

**TRADEMARK & UNFAIR COMPETITION Law**  
LAWS 7341-801

Spring 2020  
Mondays & Wednesdays, 9:00 – 10:20 am  
Room: 306

Professor Kristelia García  
[kristelia.garcia@colorado.edu](mailto:kristelia.garcia@colorado.edu) | [@kristelia](https://twitter.com/kristelia) | Office: 425  
Office hours Monday & Wednesday by appointment  
[Course website](#)

**Overview**

This course will cover U.S. federal law relating to trademark—specifically: words, phrases, slogans, logos, trade dress and other identifiers that both identify a source of a good or service to the public, and create an identity for the producer that encourages the protection of goods and services of consistent and predictable quality. We will discuss the value of competition, the importance of consumer protection, and the unique status of brands and branding as a form of intellectual property. Topics covered may include: acquisition & maintenance of trademark protection, trade dress and distinctiveness, the geographic scope of trademarks, trademark infringement and dilution, trademark rights online, First Amendment limits on trademark enforcement, defenses and remedies, false advertising, and rights of publicity.

**Prerequisite(s)**

None. If you have previously taken (or are simultaneously taking) Introduction to IP, we will inevitably cover some familiar cases, though likely in greater detail, and with an eye toward the statutory nuances and policy implications.

**Course Materials**

The readings for this course will come primarily from the casebook: Barton Beebe, *Trademark Law: An Open-Source Casebook*, version 6.0. This text is available to read and/or download for free at <http://tmcasbook.org/>. The site also has a link to purchase a low-cost hardcopy version from Amazon for \$20.26 (you will need Volumes I and 2).

Some readings will come from supplemental materials as linked in-line in the Topics & Readings section below.

In addition, you will need access to [the Lanham Act](#), the statute governing trademark law in the U.S.

Should you want a deeper dive, or clarification, on any of the topics discussed in class, [McCarthy on Trademarks and Unfair Competition](#) is a trademark treatise available on Westlaw, and in hard copy in the library.

**Evaluation & Grading Policy**

Your grade in this course will be based on (a) your performance on the midterm project (25%), and (b) your performance on the final examination (75%), with a potential adjustment based on class attendance and participation. The final exam will be a 9-hour, take-home exam in accordance with law school policy. Please check the final exam schedule for updated date and time information.

**Class Attendance & Participation**

Please plan to attend, on time, and come prepared for, all class meetings. Attendance, preparation, participation, and professionalism all count toward the class participation grade. I generally teach using [the Socratic Method](#), in which I begin by questioning specific student(s), drawn randomly, after which I take volunteers. If you know you will be unprepared, please notify me in advance. I recognize that conflicts may occasionally arise, and you need not inform me in advance of an isolated absence. If a situation arises that will result in multiple absences or instances of unpreparedness, however, this should be brought to my attention. Otherwise, it may negatively affect your participation grade.

**Audio/Visuals**

This class will make extensive use of projected slides, audio and video clips. If you have difficulty perceiving any of the materials, please see me, and/or [Disability Services](#) for assistance. I'm happy to make whatever accommodation you need. The slides and other media will also be posted to the [course website](#).

**Laptop Policy**

Laptops are permitted in class for *note-taking purposes only*. Please make a good faith effort to adhere to this policy. Use of laptops or other electronic devices for any other purpose will be considered a violation of professional courtesy, will negatively affect your participation grade, and may result in loss of laptop privileges.

**Recording Policy**

I request that you do not record class without my prior permission. If you must miss class, I encourage you to ask a classmate for notes. Out of consideration for your classmates—who may or may not be comfortable having their questions and comments memorialized—requests for a recording due to a planned absence must be received one week in advance.

**Make-up Classes**

If we are unable to meet for a regularly-scheduled class session, you will be notified in advance, and a make-up will be scheduled.

### Topics & Readings

The following reading schedule is aspirational, and subject to change as we go along and find ourselves spending more or less time on certain topics. Any changes will be announced in class for the next class meeting. I will also try to send out an email about it, so please make sure I have your correct email address. All page numbers refer to the Beebe text. Supplemental materials are noted, and linked in-line below.

Class	Topic/Major Cases	Pages
1	Introduction	11-31
2	Inherent Distinctiveness; Suggestive v. Descriptive Marks <ul style="list-style-type: none"> <li>▪ <i>Abercrombie &amp; Fitch Co. v. Hunting World, Inc.</i></li> <li>▪ <i>Zatarain's Inc. v. Oak Grove Smokehouse, Inc.</i></li> <li>▪ <i>Innovation Ventures, LLC v. N.V.E., Inc.</i></li> </ul>	33-55
3	Acquired Distinctiveness <ul style="list-style-type: none"> <li>▪ <i>Frosty Treats Inc. v. Sony Computer Entertainment America</i></li> <li>▪ <i>Cartier, Inc. v. Four Star Jewelry Creations, Inc.</i></li> <li>▪ <i>Board of Supervisors for Louisiana State University A&amp;M v. Smack Apparel Co.</i></li> </ul>	56-69
4	Generic Terms <ul style="list-style-type: none"> <li>▪ <i>Frito-Lay North America, Inc. v. Princeton Vanguard, LLC</i></li> </ul>	69-90
5	Nonverbal Marks <ul style="list-style-type: none"> <li>▪ <i>Two Pesos, Inc. v. Taco Cabana, Inc.</i></li> <li>▪ <i>Qualitex Co. v. Jacobson Products Co., Inc.</i></li> </ul>	93-111
6	Product Packaging and Configuration <ul style="list-style-type: none"> <li>▪ <i>Wal-Mart Stores, Inc. v. Samara Bros, Inc.</i></li> <li>▪ <i>In re Slokevage</i></li> <li>▪ <i>LVL XIII Brands, Inc. v. Louis Vuitton Malletier, S.A.</i></li> <li>▪ <i>McKernan v. Burek</i></li> <li>▪ <i>Best Cellars, Inc. v. Wine Made Simple, Inc.</i></li> <li>▪ <i>Fedders Corp. v. Elite Classics</i></li> <li>▪ <i>In re SnoWizard, Inc.</i></li> <li>▪ <i>In re Frankish Enterprises Inc.</i></li> </ul>	111-128
7	Trade Dress	129-146

	<ul style="list-style-type: none"> <li>▪ <i>Fun-Damental Too, Ltd. V. Gemmy Industries Corp.</i></li> <li>▪ <i>Amazing Spaces, Inv. V. Metro Mini Storage</i></li> <li>▪ <i>Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC</i></li> <li>▪ <i>In re Frankish Enterprises Ltd.</i></li> <li>▪ <i>Star Industries, Inc. v. Bacardi &amp; Co., Ltd.</i></li> </ul>	
8	<p>Functionality</p> <ul style="list-style-type: none"> <li>▪ <i>In re Morton-Norwich Products, Inc.</i></li> <li>▪ <i>Inwood Labs, Inc. v. Ives Labs, Inc.</i></li> <li>▪ <i>Traffix Devices, Inc. v. Marketing Displays, Inc.</i></li> </ul>	149-166
9	<p>Utilitarian v. Aesthetic Functionality</p> <ul style="list-style-type: none"> <li>▪ <i>Apple, Inc. v. Samsung Electronics Co. Ltd.</i></li> <li>▪ <i>Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.</i></li> <li>▪ <i>Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.</i></li> </ul>	172-179, 181-183, 185-196
10	<p>Deceptive and Deceptively Misdescriptive Marks</p> <ul style="list-style-type: none"> <li>▪ <i>In re California Innovations</i></li> <li>▪ <i>In re Nieves &amp; Nieves LLC</i></li> </ul>	197-212
11	<p>Disparaging and Scandalous Marks I</p> <ul style="list-style-type: none"> <li>▪ <a href="#">In re Heeb Media*</a></li> <li>▪ <a href="#">In re Marsha Fox*</a></li> <li>▪ <a href="#">Pro-Football v Blackhorse*</a></li> </ul> <p>*Spoiler alert: These cases were all overruled, in whole or in part, by the <i>Tam</i> case that we'll read for next class. We read them first in order to appreciate the import and impact of <i>Tam</i>.</p>	Supplemental readings
12	<p>Disparaging and Scandalous Marks II</p> <ul style="list-style-type: none"> <li>▪ <i>Matal v. Tam</i></li> <li>▪ <i>Iancu v. Brunetti</i></li> </ul>	213-246
13	<p>Use in Commerce</p> <ul style="list-style-type: none"> <li>▪ <i>Aycock Engineering, Inc. v. Airflite, Inc.</i></li> <li>▪ <i>Planetary Motion, Inc. v. Techsplosion, Inc.</i></li> </ul>	246-254, 256-268
14	<p>Guest Lecture</p>	Supplemental materials, if

	<ul style="list-style-type: none"> <li>▪ Tracy Gray, Partner at Holland &amp; Hart LLP, will discuss the impact of client risk tolerance on the preliminary TM search decision</li> </ul>	any, to be distributed
15	Midterm Project – Class Meeting at Target on 28 <sup>th</sup> St.	
16	Trademark Registration Process; Intent to Use; Incontestability <ul style="list-style-type: none"> <li>▪ <i>Kelly Services, Inc. v. Creative Harbor, LLC</i></li> <li>▪ <i>Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.</i></li> </ul>	268-302
17	Territoriality; Well-Known Marks <ul style="list-style-type: none"> <li>▪ <a href="#"><i>Dawn Donut Co. v. Hart's Food Stores, Inc.</i></a></li> <li>▪ <i>Grupo Gigante SA v. Dallo &amp; Co., Inc.</i></li> <li>▪ <i>ITC Ltd. v. Punchgini, Inc.</i></li> </ul>	323-351 & supplemental readings
18	Trademark Infringement I: Use in Commerce; Confusion <ul style="list-style-type: none"> <li>▪ <i>Rescuecom Corp. v. Google, Inc.</i></li> <li>▪ <i>Radiance Foundation, Inc. v. National Association for the Advancement of Colored People</i></li> <li>▪ <i>Borden Ice Cream Co. v. Borden's Condensed Milk Co.</i></li> </ul>	366-386
19	Trademark Infringement II: More Confusion <ul style="list-style-type: none"> <li>▪ <i>Smith v. Wal-Mart Stores, Inc.</i></li> <li>▪ <i>Ferrari S.P.A. v. Roberts</i></li> <li>▪ <i>Dastar Corp. v. Twentieth Century Fox Films Corp.</i></li> </ul>	408-427, 449-459, 473-486
20	Trademark Dilution <ul style="list-style-type: none"> <li>▪ <i>Coach Servs., Inc. v. Triumph Learning LLC</i></li> <li>▪ <i>Starbucks Corp. v. Wolfe's Borough Coffee, Inc.</i></li> <li>▪ <i>Victoria's Secret Catalogue v. Moseley</i></li> </ul>	488-498, 506-532
21	Cybersquatting; Secondary Liability <ul style="list-style-type: none"> <li>▪ <i>Sporty's Farm LLX v. Sportsman's Market, Inc.</i></li> <li>▪ <i>Tiffany (NJ) Inc. v. eBay Inc.</i></li> <li>▪ <i>Gucci America, Inc. v. Frontline Processing Corp.</i></li> </ul>	532-542, 563-587
22	Defenses to Trademark Infringement I: Descriptive and Nominative Fair Use	588-601, 612-620

	<ul style="list-style-type: none"> <li>▪ <i>KP Permanent Mark-Up v. Lasting Impression I, Inc.</i></li> <li>▪ <i>Dessert Beauty, Inc. v. Fox</i></li> <li>▪ <i>Toyota Motor Sales, U.S.A., Inc. v. Tabari</i></li> </ul>	
23	<p>Defenses to Trademark Infringement II: Nominative Fair Use and Expressive Uses</p> <ul style="list-style-type: none"> <li>▪ <i>Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC</i></li> <li>▪ <i>Gordon v. Drape Creative, Inc.</i></li> <li>▪ <a href="#">E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.</a></li> </ul>	633-656 & supplemental readings
24	<p>Defenses to Trademark Infringement III: Abandonment and the First Sale Doctrine</p> <ul style="list-style-type: none"> <li>▪ <i>ITC Ltd. V. Punchgini, Inc.</i></li> <li>▪ <i>Freecycle Sunnyvale v. Freecycle Network</i></li> <li>▪ <i>Champion Spark Plug Co. v. Sanders</i></li> </ul>	669-676, 681-690, 695-698
25	<p>False Advertising</p> <ul style="list-style-type: none"> <li>▪ <i>S.C. Johnson &amp; Son, Inc. v. Clorox Co.</i></li> <li>▪ <a href="#">Coca-Cola Co. v. Tropicana Products</a></li> <li>▪ <i>Pizza Hut, Inc. v. Papa John's Intern., Inc.</i></li> </ul>	702-711, 725-739 & supplemental readings
26	<p>Rights of Publicity</p> <ul style="list-style-type: none"> <li>▪ <a href="#">Midler v. Ford Motor Co.</a></li> <li>▪ <i>White v. Samsung Electronics America, Inc.</i></li> <li>▪ <i>In re NCAA Student-Athlete Name &amp; Likeness Licensing Litigation (skim)</i></li> </ul>	793-832 & supplemental readings
27	In-class Final Exam Review	