

# SYLLABUS

# TRADEMARK AND DECEPTIVE PRACTICES

SUMMER 2019  
3 CREDIT HOURS

## PART 1: COURSE DETAILS

### CONTACT INFORMATION

#### INSTRUCTOR

**Instructor:** Professor Roberts

**Office Hours:** *Online office hours from 10:00am-noon EST on Fridays during the course.*

**Phone:** (603) 513-5140

**E-mail:** [alexandra.roberts@law.unh.edu](mailto:alexandra.roberts@law.unh.edu)

**Best way to contact:** E-mail

**Reply policy:** I will try to respond to emails within 24 hours. If you do not receive a reply to your email within a reasonable period of time, please send it again. Sometimes email is captured by SPAM filter, is addressed incorrectly, or just simply does not get sent.

#### TECH SUPPORT

For technical support, please contact the Helpdesk at:

**Phone:** 800-472-8899

**Email:** [support@lawstudentonline.com](mailto:support@lawstudentonline.com)

### COURSE DESCRIPTION

This course will examine the precepts of trademark and unfair competition law. We will investigate issues of ownership, registration, misappropriation, infringement, and dilution in the context of words, phrases, symbols, slogans, product design, and trade dress. The course will also explore related issues such as false and comparative advertising, rights of publicity, and parody and free speech.

### COURSE LEARNING OUTCOMES

Upon completion of this course, students should be able to:

- Demonstrate foundational knowledge and understanding of substantive trademark law, including but not limited to use, protectability, distinctiveness, functionality, infringement, unfair competition, false advertising, dilution, defenses, and remedies.

- Practice adopting the perspectives of corporations, entrepreneurs, trademark prosecutors, trademark litigators, USPTO examining attorneys, marketers, and judges in considering trademark policy and strategic decisionmaking.
- Possess knowledge and understanding of the different types of protectable subject matter and the bars, hurdles, and challenges to achieving and maintaining protection.
- Read, brief, analyze, and critique both canonical and lesser-known federal trademark and TTAB cases.
- Apply knowledge gleaned from cases and scholarship to current events and hypotheticals in a nuanced way.
- Argue persuasively on questions of protectability, validity, infringement, dilution, unfair competition, and fair use, with reference to case law, policy, and evidentiary issues.
- Spot trademark-related issues in hypotheticals and analyze them using the IRAC method.
- Be able to research and respond to client inquiries efficiently and accurately and advise clients regarding trademark strategy, dispute resolution, and portfolio management.
- Navigate USPTO resources proficiently in order to aid clients in all aspects of prosecution and inter partes proceedings.
- Appraise types of evidence relevant in prosecution and litigation and be capable of amply supporting factual as well as legal arguments.

## PART 2: MATERIALS AND COURSE REQUIREMENTS


### READINGS

#### REQUIRED TEXT

The casebook for this course is Mark D. Janis and Graeme B. Dinwoodie, *Trademarks and Unfair Competition: Law & Policy* (5th Ed.). Additional materials will be posted on the LMS. “CB” refers to page numbers in the casebook.

#### RECOMMENDED TEXTS & OTHER READINGS

Please also bookmark or make note of the following resources:

- The Lanham Act and Rules of Practice: [http://www.uspto.gov/web/offices/tac/tmlaw2.html#\\_Toc52344282](http://www.uspto.gov/web/offices/tac/tmlaw2.html#_Toc52344282) (the Lanham Act is also available with hyperlinks at <http://www.bitlaw.com/source/15usc/index.html> and index at <http://www.bitlaw.com/source/15usc/wordindex.html>)
- The 2017 Trademark Manual of Examining Procedure (TMEP):  <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>
- The US Patent & Trademark Office trademark website at <http://www.uspto.gov/trademarks/index.jsp> and Trademark Electronic Search System (TESS) at <http://tmsearch.uspto.gov/>
- The Trademark Trial and Appeal Board Manual of Procedure (TBMP): [http://www.uspto.gov/trademarks/process/appeal/Preface\\_TBMP.jsp](http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp)

## TECHNOLOGY REQUIREMENTS

Students are expected to meet basic technology requirements to successfully participate in this online course. Failure to meet these requirements may cause problems accessing the course materials. It is the student's responsibility to ensure all requirements are met prior to the start of the course.

- Access to the Internet is required. While any browser can be used, Firefox and Chrome are recommended.
- Access to D2L and Online Office Hours Tool (Ex. Blackboard Collaborate). See [Part 3: Accessing the Course](#) for more details.
- You will need the capability to speak and hear so you can watch videos and participate in the live online office hours. Make sure that the device(s) you will be using have a microphone and speakers or that you have access to a headset. A webcam is optional but not required.

## PART 3: ACCESSING THE COURSE

### TIME ZONES

Please note that this course is set up to run in the Eastern Time zone. Check your syllabus for all assignments deadlines. Modules close on Sundays at 11:59 pm ET.

Eastern	Central	Mountain	Pacific
11:59pm	10:59pm	9:59pm	8:59pm

Daylight Saving Time: Daylight Saving Time (DST) may impact when your assignments are due.

As a student in a distance education course, it is your responsibility to learn and observe the time deadlines for assignments. Late work will not be accepted due to time zone differences.

### COURSE SITE (D2L)

The course will be taught entirely online in an asynchronous environment using the Learning Management System – Desire2Learn (D2L).

The course is designed to give students a dynamic online learning experience. Students will receive notice of a student orientation which will familiarize you with the basics of navigating this platform. Students will also receive their login information (username and password) via email.

To access the course:

1. Go to: <https://mycourses.lawonline.me>.

2. Enter the username and password you have been provided.
3. Locate and click on the course name under *My Courses*.
  - a. If you have trouble logging in, please contact the Helpdesk at 800-472-8899 or via email [support@lawstudentonline.com](mailto:support@lawstudentonline.com)

## OFFICE HOURS VIA ZOOM

Online office hours will be available through Zoom Online Rooms. Students will have the opportunity to speak with the instructor during these office hours. Students can also choose to share their webcam or be given permission to share documents with the instructor via the online rooms.

## PART 4: COURSE STRUCTURE

### OVERVIEW

The course is organized around a weekly schedule that will begin each Monday 12:01 AM ET and end the following Sunday 11:59 PM ET. A typical week will cover 5-13 topic areas, balanced for depth and length. Any assignments for a given topic will normally be due at the end of the weekly period unless otherwise indicated.

### ASSIGNMENTS AND ACTIVITIES

#### *QUIZZES (Knowledge Checks)*

*For each module, there will be short quizzes to confirm your understanding of the readings, lectures, and discussions. 1-3 question quizzes, typically multiple choice, will follow most videos, and you will need to complete those quizzes before moving on to the next video.*

#### *BRIEFS & ASSIGNMENTS*

*For each module there will be a written assignment for you to complete and submit. It will usually take the form of a single case brief. Some modules you may receive an additional assignment. All assignments must be submitted within the course using the assignment dropbox tool.*

#### *DISCUSSION BOARD*

1-2 questions will be posted to the discussion board for each module. For most discussion prompts, you are expected to contribute your own initial response and then read your classmates' responses and provide substantive feedback to at least two classmates' responses. The initial postings must be completed by **Thursday at midnight EST**, and the responses to your classmates must be posted by **Sunday at midnight EST**. Your answers should demonstrate a mastery of the material assigned at that point in the course. Review the grading criteria and "Discussion Board

Guidelines” to ensure maximum credit. You should expect to spend at least 2 hours per module on the discussion boards.

#### MIDTERM EXAM

The exam will take the form of a written argument in response to an office action by the US Patent & Trademark Trademark Office (USPTO). You will have five days to complete this exam, with the goal being a polished piece of writing that demonstrates strong reasoning skills and a persuasive argument.

#### FINAL EXAM

The final will take the form of an issue-spotter exam. I will post the fact pattern(s) and prompt(s) online. The exam will be limited-universe open book: you may consult your casebook, course outline, and other specified materials, but you may not use materials outside of that universe or discuss the exam with anyone else. You will have three hours to complete the exam, once you begin.

## PART 5: STUDENT RESPONSIBILITIES

### MANAGING YOUR STUDIES

The following attributes will greatly contribute to your success in this course.

- *Be self-motivated.* You should be able to manage and direct your own learning environment and methods to fulfill course requirements and achieve individual academic success.
- *Be an independent learner.* Successful online students are self-starters. They work well with the flexibility that the 24/7 any time--any place format provides. You should be able to learn on your own and at an accelerated pace without direct supervision.
- *Have a minimum level of computer literacy.* Although it is not essential to have advanced computer skills, you should possess a working knowledge of email and the Internet, as well as basic keyboarding skills.
- *Manage your time well.* You must be able to organize and plan your own best "time to learn." There is no one best time for everyone, but the key to success is to make the time to learn.
- *Utilize effective communication skills.* You must use email and discussions to communicate with your peers and me. The ability to read and to write clearly in order to communicate ideas and assignments is essential. Also, sharing reflections - of your own work as well as your course mates' - is a crucial component of a successful experience. This method provides you with rapid feedback as well as a means to inform me of any concerns or problems that you may be experiencing.
- *Be personally committed to successfully completing this online course.* Because of the flexibility in scheduling in this course, you must have a strong desire to learn and acquire knowledge and skills via online courses. Making a commitment to learn in this manner is

a very personal decision and requires a strong desire to perform in order to achieve academic success.

## RESPECTING THE ACADEMIC COMMUNITY

Netiquette consists of the rules and guidelines for acceptable behavior in electronic communication. Remember, while working in an online course you are in an academic setting and should conduct yourself accordingly.

All students are expected to follow netiquette guidelines as outlined below:

- You are not text messaging friends. This means text message acronyms (such as LOL, IMHO, BCNU, etc.) are not acceptable. Express yourself with proper spelling, grammar, and punctuation.
- Out of respect for your fellow course mates' and instructor's time, keep your communications as clear, straightforward, and concise as possible.
- Use appropriate mixed case text; avoid using all lowercase or all uppercase text (SHOUTING).
- You are your words. Your communication in an online course represents you. Always review and edit your communication before submitting.
- Give respect to your classmates. Be courteous, respectful of others' opinions, sensitive to diversity, and polite.
- Respect other people's privacy. Do not share other individuals' personal information (i.e., e-mail addresses, phone numbers, etc.) without permission.
- It's okay to disagree with someone's opinion or constructively criticize an idea. It is never okay to personally attack another student. Debate the idea; do not attack the person.
- Free speech is not an absolute right in an online course.
- Your words should be your own. If you quote from your casebook or any other text, cite accordingly.

## INSTRUCTOR EXPECTATIONS OF STUDENTS

- Students are expected to keep up with the class, to read the required readings, to watch the required recordings, and to submit assignments and activities by Sunday at 11:59pm EST of the week the topic is covered.
- Students should log on to D2L at least three times per week to check for announcements, complete work, and participate actively in discussion boards.
- Students are expected to independently complete all activities, assignments, tests, and the final exam. Do not refer to canned briefs or commercial outlines when briefing cases to submit as assignments. You may consult those materials after submitting your brief

- to check your understanding. It's fine (and you may find it helpful) to review topics in commercial outlines after they've been covered in class or before the final exam.
- You may email me with specific questions about assigned materials or topics, or about trademark law generally. If you choose to do so, please also note in your message what steps you have taken to try to answer the question on your own. I may respond directly to you or, if I think the discussion will be helpful to other students, I may email the class or address your question on the discussion board or in an announcement. I will not attribute your question(s) to you publicly.
  - I reserve the right to make changes to the syllabus during the semester; if and when I do, I will post an announcement in D2L.
  - You are responsible for all assigned material, whether or not the lecture materials cover material contained in those readings.
  - On the Discussion boards, to receive maximum points for questions, students need to follow the instructions carefully, follow word limits as instructed, and use Spell Check. There may be deductions if these guidelines are not followed.
  - The midterm and final exam are subject to strict confidentiality requirements. Please read carefully the instructions that accompany each. Sharing the exam prompts, exam memos, or sample exam answers with anyone outside of the class is forbidden and constitutes a violation of the UNH Law honor code.

## PART 6: GRADES AND GRADING POLICIES

### GRADED COURSE ACTIVITIES

The following formula will be used to calculate your final grade:

Points	Description
20%	Discussion
10%	Written Assignments
30%	Midterm Exam
40%	Final Exam

### GRADING SCALE

Your grade will conform to your school's grading policy as to whether +s and -s are given and to any applicable grading curve.

## PART 7: OTHER COURSE POLICIES

### ATTENDANCE

*This course is delivered asynchronously to accommodate students' other life obligations. Students must access each lecture for an appropriate amount of time, participate substantively in the discussion boards, and submit all assignments. Students are allowed late completion of up to 2 modules per semester.*

### COMPETENCIES

Below is a list of competencies fundamental to practicing law. These are based on the research about the skills and attitudes necessary for successful lawyers across a range of practice areas and organizations. Here is a list of competencies and the level at which they are taught in this course. We seek to have you practice all these competencies and become competent in many by the time you graduate.

#### KEY:

**E**=exposed to

**P**=practiced (includes being exposed to)

**C**=become competent (includes being exposed to and practicing)

- =not addressed in the course

"client" includes live and simulated clients

#### I. Problem solving

1. Identifies client problem and client objective: **P**
2. Identifies and diagnoses legal problems from a set of facts: **C**
3. Demonstrates sufficient grounding in substantive law to recognize legal issues and potential courses of action: **C**
4. Identifies potential outcomes and consequences and develops practical contingency plans to handle various possibilities: **P**
5. Reads law and client facts carefully: **C**
6. Listens well: **P**
7. Uses knowledge and insight of others in finding solutions to a legal problem: **E**
8. Collaborates effectively to find solution(s): **P**



**II. Client counseling and management**

1. Establishes and maintains a proper attorney-client relationship: -
2. Gathers relevant information: **P**
3. Analyzes decisions to be made: **P**
4. Counsels client about decision: **E**
5. Ascertains and implements client's decision: -
6. Demonstrates concern about the client's problems and concerns and works to gain client's trust: -
7. Demonstrates sensitivity to whatever culture, gender, race, class or other barriers might diminish communication and interaction: -
8. Understands, timely responds to and anticipates client's concerns and demonstrates respect for client's choices and values: -
9. Understands how to advise and inform client about choices, expectations and risks, and how to advise and then work with client to reach decisions: -

**III. Factual investigation and analysis**

1. Determines the need for factual investigation: **P**
2. Plans a factual investigation-uses all available sources including on-line resources: -
3. Implements the investigative strategy: -
4. Memorializes and organizes information in an accessible form: -
5. Decides whether/when to conclude the process of fact-gathering: -
6. Evaluates the information that has been gathered: **P**
7. Demonstrates understanding of the interplay between facts and legal theories and between facts and rules of evidence: **P**
8. Uncovers relevant facts (including those facts that help other side) and demonstrates how the facts will be applied: **E**
9. With respect to client and witness interviews, student: (1) pays attention, listens well and takes notes as necessary; (2) appropriately uses both open and closed questions to fully extract information (and concerns with respect to client interviews); (3) makes sure that she understands everything that was said and follows up or clarifies so as to clear up any possible ambiguities or misunderstandings; (4) maintains eye contact with person being interviewed, conveys interest and understanding with body language and words; (5) avoids legal jargon and generally presents explanations that are clear and simple; and (6) decides, in advance, what she plans to accomplish in the interview: -
10. Finds facts by mining documents, depositions and other paper records for relevant information: **E**

**IV. Legal Research**

1. Researches and applies relevant authorities – statutes, cases, regulations: -
2. Conducts effective and efficient research: -
3. Uses primary and secondary sources to conduct research: -
4. Uses applicable research tools to find relevant authority: -

5. Uses applicable research tools to discover relevant factual information: -
6. Navigates statutory and regulatory authorities effectively: **P**
7. Makes appropriate choices regarding free research resources: -

#### **V. Legal analysis and reasoning**

1. Identifies and formulates legal issues: **P**
2. Identifies relevant legal rules among range of authorities: **C**
3. Synthesizes legal rules: **P**
4. Effectively applies facts to law: **C**
5. Formulates effective legal theories: **C**
6. Identifies and addresses counter-arguments: **C**
7. Demonstrates careful case/law reading: **C**
8. Identifies critical legal and factual issues presented by a legal problem: **C**
9. Identifies the main common law, statutory and regulatory rules and authorities relevant to each issue: **P**
10. Applies legal rules to each issue: **C**
11. Determines answers to each issue and then puts the answers into a sequence that answers the overall question posed by a legal problem: **E**
12. Identifies and addresses contrary authority and, with respect to the contrary authority cited by opposing side, exposes weaknesses and wrongly selected authority: **E**
13. Sees client's problem or legal issue from many points of view and makes use of these perspectives in his or her understanding and analysis: **C**

#### **VI. Writing and Communication**

1. Organizes written documents effectively: **P**
2. Explains and applies law accurately, effectively, and clearly: **P**
3. Correctly assesses the recipient's perspective: **E**
4. Uses effective oral communication: **E**
5. Writes in concise, clear, grammatically-correct, well-organized language appropriate to the task: **P**
6. Links facts to law logically and readably: **P**
7. Speaks in simple declarative sentences, without rambling or using jargon: **P**
8. Oral communication is confident, respectful, and authentic: **P**
9. Understands the audience(s), purpose and setting for a written document or oral presentation and adapts approach accordingly: **E**
10. Demonstrates sensitivity to whatever culture, gender, race, class or other barriers might diminish communication and interaction: **E**
11. Advocates in a persuasive and effective manner: **P**

#### **VII. Professionalism**

1. Demonstrates independent professional judgment: **P**
2. Demonstrates self-directedness, self-awareness, and initiative: **P**
3. Understands the business of law: **C**

4. Takes responsibility for matters and assignments
  - a. Project management: **E**
  - b. Time management: **P**
5. Proactively seeks supervision and/or feedback: **E**
6. Assumes an active role in professional self-development: **E**
7. Handles professional and personal stress and/or identifies when s/he may need additional resources: **E**
8. Engages in regular self-reflection: **P**
9. Recognizes and take steps to address and/or resolve ethical dilemmas: **E**
10. Demonstrates collaboration skills by working effectively in a team: **P**

### **Information Literacy Requirement**

The five AALL (American Association of Law Libraries) Standards are:

- Principle I: A successful legal researcher possesses fundamental research skills.
- Principle II: A successful legal researcher gathers information through effective and efficient research strategies.
- Principle III: A successful legal researcher critically evaluates information.
- Principle IV: A successful legal researcher applies information effectively to resolve a specific issue or need.
- Principle V: A successful legal researcher distinguishes between ethical and unethical uses of information, and understands the legal issues associated with the discovery, use, or application of information.

This course fulfills the law school's information literacy policy by including:

- Trademark survey exercise requires students to learn about generally-accepted trademark survey methodology, survey classmates and peers, assess findings, and consider the credibility, accuracy, and fit of each survey type to real and hypothetical litigation (Principles I, II, III, IV).
- Midterm Office Action Response tasks students with replying to a USPTO Office Action by pulling from relevant cases, reviewing examples of responses, and applying information and precedent to advocate for a client (Principles I, II, IV).
- Online discussions throughout the semester challenge students to make judgments by applying statutory and case law but also identifying where further information is needed, i.e. where facts might be outcome-determinative in trademark disputes or registrability issues (Principles III, IV, V).

**SPECIAL ACCOMMODATIONS**

Contact your home school regarding requests for special accommodations. Please ask your school to send granted accommodations to [support@lawstudentonline.com](mailto:support@lawstudentonline.com)

**PART 8: COURSE TOPICS**

The following is a list of topics which will be covered in the course. Please refer to the course schedule for details on topics, assignments, and due dates. Any change related to the course schedule will be communicated to the students through an announcement to all students or by modifying the course syllabus and notifying students of the modified syllabus.

Module	Topics
1	<ul style="list-style-type: none"> <li>• Introduction                             <ul style="list-style-type: none"> <li>○ What is a Trademark?</li> <li>○ Foundations of Trademark &amp; Unfair Competition Law</li> <li>○ Types of Marks</li> </ul> </li> <li>• The Distinctiveness Spectrum</li> <li>• Secondary Meaning</li> </ul>
2	<ul style="list-style-type: none"> <li>• Generic Terms</li> <li>• Distinctiveness of Words</li> <li>• Distinctiveness of Non-verbal Identifiers</li> </ul>
3	<ul style="list-style-type: none"> <li>• Design/Packaging Distinction &amp; Distinctiveness of Non-verbal Identifiers</li> <li>• Exotic Subject Matter</li> <li>• Introduction to Functionality</li> </ul>
4	<ul style="list-style-type: none"> <li>• Functionality                             <ul style="list-style-type: none"> <li>○ Post-Traffix</li> <li>○ Aesthetic Functionality</li> </ul> </li> </ul>
5	<ul style="list-style-type: none"> <li>• Use as a Prerequisite for Acquiring Rights: Actual Use</li> <li>• Constructive Use &amp; Surrogate Use</li> </ul>
6	<ul style="list-style-type: none"> <li>• Abandonment</li> <li>• Registration Process</li> <li>• Exclusions from Registration</li> </ul>
7	<ul style="list-style-type: none"> <li>• Exclusions from Registration (cont.)</li> <li>• Geographic Limits on Rights &amp; the Well-Known Mark Doctrine</li> </ul>
8	<ul style="list-style-type: none"> <li>• Evolution of the Likelihood of Confusion Standard</li> <li>• Actionable Use</li> </ul>

	<ul style="list-style-type: none"> <li>• Likelihood of Confusion Factors (I)</li> </ul>
<b>9</b>	<ul style="list-style-type: none"> <li>• Likelihood of Confusion Factors (II)</li> <li>• Private Label Goods</li> <li>• Reverse Confusion</li> <li>• Post Sale Confusion</li> <li>• Initial Interest Confusion</li> </ul>
<b>10</b>	<ul style="list-style-type: none"> <li>• Dilution</li> <li>• Cybersquatting (by dilution; ACPA)</li> </ul>
<b>11</b>	<ul style="list-style-type: none"> <li>• Cybersquatting continued (ACPA; UDRP)</li> <li>• Counterfeiting</li> <li>• Descriptive Fair Use</li> </ul>
<b>12</b>	<ul style="list-style-type: none"> <li>• Nominative Fair Use</li> <li>• First Sale</li> <li>• Expressive Use of Another’s Trademark</li> </ul>
<b>13</b>	<ul style="list-style-type: none"> <li>• Remedies</li> <li>• Identity Rights in Persona</li> </ul>
<b>14</b>	<ul style="list-style-type: none"> <li>• False Advertising</li> <li>• Semester Review</li> </ul>