msk

get lucky: u.s. supreme court overturns 'defense preclusion' ruling in trademark lawsuit

Albina Gasanbekova [Edited by Robert H. Rotstein]
MSK Client Alert

May 22, 2020

Last week, the U.S. Supreme Court decided *Lucky Brand Dungarees Inc. v. Marcel Fashions Group Inc.*, No. 18-1086, 2020 WL 2477020 (U.S. May 14, 2020), a trademark case involving the scope of claim preclusion as the doctrine applies to defenses. Although recognizing that claim preclusion can apply to bar defenses, the Court explained that the so-called "defense preclusion" is an invalid application of res judicata when the earlier suit involved different trademarks, different legal theories, and different conduct occurring at different times.

Three Lawsuits and Nearly Twenty Years of Litigation

Lucky Brand and Marcel Fashions Group are competitors in the apparel industry who have been battling each other for decades. The first lawsuit began in 2001, when Marcel, the owner of the trademark "Get Lucky," accused Lucky Brand of violating trademark law by using the phrase "Get Lucky" in advertisements. That litigation resulted in settlement, in which Lucky Brand agreed to stop using the words "Get Lucky" in their branding in return for Marcel Fashion's release of certain claims against Lucky Brand. The second lawsuit between the parties began in 2005, when Lucky Brand accused Marcel Fashions of copying its designs and logos for a new clothing line. Marcel Fashions responded with counterclaims, alleging that Lucky Brand had continued to use Marcel's "Get Lucky" mark in violation of the settlement agreement. Notably, Marcel had not claimed that Lucky Brand's use of its own marks alone—that is, independently of any use of "Get Lucky"—infringed on Marcel's "Get Lucky" mark. Marcel ultimately prevailed in the 2005 lawsuit, permanently enjoining Lucky Brand from using a catchphrase "Get Lucky."

attorneys

Albina Gasanbekova

practice areas

entertainment & ip litigation

intellectual property litigation

msk

get lucky: u.s. supreme court overturns 'defense preclusion' ruling in trademark lawsuit

View Full Alert

los angeles
t 310.312.2000
f 310.312.3100

new york
t 212.509.3900
f 212.509.7239

washington, dc
t 202.355.7900
f 202.355.7899