

TRADEMARKS AND UNFAIR COMPETITION

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University of Baltimore School of Law

Fall 2014

OVERVIEW

This course considers the use of trademarks as a critical intellectual property device designed to prevent consumer confusion over the origin of products and services and the misappropriation of commercial goodwill. In addition to addressing traditional legal questions that arise from acquiring, infringing upon, and losing trademark rights under the Lanham Act and the common law, the course focuses upon special issues raised by the Internet; the free speech implications of trademarks; and issues relating to false advertising and common law unfair competition.

MEETING TIMES

The Trademarks and Unfair Competition class meets weekly at the University of Baltimore School of Law in Room _____ on Mondays from 4:45 pm to 7:30 pm, with the exception of holidays or cancellations.

COURSE MATERIALS

The required course texts is:

Jane C. Ginsburg, Jessica Litman, Mary L. Kevlin, *Trademark and Unfair Competition Law: Cases and Materials*, 5th ed.

Foundation Press, *Hardcover*

ISBN: 9781609300753

In addition, handouts may be provided periodically in class. Recommended resources are J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, and J. Astrachan, D. Thomas and P. Rosden, *The Law of Advertising*.

ATTENDANCE POLICIES

Attendance is mandatory and it is my practice to supplement this syllabus with material for class discussion, some of which will find its way into the exam. The exam has often been 5-6 essay questions, so if you miss 20 or 25 percent of the exam because the question was discussed in class but was not contained in this syllabus, you will be unhappy. Advanced preparation as well as class participation is expected. Internet or other network access is prohibited during class.

If I see you looking down and smiling, I will know it's not due to something I said. Audio or video recording of classes is permitted, but is the sole responsibility of interested students.

Please try to be in your seat when class begins.

SYLLABUS

*****THE BOLDED CASES AND TEXT ARE THE PAGES YOU MUST READ.**

Class 1: Introduction to Trademarks

George & Company v. Imagination 575 F. 3d 383 (posted on TWEN)

Casebook pp. 1-21

1. **Top Tobacco, L.P v. North Atlantic Operating Company, Inc.**
2. **Restatement of the Law (Third) Unfair Competition §1**
3. International News Service v. Associated Press
4. Cheney Bros v. Doris Silk Corp
5. Sears, Roebuck & Co. v. Stiffel Co.
6. Compco Corp v. Day-Brite Lighting, Inc.
7. Bonito Boats v. Thunder Craft Boats
8. National Basketball Association v. Motorola
9. Barclays Capital, Inc. v. Theflyonthewall.com

Class 2: Concepts of Trademarks and Unfair Competition

Case Book pp. 21-56 (SKIM THIS MATERIAL)

Subject Matter of Trademark Protection

Case Book pp. 57-85

1. **Kellogg Co. v. National Biscuit Co.**
2. **Coca-Cola Co. v. Koke Co. Of America**
3. **Peaceable Planet, Inc. v. TY, Inc.**

4. Mishawaka Rubber & Woolen Manufacturing Co. v. S.S. Kresge Co.
5. **Qualitex Co. v. Jacobson Products Co., Inc.**
6. **Traffix Devices, Inc. v. Market Displays, Inc.**
7. Note: Service Marks
8. Note: Trademark Actions Before the Trademark Tribunals and
Before the Federal Judicial Courts

Class 3: Distinctiveness of Trademarks

Case Book pp. 85-114

1. **Abercrombie & Fitch Co. v. Hunting World, Inc.**
2. **In the Matter of the Application of Quik-Print Copy Shops,
Inc.**
3. **Zobmondo Entertainment, LLC. V. Falls Media, LLC**
4. In Re Vertex Group, LLC
5. **Rock and Roll Hall of Fame and Museum v. Gentile**
6. **Wal-mart Stores, Inc. v. Samara Brothers, Inc.**
7. **American Waltham Watch Co. v. United States Watch Co.**
8. Restatement of the Law (Third) Unfair Competition §13
9. Board of Supervisors For Louisiana State University Agricultural and
Mechanical College v. Smack Apparel Co.
10. Chrysler Group LLC v. Moda Group LLC

11. 15 U.S.C. §1054 [Lanham Act §4]
12. 15 U.S.C. §1127 [Lanham Act §45]
13. 15 U.S.C. §1064 [Lanham Act §14]

Class 4: Use and Ownership

Case Book pp. 121-136

Use in Commerce

Case pp. 136-174

1. **Thoroughbred Legends, LLC v. Walt Disney Co.**
2. **American Express Co. V. Gotez**
3. **Bell v. Streetwise Records, LTD**
4. Crystal Entertainment & Filmworks Inc. v. Jurado
5. **15 U.S.C. §1127 [Lanham Act §45]**
6. **Note: Token Use**
7. In Re Dell, Inc.
8. **Larry Harmon Pictures Corp v. Williams Restaurant Corp.**
9. Note: Foreign Commerce
10. Grupo Gigante SA de CV v. Dallo & Co., Inc.
11. **ITC LTD. V. Punchgini**
12. **Aktieselskabet AF 21. November 2001 v. Fame Jeans, Inc.**
13. **Blue Bell, Inc. v. Farah Manufacturing Co.**

14. City of New York v. Tavern on the Green
15. United Drug Co. v. Theodore Rectanus Co.
- 16. Thirty Rent-A-Car System v. Thift Cars, Inc.**
17. Dudley v. HealthSource Chiropractic Inc.,
- 18. Dawn Donut Co. v. Hart's Food Stores, Inc**

Class 5: Registration of Trademarks

Case pp. 177-202

- 1. 15 U.S.C. §1051(a) [Lanham Act §1(a)]**
- 2. 15 U.S.C. §1051(b) [Lanham Act §1(b)]**
- 3. The Policies Underlying "Intent to Use"**
4. Note: US Registration Under Section 44
5. Note: Madrid Protocol Extensions to the US
- 6. William M. Borchard, How to Get and Keep a Trademark**
- 7. Note: Advantages of Trademark Registration on the Principal Register**
8. Note: The Supplemental Register
9. Note: The Notice of Registration
10. Note: Maintenance and Renewal of Registration: Sections 8 and 9 of the Lanham Act
- 11. Constructive Use as of Filing Date**
12. Larami Corp. v. Talk to Me Programs, Inc.

13. *Compagnie Gervais Danone v. Precision Formulations, LLC*

Bars to Registration

Case pp. 203-278

1. **Section 2(a) of the Lanham Act: Immoral, Scandalous, Disparaging or Deceptive Matter and False Suggestion of a Connection**
2. **In Re Fox**
3. **Boston Red Sox Baseball Club Limited Partnership v. Sherman**
4. **In Re Lebanese Arak Corp.**
5. *Bayer Aktiengesellschaft v. Stamatios Mouratidis*
6. Note: The Difference Between Deceptive Terms and Deceptively Misdescriptive Terms
7. *Hornby v. TJX Companies, Inc.*
8. 15 U.S.C. § 1052(b) and (c) [Lanham Act § 2(b) and (c)]
9. Note: Refusals Under 2(b)
10. *In re Richard M. Hoefflin*
11. **Section 2(d) of The Lanham Act: Likely Confusion**
12. **Coach Services, Inc v. Triumph Learning LLC**
13. Note: Differences in Likely Confusion Analysis for Registration and for Infringement Purposes

14. In Re Viterra Inc.
15. **Nutrasweet Co v K&S Foods Inc.**
16. Person's Co. v. Christman
17. First Niagara Ins. v. First Niagara Financial
18. Sections 2(e)(2) and (3) of the Lanham Act: Geographic Terms
19. **In Re Joint-Stock Company "Baik"**
20. In Re Miracle Tuesday, LLC
21. In re Spirits International, NV
22. Note: Special Protection for Wines and Spirits
23. Note: Geographically Suggestive Marks
24. 15 U.S.C. §1502 [Lanham Act §2(e)(4)]
25. In Re Quadrillion Publishing Ltd
26. Note: Numerals, Letters and Initials
27. 15 U.S.C. §1052(e)(5) [Lanham Act §2(e)(5)]
28. In Re Becton, Dickinson and Co.
29. In Re Vertex Group LLC

Class 6: Loss of Trademark Rights

Casebook pp. 279-314

1. **Bayer Co. v. United Drug Co.**
2. Stix Products, Inc. v. United Merchants & Mfrs., Inc.
3. Note: Protecting Trademarks Against Genericism

4. **King-Seeley Thermos Co. v. Aladdin Industries, Inc.**
5. **EI Dupont De Nemours & Co. v. Yoshida International, Inc.**
6. In re Country Music Association
7. Note: Legislative “Clarification” of Standards to Assess Genericism
8. Note: De Facto Secondary Meaning
9. **America Online, Inc. v. AT&T Corp.**
10. Facebook, Inc. v. Teachbook.com
11. Welding Services Inc. v. Forman
12. **Harley Davidson v. Grottanelli**
13. H-D Michigan v. Top Quality Serv.
14. Note: Dial 1-800-[G-E-N-E-R-I-C]
15. Recapturing Generic Terms?
16. **Miller’s Ale House v. Boynton Carolina Ale House**

Casebook page 315-348

17. **15 USC §1127 [Lanham Act §45]**
18. **Silverman v. CBS, Inc.**
19. ITC Limited v. Punchgini
20. Crash Dummy movie v. Mattel, Inc.
21. Specht v. Google, Inc.
22. Grocery Outlet Inc. v. Albertson’s Inc.
23. Note: The Song is Ended (but the Melody Lingers on)

24. **American Association for Justice v. American Trial Lawyer's Ass'n**
25. **Clark & Freeman Corp. v. Heartland Co. Ltd.**
26. **Eva's Bridal Ltd v. Halanick Enterprises, Inc.**
27. Freecycle Sunnyvale v. Freecycle Network
28. Patsy's Italian Restaurant v. Banas

Class 7

Infringement - Defendant's use in Commerce pp. 349-366 & Infringement – Secondary Liability for Trademark Infringement Casebook pp. 444-489

1. **15 USC Section 1114 [Lanham Act Section 32(1)]**
2. **Naked Cowboy v. CBS**
3. Karl Storz Endoscopy-America, Inc. v. Surgical Technologies, Inc.
4. 1-800 Contacts, Inc. v. Lens.com, Inc.
5. Rescue.com Corp v. Google, Inc.
6. Note: Use in Commerce and the Debate Over "Trademark Use"
7. **Steele v. Bulova Watch Co.**
8. **McBee v. Delica**
9. **Inwood Labs., Inc. v. Ives Labs., Inc.**
10. Georgia Pacific v. Von Drehle; Georgia Pacific v. Myers
11. **Tiffany and Company v. Ebay, Inc.**
12. Rosetta Stone Ltd. V. Google, Inc.

13. 15 USC Section 1125(a)(1)(A) [Lanham Act Section 43(a)(1)(A)]
14. Note: The Expanding Scope of Section 43(a)
- 15. DC Comics v. Powers**
16. Pretty Girl, Inc. v. Pretty Girl Fashions, Inc.
- 17. Two Pesos, Inc. v. Taco Cabana, Inc.**
18. Hammerton, Inc. v. Heisterman
- 19. Louis Vuitton Malletier v. Dooney & Bourke, Inc.**
- 20. Conopco, Inc. v. May Dept. Stores Co.**
21. McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC

Class 8

Infringement Casebook pp. 366-444 -- Likelihood of Confusion

1. Restatement of the Law (Third) Unfair Competition Section 20

Standard of Infringement

- 2. Polaroid Corp v. Polarad Elects. Corp.**

3. Restatement of the Law (Third) Unfair Competition Section 21 Proof of

Likelihood of Confusion: Market Factors

- 4. E&J Gallo Winery v. Consorzio Del Gallo Nero**
5. Banfi Products Corp. v. Kendall-Jackson Winery Ltd
6. Leelanau Wine Cellars, Ltd v. Black & Red, Inc.
7. Note: Is Likelihood of Confusion a Question of Fact or a Question of Law?

8. **Maker's Mark Distillery, Inc. v. Diageo North America, Inc.**
9. Robert G. Bone, Taking the Confusion Out of Likelihood of Confusion: Towards a More Sensible Approach to Trademark Infringement
10. **Mobil Oil Corp v. Pegasus Petroleum Corp**
11. Blockbuster Entertainment Group v. Laylco, Inc.
12. **Network Automation, Inc. v. Advanced Systems Concepts, Inc.**
13. Rosetta Stone Ltd. v. Google, Inc.
14. **Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.**
15. Jeremy N. Sheff, Veblen Brands
16. **Munsingwear, Inc .v .Jockey International**
17. Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.
18. Dreamwerks Production, Inc v. SKG Studio
19. Medic Alert Foundation v. Corel Corp
20. **Anheuser-Busch, Inc. v. Balducci Publications**

Class 9

Casebook 489-540 – Marketing Concepts and Techniques & False Endorsement & False Designation of Origin

1. Original Appalachian Artworks, Inc v. The Toy Loft, Inc.
2. **Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.**
3. **Best Cellars Inc. v. Grape Finds at Dupont, Inc.**
4. Best Cellars v. Wine Made Simple
5. Note: Rights of Publicity and Section 43(a)
6. **Allen v. National Video, Inc.**
7. **Tom Waits v. Frito-Lay, Inc.**
8. **White v. Samsung Electronics America, Inc.**
9. **America Online v. LCGM, Inc.**
10. Note: Authors' and Performer' Moral Rights
11. **Dastar Corporation v. Twentieth Century Fox Film Corp.**
12. **Bretsford Mfg., Inc. v. Smith System Mfg. Corp.**

Class 10

Casebook 541-605

Defenses to Infringement

1. **15 U.S.C §1065 [Lanham Act Section 15]**
2. Note: Section 33 of the Lanham Act
3. **Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.**
4. Note: Incontestable Registration and Strength of the Mark
5. **In Re Bose Corp.**

6. Sovereign Military Hospitaller Order of Saint John of Jerusalem of Rhodes and of Malta v. Florida Priory of the Knights Hospitallers of the Sovereign Order of Saint John of Jerusalem, Knights of Malta, The Ecumenical Order
7. Fair Use: Section 33(b)(4)
8. **United States Shoe Corp. v. Brown Group Inc.**
9. Kelly-Brown v. Winfrey
10. **Car-Freshner Corp. v. S.C. Johnson & Son Inc.**
11. **KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.**
12. **Jay Franco & Sons, Inc. v. Franek**
13. **Christian Louboutin SA v. Yves St Laurent America Holding, Inc.**
14. Au-Tomotive Gold, Inc. v. Volkswagen of America
15. **Pro-Football Inc v. Harjo**
16. Oriental Fin. Group, Inc. v. Cooperativa de Ahorro y Credito Oriental
17. **New kids on the Block v. News America Publishing**
18. **Swarovski Aktiengesellschaft v. Buidling # 19, Inc.**
19. Kassbaum v. Steppenwolf Productions, Inc.
20. **WCVB-TV v. Boston Athletic Association**
21. Toyota Motor Sales USA, Inc. v. Tabari

Class 11

Defenses to Infringement

605-664

1. Note: Failed Nominative Fair Use Defenses
2. **Smith v. Chanel, Inc.**
3. **College Savings Bank v . Florida Prepaid Postsecondary Education Expense Board**
4. **Rogers v. Grimaldi**
5. **Louis Vuitton Malletier SA v. Warner Brothers Entertainment Inc**
6. **ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc.**
7. **Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.**
8. **Dr. Seuss Enterprises, LP v. Penguin Books USA, Inc**
9. Rochelle Dreyfuss, Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity
10. Mattel Inc v. Universal Music International
11. Mattel Inc v. Walking Mountain Productions
12. Protectmarriage.com v. Courage Campaign

Class 12

Dilution

665-752

1. Barton Beebe, The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Langericht Elberfeld's Odol Decision and Frank Schechter's The Rational Basis of Trademark Protection
2. Sara Stadler, The Wages of Ubiquity in Trademark Law
3. **Ty Inc. v. Perryman**
4. Rebecca Tushnet, Gone in 60 Milliseconds: Trademark Law and Cognitive Science
5. Barton Beebe, Intellectual Property Law and The Sumptuary Code
6. Note: History of Federal Dilution Statute
7. **15 USC Section 1125© [Lanham Act Section 43(c)]**
8. **National Pork Board v. Supreme Lobster and Seafood Company**
9. Note: Surveying Dilution by "Blurring"
10. Coach Services, Inc. v. Triumph learning LLC
11. **Visa International Service Association v. JSL Corp.**
12. **Rolex Watch USA Inc v. AFP Imaging Corporation**
13. V Secret Catalogue, Inc. v. Moseley
14. **Louis Vuitton Malletier SA v. Haute Diggity Dog, LLC**

15. **Starbucks Corp v. Wolfe's Borough Coffee, Inc.**
16. Stacey L. Dogan & Mark A. Lemley, Parody as Brand (November 2, 2012)
17. **The Hershey Company v. Art Van Furniture, Inc.**
18. Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.
19. **Mastercard International Inc v. Nader 2000 Primary Committee, Inc.**
20. Mattel, Inc. v. Universal Music International
21. Louis Vuitton Malletier SA v. Hyundai Motor America
22. Dilution Under State Law

Class 13

False Advertising

Page 753-814

1. Rebecca Tushnet, Running the Gamut from A to B: Federal Trademark and False Advertising Law
2. **15 USC Section 1125(a)(1)(B) [Lanham Act Section 43(a)(1)(B)]**
3. Gordon and Breach Science Publishers SA v. America Institute of Physics
4. **Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc.**

5. Neuros Co., Ltd. v. KTurbo, Inc.
6. **Coca-Cola Co. v. Tropicana Prods., Inc.**
7. United Industries Corp. v. Clorox Co.
8. Schick Manufacturing, Inc. v. The Gillette Company
9. **Clorox Co., Puerto Rico v. Proctor & Gamble Commercial Co.**
10. **Autodesk, Inc. v. Dassault Systemes Solidworks Corp**
11. **Church & Dwight Co v The Clorox Company**
12. **Innovation Ventures LLC v. NVE, Inc.**
13. **Coors Brewing Company v Anheuser-Busch Co.**
14. **McNeil-PPC, Inc. v. Pfizer Inc.**
15. Pernod Ricard USA, LLC v. Bacardi USA, Inc.
16. Serbin v. Ziebart International Corp.
17. Ortho Pharmaceutical Corp. v. Cosprophar, Inc.
18. Famous Horse, Inc. v. 5th Avenue Photo, Inc.
19. Please read the Lexmark International, Inc. v. Static Control Components, Inc. (it is listed on the course materials page).

Class 14

Remedies **JBA PLEASE CHOOSE WHICH CASES YOU WOULD LIKE TO BE BOLD**

Pages 925-981

1. Nova Wines, Inc. v. Adler Fels Winery LLC
2. Note: Presumption of Irreparable Harm

3. Note: Centrality of Injunctive Relief and Use of Alternative Dispute Resolution
4. Home Box Office v. Showtime
5. Soltex Polymer Corp. v. Fortex Industries, Inc.
6. Perfect Fit Indus. v. Acme Quilting Co.
7. Nikon, Inc. v. Ikon Corp.
8. Gucci America, Inc. v. Daffy's, Inc.
9. Maker's Mark Distillery, Inc. v. Diageo North America, Inc.
10. Already, LLC d/b/a Yums v. Nike, Inc.
11. Taco Cabana Int'l, Inc. v. Two Pesos, Inc.
12. Banjo Buddies, Inc. v. Renosky
13. Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.
14. U-Haul International, Inc. v. Jartran, Inc.
15. Nightingale Home Healthcare, Inc. v. Anodyne Therapy, LLC
16. Trafficschool.com Inc. v. Edriver Inc.
17. Note: The Problem of Counterfeiting
18. 15 USC § 1127 [Lanham Act § 45]
19. Rolex Watch, USA, Inc. v. Michel Co.
20. Hunting World, Inc. v. Reboans
21. Century 21 Real Estate, LLC v. Destiny Real Estate Properties
22. 18 USC § 2320
23. United States v. Torkington

**STOPPED HERE WITH REMEDIES (PAGE 981) – LET ME KNOW IF YOU WANT TO GO
ANY FURTHER.**

Trademark Law
James B. Astrachan, Esquire
Syllabus

FACULTY INFORMATION

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