

AMERICAN  
CASEBOOK  
SERIES

CASES AND MATERIALS ON  
TRADEMARK LAW



Glynn Lunney

WEST

# CASES AND MATERIALS ON TRADEMARK LAW

■ ■ ■

By

**Glynn Lunney**

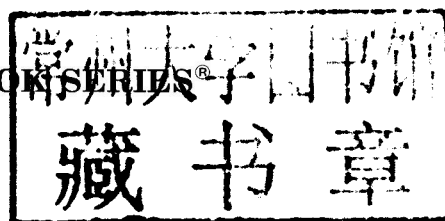
*McGlinchey Stafford Professor of Law*

*Tulane University School of Law*

AMERICAN CASEBOOK SERIES®

**WEST®**

A Thomson Reuters business



Thomson Reuters created this publication to provide you with accurate and authoritative information concerning the subject matter covered. However, this publication was not necessarily prepared by persons licensed to practice law in a particular jurisdiction. Thomson Reuters does not render legal or other professional advice, and this publication is not a substitute for the advice of an attorney. If you require legal or other expert advice, you should seek the services of a competent attorney or other professional.

*American Casebook Series* is a trademark registered in the U.S. Patent and Trademark Office.

© 2010 Thomson Reuters  
610 Opperman Drive  
St. Paul, MN 55123  
1-800-313-9378

Printed in the United States of America

**ISBN:** 978-0-314-90702-8

# **WEST'S LAW SCHOOL ADVISORY BOARD**

---

**JESSE H. CHOPER**

Professor of Law and Dean Emeritus,  
University of California, Berkeley

**JOSHUA DRESSLER**

Professor of Law, Michael E. Moritz College of Law,  
The Ohio State University

**YALE KAMISAR**

Professor of Law, University of San Diego  
Professor of Law Emeritus, University of Michigan

**MARY KAY KANE**

Professor of Law, Chancellor and Dean Emeritus,  
University of California,  
Hastings College of the Law

**LARRY D. KRAMER**

Dean and Professor of Law, Stanford Law School

**JONATHAN R. MACEY**

Professor of Law, Yale Law School

**ARTHUR R. MILLER**

University Professor, New York University  
Formerly Bruce Bromley Professor of Law, Harvard University

**GRANT S. NELSON**

Professor of Law, Pepperdine University  
Professor of Law Emeritus, University of California, Los Angeles

**A. BENJAMIN SPENCER**

Professor of Law,  
Washington & Lee University School of Law

**JAMES J. WHITE**

Professor of Law, University of Michigan

*For my sons*

# TABLE OF CASES

The principal cases are in bold type. Cases cited or discussed in the text are in roman type. References are to pages. Cases cited in principal cases and within other quoted materials are not included.

- 
- Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc., 280 F.3d 619 (6th Cir.2002), 311, 323
- ACCU Personnel, Inc. v. AccuStaff, Inc., 846 F.Supp. 1191 (D.Del.1994), 89
- A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.**, 237 F.3d 198 (3rd Cir. 2000), 416
- A.J. Canfield Co. v. Honickman, 808 F.2d 291 (3rd Cir.1986), 188, 260
- Aktiebolaget Electrolux v. Armatron Intern., Inc., 999 F.2d 1 (1st Cir.1993), 711
- Alaska Airlines, Inc. v. Brock, 480 U.S. 678, 107 S.Ct. 1476, 94 L.Ed.2d 661 (1987), 129
- Alberto-Culver Co. v. Andrea Dumon, Inc., 466 F.2d 705 (7th Cir.1972), 61
- Ale House Management, Inc. v. Raleigh Ale House, Inc., 205 F.3d 137 (4th Cir.2000), 327
- Altria Group, Inc. v. Good, \_\_\_ U.S. \_\_\_, 129 S.Ct. 538, 172 L.Ed.2d 398 (2008), 269
- AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531 (11th Cir.1986), 373, 494
- American Broadcasting Co. v. Wahl Co., 121 F.2d 412 (2nd Cir.1941), 359
- American Home Products Corp. v. Johnson and Johnson**, 577 F.2d 160 (2nd Cir. 1978), 743
- American Motors Corporation v. Action-Age, Inc., 178 U.S.P.Q. 377, 1973 WL 19941 (Trademark Tr. & App. Bd.1973), 371, 372
- American Safety Table Co. v. Schreiber, 269 F.2d 255 (2nd Cir.1959), 311
- American Thermos Products Co. v. Aladdin Industries, Inc., 207 F.Supp. 9 (D.Conn. 1962), 174
- Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252 (5th Cir.1980), 389
- Anheuser-Busch, Inc. v. Balducci Publications**, 28 F.3d 769 (8th Cir.1994), 441
- Anheuser-Busch, Inc. v. L. & L. Wings, Inc.**, 962 F.2d 316 (4th Cir.1992), 431
- Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.**, 684 F.2d 1316 (9th Cir.1982), 156
- Apple Corps Ltd. v. A.D.P.R., Inc., 843 F.Supp. 342 (M.D.Tenn.1993), 843
- Apple Corps Ltd. v. Leber, 229 U.S.P.Q. 1015, 1986 WL 215081 (Cal.App.Super.1986), 843
- Application of (see name of party)**
- Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315, 59 S.Ct. 191, 83 L.Ed. 195 (1938), 545
- Arvelo v. American Intern. Ins. Co., 875 F.Supp. 95 (D.Puerto Rico 1995), 61
- Ashley Furniture Industries, Inc. v. SanGiacomo N.A. Ltd., 187 F.3d 363 (4th Cir.1999), 302
- A. T. Cross Co. v. Jonathan Bradley Pens, Inc., 470 F.2d 689 (2nd Cir.1972), 386
- Atkinson v. John E. Doherty & Co., 121 Mich. 372, 80 N.W. 285 (Mich.1899), 785
- Attrezzi, LLC v. Maytag Corp., 436 F.3d 32 (1st Cir.2006), 714
- Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407 (2nd Cir.1917), 375
- Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc., 457 F.3d 1062 (9th Cir.2006), 325
- Babbitt Electronics, Inc. v. Dynascan Corp., 38 F.3d 1161 (11th Cir.1994), 711
- Bally Total Fitness Holding Corp. v. Faber, 29 F.Supp.2d 1161 (C.D.Cal.1998), 646
- Banjo Buddies, Inc. v. Renosky, 399 F.3d 168 (3rd Cir.2005), 711
- Barcamerica Intern. USA Trust v. Tyfield Importers, Inc.**, 289 F.3d 589 (9th Cir. 2002), 353
- Bayer Aktiengesellschaft, In re, 488 F.3d 960 (Fed.Cir.2007), 81
- Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y.1921), 173
- Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 79 S.Ct. 948, 3 L.Ed.2d 988 (1959), 712
- Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920 (10th Cir.1986), 387, 388
- Beneficial Corp. v. Beneficial Capital Corp., 529 F.Supp. 445 (S.D.N.Y.1982), 494
- Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.**, 561 F.2d 1365 (10th Cir. 1977), 714
- Bihari v. Gross, 119 F.Supp.2d 309 (S.D.N.Y. 2000), 641
- Bliss, Fabyan & Co. v. Aileen Mills, 25 F.2d 370 (4th Cir.1928), 547
- Blue Bell, Inc. v. Farah Mfg. Co., Inc.**, 508 F.2d 1260 (5th Cir.1975), 46

- Board of Supervisors for Louisiana State University Agricultural and Mechanical College v. Smack Apparel Co., 550 F.3d 465 (5th Cir.2008), 325, 399
- Board of Trade of City of Chicago v. Dow Jones & Co., Inc., 98 Ill.2d 109, 74 Ill.Dec. 582, 456 N.E.2d 84 (Ill.1983), 16
- Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989), 271
- Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co., 145 F.3d 481 (2nd Cir. 1998), 711
- Booth v. Curtis Pub. Co., 15 A.D.2d 343, 223 N.Y.S.2d 737 (N.Y.A.D. 1 Dept.1962), 840
- Borden Ice Cream Co v. Borden's Condensed Milk Co, 201 F. 510 (7th Cir.1912), 374
- Bosley Medical Institute, Inc. v. Kremer**, 403 F.3d 672 (9th Cir.2005), **646**
- Boston Athletic Ass'n v. Sullivan, 867 F.2d 22 (1st Cir.1989), 398, 449
- Boston Beer Co. Ltd. Partnership, In re, 198 F.3d 1370 (Fed.Cir.1999), 189
- Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1 (1st Cir.2008), 385
- Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.**, 510 F.2d 1004 (5th Cir.1975), 40, **391**
- Boye Needle Company, In re, 100 U.S.P.Q. 124, 1953 WL 5189 (Chief Examiner 1953), 275
- Brookfield Communications, Inc. v. West Coast Entertainment Corp.**, 174 F.3d 1036 (9th Cir.1999), **604**, 694
- Brother Records, Inc. v. Jardine, 318 F.3d 900 (9th Cir.2003), 335, 565, 566
- Brown Chemical Co. v. Meyer, 139 U.S. 540, 11 S.Ct. 625, 35 L.Ed. 247 (1891), 197
- Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513 (10th Cir.1987), 710
- Budge Mfg. Co., Inc., In re**, 857 F.2d 773 (Fed.Cir.1988), **199**
- Bulte v. Igleheart Bros., 137 F. 492 (7th Cir. 1905), 347
- Burger King of Fla., Inc. v. Brewer, 244 F.Supp. 293 (W.D.Tenn.1965), 90
- Burger King of Fla., Inc. v. Hoots**, 403 F.2d 904 (7th Cir.1968), **105**
- Burndy Corp. v. Teledyne Industries, Inc., 748 F.2d 767 (2nd Cir.1984), 767
- Byron v. Johnston, 35 Eng.Rep. 851, 1816 WL 1707 (Ch.D.1816), 25
- California Innovations, Inc., In re**, 329 F.3d 1334 (Fed.Cir.2003), **202**
- Calvin Klein Cosmetics Corp. v. Parfums de Coeur, Ltd., 824 F.2d 665 (8th Cir.1987), 557
- Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994), 600, 840
- Cartoons, L.C. v. Major League Baseball Players Ass'n**, 95 F.3d 959 (10th Cir. 1996), **788**
- Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267 (2nd Cir.1995), 548
- Carling Brewing Co. v. Philip Morris Inc., 297 F.Supp. 1330 (N.D.Ga.1968), 401
- Cashmere & Camel Hair Mfrs. Institute v. Saks Fifth Ave., 284 F.3d 302 (1st Cir. 2002), 766, 784
- Castrol Inc. v. Pennzoil Co., 987 F.2d 939 (3rd Cir.1993), 783
- C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.**, 505 F.3d 818 (8th Cir.2007), **833**
- Central Bank of Denver, N.A. v. First Interstate Bank of Denver, N.A., 511 U.S. 164, 114 S.Ct. 1439, 128 L.Ed.2d 119 (1994), 459
- Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211 (3rd Cir.2005), 565
- CES Pub. Corp. v. St. Regis Publications, Inc., 531 F.2d 11 (2nd Cir.1975), 167
- Chamber of Commerce of United States v. Brown, 554 U.S. 60, 128 S.Ct. 2408, 171 L.Ed.2d 264 (2008), 269
- Champion Spark Plug Co. v. Sanders**, 331 U.S. 125, 67 S.Ct. 1136, 91 L.Ed. 1386 (1947), **548**
- Chandon Champagne Corp. v. San Marino Wine Corp., 335 F.2d 531 (2nd Cir.1964), 61
- Chanel, Inc. v. Italian Activewear of Florida, Inc., 931 F.2d 1472 (11th Cir.1991), 713
- Chanel, Inc. v. Smith, 178 U.S.P.Q. 630, 1973 WL 19871 (N.D.Cal.1973), 557
- Charles Jacquin Et Cie, Inc. v. Destileria Serralles, Inc., 921 F.2d 467 (3rd Cir.1990), 388
- Charles of the Ritz Group Ltd. v. Quality King Distributors, Inc., 636 F.Supp. 433 (S.D.N.Y.1986), 557
- Chemical Corp. of America v. Anheuser-Busch, Inc., 306 F.2d 433 (5th Cir.1962), 505
- Cheney Bros. v. Doris Silk Corporation, 35 F.2d 279 (2nd Cir.1929), 16
- Chevron, USA, Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 104 S.Ct. 2778, 81 L.Ed.2d 694 (1984), 128
- Circuit City Stores, Inc. v. CarMax, Inc., 165 F.3d 1047 (6th Cir.1999), 102, 384
- Citibank, N.A. v. Citytrust, 756 F.2d 273 (2nd Cir.1985), 694
- City of (see name of city)**
- Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F.2d 512 (9th Cir.1989), 311
- Cleary v. News Corp., 30 F.3d 1255 (9th Cir. 1994), 27
- Clemens v. Belford, Clark & Co., 14 F. 728 (C.C.N.D.Ill.1883), 25
- Clorox Co. Puerto Rico v. Proctor & Gamble Commercial Co., 228 F.3d 24 (1st Cir.2000), 783
- Coca-Cola Co. v. Gemini Rising, Inc., 346 F.Supp. 1183 (E.D.N.Y.1972), 505
- Coca-Cola Co. v. Koke Co. of America, 254 U.S. 143, 41 S.Ct. 113, 65 L.Ed. 189 (1920), 153, 174
- Coca-Cola Co. v. Tropicana Products, Inc., 690 F.2d 312 (2nd Cir.1982), 765
- Cohn v. Petsmart, Inc., 281 F.3d 837 (9th Cir.2002), 694

- Compeco Corp. v. Day-Brite Lighting, Inc.**, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964), **265**
- Conan Properties, Inc. v. Conans Pizza, Inc.**, 752 F.2d 145 (5th Cir.1985), **567**
- Cook, Perkiss and Liehe, Inc. v. Northern California Collection Service Inc., 911 F.2d 242 (9th Cir.1990), 783
- Crescent Tool Co. v. Kilborn & Bishop Co.**, 247 F. 299 (2nd Cir.1917), **257**
- Dairy Queen, Inc. v. Wood, 369 U.S. 469, 82 S.Ct. 894, 8 L.Ed.2d 44 (1962), 712
- Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2nd Cir.1979), 273, 505, 601
- Damn I'm Good, Inc. v. Sakowitz, Inc., 514 F.Supp. 1357 (S.D.N.Y.1981), 326
- Dastar Corp. v. Twentieth Century Fox Film Corp.**, 539 U.S. 23, 123 S.Ct. 2041, 156 L.Ed.2d 18 (2003), **17**, 552
- Davidoff & CIE, S.A. v. PLD Intern. Corp., 263 F.3d 1297 (11th Cir.2001), 135
- Dawn Donut Co. v. Hart's Food Stores, Inc.**, 267 F.2d 358 (2nd Cir.1959), **90**
- Deere & Co., In re, 7 U.S.P.Q.2d 1401, 1988 WL 252363 (Trademark Tr. & App. Bd.1988), 299
- Deere & Co. v. MTD Products, Inc.**, 41 F.3d 39 (2nd Cir.1994), **498**
- Delaware & Hudson Canal Co. v. Clark**, 80 U.S. 311, 20 L.Ed. 581 (1871), **536**
- De Nobili Cigar Co. v. Nobile Cigar Co., 56 F.2d 324 (1st Cir.1932), 198
- Dial-A-Mattress Operating Corp., In re, 240 F.3d 1341 (Fed.Cir.2001), 167
- Disc Golf Ass'n, Inc. v. Champion Discs, Inc., 158 F.3d 1002 (9th Cir.1998), 313
- Dora v. Frontline Video, Inc., 18 Cal.Rptr.2d 790 (Cal.App. 2 Dist.1993), 840
- Douglas Laboratories Corp. v. Copper Tan, Inc., 210 F.2d 453 (2nd Cir.1954), 152
- Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir.1997), 600
- Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431 (3rd Cir.1994), 303, 310
- Earthquake Sound Corp. v. Bumper Industries, 352 F.3d 1210 (9th Cir.2003), 712
- Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 994 F.2d 1569 (Fed.Cir.1993), 81
- eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 126 S.Ct. 1837, 164 L.Ed.2d 641 (2006), 688, 694, 839
- Edgar Rice Burroughs, Inc. v. Manns Theatres, 195 U.S.P.Q. 159, 1976 WL 20994 (C.D.Cal. 1976), 506
- EFCO Corp. v. Symons Corp., 219 F.3d 734 (8th Cir.2000), 766
- E.I. Du Pont de Nemours & Co. v. Celanese Corp. of America, 35 C.C.P.A. 1061, 167 F.2d 484 (Cust. & Pat.App.1948), 359
- E. I. DuPont de Nemours & Co. v. Yoshida Intern., Inc., 393 F.Supp. 502 (E.D.N.Y. 1975), 174
- Emergency One, Inc. v. American FireEagle, Ltd., 228 F.3d 531 (4th Cir.2000), 372
- Enrique Bernat F., S.A. v. Guadalajara, Inc., 210 F.3d 439 (5th Cir.2000), 152
- Epic Metals Corp. v. Souliere, 99 F.3d 1034 (11th Cir.1996), 302
- Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH, 289 F.3d 351 (5th Cir.2002), 323
- Erie R. Co. v. Tompkins, 304 U.S. 64, 58 S.Ct. 817, 82 L.Ed. 1188 (1938), 15
- Estee Lauder Inc. v. Old Navy, Inc.**, 108 F.3d 1503 (2nd Cir.1997), **377**
- ETW Corp. v. Jireh Pub., Inc.**, 332 F.3d 915 (6th Cir.2003), **822**
- Everest Capital Ltd. v. Everest Funds Management, L.L.C., 393 F.3d 755 (8th Cir.2005), 479
- Everett O. Fisk & Co. v. Fisk Teachers' Agency, 3 F.2d 7 (8th Cir.1924), 359
- Exxon Corp. v. Humble Exploration Co., Inc., 695 F.2d 96 (5th Cir.1983), 371
- Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2nd Cir.1978), 806
- Fairway Foods v. Fairway Markets, 227 F.2d 193 (9th Cir.1955), 40
- Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 118 S.Ct. 1279, 140 L.Ed.2d 438 (1998), 712
- Ferrari S.P.A. v. Roberts**, 944 F.2d 1235 (6th Cir.1991), 273, **402**, 556
- Fisher Radio Corporation v. Bird Electronic Corporation, 162 U.S.P.Q. 265, 1969 WL 9101 (Trademark Tr. & App. Bd.1969), 197
- Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259 (9th Cir.1996), 458
- Foxtrap, Inc. v. Foxtrap, Inc., 671 F.2d 636, 217 U.S.App.D.C. 130 (D.C.1982), 711
- Fun-Damental Too, Ltd. v. Gemmy Industries Corp., 111 F.3d 993 (2nd Cir.1997), 302
- G.D. Searle & Co. v. Hudson Pharmaceutical Corp., 715 F.2d 837 (3rd Cir.1983), 557
- General Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405 (6th Cir.2006), 311
- Genesee Brewing Co., Inc. v. Stroh Brewing Co.**, 124 F.3d 137 (2nd Cir.1997), **175**, 188
- George v. Smith, 52 F. 830 (C.C.S.D.N.Y.1892), 375
- G.H. Mumm Champagne v. Eastern Wine Corporation, 142 F.2d 499 (2nd Cir.1944), 710
- Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539 (6th Cir.2005), 416
- Gilliam v. American Broadcasting Companies, Inc., 538 F.2d 14 (2nd Cir.1976), 26
- Girl Scouts of United States of America v. Personality Posters Mfg. Co., 304 F.Supp. 1228 (S.D.N.Y.1969), 506
- Goldstein v. California, 412 U.S. 546, 93 S.Ct. 2303, 37 L.Ed.2d 163 (1973), 271

- Gordon Bennett & Associates, Inc. v. Volkswagen of America, Inc., 186 U.S.P.Q. 271, 1975 WL 21160 (N.D.Cal.1975), 61
- Government Employees Ins. Co. v. Google, Inc., 77 U.S.P.Q.2d 1841, 2005 WL 1903128 (E.D.Va.2005), 496
- Gracie v. Gracie, 217 F.3d 1060 (9th Cir.2000), 712
- Granz v. Harris, 198 F.2d 585 (2nd Cir.1952), 25
- Grupo Gigante SA De CV v. Dallo & Co., Inc., 391 F.3d 1088 (9th Cir.2004), 120
- GTE Corp. v. Williams, 904 F.2d 536 (10th Cir.1990), 58, 89, 387
- Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.**, 202 F.2d 866 (2nd Cir. 1953), 786
- Haig & Haig Limited, In re, 118 U.S.P.Q. 229, 1958 WL 5921 (Com'r Pat. & Trademarks 1958), 275
- Hallock, Helvering v., 309 U.S. 106, 60 S.Ct. 444, 84 L.Ed. 604 (1940), 129
- Hancock v. American Steel & Wire Co. of N.J., 40 C.C.P.A. 931, 203 F.2d 737 (Cust. & Pat.App.1953), 385
- Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 36 S.Ct. 357, 60 L.Ed. 713 (1916), 88, 89
- Hard Rock Cafe Licensing Corp. v. Concession Services, Inc.**, 955 F.2d 1143 (7th Cir.1992), 450
- Hartford House Ltd. v. Hallmark Cards Inc., 647 F.Supp. 1533 (D.Colo.1986), 313
- Haywood v. Drown, — U.S. —, 129 S.Ct. 2108, 173 L.Ed.2d 920 (2009), 269
- Helvering v. — (see opposing party)**
- Henri's Food Products Co., Inc. v. Kraft, Inc., 717 F.2d 352 (7th Cir.1983), 389
- H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987 (Fed.Cir. 1986), 170
- HMH Pub. Co., Inc. v. Brincat, 504 F.2d 713 (9th Cir.1974), 58
- Holiday Inns, Inc. v. Holiday Out In America, 481 F.2d 445 (5th Cir.1973), 387, 388
- Holiday Inns of America, Inc. v. B & B Corp., 409 F.2d 614 (3rd Cir.1969), 100
- Honeywell, Inc., In re, 497 F.2d 1344 (Cust. & Pat.App.1974), 273
- Huston v. Buckeye Bait Corp., 145 F.Supp. 600 (S.D.Ohio 1955), 300
- Hutchinson Technology Inc., In re, 852 F.2d 552 (Fed.Cir.1988), 197
- Hy-Cross Hatchery, Inc. v. Osborne, 49 C.C.P.A. 1163, 303 F.2d 947 (Cust. & Pat. App.1962), 348
- Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78 (3rd Cir.1982), 270
- Illinois High School Ass'n v. GTE Vantage Inc., 99 F.3d 244 (7th Cir.1996), 173
- Imperial Tobacco Ltd., Assignee of Imperial Group PLC v. Philip Morris, Inc., 899 F.2d 1575 (Fed.Cir.1990), 372
- Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership., 34 F.3d 410 (7th Cir.1994), 370
- In re (see name of party)**
- Intermatic Inc. v. Toeppen, 947 F.Supp. 1227 (N.D.Ill.1996), 644
- International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco, 329 F.3d 359 (4th Cir.2003), 119
- International News Service v. Associated Press**, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211 (1918), 1
- International Order of Job's Daughters v. Lindeburg and Co., 633 F.2d 912 (9th Cir. 1980), 312, 396
- International Star Class Yacht Racing Ass'n v. Tommy Hilfiger, USA, Inc., 80 F.3d 749 (2nd Cir.1996), 711
- Internet Specialties West, Inc. v. Milon-Di-Giorgio Enterprises, Inc., 559 F.3d 985 (9th Cir.2009), 589
- Interstellar Starship Services, Ltd. v. Epix, Inc.**, 304 F.3d 936 (9th Cir.2002), 630
- Invisible, Inc. v. National Broadcasting Co., Inc., 212 U.S.P.Q. 576, 1980 WL 30359 (C.D.Cal.1980), 61
- Invision Production & Media Services, Inc. v. Glen J. Lerner Legal Services, 2009 WL 766502 (9th Cir.2009), 61
- Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982), 286, 314, 458
- I.P. Lund Trading ApS v. Kohler Co.**, 163 F.3d 27 (1st Cir.1998), 507
- ITC Ltd. v. Punchgini, Inc., 9 N.Y.3d 467, 850 N.Y.S.2d 366, 880 N.E.2d 852 (N.Y.2007), 120
- ITC Ltd. v. Punchgini, Inc., 482 F.3d 135 (2nd Cir.2007), 120
- Ives Laboratories, Inc. v. Darby Drug Co., Inc., 601 F.2d 631 (2nd Cir.1979), 315
- Jada Toys, Inc. v. Mattel, Inc.**, 518 F.3d 628 (9th Cir.2008), 488
- James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266 (7th Cir.1976), 400
- JCW Investments, Inc. v. Novelty, Inc., 482 F.3d 910 (7th Cir.2007), 714
- Jews For Jesus v. Brodsky, 993 F.Supp. 282 (D.N.J.1998), 645
- Johnson & Johnson v. Carter-Wallace, Inc., 631 F.2d 186 (2nd Cir.1980), 766
- Johnson & Johnson-Merck Consumer Pharmaceuticals Co. v. Rhone-Poulenc Rorer Pharmaceuticals, Inc., 19 F.3d 125 (3rd Cir. 1994), 762
- Johnson & Johnson \* Merck Consumer Pharmaceuticals Co. v. Smithkline Beecham Corp., 960 F.2d 294 (2nd Cir.1992), 764
- Johnson & Johnson Vision Care, Inc. v. 1-800 Contacts, Inc., 299 F.3d 1242 (11th Cir. 2002), 783
- K and N Engineering, Inc. v. Bulat, 510 F.3d 1079 (9th Cir.2007), 713

- Kason Industries, Inc. v. Component Hardware Group, Inc., 120 F.3d 1199 (11th Cir.1997), 586
- Keene Corp. v. Paraflex Industries, Inc., 653 F.2d 822 (3rd Cir.1981), 313
- Kellogg Co. v. Exxon Corp.**, 209 F.3d 562 (6th Cir.2000), **576**
- Kellogg Co. v. National Biscuit Co.**, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938), 152, 188, **252**
- Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368 (5th Cir. 1977), 396
- Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 94 S.Ct. 1879, 40 L.Ed.2d 315 (1974), 271
- Kidd v. Johnson, 100 U.S. 617, 10 Otto 617, 25 L.Ed. 769 (1879), 347
- King v. Innovation Books, a Div. of Innovative Corp., 976 F.2d 824 (2nd Cir.1992), 26
- King-Seeley Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577 (2nd Cir.1963), 166
- Kingsmen v. K-Tel Intern. Ltd., 557 F.Supp. 178 (S.D.N.Y.1983), 336
- K Mart Corp. v. Cartier, Inc.**, 486 U.S. 281, 108 S.Ct. 1811, 100 L.Ed.2d 313 (1988), **122**
- Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996 (2nd Cir.1995), 303, 324
- Kohler Co. v. Moen Inc., 12 F.3d 632 (7th Cir.1993), 273
- KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.**, 543 U.S. 111, 125 S.Ct. 542, 160 L.Ed.2d 440 (2004), 150, **539**
- L'Aiglon Apparel v. Lana Lobell, Inc., 214 F.2d 649 (3rd Cir.1954), 26
- Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373 (2nd Cir.1997), 273, 302
- Lever Bros. Co. v. United States**, 981 F.2d 1330, 299 U.S.App.D.C. 128 (D.C.Cir.1993), **129**
- Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352 (9th Cir.1985), 383
- Library Publications, Inc. v. Medical Economics Co., 548 F.Supp. 1231 (E.D.Pa.1982), 269
- Lindy Pen Co., Inc. v. Bic Pen Corp., 982 F.2d 1400 (9th Cir.1993), 713
- Liquid Glass Enterprises, Inc. v. Dr. Ing. h.c.F. Porsche AG, 8 F.Supp.2d 398 (D.N.J.1998), 566
- Lochner v. New York, 198 U.S. 45, 25 S.Ct. 539, 49 L.Ed. 937 (1905), 15
- Lois Sportswear, USA, Inc. v. Levi Strauss & Co., 799 F.2d 867 (2nd Cir.1986), 388, 408
- Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC**, 507 F.3d 252 (4th Cir. 2007), **523**
- Lucas Nursery and Landscaping, Inc. v. Grosse**, 359 F.3d 806 (6th Cir.2004), **655**
- Lucien Lelong, Inc. v. Lenel, Inc., 181 F.2d 3 (5th Cir.1950), 275
- Lyon Metal Products, Incorporated v. Lyon Incorporated, 134 U.S.P.Q. 31, 1962 WL 8582 (Trademark Tr. & App. Bd.1962), 371
- Made in the USA Foundation v. Phillips Foods, Inc., 365 F.3d 278 (4th Cir.2004), 587
- Majorica, S.A. v. R.H. Macy & Co., Inc., 762 F.2d 7 (2nd Cir.1985), 694
- Maltina Corp. v. Cawy Bottling Co., Inc.**, 613 F.2d 582 (5th Cir.1980), **697**
- Manhattan Industries, Inc. v. Sweater Bee by Banff, Ltd., 627 F.2d 628 (2nd Cir.1980), 60
- Marshak v. Treadwell, 240 F.3d 184 (3rd Cir. 2001), 233
- Mars Signal-Light Company, In re, 85 U.S.P.Q. 173, 1950 WL 4186 (Com'r Pat. & Trademarks 1950), 275
- Maryland Stadium Authority v. Becker**, 806 F.Supp. 1236 (D.Md.1992), **62**
- Matrix Essentials, Inc. v. Emporium Drug Mart, Inc., of Lafayette, 988 F.2d 587 (5th Cir.1993), 135
- Mattel, Inc. v. MCA Records, Inc.**, 296 F.3d 894 (9th Cir.2002), **589**
- Matthews v. Wozencraft, 15 F.3d 432 (5th Cir. 1994), 804
- McDonald's Corp. v. Druck and Gerner, DDS., P.C., 814 F.Supp. 1127 (N.D.N.Y.1993), 640
- McGinley, In re, 660 F.2d 481 (Cust. & Pat. App.1981), 234
- McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126 (2nd Cir.1979), 386, 388
- McKnight v. Taylor, 42 U.S. 161, 1 How. 161, 11 L.Ed. 86 (1843), 587
- McLean v. Fleming, 96 U.S. 245, 6 Otto 245, 24 L.Ed. 828 (1877), 250, 297, 586
- McNeilab, Inc. v. American Home Products Corp., 848 F.2d 34 (2nd Cir.1988), 766
- Mead Data Cent., Inc. v. Toyota Motor Sales, USA, Inc.**, 875 F.2d 1026 (2nd Cir. 1989), **462**
- Members First Federal Credit Union v. Members 1st Federal Credit Union, 54 F.Supp.2d 393 (M.D.Pa.1999), 110
- Memphis Development Foundation v. Factors Etc., Inc., 616 F.2d 956 (6th Cir.1980), 806
- Merck & Co., Inc. v. Medioplan Health Consulting, Inc., 425 F.Supp.2d 402 (S.D.N.Y.2006), 675
- Metro Mobile CTS, Inc. v. Newvector Communications, Inc., 643 F.Supp. 1289 (D.Ariz. 1986), 783
- Midler v. Ford Motor Co.**, 849 F.2d 460 (9th Cir.1988), **807**
- Minnesota Mining & Manufacturing Co., In re, 1952 WL 5267 (Chief Examiner 1952), 275
- Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 62 S.Ct. 1022, 86 L.Ed. 1381 (1942), 42
- Mobil Oil Corp. v. Pegasus Petroleum Corp.**, 818 F.2d 254 (2nd Cir.1987), **409**
- Modern Optics, Inc. v. Univis Lens Co., 43 C.C.P.A. 970, 234 F.2d 504 (Cust. & Pat. App.1956), 151
- Mogen David Wine Corp., In re, 51 C.C.P.A. 1260, 328 F.2d 925 (Cust. & Pat.App.1964), 273
- Money Store v. Harris Corp Finance, Inc., 689 F.2d 666 (7th Cir.1982), 152

- Moorman v. Hoge, 17 F.Cas. 715 (C.C.D.Cal. 1871), 250
- Morton-Norwich Products, Inc., In re, 671 F.2d 1332 (Cust. & Pat.App.1982), 314
- Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 123 S.Ct. 1115, 155 L.Ed.2d 1 (2003), 479, 482
- MTV Networks, a Div. of Viacom Intern., Inc. v. Curry, 867 F.Supp. 202 (S.D.N.Y.1994), 603
- Mulhens & Kropff v. Ferd Muelhens, 43 F.2d 937 (2nd Cir.1930), 347
- Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir.1987), 564
- Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2nd Cir.1999), 521, 522
- National Basketball Ass'n v. Motorola, Inc., 105 F.3d 841 (2nd Cir.1997), 17, 784
- National Conference of Bar Examiners v. Multistate Legal Studies, Inc., 692 F.2d 478 (7th Cir.1982), 151
- National Football League v. Governor of Delaware, 435 F.Supp. 1372 (D.Del.1977), 396
- National Football League Properties, Inc. v. Consumer Enterprises, Inc., 26 Ill.App.3d 814, 327 N.E.2d 242 (Ill.App. 1 Dist.1975), 270
- National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F.Supp. 507 (D.N.J.1986), 396
- National Football League Properties, Inc. v. ProStyle, Inc., 16 F.Supp.2d 1012 (E.D.Wis. 1998), 450
- National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F.Supp. 651 (W.D.Wash.1982), 396
- Natural Footwear Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383 (3rd Cir.1985), 110
- Nebbia v. New York, 291 U.S. 502, 54 S.Ct. 505, 78 L.Ed. 940 (1934), 16
- New Kids on the Block v. News America Pub., Inc.**, 971 F.2d 302 (9th Cir.1992), 558, 567
- New York Stock Exchange, Inc. v. New York, New York Hotel LLC, 293 F.3d 550 (2nd Cir.2002), 479
- NEXxUS Products Co. v. Gentle Concepts, Inc., 28 U.S.P.Q.2d 1257, 1993 WL 496824 (M.D.Fla.1993), 557
- Nintendo of America, Inc. v. Lewis Galoob Toys, Inc., 16 F.3d 1032 (9th Cir.1994), 694
- NLRB v. Jones & Laughlin Steel Corp., 301 U.S. 1, 57 S.Ct. 615, 81 L.Ed. 893 (1937), 39
- Nora Beverages, Inc. v. Perrier Group of America, Inc., 269 F.3d 114 (2nd Cir.2001), 311
- North American Medical Corp. v. Axiom Worldwide, Inc.**, 522 F.3d 1211 (11th Cir. 2008), 689
- O'Brien v. Pabst Sales Co., 124 F.2d 167 (5th Cir.1941), 805
- Omega Importing Corp. v. Petri-Kine Camera Co., 451 F.2d 1190 (2nd Cir.1971), 688
- 1-800 Contacts, Inc. v. WhenU.Com, Inc., 414 F.3d 400 (2nd Cir.2005), 675
- Original Appalachian Artworks, Inc. v. Granda Electronics, Inc., 816 F.2d 68 (2nd Cir. 1987), 134
- Osawa & Co. v. B & H Photo, 589 F.Supp. 1163 (S.D.N.Y.1984), 118
- Osem Food Industries Ltd. v. Sherwood Foods, Inc., 917 F.2d 161 (4th Cir.1990), 311
- PACCAR Inc. v. TeleScan Technologies, L.L.C., 319 F.3d 243 (6th Cir.2003), 565
- Packard v. Fox Film Corporation, 207 A.D. 311, 202 N.Y.S. 164 (N.Y.A.D. 1 Dept.1923), 25
- Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc., 216 U.S.P.Q. 897, 1982 WL 54118 (Trademark Tr. & App. Bd.1982), 99
- Pagliero v. Wallace China Co., 198 F.2d 339 (9th Cir.1952), 312, 325
- Panavision Intern., L.P. v. Toeppen, 141 F.3d 1316 (9th Cir.1998), 643, 645
- Parker Bros. v. Tuxedo Monopoly, Inc., 757 F.2d 254 (Fed.Cir.1985), 696
- Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.**, 469 U.S. 189, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985), 109, 236
- Paulsen v. Personality Posters, Inc., 59 Misc.2d 444, 299 N.Y.S.2d 501 (N.Y.Sup.1968), 840
- Pavesich v. New England Life Ins. Co., 122 Ga. 190, 50 S.E. 68 (Ga.1905), 785, 839
- Peaceable Planet, Inc. v. Ty, Inc.**, 362 F.3d 986 (7th Cir.2006), 190
- Pebble Beach Co. v. Tour 18 I Ltd., 155 F.3d 526 (5th Cir.1998), 302, 709
- People for Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir.2001), 645, 662
- PepsiCo, Inc. v. Grapette Co., 416 F.2d 285 (8th Cir.1969), 352
- Perfect Fit Industries, Inc. v. Acme Quilting Co., Inc., 618 F.2d 950 (2nd Cir.1980), 311
- Person's Co., Ltd. v. Christman**, 900 F.2d 1565 (Fed.Cir.1990), 112
- Philadelphia Storage Battery Co. v. Mindlin, 163 Misc. 52, 296 N.Y.S. 176 (N.Y.Sup. 1937), 476
- Pillsbury Co. v. Milky Way Productions, Inc., 215 U.S.P.Q. 124, 1981 WL 1402 (N.D.Ga. 1981), 506
- Pizza Hut, Inc. v. Papa John's Intern., Inc.**, 227 F.3d 489 (5th Cir.2000), 768
- Planned Parenthood Federation of America, Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1997 WL 133313 (S.D.N.Y.1997), 645
- Playboy Enterprises, Inc. v. Netscape Communications Corp.**, 354 F.3d 1020 (9th Cir.2004), 662
- Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir.2002), 565, 567
- Playtex Products, Inc. v. Georgia-Pacific Corp., 390 F.3d 158 (2nd Cir.2004), 386
- Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2nd Cir.1961), 376
- Porous Media Corp. v. Pall Corp., 110 F.3d 1329 (8th Cir.1997), 767

- PPX Enterprises, Inc. v. Audiofidelity Enterprises, Inc., 818 F.2d 266 (2nd Cir.1987), 767
- Presley's Estate v. Russen, 513 F.Supp. 1339 (D.N.J.1981), 843
- Prestonettes, Inc. v. Coty, 264 U.S. 359, 44 S.Ct. 350, 68 L.Ed. 731 (1924), 42, 567
- ProFitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C., 314 F.3d 62 (2nd Cir.2002), 587
- Pro-Football, Inc. v. Harjo, 567 F.Supp.2d 46 (D.D.C.2008), 233
- Pro-Football, Inc. v. Harjo, 415 F.3d 44, 367 U.S.App.D.C. 276 (D.C.Cir.2005), 233
- Pro-Football, Inc. v. Harjo**, 284 F.Supp.2d 96 (D.D.C.2003), 213
- Prouty v. National Broadcasting Co., 26 F.Supp. 265 (D.Mass.1939), 25
- Publications Intern., Ltd. v. Landoll, Inc., 164 F.3d 337 (7th Cir.1998), 324
- Pulitzer Publishing Company, In re, 82 U.S.P.Q. 229, 1949 WL 3647 (Com'r Pat. & Trademarks 1949), 275
- Qualitex Co. v. Jacobson Products Co., Inc.**, 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995), 288
- Quality Inns Intern., Inc. v. McDonald's Corp., 695 F.Supp. 198 (D.Md.1988), 640
- Raxton Corp. v. Anania Associates, Inc., 635 F.2d 924 (1st Cir.1980), 89
- Rescuecom Corp. v. Google Inc.**, 562 F.3d 123 (2nd Cir.2009), 677
- Reynolds Metals Co., In re, 480 F.2d 902 (Cust. & Pat.App.1973), 152
- Rhone-Poulenc Rorer Pharmaceuticals, Inc. v. Marion Merrell Dow, Inc., 93 F.3d 511 (8th Cir.1996), 766
- Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc., 855 F.2d 480 (7th Cir.1988), 475
- Ritz Carlton Hotel Co. v. Ritz Carlton Hotel Corp., 66 F.Supp. 720 (S.D.Fla.1946), 100
- Rivard v. Linville, 133 F.3d 1446 (Fed.Cir. 1998), 121
- Roberson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442 (N.Y.1902), 785
- Robi v. Five Platters, Inc., 838 F.2d 318 (9th Cir.1988), 335
- Robi v. Reed, 173 F.3d 736 (9th Cir.1999), 335
- Rogers v. Grimaldi, 875 F.2d 994 (2nd Cir. 1989), 353, 566
- Rolex Watch USA, Inc. v. Canner, 645 F.Supp. 484 (S.D.Fla.1986), 400
- Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc., 428 F.Supp. 689 (N.D.Ga.1976), 273
- Sands, Taylor & Wood v. Quaker Oats Co., 34 F.3d 1340 (7th Cir.1994), 733
- Sands, Taylor & Wood Co. v. Quaker Oats Co.**, 978 F.2d 947 (7th Cir.1992), 546, 722
- San Francisco Arts & Athletics, Inc. v. United States Olympic Committee, 483 U.S. 522, 107 S.Ct. 2971, 97 L.Ed.2d 427 (1987), 475
- Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455 (4th Cir.1996), 495, 496
- Sara Lee Corp. v. Kayser-Roth Corp., 1994 U.S. Dist. Lexis 19198 (1994), 497
- Saxony Products, Inc. v. Guerlain, Inc., 513 F.2d 716 (9th Cir.1975), 557
- Schneidewind v. ANR Pipeline Co., 485 U.S. 293, 108 S.Ct. 1145, 99 L.Ed.2d 316 (1988), 270
- Schutt Mfg. Co. v. Riddell, Inc., 673 F.2d 202 (7th Cir.1982), 710
- Schwauss, In re, 217 U.S.P.Q. 361, 1983 WL 51779 (Trademark Tr. & App. Bd.1983), 326
- S.C. Johnson & Son, Inc. v. Clorox Co., 241 F.3d 232 (2nd Cir.2001), 765, 784
- Sears, Roebuck & Co. v. Stiffel Co.**, 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661 (1964), 262
- Sengoku Works Ltd. v. RMC Intern., Ltd.**, 96 F.3d 1217 (9th Cir.1996), 330
- Shaw v. Lindheim, 919 F.2d 1353 (9th Cir. 1990), 27
- Sherrill, City of v. Oneida Indian Nation of New York, 544 U.S. 197, 125 S.Ct. 1478, 161 L.Ed.2d 386 (2005), 587
- Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417 (5th Cir.1984), 387
- Silverman v. CBS Inc.**, 870 F.2d 40 (2nd Cir.1989), 360
- Smith v. Chanel, Inc.**, 402 F.2d 562 (9th Cir.1968), 40, 44, 552, 564
- Smith v. Krause, 160 F. 270 (C.C.S.D.N.Y. 1908), 326
- Smith v. Montoro, 648 F.2d 602 (9th Cir.1981), 26
- Societe Comptoir De L'Industrie Cotonniere Etablissements Boussac v. Alexander's Dept. Stores, Inc., 299 F.2d 33 (2nd Cir. 1962), 557
- Spirits Intern., N.V., In re, 563 F.3d 1347 (Fed.Cir.2009), 212
- Spraying Systems Co. v. Delavan, Inc., 975 F.2d 387 (7th Cir.1992), 137
- Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97 (2nd Cir.2009), 387
- Sterling Brewing, Inc. v. Cold Spring Brewing Corp., 100 F.Supp. 412 (D.Mass.1951), 101
- Storck USA, L.P. v. Farley Candy Co., Inc., 797 F.Supp. 1399 (N.D.Ill.1992), 155
- Stormy Clime Ltd. v. ProGroup, Inc., 809 F.2d 971 (2nd Cir.1987), 273
- Streetwise Maps, Inc. v. VanDam, Inc., 159 F.3d 739 (2nd Cir.1998), 311
- Stuart Hall Co., Inc. v. Ampad Corp., 51 F.3d 780 (8th Cir.1995), 303
- Sugar Busters LLC v. Brennan**, 177 F.3d 258 (5th Cir.1999), 336
- Sunbeam Corp. v. Equity Industries Corp., 635 F.Supp. 625 (E.D.Va.1986), 155
- Sun-Fun Products, Inc. v. Suntan Research & Development Inc., 656 F.2d 186 (5th Cir. 1981), 386
- Sunrise Jewelry Mfg. Corp. v. Fred S.A., 175 F.3d 1322 (Fed.Cir.1999), 248
- Synergistic Intern., LLC v. Korman, 470 F.3d 162 (4th Cir.2006), 711

- Tabor v. Ulloa, 323 F.2d 823 (9th Cir.1963), 297
- Taco Cabana Intern., Inc. v. Two Pesos, Inc., 932 F.2d 1113 (5th Cir.1991), 283
- Tally-Ho, Inc. v. Coast Community College Dist., 889 F.2d 1018 (11th Cir.1989), 89
- Tamko Roofing Products, Inc. v. Ideal Roofing Co., Ltd., 282 F.3d 23 (1st Cir.2002), 711
- Taubman Co. v. Webfeats, 319 F.3d 770 (6th Cir.2003), 686
- TCPIP Holding Co., Inc. v. Haar Communications, Inc., 244 F.3d 88 (2nd Cir.2001), 479
- Team Tires Plus, Ltd. v. Tires Plus, Inc., 394 F.3d 831 (10th Cir.2005), 402
- Teledyne Industries, Inc., In re, 696 F.2d 968 (Fed.Cir.1982), 273
- TE-TA-MA Truth Foundation-Family of URI, Inc. v. World Church of Creator, 297 F.3d 662 (7th Cir.2002), 248
- Texas Pig Stands, Inc. v. Hard Rock Cafe Intern., Inc.**, 951 F.2d 684 (5th Cir.1992), 701
- THOIP v. Walt Disney Co., 690 F.Supp.2d 218 (S.D.N.Y.2010), 496
- Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277 (7th Cir.1998), 302
- Thrifty Rent-A-Car System, Inc. v. Thrift Cars, Inc., 639 F.Supp. 750 (D.Mass.1986), 89, 111
- Tiffany & Co. v. Tiffany Productions, 147 Misc. 679, 264 N.Y.S. 459 (N.Y.Sup.1932), 476
- Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2nd Cir.2010), 459
- Torkington, United States v.**, 812 F.2d 1347 (11th Cir.1987), 735
- Trade-Mark Cases, In re**, 100 U.S. 82, 10 Otto 82, 25 L.Ed. 550 (1879), 33
- Traffix Devices, Inc. v. Marketing Displays, Inc.**, 532 U.S. 23, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001), 316
- Triangle Publications v. Rohrlach, 167 F.2d 969 (2nd Cir.1948), 507
- Truck Equipment Service Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir.1976), 273, 276
- Twentieth Century Fox Film Corp. v. Dastar Corp., 68 U.S.P.Q.2d 1536, 2003 WL 22669587 (C.D.Cal.2003), 29
- Twentieth Century Fox Film Corp. v. Entertainment Distributing, 429 F.3d 869 (9th Cir.2005), 28
- Twin Peaks Productions, Inc. v. Publications Intern., Ltd., 996 F.2d 1366 (2nd Cir.1993), 353
- Two Pesos, Inc. v. Taco Cabana, Inc.**, 505 U.S. 763, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992), 276
- Ty Inc. v. Perryman**, 306 F.3d 509 (7th Cir. 2002), 482
- U-Haul Intern., Inc. v. WhenU.com, Inc., 279 F.Supp.2d 723 (E.D.Va.2003), 675
- Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366 (7th Cir.1976), 152, 389
- Union Nat. Bank of Texas, Laredo, Tex. v. Union Nat. Bank of Texas, Austin, Tex., 909 F.2d 839 (5th Cir.1990), 90
- United Drug Co. v. Theodore Rectanus Co.**, 248 U.S. 90, 39 S.Ct. 48, 63 L.Ed. 141 (1918), 83
- United Industries Corp. v. Clorox Co.**, 140 F.3d 1175 (8th Cir.1998), 753
- United States v. \_\_\_\_\_ (see opposing party)**
- United States Golf Ass'n v. St. Andrews Systems, Data-Max, Inc., 749 F.2d 1028 (3rd Cir.1984), 17
- University Book Store v. University of Wisconsin Board of Regents, 33 U.S.P.Q.2d 1385, 1994 WL 747886 (Trademark Tr. & App. Bd.1994), 399
- University of Pittsburgh v. Champion Products Inc., 686 F.2d 1040 (3rd Cir.1982), 399
- U.S. Gypsum Co., United States v., 333 U.S. 364, 68 S.Ct. 525, 92 L.Ed. 746 (1948), 383
- Valente-Kritzer Video v. Pinckney, 881 F.2d 772 (9th Cir.1989), 269
- Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed.Cir.2002), 322, 323
- Van Camp Sea Food Co. v. Alexander B. Stewart Organizations, 18 C.C.P.A. 1415, 50 F.2d 976 (Cust. & Pat.App.1931), 152
- Van Camp Sea Food Co. v. Westgate Sea Products Co., 28 F.2d 957 (9th Cir.1928), 152
- Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd., 50 F.3d 189 (3rd Cir.1995), 273
- Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264 (4th Cir.2001), 662
- Visa Intern. Service Ass'n v. JSL Corp., 610 F.3d 1088 (9th Cir.2010), 498
- Vogue Co. v. Thompson-Hudson Co., 300 F. 509 (6th Cir.1924), 390, 672
- Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350 (9th Cir.1969), 564
- Vornado Air Circulation Systems, Inc. v. Duracraft Corp., 58 F.3d 1498 (10th Cir.1995), 315
- Vuitton Et Fils S.A. v. J. Young Enterprises, Inc., 644 F.2d 769 (9th Cir.1981), 313, 325
- Waldman Pub. Corp. v. Landoll, Inc., 43 F.3d 775 (2nd Cir.1994), 26
- Wal-Mart Stores, Inc. v. Samara Bros., Inc.**, 529 U.S. 205, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000), 303, 450
- WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.**, 101 F.3d 259 (2nd Cir.1996), 71
- WCVB-TV v. Boston Athletic Ass'n, 926 F.2d 42 (1st Cir.1991), 398, 449, 564
- W. E. Bassett Co. v. Revlon, Inc., 435 F.2d 656 (2nd Cir.1970), 386, 711
- Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512 (Cust. & Pat.App.1980), 112
- Wells Fargo & Co. v. WhenU.com, Inc., 293 F.Supp.2d 734 (E.D.Mich.2003), 675

- White v. Samsung Electronics America, Inc.**, 989 F.2d 1512 (9th Cir.1993), **817**  
**White v. Samsung Electronics America, Inc.**, 971 F.2d 1395 (9th Cir.1992), **810**  
Wickard v. Filburn, 317 U.S. 111, 63 S.Ct. 82, 87 L.Ed. 122 (1942), 39  
William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526, 44 S.Ct. 615, 68 L.Ed. 1161 (1924), 457  
W.T. Rogers Co., Inc. v. Keene, 778 F.2d 334 (7th Cir.1985), 273  
Wyeth v. Levine, — U.S. —, 129 S.Ct. 1187, 173 L.Ed.2d 51 (2009), 269
- Yale Elec. Corp. v. Robertson, 26 F.2d 972 (2nd Cir.1928), 375  
Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC, 259 F.3d 25 (1st Cir.2001), 310  
Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977), 839  
**Zatarains, Inc. v. Oak Grove Smokehouse, Inc.**, 698 F.2d 786 (5th Cir.1983), **137**  
**Zazu Designs v. L'Oreal, S.A.**, 979 F.2d 499 (7th Cir.1992), **52**, 735  
Zyla v. Wadsworth, Div. of Thomson Corp., 360 F.3d 243 (1st Cir.2004), 29

**CASES AND MATERIALS ON  
TRADEMARK LAW**

# SUMMARY OF CONTENTS

---

|                                                                                 | Page       |
|---------------------------------------------------------------------------------|------------|
| TABLE OF CASES .....                                                            | xiii       |
| <b>Chapter 1. Introduction</b> .....                                            | <b>1</b>   |
| A. Competition: Fair and Unfair .....                                           | 1          |
| B. The Constitutional Basis of Federal Trademark Protection .....               | 32         |
| C. Perspectives on Trademark Policy .....                                       | 40         |
| <b>Chapter 2. Prerequisites for Trademark Protection: Use</b> .....             | <b>46</b>  |
| A. The Traditional Use Requirement .....                                        | 46         |
| B. Analogous Use .....                                                          | 62         |
| C. Federal Registration and the Intent to Use Alternative .....                 | 68         |
| <b>Chapter 3. The Geographic Scope of Trademark Rights</b> .....                | <b>83</b>  |
| A. The Common Law Approach .....                                                | 83         |
| B. Federal Registration and Geographic Scope .....                              | 90         |
| C. International Use and Domestic Rights .....                                  | 112        |
| <b>Chapter 4. Prerequisites for Trademark Protection: Distinctiveness</b> ..... | <b>136</b> |
| A. Descriptive Marks and the Spectrum of Distinctiveness .....                  | 137        |
| B. Generic Words .....                                                          | 156        |
| C. Primary Merely a Surname .....                                               | 190        |
| D. Deceptive Marks: Materially False Information .....                          | 199        |
| E. Primarily Geographically Deceptively Misdescriptive Marks .....              | 202        |
| F. Objectionable Marks .....                                                    | 212        |
| G. Federal Registration and Distinctiveness: Presumptions of Validity ...       | 234        |
| <b>Chapter 5. The Protection of “Trade Dress”</b> .....                         | <b>250</b> |
| A. The Common Law’s Protection of “Trade Dress” .....                           | 252        |
| B. The Preemption of State Law Protection of Trade Dress .....                  | 261        |
| C. The Rise of Federal Trade Dress Claims .....                                 | 274        |
| <b>Chapter 6. Trademark Ownership</b> .....                                     | <b>330</b> |
| A. Initial Ownership .....                                                      | 330        |
| B. Owning Trademarks by Purchase: Assignments .....                             | 336        |
| C. Licensing of Trademarks and the Naked License Doctrine .....                 | 353        |
| D. Loss of Trademark Rights: Abandonment by Nonuse .....                        | 360        |

|                                                           | <b>Page</b> |
|-----------------------------------------------------------|-------------|
| <b>Chapter 7. Trademark Infringement</b> .....            | <b>374</b>  |
| A. The Basic Standard: Likelihood of Confusion .....      | 374         |
| B. Expanding the Reach of “Likelihood of Confusion” ..... | 390         |
| C. Parody: A Special Case? .....                          | 431         |
| D. Secondary Liability .....                              | 450         |
| <b>Chapter 8. Dilution</b> .....                          | <b>461</b>  |
| A. State Approaches to Dilution .....                     | 462         |
| B. The Rise of Federal Dilution Claims .....              | 478         |
| C. Parody and Dilution .....                              | 523         |
| <b>Chapter 9. Trademark Defenses</b> .....                | <b>536</b>  |
| A. Fair Use .....                                         | 536         |
| B. Descriptive Use and Nominative Fair Use .....          | 548         |
| C. Laches, Estoppel, and Acquiescence .....               | 567         |
| D. The First Amendment .....                              | 589         |
| <b>Chapter 10. Trademarks on the Internet</b> .....       | <b>603</b>  |
| A. Trademark Rights on the Internet .....                 | 604         |
| B. Cyber-Gripping .....                                   | 645         |
| C. The Use of Trademarks in Search Engines .....          | 662         |
| <b>Chapter 11. Remedies</b> .....                         | <b>687</b>  |
| A. Injunctive Relief: Preliminary and Permanent .....     | 687         |
| B. Monetary Damages and Attorneys’ Fees .....             | 696         |
| C. The Special Case of Reverse Confusion .....            | 714         |
| D. Counterfeit Goods .....                                | 735         |
| <b>Chapter 12. False and Misleading Advertising</b> ..... | <b>743</b>  |
| A. “False or Misleading” .....                            | 743         |
| B. Materiality and Puffery .....                          | 768         |
| <b>Chapter 13. The Right of Publicity</b> .....           | <b>785</b>  |
| A. Origins and Justifications .....                       | 785         |
| B. Expansion .....                                        | 807         |
| C. Limits .....                                           | 822         |
| INDEX .....                                               | 845         |