

# TRADEMARK AND UNFAIR COMPETITION

Syllabus - Spring 2023

Professor [Aman Gebru](#)

Office: 341S

Email: [akgebru@Central.uh.edu](mailto:akgebru@Central.uh.edu)

Phone: 713-743-1852

Office Hours: Mondays 4:00 – 5:00 PM or by appointment

## Course Information:

- Course Number/Section Number: 5317/23964
- Meeting times: Monday and Wednesday 2:30 – 4:00 PM
- Classroom: TBD
- Casebook: Barton Beebe, Trademark Law: An Open-Source Casebook, Version 9 (2022)
  - The casebook is available in PDF and Word version free-of-charge in an open-access basis at [tmcasbook.org](http://tmcasbook.org). For students preferring to get printed copies, the website has links to print versions for affordable prices through Amazon.com.
  - Professor Beebe is on the faculty at NYU School of Law who self-published this open-source casebook is to show that creative expression is possible without the need for financial compensation, a theme that is at the heart of scholarly debate in the intellectual property law field. The result is a free or low-cost casebook for students.

## COURSE DESCRIPTION AND LEARNING OBJECTIVES

This is a one-semester, three-credit course which will introduce you to the laws and policies governing the creation, use, and licensing of trademarks. Additionally, it will deal with related issues of unfair competition such as commercial disparagement/defamation, right of publicity, and false advertising. While the course is focused entirely on U.S. law, it will at times contrast the predominantly use-based trademark system in the U.S. with registration-based systems in other countries. It examines ways in which an organization can develop, register, and assert trademark rights, as well as methods for enforcing those rights focused predominantly on the trademark infringement and dilution actions. By the end of the semester, you should be able to do the following:

- Understand the case law and statutory law that governs trademarks in the U.S.
- Apply the policy rationales of U.S. trademark law to various real and hypothetical facts
- Search the United States Patent and Trademark Office database for registered trademarks
- Explain the connection between trademarks, unfair competition, right of publicity, and false advertising

## ATTENDANCE AND CLASS PARTICIPATION

Attendance: The Law Center Student Handbook reads in part: “The Law Center has a minimum 80% attendance policy for students. Any student who attends fewer than the minimum percentage of classes may be dropped automatically from the class. Faculty members are free to impose stricter attendance standards. Faculty members may consider those who come in late or leave early as absent, or may decline to let a late student attend that day.” Absences in violation of law center policy may be sanctioned by a reduction in the final grade or, in egregious cases, by involuntary withdrawal from the class.

You must come to class unless you have a legitimate reason for not doing so. Illness and family emergencies are legitimate reasons. Out of consideration for your colleagues, do not come to class if you are ill. If you miss class due to illness or for any other reason, please get notes from your colleagues. If someone asks you for notes for a missed day of class, please share with them the notes for that day. You may also discuss what you missed with me, but please do so as soon as possible to ensure that you can catch up with the rest of the class.

Participation: I expect students to have read and done their best to understand the materials for each class. I will call on students to brief cases or comment on a particular topic. For each case we discuss in class, please be prepared to address:

- The facts
- Issues presented
- The court’s conclusion
- The court’s reasoning
- Best arguments both sides did or could make
- Any policy rationales that may impact the outcome of the case

If you are unprepared for a given class, please email me by 12:00 PM on the day of the class to let me know. Each student can take up to two free passes during the semester which will not affect assessment of the student’s performance in the course.

## EXAMS AND GRADING

Your final grade will be based primarily on an in-class final examination given at the end of the semester. This exam will be open-book and open-note, which means you can have access to the casebook, your personal notes, or notes prepared with a study group, and the internet. However, you are not allowed to bring commercial outlines.

I will give ungraded practice problems throughout the course. Use these problems to help you examine your understanding of the relevant topics and to help you prepare for the final exam.

I reserve the right to consider your performance in class attendance and practice problems when calculating your final grade.

## GENERAL TOPICS

The class will meet for 1.5 hours twice a week in which we will cover the tentative list of topics provided below. Additional reading assignments may be available in a separate document or posted on the Learning Management System (Blackboard). Based on availability of speakers, we may also have guest speakers for some of the topics.

Class 1: Introduction to Trademark Law, Reading: pages 11–31

Class 2: Trademark Distinctiveness, the Abercrombie Spectrum, and Inherent Distinctiveness, Reading: pages 32–52

Class 3: Acquired Distinctiveness and Genericism, Reading: pages 52–58, 63–95, 102–107 (skipping Elliott v. Google and section I.A.1.d Failure to Function as a Mark)

Class 4: Distinctiveness Analysis of Nonverbal Marks, Reading: pages 115, 126–146, 149–161 (skipping Two Pesos and Fun-Damental)

Class 5: Utilitarian Functionality, Reading: pages 162–164, 172–183, 190–192 (skipping Morton-Norwich and Apple v. Samsung)

Class 6: Aesthetic Functionality, Deceptive Marks, and False Suggestion of a Connection, Reading: pages 192–218

Class 7: Disparaging and Scandalous Marks, Reading: pages 219–239

Class 8: Use as Prerequisite for Rights, Reading: pages 239–258

Class 9: The Registration Process, Reading: pages 258–281 (skipping Park ‘N Fly)

Class 10: The Geographic Extent of Trademark Rights, Reading: pages 289–323 (skipping Punchgini and Belmora)

Class 11: The Actionable Use Requirement and the Contemporary LOC Test, Reading: pages 351–353, 362–367, 374–387 (skipping Rescuecom, Borden’s Ice Cream, and Polaroid)

Class 12: Survey Evidence and Sponsorship Confusion, Reading: pages 391–422

Class 13: Initial Interest and Post-Sale Confusion, Reading: pages 422–444

Class 14: Reverse Confusion and Reverse Passing Off, Reading: pages 444–472

Class 15: Trademark Dilution by Blurring, Reading: pages 474–491 (skipping Wolfe’s Borough Coffee)

Class 16: Trademark Dilution by Tarnishment, Reading: pages 503–513 (NB: short reading assignment; perhaps a class for review, exercises)

Class 17: Cybersquatting, Reading: pages 513–535 (skipping the URSS)

Class 18: Secondary Liability, Reading: pages 539–550, 559–563 (skipping Gucci v. Frontline)

Class 19: Descriptive Fair Use (classes 19 and 20 can be combined in a pinch), Reading: pages 564–586

Class 20: Nominative Fair Use, Reading: pages 586–604

Class 21: Expressive Use of Trademarks, Reading: pages 605–644 (NB: long reading assignment, but worth it)

Class 22: Abandonment, Assignment in Gross, and the First Sale Doctrine, Reading: pages 644–681 (note that if ITC v. Punchgini is not assigned above, students should be warned that they should rely on the summary of the facts provided on page 633)

Class 23: False Advertising, Reading: pages 682–702 (skipping Pizza Hut, Inc. v. Papa John’s Intern., Inc.)

Class 24: False Advertising and Substantiation, Reading: pages 715–737

Class 25: Endorsements and Social Media, Reading: pages 738–767

Class 26: Right of Publicity, Reading: pages 768–779, 789–809 (skipping Kozinski’s dissent in White v. Samsung)

Class 27: Remedies, Reading: pages 810–821

#### UNIVERSITY OF HOUSTON REQUIRED AND RECOMMENDED SYLLABUS LANGUAGE

##### COVID-19 Information

If you are experiencing any COVID-19 symptoms that are not clearly related to a pre-existing medical condition, do not come to class. Please see [Student Protocols](#) for what to do if you experience symptoms and [Potential Exposure to Coronavirus](#) for what to do if you have potentially been exposed to COVID-19.

Students are encouraged to visit the University’s [COVID-19](#) website for important information including diagnosis and symptom protocols, on-campus testing, and vaccine information. Please check the website throughout the semester for updates.

##### Vaccinations

Data suggests that vaccination remains the best intervention for reliable protection against COVID-19. Students are asked to familiarize themselves with pertinent [vaccine information](#) and to consult with their health care provider. The University strongly encourages all students, faculty and staff to be vaccinated.

### Reasonable Academic Adjustments/Auxiliary Aids

The University of Houston complies with Section 504 of the Rehabilitation Act of 1973 and the Americans with Disabilities Act of 1990, pertaining to the provision of reasonable academic adjustments/auxiliary aids for disabled students. In accordance with Section 504 and ADA guidelines, UH strives to provide reasonable academic adjustments/auxiliary aids to students who request and require them. If you believe that you have a disability requiring an academic adjustments/auxiliary aid, please contact [the Justin Dart Jr. Student Accessibility Center](#) (formerly the Justin Dart, Jr. Center for Students with DisABILITIES).

### Recording of Class

Students may not record all or part of class, livestream all or part of class, or make/distribute screen captures, without advanced written consent of the instructor. If you have or think you may have a disability such that you need to record class-related activities, please contact the [Justin Dart, Jr. Student Accessibility Center](#). If you have an accommodation to record class-related activities, those recordings may not be shared with any other student, whether in this course or not, or with any other person or on any other platform. Classes may be recorded by the instructor. Students may use instructor's recordings for their own studying and notetaking. Instructor's recordings are not authorized to be shared with *anyone* without the prior written approval of the instructor. Failure to comply with requirements regarding recordings will result in a disciplinary referral to the Dean of Students Office and may result in disciplinary action.

### Syllabus Changes

Due to the changing nature of the COVID-19 pandemic, please note that the instructor may need to make modifications to the course syllabus and may do so at any time. Notice of such changes will be announced as quickly as possible through Blackboard announcements.

### Resources for Online Learning

The University of Houston is committed to student success, and provides information to optimize the online learning experience through our [Power-On](#) website. Please visit this website for a comprehensive set of resources, tools, and tips including: obtaining access to the internet, AccessUH, and Blackboard; requesting a laptop through the Laptop Loaner Program; using your smartphone as a webcam; and downloading Microsoft Office 365 at no cost. For questions or assistance contact [UHOnline@uh.edu](mailto:UHOnline@uh.edu).

### UH Email

Please check and use your CougarNet email for communications related to this course. To access this email, [login](#) to your Microsoft 365 account with your CougarNet credentials.

### Webcams

Access to a webcam is required for students participating remotely in this course. Webcams must be turned on unless the student sends an email to me ahead of class with a reason for needing to turn off their webcam. This requirement is in place to ensure a similar quality of engagement as an in-person attendance.

## Anti-discrimination and Sexual Misconduct Policies

UHLC and the University are committed to maintaining and strengthening an educational, working, and living environment in which students, faculty, staff, and visitors are free from discrimination and sexual misconduct. If you have experienced an incident of discrimination or sexual misconduct, a confidential reporting process is available to you. For more information, please refer to the University system's [Anti-Discrimination Policy webpage](#), [Anti-Discrimination Policy](#), [Sexual Misconduct Policy webpage](#), and [Sexual Misconduct Policy](#).

Under the University Sexual Misconduct Policy, **your instructor is a “responsible employee” for reporting purposes under Title IX regulations and state law, and *must* report incidents of sexual misconduct** (sexual harassment, non-consensual sexual contact, sexual assault, sexual exploitation, sexual intimidation, intimate partner violence, or stalking) about which they become aware to the Title IX office. Please know there are places on campus where you can make a report in confidence. You can find more information about resources on the Title IX website at <https://uh.edu/equal-opportunity/title-ix-sexual-misconduct/resources/>.

## Security Escorts and Cougar Ride

UHPD continually works with the University community to make the campus a safe place to learn, work, and live. Our Security escort service is designed for the community members who have safety concerns and would like to have a Security Officer walk with them, for their safety, as they make their way across campus. Based on availability either a UHPD Security Officer or Police Officer will escort students, faculty, and staff to locations beginning and ending on campus. If you feel that you need a Security Officer to walk with you for your safety please call [713-743-3333](tel:713-743-3333). Arrangements may be made for special needs.

Parking and Transportation Services also offers a late-night, on-demand shuttle service called Cougar Ride that provides rides to and from all on-campus shuttle stops, as well as the MD Anderson Library, Cougar Village/Moody Towers and the UH Technology Bridge. Rides can be requested through the UH Go app. Days and hours of operation can be found at <https://uh.edu/af-university-services/parking/cougar-ride/>.

## Helpful Information

For various types of support, visit Coogs Care <https://uh.edu/dsa/coogscare/> and the Student Health Center: <https://www.uh.edu/healthcenter/>