



HOWARD RICE ALERT

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RECENT DEVELOPMENTS IN TRADEMARK CASES

This alert contains a summary of significant developments in recent trademark cases, spanning from approximately June 2004 to August 2005. The full report covers more than 50 cases dealing with issues arising from the impact of internationalization of commerce on trademark law, cyberspace, and fair use in trademarks, including:

- *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 125 S. Ct. 542 (2004), which held that fair use can be raised as a successful defense in a trademark infringement action, even where there is some likelihood of confusion, on the grounds that the owner of a descriptive mark, even if incontestable, must accept the risk that others will make fair use of the mark.
- *Government Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700 (E.D.Va. 2004), which held that the use of a party's trademark to sell "key word" advertising to competitors is use "in commerce" sufficient to maintain a claim under the Lanham Act.
- *1-800 Contacts Inc. v. WhenU.com Inc.*, 2005 U.S. App. LEXIS 12711 (2nd Cir. 2005), which held that the inclusion of a company's domain name in a list of non-viewable terms that trigger pop-up advertisements, possibly including ads relating to the company's competitors, does not constitute use in commerce of the company's trademarks under the Lanham Act.

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For more information or questions about items discussed in this report, please do not hesitate to contact [Karen Frank](#) (kfrank@howardrice.com or 415-434-1600) or your usual Howard Rice attorney.

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