# Trademark Law - Spring 2023 Professor Tom McThenia, Jr.

**Law # 6575**

**3 Credits**

# Required Text

The required text for this course is Dinwoodie and Janis, Trademarks and Unfair Competition **6th** Edition (2022) (HARDCOVER or e-book).

Some reading assignments may also be taken from the Trademark Manual Examining Procedure (“TMEP”), July 2022 (currently available at <https://tmep.uspto.gov/RDMS/TMEP/current>).

Other handouts or materials may be assigned during the semester.  You may access supplemental materials and view other course related information on the course CANVAS page. You are required to register on CANVAS by the end of the drop/add period for the semester.

# Classes

Classes will be held on Thursdays from 5:15 PM EST to 6:40 PM EST and

Fridays from 9:00 AM to 10:25 AM EST in Holland Hall, Room 270

# Office Hours

My office hours are on Thursdays from 4:00 p.m.- 5:15 p.m.

For your convenience, I am available throughout the week via Zoom. Please e-mail me to set up a mutually convenient time.

# Contact Information

My office is in Room TBD and my telephone number is (407) 832-8393. My e-mail address is [mcthenia@law.ufl.edu](mailto:mcthenia@ulf.law.edu) and [tom.mcthenia@gray-robinson.com](mailto:tom.mcthenia@gray-robinson.com). My law firm address is preferred as I check it regularly. I strongly encourage you to contact me regularly during the semester and to ask any questions that you may have about the course or even more generally about the practice of law.

**Course Description**

In this course we will explore the legal principles and policies of trademark law. The topics to be covered are listed in the assignment chart provided at the end of this syllabus. Please note that this course does not cover trademark practice.

**Student Learning Outcomes**

By the end of this course students will be able to:

* Explain the function, purpose and characteristics of trademarks.
* Explain the requirements for selecting and creating a valid trademark.
* Classify trademark based on their level of distinctiveness.
* Explain exclusions from trademark protection and registration.
* Explain the overview of the trademark application and prosecution process.
* Explain the international trademark process.
* Identify trade dress and its requirements.
* Describe trademark confusion and infringement.
* Identify the differences between confusion and dilution.
* Explain the role of parody as a defense to infringement.

1. Class Preparation and Participation

Preparation for class is mandatory. Before each class you must complete the assigned reading assignments and be prepared to provide thoughtful answers to questions asked during class.

Note that ABA Standard 310 requires that students devote 2 hours of out-of-class preparation for every “classroom hour” of in-class instruction. Therefore, for this 3-credit course, I expect that you will spend at least 6 hours of preparation outside of class each week. This should include very careful and thorough reading and preparation of assignments prior to each class, as well as review of your notes and class materials after each class session.

I expect you to participate meaningfully, professionally, and effectively in this course.  Exceptional preparation and participation may, at our discretion, be rewarded with an increase of your final course grade by up to one letter grade. Conversely, those who are consistently unprepared and/or who do not participate meaningfully and professionally in class could be penalized with a deduction of up to one letter grade. My assessment of the strength of your participation in the course includes, but is not limited to, such factors as the quality of classroom comments, the amount of interest demonstrated in the subject, degree of preparation for class and willingness to respond to questions, demonstration of active engagement of the material via application to contemporaneous events, class attendance, disruptive, distracting, or unprofessional behavior in the classroom, and observance of course policies.

While I encourage the free exchange of ideas and opinions in class, expressions of disagreement must be made in a professional manner that is respectful of your classmates.

Conducting yourselves in a professional manner also means not engaging in any behavior during class that may distract us or your classmates. **This includes, but is not limited to, playing computer games, surfing the web, sending e-mails, and any other use of your computers during class that does not involve note taking.** Your failure to comply with this policy may be subject to the grade deduction for participation described above, your removal from the classroom, and/or loss of your privilege to use a laptop in the classroom.

1. Class Attendance 1

Attendance is required by both the ABA and the Law School. I expect you to be on time and remain seated throughout the class period unless you have an urgent need to leave the room.

It is your responsibility to ensure that your attendance is recorded accurately. Do not misrepresent your class attendance or assist a classmate in such misrepresentation.

You will be barred from taking the final exam and will automatically failthis course if you have six (6) or more unexcused absences. If you have four (4) to five (5) absences, I may reduce your grade as described above in the section describing grade adjustments for course participation.

**Policy Related to Make-up Exams or Other Work**

The law school policy on delays in taking exams can be found at: <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies>.

**University Policy on Accommodating Students with Disabilities**

A. Students requesting accommodation for disabilities must first register with the Disability Resource Center (<https://disability.ufl.edu/>). Once registered, students will receive an accommodation letter, which must be presented to the Assistant Dean for Student Affairs (Assistant Dean Brian Mitchell). Students with disabilities should follow this procedure as early as possible in the semester.

B. Students with disabilities who experience learning barriers and would like to request academic accommodations should connect with the Disability Resource Center at: <https://disability.ufl.edu/> to get started with the Disability Resource Center. It is important for students to share their accommodation letter with their instructor and discuss their access needs as early as possible in the semester.

**University Policy on Academic Misconduct**

Academic honesty and integrity are fundamental values of the University community. Students should be sure that they understand the UF Student Honor Code at: <https://sccr.dso.ufl.edu/policies/student-honor-code-student-conduct-code>.

**Grading**

This course follows the Levin College of Law’s grading policies. I anticipate that your final course grade will be based on the final exam (50%); assigned projects (40%), subject to modification; class participation (10%); conduct, and attendance as described above. Note that the type of final examination may be subject to change due to COVID-19 uncertainties.

After course grades have been posted, you may review your exam beginning after the first week of the following semester. All exam reviews will be conducted at a mutually agreed time in our office, and you may arrange an appointment by e-mail.

The law school grading policies are available at: <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies>.

**Class Recording Policy**

The Office of Student Affairs will continue to record all classes in case students must miss class for health reasons. The Office of Student Affairs will determine when students may have access to these recordings, and the recordings will be password protected. These recordings will be retained only for a short period of time and it is the student’s responsibility to contact the Office of Student Affairs as soon as possible after an absence.

**Recording Devices and Cell Phones**

Students are allowed to record video or audio of class lectures. However, the purposes for which these recordings may be used are strictly controlled.  The only allowable purposes are (1) for personal educational use, (2[[1]](#footnote-1)) in connection with a complaint to the university, or (3) as evidence in, or in preparation for, a criminal or civil proceeding.  All other purposes are prohibited.  Specifically, students may not publish recorded lectures without the written consent of the instructor.

A “class lecture” is an educational presentation intended to inform or teach enrolled students about a particular subject, including any instructor-led discussions that form part of the presentation, and delivered by any instructor hired or appointed by the University, or by a guest instructor, as part of a University of Florida course. A class lecture does not include lab sessions, student presentations, clinical presentations such as patient history, academic exercises involving solely student participation, assessments (quizzes, tests, exams), field trips, private conversations between students in the class or between a student and the faculty or lecturer during a class session.

Publication without permission of the instructor is prohibited. To “publish” means to share, transmit, circulate, distribute, or provide access to a recording, regardless of format or medium, to another person (or persons), including but not limited to another student within the same class section. Additionally, a recording, or transcript of a recording, is considered published if it is posted on or uploaded to, in whole or in part, any media platform, including but not limited to social media, book, magazine, newspaper, leaflet, or third-party note/tutoring services. A student who publishes a recording without written consent may be subject to a civil cause of action instituted by a person injured by the publication and/or discipline under UF Regulation 4.040 Student Honor Code and Student Conduct Code.

Other information about UF Levin College of Law policies, including compliance with the UF Honor Code, Grading, Accommodations, Class Recordings, and Course Evaluations can be found at this link:

<https://ufl.instructure.com/courses/427635/files/74674656?wrap=1.>

**University Policy on Student Course Evaluations**

Students are expected to provide professional and respectful feedback on the quality of instruction in this course by completing course evaluations online via GatorEvals. Guidance on how to give feedback in a professional and respectful manner is available at <https://gatorevals.aa.ufl.edu/students/>. Students will be notified when the evaluation period opens, and can complete evaluations through the email they receive from GatorEvals, in their Canvas course menu under GatorEvals, or via <https://ufl.bluera.com/ufl/>. Summaries of course evaluation results are available to students at <https://gatorevals.aa.ufl.edu/public-results/>.

**ASSIGNMENTS**

Below are the reading assignments. I reserve the right to modify the assignments from time to time, and to utilize additional handouts and materials. All assignments are from the required text unless otherwise noted. Where problems or notes are included in the assignment, be prepared to discuss them in class. On occasion, however, time may not permit such discussion. Your review and preparation of the problems will nevertheless be a helpful exercise.

Reading Materials: 1) Trademark Manual Examining Procedure (TMEP); 2) McCarthy on Trademarks and Unfair Competition

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| **Class** | **Topic** | **Reading Assignment** |
| 1  Jan 19 | Trademark Overview: Foundations and Purposes of Trademark & Unfair Competition Law; Trademark Federal and State Statutes | CB 3-35; T**rademark Manual Examining Procedure (“TMEP”)** - currently available at USPTO: <https://tmep.uspto.gov/RDMS/TMEP/current>). Read TMEP: 101-102, 106-107; Trademark Functions and Basic Facts About Trademarks: Distinctive Marks <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf> (pp. 6-8); Pamphlet: “Florida Trademark – Service Mark - Registration and Use,” <http://form.sunbiz.org/pdf/Chapter_495_Booklet.pdf> (download and review for overview). |
| 2  Jan 20 | Registration Process: US, State and Federal: Types of Applications: Requirements for an Application: Classes, Identifications of Goods and Services | CB 375-400; Florida Trademark Act: Chapter 495 (read for overview). |
| 3  Jan 26 | Selecting Good Trademarks; The Distinctiveness Spectrum and Secondary Meaning; Generic Terms | CB 43-67, 67-86; McCarthy: 4:13 -15; 11:1-4; 11:5-8; 11:15-18; 11:22,24; 4:13-4:15; 11:1-11:14; 11:50-53; 11:54,59;11:62, 64, 66 11:72-75; TMEP: 1209. |
| 4  Jan 27 | Review of Distinctiveness of Words; Distinctiveness of Non-Verbal Identifiers: Trademark Searching | CB 86-108. |
| 5  Feb 2 | Distinctiveness of Non-Verbal Identifiers (continued); Distinctiveness memo | CB 108-148. |
| 6  Feb 3 | Exotic Subject Matter; Subject Matter Protected by Copyright; Drafting Identification of Goods | CB 153-184. |
| 7  Feb 9 | Introduction to Likelihood of Confusion: Actionable “Use” | CB 551-581. |
| 8  Feb 10 | Likelihood of Confusion: Applying the Factors Analysis | CB 581-595;  CB 600-614. |

1. Only students who are registered in the course are permitted to attend class. Guests are not permitted without my express consent. [↑](#footnote-ref-1)