



LACKENBACH SIEGEL today!

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Welcome to the Lackebach Siegel today! Online Newsletter.

Lackebach Siegel, whose history and achievements in intellectual property law span most of the Twentieth Century, has practice areas which include patents, trademarks, copyrights, unfair competition, antitrust, licensing, litigation and all facets of computer, Internet and domain name law.

Lackebach Siegel today and Since 1923 is all about Patents, Trademarks, Copyrights, Domain Names, Internet and Computer Law

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From Spring 2001 Newsletter

Dilution Dilemma Update

By Seana F.C. LaPlace (slaplace@Lackebach.com)

Prior to the enactment of the Federal Dilution Act, effective January 1996, close to thirty states provided protection for strong and unique marks through anti-dilution statutes. The state anti-dilution laws were designed to protect against the "diminishment" or "whittling away" of a trademark's distinctiveness by unauthorized use. This protection was provided by the respective states in the absence of likely confusion between the marks or competition between the parties.

From Spring 2001 Newsletter

Attorney Profile

Position at Firm: Associate
Jeffrey M. Rollings



Jeffrey Rollings Mr. Jeffrey M. Rollings is admitted to the California bar; U.S. District Court, Central District of California and is admitted to the New York bar; U.S. District Court, Southern District of New York. Education: Cornell University, A.B. 1985; Indiana University (Bloomington), J.D. 1988 magna cum laude, Order of the Coif. Member: New York State Bar, California State Bar, Indiana Law Journal 1987-1988; Indiana Moot Court Team 1988. Previous Law Firm Affiliations: Gibson, Dunn & Crutcher, and Brobeck, Phleger & Harrison. Practice Areas: Trademark, Copyright and Patent litigation, licensing and counseling; commercial litigation. E-mail: jrollings@Lackebach.com

PATENT CORNER

Featuring a recently issued patent to a client of Lackebach Siegel

United States Patent Number:

6,120,337

LIFE-SAVING DEVICE WITH LAUNCHER

Unlike the state statutes, the Federal Act provides protection from the weakening of distinctive qualities of famous trademarks. Actions are brought when the diluting use causes blurring in a consumer's mind between the marks or when the diluting use is unsavory, leading to tarnishment of the mark. The Act lists the following factors as a gauge to determine whether a mark is indeed famous: (1) degree of distinctiveness (2) length and extent of use (3) extent of advertising (4) geographical parameters of the mark's trading area (5) channels of trade (6) consumer recognition in the trading area and in the channels of trade (7) extent of similar use by third parties; and (8) ownership of a valid federal registration. Notwithstanding the inclusion of the eighth factor, the Act provides protection for both registered and unregistered trademarks.

The requirement that a mark be "famous" is higher than the "distinctive" standard previously applied in state statutes. Thus, an action for dilution is reserved for marks with powerful consumer associations. The Act seeks to prevent lessening of the capacity of a famous mark to identify and distinguish the owner's goods or services, despite a lack of confusion to consumers or competition between the parties. The remedy is simple; prevailing plaintiffs are awarded a permanent injunction against continued use of the diluting marks. In those instances where a plaintiff can establish that the defendant willfully adopted a mark with the intention to trade on the owner's reputation, the Act also provides for monetary damages.

Since the introduction of the Act in 1996 the federal circuits have produced split decisions regarding issues such as the retroactivity of the statute (instances where a diluting mark was adopted before enactment of the Act), whether dilution applies to trade dress, and if the dilution factors can be applied to competitive products. The answer to these pressing questions will not be settled until the U.S. Supreme Court agrees to address a dilution action.

Revisions of the U.S. Patent Laws and Rules - Major Changes in the Patent Landscape.

By Myron Greenspan (mgreenspan@Lackebach.com)

When harmonization efforts by the U.S. to conform with the patent laws of other countries, technology and budgetary considerations merge, it is inevitable that important changes need to take place. This occurred when the President signed the "American Inventors Protection Act of 1999" ("AIPA") which became Public Law 106-113, which both Houses of Congress had submitted as the "Intellectual Property and Communications Omnibus Reform Act of 1999".

The AIPA covers much ground, including cybersquatting. However, most of the AIPA made important changes to the Patent Act (Title 35, United States Code) and resulting changes in the Patent Rules of Practice promulgated by the United States Patent and Trademark Office ("USPTO"). The revisions to the patent laws address essentially six major topics, but also contain numerous miscellaneous amendments, only some of which will be highlighted here as these may be more significant or of more direct interest to a patent applicant, as opposed to a patent practitioner. The six major topics are as follows:

1. Promotion Services

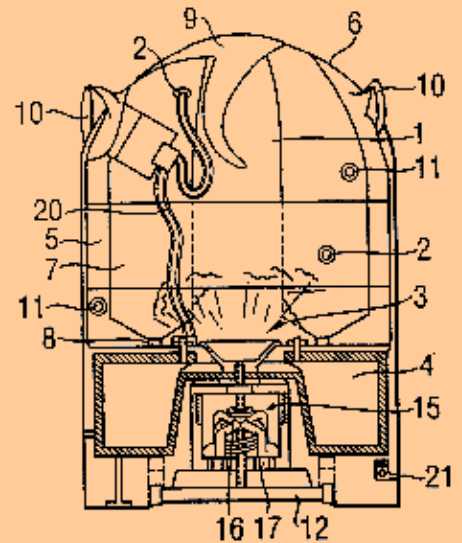
The AIPA includes provisions for the for the protection of inventors using services of invention promotion services.

2. Patent Fees

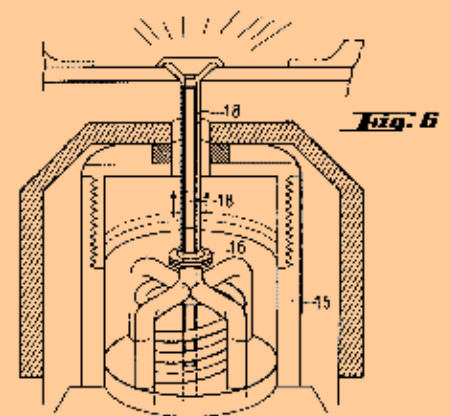
Certain patent fees charged by the USPTO were to be reduced and certain trademark fees were to be increased. These became effective December 29, 1999.

3. First User Defense

The availability of this defense to a patent infringement action became available on November 29, 1999, and applies only to new infringement actions for methods of doing or conducting business. Congress passed this law in response to the decision by the Federal Court for the Federal Circuit ("CAFC") in *State Street Bank v. Signature Financial Group* holding that various business methods may be patentable, which until recently were thought not to be patentable. Congress made it clear, however, that this defense will not be limited to business methods in any particular industry, such as financial services, but to any industry. Generally, the defense can only be used when the party accused of infringement, acting in good faith, has used the business method as a trade secret for at least one year prior to the filing date of the patent in suit. The defense is personal and a successful defense does not invalidate the patent. Instead, the accused party effectively obtains a royalty-free license under the patent. However, pleading the



This patent relates to improvements in a life preserver device complete with a launcher which remarkably improve upon the state of the art as known and employed to date.



A life preserver device equipped with a launcher which affords the possibility of the immediate inflating of a float, controlling the distance to which the same is to be launched using a chart of metric notes and a telemetric gauge attached to the float and the launcher by a system of lines which enable joining the float to the roll stand of the launcher, inside the muzzle of which the float is inserted. The life preserver is comprised of two main parts, one mainly made of rubber or latex or of a similar material to ensure the buoyancy thereof, and a second part, preferably made of metal, including different mechanisms.

Patent Corner Digest:

Notable, recent Patents secured by Lackebach Siegel

defense unsuccessfully shall be ground for an award of attorney fees to the prevailing party.

4. Extension of Patent Term

This provision only applies to utility and plant applications filed on or after May 29, 2000 and extends the patent term if a patent application has been unduly delayed in prosecution in the USPTO through no fault of the applicant. Thus, the term will be extended for one day for each day that the prosecution has been delayed by the USPTO. Examples of USPTO delays that will trigger such extensions include failure by the USPTO to issue a first Official Action within fourteen months following the filing of a new application, failure by the USPTO to reply within four months to a response filed by an applicant, and any overall delay extending the total pendency to beyond three years from the actual date of the application in the United States. However, no account will be given, with minor exceptions, to delays requested by an applicant, including obtaining extensions of time beyond the three month term normally granted by the USPTO for responding to an Official Action. Any appeals from a decision by the USPTO relating to patent term extension shall be by civil action in the form of an appeal filed in the District Court of the District of Columbia.

5. Early Publication of US Patent Applications

Long time a standard practice in most foreign countries, the USPTO will now publish, with few exceptions, applications filed on or after November 29, 2000. The applications will be published "promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought." Thus, the computation does not only go back to the filing date but to the earliest effective filing date that the application claims priority under. This provision will not apply to design patents. However, if an applicant certifies that the application has not been and will not be published in another country the applicant can request that the U.S. application not be published. If the applicant changes positions and decides to file in other countries the USPTO must be advised within 45 days of such additional filing(s). Provisions are also made for the publication of partial patent applications where only certain parts thereof will be published abroad and the applicant wishes to maintain the remaining subject matter non-published until a U.S. patent is granted. Also, as in other countries, the publication provisions specify that an applicant obtain provisional rights to obtain a reasonable royalty from the date of publication from anyone who uses the invention as long as the invention as claimed in the publication is "substantially identical to the invention as claimed in the published application". However, this also requires that the alleged infringer be given actual notice and that the claims are made available in the English language. This is likely to result in the filings of increased numbers of claims to make certain that at least one claim can be maintained, that covers an alleged infringing item, without amendments between the time of publication and the time that the patent is granted.

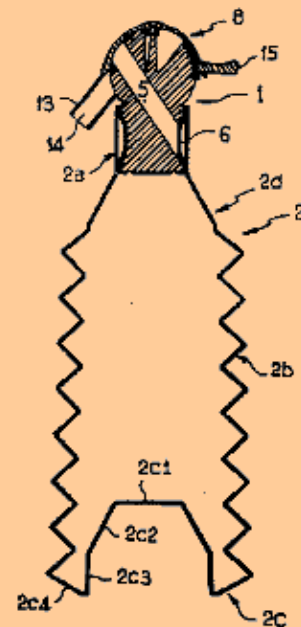
6. Optional Inter-Partes Re-Examinations

Effective on November 29, 1999 and applying only to patents issued after that date, "inter partes re-examinations", as opposed to "ex parte re-examinations", are intended to encourage people to resolve questions of patentability based on prior art and thereby reduce the volume of patent litigation in the courts. However, while this new procedure is somewhat more favorable to a third party requester, it is still biased in favor of the patentee. Thus, while a requester can participate to a greater extent in the prosecution of a re-examination only the applicant can appeal beyond the Board of Patent Appeals and Interferences. Also, only the patentee may request a court to stay a litigation in a federal court and the court must normally then stay the litigation pending the outcome of the re-examination proceedings. Additionally, the USPTO is in the process of implementing the AIPA, including working out the details on the following four rule-making packages: a. Request of Continued Examination (RCE), to change application examination and provisional application practice; b. Patent Term Adjustment (PTA), to implement the Patent Term Adjustment provisions; c. Eighteen-Month or Pre-Grant Publication (PG Pub) to implement the Eighteen Month Publication provisions; d. Inter-Partes Re-Examination, to implement Optional Inter Partes Re-Examination provisions; and e. Providing for the filing of patent applications and publication of patent documents in an electronic medium. Some of the changes have been made for the sake of harmonization. Some for the benefit of patent applicants, and some for making USPTO procedures more efficient and cost effective. Time will tell if all these changes accomplish their intended functions. In the meantime, patent applicants need to re-evaluate their procedures in applying for and enforcing their patents.

TRADEMARK CORNER

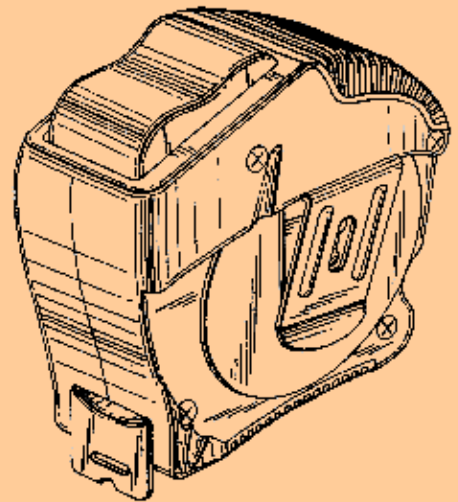
Notable, recent Trademarks secured by Lackebach Siegel

KENNETH COLE NEW YORK Registrant: K.C.P.L. Inc. S Design Registrant: Surge Components, Inc.



CONTAINER STOPPER WITH SHUT-OFF VALVE

Patent No.: 6,116,465 Assignee: BOOUZAGLO



TAPE MEASURE Patent No.: Des. 432,931 Assignee: Olympia Group, Inc.

(USA) VALVE Patent No.: Des. 429,519 Assignee: Valvulas Arco, S.A. (SPAIN) COSMETIC CONTAINER Patent No.: Des. 430,034 Assignee: Shiseido Company, Ltd. (JAPAN) AIR CONDITIONER WITH ELECTRIC DUST COLLECTOR Patent No.: 6,092,387 Assignee: Funai Electric Co., Ltd. (JAPAN) PREFABRICATED PRE-CAST CULVERT PROVIDED WITH COUPLINGS Patent No.: 6,092,962 Assignee: To-Am Industrial Co., Ltd. (KOREA) OIL SOLUBLE CALCITE OVER-BASED DETERGENTS AND ENGINE OILS CONTAINING SAME Patent No.: 6,107,259 Assignee: Witco Corporation (USA) DEVICE FOR SETTING INITIALIZING DATA FOR EVERY DESTINATION IN ELECTRONIC DEVICE Patent No.: 6,112,302 Assignee: Funai Electronic Co., Ltd. (JAPAN) GEAR EXTRUDER FOR A CAOUTCHOUC MIXTURE Patent No.: 6,106,266



Registrant: Reeves International, Inc.

R Arrow Design Registrant: Russell Harrington Cutlery, Inc. Mountain Design Registrant: Mauna Loa Macadamia Nut Corporation Room with A View Design Registrant: Park Lane Hotel, Inc. W in Globe Design Registrant: Wellgo Pedal's Corp. (Taiwan) USP and Design Registrant: United Steel Products, Inc. TAKE A POWDER Registrant: Candie's, Inc. TURBOKNIFE PRO Registrant: Olympia Industrial, Inc. BAG-O-BRANDS Registrant: Selective Marketing Inc. BUDESONEBS Registrant: Dallas Burston Healthcare Limited (UK) BONSER Registrant: Industria Adriatica Confezioni S.P.A. (Italy) CONSENSUAL DATABASE Registrant: Ernan Roman Direct Marketing Corporation WHERE IMAGINATION IS YOUR ONLY LIMIT Registrant: Liteglow Industries, Inc. NOURISH MY EYES Registrant: Fran Wilson Creative Cosmetics, Inc. NEXT STEP ES Registrant: Bauwerk Parkett (Switzerland) STABLEMATES Registrant: Reeves International, Inc. AIRLUME Registrant: Miracle Candle Company DAMIANOU Registrant: Damianou Sportswear Inc. TRADITIONAL Registrant: Reeves International, Inc. B.D.U. Registrant: Buh Daw Ueng Foods Co., Ltd.(Taiwan) NEW YORK & COMPANY Registrant: WNYC Radio CONSUMER'S CHOICE Registrant: Selective Marketing, Inc.



Registrant: Vaughan & Bushnell Manufacturing Company

MEGA TILE Registrant: Duravator Corp. EVER STAYING Registrant: Shiseido Company, Ltd. (Japan) CONTINENTAL ABRASIVES Registrant: Olympia Industrial, Inc. SCREEN SEEN AT THE MOVIES Registrant: Val Morgan Cinema Advertising, Inc. LA GIARA and DESIGN Registrant: La Giara S.R.L. (Italy) B. ROBERTS & CO. Registrant: Premier Treasure Holdings, L. L.C. ROSENROOT Registrant: Swedish Herbal Institute, Ltd. DIVELLA Registrant: F. Divella S.P. A. MAGNIFICA CLASS Registrant: Alitalia-Linee Aeree Italiane S.P.A. (Italy) MEDIACOLUMN Registrant: Mediacom Inc. (Canada) EASTERN JUNGLE GYM INC. Registrant: Eastern Jungle Gym, Inc. DUR-A-LINE Registrant: R & Y Glass Co., Inc. FLYING DIVERS Registrant: Van Rompay, Boudewijn (Belgium) CLIP-N-FILE Registrant: Karen's Concepts, Ltd. CITIPICKER Registrant: U.S. Plastics, Ltd. LITEMOR Registrant: Litemor Distributors Ltd. (Canada) GARDNER'S WORK GEAR Registrant: Olympia Industrial, Inc. EAR BAG Registrant: Ear Bag AB (Sweden) FINALIZER Registrant: T.C. Electronic A/S (Denmark) BIT & WATT Registrant: Giuseppe, Silvi (Italy) FOREMOST Registrant: Miracle Candle Company TC WORKS Registrant: T.C. Works (Germany) PASQUALE BRUNI Registrant: Gioielmoda S.R.L. (Italy) POWER SCRUB Registrant: USA Detergents, Inc. CLE DE PEAU BEAUTE Registrant: Shiseido Company, Ltd. (Japan) DRIVING IS BELIEVING Registrant: Hyundai Motor America

Assignee: Paul Troester Maschinenfabrik (GERMANY) MULTIPLE SLEEVE AND CROSS-HOLE DRIVER HAND TOOL Patent No.: 6,109,148 Inventor: Wayne Anderson et al. RECORDING-MEDIUM MIS-RECORDING PREVENTING MECHANISM Patent No.: 6,111,713 Assignee: Funai Electric Co., Ltd. (JAPAN) ROLLER SKATE AND WHEEL Patent No.: 6,113,112 Assignee: MRK Handles AG (SWITZERLAND) CONTAINER STOPPER WITH SHUT-OFF VALVE Patent No.: 6,116,465 Assignee: Bouzaglo (France) COMPACT PLIERS AND PIVOTED MULTIPLE BIT DRIVE HAND TOOL Patent No.: 6,119,561 Inventor: Wayne Anderson et al. LIFE-SAVING DEVICE WITH LAUNCHER Patent No.: 6,120,337 Assignee: Bautista Real et al (Spain) TELESCOPING MAGNET FOLDING SCREWDRIVER Patent No.: 6,119,560 Inventor: Wayne Anderson et al. UNDERGROUND WATER LEVEL SENSING UN IT AND GROUND MONITORING SYSTEM USING THE SAME Patent No.: 6, 119,535 Assignee: Toshiba Engineering Corporation (JAPAN) SPACESAVER PRODUCT DISPLAY HANGER SYSTEM Patent No.: 6,119,874 Inventor: Wayne Anderson DC POWER SOURCE DEVICE WITH STANDBY MODE Patent No.: 6,133,650 Assignee: Funai Electric Co., Ltd. (JAPAN) CODING BIT RATE CONVERTING METHOD AND APPARATUS FOR CODED AUDIO DATA Patent No.: 6,134,523 Assignee: Kokusai Denshin Denwa Kabushiki Kaisha (JAPAN) PORTABLE ELECTRONIC INFORMATION DEVICE Patent No.: 6,137,685 Assignee: Funai Electronic Co., Ltd. (JAPAN) SINGLE-NIPPLE CLAMPING WITH CORRECT POSITIONING Patent No.: 6,139,002 Inventor: Emil Stark MULTI-WIRE SZ AND HELICAL STRANDED CONDUCTOR AND METHOD OF FORMING SAME Patent No.: 6,140,589 Assignee: Nextrom, Ltd (CANADA) IMAGE PROCESSING APPARATUS Patent No.: 6,146,275 Assignee: Sega Enterprises, Ltd. (JAPAN) SYSTEM FOR THE EXPRESSION OF HETEROLOGOUS ANTIGENS AS FUSION PROTEINS Patent No.: 6,146,635 Assignee: Centro de Ingenieria Genetica Y Biotecnologia (CUBA) CONTROL SIGNAL AMPLIFICATION CIRCUIT Patent No.: 6,147,554 Assignee: Funai Electric Co., Ltd. (JAPAN) AIR CONDITIONER Patent No.: 6,155,068 Assignee: Funai Electric Co., Ltd. (JAPAN) HEADWEAR WITH A ONE-PIECE CROWN PORTION Patent No.: 6,158,053 Inventor: Wen-Ching Wang LAUNDROMAT WASTEWATER TREATMENT Patent No.: 6,159,376 Assignee: I.P. Licensing, Inc. (USA) TOOL MAGNET HOLDER Patent No.: 6,164,168 Inventor: Wayne Anderson

FOREIGN TRADEMARK DEVELOPMENTS

By Rosemarie B. Tofano

Brazil - 1500 previously "frozen" Brazilian domain names (".br") are now available (through May 4th) and contrary to prior law, foreign ownership thereof will be possible soon through Brazilian attorney-in-fact representation. If interested visit registro.br/info/proclib.html, the FARESP (Brazilian domain name authority) website. Additional names are expected to be "unfrozen" in the future.



Registrant: Jose Luis Tarancon Gomez (Spain)

CRIS-METAL Registrant: Cris-Metal Movies Para Banheiro Ltda. (Brazil) REACTION Registrant: K.C.P.L., Inc. WNYC Registrant: WNYC Radio LAS CASAS DEL TOQUI Registrant: L.T. Chile S. A. (Chile) FM Registrant: Kanebo Kabushiki Kaisha (Kanebo, Ltd.) (Japan) NOVACYCLE Registrant: Novatec Plastics & Chemicals Co., Inc. WORK GEAR Registrant: Olympia Industrial, Inc. SUPERFRAMER Registrant: Max Co., Ltd. (Japan) FOODS Registrant: Buh Daw Ueng Foods Co., Ltd. (Taiwan) ETEK Registrant: EKO S.R.L. (Italy)

Europe - The European Community Trademark Office, which provides registration in 15 European countries, will now grant service mark registration for retail store services.

Netherlands Antilles - A new Trademark Act just became effective. The new law provides for service mark registrations. Rights for both trademark and service marks are based upon registration - not use. All existing trademark registrations must be re-registered this calendar year or they will lapse.

Malaysia - Brunei - New Trade Mark legislation in these countries provide for a single Register, abolishing the previous Part A and Part B systems. The new standard for registration is that of "capable of distinguishing," the previous Part B standard. While the new law is presently in effect in Brunei, the effective date in Malaysia has not been announced.

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