

Mark P. McKenna

Notre Dame Law School

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PROFESSIONAL EXPERIENCE

Notre Dame Law School, Notre Dame, IN

Professor of Law (2011-present)

Associate Professor (with Tenure) (2008-11)

Visiting Associate Professor (Spring 2008)

- Courses: Advanced Topics in Trademark Law (Seminar); Copyright Law; Survey of Intellectual Property; Torts; Trade Dress and Design Law; Trademarks and Unfair Competition
- Committees: Appointments (2009-10, 2010-11, 2011-12); Colloquium Speakers Committee (2008-09); Faculty Development (2008-09); University Intellectual Property Committee (2008-11); Ad Hoc Search Committee for Director of Intellectual Property and Entrepreneurship Clinic (Chair) (2011)

University of Toronto Faculty of Law, Toronto, ON (Canada)

Distinguished Visiting Faculty (Spring 2012)

- Short course: Trademark Theory Seminar

Stanford Law School, Stanford, CA

Edwin A. Heafy Jr. Visiting Professor of Law (Fall 2010)

- Courses: Advanced Topics in Unfair Competition; IP: Trademarks

Saint Louis University School of Law, St. Louis, MO

Assistant Professor (2003-2008)

Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, Chicago, IL

Associate in intellectual property litigation practice (2000-2003)

EDUCATION

University of Virginia School of Law, Charlottesville, Virginia
Juris Doctor, May 2000

University of Notre Dame, Notre Dame, Indiana
Bachelor of Arts, Economics, May 1997 (*Magna Cum Laude*)

OTHER EXPERIENCE AND PROFESSIONAL SERVICE

Planning Committee, 2012 AALS Mid-Year Meeting on Intellectual Property

Chair, Intellectual Property Section, Association of American Law Schools (2011);
Chair-elect (2010)

Advisory Board Member, Intellectual Property Center, University of Richmond T.C.
Williams School of Law, Richmond, VA (2005-present)

Editorial Advisory Board Member, The IP Law Book Review, Golden Gate University
School of Law, San Francisco, CA (2010-present)

Intellectual Property Advisory Committee Member, Obama for America 2008

Board of Directors, Kane, McKenna and Associates, Inc., Chicago, IL (2002-10)

Legal Advisory Council, La Leche League International, Schaumburg, IL (2004-2010)

Board of Directors, St. Louis Volunteer Lawyers and Accountants for the Arts, St.
Louis, MO (2005-2008)

President and Founding Board Member, MRH Youth Sports, Maplewood, MO (2007-
2008)

PUBLICATIONS

Books

THE LAW OF INTELLECTUAL PROPERTY (Aspen Law & Business, Third Edition 2011)
(with Craig Nard, Michael Madison, and David Barnes)

Law Review Articles

A Consumer Decision-Making Theory of Trademark Law, 97 VIRGINIA LAW REVIEW _
(forthcoming 2012)

Is Pepsi Really a Substitute for Coke? Market Definition in Antitrust and IP, 100
GEORGETOWN LAW JOURNAL _ (forthcoming 2012) (with Mark A. Lemley) (invited
contribution to 100th Anniversary Volume)

Owning Mark(et)s, 109 MICHIGAN LAW REVIEW 137 (2010) (with Mark A. Lemley)
(<http://ssrn.com/abstract=1604845>)

- Reviewed on Jotwell at <http://ip.jotwell.com/marks-on-marks/>

Irrelevant Confusion, 62 STANFORD LAW REVIEW 413 (2010) (with Mark A. Lemley)
(<http://ssrn.com/abstract=1407793>)

Testing Modern Trademark Law's Theory of Harm, 95 IOWA LAW REVIEW 63 (2009)
(<http://ssrn.com/abstract=1348746>)

- Selected as one of the best law review articles on intellectual property law published in 2009 and selected for republication in the INTELLECTUAL PROPERTY LAW REVIEW (West 2010)

Trademark Use and the Problem of Source, 2009 UNIVERSITY OF ILLINOIS LAW REVIEW
773 (2009) (<http://ssrn.com/abstract=1088479>)

- Reviewed on Jotwell at <http://ip.jotwell.com/trademark-use-on-the-loose/>

The Normative Foundations of Trademark Law, 82 NOTRE DAME LAW REVIEW 1839
(2007) (<http://ssrn.com/abstract=889162>)

- Reprinted at 97 TRADEMARK REPORTER 1126 (2007)
- Winner of 2007 Ladas Memorial Award for writing excellence on the subject of trademarks and related matters (International Trademark Association)

The Right of Publicity and Autonomous Self-Definition, 67 UNIVERSITY OF PITTSBURGH
LAW REVIEW 225 (2005) (<http://ssrn.com/abstract=794844>)

Book Chapters and Symposium Contributions

(Dys)functionality, 48 HOUSTON LAW REVIEW _ (forthcoming 2012) (invited contribution to University of Houston Law Center Institute for Intellectual Property & Information Law Annual Conference, *Trademark: Today and Tomorrow*)

Trademark Law's Faux Federalism, in INTELLECTUAL PROPERTY AND THE COMMON LAW (Cambridge University Press, forthcoming 2012) (invited contribution to University of Pennsylvania Law School symposium on *Intellectual Property and the Common Law*)

Probabilistic Knowledge of Third-Party Trademark Infringement, 2011 STANFORD TECHNOLOGY LAW REVIEW 10 (invited contribution to symposium on Secondary and Intermediary Liability on the Internet) (<http://ssrn.com/abstract=1906826>)

Intergenerational Progress, 2011 WISCONSIN LAW REVIEW 123 (with Brett Frischmann) (invited contribution to Wisconsin Law Review symposium on Intergenerational Equity and Intellectual Property) (<http://ssrn.com/abstract=1810943>)

Back to the Future: Rediscovering Equitable Discretion in Trademark Cases, 14 LEWIS & CLARK LAW REVIEW 537 (2010) (invited contribution to Business Law Forum on Intellectual Property Remedies) (<http://ssrn.com/abstract=1577914>)

An Alternate Approach to Channeling?, 51 WILLIAM & MARY LAW REVIEW 873 (2009) (invited contribution to conference on The Boundaries of Intellectual Property) (<http://ssrn.com/abstract=1503389>)

Teaching Trademark Theory Through the Lens of Distinctiveness, 52 ST. LOUIS UNIVERSITY LAW JOURNAL 843 (2008) (invited contribution to annual teaching volume) (<http://ssrn.com/abstract=1127836>)

What's the Frequency Kenneth? Channeling Doctrines in Trademark Law, in INTELLECTUAL PROPERTY AND INFORMATION WEALTH (Peter Yu, ed., Praeger Press 2007) (<http://ssrn.com/abstract=1007074>)

Intellectual Property, Privatization and Democracy: A Response to Professor Rose, 50 ST. LOUIS UNIVERSITY LAW JOURNAL 829 (2006) (invited contribution to annual Childress Lecture program)

The Rehnquist Court and the Groundwork for Greater First Amendment Scrutiny of Intellectual Property, 21 WASHINGTON UNIVERSITY JOURNAL OF LAW & POLICY 11 (2006) (invited contribution to conference on The Rehnquist Court and the First Amendment) (<http://ssrn.com/abstract=957420>)

Works-in-Progress

The Placebo Effect in Intellectual Property (with Christopher Sprigman) (work-in-progress)

Shortsightedness in IP (with Brett Frischmann) (work-in-progress)

Trademark Defenses that Aren't (with Bill McGeeveran) (work-in-progress)

An Empirical Study of Federal False Advertising Cases (work-in-progress) (with Deborah Gerhardt and Kevin McGuire)

Other Writing

Lead Author, *Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellant*, Board of Trustees of the University of Alabama v. New Life Art, et al. (11th Circuit 2010)

SELECTED PRESENTATIONS AND SPEAKING ENGAGEMENTS

2011-12

- *Is Pepsi Really a Substitute for Coke? Market Definition in Antitrust and IP*, Georgetown Law Journal Volume 100 Symposium, Georgetown University Law Center (November 17, 2011) (with Mark A. Lemley)
- *(Dys)Functionality*, University of Washington School of Law Intellectual Property Colloquium (November 7, 2011)
- Boston IP Colloquium, Boston College Law School, *A Consumer Decision-Making Theory of Trademark Law* (October 19, 2011)
- University of Indiana, Bloomington Faculty Workshop, *A Consumer Decision-Making Theory of Trademark Law* (September 21, 2011)
- University of California Irvine Faculty Workshop, *A Consumer Decision-Making Theory of Trademark Law* (September 12, 2011)
- *Undefined Markets in IP Cases*, Eleventh Annual Intellectual Property Scholars Conference, DePaul University College of Law, Chicago, IL (August 12, 2011) (with Mark Lemley)

- *Trademark Defenses that Aren't*, Eleventh Annual Intellectual Property Scholars Conference, DePaul University College of Law, Chicago, IL (August 13, 2011) (with Bill McGeeveran)

2010-11

- University of Houston Law Center Institute for Intellectual Property & Information Law National Conference in Santa Fe, New Mexico, *Trademark Law: Today and Tomorrow* (June 3-5, 2011)
- *Intergenerational Progress*, Progressive Property Conference, McGill University (May 16-17, 2011)
- *Trademark Law's Faux Federalism*, University of Pennsylvania Law School, Center for Technology, Innovation, and Competition Symposium, *Intellectual Property and the Common Law* (May 6-7, 2011)
- University of Toronto Faculty of Law, *A Consumer Decision-Making Model of Trademark Law* (March 7, 2011)
- *Probabilistic Knowledge of Third-Party Trademark Infringement*, Stanford Technology Law Review Symposium, *Emerging Issues of Secondary Liability on the Internet* (March 4, 2011)
- University of Virginia School of Law Faculty Workshop, *A Consumer Decision-Making Model of Trademark Law* (February 25, 2011)
- Fordham Law School Intellectual Property Colloquium, *A Consumer Decision-Making Model of Trademark Law* (January 31, 2011)
- Organizer and Introductory Commentator, Notre Dame Law Review Symposium on Creativity and the Law (November 19, 2010)
- Stanford Law School Faculty Workshop, *A Consumer Decision-Making Model of Trademark Law*, (November 17, 2010)
- *Intergenerational Progress* (with Brett Frischmann), Wisconsin Law Review symposium on Intergenerational Equity and Intellectual Property (November 12-13, 2010)
- *The Placebo Effect in Intellectual Property* (with Christopher Sprigman), Tenth Annual Intellectual Property Scholars Conference, UC Berkeley School of Law (August 12-13, 2010)

2009-10

- Panel Participant, Roundtable: How Brands Help Understand Information, Innovation, and Competition, 2010 Law & Society Annual Meeting (May 30, 2010)
- Primary Discussant, Second Trademark Scholars Roundtable, DePaul University College of Law (April 16, 2010)
- *Owning Mark(et)s*, University of North Carolina School of Law Faculty Workshop (April 8, 2010)

- *Owning Mark(et)s*, Notre Dame Law School Faculty Colloquium (February 2, 2010)
- Moderator, Vanderbilt Journal of Entertainment and Technology Law Symposium, *Drawing Lines in the Digital Age: Copyright, Fair Use, and Derivative Works* (October 23, 2009)
- *Back to the Future: Rediscovering Equitable Discretion in Trademark Cases*, Lewis & Clark Law School Business Law Forum on Intellectual Property Remedies (October 3, 2009)
- *Owning Markets? Trademark Law and Market Foreclosure* (with Mark A. Lemley), Ninth Annual Intellectual Property Scholars Conference, Cardozo Law School (August 7, 2009)
- Panelist, *Intellectual Property as Social Engineering*, Southeastern Association of Law Schools Annual Meeting, West Palm Beach, FL (August 4, 2009)
- *Irrelevant Confusion*, Workshop on Trademarks and Trademark Data, a European Policy for Intellectual Property conference sponsored by the Organization for Economic Co-operation and Development and INNO-tec, at the Organization for Economic Cooperation and Development, Paris (July 17, 2009)

2008-09

- *Testing Modern Trademark Law's Theory of Harm*, University of Toronto Innovation Law & Theory Workshop (March 11, 2009)
- Pedagogy Panel, 2009 Intellectual Property Scholars Roundtable, Drake University Law School (February 27, 2009)
- *An Alternate Approach to Channeling*, The Boundaries of Intellectual Property Law Symposium, William & Mary Law School (February 6-7, 2009)
- *Modern Trademark Law and the Right to Make Derivative Works*, George Mason University School of Law Faculty Workshop (September 16, 2008)
- *Modern Trademark Law and the Right to Make Derivative Works*, at the Eighth Annual Intellectual Property Scholars Conference, Stanford Law School (August 7-8, 2008)

2007-08

- *Testing Modern Trademark Law's Theory of Harm*, Chicago Intellectual Property Colloquium (April 22, 2008) (www.chicagoip.com)
- Trademark Scholars Roundtable, Primary Discussant, University of Iowa College of Law (April 11, 2008)
- Participant in the University of Richmond School of Law Intellectual Property Institute's Evil Twin Debate Series, debating Stacey Dogan regarding "trademark use" (April 4, 2008)

- *Trademark Use and the Problem of Source in Trademark Law*, University of Pennsylvania Law School, Center on Technology, Innovation, and Competition Policy Workshop Series (October 29, 2007)
- Moderator, *Trademark Dilution: Theoretical and Empirical Inquiries*, Santa Clara University School of Law (October 5, 2007)
- *Trademark Use and the Problem of Source in Trademark Law*, at the University of Minnesota Trademark Workshop (September 15, 2007)
- *Trademark Use and the Problem of Source in Trademark Law*, at the Seventh Annual Intellectual Property Scholars Conference, DePaul University College of Law (August 10, 2007) (selected for presentation at plenary session)

2006-07

- *What if Trademark Law Really Focused on Consumer Decision-making?*, at “What Ifs and Other Alternative Intellectual Property and Cyberlaw Stories,” Michigan State University College of Law (March 31, 2007) (with Dan Hunter)
- *The Normative Foundations of Trademark Law*, at the University of California at Berkeley IP Scholarship Seminar (December 5, 2006)
- *Trademarks and Contextual Meaning*, at Loyola University of Chicago School of Law Faculty Workshop Series (October 10, 2006)
- *Trademarks and Contextual Meaning*, at the 2006 Works-In-Progress Intellectual Property Colloquium, University of Pittsburgh (October 6, 2006)
- *The Normative Foundations of Trademark Law*, at the Sixth Annual Intellectual Property Scholars Conference, University of California at Berkeley (August 11, 2006)

2005-06

- *The Narratives of Patent and Trademark Law* at Third Annual Intellectual Property and Communications Law and Policy Scholars Roundtable, Michigan State University College of Law (January 27-28, 2006)
- *The Rehnquist Court and the First Amendment*, Symposium sponsored by the Washington University Journal of Law and Policy (November 18, 2005)
- *The Normative Foundations of Trademark Law*, at the 2005 Works-In-Progress Intellectual Property Colloquium, Washington University in St. Louis (October 8, 2005)
- 2005 *Childress Memorial Lecture*, Member of Panel Commenting on Intellectual Property Components of lecture by Carol Rose (September 30, 2005)

2004-05

- *The Normative Foundations of Trademark Law*, Saint Louis University faculty workshop series (September 21, 2005) and Seton Hall University School of Law faculty workshop series (April 22, 2005)

- W(h)ither the Middleman: The Role and Future of Intermediaries in the Information Age, Michigan State University College of Law (April 8-9, 2005) – Conference Fellow and Commentator
- Washington University Digital Expo (April 7, 2005) – panel participant discussing the role of intellectual property law in the digital age, with Jonathan Whitehead (Recording Industry Association of America), Jim Spertus (Motion Picture Association of America), and Rebecca Brown (Washington University General Counsel’s office)
- *Trademarks as Property: Back to the Future* (now re-titled “The Normative Foundations of Trademark Law) at Second Annual Intellectual Property and Communications Law and Policy Scholars Roundtable, Michigan State University College of Law, February 18-19, 2005
- *Trademark Inefficiency: How Expanding Trademark Rights Distort Incentives And Encourage Waste*, at Boston University Works-In-Progress Intellectual Property Colloquium, September 2004

2003-04

- *Identity and Autonomy: Towards a Rational Theory of Identity Appropriation* (re-titled “The Right of Publicity and Autonomous Self-Definition”)
 - Presented at First Annual Intellectual Property and Communications Law and Policy Scholars Roundtable at Michigan State University College of Law (February 18-19, 2004)
 - Presented at University of Kansas School of Law Faculty Workshop (February 10, 2004)
 - Presented at Saint Louis University School of Law Faculty Workshop (January 28, 2004)
- Panel participant regarding Peer-to-Peer filesharing at Tulane Works-In-Progress Intellectual Property Colloquium (September 2003)
- Appeared on World News Roundup Late Edition on KMOX (AM 1200), St. Louis, MO on July 21, 2003 to discuss potential liability for parents whose children download music over the Internet