**Trademark & Unfair Competition Law BU School of Law**

**Prof. Stacey Dogan Fall 2014**

**Administrative Matters**

* Class meets on Tuesdays and Thursdays, 10:45-12:10, in room 101. **We will not have class on Tues, Sept 2, Thurs, Sept 25, or Tues, Nov 18. Make-ups will be held on the following Fridays, from 12:40-2:05 (note room changes): 9/19 in 211; 9/26 in 102; and 10/31 in 101.** I will have all of these make-up classes recorded for those with an unavoidable conflict.
* My office is room 304A at 910 Commonwealth Ave. You can reach me at x3-3142 or [sdogan@bu.edu](mailto:sdogan@bu.edu). Office hours will be after on Tuesdays, 12:30-2, in the Commons, or by appointment at an agreed-upon time and place.

**Grading**

* Your grade will be based on your performance on a 3-hour in-class exam.
* I use a modified panel system, which I will explain in the first day of class. Each student must sign up to be “on” for 4 classes.
* Particularly exemplary class participation can result in a half-grade bump-up (i.e., B+ to A-; B- to B). Please keep in mind that “exemplary” refers to quality, rather than quantity; the thoughtfulness of your questions and comments, rather than frequency or even accuracy, is what counts.
* Regular attendance is expected; please let me know ahead of time if you have to miss class. Poor class attendance, or obvious and repeated lack of preparation for class, can result in a half-grade bump down. This happens rarely, and only for students who are clearly failing to meet their responsibilities toward the class. I will give advance notice to students who are at risk of a bump-down.

**Reading Assignments**

This syllabus provides my initial reading plan. We will undoubtedly make adjustments during the semester, both to add new material (in the event of new developments) and to omit some (if we’re falling behind). If this happens, I will notify you in class, and will post any revisions on the Blackboard website.

Our casebook is Barton Beebe, *Trademark Law: An Open-Source Casebook*. With Professor Beebe’s permission, I am adapting the casebook for our class, and the materials posted on the Blackboard site are thus a modified version of the original Beebe casebook.

**Other resources**

*Blogs*: Rebecca Tushnet’s 43(B)log, <http://tushnet.blogspot.com/>

Eric Goldman’s Technology & Marketing Law Blog, <http://blog.ericgoldman.org/>

Marty Schwimmer’s trademark blog, <http://www.schwimmerlegal.com/>

John Welch’s *The TTAB Blog*, <http://thettablog.blogspot.com/>

Jeremy Phillips, Ilanah Simon Fhima, Johanna Gibson, and David Pearce’s *IPKat* (European IP issues), <http://ipkitten.blogspot.com/>

*Reference Materials*:

McCarthy on TM & Unfair Competition, in library or through Westlaw

Gilson on Trademark Protection and Practice, available on Lexis

**SYLLABUS:**

Class 1

1. **INTRODUCTION**
2. **ESTABLISHING RIGHTS (Part I of casebook)**

**Distinctiveness – inherent distinctiveness & the *Abercrombie* spectrum**

pp. 5-17 (*Abercrombie v. Hunting World)*

Class 2

**Descriptive vs. suggestive marks; special rules for certain marks; acquired distinctiveness**

pp. 17-41 (*Zatarains v. Oak Grove; Innovation Ventures v. NVE; Zobmondo v. Falls Media; Frosty Treats v. Sony*)

Class 3 **Acquired distinctiveness cont’d; Generic marks**

pp. 41-66 (*Cartier v. Four Star Jewelry; Board of Supervisors v. Smack Apparel; Pilates v. Current Concepts*)

Class 4 **Generic marks cont’d; further examples applying *Abercrombie*;distinctiveness of non-verbal marks**

pp. 66-96 (*Frito-Lay v. Princeton; Two Pesos v. Taco Cabana*)

Class 5 **Distinctiveness of non-verbal marks cont’d; packaging vs. design**

pp. 96-118 (*Wal-Mart v. Samara Bros.; In re Slokevage*)

Class 6 **Packaging vs. design cont’d; inherent distinctiveness of packaging & note on acquired distinctiveness of trade dress**

pp. 118-145 (*McKernan v. Burek; Best Cellars v. Wine Made Simple; Fedders v. Elite Classics; Fun-Damental Too v. Gemmy Industries; Amazing Space v. Metro Mini-Storage; Fiji v. Fiji; Star v. Bacardi*)

Class 7 **Bars to protection: functionality**

pp. 148-170 (*In re Morton-Norwich*; *Inwood v. Ives; Traffix v. Marketing Displays*)

Class 8 **Functionality post-*Traffix***

pp. 171-205 (*Valu Engineering v. Rexnord; Eppendorf v. Ritter; Talking Rain Bev. Co. v. South Beach; Specialized Seating v. Greenwich Indus.; Pagliero v. Wallace; Wallace v. Godinger; Louboutin v. YSL; note on aesthetic functionality in 9th Circuit*)

Class 9 **Deceptive & deceptively misdescriptive marks; scandalous & disparaging marks**

pp. 206-229 (*In re California Innovations; In re Marsha Fox; In re Heeb Media*)

Class 10 **Disparaging marks cont’d; marks that falsely suggest a connection; confusingly similar marks under § 2(d)**

pp. 229-257 (*Blackhorse v. Pro-Football*; *In re Jackson*)

Class 11 **Use as a prerequisite for TM rights**

pp. 258-281 (*Aycock v. Airflite; Planetary Motion v. Techsplosion*)

Class 12 **The registration process; the territorial extent of trademark rights**

pp. 281-305 (*United Drug v. Rectanus*)

Class 13 **The territorial extent of rights in registered marks; the well-known marks doctrine**

pp. 305-336 (*Persons v. Christman; Grupo Gigante v. Gallo*)

Class 14 **Well-known marks cont’d**

pp. 336-358 (*ITC v. Punchgini* (2d Cir. & NY Court of Appeals))

1. **Trademark Infringement (Part II of casebook)**

Class 15 **“Use” under the Lanham Act’s infringement provisions**

pp. 3-26 (*Rescuecom v. Google; Bosley v. Kremer*)

Class 16 **Confusion-based trademark theories – intro to LOC**

pp. 26-51 (*Borden v. Borden’s; Polaroid v. Polarad; Virgin v. Nawab*)

Class 17 **Survey evidence on confusion; sponsorship confusion**

pp. 51-79 (*Smith v. Wal-Mart;* Lemley & McKenna, *Irrelevant Confusion* (excerpt))

Class 18 **Initial interest confusion; post-sale confusion**

pp. 79-110 (*Network Automation v. Advanced Systems Concepts*; *Ferrari v. Roberts*)

Class 19 **Reverse confusion & reverse passing off; § 2(d) confusion**

pp. 110-140 (*A&H Sportswear v. Victoria’s Secret; Dastar v. Twentieth Century Fox*)

Class 20 **Dilution – intro and blurring**

pp. 141-175 (*Nike v. NikePal*; *Starbucks v. Wolfe’s Borough*)

Class 21 **Dilution – tarnishment; note on cybersquatting; secondary liability**

pp. 175-197 (*Victoria’s Secret v. Moseley; facts only of Tiffany v. eBay*)

Class 22 **Secondary liability cont’d**

pp. 197-221 (*Tiffany v. eBay cont’d; Gucci v. Frontline*)

1. **Defenses (Part III of casebook)**

Class 23 **Descriptive fair use**

pp. 2-34 (*KP Permanent v. Lasting Impression; Dessert Beauty v. Fox; Kelly-Brown v. Winfrey; International Stamp Art v. USPS; Bell v. Harley Davidson; Fortune Dynamic v. Victoria’s Secret*)

Class 24 **Nominative fair use; intro to expressive uses**

pp. 34-62 (*Toyota v. Tabari; Tiffany v. eBay;* *Louis Vuitton v. Haute Diggity Dog (through discussion of TM infringement claim*))

Class 25 **Expressive uses cont’d; intro to abandonment**

pp. 63-90, 95-104 (*Luis Vuitton v. Haute Diggity Dog (cont’d; discussion of dilution claim; ESS Entertainment v. Rock Star Videos; Brown v. Electronic Arts; Mattel v. MCA Records; Louis Vuitton v. Hyundai; MPS Entm’t v. Abercrombie & Fitch; ITC v. Punchgini)*

The documents regarding the Penn Law School controversy (pp. 91-95) are entertaining and optional.

Class 26 **Trademark abandonment; first sale**

pp. 104-136 (*Crash Dummy v. Mattel; FreecycleSunnyvale v. Freecycle Network; Champion Spark Plug v. Sanders; Nitro Leisure Prods v. Acushnet*)