almost 2 years	Denied
Louis Vuitton Malletier v. Dooney & Bourke, Inc., 340 F. Supp. 2d 415 (S.D.N.Y. 2004), <i>aff'd in part and vacated in part on other grounds</i> , 454 F.3d 408 (2d Cir. 2006)	9–10 months after initial knowledge of intended use A few weeks after sending protest letter	Denied

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Christopher Norman Chocolates, Ltd. v. Schokinag Chocolates N. Am., Inc., 270 F. Supp. 2d 432 (S.D.N.Y. 2003)	8–9 months	Denied
Kadant, Inc. v. Seeley Mach., Inc., 244 F. Supp. 2d 19 (N.D.N.Y. 2003)	4 months	Granted in part
M&G Elecs. Sales Corp. v. Sony Kabushiki Kaisha, 250 F. Supp. 2d 91 (E.D.N.Y. 2003)	6–7 months (motion filed 6 months after lawsuit commenced)	Denied
Guinness United Distillers & Vintners B.V. v. Anheuser-Busch, Inc., 64 U.S.P.Q.2d 1039 (S.D.N.Y. 2002)	9 months after first use in limited market 2 months after alleged expansion of infringement (motion filed 4 months after lawsuit commenced)	Granted
Brockmeyer v. Hearst Corp., 2002 U.S. Dist. LEXIS 11725 (S.D.N.Y. 2002)	More than 16 months after first knowledge of infringement (motion filed 2 months after lawsuit commenced)	Denied
Yurman Design Inc. v. Diamonds and Time, 169 F. Supp. 2d 181 (S.D.N.Y. 2001)	4 months	Granted
Tactica Int'l, Inc. v. Atlantic Horizon Int'l, Inc., 154 F. Supp. 2d 586 (S.D.N.Y. 2001)	1 month	Granted

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Magnet Commc'ns, LLC v. Magnet Commc'ns, Inc., 2001 WL 1097965 (S.D.N.Y. 2001)	3 months	Denied
Media Group, Inc. v. Ontel Prods. Corp., 2001 WL 169776 (D. Conn. 2001)	7–8 months (complaint filed after 4–5 months)	Denied
Origins Nat'l Res., Inc. v. Kotler, 2001 WL 492429 (S.D.N.Y. 2001)	4–6 months	Denied
Greenpoint Fin. Corp. v. Sperry & Hutchinson Co., 116 F. Supp. 2d 405 (S.D.N.Y. 2000)	4 months	Denied
Ryan v. Vulpine Stamp Co., 107 F. Supp. 2d 369 (S.D.N.Y. 2000)	2 months	Granted
ImOn, Inc. v. ImaginOn, Inc., 90 F. Supp. 2d 345 (S.D.N.Y. 2000)	4 months	Denied
First Jewellery Co. of Canada, Inc. v. Internet Shopping Network LLC, 53 U.S.P.Q.2d 1838 (S.D.N.Y. 2000)	2 months	Granted
Gidatex, S.r.L. v. Campaniello Imports, Ltd., 13 F. Supp. 2d 417, 47 U.S.P.Q.2d 1701 (S.D.N.Y. 1998)	More than 2 years (5–8 months after termination of related litigation between parties)	Denied
Lexington Mgmt. Corp. v. Lexington Capital Partners, 10 F. Supp. 2d 271 (S.D.N.Y. 1998)	5–6 months	Granted
Marcy Playground, Inc. v. Capitol Records, Inc., 6 F. Supp. 2d 277 (S.D.N.Y. 1998)	9 months	Denied
Marshak v. Thomas, 1998 WL 476192 (E.D.N.Y. 1998)	2 months	Granted

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Ushodaya Enters., Ltd. v. V.R.S. Int'l, Inc., 47 U.S.P.Q.2d 1223 (S.D.N.Y. 1998)	Almost 3 years at minimum	Denied
Gen. Cigar Co., Inc. v. G.D.M. Inc., 988 F. Supp. 647, 45 U.S.P.Q.2d 1481 (S.D.N.Y. 1997)	3 months	Granted
Les Ballets Trockadero de Monte Carlo, Inc. v. Trevino, 945 F. Supp. 563, 41 U.S.P.Q.2d 1109 (S.D.N.Y. 1996)	2 months	Granted
Krueger Int'l, Inc. v. Nightingale Inc., 915 F. Supp. 595 (S.D.N.Y. 1996)	6–9 months	Denied
Bear U.S.A., Inc. v. A.J. Sheepskin & Leather Outerwear, Inc., 909 F. Supp. 896, 38 U.S.P.Q.2d 1640 (S.D.N.Y. 1995)	1–2 months for some infringing products; 3–4 months for other infringing products	Granted as to 1–2 month delay; denied as to 3–4 month delay
Trustco Bank, Nat'l Ass'n v. Glens Falls Nat'l Bank & Trust Co., N.A., 903 F. Supp. 335 (N.D.N.Y. 1995)	3 months	Denied (but delay found excusable)
Firma Melodiya v. ZYX Music GmbH, 882 F. Supp. 1306 (S.D.N.Y. 1995)	3–4 months	Granted
Museum Boutique Intercontinental, Ltd. v. Picasso, 880 F. Supp. 153 (S.D.N.Y. 1995)	14 years (15 months after alleged change in scope of infringement while standstill agreement in effect)	Denied
Cheng v. Dispeker, 35 U.S.P.Q.2d 1493 (S.D.N.Y. 1995)	5 months	Denied
Del-Rain Corp. v. Pelonis USA Ltd., 1995 WL 116043 (W.D.N.Y. 1995)	23 months	Denied

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Swanson v. Georgetown Collection, Inc., 1995 WL 72717 (N.D.N.Y. 1995)	8 months (complaint filed after 5 months)	Denied
Mastercard Int'l, Inc. v. Sprint Commc'ns Co., 30 U.S.P.Q.2d 1963 (S.D.N.Y. 1994)	6–9 months after initial knowledge of intended use	Granted (dicta)
Tommy Hilfiger U.S.A., Inc. v. Siegfried & Parzifal, Inc., 31 U.S.P.Q.2d 1222 (S.D.N.Y. 1994)	2–3 years after notice of initial elements of infringement	Denied
Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc., 841 F. Supp. 1339 (E.D.N.Y. 1994)	3–4 years	Granted
Jordache Enters., Inc. v. Levi Strauss & Co., 841 F. Supp. 506 (S.D.N.Y. 1993)	4 years	Denied
Kraft General Foods, Inc. v. Allied Old English, Inc., 831 F. Supp. 123, 31 U.S.P.Q.2d 1094 (S.D.N.Y. 1993)	7 months after publication of defendant's mark	Granted
Chase Manhattan Corp. v. Nw. Mutual Life, 1993 WL 60602 (S.D.N.Y. 1993)	11 months: suit brought after 5 months; motion filed 6 months later	Denied
Bausch & Lomb, Inc. v. Nevitt Sales Corp., 810 F. Supp. 466, 26 U.S.P.Q.2d 1275 (W.D.N.Y. 1993)	1 month after increased scope of infringement	Granted
H.G.I. Mktg. Serv., Inc. v. Pepsico, Inc., 1992 WL 349675 (N.D.N.Y. 1992)	2–4 years	Denied
Am. Direct Mktg. v. Azad Int'l, Inc., 783 F. Supp. 84, 22 U.S.P.Q.2d 1108 (E.D.N.Y. 1992)	3–6 months	Denied (but delay found excusable)

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
MGM Pathe Commc'ns Co. v. Pink Panther Patrol, 774 F. Supp. 869, 21 U.S.P.Q.2d 1208 (S.D.N.Y. 1991)	6 months	Granted
Nat'l Football League Players Ass'n v. Nat'l Football League Props., Inc., 1991 WL 79325 (S.D.N.Y. 1991) (licensing dispute)	9 months	Denied
Century Time Ltd. v. Interchron, 729 F. Supp. 366, 14 U.S.P.Q.2d 1765 (S.D.N.Y. 1990)	6 months: suit brought after 2 months; motion filed 4 months later	Denied
Lanvin, Inc. v. Colonia, 739 F. Supp. 182 (S.D.N.Y. 1990) (licensing dispute)	7 months	Denied
Mathematica Policy Research, Inc. v. Addison-Wesley Publ'g Co. Inc., 11 U.S.P.Q.2d 1391 (S.D.N.Y. 1989)	10 months	Denied
Comic Strip, Inc. v. Fox Television Stations, Inc., 710 F. Supp. 976, 10 U.S.P.Q.2d 1608 (S.D.N.Y. 1989)	7 months	Denied
Kusan, Inc. v. Alpha Distributions, Inc., 693 F. Supp. 1372, 7 U.S.P.Q.2d 1211 (D. Conn. 1988)	17–18 months	Denied
Artemide Spa v. Grandlite Design & Mfg. Co., Inc., 672 F. Supp. 698, 4 U.S.P.Q.2d 1915 (S.D.N.Y. 1987)	7 months	Granted in part
Great Lakes Mink Ass'n v. Furrari, Inc., No. 86-6038 (S.D.N.Y. 12/21/87), 1987 U.S. Dist. LEXIS 11800	20 months	Denied
Ventura Travelware, Inc. v. A to Z Luggage Co., 1 U.S.P.Q.2d 1552 (E.D.N.Y. 1986)	Approximately 18 months	Granted
Allen Organ Co. v. CBS, Inc., 230 U.S.P.Q. 479 (S.D.N.Y. 1986)	7–8 months	Denied



<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Gear, Inc. v. L.A. Gear Cal., Inc., 637 F. Supp. 1323, 227 U.S.P.Q. 980 (S.D.N.Y. 1986)	17–18 months	Denied
Nina Ricci S.A.R.L. v. Gemcraft Ltd., 612 F. Supp. 1520, 226 U.S.P.Q. 575 (S.D.N.Y. 1985)	4 months after notice, including 6 weeks after breakdown of settlement talks	Denied
Calvin Klein Co. v. Farah Mfg. Co., Inc., 229 U.S.P.Q. 795 (S.D.N.Y. 1985)	7 years of use; plaintiff's claim of less than 6 months' notice rejected	Denied
I. Peiser Floors, Inc. v. I.J. Peiser's Sons, Inc., No. 81-3359 (S.D.N.Y. 10/4/82), 1982 U.S. Dist. LEXIS 15465	2 years	Granted
Exxon Corp. v. Xoil Energy Res., Inc., 552 F. Supp. 1008, 216 U.S.P.Q. 634 (S.D.N.Y. 1981)	Approximately 12 months	Denied
Nike, Inc. v. Rubber Mfrs. Ass'n, 509 F. Supp. 919, 212 U.S.P.Q. 225 (S.D.N.Y. 1981)	Several months	Granted
C.B. Sports, Inc. v. Gaechter-Haber & Assoc., Inc., 210 U.S.P.Q. 597 (D. Vt. 1981)	6 months	Granted
Le Sportsac, Inc. v. Dockside Research, Inc., 478 F. Supp. 602, 205 U.S.P.Q. 1055 (S.D.N.Y. 1979)	10 months	Denied
Mego Corp. v. Mattel, Inc., 203 U.S.P.Q. 377 (S.D.N.Y. 1978)	7 months after notice of intended use	Denied
Programmed Tax Sys., Inc. Raytheon Co., 419 F. Supp. 1251, 193 U.S.P.Q. 435 (S.D.N.Y. 1976)	4–5 months after actual notice; 3 years after first use	Denied

<b>SECOND CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Le Cordon Bleu S.a.r.l. v. BPC Publ'g Ltd., 327 F. Supp. 267, 170 U.S.P.Q. 477 (S.D.N.Y. 1971)	13 weeks	Denied
Gianni Cereda Fabrics, Inc. v. Bazaar Fabrics, Inc., 173 U.S.P.Q. 188 (S.D.N.Y. 1971) (copyright and trademark claims)	7½ months	Denied
Helena Rubenstein, Inc. v. Frances Denney, Inc., 286 F. Supp. 132, 159 U.S.P.Q. 346 (S.D.N.Y. 1968)	20 months	Denied
Stix Prods., Inc. v. United Merchants & Mfrs., Inc., 273 F. Supp. 250, 154 U.S.P.Q. 477 (S.D.N.Y. 1967)	Preliminary injunction motion filed 5 years after suit	Denied
Goodyear Tire & Rubber Co. v. Topps of Hartford, Inc. 247 F. Supp. 899, 147 U.S.P.Q. 240 (D. Conn. 1965)	8–9 years	Denied
Colgate-Palmolive Co. v. N. Am. Chem. Corp. 238 F. Supp. 81, 144 U.S.P.Q. 266 (S.D.N.Y. 1964)	20 months	Granted
Gillette Co. v. Ed Pinaud, Inc., 178 F. Supp. 618, 123 U.S.P.Q. 531 (S.D.N.Y. 1959)	4–5 years	Denied

<b>THIRD CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Kos Pharms., Inc. v. Andrx Corp., 369 F. 3d 700 (3d Cir. 2004)	Approximately 18 months since first knowledge of intended use of infringing mark  At least 13 months since initial knowledge of sale of infringing products	Reversal of denial and remand for entry
Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 54 U.S.P.Q.2d 1577 (3d Cir. 2000), <i>cert. denied</i> , 531 U.S. 1071, 121 S. Ct. 760 (2001)	14–15 months	Grant affirmed
Pappan Enters., Inc. v. Hardee’s Food Sys., Inc., 143 F.3d 800, 46 U.S.P.Q.2d 1769 (3d Cir. 1998)	5 weeks	Reversed district court’s denial
S&R Corp. v. Jiffy Lube Int’l, Inc., 968 F.2d 371, 23 U.S.P.Q.2d 1201 (3d Cir. 1993)	3½ months	Granted
Spark DSO, LLC v. Ormco Corp., Civ. No. 21-2841, 2022 U.S. Dist. LEXIS 36382 (E.D. Pa. Mar. 2, 2022)	31 months (complaint filed after 2½ years)	Denied
Spark Therapeutics, Inc. v. Bluebird Bio, Inc., Civ. No. 21-00705-WCB, 2022 U.S. Dist. LEXIS 13133 (D. Del. Jan. 25, 2022)	More than a year (motion filed three months after complaint)	Denied (on grounds other than delay)
Logic Tech. Dev. LLC v. Levy, Civ. No. 17-04630, 2021 U.S. Dist. LEXIS 165203 (D.N.J. Aug. 31, 2021)	5 years after first notice of infringement  3½ years after filing complaint	Denied

THIRD CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
I.M. Wilson, Inc. v. Otvetstvennostyou (“Grichko”), 397 F. Supp. 3d 721 (E.D. Pa. 2019), <i>order vacated in part on reconsideration sub nom. I.M. Wilson, Inc. v. Grichko</i> , Civ. No. 18-5194, 2019 WL 5394113 (E.D. Pa. Oct. 22, 2019)	More than 2 years after notice of infringement 1–2 months from alleged expansion of infringement	Denied on motion for reconsideration, vacating prior preliminary injunction order
Shakespeare Globe Trust v. Kultur Int’l Films, Inc., Civ. No. 18-16297, 2019 WL 1760849 (D.N.J. Apr. 22, 2019)	1 year	Granted
Dentsply Sirona Inc. v. Net32, Inc., Civ. No. 17-1530, 2018 WL 372163 (M.D. Pa. Jan. 11, 2018)	5–6 years	Denied
Smart Vent Prods. v. Crawl Space Door Sys., Civ. No. 13-5691 (D.N.J. Aug. 15, 2016)	2–7 months	Denied
Vita-Pure, Inc. v. Bhatia, Civ. No. 2:14-7831, 2015 WL 1496396 (D.N.J. Apr. 1, 2015)	4 months	Denied
American Beverage Corp. v. Diageo North America, Inc., 936 F. Supp. 2d 555 (W.D. Pa. 2013)	7–9 months	Denied
ProFoot, Inc. v. MSD Consumer Care, Inc., Civ. No. 11-7079, 2012 WL 2262904 (D.N.J. June 14, 2012) (not for publication)	3 months	Denied
Barrolle v. Liberian Sports Ass’n of Pennsylvania, Civ. No. 11-4518, 2011 WL 3047811 (E.D. Pa. July 25, 2011)	Several years	Denied
Ultimate Trading Corp. v. Daus, 2007 WL 3025681 (D.N.J. Oct. 15, 2007)	5 months	Denied

<b>THIRD CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Medavante, Inc. v. Proxymed, Inc., 2006 U.S. Dist. LEXIS 74614 (D.N.J. Oct. 12, 2006)	4 months	Granted
Lazzaroni USA Corp. v. Steiner Foods, 2006 U.S. Dist. LEXIS 20962 (D.N.J. Apr. 10, 2006)	2 months	Granted
EMSL Analytical, Inc. v. Testamerica Analytical Testing Corp., 2006 WL 892718 (D.N.J. Apr. 4, 2006)	4–6 years after initial knowledge of infringing uses 6 months after initial knowledge of alleged expansion of infringement	
Pharmacia Corp. v. Alcon Labs., Inc., 201 F. Supp. 2d 335 (D.N.J. 2002)	Approximately 2 years after initial constructive knowledge Approximately 1 year after initial actual knowledge	Denied
J & J Snack Foods Corp. v. Nestlé USA, Inc., 149 F. Supp. 2d 136 (D.N.J. 2001)	10 months (complaint filed after 2 months)	Denied
New Dana Perfumes Corp. v. The Disney Store, Inc., 131 F. Supp. 2d 616 (M.D. Pa. 2001)	50 years (as to one claim); 9–10 months (as to another claim)	Denied
Sunquest Info. Sys., Inc. v. Park City Solutions, Inc., 130 F. Supp. 2d 680 (W.D. Pa. 2000)	15 months	Granted

<b>THIRD CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharms. Co., 129 F. Supp. 2d 351, 57 U.S.P.Q.2d 1522 (D.N.J. 2000)	9 months (as to claim against product name); 4 months (as to advertising claim)	Granted
Mobilificio San Giacomo S.p.A. v. Stoffi, 1997 WL 699299 (D. Del. 1997)	6 months after filing suit (but 1 month after use of mark became unauthorized)	Granted
Rockland Mortgage Corp. v. Shareholder's Funding Inc., 835 F. Supp. 182, 30 U.S.P.Q.2d 1270 (D. Del. 1993)	6 months: suit brought after 2 months; motion filed 4 months later	Granted
Accu Personnel, Inc. v. AccuStaff Inc., 823 F. Supp. 1161, 27 U.S.P.Q.2d 1801 (D. Del. 1993)	9 months after initial knowledge of intended use, including 2 months after initial knowledge of expanded activity	Granted
W.L. Gore & Assoc., Inc. v. Totes, Inc., 23 U.S.P.Q.2d 1091 (D. Del. 1992)	4 months after increased scope of activity	Granted
Warner Lambert Co. v. McCrory's Corp., 718 F. Supp. 389, 12 U.S.P.Q.2d 1884 (D.N.J. 1989)	12 months after first use; 5 months after claimed actual notice	Denied
Am. Int'l Group, Inc. v. Am. Int'l Airways, Inc., 726 F. Supp. 1470, 14 U.S.P.Q.2d 1933 (E.D. Pa. 1989)	3 years	Denied

<b>THIRD CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Transfer Print Foils, Inc. v. Transfer Print Am., 720 F. Supp. 425, 12 U.S.P.Q.2d 1753 (D.N.J. 1989)	16 months: suit brought after 5 months; motion filed 11 months later	Granted
Country Floors, Inc. v. Gepner, 11 U.S.P.Q.2d 1401 (E.D. Pa. 1989)	At least 2 years' actual notice; up to 6 years' constructive notice	Denied
Mars, Inc. v. H.P. Mayer Corp., 1988 U.S. Dist. LEXIS 9069 (D.N.J. 1988) (not for publication)	Approximately 19 months	Denied
Reedco, Inc. v. Hoffmann-La Roche, Inc., 667 F. Supp. 1072, 2 U.S.P.Q.2d 1994 (D.N.J. 1987)	17 months after actual notice; years after notice in the press	Denied
Horizon Fin., F.A. v. Horizon Bancorp., 2 U.S.P.Q.2d 1696 (E.D. Pa. 1987)	13 years use; 8 months after geographic expansion of defendant's use	Granted
Louis Rich, Inc. v. Horace W. Longacre, Inc., 423 F. Supp. 1327, 195 U.S.P.Q. 308 (E.D. Pa. 1976)	2 months	Granted
<b>FOURTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Wilson-Cook Med., Inc. v. Wiltex, Inc., 18 U.S.P.Q.2d 1642 (4th Cir. 1991)	1 year	Denied
Nabisco Brands, Inc. v. Conusa Corp., 722 F. Supp. 1287, 11 U.S.P.Q.2d 1788 (M.D.N.C.), <i>aff'd mem.</i> , 892 F.2d 74, 14 U.S.P.Q.2d 1324 (4th Cir. 1989)	5–8 months from increase in scope of infringement	Granted

<b>FOURTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Great Star Indus. USA, LLC v. Apex Brands, Inc., No. 3:20-CV-00042-FDW-DSC, 2020 U.S. Dist. LEXIS 66123 (W.D.N.C. Apr. 13, 2020)	4 years from initial constructive knowledge 3 months from actual notice of infringement	Denied
Fleet Feet, Inc. v. Nike Inc., 419 F. Supp. 3d 919 (M.D.N.C. 2019), <i>appeal dismissed as moot and remand, vacatur of preliminary injunction denied</i> 986 F.3d 458 (4th Cir. 2021)	2 months (complaint filed after 6 weeks)	Granted
Turn & Bank Holdings, LLC v. AVCO Corp., 1:19-CV-503, 2019 U.S. Dist. LEXIS 168350, 2019 WL 4773667 (M.D.N.C. Sept. 30, 2019)	1 month	Granted
Mayson-Dixon Strategic Consulting, LLC v. Mason-Dixon Polling & Strategic Consulting, Inc., 324 F. Supp. 3d 569 (D. Md. 2018)	10 months	Granted
Dynamic Aviation Grp., Inc. v. Dynamic Int'l Airways, No. 5:15-CV-00058, 2016 U.S. Dist. LEXIS 39248 (W.D. Va. Mar. 24, 2016)	9–10 months	Granted
Potomac Conference Corp. of Seventh-Day Adventists v. Takoma Academy Alumni Ass'n, Inc., Civ. No. 13-1128, 2014 WL 857947 (D. Md. Mar. 4, 2014)	1 year (suit filed after 10 months)	Granted
Rebel Debutante LLC v. Forsythe Cosmetic Group, Ltd., 799 F. Supp. 2d 558 (M.D.N.C. 2011)	6 months	Granted in part (product recall denied)
Garden & Gun, LLC v. Twodalgals, LLC, No. 3:08cv349, 2008 WL 3925276 (W.D.N.C. Aug. 21, 2008)	5–6 weeks	Granted in part



<b>FOURTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Fairbanks Capital Corp. v. Kenney, 303 F. Supp. 2d 583 (D. Md. 2003)	More than 10 months; potentially up to 2 years	Granted in part
Great Eastern Resort Corp. v. Virtual Resort Solutions, LLC, 189 F. Supp. 2d 469 (W.D. Va. 2002)	Several years after initial knowledge of initial use 7 months after initial knowledge of alleged expansion of infringement	Granted
Rubbermaid Comm'l Prods., Inc. v. Contico Int'l, Inc., 836 F. Supp. 1247, 29 U.S.P.Q.2d 1574 (W.D. Va. 1993) (design patent and trade dress case)	Almost 2 years, including 8 months after issuance of design patent	Granted
John Lemmon Films, Inc. v. Atlantic Releasing Corp., 617 F. Supp. 992, 227 U.S.P.Q. 386 (W.D.N.C. 1985)	8 months	Denied
<b>FIFTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Am. Rice, Inc. v. Arkansas Rice Growers Coop. Ass'n, 532 F. Supp. 1376, 214 U.S.P.Q. 936 (S.D. Tex. 1982), <i>aff'd</i> , 701 F.2d 408, 218 U.S.P.Q. 489 (5th Cir. 1983)	3 weeks after increased level of infringement; 4 years after less objectionable use	Granted
Violet Crown Cinemas, LLC v. Int'l Dev. Mgmt., LLC, No. 1:21-CV-1142-RP, 2022 U.S. Dist. LEXIS 166518 (W.D. Tex. Sept. 15, 2022)	9 months	Denied

FIFTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Beatstars, Inc. v. Space Ape Ltd., No. 1:21-CV-905-LY, 2022 U.S. Dist. LEXIS 141237 (W.D. Tex. Aug. 9, 2022), <i>adopted by</i> 2022 U.S. Dist. LEXIS 165914 (W.D. Tex. Aug. 26, 2022)	11 months after first infringing use in the U.S. Additional nine months after filing complaint	Denied
A-76 Techs. v. Mass Mgmt., Civ. No. 4:21-CV-923, 2021 U.S. Dist. LEXIS 249183 (S.D. Tex. Sept. 7, 2021)	At least 6 months, potentially up to 18 months	Denied
Scrum All., Inc. v. Scrum, Inc., Civil Action No. 4:20-CV-00227, 2020 U.S. Dist. LEXIS 125002 (E.D. Tex. July 16, 2020).	7 months	Granted
Fletcher's Original State Fair Corny Dogs, LLC v. Fletcher-Warner Holdings LLC, 434 F. Supp. 3d 473 (E.D. Tex. Jan. 17, 2020)	4 months	Granted
Leaf Trading Cards, LLC v. Upper Deck Co., Civil Action No. 3:17-CV-3200-N, 2019 U.S. Dist. LEXIS 227044 (N.D. Tex. Sept. 18, 2019)	At least 1 year	Denied
Ronaldo Designer Jewelry, Inc. v. Cox, No. 1:17-CV-2-DMB-DAS, 2017 U.S. Dist. LEXIS 143047, Copy. L. Rep. (CCH) P31,147, 2017 WL 3879095 (N.D. Miss. Sept. 5, 2017)	6 months	Denied
Solofill, LLC v. Rivera, 2017 U.S. Dist. LEXIS 17604, 2017 WL 514589 (S.D. Tex. Feb. 8, 2017)	4 years (2 years from notice of infringement)	Denied
Amid, Inc. v. Medic Alert Found. United States, Inc., 241 F. Supp. 3d 788 (S.D. Tex. 2017)	1 year	Denied

<b>FIFTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
BuzzBallz, LLC v. JEM Bev. Co., LLC, Civ. No. 3:15-CV-588-L, 2015 WL 3948757 (N.D. Tex. June 26, 2015)	At least 4 months (suit filed after 6 weeks)	Denied
PIU Management, LLC v. Inflatable Zone Inc., Civ. No. H-08-2719, 2010 WL 681914 (S.D. Tex. Feb. 25, 2010)	21 months	Granted
H.D. Vest, Inc. v. H.D. Vest Mgmt. & Servs., LLC, 2009 WL 1766095 (N.D. Tex. June 23, 2009)	At least 5 and up to 11 months	Denied
Innovation Ventures, LLC v. Ultimate Lifestyles, LLC, 2009 WL 1490588 (E.D. Tex. May 27, 2009)	9 months	Denied
Ellipse Commc'ns, Inc. v. Caven, 2009 WL 497268 (N.D. Tex. Feb. 26, 2009)	More than 7 months	Denied
Adventure Plus Enters., Inc. v. Gold Suit, Inc., 2008 U.S. Dist. LEXIS 27220 (N.D. Tex. Apr. 2, 2008)	17 months (motion filed almost 3 months after lawsuit commenced)	Denied
GoNannies, Inc. v. GoAuPair.com, Inc., 464 F. Supp. 2d 603 (N.D. Tex. 2006)	7 years after initial use 6 months after alleged expansion of infringement	Denied
Amicus Commc'ns, L.P. v. Hewlett-Packard Co., 1999 WL 495921 (W.D. Tex. 1999)	2-3 years	Denied
TJM Corp. v. Xerox Corp., 25 U.S.P.Q.2d 1067 (E.D. La. 1992)	17 months: suit brought after 14 months; motion filed 3 months later	Denied

SIXTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Guar. Residential Lending, Inc. v. Homestead Mortg. Co., 2005 U.S. Dist. LEXIS 43640 (E.D. Mich. Dec. 13, 2005), <i>later proceeding</i> , 291 Fed. Appx. 734 (6th Cir. 2008)	6 years after initial use (motion by counterclaim plaintiff filed 9 months after lawsuit commenced)	Denied
Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville Inc., 514 F. Supp. 704, 213 U.S.P.Q. 559 (S.D. Ohio 1981), <i>aff'd</i> , 670 F.2d 642, 214 U.S.P.Q. 15 (6th Cir. 1982), <i>cert. denied</i> , 459 U.S. 916 (1982)	At least 2 years	Granted
Reliant Capital Sols., LLC v. Ram Payment, LLC, No. 2:22-CV-3047, 2022 U.S. Dist. LEXIS 210242 (S.D. Ohio Nov. 18, 2022)	380 Days	Denied
Hydrojug, Inc. v. Five Below, Inc., No. 1:22-CV-00728-PAB, 2022 U.S. Dist. LEXIS 159588 (N.D. Ohio Sept. 2, 2022)	4 months	Granted
CEI Grp. LLC v. C.E.I. Composite Materials, LLC, 2021 U.S. Dist. LEXIS 27673 (E.D. Mich. Feb. 12, 2021).	6 years	Denied (mainly on other grounds other than delay)
JTH Tax, Inc. v. Freedom Tax, Inc., Civil Action No. 3:19-CV-00085-RGJ, 2019 U.S. Dist. LEXIS 78532 (W.D. Ky. May 9, 2019)	11 months	Granted (as to trademark claims)
Dist. Brewing Co. v. CBC Rest., LLC, No. 2:15-CV-3114, 2016 U.S. Dist. LEXIS 46539 (S.D. Ohio Apr. 6, 2016)	20 years	Denied
CLT Logistics v. River West Brands, 777 F. Supp. 2d 1052 (E.D. Mich. 2011)	Less than 2 months	Denied (on grounds other than delay)

<b>SIXTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
King Pharmaceuticals, Inc. v. Zymogenetics, Inc., No. 2:09-cv-244, 2009 WL 4931238 (E.D. Tenn. Dec. 10, 2009)	More than 22 months	Denied
AmMed Direct, LLC v. Liberty Medical Supply, Inc., No. 3:09-00288, 2009 WL 3680539 (M.D. Tenn. Sept. 23, 2009)	Approximately 7 months	Denied (on grounds other than delay)
Wells Fargo v. WhenU.com, Inc., 293 F. Supp. 2d 734 (E.D. Mich. 2003)	9 months	Denied
R.L. Polk & Co. v. Infousa, Inc., 230 F. Supp. 2d 780 (E.D. Mich. 2002)	3 months	Granted
McDonald's Corp. v. Burger King Corp., 87 F. Supp. 2d 722, 54 U.S.P.Q.2d 1507 (E.D. Mich. 1999)	8–9 months	Denied
P.T.C. Brands, Inc. v. Conwood Co. L.P., 28 U.S.P.Q.2d 1895 (W.D. Ky. 1993)	8 months: suit brought after 2 months; motion filed 6 months later	Granted
Central Benefits Mutual Insurance Co. v. Blue Cross & Blue Shield Ass'n, 711 F. Supp. 1423, 11 U.S.P.Q.2d 1103 (S.D. Ohio 1989)	18 months	Granted

<b>SEVENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796 (7th Cir. 2002)	Years after initial knowledge of initial use At least 6 months after knowledge of alleged expansion of infringement	Denial affirmed
Ty, Inc. v. Jones Group, Inc., 237 F.3d 891, 57 U.S.P.Q.2d 1617 (7th Cir. 2001)	At least 8 months (motion filed 8 months after complaint was filed)	Grant affirmed
Vaughan Mfg. Co. v. Brikam Int'l, Inc., 814 F.2d 346, 1 U.S.P.Q.2d 2067 (7th Cir. 1987)	10 months	Granted
Floralife, Inc. v. Floraline Int'l, Inc., 633 F. Supp. 108 (N.D. Ill. 1985), <i>later proceeding</i> , 807 F.2d 518, 1 U.S.P.Q.2d 1132 (7th Cir. 1986)	At least 3 years after notice of limited use; less than 3 weeks after initial knowledge of expansion of use	Granted
Ideal Indus., Inc. v. Gardner Bender, Inc., 612 F.2d 1018, 204 U.S.P.Q. 177 (7th Cir. 1979), <i>cert. denied</i> , 447 U.S. 924, 206 U.S.P.Q. 864 (1980)	Suit filed 7 months after notice; preliminary injunction motion filed 8 months later	Granted
Helene Curtis Indus., Inc. v. Church & Dwight Co., Inc., 560 F.2d 1325, 195 U.S.P.Q. 218 (7th Cir. 1977), <i>cert. denied</i> , 434 U.S. 1070, 197 U.S.P.Q. 592 (1978)	Suit filed within weeks of notice; preliminary injunction filed 13 months later	Granted

SEVENTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Park Ridge Sports, Inc. v. Park Ridge Travel Falcons, No. 20 C-2244, 2022 U.S. Dist. LEXIS 97970 (N.D. Ill. Jan. 5, 2022) <i>adopted by</i> 2022 U.S. Dist. LEXIS 96830 (N.D. Ill. Mar. 25, 2022)	18 months since filing suit	Denied
Kohler Co. v. Whistling Oak Apts. LLC, No. 20-CV-1563, 2021 U.S. Dist. LEXIS 111642 (E.D. Wis. June 14, 2021)	1 year	Denied
Data Mgmt. Ass'n Int'l v. Enter. Warehousing Sols., No. 20-C-04711, 2020 U.S. Dist. LEXIS 242699 (N.D. Ill. Dec. 28, 2020)	10 months	Granted
Park Ridge Sports, Inc. v. Park Ridge Travel Falcons, No. 20-C-2244, 2020 U.S. Dist. LEXIS 200094 (N.D. Ill. Aug. 20, 2020), <i>adopted by</i> 2020 U.S. Dist. LEXIS 197095 (N.D. Ill. Oct. 23, 2020)	3 months (after filing complaint)	Denied
Life After Hate, Inc. v. Free Radicals Project, Inc., 410 F. Supp. 3d 891 (N.D. Ill. 2019)	14 months	Granted
USA-Halal Chamber of Commerce, Inc. v. Best Choice Meats, Inc., 402 F. Supp. 3d 427 (N.D. Ill. 2019)	2 months	Granted
SFG, Inc. v. Musk, No. 19-CV-02198, 2019 U.S. Dist. LEXIS 176145 (N.D. Ill. Oct. 10, 2019)	6–8 months	Denied (on other grounds)
Redbox Automated Retail, LLC v. Xpress Retail LLC, 310 F. Supp. 3d 949 (N.D. Ill. 2018)	18 months	Denied
Impact Networking, LLC v. Impact Tech. Sols., Inc., No. 17-C-5205, 2018 U.S. Dist. LEXIS 48815 (N.D. Ill. Mar. 26, 2018)	19 months	Denied

<b>SEVENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Essentia Health v. Gundersen Lutheran Health Sys., No. 17-CV-100-wmc, 2017 U.S. Dist. LEXIS 53539 (W.D. Wis. Apr. 7, 2017)	More than 2 years	Denied
Nat'l Fin. Partners Corp. v. Paycom Software, Inc., No. 14-C-7424, 2015 U.S. Dist. LEXIS 74700 (N.D. Ill. June 10, 2015)	4 months	Granted
Real-Time Reporters, P.C. v. Sonntag Reporting Servcs., No. 13C 5348, 2013 WL 5818460 (N.D. Ill. Oct. 29, 2013)	4 months (suit filed after 3 months)	Denied
Country Inns & Suites by Carlson, Inc. v. Nayan, LLC, 2008 WL 4735267 (S.D. Ind. Oct. 28, 2008)	Less than 1 month	Granted
Miyano Mach. USA, Inc. v. Miyano Mach., Inc., 576 F. Supp. 2d 868 (N.D. Ill. 2008)	Approximately 1 year	Granted
Nat'l Council of Young Men's Christian Assocs. of U.S. v. Human Kinetics Publishers, Inc., 2006 WL 752950 (N.D. Ill. Mar. 15, 2006)	One year	Granted
MB Fin. Bank, N.A. v. MB Real Estate Servs., L.L.C., 2003 WL 22765022 (N.D. Ill. Nov. 21, 2003)	9 months	Denied
Keystone Consol. Indus. Inc. v. Mid-States Distrib. Co., 235 F. Supp. 2d 901 (C.D. Ill. 2002)	7 months	Granted
Ty, Inc. v. Softbelly's, Inc., 2001 WL 125321 (N.D. Ill. Feb. 9, 2001)	10 months	Granted
Ty, Inc. v. Publications Int'l, Ltd., 81 F. Supp. 2d 899 (N.D. Ill. 2000)	14 months	Granted
Avent Am., Inc. v. Playtex Prods., Inc., 68 F. Supp. 2d 920 (N.D. Ill. 1999)	2-3 months	Granted



<b>SEVENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Philip Morris, Inc. v. Allen Distribs., Inc., 48 F. Supp. 2d 844, 51 U.S.P.Q.2d 1013 (S.D. Ind. 1999)	5 months	Granted
Reins of Life, Inc. v. Vanity Fair Corp., 5 F. Supp. 2d 629, 45 U.S.P.Q.2d 1854 (N.D. Ind. 1997)	8–9 months	Denied
Porsche Cars N. Am., Inc. v. Manny's Porshop, Inc., 972 F. Supp. 1128, 43 U.S.P.Q.2d 1475 (N.D. Ill. 1997)	4 years (10 years from first infringement dispute)	Granted
RWT Corp. v. Wonderware Corp., 931 F. Supp. 583 (N.D. Ill. 1996)	9 months	Denied
Eldon Indus., Inc. v. Rubbermaid, Inc., 735 F. Supp. 786, 17 U.S.P.Q.2d 1280 (N.D. Ill. 1990)	4½ years: suit brought after 4 years; motion filed 6½ months later	Denied
Stokely-Van Camp, Inc. v. Coca-Cola Co., 2 U.S.P.Q.2d 1225 (N.D. Ill. 1987)	3 months	Denied
Am. Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp., 622 F. Supp. 673, 228 U.S.P.Q. 225 (N.D. Ill. 1985)	A few months notice by high level employee; earlier notice by sales personnel	Granted
Universal City Studios, Inc. v. Mueller Chem. Co., 223 U.S.P.Q. 798 (N.D. Ill. 1983)	3 months	Granted

<b>EIGHTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Novus Franchising, Inc. v. Dawson, 725 F.3d 885 (8th Cir. 2013)	17 months	Affirmed grant of preliminary injunction as to unauthorized use of trademarks, denied as to breach of non-compete agreement on the ground of delay.
Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc., 182 F.3d 598, 51 U.S.P.Q.2d 1373 (8th Cir. 1999)	4 years	Denied
Mutual of Omaha Ins. Co. v. Novak, 775 F.2d 247, 227 U.S.P.Q. 801 (8th Cir. 1985)	12 months	Granted
Stone Strong, LLC v. Stone Strong of Tex., LLC, Civ. No. 4:21-CV-3160, 2021 U.S. Dist. LEXIS 195329 (D. Neb. Oct. 8, 2021)	15 months	Denied
Storage Concepts, Inc. v. Incontro Holdings, LLC, No. 8:20-CV-447, 2021 U.S. Dist. LEXIS 86284 (D. Neb. May 5, 2021)	8 months	Granted
Modern Point, LLC v. ACU Dev., LLC, No. 19-CV-668 (NEB/HB), 2020 U.S. Dist. LEXIS 200735 (D. Minn. Oct. 28, 2020)	2 years	Granted
TrueNorth Cos., LC v. TrueNorth Warranty Plans of N. Am., LLC, 353 F. Supp. 3d 788 (N.D. Iowa 2018)	3 years	Denied

<b>EIGHTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Cmtty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ's Church, 613 F. Supp. 2d 1140 (W.D. Mo. 2009)	Approximately 1 year	Granted
Clam Corp. v. Innovative Outdoor Solutions, Inc., 89 U.S.P.Q. 2d 1314 (D. Minn. 2008)	1 year after initial use 3 months after alleged expansion of infringement	Denied
Gander Mountain Co. v. Cabela's, Inc., 2006 WL 2788184 (D. Minn. Sept. 26, 2006)	3 months after objectionable conduct by defendant More than 2 years after litigation between parties began	Denied
<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Herb Reed Enterprises, LLC v. Florida Entertainment Management, Inc. 736 F.3d 1239 (9th Cir. 2013)	11 months	Grant of injunction reversed (on grounds other than delay)
GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 53 U.S.P.Q.2d 1652 (9th Cir. 2000)	At least 5 months (additional delay prior to filing of complaint)	Grant affirmed
Fogerty v. Poor Boy Prods., Inc., 124 F.3d 211 (9th Cir. 1997) (unpublished)	More than 1 year	Reversing district court grant

NINTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Ocean Garden, Inc. v. Marktrade Co., 953 F.2d 500, 21 U.S.P.Q.2d 1493 (9th Cir. 1991)	11 months from notice of intended sale, including 2–3 months from notice of actual sale	Granted
Desirous Parties Unlimited Inc. v. Right Connection Inc., No. 2.21-CV-01838, 2022 U.S. Dist. LEXIS 162000 (D. Nev. Sept. 7, 2022)	13 months	Granted
Zest Anchors, LLC v. Geryon Ventures, LLC, No. 22-CV-230, 2022 U.S. Dist. LEXIS 127319 (S.D. Cal. July 18, 2022)	5 years	Granted in part, denied in part
Morisky v. MMAS Research LLC, No. 2.21-CV-1301, 2022 U.S. Dist. LEXIS 75136 (W.D. Wash. April 15, 2022), <i>adopted by</i> 2022 U.S. Dist. LEXIS 74870 (W.D. Wash. Apr. 25, 2022)	3 years 6 months after complaint was filed	Denied
Real USFL, LLC v. Fox Sports, Inc., No. CV 22-1350 JFW(MARx), 2022 U.S. Dist. LEXIS 72857 (C.D. Cal. Apr. 14, 2022)	9 months	Denied
Vans, Inc. v. Walmart, Inc., No. 8:21-CV-01876-DOC-KES, 2022 U.S. Dist. LEXIS 95244 (C.D. Cal. Mar. 31, 2022)	8½ months	Granted
Nanal, Inc. v. SMK Int'l, Inc., No. 2.19-CV-02211, 2021 U.S. Dist. LEXIS 245571 (D. Nev. Dec. 27, 2021)	2 years	Denied
UV RML NL Assets v. Coulter Ventures, No. 2.21-CV-04913, 2021 U.S. Dist. LEXIS 233260 (C.D. Cal. Oct. 22, 2021)	2 years	Granted

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Icleen Entwicklungs-Und Vertiebsanstalt Für Umweltprodukte v. Blueair AB, No. 21-2236, 2021 U.S. Dist. LEXIS 246993 (C.D. Cal. Oct. 4, 2021)	9 months	Denied
Nitto Tire U.S.A. v. Gigatires, No. 8:21-CV-00797-JVS-JDEx, 2021 U.S. Dist. LEXIS 202589 (C.D. Cal. Aug. 12, 2021)	20 months	Denied
Tempo Commc'ns v. King Tech. of Mo., No. 21-CV-80-AJB-WVG, 2021 U.S. Dist. LEXIS 206387 (S.D. Cal. July 19, 2021)	5 months	Denied (on grounds other than delay)
Caryn Mandabach Prods. v. Sadlers Brewhouse, No. CV-20-10220-CBM-(JEMx), 2021 U.S. Dist. LEXIS 116713 (C.D. Cal. May 19, 2021)	2 years and 11 months	Denied
Kiva Health Brands LLC v. Kiva Brands Inc., 402 F. Supp. 3d 877 (N.D. Cal. 2019)	2½+ years	Denied
Bragi Gmbh v. OnePlus Tech. Shenzhen Co., No. C-18-2972 SBA, 2019 U.S. Dist. LEXIS 223137 (N.D. Cal. Jan. 11, 2019)	2 years and 3 months	Denied
Tadich Grill, Inc. v. Tadich Grill Dev. Co., LLC, No. 18-CV-02827-JSC, 2018 U.S. Dist. LEXIS 146437 (N.D. Cal. Aug. 28, 2018)	7 weeks	Granted in part
Kolay v. Milliken, No. 2:18-CV-00640-SVW (KSx), 2018 U.S. Dist. LEXIS 238107 (C.D. Cal. Mar. 22, 2018)	1 year	Denied
Equinox Hotel Mgmt. v. Equinox Holdings, Inc., No. 17-CV-06393-YGR, 2018 U.S. Dist. LEXIS 16914 (N.D. Cal. Feb. 1, 2018)	2½ years	Denied

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
AECOM Energy & Constr., Inc. v. Ripley, No. 2:17-CV-05398-RSWL-SS, 2017 U.S. Dist. LEXIS 160180 (C.D. Cal. Sept. 27, 2017)	4 months	Granted
Suja Life, LLC v. Pines Int'l, Inc., No. 16CV985-GPC(WVG), 2016 U.S. Dist. LEXIS 147014 (S.D. Cal. Oct. 24, 2016)	15 months	Denied (on grounds other than delay)
2die4kourt v. Hillair Capital Mgmt., LLC, No. SACV 16-01304 JVS(DFMx), 2016 U.S. Dist. LEXIS 118211 (C.D. Cal. Aug. 23, 2016)	5 months	Granted
iFreedom Direct Corp. v. McCormick, No. SACV 16-470-JLS (KESx), 2016 U.S. Dist. LEXIS 192173 (C.D. Cal. June 15, 2016)	10 months	Denied
Champion-Cain v. MacDonald, No. 14-CV-2540-GPC-BLM, 2015 U.S. Dist. LEXIS 92149 (S.D. Cal. July 15, 2015)	18 months	Denied
Lateral Link v. Springut, No. LA CV14-05695 JAK (JEMx), 2015 U.S. Dist. LEXIS 181032 (C.D. Cal. Feb. 26, 2015)	6 months	Denied
Cutting Edge Solutions, LLC v. Sustainable Low Maint. Grass, LLC, No. 14-cv-02770, 2014 WL 5361548 (N.D. Cal. Oct. 20, 2014)	18 months	Denied
Wahoo Int'l, Inc. v. Phix Doctor, Inc., No. 13cv1395, 2014 WL 2106482 (S.D. Cal. May 20, 2014)	17 months	Motion for ex parte TRO denied
Hanginout, Inc. v. Google, Inc., 54 F. Supp. 3d 1109 (S.D. Cal. 2014)	8 months (31 months after first public use)	Denied
AK Metals, LLC v. Norman Indus. Materials, Inc., 12cv2595, 2013 WL 417323 (S.D. Cal. Jan. 31, 2013)	2 months after filing complaint	Denied

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Athleta, Inc. v. Pitbull Clothing Co., Inc., 12-10499, 2013 WL 142877 (C.D. Cal. Jan. 7, 2013)	1 month from expanded use	Granted
Boldface Licensing + Branding v. By Lee Tillett, Inc., 940 F. Supp. 2d 1178 (C.D. Cal. 2013)	8 months	Granted
Russell Road Food & Beverage, LLC v. Spencer, 2:12-CV-01514, 2013 WL 321666 (D. Nev. Jan. 28, 2013)	5 months	Denied
Spiraledge, Inc. v. SeaWorld Entertainment, Inc., 13cv296, 2013 WL 3467435 (S.D. Cal. July 9, 2013)	At least 13 months	Denied
ConocoPhillips Co. v. Gonzalez, 5:12-cv-00576, 2012 WL 538266 (N.D. Cal. Feb. 17, 2012)	8 months	Denied
JL Beverage Co., LLC v. Beam, Inc., 899 F. Supp. 2d 991 (D. Nev. 2012)	12 months	Denied
SunEarth, Inc. v. Sun Earth Solar Power Co., Ltd., 846 F. Supp. 2d 1063 (N.D. Cal. 2012)	11 months (suit filed after 10 months)	Granted
Kerr Corp. v. N. Am. Dental Wholesalers, Inc., 11-0313, 2011 WL 2269991 (C.D. Cal. June 9, 2011)	8 months	Denied
Wetzel's Pretzels, LLC v. Johnson, 797 F. Supp. 2d 1020 (C.D. Cal. 2011)	1 year	Granted
Edge Games, Inc. v. Electronic Arts, Inc., 745 F. Supp. 2d 1101 (N.D. Cal. 2010)	3 years	Denied
Masters Software, Inc. v. Discovery Communications, Inc., 725 F. Supp. 2d 1294 (W.D. Wash. 2010)	1 year	Granted

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Credit One Corp. v. Credit One Financial, Inc., 661 F. Supp. 2d 1134 (C.D. Cal. 2009)	Approximately 18 months (suit filed after approximately 15 months)	Denied
Protech Diamond Tools, Inc. v. Liao, 2009 WL 1626587 (N.D. Cal. June 8, 2009)	Almost 3 years	Denied
Volkswagen AG v. Verdier Microbus and Camper, Inc., 2009 WL 928130 (N.D. Cal. Apr. 3, 2009)	Approximately 2 months	Granted
Cascade Fin. Corp. v. Issaquah Cmty. Bank, 2007 WL 2871981 (W.D. Wash. Sept. 27, 2007)	6–7 months	Denied
Topline Corp. v. 4273371 Can., Inc., 2007 WL 2332471 (W.D. Wash. Aug. 13, 2007)	10 months	Granted
PDL, Inc. v. All Star Driving School, 2007 WL 1515139 (E.D. Cal. May 22, 2007)	More than 3 years after initial use 4–6 months after initial knowledge of alleged expansion of infringement	Granted
Studio Red Inc. v. Rockwell Architecture Planning and Design, P.C., 2007 WL 1462458 (N.D. Cal. May 18, 2007)	8 months	Denied
Jonathan Neil & Assoc., Inc. v. JNA Seattle, Inc., 2007 WL 788354 (W.D. Wash. Mar. 14, 2007)	At least 9 months	Granted
Nova Wines, Inc. v. Adler Fels Winery LLC, 467 F. Supp. 2d 965 (N.D. Cal. 2006)	1–3 months	Granted



<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Conversive, Inc. v. Conversagent, Inc., 433 F. Supp. 2d 1079 (C.D. Cal. 2006)	More than 1 year	Granted
eAcceleration Corp. v. Trend Micro, Inc., 408 F. Supp. 2d 1110 (W.D. Wash. 2006)	More than 1 year	Denied
First Franklin Fin. Corp. v. Franklin First Fin., Ltd., 356 F. Supp. 2d 1048 (N.D. Cal. 2005)	11 years after first use At least 2 and up to 7 months after claimed first knowledge	Denied
SMC Promotions, Inc. v. SMC Promotions, 355 F. Supp. 2d 1127 (C.D. Cal. 2005)	4 months after suit commenced First notice by plaintiff unclear	Granted
Rain Bird Corp. v. Hit Prods. Corp., 72 U.S.P.Q.2d 1105 (C.D. Cal. 2004)	At least 17 months	Granted
Nautilus Group, Inc. v. Icon Health and Fitness, Inc., 308 F. Supp. 2d 1208 (W.D. Wash. 2003)	Several months	Granted
Perfect 10, Inc. v. Cybernet Ventures, Inc., 213 F. Supp. 2d 1146 (C.D. Cal. 2002)	9 months after suit commenced First notice by plaintiff unclear	Granted
H.O. Sports, Inc. v. Earth & Ocean Sports, Inc., 57 U.S.P.Q.2d 1927 (W.D. Wash. 2001)	1–2 months	Granted
eBay, Inc. v. Bidder's Edge, Inc., 100 F. Supp. 2d 1058 (N.D. Cal. 2000) (trespass and trademark case)	2 years	Granted

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Playboy Enters., Inc. v. Netscape Commc'ns Corp., 55 F. Supp. 2d 1070, 52 U.S.P.Q.2d 1162 (C.D. Cal. 1999)	11 months	Denied
Sun Microsystems, Inc. v. Microsoft Corp., 999 F. Supp. 1301, 46 U.S.P.Q.2d 1531 (N.D. Cal. 1998)	6 weeks	Granted
Guess?, Inc. v. Tres Hermanos, Inc., 993 F. Supp. 1277, 45 U.S.P.Q.2d 1179 (C.D. Cal. 1997)	9 months	Granted
Anheuser-Busch, Inc. v. Customer Co., 947 F. Supp. 422 (N.D. Cal. 1996)	2-3 months	Granted
Creative Tech. Ltd. v. SRT, Inc., 29 U.S.P.Q.2d 1474 (N.D. Cal. 1993)	6 months after notice and sending of protest letter	Granted
Sega Enters. Ltd. v. Accolade, Inc., 785 F. Supp. 1392, 23 U.S.P.Q.2d 1440 (N.D. Cal. 1992)	5 months: suit brought after 1½ months; motion filed 3½ months later	Granted
Lisa Frank, Inc. v. Impact Int'l, Inc., 799 F. Supp. 980 (D. Ariz. 1992)	7 months after filing complaint; 3 months after initial knowledge of expanded line of infringing products	Granted
Nat'l Yellow Pages Serv. Ass'n v. O'Connor Agency, Inc., 9 U.S.P.Q.2d 1516 (C.D. Cal. 1988)	3 years	Granted
Earth Tech. Corp. v. Env't Research & Technology, Inc., 222 U.S.P.Q. 585 (C.D. Cal. 1983)	2 years	Granted

<b>NINTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Steinway & Sons v. Robert Demars & Friends, 210 U.S.P.Q. 954 (C.D. Cal. 1981)	2 years	Granted
<b>TENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
GTE Corp. v. Williams, 731 F.2d 676, 222 U.S.P.Q. 803 (10th Cir. 1984)	3 years	Denied
Route App, Inc. v. Heuberger, No. 2.22-CV-291, 2022 U.S. Dist LEXIS 133506 (D. Utah July 26, 2022)	At least 3 months	Denied
Harley's Hope Found. v. Harley's Dream, No. 22-CV-0136, 2022 U.S. Dist. LEXIS 71750 (D. Colo. Apr. 19, 2022)	3 years	Denied
Sebo Am., LLC v. K&M Housewares & Appliances Inc., No. 1:20-CV-03683-DDD-NRN, 2021 U.S. Dist. LEXIS 71414 (D. Colo. Mar. 18, 2021)	A little more than a year	Denied
Close to My Heart, Inc. v. Enthusiast Media LLC, 508 F. Supp. 2d 963 (D. Utah 2007)	Up to 2 years after initial use Several months after alleged expansion of infringement	Denied
Hodgdon Powder Co., Inc. v. Alliant Techsystems, Inc., 2006 WL 2092391 (D. Kan. July 26, 2006)	7 months	Denied
Nature's Life, Inc. v. Renew Life Formulas, Inc., 2006 WL 62829 (D. Utah Jan. 11, 2006)	7 months	Denied

<b>TENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Pimentel & Sons Guitar Makers, Inc. v. Pimentel, 2005 WL 3664269 (D.N.M. Oct. 12, 2005)	More than 2 and up to 10 months	Granted
J.D. Williams & Co., Inc. v. Am. Home Mortgage Invest. Corp., 2005 WL 1429271 (W.D. Okla. June 13, 2005)	Approximately 6 months	Denied
Big O Tires, Inc. v. Bigfoot 4x4, Inc., 167 F. Supp. 2d 1216 (D. Colo. 2001)	More than 2 years	Granted
Packerware Corp. v. Corning Consumer Prods. Co., 895 F. Supp. 1438 (D. Kan. 1995)	3–4 months	Denied
Studio 1712, Inc. v. Etna Prods. Co., 777 F. Supp. 844, 22 U.S.P.Q.2d 1280 (D. Colo. 1991)	10 months: suit brought after 4 months; motion filed 6 months later	Granted
Universal Motor Oils Co. v. Amoco Oil Co., 15 U.S.P.Q.2d 1613 (D. Kan. 1990)	3 months	Granted
Paramount Pictures Corp. v. Video Broad. Sys., 724 F. Supp. 808, 12 U.S.P.Q.2d 1862 (D. Kan. 1989)	15 months	Denied
Cyclonaire Corp. v. U.S. Sys., Inc., 209 U.S.P.Q. 310 (D. Kan. 1980)	6 months	Granted
Volkswagenwerk, G.m.b.H. v. Frank, 198 F. Supp. 916, 131 U.S.P.Q. 236 (D. Colo. 1961)	17 months after lawsuit	Granted

ELEVENTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Wreal LLC v. Amazon.com, Inc., No. 14-21385-CIV-LENARD/GOODMAN, 2015 U.S. Dist. LEXIS 176382 (S.D. Fla. Feb. 3, 2015), <i>adopted by</i> 2015 U.S. Dist. LEXIS 187420 (S.D. Fla. Aug. 31, 2015), <i>affirmed on appeal</i> Wreal, LLC v. Amazon.com, 840 F.3d 1244, 1248 (11th Cir. 2016)	5 months	Denied
AT&T Mobility LLC v. Nat'l Ass'n for Stock Car Auto Racing, Inc., 487 F. Supp. 2d 1370 (N.D. Ga. 2007), <i>vacated and dismissed on other grounds</i> , 494 F.3d 1356 (11th Cir. 2007)	2-3 months	Granted
Ab v. Chenmed, LLC, No. 1:22-CV-22654-KMM, 2022 U.S. Dist. LEXIS 220646 (S.D. Fla. Dec. 7, 2022) (Report & Recommendation never confirmed, case settled)	6 months	Denied
Bethune-Cookman v. Dr. Mary McLeod Bethune Nat'l Alumni Ass'n Inc., No. 6:22-CV-47-WWB-DAB, 2022 U.S. Dist. LEXIS 234539 (M.D. Fla. Nov. 22, 2022)	9 months	Denied
Trust v. Armadillo Distrib. Enter., No. 8:21-CV-1967, 2022 U.S. Dist. LEXIS 175007 (M.D. Fla. Aug. 10, 2022), <i>adopted by</i> In Dime We Trust v. Armadillo Distribution Enter., No. 8:21-CV-1967-SDM-AAS, 2022 U.S. Dist. LEXIS 172820 (M.D. Fla. Sept. 23, 2022)	4 years	Denied
Restivo v. Pennachio, No. 1:21-CV-23388, 2021 U.S. Dist. LEXIS 214591 (S.D. Fla. Nov. 5, 2021)	More than 30 years	Denied

ELEVENTH CIRCUIT		
CASE	DELAY LENGTH	HOLDING ON MOTION
Tuna Family Mgmt., Inc. v. All Tr. Mgmt., Inc., No. 20-14017, 2021 U.S. Dist. LEXIS 197358 (S.D. Fla. Oct. 13, 2021)	17 months	Denied
Car Body Lab. v. Lithia Motors, No. 21-CV-21484-MORE, 2021 U.S. Dist. LEXIS 115493 (S.D. Fla. June 21, 2021), <i>adopted by</i> 2021 U.S. Dist. LEXIS 145667 (S.D. Fla. Aug. 4, 2021)	10 months	Denied
Romanick v. Mitchell, No. 2.21-CV-0065, 2021 U.S. Dist. LEXIS 215758 (N.D. Ga. July 13, 2021)	1 year	Denied
Diversified Sols., Inc. v. Ohwook! Prods., No. 21-10039-CIV-MARTINEZ, 2021 U.S. Dist. LEXIS 78233 (S.D. Fla. Apr. 23, 2021)	4 years and 7 months	Denied
Malicious Women Candle Co., LLC v. Rynn Carter Cox, 506 F. Supp. 3d 1245 (M.D. Fla. 2020)	2+ years	Denied
Sprint Commc'ns, Inc. v. Calabrese, No. 18-60788-CIV-MARTINEZ/S, 2018 U.S. Dist. LEXIS 112751 (S.D. Fla. July 5, 2018), <i>adopted by</i> 2018 U.S. Dist. LEXIS 224686 (S.D. Fla. Nov. 7, 2018)	1 year	Denied
Tech Traders, LLC v. Insuladd Env't, Ltd., No. 6:18-CV-754-Orl-40GJK, 2018 U.S. Dist. LEXIS 190514 (M.D. Fla. Nov. 7, 2018)	3 years and 5 months	Denied
Menudo Int'l, LLC v. In Miami Prod., LLC, No. 17-21559-Civ, 2017 U.S. Dist. LEXIS 179777 (S.D. Fla. Oct. 31, 2017)	Almost 2 years	Denied

<b>ELEVENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Spire, Inc. v. Cellular S., Inc., No. 17-00266-KD-N, 2017 U.S. Dist. LEXIS 146169 (S.D. Ala. Sept. 11, 2017)	18 months	Denied
Vialle Grp., B.V. v. Green Wing Grp., Inc., No. 2:16-CV-14207-ROSENBERG/LYNCH, 2016 U.S. Dist. LEXIS 188307 (S.D. Fla. Oct. 26, 2016)	8 months	Denied
Hi-Tech Pharm. v. Dynamic Sports Nutrition, No. 1:16-CV-949-MHC, 2016 U.S. Dist. LEXIS 199046 (N.D. Ga. June 2, 2016)	10 years	Denied
CORD:USE Cord Blood Bank, Inc. v. CBR Systems, Inc., No. 6:11-cv-893, 2012 WL 8745157 (M.D. Fla. Nov. 5, 2012)	Approximately 14 months after filing suit	Denied
Anesthesia Healthcare Partners Inc. v. Anesthesia Healthcare Solutions of N. Florida LLC, 3:11cv149, 2011 WL 2446377 (N.D. Fla. May 20, 2011)	Approximately 5 months	Denied
Hi-Tech Pharms., Inc. v. Herbal Health Prods., Inc., 311 F. Supp. 2d 1353 (N.D. Ga. 2004)	7 months	Denied
Seiko Kabushiki Kaisha v. Swiss Watch Int'l, Inc., 188 F. Supp. 2d 1350 (S.D. Fla. 2002)	10 months	Denied
Bulova Corp. v. Bulova Do Brasil Com. Rep. Imp. & Exp. Ltda., 144 F. Supp. 2d 1329, 59 U.S.P.Q.2d 1077 (S.D. Fla. 2001)	4½ years	Granted

<b>ELEVENTH CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Golden Bear Int'l, Inc. v. Bear U.S.A., Inc., 969 F. Supp. 742, 42 U.S.P.Q.2d 1283 (N.D. Ga. 1996)	8 months (first use was more than a year prior to plaintiff's first actual notice of use)	Denied
Glen Raven Mills, Inc. v. Ramada Int'l, Inc., 1994 WL 230365 (M.D. Fla. 1994)	16 months after notice of intended use, including 11 months after notice of actual use	Denied, but court found that plaintiff had acted promptly
Bellsouth Adver. & Publ'g Corp. v. Real Color Pages, Inc., 792 F. Supp. 775 (M.D. Fla. 1991)	7-8 months	Granted
Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 231 U.S.P.Q. 850 (N.D. Ga. 1986)	5-10 months	Granted
<b>D.C. CIRCUIT</b>		
<b>CASE</b>	<b>DELAY LENGTH</b>	<b>HOLDING ON MOTION</b>
Nat'l Rural Elec. Coop. Assocs. v. Nat'l Agric. Chem. Assoc., 26 U.S.P.Q.2d 1294 (D.D.C. 1992)	Several weeks after initial knowledge of increased scope of infringement	Granted
Delmatoff, Gerow, Morris, Langhans, Inc. v. Children's Hosp. Nat'l Med. Ctr., 12 U.S.P.Q.2d 1136 (D.D.C. 1989)	12 months	Denied



## COMMENTARY

### FIFTY YEARS OF *McCARTHY ON TRADEMARKS*

*By J. Thomas McCarthy\**

#### I. INTRODUCTION

In 2023 my publisher Thomson Reuters and I are celebrating the fiftieth anniversary of the publication of my treatise *McCarthy on Trademarks and Unfair Competition*. Today, the treatise appears in seven volumes and also appears online in the Westlaw legal database and in the ProView eBook app. I continue to modify and revise the work, and every three months it is updated with new materials and analysis.

I'm deeply gratified that my efforts over all these years on the book have been successful. My treatise is widely regarded as a reliable and accurate source for guidance in trademark and false advertising law. I'm immensely pleased that in the fifty years since the first publication of the treatise, it has been relied on as an authority in over 8,000 judicial decisions, including in eighteen U.S. Supreme Court opinions.

A number of people have asked me why and how I first came to write the book and what significant changes in trademark law I've seen over the past fifty years. In this *Trademark Reporter* commentary, I respond to questions like these.

#### II. HOW DID IT START?

My interest in trademark law was kindled when, in law school at the University of Michigan, my favorite course was Unfair Trade Practices, taught by Professor Jack Richard Pearce. That was the first time I was introduced to the complexities of the Lanham Act, which was then still relatively new and unfamiliar. It took decades for the judiciary and the practicing bar to understand all the ways the Lanham Act changed the traditional rules of trademarks and unfair competition.

Since I had a degree in electrical engineering and had worked as an engineer for a while in the early days of the U.S. space program, I was pigeonholed as a "patent lawyer." I moved to California and in the early 1960s was practicing intellectual property law in San Francisco. As a young lawyer, I found it difficult to find

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\* Author of *McCarthy on Trademarks and Unfair Competition* (5th ed. 2023 rev.); Emeritus Member, International Trademark Association.

comprehensible answers to what I thought were basic questions about trademark law. Trademark treatises in that era were written in what is now viewed as an archaically formal and stilted style.

After a few years of practice, I went into teaching as an Assistant Professor at the University of San Francisco Law School.<sup>1</sup> I soon discovered that I loved teaching and legal writing. I had an idea that I could write a short reference book on trademark law but confined to California law. I approached Bancroft-Whitney, a law book publisher in San Francisco. They responded that a book on only California trademark law and cases was too narrow a subject to have a viable market. But they said that a related company had for many years been publishing a two-volume treatise on *Unfair Competition and Trademarks* (4th ed. 1947). This was authored by Harry Nims, a prominent New York City attorney who had recently died. Nims's estate would not authorize another author to continue his book. Would I be interested in writing from scratch a two-volume treatise as a successor to the Nims treatise, covering all of the same subject matter? This sounded like a monumental task, but I was young and ambitious and assured the publisher that I could accomplish it. I submitted some samples for a few parts of such a treatise and they were approved. I signed a publishing contract in 1970 with the Lawyers Co-Operative Publishing Co., located in Rochester, New York.

Then followed three years of intensive research and writing, written in those pre-computer days on a manual typewriter. After much work, I submitted to the publisher two volumes' worth of material and breathed a sigh of relief. The first edition was published in 1973 in two hard-bound volumes in brown covers with over 800 pages in each volume. Yearly supplements that followed were inserted as "pocket parts" at the back of each volume. Fast-forward fifty years, and with the explosion in statutory and case law, the treatise has grown to seven hard-copy volumes, updated quarterly.<sup>2</sup>

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<sup>1</sup> Note for non-U.S. readers: In Europe and many other nations, unlike in the United States, a teacher does not reach the status of "professor" until after many years of experience when a "professorial chair" is available. But in U.S. law schools, young teachers are not entitled "lecturers," but "Assistant Professors." To those unfamiliar with the U.S. system of academic titles, this can cause confusion.

<sup>2</sup> In addition to the trademark treatise, I also wrote *The Rights of Publicity and Privacy* (1st ed. 1987), now in a two-volume yearly updated edition (Thomson Reuters) and co-authored by Professor Roger Schechter of George Washington University. I also wrote *McCarthy's Desk Encyclopedia of Intellectual Property* (Bureau of National Affairs, 1st ed. 1991) with a 2004 third edition co-authored by Professor Roger Schechter and Professor David Franklyn that is now out of print.

### III. TEACHING, CONSULTING, AND RETIREMENT

As a result of the popularity of my treatise, a great many good things have happened to me. When I was teaching, I often served as a consultant in trademark law to corporations and law firms and was a frequent expert witness in infringement cases. As a result, I met many smart and interesting people across the nation and around the world. I made personal friendships that have lasted for decades. My expert witness work gave me the opportunity to observe and compare different litigating styles in different parts of the country. I recall that one of the first times I was called to testify, it was before a judge in federal court in San Francisco in a non-jury trial. I was sworn in and seated in the witness chair next to the judge, who was discussing with the attorneys if it was proper to let me testify. Finally, the judge turned to me and asked: "Professor, do you think I should let you testify?" I responded, "Your Honor, I believe it's within your discretion to hear my testimony." He said: "Yes, I agree. In my discretion, I decide not to hear your testimony. Please step down. Call the next witness."

Many times when I testified in a deposition or at trial, the attorney for the other side sought to show how my testimony was contradicted by a passage in my treatise. This showed me why I think it's often a mistake to try to trip up an expert witness by using that expert witness's writings. I knew every nook and cranny in my book that could explain any apparent discrepancy. Usually, I could easily respond in my testimony by referring to the treatise text on the next page that discussed an exception to the rule. It's as if in a criminal case you tried to dispute with a witness about the arrangement of rooms in a house that the witness had lived in for decades since childhood.

This brings to mind an amusing (and apocryphal) tale that has circulated among IP litigators about a professor testifying as an expert witness. Because of my electrical engineering background, I always imagined the professor in the story to be the legendary scientist Michael Faraday. The story goes that during a courtroom appearance, Professor Faraday, author of the highly regarded treatise *Faraday on Magnetism*, was being cross-examined at length by an aggressive lawyer who persistently attempted to show how Professor Faraday's testimony was inconsistent with a passage in his treatise. The witness patiently explained how the allegedly inconsistent sentence in his treatise was taken out of context by the attorney and was explained by nearby text. But the attorney would not relent and persisted in questioning on the same treatise passage for an unduly long time. Finally, the exasperated Professor Faraday said to the cross-examining attorney: "Counsel, hand me that copy of my treatise. I can easily put an end to this quibbling." He then proceeded to tear out the page that bore the passage in question and

handed the book lacking the torn page back to the attorney. “Here, counsel, is the newest edition of *Faraday on Magnetism*.”

On several occasions I testified as an expert witness in a jury trial. While it is true that jurors often are influenced by things we lawyers think are irrelevant, usually they are pretty sharp and perceptive about what’s going on in the trial. A case that stands out in my mind is my appearance at the 1988 jury trial in Houston, Texas, in the case of *Taco Cabana International, Inc. v. Two Pesos, Inc.* This case eventually ended up in the U.S. Supreme Court and became a standard in law school case books on intellectual property.<sup>3</sup> Plaintiff Taco Cabana had a chain of Tex-Mex restaurants, and the defendant copied the trade dress layout and appearance for use in its competing Two Pesos restaurants. The trade dress issues were whether the restaurant appearance was functional, if it required proof of a secondary meaning, if there was abandonment by licensing with a lack of quality control, and if there was infringement. I was called by Jim Gambrell, the attorney for the plaintiff, to testify to assist the jury to understand the complexities of these concepts. After several days of trial, Judge Singleton said I could take the stand. Soon after I was qualified as an expert, the judge became perturbed that the trial was dragging on too long. After only three or four substantive questions to me on direct by Jim Gambrell, the judge cut the examination short, saying, “OK, that’s enough from this witness, let’s move on here. This is taking too long.” An attorney for the defense rose to cross-examine me, but the judge motioned him to sit down and told me to get off the witness stand, which I speedily did.

After the jury found the defendant liable for trade dress infringement, plaintiff’s attorneys were able to interview some of the former jurors, and their feedback was illuminating. They were looking for a perpetrator and a victim. They didn’t like the idea of a competitor copying the distinctive appearance of a rival’s restaurant. That struck them as unfair. When the former jurors were asked about my curtailed testimony, one ex-juror said: “Oh, it didn’t bother us that the judge cut short Professor McCarthy’s testimony. We knew what he would have said.” In other words, what mattered to the jurors was not the details of what I would have said on the stand. What was significant was the fact that an expert in the field like me was willing to stand up in support of the plaintiff. It gave jurors a feeling of confidence that they would be doing the right thing if they found for the plaintiff.

In 2002, after thirty-six years in the classroom, I retired from teaching and became a Professor Emeritus. Thereafter, for twenty years until 2022, I was an Of Counsel consultant to the law firm of

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<sup>3</sup> *Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113 (5th Cir. 1991), *aff’d*, 505 U.S. 763 (1992).

Morrison & Foerster in its San Francisco office. My work there was varied and intellectually stimulating. My book remains a work-in-progress with revisions issued every three months. I continue to update, rewrite, and reorganize in order to make the material as accessible and understandable as possible.

#### IV. OBSERVATIONS ON A HALF CENTURY OF TRADEMARK LAW

Fifty years have seen an enormous number of changes in the world in general and in trademark law in particular. Some of those changes in trademark law that I see as most significant are discussed below.

##### *A. Trademarks or Unfair Competition or Both?*

The two-part title of my work *Trademarks and Unfair Competition* is a reversal of that of the treatise by Harry Nims—*Unfair Competition and Trademarks*. Even in my first edition, twenty-five years after the Lanham Act, the law still retained strong currents of this duality. Perhaps no term of art in this field of law has over the years provoked such a confusion of definitions as “unfair competition.”<sup>4</sup>

For decades before and after the Lanham Act, “trademark” law was viewed as the domain of only registered marks, while cases for infringement of unregistered marks were viewed as involving “unfair competition” law.<sup>5</sup> The two strands had different rules, with “unfair competition” law focusing on the unfairness of the defendant’s conduct, not on the validity of the plaintiff’s designation.<sup>6</sup> Passage of the Lanham Act provided the primary impetus to bring the two strands together with a common set of rules. But even so, this duality created an ambivalence in the law

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<sup>4</sup> As Professor Christine Haight Farley has noted: “There may be no term in all of intellectual property law as slippery as ‘unfair competition.’” *The Lost Unfair Competition Law*, 110 TMR 739, 740 (2020).

<sup>5</sup> See *id.*, 110 TMR at 746 (“The fact of registration was then a means of demarcating the subject matter of trademark and unfair competition law. Although the cases are less clear than this tidy division, technical trademark cases involved a property right protected by trademark law, whereas in unfair competition cases the complainant had no property interest in what was imitated.”).

<sup>6</sup> See Mark P. McKenna, *Property and Equity in Trademark Law*, 23 Marq. Intell. Prop. L. Rev. 117, 126 (2019) (“Unfair competition . . . cases by definition did not involve a property interest, so in determining whether any remedy should be given, courts were not concerned with identifying the thing the plaintiff owned. They were instead focused on the defendant’s *conduct*.”) (emphasis in original). In a further complication, a symbol in an “unfair competition” case was called a “trade name,” not a “trademark.” For example: *American Products Co. v. American Products Co.*, 42 F.2d 488, 489, (E.D. Mich. 1930) (“[T]his case involves a trade-name, not a trade-mark, and therefore is governed by the law of unfair competition, not that of trade-marks. . . .”).

that continues to this day. Today, attorneys and judges continue to label a claim for infringement of a registered mark as a “trademark” claim, while an accompanying claim for infringement of an unregistered mark is often denominated as one for “unfair competition.” But for all practical purposes, the rules of validity and infringement are the same. The main difference is that the owner of a registered mark benefits from several procedural and substantive advantages, such as a presumption of validity.

### ***B. The “Federalization” of the Law of Unregistered Trademarks***

A related development occurred in the courts in the 1960s and 1970s, just before the first edition of my treatise was published. Courts began to interpret Lanham Act Section 43(a), 15 U.S.C.A. § 1125(a), as the basis for a federal law claim for infringement of an unregistered mark. Within a few years, all courts adopted this view. This had the result of moving into the federal courts almost all cases for infringement of unregistered marks and trade dress. Throughout the nineteenth century and until the seventh decade of the twentieth century, state law was the sole legal basis for assertion of infringement of an unregistered trademark. Lacking diversity jurisdiction, the case had to be filed in a state court. As discussed above, the claim was labelled “unfair competition,” not “trademark infringement.”

This all changed with federal case law precedent holding that Section 43(a) of the Lanham Act could be the basis for assertion of a claim of infringement of an unregistered trademark or trade dress in a federal court. The statutory phrase “false designation of origin” was given a new interpretation. Previously thought to be limited to false claims of geographical “origin,” it was now interpreted as also covering false claims of commercial “origin.”<sup>7</sup> In other words, it included the likelihood of confusion by use of another’s trademark.<sup>8</sup>

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<sup>7</sup> See McCarthy, Trademarks and Unfair Competition, § 27:7 (5th ed. 2023 rev.) (“Section 43(a) was originally envisioned as a federal anti-false advertising statute, with emphasis on the ‘false description or representation’ language. The phrase ‘false designation of origin’ was thought to be limited to false advertising of geographic origin.”).

<sup>8</sup> One of the first courts to take this view and begin the trend was the Sixth Circuit in *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (6th Cir. 1963) (allegations of infringement of unregistered trade dress could be brought in federal court under Lanham Act Section 43(a). While the trial judge held that “origin” meant geographic origin, the court of appeals reversed. “[T]he word, ‘origin,’ in the Act does not merely refer to geographical origin, but also to origin of source or manufacture.”). Within a few years, more and more courts adopted this view. By 1972, Judge Gurfein in the Southern District of New York could state with certainty that a claim for infringement of an unregistered mark was a federal claim that could be brought in federal court. See *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1294, 173 U.S.P.Q. 346 (S.D.N.Y. 1972) (“Regarding the claim under the Lanham Act, it is not a prerequisite that the mark

Federal law and federal courts became the source of case law precedent on infringement of an unregistered trademark, service mark, trade name, or trade dress.<sup>9</sup> This meant that a claim for trademark infringement under state law filed in a state court became a rarity.<sup>10</sup> Effective in 1989, Congress put its stamp of approval on this trend by rewriting Section 43(a) to codify the existing case law. State trademark and unfair competition common law was effectively “federalized” by Lanham Act Section 43(a).<sup>11</sup>

### *C. The Internet Transforms the Way Goods and Services Are Sold*

I think many would agree that widespread use of the Internet has brought the most significant change in trademark law in the past half century. Of course, the Internet and widespread use of smartphones have had a huge impact on society in general. For trademarks and commerce, the Internet has created a truly global market of goods and services in which people in any nation can advertise and sell their goods and services to anyone anywhere. Every day, almost 5000 container ships ply the oceans, delivering vast amounts of products that were advertised, ordered, and sold on the Internet.

In developed nations, the Internet has changed the way that buyers and sellers interact. Websites such as Amazon present the buyer with a vast array of goods delivered to one’s home within days. Websites like Etsy give small, local artisans access to a global marketplace of buyers. Every one of the thousands of online sellers needs a brand to distinguish itself from the jostling crowd of merchants seeking buyers. Trademark conflicts with prior users become more common. Fewer trademarks are available. Trademark depletion and congestion make it harder to select a new

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be registered. . . . A claim for relief arises if the defendant affixes to the goods a false designation of origin or any false description or representation.”).

<sup>9</sup> See McCarthy, *Lanham Act § 43(a): The Sleeping Giant Is Now Wide Awake*, 59-SPG Law & Contemp. Probs. 45 (1996). For all practical purposes, the rules of validity and infringement for unregistered marks are now the same as for registered marks. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (Justice Stevens, concurring: “[T]he Court interprets this section as having created a federal cause of action for infringement of an unregistered trademark or trade dress and concludes that such a mark or dress should receive essentially the same protection as those that are registered. . . . I agree with the Court’s conclusion. . . .”).

<sup>10</sup> See *Two Pesos*, 505 U.S. at 782 n.16 (“The federal courts now decide, under federal law, all but a few trademark disputes. State trademark law and state courts are less influential than ever. Today the Lanham Act is the paramount source of trademark law in the United States, as interpreted almost exclusively by the federal courts.” Stevens, J., concurring in judgment and quoting *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TMR 375, 377 (1987)).

<sup>11</sup> See McCarthy, *Trademarks and Unfair Competition*, § 27:12 (5th ed. 2023 rev.).

commercially viable mark that does not conflict with a prior registered or unregistered mark.<sup>12</sup>

### ***D. Domain Name Disputes: The UDRP***

The appearance of domain names on the Internet led to new and different kinds of conflicts involving trademarks. Around the turn of the century, I created a new Chapter 25A in my treatise to collect in one place all of the new statutory and case law precedent dealing with the use and misuse of trademarks on the Internet. The Internet Corporation for Assigned Names and Numbers (“ICANN”) took over the domain name system and has added hundreds of new top-level domains. Around the turn of the century, ICANN adopted a new Uniform Domain-Name Dispute-Resolution Policy (“UDRP”) to deal with cybersquatting. This led to the creation of a completely new kind of global and quasi-arbitration body of law. It also led to the creation of a new body of U.S. precedent when the loser of a UDRP decision seeks review in an American court. Courts soon held that the UDRP was not like binding formal arbitration and UDRP decisions are not subject to the federal Arbitration Act. This means that U.S. courts give UDRP decisions no deference: the case is reviewed *de novo* by the U.S. federal court judge.

### ***E. Domain Name Disputes: The ACPA***

Another new body of Internet law was created when, in 1999, Congress enacted the ACPA—the Anti-Cybersquatting Protection Act. This amended the Lanham Act to prohibit various forms of “cybersquatting” or “cyber-piracy” by the use of domain names that are confusingly similar to trademarks and persons’ names. As the Ninth Circuit commented, the prototypical type of cybersquatting “is the Internet version of a land grab. Cybersquatters register well-known brand names as Internet domain names in order to force the rightful owners of the marks to pay for the right to engage in electronic commerce under their own name.”<sup>13</sup> In addition, the ACPA immunized a domain name registrar from monetary and injunctive relief for registering an infringing domain name and for most actions in the implementation of a policy such as the UDRP. Because the ACPA also allowed *in rem* jurisdiction, many

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<sup>12</sup> Barton Beebe and Jeanne Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 Harv. L. Rev. 945, 948 (2018) (arguing that word mark depletion and congestion “are increasing and have reached chronic levels.”).

<sup>13</sup> *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 946 (9th Cir. 2002) (the defendant was found not to violate the ACPA). See *JYSK Bed’N Linen v. Dutta-Roy*, 810 F.3d 767, 775 (11th Cir. 2015) (“The ACPA was enacted to prevent cybersquatting. . . . Cybersquatting is essentially extortion . . . the cybersquatter muddies the clear pool of the trademark owner’s goodwill and then profits off the resulting murkiness.”).



international domain name disputes could be litigated in a U.S. court.<sup>14</sup>

### *F. The Impact of U.S. Supreme Court Cases on Trademark Law*

Some have asked me which of the U.S. Supreme Court trademark cases over the past half century I think are the most important. I can identify twenty-three Supreme Court cases in the past fifty years that have involved substantive Lanham Act issues in some way.

Trademark aficionados know that the Supreme Court takes very few cases involving Lanham Act trademark and false advertising issues. Sometimes years pass with no relevant Supreme Court decision on point.<sup>15</sup> Supreme Court trademark decisions are not like the Court's groundbreaking decisions on constitutional issues that grab the headlines of mainstream media. Few, if any, Supreme Court trademark cases have had this kind of significant impact and lasting influence. Almost all have involved relatively peripheral issues, and in those cases the decisions have made only marginal changes in the law. The Supreme Court in the intellectual property field shuns bright line rules in favor of vague guidelines that require multiple fact-specific questions to be resolved. This makes IP law more unpredictable and uncertain. If everything is relevant, then nothing is determinative. The result is that attorneys can provide fewer clear answers to clients as to what are the rules of law. This, I think, raises the expense of intellectual property litigation and favors the deep-pocket entrenched competitor over the recent entrant with a new brand. This is not good for an efficient competitive economy.

However, I do think that two decisions of the Supreme Court in this field may well have a substantial and perhaps long-lasting impact on trademark law. That is the duo of cases in 2017 and 2019 that held two related parts of the Lanham Act to be void and

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<sup>14</sup> The Prudential Ins. Co. of Am. v. Shenzhen Stone Network Info. Ltd., 58 F.4th 785, 794 (4th Cir. 2023) (court found *in rem* jurisdiction and affirmed summary judgment of violation of the ACPA by a domain name owner located in China. *Note:* The Eastern District of Virginia is the location of VeriSign, the domain name registry for the .com domain.).

<sup>15</sup> For example, for the six-year interval from the 1995 decision in *Qualitex* to the 2001 decision in *TrafFix*, I'm not aware of any substantive trademark decision by the high court. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995); *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

unconstitutional. In both *Matal v. Tam*<sup>16</sup> and *Iancu v. Brunetti*,<sup>17</sup> the high court held that parts of the Lanham Act that denied registration to certain types of marks were in conflict with the principles of free speech protected by the First Amendment. This was the first time in the seventy years since the Lanham Act became law that free speech was held to present such a direct clash with trademark law. I feel that this can lead in the future to a series of free speech challenges to other provisions of the Lanham Act. For example, already the Federal Circuit has used these cases to hold that Lanham Act Section 2(c), prohibiting the registration of the name of a living person without that person's consent, was in conflict with the First Amendment.<sup>18</sup> In 2023, the Supreme Court cut back on the use of the *Rogers v. Grimaldi*<sup>19</sup> special test of infringement used to balance free speech with an accused use of a mark in an "expressive" work.<sup>20</sup>

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<sup>16</sup> *Matal v. Tam*, 582 U.S. 218 (2017) (the case concerned the USPTO's rejection of the mark THE SLANTS for a musical group as being disparaging to persons of Asian descent. One of the prohibitions on registration in Lanham Act Section 2(a), 15 U.S.C.A. § 1052(a), is the ground that the mark "may disparage . . . persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute." All eight voting judges agreed that the disparagement clause was unconstitutional. All those Justices agreed that a trademark is a form of free speech within the First Amendment and that the disparagement bar was a form of viewpoint discrimination by the government that offended a basic principle of free speech).

<sup>17</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). One of the prohibitions on registration listed in Lanham Act Section 2(a), 15 U.S.C.A. § 1052(a), is the ground that the mark "comprises immoral . . . or scandalous matter." The primary use of this statutory bar in the 1947–2017 era was to reject applications for words or images with an offensive or sexual connotation. In this case, the USPTO rejected the application for FUCT for wearing apparel. The Supreme Court held that the "immoral" and "scandalous" statutory bars were unconstitutional. They were in violation of the free speech provisions of the First Amendment because they discriminated on the basis of viewpoint. The applicant in the *Brunetti* decision later applied to register the word FUCK for various goods and services such as jewelry and carrying cases. The Trademark Board affirmed rejection on the ground that it was "merely informational" and failed to function as a trademark. *In re Erik Brunetti*, 2022 U.S.P.Q.2d 764, 2022 WL 3644733 (T.T.A.B. 2022), *reconsideration denied* (T.T.A.B. Dec. 15, 2022).

<sup>18</sup> *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022) (holding that the First Amendment prohibited the United States Patent and Trademark Office from rejecting the application for TRUMP TOO SMALL for T-shirts based on Lanham Act Section 2(c), 15 U.S.C.A. § 1052(c), because it included the name of Donald J. Trump, a living person, without his consent. The Federal Circuit said that the phrase was protected as free speech by the First Amendment as a criticism of a public official. While the court mentioned the Supreme Court's *Tam* and *Brunetti* viewpoint discrimination decisions, the court admitted that the *Elster* case did not involve viewpoint discrimination. Nevertheless, the court held that free speech was impermissibly restricted because Section 2(c) "involves content-based discrimination.") The Supreme Court will hear this case in its upcoming term. *See Vidal v. Elster, cert. granted*, June 5, 2023 (No. 22-704).

<sup>19</sup> 875 F.2d 994 (2d Cir. 1989).

<sup>20</sup> *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 143 S. Ct. 1578 (2023).

### *G. Trademark Dilution: Theory and Law*

A significant change in the law over the past fifty years occurred with the adoption in the United States of a federal law prohibiting the “dilution” of a trademark. Until the enactment in 1996 of the first federal anti-dilution statute, trademark dilution was a largely theoretical concept. When I wrote my first edition fifty years ago, only a few states had an anti-dilution provision and there were few cases. In the early 1990s, members of the International Trademark Association felt that they needed a larger area of exclusivity for their marks, which was not provided by the traditional likelihood of confusion test. This resulted in the 1996 federal anti-dilution law, which, with its 2006 revision, gave rise to a substantial number of cases that were accompanied by a torrent of legal commentary. Numerous lawyers, judges, and professors, including myself, have written many (probably far too many) words trying to understand the meaning and impact of the federal anti-dilution laws.

Trademark dilution theorizes that a junior user’s unpermitted use of a famous mark on unrelated goods or services that are not likely to cause confusion can still cause a weakening or reduction in the ability of a famous mark to distinguish only one source.<sup>21</sup> Because it is mainly a theoretical and abstract concept, the theory of injury to a trademark by “dilution” is exceedingly difficult to explain and understand. Traditional trademark infringement caused by a likelihood of confusion over source, sponsorship, or association is a relatively simple and intuitive concept to explain and understand. By comparison, dilutive injury to a famous mark caused by a non-confusing use is an elusive and indefinable concept, difficult to explain. Misunderstanding is rampant. No group of trademark experts can agree on a coherent definition of dilution by blurring. Most academic commentators (including myself) are highly critical of the argument that trademark “dilution” should be prohibited by law.<sup>22</sup>

Unlike its European counterpart, the United States dilution law is not a “free-riding” law. The U.S. anti-dilution law solely prohibits the likelihood of dilutive *injury* to a famous mark. That is, the law requires proof of a likelihood of impairment of the distinctiveness of

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<sup>21</sup> United States adoption of the theory of trademark dilution is usually traced back to the writings almost a hundred years ago of New York attorney Frank Schechter. Schechter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 831 (1927), *reprinted in* 60 TMR 334 (1970). But what Schechter proposed was far afield from the federal legislation of today. See McCarthy, Trademarks and Unfair Competition, § 24:67.

<sup>22</sup> Academic commentators almost uniformly contend that dilution by blurring is a theoretical hypothesis and rarely, if ever, happens in the real world. That is, the argument is that impairment of the distinctiveness of a trademark by blurring without confusion is like Bigfoot, the Himalayan Yeti, or the Loch Ness Monster: a theoretical construct never proven to exist by incontrovertible evidence. See McCarthy, Trademarks and Unfair Competition, § 24:115.

the famous mark. The present Trademark Dilution Revision Act (“TDRA”) is not an “anti-free-riding” law. Yet, the Trademark Trial and Appeal Board and some courts read the statute as if it were an “anti-free-riding” law. They do this by ignoring the statutory requirement that the accused mark “impairs the definitiveness of the famous mark.”<sup>23</sup> The Trademark Board has consistently expanded the scope of the anti-dilution law by making the erroneous assumption that if the accused mark is so similar that there is “association” (it calls to mind the famous mark), then there must be a likelihood of impairment (damage) to the famous mark.<sup>24</sup>

By creating the potential for a trademark “right in gross” making a famous trademark a commercially taboo or forbidden term, dilution law has the potential to create a sweeping right of exclusivity. If aggressively enforced, dilution law has the ability to prevent use of a word or image that cannot be used in a trademark sense on any goods or services. This upsets the delicate balance between free competition and fair competition. One danger is that overly aggressive attorneys can use the anti-dilution law to expansively enforce their client’s mark that is not “famous” by any stretch of the imagination. The invocation of “dilution” can be abused to scare a small business owner into stopping use of a mark on wholly unrelated goods and services. While at present the dilution theory remains in the background of the law, it’s like a sleeping monster that without warning awakes and causes havoc.

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<sup>23</sup> 15 U.S.C.A. § 1125(c)(2)(B). See McCarthy, Trademarks and Unfair Competition, § 24:100. The Trademark Board seems to be much more fond of the anti-dilution law than are the courts. On occasion, the Trademark Board simply ignores traditional likelihood of confusion law altogether and goes directly to the anti-dilution law to resolve a case. *Sony Grp. Corp. v. Campbell*, 2022 WL 16632963, \*28 (T.T.A.B. 2022) (non-precedential. Pro se applicant’s SONISTREAM would be likely to impair the distinctiveness of opposer’s famous SONY mark. “We sustain the opposition on the basis of Opposer’s dilution claim and do not reach its likelihood of confusion claim.”)

<sup>24</sup> The Supreme Court in the *Moseley* case made it clear that “association” does not necessarily result in “impairment” of the famous mark: “[T]he mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient to establish actionable dilution. . . . [S]uch mental association will not necessarily reduce the capacity of the famous mark to identify the goods of its owner, the statutory requirement for dilution under the FTDA.” *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003). See *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 439, (S.D.N.Y. 2016), *judgment aff’d*, 674 Fed. App’x 16 (2d Cir. 2016) (“Significantly, it is not enough to show—as Louis Vuitton indisputably can—that members of the public are likely to ‘associate’ the defendant’s mark with the plaintiff’s mark (or that the defendant promotes such association). . . . [T]he operative question is whether the kind of association [defendant] creates here is likely to impair the distinctiveness of Louis Vuitton’s marks.” No dilution was found by a parody of Louis Vuitton handbags.)

### *H. Counterfeiting*

Counterfeiting remains an enormous problem. Over the past fifty years, it has steadily increased across the globe.<sup>25</sup> While popular media emphasizes the counterfeiting of high-fashion brands, I think that counterfeit pharmaceuticals, aircraft and vehicle parts, and electronic chips are much more dangerous and threatening.<sup>26</sup> Those sorts of counterfeits of inferior quality present a real danger of death and destruction. For example, the world relies on seamless communication by ever more complex electronic devices, many parts of which are easily counterfeited.<sup>27</sup>

I think the only solutions to the counterfeiting crisis are education and enforcement. The counterfeiters and the courts know what the rules of law are. But too many consumers think counterfeiting is harmless. The Internet has increased the amount of counterfeiting and made detection and enforcement even more difficult. U.S. courts are presented with difficult issues of how to notify and bring to court counterfeiters in other nations.<sup>28</sup>

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<sup>25</sup> See McCarthy, Trademarks and Unfair Competition, § 25:10 (5th ed. 2023 rev.) (noting that a report commissioned by the International Chamber of Commerce indicated that the global economic value of counterfeiting and piracy could reach US \$2.3 trillion by 2022. Counterfeiting is valued as the most lucrative transnational crime, followed by drug trafficking.).

<sup>26</sup> *Lifetime Achievement Award: J Thomas McCarthy*, World Trademark Rev. (June 29, 2018), <https://www.worldtrademarkreview.com/article/lifetime-achievement-award-j-thomas-mccarthy>.

<sup>27</sup> An investigation initiated by the Senate Armed Services Committee found clear evidence of large numbers of counterfeit electronic parts in critical military defense systems. Report of the Senate Committee on Armed Services, Inquiry into Counterfeit Electronic Parts in the Department of Defense Supply Chain, May 21, 2012 (112th Congress, 2d Sess.), available at <https://www.armed-services.senate.gov/imo/media/doc/Counterfeit-Electronic-Parts.pdf>.

The Institute of Electrical and Electronic Engineers reported in 2021 that counterfeit electronics are a threat “because they can reduce the reliability of safety-critical systems and can make even ordinary consumer electronics dangerous,” citing evidence that cellphones and e-cigarettes have blown up in the user’s face because of counterfeit batteries. Roozbeh Tabrizian and Swarup Bhunia, *How Nanotech Can Foil Counterfeiters*, IEEE Spectrum 34 (June 2021), available at <https://spectrum.ieee.org/how-nanotech-can-foil-counterfeiters>.

<sup>28</sup> Serving process on an alleged Internet counterfeiter located in another nation has presented vexing issues to U.S. courts. Use of the Hague Convention is clumsy, time-consuming, and ineffective. Several U.S. judges have ruled that service of process by e-mail is acceptable. See *Viahart, L.L.C. v. GangPeng*, No. 21-40166, 2022 WL 445161 (5th Cir. Feb. 14, 2022) (plaintiff sued several defendants located in China for trademark infringement and counterfeiting of products sold on online marketplaces. A default judgment was affirmed. “Because the magistrate judge ordered email service through [Federal Rule of Civil Proc. § 4 (f)(3)] and that was reasonably calculated to notify [the defendants in China], service was proper.”); *Kelly Toys Holdings, LLC v. Top Dep’t Store*, 2022 WL 3701216, \*7 (S.D.N.Y. 2022) (The plaintiff’s efforts to locate defendants’ physical addresses in China were reasonably diligent. The inability of those efforts to identify defendants’ addresses made them “not known” for the purposes of the Hague Convention. Service by e-mail in this counterfeiting case was proper.).

### *I. Trademarks in a Global Market*

Over the past fifty years, we've seen a vast increase in transnational commerce. This puts increasing pressure on the basic rule of the territoriality of trademark rights. Under the territoriality doctrine, "a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark."<sup>29</sup> American courts have struggled to deal with the situation where the plaintiff owned a mark abroad but not in the United States and sought to prevent use or registration of the mark by another who was the first to use in the United States.<sup>30</sup> The territoriality principle has been criticized as obsolete in an Internet-connected world where goods and services can be ordered from a vendor anywhere on the globe with the click of a mouse.

In the twenty-first century world of interconnected commerce, it seems archaic and quaint that a trademark has a separate existence in each nation. The territoriality doctrine means that a global trader must register and prove its trademark rights separately in each nation in which it sells. This raises the costs of doing business abroad. Of course, the Paris Convention has for many years facilitated registering a trademark in other nations. The underlying principle of the Convention is that foreign nationals should be given the same treatment in each of the member nations as that nation gives to its own citizens. By reducing some of the difficulties of obtaining registration in other nations, the Madrid Protocol helps to remove trade barriers and facilitates free trade.

One thing that could significantly facilitate trade and lower barriers would be to reduce the differences among nations in the rules for trademark registration and enforcement. While much has already been done in the form of international agreements, a great deal more is needed. The United States retains a first-to-use priority system, which differs from the first-to-register system used in almost all other nations. But I cannot see that difference being reconciled in the near future.

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<sup>29</sup> *Buti v. Impresa Perosa, S.R.L.*, 935 F. Supp. 458, 460 (S.D.N.Y. 1996), *aff'd*, 139 F.3d 98 (2d Cir. 1998).

<sup>30</sup> *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016) (holding that a plaintiff like Bayer who owned trademark rights only abroad and not in the United States has standing to bring claims under both Lanham Act Sections 43(a) and 14(3) against a defendant like Belmora, who was a senior user in the United States and owned a U.S. registration for the same mark for the same goods. The court made no mention of the territoriality principle.); *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067 (Fed. Cir. 2022) (Coca-Cola owned the marks THUMS UP and LIMCA for beverages in India but did not use or register the marks in the United States. The Federal Circuit reversed the Trademark Board's decision in which the Board relied on the *Belmora* decision to cancel registrations of the soft drink marks THUMS UP and LIMCA owned by Meenaxi. The Federal Circuit's majority decision discussed the territoriality doctrine but avoided a split of authority with the Fourth Circuit. The Federal Circuit based its decision on the failure of Coca-Cola to prove that it suffered harm in the United States.).

## V. CONCLUSION

Like almost every trademark practitioner and teacher, I find the field of trademark law to be immensely interesting and intellectually challenging. Nothing stays the same for long. The law must continually keep up with the increasing pace of technological innovation and seismic changes in the way goods and services are bought and sold. As artificial intelligence looms on the horizon, I'm sure that the need for the law to change and adapt will continue into the foreseeable future.

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## BOOK REVIEW

By *Elisabeth Kasznar Fekete*\*

**Artificial Intelligence and Intellectual Property.** Jyh-An Lee, Reto M. Hilty, and Kung-Chung Liu, eds. 2021. Pp. 449. \$120. Oxford University Press, Great Clarendon Street, Oxford, OX2 6DP, United Kingdom.

While technology continues to impact our daily routine in an increasingly accelerated manner, programming capabilities, language models, and mathematical command systems are trying to recreate human intelligence by developing abilities capable of identifying standards in data compilations—and these efforts are already producing and promising even greater and faster developments. The evolution of artificial intelligence (“AI”) facilitates access to data, automating not only mechanical but also cognitive tasks, and creates ever more available information as well as technological solutions in the social, legal, economic, human resources, and business arenas. At the same time, substantial challenges are generated by AI “neural nets” (i.e., “neural networks”) in all fields. Intellectual property (“IP”) lawmakers and professionals have been raising significant questions, such as the following: (i) who is the inventor of innovations or the creator of artistic, literary, dramatic, musical, or scientific works developed using generative AI; (ii) to what extent are data privacy rights preserved in new automation technology scenarios; and (iii) how might the prosecution and enforcement of intellectual property rights (“IPRs”) be affected.

Addressing these questions and many others of high complexity through reflections on the transformation, impact analysis, and studies of current and future models, *Artificial Intelligence and Intellectual Property* compiles nineteen interconnected chapters in seven parts. The book is written by twenty-five authors, who are scientific researchers from various countries, such as Brazil, China, Germany, Japan, Saudi Arabia, Singapore, Switzerland, Taiwan, the United Kingdom (the “UK”), and the United States. With undeniable expertise and a large variety of experiences as law professors, lawyers, physicians, computer science specialists, technology law consultants, and more, the contributors approach the subject matter with a broad diversity of perspectives on the

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influence of AI in the IP field. The authors' ongoing points of discussion will be, if not summarized, at least briefly referred to in this review.

Despite the limitations faced by any analysis of the matter in view of the constant development of new AI technologies, the well-constructed chapters bring to the reader an enriched perspective of the rationale behind the impacts of AI use that already exist or that are or expected to affect the categories of IP law, among which the book addresses patents, trademarks, and copyrights. The book also addresses the ramifications of the issues involved on software, unfair competition, antitrust law, and database protection.

Because the book is the result of cooperative work between Asian and European academic institutions, it does not aim to highlight any particular jurisdiction. According to its editors, although it “might have distinctly Asian and European touches,”<sup>1</sup> the authors' purpose is “to elucidate the general challenges and opportunities faced by every jurisdiction in the era of AI.”<sup>2</sup> In sum, since the matter is debated in the book under a dynamic international dimension, the reader is invited to reflect on the rationale of the repercussions of AI, including AI's social impacts and its impacts on investments. The reader is also invited to learn how to strategically use AI.

The road map promised in the editors' introduction—“Roadmap to AI and Intellectual Property: An Introduction”—is provided along the way by research exploring three main themes that unify the chapters by setting out common essential lines of observation:

- (i) the innovation capability increased by AI and how IP creations are positively affected by automation;
- (ii) the increase of negative repercussions faced by the use of AI, such as the availability and dissemination of products subject to protection by IPRs, creating an opportunity for the proliferation of counterfeit works implemented through AI; and
- (iii) solutions for IP-related issues involving AI, such as the lack of specific regulations for its implementation regarding technological and artistic creations in some jurisdictions.

Part I of the book is entitled “Technology, Business, and Basics of AI.” In “Technical Elements of Machine Learning for Intellectual Property Law” (Chapter 1), Anthony Man-Cho So helpfully provides basic knowledge on learning or self-correction patterns—a capability known as “machine learning” (“ML”)—with a view to

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<sup>1</sup> Artificial Intelligence and Intellectual Property 1 (Jyh-An Lee, Reto M. Hilty, and Kung-Chung Liu, eds., 2021).

<sup>2</sup> *Id.*

“facilitate the legal discussions on IP issues.”<sup>3</sup> This chapter is particularly useful to readers without an information technology background. For instance, the “overview of key concepts and constructions in ML”<sup>4</sup> that Man-Cho So presents in his foundational chapter helps explain “the ways human efforts are involved in the development of ML solutions.”<sup>5</sup> Man-Cho So also explains the scenario of a data-centered economy created by AI-operated software, which counterpoints traditional computer programs that are not capable of ML.

The next two chapters of Part I discuss the fundamentals of AI and how it functions, offering examples of its application in specific areas that demonstrate the importance and versatility of the role AI software can play in improving the human experience in many fields. One of the areas most affected by AI is healthcare. In that field, AI has positively influenced patient experience both in preventative and recovery measures. As Ivan Khoo Yi and Andrew Fang Hao Sen discuss in “The Rise and Application of AI in Healthcare” (Chapter 2), AI applications often make use of large amounts of data, obtained over many years. These large data sets (known as “Big Data”) have helped physicians carry out complex tasks, such as diagnoses, calculations of risk probabilities, and even surgeries—feats that only a few years ago were inconceivable. Nevertheless, AI has been used in medicine cautiously, given that it faces short-, medium-, and long-term risks regarding drugs, treatment of patients, and other issues, such as risk of distribution shift, insensitivity to impact, black box decision-making, cybercrime risk, and lack of a fail-safe, raising voices of concern, as the authors explain.

Completing Part I by addressing the foundations underlying the social, business, and economic aspects of innovation and AI’s impacts on IP, Reto M. Hilty, Jörg Hoffmann, and Stefan Scheuerer examine the “Intellectual Property Justification for AI” (Chapter 3).

Part II, entitled “Artificial Intelligence and Patent Law,” analyzes AI and its creations from the perspective of patent rights, starting with Raphael Zingg’s “Foundational Patents in AI” (Chapter 4), addressing, with tables summarizing statistics, the increasing AI patenting trend and triadic AI patents by country as well as patent eligibility requirements. One of the issues mentioned refers to patent trolls, the colloquial term for “patent enforcement entities that do not invest in bringing technology to the market via the acquired invention. Rather, they amass patent portfolios for the sole purpose of generating revenue by prosecuting infringement.”<sup>6</sup>

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<sup>3</sup> *Id.* at 11.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* at 78.

This is followed by Ichiro Nakayama's "Patentability and PHOSITA in the AI Era—A Japanese Perspective" (Chapter 5). Nakayama discusses how AI impacts society and distinguishes "AI-assisted inventions"<sup>7</sup> from "inventions of AI technologies."<sup>8</sup> Nakayama further points out that AI would create inventions more easily, thereby raising the level of the inventive step. Part II highlights the problems of maintaining an outdated patent protection system, which could reduce the number of patent applications by disincentivizing human inventors due to AI's facility to rapidly generate content, while the effects of blockchain and AI throughout the patent prosecution are studied in "Digitalized Invention, Decentralized Patent System: The Impact of Blockchain and AI on the Patent Prosecution" (Chapter 6), in which Feroz Ali addresses patent office transformation, machine prosecution, and decentralization issues.

Part III, entitled "Artificial Intelligence and Copyright Law," focuses on copyright law and when it should apply to creative works generated by or with AI. Andres Guadamuz, author of "Do Androids Dream of Electric Copyright? Comparative Analysis of Originality in AI Generated Works" (Chapter 7), touches upon his line of research on the legal ownership system of AI-generated works and on creativity and originality standards in the UK and in the EU. The chapter discusses, for instance, that in the UK a "computer-generated work"<sup>9</sup>—one that is created by AI—is deemed to lack creative input, and thus would fall outside of the creativity and originality requirements for granting such a work copyright protection.

The subject matter of AI and copyrights, with their multiple relationships—but also boundaries—vis-à-vis data-in-mind, receives further attention in three other cohesive chapters (Chapters 8–10, respectively): "Computer-generated Works under the CDPA 1988," by Jyh-An Lee; "Copyright Exceptions Reform and AI Data Analysis in China: A Modest Proposal," by Tianxiang He; and "A Taxonomy of Training Data: Disentangling the Mismatched Rights, Remedies, and Rationales for Restricting Machine Learning," by Benjamin Sobel.

Part IV, entitled "AI and IP Administration," captures the impact of AI on IP management. It begins with "Patent Examination of AI-related Inventions: An Overview of China" (Chapter 11), by Jianchen Liu and Ming Liu, which summarizes the experience in China of the major changes affecting the patent-granting process due to the transformations made by AI in the invention workflow. In "AI and Trademark Assessment" (Chapter 12), Anke Moerland

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<sup>7</sup> *Id.* at 99.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 157.

and Conrado Freitas discuss the possibility of using AI for trademark assessment—mainly, the limits faced by AI technologies when a more subjective analysis of signs is required. From their tests, Moerland and Freitas conclude that the current AI technologies used by governmental IP offices perform only simple tasks, such as searching prior registered signs, image recognition and comparison, and classification of goods and services, but they perform no examinations that involve complex and subjective examination.

An analogous issue—using AI for trademark infringement assessment (in particular, the limits faced by AI technologies when a more subjective analysis is required)—is addressed by Daniel Seng under a catchily titled section (Chapter 13)—“Detecting and Prosecuting IP Infringement with AI: Can the AI Genie Repulse the Forty Counterfeit Thieves of Alibaba?”—which tackles the use of AI to detect violations. As emphasized by the author, the methods that electronically search, capture, and report undue use of proprietary trademarks in online markets as well as the automated takedown systems of counterfeit products play an important role in policing platforms that advertise and provide e-commerce where such merchandise, listings, or content can be found. However, AI technologies still have many limitations, such as a lack of transparency, system errors, and ML operation inconsistencies. Essentially, Seng’s chapter discussing the use of automated enforcement systems, both as exposed to favorable improvements and to functional difficulties, is appreciative of trademark owner needs in a context of growing online piracy.

In Part V, entitled “Legal Aspects of Software,” Hao-Yun Chen and Peter R. Slowinski, respective authors of Chapters 14 (“Copyright Protection for Software 2.0? Rethinking the Justification of Software Protection under Copyright Law”) and 15 (“Rethinking Software Protection”), raise the need to rethink how copyright law applies to software, introducing particularities concerning software 2.0, ML, and evolutionary algorithms. These two chapters highlight the unique challenges of protecting AI applications through IPRs and suggest that trade secrets may offer better protection in some cases than copyright law.

Part VI, entitled “Protection of and Access to Data,” offers observations first by Kung-Chung Liu and Shufeng Zheng. In “Protection of and Access to Relevant Data—General Issues” (Chapter 16), Liu and Zheng provide an overview of the challenges faced by companies to access data and to protect it. In “Protection of and Access to Data under European Law” (Chapter 17), Matthias Leistner focuses on the same topic under European Union (“EU”) law, addressing three aspects: the infrastructural framework of access to data, the protection of databases, and the existing *sui generis* protection regime for databases under the EU’s Directive

96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.

Part VII, entitled “The Bigger Picture,” sheds light on the role that AI plays in the fourth industrial revolution, given that AI can detect patterns in data in a way that is not yet possible for humans—with no need for rest, completing tasks in record time and frequently with an outstanding level of quality. These and other aspects are discussed in “Competition and IP Policy for AI—Socio-economic Aspects of Innovation,” by Anselm Kamperman Sanders (Chapter 18). Against this background and considering how AI will reshape innovation, prosecution, and enforcement of IP rights, it is fair to question whether AI could be recognized as a separate, autonomous legal entity, as is done by Eliza Mik in the final chapter of the book—“AI as a Legal Person?” (Chapter 19)—in which she analyzes focal points concerning demystification and autonomy of computer creativity, while studying the issue of “granting legal personhood to an AI in the context of IP law.”<sup>10</sup>

Although many rapidly evolving advancements have been made in AI technologies following the book’s publication in 2021, such as ChatGPT, its subject matter remains current because the concepts discussed are still relevant. While recognizing that AI is developing and will continue to develop, each chapter opens questions to paradigms of the future, not intended (as referenced above) to settle responses to legal regimes of specific jurisdictions but rather to pose general questions, exchange experiences, and provide insights—for instance, on why “competition authorities will have to provide the necessary regulatory oversight”<sup>11</sup> of platform providers in respect of data sets used to train neural networks (AI) and on how AI enables new models of creativity and innovation, such as “co-created IP contents.”<sup>12</sup>

These topics are addressed along with a large series of complexities of the potential or actual changes produced by automation progress within the framework of IP. Ease of consultation is provided at the end of the book by a detailed A–Z index that scores high in relevant searchability of this collective work’s expressive content.

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<sup>10</sup> *Id.* at 438.

<sup>11</sup> *Id.* at 418.

<sup>12</sup> *Id.* at 417.

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