

TRADEMARK LAW

Fall 2007

University of Pittsburgh School of Law
Prof. Madison

Course homepage:

<http://madisonian.net/homepage/trademark/fall07/home.htm>

Prof. Madison's homepage:

<http://madisonian.net/homepage/index.htm>

COURSE INFORMATION

Class Meeting Time and Place

Mondays and Tuesdays, from 10:25 a.m.
to 11:40 a.m. in Room 109.

Contacting Prof. Madison

I have learned that few students ever appear during scheduled office hours, so I don't schedule them. I am happy to meet with you at your convenience.

My office is Room 303. Make an appointment via e-mail at madison@pitt.edu or michael.j.madison@gmail.com.

Required Course Materials

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Grading

Your grade for this course will be based on three short open research memos. The first two memos will each be worth 30% of the final grade. The final memo will be worth 40% of the final grade. The substance and format of memos, their timing, and their due dates will be discussed in class.

Slides

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Comprehensive Syllabus

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READING ASSIGNMENTS

The page numbers listed below under "Casebook" refer to Graeme B. Dinwoodie & Mark D. Janis, *Trademarks and Unfair Competition: Law and Policy* (Second Edition, 2007).

How to read the Syllabus: Except as noted below, each assignment below corresponds tentatively to one class period, though the amount of material to be covered in class, the order of the assignments, and/or the contents of a particular assignment may be changed by prior announcement. Note, for example, that we will have more class meetings than there are assignments. I will make every effort to incorporate new developments in trademark law into the Syllabus, where appropriate.

Within each assignment, the Syllabus notes the principal case(s) covered in the text. In addition to the assigned readings, where a case or other material refers to the Lanham Act (Title 15 of the United States Code), you are responsible for locating and reading the section(s) of the Act to which the text refers. If you do not own a copy of the Lanham Act, you can access a free, online version here.

For each assignment, I have specified one or more questions that we will take up in class. As part of your preparation for each class, you should prepare to respond to these questions.

For several of the units of reading, **optional** law review articles are included. Some of these are relatively short. Some are quite long. Reading some or all of them will give you a deeper picture of the current state of trademark law and policy than you will get by focusing on appellate cases and the statute alone. All of the articles are available via the University of Pittsburgh -- Trademark Law course page on the TWEN research service, in the Westlaw network.

I. Foundations and Purposes of Trademark and Unfair Competition Law

Optional: Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 Va. L. Rev. 2099 (2004)

Class 1: Introduction Casebook 3-26

Class 2: An Illustration Casebook 26-40

- Case: *Elvis Presley Enterprises v. Capece*

II. Creation of Trademark Rights

Optional: Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 Iowa L. Rev. 611 (1999)

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Class 3: Distinctiveness Casebook 43-63

- Cases: *Abercrombie & Fitch Co. v. Hunting World, Inc.*; *In re Oppehahl & Larson LLP*; *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*

Class 4: Distinctiveness Casebook 64-91

- Cases: *Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*; *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*; *Haughton Elevator Company v. Seeberger*; *Murphy Door Bed Co. v. Interior Sleep Systems, Inc.*; *Blinded Veterans Assn. v. Blinded American Veterans Found.*; *Peaceable Planet, Inc. v. Ty, Inc.*; *Star Indus., Inc. v. Bacardi & Co., Ltd.*

Class 5: Distinctiveness Casebook 91-123

- Cases: *Two Pesos, Inc. v. Taco Cabana, Inc.*; *Qualitex Co. v. Jacobson Products Co., Inc.*; *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*; *In re Slokevage*; *Yankee Candle Company, Inc. v. Bridgewater Candle Company, LLC*

Class 6: Subject Matter Exclusions Casebook 123-146

- Cases: *In re Clarke*; *Oliveira v. Frito-Lay, Inc.*; *Comedy III Productions, Inc. v. New Line Cinema*; *In re First Draft Inc.*; *Dastar v. Twentieth Century Fox Film Corp.*; *Bretford Mfg, Inc. v. Smith Sys. Mfg. Corp.*

Class 7: Functionality Casebook 147-184

- Cases: *In re Morton-Norwich Products, Inc.*; *Wallace Intl. Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*; *Brunswick Corp. v. British Seagull Ltd.*; *Qualitex Co. v. Jacobson Prods. Co., Inc.*; *Vordado Air Circulation Sys. Inc. v. Duracraft Corp.*

Class 8: Functionality Casebook 184-214

- Cases: *Traffix Devices, Inc. v. Marketing Displays, Inc.*; *Valu Engineering, Inc. v. Rexnord Corp.*; *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*; *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters*; *Au-tomotive Gold, Inc. v. Volkswagen of America, Inc.*

Memorandum Assignment Number One will be distributed around this time. The Assignment will be due on Monday, October 8.

Class 9: Use Casebook 215-244

- Cases: *Planetary Motion, Inc. v. Techsplosion, Inc.*; *Brookfield Communications, Inc. v. West Cost Entertainment Corp.*

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Class 10: Use Casebook 244-275

- Cases: *Warnervision Entertainment Inc. v. Empire of Carolina, Inc.*; *In re Rath*; *The Boogie Kings v. Guillory*; *Coca-Cola Co. v. Busch*

Class 11: Abandonment Casebook 275-301

- Cases: *Emergency One, Inc. v. American Fireeagle, Ltd.*; *Stanfield v. Osborne Industries, Inc.*; *University Book Store v. University of Wisconsin Board of Regents*

Class 12: Registration Casebook 303-332

- Cases: *Harjo v. Pro-Football, Inc.*; *In re Budge Manufacturing Co., Inc.*

Class 13: Registration Casebook 332-363

- Cases: *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*; *In re California Innovations, Inc.*; *In re United Distillers, PLC*; *In re Sauer*; *Park 'n' Fly, Inc. v. Dollar Park and Fly, Inc.*

III. Scope and Enforcement of Trademark Rights

Class 14: Geographic Limits Casebook 367-388

- Cases: *United Drug Co. v. Theodore Rectanus Co.*; *Dawn Donut Co., Inc. v. Hart's Food Stores, Inc.*; *What-a-Burger, VA v. Whataburger Corp. Christi, TX*; *National Assn. for Healthcare Communications, Inc. v. Central Arkansas Area Agency on Aging, Inc.*

Class 15: Territoriality Casebook 388-422

- Cases: *Person's Co., Ltd. v. Christman*; *Grupo Gigante v. Dallo & Co., Inc.*; *ITC Limited v. Punchgini, Inc.*; *International Bancorp LLC v. Societe Des Bains de Mer et du Cercle des Etrangers a Monaco*

Optional: Ann Bartow, *Likelihood of Confusion*, 41 San Diego L. Rev. 721 (2004)

Class 16: Likelihood of Confusion Casebook 443-479

- Cases: *Borden Ice Cream Co. v. Borden's Condensed Milk Co.*; *Fleischmann Distilling Corp. v. Maier Brewing Co.*; *Holiday Inns, Inc. v. 800 Reservations, Inc.*; *1-800 Contacts, Inc. v. WhenU.com, Inc.*; *J.G. Wentworth, S.S.C. Limited Partnership v. Settlement Funding LLC*; *Bosley Medical Institute, Inc. v. Kremer*

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Class 17: Likelihood of Confusion Casebook 479-520

- Cases: *Virgin Enterprises Ltd. v. Nawab*; *McDonald's Corp. v. Druck and Gerner, DDS., P.C., d/b/a McDental*; *Libman Company v. Vining Industries, Inc.*

Optional: Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 Yale L.J. 1717 (1999); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839 (2007)

Class 18: Likelihood of Confusion Casebook 520-534

- Cases: *Goto.com, Inc. v. Walt Disney Company*; *Boston Professional Hockey Association, Inc. v. Dallas Cap & Emblem Mfg., Inc.*

Memorandum Assignment Number Two will be distributed around this time. The Assignment will be due on Friday, November 9.

Class 19: Confusion Away from the Point of Sale Casebook 534-574

- Cases: *Brookfield Communications, Inc. v. West Coast Ent. Corp.*; *Lamparello v. Falwell*; *Playboy Enterprises, Inc. v. Netscape Communications Corp.*; *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*; *Ferrari S.P.A. Esercizio v. Roberts*; *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*

Optional: Barton Beebe, *Search and Persuasion in Trademark Law*, 103 Mich. L. Rev. 2020 (2005)

Class 20: Dilution Casebook 585-598

- Cases: *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*

Class 21: Dilution Casebook 598-611

- Cases: *Toys "R" Us, Inc. v. Akkaoui*; *Toys "R" Us, Inc. v. Feinberg*; *Nabisco, Inc. v. PF Brands, Inc.*

Class 22: Cybersquatting Casebook 611-657

- Cases: *Panavision International v. Toepfen*; *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*; *Lamparello v. Falwell*; *People for the Ethical Treatment of Animals v. Doughney*; *Harrods Ltd. v. Sixty Internet Domain Names*; *World Wrestling Federation Entertainment Inc. v. Bosman*; *Telstra Corp. Ltd. v. Nuclear Marshmallows*; *Barcelona.com v. Excelentísimo Ayuntamiento de Barcelona*

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Class 23: Permissible Uses Casebook 663-720

- Cases: *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*; *International Stamp Art, Inc. v. United States Postal Service*; *R.G. Smith v. Chanel, Inc.*; *Century 21 Real Estate Corp. v. Lendingtree, Inc.*; *Champion Spark Plug Co. v. Sanders*; *Nitro Leisure Products, L.L.C. v. Acushnet Co.*; *Gamut Trading Co. v. U.S.I.T.C.*

Class 24: Permissible Uses Casebook 720-742

- Cases: *Anheuser-Busch, Inc. v. Balducci Publications*; *Mattel, Inc. v. MCA Records, Inc.*

Class 25: False Advertising Casebook 743-770

- Cases: *United Industries Corp. v. Clorox Co.*; *Pizza Hut, Inc. v. Paper John's International, Inc.*; *Cashmere & Camel Hair Mfrs. Inst. v. Saks Fifth Avenue*

Optional: Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 Colum.-VLA J.L. & Arts 123 (1996)

Class 26: Trade Identity Rights Casebook 771-797

- Cases: *Cheatham v. Paisano Publications, Inc.*

Class 27: Trade Identity Rights Casebook 797-827

- Cases: *John W. Carson v. Here's Johnny Portable Toilets, Inc.*; *Vanna White v. Samsung Electronics America, Inc.*; *Comedy III Productions, Inc. v. Gary Saderup, Inc.*; *John Doe v. TCI Cablevision*

Optional: Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 Emory L.J. 367 (1999)

Class 28: Transactions Casebook 859-875

- Cases: *Sugar Busters v. Brennan*; *E & J Gallo Winery v. Gallo Cattle Company*; *Clorox Co. v. Chemical Bank*; *Dawn Donut Co. v. Hart's Food Stores, Inc.*

Memorandum Assignment Number Three will be distributed during the last week of class. The Assignment will be due on the last day of exams.