

Trademarks and Unfair Competition Syllabus

Spring 2021

Tuesday and Thursday 11am-12:15pm

Location/delivery: online via Zoom

Law 634-3 Section § 001

Professor Lorelei Ritchie

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Casebook: This course will use a free, online casebook, Trademark Law, An Open-Source Casebook, Version 7 (2020) (the “Beebe Casebook”). You can access the Beebe Casebook online at tmcasebook.org. Online access is free of charge. If you prefer a print version, you can order from Amazon at cost (there is a direct link from the website, tmcasebook.org). If you choose the print option, please buy both Volumes I and Volume II (we will include both in our course readings). I bought the print copies from Amazon (about \$25 total) because I like to refer to a print copy. But you can choose what works best for you. Just keep in mind that you may need to sometimes refer to your book during (online Zoom) class.

Course Description and Learning Expectations: Trademarks (especially brands and slogans) are enormously important to the United States economy. Consumers must constantly consider and differentiate between brands, and competitors must constantly be aware of their rights to use, or to avoid using, particular marks, either because someone else has rights in a similar mark or because the “mark” is actually generic, descriptive, functional, or otherwise undesirable or unenforceable, which could cost a company many millions of dollars in lost revenue.

This course covers concepts in Trademarks and Unfair Competition. The course will discuss Trademarks as a subset of Unfair Competition law, particularly at the federal level. We will discuss the basis and extent of Trademark law, including Constitutional background and statutory language; Requirements for establishing rights in a mark; the registration process; use requirements; infringement; fair use; and other issues involving ownership.

It is expected that we will have some guest lecturers from government and private practice, which will help expand students’ understanding, as well as give students more opportunity to ask questions about Trademark law and practice. By the end of the course, it is expected that you will have a solid

comfort level with the concepts of Trademark and Unfair Competition, and an understanding of how to apply relevant concepts in practice.

Attendance Policy: Under the Rules of the School of Law, students may not accumulate absences in a course numbering in excess of twice the credit hours for the course during the semester. The Rules provide for three options if a student accumulates absences in excess of the allowable number. The professor may recommend that: (a) the student be given the lowest possible grade; (b) the student be given a “W”; or (c) the student be allowed to continue in the course with a grade reduction. The Zoom information will be posted on TWEN before the first week of class.

Recording of Classes: The professor may record classes via audio or video (including for increased availability due to COVID-19 restrictions). Classes may also be recorded for ADA compliance purposes. No recordings should be used or disseminated without the professor’s permission.

Exams & Grading: There is no midterm for this course. There will be an open-book, essay-style final exam. Your course grade will be based on the final exam, with 25% of each student’s grade based on quality of participation in class, including in-class discussion and in-class group projects.

Writing Assignments: Class sessions will often include group projects, which are intended to be fun opportunities to collaborate with “colleagues” on various trademark projects. These will include some in-class writing assignments. There will not be any writing assignments required outside of class time.

Emergency Procedures: We ask that you become familiar with **Emergency Preparedness @ SIU**. Emergency response information is available on posters in buildings on campus, on the Emergency Preparedness @ SIU website, and through text and email alerts. To register for alerts, visit: <http://emergency.siu.edu/>.

Disability Policy: SIU Carbondale is committed to providing an inclusive and accessible experience for all students with disabilities. Disability Support Services coordinates the implementation of accommodations. If you think you may be eligible for accommodations but have not yet obtained approval please contact DSS immediately at 618-453-5738 or disabilityservices.siu.edu. You may request accommodations at any time, but timely requests help to insure accommodations are in place when needed. Accommodations and services are determined through an interactive process with students and may involve consideration of specific course design and learning objectives in consultation with faculty. Upon completion of a Disability Accommodation Agreement with DSS, students should bring the

agreements for each course to the School of Law Registrar's Office to ensure the School of Law provides the proper classroom and examination accommodations. Accommodation [request](#) and [renewal](#) forms can be found here: <https://law.siu.edu/academics/>.

Saluki Cares: The purpose of Saluki Cares is to develop, facilitate and coordinate a university-wide program of care and support for students in any type of distress—physical, emotional, financial, or personal. By working closely with faculty, staff, students and their families, SIU will continue to display a culture of care and demonstrate to our students and their families that they are an important part of the community. For Information on Saluki Cares: (618) 453-2461, or siucares@siu.edu, <http://salukicare.siu.edu/index.html>. At the School of Law, Assistant Dean Judi Ray is also available to help students access university resources. Her email is judiray@siu.edu, and her phone number is 618- 453-3135.

COVID-19: As a condition of on-campus enrollment, all SIUC students are required to engage in safe behaviors to avoid the spread of COVID-19, including the requirement that all students wear a mask in campus buildings, including classrooms, laboratories, and studios when others are present, regardless of social distancing. Students are expected to follow physical or social distancing guidelines by keeping at least 6 feet from others, and practicing good hand hygiene. Failure to comply with this policy may result in dismissal from the current class session. If the student refuses to leave the classroom after being dismissed, the student may be referred to the Office of Student Rights and Responsibilities. SIUC will follow federal, state and county public health recommendations and mandates in all decisions relating to university operation. Students should regularly review the link for the [SIUC COVID-19 response](#).

Workload Expectation: The American Bar Association standards for accrediting law schools contain a formula for calculating the amount of work that constitutes one credit hour. According to ABA Standard 310(b)(1), a “credit hour” is an amount of work that reasonably approximates: (1) not less than one hour of classroom or direct faculty instruction and two hours of out-of-class student work per week for fifteen weeks, or the equivalent amount of work over a different amount of time. This is a 3-credit hour class, meaning that we will spend two 75-minute blocks of time together each week (scheduled for Tuesday and Thursday). The amount of assigned reading and out of class preparation should take you about 6 hours for the week. All told, applying the ABA standard to the number of credits offered for this class, you should plan on spending a total of 9 hours per week (3 in class and 6 preparing for class) on course-related work.

Trademarks and Unfair Competition – Spring 2021 Assigned Reading

Except as otherwise noted, all references are to the Beebe Casebook.

This reading list is preliminary (the reason for some classes having multiple page segments is that I am trying to maximize information without overloading you on reading). Assignments after the first week are subject to change based on our class discussions. Each week, I will confirm the following week's reading assignment at the end of class, and by posting on TWEN.

Please complete assigned reading in advance of each class so that you are prepared to participate in, and benefit from, the discussion in class (So, by way of example, please complete the reading assignment listed for Week 1/Class 1 before the first day of class, January 19, 2021).

Week 1/Class 1: Introduction to Trademark Law, Beebe, pp11-30

Week 1/Class 2: Distinctiveness spectrum and inherent distinctiveness, Beebe pp31-51

Week 2/Class 1: Acquired Distinctiveness and Genericness, Beebe, pp51-53, 61-96 (skipping 53-61; and can skim dissent in Booking.com pp71-76)

Week 2/Class 2: Distinctiveness Analysis of Nonverbal Marks, Beebe pp 96-97, 107-127, 127-128, 131-138, 142 (skipping Two Pesos))

Week 3/Class 1: Utilitarian functionality, Beebe, pp143-160

Week 3/Class 2: Aesthetic functionality; deceptive and false suggestion of connection; pp181-189 top; 192-198

Week 4/Class 1: Disparaging and Scandalous Marks, Beebe, pp199-226

Week 4/Class 2: Use as Prerequisite for Rights, pp227-247

Week 5/Class 1: The Registration Process class 1; Beebe, pp247-269 (not Park N Fly)

Week 5/Class 2: Reading TBD [possible guest lecturer – TBD]

Week 6/Class 1: Geographic Extent of TM Rights, Beebe, pp277-296
(although we will discuss concurrent use in Week 6/2)
Week 6/Class 2: Continued, Beebe, pp296-301 (top) (can skip Gigante; we will
discuss as example in class); pp309-319 (middle; we will discuss rest of
Punchgini in class); Belmora, 325-336.

Week 7/Class 1: Actionable Use and LOC, Beebe, pp337-339 top; 348-352
bottom; 358-376 (skipping Rescuecom, Borden's)
Week 7/Class 2: Survey Evidence and Sponsorship Confusion; pp376-394
[possible guest lecturer – TBD]

Week 8/Class 1: Initial interest and Post-sale confusion, Beebe, pp406-425
Week 8/Class 2: Reverse confusion and Reverse Passing Off, Beebe pp425-448

Week 9/Class 1: Dilution by Blurring class 1; Beebe, pp450-478
Week 9/ Class 2: Dilution by Tarnishment, BB pp479-488

Week 10/Class 1 – Cybersquatting/UDRP, Beebe pp488-505
Week 10/Class 2 – Secondary liability, Beebe pp514-525; 534-538

Further assignments – TBA on TWEN.