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### **New Face Marks Ostrolenk's Sustained Growth**

Ostrolenk is pleased to announce the addition of Anna Vishev as an Associate of the firm.



Ms. Vishev has been preparing and prosecuting patent applications since 1998, covering innovations that span the technology spectrum, from financial products and software to wireless technology and consumer electronic devices. Her experience extends to appeals, interferences and opposition proceedings at the U.S. Patent and Trademark Office, thorough and purposeful intellectual property-related due diligence, as well as opinions and counseling regarding patentability, infringement, validity and freedom to operate.

### **USPTO Finds Patent at Center of Supreme Court Case Invalid**

The Supreme Court's decision in *Medimmune, Inc. v. Genentech, Inc.*, 127 S.Ct. 764, 81 USPQ2d 1225 (Jan. 9, 2007), profiled in our previous edition, permitted the licensee (Medimmune) to proceed with a Declaratory Judgment action for invalidity and non-infringement without first repudiating the license. Meanwhile, Medimmune was pursuing reexamination of the "Cabilly II" patent at issue in the case. In a final Office Action issued Feb. 16, 2007, the USPTO found all claims of Cabilly II invalid as obvious and for double-patenting.

Ms. Vishev also has extensive experience with patent litigation on behalf of both patent owners and alleged patent infringers. She regularly works with patent owners to develop litigation strategies to maximize returns on a cost-effective basis, and pursue such litigation in federal courts throughout the country. Ms. Vishev has represented numerous clients charged with patent infringement to avoid unfavorable litigation results and, as appropriate, assert various defenses, such as fraud on the Patent and Trademark Office and antitrust counterclaims, as well as assisting clients in designing around patents.

Ms. Vishev holds a J.D. from the Cardozo School of Law at Yeshiva University. She also has a B.A. in Economics from New York University, in addition to a B.E. in Robotics and Mechanical Engineering from Vitsyebk University of Technology, in the former Soviet Republic of Belarus.

### **Conferences and Meetings**

Robert Faber, Charles LaPolla, Peter Sloane and Martin J. Beran, will be attending the International Trademark Association (INTA) 129<sup>th</sup> Annual Meeting in Chicago, April 28 - May 2, 2007 on behalf of Ostrolenk.

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If upheld on appeal, cancellation of Cabilly II's claims would moot the DJ action, now on remand. However, it would not affect the Court's holding, which has shifted the balance of power between patent owners and licensees.

## TRADEMARKS & DOMAIN NAMES

The recent decision in *J.G. Wentworth, S.S.C. Limited Partnership v. Settlement Funding LLC d/b/a Peachtree Settlement Funding*, 2007 U.S. Dist. Lexis 288 (E.D. Pa., Jan. 4, 2007) is the latest trademark infringement case involving Google's Adwords Program. Unlike previous cases, the court found that Settlement Funding's use of J.G. Wentworth's marks constituted "trademark use", but dismissed the case because that use did not create a likelihood of confusion.

J.G. Wentworth alleged that Settlement Funding infringed upon the J.G. Wentworth mark by using the terms "J.G. Wentworth" or "JG Wentworth" as keywords in the Google Adwords Program and in the metatags of its website.

Individuals using the Google search engine receive search results that also include "Sponsored Links". Google's Adwords Program is a keyword-triggered advertising program that generates the Sponsored Links section on the results screen. Advertisers purchase certain keywords so that a link to their website appears as a Sponsored

Link when a user searches for the purchased keyword.

Metatags are keywords hidden in the HTML code of webpages. Internet search engines use metatags for searching the content of websites. If keywords are placed in a website's metatag, an Internet search engine will list that website on a results screen searching for that keyword.

Thus, a Google search for the terms "J.G. Wentworth" or "JG Wentworth" would have produced a Sponsored Link to the Settlement Funding website proximate to the plaintiff's website on the results screen and/or a link to the Settlement Funding website in the search results.

The Court granted Settlement Funding's motion to dismiss on the grounds that, although Settlement Funding made trademark use of J.G. Wentworth's marks, the use did not create a likelihood of confusion. In considering whether Settlement Funding made "trademark use" of the J.G. Wentworth mark, the Court found that the use of the mark to trigger Internet advertisements for itself is the type of use consistent with the statutory language that makes it a violation to use protected marks.

However, the Court found no actionable likelihood of confusion, reasoning that consumers are presented with a number of websites on a search result page for perusal. The links to Settlement Funding's website were independent and distinct, regardless of whether they were generated through the Adwords program or through the metatags of the Settlement Funding's website. In addition, the Court noted that the links generated did not incorporate J.G. Wentworth's marks. As a result, the Court concluded that consumers were not likely to confuse Settlement Funding's services, goods, advertisements links or websites for those of J.G. Wentworth.

by Sean P. McMahon, Trademark Paralegal

### Brand Awareness

In the digital age, the world is a single marketplace and trademark owners are witnessing growing levels of Internet abuse. Clients who are concerned about possible online abuse are encouraged to consider conducting an investigation to determine how their brands are being used, or possibly misused, on the Internet. An investigation will evaluate Internet content across a variety of abuse types – trademark infringement, trademark dilution, domain name abuse, traffic diversion, brand disparagement, offensive content and false affiliation – to identify a snap-shot of activity posing an immediate threat to your brand.

### **Federal Circuit to Address Scope of Attorney/Client Waiver**

On January 26, 2007, in *In re Seagate Technology, LLC* the Federal Circuit invited briefs on several issues regarding the effect of asserting an opinion of counsel as a defense against an allegation of willful patent infringement. The Federal Circuit announced that it will give *en banc* review to a writ of mandamus filed by Seagate Technology, LLC, appealing district court orders holding a broad waiver of attorney-client privilege is created. The case will have a significant impact on the attorney-client privilege and attorney work-product immunity in patent cases. The case follows an important earlier case, *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004) (*en banc*), which held that no negative inference can be drawn from an accused infringer's failure to produce an exculpatory opinion of counsel.

Willful infringement is alleged in more than 90% of patent cases. Consider: A lawsuit alleges willful infringement of a patent; the defendant asserts that it had earlier obtained a written opinion of patent counsel advising that it may freely make, use,

offer to sell or sell the accused technology because it does not infringe the asserted patent. Does such a defense waive the party's attorney-client privilege for subsequent communication between the opining attorney and the client as well? Does the waiver extend to independent trial counsel? The murky issue of what extent a party's assertion of advice of counsel as a defense to an allegation of willful patent infringement waives the attorney-client privilege is squarely at issue in *Seagate*.

This area of the law poses risks for defense counsel when the allegation of willful infringement is asserted against their client. Damages for patent infringement may be trebled where the patent owner proves willful infringement. Asserting the defense that the client had earlier retained counsel to analyze the patent asserted against the technology accused of infringement, and obtained a written opinion of non-infringement by the defendant's technology, may risk waiving the attorney-client privilege for subsequent communications as well.

Look for updates on this important issue in our future newsletters.

by George Brieger, Of Counsel

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### **Beware of Solicitations for Questionable Trademark Services**

Certain information contained in U.S. trademark applications and registrations, including the name and address of the applicant or registrant, is made available to the general public. Numerous companies use this published data to target advertisements for services directly to applicants and registrants.

You may receive unsolicited communications from companies offering trademark monitoring, watch, directory, maintenance and renewal services. In

some cases, these companies use "United States" in their company name, or a government-like seal on their letterhead. Less savvy recipients may be confused, or get the impression that the service is affiliated with the U.S. Patent and Trademark Office. These companies are not affiliated with the Patent and Trademark Office or the United States Government.

If you are interested in the services that these companies offer, we encourage you to contact us for referral to reliable and trusted providers.

## U.S. Copyright Office Comes To The Big Apple

Bella I. Karakis attended a U.S. Copyright Office seminar at Cardozo Law School on March 27, 2007. She writes:

It was an informative, well-organized event discussing many changes coming to the Copyright Office.

Long-awaited procedural changes will finally take place this summer. As of July 2007, electronic filing will be available for all copyright application filings. The new online filing system, called ECHO, is currently being tested by select, volunteer firms and individuals, to be rolled out to the general public sometime after July 1st. For all of those who have had to manually fill out copyright applications or resort to the typewriter for this job, this will be a breath of fresh air!

As the Copyright Office is expecting some initial resistance to the new system and possible kinks that will need to be worked out, they will be offering an incentive of reduced fees: \$35.00 if filed on-line, normally \$45.00.

## All Good Things Must End

The Constitution empowers Congress to grant patents "for limited times". Previously valid for 17 years from the date of issue, in 1996 utility patent terms were changed to run 20 years from the earliest filing date. It once was a fairly simple matter to gauge the term of any patent by its sequentially assigned patent number. Pat. No. 4,914,435 for a Pedestrian Traffic Signal issued April 4, 1990 to Gould, *et al.* Under the 17-year term, Gould will run until April 4, 2007.

Any patent in force on the date of the 1996 transition runs the longer of 20 years from the earliest filing date or 17 years from issue. Gould issued from a continuation application, relating back to an application filed Sept. 24, 1984. In

With the ECHO system, applications can be filled out and filed directly online, filled out on-line, and then printed and sent or the form printed, filled out and sent in the usual way.

The new application form will be an all-in-one that will be used for various art media submissions, such as those requiring forms VA, SE, TX, and PA.

Additionally, the Copyright Office is phasing out the separate positions, "Examiner" and "Cataloguers," and will be instituting a combined position called "Registration Specialists," which will require re-training current cataloguers in proper examination techniques.

It makes one wonder how well this system will work for large deposits, and whether originals will have to be sent separately to the Library of Congress. It appears that the Copyright Office is still working out the details on the deposit submission end.

Finally, the Copyright Office expects to simplify and expedite matters with more regular follow up with applicants, both by e-mail and by phone.

Gould's case, 17 years from issue is over 2½ years longer than the 20-year term.

Pat. No. 4,914,747 to Nino, for a Vehicular Headlamp, also issued on April 4, 1990, and was filed June 27, 1989. Under the 17-year term, it would have run only until April 4, 2007. The 1996 amendments give it a term until June 27, 2009, an additional 26 mos.

Patents may expire before their full term by disclaimers, reexamination, litigation, or failure to pay maintenance. Patents can also be extended to compensate for Patent Office delay, or to recoup time FDA regulated products were under review.

If any patent, new or old, is of interest to your business, is that patent still in force? Ask us.

by David J. Torrente, Associate

