

Trademark Review

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Ron Paul's Complaint to Regain RonPaul.org Constitutes Reverse Domain Hijacking

In connection with Ron Paul's presidential campaign in 2012, two supporters of Ron Paul registered the domain names RonPaul.com and RonPaul.org. The owners of the domains used them as a political fan website to promote Ron Paul, his presidential campaign and political ideals. The ronpaul.org domain redirected to the website operated at ronpaul.com. Mr. Ron Paul, however, objected to use of his name and filed domain name dispute proceedings before the WIPO Arbitration and Mediation Center. Mr. Paul alleged there was a high likelihood that people visiting the site would be confused and believe that he endorsed the site, and that the Respondents registered and were using the domain names in bad faith. The WIPO panel found that the website clearly dispels any confusion and ruled that the website was a legitimate fan site that does not seek to take unfair advantage of Mr. Paul. Further, WIPO found there was no bad faith because the site is a legitimate fan site, the Respondents offered to sell ronpaul.com only after Mr. Paul solicited an offer, and the Respondents offered the domain name ronpaul.org to Paul for no charge. Thus, the WIPO panel denied Mr. Paul's request that the domains be transferred to him. WIPO also agreed with the Respondents by ruling that Mr. Paul's proceeding against the domain that had been offered to him for free was brought in bad faith and constituted "Reverse Domain Hijacking." Reverse Domain Hijacking refers to the attempt by a trademark owner to secure a domain name by making false cybersquatting claims against the rightful owner of a domain name. Under WIPO rules, there is no penalty associated with a finding of reverse domain hijacking other than denial of the Complaint.

Paul v. Whois Privacy Services Pty. Ltd. (Case number D2013-0278), and *Paul v. DN Capital Inc.*, (Case number D2013-0371) (WIPO May 2013).

MOTT'S for Baby Food Is Considered Primarily Merely a Surname

The MOTT'S mark has been in use since 1842 for applesauce and juices. The products bear the surname of the founder, Samuel R. Mott. Mott's, LLP filed two applications to register the mark MOTT'S for baby food products. The Patent and Trademark Office refused registration on the ground that MOTT'S is primarily merely a surname. The Trademark and Trial Appeal Board affirmed the refusal of the application.

Applicant tried to establish that MOTT'S is not primarily merely a surname because MOTT is only the 1,941st most common surname and thus, is a rare surname. The Board found it is uncommon, but not rare. If Mott can establish that MOTT's also identifies a historical place or person, then it is not primarily merely a surname. In reply to the Examining Attorney's evidence that

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“Mott” has no significance other than as a surname, Applicant argued that “Mott” is a reference to Samuel R. Mott, a historical figure so widely recognized that use of MOTT has lost any surname significance. The Board disagreed, however, that Samuel R. Mott is in any way so extraordinary that he warrants treatment under the “historical person” exception to the surname refusal. The final factor considered by the Board is whether “Mott” has the look and feel of a surname. The Board found that it does.

The Applicant owns several registrations for MOTT’S, but the Board found those other registrations had little probative value in this case. The Board ruled that the prior registrations do not conclusively rebut the Examining Attorney’s position that MOTT’S is primarily merely a surname and allowance of prior registrations does not bind the Board. The Board noted that “while a uniform standard for assessing registrability of marks is an admirable goal, the Board must assess each mark on the record of public perception submitted with the application.”

In re Mott’s LLP, (TTAB April 30, 2013)

Company Uses More than Is Reasonably Necessary to Advertise that its Test Strips Work with Another’s Meters

Shasta sells generic test strips for use in glucose meters sold by LifeScan. Shasta was using an image of LifeScan’s OneTouch UltraMini glucose meter on the packaging and in advertising for its GenStrip test strips to show consumers that the test strips are made for use with the LifeScan device. Following is an image of the GenStrip packaging and an image from Shasta’s website:



GenStrip’s packaging

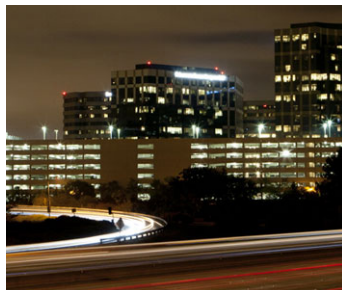


Shasta’s website

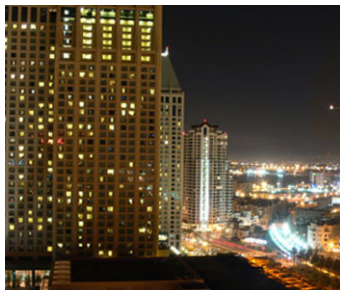
LifeScan sued Shasta for trademark infringement and sought a preliminary injunction. The court granted the preliminary injunction finding that the injunction would not deprive the public of Shasta’s test strips. Rather, the court found the injunction would reduce confusion by removing misleading advertisements and packages from the marketplace. The injunction prohibits use of any image of LifeScan’s OneTouch meters LifeScan’s and use of OneTouch logos and stylized font on the packaging, labels, or advertisements for the GenStrip product. The injunction does not prohibit Shasta from indicating that its test strips work with the LifeScan meters provided it does not use images or logos to do so. LifeScan conceded that Shasta can use the text of LifeScan’s registered marks to refer to the LifeScan meters under the nominative fair use doctrine.

LifeScan Inc. et al v. Shasta Technologies LLC et al, (Case number 3:12-cv-06360-JST N.D.Ca. May 22, 2013)

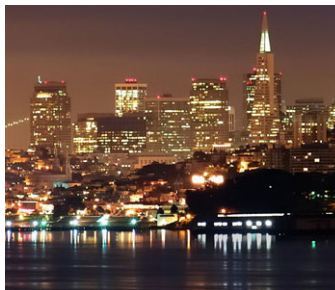
Knobbe Martens Offices



Orange County



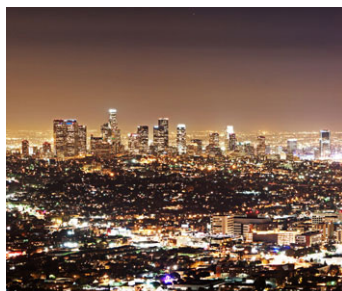
San Diego



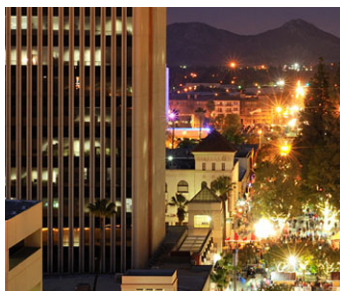
San Francisco



Silicon Valley



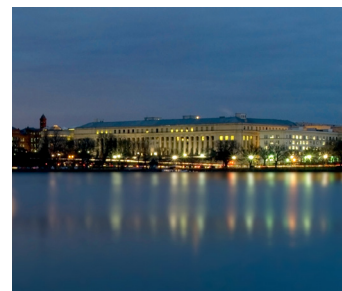
Los Angeles



Riverside



Seattle



Washington DC

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