Course Overview

This course will provide an introduction to the principles, doctrines, and policies of U.S. trademark law, which confers rights in a symbol that identifies the source of a good or service, and related areas of unfair competition. We will consider which kinds of symbols can be protected as trademarks, the standards a symbol must meet to qualify as a trademark, how rights in marks are acquired (and transferred) and how such rights can be lost, and the procedures for and benefits of federal registration of marks. The course will also examine what constitutes infringement or dilution of a trademark, as well as defenses to and remedies for infringement or dilution. Some attention will be given to trademark issues involving Internet domain names. If time allows, we will also study the right of publicity. There are no prerequisites for this course, and no science or engineering background, aptitude, or interest is required for this course. Students who have completed Survey of Copyright, Patent, and Trademark Law must have the permission of the instructor to enroll, and the course is mutually exclusive with Comparative Trademarks (L12.3002.001).

Readings & Materials


Supplementary readings will be distributed as necessary. Assignment sheets will be distributed throughout the semester. I will occasionally distribute handouts in class.
Office Hours and Contact Information

Unless otherwise announced, office hours will be held in my office, Vanderbilt Hall 423, on Tuesdays from 3:30 to 4:30 p.m. If you wish to speak with me but cannot do so during scheduled office hours, I will be glad to arrange another mutually convenient time. See me in class, or call or e-mail, to arrange a time. I may be reached by e-mail at either r.reese@nyu.edu or treese@law.utexas.edu and by phone at 212/998-6454.

I am also generally in my office during the week and happy to speak with you if I am not otherwise occupied, so feel free to stop by.

Grading

The course will be graded by a three-hour in-class final exam. The precise format of the exam will be determined and announced later in the semester, but a multiple-choice component will be included. I will take classroom performance into account in determining final grades.

Web Site, E-mail Announcements, Wireless Use

A Web site for the class is available through Blackboard. The syllabus and assignment sheets will be posted on that site.

I will occasionally send e-mail announcements to the class. For this purpose, I will use the e-mail address that you have provided on Blackboard. Please make sure that this address is up-to-date so that you receive class-related e-mail.

During class, you may not use wireless connections for e-mail or instant messaging (or analogous services), and you may only use the Internet for class-related purposes.

BNA’s Patent, Trademark & Copyright Journal

The BNA weekly publication, Patent, Trademark & Copyright Journal (PTCJ) provides extensive coverage of current developments in intellectual property law in the U.S. and is relied on by many who practice in the field to keep up with those developments. The law school has subscriber access to the online version of this journal. Find “BNA Online Services” on the Law Library’s Indexes and Databases page at http://www.law.nyu.edu/library/database.html, and then select “Patent Trademark and Copyright Journal” under the “Intellectual Property” heading. (For detailed information about access, consult with one of the law school’s reference librarians.) I encourage you to look at PTCJ if you want to learn more about current issues in the area.
Tentative Outline of Topics

The following outline of topics to be covered in the course is tentative and subject to revision as the semester progresses:

1. **INTRODUCTION**
2. **SUBJECT MATTER & STANDARDS**
   - Subject Matter
     - The Spectrum of Distinctiveness
     - Distinctiveness: Inherent & Acquired ("Secondary Meaning")
   - Generic Terms
   - Trade Dress
   - Functionality
3. **ACQUIRING (& LOSING) RIGHTS: USE**
   - Actual Use
   - Constructive Use
   - Non-Use and Uncontrolled Use
4. **REGISTRATION**
   - Registration Overview
   - Immoral, Scandalous, and Disparaging Marks
   - Deceptive Marks
   - Geographic Marks
   - Name Marks
   - Incontestability
5. **GEOGRAPHIC SCOPE AND LIMITS**
   - Geographic Limits on Common Law Rights & Registration
   - National Territoriality of Rights
   - Extraterritorial Enforcement of U.S. Trademark Rights
6. **RIGHTS & INFRINGEMENT: CONFUSION**
   - Evolution of the Confusion Standard
   - Unauthorized Use
   - Likelihood of Confusion
   - Confusion Away From the Point of Sale
   - Reverse Confusion
7. **RIGHTS: NON-CONFUSION-BASED LIABILITY**
   - Dilution
   - Domain Names and "Cybersquatting"
8. **PERMISSIBLE USES OF ANOTHER’S TRADEMARK**
   - Fair Use
   - Exhaustion: The First-Sale Doctrine
   - Parody and Speech
9. **ENDORSEMENT & RIGHT OF PUBLICITY**
   - False Endorsement
   - Right of Publicity
Further Resources

No outside reading is required for the class, but should you wish to pursue a question in more depth, a guide to selected further resources is provided here:

Treatises

Statutory Provisions and Regulations
- The text of the current provisions of the relevant portions of Title 15 of the U.S. Code (§§ 1051-1127, the Lanham Act, as amended) is contained in the supplement.
- For selected legislative history, see *McCarthy*, vol. 6, Apps. A5 and A6.
- The Restatement (Third) of Unfair Competition is available in the library.

Selected Online Resources
- Lexis has a Trademarks, Unfair Competition & Trade Secrets section that you can find by going to Area of Law—By Topic in the Sources portion of the Main Menu.
- In Westlaw, you can find trademark information in the Main Database Directory by looking under Topical Materials by Area of Practice, Intellectual Property, Trademarks and Trade Names.