

## **XII. TRADEMARKS**

### **A. CASE LAW**

#### **1. U.S. Supreme Court**

- a. ***Tiffany (NJ) Inc. v. eBay Inc.***  
**81 BNA's PTCJ 141**

The U.S. Supreme Court on November 29, 2010 denies a petition for a writ of *certiorari* in a case appealing the Second Circuit's ruling that online auction site operator eBay Inc. is not liable for trademark infringement or dilution – either directly or secondarily – based on some sellers' listing of counterfeit Tiffany jewelry, because it takes action when it has knowledge of fraud with regard to any specific listing.

#### **2. U.S. Courts of Appeal**

- a. ***Toyota Motor Sales U.S.A. Inc. v. Tabari***  
**80 BNA's PTCJ 336**

The U.S. Court of Appeals for the Ninth Circuit held on July 8, 2010 that an auto brokerage service was entitled to make at least some use of the car maker's "Lexus" trademark in its Internet domain name.

- b. ***Stayart v. Yahoo!, Inc.***  
**80 BNA's PTCJ 760**

The U.S. Court of Appeals for the Seventh Circuit ruled on September 30, 2010 that a woman dismayed to find links to "shameful" websites and advertisements upon doing a Yahoo search for her name lacked standing to sue the search engine for trademark infringement.

- c. ***Advertise.com Inc. v. AOL Advertising Inc.***  
**96 USPQ2d. 1310**

The U.S. Court of Appeals for the Ninth Circuit ruled on August 3, 2010 that infringement defendants are likely to prevail on their claim that plaintiff's "Advertising.com" mark is generic for internet advertising services, since the term "advertising" is concededly generic, and ".com" is top-level domain indicator that refers generically to almost anything connected to business on internet, since extensive precedent supports conclusion that combination of ".com" and "advertising" does not result in descriptive mark, since "Advertising.com" does not appear to represent "rare instance" in which addition of TLD to generic term results in distinctive mark.

- d. ***DSPT International Inc. v. Nahum***  
**81 BNA's PTCJ 19**

The U.S. Court of Appeals for the Ninth Circuit ruled on October 27, 2010 that using a domain name with bad faith intent by holding it for ransom gives rise to liability under the Anti-cybersquatting Consumer Protection Act.

- e. ***Board of Regents of the University of Wisconsin System v. Phoenix Software International Inc.***  
**81 BNA's PTCJ 281**

The U.S. Court of Appeals for the Seventh Circuit ruled on December 20, 2010 that in determining whether the use of two registered trademarks would be likely to create an assumption in the minds of consumers that the software products came from the same source, a district court erred in limiting its analysis to the description of the goods as found in the respective trademark registrations.

- f. ***Lahoti v. Vericheck Inc.***  
**81 BNA's PTCJ 526**

The U.S. Court of Appeals for the Ninth Circuit ruled on February 16, 2011 that a cybersquatter who succeeded in getting a trademark infringement judgment vacated 15 months earlier loses his second appeal, in that the lower court properly followed instructions on differentiating suggestive versus descriptive marks.

- g. ***Network Automation Inc. v. Advanced Systems Concepts Inc.***  
**81 BNA's PTCJ 606**

The U.S. Court of Appeals for the Ninth Circuit ruled on March 8, 2011 that trial court erred in applying the *Brookfield* "troika" of likelihood of confusion factors to the use of a mark to trigger Google ads.

### 3. **U.S. District Courts**

- a. ***Baidu Inc. v. Register.com Inc.***  
**80 BNA's PTCJ 427**

The U.S. District Court for the Southern District of New York ruled on July 22, 2010 that an Internet registrar did not induce a hacker's trademark infringement and so was not contributorily liable.

- b. ***New York-New York Hotel & Casino v. Katzin***  
**81 BNA's PTCJ 24**

The U.S. District Court for the District of Nevada ruled on October 27, 2010 that redirecting reservations to Expedia was cybersquatting, infringed hotel's marks.

**c. *Jurin v. Google Inc.*  
96 USPQ2d 1674**

The U.S. District Court for the Eastern District of California ruled on September 8, 2010 that claim asserted by owner of building materials company for false designation of origin, based on defendant search engine provider's use of plaintiff's "Styrotrim" mark as keyword that plaintiff's competitors may bid on to secure "sponsored link" that appears on search results page when users search for Styrotrim", is dismissed, since plaintiff has failed to allege how defendant's use of term creates misleading suggestion as to producer of plaintiff's goods, and any confusion that may arise as to plaintiff's affiliation with sponsored link, or as to trademark status of "Styrotrim", does not constitute confusion as to producer of goods.

**d. *Career Agents Network Inc. v. careeragentsnetwork.biz*  
96 USPQ2d 1884**

The U.S. District Court for the Eastern District of Michigan held on February 26, 2010 that plaintiff asserting claim for violation of Anticybersquatting Consumer Protection Act has not established that defendants had bad faith intent to profit in registering "careeragentsnetwork.biz" and "careeragentnetwork.biz" internet domain names, which contain plaintiff's claimed "Career Agents Network" mark and are used for "gripe" websites critical of plaintiff's business practices; use of plaintiff's alleged mark in domain names registered to criticize plaintiff's business is not "inconsistent with", or in violation of, ACPA.

**e. *1-800 Contacts Inc. v. Lens.Com Inc.*  
81 BNA's PTCJ 253**

The U.S. District Court for the District of Utah held on December 14, 2010 that invisible AdWords were a use in commerce but noninfringing, absent a likelihood of confusion.

**f. *Intel Corp. v. Americas News Intel Publishing LLC*  
97 USPQ2d 1134**

The U.S. District Court for the Northern District of California ruled on July 12, 2010 that defendant's argument that plaintiff has failed to plausibly allege that defendant "used" plaintiff's "Intel" mark, and that plaintiff thus has failed to state claim for infringement, has some merit; however, dismissal of complaint on this ground would be premature, since defendant's use of arguably redundant term "intel" in its "Americas News Intel Publishing" service could be viewed as effort to free-ride on plaintiff's mark.

**g. *Binder v. Disability Group Inc.*  
81 BNA's PTCJ 431**

The U.S. District Court for the Central District of California ruled on January 25, 2011 that a survey showing that some users who conducted a Google search using a registered

term believed that they were being lead to the trademark owner's website, as well as other evidence establish actual confusion arising from Google keyword ad.

**h. *Partners for Health and Home L.P. v. Yang*  
80 BNA's PTCJ 693**

The U.S. District Court for the Central District of California on September 13, 2010 found a likelihood of success for claims related to purchasing keyword triggers for online advertising and other online uses. The court also ruled that the owner of a registered trademark had established a likelihood of success on the merits of a claim of infringement based on the tagging of a video posted on the YouTube video clip website.

**i. *Experience Hendrix LLC v. HendrixLicensing.com Ltd.*  
97 USPQ2d 1364**

The U.S. District Court for the Western District of Washington ruled on May 19, 2010 that defense of nominative fair use is appropriate if defendant uses plaintiff's mark to describe plaintiff's product, even if defendant's ultimate goal is to describe its own product; in present case, defendants' use of "Hendrix" in URLs and business names does not constitute nominative fair use of plaintiffs' "Hendrix" family of marks, since defendants' use of "Hendrix" to describe their own product, namely, marketing and licensing of goods related to late musician Jimi Hendrix.

**j. *Ohio State University v. Thomas*  
97 USPQ2d 1454**

The U.S. District Court for the Southern District of Ohio on August 27, 2010 granted plaintiff state university combined temporary restraining order and preliminary injunction prohibiting defendants from using plaintiff's various "Buckeyes" and "Ohio State" trademarks on websites or in electronic and printed publications, since plaintiffs have demonstrated strong likelihood of success on merits of their infringement and unfair competition claims, since plaintiff will suffer irreparable harm if defendants continue to publish and disseminate their products, and since balance of harms and public policy concerns favor grant of injunction.

**k. *Passport Health Inc. v. Travel Med Inc.*  
98 USPQ2d 1344**

The U.S. District Court for the Eastern District of California on February 10, 2011 granted plaintiff summary judgment that defendants' use of plaintiff's "Passport Health" trademark in their [www.passporthealthnca.com](http://www.passporthealthnca.com) domain name is likely to cause consumer confusion, since domain name incorporates plaintiff's mark in its entirety, and thus is confusingly similar to plaintiff's mark, and since parties offer competing travel health services.

**l. *Borescopes R Us v. 1800Endoscope.com LLC.*  
98 USPQ2d 1033**

The U.S. District Court for the Middle District of Tennessee ruled on July 26, 2010 that defendant's Internet domain name [www.borescopes.us.com](http://www.borescopes.us.com) is generic, since "borescopes" is generic when used in connection with sale of borescopes, since neither [www](http://www) portion nor ".us.com" portion of domain name serves any source-indicating function, and since ".us" is known as abbreviation for United States in Internet addresses, and ".us.com" is alternative to ".com" extension for U.S.-based sites, such that addition of this domain name extension does not convert "borescopes" into protectable mark.

**4. U.S. Patent and Trademark Office**

**a. *In re Iolo Technologies LLC*  
95 USPQ2d 1498**

The Trademark Trial and Appeal Board ruled on June 9, 2010 that applicant's "Activecare" computer software is similar, for purposes of likelihood-of-confusion analysis, to services offered by registrant under its "Active Care" mark, even though computer-related goods and services are not related *per se*, since applicant's goods, which include software that analyzes and repairs or optimizes performance settings for personal computers, are complementary in function and purpose to software installation, maintenance, and updating services offered by registrant.

**b. *In re Greenliant Systems Ltd.*  
81 BNA's PTCJ 180**

The Trademark Trial and Appeal Board on November 29, 2010 affirms refusal to register "NANDrive" for flashdrives based on genericness.

**c. *In re Trek 2000 International Ltd.*  
81 BNA's PTCJ 260**

The Trademark Trial and Appeal Board reverses ruling on November 30, 2010 that "thumbdrive" is generic for USB flash drive devices. Proposed "Thumbdrive" trademark is not generic term for applicant's "flash drive" data storage devices and related software, since evidence showing some generic use is offset by evidence showing significant amount of both proper trademark use and trademark recognition.

**d. *Microsoft Corp. v. Apple Inc.*  
81 BNA's PTCJ 343**

Microsoft files a motion with the Trademark Trial and Appeal Board on January 10, 2011 opposing Apple Inc.'s attempt to register the term "App Store" for its online store where users can download applications for use on an iPod, iPad, or iPhone.