

INTA in Sunny San Diego: A Quick Wrap-Up

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by Jeffrey R. Cadwell, Cathy Dahl, Catherine Parrish Lake, Sarah Robertson, Fara Sunderji, Janet Wong, and Evan Everist



Photo by Sarah Robertson

Related People

- Jeffrey R. Cadwell
- Cathy Dahl
- Catherine Parrish Lake
- Sarah Robertson
- Fara Sunderji
- Janet Wong
- Evan Everist

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

The Dorsey Trademark, Copyright + Advertising team is back from the 2025 International Trademark Association Meeting. It was one for the books. We mixed and mingled with old and new colleagues and as well as our friends from around the world. In between all the meetings and social events, we did manage to attend a few of the important panels and of course, our committee meetings. Here are the highlights:

- **AI-Driven Advertising:** Copyright Issues in the New Frontier – This was a lively and engaging panel that focused on managing the chaos that the burgeoning use of AI by companies and independent contractors has caused relating to ownership and authorship of AI-created content. The panel several times reiterated the mantra: Be Fair, Be Bold, Be Reasonable. They encouraged companies to ask whether they actually need to own the content that is created. They also discussed contract clauses “from the wild” and pointed out what works and what can be unreasonable.

The most important takeaway was to make sure that whoever is using AI to create content is documenting the process carefully, regardless of whether it is a vendor or an employee. This is because the Copyright Office will require an explanation as to the use of AI to determine whether, and how much of, a work is registrable.

- **USPTO Update:** Fireside Chat with Acting Under Secretary of Commerce for Intellectual Property and USPTO Acting Director Coke Morgan Stewart – Acting Director Stewart answered questions about the PTO's direction under the current administration. She indicated that the USPTO has explained to the administration that as a fee generating agency – rather than a taxpayer funded agency – the USPTO should not be subject to current cost-cutting measures. Despite this, Acting Director Stewart believes the agency can continue to reduce pendency and maintain quality without filing open positions. She also indicated the USPTO is looking into the use of AI to help with review of design marks and to detect fraud. Our neighbors to the North, the Canadian Intellectual Property Office (CIPO), also provided updates about the examination process and efficiency, indicating that they hoped to clear their backlog in just a few months.
- **Greenwashing, Greenhushing and Sustainably:** INTA's Brands and Sustainability Committee met at this year's conference to discuss the hot topics of greenwashing and greenhushing. If you are not familiar, greenwashing is essentially the false marketing of green/environmental or sustainable claims. Most recently, we've seen a lot greenwashing in the context of aspirational claims, namely brands striving to be carbon neutral or reduce their emissions by a certain year. Greenhushing, on the other hand, is when brands do good for the environment, but don't publicize it. Greenhushing can occur for various reasons including, fear of accusations of greenwashing, consumer perception that "green" products are more expensive or inferior, or even for political reasons. While we didn't make any promises or claims, the committee was proud to support a digital business card initiative and encourage the use of reusable water bottles to help make the conference more sustainable for all.
- **Crafting Successful Agreements with Branding Agencies:** A roundtable discussion took place between practitioners from Canada, the UK, and US on how brands can best partner with their creative agencies and areas of best drafting practices for agreements between the two. Discussion of the scope of services and consideration of AI-generated work product dominated the conversation, including how best to allocate risk created by the use of AI particularly where this work product is specifically contemplated or where influencers are involved. Discussion of the extent of preliminary clearance work members of the group were carrying out on behalf of agencies, or that agencies were otherwise expected to conduct, also took place. An overall downward trend in full, in-depth trademark search orders more generally, as shared by the one of the leading search companies present, was also covered. The unique risks attached to working with smaller agencies, including the absence of enterprise software licenses, was also discussed.
- **Law and Policy | Rules of the Road in Engaging with Celebrities, Influencers, and Fans:** This session brought a global perspective to how companies interact with and negotiate with celebrities and influencers in relation to the promotion of their brands. The panelists focused on how they prioritize and make use of time and resources depending upon the nature and length of a promotion, as well as the potential impact of the promotional activities on their brands. Interestingly, in Argentina, many companies create specific scripts that must be used by influencers to help minimize regulatory and legal risks. Aside from potential pitfalls in agreements, the panelists also discussed deepfakes and artificial intelligence and the impact on their promotional activities and on their brands, as well as issues with poor influencer behavior and even taxation issues. Truly, an ever-evolving area as technology becomes even more intertwined in the influencer landscape.

- **Successfully Mediating IP Disputes:** Key Insights and Practical Tips – INTA’s ADR Committee hosted a panel discussion on trademark mediation, highlighting the growing value of mediation in resolving IP disputes. Panelists emphasized its advantages over litigation, including lower costs, reduced risk, and the opportunity for creative, business-focused solutions. They discussed the qualities of effective mediators, such as neutrality, communication skills, and business acumen, and considered whether mediators should propose solutions or simply facilitate dialogue. The consensus favored a balanced approach that maintains neutrality while offering constructive suggestions. The discussion also addressed the importance of preparation, confidentiality, and having decision-makers present. Challenges of virtual mediation were noted, including distractions and reduced engagement, as well as the supportive but limited role of AI. Real-world examples illustrated the need for mediators to guide the process while allowing parties to retain control over outcomes.
- **Annual Review of Trademark Cases:** Always an attendee favorite, this session featured an overview of trademark decisions over the last 12 months lead by Theodore Davis of Kilpatrick Townsend and John Welch of The TTABlog fame. Notable decisions include those upholding the validity of the Lanham Act’s “names clause” (requiring written consent to register a mark containing a person’s name) under the First Amendment (*Vidal v. Elster*, 602 U.S. 286 (2024)), confirming that inaccurate patent claims may provide grounds actionable false advertising claims (*Crocs, Inc. v. Effervescent, Inc.*, No. 22-2160 (Fed. Cir. 2024)), holding mere use of a party’s name in a judicial proceeding is not actionable under Lanham Act (*Dieujuste v. Sin*, No. 24-1522-cv (2d Cir. 2025)), confirming that the TTAB’s “something more” doctrine applies only to the relatedness of goods to services and not to goods to goods (*In re Samsung Display Co., Ltd.*, No. 90502617 (T.T.A.B. 2024)), and clarifying that product color resulting from practicing an expired patent cannot also have trademark significance because the color is functional under the expired patent (*CeramTec GmbH v. Coorstek Bioceramics LLC*, No. 2023-1502 (Fed. Cir. 2025)). John Welch also recounted his top losing TTAB arguments, with the number one slot belonging to arguments that attempt to impart in real-world limitations to goods/services in an application/registration (since the TTAB typically only considers the goods/services as listed), and listed some of his pet peeves, such as using the word “trademark” as a verb (ironically used as such by the Supreme Court in its *Elster* decision).