

Cardozo School of Law  
TRADEMARK LAW  
Fall 2008

Overview, basic information, syllabus, and  
assignments for first two weeks of class

Professor Justin Hughes  
212-790-0260  
Hughes@yu.edu

**BASIC INFORMATION**

**Class room:** Room 204

**Class hours:** Monday and Wednesday, 2:30pm – 3:51pm

**Materials:** GINSBURG, LITMAN, ET AL. TRADEMARK AND UNFAIR COMPETITION LAW (4<sup>th</sup> edition, 2007) and *possible* additional supplemental distribution packets, as provided by instructor.

**Email/Internet:** Please send any emails on weekdays. If you don't receive a response within 5 days (or sooner), I recommend sending the message again.

Internet use during class is strictly forbidden.

**Evaluation:** Grading in the course will be based on a final take home examination. In addition, class participation will be used to adjust grades upward or downward.

As part of class participation, absolutely NO internet use is permitted in the class. *Students found to be using the internet during class will be referred to the Academic Standing Committee for discipline, including, but not limited to, lowering of the final grade in this class.*

SYLLABUS  
version 1.0 – July 3, 2008

I. THE DOMINANT FRAMEWORK

|                 |             |   |
|-----------------|-------------|---|
| <i>Casebook</i> | pages 43-52 | [starting with "What is a Trademark?"]          |
|                 | 63-78       | [ <i>Qualitex</i> until <i>Abercrombie</i> ]    |
|                 | 29-38       | [excerpts from Brown, Landes & Posner articles] |
|                 | 21-22       | [ <i>Hanover</i> case]                          |
|                 | 27-29       | [ <i>Champion Spark Plug</i> case]              |
|                 | 52-59       | [ <i>Peacable Planet</i> until Hughes]          |

II. ALTERNATIVE FRAMEWORKS

|                 |             |  |
|-----------------|-------------|--|
| <i>Casebook</i> | pages 22-27 | [ <i>Stork Club</i> case]                        |
|                 | 1-3         | [through <i>International News Service</i> case] |
|                 | 38-42       | ["Breakfast with Batman"]                        |
|                 | 644-647     | [ <i>Ringling Bros v. Celozzi-Ettelson</i> case] |

III. Trademarks in the bigger world of IP

|                 |             |
|-----------------|-------------|
| <i>Casebook</i> | pages 13-20 |
|-----------------|-------------|

*Acquisition of Rights*

IV. DISTINCTIVENESS IN A TRADEMARK

|                 |              |                                    |
|-----------------|--------------|------------------------------------|
| <i>Casebook</i> | pages 78-103 | [skip questions on 86-87, 103-104] |
|-----------------|--------------|------------------------------------|

V. ACQUISITION OF TRADEMARK RIGHTS THROUGH USE

|                 |               |                                   |
|-----------------|---------------|-----------------------------------|
| <i>Casebook</i> | pages 112-146 | ["Use" to "Problems"]             |
|                 | 158-170       | ["Concurrent Use" to "Questions"] |

VI. ACQUISITION OF TRADEMARK RIGHTS THROUGH "INTENT TO USE"

|                 |               |   |
|-----------------|---------------|---|
| <i>Casebook</i> | pages 187-202 | [to "Foreign Marks," skip questions everywhere] |
|-----------------|---------------|---|

VII. THE REGISTRATION PROCESS AND TYPES OF MARKS

|                 |               |
|-----------------|---------------|
| <i>Casebook</i> | pages 172-185 |
|-----------------|---------------|

VIII. BARS TO REGISTRATION

|                 |               |   |
|-----------------|---------------|---|
| <i>Casebook</i> | pages 203-216 |   |
|                 | 223-232       | [deceptive and deceptively misdescriptive terms, false association, flags, dead Presidents]   |
|                 | 248 - 260     | [Section 2(e)(3) - geographic terms, skip questions]  |
|                 | 87 - 89       | [ <i>American Waltham Watch</i> case]   |
|                 | 260 - 273     | [Section 2(e)(4) - surnames; Section 2(e)(5) - functionality; skip questions in all sections] |

232 - 242 [Section 2(d) – confusion with existing registered mark, stop at questions]

*Confusion-based Infringement*

IX. INFRINGEMENT AND THE LIKELIHOOD OF CONFUSION

Casebook pages 332-377 [to 1-800 Contacts case]  
405-414 [Munsingwear case and 'reverse confusion' cases]  
417-429 [contributory and vicarious liability; we will only briefly discuss *Hard Rock Café* case.]  
481-504 [brief return to infringement of trade dress]

X SPEECH DEFENSES, INCLUDING PARODY

Casebook pages 816-827  
462-467 [New Kids on the Block case]  
831 – 837 [Playboy v. Welles case]  
838-843 [Mutual of Omaha case]  
852-873 [Anheuser-Busch through Walking Mountain case]

*Liability for Dilution*

XI. DILUTION LAW AND CASE LAW

Casebook pages 613 – 618 [Sara K. Stadler article *but will NOT discuss in class*]  
654 – 660 [Deere & Co. case, Hormel Foods case]  
631 – 642 [Federal dilution, skip questions]

*Other Issues*

XII. GENERICNESS

Casebook pages 274-288 [through E.I. DuPont case]

XIII. ABANDONMENT/FAILURE TO CONTROL

Casebook pages 305-312 [*Silverman v. CBS, ITC Limited*]

XV. REMEDIES

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

*End of syllabus, version 02*