

Cardozo School of Law  
TRADEMARK LAW  
Fall 2010

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:** Wednesdays 1:30 – 2:20pm  
Thursday 1:30 – 2:20pm  
Fridays 1:00 – 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  
Wednesdays:

15 September, 22 September, 27 October, and 3 November

All make-up classes will be in Room 204, **except 3 November (room 206)**. We may not use all these dates, but we will probably NOT have class the week of November 8 because I need to be at WIPO meetings in Geneva.

**Materials:** GINSBURG, LITMAN, ET AL. TRADEMARK AND UNFAIR COMPETITION LAW (4<sup>th</sup>  
edition, 2007) and 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: Wednesdays, 2:30-4:30pm or by appointment

## SYLLABUS

version 01 – 22 August 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]

### 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	
		56-62	["collective and certification. . ." through Hughes]

### *Acquisition of Rights*

### IV. DISTINCTIVENESS IN A TRADEMARK

<i>Casebook</i>	pages	78-103	[skip questions on 86-87, 103-104]
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### 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]
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### VII. THE REGISTRATION PROCESS AND TYPES OF MARKS

<i>Casebook</i>	pages	172-185	
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### 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> .]
	Excerpts from	<i>Tiffany v. eBay</i> (2 <sup>nd</sup> Cir., April 1, 2010)	
		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]
	Excerpts from	<i>Toyota v. Tabar</i> (9 <sup>th</sup> Cir., July 8, 2010)	
		725-737	[Boston Marathon cases]
		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	654 - 660	[ <i>Deere &amp; Co.</i> case, <i>Hormel Foods</i> case]
		631 - 642	[Federal dilution, skip questions]
	Excerpts from	<i>Hershey v. Art Van</i> (E.D. Mich., October 24, 2008)	

*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 01*