

TRADEMARK LAW

SPRING 2022

Loyola Law School

Professor Justin Hughes

Take Home Examination

Directions, conditions, and your professional commitments

This is a twenty-four (24) hour, take-home examination. You have 24 hours from the time you download the examination from the “Trademark Law -Take Home Exam...” TWEN course to upload your completed answer to the same TWEN course. You should place your 7-digit LLS ID in the top right header on ALL PAGES of your answer; your name should NOT appear on any page. Your answer should be submitted as a .pdf or .doc/.docx file. **(You do NOT use Exemplify for this exam.)**

Once you have received this examination, you may not discuss it with anyone (other than the Registrar’s Office) prior to the end of the LLS examination period. Nor may you discuss the examination at ANY time with any student in the class who has not taken the examination (in case a student has an accommodation to take the exam later). You may NOT collaborate on this work. You may NOT receive assistance on the substance of your answers from any other person.

This is an open book, take home examination. However, you should NOT do additional factual research for the questions nor look for any case law or court decisions outside what we studied in the course. The examination’s fact patterns may be based on real circumstances or incidents, but changed into hypotheticals. So, you should treat the “facts” as limited to what you are told in the examination. Finally, this exam may refer to cases or trademarks that were the subject of questions in prior years, but, if so, the questions this year will be different.

By turning in your answers you certify that you did not gain advance knowledge of the contents of the exam, that the answers are entirely your own work, and that you complied with all Loyola Law School rules.

The Exhibits appear at the end of this document.

GOOD LUCK

I. TRUE/FALSE QUESTIONS
(40 points maximum)

This part of the exam is worth 40 points. Each answer is worth 2 points. There are 21 questions, so in the same spirit as the LSAT and other standardized tests, you can get one (1) wrong and still get a maximum score on this section.

Please provide your answers to this section as a single column series, numbered 1 to 21, with “True” or “False” beside each number, i.e.

- 30. True
- 31. False
- 32. False
- 33. True

This list should come BEFORE your essay answer and BE ON A SEPARATE PAGE FROM YOUR ESSAY ANSWER.

If you think a question is unclear, you may write a note at the end, but only do so if you believe there is a fundamental ambiguity in the question.

SOME GENERAL QUESTIONS

- 01. *In re Clark* (1990) and *New York Pizzeria v. Syal* (2014) establish that a taste, like a smell or a sound, can serve as a indicator of the source of the goods and, therefore, be a trademark.
- 02. In *Iancu v. Brunelli* (2019), a majority of the Supreme Court concluded that the §2 bar to registration for a trademark being “scandalous” passes constitutional muster with a “narrowing construction” by which USPTO may only refuse registration to “the most vulgar, profane, or obscene works and images imaginable.”

03. In *Mobil Oil v. Pegasus Petroleum* (1987), the Second Circuit reasoned that a word and a pictorial representation could be found to be similar in meaning as a factual matter.
04. In *Gordon v. Drape Creative* (9th Cir. 2018), the appellate court agreed with the district court that for an expressive work's use of a trademark to be explicitly misleading under the *Rogers v. Grimaldi* test, the expressive work or its distributor must make an "affirmative statement of the plaintiff's sponsorship or endorsement."
05. In *Rock & Roll Hall of Fame v. Gentile Productions* (1998) the appellate panel concluded that there was no evidence of the public recognition of the Rock & Roll Hall of Fame Museum's building design as a trademark and that the Museum had not used the building design in a way that would create a "consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship."

PLAY MISTY FOR ME

"Father John Misty" is the stage name of Los Angeles-based musician Joshua Michael Tillman. Father John Misty (Misty) has released five studio albums under that name (as well as several as "J. Tillman"), has contributed to albums by Beyonce and Lady Gaga, did a studio album with the Fleet Foxes, has performed on the Coachella main stage, and is now on an international tour promoting his new album, *Chloe and the Next 20th Century*.

In addition to his eclectic music, Misty is known for his extremely creative videos, savvy use of the internet to reach his fans, and unusual merchandise.

A couple years ago Misty launched a series of t-shirts and hoodies that looked eerily similar to merchandise from the L.A. Lakers professional basketball team. **Exhibit A** shows some L.A. Lakers merchandise displaying the Lakers' logo and trade dress; **Exhibit B** shows the corresponding Misty merchandise. **Exhibit C** shows merchandise webpages from the Father John Misty website during the past 12 months.

L.A. Lakers official merchandise is sold on the Lakers' website, at Lakers' games, and at many brick and mortar locations, principally in southern California; Father John Misty merchandise is sold only at Misty concerts and from his website.

Assume the L.A. Lakers sue Misty for both likelihood of confusion and likelihood of dilution under federal trademark law.

06. Under the reasoning of *Munsingwear v. Jockey* (8th Cir. 1994), the "post-sale confusion" analysis of *Mastercrafters Clock v. Vacheron* (2d Cir. 1955) would not be appropriate because of how consumers use the respective Lakers and Misty products.
07. Under the reasoning in *Leelanau Wine Cellar v. Black & Red* (6th Cir 2007), one of the factors that will probably favor Misty in a likelihood of confusion analysis is the "channels of commerce."
08. As in *Hershey's v. Art Van* (E.D. Mich, 2008) Misty imitated the Lakers' trade dress without imitating the Lakers' word mark, raising the question whether the L. A. Lakers must establish that the trade dress by itself is famous in order to sue for dilution under federal law.
09. Because of the "attractive power" of the Lakers trade dress as used by Misty, this will be a classic case of "initial interest confusion" under *Mobil Oil v. Pegasus Petroleum* (1987) and *Blockbuster Entertainment Group v. Laylco* (1994).

SWISS, BRAZILIAN, JAPANESE

"Swiss Delice" is a small, high-end cookie maker in Switzerland - the company's name is a mix of English and French meaning "Swiss delight" or "Swiss tasty treat." Swiss Delice has decided to make a serious effort to export their products to the United States, targeting specialty gourmet food stores and high-end grocery stores like Gelson's and Pavilions.

All Swiss Delice products are made and packaged at their factory in Lucerne, Switzerland.

One of the Swiss Delice executives did an LLM in the United States, where she took Trademark Law. While she considers that most of the Swiss Delice cookies have non-controversial names – like REVE DE VANILLE (Vanilla Dream) – she is concerned about two Swiss Delice brands, BRASILIA and CHOC JAPONAIS.

BRASILIA cookies are shown in **Exhibit D**. As the packaging indicates, they are meringue cookies with Swiss chocolate and hazelnut filling. **Exhibit D** shows two different product packaging designs that Swiss Delice uses, but both have the same basic components – the Swiss Delice house mark, the BRASILIA brand mark, pictures of the cookies, an accurate description of the cookies, and an emblem that indicates the product is made in Switzerland.

Of course, Brasilia is the capital of Brazil; there are over 4 million people in the metro Brasilia area and – although founded only in 1956 – it is a designated UNESCO World Heritage Site because of its modernist architecture. <https://en.wikipedia.org/wiki/Bras%C3%ADlia>. Before the pandemic, there were non-stop flights to Brasilia from Atlanta, Dallas, Miami, New York, and Washington, D.C.

CHOC JAPONAIS cookies are shown in **Exhibit E**. As the packaging indicates, they are also meringue cookies – with cocoa cream filling and Swiss chocolate on the outside of the cookie. “Choc” is commonly used in French as an informal way to say chocolate and the word is sometimes used the same way in English, see <https://www.dictionary.com/browse/choc>.

Again, the product packaging has the same basic components – the Swiss Delice house mark, the CHOC JAPONAIS brand mark, pictures of the cookies, an accurate description of the cookies, and an emblem that indicates the product is made in Switzerland.

Of course, “Japonais” is French for “Japanese,” so the entire name of the Swiss Delice cookie in French means “Japanese Chocolate.”

Finally, Swiss Delice does not use any ingredients sourced from Brazil or Japan.

10. If Swiss Delice seeks to register BRASILIA, by the reasoning in *In re The Newbridge Cutlery Co.* (2015) and *In re Miracle Tuesday* (2012), a Trademark Examiner will probably conclude that “the mark sought to

be registered is the name of a place generally known to the public.”

11. Because Brasilia is a very large metropolis that must have hundreds, if not thousands, of bakeries, a Trademark Examiner is almost certain to conclude that American consumers will make a “goods/place association” between Brasilia and cookies.
12. If it is shown that a substantial number of consumers in gourmet food shops understand basic French, a USPTO Trademark Examiner is likely to conclude that, as a potential trademark, CHOC JAPONAIS has the same meaning as “Japanese Chocolate.”
13. Generally speaking, the presence on the packaging of both the “Swiss Delice” house mark and the emblem that indicates the product is made in Switzerland should reduce the likelihood that any consumer believes the products come from Brazil or Japan, respectively.
14. If consumers understand CHOC JAPONAIS to mean “Japanese Chocolate,” the product uses only Swiss chocolate made from cocoa beans from African countries, and the Trademark Examiner concludes that the mark is “deceptively misdescriptive” under Lanham §2(e), this will be a permanent bar to registration under Lanham §2(f).
15. Even if a USPTO Trademark Examiner concludes that Brazil and Brasilia are not known for chocolate, hazelnuts, or cookies, the Examiner is likely to conclude that Swiss Delice’s BRASILIA mark is “primarily geographically deceptively misdescriptive.”

MORE GENERAL QUESTIONS

16. The Lanham §45 definition of “use in commerce” includes when the trademark is used on “displays associated” with the product and *In re Dell* (2004), the T.T.A.B. interpreted this language to include “a website page which display a product, and provides a means of ordering the product . . . as long as the mark appears on the webpage in a manner in which the mark is associated with the goods.”
17. In *Louis Vuitton v. Haute Diggity Dog* (2007), the 4th Circuit found that the “Chewy Vuiton” dog toy was a parody that clearly fell under the exclusion from liability for dilution in Lanham §43(c)(3)(A).
18. According to *Couture v. Playdom* (Fed. Cir. 2015) offering services under a trademark but not actually providing those services does not count as “use in commerce” under the Lanham Act.
19. The Lanham Act defines a “collective mark” as a trademark used “to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a labor union or other organization.”
20. When a plaintiff claims trademark rights in a descriptive term, the *Gimix* factors used to determine secondary meaning include, but are not limited to, the length and manner of plaintiff's use, the plaintiff's volume of sales, and the amount and manner of plaintiff's advertising,
21. In *Luxottica Group v. Airport Mini Mall* (11th Cir. 2019) the Eleventh Circuit panel reasoned that a defendant's “actual or constructive knowledge of the

TRADEMARK EXAM

direct infringers' identities could arise from many sources," not just notice from the trademark holders.

FUNDAMENTAL AMBIGUITIES? *Note them with your T-F answers!*

II. Essay Question

(60 points total)

[no more than 2000 words]

This part of the examination has ONE essay problem. Please make sure that you use 1.5 line or double line spacing. Please make sure that the essay starts on A SEPARATE PAGE from the true/false section. Be sure to include a **total** word count for the essay.

The examination's fact pattern is based on *some real* circumstances, but significant parts of the story have been changed and you should treat the "facts" available to you as limited to what you are told in the examination. You should NOT do additional factual research. On the other hand, as a good lawyer you may identify additional facts your law firm should learn to analyze the issues fully.

EATING MORE OR LESS?

You are a new associate in a law firm and working in the firm's intellectual property group, headed by Mona L. Jaconde. Ms. Jaconde spoke today with Max Headroom, the general counsel of The Hershey Company (Hershey's). Hershey's Canadian subsidiary has an interesting trademark problem that requires some thoughtful analysis.

Mona is meeting with Mr. Headroom day after tomorrow. She thinks you know a lot about trademark law and, because she needs to be in San Diego tonight for a client dinner, she has assigned you to prepare a memo figuring out the issues. Giving you her wry smile, she reminds you: really, absolutely no more than 2000 words – and she needs your memo prepping her in 24 hours, absolutely no more. As she runs out the door, Mona hands you her notes which say the following:

EAT-MORE is a popular brand of candy bar in Canada. It was created in the 1930s by the Lowney Company, which has consistently marketed the candy throughout Canada with slogans “Dive into the unique taste of chewy dark toffee, peanut and chocolate” and “A real long chew.” For a somewhat tongue-in-cheek advertisement for EAT-MORE from the early 1990s, see <https://www.youtube.com/watch?v=c96m2Fmz4sM>.

Images of the EAT-MORE candy bar are shown in **Exhibit F**.

With the North American Free Trade Agreement (NAFTA) in 1994, informal trade between Canada and the United States became much easier and EAT-MORE candy bars starting appearing in candy shops, groceries, supermarkets, and convenience stores in areas close to the Canadian border in the upper Midwest and Rockies. Since February 2014, EAT-MORE has had a regular distributor for such stores in major towns in Montana (Bozeman, Helena, and Missoula) and North Dakota (Fargo, Grand Forks, and Minot). On March 1, 2015, Lowney appointed an EAT-MORE distributor for Minnesota and Wisconsin; beginning in the summer of 2020, that same distributor began selling EAT-MORE candy bars during the summer months to candy shops and speciality grocery stores in top Michigan vacation spots – Mackinac Island, Saugatuck, and Traverse City.

In 2017, all of the assets of the Lowney Company, including all rights, recipes, and know-how for EAT-MORE, were purchased by Hershey Canada, Inc., a wholly-owned subsidiary of Hersheys. Hershey’s U.S. distribution network now sometimes carries out the distribution of EAT-MORE candy bars to the areas of the U.S. mentioned above.

EET-SUM-MOR is a shortbread biscuit product from South Africa produced by Bakers Limited (<https://www.bakers.co.za>), a cookie and cracker company that is now part of National Brands Limited.

EET-SUM-MOR was introduced into the South African market in the 1940s and is probably South Africa’s most popular shortbread product. Today, EET-SUM-MOR is available in different sizes and types, including the original shortbread biscuits, a version with chocolate chips, and a mini-size sold in “snack packs.”

These various EET-SUM-MOR products are shown in **Exhibit G**.

A few years ago National Brands Ltd began a push to export its products into the U.S. market. In 2005, it contracted with a small snack distributor in Boston to introduce its products there and National Brands Ltd shipped two cases of EET-SUM-MOR biscuits (each case containing 24 retail

cartons) to that distributor; the cases arrived in Boston on December 16, 2005. This distributor did not produce substantial interest in EET-SUM-MOR, but National Brands Ltd subsequently reached a June 2014 deal with Harris Teeter to distribute EET-SUM-MOR in Harris Teeter's approximately 250 supermarkets in seven South Atlantic states (North Carolina, South Carolina, Virginia, Georgia, Florida, Delaware, and Maryland).

On September 17, 2014, National Brands Ltd filed an application to register the EET-SUM-MOR trademark at USPTO. The USPTO granted the trademark registration (#4727504) on April 28, 2015.

The USPTO registration for EET-SUM-MOR is shown in **Exhibit H**.

Currently, both products - EAT-MORE candy bars and EET-SUM-MOR biscuits are available on Amazon in the U.S., through third party sellers:

<https://www.amazon.com/Bakers-Eet-Sum-Biscuits-200g/dp/B00MTUXRBS>

https://www.amazon.com/Eat-more-Canada-Toffee-Peanut-Chocolate/dp/B0753YZHSC/ref=sr_1_3?crd=1134X401UOMRE&keywords=eat-more+candy+bar&qid=1650241692&sprefix=eat-more%2Caps%2C109&sr=8-3

On a recent trip to Traverse City, Michigan, counsel for National Brands Ltd first became aware of the EAT-MORE candy bar. Subsequently, National Brands Ltd sent Hershey Canada a cease and desist letter demanding that Hershey Canada stop all sales of EAT-MORE candy bars in the U.S. market. Because it involves sales in the United States, Hershey Canada brought the problem to Hershey's global general counsel, Mr. Headroom.

Mona Jaconde needs a memo from you in 24 hours analyzing the issues between these two parties - remember, no more than 2,000 words. She suggests that you structure your memo in this order: what kind of trademarks the respective parties have; a likelihood-of-confusion analysis between the parties' respective marks; if there is a likelihood of confusion, whether Hershey Canada has any defenses in relation to the EAT-MORE trademark; and, finally, whether any other parties may be liable for trademark infringement in this situation.

* * * *

END OF WRITTEN EXAMINATION - EXHIBITS FOLLOW

EXHIBITS -
Trademark Spring 2022 Examination

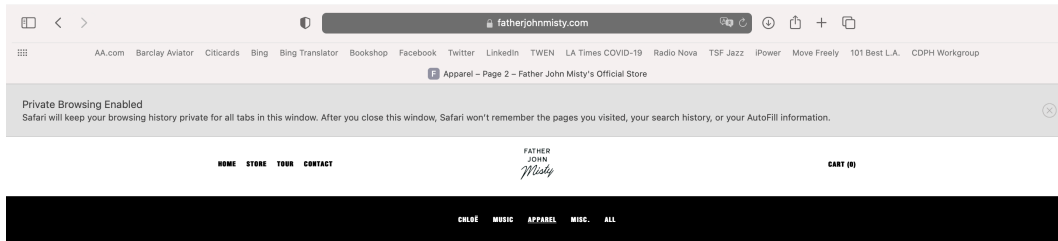
EXHIBIT A - L.A. Lakers official logos and samples of licensed shirts, including from the L.A. Lakers' website.



EXHIBIT B – Father John Misty merchandise



EXHIBIT C – two different examples of how Father John Misty merchandise has appeared on Father John Misty website in past 12 months



APPAREL

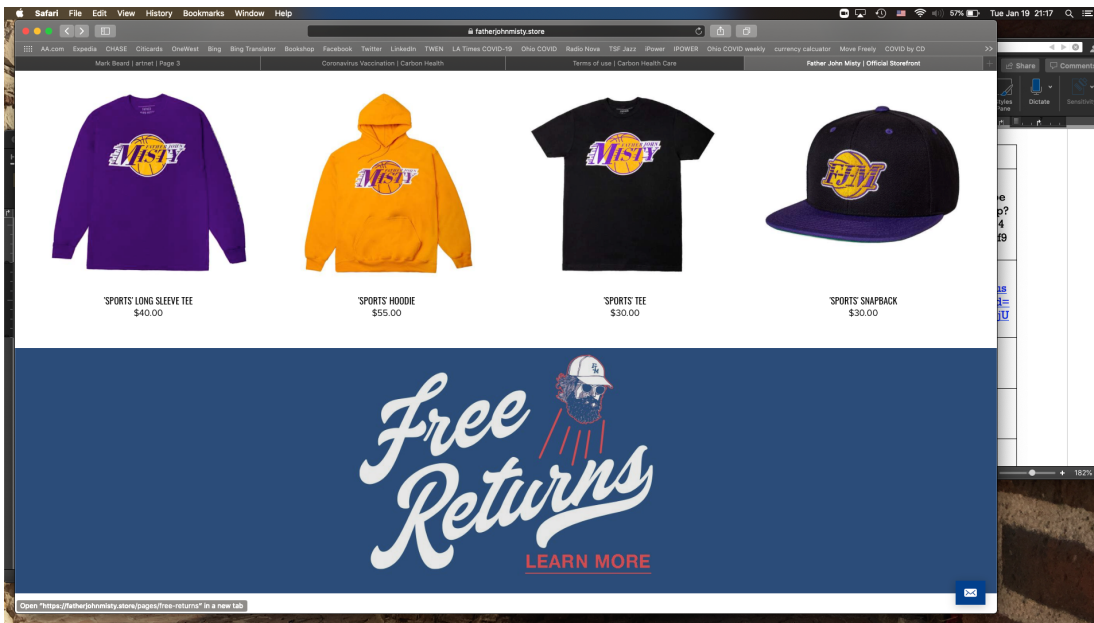
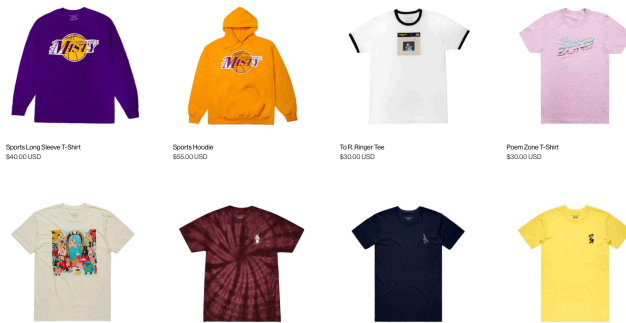


EXHIBIT D – Swiss Delice’s BRASILIA brand cookies (Two package designs)



EXHIBIT E – Swiss Delice’s CHOC JAPONAIS brand cookies



EXHIBIT F - EAT-MORE candy bars



EXHIBIT G - EAT-SUM-MOR biscuits



EXHIBIT H - EAT-SUM-MOR trademark registration

Trademark Electronic Search System (TESS)

4/17/22, 17:14



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#)[Trademarks](#) > [Trademark Electronic Search System \(TESS\)](#)

TESS was last updated on Sun Apr 17 03:47:21 EDT 2022

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [Browse Dict](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

EET-SUM-MOR

Word Mark	EET-SUM-MOR
Goods and Services	IC 030. US 046. G & S: Biscuits. FIRST USE: 20060101. FIRST USE IN COMMERCE: 20060101
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86397391
Filing Date	September 17, 2014
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	February 10, 2015
Registration Number	4727504
Registration Date	April 28, 2015
Owner	(REGISTRANT) National Brands Limited COMPANY SOUTH AFRICA 30 Sloane Street, Bryanston Gauteng SOUTH AFRICA 2021
Attorney of Record	Francis J. Duffin
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR).
Live/Dead Indicator	LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [Browse Dict](#) | [SEARCH OG](#) | [Top](#) | [HELP](#)<https://tmsearch.uspto.gov/bin/showfield?f=doc&state=4808:yp8rv9.2.1>

Page 1 of 2

END OF EXHIBITS ###
 ### END OF EXAM ###