

## TRADEMARK & UNFAIR COMPETITION

LAWS 7341-801

Fall 2020

Mondays & Wednesdays, 10:30 – 11:50 am

Room: 206 & via [Zoom](#)

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Online office hours Monday & Wednesday [by appointment](#)

[Course Website](#)

### A Note re Law School During a Global Pandemic

Our goal for the semester will be to do our best. Some days, that may mean volunteering to take the first case. Other days, that may mean muting your mic repeatedly while your partner takes a conference call on speaker. For some students, that may mean writing a midterm paper so good they decide to turn it into a Note. For other students, that may mean remembering to turn in a midterm paper. You will almost certainly hear and see my children, both with and without clothes. Your dog/cat/child/partner/roommate may join us inadvertently from time to time, or every time. All of this is fine. We will do our best.

### 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—at least in theory—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. Wherever possible, we will include and encourage discussion of the historical, cultural, and racial contexts in which trademark law arose, and how lawmakers have (and haven't) accommodated evolving norms.

### 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 7*. This text is available to read and/or download for free at <http://tmcasebook.org/>. The site also has a link to purchase a low-cost hardcopy version from Amazon for just under \$20.00 (you will need both [Volume 1](#) and [Volume 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 assessment (75%), with a potential adjustment based on class attendance and participation. The final assessment will be distributed in advance, and will be due on the last day of the exam period.

**Class Attendance & Participation**

Please plan to attend, on time, and come prepared for, all class meetings, whether live or online. 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. I will announce on-call students at the top of each class meeting. 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. All slides and other media will also be posted to the [course website](#).

**Recording Policy**

All class meetings will be recorded, transcribed, and posted to the [course website](#) for easy access anytime.

**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; Trademark Registration Process Overview	19-34, 247-253
2	Use in Commerce as Prerequisite for Rights <ul style="list-style-type: none"> <li>▪ <i>Aycock Engineering, Inc. v. Airflite, Inc.</i></li> <li>▪ <a href="#">Zazu Designs v. L'Oreal, S.A.</a></li> <li>▪ <a href="#">White v. Paramount Pictures Corp.</a></li> </ul>	227-233 & supplemental readings
3	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>	34-51
4	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>	51-63
5	Generic Marks <ul style="list-style-type: none"> <li>▪ <i>U.S. Patent and Trademark Office v. Booking.com</i></li> <li>▪ <i>Frito-Lay North America, Inc. v. Princeton Vanguard, LLC</i></li> </ul>	63-96
6	Nonverbal Marks: Trade Dress and Color; Product Packaging v. Product Configuration <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> <li>▪ <i>Wal-Mart Stores, Inc. v. Samara Bros, Inc.</i></li> </ul>	96-118

7	<p>Product Packaging Trade Dress: <i>Abercrombie v. Seabrook</i></p> <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>	128-142
8	<p>Guest Lecture</p> <ul style="list-style-type: none"> <li>▪ Tracy Gray, Partner at Holland &amp; Hart LLP, will discuss her adventures in trade dress practice</li> </ul>	Supplemental materials, if any, to be distributed
9	<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>	145-160
10	<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>	165-171, 177-187
11	<p>Deceptive and Deceptively Misdescriptive Marks</p> <ul style="list-style-type: none"> <li>▪ <a href="#"><i>In re California Innovations</i></a></li> <li>▪ <i>In re Nieves &amp; Nieves LLC</i></li> </ul>	187-198 & supplemental readings
12	<p>Disparaging and Scandalous Marks</p> <ul style="list-style-type: none"> <li>▪ <i>Matal v. Tam</i></li> <li>▪ <i>Iancu v. Brunetti</i></li> </ul>	199-226
13	<p><a href="#">Cultural Property &amp; Traditional Knowledge</a></p>	Supplemental readings

14	We will not meet for class. Your midterm project will be emailed out at the beginning of the day, and due at the end of the day. You may choose to use designated class time to complete the project, which may be completed on-site or online.	
15	The Geographic Extent of Trademark Rights <ul style="list-style-type: none"> <li>▪ <i>National Assoc. for Healthcare Comm. v. Central Arkansas Area Agency on Aging, Inc.</i></li> <li>▪ <i>Stone Creek, Inc. v. Omnia Italian Design</i></li> <li>▪ The Dawn Donut Rule</li> </ul>	277- 296
16	The Well-Known Marks Doctrine <ul style="list-style-type: none"> <li>▪ <i>Grupo Gigante SA v. Dallo &amp; Co., Inc.</i></li> <li>▪ <i>ITC Ltd. v. Punchgini, Inc.</i> (including Certified Questions)</li> <li>▪ <i>Belmora LLC v. Bayer Consumer Care AG</i></li> </ul>	300-336
17	Trademark Infringement: The Actionable Use Requirement <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> </ul>	337-352
18	Confusion-Based Infringement <ul style="list-style-type: none"> <li>▪ <i>Borden Ice Cream Co. v. Borden's Condensed Milk Co.</i></li> <li>▪ <i>Polaroid Corp v. Polarad Electronics Co.</i></li> <li>▪ <i>Virgin Enterprises Ltd. v. Nawab</i></li> </ul>	353-372
19	Surveys & 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>	376-391, 417-425, 437-447
20	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>	450-459, 466-488

21	<p>Cybersquatting; Secondary Liability</p> <ul style="list-style-type: none"> <li>▪ <i>Sporty's Farm</i></li> <li>▪ <i>Tiffany (NJ) Inc. v. eBay Inc.</i></li> <li>▪ <i>Gucci America, Inc. v. Frontline Processing Corp.</i></li> </ul>	488-496, 514-534
22	<p>Descriptive and Nominative Fair Use</p> <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>	539-551, 561-570
23	<p>Expressive Use</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>	580-592, 594-606 & supplemental readings
24	<p>Abandonment; The First Sale Doctrine &amp; Gray Market Goods</p> <ul style="list-style-type: none"> <li>▪ <i>ITC Ltd. V. Punchgini, Inc.</i></li> <li>▪ <i>Crash Dummy</i></li> <li>▪ <i>Champion Spark Plug Co. v. Sanders</i></li> <li>▪ <i>Davidoff &amp; CIE, SA v. PLD Int'l Corp.</i></li> </ul>	625-635, 648-653
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>▪ <i>Time Warner v. DirectTV</i></li> <li>▪ <i>Pizza Hut, Inc. v. Papa John's Intern., Inc.</i></li> </ul>	664-697
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> (including Kozinski's dissent)</li> <li>▪ <i>In re NCAA Student-Athlete Name &amp; Likeness Licensing Litigation</i></li> </ul>	751-785 & supplemental readings
27	In-class (Online) Final Exam Review	