

Montenegro Update

All national trademark registrations valid in Serbia as of May 28, 2008 (cut-off date) will be automatically valid in Montenegro. No revalidation of these rights is required and trademark owners are under no obligation to establish the validity of their rights in Serbia, because all existing rights as of the cut-off date have been copied from the database of Serbian IP Office to the database of Montenegro IP Office.

Serbian applications pending as of the cut-off date may be re-filed in Montenegro with original Serbian filing date preserved if re-filed by November 28, 2008.

No Fraud Pre-Publication

On May 2, 2008, the TTAB laid new precedent for the increasingly-notorious fraud cause of action. The Panel Majority in [University Games Corp. v. 20Q.net Inc.](#), Oppositions Nos. 91168142 and 91170668 (May 2, 2008), ruled that a correction of error in the goods specification of a use-based application prior to publication creates a rebuttable presumption of no fraud.

Opposer University Games Corp. filed oppositions against each of Applicant 20Q.net's applications for the mark 20Q, related to a question and answer computer game, arguing that the applications are confusingly similar to its TWENTY QUESTIONS trademark registration for a board game.

Both proceedings were ultimately consolidated, and Applicant filed for a motion for summary judgment and a counter claim of fraud, alleging that Opposer had committed fraud on the PTO when it filed its original use-based application. Opposer's original application for the mark TWENTY QUESTIONS alleged use with "Board games, t-shirts and supporting promotional materials including videos and paper products" in

International Class 28. The goods "t-shirts and supporting promotional materials including videos and paper products" were ultimately deleted following an office action requiring that they either be placed in the appropriate class or deleted altogether. During the discovery period, however, when asked to identify all products the TWENTY QUESTIONS had ever been used with, Opposer listed only those goods which appeared on the application at the time it matured to registered, namely, "a board game for correctly identifying well-known persons, places, things and years using game cards and board pieces" in International Class 28. Noting the discrepancy, Applicant filed a counter-claim for fraud alleging that Opposer fraudulently misrepresented at the time it filed its application that its mark

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.CA Domain Names Becoming More Restrictive

The Canadian Internet Registration Authority (CIRA) recently passed quarterly revisions to its policies, rules, and procedures, in relation to .CA Canadian country code top-level domain names. The most noteworthy revision, with an effective date of June 10, 2008, is the elimination of immediate availability of WHOIS information for individual Registrants. Access to WHOIS information for corporate Registrants will remain available, but may be protected in special circumstances. In the event of a trademark or other intellectual property dispute, CIRA has provided detailed Rules and Procedures for obtaining individual contact information. In addition to the WHOIS information restrictions, CIRA's own Domain Name Dispute Resolution Policy and dispute rules may present another obstacle to obtaining a registered .CA domain name that infringes upon one's intellectual property rights. This is due to the policy and rules requiring greater proof of Registrant's "bad faith" and "no legitimate interest" than typically

required for a successful UDRP proceeding. The burden of the higher standard of proof is further evidenced by the fact that only approximately 100 Dispute Resolution Decisions have been issued since 2002 through CIRA's Dispute Resolution Policy.

USPTO Pique

As has been widely discussed in the patent community, the US Patent and Trademark Office (USPTO) has been enjoined by a US District Court in Virginia from implementing new, and to most minds onerous, rule provisions restricting the number of claims, continuations and requests for continued prosecutions, and mandating submission of examination support documents that effectively requires the applicant and his attorney to perform the functions of a patent examiner. The decision has been viewed by many as just, since the attempted solution by the USPTO of its ever increasing backlog of unexamined patent applications was addressed by a sledgehammer solution that would only open the floodgates of increasingly-complex patent litigation. The breath of fresh air expected from a new, and hopefully more patent-savvy administration, no matter its political inclinations, could break open the administrative and legislative logjam created to date.

The USPTO, however, in an apparent fit of pique, has filed a notice of appeal, and must follow up with an Appeal Brief within 60 days. The consensus is that no Appeal Brief will be filed by the USPTO. Even if one is, the case will only be remanded to the U.S. District Court in Northern Virginia for determination of other issues that were not reached because of the dispositive issue that provided the grounds of the rejection, that is, that the USPTO overstepped its authority to promulgate substantive revisions that affected the rights of patent applicants.

No Fraud Pre-Publication

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was in use on “t-shirts and supporting promotional materials including videos and paper products.”

Opposer argued that deletion of the goods prior to publication of the application negated the materiality element necessary to prove fraud, as such goods were not a part of the application as considered for approval. Opposer further

clarified that at the time of its application, t-shirts and promotional products bearing the TWENTY QUESTIONS mark were in fact being distributed at trade fairs, but stated further than even if this were not the case, the deletion of the goods prior to publication requires dismissal of the fraud claim.

The Board held that the fact that Opposer amended the listing of goods prior to publication of the application constitutes

a rebuttable presumption that opposer lacked the willful intent to deceive the Patent & Trademark Office. Judge Walsh dissented, not disagreeing with the dismissal of the fraud claim, but stating his opinion that summary judgment should have been granted *sua sponte* to Opposer because timely correction of an error prior to registration and prior to any challenge to the application should completely defeat any fraud claim.