

TRADEMARK AND UNFAIR COMPETITION LAW

Andy Halaby
Fall 2011

Class hours: Tuesdays, 6:00-8:55 p.m.

Office hours: After class and by appointment

My contact information

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Course Objective

This course's objective is to provide you with a practical, business-oriented understanding of trademark and unfair competition law. We will cover general principles, including acquisition, maintenance, and enforcement of both registered and unregistered trademark rights. Litigation practices and issues will receive particular emphasis. The course will address trademark dilution, cyberspiracy and other Internet issues, federal deceptive advertising, right of publicity, and false endorsement, as well as a smattering of pertinent counterfeiting, international, evidence, and insurance law. At a minimum, you should emerge from this course with a thorough understanding of why a trademark and unfair competition practice is one of the most fun a lawyer can choose!

Materials

There are three required books for this course:

1. Jane C. Ginsburg, Jessica Litman, and Mary L. Kevlin, *Trademark and Unfair Competition Law* (4th ed. 2007), which is abbreviated "CB" in the reading assignments below.

2. The 2011 Supplement and Statutory Appendix to Ginsburg, Litman and Kevlin's *Trademark and Unfair Competition Law*, which is abbreviated "SSA."
3. Jane C. Ginsburg and Rochelle Cooper Dreyfuss, *Intellectual Property Stories* (2006), which is abbreviated "IPS."

Where cases, statutes, or other materials are assigned, you are responsible for procuring them.

Assignments

You should complete each week's assignment, **including Week 1's assignment**, before that week's class.

"Read" means to carefully study so as to be prepared to participate in class regarding, and ultimately to be examined on, that material.

"Bkgrd" means to read for background. You won't be examined on this material unless I specifically tell you otherwise, but you'll get a lot more out of lecture if you read it.

"Skim": Our time together is limited; there are aspects of the course's subject matter that we don't have time to get into very deeply. The "Skim" material addresses topics I simply want you to be aware of. Perhaps obviously, you won't be examined on it.

I will sometimes distribute or post on Blackboard additional materials of interest.

Attendance and Grading

See the Statement of Student Policies. You will take a final closed book, closed notes examination, likely three hours in length.

Students sometimes ask whether they can do a research paper instead. You can't.

Beyond the substantive and procedural subject matter, I want you to learn something about legal reasoning, jurisprudence, and practical application of the law. You should consider these topics, as discussed in class in the context of our subject matter, fair game for the exam.

Other

Two special guests are slated to join us to talk about the practical impact of trademark and unfair competition law on their businesses. I think you will really enjoy hearing from them.

I will distribute a sample final examination question during class in Week 10, and we will go over it together in Week 11.

Syllabus

<u>Week</u>	<u>Class</u>	<u>Topic</u>	<u>Assignment</u>
1	Aug. 23	I. General concepts A. Competition B. Trademarks	Bkgrd: IPS 9-35 Read: CB 1-12, 16 (bottom)-29 Bkgrd: 29 (bottom)-42
2	Aug. 30	II. What is a trademark? A. Subject matter of trademark protection 1. General 2. Service marks 3. Trade dress B. Distinctiveness 1. Inherent 2. Acquired	Bkgrd: IPS 220-57 Read: CB 43-51 (top), 52-55 (middle), 63-73 (middle), 78-95 (middle)
3	Sept. 6	III. Ownership IV. Use A. General B. "Analogous use" C. Concurrent Use V. Priority	Skim: CB 105-109 Read: CB 112-122 (top); SSA 21 (bottom)-26 (top); CB 122 (top)-126; SSA 35 (bottom)-39 (top); CB 140 (bottom)-148 (top); SSA 39-44; CB 158-169
4	Sept. 13	VI. Lanham Act section 43(a)(1)(A) A. Unregistered "marks" B. Functionality	Read: CB 476 (top), 481 (bottom)-496 (top), 498-504, 506 (bottom)-514; SSA 190-194 (top) Re-read: CB 63-71 Read: CB 545-551

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5	Sept. 20	VII. Infringement and likelihood of confusion A. General B. Initial interest confusion C. Relevant public/secondary confusion D. "Use" E. Reverse confusion	Read: CB 332-358, 363-377 (top); SSA 129 (bottom)-142 (top), 300 (bottom)-306 (middle); CB 403-405 (top); <i>Au-Tomotive Gold v. Volkswagen of America</i> , 603 F.3d 1133 (9th Cir. 2010) (through part III.A); CB 408 (bottom)-414 (middle)
6	Sept. 27	F. Secondary liability VIII. Registration A. Process and benefits B. Priority 1. Use 2. Intent to use C. Bars to registration 1. Lanham Act section 2(a) a. "deceptive" b. false association c. immoral, scandalous, or disparaging marks 2. Sections 2(b) and 2(c)	Read: CB 417 (middle)-429 (top); SSA 149-162 (top) Bkgrd: 15 U.S.C. §§ 1051-1072, 1091-1096, 1112- 1113. Briefly review (and experiment with) www.uspto.gov , especially TESS, TARR, and TMEP. Read: CB 172-197 (top), 203 (bottom)-204 (top) Skim: CB 204 (top)-217 Read: CB 217-230 (top)
7	Oct. 4	3. Section 2(d) 4. Section 2(e) a. Geographic misdescription b. Surname c. Functionality D. Incontestability	Read: CB 232-243 (top), 248-263, 264-273, 433- 439
8	Oct. 18	IX. Loss of trademark rights and other defenses A. Genericism B. Abandonment 1. General 2. Assignment in gross, etc.	Bkgrd: 15 U.S.C. §§ 1063-1064 Read: CB 274-302 (bottom), 305 (bottom)-326 (bottom) Skim: CB 326 (bottom)-331

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9	Oct. 25	C. Fraud D. Classic fair use E. Nominative fair use	Read: CB 442 (bottom)-446 (through end of first full paragraph); SSA 162 (bottom)-167 (top); CB 449 (middle)-453, 457 (middle)-467 Re-read: SSA 300 (bottom)-306 (middle) Read: 831-838 (top)
10	Nov. 1	X. Remedies A. Injunctions 1. Permanent 2. Preliminary B. Monetary remedies 1. Damages 2. Profits C. Attorneys' fees D. Counterfeiting	Bkgrd: 15 U.S.C. § 1111, 1114-1116(a), 1117 Skim: 15 U.S.C. § 1118-1121 Read: <i>EBay v. MercExchange</i> , 547 U.S. 388 (2006); CB 912-917; SSA 325-327 Skim: CB 922-934 (top) Read: <i>Maier Brewing Co. v. Fleischmann Distilling Corp.</i> , 390 F.2d 117 (9th Cir. 1968); CB 943-945, 948-966, 969 (bottom)-980 (middle)
11	Nov. 8	E. Border control measures XI. Dilution XII. ACPA XIII. Trademarks as speech	Read: CB 985-1002, 619-623, 631-639; <i>Panavision v. Toepen</i> , 141 F.3d 1316 (1998); CB 748-760 (middle); <i>Taubman Co. v. Webfeats</i> , 319 F.3d 770 (6th Cir. 2003); <i>Bosley Medical Inst. v. Kremer</i> , 403 F.3d 672 (2005); SSA 314-319 (top)
12	Nov. 15	XIV. Right of publicity and false endorsement	Read: CB 675-720 (top)
13	Nov. 22	XV. Federal deceptive advertising XVI. Special issues A. Evidence preservation B. Insurance	Read: CB 569-571, CB 576-590, 593 (bottom)-609 (top); <i>Surowiec v. Capital Title Agency</i> , 2011 U.S. Dist. LEXIS 48011 (D. Ariz. 2011); <i>Hudson Ins. v. Colony Ins.</i> , 624 F.3d 1264 (9th Cir. 2010)