

**Trademark Prosecution Summer 2023
University of Houston Law Center
4170 Martin Luther King Blvd.
Houston, Texas 77004**

Instruction: Mr. Lee B. Hunt, Adjunct Professor
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COURSE OVERVIEW: This two-hour course provides hands-on training and instruction on the process of Trademark prosecution, from pre-application searching and client admonishment through the filing of renewal documents ten years after registration. Particular attention will be paid to the bases for application-filings and common refusals. Class discussion will cover current issues in trademark law and focus on law, precedent, and the USPTO's Trademark Manual of Examining Procedure. The course will also familiarize students with the electronic systems used by the trademark bar for searching databases of current registrations and pending applications, filing electronic applications, and responding to official correspondence issued by the USPTO.

LEARNING OUTCOMES: Upon completion of this course, students will (1) have the knowledge and understanding required to prosecute a trademark application for others when licensed to practice law; (2) understand the tools and resources available to assist in the process; (3) have a familiarity with the common refusals that prevent a trademark application from advancing to registration and how to avoid or resolve them for a client.

REQUIRED READING: *Trademark and Unfair Competition, Law and Policy*, Dinwoodie; Janice, **5th Edition!!**

*****NOTE: The 6th edition is the most current; we will be using the 5th edition because the information will suffice and the book is much cheaper than the current edition. (At least one final question will come directly from the book and will not be discussed in class.)**

Trademark Manual of Examining Procedure (Current Edition). Hard copy is NOT required, as electronic version available at
<http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml>.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)

Matal v. Tam, 137 S. Ct. 1744 (2017).

Iancu v. Brunetti, 139 S. Ct. 2294 (2019).

United States Patent & Trademark Office v. Booking.com B. V., 140 S. Ct. 2298, 2300, 207 L. Ed. 2d 738 (2020).

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

Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221 (5th Cir. 2009).

FIRST DAY Reading: **Text Book:** Chapter 5-- Registration.

Cases: *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4 (2nd Cir. 1976).

PARTICIPATION: Because this is an asynchronous course, the time you attend is flexible, but the AMOUNT of participation in this course is not. You MUST participate in course discussions by commenting on the relevant subject matter using fact and substantiated opinion. Deadlines are important and must be met. Videos will post each week, and must be viewed by the end of the week.

GRADES: Your grade in this course will be based on a final exam, consisting of one short answer and two essays applying trademark law and testing your analysis of it. The test will be open book/open note.

About the Instructor

Lee B. Hunt has been an adjunct professor for the University of Houston Law Center since 2016, and also recently joined the faculty at Texas A&M School of Law. Before entering private practice, he served six years as a trademark attorney for the United States Patent and Trademark Office, examining applications for federal trademark registration, training and mentoring newly hired trademark examining attorneys, helping to draft legal policy, and providing outreach through the agency's Texas Regional Office in Dallas. He currently works as an attorney with the Fort Worth law firm of Kelly Hart & Hallman, LLP, where his practice focuses on entertainment and trademark law. Lee has a Bachelor of Science from Texas State University, Master of Public Service and Administration from the Bush School of Government at Texas A&M University, and a Doctor of Jurisprudence from the University of Houston Law Center. Lee is a former Houston Police officer, a former clerk to the Supreme Court of Texas, and a current member of the State Bars of Texas and New York. Lee resides in Fort Worth, Texas with his wife and three kids. If you have questions or concerns, please feel free to reach me by phone or at the email address provided.