

### THREE AND A HALF YEARS ENOUGH FOR LACHES

Three and a half years is a sufficient delay for the purposes of establishing laches, according to the TTAB. The Board found that under §22 of the Trademark Act, Petitioner had constructive knowledge of Respondent's registration as of the registration date. Although Petitioner prevailed by a preponderance of evidence in demonstrating a likelihood of confusion, the Board took a very dim view of the fact that the Petitioner in its pleadings had remained "*conspicuously silent regarding its reasons for the delay*" in commencing the cancellation action. Both parties used the mark GOLD SEAL, one on aircraft engine transmission harnesses and the other on aircraft engines. The marks had coexisted for over 10 years without there being any known instances of actual confusion. The Board found Respondent's investment in and development of its trademark during the intervening "*prolonged (three and a half year) period*" between registration and Petitioner's action demonstrated sufficient evidence of economic prejudice to support laches. *Teledyne Technologies, Inc. –v- Western Skyways, Inc. (Cancellation 92041265)*

### ADWORDS AND TRADEMARK LINKING UPDATE

"Where keyword placement of . . . advertising is being sold, the portals and search engines are taking advantage of the drawing power and goodwill of these famous marks." McCarthy on Trademarks & Unfair Competition § 25:70.1 (2004). Presently, the ultimate determination of liability remains unclear. In early 2005, Google faced potential liability for facilitating trademark infringement. Its "Adwords" program charged a fee to attach unaffiliated advertisements for competitor products to the results of searches incorporating trademarked words or terms. *GEICO v Google* (E.D. Va. 2005). The case later settled. More recently, Office Depot initiated a trademark infringement action against competitor Staples who purchased the keyword "VIKING". Viking Office Products is a subsidiary of Office Depot. In part, these cases focus on the theory of Initial Interest Confusion, a doctrine permitting a finding of infringement in circumstances involving only temporary confusion and where any confusion is dispelled before a purchase is actually made. What does appear to be settled is that no sale need actually take place for a trademark owner to incur actionable harm. The Internet user will have reached the site because of the defendants' use of another's trademark and such commercial use can be actionable. *Playboy v. Netscape Communications* (9<sup>th</sup> Cir, 2004).

### PUZZLER: FREEDOM FRIES for FRENCH FRIES NAME OR SOURCE IDENTIFIER?

*In re Grand Forest Holdings Incorporated (Serial Number 78220033)*, the TTAB illustrated just how thin the line can be between descriptiveness and distinctiveness. Despite evidence documenting numerous third party uses of Freedom Fries as a name for French fries, including action by the US House of Representatives changing all references to French fries on the congressional cafeteria menu to Freedom Fries as a gesture of displeasure over France's opposition to the war in Iraq, the Board, in a Citable Decision found that the record "*lack(ed)...significant evidence that, when prospective purchasers encounter the term FRENCH FRIES used on frozen French fried potatoes, they will immediately understand that it identifies a feature, quality, or characteristic of applicant's goods or that it is a secondary name of applicant's goods.*" The record included details of similar menu changes by national restaurant chains such as Fuddruckers as well as a cacophony of newspaper commentary on the issue.

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