

# TRADEMARK & UNFAIR COMPETITION

PROFESSOR KRISTELIA GARCÍA | *University of Colorado Law School*

Fall 2022 | Mondays & Wednesdays 10:30 am – 11:50 pm | Wolf Law 205 | [Course Website](#)

Office hours [by appointment](#) | Office: Wolf Law 425 | [kristelia.garcia@colorado.edu](mailto:kristelia.garcia@colorado.edu)

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## OVERVIEW

Welcome! This course will cover U.S. federal law relating to trademark; specifically: words, phrases, slogans, logos, trade dress, product packaging, 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 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.

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## PREREQUISITE(S)

None. If you have previously taken (or are simultaneously taking) Introduction to IP, we will invariably cover some of the same cases, possibly in greater detail, and with an eye toward the statutory nuances, historical context, and policy implications.

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## COURSE MATERIALS

The readings for this course will come primarily from the casebook: Barton Beebe, *Trademark Law: An Open-Source Casebook, Version 9*. This text is available to read and/or download for free at <http://tmcasebook.org/>. You can also purchase a low-cost hardcopy version from Amazon for just under \$20.00 (you will need both [Volume I](#) and [Volume 2](#)).

Other materials are available on the [course website](#), and may be downloaded at the links below.

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

You should feel free to use whichever third-party supplements you find helpful. Should you want a deeper dive, or clarification, on any of the topics discussed in class, [McCarthy on Trademarks and Unfair Competition](#), a leading treatise, is available on Westlaw and in hard copy in the library.

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## EVALUATION & GRADING POLICY

Your grade in this course will be based on (i) your performance on the midterm project (15%), (ii) your performance on the final assessment (75%), and (iii) the quality of your class participation (10%) as detailed in the section below.

The instructions for the midterm project will be distributed closer to the scheduled date. The final exam will be an in-class, open-book, open-note, three-hour exam. More detail on the format and coverage of the final examination will be provided closer to the respective exam date. Please check the law school's final exam schedule for the latest date and time information.

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## CLASS PARTICIPATION

Please plan to attend, and come prepared for, all class meetings. Attendance, preparation, participation, and professionalism all count toward the class participation grade. For each class meeting, I use a computerized algorithm to generate a list of students to be on call that day, after which volunteers are welcome. The algorithm I use departs from pure randomness so as to give everyone a fair opportunity to speak over the course of the semester. On any given day, someone who has never been on call has a greater chance of being called on than someone who has been on call once, and a much greater chance of being called on than someone who has been on call four times, and so on. This means that being on call one day makes you less likely to be on call the next, but please know that there's no guarantee, and your name could theoretically come up multiple days in a row. I will announce the on-call list at the start of each class meeting.

I understand that life happens. You can always take a pass. If you know you will be unprepared for a particular class meeting, I encourage you to nonetheless come to class (so that you might absorb whatever you can from lecture and discussion), and to please notify me by email at least 2 hours prior to lecture so that I can remove you from the queue. The same goes for isolated absences. In the case of a foreseen absence, I ask that you email me to let me know you will not be in class so that I can remove you from the on-call queue. You do not need to explain to me why you are taking a pass (and in some cases, it's probably better you don't ☺). I ask students to limit their passes to two per semester. Personal emergencies and/or illness are always excused. If either of these arise for you, please get in touch with me directly and you'll be excused without using up a pass. If a situation arises that will result in multiple absences or instances of unpreparedness, this should be brought to my attention. Otherwise, it will negatively affect your participation grade.

### **REMOTE ATTENDANCE & CLASS RECORDINGS**

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With the exception of any prerecorded lectures, all students are expected to attend class in-person for all class meetings. Students with a verified accommodation to attend remotely should discuss with me in advance so that I can enable Zoom for the approved class session(s). Please note that I cannot approve any such accommodations; they must be secured through the Dean's Office. By default, in-person class meetings will not be recorded. If you would like to request that a particular class session to be recorded, please speak with me in advance.

### **OFFICE HOURS**

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You can arrange an appointment with me for an office hour through my [online scheduling portal](#). If you do not see a time that works for you, please email me. I encourage students to sign up in groups, if helpful, and to feel free to invite classmates to join you during your appointment. When you go to book online, the portal will give the option of meeting in-person or via Zoom. Please note that the in-person option is only available on Mondays and Wednesdays.

### **AUDIO/VISUALS**

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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 work with you in making whatever accommodation may be helpful. All slides and other media will also be posted to the [course website](#) following each lecture.

### **LAPTOPS**

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Laptops are permitted in class for note-taking purposes only. Use of laptops or other electronic devices for any other purpose will be considered a violation of professional courtesies, will negatively affect your participation grade, and may result in loss of laptop privileges.

### **MAKE-UP CLASSES**

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

**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 generally send out an email with any reading updates, so please make sure I have your correct email address.

Page numbers below refer to the *Beebe* casebook. Supplemental readings and cases are linked in-line below. Listed cases indicate those most likely to be focused on in class discussion.

Class	Topics & Readings	Pages
1 Aug. 22 (M)	Introduction to Trademark Law <ul style="list-style-type: none"> <li>▪ <i>Trade-Mark Cases</i></li> </ul>	11-31
2 Aug. 24 (W)	Trademark Distinctiveness, the Abercrombie Spectrum, and Inherent Distinctiveness <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>	32-46
3 Aug. 29 (M)	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> Failure to Function as a Mark <ul style="list-style-type: none"> <li>▪ <i>In re Lee Greenwood</i></li> </ul>	52-62 107-112
4 Aug. 31 (W)	Generic Marks <ul style="list-style-type: none"> <li>▪ <i>U.S. Patent and Trademark Office v. Booking.com</i></li> <li>▪ <i>Snyder’s Lance, Inc. v. Frito-Lay North America, Inc.</i></li> </ul>	63-95
5 Sept. 7 (W)	Distinctiveness Analysis of 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> <li>▪ <i>Wal-Mart Stores, Inc. v. Samara Bros, Inc.</i></li> </ul>	115-136
6 Sept. 12 (M)	Product Packaging and Product Configuration <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>	146-161
7 Sept. 14 (W)	Bars to Protection: Utilitarian Functionality <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. [case summary]</i></li> <li>▪ <i>Traffix Devices, Inc. v. Marketing Displays, Inc.</i></li> <li>▪ <i>Apple, Inc. v. Samsung Electronics Co. Ltd.</i></li> </ul>	162-179, 184-190
8 Sept. 19 (M)	Bars to Protection: Aesthetic Functionality, Deceptive Marks, and False Suggestion of a Connection <ul style="list-style-type: none"> <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> <li>▪ <i>In re Nieves &amp; Nieves LLC</i></li> </ul>	192-194, 196-218
9 Sept. 21 (W)	Disparaging and Scandalous Marks <ul style="list-style-type: none"> <li>▪ <i>Matal v. Tam</i></li> </ul>	219-239

	<ul style="list-style-type: none"> <li>▪ <i>Iancu v. Brunetti</i></li> </ul>	
10 Sept. 26 (M)	Use as Prerequisite for Trademark Rights; Incontestability <ul style="list-style-type: none"> <li>▪ <i>Aycock Engineering, Inc. v. Airflite, Inc.</i></li> <li>▪ <i>Couture v. Playdom</i></li> <li>▪ <i>Park 'n Fly</i></li> </ul>	239-248, 281-289
11 Sept. 28 (W)	The Trademark Registration Process*	258-264, 271-281
12 Oct. 3 (M)	Guest Lecture	
13 Oct. 5 (W)	We will not meet for class. Your midterm project will be due at the end of the day.	
14 Oct. 10 (M)	The Geographic Extent of Trademark Rights and the Well-Known Marks Doctrine <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>▪ Pay attention to the notes on the <i>Dawn Donut Rule</i></li> <li>▪ <i>Grupo Gigante SA v. Dallo &amp; Co., Inc.</i></li> <li>▪ <i>ITC Ltd. v. Punchgini, Inc.</i> (skip the Certified Questions section)</li> <li>▪ <i>Belmora LLC v. Bayer Consumer Care AG</i></li> </ul>	289-299, 307-308, 314-336, 339-350
15 Oct. 11 (W)	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>	351-367
16 Oct. 17 (M)	Confusion-Based Infringement: The Contemporary Likelihood of Confusion Test <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>	367-387
17 Oct. 19 (W)	Survey Evidence, Post-Sale Confusion, and Reverse Passing Off <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>	391-406, 435-444, 459-471
18 Oct. 24 (M)	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>	474-484, 491-513
19 Oct. 26 (W)	Cybersquatting; Secondary Liability <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>	513-522, 539-559
20 Oct. 31 (M)	Descriptive and Nominative Fair Use <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>	564-576, 586-595

21 Nov. 2 (W)	Expressive Use of Trademarks and the Rogers Test <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>	605-617, 619-631 & linked case
22 Nov. 7 (M)	Abandonment; The First Sale Doctrine & Gray Market Goods <ul style="list-style-type: none"> <li>▪ <i>ITC Ltd. V. Punchgini, Inc.</i></li> <li>▪ <i>Crash Dummy Movie, LLC v. Mattel, Inc.</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>	644-654, 668-673
23 Nov. 9 (W)	<i>False Advertising</i> <ul style="list-style-type: none"> <li>▪ <i>S.C. Johnson &amp; Son, Inc. v. Clorox Co.</i></li> <li>▪ Pay attention to the note on the <i>Tropicana</i> case</li> <li>▪ <i>Time Warner v. DirecTV</i></li> <li>▪ <i>Pizza Hut, Inc. v. Papa John's Intern., Inc.</i></li> </ul>	682-714
24 Nov. 14 (M)	Endorsements and Social Media* <ul style="list-style-type: none"> <li>▪ <i>In the Matter of Lord &amp; Taylor</i></li> </ul>	738-767
25 Nov. 17 (W)	Rights of Publicity <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> (skim dissent)</li> <li>▪ <i>In re NCAA Student-Athlete Name &amp; Likeness Licensing Litigation</i> (skim dissent)</li> </ul>	768-803 & linked case
26 Nov. 28 (M)	Remedies* <ul style="list-style-type: none"> <li>▪ <i>Romag Fasteners, Inc. v. Fossil, Inc.</i></li> </ul>	810-821
27 Nov. 30 (W)	In-class Final Exam Review	