

TABLE OF CONTENTS

TABLE OF CASES	XIII
Chapter 1. Introduction	1
A. Competition: Fair and Unfair	1
International News Service v. The Associated Press	1
Notes for Discussion	13
Dastar Corp. v. Twentieth Century Fox Film Corp.	18
Notes for Discussion	26
B. The Constitutional Basis of Federal Trademark Protection	35
The Trade-Mark Cases	35
Notes for Discussion	41
C. Perspectives on Trademark Policy	43
Notes for Discussion	48
Chapter 2. Prerequisites for Trademark Protection: Use	51
A. The Traditional Use Requirement	51
Blue Bell, Inc. v. Farah Mfg. Co.	51
Zazu Designs v. L’Oreal, S.A.	57
Notes for Discussion	63
B. Analogous Use	68
Maryland Stadium Authority v. Becker	69
Notes for Discussion	74
C. Federal Registration and the Intent to Use Alternative	75
Warnervision Entertainment, Inc. v. Empire of Carolina, Inc.	78
Notes for Discussion	82
Chapter 3. The Geographic Scope of Trademark Rights	91
A. The Common Law Approach	91
United Drug Co. v. Theodore Rectanus Co.	91
Notes for Discussion	96
B. Federal Registration and Geographic Scope	98
Dawn Donut Co. v. Hart’s Food Stores, Inc.	98
Notes for Discussion	107
Burger King of Florida, Inc. v. Hoots	114
Notes for Discussion	118
C. International Use and Domestic Rights	122
1. Foreign Use and Rights Within the United States	122
Person’s Co., Ltd. v. Christman	122
Notes for Discussion	128
2. Parallel Imports	132
K Mart Corp. v. Cartier, Inc.	132
Notes for Discussion	137

	Lever Bros. Co. v. United States	141
	Notes for Discussion	145
Chapter 4. Prerequisites for Trademark Protection:		
	Distinctiveness	147
A.	Descriptive Marks and the Spectrum of Distinctiveness	148
	Zatarains, Inc. v. Oak Grove Smokehouse, Inc.	148
	Notes for Discussion	160
B.	Generic Words	169
	Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.	169
	Notes for Discussion	179
	Genesee Brewing Co. v. Stroh Brewing Co.	190
	Notes for Discussion	202
C.	Primary Merely a Surname	205
	Peaceable Planet, Inc. v. Ty, Inc.	205
	Notes for Discussion	213
D.	Deceptive Marks: Materially False Information	215
	In re Budge Mfg. Co., Inc.	215
E.	Primarily Geographically Deceptively Misdescriptive Marks	218
	In re California Innovations, Inc.	218
	Notes for Discussion	226
F.	Objectionable Marks	229
	Pro-Football, Inc. v. Blackhorse	230
	Notes for Discussion	246
G.	Federal Registration and Distinctiveness: Presumptions of Validity ...	249
	Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.	251
	Notes for Discussion	260
Chapter 5. The Protection of Trade Dress		
267		
A.	The Common Law's Protection of Trade Dress	269
	Kellogg Co. v. National Biscuit Co.	269
	Crescent Tool Co. v. Kilborn & Bishop Co.	274
	Notes for Discussion	276
B.	The Preemption of State Law Protection of Trade Dress	279
	Sears, Roebuck & Co. v. Stiffel Co.	280
	Compco Corp. v. Day-Brite Lighting, Inc.	283
	Notes for Discussion	286
C.	The Rise of Federal Trade Dress Claims	292
1.	Distinctiveness	295
	Two Pesos, Inc. v. Taco Cabana, Inc.	295
	Notes for Discussion	302
	Qualitex Co. v. Jacobson Prods. Co.	308
	Notes for Discussion	317
	Wal-Mart Stores, Inc. v. Samara Bros., Inc.	324
	Notes for Discussion	330
2.	Functionality and the Road to <i>TrafFix</i>	333

TraFFix Devices, Inc. v. Marketing Displays, Inc.	338
Notes for Discussion	345
Chapter 6. Trademark Ownership	355
A. Initial Ownership	355
Sengoku Works Ltd. v. RMC Int'l, Ltd.	355
Notes for Discussion	360
B. Owning Trademarks by Purchase: Assignments	362
Sugar Busters LLC v. Brennan	362
Notes for Discussion	374
C. Licensing of Trademarks and the Naked License Doctrine	380
Barcamerica Int'l USA Trust v. Tyfield Importers, Inc.	380
Notes for Discussion	386
D. Loss of Trademark Rights: Abandonment by Nonuse	388
Silverman v. CBS Inc.	388
Notes for Discussion	397
Chapter 7. Trademark Infringement	403
A. The Basic Standard: Likelihood of Confusion	403
Estee Lauder, Inc. v. Old Navy Clothing Co.	406
Notes for Discussion	412
B. Expanding the Reach of "Likelihood of Confusion"	421
1. Likelihood of Confusion and Promotional Goods	421
Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem	
Mfg., Inc.	422
Notes for Discussion	426
2. Protecting Prestige Goods: Post-Sale Confusion	434
Ferrari S.P.A. v. Roberts	434
Notes for Discussion	440
3. Initial Interest Confusion	442
Mobil Oil Corp. v. Pegasus Petroleum Corp.	442
Notes for Discussion	448
4. Reverse Confusion	449
A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.	449
Notes for Discussion	463
C. Parody: A Special Case?	463
Anheuser-Busch, Inc. v. L & L Wings, Inc.	463
Anheuser-Busch, Inc. v. Balducci Pubs.	474
Notes for Discussion	482
D. Secondary Liability	484
Hard Rock Café Licensing Corp. v. Concession Servs., Inc.	484
Notes for Discussion	491
Chapter 8. Dilution.....	495
A. State Approaches to Dilution	496
Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.	496
Notes for Discussion	509

B.	The Rise of Federal Dilution Claims	513
	Notes for Discussion	516
1.	Dilution: Concept and Policy	517
	Ty Inc. v. Perryman	517
	Notes for Discussion	522
2.	Dilution by Blurring	524
	Jada Toys, Inc. v. Mattel, Inc.	524
	Notes for Discussion	530
3.	Dilution by Tarnishment	535
	Deere & Company v. MTD Products, Inc.	535
	Notes for Discussion	542
4.	Trade Dress Dilution?	545
	I.P. Lund Trading ApS v. Kohler Co.	545
	Notes for Discussion	560
C.	Parody and Dilution	561
	Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC	561
	Notes for Discussion	574
	Chapter 9. Trademark Defenses	575
A.	Fair Use	575
	Canal Co. v. Clark	575
	KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.	578
	Notes for Discussion	584
B.	Descriptive Use and Nominative Fair Use	588
	Champion Spark Plug Co. v. Sanders	588
	Notes for Discussion	590
	Smith v. Chanel, Inc.	592
	Notes for Discussion	596
	The New Kids on the Block v. News America Publishing, Inc.	598
	Notes for Discussion	604
C.	Laches, Estoppel, and Acquiescence	608
	Conan Properties, Inc. v. Conans Pizza, Inc.	608
	Kellogg Co. v. Exxon Corp.	618
	Notes for Discussion	628
D.	The First Amendment	631
	Mattel, Inc. v. MCA Records, Inc.	631
	Notes for Discussion	643
	Chapter 10. Trademarks on the Internet.....	647
A.	Trademark Rights on the Internet.....	648
	Brookfield Comms. v. West Coast Enter. Corp.	648
	Interstellar Starship Services, Ltd. v. Epix, Inc.	676
	Notes for Discussion	685
B.	Cyber-Griping	692
	Bosley Medical Institute, Inc. v. Kremer	693
	Lucas Nursery & Landscaping, Inc. v. Grosse	703
	Notes for Discussion	707

C.	The Use of Trademarks in Search Engines	710
	1-800 Contacts, Inc. v. Lens.com, Inc.	714
	Notes for Discussion	731
	Chapter 11. Remedies	737
A.	Injunctive Relief: Preliminary and Permanent	737
	Herb Reed Enters., LLC v. Florida Entertainment Management	739
	Notes for Discussion	747
B.	Monetary Damages and Attorneys' Fees	750
	Maltina Corporation v. Cawy Bottling Co.	751
	Texas Pig Stands, Inc. v. Hard Rock Café International, Inc.	756
	Notes for Discussion	763
C.	The Special Case of Reverse Confusion	770
	Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.	770
	Sands, Taylor & Wood Co. v. Quaker Oats Co.	778
	Notes for Discussion	790
D.	Counterfeit Goods.....	792
	United States v. Torkington	792
	Notes for Discussion	799
	Chapter 12. False and Misleading Advertising	801
A.	"False or Misleading"	801
	American Home Products Corp. v. Johnson & Johnson	801
	United Industries Corp. v. The Clorox Co.	812
	Notes for Discussion	820
B.	Materiality and Puffery	830
	Pizza Hut, Inc. v. Papa John's International, Inc.	830
	Notes for Discussion	845
	Chapter 13. The Right of Publicity	849
A.	Origins and Justifications.....	849
	Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.	850
	Cardtoons, L.C. v. Major League Baseball Players Ass'n.....	852
	Notes for Discussion	869
B.	Expansion	872
	Midler v. Ford Motor Co.	872
	White v. Samsung Electronics America, Inc.	876
	White v. Samsung Electronics America, Inc.	883
	Notes for Discussion	887
C.	Limits	889
	ETW Corp. v. Jireh Publishing, Inc.	889
	C.B.C. Distribution and Mktg., Inc. v. Major League Baseball Advanced Media, L.P.....	900
	Notes for Discussion	905
	INDEX.....	913