

UNDERSTANDING
TRADEMARK LAW
Third Edition

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*The islands haven't shifted since last summer,
even if I like to pretend they have —
drifting, in a dreamy sort of way,
a little north, a little south, or sidewise —
and that they're free within the blue frontiers of bay.*

—William Butler Yeats

Preface

This text offers a broad introduction to the fundamental principles of the law of trademarks and unfair competition. Although deeply rooted in the common law of torts, modern trademark law has branched in many directions, as evidenced by the development of dilution and cybersquatting laws, as well as state and federal registration systems. Practitioners and students of trademark law today must be familiar with all of these branches and their various sources — which include statutes as well as common law, and federal as well as state law.

Although trademark law has become increasingly federalized since the enactment of the Lanham Act in 1946, the federal law of trademarks and unfair competition has little preemptive effect on state law. As a result, many aspects of trademark and unfair competition law are governed by both state and federal law. The state and federal approaches often converge, and sometimes diverge, but despite the increasing scope of federal trademark and unfair competition law, state law remains important.

However, conflict may arise between, on the one hand, the state and federal regimes of trademark and unfair competition law and, on the other hand, the federal regimes of copyright and patent law. An understanding of trademark law, therefore, requires an understanding of its relationship with these other doctrines — in particular, which applications of trademark or unfair competition law would so interfere with the congressional schemes of patent and copyright protection that the latter must be given preemptive effect, as illustrated by the denial of trademark protection to functional aspects of trade dress.

The law of trademarks and unfair competition constantly evolves in response to changes in commercial markets. For example, the globalization of markets for goods and services has led to the increased internationalization of trademark and unfair competition law. Federal law, for example, now considers certain foreign uses of trademarks in determining priority for federal registration and, conversely, recognizes that certain foreign activities may give rise to infringement claims under the Lanham Act. Federal law has also responded to the explosive growth of the Internet as a means for communication as well as a marketplace for goods and services. Although trademark law has traditionally protected the right of a trademark holder within the specific geographic markets where the mark is in use, such geographic boundaries are less relevant today, as brick-and-mortar locations are supplemented or displaced by Internet commerce. Internet activity can also blur the line between commercial activities subject to trademark regulation and expressive conduct that is protected by the First Amendment. In addition, activities such as keyword advertising and the use of social media raise fundamental questions about the meaning of trademark infringement.

For practitioners and students with no background in trademark and unfair competition law, this text may serve as a free-standing introduction. Those who already have some familiarity with these subjects will find the text to be a handy reference tool. Extensive footnoting and citation to authority is provided throughout, in order to assist those desiring to investigate a particular topic in greater depth.

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