

TRADEMARKS AND UNFAIR COMPETITION

Room 208
Tues. 3:05-4:30
Thurs. 3:05-4:30

Lori Krafte
Spring 2011

Required Texts:

Dinwoodie and Janis, *Trademarks and Unfair Competition: Law and Policy*, Aspen Publishers, Third Edition, 2010

2010-2011 Case and Statutory Supplement

Additional materials may be distributed from time to time.

Attendance:

Class attendance is required. If you are unable to attend a class session, please let me know in advance if possible.

Final Grades:

Your course grade will be determined by your performance on the final exam. Exceptional class participation may raise your course grade.

Office Hours:

I do not hold regular office hours, but I would be happy to schedule a time to meet with you. Please feel free to email me at lkrafte@whepatent.com, or to call my law office at 241-2324.

Course Outline:

- I. Foundations and Purposes of Trademark and Unfair Competition Law
- II. Creation of Trademark Rights
 - A. Distinctiveness
 - 1. The Spectrum of Distinctiveness
 - 2. Descriptiveness and Secondary Meaning
 - 3. Generic Terms
 - 4. Distinctiveness of Nonverbal Identifiers:
Logos, Packages, Product Design, and Colors
 - 5. The Edge of Trademark Protection: Subject-Matter Exclusions?

- B. Functionality
 - 1. An Introduction to the Concept of Functionality
 - 2. The Scope of the Functionality Doctrine
 - 3. Modern Supreme Court Approach to Functionality
 - 4. *Post-TraFFix* Applications of the Functionality Doctrine
 - C. Trademark “Use”
 - 1. Use as a Jurisdictional Prerequisite
 - 2. Use as a Prerequisite for Establishing Rights
 - 3. “Surrogate” Uses
 - 4. Abandonment: Loss of Rights Through Non-Use or Uncontrolled Uses
 - D. Registration
 - 1. The Registration Process & Post-Registration Actions
 - 2. Exclusions from Registration
 - 3. Incontestability
- III. Scope and Enforcement of Trademark Rights
- A. Geographic Limits
 - 1. Geographic Limits on Common Law Rights
 - 2. Geographic Limits and Registered Rights
 - 3. The Territorial Nature of U.S. Trademark Rights
 - 4. The Extraterritorial Enforcement of U. S. Trademark Rights
 - B. Product Limits: Confusion-Based Liability Theories
 - 1. Evolution of the Confusion Standard
 - 2. Actionable “Use” Prerequisite
 - 3. The Factors Analysis for Likelihood of Confusion
 - 4. Applying the Multifactor Test
 - 5. Confusion Away from the Point of Sale
 - 6. Reverse Confusion
 - 7. Indirect and Vicarious Theories of Infringement Liability
 - C. Product Limits: Non-Confusion-Based Liability Theories
 - 1. Dilution Protection
 - 2. Protection Against Cybersquatting
 - 3. Protection Against Counterfeiting
 - D. Other Limits: Permissible Uses of Another’s Trademarks
 - 1. Fair Use
 - 2. “First Sale” Doctrine
 - 3. Parody or Speech

VI. Remedies

- A. Injunctive Relief
- B. Monetary Relief
- C. Other Remedies

VII. Exploitation of Trademarks: Trademark Transactions

- A. Assignment of Trademarks
- B. Licensing of Trademarks
- C. Settlement Agreements Arising Out of Trademark Disputes
- D. Securitization of Trademarks
- E. Antitrust Limitations