

# PLAGER LAW OFFICES. P.C.

Registered Patent Lawyers

*A Place for Inventive and Entrepreneurial Minds*

## INTERNATIONAL INTELLECTUAL PROPERTY PROTECTION



Plager Law Offices, P.C. is pleased to announce its affiliation with foreign associates to better serve your international intellectual property. Plager Law Offices now has foreign associates in Canada, Asia and Europe to assist you with the filing of international intellectual property registrations.

An international utility patent may be filed with the United States Patent and Trademark Office pursuant to the Patent Cooperation Treaty in lieu of a domestic patent application in each country. Alternatively, an international utility patent application may be filed with the U.S. Patent and Trademark Office within twelve months after filing a domestic application.

Design Patents, unfortu-

nately, do not receive the benefit of the Patent Cooperation Treaty for a single international application. Design patents must be filed individually in each country where protection is sought with the exception of European Union member countries where a single application will provide protection in fifteen different countries: Ireland, United Kingdom, Portugal, Spain, France, Italy, Greece, Austria, Luxembourg, Belgium, Germany, Netherlands, Denmark, Sweden and Finland.

Trademark protection is governed by the Madrid Protocol which was enacted on November 2, 2003 in the United States. With the enactment of the Madrid Protocol your international trademark require-

ments can be administered here in the United States through the United States Patent and Trademark Office. A prerequisite for filing under the Madrid Protocol is the pendency or issuance of a United States 4 trademark application. ☼



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### Internet Points of Interest:

- [www.plagerlaw.com](http://www.plagerlaw.com)
- [www.uspto.gov](http://www.uspto.gov)
- [www.copyright.gov](http://www.copyright.gov)
- [www.inventorsforum.org](http://www.inventorsforum.org)
- [ww.wipo.org](http://ww.wipo.org)

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## Case Summary: Fair Use of a Trademark

On December 8, 2004, the United States Supreme Court rendered an opinion on the application and burdens for asserting the fair use defense to a claim of trademark infringement. See *KP Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 125 S. Ct. 542 (2004). Pursuant to 15 U.S.C. § 1115(b)(4), statutory fair use is defined as “a use, otherwise than as a mark, . . . of a term or devise which is descriptive of and used fairly and in good faith only to describe the goods or services of [the allegedly infringing] party”.

Generally, the fair use defense permits a party to use a trademark registrant’s mark with immunity if the use is done fairly and in good faith for either com-

parative advertising or if it’s the only way to describe a specific product. For example, using “Playmate of the Year” to describe Terri Wells, a former Playboy Playmate of the Year, was held to be a permissible nominative fair use, because “[the use] serve[d] to identify Wells as a past PEI ‘Playmate of the Year.’

The trademark at issue in the *KP Permanent* case was MicroColor® owned by Lasting Impression for use in association with permanent make-up. KP used this trademark in a large brochure to promote its products as well as placed the term on its competing product bottles to identify the product color, i.e., microcolor: blue or microcolor: red. KP further

alleged that it began using the term two years before Lasting Impression began to use the mark. The trial court found KP did not infringe the mark because it was merely descriptive of the product without any evidence of consumer association between the mark and the manufacturer. The appellate court reversed the trial court finding that consumer association was presumed because the mark had achieved incontestable status under United States Trademark Law.

The matter was taken to the Supreme Court on the narrow issue of: Does party raising the statutory fair use affirmative defense to an allegation of trademark infringement pursuant to 15 U.S.C. § 1115(b)(4)

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SeaCliff Office Park  
2134 Main Street, Suite 130  
Huntington Beach, California 92648-6445

Phone: +1.714.374.9160  
Fax: +1.714.374.9170  
E-mail: info@plagerlaw.com

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Law, Corporate Law and Litigation**

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## FIRM HAPPENINGS:



### WELCOME

Plager Law Offices welcomes , Jeffrey A. Travis. Mr. Travis is a registered patent lawyer who is admitted to practice law in the State of California. Mr. Travis' emphasis of practice is in the area of intellectual property prosecution and litigation. Mr. Travis possesses substantial patent prosecution experience in the areas of computer programming, software methods, business methods and mechanical patents. Mr. Travis graduated Whittier College School of Law, 2003.☼

### CONGRATULATIONS

Congratulations to Jerome Rosenstock who's third book entitled: *Transferring Inventions: Effective and Enforceable Contracts* has been accepted for publication by Aspen Law and Business Publishers. The book is scheduled for release in July, 2005. Mr. Rosenstock is also the author of *The Law Of Chemical and Pharmaceutical Invention* and *Patent Interference Practice Handbook* which are updated annually. Mr. Rosenstock is currently working on his fourth book related to corporate law from an intellectual property point of view. ☼

### EVENTS & NOTES

**July 8, 2005**—Presentation to Orange County Inventor's Forum, Orange Coast College, Costa Mesa, CA 7:30 p.m.

**September/October 2005**— Mark Plager will be available for meetings on the East Coast, please call to schedule an appointment.



**June 15, 2005**—Plager Law Offices successfully defended its client against a claim of patent infringement in the United States District Court for the Central of California.

**October 19, 2004**—Plager Law Offices obtained a Preliminary Injunction in favor of its client preventing further infringement of their user instruction manual in the Central District of California

### TRADEMARK: cont'd

bear the burden of negating any likelihood that the practice complained of will confuse consumers about the origin, source or affiliation of the goods or services affected? The Supreme Court held that application of the fair use defense does not require negation of all confusion for its application. Rather, it is up to the jury or judge to determine whether the confusion that exists results too much confusion for consumers in order to discern the true manufacturer or sponsor of the product.☼