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Apple Beats 'Memoji' Trademark Case At 9th Circ.

By [Bill Donahue](#)

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Law360 (July 13, 2021, 4:33 PM EDT) -- The Ninth Circuit on Tuesday rejected a trademark lawsuit against [Apple](#) over the use of "Memoji" for its customizable avatars, ruling that a smaller company had rushed to use the name merely so that it could sue the tech giant.



The Ninth Circuit said Social Technologies LLC couldn't show that it had actually used the name "Memoji" in commerce before Apple announced its avatar feature in 2018. (AP Photo/Kathy Willens)

Social Technologies LLC says it started using "Memoji" in 2016, but the appeals court said the smaller company couldn't show that it had actually ever used the name in commerce before Apple announced its avatar feature in 2018.

Among other things, the court cited emails that showed Social Tech rushing to launch a product after Apple's announcement. One message included the company's founder telling a developer about the possibility of a lawsuit against Apple and to "get your Lamborghini picked out!"

"The correspondence compels the conclusion that Social Tech's intention to develop and release its Memoji application was not a bona fide engagement of the mark in commerce, but merely an attempt to reserve its Memoji trademark and provide a basis for its lawsuit against Apple," Judge Jane A. Restani wrote for the panel.

The appeals court said Social Tech merely made "token use" of the name to reserve rights, not the kind of "bona fide use" that's required to actually secure trademark protection.

Attorneys for the parties did not immediately return requests for comment.

The case dates to 2016, when Social Tech filed a so-called intent-to-use trademark application for "Memoji." Two years later, when Apple announced its own Memoji feature, Social Tech had only engaged in early stage activities, like developing a business plan and seeking investors.

But after news of Apple's product got out, Social Tech expedited the launch of a real app under the name. Emails cited in Tuesday's opinion show that litigation was on their mind, with one saying "time to get paid, gentlemen" and another that the company was planning "a nice lawsuit against Apple."

Social Tech eventually launched an app in 2018, but it contained "numerous bugs" and was pulled from [Google's](#) app store, according to Tuesday's opinion. The company used it to secure a full trademark registration, and litigation with Apple quickly commenced.

On Tuesday, the Ninth Circuit rejected the argument that roughly 5,000 downloads of Social Tech's app was enough to constitute a bona fide use in commerce.

"It is not the number of downloads that is lacking here, but a lack of any evidence whatsoever that suggests Social Tech developed its Memoji application for genuine commercial reasons warranting trademark protection," Judge Restani wrote.

The appeals court was careful to say that "rushing to develop a product or releasing a product of low quality" were not themselves enough to bar trademark protection. But Judge Restani wrote that in the current case, Social Tech had failed to provide "any evidence" that it had actually used the name in commerce.

U.S. Circuit Judges Michael D. Hawkins and Eric D. Miller also sat on the panel for the Ninth Circuit. Judge Restani, a judge of the U.S. Court of International Trade, sat on the panel by designation.

Social Tech is represented by James Kelly and John M. Pierce of [Pierce Bainbridge PC](#).

Apple is represented by Dale Cendali, Mary Mazzello, Diana M. Torres, Lauren Schweitzer and Megan L. McKeown of [Kirkland & Ellis LLP](#).

The case is Social Technologies LLC v. Apple Inc., case number [20-15241](#)">20-15241, in the [U.S. Court of Appeals for the Ninth Circuit](#).

--Editing by Adam LoBelia.

Correction: A previous version of this article misidentified Judge Restani as a circuit court judge. The error has been corrected.

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