

# Syllabus for Trademark Law

Law 327-001  
Spring 2024  
3 Credits

Instructor: T.J. Chiang  
Office: Room 325  
Office Phone: (703) 993-9868  
E-mail: tchiang2@gmu.edu

## I. COURSE MATERIALS.

Barton Beebe, Trademark Law: An Open-Access Casebook (10th ed. 2023). Available free <https://www.tmcasebook.org/>. Paper version preferred.

## II. LEARNING OUTCOMES

By the end of the course, students should have an understanding of the principles of trademark law and the structure of the trademark system including the role of the Patent and Trademark Office. Students should achieve proficiency in evaluation trademark validity and infringement. Students should also have an understanding of the policy considerations underlying trademark law.

## III. OFFICE HOURS.

Office hours are Wednesday from 2-4pm. You do not need to make an appointment to see me at those times, though you are welcome to send an email ahead of time to let me know to expect you. I realize that many students work during the day and I am happy to meet at other times if you email me for an appointment. Generally, email is a more reliable way to reach me than phone.

## IV. GRADES.

Your grade will be based on the final exam, which is graded blindly. The final exam will be open book, but only paper materials will be allowed. For this reason, you are strongly advised to get a paper version of the casebook (either purchased or printed out). Additional details regarding the exam will be determined later in the semester.

## V. ZOOM

Barring unexpected circumstances, the class will meet in-person. However, we may have online class if special circumstances arise (e.g., if I get infected). We may also have online class on snow days. You should have the proper equipment (webcam, internet) for that possibility.

If you are experiencing symptoms of Covid-19 or any other respiratory illness, please do not come to class until you fully recover. You should email me for a Zoom link if you are medically unable to come to class. I do not allow attendance by Zoom for non-medical reasons—the reason medical absences are special is that they are designed to protect your classmates and the public.

## VI. ASSIGNMENTS

Generally, we will cover one segment per class. If we fall behind, we will carry over material to the next class. The assignments are also subject to change depending on our progress.

The assigned pages include both the excerpted cases and the author's notes about them. I recommend reading the notes, but we will focus mainly on the cases in class.

### **1. Introduction to Trademarks**

Casebook 1-25

The Trademark Cases, 100 U.S. 82 (1879)

### **2. Distinctiveness I**

Casebook 25-40

Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d. Cir. 1976)

Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir. 1983)

Innovation Ventures, LLC v. N.V.E., Inc., 694 F.3d 723 (6th Cir. 2012)

### **3. Distinctiveness II**

Casebook 40-49, 96-99

Frosty Treats Inc. v. Sony Computer Enter., 426 F.3d 1001 (8th Cir. 2005)

Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F.Supp.2d 217

(S.D.N.Y. 2004)

LSU A&M College v. Smack Apparel Co., 550 F.3d 465 (5th Cir. 2008)

### **4. Generic Marks**

Casebook 49-79

U.S. Patent & Trademark Office v. Booking.com B.V., 140 S. Ct. 2298 (2020)

Snyder's Lance, Inc. v. Frito-Lay N. Am., Inc., 542 F.Supp.3d 371 (W.D.N.C.

2021)

### **5. Trade Dress I**

Casebook 99-119

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992)

Qualitex Co. v. Jacobson Prods. Co., Inc., 514 U.S. 159 (1995)

Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000)

### **6. Trade Dress II**

Casebook 119-127

In re Slokevage, 441 F.3d 957 (Fed. Cir. 2006)

LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A., 209 F. Supp. 3d 612

(S.D.N.Y. 2016)

McKernan v. Burek, 118 F. Supp. 2d 119 (D. Mass. 2000)

Fedders Corp. v. Elite Classics, 268 F. Supp. 2d 1051 (S.D. Ill. 2003)

In re Frankish Enters. Ltd., 113 U.S.P.Q.2d 1964 (TTAB 2015)

### **7. Trade Dress III**

Casebook 127-139

Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993 (2d Cir. 1997)

Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225 (5th Cir. 2010)

Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC, 741 F.Supp.2d 1165 (C.D. Cal. 2010)  
In re Frankish Enters. Ltd., 113 U.S.P.Q.2d 1964 (TTAB 2015)

### **8. Bars to Protection: Functionality**

Casebook 141-157

In re Morton-Norwich Prods., Inc., 671 F.2d 1332 (C.C.P.A. 1982)  
Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844 (1982)  
TraFFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001)

### **9. Bars to Protection: Utilitarian Functionality**

Casebook 157-170

Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002)  
Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH, 289 F.3d 351 (5th Cir. 2002)  
Apple, Inc. v. Samsung Elecs. Co., 786 F.3d 983 (Fed. Cir. 2015)  
Specialized Seating, Inc. v. Greenwich Indus., L.P., 616 F.3d 722 (7th Cir. 2010)

### **10. Bars to Protection: Aesthetic Functionality**

Casebook 170-183

Pagliario v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952)  
Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., 916 F.2d 76 (2d Cir. 1990)  
Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206 (2d Cir. 2012)

### **11. Bars to Protection: Deceptiveness; Scandalous and Disparaging Marks**

Casebook 183-214

In re Nieves & Nieves LLC, 113 U.S.P.Q.2d 1639 (TTAB 2015)  
Matal v. Tam, 137 S. Ct. 1744 (2017)  
Iancu v. Brunetti, 139 S. Ct. 2294 (2019)

### **12. The Use in Commerce Requirement for Trademark Rights**

Casebook 214-232

Aycock Eng'g, Inc. v. Airflite, Inc., 560 F.3d 1350 (Fed. Cir. 2009)  
Couture v. Playdom, Inc., 778 F.3d 1379 (Fed. Cir. 2015)  
Planetary Motion, Inc. v. Techsplosion, Inc., 261 F.3d 1188 (11th Cir. 2001)

### **13. Trademark Registration and Incontestability**

Casebook 232-261

Kelly Servs., Inc. v. Creative Harbor, LLC, 846 F.3d 857 (6th Cir. 2017)  
Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985)

### **14. Geographic Scope and Priority I**

Casebook 261-279

Nat'l Ass'n for Healthcare Communications, Inc. v. Central Ark. Area Agency on Aging, Inc., 257 F.3d 732 (8th Cir. 2001)  
Stone Creek, Inc. v. Omnia Italian Design, Inc., 875 F.3d 426 (9th Cir. 2017)

## **15. Geographic Scope and Priority II**

Casebook 279-318

- Person's Co., Ltd. v. Christman, 900 F.2d 1565 (Fed. Cir. 1990)
- Grupo Gigante SA De CV v. Dallo & Co., Inc., 391 F.3d 1088 (9th Cir. 2004)
- ITC Ltd. v. Punchgini, Inc., 482 F.3d 135 (2d Cir. 2007)
- Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697 (4th Cir. 2016)

## **16. Trademark Infringement: Infringing Use**

Casebook 319-334

- Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2d Cir. 2009)
- Radiance Foundation, Inc. v. NAACP, 786 F.3d 316 (4th Cir. 2015)

## **17. Trademark Infringement: Confusion-Based Infringement I**

Casebook 334, 337-356, 420-432

- Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2d Cir. 1961)
- Virgin Enters. Ltd. v. Nawab, 335 F.3d 141 (2d Cir. 2003)
- Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)

## **18. Trademark Infringement: Confusion-Based Infringement II**

Casebook 356-377

- Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008)
- Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153 (2d Cir. 2016)

## **19. Trademark Infringement: Confusion-Based Infringement III**

Casebook 385, 391-420

- Jim S. Adler, P.C. v. McNeil Consultants, L.L.C., 10 F.4th 422 (5th Cir. 2021)
- Ferrari S.P.A. v. Roberts, 944 F.2d 1235 (6th Cir. 1991)
- Wreal, LLC v. Amazon.com, Inc., 38 F.4th 114 (11th Cir. 2022)

## **20. Trademark Infringement: Dilution**

Casebook 434-471

- Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356 (Fed. Cir. 2012)
- Nike, Inc. v. Nikepal Int'l, Inc., 84 U.S.P.Q.2d 1820 (E.D. Cal. 2007)
- Starbucks Corp. v. Wolfe's Borough Coffee, Inc. 736 F.3d 198 (2d Cir. 2013)
- V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382 (6th Cir. 2010)

## **21. Secondary Liability**

Casebook 495-518

- Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010)
- Gucci Am. Inc. v. Frontline Processing Corp., 721 F. Supp. 2d 228 (S.D.N.Y. June 23, 2010)
- Luxottica Group, S.P.A. v. Airport Mini Mall, LLC, 2 F.3d 1303 (11th Cir. 2019)

## **22. Defenses I: Descriptive Fair Use**

Casebook 519-536

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004)

Dessert Beauty, Inc. v. Fox, 568 F.Supp.2d 416 (S.D.N.Y. 2008)

SportFuel, Inc. v. Pepsico, Inc., 932 F.3d 589 (7th Cir. 2019)

### **23. Defenses II: Nominative Fair Use; Parody**

Casebook 539-550, 581-591

Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171 (2010)

Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC, 823 F.3d 153 (2d Cir. 2016)

Jack Daniel's Props. v. VIP Prods. LLC, No. 22-148, 2023 U.S. LEXIS 2422 (June 8, 2023)

### **24. Defenses III: Abandonment; First Sale**

Casebook 602-608, 612-624, 627-629

ITC Ltd. v. Punchgini, Inc., 482 F.3d 135 (2d Cir. 2007)

FreecycleSunnyvale v. Freecycle Network, 626 F.3d 509 (9th Cir. 2010)

Sugar Busters LLC v Brennan, 177 F.3d 258 (5th Cir. 1999)

Davidoff & CIE, S.A. v. PLD Int'l Corp., 263 F.3d 1297 (11th Cir. 2001)

### **25. Remedies**

Casebook 756-770

Nichino Am., Inc. v. Valent U.S.A. LLC., 44 F.4th 180 (3d Cir. 2022)

Romag Fasteners, Inc. v. Fossil, Inc., 140 S. Ct. 1492 (2020)

### **26. Catch-up and revision**

No new reading