

USPTO Will Recalculate Patent Term Adjustments, Fee-Free

In our January 2010 newsletter, we reported on the Federal Circuit's recent holding that the USPTO erroneously calculated patent term adjustments (PTAs) under the "overlap" provision of 35 U.S.C. 154(b)(2)(A). See also *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

The USPTO is now allowing patent holders to request a fee-free recalculation of a patent's PTA, if the request meets the following criteria:

1. *The request must state that the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A).*

2. *The patent must issue before March 2, 2010, and the request must be submitted no later than 180 days after issue.*

Notably, patents issued before August 2009 and after March 2, 2010 are not eligible for fee-free PTA recalculation. The USPTO has not yet provided a fee-free mechanism to request PTA recalculation under *Wyeth* for patents issued before August 2009. Also, the USPTO indicates that as of March 2, 2010, a new computer program will calculate PTAs in compliance with the *Wyeth* holding, so that recalculations of pre-*Wyeth* PTAs will no longer be necessary.

IpHorgan Attorney Named 2010 "Super Lawyer"

We are proud to announce that our Director of Patents, Michael L. Kenaga, was named an *Illinois Super Lawyer* for 2010. *Super Lawyers* magazine names the highest-ranking attorneys in each state, as chosen by their peers and through the independent research of *Law & Politics*. This is the third year Michael has received this honor.

Geo Domain Names Transferred to Trademark Owner in Controversial Decision

In a recent Domain Name UDRP decision, Complainant, Hayward Industries, Inc. of Elizabeth, New Jersey, was successful in obtaining a transfer of the domain names HAYWARD.COM and WWWHAYWARD.COM from Respondent, domain investor Chad Wright, aka WebQuest.com, Inc. In the controversial decision, the three-member panel from WIPO included commentary that the value paid for one of the domain names was a factor in determining the third element of a UDRP, namely, registration and use in bad faith.

Complainant sells a variety of swimming pool products under HAYWARD trademark, which has been registered in the United States since 1977. Respondent had purchased the domain names in 2006, paying \$20,000 for HAYWARD.COM, allegedly for its value as a geographic domain related to the location of Hayward, California. Hayward is a city of approximately 150,000 located in Northern California. Respondent is the owner of a number of other geographic domain names that provide pay-per-click (PPC) search engines related to the locale. The subject domain name resolved to a parking page with PPC links unrelated to the geographic location and containing links to Complainant's competitors.

Three years after receipt of a demand letter from Complainant in 2006, requesting

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IpHorgan Named "Go-To" Firm for Intellectual Property

IpHorgan is pleased to announce that it has once again been named a "Go-To" Firm by *Corporate Counsel* magazine. The annual survey polls in-house counsel at the top 500 U.S. companies for preferred law firms. This year, IpHorgan has been nominated by two of its top clients as a go-to law firm for Intellectual Property.

Who Owns WHO DAT?

Super Bowl XLIV has come and gone, with the underdog New Orleans Saints snatching a surprise 31 to 17 victory over the Indianapolis Colts. With the Super Bowl over, there is no more NFL football until the next pre-season opener in July. So what is a die-hard fan to do now? Why not analyze one play of the National Football League's trademark defense leading up to the Big Game?

Licensing of professional sports trademarks is a multi-billion-dollar industry. The NFL oversees both the sport of professional football and the business of same, including management of the Intellectual Property of the league and its 32 teams. As clearinghouse for and protector of league trademarks, the NFL has taken the middle linebacker position and been very aggressive over the years, going to significant lengths to protect professional-football-related marks from infringement.

WHO DAT is a cheer New Orleans Saints fans cry at football games. Saints fans refer to themselves as "The Who Dat Nation." WHO DAT itself derives from the chant "Who dat say dey gonna beat dem Saints," which—with its Southern edge and New Orleans flavor—Saints fans have used to cheer on their team since its inception in the 1960s. WHO DAT, as shorthand for the cheer, has appeared on various apparel and other items over the years. With the success the Saints enjoyed during this most recent football season and leading up to the Super Bowl, WHO DAT items saturated the market.

With WHO DAT, the NFL brought a full-on blitz against a number of sellers of merchandise bearing that mark. Because of the association between WHO DAT and the NEW ORLEANS SAINTS trademark, which the NFL owns and licenses, the league asserted trademark rights in the WHO DAT term, claiming that any use,

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outside an official license, was an infringement. During the week before the Super Bowl, the NFL dispatched numerous cease-and-desist letters to businesses like souvenir and T-shirt shops as well as sporting-goods stores from Bourbon Street to Miami, alleging infringement of the WHO DAT mark.

Though its defense is usually quite successful, some very powerful players read the NFL's blitz and moved swiftly to stop it. WHO DAT is a term rooted in a team cheer which, in turn, has deep roots in Louisiana and New Orleans culture, with references to WHO DAT going back to the early 1900s. As such, according to NFL detractors, the league cannot claim

sole ownership of WHO DAT. Response to the NFL came from Louisiana Senator David Vitter and Representative Charlie Melancon. WHO DAT, they asserted, is a piece of New Orleans culture and belongs to the people. Even Louisiana Governor Bobby Jindal instructed the Louisiana Attorney General to investigate potential litigation against the NFL for trying to usurp rights to WHO DAT.

With its attack thwarted, the NFL quickly huddled and only days before the Super Bowl clarified its position on WHO DAT, retracting most of its cease and desist demands. Rather than seeking to stop any use of WHO DAT, the NFL agreed it would only seek to cease use of that term when it appeared in connection with any

other unlicensed NFL trademarks. In other words, the NFL would only seek to prevent sales of unlicensed merchandise and only where another NFL mark appeared in connection with WHO DAT.

In the end, New Orleans walked away with two victories in the Super Bowl. The Saints won the Lombardi Trophy and the people of New Orleans stopped a formidable defense. Though this may just have to tide football-trademark fans over until the NFL preseason next summer, pitchers and catchers report to Spring Training in only a few days. The return of baseball will certainly mark a welcome return of sports trademark and licensing activity to follow.

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the transfer of the domain names, Respondent offered the domain name HAYWARD.COM for sale via an online auction in 2009, with an opening minimum bid of \$100,000. Respondent claimed that he had rights or legitimate interests in the domain names because "Hayward" is a geographic mark, which also has a number of other meanings and uses, and that PPC sites constitute a *bona fide* offering of services. Respondent further claimed that he never knew of Complainant, and that Complainant needed to show that it had famous rights or reputation in the name as being associated with Complainant's trade name and trademarks. Respondent also claimed that it was not significant that the parking page was not yet developed in relation to the geographic location.

In the decision, there was no dispute regarding the first element of a UDRP, namely, that the domain names were identical or confusingly similar to the HAYWARD trademark.

In the analysis of the "Rights or Legitimate Interests" element of a UDRP, the Panel

agreed with Respondent that "Hayward" is the name of a city in California and that PPC websites are not in and of themselves unlawful or illegitimate. It noted, however, that the websites had yet to be developed in accordance with the claim of Respondent's counsel more than three years earlier that the disputed domain names were related to the geographic location. Because the websites contained links to Complainant's competitors, rather than being used for links solely in connection with the geographic locale, the Panel found that Respondent had no rights or legitimate interests.

The most controversial part of the decision is in regards to whether domain names were registered and used in bad faith. Complainant had specifically alleged that bad faith existed because Respondent acquired the domain names primarily for the purpose of disrupting the business of a competitor. The Panel determined that Respondent was not a "competitor" as contemplated by the UDRP policy, since there was no direct competition. The Panel determined that there was bad faith, however, noting that PPC parking pages built around a trademark that contain

or lead to pages with links to trademark owner's competitors (as contrasted with PPC pages built around a dictionary word and used only in connection with the generic or merely descriptive meaning of the word) do not constitute a *bona fide* offering of goods or services, or a legitimate non-commercial or fair use. The Panel also rejected Respondent's claim regarding the fame of Complainant's mark, stating that "Respondent bears complete responsibility for how the disputed domain names were used and could have taken, but failed to take, steps to ensure that they were not used in connection with goods or services competitive with those offered under the HAYWARD trademark."

In its final analysis, the Panel found it informative, though not decisive, that the Respondent had purchased the domain name HAYWARD.COM for \$20,000 and was attempting to sell it for at least \$100,000. The Panel claimed that these figures would seem to indicate that Respondent saw some value in that domain name beyond its existence as the name of the city of Hayward, California, and for purposes other than as a PPC

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parking page which typically would not be expected to earn a return to justify the large investment.

This controversial finding would seem to be adding an additional subjective

factor of value paid for a domain name into the determination of whether there is registration and use of a domain name in bad faith for UDRP analysis and decisions. It would appear, however, that the UDRP outcome may have been different if Respondent had developed the domain

names into sites that contained PPC links related to the geographic location, within the interim three years after registration, rather than allowing the parking-page sites to remain with links to competitors of Complainant.