

Trademark and Unfair Competition Law
Syllabus Spring 2008 Version 4.0
 Prof. H. Tomás Gómez-Arostegui

Casebook: Graeme B. Dinwoodie and Mark D. Janis, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY (Aspen: 2d ed. 2007) plus the 2007-2008 STATUTORY SUPPLEMENT. Some readings will be posted on my class website as PDFs for you to download; they will be posted a week or so before the assigned readings: <http://www.lclark.edu/faculty/tomas/trademarks.html> [hereinafter WEB]. The casebook also maintains its own electronic supplement, which we will begin to use once we reach Chapter 7 of the book. The electronic supplement does not contain additional cases; rather, it contains archived screen shots of various websites that will be used for the problem sets. The electronic supplement is maintained at http://www.uiowa.edu/%7Etmlaw/tm_website/index.html. I will provide a password later in the semester.

Reading Assignments: The syllabus will be distributed in parts as we progress throughout the course. I will post each part to the WEB as needed. Please note that we will not always discuss all the assigned materials in class (in particular some of the notes). I usually (but not always) qualify those assignments by asking you to merely SKIM them. Though you are responsible for all the assigned materials, whether discussed or not, I consider the material we discuss in class to be the most important.

Meeting Time: We meet every Monday and Wednesday, 4:00 to 5:30 pm, in Classroom 8.

Contact Info and Office Hours: My office is on the top floor of the Legal Research Center, No. 320 (next to Dean Klonoff's office). My phone number is 503-768-6816, and my e-mail is tomas@lclark.edu. My office hours are the hours I am not teaching, so feel free to drop by any time. If you want to make sure I will be around when you drop by, just contact me and we can schedule an appointment.

Student Evaluation: Your grade for the course will be based upon a final examination at the end of the semester. The exam will be open book, meaning that you may bring in your casebook, any handouts or supplementary materials I provided to you, and any printed notes or outlines that you prepared or took a substantial part in preparing. Class participation may also affect your grade. Your participation may merit a one-step upward or one-step downward adjustment from your exam grade, or (as is more often the case) it may not merit any adjustment at all. I will consider both the quantity and quality of your participation.

Student Obligations: You are required to attend class (be on time please), read the assignments, and participate in discussions relating to those assignments. Though I will take volunteers, I will also call on people without prior notice. If you are unprepared on a particular day, please let me know before class and I will not call on you. If you feel uncomfortable with public speaking, please come see me.

Class & Day	Topics	[Approx. Total Pages for Class Session]	Notes
[01] Mon 1/14	I. Introduction A. Sources and Nature of Trademark Rights [3–12] B. The Nature of Unfair Competition Law [12–14] C. Purposes of Trademark Law [15–17] D. Modern Marketing and Trademark Law [17–26] E. An Illustration [26–40]	[36pp]	SKIM Note: TM and Copyright on pp 10–12

[02] Wed 1/16	<p>II. Distinctiveness [43–45]</p> <p>A. The Spectrum of Distinctiveness [45–54]</p> <p>B. Descriptiveness and Secondary Meaning [54–63]</p>	[21pp]	
[—] Mon 1/21	MARTIN LUTHER KING, JR. DAY		
[03] Wed 1/23	<p>C. Generic Terms [64–86]</p> <p>D. Distinctiveness of Nonverbal Identifiers: Logos, Packages, Product Design, and Colors</p> <p>1. Different Tests, Different Standards? [86–91]</p>	[27pp]	
[04] Mon 1/28	<p>2. Expanding the Types of Nonverbal Marks [91–104]</p> <p>3. The Design/Packaging Distinction [104–113]</p> <p>4. Trade Dress Protection After <i>Wal-Mart</i> [113–123]</p>	[33pp]	
[05] Wed 1/30	<p>E. The Edge of Trademark Protection: Subject-Matter Exclusions? [123–146]</p>	[23pp]	
[06] Mon 2/4	<p>III. Functionality [147–184]</p> <p>A. An Introduction to the Concept of Functionality [147–158]</p> <p>B. The Scope of the Functionality Doctrine [158–166]</p> <p>C. The Modern Supreme Court Approach to Functionality [166–184]</p>	[38pp]	
[07] Wed 2/6	<p>_. The Modern Supreme Court Approach to Functionality (cont.) [184–191]</p> <p>D. Post-<i>Traffix</i> Applications of the Functionality Doctrine [191–214]</p>	[31pp]	
[08] Mon 2/11	<p>IV. Use [215]</p> <p>A. “Use” as a Jurisdictional Prerequisite [215–217]</p> <p>B. “Use” as a Prerequisite for Establishing Rights [217–244]</p>	[30pp]	

[09] Wed 2/13	[32pp] _ “Use” as a Prerequisite for Establishing Rights (cont.) [244–262] C. “Surrogate” Uses [262–275]	
[10] Mon 2/18	[27pp] D. Loss of Rights Through Non-Use or Uncontrolled Uses [275–301]	
[11] Wed 2/20	[30pp] V. Registration [303] A. The Registration Process 1. Overview of Relevant Provisions [303–311] 2. Post-Registration Actions [311–312] B. Exclusions From Registration 1. Overview [312–313] 2. Scandalous, Disparaging, and Deceptive Marks Under Section 2(a) [313–332]	
[12] Mon 2/25	[32pp] 3. Geographic Marks [332–347] 4. Name Marks [348–355] C. Incontestability [355–363]	
[—] Wed 2/27	[Gap due to previously canceled class]	
[13] Mon 3/3	[22pp] VI. Geographic Limits on Trademark Rights A. Geographic Limits on Common Law Rights: <i>Tea Rose</i> Doctrine [367–372] B. Geographic Limits and Registered Rights [373–388]	
[14] Wed 3/5	[34pp] C. The Territorial Nature of U.S. Trademark Rights [388–422]	
[15] Mon 3/10	[20pp] D. Extraterritorial Enforcement of U.S. Trademark Rights [422–442]	
[16] Wed 3/12	[37pp] VII. Confusion-Based Trademark Liability Theories [443–444]	

	<p>A. Evolution of the Confusion Standard [444–453]</p> <p>B. The Actionable “Use” Prerequisite [453–479]</p>	
[17] Mon 3/17	<p>C. The Factors Analysis for Likelihood of Confusion [479–508]</p>	[30pp]
[18] Wed 3/19	<p>C. The Factors Analysis for Likelihood of Confusion [508–520]</p> <p>D. Applying the Multi-Factor Test [520–521]</p> <ol style="list-style-type: none"> 1. Internet [521–525] 2. Private-Label Goods [525–526] 3. Promotional Goods [526–532] 4. Section 2(d) Confusion [532–534] 	[26pp]
[—] Mon 3/24	SPRING BREAK	
[—] Wed 3/26	SPRING BREAK	
[19] Mon 3/31	<p>E. Confusion Away from the Point of Sale [534–535]</p> <ol style="list-style-type: none"> 1. Initial Interest Confusion [535–558] 2. Post-Sale Confusion [558–564] <p>F. Reverse Confusion [564–573]</p>	[40pp]
[20] Wed 4/2	<p>VIII. Non-Confusion-Based Trademark Liability Theories [585]</p> <p>A. Dilution Protection [585–586]</p> <ol style="list-style-type: none"> 1. Historical Foundations [586–591] 2. Dilution Under the Federal Trademark Dilution Act of 1995 [591–593] 3. Dilution Under the Trademark Dilution Revision Act of 2006 [594–598] 4. The Forms of Dilution [598–599] <ol style="list-style-type: none"> a. <i>Tarnishment</i> [600–603] b. <i>Blurring</i> [603–610] 5. Dilution Under Lanham Act Section 2(f) [610–611] 	[27pp]

[21] Mon 4/7	[27pp]	
	<p>B. Protection Against Cybersquatting [611]</p> <ol style="list-style-type: none"> 1. Protection Under the Dilution Statute [611–615] 2. Anticybersquatting Consumer Protection Act: Section 43(d) of the Lanham Act [615–620; 625–635] 3. ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) [638–644] 	
[22] Wed 4/9	[33pp]	
	<p>IX. Permissible Uses of Another’s Trademarks [663]</p> <p>A. Fair Use of Another’s Trademark [663]</p> <ol style="list-style-type: none"> 1. Descriptive Fair Use [664–680] 2. Nominative Fair Use [680–695] 	
[23] Mon 4/14	[26pp]	
	<p>B. Use of Another’s Trademark on Genuine Goods: “First Sale” Doctrine [695–720]</p>	
[24] Wed 4/16	[30pp]	
	<p>C. Use of Another’s Trademark in Parody or Speech [720–742; <i>Louis Vuitton Malletier v. Haute Diggity Dog</i>, 507 F.3d 252 (4th Cir. 2007)—D/L from Westlaw]</p>	<i>Vuitton</i> case: focus on the parody part
[25] Mon 4/21	[28pp]	
	<p>X. False Advertising</p> <p>A. Introduction: The Evolution of Section 43(a) False Advertising Claims [743–746]</p> <p>B. Threshold Issues [746–748]</p> <p>C. Elements of the Section 43(1)(1)(B) False Advertising Claim [748–770]</p>	
[26] Wed 4/23	[28pp]	
	<p>XII. Remedies [829]</p> <p>A. Injunctive Relief [829–835]</p> <p>B. Monetary Relief [835–855]</p> <p>C. Other Remedies [855–856]</p>	
[27] Mon 4/28	[23pp]	
	<p>XIII. Trademark Transactions [859]</p> <p>A. Assignment of Trademarks [859–869]</p>	

	<p>B. Licensing of Trademarks [870–875]</p> <p>C. Settlement Agreements Arising out of Trademark Disputes [875–881]</p>	
[28] TBD	<p>REVIEW SESSION: Please e-mail your questions to me 24 hours before class (to better enable me to answer them) or just ask your questions during the session.</p>	