

INTELLECTUAL PROPERTY

McCarthy on Trademarks and Unfair Competition

J. Thomas McCarthy

Intellectual Property Library

**McCarthy on Trademarks
and Unfair Competition**

J. Thomas McCarthy
Fourth Edition

Volume 1



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**McCARTHY ON TRADEMARKS
AND UNFAIR COMPETITION 4th**

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About the Author

J. Thomas McCarthy is a Senior Professor at the University of San Francisco School of Law, where he has taught for over thirty-five years. He is the Founding Director of the McCarthy Institute for Intellectual Property and Technology Law located at the University of San Francisco. He has practiced, written and taught in the field of trademarks and unfair competition and is a frequent speaker on the subject. He is a member of the California and the U.S. Supreme Court Bars and is admitted to practice before the Patent and Trademark Office.

He is an of counsel consultant with the law firm of Morrison & Foerster. He was a member of the A.L.I. Advisory Committee involved in drafting the 1995 Restatement of the Law of Unfair Competition, was a member of the Trademark Review Commission, which drafted the 1989 revisions to the Lanham Act, and has served for several years on the Editorial Board of *The Trademark Reporter*.

McCarthy was the recipient of: the 2003 President's Award of the International Trademark Association; the 2000 Pattishall Medal for excellence in teaching trademark law from the Brand Names Education Foundation; the 1997 Ladas Professional Author Award from the Brand Names Education Foundation; the Centennial Award in Trademark Law from the American Intellectual Property Law Association in 1997; the 1994 Jefferson Medal from the New Jersey Intellectual Property Law Association; the 1979 Rossman Award of the Patent and Trademark Office Society; and the 1965 Watson Award of the American Intellectual Property Law Association. He delivered: the 1999 Niro Lecture at DePaul Law School; the 1997 Tenzer Lecture at Cardozo Law School; the 1995 H.S. Manges Lecture at Columbia University; and the 1989 Boal Memorial Lecture for the Brand Names Education Foundation. He was the 1994 Biebel & French Distinguished Visiting Scholar in Law & Technology at the University of Dayton.

McCarthy's other books include the two-volume treatise *The Rights of Publicity and Privacy* (2d ed. 2000) (also

published by West), and McCarthy's Desk Encyclopedia of Intellectual Property (with Schechter & Franklyn) (3d ed. 2004).

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Preface to Fourth Edition

It has now been thirty-four years since the first edition of this treatise was published. Originally two volumes, it has grown to seven volumes to accommodate the explosion of case law precedent, statutory amendments and technological changes. While I continually strive to keep the coverage terse and concise, trademark law has grown continually more complex.

The explosive growth of trademark law in the last thirty years has been nothing short of astonishing. When I first wrote the book, trademark law was largely the preserve of “patent lawyers,” with only a handful of trademark-only specialists in New York and Washington, D.C. Today, thousands of practitioners across the nation practice trademark law.

Trademark law is now front-page news because trademarks are now, more than ever, an exceedingly valuable form of intellectual property. Part of this is, I think, due to an increasingly competitive global business environment, where there is a critical need for every seller to carve out a distinctive identity in a world market crowded with competitors.

I originally wrote the treatise to provide judges, attorneys, and students with a comprehensible and authoritative source in which to find and understand trademark and unfair competition law. Therefore, I am immensely pleased that this treatise has been frequently cited by the courts and the USPTO as authority. Over 3000 judicial decisions have cited and relied upon this treatise. This includes citation by the U.S. Supreme Court in nine cases and by every federal court of appeals.

Acknowledgement is due to the valuable assistance of my student researchers who aided me in keeping the Third Edition up to date prior to publication of the Fourth Edition in 1996: Cynthia R. Baroumand; Kevin C. Delaney; Jennifer R. Dupre; Susan Kay Faris; Heather Friedman; Gabrielle A. Holey; Elizabeth E. Launer; Benjamin P. Oelsner; and Lisa A. Palter. Students who have assisted me since 1996 in keep-

PREFACE

ing the Fourth Edition up to date are listed on the “Acknowledgements” page.

J. Thomas McCarthy
San Francisco, California
May, 2008

Table of Abbreviations

A.B.A.J.	American Bar Association Journal
A.L.R.	American Law Reports, Annotated
A.L.R.2d	American Law Reports, Annotated, Second Series
A.L.R.3d	American Law Reports, Annotated, Third Series
A.L.R.4th	American Law Reports, Annotated, Fourth Series
A.L.R. Fed	American Law Reports, Annotated, Federal
Am. Jur.	American Jurisprudence
Am. Jur. 2d	American Jurisprudence, Second Series
Am. Jur. Trials	American Jurisprudence, Trials
Am. U.L. Rev.	American University Law Review
Am. Rep	American Reports (1868--1876)
App. Div. 2d	New York Supreme Court, Appellate Division, Reports, Second Series
A.P.L.A.J.	American Patent Law Association Journal
Barb.	Barbour's New York Supreme Court Reports (1847--1876)
Bull. C.R. Soc'y	Bulletin of the Copyright Society
Fed. Cir.	Court of Appeals for the Federal Circuit (1982--)
Cal.	California Reports (California Supreme Court)
Cal. 2d	California Reports, Second Series (California Supreme Court)
Cal. 3d	California Reports, Third Series (California Supreme Court)
Cal. App.	California Appellate Court Reports
Cal. App. 2d	California Appellate Court Reports, Second Series
Cal. App. 3d	California Appellate Court Reports, Third Series
Cal. Bus & Prof. Code	California Business & Professions Code
Cal. Civ. Code	California Civil Code
Cal. Rptr.	California Reporter (West)
CCPA	United States Court of Customs and Patent Appeals
C.D.	Commissioner's Decisions (U.S. Patent Office)
CFR	Code of Federal Regulations

Ch. D.	Chancery Division, England (1875--1890)
Clev. Mar. L. Rev.	Cleveland Marshall Law Review
Colum. L. Rev.	Columbia Law Review
Comm'r Pats.	Commissioner of Patents
Comm. P.T.	Commissioner of Patents and Trademarks (1975--)
Conn. B.J.	Connecticut Bar Journal
Cornell L.Q.	Cornell Law Quarterly
D.L.R.	Dominion Law Reports (Canada 1912--1955)
Duke L.J.	Duke Law Journal
Eur. Intel. Prop. Rev.	European Intellectual Property Review
Eng. Rep.	English Reports (1307--1865)
Ex. Ch.	Patent Office Examiner in Chief
F.	Federal Reporter
F.2d	Federal Reporter, Second Series
F.3d	Federal Reporter, Third Series
F. Supp.	Federal Supplement
F.R.A.P.	Federal Rules of Appellate Procedure
F.R.C.P.	Federal Rules of Civil Procedure
F.R.D.	Federal Rules Decisions
F.R.E.	Federal Rules of Evidence
Fordham L. Rev.	Fordham University Law Review
Geo. Wash. L. Rev.	George Washington University Law Review
Geo. L. Rev.	Georgia Law Review
Harv. Bus. Rev.	Harvard Business Review
Harv. J. Legis.	Harvard Journal on Legislation
Harv. L. Rev.	Harvard Law Review
How. L.J.	Howard University Law Journal
IDEA	Journal of Law and Technology
IIC	International Review of Intellectual Property & Copyright Law)
Ill. App.	Illinois Appellate Court Reports
Ill. App. 2d	Illinois Appellate Court Reports, Second Series (1954--)
Ill. 2d	Illinois Supreme Court Reports, Second Series
I.T.C.	International Trade Commission
J. Pat. Off. Soc'y	Journal of the Patent Office Society
J. Tax	Journal of Taxation
Law & Contemp. Probs	Law and Contemporary Problems Law Review
L. Ed.	United States Supreme Court Reports, Lawyers' Edition
L. Ed. 2d	United States Supreme Court Reports, Lawyers' Edition, Second Series
Loyola Ch. L.J.	Loyola (Chicago) University Law Journal

TABLE OF ABBREVIATIONS

L.R. Ch.	English Law Reports, Chancery (1865--1875)
L.R. Eq.	English Law Reports, Equity (1865--1875)
L.R. QB	Law Reprint Queens Bench England (1865--1875)
Mann & G.	Manning and Granger (England)
Mass. Ann. L.	Massachusetts Annotated Laws
Mich. L. Rev.	Michigan Law Review
Misc.	New York Miscellaneous Reports
N.E.2d	Northeastern Reporter, Second Series
N.J.	New Jersey Reports
N.J. Super.	New Jersey Superior Court Report (1948--)
N.Y.	New York Court of Appeals Reports
N.Y.2d	New York Court of Appeals Reports, Second Series
N.Y.C.P.L.R.	New York Civil Practice Law & Rules
N.Y.S.	New York Supplement
N.Y.S.2d	New York Supplement, Second Series
N.J. Eq.	New Jersey Equity
Nw. U.L. Rev.	Northwestern University Law Review
OG	Official Gazette of the U.S. Patent Office
OGTM	Official Gazette, Trademark Section
Ohio St.	Ohio State Reports (1852-1964)
Ohio St. 2d	Ohio State Reports, Second Series (1964--)
Okla. B.A.J.	Oklahoma Bar Association Journal
Pac. L.J.	Pacific Law Journal (McGeorge School of Law)
Pa. L. Rev.	Pennsylvania Law Review
PEALQ	Publishers, Editors and Advertisers Law Quarterly
P.T.C.J.	Patent, Trademark & Copyright Journal
P.T.C.J. Res. & Ed.	Patent, Trademark & Copyright Journal of Research & Education
PTO	Patent and Trademark Office
S. Ct.	Supreme Court Reporter
So. Cal. L. Rev.	Southern California Law Review
Stan. L. Rev.	Stanford Law Review
T.B.M.P.	Trademark Board Manual of Procedure (U.S. Patent and Trademark Office)
T.I.A.S.	Treaties and Other International Acts Series
T.M.E.P.	Trademark Manual of Examining Procedure (U.S. Patent and Trademark Office)
Trademark Rep.	Trademark Reporter
T.M.R.P.	Trademark Rules of Practice of the U.S. Patent and Trademark Office (Title 37, C.F.R.)

McCARTHY ON TRADEMARKS

TTAB	Trademark Trial and Appeal Board (U.S. Patent and Trademark Office)
UCLA L. Rev.	University of California at Los Angeles Law Review
U. Pa. L. Rev.	University of Pennsylvania Law Review
U.S.	United States Supreme Court Reports
U.S.C.	United States Code
U.S.C.A.	United States Code, Annotated
U.S.C.C.A.N.	United States Code, Congressional and Administrative News
U.S.F. L. Rev.	University of San Francisco Law Review
USPQ	United States Patent Quarterly
USPQ2d	United States Patent Quarterly, Second Series (1987--)
U.S.T.	United States Treaties
Va. L. Rev.	Virginia Law Review
Vand. L. Rev.	Vanderbilt Law Review
Vill. L. Rev.	Villanova Law Review
Wash. App.	Washington (State) Appellate Reports
Wash. U.L.Q.	Washington University Law Quarterly
Yale L.J.	Yale Law Journal

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