



BULLETIN

PRESIDENT'S CORNER

While sitting in my office, preparing for this evening's Annual Meeting, the thought occurred that I should conclude my series of President's Corner articles by providing a brief "State-of-the Association" report. My goal is to let you know what we have accomplished this year — which has been substantial. But I also wish to acknowledge the substantial contributions of a number of outstanding men and women who have enhanced our Association.

Judges Dinner. I start with then Chief Judge Helen Nies. Her energetic and stimulating address was the highlight of this year's Annual Dinner in honor of the judiciary. Over 2,300 attended. It was a memorable evening. Judge Nies' thoughtful and provocative comments constitute a clarion call for civility on the part of all of us, both members of the bar and members of the judiciary. And I thank her for this.

Thanks, too, for the efforts of Tom Creel and those who worked so hard with him to make the Judges Dinner such a great success. We are particularly indebted to Michael Isaacs and his outstanding staff at Horizon for their effort.

Directors. As reported in this and past issues of our *Bulletin*, the Board of Directors met regularly and addressed a host of diverse projects. I thank them all for their support and counsel. And I particularly wish to recognize the contributions of Greg Battersby, Ed Filardi and Roger Smith — who are concluding their terms as Directors, following years of exemplary service.

Officers. Thanks, too, for the help and support of our officers — particularly the tireless efforts of our treasurer, Howard Barnaby, and our secretary, Bill Dippert. We are in good shape financially, and things appear to be running smoothly.

I turn now to the lifeblood of our Association — the contributions of our Commit-

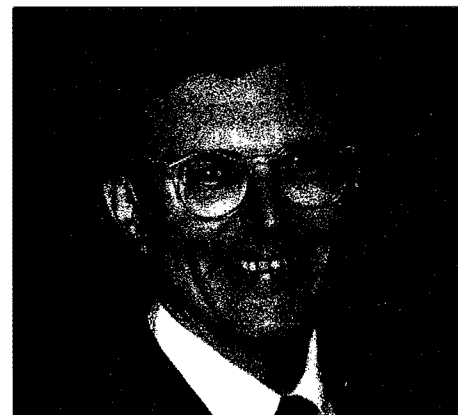
tees. Here, in alphabetical order by committee, is a brief report on their accomplishments.

Admissions. Under the continued leadership of Michael Kelly, we admitted 68 additional individuals to our Association. And, I am delighted to report, we are continuing our efforts to make the Association accessible — particularly to recent law school graduates and students.

ADR. Charlie Baker has done his usual fine job of providing leadership and direction. The extensive comments his committee submitted to WIPO — on its proposed arbitration, expedited arbitration and mediation services — were well received.

Annual Meeting. Thanks to the efforts of Marty Goldstein and his committee, preparations for our Annual Meeting are going forward in a well-organized fashion. I look forward to your attendance.

Antitrust. John Daniel and his committee are continuing to monitor the judicial reaction to the Supreme Court's recent ruling on "sham litigation." *Professional Real Estate Investors, Inc. v. Columbia Pictures Indus., Inc.*, 113 Sup.Ct. 1920 (1993). This includes the Federal Circuit's affirmation of summary judgment, dismiss-



ing an antitrust counterclaim in *Carroll Touch, Inc. v. Electromechanical Sys., Inc.*, 27 USPQ2d 1836 (Fed.Cir. 1993).

CLE. Ed Vassallo epitomizes the work of our committee chairs. He allowed himself to be drafted again — and again, the committee's work was outstanding. In particular, because of the committee's efforts, we co-sponsored an extremely successful CLE program at Fordham Law School — with nearly 200 attendees, including 30 law students. In addition, again thanks to the committee, we co-sponsored a Joint Patent Seminar with the New Jersey, Connecticut and Philadelphia IP Associations at the Grand Hyatt, which was equally well-re-

CALENDAR OF EVENTS

June 8-August 5, 1994

Franklin Pierce Law Center Eighth Annual Intellectual Property Summer Institute, Franklin Pierce Law Center, Concord, NH

June 18-22, 1994

Association of Corporate Patent Counsel, Westin Hilton Head, Hilton Head, SC

June 20-21, 1994

Japan Patent Practice Prosecution/Licensing/Litigation, Sponsored by AIPLA, Marriott Crystal Gateway, Arlington, VA

June 23-24, 1994

Practising Law Institute Seminar on Intellectual Property Antitrust, PLI Training Center, New York, NY

ceived by the approximately 150 persons who attended.

Economic Matters. Brian Poissant and his committee continued to evaluate a proposed long-term disability insurance plan which we hope to make available for members' consideration.

Employment. Richard DeLucia and his committee have continued to facilitate the interaction of job seekers and job offerers. Not surprisingly, given the current economic climate, there is an upswing in the work of this committee. The active solicitation and publication of job openings are suggested for next year.

Ethics and Grievances. Al Ewert and his committee continue to consider a (thankfully) limited number of sometimes delicate issues, with sensitivity and wisdom.

Foreign Trademarks. Because of a last minute scheduling conflict, Howard Barnaby, Sue Progoff and Virginia Richard stepped in for the Chair and co-hosted with the Fordham Law School an informative program on the Madrid Protocol. It was a great success.

Harmonization. David Weild and his committee were of invaluable assistance in drafting written comments to the PTO on a number of key harmonization issues.

Host. Ed Filardi and his committee did an excellent job of hosting the ABA's IP Law Section at last summer's annual meeting of the American Bar Association. The highlight was an outstanding reception at the United Nations, attended by 600 persons.

Incentives and Innovation. Tom Spath and his committee have now completed a very interesting survey on the incentives offered by corporations to employee-inventors in connection with the filing of patent applications. The responses to that survey have now been tabulated and are being prepared for a final report.

Legislative Oversight. Thanks to the work of Vince Palladino and his committee, we wrote to Senator DeConcini and expressed our support for his proposed bill: publishing patent applications 18 months after filing; measuring a patent's term from the application filing date; and providing provisional protection between publication and grant.

License to Practice. Dale Carlson and his committee continued to address provocative questions concerning the admission to our Association of foreign patent

agents. This greatly helped to focus the Board's debate — with the result that, again, we concluded that it would be inappropriate to invite foreign agents to join our bar association.

Meetings and Forums. Marilyn Matthes Brogan and her committee have continued our series of monthly luncheon meetings at the Cornell Club. Directed to a variety of subjects of topical interest, and with a policy of reduced attendance fees for members admitted less than five years, these meetings were very well-received and usually filled to capacity. Thanks to Marilyn and her committee, we were also able to co-sponsor with the International Patent Club an instructive address by Commissioner Lehman.

Patent Law. Thanks to the joint contributions of our Copyright Committee, under the leadership of Marilyn Smith Dawkins, and our Patent Law Committee, under the leadership of Terri Gillis, we were able to provide the PTO with detailed comments concerning the patent protection of computer-related inventions.

Public and Judicial Personnel. Ken Madsen and his committee provided additional insight and support for a number of candidates for offices important to our profession.

Publications. I really don't see how Greg Battersby gets it all done. I think it's both because he is an outstanding chairman and has an excellent committee. Our *Greenbook* has increased to approximately 220 pages, was again prepared on a Macintosh desktop publishing system (which greatly simplifies matters) and was distributed ahead of schedule. The *Bulletin* continues to provide the Association with a wealth of information on a regular basis. And I am particularly pleased to report that a new publication, our *Intellectual Property Annual*, has been distributed to members free of charge and is now being marketed to libraries and others (at the cost of \$50 per copy).

Public Information and Education. Tom Beck and his committee have now selected the Inventor of the Year and the recipient of the Judge Conner writing prize. It was a lot of work, but well worth it.

Trade Secret. Thanks to Mel Garner and his committee, we jointly hosted with the AIPLA a meeting with a delegation from the Japanese Federation of Bar Asso-

ciations. In addition, Mel and his committee formulated an insightful analysis of the Uniform Trade Secrets Act now adopted (albeit in distressingly non-uniform fashion) by 40 states and the District of Columbia.

Last, but certainly not lest, I want to thank all of you for your support and encouragement — particularly the past presidents who were so generous with their time. It has been an enormous pleasure to serve as your 1993-94 President. And it is a pleasure to welcome Pat Razzano as our President for 1994-95.

— William J. Gilbreth

JAPANESE INTELLECTUAL PROPERTY DEVELOPMENTS

by John B. Pegram

This Association is one of the over 30 member associations of the US Bar/JPO Liaison Council whose representatives have met with high officials of the Japanese Patent Office in each of the last four years. The minutes of the Council's November 18, 1993 meeting in Tokyo were released earlier this year and are summarized here.

The New York area was well represented at the 1993 meeting. In addition to the author, who attended as NYIPLA's representative, the participants included Christopher Chalsen (AIPLA), Aaron Karas and Leonard Mackey (ABA), and Michael Meller and Victor Siber (International Patent Club).

Following opening addresses by Chairman Wataru Asou and Council Chair, Ogden H. Webster, the meeting commenced with a status report by the JPO and a report on recent developments in the United States regarding harmonization of intellectual property systems. The remainder of the program was an exchange of educational presentations on various aspects of the U.S. and Japanese patent systems. Presentations by U.S. participants included discussions of the doctrine of equivalents, the

Madrid Protocol for international registration of marks, and the current status of industrial design legislation. The Japanese presentations are discussed in detail below.

JPO STATUS REPORT

In the JPO opening status report, General Administration Division Director Masataba Sase reported that the average examination period had been reduced from 37 months in 1988 to 28 months in 1992 and that the target goal was 24 months. Some progress had been made in obtaining permission to hire additional examiners. He reported that there had been 2200 requests for accelerated examination in 1992, but indicated that the JPO was surprised that more foreigners did not request acceleration.

EXAMINATION GUIDELINES

The Director of the Examination Standards Office, Koji Hirayama, discussed the new Examination Guidelines which were disseminated to the examiners in late 1993. A guideline expresses a basic fundamental idea and philosophy for conducting examination. A serious effort has been made to correlate the new guidelines with those prevailing in Europe and the United States. The revised guidelines include special provisions for biotechnology and computer software-related inventions. An English translation of the new Examination Guidelines is now available for purchase from the Japanese Group of the AIPPI, Toranomon Denki Bldg., 7th Fl., 8-1, Toranomon 2-chome, Minato-ku, Tokyo 105, Japan.

NEW LAW

Mr. Hirayama also explained major provisions of the amendments to the Japanese Patent and Utility Model Laws which will be applied to applications filed after January 1, 1994. In the past, the JPO has been relatively liberal in permitting amendment of patent specifications which has been especially useful for foreign applicants in correcting errors in last minute translations. The new law adopts a strict "new matter" rule, similar to that in the United States. Like the United States, specification amendments will be permitted only on the basis of disclosure in the specification and drawings as filed.

Under the new law, the JPO will move toward a compact prosecution procedure, similar to that in the United States. Amendment after a final notification of refusal, which may be the second action, will be limited. Interviews, however, are possible before and after a final refusal, and further amendment based upon the result of the interview may be possible.

Mr. Oshida, Director of the Intellectual Property Legislation Revision Deliberation Office, and Deputy Commissioner Shingo Tsuji, discussed the availability of divisional applications, which in some cases may serve the same objective as continuation applications in the United States. Mr. Oshida said that the JPO was considering relaxation of the standards for filing divisional applications.

An article on "Revision of Patent and Utility Model Laws" by the JPO's Industrial Property Legislation Revision Deliberation Office appears in the January 1994 issue of the *Journal of the Japanese Group of the AIPPI*.

DOCTRINE OF EQUIVALENTS IN JAPAN

Mr. Oshida noted that, in applying the doctrine of equivalents, Japanese cases have analyzed the facts as of the time of filing the application, and a substitutionability of elements test has been used. He added that the Japanese law does not prohibit analysis as of the time of infringement, but said that no case has gone that way in the Supreme Court.

OPPOSITION PROCEDURE

In past discussions with Japanese groups, there had been indications that a change from pre-grant to post-grant opposition might be possible as a part of patent law harmonization. Consolidation of multiple oppositions had also been suggested to the JPO. Mr. Oshida agreed that a post-grant opposition procedure would shorten the patent pendency period and allow oppositions to be consolidated, thereby reducing the time and cost of an opposition procedure. He stated, however, that the current pre-grant opposition system allows a stable granting of patent rights which have no deficiency.

There was, he said, no consensus for a change from the pre-grant opposition sys-

tem to a post-grant opposition system at this time and that there has been no progress made regarding the consolidation of multiple oppositions. He stated that there were 5,565 oppositions filed in 1992 and there were only 8 cases in which there were more than 10 oppositions filed.

TRANSLATIONS

At a prior meeting, the Council brought the problem of poor quality last-minute translations to the attention of the JPO, suggesting that filing in a foreign language could be followed by a translation within a few months which would result in better quality translations. The quality of translations will be particularly important in applications filed under the law effective January 1, 1994, because of the prohibition of introducing "new matter." At the November meeting, Mr. Oshida indicated that such a change in Japanese law might be possible as a part of a grand patent law harmonization package. Subsequently, the JPO and USPTO have announced an agreement that Japan will introduce legislation to permit such filing and that the United States will introduce legislation calling for a patent term of 20 years from filing and publications of applications after 18 months.

NEXT MEETING

The fifth meeting of the Council with the JPO is now being planned. If you have any general problems regarding JPO practice issues you want brought to the attention of the JPO, please write now to John B. Pegram, fax (212) 586-1461. ■

NEWS FROM THE BOARD OF DIRECTORS

by William H. Dippert

The Board of Directors met on March 15, 1994. Mr. Gilbreth presided.

The reading of the minutes of the February 15, 1994 meeting was waived. Upon motion the minutes were unanimously ap-

proved. Mr. Barnaby distributed copies of the Treasurer's Report. He advised that the Association's bank balance is temporarily swelled due to receipts for the Judges Dinner. Upon motion the Treasurer's Report was approved.

Mr. Barnaby and Mr. Gilbreth commented concerning the two-day conference on intellectual property sponsored by Fordham Law School. Mr. Barnaby indicated that there would be a separate mailing to Association members inviting them to attend just the portion of the program concerning the Madrid Protocol, which portion is scheduled for the morning of Friday, April 8. Mr. Gilbreth commented that he was aware that some people had reacted to the cost for the entire two-day program. In addition, there has been some comments concerning the program announcement, namely, that while the announcement identifies sponsors who contributed monetary support, there was no mention about those who made non-monetary contributions, such as our Association.

Ms. Ryan presented the Nominating Committee's report. Edward V. Filardi was nominated as Second Vice President, Howard B. Barnaby was nominated as Treasurer, William H. Dippert was nominated as Secretary, Michael J. Kelly, David W. Plant, and Thomas E. Spath were nominated as Directors, and Edward Vassallo, Gregory Battersby, Arthur S. Tensor, M. Andrea Ryan, and William J. Gilbreth were nominated for the 1994-1995 Nominating Committee.

Mr. Gilbreth commented about pending intellectual property legislation. Senator De Concini's bill contains a provision for an 18-month publication date. Marty Goldstein reported that Rick Gilbert of the AIPLA said he wants to study that provision.

Mr. Gilbreth mentioned that Ms. Ryan had suggested offering assistance to Governor Cuomo and Senator Moynihan on intellectual property matters. Mr. Gilbreth has made some initial calls and will follow up on this. In addition, he will attempt to contact Senator D'Amato as well.

Mr. Gilbreth led discussion concerning a proposed letter to the Commissioner conveying comments on patent protection for software-related inventions. A motion by Mr. Smith to send the letter was seconded and passed unanimously.

There was discussion concerning an invitation by WIPO to attend another meeting concerning the Madrid Protocol. In view of the developments concerning the Madrid Protocol, there is a question as to the significance of this proposed meeting. Mr. Gilbreth will attempt to get additional materials concerning the proposed meeting. Also, Mr. Barnaby will talk to John Olsen and report at the next meeting.

Mr. Creel reported concerning the 1994 Judges Dinner. He indicated that approximately 2500 reservations had been received and that the number of Honored Guests who have accepted is up slightly from last year. Also, he said that table assignments are expected later that week and that letters

to the Honored Guests and their escorts would be going out. Mr. Creel also reported that a brunch primarily for Honored Guests and Board members is scheduled for Saturday, March 26, in Mr. Gilbreth's suite at the Waldorf. According to Mr. Creel, a three-year financial arrangement between the Association and the Waldorf has not yet been finalized.

Mr. Gilbreth reported a request for life membership from Thomas Whaley. Mr. Dippert will review old *Greenbooks* to determine the extent of Mr. Whaley's activities in the Association.

Mr. Goldstein reported concerning the Annual Meeting scheduled for May 26. Dean John Feerick of Fordham will be the main speaker.

There was discussion of inviting intellectual property professors from area law schools, possibly with one or more interested students. That will be considered. Also, Ms. Ryan suggested that firms invite summer associates to the dinner. Mr. Gilbreth offered to put that in his column in the *Bulletin*.

Mr. Gilbreth commented that attendance for the ADR Program is disappointing so far. He suggested that since all federal courts have ADR, it would be good to know about it, and he recommended that firms and corporations encourage attendance.

Mr. Battersby reported that the *Annual* was being mailed that day. ■

The New York Intellectual Property Law Association, Inc.

announces the publication of

The 1994 Intellectual Property Law Annual

The 1994 NYIPLA Intellectual Property Law Annual is the only publication that provides current information from leading practitioners in the field on the latest developments in intellectual property law on both the national and international levels.

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REVIEW OF RECENT TRADEMARK CASES INVOLVING SUMMARY JUDGMENT MOTIONS

by T. Jeffrey Quinn

Administrative Trademark Judge Trademark Trial and Appeal Board

Originally prepared by T. Jeffrey Quinn and Laurence R. Hefter for use at the United States Court of Appeals for the Federal Circuit Eighth Annual Judicial Conference on May 31, 1990; updated by T. Jeffrey Quinn in January 1994.

Mr. T. Jeffrey Quinn, Administrative Trademark Judge for the Trademark Trial and Appeal Board, has compiled an extensive listing of recent trademark cases involving summary judgment motions before the Trademark Trial and Appeal Board and the Court of Appeals for the Federal Circuit. Mr. Quinn has graciously allowed this listing to be included in the *NYIPLA Bulletin* as an insert for its members.

The following is a summary of cases involving motions for summary judgment before the Trademark Trial and Appeal Board and the Court of Appeals for the Federal Circuit reported at 9 USPQ2d 1001 (January 2, 1989) through 29 USPQ2d 1080 (January 3, 1994). Attached as Appendix A is a list of summary judgment cases before the Board and Federal Circuit from 1984 to the end of 1988 which appeared in *TTAB Practice Hints From the Practitioner: Survey of Summary Judgment at the Trademark Trial and Appeal Board*; 1984 to date, J. Paul Williamson, ABA-PTC Section, Fourth Annual Spring Educational Program, March 29-30, 1989. This reproduction is made with the approval of Mr. Williamson.

LIKELIHOOD OF CONFUSION

Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) [Federal Circuit reverses and remands for trial, finding that the evidence of third-party use raised a material fact issue about strength of plaintiff's mark and Board erred in drawing inference against non-moving party based on statements made by declarants related to plaintiff and not shown to be representative of consuming public]

Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) [Federal Circuit reverses holding that OLD TIME for donuts, rolls, buns, bread, fruit pies and ice cream and YE OLDE TYME for mixes for cornbread, doughnuts, breads, frying batter, cakes, muffins, tortillas, and breadings, and for cookies likely to cause confusion — case remanded since Board erred in granting summary judgment for petitioner on basis of inferences favoring petitioner, the moving party — law requires that all reasonable inferences be drawn in favor of the nonmovant]

Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) [opposer's marks GRAND OLD OPRY, GRAND OLE OPRY, OZARK OPRY, and OPRYLAND and applicant's mark THE CAROLINA OPRY must be considered in their entireties — evidence supported reasonable

inferences in opposer's favor; Board's decision dismissing opposition is vacated and case remanded]

Kellogg Co. v. Pack'em Enterprises, Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), *aff'g* 14 USPQ2d 1545 (TTAB 1990) [applicant's motion for summary judgment of no likelihood of confusion granted because applicant's mark FROOTIE ICE & elephant design for frozen ice bars and opposer's mark FROOT LOOPS for breakfast cereals differed substantially in appearance, sound, connotation and commercial impression]

National Cable Television Assn. Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) [Federal Circuit affirms — virtual identity of marks for closely related services outweighs other factors bearing on likelihood of confusion]

Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ 1783 (Fed. Cir. 1990) [OCTACOMM for computer programs and OCTOCOM marks for modems likely to cause confusion — testimony that use is restricted to particular trade channel does not create a material fact question if identification of goods has no such restriction]

Cortex Corp. v. W. L. Gore & Associates, Inc., 28 USPQ2d 1152 (Fed. Cir. 1993) (unpublished) [Federal Circuit reverses, finding no likelihood of confusion between applicant's mark CORTEX for computer programs and opposer's mark GORE-TEX for insulated wires, cables and filtration apparatus, since marks are dissimilar in appearance, connotation and commercial impression; parties' products are dissimilar; both parties sell their goods to discriminating purchasers under conditions designed to insure care in discerning goods' source; fame of opposer's mark does not extend beyond fabric and clothing products; and no evidence of actual confusion was presented, despite twelve years of marks' contemporaneous use]

Johnson & Johnson v. Jack Frost Laboratories, Inc., 14 USPQ2d 1076 (Fed. Cir. 1990) (unpublished) [Federal Circuit reversed Board's grant of summary judgment of no likelihood of confusion; likelihood of confusion is question of law which Federal Circuit reviews de novo]

Wool Bureau, Inc. v. Warenzeichenverband, 10 USPQ2d 1559 (Fed. Cir. 1989) (unpublished) [Federal Circuit affirmed Board's

grant of summary judgment of no likelihood of confusion; sole evidence introduced by opposer, an affidavit of its president, was conclusory and contained speculative allegations not having any basis in fact]

Metromedia Steakhouses Inc. v. Pondco II Inc., 28 USPQ2d 1205 (TTAB 1993) [genuine issues of material fact remain regarding applicant's intent in adopting mark and likelihood of confusion between opposer's marks BONANZA and PONDEROSA and applicant's mark RANCH STEAK & SEAFOOD and design, all for restaurant services]

Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992) [confusion likely between NALEX and NOLEX for pharmaceutical products — very important to avoid confusion where marks are used on pharmaceuticals]

Sears Mortgage Corp. v. Northeast Savings F.A., 24 USPQ2d 1227 (TTAB 1992) [no likelihood of confusion between APPROVAL PLUS for mortgage banking and mortgage brokerage services and APPROVALFIRST for mortgage payment financial consulting services — respondent's concession that marks "may" suggest same thing does not constitute concession that marks have same connotation]

Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742 (TTAB 1992) [likelihood of confusion found between INFORMATION FINDER and KNOWLEDGE FINDER for computer programs; issue is decided on basis of broad identifications, notwithstanding possible Sec. 18 restriction of opposer's registration]

Aires Systems Corp. v. World Book Inc., 26 USPQ2d 1926 (TTAB 1993) [no likelihood of confusion when identifications of goods in opposer's registration and applicant's application are restricted and limited in a commercially significant manner]

INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992) [cross motions for summary judgment — likelihood of confusion exists between PASSPORT for banking services and CORPORATE DOLLARS PASSPORT for credit cards]

Phoenix Closures Inc. v. Yen Shaing Corp., 9 USPQ2d 1891 (TTAB 1988) [cross motions for summary judgment; applicant's motion granted in view of no likelihood of confusion between opposer's PHOENIX marks for closures and liners for bottles and containers and applicant's PHOENIX & design mark for vacuum bottles, thermal food jars and the like]

Presto Products Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1988) [cross motions for summary judgment; opposer's motion granted on ground that likelihood of confusion exists between KID STUFF and KIDWIPES for identical goods, namely moistened towelettes]

Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989) [respondent's motion for summary judgment denied since respondent failed to meet its burden for establishing initially the absence of any genuine

issue of material fact regarding priority and likelihood of confusion between CASTLE marks for casino services and THE CASTLE and TARA and castle design for hotels, motels and associated services]

S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987) [opposer's motion for summary judgment of no likelihood of confusion (on a counterclaim) as between ADRIEN ARPEL for beauty care services and HELENE ARPELS for shoes, belts, clothing, accessories, handbags and retail store services denied for lack of proper support for the motion]

National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212 (TTAB 1990) [likelihood of confusion found in contemporaneous use of SUPER BOWL for entertainment services in the form of an annual championship football game (and related licensed uses of the mark) and SUPER BOWL for greeting cards]

Blue Cross and Blue Shield Ass'n. v. Harvard Community Health Plan Inc., 17 USPQ2d 1075 (TTAB 1990) [likelihood of confusion found in contemporaneous use of BLUE CROSS/BLUE SHIELD (and other marks containing the word BLUE) for health care services and THE CURE FOR THE BLUES for health care services]

PRIORITY

Action Temporary Services, Inc. v. Labor Force, Inc., 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989) [concurrent use proceeding, Board granted senior user's motion for summary judgment; Federal Circuit reversed, holding that a federally registered mark in force at the time of an applicant's adoption of the same or similar mark, but which registration is subsequently canceled, does not prevent the applicant from being a "lawful use[r]" under Section 2(d) of the Lanham Act, subsequent to that cancellation]

Person's Co. v. Christman, 9 USPQ2d 1477 (TTAB 1988), *recon denied*, 10 USPQ2d 1634 (TTAB 1989), *aff'd*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) [respondent's motion for summary judgment on priority granted; respondent's knowledge of use of petitioner's mark outside U.S. commerce did not preclude good faith adoption and use of the identical mark in the U.S. prior to the entry of the foreign petitioner and user into the domestic market]

VO-Toys, Inc. v. Bounce, Inc., 10 USPQ2d 1245 (TTAB 1989), *vacated and remanded*, 889 F.2d 1101, 13 USPQ2d 2033 (Fed. Cir. 1989) (unpublished) [Board erroneously granted summary judgment in petitioner's favor without first determining whether petitioner used its mark in good faith before respondent abandoned its mark]

Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993) [TLRA does not alter ways in which priority can be established — opposer can defeat priority date (constructive use date) established by applicant's intent to use application with prior use that is analogous to trademark use; thus, use analogous to trademark use may be used to establish priority against intent-to-use applicant, even though such use may not have constituted technical trademark use necessary for opposer to file use-based application]

Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992) [since neither party's mark is inherently distinctive, the priority issue to be determined is the priority of acquisition of acquired distinctiveness]

Big Blue Products, Inc. v. Int'l. Business Machines Corp., 19 USPQ2d 1072, (TTAB 1991) [motion for summary judgment on priority issue denied on basis of existence of genuine issue of fact as to when (if at all), before applicant's technical trademark use of BIG BLUE on typewriter ribbons, the relevant public began to associate the applicant's nickname BIG BLUE with typewriter ribbons emanating from applicant]

Interfax Inc. v. SearchCraft Inc., 21 USPQ2d 1553 (TTAB 1991) [plaintiff's evidence establishes its priority of use, even though plaintiff's evidence is marked "confidential" and is subject to protective order, since plaintiff's agreement to consider evidence of its first use as "confidential" does not retroactively convert such first use into activity so confidential and secret as to divest plaintiff of its established rights]

Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc., *supra* [defense based on doctrine of "family of marks" is not available to defendant in Board proceedings]

DESCRIPTIVENESS/DISTINCTIVENESS

The Loglan Institute Inc. v. The Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992) [although genericness is a question of fact, the parties each moved for summary judgment — LOGLAN is generic for a language and equitable defenses are not allowed against a claim of genericness]

The Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) [mark CHABLIS WITH A TWIST is neither geographically deceptive under Section 2(a) nor primarily geographically deceptively misdescriptive under Section 2(e) (2)]

Omnicom Inc. v. Open Systems Inc., 19 USPQ2d 1876 (TTAB 1989) [plaintiff's burden of proving mere descriptiveness is the same whether or not defendant's application/registration included a claim of acquired distinctiveness under Section 2(f)]

Nature's Way Products Inc. v. Nature's Herbs Inc., 9 USPQ2d 2077 (TTAB 1989) [petitioner's motion for summary judgment granted on ground that NATURE'S MEDICINE ("MEDICINE" disclaimed) is descriptive as applied to vitamins and dietary food supplements]

Neapco Inc. v. Dana Corp., 12 USPQ2d 1746 (TTAB 1989) [petitioner's motion for summary judgment denied on issue of descriptiveness and lack of secondary meaning]

ABANDONMENT

Roush Bakery Products Co. v. F. R. Lepage Bakery, Inc., 4 USPQ2d 1401 (TTAB 1987), *aff'd*, 851 F.2d 351, 7 USPQ2d 1395,

vacated and remanded, 863 F.2d 43, 9 USPQ2d 1335 (Fed. Cir. 1988), 13 USPQ2d 1335 (TTAB 1989) [cross motions for summary judgment; petitioner's motion for summary judgment on basis of abandonment due to a transfer of a collective trademark registration to a noncollective organization granted, and affirmed by Federal Circuit, then vacated and remanded by the Federal Circuit; on remand, petitioner's motion granted as to standing and otherwise denied; respondent's cross motion denied]

Person's Co. v. Christman, *supra* [Federal Circuit affirmed Board's grant of respondent's motion for summary judgment of no abandonment where respondent made intermittent sales, with no periods of nonuse long enough to raise presumption of abandonment]

Imperial Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990) [Federal Circuit affirmed Board's grant of petitioner's motion for summary judgment on ground that registered mark, obtained on the basis of a foreign registration, had been abandoned based on nonuse for more than five years and inability of respondent to establish any special circumstances which excused its nonuse]

First National Bank of Omaha v. Autoteller Systems Service Corp., 9 USPQ2d 1740 (TTAB 1988) [respondent's motion for summary judgment (on counterclaim) granted on ground of abandonment of petitioner's pleaded registration; since petitioner abandoned rights in mark, Section 2(d) claim in petition fails]

Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 USPQ2d 1241 (TTAB 1989) [plaintiff's motion for summary judgment on ground of abandonment is denied since defendant's showing is sufficient to demonstrate existence of genuine issues of material fact relative to defendant's intent to resume use]

Oshman's Sporting Goods Inc. v. Highland Import Corp., 16 USPQ2d 1395 (TTAB 1990) [petition dismissed on basis of petitioner's abandonment of mark for shoes due to cessation of imports, selling off remaining inventory with no intent to resume, and subsequent de minimis sales, despite opening of large retail stores under similar mark]

Parfums Nautee Ltd. v. American International Industries, 22 USPQ2d 1306 (TTAB 1992) [due to assignor's abandonment, assignment to respondent was invalid since an abandoned trademark is not capable of assignment — respondent failed to show any constancy of effort in marketing any products under the mark which would constitute persuasive evidence of an intention to resume meaningful commercial use of the mark]

The Procter & Gamble Co. v. Sentry Chemical Co., 22 USPQ2d 1589 (TTAB 1992) [notwithstanding its holding that applicant had stated proper grounds (namely, partial abandonment) for a counterclaim seeking a trade channel restriction, under Section 18 of the Trademark Act, of opposer's pleaded registration of the mark MR. CLEAN, Board entered summary judgment against applicant on the counterclaim, in view of applicant's failure to establish the partial abandonment pleaded in its counterclaim]

Linville v. Rivard, 26 USPQ2d 1508 (TTAB 1993) [once a registration issues on the basis of Section 44, it stands on same footing as any other registration with the registration date being the trigger of the two-year period for commencing use; the terms "use" and "nonuse" in the Act mean use and nonuse in the United States; excusable nonuse not shown and acquisition of third-party rights and reliance on their licensed use does not cure abandonment]

FRAUD

Person's Co. Ltd. v. Christman, *supra* [Federal Circuit affirmed Board's grant of respondent's motion for summary judgment of no fraud where respondent was aware of petitioner's use of mark in Japan, but was unaware of any use by petitioner in U.S. or any intention or plans of petitioner to use mark outside of Japan]

Garri Publication Associates Inc. v. Dabora Inc., 10 USPQ2d 1694 (TTAB 1988) [respondent's motion for summary judgment on fraud claim granted in view of respondent's showing that respondent made use of its mark in interstate commerce prior to the filing of its application]

Neapco Inc. v. Dana Corp., *supra* [respondent's motion for finding no fraud on summary judgment granted]

Mister Leonard Inc. v. Jacques Leonard Couture Inc., 23 USPQ2d 1064 (TTAB 1992) [fraud found where registrant's officer knowingly provided false, material information to counsel for preparation of the Section 8 and 15 affidavit — applicant or registrant is under a duty to correct material, false statements made to the PTO when their falsity becomes known]

Metromedia Steakhouses Inc. v. Pondco II Inc., *supra* [genuine issue of material fact remains regarding whether applicant knowingly made a false statement or that it intended to procure, by means of fraud, a registration to which it realized it was not entitled]

STANDING

Institut National v. Vintners International, *supra* [government agency which acts on behalf of wine producers has associational standing to oppose registration]

Coup v. Vornado, Inc., 9 USPQ2d 1824 (TTAB 1988) [respondent's motion for summary judgment granted on basis that petitioner lacked standing since petitioner did not own the pleaded mark]

Estate of Ladislao Jose Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991) [opposer's estate properly states its standing to oppose registration of the mark BIRO for ball point pens on the grounds that the mark falsely suggests a connection with Biro, under Section 2(a), by allegation that Biro, whose surname is identical to the mark sought to be registered, was the generally acknowledged inventor of the ball point pen]

GROUND S

Century 21 Real Estate Corp. v. Century Life of America, 10 USPQ2d 2034 (TTAB 1989) [request for reconsideration denied; opposer's motion for summary judgment denied because insufficiency of specimens is not a ground for sustaining an opposition]

CONCURRENT USE

Houlihan v. Parliament Import Co., 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990) [concurrent use rights derived from territorial assignment (rather than from good faith adoption in a remote territory) may serve as a basis for concurrent use registration]

Action Temporary Services Inc. v. Labor Force Inc., *supra* [Federal Circuit reverses and remands — Board erred in its conclusion that the constructive notice effects of senior party's canceled federal registration precluded junior user from being a lawful concurrent user of its mark subsequent to that cancellation — canceled registration does not provide constructive notice of anything and cannot prevent a party from being a "lawful user" of a mark when that party's use is subsequent to the cancellation of the federal registration]

DataNational Corp. v. BellSouth Corp.; Ass'n. of N. American Directory Publishers, Reuben H. Donnelley Corp., Donnelley Information Publishing, Inc., U.S. West, Inc., and Christian Publishing & Services, Inc. v. BellSouth Corp.; et al., 18 USPQ2d 1862 (TTAB 1991) [concurrent use applicant denied a concurrent use registration of the "walking fingers" design for classified telephone directories, as a matter of law, in view of the Board's finding that the design is a generic designation in those territories outside the territory claimed by the concurrent use applicant]

Fleming Companies, Inc. v. Thriftway, Inc. v. Certified Grocers of Florida, Inc., 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D.OH. 1992) [concurrent use applicant denied concurrent use registration for territory into which it expanded after constructive and actual notice of another party's concurrent use registration covering that territory and in the absence of an agreement between the parties concerning use of their respective marks in that territory]

APPEALABILITY

Copelands' Enterprises, Inc. v. CNV Inc., 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989) [grant of partial summary judgment by Board, which does not result in disposition of the proceeding, cannot be appealed to the Federal Circuit]

EQUITABLE DEFENSES

Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc., 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992) [applicant which earlier asserted priority rights in mark when opposer first objected to applicant's use of that mark cannot raise defense of laches or equitable estoppel against opposer in a subsequent opposition to applicant's attempt to register a similar mark]

The Loglan Institute Inc. v. The Logical Language Group Inc., supra [equitable defenses are not allowed against a claim of genericness — overriding public interest to rid register of generic marks]

National Cable Television Assn. Inc. v. American Cinema Editors Inc., supra [laches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made — in Board proceedings, the objection is to the rights which flow from registration of the mark, so operative date is the date of publication for opposition in the Official Gazette]

DAK Industries Inc. v. Daiichi Kosho Co. Ltd., 25 USPQ2d 1622 (TTAB 1992) [laches does not begin to run in opposition until mark is published]

S & L Acquisition Co. v. Helene Arpels, Inc., supra [opposer's motion for summary judgment on applicant's counterclaim for cancellation of registration granted on basis of opposer's ownership of an earlier registration (subject to opposer's providing a status and title copy of the pleaded registration)]

Treadwell's Drifters, Inc. v. Marshak, 18 USPQ2d 1318 (TTAB 1990) [equitable defenses found available against a Section 2(a) claim that respondent's mark falsely suggests a connection with cancellation petitioner]

SECTION 44

Clairol Inc. v. Compagnie D'Editions et de Propagande du Journal La Vie Claire Cevic S.A., 24 USPQ2d 1224 (TTAB 1991) [Trademark Law Revision Act requirement that foreign applicants under Section 44 have bona fide intention to use mark in commerce does not apply retroactively, nor did Trademark Act, prior to 1988 enactment of TLRA, contain implicit requirement of bona fide intention to use]

United Rum Merchant's Ltd. v. Distillers Corp. (S.A.), 9 USPQ2d 1481 (TTAB 1988) [summary judgment granted for opposer (subject to proof of standing) on ground that mark as shown in U.S. application did not conform with the appearance of the mark in the Section 44(e) registration]

Marmark Ltd. v. Nutrexpa S.A., 12 USPQ2d 1843 (TTAB 1989) [opposer's motion for summary judgment granted on basis that goods in U.S. application exceeded the scope of the goods set forth in the foreign registration upon which the U.S. application is based]

CLAIM/ISSUE PRECLUSION

Vitaline Corp. v. General Mills, Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989) [Federal Circuit affirmed Board's grant of respondent's motion for summary judgment on basis of claim preclusion; petitioner's claim of abandonment based on same facts as its claim for fraud in prior action between the parties]

MasterCard Int'l v. American Express Co., 14 USPQ2d 1551 (TTAB 1990) [prior district court decision involving same parties finding American Express' mark GOLD CARD generic for charge

card services precluded American Express from relitigating genericness of GOLD CARD for charge card services in opposition proceeding, but did not preclude American Express from litigating the genericness or descriptiveness of GOLD CARD for check cashing services in cancellation proceeding or hotel and motel reservation services in opposition proceeding]

Perma Ceram Enterprises Inc. v. Preco Industries Ltd., supra [applicant now seeking registration under Section 2(f) is not precluded, under issue preclusion, from claiming acquired distinctiveness prior to earlier Board decision holding mark to be deceptively misdescriptive since applicant, in the earlier proceeding, sought registration without resort to Section 2(f) and did not raise acquired distinctiveness as a defense against the claim of deceptive misdescriptiveness — thus, issue of acquired distinctiveness was not raised, litigated and actually determined in earlier proceeding]

Aromatique Inc. v. Lang, 25 USPQ2d 1359 (TTAB 1992) [applicant which abandoned, with prejudice, its prior application to register mark "AromaTies," for personal sachets for men, is equitably estopped from seeking to register substantially identical mark for identical goods, since opposer, in consenting to abandonment with prejudice and accepting dismissal without prejudice of its earlier opposition, had reasonable belief that any right applicant may have had to seek registration of "AromaTies" had been abandoned, and since applicant's subsequent very minor alterations do no rise to level sufficient to create new mark]

Metromedia Steakhouses Inc. v. Pondco II Inc., supra [earlier Board judgment against applicant in opposition proceeding involving word mark RANCH STEAK & SEAFOOD does not preclude applicant from seeking registration of word and design mark RANCH STEAK & SEAFOOD since design elements in second mark make it different from the first mark, and evidence as to likelihood of confusion with the first mark would not be precisely the same evidence with respect to likelihood of confusion with the second mark]

FRCP 56(F) DISCOVERY

Opryland USA Inc. v. The Great American Music Show Inc., supra [party is entitled to discovery under FRCP 56(f) regarding the public perception of the involved marks]

DAK Industries Inc. v. Daiichi Kosho Co. Ltd., supra [applicant not entitled to discovery prior to resolution of opposer's motion for summary judgment on applicant's equitable defenses since facts as to opposer's intent and knowledge prior to opposition have no bearing on whether or not applicant had reason to conclude that opposer's actions demonstrated consent]

Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc., supra [presumed from party's failure to file FRCP 56(f) motion that party did not consider discovery essential to its response]

Orion Group, Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989) [opposer entitled to discovery to enable opposer to respond to applicant's motion for summary judgment]

SECTION 18/INTENT TO USE

Eastman Kodak Co. v. Bell & Howell Document Management Products Co., ___ F.2d ___, 26 USPQ2d 1912 (Fed. Cir. 1993), *aff'g* 23 USPQ2d 1878 (TTAB 1992) [in cases where issue is how will applicant's mark be used and perceived (e.g., mere descriptiveness or model/grade designation), and where applicant has filed an intent-to-use application and no use has yet commenced, question cannot be resolved until use has commenced — opposition dismissed without prejudice to the filing of a petition to cancel the registration issued after a statement of use has been filed]

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993) [absence of documentary evidence regarding applicant's bona fide intention to use its mark in commerce is sufficient to prove that applicant lacks such intention, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence — inferences drawn in favor of each party and factual question of whether applicant's intention is bona fide make issue unsuited to disposition on summary judgment]

The Procter & Gamble Co. v. Sentry Chemical Co., *supra* [TLRA Section 18 — abandonment established if registrant not using mark on goods within scope of goods recited in registration, if registrant has no intention to resume (or commence) use on such goods, and if restriction sought is "commercially significant"]

Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742 (TTAB 1992) [Section 18 request must not only be tied to a specific ground for cancellation, but the request for partial cancellation must be specific so that opposing party has adequate notice of the restriction being sought to the identification of goods as well as fair notice of what limitation, if any, party is willing to accept to the identification of goods]

Aires Systems Corp. v. World Bank Inc., 26 USPQ2d 1926 (TTAB 1993) [where a registration not over five years old has an identification of goods broad enough to encompass goods and/or trade channels in connection with which the registrant has never used its mark, a petition for partial cancellation may seek on the ground of nonuse to restrict the registration to the goods and/or trade channels as to which the registrant has actually used its mark, or to exclude specifically certain goods and/or trade channels as to which there has been no use — petitioner must prove its standing and nonuse, and also that the restriction sought is a commercially significant one]

MISCELLANEOUS ISSUES

Institut National v. Vintners International, *supra* [no mutilation of the mark notwithstanding the omission of geographically descriptive word "California" which appears on the label pursuant to BATF regulations]

Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991) [Board erred in ruling that applied-for mark is unitary (word and design elements are not so merged

together that they cannot be regarded as separate) — questions remain as to whether the descriptive portion of the mark dominates the mark enough to preclude disclaimer and whether the descriptive portion of the mark is sufficiently separate from the rest of the mark to be removable]

Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) [Board erred in ruling that registrant did not intend to deceive by its improper use of trademark registration notice, since factual question of intent is particularly unsuited to disposition on summary judgment, and since registrant's self-serving declarations are insufficient in the context of summary judgment to overcome other evidence regarding deceptive use of trademark registration symbol]

Opryland USA Inc. v. The Great American Music Show Inc., *supra* [costs imposed against party for unwarranted motion for sanctions which required opponent to defend its good faith against vague and unsupported inference of bad faith]

Larry Harmon Pictures Corp. v. Williams Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991) [services of a single location restaurant found to be rendered "in commerce" where record showed that the restaurant drew some of its clientele from out of state and was mentioned by travel writers in newspapers and magazines published in other states]

Octocom Systems, Inc. v. Houston Computer Services, Inc., *supra* [sanctions entered for frivolous appeal on basis that appellant blindly disregarded established precedent and raised arguments with no factual foundation]

Nabisco Brands, Inc. v. Keebler Company, 28 USPQ2d 1237 (TTAB 1993) [a defendant is not required to respond to a plaintiff's motion for summary judgment before the defendant receives from the Board a notification of the institution of the proceeding; FRCP 56(a) providing that a plaintiff's motion for summary judgment may be filed "at any time after the expiration of 20 days from the commencement of the action" is not, under Trademark Rule 2.116, "applicable and appropriate" to opposition proceedings]

United States Olympic Committee v. O.M Bread Inc., 26 USPQ2d 1221 (TTAB 1993) [Board has authority to rule on whether registration sought by applicant is prohibited by Sec. 380(c) of the Amateur Sports Act, and to determine whether mark is encompassed within grandfather provisions of that Act — Board holds that grandfathered rights in OLYMPIC do not extend to OLYMPIC KIDS]

Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992) [motion to dismiss accompanied by matters outside the pleadings — motion treated as one for summary judgment, with parties notified thereof and allowed opportunity to supplement the record]

Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990) [where a petition to cancel a registration is brought on the grounds of likelihood of confusion, prior to the fifth anniversary of that

registration, the subsequent filing of a Section 15 affidavit, without knowledge of the filing of the petition to cancel, does not serve to defeat the claim for cancellation]

Flow Technology, Inc. v. Picciano, 18 USPQ2d 1970 (TTAB 1991) [likelihood of confusion to be determined on the basis of the goods as shown in the opposer's pleaded registration and applicant's application unless applicant's entitlement to a registration for a narrower range of goods has been put in issue either by the pleadings or a motion under Rule 2.133]

Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 24 USPQ2d 1376 (TTAB 1992) [the filing of an answer is not a condition precedent to the requirement that a responding party file a counterclaim when the party is confronted with a motion for summary judgment and becomes aware of the factual basis for a counterclaim which might defeat the motion]

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TTAB Practice Hints from the Practitioner: Survey of Summary Judgment at the Trademark Trial and Appeal Board; 1984 to date, J. Paul Williamson, ABA-PTC Section, Fourth Annual Spring Educational Program, March 29-30, 1989.

Tips from the TTAB: Inter Partes Summary Judgment Revisited, T. Jeffrey Quinn, 76 Trademark Reporter 73 (1986).

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APPENDIX A

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 106 S. Ct. 2505 (1986), *motion denied*, 480 U.S. 903, 107 S. Ct. 1343 (1987)

Andre Oliver, Inc. v. Products Exchange Co., 1 USPQ2d 1817 (TTAB 1986)

Approved Pharmaceutical Corp. v. P. Leiner Nutritional Products, Inc., 5 USPQ 2d 1219 (TTAB 1987)

Avakoff v. Southern Pacific Company, 226 USPQ 435 (Fed. Cir. 1985)

Avon Products, Inc. v. MacCon, Ltd., 225 USPQ 977 (TTAB 1985)

Bausch & Lomb v. Leupold & Stevens, Inc., 1 USPQ2d 1497 (TTAB 1986)

Block Drug Co. v. E.R.N.I. Inc., 37 BNA PTCJ 199, Dec. 22, 1988 ___ USPQ ___ (TTAB 1988)

Bongrain International (American) Corp. v. Delice de France, Inc., 1 USPQ 2d 1775 (Fed. Cir. 1987)

Bongrain International (American) Corp. v. Moquet, Ltd., 230 USPQ 626 (TTAB 1986)

Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985)

Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548 (1986)

Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd., 222 USPQ 187 (Fed. Cir. 1984)

Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984)

Colonial Arms Corp. v. Trulock Firearms, Inc., 5 USPQ 2d (TTAB 1987)

Consolidated Foods Corp. v. Berkshire Handkerchief Co., 229 USPQ 619 (TTAB 1986)

Consolidated Foods Corp. v. Big Red, Inc., 226 USPQ 829 (TTAB 1985)

Consolidated Foods Corp. v. Big Red, Inc., 231 USPQ 744, (TTAB 1986)

Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984)

Coup v. Vornado, Inc., 9 USPQ 2d 1895 (TTAB 1988)

Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985)

- Dresser Industries, Inc. v. Coupling Systems, Inc.*, 206 USPQ 756 (TTAB 1979)
- Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ 2d 1026 (Fed. Cir. 1988)
- First National Bank of Omaha v. Autoteller Systems Service Corp.*, 9 USPQ 2d 1740 (TTAB 1988)
- Gal v. Israel Military Industries of the Ministry of Defense*, 230 USPQ 669 (TTAB) *aff'd*, (Fed. Cir. 1986) (unpublished opinion)
- Gal v. Israeli Military Industries of the Ministry of Defense*, 1 USPQ 2d 1424 (Com'r. Pat. & Tm. 1986), *aff'd*, 824 F.2d 980 (Fed. Cir. 1987)
- Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620 (TTAB 1985)
- Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986)
- Gray v. Dan Bargaintown*, 229 USPQ 474 (TTAB 1986), *aff'd* 3 USPQ 2d 1306 (Fed. Cir. 1987)
- Greyhound Corp. v. Both Worlds, Inc.*, 6 USPQ 2d 1635 (TTAB 1988)
- Hawaiian Host, Inc. v. Rowntree MacKintosh PLC.*, 225 USPQ 628 (TTAB 1985)
- International Order of Job's Daughters v. Lindeburg & Co.*, 220 USPQ 1017, (Fed. Cir. 1984)
- Jeweler's Vigilance Committee, Inc. v. Ullenberg Corp.*, 2 USPQ 2d 2021 (Fed. Cir.) *on remand*, 5 USPQ 2d 1622 (TTAB 1987), *rev'd* 7 USPQ 2d 1628 (Fed. Cir. 1988)
- J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986)
- Keebler Company v. Murray Bakery Products*, 9 USPQ 2d 1736 (Fed. Cir. 1989)
- La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.o.a.*, 8 USPQ 2d 1143 (TTAB 1988)
- Levi Straus & Co. v. Genesco, Inc.*, 222 USPQ 939 (Fed. Cir. 1984)
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- Nestle Co. v. Grenadier Chocolate Co.*, 212 USPQ 214 (TTAB 1981)
- Nestle Co. v. Jovva Corp.*, 227 USPQ 477 (TTAB 1985)
- New York Times Co. v. Sullivan*, 376 U.S. 254, 84 S. Ct. 710, (1964)
- NutraSweet Co. v. K & S Foods, Inc.*, 4 USPQ 2d 1964 (TTAB 1987)
- Parker Bros. v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984), *appeal dismissed*, 226 USPQ 11 (Fed. Cir. 1985)
- Pegasus Petroleum Corp. v. Mobile Oil Corp.*, 227 USPQ 1040 (TTAB 1985)
- Person's Co. v. Christman*, 9 USPQ 2d 1477 (TTAB 1988)
- Phoenix Closures, Inc. v. Yen Shaing Corp. Ltd.*, 9 USPQ 2d 1891 (TTAB 1988)
- Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ 2d 1895 (TTAB 1988)
- Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 USPQ 741 (Fed. Cir. 1984)
- Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718 (TTAB 1985)
- Roush Bakery Products Co. v. F.R. Lepace Bakery, Inc.*, 4 USPQ 2d 1401 (TTAB 1987), *aff'd* 7 USPQ 2d 1395, *vacated and remanded* 9 USPQ 2d 1335 (Fed. Cir. 1988)
- S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ 2d 1221 (TTAB 1987)
- Sweats Fashions Inc. v. Pannill Kniggint Co.*, 4 USPQ 2d 1793 (Fed. Cir. 1987)
- Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412 (TTAB 1986)
- Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986)
- Torres v. Cantine Torresella S.r.l.*, 1 USPQ 2d 1483 (Fed. Cir. 1986)
- United Rum Merchants Ltd. v. Distiller's Corp. (S.A.) Ltd.*, 9 USPQ 2d 1481 (TTAB 1988)
- U.S. Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340 (TTAB 1984)
- Von Schorlemer v. Schorlemer Weinkelleri GmbH*, 5 USPQ 2d 1376 (TTAB 1986)
- Walden Book Co. v. B. Dalton Co.*, 4 USPQ 2d 1414 (TTAB 1987)

CONFERENCE ADDRESSES MADRID PROTOCOL ISSUES

On April 7th and 8th, the second annual conference on International Intellectual Property Law and Policy was held at the Fordham University School of Law. The conference was well attended and addressed many of the current issues in the area such as EEC harmonization of intellectual property and international computer software protection.

One of the more interesting "break-out" sessions dealt with the pros and cons of the Madrid Protocol. Basically, the Madrid Protocol allows for registration of a trademark in multiple countries by filing one international registration with the World Intellectual Property Organization (WIPO). The panelists for the session expressed a variety of views on whether the Protocol would benefit U.S. trademark owners. However, with congressional approval all but assured and full U.S. participation expected by February 1996, the panelists all agreed that, for better or worse, the Madrid Protocol will be a reality.

The panelists included Dr. Ludwig Baeumer from WIPO; James T. Walsh from the U.S. Patent and Trademark Office; Dr. Ian Jay Kaufman from Ladas & Parry; Albert Robin from Robin, Blecker, Daley & Driscoll and Virginia Richard from Kane, Dalsimer et al. The moderator was Susan Proffoff from Fish & Neave. ■

NYIPLA AND PTIC CO-SPONSOR PROGRAM ON NAFTA

This Columbus Day weekend escape to the picturesque surroundings of The

Sagamore resort on Lake George in upstate New York for a joint program of The New York Intellectual Property Law Association and the Patent and Trademark Institute of Canada. The program will kick off with the annual meeting of the Patent and Trademark Institute of Canada which will run from October 5-7, 1994. On Saturday, October 8, the NYIPLA and PTIC will co-sponsor a program on NAFTA. A diverse group of experienced representatives from business, government and the law will debate and discuss the intellectual property aspects of NAFTA as well as its overall trade implications. The program will conclude on Sunday, October 9 with the NYIPLA's annual fall CLE program. Participants from the respective associations will be able to attend programs of the other association, as well as the joint program on NAFTA.

Further information on the program and registration details will be contained in a future issue of the *Bulletin*, or can be obtained from Brian Slater of Fitzpatrick, Cella, Harper & Scinto, (212) 758-2400. ■

RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

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The Supreme Court recently held, in a unanimous opinion, that the commercial nature of the 2 Live Crew rap parody of Roy Orbison's "Oh, Pretty Woman" did not make it presumptively unfair. *Campbell v. Acuff-Rose Music, Inc.*, 29 USPQ2d 1961 (U.S. Sup Ct. 1994). Though the Court remanded for a reevaluation on the music taken by 2 Live Crew, it was satisfied that the lyrics of the parody song were fair use. Justice Kennedy wrote a concurring opinion which would have placed limits on the proper use of parodies.

2 Live Crew initially sought a license from the owner of the copyright to Roy Orbison's "Oh, Pretty Woman," Acuff-

Rose Music, Inc. and was denied. Acuff-Rose then sued Luther Campbell and others (2 Live Crew) for copyright infringement. 2 Live Crew was granted summary judgment in the Tennessee district court that the rap song was a fair use parody of the original song. See *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp 1150, 18 USPQ2d 1114 (M.D. Tenn. 1991). The Sixth Circuit, however, citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 17 (1984), reversed the summary judgment ruling that the commercial nature of 2 Live Crew's rap version outweighed parody aspects of the song.

Justice David Souter wrote the unanimous decision for the Supreme Court and found that the Sixth Circuit's ruling must be reversed and remanded. Souter wrote that there must be some opportunity for fair use of copyrighted materials in order to promote the sciences and the useful arts. The primary factors of a fair use under §107 of the copyright laws are the purpose and character of the use. This purpose and character include whether the use is commercial or not. Central to this inquiry is the determination of whether the use of the copyrighted work adds something new, i.e., expression, meaning or message, or merely supersedes the original work. In other words, the question is whether or not the new use is "transformative." Thus, the more transformative a new use is, the less emphasis that is applied to other factors such as the commercial nature of the new use.

Souter's decision discussed several aspects of parody. If the parody merely used the original work as a vehicle to comment on other than that work, the claim to fair use diminishes. A reasonable perception that the work is indeed a parody is also a factor to be considered. The Court made it clear that the commercial nature of a parody is only one of many factors to be considered in determining fair use. If the commercial nature was presumptively not fair, this would tend to overwhelm the other factors. Also, "the amount and substantiality of the portion used in relating to the copyrighted work as a whole" needs to be reasonable as to the purpose of the copying. It was important to the Court that the parody "departed markedly" from the original, in regard to the lyrics of the song. However, as to the music, the Court did not offer an opinion, and remanded for a reevaluation.

The final factor that the Court focused on was the effect of the use upon the potential market for or value of the copyrighted work. This factor takes into account the market harm for the original and the derivative work.

TRADEMARKS

In *Shakespeare Co. v. Silstar Corp. of America Inc.*, 28 USPQ2d 1765 (4th Cir. 1993), the Court of Appeals for the Fourth Circuit held that the power of a district court to cancel a trademark registration under §1119 of the Lanham Act does not apply to incontestable marks found to be functional. The court, in a case of first impression, cited the Supreme Court's decision in *Park 'N' Fly* for the proposition that the district court's power of cancellation under § 1119 is limited to the grounds set forth in § 1064. §1064 does not include functionality.

Shakespeare Co. is the manufacturer of fishing rods which it produces under the moniker "Ugly Stik." This line of fishing rods was introduced in 1976. The composition of the "Ugly Stiks" gives them a clear tip and makes them light weight and quite strong because of the type of fiberglass used. The "Ugly Stik" is a superior fishing rod because of this composition. Shakespeare obtained a trademark registration for its clear tip rod in 1983. The mark became incontestable in 1989. Silstar Corp. introduced its own line of fishing rods in 1990 featuring a color combination and clear fiberglass section making it similar to the Shakespeare fishing rods. In the infringement suit filed by Shakespeare under §43 of the Lanham Act, the district court granted a preliminary injunction for Shakespeare, but later found the clear tip of its rods to be functional because the very appearance of the fishing rods communicates to the consumer that it is composed of fiberglass, and that the clear tip is not a designator of origin.

A trademark becomes incontestable five (5) years after it is registered on the principal register. Incontestability is conclusive evidence of the mark's validity and ownership subject to certain defenses such as laches, estoppel and acquiescence. In this case, Silstar sought cancellation of Shakespeare's marks in its responsive pleading under §1119, which empowers a

district court to cancel registrations. Normally, when cancellation of a mark is sought through the TTAB, it is limited to §§ 1064 and 1115. The question raised by this case is whether the district court is held to the same limitations as the TTAB.

The Fourth Circuit interpreted the Supreme Court's *Park 'N' Fly* decision as holding that the Lanham Act imposes limitations on a district court in canceling a trademark. Therefore, since functionality is not one of the grounds set forth for cancellation in the Lanham Act, it may not be used as the sole basis for cancellation by a district court of a mark which has been registered for over five years.

Judge Niemeyer of the Fourth Circuit dissented to the majority opinion on the grounds that this case dealt with more than the mere cancellation of a mark. It ultimately dealt with the underlying issue of whether an enforceable trademark exists at all. Judge Niemeyer felt that functionality was a concept which must be employed notwithstanding the Lanham Act in that functionality "is a public policy trump card that may be played against an otherwise valid trademark, not an element to be considered in determining a mark's validity."

PATENTS

In *Fairchild Semiconductor Corp. v. Nintendo Co.*, DC Wash, No. C92-1971 2/14/94, the District Court for the Western District of Washington held that the presence of structural limitations in claims directed to "locking means" and "connector means" did not prevent them from being construed as means-plus-function claims, pursuant to Title 35 U.S.C. § 112 para. 6. The court granted summary judgment to Nintendo on the rationale that it was not possible to understand the structure embodied in the claim without understanding the function which it performed.

Fairchild Semiconductor Corp. is the owner of a patent which allows users to program a computer chip to play the games they choose, rather than playing only those games which are built into the machine. Fairchild filed suit against Nintendo for infringement of a claim to their patent which included a console with a "connector means," a "chute means including a locking means" to hold the cartridge in place and "a plurality of parameter selection

switches" which control the signals. Fairchild argued that the elements in their patent which were referred to as "locking means" and "connector means" should be construed as structural means. Fairchild wished to avoid a construction of their claims under §112 para. 6 and thereby be limited in the scope of their claims to the structure recited in the specification or its equivalent. Judge Coughenour did not buy into Fairchild's argument and pointed out that the claims were not ambiguous and though a "means" must not always refer to a function, in this case, the function was necessary to understand the structure. The fact that the means employed in the claim to the patent do indeed contain structural limitations does not preclude them from being interpreted as means-plus-function under §112 para. 6.

The court then went on in its analysis of the infringement of the claims as means-plus-function. A literal infringement of a means-plus-function claim requires that it perform the exact same function of the claim. In this regard, Judge Coughenour found that the Nintendo system performed an identical function. Literal infringement of a means-plus-function claim also requires that the accused device perform the claimed function with a structure that is identical to or equivalent to that described in the specification of the patent. In this regard, the court found that Nintendo's system was not identical to or equivalent to the structure of the patent. Finally, the court analyzed the infringement of Fairchild's patent under the doctrine of equivalents. In this regard, the court found that the Nintendo system operated in a different way from the locking means of the claim of the patent. Further to this, the court invoked the doctrine of prosecution history estoppel. During the prosecution of the patent, Fairchild had argued that the patented connector required zero or low friction for its cartridge assembly that locks into place using a spring device. Thus, since the Nintendo connector used a high friction edge card connector that is not locked into place, there was no infringement.

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