

APPENDIX B

List of files on FOCD

FILE NAME	DESCRIPTION
A-1.rtf	Trademark Sublicense Agreement between Dobson Cellular of Arizona, Inc. and WMC Partners, L.P.
A-2.rtf	Trademark License Agreement between Aspect Electronics, Inc. and Aspect Medical Systems, Inc.
A-3.rtf	Trademark and Content Agreement between CBS Corporation, CBS Worldwide, Inc., and Medscape, Inc.
A-4.rtf	Trademark and Trade Name Agreement between General Electric Company and GE Fuel Cell Systems, LLC
A-5.rtf	Trademark and Service Mark Licensing Agreement between LimToo, Inc. and Limco, Inc.
A-6.rtf	Trademark Transition License Agreement between Terneco Inc. and Newport News Shipbuilding Inc.
A-7.rtf	Digital Audio System License Agreement, Internet Coders Source Code, Trademark, and Know-How License between Liquid Audio, Inc. and Dolby Laboratories Licensing Corporation
A-8.rtf	Trademark License Agreement between Playboy Enterprises, Inc. and Playboy TV International, LLC
A-9.rtf	Sprint Spectrum Trademark and Service Mark License Agreement between Sprint Spectrum L.P. and Alamosa PCS, LLC
A-10.rtf	License Agreement between CBS Corporation and Switchboard Inc.
A-11.rtf	Trademark License Agreement between Netscape Communications Corporation and Cyber-Source Corporation

App. B**CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW**

FILE NAME	DESCRIPTION
A-12.rtf	Trademark Co-License Agreement between Internet World Media, Inc. and internet.com LLC
A-13.rtf	Agreement between Avid Sportswear Inc. and Championship Committee Merchandising Limited
A-14.rtf	World-Wide Trademark Ownership, Use, and Assignment Agreement between Bowater Incorporated and Rexam plc
A-15.rtf	Trademark License Agreement between Hallmark Licensing, Inc. and Odyssey Holdings, L.L.C.
A-16.rtf	Trademark License Agreement between Yahoo! Inc. and Netscape Communications Corporation
A-17.rtf	Trademark License Agreement between ZDNet and ZD Education
A-18.rtf	Trademark License Agreement between Agere Systems Inc. and Lucent Technologies Inc.
A-19.rtf	Trademark License Agreement between WBT Operating LLC and Training Media Operating LLC
A-20.rtf	Trademark Assignment from ValueClick, LLC to Web Ignite Corporation
A-21.rtf	Consent Agreement between Value America, Inc. and Stephen S. Freedman
A-22.rtf	Sub-License of Technology and Trademark Rights between PointCast Japan, L.L.C. and PointCast K.K.
A-23.rtf	Trademark Agreement between Plug Power, LLC and GE Fuel Cell Systems, LLC
A-24.rtf	Agreement between Digital Equipment Corporation and AltaVista Technology, Inc.
A-25.rtf	Trademark License Agreement between PETsMART, Inc. and PETsMART.com, Inc.
A-26.rtf	Trademark Assignment Agreement between Pearle, Inc., Pearle Vision, Inc., Pearle B.V., and Pearle Trust B.V. I.O.
A-27.rtf	Trademark License Agreement between Net2Phone, Inc. and Netscape Communications Corporation

LIST OF FILES ON FOCD

App. B

FILE NAME	DESCRIPTION
A-28.rtf	Trademark Assignment Agreement between emachines, Inc. and Korea Data Systems America, Inc.
A-29.rtf	Bill of Sale between Medscape, Inc. and CompRx, Inc.
A-30.rtf	Technology and Trademark License Agreement by Buy.Com, Inc., Buy.Com UK Limited, and John Lewis plc
A-31.rtf	Amended and Restated License to Use the Air Miles Trade Marks in Canada between Air Miles International Holdings N.V. and Loyalty Management Group Canada Inc.
A-32.rtf	License to Use the Air Miles Trademarks in the United States between Alliance Data Systems Corporation and Air Miles International Holdings N.V.
A-33.rtf	Agreement between Empower Health Corporation and C. Everett Koop, M.D.
A-34.rtf	License and Confidential Information Agreement between Health¬Central.com and Dean Edell, M.D.
A-35.rtf	License Agreement between The Jim Henson Company, Inc. and Odyssey Holdings, Inc.
A-36.rtf	Trademark License Agreement between Sears, Roebuck and Co. and 1129 Holding, Inc.
A-37.rtf	Trademark License Agreement between Avid Sportswear, Inc. and Levi Strauss & Co.
A-38.rtf	Trademark License Agreement between Audiovox Corporation and Audiovox Communications Corporation
A-39.rtf	Trademark License Agreement between Maxwell Shoe Company Inc. and Anne Klein
A-40.rtf	Trademark License Agreement between Balance Bar Company and Jenny Craig, Inc.
A-41.rtf	Patent and Trademark Security Agreement between Digital Angel Corporation and Wells Fargo Business Credit, Inc.
A-42.rtf	License Agreement between Salton, Inc. and Westinghouse Electric Corporation

App. B**CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW**

FILE NAME	DESCRIPTION
A-43.rtf	Trademark License Agreement between Ralph Lauren Home Collection, Inc., Polo Ralph Lauren Corporation, The Polo/Lauren Company, L.P., and WestPoint Stevens, Inc.
A-44.rtf	License Agreement between Ashworth, Inc. and Callaway Golf Company
A-45.rtf	Master Trademark Ownership and License Agreement between NPTest, Inc., Schlumberger Technologies, Inc., Schlumberger Technology Corporation, and Schlumberger BV
A-46.rtf	License Agreement between Fotoball USA, Inc. and Major League Properties, Inc.
A-47.rtf	License Agreement between Mossimo, Inc. and Target Stores
A-48.rtf	Trademark/Service Mark Purchase Agreement between Wynn Resorts, Ltd. and The STAD Trust
A-49.rtf	License Agreement between Sharon Lallouz, Omniscent Corp., and Moar International
A-50.rtf	License Acquisition Agreement between Nimbus Group, Inc. and Omniscent Corp.
A-51.rtf	Trademark License Agreement between Sun Microsystems, Inc. and Inprise Corporation
A-52.rtf	Trademark License Agreement between Dresser, Inc. and Halliburton Company
A-53.rtf	Trademark License Agreement between VCG Holding Corp. and Lowrie Management, LLLP
A-54.rtf	Assignment of Trademarks between Infocure Corporation and Practiceworks Systems, LLC
A-55.rtf	Trademark License Agreement between Lenovo (Beijing) Limited and Bonson Information Technology Limited
A-56.rtf	Trademark License Agreement between Baidu Online Network Technology (Beijing) Co. Ltd. and Beijing Baidu Netcom Science and Technology Co. Ltd.
A-57.rtf	Trademark License Agreement between Hurray! Times Communications (Beijing) Ltd. and Beijing Cool Young Information Technology Co. Ltd.

LIST OF FILES ON FOCD

App. B

FILE NAME	DESCRIPTION
A-58.rtf	Trademark License Agreement between Ctrip Compute Technology (Shanghai) Company Ltd. and Affiliated Chinese Entity
A-59.rtf	Trademark License Agreement and Settlement Agreement and Release between Blondie Rockwell, Inc. and Innovo Azteca Apparel, Inc.
A-60.rtf	Trademarks License Agreement between AstraZeneca AB and Maillefer Instruments Holdings S.A.
A-61.rtf	Trademark License Agreement between Avaya, Inc. and Lucent Technologies Inc.
A-62.rtf	Trademark License Agreement between Focus Media Technology (Shanghai) Co., Ltd. and Shanghai Focus Media Advertisement Co., Ltd.
A-63.rtf	Trademark License Agreement between Guess?, Inc.; Guess? IP Holder L.P.; and Parlux Francesces, Inc.
A-64.rtf	Amended and Restated Trademark License Agreement between Palm Trademark Holding Company L.L.C. and PalmSource Inc.
A-65.rtf	Exclusive Patent, Trademark and Trade Name License Agreement by and between Easy Golf Corporation and Bio-Thrust, Inc.
A-66.rtf	Trademark License Agreement between Lone Star Steel Company, L.P. and Hengyang Valin MPM Steel Tube Co., Ltd.
A-67.rtf	Trademark License Agreement between Time Warner, Inc. and Time Warner Telecom Inc.
A-68.rtf	Trademark License and Services Agreement between Vita Ventures, LLC and G-Nutritional, LLC
A-69.rtf	Trademark License between Dominion Entertainment, Inc. and BCI Eclipse Company LLC
A-70.rtf	Trademark License Agreement between The Island Real Estate Group, Inc. and Island Retail Real Estate Trust, Inc.
A-71.rtf	Publisher Trademark License Agreement between R.H. Donnelley Publishing & Advertising, R.H. Donnelley Directory Company, and Embarq Corporation

App. B**CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW**

FILE NAME	DESCRIPTION
A-72.rtf	Trademark License Agreement between Embarq Directory Trademark Company LLC, R.H. Donnelley Publishing & Advertising, Inc., CenDon LLC, and R.H. Donnelley Directory Company
A-73.rtf	Trademark Assignment and License Agreement between Sprint Nextel Corporation and Embarq Corporation
A-74.rtf	Trademark License Agreement between Sankosha Engineering Co. Ltd. and Alliance Laundry Systems LLC
A-75.rtf	Trademark License Agreement between Stride Rite Corporation and Timmy Hilfiger Licensing, Inc.
A-76.rtf	Reseller Agreement between Transparency Systems, Inc. and DigitalFX International, Inc.
A-77.rtf	License Agreement between BioAlliance Pharma SA and Par Pharmaceutical, Inc.
A-78.rtf	IR Trademark License Agreement between International Rectifier Corporation and Vishay Intertechnology, Inc.
A-79.rtf	Trademark License Agreement between Solvay Pharmaceuticals, Inc. and Jazz Pharmaceuticals, Inc.
A-80.rtf	IMN Trademark License Agreement between IMN Data Storage Holdings C.V. and TDK Corporation
A-81.rtf	Trademark License Agreement between Inspire Pharmaceuticals, Inc. and InSite Vision Inc.
A-82.rtf	Trademark License and Purchase Agreement between One Seven Props and Nascent Wine Company, Inc.
A-83.rtf	Trademark Assignment and Agreement between Vicis Capital Master Fund and Medical Media Television, Inc.
A-84.rtf	Contract Related to the Co-Existence of Trademarks Between Jeanne Lanvin Corporation and Inter Parfums, Inc.
A-85.rtf	Trademark License Agreement between Grubb & Ellis Company and Grubb & Ellis Realty Advisors

LIST OF FILES ON FOCD

App. B

FILE NAME	DESCRIPTION
A-86.rtf	Trademark License Agreement between GSCP (NJ) L.P. and GSC Investment Corp.
A-87.rtf	Professional Service and License Agreement between Challenger Powerboats, Inc. and Pininfarina Extra USA Corp.
A-88.rtf	Trademark License Agreement between China Mobile Ltd. and China Mobile Communications Corp.
A-89.rtf	Publishing Agreement between Windstream Corporation and Windstream Yellow Pages, Inc.
A-90.rtf	Buffalo Wild Wings® Franchise Agreement between Buffalo Wild Wings International, Inc. and AMC Port Huron, Inc.
A-91.rtf	Trademark License Agreement between FMC Technologies, Inc. and John Bean Technologies Corporation
A-92.rtf	Trademark Assignment and Coexistence Agreement between FMC Technologies, Inc. and John Bean Technologies Corporation
A-93.rtf	Assignment of Trademark by Implantable Vision, Inc. to BT Acquisitions, Inc.
A-94.rtf	Trademark License Agreement between J. Lindeberg AB and J. Lindeberg USA, LLC
A-95.rtf	Trademark and Research License Agreement between National Corn Growers Association and National Renewable Energy Investment Fund, Inc.
A-96.rtf	Agreement of Transfer of Trademark Application Rights between Vita Spirits, Inc. and Vita Spirits Corp.
A-97.rtf	Trademark License Agreement between The Goodyear Tire & Rubber Company and Titan Tire Corporation
A-98.rtf	Trademark License Agreement between CDC Corporation and CDC Software Corporation
A-99.rtf	Trademark Assignment between Exmovere Holdings, Inc. and Exmovere LLC
A-100.rtf	License Agreement between Synergistic Holdings, LLC and Accelerated Acquisitions IV, Inc.

App. B**CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW**

FILE NAME	DESCRIPTION
A-101.rtf	Master License Agreement between Fossil, Inc. and Fossil Partners, L.P.
A-102.rtf	Trademark License Agreement Executed Version between TruGreen Companies LLC and TruGreen LandCare LLC
A-103.rtf	Patent, Trademark and Copyright Assignment and Assumption between Wilmington Trust Company and PNC Bank
A-104.rtf	Trademark License Agreement between Fujian Xiniya Garments and Weaving Co., Ltd. and Shuochen Apparels Development Co., Ltd.
A-105.rtf	Trademark License Agreement between Fifth Street Capital LLC and Fifth Street Senior Floating Rate Corp.
A-106.rtf	Trademark License Agreement between NRG Energy, Inc. and NRG Yield, Inc.

Table of Laws and Rules

UNITED STATES CONSTITUTION

Sec.		Sec.	
Art. 1, § 8.....	5:5	Art. 8, § 8	12:4
Art. III	12:9		

COMMUNICATIONS DECENCY ACT OF 1996

Sec.		Sec.	
230(c)(1).....	15:16		

FAIR LABOR STANDARDS ACT

Sec.	Sec.	Sec.	Sec.
6.....	24:2	12	24:2
7.....	24:2		

LANHAM ACT

Sec.	Sec.	Sec.	Sec.
1.....	6:8	13(b).....	7:7
2.....	5:14	14.....	3:8, 6:25
2(3)(4).....	5:20	14(5).....	4:3
2(a).....	5:11, 5:12	15	6:23
2(c).....	5:13	16	6:19
2(d).....	2:11	17	6:18
2(f).....	5:9, 5:22, 6:9, 7:1	18	5:16
4.....	4:3	21	6:16
5.....	2:9, 17:2, 17:13	29.....	7:2, 12:16
8.....	6:21, 20:4	32	17:11
9.....	6:21	32(1).....	12:2, 15:6
10.....	3:6, 7:13	32(2)	12:15
13(a).....	7:7	33.....	4:16, 12:2, 17:11

Tbl of L&R-1

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

LANHAM ACT—Continued

Sec.	Sec.	Sec.	Sec.
33(a)	2:4, 6:1	43(a)(3).....	4:16
33(b).....	2:4, 6:1, 6:17	43(b).....	12:3
33(b)(4).....	12:22	43(c).....	10:2, 10:7, 17:11
34(d).....	11:4	43(c)(1)	10:4
35	11:8	43(c)(2)(A),(B)	10:15
35(a)	12:16, 12:18, 14:17	43(c)(2)(C).....	10:14
35(b).....	11:8	43(c)(3).....	10:16
35(c).....	11:8	43(c)(3)(A)(1)	8:18
36	11:8, 12:20	43(d)	8:1, 14:3, 14:10, 14:14
37	3:8, 7:8, 12:19	43(d)(1)(A)(II)	14:10
38.....	6:26, 7:8	43(d)(2).....	14:16
39	12:5	43(d)(2)(D)	14:18
42	7:17	44.....	6:14, 21:2
43	17:2	44(e).....	6:14
43(a)	5:1, 8:7, 12:3, 13:8, 13:14, 13:15, 13:19, 15:6, 15:9, 17:11, 17:12	45	3:2, 3:5, 4:1, 4:2, 4:3, 4:4
43(a)(1)	12:3, 13:1, 13:8	47	14:4, 14:14
43(a)(1)(B).....	13:1	49	14:10
		1060.....	20:8

TARIFF ACT OF 1930

Sec.	Sec.
526	8:17

UNITED STATES CODE ANNOTATED

11 U.S.C.A. Sec.	Sec.	15 U.S.C.A. Sec.	Sec.
362	20:4	47	14:14
362(a)(1).....	20:4	111.....	12:16
365	20:10, 24:2	117(a)	12:18
365(c)(1).....	24:2	1050 et seq.	27:2
365(n).....	20:11	1051 et seq.	12:16
523(a)(6)	20:16	1051(a)	6:8
541(a)(1).....	20:2	1051(b)	6:8
14 U.S.C.A. Sec.	Sec.	1052.....	5:14
1115(b)	2:4	1052(a)	5:11, 5:12
15 U.S.C.A. Sec.	Sec.	1052(c)	5:13
35(d)	14:17	1052(d)	2:11
35(e)	14:17	1052(e)(4).....	5:20
		1052(f).....	5:9, 5:22, 6:9

TABLE OF LAWS AND RULES

UNITED STATES CODE ANNOTATED—Continued

15 U.S.C.A. Sec.	Sec.	15 U.S.C.A. Sec.	Sec.
1054	4:3	1125(a)(3)	4:16
1055	2:9, 17:2, 17:13	1125(b)	12:3
1057	7:7	1125(c)	10:7
1058	6:21, 20:4	1125(c)(1).....	10:4, 10:6
1059	6:21	1125(c)(2)(A)	10:15
1060	3:6, 7:13, 20:8, 20:9	1125(c)(2)(B)	10:15
1063(a)	7:7	1125(c)(2)(C)	10:14
1063(b)	7:7	1125(c)(3)	10:16
1064	3:8, 6:25, 7:7	1125(c)(3)(A)(1).....	8:18
1064(5)	4:3	1125(c)(3)(A)(i)	10:16
1065	6:23	1125(c)(3)(A)(ii)	10:16
1066	6:19	1125(c)(3)(C)	10:20
1067	6:18	1125(c)(4).....	10:6
1068	5:16	1125(c)(5)	10:21
1071	6:16	1125(d)	14:3
1071(b)	6:17	1125(d)(2)	14:16
1111	7:2	1125(d)(3)(A)(ii)(II)	14:16
1114	17:11	1125(d)(2)(D)	14:18
1114(1)	12:2	1125(d)(2)(D)(ii)	14:19
1114(2)	12:15	1125(d)(B)(ii)	14:10, 14:13
1115	4:16, 12:2	1126	6:14, 21:2
1115(a)	2:4, 6:1	1126(e)	6:14
1115(b)	6:1	1127	3:3, 3:5, 4:1, 4:2, 4:3, 4:4, 17:2, 17:11
1115(b)(4)	12:22	1129	14:4
1115(b)(7)	12:32	1141 to 1141n	6:25
1116(d)	11:4	1141i(a)	6:25
1116(d)(11)	11:7	1141i(b)	6:25
1117	11:8, 12:17	8131	14:4
1117(a) ..	12:16, 12:18, 14:17, 20:16	1501 et. seq.	2:1
1117(b)	11:8, 20:16		
1117(c)	11:8		
1117(d)(e)	14:17	17 U.S.C.A. Sec.	Sec.
1118	11:8, 12:20	1 et seq.	15:7
1119	3:8, 12:5, 12:9, 12:19	101 et seq.	12:16
1120	6:26		
1121	12:5	18 U.S.C.A. Sec.	Sec.
1122	12:10	2320(a)(1)	11:1
1124	7:17	2320(a)(2)	11:1
1125	12:2, 17:11	2320(b)	11:1
1125(a)	5:1, 12:3, 12:18, 13:2, 14:12, 17:11	2320(c)	11:1
1125(a)(1)	12:3, 13:1	2320(e)(1)	11:1
1125(a)(1)(A)	13:2	2320(e)(2)	11:1
1125(a)(1)(B)	13:1, 13:2	2320(e)(3)	11:1
		2320(f)	11:1

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

UNITED STATES CODE ANNOTATED—Continued

19 U.S.C.A. Sec.	Sec.	35 U.S.C.A. Sec.	Sec.
1526	8:17	101 to 103	4:16
26 U.S.C.A. Sec.	Sec.	103	4:16
482	19:17	171	4:17
1253(1)(d)(B)	19:15		
28 U.S.C.A. Sec.	Sec.	47 U.S.C.A. Sec.	Sec.
2201	12:9	230(c)(1).....	15:14

UNITED STATES PUBLIC LAWS

Pub. L. No.	Sec.	Pub. L. No.	Sec.
99-514, § 803(a)	19:19	112-190.....	6:25
100-667 (Nov. 16, 1988)	2:8		

TREASURY REGULATIONS

Reg.	Sec.
1.482-4(f)(3)(ii)(A)	19:18

CODE OF FEDERAL REGULATIONS

16 C.F.R. Sec.	Sec.	37 C.F.R. Sec.	Sec.
Part 436	17:10	2.21.....	6:9
436.1	17:10	2.22.....	6:9
		2.23.....	6:9
26 C.F.R. Sec.	Sec.	2.32.....	6:9
1.197-2(b)(10)	19:2	2.33	6:9, 6:13
1.197-2(d)(2)(iii)	19:5	2.34(a)(3)(i).....	6:14
1.197-2(e)(2)(ii).....	19:11	2.34(a)(3)(ii)	6:14
1.197-2(g)(6).....	19:5	2.37.....	6:9
1.263A-1(e).....	19:19	2.52(b)	6:9
1.263A-1(e)(3)(i).....	19:19	2.56 to 2.57.....	6:11
1.482-4T(f)	19:18	2.56	6:11
2.34(a)	6:9	2.71(d)	6:9
		2.81	6:13
37 C.F.R. Sec.	Sec.	2.86.....	6:9
Part 2	6:20	2.88	6:13
2.6.....	6:10	2.91(b).....	6:19
2.17.....	6:9	2.96	6:19

TABLE OF LAWS AND RULES

CODE OF FEDERAL REGULATIONS—Continued

37 C.F.R. Sec.	Sec.	37 C.F.R. Sec.	Sec.
2.102(b).....	7:7	2.142(e).....	6:15
2.142(d)	6:15	2.241 et seq.....	6:15

FEDERAL RULES OF CIVIL PROCEDURE

Rule	Sec.	Rule	Sec.
9(b).....	6:26	37	12:33
12(e).....	2:12		

EXECUTIVE ORDER

No.	Sec.
13224, § 1 (September 23, 2001)	27:2

**PATENT TRADEMARK OFFICE TRADEMARK
MANUAL OF EXAMINING PROCEDURE**

Sec.	Sec.	Sec.	Sec.
805	6:9	807.03 et seq.....	6:9
806	6:14	807.04 et seq.....	6:9
807	6:9	1002 et seq.	6:14
807.01	6:9	Ch 1000	6:14

**PATENT TRADEMARK OFFICE TRADEMARK
MANUAL OF EXAMINING PROCEDURE, 5TH
EDITION**

Sec.	Sec.	Sec.	Sec.
904	6:11	1715	7:6
1202.13.....	4:12	1203 to 1207.02	5:1
1507	6:19		

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

FEDERAL REGISTER

72 Fed. Reg.	Sec.	73 Fed. Reg.	Sec.
42242.....	6:15	13781.....	6:9

HOUSE OF REPRESENTATIVES BILLS

No.	Sec.
6215	6:25

ALABAMA CODE

Sec.	Sec.
8-12-17	10:3

ALASKA STATUTES

Sec.	Sec.	Sec.	
45.50.180(d)	10:3, 10:24	45.50.180(e)	10:3

ARIZONA STATUTES

Sec.	Sec.	Sec.	
44-1448.01	10:3	44-1453.....	11:2

ARKANSAS CODE ANNOTATED

Sec.	Sec.
4-71-213	10:3

CALIFORNIA BUSINESS AND PROFESSIONS CODE

Sec.	Sec.	Sec.	
14247.....	10:3	17204.....	13:2

TABLE OF LAWS AND RULES

CONNECTICUT GENERAL STATUTES

Sec.	Sec.	Sec.	Sec.
35-11a(11).....	10:3	53-347(a)	11:2
35-11i(c).....	10:3	1805-110.5	11:2

DELAWARE CODE

6 Del. Code Ann. Sec.	Sec.	11 Del. Code Ann. Sec.	Sec.
3313	10:3	926	11:2

FLORIDA STATUTES

Sec.	Sec.	Sec.	Sec.
495.011(6).....	10:3	817.41.....	13:16
495.151.....	10:3	831.032.....	11:2

GEORGIA CODE

Sec.	Sec.	Sec.	Sec.
10-1-451(b)	10:3	10-1-454	11:2

HAWAII REVISED STATUTES

Sec.	Sec.	Sec.	Sec.
482-1(2)	10:3	708-875.....	11:2
482-32.....	10:3		

IDAHO CODE

Sec.	Sec.	Sec.	Sec.
48-501(5)	10:3	48-513	10:3

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

ILLINOIS COMPILED STATUTES

765 Ill. Comp. Stat.	Sec.	765 Ill. Comp. Stat.	Sec.
104/2	11:2	1036/65.....	10:3
1036/5(c)	10:3		

INDIANA CODE

Sec.	Sec.	Sec.	
24-2-1-2(3).....	10:3	24-2-1-13.5	10:3

IOWA CODE

Sec.	Sec.
548.113.....	10:3

KANSAS STATUTES

Sec.	Sec.	Sec.	
81-202(k)	10:3	81-214.....	10:3

LOUISIANA REVISED STATUTES ANNOTATED

Sec.	Sec.
51:223.1	10:3

MAINE REVISED STATUTES ANNOTATED

10 M.R.S.A. Sec.	Sec.
1530.....	10:3

TABLE OF LAWS AND RULES

MASSACHUSETTS GENERAL LAWS

Ch	Sec.
110H, § 13.....	10:3

MINNESOTA STATUTES

Sec.	Sec.	Sec.	
333.18(7)	10:3	333.285.....	10:3

MISSISSIPPI CODE ANNOTATED

Sec.	Sec.
75-25-25.....	10:3

MISSOURI STATUTES

Sec.	Sec.
417.061.....	10:3

MONTANA CODE

Sec.	Sec.
30-13-334.....	10:3

NEBRASKA REVISED STATUTES

Sec.	Sec.	Sec.	
87-128(c)	10:3	87-140.....	10:3

NEVADA REVISED STATUTES

Sec.	Sec.
600.435.....	10:3

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

NEW HAMPSHIRE REVISED STATUTES

Sec.	Sec.
350-A:12.....	10:3

NEW JERSEY STATUTES

Sec.	Sec.	Sec.
2A:32B-2	12:18	56:3-13.20
56:3-13.1a	10:3	10:3

NEW MEXICO STATUTES

Sec.	Sec.	Sec.
57-3B-3(B).....	10:3	57-3B-15
		10:3

NEW YORK GENERAL BUSINESS LAW

Sec.	Sec.
360-1.....	10:3

OREGON REVISED STATUTES

Sec.	Sec.
647.107.....	10:3

PENNSYLVANIA CONSOLIDATED STATUTES

54 Pa. Cons. Stat. Sec.	Sec.
1102.....	10:3

TABLE OF LAWS AND RULES

PENNSYLVANIA STATUTES ANNOTATED

54 Pa. Stat. Ann. Sec.	Sec.
1124	10:3

RHODE ISLAND GENERAL LAWS

Sec.	Sec.
6-2-12	10:3

SOUTH CAROLINA CODE

Sec.	Sec.
39-15-1105(2).....	10:3

TENNESSEE CODE

Sec.	Sec.	Sec.	
47-25-501(3).....	10:3	47-25-513.....	10:3

**TEXAS BUSINESS AND COMMERCE CODE
ANNOTATED**

Sec.	Sec.
16.001 & 16.103.....	10:3

UTAH CODE

Sec.	Sec.	Sec.	
70-3a-103(c)	10:3	70-3a-403.....	10:3

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

VIRGINIA CODE

Sec.	Sec.
47-2-13	10:3

WASHINGTON REVISED CODE

Sec.	Sec.	Sec.	
19.77.010(6)	10:3	19.77.160	10:3

WEST VIRGINIA CODE

Sec.	Sec.
47-2-1(11)	10:3

WYOMING STATUTES

Sec.	Sec.	Sec.	
40-1-101(j).....	10:3	40-1-115.....	10:3

UNIFORM COMMERCIAL CODE (REV.)

Sec.	Sec.	Sec.	
9-109	20:8	9-311	20:8
9-109, Comment 8.....	20:8	9-311(a)(1).....	20:8
9-109(c)(1).....	20:8		

UNIFORM COMMERCIAL CODE

Sec.	Sec.	Sec.	
9-104	20:8	9-302(3)	20:8
9-104(a)	20:8	9-302(3)(a).....	20:8
9-106	20:8	9-302(4)	20:8
9-203	20:7		

TABLE OF LAWS AND RULES

**RESTATEMENT THIRD, TORTS (PRODUCTS
LIABILITY)**

Sec.	Sec.
14	17:14

RESTATEMENT THIRD, UNFAIR COMPETITION

Sec.	Sec.	Sec.
27	15:15	Ch 3, § 17(c).....
33, Comment c	17:9	4:18
33(c).....	17:5	

<http://www.pbookshop.com>

Table of Cases

A

- Abdallah v. Pileggi, 152 F.3d 948 (Fed. Cir. 1998)—13:10
- Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc., 280 F.3d 619, 2002 FED App. 0060P (6th Cir. 2002)—4:18
- Abraham v. Alpha Chi Omega, 708 F.3d 614 (5th Cir. 2013)—12:29, 12:31
- Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants Inc., 104 U.S.P.Q.2d 1234, 2012 WL 5189401 (T.T.A.B. 2012)—6:25
- Academy of Motion Picture Arts and Sciences v. Network Solutions Inc., 989 F. Supp. 1276 (C.D. Cal. 1997)—10:22
- Acuity v. Bagadia, 2008 WI 62, 310 Wis. 2d 197, 750 N.W.2d 817 (2008)—16:4
- Adrian Giger and Thomas Giger, In Re, 78 U.S.P.Q.2d 1405, 2006 WL 639159 (T.T.A.B. 2006)—5:20
- Advance Watch Co., Ltd. v. Kemper Nat. Ins. Co., 99 F.3d 795, 1996 FED App. 0350P (6th Cir. 1996)—16:2
- Agri-Supply Company, Inc. v. Agrisupply.Com, 457 F. Supp. 2d 660 (E.D. Va. 2006)—14:18
- Allied Maintenance Corp. v. Allied Mechanical Trades, Inc., 42 N.Y.2d 538, 399 N.Y.S.2d 628, 369 N.E.2d 1162 (1977)—10:4
- ALPO Petfoods, Inc. v. Ralston Purina Co., 913 F.2d 958 (D.C. Cir. 1990)—13:3
- Alpo Petfoods, Inc. v. Ralston Purina Co., 720 F. Supp. 194 (D.D.C. 1989)—13:12, 13:19
- Already, LLC v. Nike, Inc., 133 S. Ct. 721, 184 L. Ed. 2d 553 (2013)—12:5
- Already, LLC v. Nike, Inc., 133 S. Ct. 24, 183 L. Ed. 2d 674 (2012)—12:9
- ALS Scan, Inc. v. Digital Service Consultants, Inc., 293 F.3d 707, 52 Fed. R. Serv. 3d 1121 (4th Cir. 2002)—15:6
- AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531 (11th Cir. 1986)—12:29
- American Ass'n of Orthodontists v. Yellow Book USA, Inc., 277 S.W.3d 686 (Mo. Ct. App. E.D. 2008)—13:2
- American Ass'n. of Orthodontists v. Yellow Book USA, Inc., 434 F.3d 1100 (8th Cir. 2006)—13:2
- American Broadcasting Co. v. Wahl Co., 121 F.2d 412 (C.C.A. 2d Cir. 1941)—17:2
- American Exp. Co. v. CFK, Inc., 947 F. Supp. 310 (E.D. Mich. 1996)—10:11
- American Fertility Soc., In re,

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- 188 F.3d 1341 (Fed. Cir. 1999)—4:20
American Home Products Corp. v. Johnson & Johnson, 654 F. Supp. 568 (S.D. N.Y. 1987)—13:11
American Home Products Corp. v. Johnson and Johnson, 577 F.2d 160 (2d Cir. 1978)—13:11
American Intern. Reinsurance Co., Inc. v. Airco, Inc., 570 F.2d 941 (C.C.P.A. 1978)—2:6
American Rice, Inc. v. Arkansas Rice Growers Co-op. Ass'n, 701 F.2d 408 (5th Cir. 1983)—21:6
American Rice, Inc. v. Producers Rice Mill, Inc., 518 F.3d 321 (5th Cir. 2008)—4:7, 9:7, 21:6
American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9 (D. Conn. 1962)—3:5
America's Best Franchising Inc. v. Abbott, 106 U.S.P.Q.2d 1540, 2013 WL 1960644 (T.T.A.B. 2013)—6:18
Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 29 Fed. R. Serv. 2d 1528 (5th Cir. 1980)—9:11, 9:12, 9:13
An-Hung Yao v. State, 975 N.E.2d 1273 (Ind. 2012)—11:3
Angel Flight of Georgia, Inc. v. Angel Flight America, Inc., 522 F.3d 1200 (11th Cir. 2008)—6:26, 9:11, 12:14, 12:19, 12:29
Anheuser-Busch, Incorporated v. Kelly J. Holt, 92 U.S.P.Q.2d 1101, 2009 WL 3078027 (T.T.A.B. 2009)—4:24
Animals for Advertising Inc. v. Long, 84 U.S.P.Q.2d 1712, 2007 WL 4214818 (W.I.P.O.A.M.C. 2007)—14:9
Apple Computer v. Tvnnet.net, Inc., 90 U.S.P.Q.2d 1393, 2007 WL 2460995 (T.T.A.B. 2007)—5:15
Apple Computer Inc., In re, 57 U.S.P.Q.2d 1823, 1998 WL 1759037 (Comm'r Pat. & Trademarks 1998)—7:6
Aristocrat Technologies, Inc. v. High Impact Design & Entertainment, 642 F. Supp. 2d 1228 (D. Nev. 2009)—21:6
Aroa Marketing, Inc. v. Hartford Ins. Co. of Midwest, 198 Cal. App. 4th 781, 130 Cal. Rptr. 3d 466 (2d Dist. 2011)—16:6
Associated General Contractors of California, Inc. v. California State Council of Carpenters, 459 U.S. 519, 103 S. Ct. 897, 74 L. Ed. 2d 723 (1983)—13:2
Associated Press v. All Headline News Corp., 608 F. Supp. 2d 454 (S.D. N.Y. 2009)—13:6
Association of the United States Army, In re, 85 U.S.P.Q.2d 1264, 2007 WL 1033481 (T.T.A.B. 2007)—4:8
Association Pour la Defense et la Promotion de Loeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk, 82 U.S.P.Q.2d 1838, 2007 WL 749714 (T.T.A.B. 2007)—5:12
Atlas Copco AB v. Atlascopcoiran.com, 533 F. Supp. 2d 610 (E.D. Va. 2008)—14:14, 14:16

TABLE OF CASES

- Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc., 544 F. Supp. 2d 933 (D. Ariz. 2008)—8:16
- Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc., 457 F.3d 1062 (9th Cir. 2006)—4:18, 8:16
- Audi AG v. Shokan Coachworks, Inc., 592 F. Supp. 2d 246 (N.D. N.Y. 2008)—10:8, 12:29, 12:30
- Aveda Corp. v. Evita Marketing, Inc., 706 F. Supp. 1419 (D. Minn. 1989)—4:6
- Avery Dennison Corp. v. Supton, 189 F.3d 868 (9th Cir. 1999)—10:20
- Aycock Engineering, Inc. v. Airflite, Inc., 560 F.3d 1350 (Fed. Cir. 2009)—2:8
- B**
- Baby Buddies, Inc. v. Toys R Us, Inc., 611 F.3d 1308 (11th Cir. 2010)—13:16
- Baden Sports, Inc. v. Molten USA, Inc., 556 F.3d 1300 (Fed. Cir. 2009)—13:16
- Badger Meter, Inc. v. Grinnell Corp., 13 F.3d 1145 (7th Cir. 1994)—12:14
- Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc., 89 U.S.P.Q.2d 1262, 2008 WL 5195356 (T.T.A.B. 2008)—2:9
- B & B Hardware, Inc. v. Hargis Industries, Inc., 716 F.3d 1020 (8th Cir. 2013)—12:7
- Banjo Buddies, Inc. v. Renosky, 399 F.3d 168 (3d Cir. 2005)—12:16
- Barbecue Marx, Inc. v. Ogden, Inc., 235 F.3d 1041 (7th Cir. 2000)—9:13
- Barcamerica Intern. USA Trust v. Tyfield Importers, Inc., 289 F.3d 589, 52 Fed. R. Serv. 3d 415 (9th Cir. 2002)—17:6
- Bayer Aktiengesellschaft, In re, 488 F.3d 960 (Fed. Cir. 2007)—3:5
- Bayer Co. v. United Drug Co., 272 F. 505 (S.D. N.Y. 1921)—3:5
- Becht, Dickinson and Co., In re, 675 F.3d 1368 (Fed. Cir. 2012)—4:17
- Belk, Inc. v. Meyer Corp., U.S., 679 F.3d 146, 82 Fed. R. Serv. 3d 373 (4th Cir. 2012)—12:16
- Beltronics USA, Inc. v. Midwest Inventory Distribution, LLC, 562 F.3d 1067 (10th Cir. 2009)—8:15
- Beltronics USA, Inc. v. Midwest Inventory Distribution LLC, 522 F. Supp. 2d 1318 (D. Kan. 2007)—8:15
- Benjamin J. Giersch v. Scripps Networks, Inc., 90 U.S.P.Q.2d 1020, 2009 WL 706673 (T.T.A.B. 2009)—2:10
- Bensusan Restaurant Corp. v. King, 937 F. Supp. 295 (S.D. N.Y. 1996)—15:6
- BetaBatt, Inc., In re, 89 U.S.P.Q.2d 1152, 2008 WL 5232795 (T.T.A.B. 2008)—4:21
- B.H. Smith, Inc. v. Zurich Ins. Co., 285 Ill. App. 3d 536, 221 Ill. Dec. 700, 676 N.E.2d 221 (1st Dist. 1996)—16:3
- Bible Way Church of Our Lord Jesus Christ World Wide, Inc. v. Showell, 578 F.

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Supp. 2d 164 (D.D.C. 2008)—15:6
Big O Tire Dealers, Inc. v. Good-year Tire & Rubber Co., 561 F.2d 1365, 2 Fed. R. Evid. Serv. 443 (10th Cir. 1977)—13:17
Big O Tire Dealers, Inc. v. Good-year Tire & Rubber Co., 408 F. Supp. 1219 (D. Colo. 1976)—8:6
Bihari v. Gross, 119 F. Supp. 2d 309 (S.D. N.Y. 2000)—15:9
Binney & Smith v. Rose Art Industries, 60 U.S.P.Q.2d 2000, 2001 WL 910943 (E.D. Pa. 2001)—10:6
Blackstone Potato Chip Co., Inc., In re, 109 B.R. 557 (Bankr. D. R.I. 1990)—20:11
Blau v. YMI Jeanswear, Inc., 2004 WL 5313967 (C.D. Cal. 2004)—11:7
Blumenfeld Development Corp. v. Carnival Cruise Lines, Inc., 669 F. Supp. 1297 (E.D. Pa. 1987)—9:6
Blum's of San Francisco, Inc. v. Platt, 176 U.S.P.Q. 347, 1972 WL 17702 (S.D. N.Y. 1972)—4:6
Board Of Regents of University Of Wisconsin System v. Phoenix Intern. Software, Inc., 653 F.3d 448, 272 Ed. Law Rep. 79 (7th Cir. 2011)—12:8
Board of Regents of University of Wisconsin System v. Phoenix Software Intern., Inc., 565 F. Supp. 2d 1007 (W.D. Wis. 2008)—12:10
Boerne, City of v. Flores, 521 U.S. 507, 117 S. Ct. 2157, 138 L. Ed. 2d 624 (1997)—12:28
Bogoni v. Gomez, 847 F. Supp. 2d 519 (S.D. N.Y. 2012)—14:14
Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112 (1st Cir. 2006)—15:9
Bose Corp., In re, 580 F.3d 1240 (Fed. Cir. 2009)—6:26
Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1 (1st Cir. 2008)—4:20
Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004 (5th Cir. 1975)—8:8
Boston Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman, 88 U.S.P.Q.2d 1581, 2008 WL 4149008 (T.T.A.B. 2008)—5:11
Boulevard Entertainment, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003)—5:10
Bourdeau Bros., Inc. v. International Trade Com'n, 444 F.3d 1317 (Fed. Cir. 2006)—8:17
Bpj Enterprises Ltd., In re, 7 U.S.P.Q.2d 1375, 1988 WL 252361 (Comm'r Pat. & Trademarks 1988)—7:6
Bracco Diagnostics, Inc. v. Amersham Health, Inc., 627 F. Supp. 2d 384 (D.N.J. 2009)—13:4
Breaking the Chain Foundation, Inc. v. Capitol Educational Support, Inc., 589 F. Supp. 2d 25 (D.D.C. 2008)—12:20
Bridgestone Americas Tire Operations, LLC v. Federal Corp., 673 F.3d 1330 (Fed. Cir. 2012)—5:15
Bridgestone/Firestone Research,

TABLE OF CASES

C	
Inc. v. Automobile Club De L'Quest De La France, 245 F.3d 1359 (Fed. Cir. 2001)—6:16	Caesars World, Inc. v. Venus Lounge, Inc., 520 F.2d 269 (3d Cir. 1975)—12:17
Brighton Collectibles, Inc. v. Renaissance Group Intern., 239 Fed. Appx. 333 (9th Cir. 2007)—20:4	Cairns v. Franklin Mint Co., 292 F.3d 1139 (9th Cir. 2002)—12:23
Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036 (9th Cir. 1999)—2:12, 14:2, 15:8	California Innovations, Inc., In re, 329 F.3d 1334 (Fed. Cir. 2003)—5:9
Brother Records, Inc. v. Jardine, 318 F.3d 900 (9th Cir. 2003)—12:23	Campbell v. Irving Oil Corp., 1998-1 Trade Cas. (CCH) ¶ 72164 (D. Me. 1998)—18:3
Brouwerij Bosteels, In re, 96 U.S.P.Q.2d 1414, 2010 WL 3501476 (T.T.A.B. 2010)—4:23	Carefirst of Maryland, Inc. v. Carefirst Pregnancy Centers, Inc., 334 F.3d 390, 56 Fed. R. Serv. 3d 361 (4th Cir. 2003)—15:6
Brown Shoe Company, Inc. v. Molly D. Robbins, 90 U.S.P.Q.2d 1752, 2009 WL 1360688 (T.T.A.B. 2009)—4:22	Carlay Co. v. Federal Trade Commission, 153 F.2d 493 (C.C.A. 7th Cir. 1946)—13:6
Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527 (Fed. Cir. 1994)—4:18	Carnival Corp. v. SeaEscape Casino Cruises, Inc., 74 F. Supp. 2d 1261 (S.D. Fla. 1999)—9:6
Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 23 Fed. R. Evid. Serv. 1272 (10th Cir. 1987)—12:16	Catapult Entertainment, Inc., In re, 165 F.3d 747 (9th Cir. 1999)—20:11
Bunn-O-Matic Corp. v. Bunn Coffee Service, Inc., 88 F. Supp. 2d 914 (C.D. Ill. 2000)—17:13	Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211 (3d Cir. 2005)—12:23
Burck v. Mars, Inc., 571 F. Supp. 2d 446 (S.D. N.Y. 2008)—8:7	Century 21 Real Estate LLC v. Century Ins. Group., 2007 WL 484555 (D. Ariz. 2007)—10:13
Burger King Corp. v. Mason, 855 F.2d 779 (11th Cir. 1988)—12:16	Century 21 Real Estate, LLC v. Destiny Real Estate Properties, 101 U.S.P.Q.2d 1423, 2011 WL 6736060 (N.D. Ind. 2011)—11:5
Burgess v. Gilman, 78 U.S.P.Q.2d 1773, 2006 WL 449212 (D. Nev. 2006)—3:3	Certa ProPainters, Ltd., In re, 2008 WL 5009753 (T.T.A.B. 2008)—5:14
CFLC, Inc., In re, 89 F.3d 673 (9th Cir. 1996)—20:11	CGS Industries, Inc. v. Charter

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Oak Fire Ins. Co., 720 F.3d 71 (2d Cir. 2013)—16:6, 16:8
- ChaCha Search Inc. v. Grape Technology Group Inc., 105 U.S.P.Q.2d 1298, 2012 WL 6929402 (T.T.A.B. 2012)—4:21
- Chamilia, LLC v. Pandora Jewelry, LLC, 85 U.S.P.Q.2d 1169, 2007-2 Trade Cas. (CCH) ¶ 75945, 2007 WL 2781246 (S.D. N.Y. 2007)—13:4
- Champion Spark Plug Co. v. Sanders, 331 U.S. 125, 67 S. Ct. 1136, 91 L. Ed. 1386 (1947)—8:13
- Charles N. Van Valkenburgh, In re, 97 U.S.P.Q.2d 1757, 2011 WL 165454 (T.T.A.B. 2011)—4:17
- Charles of the Ritz Group Ltd. v. Quality King Distributors, Inc., 636 F. Supp. 433 (S.D. N.Y. 1986)—8:18
- Checkers Drive-In Restaurants, Inc. v. Commissioner of Patents and Trademarks, 51 F.3d 1078 (D.C. Cir. 1995)—20:4
- Chemical Corp. of America v. Anheuser-Busch, Inc., 306 F.2d 438, 2 A.L.R.3d 739 (5th Cir. 1962)—12:25
- Chester L. Krause v. Krause Publications, Inc., 76 U.S.P.Q.2d 1904, 2005 WL 3175174 (T.T.A.B. 2005)—5:13
- Chevron Intellectual Property Group LLC, In re, 96 U.S.P.Q.2d 2026, 2010 WL 5010883 (T.T.A.B. 2010)—4:23, 4:26
- Chicago Bears Football Club, Inc. v. 12th Man/Tennessee LLC, 83 U.S.P.Q.2d 1073, 2007 WL 683778 (T.T.A.B. 2007)—4:18
- Chippendales USA, Inc., In re, 90 U.S.P.Q.2d 1535, 2009 WL 804141 (T.T.A.B. 2009)—4:26
- Chloe v. Queen Bee of Beverly Hills, LLC, 616 F.3d 158 (2d Cir. 2010)—15:6
- Christian Broadcasting Network, Inc., The v. ABS-CBN International, 84 U.S.P.Q.2d 1560, 2007 WL 2253483 (T.T.A.B. 2007)—9:5
- Christian Dior, S.A.R.L. v. Miss Dior of Flatbush, Inc., 173 U.S.P.Q. 416, 1972 WL 18024 (E.D. N.Y. 1972)—2:3
- Christian Science Bd. of Directors of First Church of Christ, Scientist v. Evans, 105 N.J. 297, 520 A.2d 1347 (1987)—12:28
- C.I.R. v. Sunnen, 1948-1 C.B. 7, 333 U.S. 591, 68 S. Ct. 715, 92 L. Ed. 898, 77 U.S.P.Q. 29, 48-1 U.S. Tax Cas. (CCH) P 9230, 36 A.F.T.R. (P-H) P 611 (1948)—12:6
- Circuit City Stores, Inc. v. CarMax, Inc., 165 F.3d 1047, 1999 FED App. 0026P (6th Cir. 1999)—9:2
- Citibank, N.A. v. City Bank of San Francisco, 206 U.S.P.Q. 997, 1980 WL 30239 (N.D. Cal. 1980)—2:3
- Citigroup Inc. v. Capital City Bank Group, Inc., 637 F.3d 1344 (Fed. Cir. 2011)—5:18
- Citigroup Inc. v. Capital City Bank Group, Inc., 94 U.S.P.Q.2d 1645, 2010 WL 595586 (T.T.A.B. 2010)—10:13

TABLE OF CASES

- City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc., 106 U.S.P.Q.2d 1668, 2013 WL 2151098 (T.T.A.B. 2013)—2:6
- City of Houston, In re, 101 U.S.P.Q.2d 1534, 2012 WL 423805 (T.T.A.B. 2012)—5:14
- Clam Corp., Inc. v. Innovative Outdoor Solutions, Inc., 89 U.S.P.Q.2d 1314, 2008 WL 5244845 (D. Minn. 2008)—12:11
- Clarke, In re, 17 U.S.P.Q.2d 1238, 1990 WL 354572 (T.T.A.B. 1990)—4:11, 4:12
- Clock Spring, L.P. v. Wrapmaster, Inc., 560 F.3d 1317 (Fed. Cir. 2009)—13:3
- Clorox Co., The v. Chemical Bank, 40 U.S.P.Q.2d 1098, 1996 WL 579826 (T.T.A.B. 1996)—20:9
- Clorox Co. Puerto Rico v. Proctor & Gamble Commercial Co., 228 F.3d 24, 47 Fed. R. Serv. 3d 1166 (1st Cir. 2000)—13:6, 13:7, 13:11
- Closed Loop Marketing, Inc. v. Closed Loop Marketing, LLC, 589 F. Supp. 2d 1211 (E.D. Cal. 2008)—4:24
- Coach, Inc. v. Goodfellow, 717 F.3d 498 (6th Cir. 2013)—8:21
- Coach Services, Inc. v. Triumph Learning LLC, 668 F.3d 1356 (Fed. Cir. 2012)—7:7
- Coach Services, Inc. v. Triumph Learning LLC, 96 U.S.P.Q.2d 1600, 2010 WL 3798519 (T.T.A.B. 2010)—9:4
- Coahoma Chemical Co., Inc. v. Smith (Black Panther Com-
- pany, Inc., Assignee, Substituted); Same v. Howerton Gowen Company, Inc. (Black Panther Company, Inc., Assignee, Substituted), 113 U.S.P.Q. 413, 1957 WL 7113 (Comm'r Pat. & Trademarks 1957)—2:7
- Coastal Abstract Service, Inc. v. First American Title Ins. Co., 173 F.3d 725 (9th Cir. 1999)—13:4
- Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D. N.Y. 1972)—12:25
- Coca-Cola Co. v. Procter & Gamble Co., 822 F.2d 28 (6th Cir. 1987)—13:7
- Coca-Cola Co. v. Tropicana Products, Inc., 690 F.2d 312 (2d Cir. 1982)—13:7
- College Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 119 S. Ct. 2219, 144 L. Ed. 2d 605, 135 Ed. Law Rep. 362 (1999)—12:8, 12:10
- Comband Technologies, Inc., In re, 69 F.3d 532 (4th Cir. 1995)—20:3
- Comexa Ltda., In re, 60 U.S.P.Q.2d 1118, 2001 WL 717676 (T.T.A.B. 2001)—5:16
- Compania De Licores Internacionales S.A., In Re, 102 U.S.P.Q.2d 1841, 2012 WL 1267898 (T.T.A.B. 2012)—5:9
- Conopco, Inc. v. Campbell Soup Co., 95 F.3d 187 (2d Cir. 1996)—12:18
- Conopco, Inc. v. May Dept. Stores Co., 46 F.3d 1556 (Fed. Cir. 1994)—8:18

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Consolidated Foods Corporation, In re, 187 U.S.P.Q. 63, 1975 WL 21247 (T.T.A.B. 1975)—5:14
- Consolidated Natural Gas Company v. Cng Fuel Systems, Ltd., 228 U.S.P.Q. 752, 1985 WL 73058 (T.T.A.B. 1985)—5:12
- Continental Cas. Co. v. Consolidated Graphics, Inc., 646 F.3d 210 (5th Cir. 2011)—16:4
- Cook, Perkiss and Liehe, Inc. v. Northern California Collection Service Inc., 911 F.2d 242 (9th Cir. 1990)—13:3, 13:6
- Cooper, Application of, 254 F.2d 611 (C.C.P.A. 1958)—5:5
- Cooper Industries, Inc. v. Leatherman Tool Group, Inc., 532 U.S. 424, 121 S. Ct. 1678, 149 L. Ed. 2d 674 (2001)—13:20
- Coors Brewing Co., In re, 343 F.3d 1340 (Fed. Cir. 2003)—5:17
- Cosmetically Sealed Industries, Inc. v. Chesebrough-Pond's USA Co., 125 F.3d 28 (2d Cir. 1997)—12:22
- Council of Better Business Bureaus, Inc v. Better Business Bureau of South Florida, Inc, 200 U.S.P.Q. 282, 1978 WL 21729 (S.D. Fla. 1978)—17:3
- Cox Enterprises, Inc., In re, 82 U.S.P.Q.2d 1040, 2007 WL 117511 (T.T.A.B. 2007)—5:8
- C.P. Interests, Inc. v. California Pools, Inc., 238 F.3d 690, 56 Fed. R. Evid. Serv. 422, 48 Fed. R. Serv. 3d 1100 (5th Cir. 2001)—2:12
- CreAgri, Inc. v. USANA Health Sciences, Inc., 474 F.3d 626 (9th Cir. 2007)—2:7
- Crystal Entertainment & Filmworks, Inc. v. Jurado, 643 F.3d 1313 (11th Cir. 2011)—2:9
- Cynosure, Inc., In re, 90 U.S.P.Q.2d 1644, 2009 WL 1268438 (T.T.A.B. 2009)—5:15, 5:16
- D**
- Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979)—10:14
- Dallas Cowboys Football Club, Ltd. v. America's Team Properties, Inc., 616 F. Supp. 2d 622 (N.D. Tex. 2009)—10:14
- Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 123 S. Ct. 2041, 156 L. Ed. 2d 18, 194 A.L.R. Fed. 731 (2003)—12:4, 13:16
- Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358 (2d Cir. 1959)—9:2, 17:3
- Dean S. Carlson, In re, 91 U.S.P.Q.2d 1198, 2009 WL 1719596 (T.T.A.B. 2009)—4:21
- Deere & Co. v. International Trade Com'n, 605 F.3d 1350 (Fed. Cir. 2010)—8:17
- Dell Inc., In re, 71 U.S.P.Q.2d 1725, 2004 WL 1942043 (T.T.A.B. 2004)—4:1
- Del Monte Fresh Produce N.A., Inc. v. Transportation Ins. Co., 500 F.3d 640 (7th Cir. 2007)—16:6
- Deltek, Inc. v. Iuvo Systems, Inc., 91 U.S.P.Q.2d 1926,

TABLE OF CASES

- 2009 WL 1073196 (E.D. Va. 2009)—15:10
- DHL Corp. and Subsidiaries v. C.I.R., 285 F.3d 1210 (9th Cir. 2002)—19:17, 19:18
- Dial One of the Mid-South, Inc. v. BellSouth Telecommunications, Inc., 269 F.3d 523 (5th Cir. 2001)—12:15
- Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC, 369 F.3d 1197, 64 Fed. R. Evid. Serv. 617 (11th Cir. 2004)—4:17
- Discovery Zone, Inc., In re, 300 B.R. 856 (Bankr. D. Del. 2003)—20:15
- Dixie Restaurants, Inc., In re, 105 F.3d 1405 (Fed. Cir. 1997)—5:16
- Doeblers' Pennsylvania Hybrids, Inc. v. Doebler, 442 F.3d 812 (3d Cir. 2006)—17:7
- Dogloo, Inc. v. Northern Ins. Co. of New York, 907 F. Supp. 1383 (C.D. Cal. 1995)—13:3, 16:5
- Dominic's Restaurant of Dayton, Inc. v. Mantia, 683 F.3d 757 (6th Cir. 2012)—20:4
- Dress for Success Worldwide v. Dress 4 Success, 589 F. Supp. 2d 351 (S.D. N.Y. 2008)—3:7
- Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 924 F. Supp. 1559 (S.D. Cal. 1996)—10:18, 10:19, 10:20
- DSPT Intern., Inc. v. Nahum, 624 F.3d 1213 (9th Cir. 2010)—14:14
- Dudley v. HealthSource Chiropractic, Inc., 585 F. Supp. 2d 433 (W.D. N.Y. 2008)—14:14
- DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd., 695 F.3d 1247 (Fed. Cir. 2012)—4:21
- E**
- E. & J. Gallo Winery v. Spider Webs Ltd., 286 F.3d 270 (5th Cir. 2002)—14:14, 14:15, 14:17
- Earthquake Sound Corp. v. Bumper Industries, 352 F.3d 1210 (9th Cir. 2003)—12:18
- Eastern R. R. Presidents Conference v. Noerr Motor Freight, Inc., 365 U.S. 127, 81 S. Ct. 525, 5 L. Ed. 2d 464 (1961)—13:15
- eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 126 S. Ct. 1337, 164 L. Ed. 2d 641, 27 A.L.R. Fed. 2d 685 (2006)—12:11
- Edina Realty, Inc. v. TheMLSonline.com, 80 U.S.P.Q.2d 1039, 2006 WL 737064 (D. Minn. 2006)—15:14
- EH Yacht, LLC v. Egg Harbor, LLC, 84 F. Supp. 2d 556 (D.N.J. 2000)—20:3
- E.I. Du Pont De Nemours & Co. v. Celanese Corp. of America, 167 F.2d 484, 3 A.L.R.2d 1213 (C.C.P.A. 1948)—17:2
- E. I. DuPont DeNemours & Co., Application of, 476 F.2d 1357 (C.C.P.A. 1973)—5:15
- E. I. Du Pont De Nemours and Company v. Big Bear Stores, Inc., 161 U.S.P.Q. 50, 1969 WL 9025 (T.T.A.B. 1969)—2:12
- 800-JR Cigar, Inc. v. GoTo.com, Inc., 437 F. Supp. 2d 273 (D.N.J. 2006)—15:14

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Elan Pharmaceutical Research Corp. v. Employers Ins. of Wausau, 144 F.3d 1372 (11th Cir. 1998)—16:7
- Electronic Laboratory Supply Co., Inc. v. Cullen, 977 F.2d 798 (3d Cir. 1992)—11:7
- Electronics Corp. of America v. Honeywell, Inc., 358 F. Supp. 1230 (D. Mass. 1973)—12:17
- El Greco Leather Products Co., Inc. v. Shoe World, Inc., 806 F.2d 392 (2d Cir. 1986)—8:12
- Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188, 40 Fed. R. Serv. 3d 1021 (5th Cir. 1998)—12:25
- Elvis Presley Enterprises, Inc. v. Capece, 950 F. Supp. 783 (S.D. Tex. 1996)—10:14
- Employment Div., Dept. of Human Resources of Oregon v. Smith, 494 U.S. 872, 110 S. Ct. 1595, 108 L. Ed. 2d 876 (1990)—12:28
- Energy Brands Inc. v. Spiritual Brands, Inc., 571 F. Supp. 2d 458 (S.D. N.Y. 2008)—15:6
- Eppendorf Netheler-Hinz GMBH v. Ritter GMBH, 289 F.3d 351 (5th Cir. 2002)—4:17
- ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 2003 FED App. 0207P (6th Cir. 2003)—12:3, 12:27
- Eureka Water Co. v. Nestle Waters North America, Inc., 690 F.3d 1139, 78 U.C.C. Rep. Serv. 2d 363 (10th Cir. 2012)—17:1
- Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co. Kg, 34 U.S.P.Q.2d 1266, 1995 WL 231387 (T.T.A.B. 1995)—5:16
- Eva's Bridal Ltd. v. Halanick Enterprises, Inc., 639 F.3d 788 (7th Cir. 2011)—17:6
- Exide Technologies, In re, 607 F.3d 957 (3d Cir. 2010)—20:10
- Exxon Corp. v. Oxxford Clothes, Inc., 109 F.3d 1070 (5th Cir. 1997)—17:3, 17:5, 17:8
- EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc., 746 F.2d 375 (7th Cir. 1984)—10:4
- F
- Family Inns of America, Inc., In re, 180 U.S.P.Q. 332, 1974 WL 19870 (Comm'r Pat. & Trademarks 1974)—6:19
- Fanucus Horse Inc. v. 5th Ave. Photo Inc., 624 F.3d 106 (2d Cir. 2010)—8:7, 13:2
- Farmer v. Florence County Sheriff's Office, 401 S.C. 606, 738 S.E.2d 473 (2013)—11:2
- Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc., 314 F.3d 48, 60 Fed. R. Evid. Serv. 231 (2d Cir. 2002)—13:4
- Federal Treasury Enterprise Sojuzplodoimport v. Spirits Intern. N.V., 623 F.3d 61 (2d Cir. 2010)—6:23
- Fendi S.a.s. Di Paola Fendi E Sorelle v. Cosmetic World, Ltd., 642 F. Supp. 1143 (S.D. N.Y. 1986)—11:8
- Ferrari S.P.A. v. Roberts, 944 F.2d 1235 (6th Cir. 1991)—8:5
- Ferrellgas Partners, Inc. v. Barrow, 80 U.S.P.Q.2d 1097,

TABLE OF CASES

- 2006 WL 372602 (M.D. Ga. 2006)—8:21
- Finance Inv. Co. (Bermuda) Ltd. v. Geberit AG, 165 F.3d 526, 42 Fed. R. Serv. 3d 515 (7th Cir. 1998)—17:11
- First Health Group Corp. v. BCE Emergis Corp., 269 F.3d 800 (7th Cir. 2001)—13:4
- FirstHealth of Carolinas, Inc. v. CareFirst of Maryland, Inc., 479 F.3d 825 (Fed. Cir. 2007)—6:16
- First Nat. Bank in Sioux Falls v. First Nat. Bank South Dakota, 679 F.3d 763, 88 Fed. R. Evid. Serv. 654 (8th Cir. 2012)—9:14
- First Nat. Bank in Sioux Falls v. First Nat. Bank, South Dakota, 153 F.3d 885 (8th Cir. 1998)—9:14
- Fishman Transducers, Inc. v. Paul, 684 F.3d 187 (1st Cir. 2012)—12:16
- Fleetwood Folding Trailers, Inc. v. Coleman Co., Inc., 38 Kan. App. 2d 30, 161 P.3d 786 (2007)—11:5
- Fleischer Studios, Inc. v. A.V.E.L.A., Inc., 654 F.3d 958 (9th Cir. 2011)—4:23
- Florists' Transworld Delivery Inc., In re, 106 U.S.P.Q.2d 1784, 2013 WL 2494151 (T.T.A.B. 2013)—4:18
- Ford Motor Co. v. GreatDomains.com, Inc., 60 U.S.P.Q.2d 1446, 2001 WL 1176319 (E.D. Mich. 2001)—15:16
- Ford Motor Co. v. 2600 Enterprises, 177 F. Supp. 2d 661 (E.D. Mich. 2001)—15:7
- Fox, In re, 702 F.3d 633 (Fed. Cir. 2012)—5:10
- Foxtrap, Inc. v. Foxtrap, Inc., 671 F.2d 636 (D.C. Cir. 1982)—13:19
- FragranceNet.com, Inc. v. FragranceX.com, Inc., 493 F. Supp. 2d 545 (E.D. N.Y. 2007)—15:14
- Freecycle Network, Inc. v. Oey, 505 F.3d 898 (9th Cir. 2007)—13:4, 13:5
- FreecycleSunnyvale v. Freecycle Network, 626 F.3d 509 (9th Cir. 2010)—17:6
- Freedom Sav. and Loan Ass'n v. Way, 757 F.2d 1176, 17 Fed. R. Evid. Serv. 1290 (11th Cir. 1985)—6:5
- Fruit of the Loom, Inc. v. Girouard, 994 F.2d 1359 (9th Cir. 1993)—9:4
- G**
- G&W Laboratories, Inc. v. G W Pharma Limited, 89 U.S.P.Q.2d 1571, 2009 WL 226025 (T.T.A.B. 2009)—6:26
- Garden Way, Inc. v. Home Depot, Inc., 94 F. Supp. 2d 276 (N.D. N.Y. 2000)—13:7
- GE Commercial Finance Business Property Corp., Application of v. Hakakian, 13 Misc. 3d 413, 821 N.Y.S.2d 391 (Sup 2006)—3:6
- General Cas. Co. of Wisconsin v. Wozniak Travel, Inc., 762 N.W.2d 572 (Minn. 2009)—16:3, 16:4
- General Conference Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402 (6th Cir. 2010)—12:28
- General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 U.S.P.Q.2d

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- 1179, 2008 WL 1808554 (T.T.A.B. 2008)—3:3
- General Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405, 2006 FED App. 0393P (6th Cir. 2006)—4:15, 4:17
- General Tire & Rubber Co. v. Greenwold, 127 U.S.P.Q. 2d 1960 WL 8000 (S.D. Cal. 1960)—2:12
- Geneva Intern. Corp. v. Petrof, SPOL, S.R.O., 529 F. Supp. 2d 932 (N.D. Ill. 2007)—17:17
- Genna v. Lady Foot Intern., Inc., 1986-2 Trade Cas. (CCH) ¶ 67317, 1986 WL 1236 (E.D. Pa. 1986)—18:3
- Georgia-Pacific Consumer Products LP v. Four-U-Packaging, Inc., 701 F.3d 1093 (6th Cir. 2012)—12:7
- Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp., 647 F.3d 723 (7th Cir. 2011)—4:17
- Getty Petroleum Corp. v. Bartco Petroleum Corp., 858 F.2d 103, 12 Fed. R. Serv. 3d 34 (2d Cir. 1988)—12:17
- Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539, 2005 FED App. 0387P (6th Cir. 2005)—8:4, 15:9
- Giovanni Food Co., Inc., In re, 97 U.S.P.Q.2d 1990, 2011 WL 810217 (T.T.A.B. 2011)—5:17
- Gonzales v. O Centro Espirita Beneficente Uniao do Vegetal, 546 U.S. 418, 126 S. Ct. 1211, 163 L. Ed. 2d 1017 (2006)—12:28
- Google Inc. v. American Blind & Wallpaper, 2007 WL 1159950 (N.D. Cal. 2007)—15:14
- GoPets Ltd. v. Hise, 657 F.3d 1024 (9th Cir. 2011)—14:15
- Government Employees Ins. Co. v. Google, Inc., 330 F. Supp. 2d 700 (E.D. Va. 2004)—15:14, 15:15
- Gracie v. Gracie, 217 F.3d 1060 (9th Cir. 2000)—12:16
- Grand Metropolitan Foodservice Inc., In re, 30 U.S.P.Q.2d 1974, 1994 WL 270710 (T.T.A.B. 1994)—4:21
- Green v. Fornario, 486 F.3d 100 (3d Cir. 2007)—12:18
- Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway and Sons, 365 F. Supp. 707 (S.D. N.Y. 1973)—8:4
- GSI Group, Inc. v. Sukup Mfg. Co., 2008 WL 4826265 (C.D. Ill. 2008)—13:12
- Gucci America, Inc. v. Daffy's Inc., 354 F.3d 228 (3d Cir. 2003)—12:11, 12:16
- Gucci America, Inc. v. Hall & Associates, 135 F. Supp. 2d 409 (S.D. N.Y. 2001)—15:16
- Guggenheim Capital, LLC v. Birnbaum, 722 F.3d 444 (2d Cir. 2013)—12:33
- H**
- H-D Michigan, LLC v. Hellenic Duty Free Shops S.A., 694 F.3d 827 (7th Cir. 2012)—21:5
- Habush v. Cannon, 100 U.S.P.Q.2d 1890, 2011 WL 2477236 (Wis. Cir. Ct. 2011)—15:14
- Hacot-Colombier, In re, 105 F.3d 616 (Fed. Cir. 1997)—6:16
- Halo Management, LLC v. In-

TABLE OF CASES

terland, Inc., 64 Fed. R. Evid. Serv. 1077 (N.D. Cal. 2004)—17:6	Maidenform, Inc., 87 U.S.P.Q.2d 1715, 2008 WL 1976596 (T.T.A.B. 2008)—9:6
Halo Management, LLC v. Interland, Inc., 308 F. Supp. 2d 1019 (N.D. Cal. 2003)—17:6	Heisman Trophy Trust v. Smack Apparel Co., 595 F. Supp. 2d 320 (S.D. N.Y. 2009)—9:8
Hansen Beverage Co. v. National Beverage Corp., 493 F.3d 1074 (9th Cir. 2007)—4:8	Hensley Mfg. v. ProPride, Inc., 579 F.3d 603 (6th Cir. 2009)—12:1, 17:16
Hard Rock Cafe International (USA) Inc. v. Morton, 1999 WL 701388 (S.D. N.Y. 1999)—15:11	Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc., 43 U.S.P.Q.2d 1193, 1997 WL 335807 (D.D.C. 1997)—5:14
Hard Rock Cafe Intern. (USA) Inc. v. Morton, 1999 WL 717995 (S.D. N.Y. 1999)—15:11	HORMEL FOODS CORPORATION AND HORMEL FOODS, LLC v. SPAM ARREST, LLC, 2007 WL 4287234 (T.T.A.B. 2007)—10:10, 10:13
Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1999 WL 375907 (T.T.A.B. 1999)—5:11	Horchag Research Ltd. v. Pellegrini, 337 F.3d 1036 (9th Cir. 2003)—15:10
Harleysville Mut. Ins. Co. v. Buzz Off Insect Shield, L.L.C., 364 N.C. 1, 692 S.E.2d 605 (2010)—16:6	Hotels.com, L.P., In re, 573 F.3d 1300 (Fed. Cir. 2009)—4:20
Harold H. Huggins Realty, Inc. v. FNC, Inc., 634 F.3d 787 (5th Cir. 2011)—13:2	Hudson Ins. Co. v. Colony Ins. Co., 624 F.3d 1264 (9th Cir. 2010)—16:3
Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197 (9th Cir. 1989)—13:17	Hudson Ins. Co. v. Colony Ins. Co., 2008 WL 5504572 (C.D. Cal. 2008)—16:3
Harrods Ltd. v. Sixty Internet Domain Names, 302 F.3d 214, 53 Fed. R. Serv. 3d 955 (4th Cir. 2002)—14:18	Hugo Boss Fashions, Inc. v. Federal Ins. Co., 252 F.3d 608 (2d Cir. 2001)—16:8
Hasbro, Inc. v. Internet Entertainment Group, Ltd., 40 U.S.P.Q.2d 1479, 1996 WL 84853 (W.D. Wash. 1996)—10:11, 10:14	Hulting, In re, 107 U.S.P.Q.2d 1175, 2013 WL 3496656 (T.T.A.B. 2013)—5:2
Hasbro Industries, Inc. v. Hot Items, Inc., 473 F. Supp. 1286 (S.D. N.Y. 1979)—4:17	Hunt Control Systems, Inc. v. Koninklijke Philips Electronics N.V., 2011 WL 2062161 (T.T.A.B. 2011)—5:18, 6:20
H.D. Lee Company, Inc., The v.	Huthwaite, Inc. v. Sunrise Assisted Living, Inc., 261 F. Supp. 2d 502 (E.D. Va. 2003)—2:6

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Hy Cite Corp. v. Badbusinessbureau.com, L.L.C., 297 F. Supp. 2d 1154 (W.D. Wis. 2004)—15:6
- Hydron Technologies Inc., In re, 51 U.S.P.Q.2d 1531, 1999 WL 813992 (T.T.A.B. 1999)—4:1
- Hymen v. Nationwide Mut. Fire Ins. Co., 304 F.3d 1179 (11th Cir. 2002)—16:3
- I**
- iAccess, Inc. v. WEBcard Technologies, Inc., 182 F. Supp. 2d 1183 (D. Utah 2002)—15:6
- Idaho Potato Com'n, State of v. G & T Terminal Packaging, Inc., 425 F.3d 708 (9th Cir. 2005)—11:5
- Illinois Tool Works Inc. v. Independent Ink, Inc., 547 U.S. 28, 126 S. Ct. 1281, 164 L. Ed. 2d 26 (2006)—18:4
- Impact Distributors, Inc., In re, 260 B.R. 48 (Bankr. S.D. Fla. 2001)—20:5
- Industrial Molding Corp. v. American Mfrs. Mut. Ins. Co., 17 F. Supp. 2d 633 (N.D. Tex. 1998)—16:3, 16:4
- Innovative Technologies Corporation of America, Inc., In re, 2008 WL 4354133 (T.T.A.B. 2008)—4:22
- in Over Our Heads Inc., In re, 16 U.S.P.Q.2d 1653, 1990 WL 354546 (T.T.A.B. 1990)—5:11
- In re theDot Communications Network LLC, 101 U.S.P.Q.2d 1062, 2011 WL 6099688 (T.T.A.B. 2011)—5:6
- Interactive Products Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 55 Fed. R. Serv. 3d 1129, 2003 FED App. 0111P (6th Cir. 2003)—12:1, 15:4
- International Mobile Machines Corp. v. International Telephone & Telegraph Corp., 800 F.2d 1118 (Fed. Cir. 1986)—2:8
- International Order of Job's Daughters v. Lindeburg and Co., 633 F.2d 912 (9th Cir. 1980)—8:8
- International Star Class Yacht Racing Ass'n v. Tommy Hilfiger U.S.A., Inc., 146 F.3d 66, 49 Fed. R. Evid. Serv. 719 (2d Cir. 1998)—12:16
- Internet Specialties West, Inc. v. Milon-DiGiorgio Enterprises, Inc., 559 F.3d 985 (9th Cir. 2009)—12:29, 14:2
- Interstate Bakeries Corp. v. OneBeacon Ins. Co., 686 F.3d 539 (8th Cir. 2012)—16:2
- interState Net Bank v. NetB@nk, Inc., 348 F. Supp. 2d 340 (D.N.J. 2004)—3:6
- Investools, Inc. v. Investools.com, 81 U.S.P.Q.2d 2019, 2006 WL 2037577 (E.D. Va. 2006)—14:16
- Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 102 S. Ct. 2182, 72 L. Ed. 2d 606, 34 Fed. R. Serv. 2d 1101 (1982)—8:21, 15:15
- J**
- JA Apparel Corp. v. Abboud, 682 F. Supp. 2d 294 (S.D. N.Y. 2010)—17:16

TABLE OF CASES

- JA Apparel Corp. v. Abboud, 568 F.3d 390 (2d Cir. 2009)—17:16
- J.A. Brundage Plumbing & Roto-Rooter, Inc. v. Massachusetts Bay Ins. Co., 818 F. Supp. 553 (W.D. N.Y. 1993)—16:3
- J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460 (Fed. Cir. 1991)—6:3
- Japan Telecom, Inc. v. Japan Telecom America Inc., 287 F.3d 866 (9th Cir. 2002)—12:31
- Jay Franco & Sons, Inc. v. Franek, 615 F.3d 855 (7th Cir. 2010)—4:17
- Jefferson Parish Hosp. Dist. No. 2 v. Hyde, 466 U.S. 2, 104 S. Ct. 1551, 80 L. Ed. 2d 2 (1984)—18:3
- Jews For Jesus v. Brodsky, 993 F. Supp. 282 (D.N.J. 1998)—10:11, 14:2, 14:13, 15:7
- J.G. Wentworth, S.S.C. Ltd. Partnership v. Settlement Funding LLC, 85 U.S.P.Q.2d 1780, 2007 WL 30115 (E.D. Pa. 2007)—15:14
- Jibjab Media, Inc., In re, 2009 WL 389881 (T.T.A.B. 2009)—5:10
- John Allan Co. v. Craig Allen Co. L.L.C., 540 F.3d 1133 (10th Cir. 2008)—12:14
- John C. Flood of Virginia, Inc. v. John C. Flood, Inc., 642 F.3d 1105 (D.C. Cir. 2011)—17:13
- Johnny's Fine Foods, Inc. v. Johnny's Inc., 286 F. Supp. 2d 876 (M.D. Tenn. 2003)—12:29
- Johnson & Johnson-Merck Consumer Pharmaceuticals Co. v. Rhone-Poulenc Rorer Pharmaceuticals, Inc., 19 F.3d 125 (3d Cir. 1994)—13:11
- Jonathan Drew, Inc. d/b/a Drew Estate, In re, 97 U.S.P.Q.2d 1640, 2011 WL 481329 (T.T.A.B. 2011)—5:9
- Jones Day v. Blockshopper LLC, 89 U.S.P.Q.2d 1623, 2008 WL 4925644 (N.D. Ill. 2008)—10:19
- Jordache Enterprises, Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 92 A.L.R. Fed. 1 (10th Cir. 1987)—12:25

K

- K and N Engineering, Inc. v. Bulat, 510 F.3d 1079 (9th Cir. 2007)—11:8
- Kason Industries, Inc. v. Component Hardware Group, Inc., 120 F.3d 1199 (11th Cir. 1997)—12:29
- Kathleen Hiraga v. Sylvester J. Arena, 90 U.S.P.Q.2d 1102, 2009 WL 723334 (T.T.A.B. 2009)—6:26
- Keene Corp. v. Paraflex Industries, Inc., 653 F.2d 822 (3d Cir. 1981)—4:18
- Kellogg Co. v. Exxon Corp., 209 F.3d 562, 2000 FED App. 0123P (6th Cir. 2000)—12:30
- Kelly-Brown v. Winfrey, 717 F.3d 295 (2d Cir. 2013)—12:1
- Kelly-Brown v. Winfrey, 40 Media L. Rep. (BNA) 1481, 103 U.S.P.Q.2d 1375, 2012 WL 701262 (S.D. N.Y. 2012)—12:1
- Kia Motors America, Inc. v. Au-

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- toworks Distributing, 31 Int'l Trade Rep. (BNA) 1795, 90 U.S.P.Q.2d 1598, 2009 WL 499543 (D. Minn. 2009)—8:17
- King of the Mountain Sports, Inc. v. Chrysler Corp., 185 F.3d 1084 (10th Cir. 1999)—9:13
- Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc., 97 U.S.P.Q.2d 1912, 2011 WL 481339 (T.T.A.B. 2011)—4:17
- K Mart Corp. v. Cartier, Inc., 486 U.S. 281, 108 S. Ct. 1811, 100 L. Ed. 2d 313 (1988)—8:17
- Kos Pharmaceuticals, Inc. v. Andrx Corp., 369 F.3d 700 (3d Cir. 2004)—9:11
- KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 408 F.3d 596 (9th Cir. 2005)—12:22
- KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004)—12:22
- Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942 (N.D. Ill. 2002)—4:25
- Krasnyi Oktyabr, Inc. v. Trilini Imports, 578 F. Supp. 2d 455 (E.D. N.Y. 2008)—17:11
- Kregos v. Associated Press, 731 F. Supp. 113 (S.D. N.Y. 1990)—4:17
- Krehl v. Baskin-Robbins Ice Cream Co., 664 F.2d 1348 (9th Cir. 1982)—18:3
- L**
- Lahoti v. Vericheck, Inc., 636 F.3d 501 (9th Cir. 2011)—4:24
- Lands' End, Inc. v. Manback, 797 F. Supp. 511 (E.D. Va. 1992)—4:1
- Laura Scudder's v. Pacific Gamble Robinson Co., 136 U.S.P.Q. 418, 1962 WL 8576 (T.T.A.B. 1962)—2:12
- Lebanese Arak Corporation, In re, 94 U.S.P.Q.2d 1215, 2010 WL 766488 (T.T.A.B. 2010)—5:10, 5:11
- Lebas Fashion Imports of USA, Inc. v. ITT Hartford Ins. Group, 50 Cal. App. 4th 548, 59 Cal. Rptr. 2d 36 (2d Dist. 1996)—16:2, 16:3
- Les Halles De Paris J.V., In re, 334 F.3d 1371 (Fed. Cir. 2003)—5:9
- Lettuce Entertain You Enterprises, Inc. v. Leila Sophia & R. LLC, 638 F. Supp. 2d 895 (N.D. Ill. 2009)—12:22
- Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 719 F.3d 1367 (Fed. Cir. 2013)—12:6, 12:7
- Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158 (9th Cir. 2011)—10:13
- Levi Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817 (9th Cir. 1980)—8:5
- Levi Strauss & Co. v. GTFM, Inc., 196 F. Supp. 2d 971 (N.D. Cal. 2002)—3:4
- Levi Strauss & Co. v. San Francisco 415 Co., 1996 WL 724786 (N.D. Cal. 1996)—10:11
- Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Tex., 185 F. Supp. 895 (E.D. Ark. 1960)—5:14
- Lockheed Martin Corp. v. Net-

TABLE OF CASES

- work Solutions, Inc., 141 F. Supp. 2d 648 (N.D. Tex. 2001)—14:11, 14:19
- Lockheed Martin Corp. v. Skunkworx Custom Cycle, 74 U.S.P.Q.2d 1486, 2005 WL 1131161 (W.I.P.O.A.M.C. 2005)—14:9
- Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867 (2d Cir. 1986)—4:23
- Lorillard Tobacco Co. v. S & M Brands, Inc., 616 F. Supp. 2d 581 (E.D. Va. 2009)—8:18
- Lou v. Otis Elevator Co., 77 Mass. App. Ct. 571, 933 N.E.2d 140 (2010)—17:14
- Louis Vuitton Malletier v. Dooney & Bourke, Inc., 340 F. Supp. 2d 415 (S.D. N.Y. 2004)—9:12
- Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc., 658 F.3d 936 (9th Cir. 2011)—8:22, 11:8
- Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc., 591 F. Supp. 2d 1098 (N.D. Cal. 2008)—8:22, 15:15
- Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007)—10:15, 10:16, 12:25
- Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 464 F. Supp. 2d 495 (E.D. Va. 2006)—10:14
- Louis Vuitton Malletier S.A. v. LY USA, Inc., 676 F.3d 83 (2d Cir. 2012)—11:5, 11:8
- Lucas Nursery and Landscaping, Inc. v. Grosse, 359 F.3d 806, 2004 FED App. 0071P (6th Cir. 2004)—14:14
- Luxuria, s.r.o., In re, 2011 WL 4871869 (T.T.A.B. 2011)—5:10
- Lyons Partnership v. Giannoulas, 179 F.3d 384 (5th Cir. 1999)—12:25
- M**
- M-5 Steel Mfg., Inc. v. O'Hagin's Inc., 61 U.S.P.Q.2d 1086, 2001 WL 1167788 (T.T.A.B. 2001)—4:18
- Madrigal Audio Laboratories, Inc. v. Cello, Ltd., 799 F.2d 814 (2d Cir. 1986)—17:16
- Majestic Distilling Co., Inc., In re, 315 F.3d 1311 (Fed. Cir. 2003)—6:16
- Maker's Mark Distillery, Inc. v. Diageo North America, Inc., 673 F.3d 410 (6th Cir. 2012)—4:18, 8:7
- Malletier v. Dooney & Bourke, Inc., 561 F. Supp. 2d 368 (S.D. N.Y. 2008)—10:13
- Maritz, Inc. v. Cybergold, Inc., 947 F. Supp. 1328 (E.D. Mo. 1996)—15:6
- Marlyn Nutraceuticals, Inc. v. Mucos Pharma GmbH & Co., 571 F.3d 873 (9th Cir. 2009)—3:4, 12:11
- Mars, Inc., In re, 105 U.S.P.Q.2d 1859, 2013 WL 326569 (T.T.A.B. 2013)—4:17, 4:26
- Martha Graham School and Dance Foundation, Inc. v. Martha Graham Center of Contemporary Dance, Inc., 153 F. Supp. 2d 512 (S.D. N.Y. 2001)—17:13
- Martin's Famous Pastry Shoppe, Inc., In re, 748 F.2d 1565 (Fed. Cir. 1984)—5:16
- Maruti.Com v. Maruti Udyog Ltd., 447 F. Supp. 2d 494 (D. Md. 2006)—14:12

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Marvin J. Perry, Inc. v. Hartford Cas. Ins. Co., 615 F. Supp. 2d 432 (D. Md. 2009)—16:6
- Masters v. UHS of Delaware, Inc., 631 F.3d 464 (8th Cir. 2011)—12:16
- Mattel, Inc. v. The Brainy Baby Company, Llc, 101 U.S.P.Q.2d 1140, 2011 WL 7005540 (T.T.A.B. 2011)—5:5
- Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002)—12:27
- Matusalem, In re, 158 B.R. 514 (Bankr. S.D. Fla. 1993)—20:11
- McBee v. Delica Co., Ltd., 417 F.3d 107 (1st Cir. 2005)—21:6
- McDonald's Corp. v. Arche Technologies, 17 U.S.P.Q.2d 1557, 1990 WL 10072486 (N.D. Cal. 1990)—10:6
- McDonald's Corp. v. Druck and Gerner, DDS., P.C., 814 F. Supp. 1127 (N.D. N.Y. 1993)—6:3
- McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 95 A.L.R. Fed. 1 (S.D. N.Y. 1986)—6:3
- McDonald's Corp. v. McClain, 37 U.S.P.Q.2d 1274, 1995 WL 785743 (T.T.A.B. 1995)—6:3
- McDonald's Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1989 WL 274414 (T.T.A.B. 1989)—6:3
- McNeil-P.C.C., Inc. v. Bristol-Myers Squibb Co., 938 F.2d 1544 (2d Cir. 1991)—13:13
- McNeilab, Inc. v. American Home Products Corp., 848 F.2d 34 (2d Cir. 1988)—13:11
- McNeil Nutritionals, LLC v. Heartland Sweeteners LLC, 566 F. Supp. 2d 378 (E.D. Pa. 2008)—8:2
- McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC, 511 F.3d 350 (3d Cir. 2007)—4:15, 8:2, 8:4, 9:9
- Mead Johnson & Co. v. Abbott Laboratories, 201 F.3d 883 (7th Cir. 2000)—13:8
- Mediashare Corp., In Re, 43 U.S.P.Q.2d 1304, 1997 WL 413904 (T.T.A.B. 1997)—4:1
- Medicine Shoppe Intern., Inc. v. S.B.S. Pill Dr., Inc., 336 F.3d 801 (8th Cir. 2003)—20:11
- MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 127 S. Ct. 764, 166 L. Ed. 2d 604 (2007)—7:4, 12:9
- Medinol Ltd. v. Neuro Vasx, Inc., 67 U.S.P.Q.2d 1205, 2003 WL 21189780 (T.T.A.B. 2003)—6:26
- Medline Industries, Inc. v. Strategic Commercial Solutions, Inc., 553 F. Supp. 2d 979 (N.D. Ill. 2008)—14:15
- Meece, In re, 261 B.R. 403 (Bankr. N.D. Tex. 2001)—20:16
- Merck & Co., Inc. v. Mediplan Health Consulting, Inc., 425 F. Supp. 2d 402 (S.D. N.Y. 2006)—15:14
- Metro Mobile CTS, Inc. v. Newvector Communications, Inc., 643 F. Supp. 1289 (D. Ariz. 1986)—13:6
- Milbank Tweed Hadley & McCloy LLP v. Milbank Holding Corp., 82 U.S.P.Q.2d 1583, 2007 WL 1438114 (C.D. Cal. 2007)—10:11

TABLE OF CASES

Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC, 702 F.3d 1312 (11th Cir. 2012)—4:20	calTec Communications, Inc., 122 F. Supp. 2d 1046 (D. Minn. 2000)—15:6
Mink v. AAAA Development LLC, 190 F.3d 333 (5th Cir. 1999)—15:6	N
Minnesota Mining and Mfg. Co. v. Rauh Rubber, Inc., 943 F. Supp. 1117 (D. Minn. 1996)—10:5	N.A.D., Inc., In re, 57 U.S.P.Q.2d 1872, 2000 WL 33158291 (T.T.A.B. 2000)—5:17
Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254 (2d Cir. 1987)—4:7	National Business Forms & Printing, Inc. v. Ford Motor Co., 671 F.3d 526, 81 Fed. R. Serv. 3d 1285 (5th Cir. 2012)—8:7, 8:9, 10:12
Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504 (C.C.P.A. 1956)—4:21	National Collection & Credit Control, Inc., In re, 152 U.S.P.Q. 200, 1966 WL 7144 (T.T.A.B. 1966)—5:14
Monsanto Co. v. Campuzano, 206 F. Supp. 2d 1270 (S.D. Fla. 2002)—10:4	N.C.P. Marketing Group, Inc., In re, 337 B.R. 230 (D. Nev. 2005)—20:11
Monte Carlo Shirt, Inc. v. Daewoo Intern. (America) Corp., 707 F.2d 1054, 36 U.C.C. Rep. Serv. 487 (9th Cir. 1983)—8:12	Nemet Chevrolet, Ltd. v. Consumeraffairs.com, Inc., 564 F. Supp. 2d 544 (E.D. Va. 2008)—13:2, 13:3
Moore Business Forms, Inc. v. Ryu, 960 F.2d 486, 118 A.L.R. Fed. 677 (5th Cir. 1992)—17:8	Neogen Corp. v. Neo Gen Screening, Inc., 282 F.3d 883, 2002 FED App. 0080P (6th Cir. 2002)—15:6
Morton-Norwich Products, Inc., In re, 671 F.2d 1332 (C.C.P.A. 1982)—4:17	Network Automation, Inc. v. Advanced Systems Concepts, Inc., 638 F.3d 1137 (9th Cir. 2011)—15:14
Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 123 S. Ct. 1115, 155 L. Ed. 2d 1 (2003)—10:2, 10:4	New Hampshire Ins. Co. v. Foxfire, Inc., 820 F. Supp. 489 (N.D. Cal. 1993)—16:1, 16:4
Motor City Bagels, L.L.C. v. American Bagel Co., 50 F. Supp. 2d 460 (D. Md. 1999)—11:5	New Hampshire Ins. Co. v. Power-O-Peat, Inc., 907 F.2d 58 (8th Cir. 1990)—16:6
M2 Software, Inc., a Delaware corporation v. Madacy Entertainment, a corporation, 421 F.3d 1073 (9th Cir. 2005)—9:7	New Hampshire Ins. Co. v. R.L. Chaides Const. Co., Inc., 847 F. Supp. 1452 (N.D. Cal. 1994)—16:4
Multi-Tech Systems, Inc. v. Vo-	New Kids on the Block v. News America Pub., Inc., 971

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- F.2d 302 (9th Cir. 1992)—
12:23
NewMarkets Partners LLC v.
Oppenheim, 638 F. Supp.
2d 394 (S.D. N.Y. 2009)—
21:7
Newport News Holdings Corp.
v. Virtual City Vision, Inc.,
650 F.3d 423, 79 Fed. R.
Serv. 3d 630 (4th Cir.
2011)—14:14
New York Stock Exchange, Inc.
v. New York, New York Ho-
tel LLC, 293 F.3d 550 (2d
Cir. 2002)—12:25
Nextel Communications, Inc. v.
Motorola, Inc., 91
U.S.P.Q.2d 1393, 2009 WL
1719598 (T.T.A.B. 2009)—
4:11, 4:23
Nida Corp. v. Nida, 118 F. Supp.
2d 1223 (M.D. Fla. 2000)—
15:6
Nightingale Home Healthcare,
Inc. v. Anodyne Therapy,
LLC, 626 F.3d 958 (7th Cir.
2010)—12:18
Nike, Inc. v. Already, LLC, 663
F.3d 89 (2d Cir. 2011)—12:9
Nike, Inc. v. Nikepal Intern.,
Inc., 84 U.S.P.Q.2d 1820,
2007 WL 2782030 (E.D.
Cal. 2007)—10:11, 10:13
Nikkal Industries, Ltd. v. Sal-
ton, Inc., 735 F. Supp. 1227
(S.D. N.Y. 1990)—13:10
Nikon Inc. v. Ikon Corp., 987
F.2d 91 (2d Cir. 1993)—10:4
Northern Pac. Ry. Co. v. U.S.,
356 U.S. 1, 78 S. Ct. 514, 2
L. Ed. 2d 545 (1958)—18:1
Northland Ins. Companies v.
Blaylock, 115 F. Supp. 2d
1108 (D. Minn. 2000)—
14:14
Novak v. Overture Services,
Inc., 309 F. Supp. 2d 446
(E.D. N.Y. 2004)—15:6
N.V. Organon, In re, 79
U.S.P.Q.2d 1639, 2006 WL
1723556 (T.T.A.B. 2006)—
4:14, 4:17
- O**
- Office of Personnel Management
v. MS Technology Inc., 70
U.S.P.Q.2d 1333, 2003 WL
23472306 (National Arb.
Forum 2003)—14:9
1-800 Contacts, Inc. v.
Lens.com, Inc. 722 F.3d
1229 (10th Cir. 2013)—
15:14
1-800 Contacts, Inc. v.
WhenU.Com, Inc., 414 F.3d
400 (2d Cir. 2005)—15:13,
15:14
1992, Inc., In re, 137 B.R. 778,
17 U.C.C. Rep. Serv. 2d 598
(Bankr. C.D. Cal. 1992)—
20:8
One Industries, LLC v. Jim
O'Neal Distributing, Inc.,
578 F.3d 1154, 74 Fed. R.
Serv. 3d 778 (9th Cir.
2009)—2:12
1800Mattress.com IP, LLC, In
re, 586 F.3d 1359 (Fed. Cir.
2009)—4:20
ONY, Inc. v. Cornerstone Thera-
peutics, Inc., 720 F.3d 490
(2d Cir. 2013)—13:6
Oppedahl & Larson LLP, In re,
373 F.3d 1171 (Fed. Cir.
2004)—6:16
Oriental Financial Group, Inc.
v. Cooperativa de Ahorro y
Credito Oriental, 698 F.3d
9 (1st Cir. 2012)—12:29
Osmose, Inc. v. Viance, LLC,
612 F.3d 1298 (11th Cir.
2010)—13:12

TABLE OF CASES

- Osmotica Holdings Corporation,
In re, 95 U.S.P.Q.2d 1666,
2010 WL 2513862 (T.T.A.B.
2010)—6:11
- P**
- PACCAR Inc. v. TeleScan Technologies, L.L.C., 319 F.3d
243, 2003 FED App. 0040P
(6th Cir. 2003)—15:9
- Pacific Telesis Group v. International Telesis Communications, 795 F. Supp. 979
(C.D. Cal. 1991)—9:4
- Pagliero v. Wallace China Co.,
198 F.2d 339 (9th Cir.
1952)—4:18
- PARFUMS DE COEUR, LTD. v.
LORY LAZARUS, 83
U.S.P.Q.2d 1012, 2007 WL
683784 (T.T.A.B. 2007)—
5:15
- Paris Glove of Canada, Ltd. v.
SBC/Sporto Corp., 84
U.S.P.Q.2d 1856, 2007 WL
2422997 (T.T.A.B. 2007)
3:4
- PDK Labs, Inc. v. Friedlander,
103 F.3d 1105 (2d Cir.
1997)—13:2
- Pebble Beach Co. v. Tour 18 I,
Ltd., 942 F. Supp. 1513
(S.D. Tex. 1996)—9:6
- Peerless Lighting Corp. v.
American Motorists Ins.
Co., 82 Cal. App. 4th 995,
98 Cal. Rptr. 2d 753 (1st
Dist. 2000)—16:2, 16:3, 16:4
- Pennzoil-Quaker State Co. v.
Smith, 2008 WL 4107159
(W.D. Pa. 2008)—11:5
- People v. Ebelechukwu, 403 Ill.
App. 3d 62, 344 Ill. Dec.
516, 937 N.E.2d 222 (1st
Dist. 2010)—11:2
- People for Ethical Treatment of
Animals, Inc. v. Doughney,
113 F. Supp. 2d 915 (E.D.
Va. 2000)—15:7
- Perfect 10, Inc. v. Visa Intern.
Service Ass'n, 494 F.3d 788
(9th Cir. 2007)—8:22
- Pernod Ricard USA, LLC v. Bacardi U.S.A., Inc., 653 F.3d
241 (3d Cir. 2011)—13:11
- Petition for Writ of Certiorari,
2012 WL 441275—12:9
- Philip Morris USA v. Williams,
549 U.S. 346, 127 S. Ct.
1057, 166 L. Ed. 2d 940
(2007)—8:6, 13:20
- Philip Morris USA Inc. v. Lee,
547 F. Supp. 2d 667 (W.D.
Tex. 2008)—8:22
- Philip Morris USA Inc. v. Williams,
556 U.S. 178, 129 S.
Ct. 1436, 173 L. Ed. 2d 346
(2009)—13:20
- PhotoMedex, Inc. v. Irwin, 601
F.3d 919 (9th Cir. 2010)—
13:14
- Pierce Foods Corporation, In re,
230 U.S.P.Q. 307, 1986 WL
83587 (T.T.A.B. 1986)—3:4
- Pirone v. MacMillan, Inc., 894
F.2d 579 (2d Cir. 1990)—
12:3
- Pizza Hut, Inc. v. Papa John's
Intern., Inc., 227 F.3d 489
(5th Cir. 2000)—13:3, 13:6,
13:9
- Planned Parenthood Federation
of America, Inc. v. Bucci, 42
U.S.P.Q.2d 1430, 1997 WL
133313 (S.D. N.Y. 1997)—
14:2, 14:13
- Playboy Enterprises, Inc. v. Net-
scape Communications
Corp., 354 F.3d 1020 (9th
Cir. 2004)—15:14
- Playboy Enterprises, Inc. v. Net-
scape Communications

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Corp., 2000 WL 1308815 (C.D. Cal. 2000)—15:12
- Playboy Enterprises, Inc. v. Netscape Communications Corp., 55 F. Supp. 2d 1070 (C.D. Cal. 1999)—15:12
- Playboy Enterprises, Inc. v. St. Paul Fire & Marine Ins. Co., 769 F.2d 425 (7th Cir. 1985)—16:4
- Playboy Enterprises, Inc. v. Terri Welles, Inc., 78 F. Supp. 2d 1066 (S.D. Cal. 1999)—15:10, 15:12
- Pohl-Boskamp GmbH & Co., In re, 106 U.S.P.Q.2d 1042, 2013 WL 1234849 (T.T.A.B. 2013)—4:12, 4:14, 4:17
- Polk's Model Craft Hobbies Inc., In re, 40 U.S.P.Q.2d 1711, 1995 WL 908275 (Bankr. D. N.J. 1995)—4:17
- Polymer Technology Corp. v. Mimran, 37 F.3d 74 (2d Cir. 1994)—8:10
- Pom Wonderful LLC v. Coca-Cola Co., 679 F.3d 1170 (9th Cir. 2012)—13:14
- Power Test Petroleum Distributors, Inc. v. Calcu Gas, Inc., 754 F.2d 91 (2d Cir. 1985)—15:3
- PPX Enterprises, Inc. v. Audiofidelity Enterprises, Inc., 818 F.2d 266 (2d Cir. 1987)—13:18
- Prakash Melwani v. Allegiance Corporation, 97 U.S.P.Q.2d 1537, 2010 WL 5574281 (T.T.A.B. 2010)—6:20
- Presbyterian Church in U.S. v. Mary Elizabeth Blue Hull Memorial Presbyterian Church, 393 U.S. 440, 89 S. Ct. 601, 21 L. Ed. 2d 658 (1969)—12:28
- Prestonettes, Inc., v. Coty, 264 U.S. 359, 44 S. Ct. 350, 68 L. Ed. 731 (1924)—8:14
- Princeton Graphics Operating, L.P. v. NEC Home Electronics (U.S.A.), Inc., 732 F. Supp. 1258 (S.D. N.Y. 1990)—13:10
- Princeton Tectonics, Inc., In re, 95 U.S.P.Q.2d 1509, 2010 WL 2604976 (T.T.A.B. 2010)—5:17
- Principe v. McDonald's Corp., 631 F.2d 303 (4th Cir. 1980)—18:3
- Procter & Gamble Co. v. Kimberly-Clark Corp., 569 F. Supp. 2d 796 (E.D. Wis. 2008)—13:6
- Proctor & Gamble Co. v. Hauen, 222 F.3d 1262, 104 A.L.R.5th 737 (10th Cir. 2000)—13:4, 13:5
- Pro Football, Inc. v. Harjo, 565 F.3d 880, 64 A.L.R. Fed. 2d 651 (D.C. Cir. 2009)—5:11
- Q**
- Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 115 S. Ct. 1300, 131 L. Ed. 2d 248 (1995)—4:10, 4:18, 4:19
- Quality Inns Intern., Inc. v. McDonald's Corp., 695 F. Supp. 198 (D. Md. 1988)—6:3
- Quantegy, Inc., In re, 326 B.R. 467 (Bankr. M.D. Ala. 2005)—20:11
- Quick Technologies, Inc. v. Sage Group PLC, 313 F.3d 338, 54 Fed. R. Serv. 3d 220 (5th Cir. 2002)—12:16

TABLE OF CASES

- R**
- R & R Partners, Inc. v. Tovar, 447 F. Supp. 2d 1141 (D. Nev. 2006)—3:6, 9:8
- Ray Communications, Inc. v. Clear Channel Communications, Inc., 673 F.3d 294 (4th Cir. 2012)—12:29
- Rearden LLC v. Rearden Commerce, Inc., 683 F.3d 1190 (9th Cir. 2012)—2:6, 9:11
- Rearden LLC v. Rearden Commerce, Inc., 597 F. Supp. 2d 1006 (N.D. Cal. 2009)—4:24
- Reebok Intern., Ltd. v. Marnatech Enterprises, Inc., 970 F.2d 552, 22 Fed. R. Serv. 3d 1314 (9th Cir. 1992)—21:6
- Reemtsma Cigarettenfabriken G.M.B.H., In re, 122 U.S.P.Q. 339, 1959 WL 6173 (T.T.A.B. 1959)—5:10
- RENAISSANCE RIALTO INC. v. KY BOYD, 107 U.S.P.Q.2d 1083, 2013 WL 3191218 (T.T.A.B. 2013)—7:7
- Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2d Cir. 2009)—8:1, 15:14
- Rescuecom Corp. v. Google, Inc., 456 F. Supp. 2d 393 (N.D. N.Y. 2006)—15:14
- Research in Motion Limited v. Defining Presence Marketing Group, Inc. and Axel Ltd. Co., 102 U.S.P.Q.2d 1187, 2012 WL 893481 (T.T.A.B. 2012)—5:15, 5:18, 10:15
- Research In Motion Limited v. NBOR Corporation, 92 U.S.P.Q.2d 1926, 2009 WL 4694941 (T.T.A.B. 2009)—6:13
- Revell v. Lidov, 317 F.3d 467, 173 Ed. Law Rep. 403 (5th Cir. 2002)—15:6
- Rhone-Poulenc Rorer Pharmaceuticals, Inc. v. Marion Merrell Dow, Inc., 93 F.3d 511 (8th Cir. 1996)—13:12, 13:13
- Richard M. Hoefflin, In re, 97 U.S.P.Q.2d 1174, 2010 WL 5191373 (T.T.A.B. 2010)—5:13
- Ringling Brothers-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp., 937 F. Supp. 204 (S.D. N.Y. 1996)—10:11, 19:14
- Robinson Knife Mfg. Co., Inc. v. C.I.R., 600 F.3d 121 (2d Cir. 2010)—19:19
- Rocket Trademarks Pty Ltd. v. Phard S.p.A., 98 U.S.P.Q.2d 1066, 2011 WL 810221 (T.T.A.B. 2011)—5:18
- Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989)—12:27
- Rogers v. Grimaldi, 695 F. Supp. 112 (S.D. N.Y. 1988)—12:27
- Rolex Watch U.S.A., Inc. v. AFP Imaging Corporation, 101 U.S.P.Q.2d 1188, 2011 WL 6780738 (T.T.A.B. 2011)—6:8, 10:13, 10:15
- Rolf Dietrich, In re, 91 U.S.P.Q.2d 1622, 2009 WL 2138978 (T.T.A.B. 2009)—4:17
- Roman Cleanser Co., Matter of, 43 B.R. 940, 39 U.C.C. Rep. Serv. 1770 (Bankr. E.D. Mich. 1984)—20:8
- Rose Art Industries, Inc. v. Swanson, 235 F.3d 165 (3d Cir. 2000)—6:3
- Rosetta Stone Ltd. v. Google, Inc., 676 F.3d 144 (4th Cir. 2012)—15:14

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Rosetta Stone Ltd. v. Google Inc., 732 F. Supp. 2d 628 (E.D. Va. 2010)—15:14
- Rosetta Stone Ltd. v. Google, Inc., 730 F. Supp. 2d 531 (E.D. Va. 2010)—15:14
- Ryan v. Volpone Stamp Co., Inc., 107 F. Supp. 2d 369 (S.D. N.Y. 2000)—17:12
- S**
- Saddlesprings, Inc. v. Mad Croc Brands, Inc., 104 U.S.P.Q.2d 1948, 2012 WL 5196161 (T.T.A.B. 2012)—6:25
- Sallen v. Corinthians Licenciamientos LTDA, 273 F.3d 14 (1st Cir. 2001)—14:11
- Sanderson Farms, Inc. v. Tyson Foods, Inc., 547 F. Supp. 2d 491 (D. Md. 2008)—13:2
- S&L Vitamins, Inc. v. Australian Gold, Inc., 521 F. Supp. 2d 188 (E.D. N.Y. 2007)—8:15
- Sandoz Pharmaceuticals Corp. v. Richardson-Vicks, Inc., 902 F.2d 222 (3d Cir. 1990)—13:14
- Sands, Taylor & Wood Co. v. Quaker Oats Co., 1995 WL 221871 (N.D. Ill. 1995)—12:22
- Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947 (7th Cir. 1992)—12:22
- Sands, Taylor & Wood Co. v. Quaker Oats Co., 1985 WL 1567 (N.D. Ill. 1985)—12:22
- Sanofi-Aventis v. Advancis Pharmaceutical Corp., 453 F. Supp. 2d 834 (D. Del. 2006)—3:4
- Santa's Best Craft, LLC v. St. Paul Fire and Marine Ins. Co., 611 F.3d 339 (7th Cir. 2010)—16:8
- Schiapparelli Searle, In re, 26 U.S.P.Q.2d 1520, 1993 WL 156483 (T.T.A.B. 1993)—4:1
- Schieffelin & Co. v. Jack Co. of Boca, Inc., 725 F. Supp. 1314 (S.D. N.Y. 1989)—12:25
- Schlotzsky's, Ltd. v. Sterling Purchasing and Nat. Distribution Co., Inc., 520 F.3d 393 (5th Cir. 2008)—18:4
- Schmidheiny v. Weber, 319 F.3d 581 (3d Cir. 2003)—14:15
- S.C. Johnson & Son, Inc. v. Clorox Co., 241 F.3d 232 (2d Cir. 2001)—13:7
- S. C. Johnson & Son, Inc. v. Drop Dead Co., 210 F. Supp. 816 (S.D. Cal. 1962)—4:6
- S. C. Johnson & Son, Inc. v. Gold Seal Co., 230 F.2d 832 (D.C. Cir. 1956)—5:7
- Scott Fetzer Co. v. House of Vacuums Inc., 381 F.3d 477 (5th Cir. 2004)—8:10
- Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342 (C.C.P.A. 1977)—4:26
- Sea Tow Services Intern., Inc. v. Pontin, 607 F. Supp. 2d 378 (E.D. N.Y. 2009)—17:12
- Sebastian Intern., Inc. v. Longs Drug Stores Corp., 53 F.3d 1073 (9th Cir. 1995)—8:15
- Secalt S.A. v. Wuxi Shenxi Const. Machinery Co., Ltd., 668 F.3d 677 (9th Cir. 2012)—4:17, 12:18
- SecuraComm Consulting Inc. v. Securacom Inc., 166 F.3d 182 (3d Cir. 1999)—12:16
- Seven-Up Bottling Co. v. Seven-Up Co., 561 F.2d 1275 (8th Cir. 1977)—17:13

TABLE OF CASES

- Seven-Up Co. v. Coca-Cola Co.,
86 F.3d 1379 (5th Cir.
1996)—13:4
- Shaw Family Archives Ltd. v.
CMG Worldwide, Inc., 486
F. Supp. 2d 309 (S.D. N.Y.
2007)—8:1
- Shell Co. (Puerto Rico) Ltd., The
v. Los Frailes Service Sta-
tion, Inc., 605 F.3d 10 (1st
Cir. 2010)—11:5
- Shields v. Zuccarini, 89 F. Supp.
2d 634 (E.D. Pa. 2000)—
14:14
- Shinnecock Smoke Shop, In re,
2008 WL 4354159 (T.T.A.B.
2008)—5:12
- Shipley Company Inc., In re,
230 U.S.P.Q. 691, 1986 WL
83609 (T.T.A.B. 1986)—4:1
- Shire US Inc. v. Barr Labora-
tories, Inc., 329 F.3d 348
(3d Cir. 2003)—4:17
- ShoLodge, Inc. v. Travelers
Indem. Co. of Illinois, 168
F.3d 256, 1999 FED App.
0043P (6th Cir. 1999)—16:2
- ShutEmDown Sports, Inc. v.
Carl Dean Lacy, 102
U.S.P.Q.2d 1036, 2012 WL
684464 (T.T.A.B. 2012)—6:8
- Siegel v. Chicken Delight, Inc.,
448 F.2d 43, 14 A.L.R. Fed.
458 (9th Cir. 1971)—18:2,
18:4
- Silberman v. CBS Inc., 870 F.2d
40 (2d Cir. 1989)—3:3
- S Industries, Inc. v. Centra
2000, Inc., 249 F.3d 625, 49
Fed. R. Serv. 3d 1308 (7th
Cir. 2001)—12:18
- S Industries, Inc. v. Stone Age
Equipment, Inc., 12 F.
Supp. 2d 796 (N.D. Ill.
1998)—9:6
- Singer Management Consul-
tants, Inc. v. Milgram, 650
F.3d 223 (3d Cir. 2011)—
12:18
- Site Pro-1, Inc. v. Better Metal,
LLC, 506 F. Supp. 2d 123
(E.D. N.Y. 2007)—15:14
- Skylink Technologies, Inc. v. As-
surance Company of Amer-
ica, 400 F.3d 982 (7th Cir.
2005)—16:6
- Smartfoods, Inc. v. Northbrook
Property and Cas. Co., 35
Mass. App. Ct. 239, 618
N.E.2d 1365 (1993)—16:4
- SMJ Group, Inc. v. 417 Lafay-
ette Restaurant LLC, 439
F. Supp. 2d 281 (S.D. N.Y.
2006)—12:26
- Societe Des Produits Nestle,
S.A. v. Casa Helvetia, Inc.,
982 F.2d 633 (1st Cir.
1992)—8:17
- Soloflex, Inc. v. NordicTrack,
Inc., 31 U.S.P.Q.2d 1721,
1994 WL 568401 (D. Or.
1994)—10:4
- Soma Medical Intern. v. Stan-
dard Chartered Bank, 196
F.3d 1292 (10th Cir.
1999)—15:6
- Sound Unseen Ltd. v. Vander-
horst, 77 U.S.P.Q.2d 1585,
2005 WL 3772268
(W.I.P.O.A.M.C. 2005)—
14:9
- Southern Grouts & Mortars,
Inc. v. 3M Co., 575 F.3d
1235 (11th Cir. 2009)—
14:14
- Sovereign Military Hospitaller
Order of Saint John of Je-
rusalem of Rhodes and of
Malta v. Florida Priory of
Knights Hospitallers of Sov-
ereign Order of Saint John
of Jerusalem, Knights of

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- Malta, Ecumenical Order, 702 F.3d 1279 (11th Cir. 2012)—6:26, 9:1, 13:9
- Specialized Seating, Inc. v. Greenwich Industries, LP, 616 F.3d 722 (7th Cir. 2010)—4:17
- Spirits Intern., N.V., In re, 563 F.3d 1347 (Fed. Cir. 2009)—5:9
- Standard Brands v. Smidler, 151 F.2d 34 (C.C.A. 2d Cir. 1945)—4:25
- Stanfield v. Osborne Industries, Inc., 52 F.3d 867 (10th Cir. 1995)—17:5, 17:6
- Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97 (2d Cir. 2009)—10:13
- Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 79 U.S.P.Q.2d 1138, 2005 WL 3527126 (S.D. N.Y. 2005)—9:10
- State Auto Property and Casualty Insurance Company v. Travelers Indemnity Company of America, 343 F.3d 249 (4th Cir. 2003)—16:3, 16:4, 16:6
- State Farm Mut. Auto. Ins. Co. v. Campbell, 538 U.S. 408, 123 S. Ct. 1513, 155 L. Ed. 2d 585, 60 Fed. R. Evid. Serv. 1349, 1 A.L.R. Fed. 2d 739 (2003)—13:20
- Static Control Components, Inc. v. Lexmark Intern., Inc., 697 F.3d 387 (6th Cir. 2012)—13:2
- Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576 (Fed. Cir. 1984)—17:7
- Stork Restaurant v. Sahati, 166 F.2d 348 (C.C.A. 9th Cir. 1948)—4:25
- St. Paul Fire and Marine Ins. Co. v. Advanced Interventional Systems, Inc., 824 F. Supp. 583 (E.D. Va. 1993)—16:3
- Sullivan v. CBS Corp., 385 F.3d 772 (7th Cir. 2004)—9:7
- Sunbeam Products Inc. v. West Bend Co., 39 U.S.P.Q.2d 1545, 1996 WL 511639 (S.D. Miss. 1996)—10:11
- Super Bakery, Incorporated v. Ward E. Benedict, 96 U.S.P.Q.2d 1134, 2010 WL 3798526 (T.T.A.B. 2010)—6:20, 6:25
- Super Duper Inc. v. Pennsylvania Nat. Mut. Cas. Ins. Co., 385 S.C. 201, 683 S.E.2d 792 (2009)—16:3
- Superformance Intern., Inc. v. Hartford Cas. Ins. Co., 203 F. Supp. 2d 587 (E.D. Va. 2002)—16:6
- Surefoot LC v. Sure Foot Corp., 531 F.3d 1236 (10th Cir. 2008)—7:4, 12:9
- Swarovski Aktiengesellschaft v. Building No. 19, Inc., 2013 WL 959265 (D.R.I. 2013)—12:23
- Swarovski Aktiengesellschaft v. Building No. 19, Inc., 704 F.3d 44 (1st Cir. 2013)—12:11, 12:23
- Swiss Watch International, Inc. v. Federation of the Swiss Watch Industry, 101 U.S.P.Q.2d 1731, 2012 WL 504693 (T.T.A.B. 2012)—4:3

T

- T.A.B. Systems v. Pactel Teletrac, 77 F.3d 1372 (Fed. Cir. 1996)—2:12
- Taubman Co. v. Webfeats, 319

TABLE OF CASES

- F.3d 770, 54 Fed. R. Serv. 3d 1026, 2003 FED App. 0043P (6th Cir. 2003)— 12:14, 15:7
- Tdata Inc. v. Aircraft Technical Publishers, 411 F. Supp. 2d 901 (S.D. Ohio 2006)—15:9
- Teletech Customer Care Management (California), Inc. v. Tele-Tech Co., Inc., 977 F. Supp. 1407 (C.D. Cal. 1997)—10:11
- The Government of the District of Columbia, In re, 101 U.S.P.Q.2d 1588, 2012 WL 423804 (T.T.A.B. 2012)— 5:14
- the Procter & Gamble Co., In re, 105 U.S.P.Q.2d 1119, 2012 WL 6064533 (T.T.A.B. 2012)—4:26
- Thomas Nelson, Inc., In re, 97 U.S.P.Q.2d 1712, 2011 WL 481341 (T.T.A.B. 2011)— 4:23
- Thor Tech, Inc., In re, 90 U.S.P.Q.2d 1634, 2009 WL 1098997 (T.T.A.B. 2009)— 5:17, 5:19
- Ticketmaster Corp. v. Tickets.com, Inc., 2000 Copr. L. Dec. P 28146, 2000 WL 1887522 (C.D. Cal. 2000)—15:7
- Ticketmaster Corp. v. Tickets.Com, Inc., 54 U.S.P.Q.2d 1344, 2000 WL 525390 (C.D. Cal. 2000)— 15:7
- Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010)—8:21, 15:15
- Tiffany (NJ) Inc. v. eBay, Inc., 576 F. Supp. 2d 463 (S.D. N.Y. 2008)—10:16, 15:15
- Time Inc. Magazine Co. v. Globe Communications Corp., 712 F. Supp. 1103 (S.D. N.Y. 1989)—4:17
- Tire Engineering and Distribution, LLC v. Shandong Linglong Rubber Co., Ltd., 682 F.3d 292 (4th Cir. 2012)— 12:16, 21:6
- T. Marzetti Co. v. Roskam Baking Co., 680 F.3d 629 (6th Cir. 2012)—4:20
- TMT North America, Inc. v. Magic Touch GmbH, 124 F.3d 876 (7th Cir. 1997)— 2:13, 17:9
- TMT North America, Inc. v. The Magic Touch GmbH, 57 F. Supp. 2d 536 (N.D. Ill. 1999)—17:3
- Together Development Corp., In re, 227 B.R. 439, 37 U.C.C. Rcp. Serv. 2d 227 (Bankr. D. Mass. 1998)—20:8
- Tono Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir. 1981)—12:25
- Tomerlin Trust v. C.I.R., 87 T.C. 876, 1986 WL 22043 (1986)—19:16
- Too, Inc. v. TJX Companies, Inc., 229 F. Supp. 2d 825 (S.D. Ohio 2002)—8:11
- Torres v. Goodyear Tire & Rubber Co., Inc., 901 F.2d 750 (9th Cir. 1990)—17:14
- Total Call Intern., Inc. v. Peerless Ins. Co., 181 Cal. App. 4th 161, 104 Cal. Rptr. 3d 319 (2d Dist. 2010)—16:6
- Tower Tech, Inc., In re, 64 U.S.P.Q.2d 1314, 2002 WL 992268 (T.T.A.B. 2002)— 4:21
- Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F.3d 1171 (9th Cir. 2010)—12:23
- Toys R Us Inc. Abir, 45

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- U.S.P.Q.2d 1944, 1997 WL 857229 (S.D. N.Y. 1997)—10:11
Toys "R" Us, Inc. v. Akkaoui, 40 U.S.P.Q.2d 1836, 1996 WL 772709 (N.D. Cal. 1996)—10:11
Toys "R" Us, Inc. v. Step Two, S.A., 318 F.3d 446, 55 Fed. R. Serv. 3d 591 (3d Cir. 2003)—15:6
TrafficSchool.com, Inc. v. Edriver Inc., 653 F.3d 820 (9th Cir. 2011)—13:2, 13:21
TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 121 S. Ct. 1255, 149 L. Ed. 2d 164 (2001)—4:16, 4:17, 4:18
Trak Inc. v. Ski-Trac, Inc., 209 U.S.P.Q. 507, 1980 WL 30262 (N.D. Cal. 1980)—9:6
Trans Continental Records, Inc., In re, 62 U.S.P.Q.2d 1541, 2002 WL 448738 (T.T.A.B. 2002)—5:8
Trans Union LLC v. Credit Research, Inc., 142 F. Supp. 2d 1029 (N.D. Ill. 2001)—15:10
Travelers Property Casualty Company of America v. Charlotte Russe Holding, Inc., 207 Cal. App. 4th 969, 144 Cal. Rptr. 3d 12 (2d Dist. 2012)—16:6
Trek 2000 International Ltd., In re, 97 U.S.P.Q.2d 1106, 2010 WL 5099653 (T.T.A.B. 2010)—4:20, 7:3
True Blue Productions Inc. v. Hoffman, 73 U.S.P.Q.2d 1512, 2004 WL 3677014 (W.I.P.O.A.M.C. 2004)—14:9
Tudor Motor Lodge Associates, Ltd. Partnership, In re, 102 B.R. 936 (Bankr. D. N.J. 1989)—20:12
Turner Greenberg Associates, Inc. v. C & C Imports, Inc., 320 F. Supp. 2d 1317 (S.D. Fla. 2004)—8:3
Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335 (C.C.P.A. 1981)—8:7
Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992)—4:15
Ty Inc. v. Perryman, 306 F.3d 509 (7th Cir. 2002)—8:10
- U**
- U-Haul Intern., Inc. v. Jartran, Inc., 601 F. Supp. 1140 (D. Ariz. 1984)—13:17
Union Ins. Co. v. Knife Co., Inc., 897 F. Supp. 1213 (W.D. Ark. 1995)—16:3
Unique Sports Products, Inc. v. Ferrari Importing Co., 720 F.3d 1307 (11th Cir. 2013)—7:19
United Industries Corp. v. Clorox Co., 140 F.3d 1175 (8th Cir. 1998)—13:6, 13:12
United Mine Workers of America v. Pennington, 381 U.S. 657, 85 S. Ct. 1585, 14 L. Ed. 2d 626 (1965)—13:15
University of Alabama Bd. of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012)—12:27
Upslope LLC., In re, 2011 WL 481333 (T.T.A.B. 2011)—5:17
U.S. v. Chong Lam, 677 F.3d 190 (4th Cir. 2012)—11:1
U.S. v. Cone, 714 F.3d 197, 91 Fed. R. Evid. Serv. 149 (4th Cir. 2013)—11:1

TABLE OF CASES

- U.S. v. Petrosian, 126 F.3d 1232, 47 Fed. R. Evid. Serv. 1351 (9th Cir. 1997)—11:5
- U.S. v. Torkington, 812 F.2d 1347 (11th Cir. 1987)—11:5
- U.S. Healthcare, Inc. v. Blue Cross of Greater Philadelphia, 898 F.2d 914 (3d Cir. 1990)—13:3
- U.S. Navy v. United States Manufacturing Co., 2 U.S.P.Q.2d 1254, 1987 WL 123804 (T.T.A.B. 1987)—5:14
- U.S. Structures, Inc. v. J.P. Structures, Inc., 130 F.3d 1185, 1997 FED App. 0354P (6th Cir. 1997)—11:5
- Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research, 527 F.3d 1045 (10th Cir. 2008)—14:10, 14:13
- V**
- Valu Engineering, Inc. v. Nelu Plastics, Inc., 732 F. Supp. 1024 (N.D. Cal. 1990)—13:4
- Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002)—4:17
- Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156 (Fed. Cir. 1991)—2:12
- Vanity Fair Mills, Inc. v. T. Eaton Co., 234 F.2d 633 (2d Cir. 1956)—21:7
- Venture Tape Corp. v. McGills Glass Warehouse, 540 F.3d 56 (1st Cir. 2008)—12:16, 15:9
- Verizon California Inc. v. Navigation Catalyst Systems, Inc., 568 F. Supp. 2d 1088 (C.D. Cal. 2008)—14:14
- Vernon Chatman III, In re, 2009 WL 273243 (T.T.A.B. 2009)—4:24
- Vertex Group LLC, In re, 2009 WL 625581 (T.T.A.B. 2009)—4:11, 4:19
- Victoria's Secret Stores v. Artco Equipment Co., Inc., 194 F. Supp. 2d 704 (S.D. Ohio 2002)—15:7
- Vienna Sausage Manufacturing Co., In re, 16 U.S.P.Q.2d 2044, 1990 WL 354558 (T.T.A.B. 1990)—3:4
- Villeroy & Boch Keramische Werke K.G. v. THC Systems, Inc., 999 F.2d 619 (2d Cir. 1993)—4:18
- Virtual Works Inc. v. Volkswagen of America, Inc., 238 F.3d 264 (4th Cir. 2001)—14:14
- Visa Intern. Service Ass'n v. JSL Corp., 590 F. Supp. 2d 1306 (D. Nev. 2008)—10:11, 10:13, 10:15
- Vita-Mix Corp. v. Basic Holding, Inc., 581 F.3d 1317 (Fed. Cir. 2009)—2:6
- Voice-Tel Enterprises, Inc. v. JOBA, Inc., 258 F. Supp. 2d 1353 (N.D. Ga. 2003)—15:7
- Voice of the Arab World, Inc. v. MDTV Medical News Now, Inc., 645 F.3d 26 (1st Cir. 2011)—12:11
- Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350 (9th Cir. 1969)—8:7
- Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812 (1st Cir. 1987)—8:7
- Vuitton Et Fils S.A. v. J. Young Enterprises, Inc., 644 F.2d 769 (9th Cir. 1981)—4:18
- W**
- Waco Intern., Inc. v. KHK Scaffolding Houston Inc., 278

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

- F.3d 523, 51 Fed. R. Serv. 3d 1498 (5th Cir. 2002)—11:7
- Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 120 S. Ct. 1339, 146 L. Ed. 2d 182 (2000)—4:15, 4:19, 4:26
- Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp., 382 U.S. 172, 86 S. Ct. 347, 15 L. Ed. 2d 247 (1965)—16:6
- Wallace Intern. Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 916 F.2d 76 (2d Cir. 1990)—4:18
- Watkins v. U.S. Bureau of Customs and Border Protection, 643 F.3d 1189 (9th Cir. 2011)—7:17
- WAWA Dairy Farms v. Haaf, 40 U.S.P.Q.2d 1629, 1996 WL 460083 (E.D. Pa. 1996)—10:11
- WCVB-TV v. Boston Athletic Ass'n, 926 F.2d 42 (1st Cir. 1991)—17:13
- Weight Watchers Intern., Inc. v. Stouffer Corp., 744 F. Supp. 1259 (S.D. N.Y. 1990)—13:7
- Wellington Vision, Inc., In re, 364 B.R. 129 (S.D. Fla. 2007)—20:12
- Wendy's Intern., Inc. v. Big Bite, Inc., 576 F. Supp. 816 (S.D. Ohio 1983)—12:25
- Westfield Cos. v. O.K.L. Can Line, 155 Ohio App. 3d 747, 2003-Ohio-7151, 804 N.E.2d 45 (1st Dist. Hamilton County 2003)—16:4
- West Indian Sea Island Cotton Ass'n Inc. v. Threadtex, Inc., 761 F. Supp. 1041 (S.D. N.Y. 1991)—13:2
- Westinghouse Elec. Corp. v. General Circuit Breaker & Elec. Supply Inc., 106 F.3d 894 (9th Cir. 1997)—11:5
- What-A-Burger Of Virginia, Inc. v. Whataburger, Inc. Of Corpus Christi, Texas, 357 F.3d 441 (4th Cir. 2004)—12:29
- William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526, 44 S. Ct. 615, 68 L. Ed. 1161 (1924)—4:17
- Williams v. Philip Morris Inc., 340 Or. 35, 127 P.3d 1165 (2006)—13:20
- Windsurfing Intern. Inc. v. AMF Inc., 828 F.2d 755 (Fed. Cir. 1987)—7:4
- Winfield Collection, Ltd. v. McCauley, 105 F. Supp. 2d 746 (E.D. Mich. 2000)—15:6
- Woodland Furniture, LLC v. Larsen, 142 Idaho 140, 124 P.3d 1016 (2005)—4:18
- World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 100 S. Ct. 559, 62 L. Ed. 2d 490 (1980)—15:6
- World Religious Relief v. Gospel Music Channel, 563 F. Supp. 2d 714 (E.D. Mich. 2008)—12:9
- Wright, In re, 355 B.R. 192 (Bankr. C.D. Cal. 2006)—20:16
- W.T. Rogers Co., Inc. v. Keene, 778 F.2d 334 (7th Cir. 1985)—4:18
- Wynn Oil Co. v. American Way Service Corp., 943 F.2d 595 (6th Cir. 1991)—12:16

Y

- Yahoo!, Inc. v. Yahooahitos.com, 82 U.S.P.Q.2d 1361, 2006

TABLE OF CASES

WL 2303166 (E.D. Va. 2006)—14:16	Z
Yellowbook Inc. v. Brandeberry, 708 F.3d 837 (6th Cir. 2013)—2:13	Zenith Electronics Corp. v. Exzec, Inc., 182 F.3d 1340 (Fed. Cir. 1999)—13:15
YKK Corp. v. Jungwoo Zipper Co., Ltd., 213 F. Supp. 2d 1195 (C.D. Cal. 2002)—10:4	Zino Davidoff SA v. CVS Corp., 571 F.3d 238 (2d Cir. 2009)—8:15
Yoo-Hoo Chocolate Beverage Corp. v. A.J. Canfield Co., 229 U.S.P.Q. 653, 1986 WL 9720 (D.N.J. 1986)—4:24	Zippo Mfg. Co. v. Zippo Dot Com, Inc., 952 F. Supp. 1119 (W.D. Pa. 1997)—15:6

<http://www.pbookshop.com>

Index

ABANDONMENT

Generally, **3:1**
Change of mark or product, **3:4**
Express abandonment, **3:2**
Non-use, abandonment by, **3:3**

ACQUIESCENCE

Infringement, **12:30**

ACQUISITION OF RIGHTS

Generally, **1:2, 2:1 to 2:13**
Asset of firm being acquired, **2:13**
Concurrent use, **2:11**
Federal registrations. **Registration of Trademarks** (this index)
Priority, **2:10 to 2:12**
State name registries, **2:3**
Tacking, **2:12**
Use of mark
 generally, **2:5**
 bona fide use, **2:8**
 identity of mark holder, **2:9**
 in commerce, **2:6**
 legal use, **2:6**

ACQUISITIONS

Licensing problems, **17:9**

ADVERSE RULINGS

Eliminating, **7:19**

ADVERTISING

Comparative, **8:18, 10:17**
False Advertising (this index)
Insurance coverage for infringement, **16:2 to 16:6**
Web site
 banner, **15:12**
 key-word advertising programs, **15:14**
 pop-up, **15:13**

ALLOCATION

Taxation, **19:17**

AMENDMENTS

Sample licensing agreements, **27:1, 27:2**

AMORTIZATION OF TRADEMARKS

Generally, **19:2 to 19:11**
Amortizable intangible, **19:3**
Antichurning rules, **19:7**
Capitalized expenses, **19:5**
Disposition, **19:10**
Intangible, amortizable, **19:3**
Nonrecognition transactions, **19:8**
Renewals, **19:9**
Trademark value, **19:4**
Transactions
 generally, **19:6 to 19:11**
 antichurning rules, **19:7**
 disposition, **19:10**
 nonrecognition transactions, **19:8**
 renewals, **19:9**
Value of trademark, **19:4**

ANTICHURNING RULES

Amortization of trademarks, **19:7**

ANTICYBERSquatting CONSUMER PROTECTION ACT

Generally, **14:10 to 14:19**
Bad faith, **14:14**
Effective date, **14:15**
Ex rem litigation, **14:16**
Intent to profit, bad faith, **14:14**
Remedies
 against domain names sued in rem, **14:18**

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

ANTICYBERSQUATTING CONSUMER PROTECTION ACT—Cont'd Remedies—Cont'd against registrant sued in personam, 14:17 against registrars, 14:19 Safe harbor, 14:13 Standing of mark-holder, 14:12 Time issues, 14:15 Uniform Dispute Resolution Policy, relationship to, 14:11	ATTORNEY FEES Infringement, 12:18
ANTITRUST CONCERN Infringement violations, 12:32 Licensing, 17:15	AUDIT PROGRAMS Generally, 7:10 to 7:16 Assignments, 7:13 Due diligence, 7:16 Internet, 7:15 Licenses, 7:13 Quality control, 7:12 Registration, 7:11
APPEALS Federal Circuit to overturn Trademark Trial and Appeals Board decision, 6:16 Federal district court to overturn Trademark Trial and Appeals Board decision, 6:17 Trademark Trial and Appeals Board, 6:15 to 6:17	BAD FAITH Anticybersquatting Consumer Protection Act, 14:14 Remedies for false advertising, 13:19
APPLICATIONS Registration of Trademarks (this index)	BANKRUPTCY Generally, 1:20, 20:1 to 20:16 Assets of bankruptcy estate, 20:2 to 20:5 Assignment of intent-to-use application as security, 20:9 Attachment of collateral, 20:7 Automatic stay of assets, 20:4 Collateral, trademarks as, 20:6 to 20:9 Infringement claims, 20:16 Licenses (this index) Perfection of collateral, 20:8 Sale of assets, 20:3 Security interest, 20:6 to 20:8 Stay, automatic, 20:4 Transfers, prepetition, 20:5
APPROVAL Lack of consent of individual named or portrayed, 5:13	
ARBITRARY MARKS Protectable upon adoption, 4:25	
ARTISTIC USE First Amendment defense, 12:27	
ASSETS Acquisition of mark as asset of firm being acquired, 2:13 Bankruptcy estate, of, 20:2 to 20:5	BANNERS Internet advertising, 15:12
ASSIGNMENTS Audit programs, 7:13 Intent-to-use-application in bankruptcy proceedings, of, 20:9	BLURRING Dilution, 10:15
	BREACH OF CONTRACT International issues, suing foreign plaintiff for breach of United States contract, 21:5
	CANCELLATIONS Proceedings before Patent and Trademark Office, 7:8

INDEX

- CANCELLATIONS—Cont'd**
 Registration of trademarks, **6:25**
- CAPITALIZED EXPENSES**
 Amortization of trademarks, **19:5**
- CEASE-AND-DESIST LETTERS**
 Protection of marks, **7:4**
- CERTIFICATION MARKS**
 Generally, **4:3**
- CHANGE IN CIRCUMSTANCES**
 Likelihood of confusion, **9:14**
- CHANNELS OF TRADE**
 Likelihood of confusion, **9:10**
- CHOICE OF LAW**
 Jurisdiction (this index)
- CLAIM PRECLUSION**
 Infringement litigation, **12:6**
- COLLATERAL**
 Bankruptcy proceedings, **20:6 to 20:9**
- COLLECTIVE MARKS**
 Generally, **4:4**
- COLOR MARKS**
 Generally, **4:10**
- COMMERCE**
 Use of mark in, **2:6**
- COMMON-LAW PROTECTION**
 Dilution, **10:3**
- COMMUNICATIONS DECENCY ACT**
 Generally, **15:16**
- COMPARATIVE ADVERTISING**
 Infringement, **8:18**
- COMPENSATORY DAMAGES**
 Infringement, **12:16**
- COMPOSITE MARKS**
 Generally, **4:8**
- CONCEPTUAL STRENGTH**
 Strength of Marks (this index)
- CONCURRENT USE**
 Priority of rights, **2:11**
- CONCURRENT USE PROCEEDINGS**
 Registration of trademarks, **6:18**
- CONFUSION**
 Likelihood of Confusion (this index)
- CONSENT**
 Lack of consent of individual named or portrayed, **5:13**
- CONTINGENT PAYMENTS**
 Taxation, **19:15**
- CONTINUING INTEREST**
 Taxation, **19:13**
- CONTRIBUTORY DILUTION**
 Generally, **10:22**
- CONTRIBUTORY INFRINGEMENT**
 Generally, **8:21**
- CORPORATE NAMES REGISTRIES**
 Generally, **2:3**
- COSTS**
 Infringement litigation, **12:18**
- COUNTERFEIT MARKS**
 Generally, **1:11, 11:1 to 11:8**
 Civil liability, **11:4 to 11:8**
 Criminal liability, **11:1 to 11:3**
 Ex parte seizure, **11:6**
 Infringement, **8:23**
 Protection of marks, **7:18**
 Remedies against defendant, **11:8**
 State statutes, **11:2, 11:3**
- CREATIVE WORKS**
 Registration of titles to creative works, **5:5**

CRITICISM	DILUTION
First Amendment defense, 12:26	Generally, 1:10, 10:1 to 10:24
CUSTOMERS	Blurring, 10:15
Level of care by, 9:9	Comments related to holder of famous mark, exception for, 10:18
Likelihood of confusion, 5:19	Comparative advertising exception, 10:17, 10:18
Overlap of, 9:8	Competing goods, 10:4
CYBERSQUATTING	Contributory, 10:22
Anticybersquatting Consumer Protection Act (this index)	Distinctiveness, 10:10
DAMAGES AND REMEDIES	Exceptions, 10:16 to 10:20
Anticybersquatting Consumer Protection Act (this index)	Fair use exceptions, 10:17, 10:18
False advertising	Fame, 10:11
generally, 13:17 to 13:20	History, 10:2
bad faith, 13:19	Infringement, 8:19
proof needed to obtain damages, 13:18	Jurisdiction, 10:23
punitive damages, 13:20	News reporting and commentary exception, 10:19
Infringement litigation	Noncommercial use, 10:20
generally, 12:14 to 12:20	Products, mark holder's own, 10:5
attorney fees, 12:18	Registration of trademarks, 5:22
compensatory damages, 12:16	Similarity of marks, 10:13
costs, 12:18	State statutes interaction with federal statutes, 10:23
injunction, permanent, 12:14	usefulness of, 10:24
innocent infringer, 12:15	Tarnishment, 10:14
punitive damages, 12:17	Trade dress, 10:6
Trademark Dilution Revision Act, 10:21	Web sites, 15:5
DASTAR CASE	DISPARAGING MARKS
Infringement limitations created by, 12:4, 13:16	Registration of trademarks, 5:11
DECLARATORY JUDGMENTS	DISPOSITION
Infringement litigation, 12:9	Amortization of trademarks, 19:10
DEFENSES	DISPUTE RESOLUTION
Infringement (this index)	Domain Names (this index)
DEFERRED PAYMENTS	DISTINCTIVENESS
Taxation, 19:21	Dilution of trademarks, 10:10
DESCRIPTIVE MARKS	Trade dress, 4:26
Conceptual strength, 4:21 to 4:23	DISTRIBUTION CHAIN
Without secondary meaning, 5:4 to 5:6	Generally, 8:9 to 8:17
	Domestic commerce, 8:15, 8:16
	First sale doctrine, 8:10, 8:16

INDEX

- DISTRIBUTION CHAIN—Cont'd**
Materially different goods, 8:11
Over runs, 8:11
Parallel importation, 8:17
Repackaging, 8:14
Resale of used merchandise, 8:13
Unauthorized distribution, 8:11, 8:15
Used merchandise, resale of, 8:13
- DOMAIN NAMES**
Generally, 1:14, 14:1 to 14:9
Cybersquatting. **Anticybersquatting Consumer Protection Act (this index)**
Federal statutes, 14:2, 14:4
Invoking others' marks, 15:3
Lanham Act, 14:3, 14:4
Post-domain name path, 15:4
Registration of top level domain names, 5:6
Trademark status of, 15:2
Uniform Dispute Resolution Policy
Generally, 14:5 to 14:9
Anticybersquatting Consumer Protection Act, relationship to, 14:11
decisions, availability of, 14:8
decisions, examples of, 14:9
procedures, 14:6
substantive elements, 14:7
- DUE DILIGENCE**
Audit programs, 7:16
- ENDORSEMENTS**
Likelihood of confusion, 8:7
- EX PARTE SEIZURE**
Counterfeit marks, 11:6
- EX REM LITIGATION**
Anticybersquatting Consumer Protection Act, 14:16
- EXECUTORY CONTRACTS**
License agreements, 20:10 to 20:15
- EXPRESS ABANDONMENT**
Generally, 3:2
- FAIR USE**
Comments related to holder of famous mark, exception for, 10:18
Comparative advertising exception, 10:17
Infringement defense, 12:22, 12:23
Metatags, 15:10
- FALSE ADVERTISING**
Generally, 1:13, 13:1 to 13:21
Behavior infringing intellectual property, 13:15
Claims, types of, 13:12 to 13:16
Commercial advertising, 13:4
Dastar case, 12:4, 13:16
Elements of a claim, 13:3 to 13:11
Explicitly false statements, 13:7
Injunctions, 13:21
International issues, 21:7
Lanham Act, 13:1 to 13:21
Literally false statements, 13:7
Meaning of statement, 13:10, 13:11
Misleading statements, 13:8, 13:9
Opinions, 13:6
Promotion, 13:4
Puffery, 13:6
Remedies, 13:17 to 13:20
Standing, 13:2
Supporting data, 13:12
Unsubstantiated claims, 13:13
Web sites, 15:5
- FAMILY OF MARKS**
Creation of, 6:3
Likelihood of confusion, 9:5
- FAMOUS MARKS**
Dilution, 10:11
Fair use involving comments related to holder of, 10:18

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

FANCIFUL MARKS Protectable upon adoption, 4:25	GENERIC MARKS—Cont'd Genericide, 3:5, 7:9
FEDERAL REGISTRATION Registration of Trademarks (this index)	GEOGRAPHIC MARKS Registration of trademarks, 5:8, 5:9
FEES Attorney, 12:18 Licenses (this index) Registration of trademark applications, 6:10	GOOD FAITH Bad Faith
FICTITIOUS NAME REGISTRIES Generally, 2:3	GOODS OR SERVICES Likelihood of confusion in registration of trademarks, 5:17
FIRST AMENDMENT Generally, 12:24 to 12:28 Artistic use, 12:27 Criticism, 12:26 Parody, 12:25 Religion clauses, 12:28	GOVERNMENTAL INSIGNIAS Registration of trademarks, 5:14
FIRST SALE DOCTRINE Infringement, 8:10, 8:16	GRAPHIC MARKS Generally, 4:7
FIXED PAYMENTS Taxation, 19:16	Hyperlinks Generally, 15:7
FLAGS Registration of trademarks, 5:14	IMMORAL MARKS Registration of trademarks, 5:10
FOREIGN ISSUES International Issues (this index)	IMMUNITY Infringement, state sovereign immunity, 12:8
FRAMING Internet, 15:11	IMPORTS Parallel importation, infringement by, 8:17
FRANCHISING Licensing problems, 17:10	IN PERSONAM LITIGATION Domain names, 14:17
FRAUD Registration of trademarks, 6:26	IN REM LITIGATION Domain names, 14:18
FUNCTIONAL MARKS Registration of trademarks, 5:21	INCONTESTABILITY Registration of trademarks, 6:23
FUNCTIONALITY Trade Dress (this index)	INFRINGEMENT Generally, 1:8, 8:1 to 8:23, 12:1 to 12:33 Acquiescence, 12:30 Advertising, comparative, 8:18 Antitrust violations, 12:32 Bankruptcy, 20:16 Cancellation of registrations, 12:19
GENERIC MARKS Conceptual strength, 4:20	

INDEX

INFRINGEMENT—Cont'd
Claim preclusion, 12:6
Comparative advertising, 8:18
Contributory, 8:21, 15:15
Counterfeit marks, 8:23
Damages and Remedies (this index)
Dastar case, 12:4, 13:16
Declaratory judgments, 12:9
Defendants, 12:10
Defenses
 generally, 12:21 to 12:33
 acquiescence, 12:30
 antitrust violations, 12:32
 fair use, 12:22, 12:23
 First Amendment, 12:24 to 12:28
 laches, 12:29
 religion clauses, 12:28
 unclean hands, 12:31
Destruction of infringing materials, 12:20
Dilution, 8:19
Distribution Chain (this index)
Fair use, 12:22, 12:23
First Amendment
 generally, 12:24 to 12:28
 artistic use, 12:27
 criticism, 12:26
 parody, 12:25
 religion clauses, 12:28
First sale doctrine, 8:10
Foreign infringement lawsuit in United States court, 21:6
Injunctions
 permanent, 12:14
 preliminary, 12:11
Insurance Coverage (this index)
International lawsuit in United States court, 21:6
Internet issues, 8:20
Intrusion, 8:1
Issue preclusion, 12:7
Jurisdiction, 12:5
Laches, 12:29

INFRINGEMENT—Cont'd
Likelihood of Confusion (this index)
Limitation of actions, 12:5
Litigation, 12:1 to 12:33
Nominative fair use, 12:23
On web sites, 15:15
Payments, taxation, 19:20
Permanent injunctive relief, 12:14
Personal name, 12:33
Preliminary injunctive relief, 12:11
Promotional goods, 8:8
Registered marks, 12:2
Registrations, cancellation of, 12:19
Religion clauses, defenses, 12:28
Rights and intrusion, 8:1
Settlements, 12:12, 12:13
Standing, 12:5
State sovereign immunity, 12:8
Types of, 8:1 to 8:23
Unclean hands, 12:31
Unregistered marks, 12:3
Vicarious, 8:22, 15:15
Web sites, 15:5

INITIAL INTEREST
Likelihood of confusion, 8:4

INJUNCTIONS
False advertising, 13:21
Permanent, 12:14
Preliminary, 12:11

INNOCENT INFRINGER
Remedies, 12:15

INSIGNIAS
Governmental, 5:14

INSURANCE COVERAGE FOR INFRINGEMENT
Generally, 1:16, 16:1 to 16:8
Advertising injury, 16:2 to 16:6
Exclusions, 16:6
Nexus, causal, 16:5
Notice to insurer, 16:7

- INSURANCE COVERAGE FOR INFRINGEMENT—Cont'd**
Settlements, 16:8
- INTANGIBLES**
Amortization of trademarks, 19:3
- INTENT**
Bad faith intent to profit,
Anticybersquatting
Consumer Protection Act,
14:14
Likelihood of confusion, 9:12
- INTENT TO USE**
Assignment as security in bankruptcy proceedings, 20:9
Registration of trademarks, 6:8
- INTERFERENCE PROCEEDINGS**
Registration of trademarks, 6:19
- INTERNATIONAL ISSUES**
Generally, 1:21, 21:1 to 21:7
Breach of United States contract, suing foreign plaintiff for, 21:5
False advertising, suing in United States court, 21:7
Foreign equivalents, conceptual strength of, 4:22
Infringement, 21:6
Madrid Protocol, 21:4
Registration
 federal applications, 6:8, 6:14
 foreign marks in the United States, 21:2
 United States marks abroad, 21:3, 21:4
- INTERNET**
Generally, 1:15, 15:1 to 15:16
Advertisements
 banner, 15:12
 key-word advertising programs, 15:14
 pop-up, 15:13
Audit programs, 7:15
Banner advertisements, 15:12
- INTERNET—Cont'd**
Communications Decency Act, 15:16
Contributory infringement, 15:15
Dilution of trademark, 15:5
Domain Names (this index)
False advertising within web sites, 15:5
Framing, 15:11
Hyperlinks, 15:7
Infringement
 generally, 8:20
 vicarious and contributory, 15:15
 web sites, within, 15:5
Jurisdiction based on web sites, 15:6
Key-word advertising programs, 15:14
Metatags, 15:8 to 15:10
Pop-up advertisements, 15:13
Vicarious infringement, 15:15
- ISSUE PRECLUSION**
Infringement litigation, 12:7
- JURISDICTION**
Dilution, federal and state statutes, 10:23
Infringement litigation, 12:5
Web sites as basis, 15:6
- KEY-WORDS**
Search engine advertising, 15:14
- LACHES**
Infringement, 12:29
- LANHAM ACT**
Domain names, 14:3, 14:4
False Advertising (this index)
- LETTERS OF PROTEST**
Patent and Trademark Office, 7:6
- LICENSES**
Generally, 1:17, 17:1 to 17:17
Acquisition, 17:9
Amended, 27:1, 27:2
Antitrust concerns, 17:15

INDEX

- LICENSES—Cont'd**
- Audit programs, 7:13
 - Authority to license, 17:2
 - Bankruptcy law, 20:10 to 20:15
 - Benefits, 17:13
 - Detrimental effects of licensing, 17:14
 - Execution contracts
 - generally, 20:10
 - assumption, 20:12
 - rejection, 20:11
 - Fees
 - generally, 20:13
 - bankruptcy proceedings, 20:14, 20:15
 - Former licensee's rights, 17:12
 - Franchising, 17:10
 - Multiple documents, 17:17
 - Personal name used as mark, 17:16
 - Product lines, divisibility by, 17:4
 - Quality control requirements, 17:5, 17:7
 - Restated agreements, 27:1, 27:2
 - Retail products sample agreement, 25:1, 25:2
 - Sample license agreements** (this index)
 - Service mark sample agreements, 26:1, 26:2
 - Standing to sue for infringement, 17:11
 - Territories, divisibility by, 17:4
 - Written agreements, 17:3
- LIKELIHOOD OF CONFUSION**
- Generally, 1:9, 5:15 to 5:19, 8:2 to 8:7, 9:1 to 9:14
 - Actual confusion, 9:11
 - Association or endorsement, 8:7
 - Change in circumstances, 9:14
 - Channels of trade, 9:10
 - Comparison of marks, 9:3
 - Competition between goods or services, 9:6
 - Context of comparison, 9:3
 - Customers
 - channels of trade, 5:19
- LIKELIHOOD OF CONFUSION**
- Cont'd
 - Customers—Cont'd
 - level of care by, 9:9
 - overlap of, 9:8
 - Endorsements, 8:7
 - Family of marks, similarity to, 9:5
 - Goods or services, 5:17
 - Infringement, 8:2 to 8:7
 - Intent, 9:12
 - Metatags, initial interest confusion of, 15:9
 - Palming off, 8:3
 - Point-of sale, 8:2, 8:3
 - Priority, importance of, 9:2
 - Registration of trademarks, 5:15 to 5:19
 - Reverse confusion, 8:6
 - Reverse passing off, 8:3
 - Similarity of marks, 9:4, 9:5
 - Strength of marks, 9:7
 - Trade, channels of, 9:10
- LIMITATION OF ACTIONS**
- Infringement litigation, 12:5
- LOSS OF REGISTRATION**
- Comparison to loss of rights, 3:8
- LOSS OF RIGHTS**
- Generally, 1:3, 3:1 to 3:8
 - Abandonment** (this index)
 - Genericide, 3:5
 - Merger, 3:7
 - Naked transfer, 3:6
 - Transfer, naked, 3:6
- MADRID PROTOCOL**
- Generally, 21:4
- MARKETING CONSIDERATIONS**
- Choosing a mark, 6:2
- MATERIALITY**
- False advertising, 13:9

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

MATERIALLY DIFFERENT GOODS
Infringement, **8:11**

MERCHANDISING GOODS
Infringement, **8:8**

MERGER
Loss of rights, **3:7**

METATAGS
Definition, **15:8**
Fair use defenses, **15:10**
Initial interest confusion, **15:9**

NAKED TRANSFER
Loss of rights, **3:6**

NAMES
Domain Names (this index)
Personal Names (this index)

NEWS REPORTING AND COMMENTARY EXCEPTION
Dilution exception, **10:19**

NONCOMMERCIAL USE
Dilution exception, **10:20**

NONRECOGNITION TRANSACTIONS
Amortization of trademarks, **19:8**

OPINIONS
False advertising, **13:6**

OPPOSITION
Proceedings before Patent and Trademark Office, **7:7**
Registration of trademarks, **6:20**

OVER RUNS
Infringement, **8:12**

PALMING OFF
Likelihood of confusion, **8:3**

PARALLEL IMPORTATION
Infringement, **8:17**

PARODY
First Amendment defense, **12:25**

PASSING OFF
Likelihood of confusion, **8:3**

PATENT AND TRADEMARK OFFICE
Registration of Trademarks (this index)
Cancellation proceedings, **7:8**
Letters of protest, **7:6**
Opposition proceedings, **7:7**
Proceedings, **7:5 to 7:8**

PAYMENTS
Taxation (this index)

PERMANENT INJUNCTIONS
Infringement litigation, **12:14**

PERMISSION
Lack of consent of individual named or portrayed, **5:13**

PERSONAL NAMES
Infringement, **12:33**
Licensing issues, **17:16**
Registration of trademarks, **5:13**
Surnames, **5:20**

POINT-OF SALE
Likelihood of confusion, **8:2, 8:3**

POP-UPS
Internet advertising, **15:13**

POWER, SIGNIFICANT
Taxation, **19:13**

PRELIMINARY INJUNCTIONS
Infringement litigation, **12:11**

PRINCIPLE REGISTER
Generally, **6:1**
Registration of trademarks, **6:22**

PRIORITY
Generally, **2:10**
Concurrent use, **2:11**
Tacking, **2:12**

PROMOTIONAL GOODS
Infringement, **8:8**

INDEX

PROTECTION OF MARKS

Generally, 1:7, 7:1 to 7:19
Adverse rulings, eliminating, 7:19
Audit Programs (this index)
Cease-and-desist letters, 7:4
Counterfeiting, preparation for, 7:18
Genericide, prevention of, 7:9
Importation, government assistance to prevent, 7:17
Marking, 7:2
Watch services, 7:3

PTO

Patent and Trademark Office
(this index)

PUFFERY

False advertising, 13:6

PUNITIVE DAMAGES

False advertising, 13:20
Infringement, 12:17

QUALITY CONTROL

Audit programs to protect marks, 7:12
License requirements, 17:5, 17:7

REGISTRATION OF TRADEMARKS

Generally, 1:5, 1:6, 2:4, 6:1 to 6:26

Appeals (this index)

Applications
generally, 6:8 to 6:17
content, 6:9
fees, 6:10
international agreement based, 6:8, 6:14
specimens, 6:11
use based, 6:12, 6:13
Audit programs, 7:11
Benefits of, 5:1
Cancellations, 6:25
Concurrent use proceedings, 6:18
Confusion. **Likelihood of Confusion** (this index)
Creative works, titles to, 5:5

REGISTRATION OF

TRADEMARKS—Cont'd
Deceptively misdescriptive, 5:7, 5:9
Descriptive without secondary meaning, 5:4 to 5:6
Dilution, likely to cause, 5:22
Disparaging marks, 5:11
Domain names, top level, 5:6
Family of marks, creation of, 6:3
Flags, 5:14
Fraud, 6:26
Functional marks, 5:21
Geographic marks
primarily geographically deceptively misdescriptive, 5:9
primarily geographically descriptive, 5:8
Governmental insignias, 5:14
Imperial marks, 5:10
Incontestability, 6:23
Insignias, governmental, 5:14
Intent to use, 6:8
Interference proceedings, 6:19
International agreements, 6:8, 6:14
Legal considerations, 6:2
Likelihood of Confusion (this index)
Loss of, comparison to loss of rights, 3:8
Maintenance, 6:21 to 6:24
Marketing considerations, 6:2
Misdescriptive, 5:7
Not functioning as mark, 5:2
Oppositions, 6:20
Personal names, 5:13
Primarily geographically deceptively misdescriptive geographic marks, 5:9
Primarily geographically descriptive geographic marks, 5:8
Principle register, move to, 6:22
Scandalous marks, 5:10
Searches, 6:4, 6:5

REGISTRATION OF TRADEMARKS—Cont'd
Secondary meaning, descriptive mark without, **5:4 to 5:6**
Style of words, **5:18**
Suggestive marks, **5:12**
Supplemental register, **6:1, 6:22**
Surname, primarily merely, **5:20**
Unregistered marks, protectability of, **5:1**
Use based applications, **6:12, 6:13**
Weak trademarks, protection for, **6:24**

REGISTRIES
State corporation and fictitious name, **2:3**

RELIGION
Infringement, religion clauses, defenses, **12:28**

REMEDIES
Damages and Remedies (this index)

RENEWALS
Amortization of trademarks, **19:9**

REPACKAGING
Infringement, **8:14**

RESALE
Used merchandise, of, **8:13**

RESTATED LICENSING AGREEMENTS
Sample agreement, **27:1, 27:2**

RETAILS PRODUCTS
Sample license agreement, **25:1, 25:2**

RETROACTIVITY
Trademark Dilution Revision Act, **10:8**

REVERSE CONFUSION
Likelihood of, **8:6**

REVERSE PALMING OFF
Likelihood of confusion, **8:3**

REVERSE PASSING OFF
Likelihood of confusion, **8:3**

RIGHT, SIGNIFICANT
Taxation, **19:13**

ROYALTIES
Taxation, **19:19**

SAFE HARBOR
Anticybersquatting Consumer Protection Act, **14:13**

SAMPLE LICENSE AGREEMENTS
Artisanal Cheese, LLC and Artisanal Fromagerie & Bistro, LLC, **23:1, 23:2**
Artisanal Fromagerie & Bistro, LLC and Artisanal Cheese, LLC, **23:1, 23:2**
Colony Resorts LVH Acquisitions, LLC and HLT Existing Franchise Holding LLC, **27:1, 27:2**
CPI Corp. and Sears Roebuck & Company, **22:1, 22:2**
Crystal Magic, Inc. and NBA Properties, Inc., **25:1, 25:2**
Delaware Management Holdings, Inc. and Lincoln Investment Advisors Corp., **26:1, 26:2**
HLT Existing Franchise Holding LLC and Colony Resorts LVH Acquisitions, LLC, **27:1, 27:2**
Lincoln Investment Advisors Corp. and Delaware Management Holdings, Inc., **26:1, 26:2**
NBA Properties, Inc. and Crystal Magic, Inc., **25:1, 25:2**
Phoenix Footwear Group, Inc. and Tommy Bahama Group, Inc., **24:1, 24:2**
Sears Roebuck & Company and CPI Corp., **22:1, 22:2**
Tommy Bahama Group, Inc. and Phoenix Footwear Group, Inc., **24:1**

INDEX

- SCENTS**
Generally, **4:12**
- SEARCH ENGINES**
Key-word advertising, **15:14**
- SEARCHES**
Mark clearance, **6:4, 6:5**
- SECONDARY MEANING**
Conceptual strength, **4:23**
Descriptive mark without, **5:4 to 5:6**
- SECURITY INTERESTS**
Bankruptcy, **20:6 to 20:8**
- SEIZURES**
Counterfeit marks, **11:6**
Wrongful, **11:7**
- SERVICE MARKS**
Generally, **4:2**
Sample license agreement, **26:1, 26:2**
- SETTLEMENTS**
Infringement litigation, **12:12, 12:13**
Insurance coverage for infringement, **16:8**
- SIGNIFICANT POWER, RIGHT, OR CONTINUING INTEREST**
Taxation, **19:13**
- SIMILARITY**
Dilution, **10:13**
- SIMILARITY OF MARKS**
Likelihood of confusion, **9:5, 9:6**
- SMELLS**
Generally, **4:12**
- SOUND MARKS**
Generally, **4:11**
- SPECIMENS**
Registration of trademark applications, **6:11**
- STANDING**
False advertising, **13:2**
Infringement litigation, **12:5, 17:11**
- STATES**
Common-law dilution protection, **10:3**
Counterfeit marks, statutes, **11:2, 11:3**
Dilution, federal and state statutes, **10:23**
Name registries, **2:3**
Sovereign immunity, infringement, **12:8**
Statutory dilution protection, **10:3**
- STAY OF PROCEEDINGS**
Automatic stay in bankruptcy estate, **20:4**
- STRENGTH OF MARKS**
Generally, **4:19 to 4:26**
Descriptive, **4:21 to 4:23**
Foreign equivalents, doctrine of, **4:22**
Generic, **4:20**
Likelihood of confusion, **9:7**
Secondary meaning, **4:23**
Suggestive, **4:24**
- SUGGESTIVE MARKS**
Conceptual strength, **4:24**
Registration of trademarks, **5:12**
- SUPPLEMENTAL REGISTER**
Generally, **6:1**
Registration of trademarks, **6:22**
- SURNAMES**
Personal Names (this index)
- TACKING**
Priority of rights, **2:12**
- TARNISHMENT**
Dilution, **10:14**
- TASTE**
Generally, **4:14**

CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW

TAXATION

Generally, **1:19, 19:1 to 19:21**
Allocation, **19:17**
Amortization of Trademarks
(this index)
Contingent payments, **19:15**
Continuing interest, significant,
19:13
Deferred payments, **19:21**
Fixed payments, **19:16**
Infringement payments, **19:20**
Ownership of intangible, **19:18**
Payments
 transfers of trademarks, **19:14 to 19:16**
 types of, **19:19 to 19:21**
Power, significant, **19:13**
Right, significant, **19:13**
Royalties, 19:19
Royalty payments, **19:19**
Significant power, right, or
 continuing interest, **19:13**
Transfers of trademarks
 generally, **19:12 to 19:17**
 allocation, **19:17**
 contingent payments, **19:15**
 continuing interest, significant,
19:13
 fixed payments, **19:16**
 payments
 generally, **19:14 to 19:16**
 contingent payments, **19:15**
 fixed payments, **19:16**
power, significant, **19:13**
right, significant, **19:13**
significant power, right, or
 continuing interest, **19:13**

TDRA

**Trademark Dilution Revision
Act** (this index)

TELEPHONE NUMBERS

Generally, **4:9**

TERRITORIAL RIGHTS

Licenses, **17:4**

TOUCH

Generally, **4:13**

TRADE DRESS

Generally, **4:15 to 4:18**
Aesthetic functionality, **4:18**
Dilution, **10:6**
Functionality
 generally, **4:16 to 4:18**
 aesthetic functionality, **4:18**
 utilitarian functionality, **4:17**
Inherently distinctive, **4:26**
Utilitarian functionality, **4:17**

TRADEMARK DILUTION

REVISION ACT

Generally, **10:7 to 10:21**
Blurring, **10:15**
Defendant's use of mark, **10:12**
Distinctiveness, **10:10**
Elements, **10:9 to 10:15**
Exceptions, **10:16 to 10:20**
Fame, **10:11**
History of dilution, **10:2**
Remedies, **10:21**
Retroactivity, **10:8**
Similarity, **10:13**
Tarnishment, **10:14**

TRADEMARK TRIAL AND APPEALS BOARD

Appeal of final rejection of
application to, **6:15 to 6:17**

TRANSFER OF RIGHTS

Naked transfer, **3:6**

TRANSFERS OF TRADEMARKS

Taxation (this index)

TTAB

**Trademark Trial and Appeal
Board** (this index)

TYING ARRANGEMENTS

Generally, **1:18, 18:1 to 18:4**
Business format systems, **18:2**
Distribution systems, **18:3**

INDEX

TYING ARRANGEMENTS

—Cont'd

Market power, **18:4**

TYPES OF MARKS

Generally, **1:4, 4:1 to 4:26**

UNAUTHORIZED DISTRIBUTORS

Infringement, **8:15**

UNAUTHORIZED GOODS

Infringement, **8:11**

UNCLEAN HANDS

Infringement, **12:31**

USED MERCHANDISE

Resale of, **8:13**

VALUE OF TRADEMARK

Amortization of trademarks, **19:4**

VERBAL MARKS

Generally, **4:6**

VICARIOUS INFRINGEMENT

Generally, **8:22, 15:15**

WATCH SERVICES

Protection of marks, **7:3**

WEAK TRADEMARKS

Protection for, **6:24**

WEB SITES

Internet (this index)

WRONGFUL SEIZURE

Counterfeit marks, **11:7**

<http://www.pbookshop.com>