

Trademark Law: An Open-Source Casebook

Significant Changes from v4.0 to v5.0

17 July 2018

Listed here are the major changes from Version 4.0 to Version 5.0. **New excerpted opinions are given in bold.**

Refer to the redlines posted on the casebook website for less significant changes (correction of typos, grammar, etc.). In recent versions of Microsoft Word, load the redline, go to the review tab, and use the “Next” function to proceed through all changes.

Introduction

- Dropped paragraphs in McKenna excerpt about *Southern v. How*
- Added detail that *Blanchard v. Hill* resulted in no injunction

Part I

- Added reference to registration of Play-Doh scent
- Deleted reference to registration of image of hand gesture
- Added question asking whether the Innovation Ventures court (5-hour Energy) adopted a sensible approach to determining suggestiveness
- Added paragraph on protectability of hashtag expressions
- Deleted previous opinions and inserted **new TTAB opinion in Frito-Lay North America, Inc. v. Princeton Vanguard, LLC**
- Deleted comment about Anti-Monopoly case and unique products
- Pared down Justice Stevens’ concurrence in *Two Pesos*
- Added excerpt from ***LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.***
- Pared down *Amazing Spaces* a bit
- Pared down *In re Morton-Norwich* a bit
- Inserted ***In re Brunetti***
- In ITU part, replaced *M.Z. Berger* with ***Kelly Services, Inc. v. Creative Harbor, LLC***
- Tried to improve somewhat the examples for 7(c) and 33(b)(4)

Part II

- Added paragraph giving a bit more context for Radiance Foundation
- Added new subpart giving a few more examples of cases where courts found LOC or found no LOC
- Added reference to *Lucasfilm v. Ren Ventures* on the issue of trademark rights in fictional elements of expressive works
- Pared down *Dastar* a bit
- Pared down the Charbucks case a bit
- In UDRP subpart, deleted *Eastman Sporto* and inserted ***Pinterest***
- In comments following *eBay v Tiffany*, added comment asking about Amazon’s liability for sale on its site by third parties of counterfeits and the impact of *Tiffany v. eBay* on brick-and-mortar secondary liability.

Part III

- Rearranged *Mattel v. Walking Mountains* so that it is now offered as an example of a nominative fair use opinion
- Pared down *Brown v. EA* a bit
- Added excerpt from ***Virag v. Sony*** as example of *Rogers v. Grimaldi* applied
- Added question about “prong zero” of *Rogers v. Grimaldi* on whether the defendant’s work is an expressive work
- Added a comment on why a firm might deliberately abandon a mark
- Added a comment on intent not to abandon versus intent not to resume use
- Added ***Davidoff v. PLD Int’l*** for those who don’t want to assign *Nitro Leisure*

Part IV

- Dropped this part entirely on the ground that no one seems to use it. For those who wish to incorporate false advertising, Version 4.0 of the casebook remains accessible at tmcasbook.org.

Part IV (Right of Publicity)

- Pared down *NCAA* majority opinion

Part V (Remedies)

- Deleted *Juicy Couture* and inserted ***adidas v. Skechers***