

Loyola Law School
TRADEMARK LAW

Fall 2021 / **Syllabus VERSION 2.2**

Professor Justin Hughes

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BASIC INFORMATION

This syllabus is premised on Loyola Law School resuming in-person, in-class sessions in the fall semester; syllabus will be revised to reflect any significant developments.

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

All times listed for this class are in Pacific Standard/Daylight Time (PST/PDT).

We will probably **NOT** have classes on two **Wednesdays, 1 September, and 29 September.**

Students should schedule and plan to attend Trademark Law class on **Monday, 4 October** [LLS Flex Day], **Friday, 19 November** [LLS Flex Day], and **Tuesday, 23 November** [LLS Flex Day].

These will be used for needed make-up classes and/or a review session. Access to recordings of make-up classes will not be made available to students without compelling justification.

Class room for in-person meetings: Hall of the 80s

Required Materials:

GINSBURG, LITMAN, AND KEVLIN, *TRADEMARK AND UNFAIR COMPETITION LAW* (6th edition, Carolina Academic Press, 2017) and *additional supplemental materials* on Brightspace. In that case book, do not read authors' "QUESTIONS" or "NOTES" in assigned pages *unless specifically directed in this syllabus.*

Attendance:

Section 3.2 of the JD Handbook states, "A student is required to attend classes regularly. A student may be withdrawn, and/or excluded from an examination, and given a failing grade in any course in which the student has not maintained a satisfactory attendance record."

Course routine:

Each student is responsible to read, understand, and abide by Professor Hughes' "rules of the road" memo

<[m-rulesoftheroadTM.pdf](#)> on Brightspace which describe how the course will be conducted; what you can expect from Professor Hughes; and what Professor Hughes will expect of you.

Evaluation:

Grading in the course will be based principally on a 24-hour take home examination at the end of the semester.

In addition, class participation may be used to adjust grades upward or downward for a limited number of students. Students are expected to be prepared each class to participate based on class readings.

For in-person class meetings held at the Law School, internet use by students attending in-person classes is strictly FORBIDDEN unless otherwise specific. Students found to be using the internet during class may have their final grade lowered significantly.

Law school-wide notices:

Reasonable Accommodations:

Loyola Law School adheres to a policy of nondiscrimination in its educational programs, admissions policies, financial aid, and other school-related programs on the basis of sex, age, race, color, religious creed, national origin, sexual orientation, disability, marital, parental or veteran status. The Law School complies fully with the provisions of Title IX of the Education Amendments of 1972, Title III of the Americans with Disabilities Act, Section 504 of the Rehabilitation Act of 1973, and related administrative regulations and executive orders promulgated thereunder.

Students in need of reasonable accommodations may review the application guidelines and appeals process at - <https://my.lls.edu/studentaffairs/disabilityaccommodations>. For additional information, a student may contact Student Accessibility Services (SAS) in the Office of Student Affairs at accessibility@lls.edu or 213-736-8151.

Reporting Requirements of Sexual or Interpersonal Misconduct.

Loyola Law School is dedicated to fostering the education of the whole person and strives to provide an environment that encourages the search for truth and freedom of inquiry. The School recognizes the important contribution a diverse community of students, faculty and staff makes towards the advancement of its goals and ideals. The School is committed to providing an environment that is free of discrimination and harassment as defined by federal, state and local law, as well as under this policy. Any violations of this policy will be treated as serious misconduct and result in appropriate disciplinary action up to and including dismissal from the School.

As responsible employees, faculty are required to report any case of suspected sexual or interpersonal misconduct and cannot protect student confidentiality. For information about confidential counseling on campus and for general information about consensual relationships, sexual harassment, and sexual assault, please review the following information on the Office of Student Affairs webpage: Student-on-Student Sexual Misconduct & Interpersonal Conduct Policy & Protocol; LLS & Community Sexual Assault & Interpersonal Misconduct Resource Contact List; & Project Callisto.

SYLLABUS

version 2.1 - 09 November 2021

Unless noted, all page assignments are from the casebook. Do NOT read “Questions” or “Notes” in the case book unless specifically instructed:

I. THE DOMINANT FRAMEWORK

Casebook	59–69	[“A. Subject Matter of Trademark . . .” until <i>Peaceable Planet</i>]
	73–88	[<i>Qualitex</i> until <i>Abercrombie</i>]
	42–49	[excerpts from Brown, Landes & Posner articles]
	30–32	[<i>Hanover Star Milling v. Metcalf</i> case]
	39–41	[<i>Champion Spark Plug v. Sanders</i> case]

II. ALTERNATIVE FRAMEWORKS

Casebook	32–36	[<i>Stork Restaurant v. Sahati</i> case]
	9–11	[Restatement Section until <i>Cheney Bros.</i>]
	53–57	[Litman, <i>Breakfast with Batman</i>]
Brightspace	Ringling Bros v. Celozzi-Ettelson case	

III. TMS IN THE BIGGER WORLD OF IP

Casebook	23–30	[“B. Trademarks” until <i>Hanover Star Milling</i>]
	119–124	[“collective and certification marks”]

Acquisition of Rights

IV. DISTINCTIVENESS IN A TRADEMARK

Casebook	89–92	[<i>Abercrombie & Fitch, In re Quik-Print</i>]
Brightspace	“Secondary Meaning” from 4 th Edition, marked pages 87-103 [<i>American Waltham Watch v. U.S. Watch, International Kennel Club of Chicago, Restatement (Third), and Rock & Roll Hall of Fame and Museum v. Gentile</i>]	

V. ACQUISITION OF TRADEMARK

RIGHTS THROUGH USE

Casebook	140–146	[15 U.S.C. § 1127 through <i>Larry Harmon Pictures</i>]
Brightspace	<i>Proctor & Gamble v. Johnson & Johnson</i> (S.D.N.Y. 1979)	
Brightspace	<i>Maryland Stadium Authority v. Becker</i> (D. Md. 1992)	
Casebook	158–180	[<i>Blue Bell Inc. v. Farah</i> through <i>Dawn Donuts</i>]

VI. THE REGISTRATION PROCESS AND "INTENT TO USE"

Casebook	183–184	[thru 15 U.S.C. § 1051(b)]
	190–208	[middle paragraph on 190, then “Note: . . . Section 44” thru <i>Laramie Corp. v. Talk to Me</i>]

VII. BARS TO REGISTRATION

Casebook	213-218	[Section 2(a), <i>In re Fox</i>]
Brightspace		Page 19-35 Ginsburg, Litman, and Kevlin 6 th edition 2020 Supplement
		<i>Matal v. Tam</i> , U.S. Supreme Court (2017)
		<i>Iancu v. Brunetti</i> , U.S. Supreme Court (2019)
		Note: Implications of <i>Matal</i> and <i>Iancu</i>
	231-235	[<i>Bayer Aktiengesellschaft</i> through “Note: the Differences . . .”]
	242-245	[“2. Sections 2(b) and 2(c) . . .” thru <i>In re Hoefflin</i>]
	265 - 275	[4. Section 2(e)(2)248-252 through <i>In re Miracle Tuesday</i>]
	278-291	[“Note: ‘Geographically Suggestive’ Marks” through <i>In re Becton</i>]
	245	[<i>Lanham</i> § 2(d) only]
Brightspace		<i>Nutrasweet v. K&S Foods, Inc.</i> (T.T.A.B. 1987)
Casebook	256-262	[<i>B&B Hardware, Inc. v. Hargis Industries</i>]

Confusion-based Infringement

VIII. INFRINGEMENT AND THE LIKELIHOOD OF CONFUSION

Casebook	365	[15 USC § 32(1)]
	383-416	[“B Likelihood of Confusion” to Questions]
	420-429	[<i>Mobil Oil v. Pegasus</i> through <i>Network Automation</i>]
	438-440	[<i>Mastercrafters Clock</i>]
	442-451	[<i>Munsingwear v. Jockey</i> thru <i>Dreamwerks v. SKG</i>]
	484-490	[<i>Two Pesos, Inc. v. Taco Cabana</i>]
	100-104	[<i>WalMart. v. Samara Bros.</i>]
	463-475	[<i>Inwood Labs v. Ives Labs</i> through <i>Tiffany v. eBay</i>]
Brightspace		<i>Luxottica Group v. Airport Mini Mall</i> (11th Cir. 2019)

IX. SPEECH DEFENSES, INCLUDING PARODY

Casebook	572-580	[“Fair use” through <i>Car-Freshener Corp. v. S.C. Johnson</i>]
	608-613	[Nominative Fair Use,” <i>New Kids on the Block</i>]
	619-623	[<i>WCVB v. Boston Athletic, Toyota v. Tabar</i>]
	661-664	[<i>Mattel v. Universal Music</i>]
Brightspace		<i>Gordon v. Draper</i> (9th Cir. 2018)

X. DILUTION LAW

Casebook	701-712	[Federal dilution through <i>National Pork Board</i>]
	742-744	[<i>Hershey v. Art Van</i>]
	735-741	[<i>Louis Vuitton v. Haute Diggity</i> through <i>Starbucks v. Wolfe’s</i>]

Other Issues

XI. GENERICNESS

Casebook 295–310 [“Genericism” through *Dupont v. Yoshida International*]
Brightspace USPTO v. *Booking.com*. (Supreme Court, 2020)

XII. FAILURE TO CONTROL/ ABANDONMENT

Casebook 348–354 [Clark & Freeman, *Eva’s Bridal*]
331–337 [“B. Abandonment” through *Silverman v. CBS*]

XIII. REMEDIES

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



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End of syllabus, version 02.1

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THIS IS AVAILABLE ON BRIGHTSPACE