

UNIVERSITY OF HOUSTON LAW CENTER

COURSE SYLLABUS Revised 9/10/2018

TRADEMARK LAW AND UNFAIR COMPETITION

FALL SEMESTER 2018

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 on time at 2:30 p.m. and end at 4:00 p.m. on Monday and Wednesday. Attendance will be taken by sign in sheet. 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 short answers 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 all classes 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

Professor Muller may be contacted through his email: kimmuller12@gmail.com or through the cougar net web site.

6. **Assignments:**

Classes 1-2, (Aug. 20 and 22, 2018)

- Course Book – Open Source Beebe, p. 2-26
- Trademarks 101 Slides (not a preread)
- US PTO.gov
- TMEP

Classes 3-4, (Aug. 27 and 29, 2018)

- Trademark Acquisition and Economic Power of Marks

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)

Zatarians, Inc. v. Oak Grove Smokehouse 698 F. 2nd 786 (5th 1983)

In re Cordua 2015-1432 118 USPQ 2nd 1632 (Fed Cir. 2014)

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

Metal v. Tan 6/19/17 No. 15-1293 582 U.S. – (2017)

Acquisition of Marks

Marketing 101

Clearance Searches:

Purpose

Scope

- U.S. Trademark Register;
- U.S. pending trademark applications;
- State registrations;
- Market directories;
- Phone books (major cities);
- Trade name listings; and
- Reported decisions

Shortcuts – Knock out Search
goods/services

Analysis of a Search:

Conflicts

Consents

Risk Analysis

Privileged Opinions to clients

Classes 5, (Sept. 5, 2018)

Functionality

Classes 6, (Sept. 10, 2018)

- Infringement Precursor
- Course Book – Beebe, Part 2, Infringement
- 15 USC 1114, 1125 (a), 1125 (c), 1125 (d)
- Types of Confusion and Dilution
- Borden Ice Cream Co. v. Borden's Condensed Milk Co. 201 F. 510 (7th Cir. 1912)
- Polaroid Corp. v. Polaroid Electronics Corp. 287 F. 2nd 492 (2nd Cir. 1961)
 1. Likelihood of Confusion is an empirical inquiry looking to the future.
 2. The understanding of who a prior user is not always clear especially for different goods.
 3. Recognize that it is very difficult to determine the state of mind of numberless individuals using relevant evidence.
 4. All circuits have different likelihood of confusion test factors.
 5. Factor of secondary meaning in a likelihood of confusion scenario.

The Board of Regents of the University of Houston System v. South Texas College of Law Civil Action 4:16 Cr. 1839 S. District of Texas

Class 7, (Sept. 12, 2018) S. Beldin

Classes 8, 9 and 10 (Sept. 17, 19 and 24, 2018) – Infringement/Dilution

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)

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

Abercrombie & Fitch v. Hunting World 537 F. 2nd 4 (2nd Cir. 1990)

La Societe' Anonyme des Parfume Le Gallion v. Jean Patou, Inc.
495 F. 2nd 1265 (2nd Cir, 1974)

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

Trade Dress – Two Pecos v. Taco Cabana 505 U.S. 763 (1992)

- Distinctiveness
- Bars to Protection
- Searching and Clearance
- Guidelines of Use
- Constructive Notice

Class 11 and 13 (Sept 26 and Oct 3, 2018) – Dilution

Course Book Beebe, Part 2, Dilution

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)

Gibson Guitar Corp v. Paul Reed Smith Guitars LP 423 F. 3rd 539 (6th Cir. 2005)

Starbucks Corp v. Wolfe's Borough Coffee, Inc. 588 F. 3rd 97 (2nd Cir. 2009)

Class 12 (Oct 1, 2018) – Michael Metteauer

Defenses and Limitations:

Classes 14 and 15 (Oct. 8 and 10, 2018)

Course Book, Beebe, Part 3

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

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

Weiner King, Inc. v. Weiner King Corp. 615 F.2nd 512 (CCPA 1980)

Haagen-Dazs, Inc. v. Fressen Ghadje LTD 493 F. Supp. 73 (SDNY 1980)

American Rice, Inc. v. Producers Rice Mill, Inc. 518 F. 3rd 321 (5th Cir. 2008)

Angel Flight of GA., Inc. v. Angel Flight AM, Inc. 522 F. 3rd 1200 (11th Cir. 2008)

Lever Bros Co. v. US 877 F.2nd 101 (United States Circuit Court of Appeals, P.C. 1989)

Kellogg Co. v. Exxon Corp. 209 F. 3rd 562 (6th Cir. 2000)

Anheuser Busch, Inc. v. Balducci 28 F. 3rd 769 (8th Cir. 1994)

Class 16, (Oct. 15, 2018) Remedies:

Course Book Beebe, Part 4

15 USC 1116 (a) and (d)

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

Winter v. Natural Res. Def. Counsel 555 U.S. 7 (S Ct. Court 2008)

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

Classes 17, (Oct. 17, 2018)

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)

Louis Vuitton SA. V Lee 875 F. 2nd 584 (7th Cir. 1989)

Davidoff SA v CVS Corp. 571 F. 3rd 238 (2nd. Cir 2009)

In General Electric Co. v. Speicher 676 F. Supp 1421 (N.D. Ind. 1988)

US v. Chong Lam 677 F. 3rd. 190 (4 Cir. 2012)
Course Book, Beebe Part 2 and 3

Class 18 Oct. 22, 2018 – Guest Lecture – Justin Blok - Damages

Class 19 (Oct. 24, 2018)

Paul Van Slyke – Guest Lecturer - False Advertising

Class 20 (Oct. 29, 2018)

Ed Blair – Guest Lecturer – Survey Evidence
Beebe Part 2 and 3

Class 21, (Oct. 31, 2018)

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. Doughey
263 F. 3rd 359 (4th Cir. 2001)

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

Classes 22, (Nov. 5, 2018)

Elizabeth King - Guest Lecturer

Classes 23 and 24, (Nov. 7 and 12, 2018)

Right of Publicity:

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 U.S. 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

Classes 25 (Nov. 14, 2018)

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 USC 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)

Class 26 (Nov. 19, 2018)

Review Class

