

# CASES AND MATERIALS ON TRADEMARK LAW

■ ■ ■

By

**Glynn Lunney**

*McGlinchey Stafford Professor of Law*

*Tulane University School of Law*

**AMERICAN CASEBOOK SERIES®**

**WEST®**

A Thomson Reuters business

# TABLE OF CONTENTS

---

	Page
TABLE OF CASES .....	xiii
<b>Chapter 1. Introduction</b> .....	<b>1</b>
A. Competition: Fair and Unfair .....	1
<i>International News Service v. The Associated Press</i> .....	1
<i>Notes for Discussion</i> .....	12
<i>Dastar Corp. v. Twentieth Century Fox</i> .....	17
<i>Notes for Discussion</i> .....	25
B. The Constitutional Basis of Federal Trademark Protection .....	32
<i>The Trade-Mark Cases</i> .....	33
<i>Notes for Discussion</i> .....	38
C. Perspectives on Trademark Policy .....	40
<i>Notes for Discussion</i> .....	45
<b>Chapter 2. Prerequisites for Trademark Protection: Use</b> .....	<b>46</b>
A. The Traditional Use Requirement .....	46
<i>Blue Bell, Inc. v. Farah Mfg. Co.</i> .....	46
<i>Zazu Designs v. L'Oreal, S.A.</i> .....	52
<i>Notes for Discussion</i> .....	57
B. Analogous Use .....	62
<i>Maryland Stadium Authority v. Becker</i> .....	62
<i>Notes for Discussion</i> .....	67
C. Federal Registration and the Intent to Use Alternative .....	68
<i>Warnervision Entertainment, Inc. v. Empire of Carolina, Inc.</i> .....	71
<i>Notes for Discussion</i> .....	75
<b>Chapter 3. The Geographic Scope of Trademark Rights</b> .....	<b>83</b>
A. The Common Law Approach .....	83
<i>United Drug Co. v. Theodore Rectanus Co.</i> .....	83
<i>Notes for Discussion</i> .....	88
B. Federal Registration and Geographic Scope .....	90
<i>Dawn Donut Co. v. Hart's Food Stores, Inc.</i> .....	90
<i>Notes for Discussion</i> .....	98
<i>Burger King of Florida, Inc. v. Hoots</i> .....	105
<i>Notes for Discussion</i> .....	108
C. International Use and Domestic Rights .....	112
1. Foreign Use and Rights Within the United States .....	112
<i>Person's Co., Ltd. v. Christman</i> .....	112
<i>Notes for Discussion</i> .....	118
2. Parallel Imports .....	122
<i>K Mart Corp. v. Cartier, Inc.</i> .....	122
<i>Notes for Discussion</i> .....	126
<i>Lever Bros. Co. v. United States</i> .....	129
<i>Notes for Discussion</i> .....	133

	Page
<b>Chapter 4. Prerequisites for Trademark Protection: Distinctiveness</b> .....	<b>136</b>
A. Descriptive Marks and the Spectrum of Distinctiveness.....	137
<i>Zatarains, Inc. v. Oak Grove Smokehouse, Inc.</i> .....	137
<i>Notes for Discussion</i> .....	148
B. Generic Words.....	156
<i>Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.</i> .....	156
<i>Notes for Discussion</i> .....	165
<i>Genesee Brewing Co. v. Stroh Brewing Co.</i> .....	175
<i>Notes for Discussion</i> .....	188
C. Primary Merely a Surname.....	190
<i>Peaceable Planet, Inc. v. Ty, Inc.</i> .....	190
<i>Notes for Discussion</i> .....	197
D. Deceptive Marks: Materially False Information.....	199
<i>In re Budge Mfg. Co., Inc.</i> .....	199
E. Primarily Geographically Deceptively Misdescriptive Marks.....	202
<i>In re California Innovations, Inc.</i> .....	202
<i>Notes for Discussion</i> .....	209
F. Objectionable Marks.....	212
<i>Pro-Football, Inc. v. Harjo</i> .....	213
<i>Notes for Discussion</i> .....	231
G. Federal Registration and Distinctiveness: Presumptions of Validity ...	234
<i>Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.</i> .....	236
<i>Notes for Discussion</i> .....	244
<b>Chapter 5. The Protection of "Trade Dress"</b> .....	<b>250</b>
A. The Common Law's Protection of "Trade Dress".....	252
<i>Kellogg Co. v. National Biscuit Co.</i> .....	252
<i>Crescent Tool Co. v. Kilborn &amp; Bishop Co.</i> .....	257
<i>Notes for Discussion</i> .....	258
B. The Preemption of State Law Protection of Trade Dress.....	261
<i>Sears, Roebuck &amp; Co. v. Stiffel Co.</i> .....	262
<i>Compco Corp. v. Day-Brite Lighting, Inc.</i> .....	265
<i>Notes for Discussion</i> .....	268
C. The Rise of Federal Trade Dress Claims.....	274
1. Distinctiveness.....	276
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> .....	276
<i>Notes for Discussion</i> .....	283
<i>Qualitex Co. v. Jacobson Prods. Co.</i> .....	288
<i>Notes for Discussion</i> .....	297
<i>Wal-Mart Stores, Inc. v. Samara Bros.</i> .....	303
<i>Notes for Discussion</i> .....	309
2. Functionality and the Road to <i>TraFFix</i> .....	312
<i>TraFFix Devices, Inc. v. Marketing Displays</i> .....	316
<i>Notes for Discussion</i> .....	322
<b>Chapter 6. Trademark Ownership</b> .....	<b>330</b>
A. Initial Ownership.....	330
<i>Sengoku Works Ltd. v. RMC Int'l, Ltd.</i> .....	330
<i>Notes for Discussion</i> .....	334

	<b>Page</b>
B. Owning Trademarks by Purchase: Assignments .....	336
<i>Sugar Busters LLC v. Brennan</i> .....	336
<i>Notes for Discussion</i> .....	347
C. Licensing of Trademarks and the Naked License Doctrine .....	353
<i>Barcamerica Int'l USA Trust v. Tyfield Importers, Inc.</i> .....	353
<i>Notes for Discussion</i> .....	359
D. Loss of Trademark Rights: Abandonment by Nonuse .....	360
<i>Silverman v. CBS Inc.</i> .....	360
<i>Notes for Discussion</i> .....	369
<b>Chapter 7. Trademark Infringement</b> .....	<b>374</b>
A. The Basic Standard: Likelihood of Confusion .....	374
<i>Estee Lauder, Inc. v. Old Navy Clothing Co.</i> .....	377
<i>Notes for Discussion</i> .....	383
B. Expanding the Reach of "Likelihood of Confusion" .....	390
1. Likelihood of Confusion and Promotional Goods .....	390
<i>Boston Prof'l Hockey v. Dallas Cap &amp; Emblem Mfg., Inc.</i> .....	391
<i>Notes for Discussion</i> .....	395
2. Protecting Prestige Goods: Post-Sale Confusion .....	402
<i>Ferrari S.P.A. v. Roberts</i> .....	402
<i>Notes for Discussion</i> .....	407
3. Initial Interest Confusion .....	409
<i>Mobil Oil Corp. v. Pegasus Petroleum Corp.</i> .....	409
<i>Notes for Discussion</i> .....	415
4. Reverse Confusion .....	416
<i>A &amp; H Sportswear, Inc. v. Victoria's Secret Stores, Inc.</i> .....	416
<i>Notes for Discussion</i> .....	431
C. Parody: A Special Case? .....	431
<i>Anheuser Busch, Inc. v. L &amp; L Wings, Inc.</i> .....	431
<i>Anheuser-Busch, Inc. v. Balducci Pubs.</i> .....	441
<i>Notes for Discussion</i> .....	449
D. Secondary Liability .....	450
<i>Hard Rock Café Licensing Corp. v. Concession Servs., Inc.</i> .....	450
<i>Notes for Discussion</i> .....	457
<b>Chapter 8. Dilution</b> .....	<b>461</b>
A. State Approaches to Dilution .....	462
<i>Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.</i> .....	462
<i>Notes for Discussion</i> .....	474
B. The Rise of Federal Dilution Claims .....	478
<i>Notes for Discussion</i> .....	481
1. Dilution: Concept and Policy .....	482
<i>Ty Inc. v. Perryman</i> .....	482
<i>Notes for Discussion</i> .....	487
2. Dilution by Blurring .....	488
<i>Jada Toys, Inc. v. Mattel, Inc.</i> .....	488
<i>Notes for Discussion</i> .....	494
3. Dilution by Tarnishment .....	498
<i>Deere &amp; Company v. MTD Products, Inc.</i> .....	498
<i>Notes for Discussion</i> .....	505

	Page
4. Trade Dress Dilution? .....	507
<i>I.P. Lund Trading ApS v. Kohler Co.</i> .....	507
<i>Notes for Discussion</i> .....	521
C. Parody and Dilution .....	523
<i>Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC</i> .....	523
<i>Notes for Discussion</i> .....	534
<b>Chapter 9. Trademark Defenses</b> .....	<b>536</b>
A. Fair Use .....	536
<i>Canal Co. v. Clark</i> .....	536
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> .....	539
<i>Notes for Discussion</i> .....	545
B. Descriptive Use and Nominative Fair Use .....	548
<i>Champion Spark Plug Co. v. Sanders</i> .....	548
<i>Notes for Discussion</i> .....	550
<i>Smith v. Chanel, Inc.</i> .....	552
<i>Notes for Discussion</i> .....	556
<i>The New Kids on the Block v. News America Publishing, Inc.</i> .....	558
<i>Notes for Discussion</i> .....	564
C. Laches, Estoppel, and Acquiescence .....	567
<i>Conan Properties, Inc. v. Conans Pizza, Inc.</i> .....	567
<i>Kellogg Co. v. Exxon Corp.</i> .....	576
<i>Notes for Discussion</i> .....	586
D. The First Amendment .....	589
<i>Mattel, Inc. v. MCA Records, Inc.</i> .....	589
<i>Notes for Discussion</i> .....	599
<b>Chapter 10. Trademarks on the Internet</b> .....	<b>603</b>
A. Trademark Rights on the Internet .....	604
<i>Brookfield Comms. v. West Coast Enter. Corp.</i> .....	604
<i>Interstellar Starship Services, Ltd. v. Epix, Inc.</i> .....	630
<i>Notes for Discussion</i> .....	639
B. Cyber-Gripping .....	645
<i>Bosley Medical Institute, Inc. v. Kremer</i> .....	646
<i>Lucas Nursery &amp; Landscaping, Inc. v. Grosse</i> .....	655
<i>Notes for Discussion</i> .....	660
C. The Use of Trademarks in Search Engines .....	662
1. Likelihood of Confusion .....	662
<i>Playboy Enters. Inc. v. Netscape Comms. Corp.</i> .....	662
<i>Notes for Discussion</i> .....	672
2. Trademark Use .....	674
<i>Rescuecom Corp. v. Google Inc.</i> .....	677
<i>Notes for Discussion</i> .....	684
<b>Chapter 11. Remedies</b> .....	<b>687</b>
A. Injunctive Relief: Preliminary and Permanent .....	687
<i>North American Medical Corp. v. Axiom Worldwide, Inc.</i> .....	689
<i>Notes for Discussion</i> .....	693
B. Monetary Damages and Attorneys' Fees .....	696
<i>Maltina Corporation v. Cawby Bottling Co.</i> .....	697
<i>Texas Pig Stands, Inc. v. Hard Rock Café International, Inc.</i> .....	701
<i>Notes for Discussion</i> .....	709
C. The Special Case of Reverse Confusion .....	714
<i>Big O Tire Dealers, Inc. v. Goodyear Tire &amp; Rubber Co.</i> .....	714
<i>Sands, Taylor &amp; Wood Co. v. Quaker Oats Co.</i> .....	722
<i>Notes for Discussion</i> .....	733

	Page
D. Counterfeit Goods .....	735
<i>United States of America v. Torkington</i> .....	735
<i>Notes for Discussion</i> .....	741
<b>Chapter 12. False and Misleading Advertising</b> .....	<b>743</b>
A. "False or Misleading" .....	743
<i>American Home Products Corp. v. Johnson &amp; Johnson</i> .....	743
<i>United Industries Corp. v. The Clorox Co.</i> .....	753
<i>Notes for Discussion</i> .....	761
B. Materiality and Puffery .....	768
<i>Pizza Hut, Inc. v. Papa John's International, Inc.</i> .....	768
<i>Notes for Discussion</i> .....	782
<b>Chapter 13. The Right of Publicity</b> .....	<b>785</b>
A. Origins and Justifications .....	785
<i>Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.</i> .....	786
<i>Cardtoons, L.C. v. Major League Baseball Players Ass'n</i> .....	788
<i>Notes for Discussion</i> .....	804
B. Expansion .....	807
<i>Midler v. Ford Motor Co.</i> .....	807
<i>White v. Samsung Electronics America, Inc.</i> .....	810
<i>White v. Samsung Electronics America, Inc.</i> .....	817
<i>Notes for Discussion</i> .....	821
C. Limits .....	822
<i>ETW Corp. v. Jireh Publishing, Inc.</i> .....	822
<i>C.B.C. Distribution &amp; Mktg., Inc. v. Major League Baseball Advanced Media, L.P.</i> .....	833
<i>Notes for Discussion</i> .....	838
INDEX .....	845