

DIPLA NEWS

A Service of the Dayton Intellectual Property Law Association

Volume 12, Issue 9

May, 2010

©2010 Dayton Intellectual Property Law Association

**Join us tomorrow, May 14, 2010, at the Engineer's Club to hear
Tim Hagan from Dinsmore & Shohl present on recent developments in Federal Circuit caselaw
Lunch from 11:30-12:15; Speaker 12:15-1:15**

Reminder

No June meeting.

Instead, please consider attending the 19th Annual Program in Law and Technology Seminar on Significant Developments in the Intellectual Property Law of Computers and Cyberspace at UDSL **Friday June 11, 2010**. Registration at 8AM, seminar from 8:30 – 4:00. For more information, contact Nan Holler-Potter at 937-229-4676 or hollernl@notes.udayton.edu.

UPDATE ON FALSE PATENT MARKING

In the January DIPLA news, I reported that the Federal Circuit in *The Forest Group, Inc. v. Bon Tool Company* held that "the plain language of 35 U.S.C. § 292 requires courts to impose penalties for false marking on a per article basis." The case was remanded with instruction to the district court to recalculate the penalty on a per article basis. The Southern District of Texas has determined that the penalty should at least recapture all of the revenue generated from the sale of the falsely-marked product. The products sold were priced between \$103 and \$180. The district court set the penalty at the higher price of \$180 per product sold.

THE RISK OF CONTINUATION-IN-PART APPLICATIONS

A continuation-in-part application ("CIP") that lacks sufficient written description to support claims later added to a child patent could result in a loss of up to a \$100 million in damages. In [Anascape v. Nintendo](#) (April 2010), the Federal Circuit found the claims of Anascape's U.S. Patent No. 6,906,700 invalid because the CIP could not serve as a priority document to antedate prior art since it did not satisfy the written description with respect to claims added to the '700

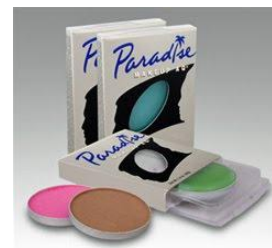
patent. The claims were related to controllers for game systems.

Interestingly, the Federal Circuit relied only on the portions of the specification that related to the description of the actual invention. In other words, the court refused to look to the CIP's background discussion of prior art joysticks for teachings that would support the claims of the '700 patent.

CONFUSINGLY SIMILAR, "AQ" and "PARADISE MAKEUP AQ"?

NOT ACCORDING TO THE TTAB

The AQ and PARADISE MAKEUP AQ marks are both used for cosmetic and makeup items. The



trademark examiner refused to register PARADISE MAKEUP AQ as being confusingly similar to AQ, arguing that both marks contain the word "AQ," which is arbitrary, and that

"AQ" is what consumers would likely associate with a company.

On Appeal, the applicant of PARADISE MAKEUP AQ argued that "PARADISE" is the dominant word in the mark (and had so argued during prosecution), since it is arbitrary and appears first. Secondly, the applicant asserted that "AQ" stood for aqueous in its mark, but that the mark AQ did not.

The TTAB agreed with the Applicant and further found that the use of a generic term such as "MAKEUP" further emphasized the importance of the first word "PARADISE."

DIPLA Officers

Past President – Kimberly Gambrel
President – Thomas Lees

First Vice President – Julie Zink
Second Vice President – Donald Burton

Secretary – Susan M. Oiler
Treasurer – Richard McNeely