

Undue Prejudice in an Acquiescence Defense

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Intellectual Property national co-chair Karen Artz Ash and partner Bret Danow discuss the equitable defense of acquiescence in a claim of trademark infringement. They note that in general, an acquiescence defense requires that a defendant satisfy three elements: (1) it received assurances from the plaintiff that the defendant could use the mark; (2) it relied on such assurances; and (3) it would experience undue prejudice if it now had to cease use of the mark. They discuss *Pennzoil-Quaker State Co v. Miller Oil and Gas Operations et al*, a recent case that clarified the role that "undue prejudice" plays in the determination of whether a defendant can establish a claim of acquiescence. They note the value of the *Pennzoil* case, remarking that it "gives potential defendants guidance on what they will need to demonstrate in order to avail themselves of the equitable defense of acquiescence."

CONTACTS

For more information, contact your Katten attorney or any of the following attorneys.



Karen Artz Ash

+1.212.940.8554

karen.ash@katten.com



Bret J. Danow

+1.212.940.6365

bret.danow@katten.com