

Loyola Law School
TRADEMARK LAW
Spring 2016

Overview, basic information and syllabus

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BASIC INFORMATION and SYLLABUS – version 01

Class room: Hall of the 80's

Class hours: Mondays and Wednesday, 6:00-7:30pm

Materials: GINSBURG, LITMAN, AND KEVLIN, TRADEMARK AND UNFAIR COMPETITION LAW (5th edition, 2013) and *additional supplemental materials* on TWEN. In casebook, do **not** read authors' "PROBLEMS" and "NOTES AND QUESTIONS" in assigned pages unless specifically directed in this syllabus.

Office hours: Burns 314, Mondays and Wednesdays, 3-5pm *but appointments by email are welcome and preferable*

Evaluation and Class Format:

Grading in the course will be based on a final examination. In addition, class participation may be used to adjust grades upward or downward. Students are expected to be prepared each class to participate based on class readings. Internet use during class is strictly FORBIDDEN.

Students found to be using the internet during class will have their final grade lowered significantly.

SYLLABUS
version 01 – 04 January 2016

I. THE DOMINANT FRAMEWORK

| | | | |
|-----------------|-------|-------|---|
| <i>Casebook</i> | pages | 57-66 | [to <i>Peaceable Planet</i>] |
| | | 70-85 | [<i>Qualitex</i> until <i>Abercrombie</i>] |
| | | 41-48 | [excerpts from Brown, Landes & Posner articles] |
| | | 29-31 | [<i>Hanover</i> case] |
| | | 38-40 | [<i>Champion Spark Plug</i> case] |

II. ALTERNATIVE FRAMEWORKS

| | | | |
|---------------------|-------|-------|--|
| <i>Casebook</i> | pages | 31-35 | [<i>Stork Club</i> case] |
| | | 7-9 | [through <i>International News Service</i> case] |
| | | 53-56 | ["Breakfast with Batman"] |
| <i>TWEN reading</i> | | | <i>Ringling Bros v. Celozzi-Ettelson</i> case |

III. Trademarks in the bigger world of IP

| | | | |
|-----------------|-------|---------|--|
| <i>Casebook</i> | pages | 21-29 | ["B. Trademarks" to <i>Hanover</i>] |
| | | 115-119 | ["collective and certification marks"] |

Acquisition of Rights

IV. DISTINCTIVENESS IN A TRADEMARK

| | | | |
|----------------------|-------|-------|--|
| <i>Casebook</i> | pages | 85-89 | [<i>Abercrombie & Fitch</i> and <i>In re Quik-Print</i>] |
| <i>TWEN readings</i> | | | Pages 87-103 of 4 th Edition [<i>American Waltham Watch v. U.S. Watch</i> , <i>International Kennel Club of Chicago</i> , Restatement (Third), and <i>Rock & Roll Hall of Fame and Museum v. Gentile</i>] |

V. ACQUISITION OF TRADEMARK RIGHTS THROUGH USE

| | | | |
|---------------------|-------|-----------|--|
| <i>TWEN reading</i> | | | <i>Proctor & Gamble v. Johnson & Johnson</i> |
| <i>Casebook</i> | pages | 136 – 137 | [C. "Use in Commerce"] |
| | pages | 140 - 143 | [<i>Larry Harmon Pictures</i> to "Questions"] |
| <i>TWEN reading</i> | | | <i>Maryland Stadium Authority v. Becker</i> , 806 F. Supp 1236 (D. Md. 1992) |
| <i>Casebook</i> | pages | 152 – 174 | [<i>Blue Bell Inc.</i> through <i>Dawn Donuts</i>] |

VI. THE REGISTRATION PROCESS AND "INTENT TO USE"

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|-----------------|-------|-----------|--|
| <i>Casebook</i> | pages | 177 - 197 | ["A. The Bases and Process" through <i>Laramie Corp.</i>] |
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VII. BARS TO REGISTRATION

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|---------------------|-------|---------|--|
| <i>Casebook</i> | pages | 203-207 | [<i>In re Fox</i>] |
| <i>TWEN reading</i> | | | <i>In re Squaw Valley</i> , 80 U.S.P.Q.2d 1264 (TTAB, 2 June 2006) <i>In re Simon Shiao Tam</i> , Fed. Circuit, 2014-1203, 22 December 2015 |
| <i>Casebook</i> | pages | 219-223 | [<i>Bayer Aktiengesellschaft</i> through "Note: the |

| | | |
|--------------|-----------|---|
| | | Differences Between Deceptive Terms” and “Deceptively Misdescriptive’ Terms] |
| pages | 229-232 | [“2. Sections 2(b) and 2(c) . . .” through <i>In re Hoefflin</i>] |
| | 248 - 252 | [“4. Section 2(e)(2). . .” through <i>In re Joint Company . .</i>] |
| | 260- 275 | [“Note: Geographically Suggestive” Marks to <i>In re</i> <i>Vertex Group</i> ; skip questions in all sections] |
| | 232 | [statutory provision only, Lanham § 2(d)] |
| | 242 - 244 | [<i>Nutrasweet v. K&S Foods, Inc.</i>] |
| TWEN reading | | <i>Marshall Field & Co. v. Mrs. Fields</i> , 25 U.S.P.Q.2d 1321 (TTAB, 1992) |

Confusion-based Infringement

VIII. INFRINGEMENT AND THE LIKELIHOOD OF CONFUSION

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|----------|-------|-----------|--|
| Casebook | pages | 349 | [statutory provision, 15 USC § 32(1)] |
| | | 366 – 398 | [“B Likelihood of Confusion” to Questions] |
| | | 402 – 420 | [<i>Mobil Oil</i> to Questions] |
| | | 422 – 423 | [<i>Mastercrafters Clock</i>] |
| | | 426 – 435 | [<i>Munsingwear</i> through <i>Dreamwerks v. SKG Studio</i>] |
| | | 468 - 474 | [<i>Two Pesos, Inc. v. Taco Cabana</i>] |
| | | 444 - 450 | [contributory and vicarious liability; <i>Inwood</i> .] |
| | | 452 – 456 | [<i>Tiffany v. eBay</i>] |

IX. SPEECH DEFENSES, INCLUDING PARODY

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|----------|-------|-----------|---|
| Casebook | pages | 557 – 561 | [“Fair use” and <i>United States Shoe Corp</i>] |
| | | 592 - 597 | [“Nominative Fair Use” - <i>New Kids on the Block</i>] |
| | | 600 - 605 | [WCVB-TV case through <i>Toyota v. Tabar</i>] |
| | | 654 – 660 | [<i>Mattel</i> (“Barbie”) cases] |

X. DILUTION LAW

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|----------|-------|-----------|---|
| Casebook | pages | 688 – 693 | [Federal dilution, through <i>National Pork Board</i>] |
| | | 732 - 736 | [<i>Hershey v. Art Van</i>] <i>Other Issues</i> |

XI. GENERICNESS

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|----------|-------|---------|--|
| Casebook | pages | 279-294 | [through <i>E.I. DuPont v. Yoshida International</i>] |
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XII. FAILURE TO CONTROL/ ABANDONMENT

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|----------|-------|-----------|---|
| Casebook | pages | 333 – 338 | [<i>Clark & Freeman, Eva’s Bridal Ltd.</i>] |
| | | 315 - 320 | [“B. Abandonment” through <i>Silverman v. CBS</i>] |

XV. REMEDIES

I will provide a summary discussion of remedies -- no reading required

End of syllabus, version 01

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THIS IS AVAILABLE ON THE TWEN SYSTEM