

UNIVERSITY OF HOUSTON LAW CENTER

COURSE SYLLABUS

TRADEMARK LAW AND UNFAIR COMPETITION

FALL SEMESTER 2017

KIMBLEY L. MULLER, ADJUNCT PROFESSOR

1. **Required Course Materials:**

Barton Beebe, Trademark Law: An Open Source Casebook, Ver. 3.0
<http://tmcasebook.org/>

Additional course materials, such as supplemental materials and case opinions not found in the casebook will be provided from time-to-time at no cost to the student.

Additional text if desired but not required: Trademarks and Unfair Competition, 10th Edition David C. Hilliard, et al.

2. **Attendance:** Classes convene at 1:00 p.m. and end at 2:20 p.m. on Tuesdays and Thursdays. University policy requires that a student be marked as “**absent**” if she/he is more than **15 minutes** late for class. Students are required to attend 80% of the classes, which means that if a student misses more than 5 classes during the semester that student is automatically dropped from class. There will be a seating chart meaning the student must sit in that seat once the chart is established the seating chart gives a name to a seat in the room.

3. **Grades:** Grades are solely based on a student’s performance on the exam given at the end of the semester. The exam is three (3) hours long and is a mixture of true/false, multiple choice questions and short and long essays, which cover materials and matters discussed during the semester. The exam will use open materials except no electronic media will be permitted. It does not have to be repeated, but it will be anyway: Students are bound by the University of Houston Law Center Honor Code. The exams are graded in accordance with law school grading policies.

4. **Teaching Method:** This course is taught primarily by lecture and “case analysis” method where the professor asks a student to recite the facts, issues, and conclusions of a case and respond to questions from the professor during and after recitation. Others in the class are highly encouraged to participate by providing other views or relevant comments. Students are expected to be prepared for each class by reading the assigned materials. “Students may` be randomly called to discuss cases” or called on as assigned before class.

The room video recording “mediasite” system will be used and class will be recorded._

On a weekly basis, page numbers for Beebe will be provided

5. **Counseling and Psychological Services (CAPS):** These Services can help students who are having difficulties managing stress, adjusting to the demands of a professional program, or feeling sad and hopeless. You can reach CAPS (<http://www.uh.edu/caps>) by calling 713-743-5454 during and after business hours for routine appointments or if you or someone you know is in crisis. No appointment is necessary for the “Let's Talk” program, a drop-in consultation service at convenient locations and hours around campus. http://www.uh.edu/caps/outreach/lets_talk.html

6. **Assignments:**

Classes 1-2, (Aug. 22 and 24, 2017)

- Course Book – Open Source Beebe, p. 2-26
- TMEP
- Trademarks 101 Video
- US PTO.gov

Classes 3-4, (Aug. 29 and 31, 2017)

Cases:

Pagliero v. Wallace China Co. 198 F. 2nd 339 (9th Cir. 1952)

Dawn Donut, Inc. v. Hart's Food Stores, Inc. 267 F. 2nd 358 (2nd Cir. 1952)

Abercrombie & Fitch v. Hunting World 537 F. 2nd (2nd Cir. 1990)

TrafFix Devices, Inc. v. Marketing Displays 532 US 23 (2001)

- Course Book – Open Source Beebe, Part 1
- Distinctiveness
- Bars to Protection
- Searching and Clearance
- Guidelines of Use
- Notice

Class 5, (Sept. 5, 2017)

Guest Lecture – Non-conventional Trademarks, Elizabeth King

Class 6, (Sept. 7, 2017)

- Infringement
- Course Book – Beebe, Part 2
- 15 USC 1114, 1125 (a), 1125 (c), 1125 (d)
- Types of Confusion and Dilution

Classes 7, 8 and 9 (Sept. 12, 14 and 19, 2017)

Rosetta Stone v. Google 676 F. 3rd 144 (4th Cir. 2012)

Rescuecom Corp v. Google 562 F.3rd 123 (2nd Cir. 2007)

Radiance Foundation, Inc. v. NAACP 376 F. 3rd 316 (4th Cir. 2015)

History Borden Ice Cream Co. v. Borden's Condensed Milk Co. 201 F. 510 (7th Cir. 1912)

The Board of Regents of the University of Houston System v. South Texas College of Law 4:16 Cir. 01839 5th Cir.)

Polaroid Corp. v. Polaroid Electronics Corp. 287 F. 2nd 492 (2nd Cir. 1961)

Multi time Machine v. Amazon.com 804 F. 3rd 930 (9th Cir 2015)

AMF v. Sleekcraft Boats 599 F.2nd 341 (9th Cir. 1979)

Ferrari v. Roberts 944 F. 2nd 1235 (6th Cir. 1991)

Dreamwerks Production Group, Inc. v. SKG Studio 142 F. 3rd 1127 (9th Cir. 1988)

TMEP 1207.01

Sporty's Farm v. Sportsman's Market, Inc. 202 F. 3rd 489 (2nd Cir. 2000) 15 USC 1125

Course Book Beebe, Part 2

Classes 10, 11 and 12 (Sept 21, 26 and 28, 2017)

Defenses:

Course Book, Beebe, Part 3

KP Permanent Make-up, Inc. v. Lasting Impressions 543 US 111 (2004)

Sorensen v. WD – 40 Company 792 F. 3rd 712 (7th Cir. 2005)

New Kids on the Block v. News AM. Publishing 971 F. 2nd 302 (9th Cir. 1992)

Louis Vitton Malletier SA v. Haute Diggity Dog 507 F. 3rd 252 (4th Cir. 2007)

Rogers v. Grimaldi 875 F. 2nd 994 (2nd Cir. 1989)

Mattel, Inc. v. MCA Records 296 F. 3rd 894 (9th Cir. 2002)

Mattel Inc. v. Walking Mountain Properties 353 F. 3rd 792 (9th Cir. 2003)

Class 13, (Oct. 3, 2017)

Survey Evidence – Guest Lecture

Course Book, Beebe Part 2 and 3

Classes 14 and 15, (Oct. 5 and 10, 2017)

Remedies:

Course Book Beebe, Part 4

35 USC 1116 (d) 13

15 USC 1116 (a)

eBay Inc. v. Merc Exchange LLC 547 US 388 (S Ct. 2006)

Winter v. Natural Res. Def. Counsel 555 US 7 (St. Court 2008)

International Star Class Yacht Racing Ass'n v. Tommy Hilfiger 80 F. 3rd 749 (2nd Cir. 1996)

Class 16 (Oct. 17, 2017)

False Advertising

Course Book Beebe, Part 4

Guest Lecturer

Class 17, (Oct. 19, 2017)

Anti- Counterfeiting:

Trademark Counterfeiting Act 1984
15 USC 1116 (d) and 1117 (b)

18 USC 2320

EL Greco Leather Products Co. v. Shoe World
599 F. Supp 1380 (E.D.N.Y) 806 F. 2nd 392 (2nd Cir. 1986)

Classes 18 and 19, (Oct. 24 and Oct. 26, 2017)

Right of Publicity:

Cases and Statutes

White v. Samsung Electronics America, Inc. 989 F. 2nd 1512 (9th Cir. 1993)

15 USC §1125 (a)

Hustler Magazine v. Falwell 485 US 46 (5 Cir. 1988)

Campbell v. Acuff – Rose Music, Inc. v. Campbell 510 US 569 (1994)

In re NCAA Student – Athlete Name v. Likeness Licensing 724 F. 3rd 1268 (9th Cir. 2013)

California Civil Code 3344 & 3344.1

NY Civil Rights Law §51

Domain Names:

Classes 20 and 21 (Oct. 31 and Nov, 2, 2017)

International Domain Names
15 USC 1125 (d); (i)

Toyota Motor Sales, USA, Inc., v. Tabari
610 F. 3rd 1171 (9th Cir. 2010)

Pagnelli Plumbing Co. v. Gillece Plumbing and Heating 98 USPQ 2nd 1997 (WD Pa 2011) 2011 US Dis Lexis 15090 (WD Penn. 2011)

Gopets LTD v. Hise
657 F. 3rd 1024 (9th Cir. 2011)
35 USC 1125 (d) (i)

People for the Ethical Treatment of Animals v. Doughty
263 F. 3rd 359 (4th Cir. 2001)

Solid Host, NL v. Namecheap, Inc.
652 F. Supp 2nd 1092 (CD Cal 2009)

Classes 22 and 23, (Nov. 7 and 9, 2017)

Licensing and Assigning Trademarks:

Kentucky Fried Chicken v. Diversified Packaging 549 F. 2nd 368 (5th Cir. 1977)

TMEP 1201.03 (b)

Shell Oil Co. v. Commercial Petroleum, Inc. 928 F. 2nd 104 64th Cir. 1991)

35 USG 1125 (a) (c)

Siegal v. Chicken Delight, Inc.
448 F. 2nd 43 (9th Cir. 1971)

Dibold, Inc. v. Multra – Guard, Inc.
189 USPQ 119 (TTAB 1975)

Madrigal Audio Laboratories, Inc. v. Cello, Ltd. 799 F. 2nd 814 (2nd Cir. 1986)

Classes 24 and 25, (Nov. 14 and 16, 2017)

Trademarks in Litigation:

Expert Witnesses and Exhibits
Opening Statements
Closing Statements
Proving Ownership
Proving Confusion
Actual Confusion

Class 26, – Review of Course (Nov. 23, 2017)