

## **February 2006 Newsletter**

### **The Federal Trademark Dilution Bill**

Currently the Trademark Dilution Revision Act of 2005, HR 863 is undergoing revision but its main provisions set out several changes in the current law pertaining to trademark holders.

- To violate H.R 683, it need only be demonstrated that a “likelihood of dilution” exists to the owner’s famous mark - much less demanding to prove. An owner will not need to wait until the diluter has caused actual economic damage to his trademark, but can redress the danger of injury, resulting from blurring or tarnishment, at its incipiency.
- The FTDA does not define fame but rather sets out an ambiguous list of eight non-exclusive factors by which courts will determine a trademark’s fame. Uncertainty plagues trademark owners and courts are hopelessly split. HR 683 instead focuses court’s consideration of fame to three criteria which will establish the new standard of “whether a mark is widely recognized by the general consuming public of the United States..”
  - The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or by third parties.
  - The amount, volume, and geographic extent of sales of goods or services offered under the mark
  - The extent of actual recognition of the mark

### **Registration Fraud**

In a January 10, 2006 decision, the TTAB again held that in signing a statement of use, applicants must make a reasonable inquiry as to whether the mark is in fact in use in connection with the goods claimed and cannot simply rely on prior registrations or on the mere fact that his or her attorney prepared the statement of use. Moreover, a subsequent restriction to the registration does not cure the earlier fraud. Fraud in obtaining the registration, however, does not invalidate ones common law rights. *Standard Knitting, Ltd –v-v Toyota Jidosha Kabushiki Kaisha Opposition No. 91116242*

### **EU Sunrise Update**

Sunrise Phase Two of the .eu domain name application process begins on February 7, 2006, and lasts until April 6, 2006. In addition to those who qualified to submit an application during Phase I, owners of any other prior rights recognized by a European Union member state is also qualified to register .eu domains during Phase II. This means owners of a well-known trademark, an unregistered trademark (if protected in the Member State in which the applicant is claiming the right), or the official name of a company as it is registered, trade names, or other business identifiers. The requirements of documentary evidence for the validation process vary depending upon the type of prior right claimed, and may include affidavits signed by the relevant competent authority attesting that the right claimed is protected by the particular member states, or proof that the right has met the Member State’s requirements to receive the protection of the prior right claimed. This second requirement in many instances may be fulfilled in the form of a Final Judgment by a court, a Certificate of Incorporation, or extract from a corporate registry.

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