

Loyola Law School  
TRADEMARK LAW  
Fall 2017

Professor Justin Hughes  
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**BASIC INFORMATION and SYLLABUS – version 01**

**Class room:**

R205 in the Library

**Class hours:**

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

We will **NOT** have class on **Wednesday, 6 September** and probably **NOT** on **Monday, 23 October** and **Wednesday, 25 October**.

Assume that we **WILL** have make-up classes on **Monday, 9 October** [an “open class” day] as well as **Monday, 27 November** and/or **Tuesday, 28 November** [“flex” days]. I will do everything I can to make sure that the make-up classes are at the same time and in the same room; please reserve these dates on your calendar.

**Materials:**

**GINSBURG, LITMAN, AND KEVLIN, TRADEMARK AND UNFAIR COMPETITION LAW** and *additional supplemental materials* on TWEN.

In that case book, do **not** read authors’ “PROBLEMS” and “NOTES AND QUESTIONS” in assigned pages *unless specifically directed in this syllabus*.

NOTE that there are two available editions of this case book: the 5<sup>th</sup> edition (2013) and the 6<sup>th</sup> edition (2017). I recommend that you buy the 5<sup>th</sup> edition – new or used. The LLS book store is stocking the 5<sup>th</sup> edition. **But this syllabus also includes the corresponding pages of the new, 6<sup>th</sup> edition.**

**Office hours:**

Burns 314, Mondays and Wednesdays, 3:30-5pm *unless otherwise announced*.

## Evaluation and Class Format:

Grading in the course will be based on a final, 24-hour take-home 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 - 07 August 2017

		FIFTH EDITION	SIXTH EDITION	
I.	THE DOMINANT FRAMEWORK			
	Casebook	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			
	Casebook	pages	31-35	[ <i>Stork Club</i> case]
			7-9	[to <i>Cheney Bros. v. Doris Silk</i> ]
			53-56	[ <i>Breakfast with Batman</i> ]
	TWEN reading			<i>Ringling Bros v. Celozzi-Ettelson</i> case
III.	TMS IN THE BIGGER WORLD OF IP			
	Casebook	pages	21-29	["B. Trademarks" to <i>Hanover</i> ]
			115-119	["collective and certification marks"]
	<i>Acquisition of Rights</i>			
IV.	DISTINCTIVENESS IN A TRADEMARK			
	Casebook	pages	85-89	89-92 [ <i>Abercrombie &amp; Fitch, In re Quik-Print</i> ]
	TWEN readings		Pages 87-103 of 4 <sup>th</sup> Edition [ <i>American Waltham Watch v. U.S. Watch, International Kennel Club of Chicago, Restatement (Third), and Rock &amp; Roll Hall of Fame and Museum v. Gentile</i> ]	

		FIFTH EDITION	SIXTH EDITION	
V.	ACQUISITION OF TRADEMARK RIGHTS THROUGH USE			
	TWEN reading	<i>Proctor &amp; Gamble v. Johnson &amp; Johnson</i>		
	Casebook pages	136-137	140	[15 U.S.C. § 1127 until Note]
		140-143	144-146	[ <i>Larry Harmon Pictures</i> ]
	TWEN reading	<i>Maryland Stadium Authority v. Becker</i> (D. Md. 1992)		
	Casebook pages	152-158	158-164	[ <i>Blue Bell Inc.</i> ]
		161-174	167-180	[ <i>United Drug</i> through <i>Dawn Donuts</i> ]
VI.	THE REGISTRATION PROCESS AND "INTENT TO USE"			
	Casebook pages	177-178	183-184	[thru 15 U.S.C. § 1051(b)]
		180-197	190-208	["Note: . . . Section 44" thru <i>Laramie Corp. v. Talk to Me</i> ]
VII.	BARS TO REGISTRATION			
	Casebook pages	203-207	213-218	[Section 2(a), <i>In re Fox</i> ]
	TWEN reading	<i>Matal v. Tam</i> , U.S. Supreme Court, 19 June 2017		
	Casebook pages	219-223	231-235	[ <i>Bayer Aktiengesellschaft</i> thru "Note: the Differences . . ."]
		229-232	242-245	["2. Sections 2(b) and 2(c) . . ." thru <i>In re Hoefflin</i> ]
		248-252	<i>In re Joint Stock Company supplement</i>	
		260-275	278-291	["Note: Geographically Suggestive" Marks to <i>In r</i> <i>Vertex Group</i> ]
		232	245	[Lanham § 2(d) only]
	TWEN reading	<i>Nutrasweet v. K&amp;S Foods, Inc.</i> , 4 U.S.P.Q.2d 1964 (T.T.A.B. 1987)		
		<i>Marshall Field &amp; Co. v. Mrs. Fields</i> , 25 U.S.P.Q.2d 1321 (TTAB, 1992)		
		<i>B&amp;B Hardware, Inc. v. Hargis Industries, Inc.</i> , 135 S. Ct. 1293 (2015).		
	<i>Confusion-based Infringement</i>			
VIII.	INFRINGEMENT AND THE LIKELIHOOD OF CONFUSION			
	Casebook pages	349	365	[15 USC § 32(1)]
		366-398	383-416	["B Likelihood of Confusion" to Questions]
		402-417	420-429	[through <i>Network Automation</i> ]
		422-423	438-440	[ <i>Mastercrafters Clock</i> ]
		426-435	442-451	[ <i>Munsingwear</i> thru <i>Dreamwerks</i> ] <i>Harlem Wizards</i> case

			FIFTH EDITION	SIXTH EDITION	
			468-474	484-490	[ <i>Two Pesos, Inc. v. Taco Cabana</i> ]
			444-450	463-469	[Secondary liability; <i>Inwood</i> .]
			452-456	471-474	[ <i>Tiffany v. eBay</i> ]
<b>IX.</b>	<b>SPEECH DEFENSES, INCLUDING PARODY</b>				
	Casebook	pages	557-561	572-576	["Fair use," <i>United States Shoe</i> ]
			592-597	608-613	[Nominative Fair Use," <i>New Kids on the Block</i> ]
			600-605	619-623	[ <i>WCVB-TV, Toyota v. Tabar</i> ]
			654-657	661-664	[ <i>Mattel v. Universal Music</i> ]
			657-660	669-670	[ <i>Mattel v. Walking Mountain</i> ]
<b>X.</b>	<b>DILUTION LAW</b>				
	Casebook	pages	688-693	701-712	[Federal dilution thru <i>National Pork Board</i> ]
			732-736	742-744	[ <i>Hershey v. Art Van</i> ]
	<i>Other Issues</i>				
<b>XI.</b>	<b>GENERICNESS</b>				
	Casebook	pages	279-296	295-304	[through <i>DuPont v. Yoshida</i> ]
				305-310	[in 6 <sup>th</sup> , skip <i>Elliot v. Google</i> ]
<b>XII.</b>	<b>FAILURE TO CONTROL/ ABANDONMENT</b>				
	Casebook	pages	333-338	348-354	[ <i>Clark &amp; Freeman, Eva's Bridal</i> ]
			315-320	331-337	["B. Abandonment" through <i>Silverman v. CBS</i> ]
<b>XV.</b>	<b>REMEDIES</b>				
					<i>I will provide a summary discussion of remedies ~ no reading required</i>



End of syllabus, version 01

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THIS IS AVAILABLE ON THE TWEN SYSTEM