

Cardozo School of Law  
TRADEMARK LAW  
Spring 2010

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

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**BASIC INFORMATION**

**Class room:** Room 423

**Class hours:** Monday, 11-11:50am  
Friday, noon – 1:50pm

**Make-up classes:** As a precaution – because of my Washington obligations – I have  
scheduled our classroom for make-up classes on the following Mondays:

February 8  
February 22  
March 8  
March 22  
April 12

I do **not** think we will use many of these dates, but I wanted to be safe. On  
a Monday when we have a make-up, it will be like the Friday class  
schedule (50 minutes of class, break, 50 minutes of class).

**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 may be referred to the Academic Standing Committee and Professor Hughes reserves the option of lowering of the final grade of such a student.*

**Office Hours:** Mondays, 2:00-4:00pm or by appointment

## SYLLABUS

version 01 – January 4, 2010

### 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

*Casebook* pages 13-20

### *Acquisition of Rights*

### IV. DISTINCTIVENESS IN A TRADEMARK

*Casebook* 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"

*Casebook* pages 187-202 [to "Foreign Marks," skip questions everywhere]

### VII. THE REGISTRATION PROCESS AND TYPES OF MARKS

*Casebook* 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

<i>Casebook</i>	pages	332-377	[to <i>1-800 Contacts</i> case]
		405-414	[ <i>Munsingwear</i> case and 'reverse confusion' cases]
		417-423	[contributory and vicarious liability; <i>Inwood</i> .]
		481-496	[brief return to infringement of trade dress]

X SPEECH DEFENSES, INCLUDING PARODY

<i>Casebook</i>	pages	816-823	
		462-467	[ <i>New Kids on the Block</i> case]
		838-843	[ <i>Mutual of Omaha</i> case, <i>but will NOT discuss in class</i> ]
		852-873	[ <i>Anheuser-Busch</i> through <i>Walking Mountain</i> case]

*Liability for Dilution*

XI. DILUTION LAW AND CASE LAW

<i>Casebook</i>	pages	613 - 618	[Sara K. Stadler article <i>but will NOT discuss in class</i> ]
		654 - 660	[ <i>Deere &amp; Co.</i> case, <i>Hormel Foods</i> case]
		631 - 642	[Federal dilution, skip questions]

*Other Issues*

XII. GENERICNESS

<i>Casebook</i>	pages	274-288	[through <i>E.I. DuPont</i> case]
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XIII. ABANDONMENT/FAILURE TO CONTROL

<i>Casebook</i>	pages	305-312	[ <i>Silverman v. CBS, ITC Limited</i> ]
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XV. REMEDIES

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

*End of syllabus, version 02*