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SCOTUS Opinion: Profits Can Be Awarded In Trademark Infringement Case Without Willfulness

28 Apr 2020

Section 1117(a) of the U.S. Code requires proof that a trademark infringer acted willfully in order for a court to award lost profits for trademark dilution under Section 1125(c) of the Lanham Act, but does not mention trademark infringement. In *Romag Fasteners, Inc. v. Fossil Group, Inc.*, Romag sued Fossil for trademark infringement under Section 1125(a). The jury did not find that Fossil acted willfully, and the district court declined to award profits, holding that proof of willfulness was a prerequisite to that recovery just as it is for a trademark dilution claim. The Federal Circuit agreed, but the Court unanimously reversed and held that the requirement to prove willfulness for trademark dilution did not also apply to claims for trademark infringement.

The majority opinion by Justice Gorsuch declined to read that language into Section 1125(a), given that the willfulness requirement was expressly written into other parts of the statute, such as for dilution. Justice Alito, joined by Justices Breyer and Kagan, filed a brief concurrence stating that prior case law only considered willfulness to be a highly important consideration and not a requirement when it came to awards for profits. Justice Sotomayor concurred in the judgment, noting that while she agreed willfulness was not a prerequisite for an award of profits, awarding profits for innocent infringement would not be in keeping with past case law.

A link to the opinion is here: https://www.supremecourt.gov/opinions/19pdf/18-1233_5he6.pdf

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TAGGED: SCOTUS opinion, Lanham Act, Romagg Fasteners Inc v. Fossil Group Inc., Trademark Infringement, Willfulness