

Trademark Law: An Open-Source Casebook

Significant Changes from Version 6.0 to Version 7

July 8, 2020

Listed here are the major changes from Version 6.0 to Version 7. **New excerpted opinions and other very significant changes are given in bold.** This is a highly schematic list. Its purpose is just to protect past users of the book from any major surprises when teaching the book again.

Refer to the redline posted on the casebook website for less significant changes (correction of typos, grammar, etc.).

Introduction

- Added note asking whether trademarks indicate source or in some cases obscure source

Part I

- Added footnote on registrability/protectability of full personal names
- Deleted comment on “primary significance” of the mark
- **Added *USPTO v Booking.com***
- Added comment on generic colors
- Added comment on why Qualitex sought cert
- Trimmed *Slokevage* somewhat
- Moved some of the casebook introductory discussion of inherent distinctiveness analysis of product packaging
- **Deleted *In re California Innovations* and replaced with overview of case**
- **Added *Levy v. adidas AG* to use in commerce section**
- Trimmed *Kelly Services* somewhat
- Added reference to *Peter v. NantKwest*
- **Substantially rewrote “Geographic Extent of Trademark Rights” section**
 - **Added *National Association for Healthcare Communications v. Central Arkansas Area Agency on Aging***
 - Moved *Stone Creek*

Part II

- Deleted overview of *Spring Mills, Inc. v. Ultracashmere House*
- Trimmed *Smith v. Wal-Mart* somewhat
- **Added excerpt from *Board of Supervisors v. Smack Apparel* to discussion of sponsorship confusion**
- Added note on state antidilution law
- **Reconfigured secondary liability section**
 - **Added *Luxottica Group v Airport Mini Mall* to cover landlord-tenant secondary liability**

Part III

- **In descriptive fair use section, added *SportFuel, Inc. v. PepsiCo, Inc.* and deleted *Sorensen v. WD-40 Company***

- In nominative fair use section, added very brief excerpt from *Board of Supervisors v. Smack Apparel*
- Reconfigured expressive uses section
 - Moved Fitchuation case excerpt
 - Added comment on *Gordon's* treatment of *Rogers'* second prong
 - Added comment on *Facenda v NFL Films*
 - **Added excerpt from *Bad Spaniels* opinion**
 - **Added excerpt from *LV v. Hyundai* on parody**
 - **Added excerpt from *LV v. My Other Bag* SDNY opinion on parody**
- Added comment on Linux and abandonment
- After *Sugar Busters* opinion, added comment on protectability of book titles
- **Restored *Nitro Leisure Products v. Acushnet* (previously deleted from version 6, and returned by popular demand)**

Part IV

- Renamed section including the *Papa Johns* case “Literally True But Misleading Advertising”
- Added comment on difference between consumer deception and materiality
- Trimmed *Castrol v Quaker State* somewhat
- **In comparative claims section, replaced *Castrol v Penzoil* with *Groupe SEB USA, Inc. v. Euro-Pro Operating LLC***
- **In online false endorsement section, added the FTC complaint in *In the Matter of Lord & Taylor, LLC***

Part VI

- **Added *Romag Fasteners, Inc. v. Fossil, Inc.***