

Loyola Law School  
**TRADEMARK LAW**

Spring 2022 / **Syllabus VERSION 1**

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, 3:40-5:10pm [Pacific time]

The law school plans to convene classes on Zoom for the first two weeks of the semester, so our classes on **10, 12, and 19 January** will be on Zoom. Hopefully, we will hopefully meet in person beginning on **24 January**.

But classes on **7 March** and **9 March** will also likely be on Zoom [Professor Hughes is also scheduled to teach at Oxford that week.]

Students should schedule and plan to attend Trademark Law class on **Thursday, 21 April** as well as **Friday, 22 April** [LLS Flex Days] at the regularly scheduled time, **3:40-5:10pm**. One of these days will be used for a review session. Access to recording of the review session will not be 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* (6<sup>th</sup> 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 A student may be withdrawn, and/or excluded from an examination, and given a failing grade in any course in which the student has not maintained a satisfactory attendance record."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.

As stated in the LLS course catalog, when the class is meeting in person in Hall of the 80s,

**Laptop [and tablet] use will not be permitted in this class.**

<https://webdb.lls.edu/courses/index.php?c=LAWF-4005&yt=2022+SP&sf=t&s=trademark&a=1>

Because of this rule, all students are expected to have paper versions of the casebook; less expensive used copies should be readily available.

## 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.

**In addition to no laptops, internet use by students (with smartphones) is strictly FORBIDDEN in in-person class meetings.** 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](mailto: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 1 - 02 January 2022

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**

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

### **II. ALTERNATIVE FRAMEWORKS**

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

### **III. TMS IN THE BIGGER WORLD OF IP**

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

*Acquisition of Rights*

### **IV. DISTINCTIVENESS IN A TRADEMARK**

<i>Casebook</i>	<b>89–92</b>	[ <i>Abercrombie &amp; Fitch, In re Quik-Print</i> ]
<i>Brightspace</i>		"Secondary Meaning" from 4 <sup>th</sup> Edition, pages 89-103 [ <i>International Kennel Club of Chicago</i> , Restatement (Third), and <i>Rock &amp; Roll Hall of Fame and Museum v. Gentile</i> ]

### **V. ACQUISITION OF TRADEMARK RIGHTS THROUGH USE**

<i>Casebook</i>	<b>140-146</b>	[15 U.S.C. § 1127 through <i>Larry Harmon Pictures</i> ]
<i>Brightspace</i>		<i>Proctor &amp; Gamble v. Johnson &amp; Johnson</i> (S.D.N.Y. 1979)

	<i>Brightspace</i>		<i>Maryland Stadium Authority v. Becker</i> (D. Md. 1992)
	<i>Casebook</i>	158–180	[ <i>Blue Bell Inc. v. Farah</i> through <i>Dawn Donuts</i> ]
<b>VI.</b>	<b>THE REGISTRATION PROCESS AND "INTENT TO USE"</b>		
	<i>Casebook</i>	183–184	[thru 15 U.S.C. § 1051(b)]
		190–208	[middle of 190; “Note: . . . Section 44” thru <i>Laramie Corp</i> ]
<b>VII.</b>	<b>BARS TO REGISTRATION</b>		
	<i>Casebook</i>	213–218	[Section 2(a), <i>In re Fox</i> ]
	<i>Brightspace</i>		<b>Page 19-35 Ginsburg, Litman, and Kevlin 6<sup>th</sup> edition 2020 Supplement</b>
			<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	[Lanham § 2(d) only]
	<i>Brightspace</i>		<i>Nutrasweet v. K&amp;S Foods, Inc.</i> (T.T.A.B. 1987)
	<i>Casebook</i>	256-262	[ <i>B&amp;B Hardware, Inc. v. Hargis Industries</i> ]
			<i>Confusion-based Infringement</i>
<b>VIII.</b>	<b>INFRINGEMENT AND THE LIKELIHOOD OF CONFUSION</b>		
	<i>Casebook</i>	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> ]
	<i>Brightspace</i>		<i>Luxottica Group v. Airport Mini Mall</i> (11th Cir. 2019)
<b>IX.</b>	<b>SPEECH DEFENSES, INCLUDING PARODY</b>		
	<i>Casebook</i>	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> ]
	<i>Brightspace</i>		<i>Gordon v. Draper</i> (9th Cir. 2018)

X. DILUTION LAW

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

*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*



**For in-person class meetings held at the Law School, internet use is strictly FORBIDDEN;  
Laptops and tablets are not to be used in class.**

End of syllabus, version 01

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THIS IS AVAILABLE ON BRIGHTSPACE