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Becoming master of your domain: The UDRP versus the Anti-Cybersquatting Consumer Protection Act

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A. Introduction

Who would believe that a mere 14 years ago, in the toddler-stage of the Internet's still-young life, the registration of Web domain names would have come as news to one of the world's most famous brands—McDonald's Corporation? Yet that is the situation described in an article published in the October 1994 issue of *Wired* magazine.¹ The author of that article, Joshua Quittner, was a *Newsday* correspondent for cyberspace issues. In the article, he explained to a McDonald's media rela-

tions person how the gold rush was on for important domain names on the Internet. The company's representative seemed incredulous to learn this information, and even more so when Quittner told her that, "Some companies are even registering the names of their competitors."²

The article pointed out that only about one-third of the Fortune 500 companies at the time had registered an obvious version of their names, and 14 percent of the total had found the domain name corresponding to their trade name already snagged by somebody else. Even huge media companies were not immune. The domain name "abc.com" belonged to ABC Design in Seattle, "cbs.com" was registered to a Minnesota consultant, and "fox.com" was found under a company called the Flexible Online Exchange in California.³ At the time the article was being researched, there were a very limited number of people responsible for the assignment and registration of domain names on the Internet. That was then the job of an agency called the Internet Network Information Center (or, InterNIC), part of the National Science Foundation, and it had only three employees assigned to this task.

B. Background & Establishment of Domain Name Dispute Resolution Procedures

Things have changed since 1994. Today, there is much more awareness of the issues implicated in the ownership and use of domain names.⁴ Companies

are much better attuned to the immense value of domain names and their function, related to trademarks, of identifying sources of goods, services, and information on the Internet. The original rudimentary system of assigning them purely on a "first come, first served" basis has given way to a more sophisticated version of the Domain Name System (DNS) and legal methods of assignment and dispute resolution. Thousands of domain name applications, a great increase over the volume handled just a few short years ago, are now processed per month by just one corporation, Network Solutions, LLC (originally known as NSI). In 2006, Network Solutions managed more than 7.6 million domain names.⁵

NSI was the initial sole Internet registrar for the .com, .org, and .net generic top level domains (gTLDs). The Domain Name System comprises two types of top-level domains. The first type, generic top-level domains, gTLDs, include not only .com (commercial companies), .org (not-for-profits), and .net (network providers), but also .edu (educational institutions), .gov (U.S. government), .mil (military), and .int (international treaty organizations).⁶ The second, country code top-level domains, ccTLDs, are two-letter abbreviations (such as .us for the United States).

In 1998, a system was proposed that would support multiple privatized registrars for domain names.⁷ Today, these registrars are accredited and supervised by ICANN, the Internet Corporation for Assigned Names and Numbers, a non-profit corporation which was established

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that year through a process aimed at forging a consensus among the international community of Internet users for more efficient administration of the DNS.⁸

The UDRP

In 1999, the World Intellectual Property Organization (WIPO) convened a series of meetings and a panel of experts in order to gather views worldwide on the management of the DNS and the resolution of domain name disputes. The resulting report, "The Management of Internet Names and Addresses: Intellectual Property Issues," ("WIPO Management Report") was published on April 30, 1999.⁹ The third chapter of the WIPO Management Report is entitled, "Resolving Conflicts in a Multijurisdictional World with a Global Medium: A Uniform Dispute-Resolution Policy."

In the Report, WIPO recommended that domain name holders should be required to submit to an administrative dispute resolution process aimed at what it called "abusive registration" of domain names. (Although WIPO used that phraseology, this practice is often termed "cybersquatting.")

WIPO defined "abusive registration" as follows:

- (1) The registration of a domain name shall be considered to be abusive when all of the following conditions are met:
 - (i) the domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; and
 - (ii) the holder of the domain name has no rights or legitimate interest in respect of the domain name; and
 - (iii) the domain name has been registered and is used in bad faith.
- (2) For the purposes of paragraph (1)(iii), the following, in particular, shall be evidence of the registration and use of a domain name in bad faith:
 - (i) an offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration; or
 - (ii) an attempt to attract, for financial gain, internet users to the domain name holder's Web site or other on-line location, by creating confusion with the trade or service mark of the complainant; or

(iii) the registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been established on the part of the domain name holder; or

(iv) the registration of the domain name in order to disrupt the business of a competitor.¹⁰

On October 24, 1999, in response to the WIPO report, ICANN approved a policy, modeled largely on the WIPO recommendations, known as the Uniform Domain Name Dispute Resolution Policy (UDRP), for resolution of domain name disputes. The UDRP went into effect on December 1, 1999.¹¹ Since then, several thousand arbitration proceedings have been brought under the UDRP, which has been adopted by many accredited registrars for almost all gTLDs as a more cost-effective and efficient way to resolve most domain name disputes. Arbitration utilizing the UDRP through WIPO's Arbitration and Mediation Center has also been adopted with respect to several ccTLDs.¹² The UDRP is incorporated by reference into all registration contracts with those registrars that have adopted it, and the domain name registrants are thereby required to submit to it whenever disputes arise with trademark owners.

The Anti-Cybersquatting Consumer Protection Act

At the same time that the ICANN Board was adopting and approving the UDRP, the U.S. Congress was considering legislation to amend the Lanham Act, the federal trademark statute, in order to address the cybersquatting issue. The result was the Anti-Cybersquatting Consumer Protection Act (ACPA or Act), which was passed and signed into law despite the initial opposition of the Clinton administration, which felt that the bill "undermined ICANN's authority."¹³ The ACPA was incorporated into the Lanham Act as § 43(d) (15 U.S.C. § 1125(d)), and took effect on November 29, 1999.

The ACPA created a federal cause of action against anyone who, with the bad faith intent to profit from a trademark, registers, traffics in, or uses a domain name that is either:

- a) the same as or confusingly similar to a distinctive trademark, or
- b) the same as or confusingly similar to or dilutive of a famous mark.

One of the keys to an action by a trademark owner under the ACPA is the

"bad faith" of the domain name owner in either registering, trafficking in, or using the domain name.¹⁴ The statute contains a non-exhaustive list of nine factors that a court may consider in determining whether "bad faith" exists on the part of the defendant. Paraphrasing the Act, the factors are as follows:

- 1) any trademark or other IP rights the defendant has in the domain name;
- 2) the extent to which the domain name is the legal name of the defendant or is otherwise commonly used to identify the defendant;
- 3) defendant's prior use of the domain name in connection with the bona fide offering of goods or services;
- 4) defendant's bona fide noncommercial or fair use of the trademark in an online site accessible under the domain name;
- 5) defendant's intent to create the likelihood of confusion (as to source, sponsorship, affiliation, or endorsement) and to divert customers from the site of the trademark owner's online site, either for commercial gain or with the intent to tarnish or disparage the mark;
- 6) defendant's offer to sell, transfer, or assign the domain name, either to the trademark owner or to a third party, for financial gain without having used or having an intent to use the domain name in a bona fide way (or prior conduct indicating a pattern of such);
- 7) defendant's use of false or misleading contact information when applying for registration of the domain name (or prior conduct indicating a pattern of such);
- 8) defendant's registration or acquisition of multiple domain names that the defendant knows are identical or confusingly similar to others' distinctive trademarks or dilutive of others' famous marks; and
- 9) the extent to which the trademark incorporated into the defendant's domain name is or is not distinctive or famous.¹⁵

The first four factors are potential reasons why a defendant might register, traffic in, or use a domain name while acting in good faith, while the second four factors (5 through 8) are particularly indicative of bad faith conduct or intent.

C. Proceedings Under the ACPA and the UDRP

Each of the above alternatives for resolution of disputes involving domain

names and trademarks presents different advantages and disadvantages. This section discusses those aspects of each proceeding, from the standpoint of the trademark owner.

The ACPA

A proceeding brought under the Anti-Cybersquatting Consumer Protection Act is not an administrative proceeding, but a federal civil lawsuit filed in a U.S. District Court.

To establish a claim under the ACPA, the plaintiff must plead and prove the following elements:

1. that the plaintiff owns a valid distinctive or famous trademark;
2. that the registrant-defendant either registers, "traffics in," or uses a domain name;
3. that the domain name is either i) identical or "confusingly similar" to the plaintiff's mark, if the mark is distinctive (at the time of registration of the domain name), or ii) identical to, "confusingly similar" to, or dilutive of the plaintiff's mark, if it is famous (at the time of registration of the domain name); and
4. that the registrant-defendant has a "bad faith" intent to profit from the mark.¹⁶

The term "traffics in" is defined in the Act to refer to transactions that "include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration."¹⁷ It is thus far broader than mere registration or use. In determining whether the defendant has the required "bad faith" intent to profit from the mark, the court "may" utilize the statutory non-exclusive list of nine factors. The above-quoted term "confusingly similar" is not defined in the Act. However, it has been interpreted as a significantly lesser standard than "likelihood of confusion," which pertains in a trademark infringement action. *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 783 (8th Cir. 2004).

Because an action under the ACPA is a claim brought under the Lanham Act, the usual trademark remedies are available. These include injunctive relief (TROs and preliminary and permanent injunctions) under § 34 of the Lanham Act and traditional monetary awards under § 35(a), including recovery of the damages suffered by the plaintiff, the defendant's profits, and the costs of the action.

In addition to these, the ACPA provides two additional remedies: a) the

"forfeiture or cancellation" of the domain name, or its transfer to the mark holder;¹⁸ and b) an election by the plaintiff to recover statutory damages of anywhere between \$1,000 and \$100,000 per domain name.¹⁹

A trademark owner may also pursue an *in rem* action under the ACPA. This is a valuable provision for trademark owners who may not be able to locate cybersquatters or establish in personam jurisdiction over them. In those situations, provided the plaintiff has exercised due diligence, an *in rem* action may be filed against the domain name itself. Suit must be filed in the judicial district in which "the domain name registrar, registry, or other domain name authority" is located.²⁰ The plaintiff's remedy in an *in rem* action is limited to the forfeiture, cancellation, or transfer of the domain name.²¹

Finally, since it is a form of federal civil litigation, the usual array of discovery devices (e.g., interrogatories, document production, depositions, etc.) is available for use by the parties to an ACPA action.

The UDRP

Compared to a suit under the ACPA, a proceeding under the UDRP is simpler and quicker. However, the remedies provided are narrower.

To establish a claim under the UDRP, the complainant is required to prove the following three elements:

1. that the respondent has no rights or legitimate interest with respect to the domain name;
2. that the domain name is identical or "confusingly similar" to a trademark in which the complainant has rights;
3. that the domain name was registered and used in "bad faith."²²

Determinations of "bad faith" are made based on the four factors²³ discussed above with reference to the WIPO Management Report.

The only remedy provided under the UDRP is the transfer or cancellation of the respondent's domain name.²⁴ Several domain names can be addressed in a single UDRP proceeding, but the filing fees vary by the number of domain names being challenged. Unlike ACPA actions, there is no possibility of an award of injunctive relief, damages or costs. See, e.g., WIPO UDRP Rule 19(a) (complainant is to bear fees for the proceeding).

Also, because it is a limited arbitration proceeding, an action under the UDRP affords no opportunity for investigation or conducting discovery. Furthermore,

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UDRP proceedings are not considered binding on the courts because of the limited nature of the issues considered.²⁵ Judicial review is contemplated in the UDRP. A losing respondent can prevent the loss or transfer of its domain name by filing suit within 10 business days.²⁶

Experience with UDRP proceedings has demonstrated that more than 80 percent of them have been resolved in the trademark owner's favor.²⁷

The Differences

Several factors may influence a trademark owner's decision to pursue one or the other of these two quite different types of relief against a cybersquatter.

In general, one primary reason a trademark owner would opt for filing suit under the ACPA is the desire to seek an award of monetary damages. They could comprise either traditional trademark damages, such as lost sales and/or the defendant's profits, or the statutory damages provided for by the ACPA. The latter, which can reach an upper limit of \$100,000 per domain name, could be an attractive option under the right circumstances. In general, seeking damages may be advantageous when there is a favorable chance of success in the litigation, actual damages can be readily proved, and the opportunity exists to actually collect them.

Another attractive feature of an ACPA action is the opportunity to file an *in rem* suit. This could be useful where the defendant is difficult to ascertain, has evaded service of process, or where obtaining personal jurisdiction over the defendant in a U.S. court might be hard or impossible.

Finally, only the ACPA option offers the opportunity for conducting discovery against the defendant in order to flesh out, if necessary, the circumstances of the alleged violation or the defendant's bad faith.

A key tradeoff to use of the ACPA is the expense associated with it. As with any federal litigation, filing and conducting the suit is expensive, often costing tens of thousands of dollars in fees, as well as consuming a few years in federal court.

Another limitation of the ACPA is that the plaintiff's trademark(s) must be either distinctive or famous *at the time* of the registration of the defendant's domain name. This is not only a factor in the determination of bad faith under the Act; it is also a threshold "jurisdictional" requirement for the ACPA to apply. The

owner of a mark that is merely descriptive at the time of the defendant's registration will not be able to avail itself of the ACPA as a cause of action.

Finally, under the ACPA, the plaintiff must prove that the defendant has a bad faith intent *to profit* from use of the trademark. The UDRP, by contrast, only requires "bad faith" as an element, but it need not be "to profit." In fact, the fourth of the factors used to determine bad faith under the UDRP (i.e., disrupting the business of a "competitor") appears to weigh in favor of the registrant of a domain name used for non-commercial purposes.

As an alternative, the UDRP proceeding provides a quicker, but more limited, remedy. Proceedings can be resolved in as little as 60 days. However, as discussed above, remedies under the UDRP are limited to cancellation of the respondent's domain name or its transfer to the complainant. A lawyer is not required for filing a complaint under the UDRP (although most such proceedings are, in fact, filed by attorneys on behalf of their clients). Also, arbitration proceedings under the UDRP are decided strictly on the written materials, another way to limit costs.

Moreover, the UDRP is a good option when the domain name involves issues of international scope. Even if the domain name registrant is domiciled in a country outside of the U.S., a UDRP proceeding may be filed whenever the particular domain name registrar has adopted and incorporated the UDRP into the registration agreement. As mentioned above, this already has been done with regard to many country code TLDs. The UDRP presents a distinct advantage in such cases because problems associated with personal jurisdiction are eliminated.²⁸

However, the UDRP requires that the complainant show that the respondent both registered *and* used the domain name in bad faith. (In contrast, under the ACPA, a finding of bad faith can be based on the defendant's registration, use, or trafficking in the domain name.) It is possible to conceive of situations where this issue might be problematic for the complainant. For example, a respondent in a UDRP action might have registered its domain name in good faith, fully intending to use it to sell goods or services completely unrelated to the corresponding trademark of the complainant. Those plans could have fallen through, leaving the registered domain name and a corresponding Web site out there

on the Internet which the trademark owner might wish to have transferred to it. However, in the scenario just posited, there would be no use and no proof of bad faith in registering the domain name, so the owner of the corresponding mark might not be able to make a case under the UDRP.

Another possible downside to use of the UDRP is that the arbitration panel's decision can be contested in court. As mentioned above, the findings and ruling of the UDRP panel carry no formal weight in any future litigation. If a trademark owner is confronting a litigious respondent that the complainant suspects might later litigate the whole matter anyway, the complainant might prefer to simply forego the UDRP proceeding and take the defendant straight to court via the ACPA.

D. Conclusion

In short, the choice of which option, ACPA or UDRP, to select depends on a weighing of various factors including costs, timing, chances of success, the adjudicator's ability to address trademark issues not susceptible for decision under the UDRP, and the desire and ability to obtain and recover damages. Attorneys should be acquainted with both procedures and be prepared to evaluate these factors in advising clients of their options in dealing with cybersquatters.

1. "Billions Registered," *Wired* magazine, Issue no. 2.10 (Oct. 1994), p. 50.

2. Her response to this information was, "You're kidding." *Id.* For a time, Quittner himself owned the registration to the mcdonalds.com domain name, but he eventually relinquished it to McDonald's.

3. *Id.* at 53.

4. Domain names are familiar strings of letters and numbers that can be used to access Web site locations in lieu of Internet Protocol addresses, which are unique strings of numbers that the Internet ultimately uses to locate the servers for Web sites. Thus, navigation of the Web is made more mnemonic and simpler for users.

5. <http://en.wikipedia.org/wiki/Network_Solutions_LLC> (last accessed on Nov. 15, 2008).

6. In 2000, ICANN selected seven new gTLDs, including .info and .biz. ICANN is currently considering the introduction of several new gTLDs. See <<http://www.icann.org/en/topics/new-gtld-program.htm>> for more information (last accessed on Nov. 18, 2008).

7. The system grew out of the publication, on February 20, 1998, of a proposed rule by the National Telecommunications and Information Administration (NTIA), part of the

U.S. Dept. of Commerce, called "A Proposal to Improve the Technical Management of Internet Names and Addresses" (known as the "Green Paper"). A January 1998 discussion draft of this document is available at <<http://www.ntia.doc.gov/ntiahome/domainname/dnsdrft.htm>>.

8. See <<http://www.icann.org/en/about/>> for more information on ICANN's background, organization, and functions (last accessed on Nov. 15, 2008).

9. The full report can be found at WIPO's Web site at: <<http://www.wipo.int/amc/en/processes/process1/report/finalreport.html#11>>.

10. WIPO Management Report, ¶ 171.

11. The UDRP itself is found at <<http://www.icann.org/en/dndr/udrp/policy.htm>>.

12. See the list of ccTLDs posted at <<http://www.wipo.int/amc/en/domains/cctld/index.html>> (last accessed on Nov. 15, 2008).

13. Michelle A. Flores, "Cybersquatting: Domain Names in Cyberspace, Settling a New Frontier" (2000), p. 4, found at <http://home.cfl.rr.com/michelleanne/hypertextweb/political_fs.html> (last accessed on Nov. 15, 2008).

14. Note that, under the UDRP, both the registration *and* use of the domain name must be in bad faith.

15. See 15 U.S.C. § 1125(d)(1)(B)(i)-(IX). The act also specifically provides that bad faith shall not be found where the domain name owner reasonably believed that its use was a fair use or was otherwise lawful. 15 U.S.C. § 1125(d)(1)(B)(ii).

16. 15 U.S.C. § 1125(d)(1)(A).

17. 15 U.S.C. § 1125(d)(1)(E).

18. 15 U.S.C. § 1125(d)(1)(C).

19. 15 U.S.C. § 1117(d).

20. 15 U.S.C. § 1125(d)(2)(C). *See also*, *Harrods Ltd. v. Sixty Internet Domain Names*,

302 F.3d 214, 225 (4th Cir. 2002).

21. 15 U.S.C. § 1125(d)(2)(D)(i).

22. UDRP, ¶ 4.a.

23. UDRP, ¶ 4.b.

24. UDRP, ¶ 4.i.

25. *See Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (4th Cir. 2003) (referring to the UDRP as "adjudication lite").

26. UDRP, ¶ 4.k.

27. Mark V.B. Partridge, "How to Win Domain Name Cases," published in the online magazine "Managing Intellectual Property" (Feb. 2005 issue), found at <www.managingip.com> (last accessed on Nov. 15, 2008).

28. As discussed above, an *in rem* proceeding under the ACPA's provisions could also be brought under these circumstances, but, given the same limitation on remedies in such proceedings, the UDRP would appear to be simpler, cheaper, and easier.

Litigating keywords like it's 1999: An overview of recent (non) developments in the law applicable to keyword advertising

By Daliah Saper & Dominika Szreder¹; Copyright Saper Law Offices, LLC 2008

Let's say your 10-year anniversary is tomorrow. If you are like most attorneys, the only preparation you have undertaken is to calendar the event in your BlackBerry. In hopes of finding those special last-minute tickets, you jump on Google and run a search on "Ticketmaster." While the first few search results link directly to Ticketmaster's homepage, you notice two "sponsored links" immediately to the right of those Ticketmaster links. One of these links, TicketLiquidator.com, promises to beat *everyone's* prices. Not one to miss a good deal, you click directly on TicketLiquidator's sponsored link. Two Celine Dion tickets later, Ticketmaster is out one customer but you and your significant other are in for a magical time. This scenario invites the question: is TicketLiquidator.com lawfully competing with Ticketmaster, or is this a case of trademark infringement in the Internet era?

This article first provides a brief overview of keyword advertising on search engines and the potential implication of infringement when those keywords are a competitors' trademark, like Ticketmaster. The article then outlines the divisive

split among federal courts over whether keyword advertising that utilizes a competitor's trademark constitutes trademark infringement. The absence of an identifiable legal framework, or even a clear trend in the courts, is not a problem unique to our domestic jurisprudence. As this article discusses, the national court systems in the European Union are faced with bodies of law equally as disjointed as our own, with the exception that recent developments in France's high court may finally result in a more settled legal landscape.

What is Keyword Advertising Anyway?

In late 1999, Google was one of the first search engines to try out a new business model based on linking search terms to paid advertising. Nearly a decade later, this provocative business model has become the gold standard for all major search engines, generating billions of dollars in advertising revenue. In 2007 alone, Google generated \$16.4 billion through Adwords, which has quickly become its flagship product and primary source of revenue. Through Google's current AdWords program, advertisers may

bid on or purchase keywords, effectively paying for the right to a "sponsored link" each time an Internet user enters the purchased keyword as a search term. Stated differently, in response to a search, Google not only provides a list of links to relevant sites, but also provides links to those advertisers that purchased keywords through AdWords. Thus, advertisers that purchase keywords pay for the rights to have their Web site displayed in the "sponsored links" section on the right hand side of the screen whenever an Internet user searches those words. Google charges the advertiser a fee each time an Internet user clicks on the sponsored link.

Keywords—as used in AdWords -- are different from metatags. Metatags are HTML or XHTML elements that are used to provide structured metadata for a Web page. These elements are placed as tags in the head section of HTML or XHTML documents. There are three types of metatags: (1) those describing the content of a Web page; (2) those used by search engines to determine whether a particular Web page is relevant to a search term; and (3) those indicating which Web pages are not relevant. The

metatags contain active words used by the search engine to generate a search result list. Like the keywords used in AdWords, metatags are not ordinarily visible to users. Accordingly, trademark litigation stemming from the use of keywords—in either the AdWords or metatags context—involves “invisible” trademark use.

Although AdWords has garnered much praise for its business ingenuity, Google has been criticized and increasingly sued for permitting advertisers to bid on trademarked keywords, particularly those belonging to advertisers’ competitors. Businesses have been battling with their competitors over trademark disputes ever since Google’s AdWords program began.² Often, one business will pay to use its competitor’s trademark as an AdWord keyword. Competitors often argue that this constitutes trademark infringement because it is intended to confuse and eventually divert consumers. One might think that throughout the course of the past near-decade AdWords has been around, courts would have delineated an intelligible legal framework identifying the trademark implications of keyword advertising. One might think wrong. The unsettled state of keyword advertising and trademark law is even more questionable and pervasive today than it was in late 1999, and a string of recent contradicting cases and failed legislation are testament to that uncertainty.

Establishing Trademark Infringement

To prevail on an infringement claim under §32(1) of the Lanham Act, a plaintiff must demonstrate that he/she owns a valid trademark entitled to protection under the statute that defendant used in commerce, without consent, and in connection with the sale or advertising of goods or services.³ The plaintiff must then demonstrate that defendant’s use of the trademark “is likely to cause consumers confusion as to the origin or sponsorship of the defendant’s goods.”⁴ Thus, to be infringing, the questionable conduct must be considered *use* under the Lanham Act, and it must be *likely to cause confusion* among consumers as to the *source* of the goods or services. Whether keyword advertising constitutes trademark infringement is sharply divided among the federal courts. For example, Second Circuit district courts have generally found that use of a keyword to create a “sponsored link” alongside actual search

results does not amount to use in commerce as articulated under the Lanham Act.⁵ Conversely, the Ninth Circuit has consistently held that keyword advertising plainly constitutes use in commerce.⁶

Use in Commerce

Courts still disagree as to whether use of a trademarked keyword constitutes use in commerce under the Lanham Act. On the one hand, district courts in the Second Circuit, which covers Vermont, New York, and Connecticut, have found that Adword and metatag usage does not constitute use in commerce.⁷ As such, both keyword purchasers and search engines like Google have not been held liable for trademark infringement. On the other hand, federal district courts in Illinois, Minnesota, Pennsylvania, and Arizona have held that Adword and/or metatag usage constitutes use in commerce that may lead to trademark infringement under the Lanham Act.⁸ A court in the Southern District of Ohio has even gone so far as to hold metatag usage as *per se* trademark infringement, meaning that simply using a trademark as a metatag is infringement, even if there is no likelihood of consumer confusion.⁹

Just this past year in *Hysitron, Inc. v. MTS Systems Corp.*, a Minnesota court denied defendant’s motion for partial summary judgment on the issue of trademark infringement, finding that the use of plaintiff’s trademark as a keyword constituted use in commerce under the Lanham Act.¹⁰ The defendant, a direct competitor of plaintiff in the nanomechanical test equipment industry, purchased plaintiff’s trademark as a keyword. The sponsored link associated with the keyword purchase did not visibly include plaintiff’s trademark. Nonetheless, plaintiff sued for both trademark infringement and unfair competition, and in response defendant filed a motion for partial summary judgment on the trademark claim. Relying on the logic of Second Circuit line of cases, defendant argued that the use in commerce requirement was not satisfied by keyword advertising. The court disagreed, noting that under the “plain meaning” of the Lanham Act, use of a competitor’s trademark to create a sponsored link qualifies as use in commerce. Because there remained a question of material fact as to the likelihood of confusion, the court denied defendant’s motion.

In contrast to the *Hysitron* holding, the court in *Tiffany and Co. v. eBay, Inc.* held that the nominative fair use doc-

trine protected defendant’s purchase of the plaintiff’s trademark as a keyword.¹¹ Sellers on eBay’s marketplace would frequently offer counterfeit as well as genuine Tiffany jewelry for sale. In turn, eBay advertised the availability of authentic Tiffany products on its Web site and also purchased “tiffany” as a keyword. Tiffany sued eBay for trademark infringement along with a slew of other claims relating to the counterfeit Tiffany products on eBay’s Web site. While discussing keyword advertising and infringement, the court analyzed whether eBay’s keyword purchases qualified as use in commerce. Because the keyword ads used by eBay actually displayed Tiffany’s trademarks to the Internet user, the court noted that the use was not “entirely internal.” Notwithstanding, the court held that the keyword purchase constituted nominative fair use, since eBay’s use of “tiffany” in the “sponsored links” was identical to its use of “tiffany” on its Web site, which the court found to be permissible.

Consumer Confusion

Even when a court decides that keyword usage constitutes use in commerce under the Lanham Act, there is a lack of consensus as to whether the use is likely to cause consumer confusion. The focus of the analysis is whether consumers mistake the source of the advertised products/services. In the case of keyword advertising, this centers on whether consumers confuse the advertiser’s sponsored link with the actual trademark owner. If consumers access the sponsored link, do they believe they are on the trademark owner’s site? While advertisers and Google argue that there is no consumer confusion, trademark owners increasingly disagree, claiming that such use of their marks creates “initial interest confusion.”

The idea of “initial interest confusion” arose in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*¹² The dispute involved West Coast Video’s use of another video store’s trademark, “MovieBuff” as a metatag. The Court of Appeals for the Ninth Circuit found that the use of another’s trademark as a metatag resulted in what they referred to as “initial interest confusion.” Initial interest confusion can be explained as a ‘bait and switch’ luring away of a trademark owner’s potential consumers by initially passing off goods as those of the owner, even if the consumer’s confusion later goes away. For example, even though the results that popped up after searching

"moviebuff" on Google included both businesses' Web sites, the fact that some consumers might end up on West Coast Video's Web site instead was problematic. Because West Coast's Web site was so similar to MovieBuff's, many consumers might initially be confused and not realize they are on the wrong Web site, or might realize but decide to go ahead with the new video store, essentially luring MovieBuff's consumers away.

Recently in *Storus Corp. v. Aroa Marketing, Inc.*, a California district court granted summary judgment to plaintiff, finding that the use of a competitor's trademark as a keyword and in the text of ad copy resulted in impermissible "initial interest confusion."¹³ As a money clip retailer, defendant sold its own line of products on its Web site, as well as plaintiff's Smart Money Clip. In an effort to promote its business, defendant purchased the phrase "smart money clip" as a keyword. Each time an Internet user entered the keyword, defendant's ad copy displayed the phrase "Smart Money Clip" in its heading as a sponsored link on the search results page. The court found that defendant's use of plaintiff's trademark as a keyword and as part of ad copy created a likelihood of "initial interest confusion." Although Internet users may not be confused as to product source once they reached defendant's Web site, the court held that under "initial interest confusion, source confusion need not occur; rather . . . the wrongful act is the defendant's use of plaintiff's mark to divert consumers to a Web site that consumers know is not plaintiff's Web site." Because the defendant failed to prove that confusion factors weighed against a finding of a likelihood of confusion, summary judgment was granted for the plaintiff.

In stark contrast to *Aroa Marketing*, the court in *Designer Skin, LLC v. S&L Vitamins, Inc.*, granted summary judgment in favor of defendant, finding that "initial interest confusion" does not exist where there is no evidence of any attempt by defendant to actually deceive consumers.¹⁴ Defendant, a reseller of various products including those of plaintiff, purchased plaintiff's trademarks as keywords. Plaintiff sued for trademark infringement, arguing among other things that defendant's use of its trademarks as keywords resulted in "initial interest confusion." The court rejected this argument, stating that "initial interest confusion" should only be employed to address deceptive "bait and switch" scenarios, where trademarks

are used to take away customers from a competitor's Web site to another site that only sells competing products. In this case, plaintiff's products were offered for sale on defendant's Web site, and there was no evidence of intention to deceive Internet users.

In a middle-of-the-road decision, the court in *T.D.I. International, Inc. v. Golf Preservations, Inc.*, solidified every trademark attorney's frustrations with this area of law.¹⁵ Denying defendant's motion to dismiss, the court in *Golf Preservations* held that "in light of the uncertain state of the law on the [keyword purchase] issue presented in this case" plaintiff stated a claim for relief that was "plausible on its face." The defendant company, founded by a former employee of plaintiff's company, purchased plaintiff's trademark as a keyword. Relying on decisions from both the Sixth and Second Circuits, the defendant argued that keyword advertising did not constitute trademark use because Internet users do not see plaintiff's trademark associated in any way with defendant's Web site. After considering cases presented by both the plaintiff and defendant, the court simply noted the uncertainty in the law without providing any guidance one way or the other and denied the motion to dismiss.

The Short Story of the Failed Utah "Trademark Protection Act"

In March 2007, the Utah legislature enacted the short-lived Senate Bill 236, also known as the "Trademark Protection Act." This new law allowed businesses to register trademarks as "electronic registration marks." In the event anyone other than the trademark owner used the electronic registration mark to trigger keyword advertising, the Utah statute imposed civil liability on both the advertiser who purchased the keyword and the search engine operator which sold the keyword. Even before the ink was dry on the newly enacted law, powerhouses like Microsoft and Google began aggressively lobbying for a rewrite. In response to the mounting criticism, the Utah legislature quietly amended the bill in March of 2008, effectively removing the provisions of the law that prohibited keyword advertising.¹⁶

State of the European Union

Much like the United States, courts in the European Union have also faced difficulty in defining the parameters of trademark law for keyword advertising.

National courts of member states in the European Union have taken different approaches in determining whether trademark owners have the right to prevent both advertisers from purchasing their trademark as a keyword and search engines from selling the right to that keyword.

France

Although decisions in France have found search engines liable for selling trademarks as keywords, the legal basis for these decisions ranges from trademark infringement to misleading advertising. Infringement has been found where the sponsored link Web sites are accessible in France, irrespective of what the top level domain extension may be. One of the leading decisions on the issue, *Overture v. Accor*, held that search engine operators should be liable for trademark infringement based on the plain language of French trademark law.¹⁷ In *Accor*, Yahoo!'s keyword advertising provider Overture had offered Accor's trademarks to advertisers that were direct competitors of Accor. The court reasoned that since under French trademark law, one may not reproduce, use or affix another's trademark to goods/services without permission, Overture infringed Accor's trademark.¹⁸ Nonetheless, the Paris High Court has recently departed from *Accor's* precedent in *Laurent v. Google France*.¹⁹ In *Laurent*, the court reasoned that Google simply offered a keyword to an advertiser, which in and of itself didn't infringe on any trademark rights. Likening the transaction to more traditional advertising services, the court refused to find any infringement (though Google was still held liable for its failure to investigate whether the requested keywords were being used to "favour" trademark infringement).

United Kingdom

Unlike French courts, UK courts have been much more hesitant to find trademark infringement in cases involving keyword advertising. The English High Court recently held that a search engine selling trademarked keywords does not "use" the trademarks at question; rather, it is the Internet user who employs use of such trademarks in order to conduct a search.²⁰ In the UK, the sale of trademarked keywords to advertisers does not "affect the owner's interests as proprietor of the mark," particularly when search results do not visibly refer to the trademark owner's business in the first place.²¹ Given the clear trend of the law in the

UK, in 2008 Google changed its AdWords policies in the UK. Google no longer monitors or restricts keyword sales to users in the UK (and Ireland).

Germany

Much like the UK, recent German court decisions are also reluctant to find trademark infringement. In February of this year, the Higher Regional Court of Frankfurt ruled that an advertiser using another's trademark as a keyword on Google does not infringe on trademark rights, so long as the keyword ad is separate and apart from the actual search results.²² Use of trademarks in keyword advertising does not amount to actionable trademark use, as Internet users can readily identify the ads as originating from competitors.

Italy

In Italy, the first and only case on keyword advertising distinguished Google's AdWord program from actionable trademark infringement. According to the court, keyword advertising does not inherently encroach upon the function of trademarks, which is to signal the source of products/services.²³ Both Google and advertisers who purchase keywords do not use the trademarks to signal source of products/services. However, the Italian courts did recognize a cause of action for unfair competition by the advertiser in these circumstances.

European Court of Justice Preliminary Ruling

In response to the unpredictable legal standards arising throughout the European Union, the French Supreme Court requested a preliminary ruling from the European Court of Justice ("ECJ") for three different Google cases centered on keyword advertising (*Google v. Cnrhh*; *Google v. Viaticum Ltd*; *Google v. Louis Vuitton Malletier*). Specifically, the Supreme Court wants the ECJ to rule on the cases based on the EU Trademark Directive and Community Trademark Regulation. A ruling from the ECJ will establish whether trademark owners can prevent advertisers and search engines from using their trademarks as keywords, and whether search engines can be held liable for not preventing unlawful trademark use of keywords.

A Lesson From Our European Counterparts

Given the global nature of commerce and increasing interest in protecting trademark portfolios, the call for uniformity in trademark laws is not only favorable—it's necessary. While the European Union awaits the ECJ preliminary ruling on the legality of keyword advertising, the US courts should finally start to make sense of the mess that has recently been made of trademark jurisprudence. Be it through a Supreme Court ruling, federal legislation, or synergy between the circuit courts, the legal uncertainty surrounding keyword advertising must be addressed for the sake of facilitating business across both state and international lines.

While there is no clear answer at the moment, there is some hope for the trademark attorney trying to advise his/her clients. The law surrounding use of a competitor's trademark in the text of a Google AdWords advertisement appears to be established. In general, using a competitor's trademark directly in the text of your own sponsored link advertisement inevitably constitutes use in commerce under the Lanham Act, and also is likely to confuse consumers as to the source of the goods or services being advertised.

In the Meantime...

For those advertisers interested in utilizing Google's AdWords program, a word of caution is necessary. As a result of the differing interpretations by the federal courts, businesses that purchase the trademarks of a competitor as keywords have liability exposure for trademark infringement. Further confusing matters, liability may depend on the jurisdiction in which suit is brought and the laws applied in that suit. However, there are a few steps that any business owner thinking about purchasing a Google AdWord can take to minimize potential liability under current trademark law.

1. Consider purchasing a general or descriptive term instead of the exact trademark of your competitor. For example, purchasing "athletic shoes" or "sneakers" as keywords is less likely to infringe someone's trademark than the purchase of "NIKE" or "CONVERSE."

2. Perform a trademark search before purchasing the term. To the extent the competitor has not used or registered the mark, the risk that the competitor will launch a lawsuit may be lower than if the competitor has registered its trademarks.

3. Do not use the competitor's trademark in the text of any advertisement. Courts generally find this practice infringes on the plaintiff's trademark.

1. dsaper@saperlaw.com & <dszreder@saperlaw.com>

2. *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700 (E.D. Va. 2004); *Buying for the Home, LLC v. Humble Abode, LLC*, 2006 WL 3000459 (D.N.J. Oct. 20, 2006); *Google Inc. v. American Blind & Wallpaper Factory, Inc.*, No. 03-05340 JF, 2005 US Dist. LEXIS 6228 (N.D. Cal. Mar. 30, 2005); *J.G. Wentworth v. Settlement Funding, LLC*, 2007 U.S. Dist. LEXIS 288 (E.D. Pa. Jan. 4, 2007)

3. 15 U.S.C. §1114(1). See *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 406-07 (2d Cir. 2005)

4. *Savin Corp. v. Savin Group*, 391 F.3d 439, 456 (2d Cir. 2004)

5. *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402 (S.D. N.Y. 2006); *1-800 Contacts v. WhenU.com, Inc.*, 414 F.2d 400 (2d Cir. 2005), cert denied, 546 U.S. 1033 (2005)

6. *Brookfield Comms., Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999); *Google Inc. v. American Blind & Wallpaper Factory, Inc.*, 2007 U.S. Dist. LEXIS 32450 (N.D. Cal. 2007)

7. 425 F. Supp. 2d 402 (S.D.N.Y. 2006); *Rescuecom Corp. v. Google, Inc.*, 456 F. Supp. 2d 393 (N.D.N.Y. 2006); *Site Pro-1, Inc. v. Better Metal, LLC*, 2007 U.S. Dist. LEXIS 34107 (E.D.N.Y. May 9, 2007); *Fragrancenet.com, Inc. v. Fragrancel.com, Inc.*, 492 F. Supp. 2d 545 (E.D.N.Y. 2007)

8. *Edina Realty, Inc. v. Themlsonline.com*, 2006 U.S. Dist. LEXIS 13775 (D. Minn. Mar. 20, 2006); *Hysitron Inc. v. MTS Systems Corp.*, 2008 WL 3161969 (D. Minn. Aug. 1, 2008); *Soilworks, LLC v. Midwest Indus. Supply, Inc.*, 2008 WL 3286975 (D. Ariz. Aug. 7, 2008); *International Profit Associates, Inc. v. Paisola*, 461 F.Supp.2d 672 (N.D. Ill. 2006)

9. *Tdata Inc. v. Aircraft Technical Publishers*, 411 F.Supp.2d 901 (S.D. Ohio 2006) (calling metatagging "nefarious conduct")

10. 2008 WL 3161969 (D. Minn. Aug. 1, 2008)

11. 2008 WL 2755787 (S.D.N.Y. Jul. 14, 2008)

12. 174 F.3d 1036 (9th Cir. 1999)

13. 2008 WL 449835 (N.D. Cal. Feb. 15, 2008)

14. 2008 WL 2116646 (D. Ariz. May 20, 2008)

15. 2008 U.S. Dist. LEXIS 7427 (E.D. Ky. Jan. 31, 2008)

16. S.B. 151, Trademark Protection Act Amendments

17. Versailles Court of Appeal, November 2, 2006

18. Article L.713-2.

19. Paris High Court, February 13, 2007

20. *Victor Andrew Wilson v. Yahoo! UK Ltd and Overture Services Ltd*, English High Court, 361(Ch), February 20, 2008

21. *Arsenal Football Club plc v. Matthew Read*, c-206/01, November 12, 2002

22. Frankfurt Appeal Court, February 26, 2008

23. *Key 21 v. Multiutility and Google Italy, Court of Milan*, October 15, 2007

PTO Consistency Initiative: 29 September 2008

In an effort to further improve quality, the Office has created a centralized process by which an applicant may bring to the attention of the Office situations where, in applicant's opinion, the Office has acted inconsistently in its treatment of applicant's pending applications/recent registration(s). Specifically, applicants may submit a Request for Consistency Review when a substantive or procedural issue (excluding any issues involving identifications of goods and services) has been addressed in a significantly different manner in different cases, subject to the following provisions: (1) the request is based on co-pending applications or an application and a registration owned by the same legal entity or a successor in interest (e.g., assignee); (2) the registration(s) involved was issued less than one year prior to the date of the request; (3) at least one of the applications in the request is in a pre-publication status at the time of the request; and (4) the allegedly inconsistent treatment has already occurred. Third parties are prohibited from submitting requests in this forum, and the Office will not consider or act on such requests.

Please note that the establishment of this process should not discourage applicants from first contacting the assigned examining attorneys to address consistency issues. On the contrary, applicants are encouraged to do so because of the examining attorneys' familiarity with and knowledge of the issues raised in their Office actions.

Issues concerning identification and classification of goods and services have been excluded from the program at this time, in large part because of the easy mechanism for consistency where an applicant selects an acceptable identification set out in the Office's Manual of Acceptable Identifications of Goods and Services. Nonetheless, applicants who are unable to resolve identification and classification issues in co-pending applications assigned to more than one examining attorney may contact the managing attorneys of the law offices involved (see list at <<http://www.uspto.gov/teas/contactUs.htm>>). Of course, as a matter of practice, applicants should first make a good faith effort to resolve these issues amongst the examining attorneys assigned to the applications

before contacting managing attorneys. Applicants should not contact the examining attorney of any application that has already registered unless the examining attorney is also assigned to one of the co-pending applications at issue.

In all requests, applicants must briefly describe the allegedly inconsistent action, and list the application(s) and/or registration(s) involved. Requests must be limited to situations where inconsistent treatment allegedly has already occurred. All requests will be scanned into the USPTO's database and will be viewable by the public through Trademark Document Retrieval (TDR). Applicants may not submit additional evidence. If evidence is submitted, it will not be considered during this process.

The Office will promptly review and consider each request. The Office will not respond directly to the request, but action will be taken in the pending application(s) if the Office deems it appropriate. Requesters can expect that any action taken should occur within four to six weeks of the date of the request, and requesters may review the Office's online electronic systems (TDR, TARR) to monitor changes in the identi-

fied applications. Requesters should note, however, that subsequent action taken by the Office may differ from that requested. Alternatively, the Office may determine that different handling of the cases is appropriate, and no action will be taken. Generally, no action can be taken to amend, or cancel and restore to application status any existing registrations as a result of a request.

Applicants must send requests to TMCONSISTENCY@USPTO.GOV. The filing of a request does not provide a basis to request suspension of an application or appeal and will not stay the period for replying to an Office action, filing a notice of appeal or submitting any other filing that is due before the Office.

The Office anticipates that this consistency initiative will provide a useful mechanism for the public to raise concerns and a valuable means for the Office to improve quality. The initiative is being conducted as a one-year pilot to allow for evaluation and refinement of the process as needed.

[For more PTO Announcements and Press Releases, see <www.uspto.gov/main/news-andnotices.htm>

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Labeling for human drug products now requires toll-free number for reporting adverse events

Final Rule: Toll-Free Number for Reporting Adverse Events on Labeling for Human Drug Products

Federal Register: October 28, 2008 (Volume 73, Number 209) Page 63886-63897

AGENCY: Food and Drug Administration, HHS.

SUMMARY: The Food and Drug Administration (FDA) is issuing a final rule that confirms the interim final rule entitled "Toll-Free Number for Reporting Adverse Events on Labeling for Human Drug Products" (73 FR 402, January 3, 2008) (interim final rule) and responds to comments submitted in response to the request for comments in the

proposed rule of the same title (69 FR 21778, April 22, 2004) (proposed rule). This final rule affirms the interim final rule's requirement for the addition of a statement to the labeling for certain human drug products for which an application is approved under section 505 of the Federal Food, Drug, and Cosmetic Act (the act). The statement includes a toll-free number and advises that the number is to be used only for reporting side effects and is not intended for medical advice (the side effects statement). This final rule also affirms the interim final rule's addition of new part 209 to the regulations requiring distribution of the side effects statement. This final rule implements provisions of the Best Pharmaceuticals for Children

Act (the BPCA) and the Food and Drug Administration Amendments Act of 2007 (FDAAA).

DATES: Effective Date: This final rule is effective November 28, 2008. Compliance Date: The compliance date for this final rule is July 1, 2009. For more information on the compliance date see section II of the SUPPLEMENTARY INFORMATION section of this document.

FOR FURTHER INFORMATION CONTACT: Carol Drew, Center for Drug Evaluation and Research, Food and Drug Administration, 10903 New Hampshire Ave., Bldg. 51, rm. 6306, Silver Spring, MD 20993-0002, 301-796-3601.



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February 2009

Tuesday - Saturday, 2/03/09 - 2/07/09—Chicago, ISBA Regional Office—40-hour Mediation/Arbitration Training. Master Series Presented by the Illinois State Bar Association.

Friday, 2/06/09—Bloomington, Doubletree—Agricultural Law Update 2009. Presented by the ISBA Agricultural Law Section, co sponsored by the ISBA General Practice, Solo & Small Firm Section.

Thursday, 2/12/09—Chicago, ISBA Regional Office—Workers' Compensation - Back to Basics. Presented by the ISBA Workers' Compensation Section.

Friday, 2/13/09—Chicago, ISBA Regional Office—Fool for a Client: A Guide to Representing Yourself in ARDC Proceedings. Presented by the ISBA Standing Committee on Attorney, Registration & Disciplinary Commission.

Monday, 2/16/09—Fairview Heights, Four Points by Sheraton—Workers' Compensation - Back to Basics. Presented by the ISBA Workers' Compensation Section.

Friday, 2/20/09—Champaign, Hawthorn Suites—Fool for a Client: A Guide to Representing Yourself in ARDC Proceedings. Presented by the ISBA Standing Committee on Attorney, Registration & Disciplinary Commission.

Friday, 2/27/09—Chicago, ISBA Regional Office—Sharpen Your Trial Skills. Presented by the ISBA Tort Law Section.

Friday, 2/27/09—Hoffman Estates, Northern Illinois University Hoffman Estates —Safe and Sound: The Attorney's Role in School Safety and Security. Presented by the ISBA Education Law Section (cap 75).

March 2009

Thursday, 3/05/09—Chicago, ISBA Regional Office—Legal Technology for Non-Techies: Topics, Trends, and Tips to Help Your Practice. Presented by the ISBA Standing Committee on Legal Technology.

Friday, 3/06/09—Chicago, ISBA Regional Office—Advanced Practice Issues For Employment Lawyers. Presented by the ISBA Labor & Employment Section.

Friday, 3/06/09—Fairview Heights, Four Points by Sheraton—Resolving Family Law Issues. Presented by the ISBA Family Law Section.

Friday, 3/13/09—Chicago, ISBA Regional Office—Resolving Family Law Issues. Presented by the ISBA Family Law Section.

Friday, 3/27/09—Rockford, Northern Illinois University Outreach Centers—Hanging Out Your Shingle (Without Hanging Yourself). Presented by the ISBA General Practice, Solo & Small Firm Section.

Friday, 3/27/09—Chicago, ISBA Regional Office—Trial Practice: Pre-Trial Motions through Appeal. Presented by the ISBA Civil Practice and Procedure Section.

April 2009

Friday - Saturday, 4/17/09 - 4/18/09—Edwardsville, Lewis & Clark Community College—Basic Skills for New Attorneys. Presented by the Illinois State Bar Association.

May 2009

Friday - Saturday, 5/08/09 - 5/09/09—Chicago, ISBA Regional Office—Basic Skills for New Attorneys. Presented by the Illinois State Bar Association.

June 2009

Thursday - Friday, 6/04/09 - 6/05/09—Peoria, Bradley University—The 2009 Annual Illinois Traffic Court Conference—Presented by the Illinois Traffic Court Conference Committee, Co-sponsored by the Illinois State Bar Association.

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