

Lee Johnston in Bloomberg Law: Lucky Brand to Argue Circuit's Trademark Defense Ban was Rogue

January 22, 2020 Lee Johnston

PRACTICES Intellectual Property, Trademark and Advertising, Trademark Litigation

Haynes Boone Partner [Lee Johnston](#) talked with *Bloomberg Law* about a U.S. Supreme Court trademark infringement case involving Lucky Brand Dungarees Inc. and Marcel Fashion Group Inc.

Here is an excerpt:

A 2003 settlement between the companies is at the center of the dispute. The appellate court barred Lucky Brand from pointing to the settlement as a defense after not doing so in an earlier infringement lawsuit over Marcel's "Get Lucky" trademark.

The case has broad implications for civil procedure, because it gives the justices the chance to settle the question of whether litigants can raise a defense that they could've raised, but didn't, in earlier litigation. It also highlights the importance of clearly writing terms in settlement agreements, especially ones that release a party from liability.

Proper Outcome

Lucky Brand argued in its Supreme Court brief that the U.S. Court of Appeals for Second Circuit invented a rule "contrary to nearly 150 years of case law" that would allow defendants to litigate even peripheral defenses to the bitter end.

Marcel countered in its high court brief that *res judicata*, the doctrine underlying issue and claim preclusion, also applies to defenses for the same reason: it prevents parties from prolonging litigation by bringing a new argument after each loss or by re-litigating decided issues. Marcel said its trademark infringement allegations remain the same, despite different time frames.

Trademark rights and defenses "wax and wane" over time, making equating claims from different times problematic, intellectual property attorney Lee Johnston of Haynes Boone said.

To read the full article, click [here](#). (Subscription required)