



## OSTROLENK Wins Two Key Trademark Disputes

OSTROLENK partner Peter S. Sloane successfully represented Novartis AG before the Trademark Trial and Appeal Board (TTAB) in opposing an application to register the mark PERFECT FOCUS for optical lenses for eyeglasses, filed by Craig Chasnov, an individual. CIBA Vision, the eye care unit of Novartis, sells soft contact lenses under the famous mark FOCUS.

In the opposition, Chasnov defied a TTAB order compelling discovery. As a result, in a May 16, 2007 decision, the TTAB granted Novartis' motion for discovery sanctions, and entered judgment against the applicant, sustaining the opposition and refusing registration.

OSTROLENK also prevailed in a contested Internet domain name proceeding, successfully transferring the domain name *moneystore.com* to the firm's client, MLD Mortgage Inc. Stephen J. Quigley, of counsel to the firm, handled this matter.

For over 40 years, MONEY STORE has been a famous trademark for personal and home loans, popularized by Major League Baseball Hall of Fame celebrity spokesmen Phil Rizzuto of the New York Yankees and Jim Palmer of the Baltimore Orioles. MLD owns U.S. trademark registrations for MONEY STORE and THE MONEY STORE and promotes its services on the website *themoneystore.com*.

The domain name *moneystore.com* was registered in 1998 and for the next eight years the site was "under construction." The domain name was purchased for \$20,000 in November 2006 by Gabriel Gomez Rojo, an individual residing in Spain, who posted links on the web site to more than 50 banks and other institutions providing loan services that competed directly with MLD. Mr. Gomez did not offer any services himself – rather, he profited from each "click-through" on the *moneystore.com* site to a linked site.

MLD's complaint stated that it owns trademark rights in MONEY STORE; Mr. Gomez had no legitimate rights in MONEY STORE; and Mr. Gomez had registered and was using the *moneystore.com* domain name in a bad faith effort to divert consumers seeking MLD's web site to his own site, and subsequently to the sites of MLD's competitors. Mr. Gomez countered that MLD sat on its rights for nearly nine years; that MONEY



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**Association of Patent Law Firms' 10<sup>th</sup> Annual Meeting is Sept 26<sup>th</sup>, 2007, New York, NY**  
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## ©Computer Programs: Which Parts Are Protectable?

In the recent decision *Hutchins v. Zoll Medical Corporation* (\_\_\_ F.3d \_\_\_, 2007 WL 1892467, 83 U.S.P.Q. 2d 1264 (Fed. Cir., July 7, 2007), the U.S. Court of Appeals for the Federal Circuit, applying First Circuit law, found that Zoll's AEDPlus® (Automatic External Defibrillator) did not violate two Hutchins' copyrights in his computer system which provided automated voice and visual signals and instructions to guide rescue personnel in administering CPR to patients.

The case arose from Donald Hutchins' claims of copyright and patent infringement by Zoll of his computer system which assisted the administration of CPR by emergency personnel. A Massachusetts District Court granted summary judgment for Zoll on all claims. Hutchins appealed to the Federal Circuit.

Under 17 U.S.C. § 102(b), the mode of expression is copyrightable but an "idea, procedure, process, system, method of operation, concept" is not. When applied to computer programs, copyright protection extends to computer codes, design, text and screen displays. However *Lotus Development Corp. v. Borland International, Inc.* 49 F.3d 807, 818 (1<sup>st</sup> Cir. 1995), *aff'd* 516 U.S. 233, 116 S.Ct. 804, 133 L.Ed.2d 610 (1996), held protection does not extend to "methods that are performed with program guidance."

Hutchins claimed that Zoll's program violated his copyright in the "text of his computer program." The Federal Circuit, however, agreed with the lower court in its application of *Lotus v. Borland* in finding that his "copyright does not protect the technological process independent of the program that carries it out." In other words, the District Court found that Mr. Hutchins' copyright covers the software code and may extend coverage to

"specific audio-visual form" and original text, but does not extend to standard CPR instructions or "their placement in electronic form" or the "methods of operation."

Hutchins also claimed infringement of his copyright in the "Script and Word List" for words and phrases used in his computer system for CPR guidance. The court cited to the decision in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991) in stating that a copyright in "a list or a compilation of public information" protects only the original elements of the work, including the compilation itself and does not extend to the purely functional elements, such as the individual words and phrases.

Hutchins claimed that the Zoll computer system used 27 of the words and phrases that appear in his list of copyrighted words. Only two of the 27 phrases were found by the District Court to be identical, and three similar, among them "call for help" and "check breathing." As these phrases are part of standard CPR instructions, the District Court found that they are completely functional in character and therefore not protectable by copyright. The Federal Circuit upheld the lower court, stating that placing standard phrases into digitized format does not in itself give copyright protection against all other digitized use of such standard words.

In conclusion, the Federal Circuit found that summary judgment was properly granted below and admonished that "standard instructions for performing CPR are indispensable for applying CPR, and remain in the public domain."

by Bella I. Karakis, Of Counsel



## Trademarks In Foreign Languages

Trademark owners will often find themselves doing business in countries where the local language is not based on the Latin alphabet. A brand owner may believe that its English language mark would be more recognizable and distinctive in the local language. OSTROLENK encounters this challenge frequently when registering clients' trademarks in Korea, Japan, China and Russia. Still other writing systems exist in other parts of the world, such as the Middle East, posing similar challenges. Brand owners considering conducting business in countries whose language is based on a different writing system should seek expert advice before launching their brand.

### 한국어 KOREA & JAPAN 日本語

In Korea and Japan, the population predominantly speaks and understands English, taught in both countries from middle school on. Thus, Korean and Japanese citizens are largely capable of reading and understanding English language marks. From a practical standpoint, the existence of an English language trademark on the Japanese or Korean registers *should* serve to block a third party's attempt to register a similar mark transliterated into the local language. Thus, if costs are a concern, it can be sufficient to only register an English version of the mark in Korea and Japan.

However, many brand owners market their products in local languages, to promote brand recognition and awareness, and to preserve the integrity of the brand. The adaptation of a mark into Korean and Japanese typically involves transliteration, transcribing a word or text from one writing system into another.

In considering a local language version of a

mark, one problem is that different methods of transliteration can distort the meaning and impression of a mark. For example, Japanese does not distinguish the vowel sound of "run" and "ran", or the consonant sound of "row" and "low". Also, the rules by which sounds can be combined are restrictive. As a result, the pronunciation of the transliterated word can differ considerably from the original English. Additionally, attention should be given to whether the transliterated mark conveys a negative meaning or connotation.

### CHINA

### 汉语/漢語

The Chinese language poses different problems for brand owners. While English is also taught in middle school of China's larger cities, the majority of China's rural population does not read English. Therefore, the majority of the Chinese population will not recognize a word or pronounce a Latin script trademark. Generally, a registration for an English language mark does not block a third party's attempt to register a local language version of the mark. This is partly due to the fact that a third party's transliterated version will likely have a different meaning from the original Latin script version, in addition to a different appearance.

Thus, in order to promote brand recognition and protect against third party applications it is recommended to register a Latin script mark in Chinese. The task of transliterating an English language mark into Chinese should not be taken lightly. Chinese uses characters that have associated meanings, and an English language mark transliterated into Chinese takes on the meaning of those characters. Particular attention must be given to the meanings of Chinese

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## Two Key Wins by OSTROLENK

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STORE is a generic term; that MONEY STORE is virtually unknown in Europe; and that he intended to develop an online currency exchange within Europe.

The Panel rejected all of Mr. Gomez's defenses, finding that MLD had established all three elements required under ICANN policy, i.e., 1) MLD's MONEY STORE trademark and the *moneystore.com* domain name were identical; 2) Mr. Gomez was not using the domain name in connection with the *bona fide* offering of goods or services; and 3) Mr. Gomez registered and used the domain name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to his site by creating a likelihood of confusion with MLD's MONEY STORE mark.

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## Trademarks In Foreign Languages

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characters to be used, and the resulting meaning that will arise from their combination.

### RUSSIA

Given the differences between the English and Russian languages, in particularly the differences between the "characters" of their alphabets, it is import to consider the manner in which trademarks are registered in Russia. Trademarks need not be registered in Cyrillic, but most advertising in Russia appears in the Russian language. Russian consumers tend to expect a foreign product to be marketed and sold in their native language.

From a legal perspective, the issue of registering a trademark in both English and Cyrillic is relevant when addressing the issue of likelihood of confusion. A mark registered in English will not necessarily block a similar mark in Cyrillic. In Russia, likelihood of confusion is considered by virtue of their phonetic, visual similarities and the overall impression conveyed. Thus, an English language trademark will convey a different overall impression than the Cyrillic version of the mark.

There are various approaches to consider when adapting a mark into Cyrillic. A mark can be transliterated on a letter by letter basis, transcribed phonetically as a whole, or translated into a corresponding Russian word. To ensure adequate protection of a mark in Russia, a brand owner should consider at least filing for one version of its mark in the local tongue.

by Sean P McMahon, Trademark Paralegal

## *Pro Bono Publico*

The Canons of Ethics impress upon all attorneys to perform *pro bono* work to ensure that legal services are available to all who need them. OSTROLENK shares that commitment, as a firm and among the members of its professional staff.

OSTROLENK has joined with Pro Bono Partnership ([www.probonopartnership.org](http://www.probonopartnership.org)), an organization with offices in New York and New Jersey, which matches organizations in the New York, New Jersey and Connecticut metropolitan area that are in need of legal service with willing volunteers. OSTROLENK partner Peter S. Sloane has most recently volunteered his time to advise a charitable organization on trademark matters. Since joining OSTROLENK in 2006, associate Art Cody has continued his *pro bono* representation of an Alabama death row inmate, in addition to his legal and lay writing on the issue of capital punishment.