

**TRADEMARK PRACTICE
GROUP NEWSLETTER**

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Allison McDade, Editor

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allison_mcdade@dell.com

CHAIR REPORT

Trademark Law Committee

Chair – Jonathan Hudis (jhudis@oblon.com)

Co-Chair – Allison Strickland (astrickland@frosszelnick.com)

We look forward to seeing everyone at the AIPLA 2004 Spring Meeting in Dallas, Texas. A joint meeting of all the Trademark Committees will take place on Friday, May 14, 2004 from 3:30 to 5:30 p.m.

Among the speakers during our joint meeting will be Allison McDade, Counsel, Trademarks & Copyrights, Dell Inc. Allison will give a presentation on the value and protection of corporate brands. Parker Bagley, of Milbank, Tweed, Hadley & McCloy, LLP and Jack Matney, of Jenkins & Gilchrist, will provide us with an update on the status of legislative efforts to amend the Federal Trademark Dilution Act. Parker's and Jack's presentation will be especially timely, given the hearing held by the Subcommittee on Courts, the Internet, and Intellectual Property, Committee on the Judiciary, U.S. House of Representatives on April 22, 2004. The hearing was entitled "Oversight Hearing on the Committee Print to Amend the Federal Trademark Dilution Act."

We also will hear from Brett Heavner, of Finnegan, Henderson, Farabow, Garrett & Dunner LLP, who will provide us with an update of recently published trademark decisions of interest. Additionally, Allison Strickland, of Fross, Zelnick, Lehrman & Zissu, P.C., will let us know of recent happenings on the trademark side of the U.S. Patent and Trademark Office.

Finally, a portion of our joint meeting will be presented by the Trademark Internet/Cyberspace Committee. They will feature speakers on (i) recent cases involving pop-up advertising (including the recent "Gator" litigation) and (ii) keyword sales by search engines [a topic which has received some media attention in the wake of Google's recent announcement that it would be easing restrictions on keyword sales that involve trademarks].

STANDING COMMITTEE REPORTS

Trademark Legislation Committee

Chair – Parker H. Bagley (pbagley@milbank.com)

Vice Chair – Jackson Matney (jmatney@jenkens.com)

It has been an extremely active time for our committee. First, in January 2004, we were asked to draft a Resolution regarding a proposed amendment to the Lanham Act provisions regarding certification marks that the International Potato Commission was lobbying for, following an adverse decision in the courts. The committee leadership was opposed to the IPC's proposed legislation and Jack Matney drafted a resolution and we sent it out for committee vote. We later drafted a second resolution but did not seek a vote as we learned that the IPC had discontinued their lobbying efforts.

Later in January and through March, we turned to INTA's proposal to amend the Federal Dilution statute. The INTA proposal included at least ten discrete amendments, several of which were controversial and which required us to parse out the proposals into five separate resolutions, which were also sent out for committee vote. Kim van Voorhis and Jack Matney were actively involved in this effort. The resolutions were presented to the AIPLA Board in March, and AIPLA's positions communicated to Congress.

On Thursday, April 22, 2004, a hearing was held by the Subcommittee on Courts, the Internet, and Intellectual Property, Committee on the Judiciary, U.S. House of Representatives. The hearing was entitled "Oversight Hearing on the Committee Print to Amend the Federal Trademark Dilution Act." We will be reporting the latest developments in this unfolding story during the joint Trademark Committees meeting in Dallas.

Trademark Litigation Committee

Chair - B. Brett Heavner (b.brett.heavner@finnegan.com)

Vice Chair – Jane Shay Wald (jwald@irell.com)

The trademark litigation committee is continuing its efforts to put together a litigation forms notebook for distribution later this year. This summer we will be compiling our annual summary of recent Trademark decisions that will be presented at the October meeting. We have also been working on a formal resolution to submit to the AIPLA board on the proposed changes to electronic discovery.

Trademark Internet/Cyberspace Committee

Chair – Brian B. Darville (bdarville@oblon.com)

Vice Chair – Stephen P. Meleen (smeleen@fulbright.com)

The Trademark Internet/Cyberspace Committee continues to follow developing issues in trademark law relating to online activities. At the 2004 Spring Meeting, we are coordinating presentations on two such issues. The first involves pop-up advertising tied to various terms, including trademarks, such as in the litigation involving Gator Corporation. Those of you who attended the 2003 Annual Meeting may recall a similar

discussion on this topic, and we will be giving “equal time” to the attorneys for Gator Corporation to discuss the issues from their point of view. Our second topic will be litigation over the sale of “keywords” that bring up sponsored results when entered in a search engine. This presentation has become particularly relevant in light of the recent announcement by Google that it will be easing restrictions on keyword sales involving trademarks, and will include a discussion of the possible impact of that decision. We look forward to seeing everyone in Dallas.

Trademark Relations with the USPTO Committee

Chair – Sheldon Klein (kleins@arentfox.com)

Vice Chair – Roberta S. Bren (rbren@oblon.com)

The USPTO remains electronically challenged when it comes to the Madrid Protocol filings. Paper still rules! The requirement for filing electronically has been postponed to November 2, 2004 <http://www.uspto.gov/web/trademarks/madrid/madrid17dec2003.htm>.

The Official Gazette dated April 6, 2004, included an announcement from the USPTO that they were ending the practice of printing paper copies of electronically filed trademark documents such as applications for registration, responses to office actions, Amendments to Allege Use and Declarations of Use. As of April 12, 2004, all file requests must be requested through the Trademark Assistance Center, which is open from 8:30-5:00 weekdays, on the fourth floor of 2900 Crystal Drive in Arlington Virginia. It is estimated that files will be available within about two hours of the request. The USPTO was careful to note that the two hour estimate was only an estimate. The new file access policy does not apply to the Trademark Trial and Appeal Board.

The Trademark Relations Committee reviewed and provided comments on the proposed Changes in the Requirements for Amendment and Correction of Trademark Registrations. Michael Kirk presented these comments to the USPTO on behalf of AIPLA, which can be found at <http://www.uspto.gov/web/trademarks/tmsection7/>.

The electronic version of the Official Gazette dated April 20, 2004, included, for the first time, color drawings. Although the intent was to include color drawings in the print version, black and white prevails. Since the USPTO is only reviewing the electronic version, the failure to include color came as a bit of a surprise. Time will tell if color marks find their way into future printed versions of the Official Gazettes.

The Official Gazette publication notices also recently included the Examining Attorney’s names. There has been lots of speculation as to why the names began to appear. Wonder no more. Apparently, this was unintentional so eventually we can expect them to disappear from future Official Gazettes.

The USPTO is in the process of hiring additional Examining Attorneys.

The move to Alexandria for the Trademark Operation is expected to take place in October 2004.

Trademark Treaties/International Law Committee

Chair – Graeme B. Dinwoodie (gdinwood@kentlaw.edu)

Vice Chair – Jonathan Richards (jrichards@wnpatent.com)

At the Mid-Winter Meeting, the Committee’s meeting focused primarily on the proposed Revised Trademark Law Treaty (“RTLTL”), and in particular Article 20 of the RTLTL. Article 20 provides: “Use of a mark by natural persons or legal entities other than the holder shall be deemed to constitute use by the holder himself if such use is made with the holder’s consent.” The related Notes go on to state:

20.02 **Certain national or regional laws, however, provide that use by persons other than the holder may be held to constitute use of the mark by the holder only if certain conditions are fulfilled, such as the conclusion of a formal license contract containing quality control clauses** or such as the recordal of such a contract. In this respect, Article 19.2 of the TRIPS Agreement expressly allows a requirement that there be control of a licensee’s use of a mark by the holder in order to recognize such use for maintaining the registration of the mark.

20.03 The effect of Article 20 is that, **whenever the question of use becomes relevant**, any use of a mark by any person other than the holder must be deemed to be use of the mark by the holder, provided that such use is made with the consent of the holder. **No other condition, such as control by the holder of the use of the mark, may be required by a Contracting Party.** Consequently, if in the absence of use of the mark by the holder, a third party uses that mark with the consent of the holder, the mark cannot be invalidated on the ground of non use. **To this extent, Article 20 is broader than Article 19.2 of the TRIPS Agreement.** (emphasis added)

Jon Richards, Vice Chair of the Committee, who has attended the last two meetings of the WIPO Standing Committee on the Law of Trademarks (“SCT”) at WIPO Headquarters in Geneva, Switzerland, where this issue has been discussed, gave a summary of where the treaty discussions stood and a lively discussion ensued.

Following this discussion, the Committee prepared a resolution, which was adopted by the Board, opposing any prohibition on quality control requirements. Jon Richards will attend the SCT Meeting on April 26-30, and will make the Association’s position known there. Thanks to Jon for tremendous work in getting the resolution ready for Board approval.

The Committee has also continued to monitor the ongoing discussions in The Hague Conference on Private International Law regarding the enforcement of choice of forum clauses in B2B contracts. The intellectual property issues have been quite contentious, and it is not yet fully clear how the final treaty will address trademark issues. It is

possible that industrial property will be excluded from the scope of the treaty. A Diplomatic Conference is scheduled for early 2005 to adopt this treaty, and the Committee expects to be in communication with members regarding its international trademark aspects.

Finally, we continue to monitor the implementation of the Madrid Protocol, along with other trademark committees of the Association. At the AIPLA 2004 Spring Meeting in Dallas, Texas, the Committee will participate in a joint meeting of all the Trademark Committees, which will take place on Friday, May 14, 2004 from 3:30 to 5:30 p.m. At that time, an update on the RTLTL discussions in the SCT will be provided.

TTAB Subcommittee

Chair -Linda L. McLeod (linda.mcleod@finnegan.com)

The Trademark Trial and Appeal Board has expanded electronic filing through the ESTTA database to include all ex parte filings (including notices of appeal, motions to extend or suspend the time for filing briefs, requests for oral hearing, and requests for remand) and cancellation proceedings. The ESTTA database is now fully operational, and virtually every type of paper can be filed electronically. The Board is also fine tuning ESTTA to allow, in the future, stipulations in inter partes proceedings to be both filed and decided (granted) electronically and change of correspondence address to be completed electronically.

The Trademark Trial and Appeal Board Manual of Procedure (TBMP) will be updated soon to include the new rules implemented under the Madrid Protocol changes. In addition, the Board is considering the possibility of amending the Trademark Rules to adopt the automatic disclosure and related provisions under Fed. R. Civ. P. 26. Although the Board has considered such changes in the past, there does appear to be increased momentum on the part of the Board and the Office of General Counsel to evaluate the effects of these Rule 26 provisions on TTAB practice. The Committee will continue to monitor any new developments on proposed rule changes, if any.

As of March 2004, the Board reported that they are meeting productivity goals, with average time for final decisions (for ex parte and inter partes proceedings fully briefed in merits) at 10.9 months; average time for decisions on contested and summary judgment motions at 11.7 months; and average time for decision on extensions of time to oppose at 7 days. The Board also reported that the backlogs for extensions of time to oppose have been eliminated.

The Committee has learned that the USPTO's new consolidated headquarters facility in Alexandria, Virginia will include three hearing rooms, including one large hearing room to accommodate an augmented panel of Judges. The Board will share the hearing room spaces with the Patent Board. At this time, the USPTO plans to have one of the shared hearing rooms serve as an electronic court room that will permit video conference hearings and electronic trial aides.

Finally, Administrative Trademark Judge Robert F. Cissel retired in April 2004 after a long and distinguished career at the Board and the USPTO. At this time, the Board has no immediate plans to replace Judge Cissel.