

The Law of Branding: Trademarks, Trade Dress & Unfair Competition

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Course Outline and Reading Assignments

Welcome to the George Mason University School of Law course on trademark law, which focuses on how businesses identify their products through brand names, advertising and packaging.

All reading assignments have been reproduced in the collection materials available from the Law School for this course.

Grading and Evaluation

On the assumption that many students are enrolled because they wish to be hired as attorneys, I grade students in the same way that I evaluate prospective associates who may wish to work for a law firm. Strong analytical thought, articulately expressed -- and at times with style -- is the currency of this classroom.

There will be two short papers (5 - 10 pages, typed, double-spaced) and a take home, open book, final exam. Class participation can enhance but not lower your grade.

Tuesday and Thursday, August 22 and 24

Lecture

Introduction - The History of Branding
Trademarks and Consumer Protection
What is a Trademark?

Practical

Business Presentation: Branding and Packing for the Marketing Force

- A presentation commonly made to businesses on how to develop brands and avoid infringement claims.

Reading Assignments

Hanover Star Milling Co. v. Metcalf, 240 U.S. 403 (1916); *T&T Manufacturing Co. v. A.T. Cross Co.*, 587 F.2d 533 (1st Cir. 1978); PTO Policy on Registration of Domain Names as Trademarks

Tuesday and Thursday, August 29 and 31

Lecture

Trademark Selection
Strength of Marks
Use As A Trademark

Practical

Oral Argument: Registrability of the Mark FOUNTAIN STYLE for "soft drinks."

Reading Assignments

Miller Brewing Co. v. Jos. Schlitz Brewing Co., 605 F.2d 990 (7th Cir. 1979); *Nestle Co. v. Chester's Market, Inc.*, 571 F. Supp. 763 (D. Conn. 1983), *rev'd* 756 F.2d 280 (2nd Cir. 1985); *In re Huddle*, 216 USPQ 358 (TTAB 1982); *In re Colonial Refining and Chemical*, 196 USPQ 46 (TTAB 1977); Examining Attorney Office Action Holding FOUNTAIN STYLE to be Merely Descriptive (handout).

Tuesday and Thursday, September 5 and 7

Lecture

Secondary Meaning -- Protecting Descriptive Terms and Non-distinctive Designs
Acquisition of Rights: The Common Law Scandalous Marks

Practical

Oral Argument: The Cleveland Indians Logo

Reading Assignments

New West Corp. v. NYM Co. of Cal., Inc., 595 F.2d 1194 (9th Cir. 1979); *Unisplay S.A. v. American Electric Sign Co.*, 28 USPQ2d 1721 (E.D. Wa. 1993); *Person's Co. v. Christman*, 900 F.2d 1565 (Fed. Cir. 1990); Excerpts from *Harjo v. Pro-Football, Inc.*, *slip opinion*.

Tuesday and Thursday, September 12 and 14

Lecture

Federal Registration vs. Common Law Rights

Practical

San Giorgio Trademark File Wrapper

Reading Assignments

Thrifty Rent-A-Car System, Inc. v. Thrift Car, Inc., 639 F. Supp. 750 (D.Mass. 1986); *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F. Supp. 358 (2d Cir. 1959); *Holiday Inns of America vs. B&B Corp.*, 409 F.2d 614 (3rd Cir. 1969); *Lane Ltd. Vs. Jackson Int'l Trading Co.*, 33 USPQ2d 1351 (TTAB 1994).

Tuesday and Thursday, September 19 and 21

Lecture

Intent to Use Applications

Use-Based Applications

Post-Registration -- Statements of Use and Incontestability

Practical

Oral Argument: Fraud on the Patent Office

Reading Assignments

Expert Witness Report of Edward M. Prince; Expert Witness Report of Gary D. Krugman; *Family Circle v. Family Circle Associates, Inc.*, 205 F. Supp. 940 (DNJ 1962); *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985).

Tuesday and Thursday, September 26 and 28

Lecture

Infringement -- Likelihood of Confusion

Sound, Appearance and Meaning

Surveys

Practical

Examination of a Survey Expert

Reading Assignments

Jordache Enters v. Levi Strauss & Co., 841 F. Supp. 506 (SDNY 1993); *Academy of Motion Picture Arts & Sciences v. Creative House Promotions*, 944 F.2d 1446 (9th Cir. 1991); *Esso v. Humble Oil & Refining Co.*, 363 F.2d 945 (5th Cir. 1966); Survey Reports.

Tuesday and Thursday, October 3 and 5

Lecture

Abandonment of Trademark Rights
Non-use of mark
Abandonment through Naked Licensing and Uncontrolled Use

Practical

Summary Judgment Argument: SAN GIORGIO

Reading Assignments

Exxon Corp. v. Humble Exploration Co., 695 F.2d 96 (5th 1983); *Sheila's Shine Products, Inc. v. Sheila Shine, Inc.*, 486 F.2d 114 (5th Cir. 1973); *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565 (Fed. Cir. 1995).

Thursday, October 12

Lecture

Defenses

- Equitable Defenses
- Fair Use

Practical

Oral Argument -- SENSITIVE EYES vs. FOR SENSITIVE EYES

Reading Assignments

SCI Systems, Inc. v. Solidstate Controls, Inc., 748 F. Supp. 1257 (SD Ohio 1990); *Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 F.2d 145 (5th Cir. 1985); *Zatarains, Inc. v. Oak Grove Smokehouse*, 698 F.2d 786 (5th Cir. 1983).

Tuesday and Thursday, October 17 and 19

Lecture

Trade Dress Infringement

- Infringement of Packaging
- Infringement of Advertising
- Infringement of Product Configurations

Practical

Anatomy of California SunCare, Inc. vs. ETS, Inc.

Reading Assignments

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992); *Ciba-Geigy Corp. v. Bolar Pharmaceutical*, 547 F. Supp. 1095 (D.N.J. 1982); *Le*

Sportsace, Inc. v. K-Mart Corporation, 754 F.2d 71 (2nd Cir. 1985); *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* (99-150) 165 F.3d 120, reversed and remanded.

Tuesday and Thursday, October 24 and 26

Lecture

Dilution

Parody: The Constitutional Right to Laugh

Practical

Parody Case Studies

Reading Assignments

Mead Data Cent., Inc. v. Toyota Motor Sales, Inc., 875 F.2d 1026 (2d 1961); *Star Markets v. Texaco, Inc.*, 950 F. Supp. 1030 (1996); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

Tuesday and Thursday, October 31 and November 2

Lecture

Unusual Trademarks

- Color
- Sound
- Smell

Practical

Oral Argument: Color Depletion Theory

Reading Assignments

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995); *In re General Electric Broadcasting Co.*, 199 USPQ 560 (TTAB 1978); *In re Clarke*, 17 USPQ2d 1238 (TTAB 1990).

Tuesday and Thursday, November 7 and 9

Lecture

Remedies: Injunctions, Damages and Attorneys Fees

Practical

Examination of a Damage Expert

Reading Assignments

Citibank v. Citytrust, 756 F.2d 273 (2nd Cir. 1985); *Big O Tire Dealers, Inc. v. Goodyear*, 561 F.2d 1365 (10th Cir. 1977); *International Star Class*

Yacht Racing Ass'n v. Tommy Hilfiger U.S.A., Inc., 80 F.2d 749 (2d Cir. 1996).

Tuesday and Thursday, November 14 and 16

Lecture

Infringement in Cyberspace
Initial Interest Confusion

Practical

Oral Argument: Jurisdiction Over Cybersquatters

Reading Assignments

Millennium Enterprises v. Millennium Music, LP, 33 F.Supp.2d 907 (D.Or. 1999); *Porsche Cars, N.A. v. PORSCH.COM, et.al.*, C.A. No. 99-0006-A; *Panavision Int'l L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996), *aff'd*, 141 F.3d 1316 (9th Cir. 1998); ICANN Uniform Domain Name Dispute Resolution Policy; 1999 Anticyber-squatting Consumer Protection Act; Article "Suits for Statutory Damages May Take Toll on Cyberpiracy Trademark Traffic," by Norm St. Landau.

Tuesday and Tuesday, November 21 and 28

Lecture

Class Summary: Putting It All Together -- Client Counseling

Practical

Review of Trademark Search Opinions -- A Client Counseling Session

Reading Assignments

Trademark Search Opinion (Handout)

Thursday, November 30

Review and Questions