

TRADEMARK & BRANDING LAW

Fall 2024 Syllabus

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SYLLABUS

Meetings **Location** 103
Class Times T Th 1:45–3:45 p
Office Hours Signups available on Canvas
Calendar <https://www.stu.edu/law/students/academic-calendars/>

Evaluation This is a skills-based course. We will cover substantive black letter law in class but **there is no final exam**. Rather, your evaluation will be based on a client simulation in which you will apply substantive law to solve problems:

Project I	30%
Project II	30%
Project III	30%
Participation & Professionalism	10%

Materials **Required Casebook**
Barton Beebe, *Trademark Law: An Open-Source Casebook* (v. 11.0 July 2024). <https://www.tmcasebook.org>. You may also purchase a hard copy available in two volumes from Amazon for about \$40.00. [Volume I](#), [Volume II](#)

Scope Brand names such as COCA-COLA, NIKE, and APPLE are much more than trademarks: they are icons of modern culture. The core of brand-name law is trademark law, the law governing fair and unfair competition regarding the words and symbols used by businesses for their goods and services. But in an information age, the law of brand names touches far more than hornbook trademark law, including social media branding practices that recruit consumers as soldiers in the corporate branding machine; disruptive technology that makes brand enforcement difficult; and cultural norms that treat brand names as symbols of social status and commentary, such as “this watch is the Mercedes of watches,” or the parodic song “Barbie Girl.” Any attorney who advises businesses in connection with product naming, marketing, or digital outreach should therefore have a solid grounding in the law of trademarks and branding. Accordingly, this course covers major topics in domestic trademark law, such as subject-matter, distinctiveness, genericness, the likelihood of confusion test, dilution, cybersquatting, and enforcement. It also pays close attention to the interplay of technology and law.

The course qualifies for skills credits as well as towards the St. Thomas Law IP certificate.

Outcomes *Trademark & branding law and theory (STU outcomes # 1-3):* Examples include distinctiveness, functionality, genericness, likelihood of confusion, dilution, and defenses such as fair use; transactional issues such as ownership, registration, assignment and licensing; and digital brand-name

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issues such as cybersquatting, UDRP domain name dispute resolution, keyword and metatag infringement.

Integrating law and theory with practice skills and professional values (STU outcomes # 1-7): Developing basic practitioner proficiency in tasks common to trademark/brand-name lawyering and tying professional values into practice.

Professionalism

The Florida Bar has stated that:

Professionalism is the pursuit and practice of the highest ideals and tenets of the legal profession. It embraces far more than simply complying with the minimal standards of professional conduct. The essential ingredients of professionalism are character, competence, commitment, and civility.

Your reputation earned in school follows you; build a good one.

Inclusion

There are no “stupid questions” in my class. Do not be afraid to ask questions, express opinions, or challenge my representations, however, please contribute only after reflection and deliberation. All perspectives and opinions are welcome.

Plagiarism

Outside assistance from others, human, AI, or otherwise, without my express authorization, will not be tolerated. Any violation of this policy constitutes a violation of the *St. Thomas University College of Law Honor Code*.

Attendance

There are no excused absences in this class. Students who are more than fifteen minutes late, or who miss more than fifteen minutes of class time are absent. I reserve the right to lock the door at the start of class or otherwise refuse late entry.

You should not miss class. You are, however, permitted to miss 20% of this course's class sessions under STU College of Law Policy. If you have a personal, family, or other emergency problem that will cause you to miss 20% or more of class sessions, you need to contact Student Affairs as soon as possible.

It is your responsibility to sign the attendance sheet before I leave the classroom as I do not retroactively change the attendance sheet. No exceptions.

Tardiness

A professional arrives early and never makes excuses. Late students are not admitted as I lock the door at the start of lecture starting the second week of classes. Habitual tardiness or unpreparedness will not be tolerated.

Technology

The Florida Bar wants technologically competent lawyers. You are free to use technology in whatever manner you deem, in your reasonable judgment, best to advance your professional development in my class, if you do so in a manner that does not distract your classmates from their own academic success.

You are not permitted to record or photograph class discussions or materials.

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- Disability** If you believe you need or are entitled to receive accommodations due to a disability, contact Student Affairs as soon as possible. See <http://www.stu.edu/law/students/disability-accommodations>.
- Copyright** All class materials constituting my authorship are subject to a [Creative Commons CC-BY-NC-ND 4.0 International License](#). These include my study guides and other practice materials. You are not permitted to record or photograph my PowerPoints or the lecture during class, as I provide you copies with proper attribution. Rights in all other materials are retained by their respective owners.
- Legal** **I am a Florida licensed attorney, but I am not your lawyer.** Please refrain from asking my legal opinion on personal cases or about cases you may be working on at your place of employment as classroom hypotheticals.
- Changes** I reserve the right to amend the syllabus as I deem necessary, for any reason, with written notice to you through Canvas and/or email.

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ASSIGNMENTS

Date	Topics	Casebook
Aug 27	Intro	1–26
29	Inherent Distinctiveness	27–51
Sept 3	Acquired Distinctiveness; Generic Marks; Failure to Function	51–56, 63–81, 120–130
5	Nonverbal Marks I	130–160
10	Nonverbal Marks II	160–178
12	Section 2 Bars: Utilitarian Functionality	178–203, 211–218
17	Section 2 Bars: Aesthetic Functionality; Deceptive	220–246
19	Section 2 Bars: False Connection; Confusing; Disparaging and Scandalous I	246–266
24	Section 2 Bars: Disparaging & Scandalous II	266–302
26	Trademark Registration	324–354
27	Project I Due @ 5:00 PM	
Oct 1	Geographic Boundaries	354–379
3	Actionable Use; Consumer Confusion I	432–456
8	Consumer Confusion II	457–476
10	Survey Evidence; Sponsorship or Affiliation Confusion	476–505
15	Initial Interest Confusion; Post Sale Confusion	515–542
17	Reverse Confusion; Reverse Passing Off	542–578
22	Trademark Dilution I	581–605
24	Trademark Dilution II	605–631
29	Cybersquatting & UDRP	631–663
31	Descriptive Fair Use	695–722
Nov 1	Project II Due @ 5:00 PM	
5	Nominative Fair Use	726–748
7	Expressive Uses	748–764, 766–767, 781–795
12	Trademark Abandonment	809–832
14	Assignments in Gross; The First Sale Doctrine	832–856
19	False Advertising; Endorsements	856–858, 881–898, 926–949
21	Rights of Publicity	954–979
25	Project III Due @ 5:00 PM	