

## Highlights

*McCarthy on Trademarks and Unfair Competition 5th* is now delivered in pamphlet form. The set updates your treatise with the latest developments. If you are a subscriber to this set, this first release of the year replaces the third and fourth volumes of the softcover set. To file, remove and recycle your current volumes three and four. Place the new volumes three and four in order on your shelf.

### Highlights of the December 2025 update (Release 2025-4) to *McCarthy on Trademarks and Unfair Competition 5th*

- **Export Sales Causing Confusion Abroad.** The Ninth Circuit rejected a trademark owner’s argument that likelihood of confusion abroad caused by sales occurring outside the U.S. are sufficient to trigger the Lanham Act if the product was made and transported in the United States and then exported. Infringement claim was dismissed where defendant’s accused nutritional supplement was made in the United States and only sold abroad. *Doctor’s Best, Inc., v. Nature’s Way Products, LLC*, § 29:57.
- **The Jack Daniel’s Case on Remand from the Supreme Court.** The district court used a traditional multi-factor test for trademark infringement and found that Jack Daniels had not proven that the accused parody dog toy constituted a trademark infringement. However, the district court found that the dog toy labeled with jokes about dog poop constituted dilution by tarnishment. *VIP Products LLC, v. Jack Daniel’s Properties*, § 24:90.
- **Statutory Damages for Counterfeiting.** Affirming a jury award of more than \$1 million in statutory damages, the Eleventh Circuit, using Copyright law as a guide, held that there is no requirement that statutory damages be related to the trademark owner’s actual damages. *Top Tobacco, L.P., v. Star Importers & Wholesalers, Inc.*, § 30:95.
- **The Natural Expansion Zone of Products or Services and Intervening Users.** The author criticizes the Federal Circuit’s decision holding that the “doctrine” of natural zone of expansion can only be applied “defensively” and not “offensively.” The author argues that the only applicable “doctrine” is the statutory test of likelihood of confusion. *Dollar Financial Group, Inc., v. Brittex Financial, Inc.*, §§ 24:20-24:21.
- **Denial of a Preliminary Injunction.** Affirming denial of a preliminary injunction, the First Circuit emphasized that: “Likelihood of success on the merits is the sine qua non of the preliminary injunction analysis.” No such likelihood was found as to two similarly named tourist businesses adjacent to the

famed Lizzie Borden house in Massachusetts. *US Ghost Adventures, LLC, v. Miss Lizzie's Coffee LLC*, § 30:45.