Trademarks and Deceptive Trade Practices Fall 2008
FINAL EXAMINATION

Professor William O. Hennessey Monday December 15, 2008

General Instructions

This is a three-hour open-book exam, based upon two hypothetical sets of facts. You may consult any written materials used in this course (casebook, supplement, statute, and notes) but not treatises, commercial casenotes, study aids, or encyclopedias. Activity on the problem outside the exam room, access to online materials, or discussion with any other person during the exam period is prohibited. The total is 100 points but the first question is 30 points and the second is 70 points. (So you should allocate your time accordingly.) Do not give answers for questions that are not asked! Be sure to put your exam number on each item which you submit to be graded. Please answer the questions in blue books or electronic equivalent thereto. Write on only one side of the page and observe margins. Organize your answer before you begin to write and try to keep your answers to the point. Note to MIP students: do not write "MIP student" or put any marks on your exam booklet which would indicate that you are an MIP student

Part I. FACTS

Becky Green, from Bellows Falls, Vermont, is the wealthy, rebellious great-granddaughter of Hetty Green, who was famously listed in the *Guinness Book of World Records* as having been the "World's Greatest Miser." (Hetty Green made her vast fortune in the "First Gilded Age" in the late 19th and early 20th century but was notoriously stingy, and is reported to have died at the age of 81 because she refused to pay $150 for a simple operation.) Green, who inherited (in addition to a lot of money) some of her great-grandmother's feistiness, is a "maverick" of sorts. She has rejected the opulent but spiritually empty lifestyles of the rest of her wealthy siblings and cousins of the present "Second Gilded Age", who spend most of their time on trips to luxury resorts from Aspen, Colorado and Pat's Peak, New Hampshire to Caribbean islands, the Maldives in the Indian Ocean, and Klosters, Switzerland when they are not partying and swilling (or even bathing in) champagne with friends in New York and LA.

While she is not interested in the "jet set" lifestyle of her peers, Becky is nevertheless an inveterate traveler herself. Beginning in 1995, and inspired by the "Lonely Planet" series of travel guides, Green has traveled to some of the most remote regions of the Earth, from West Wasilla Alaska, to Kiva, Uzbekistan, to Chisinau, Moldova (former Bessarabia), to the Mato Grosso region of southwest Brazil and everywhere in-between. Green is no "day tripper" — she is a true believer in learning about the people, the cultures, and the flora and fauna in the places she visits. And Becky believes in lowering her "carbon footprint" by back-packing into the wilderness, riding pack animals and other generally frugal behavior (once she gets off the plane.)

In 2003 and with time on her hands, she decided to begin a new venture. She started a company called "TRAVELGREEN", a web-based travel agency charging visitors an annual fee. She also registered the website <www.travelgreen.com>. Green has a single employee, Vandana White (whom Green first met when studying martial arts at a Daoist monastery at Wudangshan, China). Vandana White brought her extensive experience in internet webpage design to the venture. Visitors to the travelgreen.com website can read about the newest and best places for travel adventures for like-minded people. The website also explains the TRAVELGREEN educational mission:

> To foster the global movement towards a just society that embraces global public goods, sustainable development, ecological restoration, and universal human rights by providing educational travel services dedicated to helping people find opportunities to undertake socially conscious travel. We intend to design and implement various programs that aim to meet the following objectives:
>
> * To promote socially conscious travel both domestically and internationally.
> * To provide opportunities and support for people to undertake educational travel.
> * To offer and link people with green travel resources and ideas that minimize their ecological impact and manage their social impacts while traveling.
> * To offer a library of information on socially conscious travel considerations and educational travel options.

After living in Russia for 3 months in 2004 and completing a unicycle trip together across Eastern Europe, Turkey, and Egypt, Green and White temporarily settled in Washington.

> Question 1 (30 points) You work in the trademark law firm of Sader and Masoch, LLP. If Green were to ask you for legal advice based on the above facts and reasonable inferences from those facts only, what advice would you give as to whether she is eligible to register the block letter word mark "TRAVELGREEN", for internet-based travel services on the Principal Register in the USPTO? Are there any issues that the USPTO examiner could raise to reject the application for registration of the mark on the Principal Register completely or limit the scope of such a registration? If so, what arguments could be raised to traverse (counter) such a rejection? What other information, if any, would you want to know in order to make an informed opinion as to the registrability of the word mark " TRAVELGREEN" for an internet-based travel service, and what strategic advice could you provide your client to enhance the possibility of acquiring the broadest possible federal registration?

Part II - MORE FACTS

Over the years since 2004, Travelgreen.com has built up a strong following among eco-friendly travelers (not "tourists," please) throughout the United States, Europe, and Japan. Green and White went on the road again traveling through South and Central America in February 2007. Through the internet, subscribers to their website could follow their adventures, get eco travel tips, and stay on top of green travel news by subscribing to the feed, learning along the way about the glaciers in El Calafate, elephant seals, penguins, and guanacos, whale watching, and organic farming on a chacra (farm) in Puerto Madryn, as well as all sorts of other valuable travel advice for the eco-traveler on a shoestring. Things went on swimmingly until a rift arose between Green and White in Tierra del Fuego, at the southern tip of South America. Apparently Vandana White, tired of the rough (or as she calls it "stingy") conditions Green demands on their global perambulations, wanted a restful month in a plush (and very expensive) "eco-spa" she had heard about in Cabos San Diego, Argentina, which features Japanese hot springs, Zen meditation, and shiatsu massage, while Green wanted to kayak the Straits of Magellan and photograph elephant seals. Words were exchanged between the Becky and Vandana that should not have been said, and they went their separate ways. White returned immediately from her month at the eco-spa to her parents' home in the Potomac suburbs of Washington D.C. and Green went on to kayak in the Falkland Islands and count emperor penguins on ice floes for the Save The World Foundation.

After returning to Washington D.C., White decided to strike out on her own, and to cater to a more "sensible up-market eco-consumer" (the kind that is not interested in living "off-the-grid" (that is, without electricity and using earthworm composting toilets) that Green favored. By the time Green got back to Washington D.C., White had set up her own web-based travel agency entitled "Travel Green with Vandana". Apparently, White has not sought federal protection for her new venture but has registered the web address <www.travelgreenwithvandana.com>. A consumer search for the term "travelgreen" on a computer would find Vandana White's site as a sponsored link. The marketing focus White adopted involves designing and leading treks into the "wild" (they're actually very safe but exotic luxury resorts) for wealthy (but bored) 20-something "trustafarians."[1] Those are exactly the type of clients Becky Green found reprehensible and avoided. Green has received negative comments on the www.travelgreen.com site from two committed "green travellers" complaining that TravelGreen has "sold out" in search of the once "almighty" dollar and is no longer devoted to the principles of eco-tourism it once stood for.

---

[1] Definition of a "trustafarian" from Urbandictionary.com: "A rich young person, from a mansion house in the shires, usually with trust funds from mummy and daddy yet pretends he or she is poor. This species, more often than not, has dreadlocks, wears ethnic clothing, plays the digeree-doo, dodges soap and generally mopes around thinking themselves as an alternative and above everyone else. Over the last 20 years or so, these creatures infested India, Thailand and Nepal under the guise that they were travelers, not tourists. Most will end up working for their daddy as venture capitalists.

Question 2 (70 points) (Assume for the purpose of this question that Green was successful in acquiring federal trademark registration for the word mark "TRAVELGREEN" as set forth in Question 1.)

Green has come to your firm for advice on what to do about the fact that her TRAVELGREEN mark "is being infringed" and the "goodwill" of her agency misappropriated by Vandana White's new venture. Your senior managing partner, Baal Masoch, has assigned you to research the possibility of bringing a civil action in federal district court seeking a preliminary injunction against White's use of the term "Travel Green with Vandana". In preparation, you are asked for a preliminary opinion as to the possible claims that could be asserted and the likelihood of success on the merits on each such claim. Applying the principles of Trademark and Deceptive Trade Practices law you have acquired in this course (or other courses), set forth the possible causes of action Green can raise, the likely defenses White might pose and arguments White might make, and, where applicable, the relevant burdens of proof the parties might bear. (*You can use the* Polaroid *factors on p. 332 of the Casebook if you want.*) Discuss which claims raised (if any) are likely to succeed on the merits, whether the court will likely issue an injunction, and if an injunction were to issue, what would be its scope. (*NOTE: DO NOT address the issue of cybersquatting under Lanham Act Section 43(d).*)