

Lackebach Siegel, LLP *today!*

INTELLECTUAL PROPERTY ATTORNEYS SINCE 1923

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PATENT CORNER

Featuring a patent recently issued to a Lackebach Siegel client

United States Patent Number:

6,965,814

POOL CLEANING APPARATUS

A system for determining the effectiveness of the filtering and maneuverability of a robot for cleaning swimming pools, the robot includes a robot propelling motor, at least one water pump having an impeller and an impeller motor, a pool water inlet leading to a filter, a filtered water outlet, and a propelling mechanism for propelling the robot along the floor and/or walls of the swimming pool, the system comprising a computer for determining and setting an initial power to be supplied to the impeller motor, a first circuit for sensing the actual power supplied to the impeller motor during its operation, a second circuit for calculating the ratio between the set power and an instantaneous power supplied to said impeller motor, and a producer connected to the second circuit for producing an indication signal when the ratio exceeds a predetermined value. A controller for controlling the at least one impeller motor in consideration of the ratio; and a sensor for sensing the inclination of the floor and/or wall on which the robot is propelled are also provided.

See drawing on page 6

The More I.P. the Merrier!

By Howard N. Aronson

Many products and concepts may be protected by more than one type of intellectual property (I.P.) protection: combinations of patent (including design, utility, and plant), trade secret, trademark (including trade dress), mask work, and copyright may apply. A computer software product, for example, might be protected by both copyright and a business method patent, while a conventional electronic device (such as a telephone or television) might be protected by design and utility patents as well as by a mask work registration and trademark registration. Although some products or concepts can embody more than one type of I.P., in some instances a choice between types of protection must be made, with the big picture goal usually governing the ultimate decision.

Trade secret protection for a manufacturing process would be lost if the process were the subject of a utility patent. And design patent protection for a popcorn popping machine would be lost if the ornamental appearance had functional characteristics that were protected by a utility patent.

Patents, trade secrets, trademarks, mask works and copyrights can each be owned, sold, licensed, secured as collateral and enforced in our courts. While rights that are developed from the brain – intellectual property – often grouped together, each is different and is acquired and enforced in a unique manner.

PATENTS are designed to protect that which is novel, non-obvious and useful, and include:

- > Utility patents for the technical or functional aspects of compositions of matter, chemical, electrical and mechanical devices, processes to manufacture all of such, business methods, living organisms, and many other technologies that are novel and unobvious to one skilled in the relevant art.

- > Design patents for the ornamental appearance of articles of manufacture. Function is not an aspect of this type of property; only the appearance of an item is protected from emulation.

- > Plant patents for the asexually reproduced and distinct new variety of plant, cultivated mutants, hybrids and newly found seedlings other than a

Continued on Page 3: The More I.P. the Merrier!

Attorney Profile

Position at Firm: Senior Patent Counsel



Andrew F. Young

Patent Department

As senior patent counsel, Mr. Young has primary responsibility for acquisition, exploitation, management and enforcement of patents on behalf of firm clients. His experience includes intellectual property licensing, confidentiality management, patent opinion memoranda, patent portfolio management and preservation of technology for a wide variety of clients. Mr. Young has counseled clients from initial incubation through all phases of venture funding and growth, during public offering and fundings, to full-scale production.

Continued on Page 8: Attorney Profile

Lackenbach Siegel *today* and Since 1923

More Control of Junk Faxes

By Cathy E. Shore-Sirotnin

The Federal Communications Commission's ("the FCC") Junk Fax Prevention Act of 2005 (the "Act") became effective on August 1, 2006. The Act amends the FCC's prior rules governing facsimile advertising. The Act prohibits the use of a telephone facsimile machine, computer or other device to send an unsolicited advertisement to a telephone facsimile machine unless:

(1) The unsolicited advertisement is from a sender with an established business relationship with the recipient;

(2) The sender obtains the fax number directly from the recipient or ensures that the recipient voluntarily agreed to make the number available for public distribution; and

(3) The advertisement contains clear and conspicuous notice and contact information (meaning the telephone and facsimile number) on the first page of the fax that allows the recipient to "opt-out" of future unsolicited fax transmissions from the sender, including at least one cost-free mechanism (e.g., a website or email address, if neither the telephone number nor fax number is toll-free).

The Act defines key terms as follows:

> **Established business relationship** - "a prior or existing relationship formed by a voluntary two-way communication between a person or entity and a business or residential subscriber . . . on the basis of an inquiry, application, purchase or transaction by the business or residential subscriber regarding products or services offered by such person or entity, which relationship has not been previously terminated by either party;"

> **Unsolicited advertisement** - "any material advertising the commercial availability or quality of any property, goods, or services which is transmitted to any person without the person's prior express invitation or permission, in writing or otherwise;" and

> **Clear and conspicuous notice** - "a notice that would be apparent to the reasonably consumer, separate and distinguishable from the advertising copy or other disclosures, and placed at either the top or bottom of the facsimile."

The notice mechanisms must permit opt-out requests 24 hours a day, 7 days a week. A sender must honor opt-out requests within the shortest reasonable period of time, not to exceed thirty days. Notably, small businesses and nonprofit trade associations are not exempted from the requirements of the Act.

Did You Know?

Unsolicited fax transmissions must have an Opt-Out telephone number, facsimile number, website address or e-mail address identified in the sender's facsimile advertisement.

An opt-out request not to send future unsolicited advertisements to a facsimile machine only complies with the requirements of the Act if: the request identifies the telephone number(s) of the telephone facsimile machine(s) to which the request relates; and the request is made to the telephone number, facsimile number, website address or e-mail address identified in

the sender's facsimile advertisement.

Interestingly, in addition to the originator or sender of the unsolicited fax, a "facsimile broadcaster" may also be liable for a violation of the Act if it demonstrates a high degree of involvement in, or actual notice of, the unlawful activity and fails to take steps to prevent such facsimile transmissions. A "facsimile broadcaster" is a person or entity that transmits messages to telephone facsimile machines on behalf of another person or entity for a fee.

Unfortunately for those receiving unwanted faxes, like other FCC Acts, there is no private cause of action for violation of the Junk Fax Prevention Act. However, one certainly can file a complaint with the FCC, or a state or local agency, such as the State Attorney General, or the local Better Business Bureau.

To learn more about Junk Faxes, contact: Cathy E. Shore-Sirotnin, CShore@Lackenbach.com

MORE TRANSLATIONS...

A ROSE, is a ROSA, is a BARA, is a MEI KUEI? By Nancy Dwyer Chapman

The Trademark Trial and Appeal Board has issued several opinions on trademark controversies involving the "doctrine of foreign equivalents" in the past few years, and it has continued to refine its interpretation of how foreign wording and their translations into English are evaluated for confusing similarity and ability to register.

The doctrine of foreign equivalents mandates that "foreign words from common languages" be translated into English in a trademark application in order that the Examiner can make a determination whether the English meaning might be confusingly similar to a prior registration or earlier-filed application, or whether that meaning could be descriptive or even generic. "The doctrine is applied when it is likely that the ordinary American purchaser would stop and translate [the word(s)] into its English equivalent." If it is not likely that the American buyer would recognize the designation as a foreign word or translate the word, then the doctrine of foreign equivalents is not applied. The key determinant is whether the meaning is well known to an American buyer who is knowledgeable in the foreign language: would that person see the foreign word and conjure up the English equivalent?

For example: BUENOS DIAS for soap was found to be confusingly similar to GOOD MORNING for shaving cream, and SONOP (Afrikaans for "SUNRISE") for wines, distilled spirits and liquors was held likely to cause confusion with the registered mark SUNRISE for wine.

But, VEUVE ROYALE was recently held not confusingly similar to THE WIDOW because "an appreciable number of purchasers are unlikely to be aware that VEUVE means "widow" and are unlikely to translate the mark into English;" HERE & THERE for fashion consulting services was found not confusingly similar to DECI DELA (translated as "here and there") for fragrances; TIA MARIA for Mexican restaurants was held not confusingly similar to AUNT MARY'S for canned vegetables; OUDE MEESTER (Afrikaans for "Old Master") for cigars was found not likely to be confused with DUTCH MASTER for cigars; and GORDON BLEU for edible shelled nuts was determined not confusingly similar to BLUE RIBBON for shelled and unshelled edible nuts.

Continued on Page 3

Patents, Trademarks, Copyrights

The More I.P. the Merrier! continued from cover...

Continued From Page 1

tuber-propagated plant or a plant found in an uncultivated state.

TRADE SECRETS preserve and protect a competitive advantage achieved by a business based upon confidential knowledge. A trade secret is a property right that can exist in perpetuity, separate from patent rights. Manufacturing and technical secrets, formulations, recipes, confidential process information and compilation such as customer lists, manufacturing resources, unpublished computer code and the like are all potential trade secret materials.

TRADEMARKS (including service marks) are designed to identify the origin and source of goods for the ultimate benefit of consumers, to assure consistency of quality for repeat purchases, and to serve as an advertisement by which a manufacturer can bypass individual retailers to reach consumers directly.

The trademark laws are designed, in part, to protect the marketer who owns the trademark, but the overriding concern has always been to protect the purchasing public from confusing the product it desires to purchase with a similar product from a different source.

TRADE DRESS is a species of trademark rights, covers the overall appearance of a product, such as packaging or containers, but can be as wide-ranging as the appearance of restaurant interiors and golf-course holes. The law makes virtually no distinction between trademark and trade dress.

COPYRIGHTS are a long duration monopoly for works of artistic endeavor, including musical, literary, pictorial, graphic and architectural works, and encompasses not only books, graphics, movies, music, and sculptures, but also technical works such as computer source code, building designs, and architectural drawings. The subject matter of a copyright must be in a fixed or tangible form.

MASK WORKS are integrated electronic circuits, better known as semiconductor circuits in chip form. Every semiconductor and integrated circuit includes some form of a series of functional images or patterns controlling the circuit's electronic operation. These images and patterns are broadly referred to as "mask works," a name derived from their manufacturing process

The Need for Different Types of Protection

A competitor may monitor the marketplace for the products of others, wait to see which ones prove successful, then enter the marketplace with an exact copy and ride the success of the seminal version – all with impunity in the name of competition and the overriding public good. One federal judge lamented:

While I feel obliged to . . . dismiss this claim [copying a design], I do so with reluctance, because of the devious conduct of defendant to get a 'free ride' based upon plaintiff's efforts to develop a market for its product. But this inequity is overbalanced by the preference of the [trademark laws] to encourage competitors, even slavish copiers, for the greater public good.

Continued on Page 10

MORE TRANSLATIONS, continued from page 2...

Even if there is similarity of meaning, that identity may well be overshadowed by differences in sight and sound. "[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source." Applying this realistic approach to the use of foreign language terms in trademarks, the Trademark Trial and Appeal Board has also found LABONTE for cheese (translated from French as "the goodness") and GOOD-NESS for cheese were not confusingly similar, and HI-FASHION SAMPLER for fingernail polish and HAUTE MODE for hair coloring shampoo likewise not confusingly similar.

- If the meaning is not identical, the doctrine of foreign equivalents probably does not apply, e.g., OUDE MEESTER versus DUTCH MASTER for cigars where the goods were identical, but the meanings and the overall impressions were sufficiently different to avoid confusion.

- If the goods/services are not identical, those differences might be enough to overcome a likelihood of confusion rejection, e.g., TIA MARIA for restaurants versus AUNT MARY'S for canned vegetables, good and services sufficiently dissimilar.

- Differences in the appearances and sounds of each mark can outweigh the similarities in meaning, especially if the marks feature dissimilar fonts, designs or letter types, e.g., HERE & THERE and DECI DELA look and sound completely unlike.

Recommendations: If the trademark you seek to be registered is comprised of or contains non-English words, provide us with the English translation. You should also provide us that information when you order an availability search, since those pre-application filing searches can spot potential doctrine of foreign equivalent problems. Lackenbach Siegel trademark attorneys determine whether a rose by any other name might or might not become a case of confusing similarity.

For a list of citations for the decisions discussed above, or to discuss translations, please contact: Nancy D. Chapman, Chapman@Lackenbach.com

More Counterfeits Caught!

FAKES CAUSE THE LOSS OF MILLIONS OF JOBS AND COMPROMISE INTERNATIONAL SECURITY

More Fakes - Try Customs

By Renée L. Duff

As the economy has become increasingly more global, the size and scope of product counterfeiting has skyrocketed. No longer limited to fake Gucci bags and knock-off Rolex watches sold on street corners in big cities, the International Chamber of Commerce estimates that seven percent of the world trade is in counterfeit goods and that the counterfeit market is worth \$350 billion.

The International Anti-Counterfeiting Coalition reports that the actions of counterfeiters make it more difficult for legitimate retailers to compete in the marketplace – and honest intellectual property owners are forced to cut back work forces because of decreased sales. The result is the loss of millions of dollars in tax revenues to governments, as well as tens of thousands of legitimate jobs, all due to the manufacture, distribution and sale of counterfeit goods.

Additionally, and indeed most alarmingly, the United States Congress has recognized organized crime's increasing role in the theft of intellectual property, and there have been reported links between counterfeiting and piracy and terrorist organizations that use the sale of fake and unauthorized goods to raise funds and launder money.

In response to this escalating trend and in an effort to help intellectual property owners fight back, U.S. Customs and Border Protection (“Customs”) has made protection of intellectual property rights (trademarks, copyrights, etc.) a priority. An aggressive Intellectual Property Rights enforcement program has been implemented by Customs, which devotes substantial resources to target, intercept, detain, seize and forfeit shipments of goods that violate

the rights of intellectual property holders. Enforcement is accomplished through the cooperative efforts of Customs’ trained enforcement officers, other government agencies, and the trade community itself.

Customs has the authority to exclude the importation of articles that violate a trademark, copyright or trade name. An intellectual property rights owner is therefore protected without having to sue in a civil court for infringement, with the attendant costs and delays. Shipments are monitored to prevent the importation of counterfeit articles based on registered trademarks and copyrights that are registered with Customs. As only a percentage of all goods entering the country can be visually inspected by Customs, certain “red flags” exist that may indicate a potential problem and prompt Customs to take action on behalf of a registered rights holder:

- **Merchandise is missing lot numbers, factory codes, expiration dates, dates of manufacture or other national requirements**
- **Shipments are described in vague or unusual terms, such as articles of plastic, metal discs, samples, parts, molds, dies, etc.**
- **Merchandise is imported from a country not identified by the rights holder as a country where genuine goods are manufactured**
- **Profiles indicate that specific exporters known to have produced counterfeit merchandise in the past are vendors for the importer**

By utilizing Customs’ “Recordation Program,” protection of intellectual property rights at the U.S. border can be achieved. “Recordation” refers to the process by which information about specific registered trademarks, copyrights, or trade names, as well as photographs of genuine merchandise, is collected and entered into an electronic database accessible by Customs officers across the country. Customs uses

this recordation information to actively monitor shipments and attempts to prevent the importation of counterfeit goods. There are currently about 20,000 recordations of intellectual property rights with Customs.

During 2005 the value of intellectual property rights based seizures was in excess of \$93 million dollars, and a typical day saw an average of \$329,119 worth of fraudulent commercial merchandise seized at ports of entry. In 2004, a record year, over \$138,000 million dollars of goods were seized due to intellectual property recordations. But in 2005, U.S. Customs made over 8,000 seizures, a 10% increase over 2004, reflecting increased concern for intellectual property rights.

Wearing apparel and handbags represented about one-third of all goods seized in 2005 at our border, while footwear represents 10%, consumer electronics 10% and toys/electronic games about 9% of total seizures. Pharmaceuticals were only 2% of such seizures.

Acts of piracy defrauds consumers, constitutes unfair competition to legitimate businesses, causes economic harm, and can pose a danger to public health and safety. Counterfeiters illegally profit at the expense of creators, manufacturers, distributors and retailers, as well as governments. Given that obtaining Customs protection is a relatively simple and inexpensive process with a vast scope of potential benefits to intellectual property rights holders, consider implementing a Customs Recordation Program for your company’s intellectual property assets and take an active role in preventing intellectual property theft.

To discuss your Customs recordation plans, please contact: Renée L. Duff, RDuff@Lackebach.com

More Truth...

EFFECTIVE EXCULPATORY OPINION PREPARATION

More Patent Opinions

By Andrew F. Young

Once a maker, user or seller of a product has actual notice that his activities may constitute patent infringement, an affirmative duty of care exists to investigate it and form a good faith belief regarding the merits. Such review often extends to infringement, patent validity, file wrapper estoppel and related inquiries. Actual notice may take many forms, including receipt of cease and desist correspondence or a patent-issuance notice from a potential licensor, or it may be the result of a due-diligence search.

Once actual notice exists from any source, and infringement is deemed to be doubtful, the effective preparation of an exculpatory non-infringement legal opinion is often recommended as a defense to “willful” infringement allegations in the event of litigation. When an infringement is “willful” the infringer is exposed to potentially crippling damages and attorneys fees – all within the discretion of the court. The appellate court in *Exxon Chemical Patents Inc. v. The Lubrizol Corp.*, upheld the award of \$48 million dollars in enhanced damages, on top of the actual damages, based on finding willful infringement and bad faith.

Willfulness determinations are based on the “totality of the circumstances” under a reasonable prudent person standard. An exculpatory infringement opinion may serve as an effective and judicially respected shield to enhanced damages, but it is subjected to intense scrutiny. When employed as shield, a confidential opinion will become public as will the materials and efforts employed to craft the opinion.

Recently (June 2006), the Court of Appeals for the Federal Circuit found a flaw with an exculpatory legal opinion based on a factual deficiency provided to patent counsel (*Liquid Dynamics Corp. v. Vaughan Co.*). The flaw was the defendant’s failure to present its patent counsel with a complete set of “vertical vector plots of fluid flow” despite the provision of a partial set. Plaintiff argued that, “the jury could disregard [Defendant’s] reliance on counsel’s opinion of non-infringement...” due to the simple omission of some technical data being provided to counsel. The appellate court found that such “concealed” data could be sufficient to allow the jury to discount the opinion.

As a finding of “willful infringement is made after considering the totality of the circumstances...the evidence is weighed and evaluated by the trier of fact.” The courts consider several factors when determining whether an infringer acted in bad faith and whether damages should be increased, such as, if the infringer investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed.” Good faith may normally be shown by obtaining the advice of legal counsel as to infringement or patent validity. But when counsel’s opinion is found to be based on incomplete facts or available data, a fact finder may discount its usefulness in determining a party’s good faith.

In connection with an exculpatory non-infringement opinion, consider:

- Designating a single corporate nexus for all information regarding the opinion – preferably an officer with both technological and legal experience. Where the corporate nexus is not technically capable, a competent technical liaison must be designated to support that role.
- Conducting a comprehensive pre-opinion investigation to gather and identify all the necessary information, including: facts and information involving the actual manufacture, sale, use, or importation of the accused product; the complete prosecution history for the patent in question, both domestic and foreign, prior art documents and information concerning both the accused device and the patent, prior oral or partial opinions.
- Conducting one or more prior art searches for validity purposes.
- Selecting patent counsel not intended to function as trial counsel or as a fact witness.

*To learn more about Patent Infringement Opinions and Patents in general, please contact:
Andrew F. Young, AYoung@Lackebach.com*

Patents, Trademarks, Copyrights

PATENT CORNER

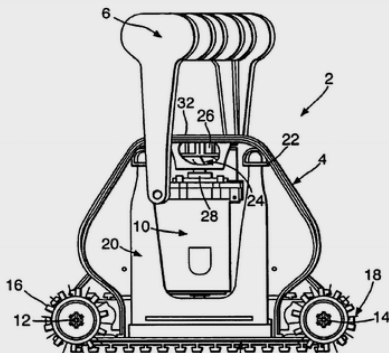
POOL CLEANING APPARATUS

United States Patent Number:

6,965,814

Date of Patent
November 15, 2005

Assignee:
Maytronics Ltd. (IL)



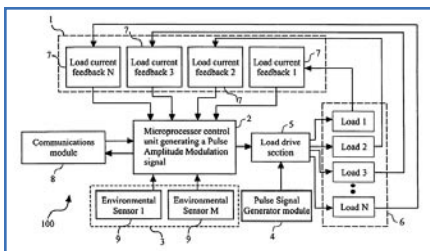
Notable, recent LS Patents

DEVICE FOR STOPPERING A CONTAINER AND DRAWING OFF A FLUID PRODUCT

Patent No.: 7,077,294
Assignee: Bericap (FR)

ILLUMINATION CONTROL SYSTEM

Patent No.: 6,963,175
Assignee: Radiant Research Limited (GB)

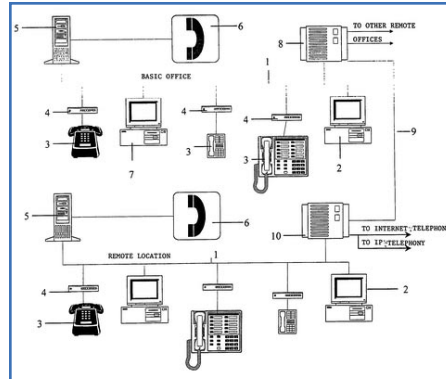


METHOD AND CIRCUITRY FOR HIGH POWER AMPLIFIERS WITH VOLTAGE CONVERSION TO AVOID PERFORMANCE DEGRADATIO, SYSTEM SHUTDOWN AND PERMANENT DAMAGE IN CASE OF WORST CASE DATA PATTERN

Patent No.: 7,046,973
Assignee: Nokia Corporation (FI)

TELEPHONE NETWORK FOR A STRUCTURED ITEM AND TELEPHONE COMMUNICATION SYSTEM BETWEEN REMOTE STRUCTURED ITEMS USING THIS NETWORK

Patent No.: 6,973,169
Inventor: Aleksandr Fyedorovich Lukin (RU)



COMPLIANT SURFACE MOUNT ELECTRICAL CONTACTS FOR CIRCUIT BOARDS AND METHOD OF MAKING AND USING SAME

Patent No.: 6,997,727
Assignee: Zierick Manufacturing Corp. (USA)

ONE BOTTLE TOTE APPARATUS

Patent No.: D513,363
Assignee: Built NY, inc. (USA)

VICTORIA CUT JEWEL

Patent No.: D514,013
Assignee: Gitanjali Gem Limited (IN)

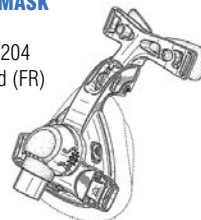


CONNECTOR ADAPTER WITH MEMORY FUNCTION UNIT

Patent No.: 6,971,895
Assignees: Tokyo Communication Equipment MFG co., Ltd. (JP)
NTT DoCoMo Inc. (JP)

FRONT FACE PORTION OF MASK ASSEMBLY

Patent No.: D515,204
Assignee: ResMed (FR)



ROASTING APPARATUS

Patent No.: 6,952,991
Assignee: Lifetime Hoan Corporation (USA)

SHOE SOCK

Patent No.: D513,358
Assignee: Aerogroup International Inc. (USA)

SWAY BAR BUSHING

Patent No.: 6,971,640
Assignee: Research and Manufacturing Corp. of America (USA)

SYNCHRONIZED FLASHING LIGHTING DEVICE

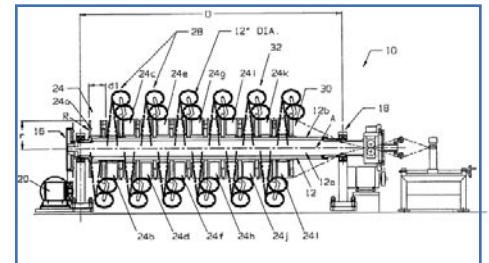
Patent No.: 6,997,591
Assignee: World Imports International, Inc. (USA)

BRAIDER

Patent No.: 7,011,097
Assignee: Each2Each, Inc. (USA)

COMPACT UNIVERSAL CONCENTRIC STRANDER WITH TAKE-OFF SHEAVES MOUNTED ON STRANDER SHAFT

Patent No.: 6,948,304
Assignee: Roteq Machinery Inc. (USA)



DESK LAMP

Patent No.: D522,158
Assignee: Yamagiwa Corporation (JP)

UNIVERSAL CONTAINER FOR CHEMICAL TRANSPORTATION

Patent No.: D510,872
Assignee: PVC Container Corporation (USA)

WASHBASIN FOR BATHROOMS

Patent No.: D513,794
Assignee: Sonia, S.A. (ES)

TOWEL RAIL FOR BATHROOM

Patent No.: D516,849
Assignee: Ibergesfer, S.L. (ES)

SNAP TOP TOTE APPARATUS

Patent No.: D514,803
Assignee: Built NY, Inc. (USA)

SIDE ELEMENT OF A SHOE UPPER

Patent No.: D508,306
Assignee: Aerogroup International, Inc. (USA)

RECEIVER HAVING A PRESET TUNER

Patent No.: 7,080,393
Assignee: Funai Electric Co., Ltd. (JP)

Continued on Page 8

Domain Names, Internet and Ad Law

TRADEMARK CORNER

Notable, recent LS Trademarks

DVF

Registrant: Diane Von Furstenberg Studio (USA)

V-LO

Registrant: Dexter-Russell, Inc. (USA)

C

Registrant: Cycleurope AB (Sweden)



SILAFECT

Registrant: Fran Wilson Creative Cosmetics, Inc. (USA)

TROESTER

Registrant: Troester GMBH & Co. Kg (Germany)



SPEEDCLIP THE NEW CLIP PEDAL STANDARD

Registrant: Wellgo Pedal's Corp. (Taiwan)

VP TECH

Registrant: V.P. Holding S.P.A. (Italy)

DURANCE

Registrant: Sarl Le Lavandin De Grignan (France)

IMMUNOTEC

Registrant: Immunotec Research Ltd. (Canada)

CABBAGES & ROSES

Registrant: Cabbages & Roses Ltd. (United Kingdom)

IKOREL

Registrant: Chugai Seiyaku Kabushiki Kaisha (Japan)

ULTRA-FOOD

Registrant: Comasec (France)

INPACEL

Registrant: Vinson Industria De Papel Arapoti Ltda. (Brazil)

SFERRA BROS.

Registrant: Sferra Bros. Ltd. (USA)



AQUADIS

Registrant: Aquadis International Inc. (Canada)

ISTIKBAL

Registrant: Istakbal Mobilya Sanayi Ve Ticaret Anonim Sirketi (Turkey)

CYBORG009

Registrant: Avex Entertainment Inc. (Japan)

ESCONDIDA

Registrant: Payday Records, Inc. (USA)



LADY POWER STICK

Registrant: A.P. Deauville, LLC (USA)

ULTIMATE GROWING SYSTEM

Registrant: W. Atlee Burpee Co. (USA)

AZERA

Registrant: Hyundai Motor America (USA)

MIEL DE BOIS

Registrant: Shiseido Company, Ltd. (Japan)



DR. CI:LABO

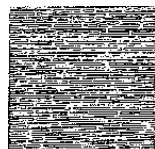
Registrant: Dr. Ci:labo Co., Ltd. (Japan)

AERO SEKUR

Registrant: Aero Sekur S.P.A. (Italy)

PORTWISE

Registrant: Portwise AB (Sweden)



DESIGN ONLY

Registrant: Dexter-Russell, Inc. (USA)

SKYTOP

Registrant: Chukoh Chemical Industries, Ltd. (Japan)

GOTO

Registrant: Kabushikigaisya Goto Kogaku Kenkyujyo (Japan)

BREYER

Registrant: Reeves International, Inc. (USA)

POWERLITE

Registrant: Max Co., Ltd. (Japan)

EAU D'ITALIE LE SIRENUSE

Registrant: Le Sirenuse S.P.A. (Italy)

TWIST & SHOUT

Registrant: Aerogroup International Holdings, Inc. (USA)

BELLI GEL

Registrant: Massimo Guarducci S.R.L. (Italy)



DVIEO

Registrant: Overview Limited (UK)

EXTRA FINE VODKA WODKA GDANSKA WODKI GDANSKIE M 1997

Registrant: Destylarnia Sobieski S.A. (Poland)

ALITALIA VOLARE CLUB

Registrant: Alitalia - Linee Aeree Italiane S.P.A. (Italy)

METAVOLTAGE

Registrant: Shiseido Company, Ltd. (Japan)

LOCWAVE

Registrant: YKK Corporation (Japan)

KNIFE VAULT

Registrant: Lifetime Brands, Inc. (USA)

RD ROYAL DEMEURE HOTEL GROUP

Registrant: International Hospitality Management. S.P.A. (Italy)

VENAIR

Registrant: Venair Iberica, S.A. (Spain)

Continued on Page 9

More Patents

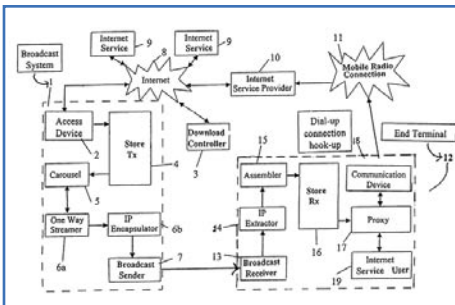
PATENT CORNER

Continued from Page 6: Patent Corner

METHOD AND SYSTEM FOR COMMUNICATION WITH THE INTERNET

Patent No.: 7,058,394

Assignee: T-Mobile Deutschland GmbH (DE)



METHOD FOR PRODUCING UNDERGARMENTS BY USING GLUED JOINTS

Patent No.: 7,060,157

Inventors: Hans Bauer, Fred Zeschky, Peter Frolich (DE)

APPARATUS AND METHOD FOR THE DISTRIBUTION OF CONSUMER PRODUCT INFORMATION

Patent No.: 7,010,876

Assignee: Shape CD Ltd. (USA)

ADENO-ASSOCIATED VIRAL VECTOR-BASED METHODS AND COMPOSITIONS FOR INTRODUCING AN EXPRESSION CASSETTE INTO A CELL

Patent No.: 7,060,497

Assignee: The Board of Trustees of the Leland Stanford Junior University (USA)

METHOD FOR SYNCHRONIZING THE INTERNAL CLOCK OF A MOBILE RADIO TERMINAL WITH LOCAL TIME

Patent No.: 6,999,787

Assignee: T-Mobile Deutschland GmbH (DE)

MULTICAST FILE TRANSMISSION METHOD

Patent No.: 6,941,501

Assignee: KDDI Corporation

LINEARIZATION OF AN AMPLIFIER

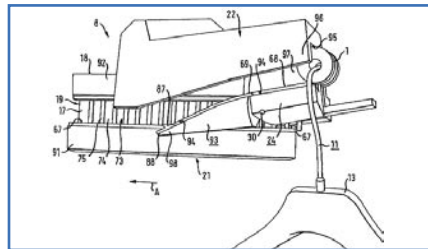
Patent No.: 7,053,709

Assignee: Nokia Corporation (FI)

SUSPENSION-CONVEYOR DIVERTER

Patent No.: 6,991,090

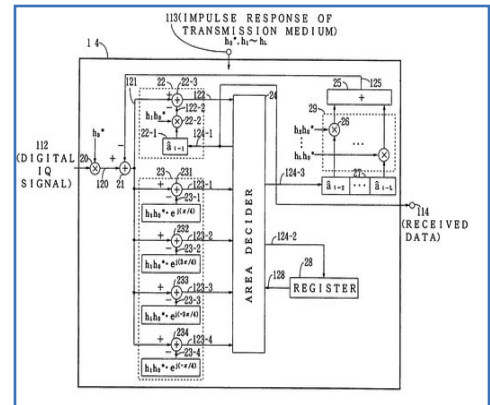
Inventor: Franz Gaertner (DE)



DECISION FEEDBACK EQUALIZER

Patent No.: 6,966,169

Assignee: Iwatsu Electric Co., Ltd.



APPARATUS AND ASSOCIATED METHOD, FOR SELECTABLY CONTROLLING PACKET DATA FLOW IN A PACKET RADIO COMMUNICATION SYSTEM

Patent No.: 7,023,803

Assignee: Nokia Corporation (FI)

CIRCUIT ARRANGEMENT FOR CONTROLLING POWER SEMICONDUCTOR TRANSISTORS

Patent No.: 7,038,500

Assignee: Semikron Elektronik GmbH & Co. (DE)

Attorney Profile Continued from Page 1: Andrew F. Young

After his initial training in ceramic engineering and material science at Alfred University, and advanced studies at Sheffield University in England, where Mr. Young studied glass science and high temperature chemistry, metallurgy, and mechanics, he pursued an engineering management career prior to practicing patent law with the Material Science Division of AlliedSignal, Inc. (now Honeywell) where he worked for four years. Mr. Young successfully helped manage and troubleshoot the world-famous amorphous alloy-ribbon Metglass® product to full-scale production.

Mr. Young has an extensive background in high technology fields including material science, ceramic and chemical engineering, nanotechnologies, complex mechanical systems, optics and optical systems, data transfer and computer technology, semiconductor systems, electronics and electronic control networks, data security systems, and high alloy metallurgical systems, as well as business methods and models. Clients seeking Mr. Young's advice include semiconductor manufacturers, single crystal manufacturers and integrated chip manufacturers and assemblers.

At Lackenbach Siegel, Mr. Young was instrumental in installing and monitoring the firm's electronic patent filing system, provid-

ing clients the option of same day patent application filing.

Member: American Ceramic Society; Association for Iron and Steel Technologies; Intellectual Property divisions of the N.J. and N.Y. bar associations; American Intellectual Property Law Association

Prior Law Firm Affiliation: Morrison Law Firm – representing Asian entities

Co-Author: Acquiring and Protecting Intellectual Property Rights, LexisNexis, 2006; Patent, Trade Secret, and Mask Work chapters

Education: Alfred University (B.S.C.E. 1991). Sheffield University, U.K. (Studies in Glass Science and Engineering) Widener University (J.D. 1998).

E-mail: AYoung@Lackenbach.com

More Trademarks

TRADEMARK CORNER

Continued from Page 7: Trademark Corner

BTK

Registrant: TBK Co., Ltd.
(Japan)



IRON CHEF

Registrant: Fuji Television Network Inc. (Japan)

SIKATHERM

Registrant: Sika AG (Switzerland)

SENSATIONS

Registrant: Orchard Yarn and Thread Company, Inc.
(USA)

BOWSTONE BLOCKWALL SYSTEMS

Registrant: Hexacore Technology PTY Ltd.
(Australia)

AJINOMOTO

Registrant: Ajinomoto Co., Inc.
(Japan)

HYDE INDUSTRIAL BLADE SOLUTIONS

Registrant: Hyde Tools, Inc. (USA)



FINCA FLICHMAN DEDICADO

Registrant: Finca Flichman S.A.
(Argentina)

COOL HUNTING PEOPLE

Registrant: Cool Hunting People S.R.L.
(Italy)

EVERLAST

Registrant: Everlast World's Boxing Headquarters
Corporation (USA)

WOLF GORDON

Registrant: Wolf-Gordon Inc. (USA)



CODE BLUE

Registrant: Channellock Inc.
(USA)

MARCHE MADISON

Registrant: Kim Kyung Ho
(Korea)

1 2 3 SECURE SYMBOLOGY

Registrant: Secure Symbology, Inc. (USA)

ALEXANDA

Registrant: Skylark Industries Ltd.
(China)



AC HEALTHCARE SUPPLY

Registrant:
AC Healthcare Supply, Inc.
(USA)

ULTRA

Registrant: Ultra Records, Inc.
(USA)

SOLE A BY AEROSOLES

Registrant: Aerogroup International Holdings, Inc. (USA)



PHARMADULE

Registrant: Pharmadule Emtunga AB
(Sweden)

VISKO

Registrant: OY Visiko AB (Finland)



XAICA

Registrant: Carrillo Etcharren, Ricardo
(Mexico)

TECHNOCAP

Registrant: Gestion Technocap Inc.
(Canada)

BELLA MIA

Registrant: Alex Spa
(Italy)

HPP

Registrant: Hyundai Motor America
(USA)

CODE BLUE BY CHANNELLOCK

Registrant: Channellock Inc.
(USA)

OPTIGRAF

Registrant: Optigraf AG (Switzerland)



Optigraf

BODACLICK

Registrant: Bodaclick, S.L.
(Spain)

XILARATE

Registrant: Southern Beverage Packers, Inc.
(USA)

PODIUM

Registrant: Petroleo Brasileiro S/A - Petrobras
(Brazil)

EURO COLA

Registrant: Refrescos Europeos, S.L. (Spain)



COLIN COWIE

Registrant: CAW Cowie, Inc.
(USA)

A ARC FASTENING

Registrant: YKK Corporation
(Japan)

POLARSAT

Registrant: Polarsat, Inc.
(Canada)

More Intellectual Property Law

The More I.P. The Merrier!... Continued from Page 3

THE NEED FOR DIFFERENT TYPES OF PROTECTION

Different types of intellectual property protection provide the means to attack such a “free ride.” Good attorneys select more than one type of protection because of the relative effectiveness in enforcement and differing duration of protection of each type of right. Trademark protection may be perpetual if actual use of the mark occurs continually, whereas a design patent can last only a maximum of 14 years. Copyrights last decades longer, and trade secret rights, even without use, can be of unlimited duration.

Utility and design patent protection each provide a remedy for infringement even when there is no actual use of the patented invention and, in many instances, when the holder of a patent does not even have an operating business. Similarly, the holder of a copyright need not manufacture, distribute or deal in any manner with the protected work for an infringement to be found. This is contrasted with trademark rights, where actual use of the trademark by the owner is fundamental to protection, and infringement actions are based upon a claim of likelihood of confusion of the source of origin.

The interrelationship that has developed between the various forms of intellectual property rights is complicated and can be, on occasion, fraught with uncertainty.

More is Better

The various forms of intellectual property protection are not generally mutually exclusive and may be useful to one another to establish the various prerequisites for protection. Conversely, the process of obtaining one type of protection might undermine a claim to another

type. For example, information about the publication or first use date in a copyright or trademark application may make patent protection impossible, as there is a prohibition against filing for patents more than one year after public exposure. The evidentiary value of statements made when securing a patent related to utility can have a negative impact upon enforcing copyrights, design patents, trade dress and trademarks.

The existence of a design patent may reflect favorably on the lack of functionality of a design and therefore prove helpful in seeking copyright, trade dress and trademark protection, because there is a prima facie declaration of non-functionality created by federal patent law following an examination of a design patent. While the existence of a design patent alone may provide “some evidence” of non-functionality, it does not bestow a holding of distinctiveness or recognition of the design patent subject matter as unequivocally protectable trade dress.

Copyrights with Design Patents and Trade Dress

Copyrights and design patents readily coexist. The United States Supreme Court has stated: “neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.” For example, a wristwatch face having a caricature figure was granted a design patent while the face was already protected by a copyright on the caricature as a work of art. The mere fact that copyright outlives patent protection does not preclude obtaining both forms of protection for a single design. The validity of a

design patent is independent of the validity of a copyright, but the existence of one should assist counsel in asserting the lack of functionality of the other.

Trade dress rights (synonymous with trademark rights) can be used to protect distinctive written materials, such as sales brochures, reminder letters, and monthly reports used, for example, in connection with an auto service reminder letter business. Using a trade dress theory, a competitor’s reminder business was enjoined from using brochures, letters and reports that were graphically confusingly similar to those of the plaintiff. Such written materials and associated graphics are unquestionably capable of copyright protection. Both or either type of protection is available for non-functional and graphically distinctive aspects of business literature.

Utility Patents Affect Trade Secrets

Utility patent law creates a limited opportunity to obtain a property right in an idea. Once an inventor has decided to lift the veil of secrecy from his work, which ends any rights in trade secret protection, he must be satisfied with the protection of a federal patent and the dedication of his idea to the public at large. As Judge Learned Hand once stated: “[I]t is a condition upon the inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy [i.e. a trade secret] or legal monopoly.”

Utility Patents and Trademarks

Trademark and utility patent protection were found to be mutually exclusive when trademark registration was sought for the figure “8” configuration of a lock, where a utility patent had been granted for the same configuration. The court reviewed the background of the patent

Did You Know?

The Coca-Cola syrup formula has been protected as a trade secret for over a century but would have been irrevocably lost to the public domain in less than two decades if patent protection were possible and chosen over trade secret protection in 1887.

More Patents & Trademarks News

The More I.P. The Merrier!... Continued from Page 10

WHAT HAPPENS WHEN A DESIGN PATENT EXPIRES?

and noted that the application stated that the lock "shape is reduced to the minimum size and requires only the minimum amount of metal in its construction." The patent application disclosure was evidence of functionality of the design and the court granted summary judgment against the trademark applicant. It is worth noting that the court found that the utility patent, even though expired, acted to preclude trademark protection.

A utility patent is "strong evidence that the features therein claimed are functional" and that a party claiming trademark protection of such features "must carry the heavy burden showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device."

An Indiana district court took a surprisingly strict position recently in broadly condemning a claim of trademark rights in a design when a utility patent existed:

[W]here a trademark right in a product configuration would prevent the public from practicing a useful invention that was the subject of an expired utility patent, the trademark is not valid because what it protects is a functional design or feature of the product. The trademark claim must give way to the public's rights under the patent bargain with inventor; exclusive rights for a limited period of time followed by a public right to practice the invention. (Eco. Mfg., 295 F. Supp. 2d. 870)

Design Patents and Trademarks

A design patent is analytically distinct from a trademark or protectable trade dress, but industrial products may qualify for both kinds of protection without violating the policy goals of either patent or trademark law. The purpose of

patent law is to encourage innovation by excluding emulation for a limited period of time. The purpose of trademark (and trade dress) law is to prevent confusion as to the source of goods. Trademark rights do not extend the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other.

A design patent, unlike a utility patent, is granted for a product's nonfunctional, ornamental features. To qualify for a design patent, the features must be new, non-obvious and ornamental. They need not be inherently distinctive. As the Supreme Court has stated, "To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability." When a design patent expires, the design may be copied freely, unless such copying violates trademark law.

Novelty, a patent criterion, is irrelevant for trademark or trade dress protection; protectable trademarks must inherently be distinctive or acquire secondary meaning. Many patented (or formerly patented) designs cannot meet this standard. If the producer has made no efforts promote brand recognition, it will be unable to show the design has a secondary meaning. If, by contrast, the design has so dominated the market that it virtually defines it, the design may be generic or functional and thus ineligible for protection. If the market has evolved into one in which knock-offs or close copies are common and consumers are sophisticated, as in the clothing and handbag industries, proving the likelihood of confusion with an emulation will likely be challenging.

The long-established position of the Court of Appeals for the Federal Circuit has been that the existence of a design

patent on a purely arbitrary and nonfunctional configuration does not preclude protection of that configuration also as a trademark.

Mask Works and Patents and Copyrights

The federal Semiconductor Chip Protection Act that created protection for mask works states that it does not affect any right or remedy held by any person under the patent or copyright laws. The Act further provides that it does not detract from any rights of a mask work owner under any other federal law with respect to any mask work first commercially exploited before July 1, 1983. The Congressional legislative history makes it clear that traditional state law trade secret protection is not equivalent to the rights and remedies afforded by SCPA.

For more information about your various Intellectual Property matters, please contact: Howard N. Aronson, HAronson@Lackebach.com

Acknowledgement Zone

Lackebach Siegel Ranked in the Top 5 in Trademark Filing

Howard N. Aronson of Lackebach Siegel was ranked in the **Top 5** of all trademark attorneys nationwide by the *Trademark Insider* First Quarter 2006 report based upon applications submitted to the USPTO.

Of the 762,500 lawyers in private practice in the U.S. the *Trademark Insider* 2005 Annual Report listing the top U.S. attorneys ranked Mr. Aronson of Lackebach Siegel **ninth (9th)** in the nation!

Lackebach Siegel is renowned in the trademark industry, most recently being granted an **Industry Leaders Award** by *NameProtect* for 2005.

Foreign Trademark Developments

More Electronic Issues

By Robert Golden

Amendments to the Federal Rules of Civil Procedure will likely become effective on December 1, 2006 affecting the discovery of digital or electronic information, placing the burden on litigants to preserve electronic information in the same manner that traditional paper evidence needs to be preserved. Under amended Rule 34(a), a reviewing party has the right to "test or sample" electronically stored information, which should help counsel plan the most efficient methods for conducting full-scale discovery. The amended Rule will permit the requesting party to specify the form for producing electronically stored information. The same information can be stored as a wide variety of file types, e.g., stored as a Word document, or scanned and saved as a PDF, TIFF, or JPEG file. Different formats of the same document may reveal different information, as some forms reveal hidden `meta tags` that may

reveal creation dates, authors, editors, and the like. The party responding to the request has the right to object to the requested form. The "default" forms under the new Rule are those "in which [requested information] is ordinarily maintained" or "that are reasonably usable."

Because the rules are confusing to lawyers and clients alike, there has been much concern over potential sanctions by the courts for failing to abide by the requirements of the new rules. Thus, new Rule 37(f), often referred to as the "safe harbor provision" provides: "**Absent exceptional circumstances, a court may not impose sanctions under these rules on a party for failing to provide electronically stored information lost as a result of the routine, good-faith operation of an electronic information system.**" The safe harbor, however, is intended to protect against only the "routine, good-faith operation of an electronic information system." For example, an e-mail back-up tape overwritten as part of ordinary system maintenance, without the intent to destroy evidence.

For more information about Electronic Issues, please contact: Robert Golden, RGolden@Lackebach.com

FOREIGN TRADEMARK DEVELOPMENTS

By Rosemarie B. Tofano

Canada – A Superior Court recently held that the ownership of unregistered trademarks (common-law trademarks) that were subject of a security interest agreement, upon default, becomes vested in the perfected secured creditor. The unregistered nature of the right did not interfere with the operation of relief pursuant to the security agreement.

>The Supreme Court recently granted expansive protection to a famous mark indicating that: "fame is capable of carrying the mark across product lines where lesser marks would be circumscribed to their traditional wares or services."

United Kingdom – Starting October 2007, an application will no longer be rejected on the basis of similarity with an earlier pending or registered National, International or European Community (CTM) mark. Applications will be published and proprietors of any such similar prior marks will be notified and allowed three months to oppose. This facet of UK practice will generally mimic European Community procedures.

European Community – The member countries of the European Union will soon (January 1, 2007) increase to include Bulgaria and Romania as part of a European Community Trade Mark (CTM) and Registered Community Designs (RCD). The CTM will therefore extend to 27 countries from the 25 present member states. Croatia, Macedonia and Turkey are considered "candidate" countries that may be eligible for membership in the future.

Puerto Rico – The Supreme Court recently ruled that marks registered based upon an intent-to-use (ITU) must have proof of use filed within five years from filing, not registration. ITU applications pending more than five years without use cannot proceed to registration. Accordingly, thousands of existing registrations where no use or statement of use has been filed are apparently in jeopardy.

Japan – Registration for retail store services will soon be possible. Registration will be granted for traditional retail stores as well as mail order facilities and Internet operations without "brick and mortar" locations. To avoid jeopardy, a three-month grace period will exist whereby all applications filed during such term will be granted a single filing date. The effective date for the change of law, and starting date of the grace period, will be announced prior to June 2007.

>For at least the last four years, Matsushita Electric and Canon have been the top two companies filing patent applications in Japan. During 2005, Matsushita had 14,732 patent applications published and Canon had 9,316 patent applications published in Japan.

Korea – Starting July 2007, the trademark law will be amended to allow legitimate trademark owners to avoid prior "imitation" filings to prevent legitimate use. The new law proposes to prevent registration when a mark recognized within or outside Korea is sought to be registered "to obtain unjust profits or to inflict harm on the other party..." Registration of an imitation mark will not, under the new law, prevent prior

legitimate usage in Korea to continue if consumers recognize the mark as a trademark in Korea. The scope of registrable marks under the new law will be enlarged to include color marks, holograms and other non-verbal marks. And to assist legitimate trademark owners, the opposition period will be doubled to two months.

>It was reported that Hyundai Motors (a Lackebach client in the USA) is offering its employees in Korea 10% of royalties received from patent infringement settlements or court awards that they find and report. Hyundai intends to vigorously enforce its patent rights against competitors and is rewarding its employees who assist in finding and reporting infringements.

For more information about Foreign Trademarks, please contact: Rosemarie B. Tofano, RTofano@Lackebach.com

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