



OSTROLENK's New Website is Live! Visit Us at www.OSTROLENK.com

OSTROLENK has completely redesigned its website, and we invite you to come take a look. Besides giving the website a completely new look and feel, we have tried to make the site much more useful and user friendly. You may even recognize our unified website and newsletter banner. The redesigned website aims to communicate who we are at OSTROLENK, the work we have done, and what we can do for you.

The website is a wealth of information about who we are as a firm. You can read about our firm history and attorney biographies. In addition you can find contact information for any of the firm's attorneys and directions to our offices.

To learn about the work we've done, you can browse our Publications section to read topics about current case law, and view some of our recent court decisions. Have you missed one of our newsletters? You can find all those in our Publication section, too.

You can discover what OSTROLENK can do for your business by perusing our Practice Areas. These areas highlight the many facets of intellectual property that we at OSTROLENK handle on a routine basis. On a more practical level, we have enhanced our client service by adding a secure extranet capability to allow for the confidential transmission of large files where e-mail is not practical or desirable.

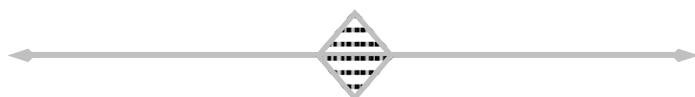
We hope you will take a few minutes to visit our new website at www.OSTROLENK.com and please make sure to check it regularly for updates. Any suggestions or comments you may have regarding the website will be greatly appreciated and can be e-mailed to us at newsletter@OSTROLENK.com.

by Michael G. Lafferty, IT Manager

OSTROLENK Partners Named to PLI Patent Prosecution Boot Camp Faculty

OSTROLENK partners Robert C. Faber and Doug A. Miro have been named to the New York Faculty of the Practising Law Institute's *Fundamentals of Patent Prosecution 2007: A Boot Camp for Claim Drafting and Amendment Writing*. Mr. Faber, who is the current author of the treatise *Landis on Me-*

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Trademark Happenings

BY SEAN P. McMAHON, TRADEMARK PARALEGAL

The recent decision in *ITC Limited v. Punchgini, Inc.*, 482 F.3d 135 (2nd Cir. 2007), has created a split among the Federal Circuit Courts of Appeal on the issue of whether the U.S. trademark statute (Lanham Act) recognizes a famous foreign mark exception to territoriality. The Second Circuit held here that no such exception exists, while the Ninth Circuit's decision in *Grupo Gigante S.A. de C.V. v. Dallo & Co., Inc.*, 391 F.3d 1088 (9th Cir. 2004) recognized the exception. The Second Circuit affirmed summary judgment for the Defendants, holding that the Plaintiff ("ITC Ltd."), the owner of an arguably famous trademark overseas, could not pursue a claim after it abandoned its mark in the United States.

ITC Ltd. is an Indian company that has owned and operated "Bukhara" restaurant in New Delhi since 1977. The company expanded its "Bukhara" restaurants to cities such as Hong Kong, Bangkok, Bahrain, Montreal, Bangladesh, Singapore, Katmandu, Amman, New York and Chicago. Today, all but the New Delhi, Singapore, Katmandu and Amman restaurants have closed.

ITC Ltd. opened its New York restaurant in 1986 and its Chicago establishment in 1987. Shortly after opening in New York, ITC Ltd. obtained federal trademark registration for "Bukhara" covering restaurant services. The New York restaurant closed five years after opening, and the Chicago restaurant closed in 1997.

Two years after the closing of the Chicago restaurant, several former employees of the New Delhi Bukhara incorporated Punchgini, Inc. and opened the "Bukhara Grill" in New York. In 2002, ITC Ltd. filed suit alleging, *inter alia*, unfair

competition. Defendants argued that ITC Ltd. abandoned their rights in the "Bukhara" mark.

The district court accepted Defendants' arguments on summary judgment, finding that ITC Ltd. had abandoned its mark without the foreseeable intent to resume use for three consecutive years. ITC Ltd. appealed the decision to the Court of Appeals for the Second Circuit.

To make a claim for unfair competition ITC Ltd. needed to show that (1) they had priority rights in the mark, (2) that their mark is distinctive as to the source of goods and/or services, and (3) that there is a likelihood of confusion. Since the Court ruled that the "Bukhara" mark had been abandoned, to assert priority rights at the time of the Defendants' allegedly infringing use, ITC Ltd. argued that its "Bukhara" mark was famous outside of the U.S.



Newcomer Bukhara Grill: Free Riding or Filling a Void?

The Court explained that the territoriality principle recognizes that ownership of a mark in one country does not automatically confer upon the owner the exclusive right to use that mark in another country. In its opinion, the Second Circuit acknowledged that some courts, the Trademark Trial and Appeals Board (TTAB) of the U.S. Patent and Trademark Office, and commentators have adopted an exception to the territoriality principle, permitting marks used outside the U.S. and achieving a certain level of notoriety and fame in the U.S. to be entitled to protection. Despite accepting that there were legitimate policy reasons in support of the exception, the Court found that the Lanham Act does not contain a famous foreign mark exception.

In conclusion, the Second Circuit ruled that ITC Ltd. could not bring a federal claim for unfair competition since Congress had not incorporated the famous foreign marks doctrine into the Lanham Act.

In Personam

Cameron S. Reuber (pictured below) joins OSTROLENK in New York by way of our Washington, D.C. office. There, he second-chaired several patent litigations in various district courts throughout the country, as well as the Court of Appeals for the Federal Circuit, concerning a wide variety of technology including mechanical, electrical, chemical, pharmaceutical, medical devices, software, and high-density plastics.

In addition to patent matters, Cameron has also litigated several trademark, copyright, unfair competition, anti-counterfeiting, deceptive trade practices, and technology-related business disputes. During the course of his practice he has been the lead associate on two major patent litigation matters involving billion-dollar products. One of those cases resulted in a \$50 million recovery for a client – one of the top 25 patent litigation settlements of all time.

Prior to joining the D.C. Office, Cameron, a native of Smith's Parish, Bermuda, attended Fork Union Military Academy, Virginia Tech, and Wesleyan College, before receiving his Juris Doctor from George Mason University with a coursework concentration in intellectual property law.



Ee Ming Yap (pictured above) is pleased to join OSTROLENK as a Summer Associate. She has just completed her first year of law school at Franklin Pierce Law Center in Concord, NH.

Before beginning at Pierce Law, she graduated from UCLA with a B.A. While studying at UCLA, she worked as a Student Intern at an Influenza A virus lab, and later as a Lab Assistant at an Anthrax toxin lab. She co-authored "Inhibition of Influenza Virus Matrix (M1) Protein Expression and Virus Replication by U6 Promoter-Driven and Lentivirus Mediated Delivery of siRNA" published in the *Journal of General Virology* (2004) 85, 1877-1884.

Ee Ming worked last year in International Rectifier's legal department assisting attorneys on filing semiconductor patents. This, together with her biology lab work experience, sparked her interest in intellectual property law, making Pierce Law's renowned IP program a natural fit.

When Ee Ming returns to school in the fall, in addition to continuing her studies she will serve as a teaching assistant for the 1L legal writing program.

Safeguarding Your Domain Name

Your business' domain name is all at once a worldwide 24/7/365 address, telephone number, welcome mat and doorstep. Whether you meet your customers on the internet only, in brick-and-mortar locations, or a combination of the two, losing a domain name means losing business.

International governing body ICANN requires accredited domain name registrars to create and maintain a "Whois" record for each domain name it registers. Thus, registrants must provide both administrative and technical contact information including a name, address, telephone number and e-mail address.

At least annually, a registrar must present the current Whois information to the registrant, and remind the registrant that provision of false Whois information can be grounds for cancellation of their domain name. Registrants must review their Whois data, and make any necessary corrections to ensure accuracy.

Third parties who become interested in a registered domain name may use inaccurate Whois data to have the prior registration cancelled. In one case earlier this year, registrar GoDaddy.com cancelled the registration of FamilyAlbum.com, and transferred it to another customer who had placed a backorder on the name. When a party complains to a registrar that a domain's Whois data is inaccurate, ICANN regulations require registrars to investigate. In this case, the prior registrant's technical contact e-mail address was out of date, although the name and mailing address were correct. Apparently, GoDaddy.com only used e-mail to attempt to contact the prior registrant.

Therefore, it is critical to review notices from your registrars and maintain accurate Whois data in order to safeguard your domains. At the same time, you can check to use others' inaccurate Whois data offensively to seek cancellation of a domain name of interest.

by Sean P. McMahon, Trademark Paralegal

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chanics of Patent Claim Drafting, will serve as a lecturer at the program. Mr. Miro, who was named to the 2006 list of New York Super Lawyers, will serve as a clinical instructor.

A copy of the program brochure is available on the firm website at www.OSTROLENK.com, where you will also find a link to direct you to PLI's website for more information and registration. OSTROLENK is proud to have its attorneys sought out by their peers for their expertise, and to contribute to the continuing education of the patent bar.

Call for Reader Comments

We hope that you find our revamped newsletter insert useful and enjoyable to read. Together with our redesigned website, OSTROLENK is continuing its client-focused efforts to maintain open communication and build meaningful working relationships.

Every good communication channel requires input from both ends. Therefore, we have opened an e-mail address at newsletter@OSTROLENK.com to receive your comments or thoughts. If there is anything that you would like to see as a part of our newsletter in a future edition, we are eager to hear from you.

David J. Torrente, Editor