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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."

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