

Table of Contents

Volume 1

CHAPTER 1. BACKGROUND AND HISTORY OF SECTION 43(a)

- § 1:1 Introduction
- § 1:2 Current 43(a)
- § 1:3 Earlier versions of Section 43(a)
- § 1:4 Amendments and additions to Section 43(a)
- § 1:5 Limitations on Section 43(a)—Commerce
- § 1:6 —Copyright and patent
- § 1:7 —First Amendment

CHAPTER 2. AN OVERVIEW OF SECTION 43(a)

- § 2:1 Overview of Section 43(a)
- § 2:2 Prongs of Section 43(a)
- § 2:3 Misappropriation
- § 2:4 Injuries and complaints not redressable under Section 43(a)
- § 2:5 —Contractual disputes
- § 2:6 —Marketing schemes and business ideas
- § 2:7 —Other federal laws
- § 2:8 —Trade disparagement and libel before November 16, 1989
- § 2:9 —Movie and video ratings by non-competitors
- § 2:10 —Efforts to gain trademark exclusivity
- § 2:11 —Miscellaneous
- § 2:12 Circuit variations
- § 2:13 —First Circuit
- § 2:14 —Second Circuit
- § 2:15 —Third Circuit
- § 2:16 —Fourth Circuit
- § 2:17 —Fifth Circuit
- § 2:18 —Sixth Circuit
- § 2:19 —Seventh Circuit
- § 2:20 —Eighth Circuit
- § 2:21 —Ninth Circuit
- § 2:22 —Tenth Circuit
- § 2:23 —Eleventh Circuit
- § 2:24 —District of Columbia

CHAPTER 3. PROTECTABILITY AND

INFRINGEMENT OF INDICIA OF COMMERCIAL ORIGIN

I. TRADE INDICIA

- § 3:1 Section 43(a)(1)(A) generally
- § 3:2 Trademarks and other indicia of origin
- § 3:3 Generic terms
- § 3:4 Descriptive terms
- § 3:5 —Secondary meaning
- § 3:6 Suggestive marks
- § 3:7 Arbitrary or fanciful marks
- § 3:8 Geographic terms
- § 3:9 Non-verbal marks, including colors, logos, and designs
- § 3:10 Numbers
- § 3:11 Secondary marks
- § 3:12 Geographic scope of mark rights
- § 3:13 Loss of trademark rights

II. LIKELIHOOD OF CONFUSION

- § 3:14 Likelihood of confusion—General principles
- § 3:15 Reverse confusion and reverse palming off
- § 3:16 Initial interest confusion
- § 3:17 Post-sale confusion
- § 3:18 Similarity of marks
- § 3:19 Strength of marks
- § 3:20 Proximity of products or services
- § 3:21 Proximity of channels of trade
- § 3:22 Audience
- § 3:23 Actual confusion
- § 3:24 Intent
- § 3:25 Additions to avoid likelihood of confusion
- § 3:26 Communicative works
- § 3:27 Parody

III. INFRINGING AND NON-INFRINGING ACTIONS

- § 3:28 Passing off/palming off
- § 3:29 Mark use in the distribution chain—Genuine goods and related services
- § 3:30 —Repackaging or relabeling goods
- § 3:31 —Used, refurbished, and altered goods
- § 3:32 —Gray market goods (parallel imports)
- § 3:33 —Retransmission of television program
- § 3:34 Fair use
- § 3:35 Nominative fair use
- § 3:36 Internet use
- § 3:37 Other non-infringing uses

TABLE OF CONTENTS

IV. PERSONS LIABLE

- § 3:38 Direct infringement
- § 3:39 Vicarious infringement
- § 3:40 Contributory infringement
- § 3:41 Liability of employees and officers

CHAPTER 4. PROTECTION OF TRADE DRESS

- § 4:1 Definition of trade dress
- § 4:2 Scope of trade dress
- § 4:3 Infringement of trade dress
- § 4:4 Conceptual strength and acquired distinctiveness
- § 4:5 Specificity
- § 4:6 Dispelling confusion with disclaimers or other marks

CHAPTER 5. PROTECTION OF PRODUCT CONFIGURATIONS AS TRADE DRESS

- § 5:1 Overview
- § 5:2 Product configurations versus packaging
- § 5:3 Specific cases—Products protected on motion
- § 5:4 —Products not protected during pre-trial motion practice
- § 5:5 —Products protected after trial
- § 5:6 —Products not protected after trial
- § 5:7 Functionality—Overview
- § 5:8 Definition of functionality
- § 5:9 Evidence of utilitarian functionality
- § 5:10 Relationship of utilitarian functionality to types of matter
- § 5:11 Specific matter classified as having utilitarian functionality
- § 5:12 Specific matter classified as not having utilitarian functionality
- § 5:13 Aesthetic functionality
- § 5:14 Specific matter found to be aesthetically functional
- § 5:15 Specific matter not found to be aesthetically functional

CHAPTER 6. ADVERTISING

- § 6:1 Cause of action for false advertising
- § 6:2 Allowable plaintiffs
- § 6:3 Actionable “commercial advertising or promotion”
- § 6:4 Factual statements
- § 6:5 Interpreting accused matter
- § 6:6 Literally false
- § 6:7 Literally false by necessary implication
- § 6:8 Misleading
- § 6:9 Establishment claims
- § 6:10 Comparative claims
- § 6:11 Materiality
- § 6:12 Examples of litigated claims

CHAPTER 7. CELEBRITIES

- § 7:1 Overview of available claims
- § 7:2 —Limitations
- § 7:3 Trademarks and service marks
- § 7:4 —Merchandising
- § 7:5 —Performing groups and entertainment services
- § 7:6 False endorsement
- § 7:7 Specific celebrities

CHAPTER 8. SURVEYS

- § 8:1 Overview of survey use
- § 8:2 Requirements for reliable surveys
- § 8:3 Surveys regarding genericism
- § 8:4 Surveys regarding public awareness of matter
- § 8:5 Surveys regarding likelihood-of-confusion
- § 8:6 Surveys regarding the meaning of an advertisement

CHAPTER 9. JURISDICTION AND PROCEDURE

- § 9:1 Subject matter jurisdiction
- § 9:2 —Declaratory Judgment Act
- § 9:3 Personal jurisdiction
- § 9:4 Venue
- § 9:5 Transfer—Among federal district courts
- § 9:6 —Contracts regarding venue or arbitration; forum non conveniens
- § 9:7 Removal and remand
- § 9:8 Statute of limitations
- § 9:9 Pleading
- § 9:10 Plaintiffs
- § 9:11 Defendants; sovereign immunity
- § 9:12 Use in commerce; extraterritorial use
- § 9:13 Equitable defenses—Unclean hands
- § 9:14 —Laches
- § 9:15 — —Delay
- § 9:16 — —Progressive encroachment
- § 9:17 — —Prejudice
- § 9:18 — —Effect
- § 9:19 —Acquiescence; equitable estoppel; waiver
- § 9:20 Preclusion—Claim preclusion
- § 9:21 —Issue preclusion
- § 9:22 —Related doctrines
- § 9:23 Pretrial motions
- § 9:24 Default
- § 9:25 Trial
- § 9:26 Appeal

Volume 2

TABLE OF CONTENTS

CHAPTER 10. RELIEF

§ 10:1	Overview
§ 10:2	Statutory language
§ 10:3	Preliminary relief
§ 10:4	Innocent infringers
§ 10:5	Permanent injunction
§ 10:6	—Destruction of infringing material
§ 10:7	—Advertising
§ 10:8	Contempt
§ 10:9	Damages
§ 10:10	Profits
§ 10:11	Costs
§ 10:12	Attorney’s fees
§ 10:13	Prejudgment interest
§ 10:14	Post judgment interest

APPENDICES

APPENDIX A.	The Trademark Law Revision Act of 1988 (Pub. Law 100-667, Nov. 16, 1988)
APPENDIX B.	Legislative History Trademark Law Revision Act of 1988: Section 43(a) Provisions
APPENDIX C.	Trademark Remedy Clarification Act
APPENDIX D.	Legislative History of Trademark Remedy Clarification Act
APPENDIX E.	Legislative History: Trademark Revision Act of 1987 (Senate Judiciary Committee on S. 1883)
APPENDIX F.	Legislative History: Trademark Revision Act of 1988 (House Judicial Committee on H.R. 4156)
APPENDIX G.	Trademark Assignment and Settlement Agreement

Table of Cases

Index