

Hot Topics, Recent Cases and Litigation Alternatives

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Trademark Trial and Appeal Board Proceedings

- Pros
 - ◆ Ability to stop registration of identical or similar mark
 - ◆ Less expensive than federal court proceeding
 - ◆ Pace is generally slower

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Trademark Trial and Appeal Board Proceedings, *continued*

- Cons
 - ◆ No power to enjoin use of mark; only power to stop registration
 - ◆ No power to award damages or attorneys fees
 - ◆ Final decisions by TTAB can take two years from filing

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Why Does Registration Matter?

- Settlement
- Deterrence
- Territory

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Types of TTAB Proceedings

- Oppositions
- Cancellations
- Concurrent Use Proceedings

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Types of TTAB Proceedings, *continued*

- Oppositions
 - ◆ Section 13 of the Lanham Act; Plaintiff (Opposer) seeks to prevent issuance of registration
- Extensions of Time to Oppose
 - ◆ Mark published in Official Gazette—30 days to oppose or seek extension
 - ◆ Initial extension request(s)—30 days as of right or 90 days with good cause
 - ◆ Final extension request—60 days additional with consent of other side

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**Types of TTAB Proceedings,
*continued***

■ **Cancellations**

- ◆ Under Sections 14 and 24 of the Lanham Act, Plaintiff (Petitioner) may seek to cancel a registration of another's mark.
- ◆ Can cancel registrations on Supplemental Register

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**Types of TTAB Proceedings,
*continued***

■ **Concurrent Use Proceedings**

- ◆ Mechanism to determine whether one or more parties are entitled to concurrent registration of same mark
- ◆ Commonly used to restrict geographic scope of each party's mark

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**Bases for Oppositions and
Cancellations**

■ **Likelihood of Confusion—Section 2(d) of
Lanham Act, 15 U.S.C. § 1052(d)**

- ◆ Multi-factor "likelihood of confusion" test—
In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

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Bases for Oppositions and Cancellations, *continued*

- ◆ Likelihood of Confusion Factors:
 - a) similarity of the marks and goods and services
 - b) similarity of channels of trade
 - c) sophistication of purchasers
 - d) fame of prior mark
 - e) number of other similar marks in marketplace
 - f) actual confusion, among other factors

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Bases for Oppositions and Cancellations (*continued*)

- Descriptiveness—Section 2(e) of the Lanham Act, 15 U.S.C. § 1052(e)
 - ◆ Merely descriptive.
 - ◆ Test: whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the goods or services in connection with which it is used.

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Bases for Oppositions and Cancellations (*continued*)

- Dilution—Sections 43(c) and 13 of the Lanham Act, 15 U.S.C. §§ 1125(c) and 1063
 - To prove dilution claim, opposer must show:
 - i) Other party's mark is used or intended to be used in commerce
 - ii) Applicant adopted its mark after opposer's mark became famous
 - iii) Opposer's mark is both famous and distinctive
 - iv) Applicant's mark likely to cause dilution of opposer's mark.

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Bases for Oppositions and Cancellations (*continued*)

- Additional Grounds
 - ◆ Immoral, deceptive or scandalous matter
 - ◆ Disparaging or false connection with persons living or dead, institutions, beliefs or national symbols
 - ◆ Flag or coat of arms or other insignia of United States or of any state or municipality or any foreign nation
 - ◆ Name, portrait or signature identifying living individual without consent

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Bases for Oppositions and Cancellations (*continued*)

- Limited Grounds for Cancellation Proceedings after Five Years
 - ◆ Cannot cancel registration after five years on grounds of likelihood of confusion or descriptiveness
 - ◆ Can cancel for genericness; abandonment; fraud; functionality; and Section 2(a), (b) or (c) grounds

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Bases for Oppositions and Cancellations (*continued*)

- Tips for Filing Notice of Opposition or Cancellation
 - ◆ Notice Pleading
 - ◆ Filing and Service – rule change requires parties to serve pleading and file with proof of service to initiate proceeding

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TTAB Discovery

- Disclosure Conference
- Initial Disclosures
- Expert Disclosures
- Pretrial Disclosures

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TTAB Discovery Tools

- Depositions
- Document Requests
- Interrogatories (each party is limited to 75 including subparts)
- Requests for Admission

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TTAB Motion Practice

- Motions to extend time
- Other motions available—motions to dismiss, to compel, to strike, for summary judgment

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TTAB Trials

- Plaintiff goes first (30-day period)
- Defendant goes second (30-day period)
- Plaintiff gets rebuttal (15-day period)
- Notice of Reliance
 - ◆ Discovery depositions of adverse witnesses
 - ◆ Adverse party's answers to interrogatories or responses to requests to admit
 - ◆ Registrations of the parties
 - ◆ Printed publications
 - ◆ File of application or registration not subject of proceeding

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TTAB Testimonial Depositions

- Live testimony taken at law offices—no judge present
- Transcripts submitted to TTAB
- Disputes can be resolved by Board during deposition

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TTAB Trial Briefs

- TTAB Trial Briefs
 - ◆ 55-page limit for each side; 25-page limit for reply brief
- Oral Argument
- Appeals

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UDRP PROCEEDINGS

- Background
- Pros and Cons
- Applies to all generic top-level domains (“gTLDs”)— .com, .net, .org
- Not all country code top-level domains (“ccTLDs”) subject to ICANN’s rules

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UDRP Dispute Resolution Providers

- UDRP Dispute Resolution Providers
 - ◆ World Intellectual Property Organization (“WIPO”)
 - ◆ National Arbitration Forum (“NAF”)
- Formalities
 - ◆ Complaint submitted online; Registrant may respond
 - ◆ One or three arbitrators

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Complaint

- Complainant must show:
 - i) Domain name identical or confusingly similar to trademark;
 - ii) Registrant has no rights or legitimate interests in domain name; and
 - iii) Domain name registered and is being used in bad faith

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Confusing Similarity

- Not requirement that complainant own trademark registration
- Misspellings of trademark not generally viable defense
- Deletion of spaces, substitution of "and" for ampersand symbol and other similar variations dictated by the limitations of the Internet naming system

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Registrant's Absence of Rights or Legitimate Interest

- Legitimate Interest?
NO
 - ◆ Registrar granted cybersquatter registration
 - ◆ Trademark owner inadvertently allowed registration to lapse
 - ◆ Need contractual arrangement for registrant to claim it is acting for complainant
 - ◆ Registrant plans to resell name
 - ◆ Use of domain name to link to unrelated site

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Registrant's Absence of Rights or Legitimate Interest

- Legitimate Interest?
YES
 - ◆ Use in connection with bona fide offering of goods/services

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Bad Faith

- Offering to sell domain name for profit
 - ◆ Complainant seeks to purchase domain name from registrant—bad faith if registrant seeks profit in return
 - ◆ Respondent seeks leverage other than money
- False registration information
- Lack of actual or contemplated use of domain name

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Bad Faith, *continued*

- Presumption of bad faith where complainant's mark is highly distinctive
- Registration of multiple domain names
- Registrant's fair use defense—concrete evidence required
- Registrant's intent to confuse domain name with complainant's trademark

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UDRP Remedies

- Cancel or transfer domain name
 - No injunctive relief
 - No monetary damages or attorneys fees
- Appeal**
- Losing party can appeal to Federal Court

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Hot Topics/Recent Cases

- Keyword Advertising
- Social Networking
- Contributory Infringement
- Irreparable Harm

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Keyword Advertising -- Basics

- Keyword advertising - advertisers purchase competitor's trademarks as keyword to trigger their own advertisements on search results pages of search engines
- Trademark law issues
 - ◆ Has defendant used plaintiff's mark in commerce?
 - ◆ Is there a likelihood of confusion?

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Keyword Advertising – Use in Commerce

- Majority of courts have held use of trademark as keyword to trigger banner ads, pop-ups ads or sponsored links constitutes use in commerce under the Lanham Act (9th Circuit in *Playboy Enterprises, Inc. v Netscape Communications Corp.*, 354 F.3d 1020 (9th Cir. 2004); 10th Circuit in *Australian Gold, Inc. v. Hartfield*, 436 F.3d 1228 (10th Cir. 2006); other district courts)

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Keyword Advertising – Use in Commerce, *continued*

- Second Circuit reaches different result in *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400 (2nd Cir. 2006)
- Second Circuit distinguishes *WhenU.com* case in *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123 (2nd Cir. 2009)

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Keyword Advertising – Likelihood of Confusion

- Several courts have found likelihood of confusion based on initial interest confusion when consumer is lured to site even if she realizes true source of goods before any sale is consummated
- Contrary view: *J.G. Wentworth, S.S.C. Ltd. v. Settlement Funding LLC*, 2007 WL 30115 (E.D. Pa. 2007) – defendant’s website appears as one of many choices on search results page for consumers to investigate with no use of plaintiff’s mark in ads or links

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Social Networking Sites

- Twitter lawsuits – *Oneok, Inc. v. Twitter, Inc.* (N.D. Okla. 2009) and *La Russa v. Twitter, Inc.* (Superior Ct. Cal. 2009)
- *Hasbro, Inc. v. RJ Softwares et al* (S.D.N.Y. 2008) – suit over game Scrabulous introduced on Facebook

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Contributory Infringement

- *Tiffany (NJ), Inc. v. eBay Inc.*, 600 F.3d 93 (2nd Cir. 2010) – generalized knowledge of infringement on website insufficient

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Irreparable Harm

- *Salinger v. Colting*, 94 U.S.P.Q. 2d 1577 (2nd Cir. 2010) – no presumption of irreparable harm for copyright infringement
- Footnote in case suggests presumption would be inapplicable in all cases, including trademark
- Practical implications - proving irreparable harm

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