

TRADEMARK
and
UNFAIR COMPETITION LAW
CASES AND COMMENTS
Sixth Edition

Peter B. Maggs
Roger E. Schechter

American Casebook Series®

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TRADEMARK
AND
UNFAIR COMPETITION
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CASES AND COMMENTS

Sixth Edition

By

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Preface to the Sixth Edition

In some instances the preparation of a new edition of a casebook requires merely the inclusion of the most important recent decisions since the publication of the previous version. In other cases, however, legal, economic and social developments require a thorough rethinking of the organization and content of a teaching book to better capture what is going on in a field of law. This edition of these materials—a collection that traces its lineage back to 1933—falls most decidedly in the latter category. The scope of those changes is reflected in a significant revision of the organizational scheme of the book, the inclusion of significant amounts of new material, the deletion of other large blocks of material, and indeed in our adoption of a new title.

Since we last revised these materials, the law has increasingly come to treat trademarks as a form of pure property, significantly divorced from underlying goodwill and significantly protected from third-party uses even where there is no risk of consumer confusion. These trends are vividly evidenced by, but not limited to, the adoption of a federal remedy for trademark dilution in the mid-nineties and the increasingly aggressive efforts of firms to protect product and packaging shape under the evolving law of trade dress. In addition, the explosive growth of the Internet has generated a host of previously unforeseen issues involving the use of trademarks in cyberspace. Moreover, the publication of a new Restatement devoted explicitly to Unfair Competition issues has served to create a more unified and coherent concept of the scope of the subject matter. We have attempted to give all these developments their due with greatly expanded coverage of dilution, with a discrete chapter dealing with the issues of trademarks on the Web, and with extensive citations to the Restatement. We have also added expanded materials on trademark remedies and affirmative defenses to this edition, along with numerous illustrations. In all this, we hope to have produced a book that more closely corresponds to the content of the increasingly large number of Trademark and Unfair Competition courses around the country.

Long-time users of this book will also notice a greatly expanded number of notes following most of the principal cases. We have tried, in these short paragraphs, to alert students to collateral issues, to cite key resources in the legal literature, and to raise what we hope are provocative questions. We have also continued to emphasize the consumer interest in trademark disputes and other unfair competition controversies, both through questions about the wisdom of various legal doctrines, and by including materials that specifically deal with consumer remedies. To make room for these various additions, and to keep the book more focused on the core issues of unfair competition law, we have, with mixed feelings, decided to remove our materials on both price discrimination,

and federal copyright law. Despite these significant changes, many of the landmark cases remain, and our coverage still ranges far beyond trademark cases, to cover the right of publicity, trade secret theft, the misappropriation doctrine, and public and private remedies for false advertising.

It has become a bit of a cliché to say that we live in a “branded” society, in which the power and worth of trademarks as important business assets has never been greater. Cliches however, sometimes reflect underlying truths. It is an extraordinary time to undertake the study of trademark law. There is a sense of dynamism in this area, as in all areas of intellectual property law, that is perhaps unmatched anywhere else on the legal landscape. We hope we have put together an informative and provocative set of cases and comments that will help a new generation of lawyers take their first steps towards mastering this field.

Unfortunately, our friend and mentor Glen Weston, who was our senior co-editor for the most recent two editions of this book, opted not to participate in the preparation of this edition. Despite our entreaties he understandably declined to interrupt his retirement, and we greatly missed his scholarly insights and wise counsel. Nonetheless his influence, and that of S. Chesterfield Oppenheim, who originated these materials two-thirds of a century ago, remains on every page. We, and everyone who learns from these materials, are in their intellectual debt, and it is a pleasure to thank them here for all that they have taught us.

PETER B. MAGGS
ROGER E. SCHECHTER

July, 2002

EDITORIAL NOTE

We have omitted, without any indication, certain footnotes in some of the opinions reproduced in the text, certain internal case citations within those opinions, and citations to some parallel reporters. All other editorial deletions have been indicated with asterisks. Remaining footnotes in opinions bear the original footnote numbers. All citations to the Internet are to web pages that were active in early 2002.

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