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 1002 on Mondays from 4:45 pm to 7:30 pm, with the exception of holidays or cancellations.

COURSE MATERIALS

The required course texts is:
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:

George & Company v. Imagination 575 F. 3d 383 (posted on TWEN - DO NOT READ ABANDONMENT)

Introduction to Trademarks
Casebook pp. 1-21

2. Restatement of the Law (Third) Unfair Competition § 1
4. Cheney Bros v. Doris Silk Corp
5. Sears, Roebuck & Co. v. Stiffel Co.
7. Bonito Boats v. Thunder Craft Boats
8. National Basketball Association v. Motorola

Class 2:

Concepts of Trademarks and Unfair Competition
Casebook pp. 21-56 (SKIM THIS MATERIAL)

Subject Matter of Trademark Protection
Casebook pp. 57-85

2. Coca-Cola Co. v. Koke Co. Of America
3. Peaceable Planet, Inc. v. TY, Inc.
5. Qualitex Co. v. Jacobson Products Co., Inc.
7. Note: Service Marks
8. Note: Trademark Actions Before the Trademark Tribunals and Before the Federal Judicial Courts

Class 3:

Distinctiveness of Trademarks
Casebook pp. 85-114
1. Swatch AG v. Beehive Wholesale, LLC (on TWEN)
3. In the Matter of the Application of Quik-Print Copy Shops, Inc.
4. Zobmondo Entertainment, LLC. V. Falls Media, LLC
5. In Re Vertex Group, LLC
6. Rock and Roll Hall of Fame and Museum v. Gentile
7. Wal-mart Stores, Inc. v. Samara Brothers, Inc.
8. American Waltham Watch Co. v. United States Watch Co.
10. Board of Supervisors For Louisiana State University Agricultural and Mechanical College v. Smack Apparel Co.
11. Chrysler Group LLC v. Moda Group LLC

Class 4:

Use and Ownership
Casebook pp. 121-174

1. Thoroughbred Legends, LLC v. Walt Disney Co.
2. American Express Co. V. Gotez
3. Bell v. Streetwise Records, LTD
6. Note: Token Use
7. In Re Dell, Inc.
8. Larry Harmon Pictures Corp v. Williams Restaurant Corp.
9. Note: Foreign Commerce
11. ITC LTD. V. Punchgini
14. City of New York v. Tavern on the Green
15. United Drug Co. v. Theodore Rectanus Co.
17. Dudley v. HealthSource Chiropractic Inc.,
18. Dawn Donut Co. v. Hart’s Food Stores, Inc.
Class 5:

Registration of Trademarks
Casebook 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
Casebook 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
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
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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 NewBridge Cutlery Co., 776 F.3d 854 (Fed. Cir. 2015)- ON TWEN**
20. **In Re Joint-Stock Company “Baik”**
21. In Re Miracle Tuesday, LLC
22. In re Spirits International, NV
23. Note: Special Protection for Wines and Spirits
24. Note: Geographically Suggestive Marks
26. In Re Quadrillion Publishing Ltd
27. Note: Numerals, Letters and Initials
28. 15 U.S.C.§1052(e)(5) [Lanham Act §2(e)(5)]
29. In Re Becton, Dickinson and Co.
30. In Re Vertex Group LLC
31. **Blackhorse v. Pro-Football, Inc. (Supplement, Page 6)**

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. **El Dumont 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**
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**
Abandonment
Casebook page 315-348

17. Wells Fargo & Company v. ABD Insurance and Financial Services (on TWEN)
18. 15 USC § 1127 [Lanham Act § 45]
20. ITC Limited v. Punchgini
23. Grocery Outlet Inc. v. Albertson’s Inc.
24. Standard for Proving Abandonment
25. Note: The Song is Ended (but the Melody Lingers on)
26. American Association for Justice v. American Trial Lawyer’s Ass’n
27. Clark & Freeman Corp. v. Heartland Co. Ltd.
29. Freecycle Sunnyvale v. Freecycle Network
30. Patsy’s Italian Restaurant v. Banas
32. Spect v. Google, Inc. (Supplement, Page 22)

Class 7:

Infringement - Defendant’s use in Commerce
Casebook pp. 349-366

1. 15 USC Section 1114 [Lanham Act Section 32(1)]
2. Naked Cowboy v. CBS
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

Infringement-Likelihood of Confusion
Casebook pp. 366-421

9. Restatement of the Law (Third) Unfair Competition Section 20
Standard of Infringement
11. Restatement of the Law (Third) Unfair Competition Section 21
   Proof of Likelihood of Confusion: Market Factors
12. George & Company v. Imagination 575 F. 3d 383 (posted on TWEN)
14. E&J Gallo Winery v. Consorzio Del Gallo Nero
15. Banfi Products Corp. v. Kendall-Jackson Winery Ltd
17. Note: Is Likelihood of Confusion a Question of Fact or a Question of Law?
20. Mobil Oil Corp v. Pegasus Petroleum Corp

Class 8:

Infringement-Likelihood of Confusion Continued
Casebook pp. 422-458

2. Jeremy N. Sheff, Veblen Brands
3. Munsingwear, Inc. v. Jockey International
5. Dreamwerks Production, Inc. v. SKG Studio
6. Medic Alert Foundation v. Corel Corp
8. Inwood Labs, Inc. v. Ives Labs, Inc.
9. Georgia Pacific v. Von Drehle; Georgia Pacific v. Myers

Lanham Act
Casebook pp. 459-487
12. 15 USC Section 1125(a)(1)(A) [Lanham Act Section 43(a)(1)(A)]
13. Note: The Expanding Score of Section 43(a)
14. **DC Comics v. Powers**
16. **Two Pesos, Inc. v. Taco Cabana, Inc.**
17. Hammerton, Inc. v. Heisterman
18. **Louis Vuitton Malletier v. Dooney & Bourke, Inc.**
19. **Conopco, Inc. v. May Dept. Stores Co.**

**Class 9:**

**Lanham Act- Marketing Concepts and Techniques, False Endorsement, False Designation of Origin**

*Casebook pp. 489-540*

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:**

**Defenses to Infringement**

*Casebook pp. 541-605*

1. 15 U.S.C § 1065 [Lanham Act Section 15]
2. Note: Section 33 of the Lanham Act
4. Note: Incontestable Registration and Strength of the Mark
5. *In Re Bose Corp.*
7. Fair Use: Section 33(b)(4)
8. United States Shoe Corp. v. Brown Group Inc.
9. Kelly-Brown v. Winfrey
11. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.
12. Jay Franco & Sons, Inc. v. Franek
15. Pro-Football Inc v. Harjo
17. New kids on the Block v. News America Publishing
20. WCVB-TV v. Boston Athletic Association
21. Toyota Motor Sales USA, Inc. v. Tabari
22. Kelly-Brown v. Winfrey (Supplement, Page 34)

Class 11:

Defenses to Infringement
Casebook pp. 605-664

1. Note: Failed Nominative Fair Use Defenses
2. Smith v. Chanel, Inc.
3. First Sale
4. College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board
5. Rogers v. Grimaldi
11. Rochelle Dreyfuss, Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity
12. Mattel Inc v. Universal Music International
13. **Mattel Inc v. Walking Mountain Productions**

14. **Protectmarriage.com v. Courage Campaign**

15. **Pennzoil-Quaker State Co. v. Miller Oil and Gas Operations, 779 F.3d 290 (5th Cir., 2015).**

Class 12:

Dilution

Casebook pp. 665-752

1. **Barton Beebe, The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Landgericht Elberfeld’s Odol Decision and Frank Schecter’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.**


20. **Mattel, Inc. v. Universal Music International**

21. **Louis Vuitton Malletier SA v. Hyundai Motor America**

22. **Dilution Under State Law**

23. **Inter IKEA Systems BV v. Akea LLC (Supplement, Page 44)**

24. **Chanel, Inc v. Makarczyk (Supplement, Page 44)**
Class 13:

False Advertising
Casebook pp. 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)]
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
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.
15. Pernod Ricard USA, LLC v. Bacardi USA, Inc.
17. Ortho Pharmaceutical Corp. v. Cosprohar, 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).

Internet Domain Names
Casebook 815-924

**Read article on TWEN: Slutsof v. Instagram highlights unpredictability of domain name enforcement

21. ICANN and the Problem of Legetimacy by Jonathan Weinberg
22. Internet Corporation for Assigned Names and Numbers, Basic TLD Information
23. The DNS Wars by Jessica Litman
24. 15 USC Section 1125(d)(1)
27. Southern Company v. Dauben, Inc.
28. Land’s End, Inc. v. Remy
29. Gopets Ltd. v. Hise
31. Lucas Nursery and Landscaping, Inc. v. Grosse
32. Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research
33. Note: Section 43(d) and Gripe Sites
34. People for the Ethical Treatment of Animals v. Doughney
35. Lamparello v. Falwell
36. Bad Faith in Cyberspace: Grounding Domain Name Theory in Trademark, Property and Restitution
37. Solid Host, NL v. Namecheap, Inc.
38. Microsoft Corp v. Shah
39. Ford v. GreatDomains.com
41. 15 USC Section 1125(d)(2)
42. Harrods Limited v. Sixty Internet Domain Names
43. Cable News Network LP v. CNNNews.com
44. Note: In Rem Actions Regarding US Registrations of Foreign-Held Domain Names Corresponding to Foreign Trademarks
45. ICANN and the Uniform Trademark Domain Name Dispute Resolution Policy
46. Uniform Domain Name Dispute Resolution Policy
47. Dial-a-Mattress Operating Corp. v. Christopher E. Moakely
48. Deutsche Welle v. Diamondware Limited
50. The Orange Bowl Committee, Inc. v. Front and Center Tickets, Inc/ Front and Center Entertainment
51. Direct Line Group Ltd v. Purge I.T.
52. Air Austral v. Tian Yi Tong Investment Ltd
53. Hoteles Turisticos Unidos SA HOTUSA v. Jomar Technologies
54. Southern California Regional Rail Authority v. Arkow
55. Note: New Top Level Domains and New Rights Protections Mechanisms
56. Sallen v. Corinthians Licencamientos LTDA
57. Dluhos v. Strasberg
58. Barcelona.com, Inc. v. Excelentisimo Ayuntamiento de Barcelona

Class 14:

Remedies
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** READ TAKOMA ACADEMY OPINION POSTED ON TWEN**

Casebook pp. 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.
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
17. Trafficschool.com Inc. v. Edriver Inc.
18. Note: The Problem of Counterfeiting
19. 15 USC § 1127 [Lanham Act § 45]
20. Rolex Watch, USA, Inc. v. Michel Co.
21. Hunting World, Inc. v. Reboans
22. Century 21 Real Estate, LLC v. Destiny Real Estate Properties
23. 18 USC § 2320
24. United States v. Torkington

FACULTY INFORMATION

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