

Trademark and Unfair Competition Law
Syllabus Spring 2011 Version 4.5
 Prof. H. Tomás Gómez-Arostegui

Casebook: Graeme B. Dinwoodie and Mark D. Janis, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY (Aspen: 3d ed. 2010). Class website: <http://www.lclark.edu/faculty/tomas/trademarks.html>.

Reading Assignments: 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 Tuesday and Thursday, 8:00 p.m. to 9:20 p.m., in Classroom 7.

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 anything under the sun, so long as it is in hardcopy format, e.g., your casebook, hornbooks, any handouts or supplementary materials I provided to you, and any printed or handwritten notes or outlines. 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. The ABA requires all ABA-accredited schools to have a posted **attendance policy**. Mine is as follows: If you have four (4) unexcused absences in our class, you will be docked a grade. So, if your final exam score was an A-, for example, your grade in the class will drop to a B+. If you have six (6) unexcused absences, you will be docked two grade levels. So, if you started with an A-, you would end up with a B. Eight (8) or more unexcused absences could lead to you being dropped from the class entirely and having to re-take Trademarks.

| Class & Day | Topics | [Approx. Total Pages for Class Session] | Notes |
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| [01] Tues 1/11 | 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 [18–26] E. An Illustration [27–40] | [36pp] | SKIM Note: TM and Copyright on pp 11–12 SKIP nn. 3-4 on p 23–24 |

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| [02] Thu 1/13 | <p style="text-align: right;">[23pp]</p> <p>II. Distinctiveness [45–47]</p> <p>A. The Spectrum of Distinctiveness [47–56]</p> <p>B. Descriptiveness and Secondary Meaning [56–68]</p> | |
| [03] Tues 1/18 | <p style="text-align: right;">[27pp]</p> <p>C. Generic Terms [68–92]</p> <p>D. Distinctiveness of Nonverbal Identifiers: Logos, Packages, Product Design, and Colors</p> <p>1. Different Tests, Different Standards? [92–96]</p> | SKIP n. 3 on p 82 and n. 6 on pp 83; Problems 2-3 and 2-4 |
| [04] Thu 1/20 | <p style="text-align: right;">[34pp]</p> <p>2. Expanding the Types of Nonverbal Marks [97–111]</p> <p>3. The Design/Packaging Distinction [111–120]</p> <p>4. Trade Dress Protection After <i>Wal-Mart</i> [120–131]</p> | SKIP Problem 2-5 |
| [05] Tues 1/25 | <p style="text-align: right;">[25pp]</p> <p>E. The Edge of Trademark Protection: Subject-Matter Exclusions? [131–155]</p> | |
| [06] Thu 1/28 | <p style="text-align: right;">[38pp]</p> <p>III. Functionality</p> <p>A. An Introduction to the Concept of Functionality [157–168]</p> <p>B. The Scope of the Functionality Doctrine [168–176]</p> <p>C. The Modern Supreme Court Approach to Functionality [176–194]</p> | |
| [07] Tues 2/1 | <p style="text-align: right;">[32pp]</p> <p>D. The Modern Supreme Court Approach to Functionality (cont.) [195–202]</p> <p>D. Post-Traffix Applications of the Functionality Doctrine [202–226]</p> | SKIP Problem 3-3 |
| [08] Thu 2/3 | <p style="text-align: right;">[30pp]</p> <p>IV. Use</p> <p>A. “Use” : Jurisdictional Prerequisite [227–229]</p> <p>B. “Use” : Prerequisite for Establishing Rights [229–56]</p> | |

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| [09] Tues 2/8 | <p style="text-align: right;">[32pp]</p> <p>–. “Use” : Prerequisite for Establishing Rights (cont.) [256–277]</p> <p>C. “Surrogate” Uses [277–87]</p> | SKIP Problems 4-6 and 4-7 |
| [--] Thu 2/10 | Class Canceled | |
| [10] Tues 2/15 | <p style="text-align: right;">[25pp]</p> <p>D. Loss of Rights Through Non-Use or Uncontrolled Uses [290–315]</p> | SKIP Problems 4-12 and 4-13 and The Sports Heritage Act |
| [11] Thu 2/17 | <p style="text-align: right;">[29pp]</p> <p>V. Registration</p> <p>A. The Registration Process</p> <ol style="list-style-type: none"> 1. Overview of Relevant Provisions [317–325] 2. Post-Registration Actions [325–327] <p>B. Exclusions From Registration</p> <ol style="list-style-type: none"> 1. Overview [327] 2. Scandalous, Disparaging, and Deceptive Marks Under Section 2(a) [327–347] | SKIP Problems 5-3, 5-4, 5-5, and 5-6 |
| [12] Tues 2/22 | <p style="text-align: right;">[31pp]</p> <ol style="list-style-type: none"> 3. Geographic Marks [347–363] 4. Name Marks [363–370] <p>C. Incontestability [370-379]</p> | |
| [--] Thu 2/24 | Class canceled—Snow | |
| [--] Tues 3/1 | Distinguished IP Visitor Lecture—Class canceled | |

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| [13] Thu 3/3 | <p style="text-align: right;">[21pp]</p> <p>VI. Geographic Limits on Trademark Rights</p> <p>A. Geographic Limits on Common Law Rights: <i>Tea Rose</i> Doctrine [383–388]</p> <p>B. Geographic Limits and Registered Rights [389–399]</p> <p>C. The Territorial Nature of U.S. Trademark Rights [399–403]</p> | |
| [14] Tues 3/8 | <p style="text-align: right;">[29pp]</p> <p>C. The Territorial Nature of U.S. Trademark Rights [403–431]</p> | |
| [15] Thu 3/10 | <p style="text-align: right;">[27pp]</p> <p>C. The Territorial Nature of U.S. Trademark Rights [432–438]</p> <p>D. Extraterritorial Enforcement of U.S. Trademark Rights [438–458]</p> | <p>SKIP Problems 6-4 and 6-6 but READ Problems 6-3 and 6-5</p> <p>SKIP n. 8 on p. 458</p> |
| [16] Sat 3/12 Make-Up Sess. | <p style="text-align: right;">[33pp]</p> <p>VII. Confusion-Based Trademark Liability Theories [459–460]</p> <p>A. Evolution of the Confusion Standard [460–469]</p> <p>B. The Actionable “Use” Prerequisite [469–491]</p> | |
| [17] Sat 3/12 Make-Up Sess. | <p style="text-align: right;">[30pp]</p> <p>C. The Factors Analysis for Likelihood of Confusion [505–534]</p> | <p>SKIP Problems 7-2 and 7-3 but READ Problems 7-4 and 7-5</p> |
| [18] Tues 3/15 | <p style="text-align: right;">[17pp]</p> <p>C. The Factors Analysis for Likelihood of Confusion [535–544]</p> <p>D. Applying the Multi-Factor Test</p> <p>2. Private-Label Goods—Problem 7-8 [547–549]</p> <p>3. Promotional Goods [549–551]</p> <p>4. Section 2(d) Confusion [555–557]</p> | <p>READ Problems 7-8, 7-10, and 7-11 but SKIP all others</p> |
| [19] Thu 3/17 | <p style="text-align: right;">[22pp + 7pp to skim]</p> | |

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| | E. Confusion Away from the Point of Sale [558] 1. Initial Interest Confusion [558–574] 2. Post-Sale Confusion [574–580] F. Reverse Confusion [580-587] | SKIM |
| [--] Tues 3/22 | SPRING BREAK | |
| [—] Thu 3/24 | SPRING BREAK | |
| [20] Tues 3/29 | <div style="text-align: right;">[33pp]</div> VIII. Non-Confusion-Based Trademark Liability Theories A. Dilution Protection [609–610] 1. Historical Foundations [610–615] 2. Dilution Under the Federal Trademark Dilution Act of 1995 [615–618] 3. Dilution Under the Trademark Dilution Revision Act of 2006 [618–623] 4. The Forms of Dilution [623–624] a. <i>Tarnishment</i> [625–635] b. <i>Blurring</i> [635–641] | READ Problem 8-1 |
| [21] Thu 3/31 | <div style="text-align: right;">[26pp]</div> B. Protection Against Cybersquatting [647] 1. Protection Under the Dilution Statute [647–651] 2. Anticybersquatting Consumer Protection Act: Section 43(d) of the Lanham Act [651–656; 662–672] 3. ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) [675–681] | |
| [22] Tues 4/5 | <div style="text-align: right;">[29pp]</div> IX. Permissible Uses of Another’s Trademarks A. Fair Use of Another’s Trademark [703] 1. Descriptive Fair Use [704–717] 2. Nominative Fair Use [721–734] | |
| [23] Thu 4/7 | <div style="text-align: right;">[27pp]</div> B. Use of Another’s Trademark on Genuine Goods: “First Sale” Doctrine [737–763] | |
| [24] Tues 4/12 | <div style="text-align: right;">[31pp]</div> C. Use of Another’s Trademark in Parody or Speech [764–794] | |

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| [24] Tues 4/12 | <p style="text-align: right;">[31pp]</p> <p>C. Use of Another's Trademark in Parody or Speech [764–794]</p> | |
| [25] Thu 4/14 | <p style="text-align: right;">[27pp]</p> <p>X. False Advertising</p> <p>A. Introduction: The Evolution of Section 43(a) False Advertising Claims [803–806]</p> <p>B. Threshold Issues [806–809]</p> <p>C. Elements of the Section 43(1)(1)(B) False Advertising Claim [809–829]</p> | |
| [26] Tues 4/19 | <p style="text-align: right;">[30pp]</p> <p>XII. Remedies [897]</p> <p>A. Injunctive Relief [897–907]</p> <p>B. Monetary Relief [908–926]</p> | |
| [27] Thu 4/21 | <p style="text-align: right;">[19pp]</p> <p>XIII. Trademark Transactions [937]</p> <p>A. Assignment of Trademarks [937–945]</p> <p>B. Licensing of Trademarks [948–951]</p> <p>C. Settlement Agreements Arising out of Trademark Disputes [953–959]</p> <p>PLUS REVIEW SESSION: Please e-mail your questions to me</p> | |