

Trademark Law: An Open-Source Casebook

Significant Changes from v3.0 to v4.0

26 June 2017

Listed here are the major changes from Version 3.0 to Version 4.0. **New excerpted opinions are given in bold.**

Refer to the redlines posted on the casebook website for less significant changes (correction of typos, grammar, etc.). In recent versions of Microsoft Word, load the redline, go to the review tab, and use the “Next” function to proceed through all changes.

Introduction

- Deleted some citations from footnote 30 of the McKenna excerpt.
- Added comment and passage from *Restatement* on “technical trademarks,” “trade names,” and the role of intent in late nineteenth century trademark law.
- Moved comment on trademark law and property from after the McKenna excerpt to after the discussion of policy justifications for trademark protection.

Part I

- Part I introductory paragraphs: added example of hand gesture that has been registered as a trademark
- Part I.A.1.a.ii: Deleted *Zobmondo* entirely
- Part I.A.1.a.iii: Added comment on surveying for suggestiveness versus descriptiveness based on *Rise-N-Shine, LLC v. Duner-Fenter*, No. 14 Civ. 1305, 2015 WL 876470 (S.D.N.Y. Feb. 28, 2015)
- Part I.A.1.c: Added comment on informational slogans and meme marks focusing on efforts to register “Nevertheless, she persisted.”
- Part I.A.2.a: Deleted footnote 7 from Stevens concurrence (which just quoted old 43(a)) as unnecessary
- Part I.A.2.a: Deleted footnote 19 from Stevens concurrence (string citation) as unnecessary
- Part I.B introductory paragraphs: Modified in light of *Tam*
- Part I.B.1.c: Added a but see reference to *Deere & Co. v. FIMCO Inc.*, No. 15 Civ. 105, 2017 WL 927235, at *21-26 (W.D. Ky. Mar. 8, 2017) on aesthetic functionality of John Deere Green
- Part I.B.3: Deleted the scandalous and disparaging marks cases and created new subpart I.B.5 with excerpt from ***Matal v. Tam*, No. 15–1293, 582 U.S. __ (U.S. June 19, 2017)**
- Part I.C: Replaced citation to *Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 929 F.2d 662, 18 U.S.P.Q.2d 1292 (Fed. Cir. 1991) with citation to *Christian Faith Fellowship Church v. adidas AG*, 841 F.3d 986, 995 (Fed. Cir. 2016)
- Part I.C: Updated discussion of Leo Stoller to include his sentencing

- Part I.D: Added comment on the phenomenon of “submarine trademarks”
- Part I.D.1: Added bullet point on role of supplemental registration in facilitating certain registrations by U.S. firms abroad
- Part I.D.2: Deleted two paragraphs just before conclusion of *M.Z. Berger*
- Part I.D.3.a: Added language suggesting that courts may give some weight to the identification of goods and services in infringement litigation
- Part I.D.3.f: Added sentence explaining that applicants that appeal TTAB decisions to the district court (rather than the appellate court) must pay PTO’s reasonable expenses regardless of the outcome of the appeal
- Part I.E: Reversed order of treatment of geographic extent of rights in registered and unregistered marks to begin with registered marks; deleted *United Drug Co. v. Theodore Rectanus*, 248 U.S. 90 (1918); added **Stone Creek, Inc. v. Omnia Italian Design, Inc.**, __ F.3d __, 2017 WL 2951672 (9th Cir. July 11, 2017), to section on unregistered marks
- Part I.E.3: Modified the introductory paragraphs in light of *Belmora*
- Part I.E.3.a: Deleted the comment on territoriality and use in commerce because of *Belmora*
- Part I.E.3.b: Deleted various paragraphs from *ITC v. Punchgini* to try to shorten the opinion
- Part I.E.3.c: Added ***Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016)**

Part II

- Part II.A.1: Deleted half of paragraph 3 of the *Rescuecom* opinion to try to shorten it
- Part II.B.1.a: Deleted two paragraphs from *Borden* to try to shorten it
- Part II.B.2: Added citation to *Florida Int’l Univ. Bd. of Trustees v. Florida Nat’l Univ., Inc.*, 830 F.3d 1242, 1256 (11th Cir. 2016) on sophistication of relevant consumers
- Part II.B.4: Added excerpt from *Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ.*, LLC 823 F.3d 153, 161-163 (2d Cir. May 18, 2016), on types of confusion that are actionable
- Part II.B.4: Added comment on “signifier confusion” and “affiliation confusion”
- Part II.B.6: Deleted two paragraphs from *Ferrari* to try to make it shorter
- Part II.C.2: Deleted various paragraphs from *Starbucks* to try to make it shorter
- Part II.C.3: Added comment asking if antidilution law is constitutional in light of *Tam*
- Part II.D.1: Deleted various paragraphs from *Lamparello* to try to make it shorter
- Part II.E: Deleted various paragraphs from *Gucci* to try to make it shorter

Part III

- Part III.B.1: Added block quotation of the *New Kids* factors to the introductory paragraphs
- Part III.C.1: Deleted paragraph 6 from Haute Diggity Dog to try to make it shorter
- Part III.D.1: Deleted various paragraphs from *ITC v Punchgini*
- Part III.D.2: Added comments on reclaiming abandoned marks and on residual goodwill
- Part III.E: Added comment on the ill-fated purchase by Volkswagen of Rolls-Royce in all but name

Part IV

- Part IV.B: Added subpart on endorsements, testimonials, and reviews, with excerpts from ***FTC Guides Concerning Use of Endorsements and Testimonials in Advertising*** and ***The FTC's Endorsement Guides: What People Are Asking***

Part V

- Added map showing forms of right of publicity protection available in the 50 states

Part VI

- Part VI.A: Added comment on Second Circuit treatment of *eBay* and referring to Lemley's article on eBay and trademark law
- Part VI.C: Added discussion of corrective advertising
- Part VI.D: Updated citations of circuits applying *Octane Fitness*
- Part VI.F: Added reference to 5-Hour Energy counterfeiting case