Dispute Over KIVA Trademark Continues to Smolder

January 9, 2020 – The TMCA
by Evan Everist

A dispute over the trademark KIVA involving use of the mark with health food and cannabis continues to smolder in the Northern District of California.

In late 2018, Kiva Health Brands (a national health food and supplements company) sued Kiva Brands (a company selling cannabis-infused edibles in California) under federal and state trademark law. Kiva Brands answered with a number of affirmative defenses (including prior use of the mark and laches) and its own federal and state trademark claims based on alleged prior use of the KIVA mark in California. In late 2019, the Court granted Kiva Health Brands' motion to dismiss Kiva Brands' federal trademark counterclaims. It ruled that Kiva Brands cannot assert federal trademark rights (even unregistered rights) because Kiva Brands sells federally illegal products and unlawful use cannot form the basis of a valid federal trademark claim.

The parties both moved for summary judgment in late 2019 related to Kiva Brands' various affirmative defenses and recently filed response briefs on January 3, 2020. Kiva

Related People

- Evan Everist

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Health Brands argues it should prevail against Kiva Brands' prior-use affirmative defense given the Court's prior ruling that Kiva Brands cannot offensively assert any federal trademark rights. Kiva Health Brands claims that, "where a mark is used for cannabis products, the [federal trademark law] does not recognize those 'rights' for a federal registration or for any other purpose." It also contends that any state trademark rights held by Kiva Brands would be preempted by Kiva Health Brands' federally registered rights - although Kiva Health Brands still has not sought dismissal or summary judgment on Kiva Brands' state trademark claims.

For its part, Kiva Brands requests summary judgment on its laches defense, asserting that Kiva Health Brands unreasonably delayed in filing suit, which resulted in significant prejudice to Kiva Brands. Kiva Brands claims that, under pertinent case law, Kiva Health Brands had only two or three years to bring its claim, while Kiva Health Brands claims it had at least four years and filed within that window.

Dorsey will continue to monitor the progress of this case, which has provided helpful insights into trademark disputes involving cannabis, especially the potential limitations of common law trademark rights for such products.