## **C**ONTENTS

| Preface to<br>Preface to |    |   | xxiii<br>xxv |
|--------------------------|----|---|--------------|
| PART I                   |    | UNDATIONS AND PURPOSES OF TRADEMARK<br>D UNFAIR COMPETITION LAW | 1            |
|                          | In | troduction to Trademark and Unfair                              |              |
| 1                        | Co | DMPETITION LAW  | 3            |
|                          | А. | Sources and Nature of Trademark Rights                          | 3            |
|                          |    | The Trade-Mark Cases  | 3            |
|                          |    | Hanover Star Milling Co. v. Metcalf                             | 7            |
|                          |    | Mishawaka Rubber & Woolen Mfg. Co. v.                           |              |
|                          |    | S.S. Kresge Co.   | 8            |
|                          |    | Yale Electric Corp. v. Robertson                                | 8            |
|                          |    | Prestonettes, Inc. v. Coty                                      | 8            |
|                          |    | Notes and Questions   | 9            |
|                          |    | Note: Trademarks and Copyrights and Patents                     | 11           |
|                          | В. | The Nature of Unfair Competition Law                            | 12           |
|                          |    | International News Service v. Associated Press                  | 12           |
|                          |    | Dastar Corp. v. Twentieth Century Fox Film Corp.                | 14           |
|                          |    | Notes and Questions   | 14           |
|                          | С. | Purposes of Trademark Law                                       | 16           |
|                          |    | Daniel M. McClure, Trademarks and                               |              |
|                          |    | Competition: The Recent History                                 | 16           |
|                          |    | Notes and Questions   | 18           |
|                          | D. | Modern Marketing and Trademark Law                              | 18           |
|                          |    | Jerre B. Swann, Dilution Redefined for the Year 2002            | 19           |
|                          |    | Alex Kozinski, Trademarks Unplugged                             | 22           |
|                          |    | Notes and Questions   | 23           |
|                          |    | Graeme B. Dinwoodie, (National) Trademark Laws                  |              |
|                          |    | and the (Non-National) Domain Name System                       | 25           |
|                          |    | Notes and Questions   | 28           |
|                          | E. | An Illustration   | 28           |
|                          |    | Perry v. H. J. Heinz Company Brands, L.L.C.                     | 28           |
|                          |    | Notes and Questions   | 34           |
|                          |    | Figure 1-1: A Trademark Timeline                                | 36           |
|                          |    | Figure 1-2: A Comparison of Copyright, Patent,                  |              |
|                          |    | and Trademark   | 37           |
|                          |    | Figure 1-3: Appeal Routes                                       | 39           |

| Contents |
|----------|
|----------|

| PART II | CI | REATION OF TRADEMARK RIGHTS                                       | 41         |
|---------|----|---|------------|
|         | Dı | STINCTIVENESS   | 43         |
| 2       |    | Restatement (Third) of Unfair Competition Section 9               | 43         |
|         |    | Lanham Act Section 45   | 43         |
|         |    | Notes and Questions   | 44         |
|         | A. | The Spectrum of Distinctiveness                                   | 45         |
|         |    | Abercrombie & Fitch Co. v. Hunting World, Inc.                    | 45         |
|         |    | Restatement (Third) of Unfair Competition Section 13              | 48         |
|         |    | Notes and Questions   | 48         |
|         | В. | Descriptiveness and Secondary Meaning                             | 51         |
|         |    | Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.                    | 51         |
|         |    | Notes and Questions   | 56         |
|         |    | Restatement (Third) of Unfair Competition                         |            |
|         |    | Section 13, Comment (e)   | 61         |
|         |    | Notes and Questions   | 62         |
|         | С. | Generic Terms   | 67         |
|         |    | Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.          | 67         |
|         |    | Mil-Mar Shoe Co., Inc. v. Shonac Corp.                            | 70         |
|         |    | Haughton Elevator Co. v. Seeberger                                | 72         |
|         |    | Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.            | 73         |
|         |    | Blinded Veterans Ass'n v. Blinded American                        |            |
|         |    | Veterans Found.   | 76         |
|         |    | Notes and Questions   | 80         |
|         |    | United States Patent & Trademark Office v.                        |            |
|         |    | Booking.com B.V.  | 86         |
|         |    | Notes and Questions   | 97         |
|         |    | Problem 2-1: Preventing Genericide                                | 98         |
|         | -  | Problem 2-2: Word Mark Distinctiveness                            | 100        |
|         | D. |   |            |
|         |    | Product Design, and Colors  | 101        |
|         |    | 1. Different Tests, Different Standards?                          | 101        |
|         |    | In Re Lululemon Athletica Canada, Inc.                            | 102        |
|         |    | Notes and Questions   | 107        |
|         |    | Star Indus., Inc. v. Bacardi & Co. Ltd.                           | 109        |
|         |    | Amazing Spaces, Inc. v. Metro Mini Storage                        | 112        |
|         |    | In Re Vox Populi Registry Ltd.                                    | 120        |
|         |    | Notes and Questions   | 123        |
|         |    | 2. Expanding the Types of Nonverbal Marks                         | 124<br>125 |
|         |    | Two Pesos, Inc. v. Taco Cabana, Inc.                              | 125        |
|         |    | Notes and Questions   | 131        |
|         |    | Qualitex Co. v. Jacobson Products Co., Inc.                       | 131        |
|         |    | Notes and Questions<br>3. The Design/Packaging Distinction        | 137        |
|         |    | a. Post– <i>Two Pesos</i> Circuit Split in the Test of Inherent   | 13/        |
|         |    | Distinctiveness of Trade Dress                                    | 137        |
|         |    | b. The Protection of Packaging Trade Dress After <i>Two Pesos</i> | 10/        |
|         |    | and Qualitex  | 138        |
|         |    | Line Zummeren   | 100        |

xii

T1 0

|    | c. The Supreme Court Enters the Fray: Product Design       |        |
|----|--|--------|
|    | Trade Dress  | 140    |
|    | Wal-Mart Stores, Inc. v. Samara Brothers, Inc.             | 140    |
|    | Notes and Questions  | 144    |
|    | 4. Trade Dress Protection After Wal-Mart                   | 145    |
|    | In re Slokevage  | 145    |
|    | In re Forney Industries, Inc.                              | 148    |
|    | Notes and Questions  | 152    |
|    | Yankee Candle Company, Inc. v. Bridgewater                 |        |
|    | Candle Company, LLC  | 153    |
|    | Notes and Questions  | 158    |
|    | Problem 2-3: Cheerios                                      | 161    |
| E. | The Edge of Trademark Protection: Subject-Matter Exclusion | s? 164 |
|    | 1. Exotic Source-Identifiers                               | 165    |
|    | In re Clarke   | 165    |
|    | Notes and Questions  | 167    |
|    | 2. Subject Matter Protected by Copyright                   | 168    |
|    | Oliveira v. Frito-Lay, Inc.                                | 168    |
|    | Notes and Questions  | 172    |
|    | Dastar Corp. v. Twentieth Century Fox Film Corp.           | 174    |
|    | Notes and Questions  | 180    |
|    | Problem 2-4: Dastar Karaoke                                | 183    |

3

### FUNCTIONALITY 185 A. An Introduction to the Concept of Functionality 185 In re Morton-Norwich Products, Inc. 186 Notes and Questions 194 The Scope of the Functionality Doctrine 195 Β. Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc. 195 Brunswick Corp. v. British Seagull Ltd. 200 Notes and Questions 201 The Supreme Court's Approach to Functionality 202 C. Kellogg Co. v. National Biscuit Co. 203 Qualitex Co. v. Jacobson Prods. Co., Inc. 206 TrafFix Devices, Inc. v. Marketing Displays, Inc. 208 Notes and Questions 213 D. Post-TrafFix Applications of the Functionality Doctrine 216 1. Utilitarian Features 216 Valu Engineering, Inc. v. Rexnord Corp. 216 Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH 221 Jay Franco & Sons, Inc. v. Franek 222 Bodum USA, Inc. v. A Top New Casting Inc. 226 Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp. 231 Notes and Questions 237 The Evidentiary Inference: Further Notes and Questions 239

xiii

| 2. | Aesthetic Features                                    | 242 |
|----|---|-----|
|    | Abercrombie & Fitch Stores, Inc. v. American Eagle    |     |
|    | Outfitters, Inc.                                      | 242 |
|    | Leapers, Inc. v. SMTS, LLC                            | 246 |
|    | Christian Louboutin S.A. v. Yves Saint Laurent        |     |
|    | America, Inc.   | 249 |
|    | Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc. | 256 |
|    | Notes and Questions                                   | 260 |
|    | Problem 3-1: The Hershey Bar                          | 263 |



#### USE 265 "Use" as a Jurisdictional Prerequisite A. 265 Actual "Use" as a Basis for Establishing Rights B. 266 1. Establishing Actual Use 267 Lanham Act Section 1 267 Lanham Act Section 45 268 Notes and Questions 268 Problem 4-1: Use in Connection with Goods 270 Aycock Engineering, Inc. v. Airflite, Inc. 270 Notes and Questions 275 Planetary Motion, Inc. v. Techsplosion, Inc. 276 Notes and Questions 280 Problem 4-2: Illegal Uses 282 Proving Use in Registration Practice 283 2. Priority of Use 288 Lanham Act Section 2(d)289 289 Notes and Questions Problem 4-3: The Use Requirement and Merely 291 Descriptive Marks Problem 4-4: Tacking 291 Constructive Use as a Basis for Establishing Rights 294 C. S. Rep. No. 100-515 295 296 1. Establishing Intent to Use Lanham Act Section 1 296 M.Z. Berger & Co., Inc. v. Swatch AG 297 Notes and Questions 302 Constructive Use Priority 303 2. Lanham Act Section 7(c)303 Notes and Questions 304 D. Foreign Activity as a Basis for Establishing Rights 305 Lanham Act Section 44(e) 305 In re Rath 306 Notes and Questions 312 Lanham Act Section 44(d) 313 Notes and Questions 313 Lanham Act Section 66 314 Lanham Act Section 67 314 Lodestar Anstalt v. Bacardi & Co. Ltd. 314

xiv

5

|    | Notes and Questions  | 324        |
|----|--|------------|
| E. | "Surrogate" Uses   | 326        |
|    | 1. Uses by Affiliates  | 327        |
|    | Problem 4-5: Truth in Rock   | 329        |
|    | 2. Public as a "Surrogate" User  | 330        |
|    | Coca-Cola Co. v. Busch   | 330        |
|    | Notes and Questions  | 331        |
|    | Problem 4-6: Krusty Krab   | 334        |
| F. | Loss of Rights Through Non-Use or Uncontrolled Uses  | 335        |
|    | 1. Abandonment Through Non-Use   | 335        |
|    | Emergency One, Inc. v. American FireEagle, Ltd.  | 335        |
|    | Notes and Questions  | 339        |
|    | Problem 4-7: Residual Goodwill   | 343        |
|    | Problem 4-8: Trademark Maintenance Programs<br>Problem 4-9: Trademarks and the Relocation of | 345        |
|    | Sports Franchises  | 346        |
|    | 2. Abandonment Through Failure to Control Use  | 348        |
|    | Restatement (Third) of Unfair Competition  |            |
|    | Section 33, Comments A-C   | 348        |
|    | Lawn Managers, Inc. v. Progressive Lawn Managers, Inc.                                       | 350        |
|    | Notes and Questions  | 357        |
|    | Problem 4-10: Quality Control and  | 2(0        |
|    | Differentiated Product Lines   | 360        |
|    | University Book Store v. University of Wisconsin Board                                       | 260        |
|    | of Regents   | 360        |
|    | Notes and Questions  | 366<br>368 |
|    | E. & J. Gallo Winery v. Gallo Cattle Company<br>Notes and Questions                          | 308<br>371 |
|    | Notes and Questions  | 0/1        |
| Rı | EGISTRATION  | 375        |
| А. | The Registration Process, Post-Registration Actions,   |            |
|    | and Incontestability   | 375        |
|    | 1. Overview of Relevant Provisions   | 375        |
|    | Figure 5-1   | 375        |
|    | 2. Post-Registration Actions   | 385        |
|    | 3. Incontestability  | 391        |
|    | Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.   | 393        |
|    | Notes and Questions  | 398        |
| В. | Exclusions from Registration   | 400        |
|    | 1. Overview  | 400        |
|    | 2. Scandalous, Disparaging, Deceptive, and Deceptively                                       | 101        |
|    | Misdescriptive Marks Under Section $2(a)$ and $2(e)(1)$                                      | 401        |
|    | Matal v. Tam   | 402        |
|    | Iancu v. Brunetti  | 412        |
|    | Notes and Questions  | 419        |
|    | In re Budge Mfg. Co., Inc.   | 421        |
|    | Notes and Questions<br>Problem 5, 1, Section 2(a) Decentiveness Versus                       | 422        |
|    | Problem 5-1: Section $2(a)$ Deceptiveness Versus   | 423        |
|    | Section $2(e)(1)$ Deceptive Misdescriptiveness   | 423        |

xv

|         |     | Problem 5-2: Temporary Deception and the                  |     |
|---------|-----|---|-----|
|         |     | Section 2(a) Deceptiveness Inquiry                        | 423 |
|         |     | Problem 5-3: Government Symbols                           | 424 |
|         |     | 3. Geographic Marks                                       | 425 |
|         |     | In re The Newbridge Cutlery Co.                           | 426 |
|         |     | Notes and Questions                                       | 432 |
|         |     | In re California Innovations, Inc.                        | 435 |
|         |     | Notes and Questions                                       | 439 |
|         |     | 4. Name Marks   | 442 |
|         |     | In re United Distillers, Plc                              | 442 |
|         |     | Notes and Questions                                       | 443 |
|         |     | In re Sauer   | 445 |
|         |     | Notes and Questions                                       | 446 |
|         |     | Problem 5-4: Celebrity Names                              | 449 |
|         |     | Problem 5-5: Review Exercises—Applying                    |     |
|         |     | Section 2   | 449 |
| PART II | I S | COPE AND ENFORCEMENT OF                                   |     |
|         | Т   | <b>TRADEMARK RIGHTS</b>                                   | 451 |
|         |     |   |     |
| 6       | G   | eographic Limits on Trademark Rights                      | 453 |
|         | А.  | Geographic Limits on Common Law Rights: Tea Rose-Rectanus |     |
|         |     | Doctrine  | 453 |
|         |     | United Drug Co. v. Theodore Rectanus Co.                  | 453 |
|         |     | Notes and Questions                                       | 456 |
|         | В.  | Geographic Limits and Registered Rights                   | 459 |
|         |     | Dawn Donut Co., Inc. v. Hart's Food Stores, Inc.          | 459 |
|         |     | National Ass'n for Healthcare Communications,             |     |
|         |     | Inc. v. Central Arkansas Area Agency on Aging, Inc.       | 462 |
|         |     | Guthrie Healthcare System v. ContextMedia, Inc.           | 467 |
|         |     | Notes and Questions                                       | 476 |
|         | С.  | The Territorial Nature of U.S. Trademark Rights           | 479 |
|         |     | Person's Co., Ltd. v. Christman                           | 479 |
|         |     | Grupo Gigante v. Dallo & Co., Inc.                        | 482 |
|         |     | ITC Limited v. Punchgini, Inc.                            | 489 |
|         |     | Belmora LLC v. Bayer Consumer Care AG                     | 498 |
|         |     | Notes and Questions                                       | 507 |
|         |     | International Bancorp LLC v. Societe des Bains de Mer     |     |
|         |     | et du Cercle des Etrangers a Monaco                       | 511 |
|         |     | Notes and Questions                                       | 517 |
|         |     | Problem 6-1: Scottish Beer Sales                          | 518 |
|         | D.  | The Extraterritorial Enforcement of U.S. Trademark Rights | 518 |
|         |     | Steele v. Bulova Watch Co.                                | 518 |
|         |     | Vanity Fair Mills, Inc. v. T. Eaton Co., Ltd.             | 521 |
|         |     | Sterling Drug, Inc. v. Bayer AG                           | 525 |
|         |     | McBee v. Delica Co.                                       | 527 |
|         |     | Trader Joe's Co. v. Hallatt                               | 534 |
|         |     | Hetronic International, Inc. v. Hetronic                  |     |
|         |     | Germany GmbH  | 542 |
|         |     | Notes and Questions                                       | 548 |
|         |     | *   |     |

7

|     |       | Problem 6-3: Irish Furniture Sales                      | 549         |
|-----|-------|---|-------------|
| Сс  | NFI   | usion-Based Trademark Liability Theories                | 551         |
| A.  |       | blution of the Confusion Standard                       | 552         |
| 11. | LW    | Borden Ice Cream Co. v. Borden's Condensed Milk Co.     | 552         |
|     |       | Fleischmann Distilling Corp. v. Maier Brewing Co.       | 555         |
|     |       | Notes and Questions                                     | 558         |
| B.  | Th    | e Actionable "Use" Prerequisite                         | 561         |
| D.  | 1 110 | Holiday Inns, Inc. v. 800 Reservations, Inc.            | 562         |
|     |       | Notes and Questions                                     | 566         |
|     |       | Rescuecom Corp. v. Google Inc.                          | 567         |
|     |       | Notes and Questions                                     | 579         |
| C.  | Th    | e Factors Analysis for Likelihood of Confusion          | 581         |
| 0.  | 1.    | Overview; Discussion Questions                          | 581         |
|     | 1.    | Figure 7-1: Factor Tests in Likelihood-of-Confusion     | 501         |
|     |       | Analysis  | 583         |
|     | 2.    | Applying the Factors Analysis                           | 589         |
|     | 2.    | Virgin Enterprises Ltd. v. Nawab                        | 589         |
|     |       | McDonald's Corp. v. Druck and Gerner,                   | 507         |
|     |       | D.D.S., P.C., d/b/a McDental                            | 595         |
|     |       | Libman Company v. Vining Industries, Inc.               | 600         |
|     |       | Introduction to Notes and Questions on the Factors      | 000         |
|     |       | Analysis  | 605         |
|     |       | Notes and Questions: Similarity of Marks Factor         | 605         |
|     |       | Problem 7-1: Pickle Problem                             | 611         |
|     |       |   | 011         |
|     |       | Problem 7-2: Similarity Factor for Foreign              | 612         |
|     |       | Language Word Marks                                     | 012         |
|     |       | Problem 7-3: Similarity Analysis for Nonverbal<br>Marks | 613         |
|     |       |   | 615         |
|     |       | Notes and Questions: Strength Factor                    | 616         |
|     |       | Notes and Questions: Intent Factor                      | 010         |
|     |       | Notes and Questions: Buyer Sophistication               | <i>(</i> 10 |
|     |       | Factor; Reasonably Prudent Purchaser                    | 618<br>620  |
|     |       | Notes and Questions: Actual Confusion Factor            | 620         |
|     |       | Notes and Questions: Relatedness of Goods/              | (22         |
|     |       | Channels of Trade/Bridging the Gap                      | 623         |
|     |       | Problem 7-4: Related or Unrelated? Confusing            | (27         |
|     | 2     | or Not?   | 627         |
|     | 3.    | The Factors Analysis Applied to Private-Label Goods     | 628         |
|     |       | Problem 7-5: Likelihood of Confusion in                 | (20)        |
|     |       | Private-Label Goods Cases                               | 628         |
|     | 4.    | The Factors Analysis Applied to Promotional Goods       | 630         |
|     |       | Boston Professional Hockey Association, Inc. v. Dallas  | (00         |
|     |       | Cap & Emblem Mfg., Inc.                                 | 630         |
|     | _     | Notes and Questions                                     | 632         |
|     | 5.    | The Factors Analysis Applied Under Section 2(d)         | 636         |
|     |       | Lanham Act, Section 2(d)                                | 636         |

Problem 6-2: Italian Online Magazine Sales

xvii

549

|    | Problem 7-6: Effect of PTO Section 2(d)                   |     |
|----|---|-----|
|    | Determinations in Subsequent Litigation                   | 639 |
|    | Problem 7-7: Effect of Litigation Determinations          |     |
|    | in Subsequent PTO Proceedings                             | 641 |
| D. | Confusion Away from the Point of Sale                     | 641 |
|    | 1. Post-Sale Confusion                                    | 642 |
|    | Ferrari S.P.A., Esercizio v. Roberts                      | 642 |
|    | Notes and Questions                                       | 646 |
|    | 2. Initial Interest Confusion                             | 649 |
|    | Multi Time Machine, Inc. v. Amazon.com, Inc.              | 650 |
|    | Notes and Questions                                       | 661 |
| E. | Reverse Confusion   | 664 |
|    | A ヴ H Sportswear, Inc. v. Victoria's Secret Stores, Inc.  | 665 |
|    | Notes and Questions                                       | 671 |
| F. | Indirect and Vicarious Theories of Infringement Liability | 675 |
|    | Inwood Laboratories, Inc. v. Ives Laboratories, Inc.      | 675 |
|    | Tiffany (NJ) Inc. v. eBay Inc.                            | 679 |
|    | Notes and Questions                                       | 685 |
|    | Problem 7-8: Brother Billy and the Baptists'              |     |
|    | Bathrooms   | 692 |
|    | Problem 7-9: Trade "Disparagement"?                       | 692 |
|    |   |     |

8

# Non-Confusion-Based Trademark Liability Theories

| Theories |                            |  | 695 |
|----------|----------------------------|--|-----|
| А.       | Dilution Protection        |  | 695 |
|          | 1. The Concept of Dilution |  | 695 |
|          |                            | Notes and Questions                                  | 697 |
|          | 2.                         | Anatomy of the Federal Trademark Dilution Provisions | 698 |
|          |                            | Lanham Act Section 43(c)                             | 698 |
|          |                            | Notes and Questions                                  | 700 |
|          | 3.                         | The Forms of Dilution: Dilution by Tarnishment and   |     |
|          |                            | Dilution by Blurring                                 | 703 |
|          |                            | a. Tarnishment                                       | 703 |
|          |                            | Toys "R" Us, Inc. v. Akkaoui                         | 703 |
|          |                            | Toys "R" Us, Inc. v. Feinberg                        | 704 |
|          |                            | V Secret Catalogue, Inc. v. Moseley                  | 705 |
|          |                            | Notes and Questions                                  | 712 |
|          |                            | Problem 8-1: Dilution by Burnishing?                 | 713 |
|          |                            | b. Blurring  | 713 |
|          |                            | Starbucks Corp. v. Wolfe's Borough Coffee, Inc.      | 714 |
|          |                            | Visa Int'l Service Assoc. v. JSL Corp.               | 721 |
|          |                            | Notes and Questions                                  | 724 |
|          | 4.                         | Dilution Under Lanham Act §2(f)                      | 728 |
| В.       | Pro                        | otection Against Cybersquatting                      | 729 |
|          | 1.                         | Protection Under the Dilution Statute                | 729 |
|          |                            | Panavision International v. Toeppen                  | 729 |
|          |                            | Notes and Questions                                  | 732 |
|          | 2.                         | Anticybersquatting Consumer Protection Act:          |     |
|          |                            | Section 43(d) of the Lanham Act                      | 733 |

### xviii

9

|    |           | Sporty's Farm L.L.C. v. Sportsman's Market, Inc.        | 733        |
|----|-----------|---|------------|
|    |           | DSPT Int'l, Inc. v. Nahum                               | 738        |
|    |           | Newport News Holding Corp. v. Virtual City Vision, Inc. | 742        |
|    |           | Lamparello v. Falwell                                   | 746        |
|    |           | Notes and Questions                                     | 749        |
|    |           | Harrods Ltd. v. Sixty Internet Domain Names             | 753        |
|    |           | Notes and Questions                                     | 762        |
|    | 3.        | ICANN Uniform Domain Name Dispute Resolution Policy     |            |
|    |           | (UDRP)  | 765        |
|    |           | Final Report of the WIPO Internet Domain Name           |            |
|    |           | Process (Executive Summary, April 30, 1999)             | 765        |
|    |           | World Wrestling Federation Entertainment,               |            |
|    |           | Inc. v. Bosman  | 768        |
|    |           | Telstra Corp. Ltd. v. Nuclear Marshmallows              | 771        |
|    |           | Notes and Questions                                     | 773        |
|    |           | Coach, Inc. v. Koko Island                              | 775        |
|    | 4.        | The Relationship Between the UDRP and the ACPA          | 783        |
|    |           | Barcelona.com, Inc. v. Excelentisimo Ayuntamiento       |            |
|    |           | de Barcelona  | 783        |
|    |           | Notes and Questions                                     | 790        |
| Dr | DM        | ssible Uses of Another's Trademarks                     | 793        |
| A. |           | Use of Another's Trademark                              | 793        |
| л. | ган<br>1. | Relationship Between Fair Use and Confusion             | 793<br>794 |
|    | 1.        | KP Permanent Make-Up, Inc. v. Lasting                   | / 74       |
|    |           | Impression I, Inc.                                      | 794        |
|    |           | Notes and Questions                                     | 799        |
|    | 2.        | Descriptive Fair Use                                    | 799        |
|    | 2.        | Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand | ///        |
|    |           | Management, Inc.  | 800        |
|    |           | Kelly-Brown v. Winfrey                                  | 805        |
|    |           | Marketquest Group, Inc. v. BIC Corp.                    | 813        |
|    |           | Notes and Questions                                     | 817        |
|    |           | Problem 9-1: Fair Use of Names                          | 820        |
|    |           | Problem 9-2: Fair Use of Geographic Indicators          | 822        |
|    | 3.        | Nominative Fair Use                                     | 822        |
|    |           | R. G. Smith v. Chanel, Inc.                             | 823        |
|    |           | Notes and Questions                                     | 826        |
|    |           | Century 21 Real Estate Corp. v. LendingTree, Inc.       | 828        |
|    |           | Toyota Motor Sales, U.S.A., Inc. v. Tabari              | 835        |
|    |           | Notes and Questions                                     | 843        |
|    |           | Problem 9-3: Applying Nominative Fair Use Tests         | 845        |
|    |           | Problem 9-4: Nominative Fair Use in Movies<br>and TV    | 016        |
| B. | Llas      | of Another's Trademark on Genuine Goods:                | 846        |
| Б. |           | rst Sale" Doctrine                                      | 847        |
|    | гII       |   | 847<br>849 |
|    |           | Notes and Questions                                     | 849<br>854 |
|    |           | Champion Spark Plug Co. v. Sanders                      | 855        |
|    |           | Notes and Questions                                     | 033        |

### xix

859

| Gamut Trading Co. v. U.S.I.T.C.                            | 860        |
|--|------------|
| Notes and Questions  | 866        |
| C. Expressive Use of Another's Trademark                   | 867        |
| Anheuser-Busch, Inc. v. Balducci Publications              | 867        |
| Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LI      | C 872      |
| Mattel, Inc. v. MCA Records, Inc.                          | 881        |
| Notes and Questions  | 886        |
| Twentieth Century Fox Television v. Empire Dist., Inc.     | 890        |
| Notes and Questions  | 893        |
| Gordon v. Drape Creative, Inc.                             | 896        |
| Notes and Questions  | 905        |
| Problem 9-6: Trademarks and Virtual Worlds                 | 909        |
| Problem 9-7: "Dumb" Starbucks                              | 909        |
| FALSE ADVERTISING  | 911        |
| A. Introduction: The Evolution of Section 43(a) False      | /11        |
| Advertising Claims   | 911        |
| Notes and Questions  | 913        |
| B. Threshold Issues  | 913<br>914 |
| Problem 10-1: Standing                                     | 914<br>914 |
| Problem 10-2: Commercial "Advertising or                   | 714        |
| Promotion"   | 917        |
|  | 917        |
|  | 918<br>918 |
| United Industries Corp. v. Clorox Co.                      | 918        |
| Notes and Questions<br>Problem 10-3: This Casebook Rocks   |            |
|  | 927<br>928 |
| Pizza Hut, Inc. v. Papa John's International, Inc.         | 928        |
| Notes and Questions  |            |
| Cashmere & Camel Hair Mfrs. Inst. v. Saks Fifth Aver       |            |
| Notes and Questions  | 940        |
| Trafficschool.com, Inc. v. Edriver, Inc.                   | 945        |
| Notes and Questions  | 947        |
| Problem 10-4: "Ambush" Advertising                         | 947        |
| Problem 10-5: Lanham Act False Advertising                 | 0.40       |
| Versus Other Federal Labeling Regulations                  | 948        |
| TRADE IDENTITY RIGHTS IN ONE'S PERSONA:                    |            |
| ENDORSEMENT, ATTRIBUTION, AND PUBLICITY                    | 951        |
| A. Section $43(a)$ and the Protection of Personal Identity | 952        |
| 1. False Over-Attribution                                  | 952        |
| Notes and Questions  | 954        |
| 2. False Under-Attribution                                 | 956        |
| Notes and Questions  | 959        |
| Problem 11-1: <i>Dastar</i> and False Advertising          | /0/        |
| Theories in Under-Attribution Cases                        |            |
| Featuring Kim Kardashian                                   | 962        |
| B. Right of Publicity                                      | 962        |
| 1. Overview of Statutory and Common Law Regimes            | 963        |
| 1. Overview of Statutory and Common Law Regnines           | 203        |

Problem 9-5: Shoe "Customization"

10

11

|                     | Indiana Code Title 32 (Property)—Art. 36               |      |  |  |  |
|---------------------|--|------|--|--|--|
|                     | (Publicity) Chap. 1 (Rights of Publicity)              |      |  |  |  |
| Notes and Questions |  |      |  |  |  |
|                     | Figure 11-1  |      |  |  |  |
|                     | Problem 11-2: Copyright and Trademark                  |      |  |  |  |
|                     | Preemption of the Right of Publicity                   | 974  |  |  |  |
|                     | Cheatham v. Paisano Publications, Inc.                 | 975  |  |  |  |
|                     | Notes and Questions                                    | 979  |  |  |  |
| 2.                  | Protectable Aspects of Persona                         | 979  |  |  |  |
|                     | John W. Carson v. Here's Johnny Portable Toilets, Inc. | 980  |  |  |  |
|                     | Vanna White v. Samsung Electronics America, Inc.       | 982  |  |  |  |
|                     | Vanna White v. Samsung Electronics America, Inc.       | 985  |  |  |  |
|                     | Notes and Questions                                    | 989  |  |  |  |
|                     | Problem 11-3: The Right of Publicity and               |      |  |  |  |
|                     | Portrayals of Fictional Characters                     | 990  |  |  |  |
| 3.                  | Limitations on the Right of Publicity                  |      |  |  |  |
|                     | Hart v. Electronic Arts, Inc.                          | 993  |  |  |  |
|                     | Notes and Questions                                    | 1006 |  |  |  |
|                     | Daniels v. Fanduel, Inc.                               | 1010 |  |  |  |
|                     | Notes and Questions                                    | 1015 |  |  |  |
|                     | Michael Jordan v. Jewel Food Stores, Inc.              | 1016 |  |  |  |
|                     | Problem 11-4: The Scottish Elvis                       | 1025 |  |  |  |
|                     | Problem 11-5: Sheriff Andy Griffith                    | 1026 |  |  |  |
|                     | Problem 11-6: G.I. George                              | 1026 |  |  |  |
|                     | Problem 11-7: The Soldier's Right of Publicity         | 1027 |  |  |  |
|                     | Problem 11-8: Guitar Hero                              | 1028 |  |  |  |



Index

## Remedies

|                | Re                                | EMEDIES                                     | 1029 |  |
|----------------|-----------------------------------|---|------|--|
| 12             | А.                                | Injunctive (and Other Non-Monetary) Relief  | 1029 |  |
|                | Goto.com, Inc. v. Walt Disney Co. |   |      |  |
|                |                                   | Notes and Questions                         | 1032 |  |
|                |                                   | The Effect of <i>eBay</i> and the Trademark |      |  |
|                |                                   | Modernization Act of 2020                   | 1038 |  |
|                |                                   | Notes and Questions: Other Non-Monetary     |      |  |
|                |                                   | Relief                                      | 1039 |  |
|                | В.                                | Monetary Relief                             | 1040 |  |
|                |                                   | Lindy Pen Co. v. Bic Pen Corp.              | 1040 |  |
|                |                                   | Romag Fasteners, Inc. v. Fossil Group, Inc. | 1045 |  |
|                |                                   | Notes and Questions                         | 1048 |  |
|                |                                   | LHO Chicago River, L.L.C. v. Perillo        | 1052 |  |
|                |                                   | Notes and Questions                         | 1054 |  |
|                | C.                                | Counterfeiting                              | 1057 |  |
|                |                                   | K & N Engineering, Inc. v. Bulat            | 1057 |  |
|                |                                   | Notes and Questions                         | 1059 |  |
| Table of Cases |                                   |   |      |  |

1079