



RED OR WHITE? IT MAY NOT MATTER

For over ten years, trademark dilution has been grounds for opposing or canceling a trademark before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office (the “Board”). During this time, the Board has issued only a handful of trademark dilution decisions. Recently, in *National Pork Bd. v. Supreme Lobster and Seafood Co.*, Opp. No. 91166701 (TTAB June 11, 2010), the Board upheld a trademark opposition on the grounds of dilution.

In this case, Supreme Lobster and Seafood Company (“Supreme”) tried to register the trademark THE OTHER RED MEAT, for fresh and frozen salmon. The National Pork Board and National Pork Producers Council (collectively “Opposers”) opposed the registration on the grounds that Supreme’s mark was likely to cause confusion and dilute Opposers’ mark, THE OTHER WHITE MEAT, for “association services namely, promoting the interests of

members of the pork industry.”

The Board considered three points: whether THE OTHER WHITE MEAT is famous; whether THE OTHER WHITE MEAT became famous prior to the date of

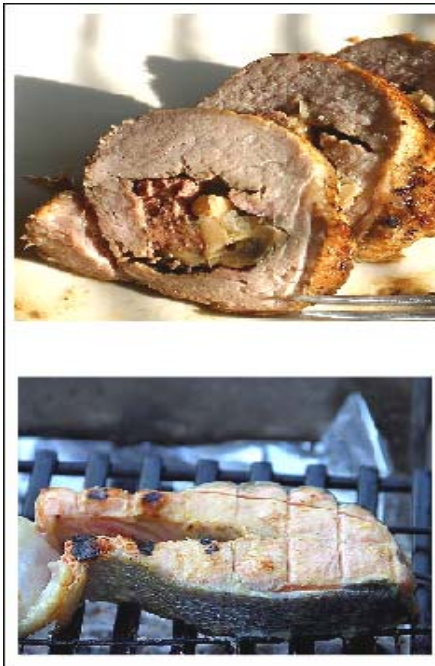
Supreme’s intent-to-use trademark application; and whether THE OTHER RED MEAT is likely to blur the distinctiveness of the THE OTHER WHITE MEAT. The analysis was considered in view of Section 43(c) of the Trademark Act and the facts alleged in the case.

The Opposers alleged that approximately \$550 million had been spent on promotion and advertisement of pork products using THE OTHER WHITE MEAT. Promotion activities included radio, television, billboard, taxi cab, and transit shelter advertising campaigns, as well as featuring the mark in supermarket promotional programs, on meat pack-

age labeling, celebrity endorsements, and Internet websites. The Opposers also alleged that some retailers and food manufacturers participated in co-branded advertising campaigns to promote the mark. These were effective factual allegations.

In addition, the Board considered a consumer survey conducted in 2000 by Northwestern University that showed nearly eighty percent awareness of THE OTHER WHITE MEAT mark among the general adult population. The survey showed that the slogan ranked higher than other marks that have been recognized as famous, including

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JUST DO IT, DON'T LEAVE HOME WITHOUT IT, and KING OF BEERS. Accepting Opposers' contention that THE OTHER WHITE MEAT was among the most well-known advertising slogans in the United States, the Board concluded that Opposers' mark is famous. The Board also concluded that the fame was established prior to Supreme's intent-to-use trademark application filing date.

As for the issue whether THE OTHER RED MEAT is likely to blur the distinctiveness of the THE OTHER WHITE MEAT, the Board found the two marks were highly similar because both had the same structure and cadence, as well as three of the same words. Both slogans were found to evoke the same thought process, which was suggestive of a comparison of the promoted meat with other kinds of meat. The Board referred to Opposers' dilution survey showing that more than 35% of respondents associated Supreme's THE OTHER RED MEAT with Opposers' THE OTHER WHITE MEAT,

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alone or in combination with other information, establishes a *prima facie* case of unpatentability, or (2) is inconsistent with any of the applicant's arguments in favor of patentability.

Non-compliance with this duty can invalidate a patent and give rise to a charge of inequitable conduct. In *Therasense*, representations were made to the European Patent Office that were in contradiction to representations made to the United States Patent and Trademark Office ("PTO"), in a related patent application. The contradictory statements were not disclosed to the PTO. The contradictions and lack of disclosure led to a finding of inequitable conduct, which invalidated the patent. *Therasense* appealed.

At issue in *Therasense* is whether the doctrine of inequitable conduct has been expanded beyond its original application to cases of intentional fraud, and whether its abuse by defendants in patent infringement cases warrants revising the legal standards associated with the doctrine. The Federal Circuit is now considering the tests for proving materiality and intent, and whether a party's intent should be determined based on a reference's materiality.

Dozens of briefs were submitted to the Federal Circuit by interested parties, including the PTO. The threat of inequitable conduct causes patent applicants to deluge patent examiners with prior art references, even though such references may be only remotely connected to the subject matter of a patent application. The result is overwhelmed patent examiners and applicants alike.

Check back with the Ostrolenk Faber newsletter for updates on this important case.

Douglas A. Miro, Partner
Joel J. Felber, Associate

Inequitable Conduct: Revisited



The vast majority of defendants in patent infringement suits make a claim of inequitable conduct in order to invalidate the patents that they allegedly infringe. This defense charges that a patent in question was procured by committing fraud on the Patent Office.

The standard for alleging inequitable conduct may be too low, and oral arguments on this issue were recently held in the Court of Appeals for the Federal Circuit in *Therasense v. Becton Dickinson* ("*Therasense*"), and a decision is due out by the end of the term.

During patent prosecution, applicants and their attorneys are under a duty to disclose to the Examiner any prior art which (1) either

Intellectual Property Protection

Part 2 in a Series

This is the second part in a continuing series of articles to address steps for protecting valuable intellectual property. This Winter 2010 Ostrolenk Newsletter series continues with steps

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PROSECUTION LATCHES - 1998... 1999... 2000... 2001... 2002...

"Prosecution latches" is a defense that a patentee unreasonably and unexplainably delayed prosecution of a patent application. This may be used as a basis to rule that any resulting patent is unenforceable.

Prosecution latches has been likened to a silver bullet to a charge of patent infringement involving so-called "submarine patents." Submarine patents are patents that claim priority back many years, sometimes decades, and only become publicly known upon issuance. Once recognized as narrowly effective against the infamous Lemelson "submarine patents," prosecution latches grew to be a popular tool for a wider range of infringement charges. The Court of Appeals for the Federal Circuit ("CAFC"), however, has recently severely curtailed the use of prosecution latches as a defense.

In *Cancer Research Technology Ltd. v. Barr Laboratories, Inc.* (Fed. Cir 2010), the CAFC reversed a district court finding of prosecution latches, and inequitable estoppel. In addition, the CAFC substantially narrowed the applicability of prosecution latches to prevent enforcement of a patent.

The case involved a patent specification dating back to 1982 that identified sets of thirteen tetrazine derivatives with anticancer activities based on animal studies. Initially, the Patent Office rejected the claims in the application for lack of utility. Rather than filing a substantive response, the applicant simply filed a continuation application, and allowed the parent application to go abandoned. This pattern went on for years. In 1991, Cancer Research obtained ownership of the then pending patent application, and responded substantively to the Patent Office. A patent issued in 1993.

The U.S. Food and Drug Administration later approved a compound covered by the patent (marketed as TEMODAR) for the treatment of one type of cancer in 1999, and a second in 2005, and in 2007 Barr Laboratories filed an Abbreviated New Drug Application ("ANDA") for a generic form of TEMODAR. Cancer Research sued Barr for patent infringement.

After a bench trial, the district court found that the patent at issue was unenforceable due to prosecution latches and inequitable conduct. The district court accepted Barr's argument that, since no meaningful response was provided to the repeated Patent Office rejections for almost a decade, the patent was unenforceable due to prosecution latches. The district court concluded that the delay was unreasonable and unexplained, and thus, prosecution latches applied.

On appeal, however, the Federal Circuit reversed. In particular, the CAFC held that prosecution latches doctrine requires a showing of prejudice in addition to unreasonable delay. More specifically, the Court held that "to establish prejudice, an accused infringer must show evidence of intervening rights, i.e., that either the accused infringer or others invested in, worked on, or used the claimed technology during the period of delay." (Slip Op. at 9). Barr provided no evidence to suggest that it or any other party attempted to develop the claimed compounds during the period of delay. The CAFC further reasoned that there was no public harm caused by the unreasonable delay since, in the absence of the patent, Cancer Research likely would not have been incentivized to develop TEMODAR.

In dissent, Judge Prost rejected the notion that prosecution latches requires prejudice and intervening rights, based on lack of precedent. Judge Prost also noted that Barr and the public were harmed by Barr's inability to market a generic version of TEMODAR.

Although prosecution latches remains a valid defense, it may be harder to use. Beyond showing merely unreasonable and unexplained delay during prosecution, defendants will now have to show that the delay caused prejudice in some way to another party. Indeed, the majority in *Cancer Research* requires a showing of intervening rights to prove such prejudice. This raises the standard considerably, and may likely remove this defense from the arsenal from many defendants.

Keith J. Barkaus, Associate



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which clearly demonstrated an association between the marks.

The Board also took note that Opposers' mark was entitled to a presumption of inherent distinctiveness for being incontestable (a "Section 15 Affidavit" had been acknowledged), and that Opposers' use of the mark THE OTHER WHITE MEAT was virtually exclusive. The Board also remarked that Opposers' mark has "become part of the fabric of popular culture in the United States," and was the fifth most recognized consumer slogan in the United States according to the Northwestern Study. This high recognition of Opposers' mark in the United States supported a finding of dilution.

The Board also considered evidence that Supreme's CEO was aware of Opposers' mark and that Supreme had customer relationships with restaurants in the Chicago area that participated in Opposers' THE OTHER WHITE MEAT campaign. The Board also considered that Supreme had admitted choosing the mark THE OTHER RED MEAT to suggest nutritious qualities of salmon, which happened to be the same connotation with respect to pork that Opposer intended with its mark. The Board was reluctant to hold that Supreme acted in bad faith. The Board concluded, however, that Supreme's belief that it was permissible to create an association with Opposers' mark was sufficient to support a conclusion of likelihood of dilution by blurring, and sustained the opposition as a result.

This case highlights the importance of surveys to establish dilution and blurring. Moreover, brand surveys are good indicators of a mark's level of fame of a mark.

Sean P. McMahon, Associate

Intellectual Property Protection (Continued from page 2)

associated with trademark protection.

In the Fall, 2010 Newsletter, we discussed conducting a trademark search for the possibility of an identical or similar mark to yours. If an identical or similar mark is disclosed in either a knock-out or full search, you will not necessarily

be precluded from using or attempting to register your proposed mark. Whether your mark infringes another mark is determined by considering a number of factors, including not only the similarities of the marks, but also the strength or fame of the existing mark, the similarities between the respective goods or services and channels of trade, the quality of the goods or services, your good or bad faith in selecting the mark, and the sophistication of the customers.

Another consideration is whether a trademark that appears to be a direct conflict has been abandoned. Trademark registrations in the United States are issued for ten year periods and further investigation may be warranted to determine whether a registered mark is currently in use. The Internet is a good place to start. If the mark in question appears on the registered owner's web site, it's a pretty good bet that it is presently in use - although merely showing up on a web page is not conclusive evidence of use. Ultimately, you may want to retain the services of an agency which specializes in trademark investigations. Be cautious, however, when investigating a mark in an intent to use application. It could be in the development stage, but not appear on a web site or be known to customer service representatives or marketing staff.

Stephen J. Quigley, Of Counsel

(Check back in the Spring 2011 Ostrolenk Newsletter for the remainder of this and other articles in this Series).

Ostrolenk Faber LLP ***Firm News***

Ostrolenk Faber LLP is proud to announce that partner Douglas A. Miro was again named among the top intellectual property attorneys in the New York Metropolitan area by the New York *Super Lawyers, 2010*. Only the top 5% of attorneys in each state are named to the list. This is Mr. Miro's third selection to the New York *Super Lawyers* list and the second year in a row.