

TC'S IP CORNER[®]





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Welcome to TC's IP Corner® Holiday edition. We are excited to share this quarterly newsletter with our clients, colleagues, and friends as we examine hot topics, interesting cases, and weird yet entertaining happenings in the world of intellectual property.

If you have ideas for future editions, please reach out to one of the editors listed below.

SO YOU WANT YOUR HOLIDAY TRO...

A temporary restraining order is a court order issued to maintain the status quo and prevent immediate harm until the court can hold a preliminary injunction hearing. A temporary restraining order can be issued without notice to the adverse party only if the movant submits the following: (A) specific facts in an affidavit or a verified complaint clearly showing that immediate and irreparable injury, loss, or damage will result to the movant before the adverse party can be heard in opposition; and (B) a certification in writing by the movant's attorney stating any efforts made to give notice and the reasons why notice should not be required.

In patent cases, like in other cases, temporary restraining orders are an extreme remedy, and courts will require strict proof before issuing an order. Such was the case in *Tumble Living, Inc. v. Cozey Inc.*, Case No. 1:25-CV-13592 (N.D. Ill. filed Nov. 5, 2025), where the court denied the patent owner's motion for a temporary restraining order. The court in *Tumble Living* concluded that the patent owner failed to show that a temporary restraining order is needed to avoid immediate and irreparable injury without giving the defendant a chance to respond. In its motion, the patent owner argued the defendant and the patent owner were competitors in the washable rug product market. The patent owner argued that, in fact, the two parties are "the only two entities that sell multiple piece, multiple layer, washable rug products" that practice the asserted patent. To argue immediate and irreparable harm, the plaintiff argued that a temporary restraining order is particularly necessary "as the parties prepare for Black Friday / Cyber Monday ("BFCM") and the subsequent holiday season—the time of year when [the defendant's] infringement hurts [patent owner] the most." The court rejected this argument, stating that the "holiday-shopping season is not a persuasive basis to dispense with notice."

Other courts that have found immediate and irreparable harm provide some insight into the types of evidence that may prove successful. For example, in *AMVAC Chemical Corp. v. Aceto Agricultural Chemicals Corp.*, 2008 WL 2456076, at *2 (N.D. Ga. May 8, 2008), the court found immediate and irreparable harm where, two days before the hearing, one of the patent owner's customers contacted the patent owner and demanded a substantial rebate in light of the product available from the defendant. In another case, the Federal Circuit found that lost market share may also form the basis for irreparable and immediate harm. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1336 (Fed. Cir. 2013).

The patent owner in *Tumble Living*, on the other hand, failed to show any concrete harm or loss of market share. Perhaps wisely, the court concluded that Tumble Living's arguments, if successful, may lead to a slew of temporary restraining order motions around the holidays, with no additional evidence of irreparable harm. Even so, it may be frustrating as a patent owner if an infringer is able to capitalize from an infringing product during the holiday season. If you have any questions about temporary restraining order strategies in light of cases like *Tumble Living*, please reach out to a member of our IP group.

TRADEMARK SCAMMERS DON'T TAKE THE HOLIDAYS OFF

Trademark scams are unfortunately very common, and they come in a variety of forms. One scam for which we have seen a recent uptick is the “file a trademark application now or lose your trademark rights” scam. Fake lawyers (or perhaps real but unethical ones) try to scare businesses into believing that another business is about to file a trademark application for a trademark that, coincidentally, is the same trademark used by the business being contacted. If the contacted business does not hire the lawyer to immediately file a trademark application ahead of this other purported business, all rights will be lost (according to the scammer). One variation of this scam (recently received by one of our clients) is shown below:

Dear []

I hope this correspondence finds you well. I am writing regarding the recent matter involving the trademark [], and the application initiated by an entity based in Virginia. We have been made aware that a competing filing is anticipated, and there is now a narrow 24-hour period within which to assert your rights to this mark. In light of your prior use of this name in commerce, you are entitled to claim priority, and we are prepared to assist you in promptly securing those rights.

Kindly confirm whether you wish to proceed. If we do not receive instructions to move forward, we will be obliged to withdraw from this matter, which may allow the competing party to obtain registration of the trademark. Such an outcome could jeopardize your ability to maintain ³ownership and continued use of the name.

These solicitations are generally false and misleading for a variety of reasons. The scammers are using fear and urgency in an effort to drum up business and receive payment for fictitious, worthless or unnecessary services.

If you receive an email like the one above, or any other suspicious communication involving your trademarks, you should consult with your actual trademark lawyer. We recommend against responding to these types of emails, which can lead to more aggressive tactics and more scams.

For additional resources on trademark scams, the U.S. Trademark Office website provides informative and valuable information on a variety of topics. www.uspto.gov/trademarks/protect.

If you have any trademark questions or trademark needs, please reach out to a member of our IP group.

VETEMENTS' TREND-SETTING CLOTHING LINE FAILED TO TRANSLATE WITH THE USPTO AND FEDERAL CIRCUIT

Swiss-French luxury fashion house Vetements Group AG recently asked the Supreme Court to take up its case¹ after both the Trademark Trial and Appeal Board (“TTAB”) and the Federal Circuit rejected its trademark applications.

Vetements seeks to register the marks VETEMENTS (in standard character) and **VETEMENTS** (in stylized form) on the Principal Register for:

Shirts, skirts, sweaters, coats, jackets, suits, caps being headwear, headwear, hats, hoods, visors being headwear, scarves, gloves, shoes, boots, waist belts, T-shirts, pants, blouses, dresses in International Class 25

Online retail store services for shirts; skirts; sweaters; coats; jackets; suits; caps; head wear; hats; hoods; visors; scarves; gloves; shoes; boots; waist belts; T-shirts; pants blouses; dresses in International Class 35

In both applications, Vetements submitted the following translation: “The English translation of ‘vetements’ in the mark is ‘clothing.’”

Applicant amended both applications to submit a claim of acquired distinctiveness in the alternative.²

¹ *In Re Vetements Grp. Ag*, No. 88944198, 2023 WL 3271156 (Apr. 21, 2023), *aff'd*, 137 F.4th 1317 (Fed. Cir. 2025), *petition for cert. filed, Vetements Group AG, Petitioner v. Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director, United States Patent and Trademark Office* (U.S. Aug. 21, 2025) (No. 25-215).

² A claim of acquired distinctiveness in the alternative is an argument strategy wherein an applicant may argue against the examining attorney’s refusal (such as a descriptiveness refusal) and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness and is eligible for registration. In this situation, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. TMEP 1212.02(c).

The Examining Attorney issued a final refusal of registration in both applications for the Class 25 goods and Class 35 services on the ground that the marks as applied to clothing and online retail store services for clothing were generic,³ or in the alternative, merely descriptive without acquired distinctiveness. Vetements appealed the Examining Attorney's refusal to the TTAB, which affirmed the Examining Attorney's finding.

In reaching its conclusion, the TTAB applied the doctrine of foreign equivalents. Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, and similarity of connotation to determine confusing similarity with English word marks. This doctrine is not an absolute rule and instead should be viewed as a guideline. It does not apply to words from dead or obscure languages, and caution should be taken when the foreign term and the English term to which it is compared are not exact synonyms. As a general principle, the doctrine of foreign equivalents is applied in situations in which an American consumer is likely to "stop and translate" foreign words into their English equivalent.

The TTAB found that French is the fifth-most spoken non-English language at home, and it is the second most widely taught non-English language in schools in the United States. The TTAB reasoned that VETEMENTS is subject to the doctrine of foreign equivalents because the ordinary American purchaser is likely to stop and translate the marks into English, particularly because they are the French word for clothing and are used in connection with pieces of clothing and clothing-related retail services. After translating the marks, the TTAB then considered the marks under the test for genericness, which asks whether the marks would be understood by the consuming public for the identified goods and services primarily to refer to the genus of goods or services under consideration. Using the marks' translation, the TTAB found that members of the relevant public would primarily understand the VETEMENTS marks to refer to a genus of clothing items and online retail store services featuring clothing

³

A term is "generic" if it is the common name for a category of goods or services (e.g., computer, phone). Any term that the relevant public uses or understands to refer to the genus of goods or services, or a key aspect or central focus or subcategory of the genus, is generic.

items and online retail store services featuring clothing items; thus the TTAB found the VETEMENTS marks generic. The TTAB also found the proposed marks were highly descriptive, and Vetements failed to establish that the proposed marks had acquired distinctiveness. Vetements appealed the TTAB's ruling to the Federal Circuit. The Federal Circuit concluded that the TTAB properly considered the proposed marks under the doctrine of foreign equivalents.

Vetements has now requested the Supreme Court to hear its case, arguing in its petition that the Federal Circuit's opinion contradicts Supreme Court cases such as *Menendez v. Holt*,⁴ which found that the trademark "LA FAVORITA" for flour could be registered because it was "a fancy name, and in a foreign language" and *U.S. Patent and Trademark Office v. Booking.com*,⁵ which found "BOOKING.COM" not to be a generic term to consumers.

If this case is taken up by the Supreme Court, it is one to watch as it could provide guidance and clarification on how the doctrine of foreign equivalents is applied. If you or a client is interested in applying to register a non-English term as a trademark in the United States, please reach out to a member of our IP group.

⁴
128 U.S. 514, 520 (1888)

⁵
591 U.S. 549 (2020)

DON'T SKIMP ON THE PREP TIME

While December often brings holiday excitement, it's also a good time for a reminder that thorough preparation is essential before filing a patent infringement lawsuit. The case of *EscapeX v. Google* illustrates the consequences of failing to conduct an adequate pre-suit investigation and the broader implications of frivolous patent litigation.

Background

EscapeX sued Google in the U.S. District Court for the Western District of Texas, alleging that YouTube Music infringed U.S. Patent No. 9,009,113 (the '113 patent). Google responded that the accused features were not present in YouTube Music, pointing to EscapeX's inadequate pre-suit investigation. EscapeX then amended its complaint to target YouTube Video with Auto-Add. Google countered that the product predated the '113 patent, which would invalidate EscapeX's patent if EscapeX's infringement claim was true.

In a separate case, the Southern District of New York found the '113 patent directed to ineligible subject matter. Despite this adverse ruling, EscapeX filed a "joint stipulation of dismissal" requiring each party to bear its own costs—without Google's consent. After Google objected, EscapeX withdrew the stipulation and filed a second stipulation of dismissal with no requirement that each side would bear their own fees.

Attorneys' Fees and Court Findings

Google moved for its attorneys' fees, arguing EscapeX pursued frivolous claims and prolonged litigation unnecessarily. The district court agreed, awarding Google over \$190,000. When EscapeX attempted to amend the judgment with evidence of its pre-suit investigation, the court denied the motion and later awarded Google an additional \$60,000 for defending against EscapeX's "reckless" filings.

The court deemed the case “exceptional” under 35 U.S.C. § 285, citing both compensation and deterrence. EscapeX’s lack of diligence and failure to respond to Google’s meet-and-confer requests were central to the ruling. The Federal Circuit affirmed, emphasizing deterrence even against non-practicing entities. Importantly, the court clarified that zealous advocacy does not excuse neglecting fundamental duties such as conducting a thorough pre-suit investigation.

Broader Implications

This case highlights several important themes of patent litigation:

- **Pre-suit investigation:** EscapeX’s failure to investigate thoroughly led to targeting the wrong product and undermined its claims. The court’s ruling highlights the expectation that litigants to do their homework before filing suit.
- **Litigation conduct:** EscapeX’s disregard for procedural duties, including filing a stipulation without consent, contributed to the fee award.
- **Deterrence of frivolous suits:** The ruling underscores that courts will penalize baseless litigation, regardless of whether the plaintiff is a non-practicing entity. The decision sends a message that attempts to pressure tech giants with weak suits may backfire.
- **Patent trolls and settlement pressure:** While the court denied animus toward EscapeX’s non-practicing status, it acknowledged the broader problem of entities filing suits to force modest settlements. The ruling suggests that some courts may be willing to push back against this strategy by awarding fees in frivolous cases.

Lessons for Practitioners and Patentees

Patent litigators and patentees should take several lessons from *EscapeX v. Google*:

- Conduct a comprehensive pre-suit investigation to ensure claims are well-founded.
- Maintain professionalism in litigation conduct and abide by the court rules.
- Recognize that courts may use fee awards as a deterrent mechanism against frivolous suits. The fact over \$250,000 of fees were awarded to Google highlights this.
- Understand that non-practicing entities are not immune from fee-shifting simply because they lack operating businesses.

The court highlighted that zealous advocacy does not excuse neglecting fundamental duties such as adequate pre-suit investigation. *EscapeX v. Google* serves as a cautionary tale: patent litigators must ensure claims are well-founded and litigation conduct remains professional. The case reinforces the importance of diligence, candor, and respect for procedural norms in litigation.

If you need assistance with a patent issue, please reach out to a member of our IP group.

FEDERAL CIRCUIT HOLDS IPR ESTOPPEL DOES NOT AFFECT THE USPTO

The Federal Circuit recently held that IPR estoppel does not prevent the United States Patent and Trademark Office (“USPTO”) from maintaining an *ex parte* reexamination¹ proceeding based upon submissions by parties subject to *inter partes* review (“IPR”) estoppel.² The case at issue is *In re Gesture Tech. Partners, LLC*, No. 2025-1075, 2025 WL 3439349 (Fed. Cir. Dec. 1, 2025). The Federal Circuit’s holding in this case may incentivize parties to simultaneously file petitions for IPR and *ex parte* reexamination where establishing invalidity of a patent is of critical importance.

Background

Samsung requested *ex parte* reexamination of Gesture’s U.S. Pat. No. 7,933,431. At the same time the *ex parte* reexamination was pending, two IPR proceedings were also pending, one of which was filed by Unified Patents LLC.³ After the Board issued its final written decision in that IPR, Gesture petitioned to terminate the *ex parte* reexamination proceeding, arguing that because Samsung is a member of Unified Patents, Samsung was estopped under 35 U.S.C. § 315(e)(1) from maintaining the reexamination proceeding. The USPTO denied the petition and concluded that the estoppel provision of § 315(e)(1) did not apply to ongoing *ex parte* reexaminations. The reexamination proceeding resulted in a final rejection, which was later affirmed by the Patent Trial and Appeal Board. Gesture then appealed to the Federal Circuit.

¹ *Ex parte* reexamination is an administrative proceeding that reviews the validity of a patent. See, e.g., Manual of Patent Examining Procedure § 2209. Any person may submit a request based on certain categories of prior art and, if the USPTO determines that a substantial new question of patentability is presented, reexamination will be ordered. *Id.* As denoted by the name, the reexamination proceeding is solely between the USPTO and the patentee, and there is no further involvement by the requester once reexamination is ordered.

² IPR is an administrative proceeding by which parties may directly challenge the validity of one or more claims of a patent at the USPTO. Unlike *ex parte* reexamination proceedings, the petitioner is actively involved throughout the proceeding and actively litigates the validity of the challenged claims.

³ *Unified Patents LLC v. Gesture Tech. Partners LLC*, IPR2021-00917 (P.T.A.B. May 14, 2021).

The Federal Circuit's Decision

The Federal Circuit began by examining the language of 35 U.S.C. § 315(e)(1)—the provision governing IPR estoppel for proceedings before the USPTO—which states:

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

The Federal Circuit emphasized that, in *ex parte* reexaminations, it is the USPTO that maintains the proceeding rather than the petitioner.⁴ Accordingly, because the estoppel provisions did not bind the USPTO, the Federal Circuit affirmed the denial of Gesture's petition to terminate the *ex parte* reexamination proceeding.⁵

Conclusion

While it remains to be seen how this case will affect post-grant proceedings before the USPTO, it is possible the decision will incentivize parties to file petitions for both IPR and *ex parte* reexamination early enough in the case for the *ex parte* reexamination to be ordered before IPR estoppel could bind the petitioner. Because the *ex parte* proceeding would be maintained by the USPTO—and therefore not subject to IPR estoppel—it would provide a second chance to invalidate any claims remaining after the IPR's conclusion. Please reach out to a member of TC's IP group if you have a patent issue.

⁴ *Gesture*, 2025 WL 3439349, at *3 (“A petitioner requests a reexamination . . . and a petitioner may file a reply if the patent owner chooses to file a statement . . . but the petitioner does not maintain the proceeding. Rather, the Patent Office does.”)

⁵ *Id.*

YES... THIS REALLY HAPPENED

Christmas Tree Edition

A hallmark of the holiday season for many is gathering around the Christmas tree. Along with that tradition comes the age-old debate: real tree or artificial? Real trees offer the gold standard of holiday cheer, complete with the unmistakable evergreen scent that fills the room. But they also require a not-insignificant commitment—driving to a tree lot or farm, picking and cutting a tree, strapping it to the roof of your station wagon, and hoping it makes the trip home intact. Artificial trees, by contrast, are easy to assemble, decorate, and store, but they lack the authenticity many people crave. Surely there must be a middle ground.

Enter the “Semiartificial Christmas Tree” of U.S. Patent No. 2,186,351, patented in 1940. The '351 patent describes a clever hybrid solution featuring a telescopic metal trunk mounted on a base. At regular intervals along the trunk are circular rings equipped with outward-facing sockets designed to hold real tree branches. Rather than cutting down an entire tree, users simply trim branches from a live fir or pine and insert them into the sockets, building a full-looking Christmas tree branch by branch.

This design preserved the fresh look and scent of a real tree while avoiding the need to fell one entirely. And if branches dried out over the course of the season, they could be easily replaced with a few fresh cuttings. With this invention, the age-old question of real or artificial trees is met with a solution that gives best of both worlds—an easy-to-deploy artificial structure paired with natural greenery.

Happy holidays all!

YES... THIS REALLY HAPPENED

Christmas Tree Edition

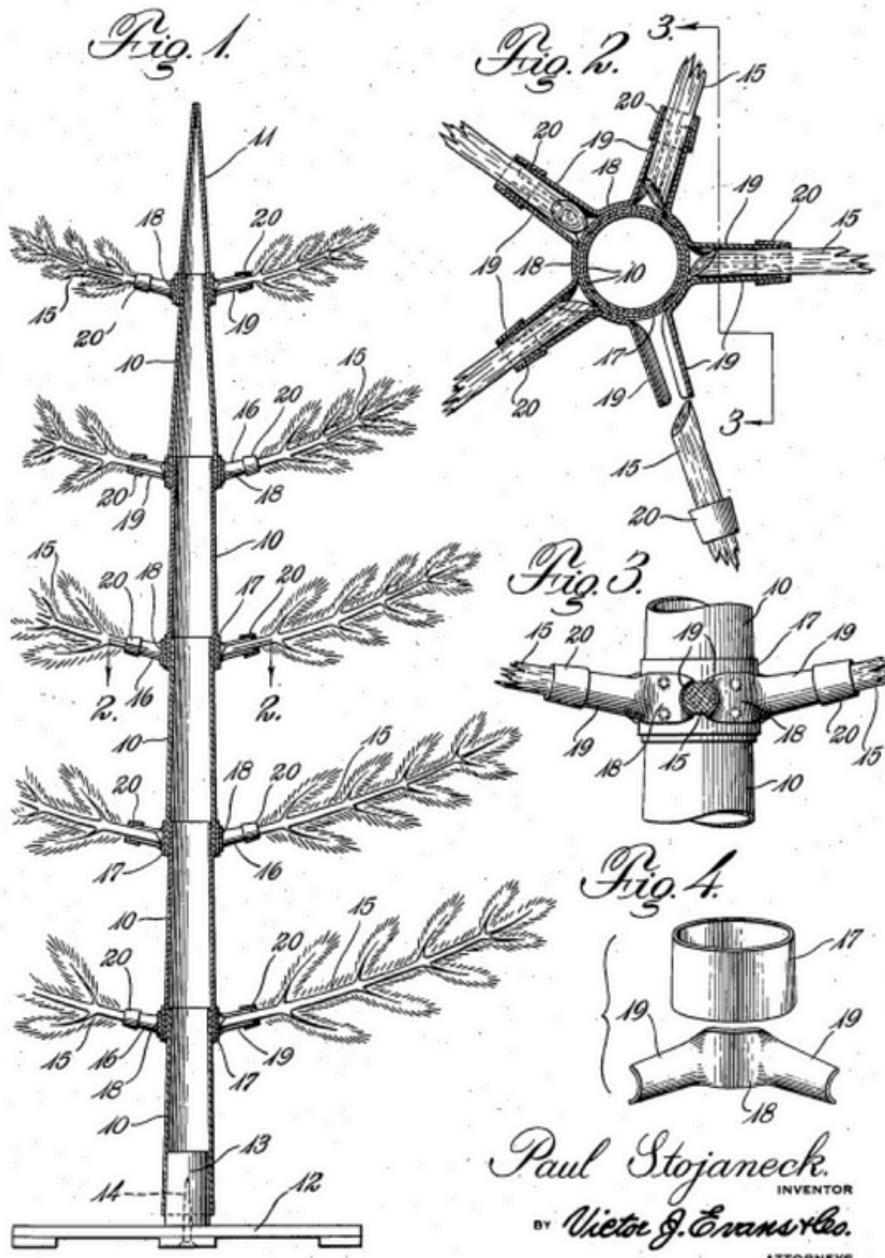
Jan. 9, 1940.

P. STOJANECK

2,186,351

SEMIARTIFICIAL CHRISTMAS TREE

Filed Sept. 12, 1938



Paul Stojaneck.
INVENTOR
BY Victor J. Evans & Co.
ATTORNEYS



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