

FENNEMORE CRAIG

I - Law

INTELLECTUAL PROPERTY LAW ALERT

Fennemore Craig I-Law, a bi-weekly e-mail from Fennemore Craig's Intellectual Property Group, provides an update on e-commerce, Internet, trademark, patent, licensing and copyright news.

Fennemore Craig counsels clients on Internet, branding and e-commerce issues and protection and commercial exploitation of patents, copyrights, trademarks, and trade secrets. Clients include a range of domestic and international businesses from Internet start-ups to large multi-nationals in industries ranging from computer software and hardware to pharmaceuticals, toys, games, optics, and electronics.

If you think other people would benefit from this communiqué, please let them know that they can subscribe by sending an e-mail to Cheryl Martin-DeVries at cdevries@fclaw.com. Back issues of *Fennemore Craig I-Law* can be found at the Issues & Answers section of our web site at www.fennemorecraig.com.

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TRADEMARKS

- Shortly after the Iraq war began, Sony filed an application to register "Shock & Awe" as a trademark for an online and video computer game. It subsequently withdrew the application. 13 other applications for SHOCK AND AWE were also filed.
http://www.gamesindustry.biz/content_page.php?section_name=pub&aid=1511
(free registration required)
<http://www.nandotimes.com/technology/story/850527p-5964227c.html>
- Friends don't let friends select trademarks without an availability search. AOL once again learns the lesson that it is critical you check out the availability of a new trademark before adopting it. AOL was changing the name of its Mozilla browser to Phoenix, but that was already taken. So now the new name is Firebird, but that may already be taken too.
http://news.com.com/2100-1032-997089.html?tag=fd_top

- More on the recent district court decision allowing the use of a competitor's name in metatags.
<http://ipcenter.bna.com/pic2/ip.nsf/id/RSAR-5LHHUA?OpenDocument>
- Use of trademarks in the "post-domain path" of an URL is not a trademark infringement. The "post-domain path" is all the stuff that follows the domain name. For example, all the stuff after "fennemorecraig.com" in "fennemorecraig.com/Harlem Globetrotters/Everyeady/Mail Boxes Etc./" is the "post-domain path." First link to media coverage; second link to case.
<http://research.yale.edu/lawmeme/modules.php?name=News&file=article&sid=1072>
<http://pacer.ca6.uscourts.gov/opinions.pdf/03a0111p-06.pdf>
- Supreme Court refuses to hear bargainbabies.com trademark dispute brought by the Beanie Babies' people.
http://biz.yahoo.com/djus/030407/1603001037_1.html
- Brand new name; same company. WorldCom is changing its name in order to remove the taint associated with its prior scandals. The new name will use its more popular subsidiary name, MCI.
<http://www.washingtonpost.com/wp-dyn/articles/A5192-2003Apr10.html>

COPYRIGHTS

- The Digital Millennium Copyright Act strikes again. Two computer science students were forced to cancel their presentation to a security conference after receiving a cease and desist letter (as well as a TRO) prior to the presentation.
(archive fee required to view entire article)
<http://www.salon.com/tech/feature/2003/04/15/acidus/>
- 85 Navel Academy midshipmen punished for illegally downloading music and movies.
<http://www.washingtonpost.com/wp-dyn/articles/A28647-2003Apr15.html>
- Combination of unprotectable elements receives narrow copyright protection, but only from direct copying. In this case, it was a glass-in-glass jellyfish sculpture.
<http://ipcenter.bna.com/pic2/ip.nsf/id/RSAR-5LHHU4?OpenDocument>
- ACLU fails to have the Digital Millennium Copyright Act declared unconstitutional, at least at the trial court level.
http://news.com.com/2100-1025-996245.html?tag=cd_mh
- British Internet cafe agrees to pay content provider settlement for allowing customers to download copyrighted works.
<http://news.com.com/2110-1025-996248.html?tag=cdsht>
- Not surprisingly, college students are simply not accepting the efforts (such as recent lawsuits against students) of the recording industry to stop music downloading. This quote has to send chills through the industry: "This is exactly like going to the library. Do I have to pay to check out a book? I'm just listening to the song, not selling it."
http://www.usatoday.com/life/2003-04-09-download_x.htm

ONLINE & E-COMMERCE ISSUES

- 48,000 Internet fraud complaints to FBI in 2002; 3X as many as the year before.
http://news.com.com/2100-1025-996270.html?tag=cd_mh
- Oh, the humanity! Many of those who do not use the Internet are avoiding it because they (gasp!) are not interested.
http://news.com.com/2100-1032-997140.html?tag=cd_mh
<http://www.washingtonpost.com/wp-dyn/articles/A41817-2003Apr16.html>

- Police chief suspended for failing to deal with racist and sexually offensive emails sent by others in the department.
http://www.pantagraph.com/stories/041503/new_20030415014.shtml
- Marketers are beginning to use weblogs to sell products. The thinking, apparently, is that weblogs are more "real" and therefore, more effective than commercials. We'll see.
<http://slate.msn.com/id/2081419/>
- Using webbloggers can spin out of control (Warning: Mature themes discussed in this article).
<http://slate.msn.com/id/2081467/>
- Get rid of the "elvisthechicken2003@yahoo.com" email address. Job applicants who use unusual email addresses are less likely to get the job, according to a UK survey.
http://news.com.com/2100-1032-996938.html?tag=cd_mh
- There is now a web site that allows consumers to name their own price for any product they want. How? By allowing consumers to create their own bar codes for products using the site's bar code generator. All the consumer needs to do is take the generated bar code and place it over the product's bar code at any store. Site creators claim the site is a satire commenting on the absurdity of web sites which claim they are "giving power" to consumers by allowing them to name their own price. Companies that use bar codes, like Wal-Mart, think the web site is inciting theft and fraud.
(archive fee required to view entire article)
<http://www.salon.com/tech/feature/2003/04/10/barcode/index.html>
<http://www.washingtonpost.com/wp-dyn/articles/A25386-2003Apr14.html>
- Seventh Circuit holds that Internet ban as a condition for release from prison is improper.
<http://www.ca7.uscourts.gov/op3.fwx?submit1=showop&caseno=02-1389.PDF>
- State law barring sale over the Internet of wine to someone in the state is an unconstitutional violation of the commerce clause.
<http://news.com.com/2110-1028-996242.html?tag=cshrt>
- Single publication rule applies to defamation published online.
<http://caselaw.lp.findlaw.com/data2/circs/2nd/009220p.pdf>
- An anti-spam company created a spam filter that employs Haiku poetry as part of the filter. Now the company is suing bulk-spammers for copyright and trademark infringement because they are illegally copying and inserting the Haiku in their spam to bypass the filter.
http://news.com.com/2100-1024-995568.html?tag=cd_mh
- Haiku suit settled
I-Law writes own haiku
No one is happy
<http://www.internetnews.com/IAR/article.php/2191441>
- Insurance companies like spam.... or, at least, they oppose New York's anti-spam bill.
<http://albany.bizjournals.com/albany/stories/2003/04/07/daily18.html>
- Generally speaking, it is a bad idea to buy your driver's license online. FTC is now shutting down web sites that sell them by sending out spam.
(free registration required)
<http://www.latimes.com/technology/la-hy-wheels16apr16001424.1,7165203.story>
- Just a drop in the ocean. Man sues spammer under Idaho state anti-spam law that allows award of \$100.
http://www.usatoday.com/tech/news/techpolicy/2003-04-14-spam-court_x.htm

- A much larger drop in the ocean! AOL sues 5 major spammers seeking \$10 million.
http://news.com.com/2100-1025-996864.html?tag=fd_top
<http://www.washingtonpost.com/wp-dyn/articles/A26420-2003Apr14.html>
- Spam is hell. War results in more spam.
<http://www.washingtonpost.com/wp-dyn/articles/A55170-2003Apr8.html>
- Patriotism is the last refuge of spammers.
<http://www.washingtonpost.com/wp-dyn/articles/A1191-2003Apr9.html>
- Even our fighting men and women are getting lots of spam (which is particularly annoying since they are limited to 1/2 hour of email per day).
(free registration required)
<http://www.latimes.com/technology/la-war-spam5apr05,1,2647916.story>
- Anti-spam activist does not need to take down personal information about an alleged spammer from his web site.
<http://www.washingtonpost.com/wp-dyn/articles/A51721-2003Apr7.html>
- Is pornography spam going to become more than just a technical problem and annoyance for employers? Some think a failure to stop pornography spam could create a "hostile environment" for employment sexual harassment claims.
http://news.com.com/2100-1032-995658.html?tag=fd_lede1_hed
- Saddam Hussein memorabilia is selling like hotcakes online.
(free registration required)
<http://www.nandotimes.com/technology/story/849377p-5957512c.html>
- The town of Amboy (located in the Mojave Desert in California) tried to sell itself on eBay last month, but no one bid its asking price.
(free registration required)
<http://www.nandotimes.com/technology/story/844554p-5932277c.html>

PRIVACY

- Republicans want to make the Patriot Act (which makes spying on citizens and others who the government says are dangerous) permanent. Currently, the law is set to expire in 2005.
(free registration required)
<http://www.nytimes.com/2003/04/09/international/worldspecial/09TERR.html>

BIOTECH ISSUES

- Map of the human genome is completed.
<http://www.washingtonpost.com/wp-dyn/articles/A26372-2003Apr14.html>

DOMAIN NAMES

- Prudential insurance company could not recover prudentialmotors.com from a pornography operator because domain name was not similar enough to Prudential's trademark (!).
http://www.demys.net/news/2003/04/10_pr.htm
- Arizona's Citizens Clean Elections Committee has obtained the domain name AZCleanElections.com, .net, and .org.
<http://www.cpradr.org/ICANNDecisionCPR0305-030324.htm>

- Congress passes legislation that makes it a crime (yes, jail time) for intentionally using innocuous sounding domain names for pornography sites. The law also makes computer generated child pornography illegal
<http://www.washingtonpost.com/wp-dyn/articles/A4830-2003Apr10.html>
<http://news.com.com/2110-1028-996537.html?tag=cdshrt>
- Norristown town officials have sued the owner of norristown.com to get the domain name.
http://www.timesherald.com/site/news.cfm?newsid=7650028&BRD=1672&PAG=461&dept_id=33380&rfi=6

PATENTS

- Including your own patent in your disclosure statement to the Patent Office does not constitute an admission that the patent is prior art.
<http://ipcenter.bna.com/pic2/ip.nsf/id/BNAP-5LMLXR?OpenDocument>
- The Supreme Court isn't going to like this. Federal Circuit Court decides it can ignore Festo and decide case on other grounds, even though the Supreme Court remanded the case to the Federal Circuit instructing it to reconsider its decision in light of Festo.
<http://ipcenter.bna.com/pic2/ip.nsf/id/RSAR-5LHHU3?OpenDocument>

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