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## PREFACE TO SIXTH EDITION

We are pleased to present the Sixth Edition of Trademarks and Unfair Competition: Law and Policy. Like its predecessor, the Sixth Edition is being made available in multiple formats, including a looseleaf format priced considerably below the price for the hardbound book. This edition retains the essential structure that we introduced in the first edition in 2004, which has now become a standard approach to teaching the subject (and replicated in other books). Longtime users will note that in addition to incorporating prominent new decisions (such as the *Booking.com* case on genericness) and new legislation (the Trademark Modernization Act of 2020), we have made other important modifications. For example, in Chapter 1, we have replaced the venerable *Elvis Presley Enterprises* case with the METCHUP case, which we believe is destined to become a classic (the case, not the food product).

We wrote this book to provide the grist for trademark law classes. The foundation of those classes is treatment of the doctrinal content of trademark law, but we sought also to provoke a scholarly discussion around issues of trademark theory and policy that had previously lacked adequate attention. We are delighted that the balance of doctrine and theory we pursued has been well-received, both by students seeking an enduring understanding of the subject and by scholars engaged in critical exploration.

We had more particular ambitions in mind, too—such as integrating (and deepening) the coverage of trade dress, probing new developments in online marketing, and highlighting advances in international and comparative trademark law. Those aspirations continue to animate our work, now two decades and six editions later. We intend for the book to remain useful for students, lawyers, judges, and scholars for many years to come.

We have appreciated the help of many individuals in preparing this new edition of the book. Professor Janis benefitted from the efforts of research assistants Peyton Gilliatt, Taylor Lavender, Alex Mischke, Matthew Spegele, and Allison Strong, as well as administrative support from the Center for Intellectual Property Research at the Indiana University Maurer School of Law. And, as always, we greatly appreciate the comments we have received from users of the book, both students and fellow trademark professors. We hope that you will continue to offer us your reactions.

Graeme B. Dinwoodie  
Mark D. Janis

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## PREFACE TO FIRST EDITION

Trademark and unfair competition law impinges upon every aspect of human activity—the social, the commercial, the political . . . and the Elvis. As you'll see from the first chapter, the law of trademarks is a study in the dynamics of popular culture. Trademark law is about beer, clothes, cars, cologne, laundry detergent, and what goes through people's minds when they shop at the mall or on the Internet. More thematically, it is about encouraging and preserving investments in goodwill and identity while preserving freedom in the popular discourse. It is about protecting consumers from being misled, and about encouraging producers to maintain consistent quality in their goods and services. These are the themes of this book, and popular culture is the backdrop.

This book is also about change. Because popular culture mutates so rapidly (and often capriciously), trademark law experiences enormous evolutionary pressures. Today, those pressures are causing profound changes in the structure and doctrine of trademark and unfair competition law. The most exciting, most contested changes of late have sprung from three sources: the revolution in electronic commerce, the contemporary obsession with image, and globalization. The revolution in electronic commerce has brought us disputes over domain name ownership, and a host of Internet practices (such as protest websites and pop-up ads) that raise issues of control over trade reputation or the nature of online competition. The contemporary obsession with image has engendered debates over what uses of trademarks should be permitted without the consent of the trademark owner. And the frequently nonverbal character of image has translated into disagreements over the protection of nontraditional source-identifiers such as product design. Finally, reflecting the increasingly global nature of society, these disputes are no longer confined within national borders, and the policy consequences of trademark decisions are no longer felt only in the domestic sphere. We have emphasized these developments throughout the book.

Despite these profound changes in trademark and unfair competition law, we have organized the materials according to a traditional understanding of intellectual property systems. The book proceeds on the basis of broad topics, into which we have sought to integrate new and exotic subjects alongside their more traditional counterparts. Thus, we address, in order, trademark creation, trademark scope and enforcement, and trademark transactions. This approach is more bold than it may seem, and it raises a number of challenging questions about the seemingly ad hoc progression of recent trademark law. For instance, as to the creation of rights, this arrangement might cause a reader to question why rules for recognition of one type of trademark subject matter (e.g., word marks) should differ from rules for recognition of another (e.g., trade dress). Similarly, concerning the scope and enforcement of rights, this arrangement may lead a reader to consider how the trademark dilution cause of action (introduced into federal law almost a decade ago) and the new cybersquatting cause of action (introduced in late 1999) align with other, traditional enforcement theories. Finally, our grouping of topics in a "transactions" unit that addresses transfer, licensing, franchising, and limits on the commercial exploitation of trademarks is designed to make students see the connections among issues that face transactional intellectual property lawyers on a daily basis. We believe that our integration of new law and

traditional principles within a single conception of the field is unique, and hopefully more accessible to students, judges, legislators, and others who think about trademark law and policy.

A word about the format of the book. We are believers in the traditional case method of teaching, and so the book consists primarily of cases. We aren't believers in severe editing of cases. As former litigators, we tend to think that issues like procedure, facts, and evidence actually matter, and heavy editing can too often preclude proper discussion of these topics. Where we have edited original materials, this is indicated by ellipses or bracketed explanatory phrases. We have indicated deletions of citations by the bracketed abbreviation [cit.]. We have omitted most footnotes without indication; those that remain retain their original numbering.

We also have included a series of problems that challenge the reader to apply and extend the principles developed in the main cases and notes. A number of the problems are drawn from real-life examples. Others, such as any that portray the two of us as heroic, might possibly be embellished.

We have many people to thank for their contributions to this project. We benefited from the insights of several anonymous reviewers, whose names are Professors Julie Cohen, Tom Cotter, Lydia Loren, and Marshall Leaffer, along with a few others who are truly anonymous. We also benefited greatly from comments received from several trademark law professors, including Professors Graeme Austin, Barton Beebe, and Tim Holbrook, who used the materials in manuscript form. Students in our classes at Chicago-Kent College of Law and the University of Iowa College of Law offered helpful comments. Kati Jumper provided phenomenal secretarial support through many, many years' worth of drafts. Iowa students Kate Cox, Lynda Fitzpatrick, Paula Fritsch, Rob Hodgson, and Scott Timmerman, and Chicago-Kent students Jessica Kaiser, Christopher Kaiser, Aashit Shah, and Sheng Wu provided excellent research assistance. Thanks to our publishers, particularly Carol McGeehan, for encouraging us to pursue our vision of how best to teach trademark and unfair competition law. Finally, we could not have done any of this without the support of our respective families: Professor Janis is particularly grateful to Julie, Aimee, Katie, and Kyle; Professor Dinwoodie owes much more than can be conveyed by an acknowledgment to Isa, David, Christine, Davy, and Brian. Professor Janis is also especially grateful for the friendship of his colleague Professor Hillary Sale. And he apologizes in advance to his Brother Billy (he tried to change names to protect the innocent, but Professor Dinwoodie wouldn't let him).

Graeme B. Dinwoodie  
Mark D. Janis

May 2004