

# CRUZ & RUZ, PLLC

RECENT DEVELOPMENTS IN INTELLECTUAL PROPERTY LAW  
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"The true sign of intelligence is  
not knowledge but imagination."

Albert Einstein

## BENEFITS OF FEDERAL TRADEMARK REGISTRATION

1. Evidence of ownership of the trademark.
2. Constructive notice nationwide of the trademark owner's claim.
3. Jurisdiction of federal courts.
4. Possibility of obtaining enhanced damages otherwise not available.
5. A basis for obtaining registration in foreign countries.
6. Can be recorded with U.S. Customs Service to prevent importation of infringing foreign goods.

## TRADEMARKS

### Generic Marks.

There are four main categories of marks. One of these is known as "generic." A term cannot be protected as a trademark when it refers to a whole "genus" of goods or services. Such terms cannot distinguish one product within the genus from another. In other words, generic marks cannot provide any indication of source.

In the recent case of *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 U.S.P.Q.2d (BNA) 1682 (Fed. Cir. 2009) the Federal Circuit dealt with the issue of whether a generic term, such as the word "mattress," was otherwise protectable by the addition of a top-level domain name, such as the familiar ".com" designation. The Federal Circuit affirmed the TTAB finding that "mattress.com" was generic in relation to online retail store services in the field of mattresses, beds, and bedding. The main issue was whether the relevant public understood "mattress" to refer to the genus of services at issue, namely, online retail stores in the field of mattresses, bed and bedding. The Federal Circuit found that the TTAB properly gave controlling weight to the large number of similar uses of "mattress.com" by third parties, as well as the common meaning of words "mattress" and ".com." Additionally, the Federal Circuit found substantial evidence to support the TTAB's conclusion that consumers would immediately recognize "mattress.com" as a term that denotes a commercial website that provides retail services featuring mattresses. Thus, the registration of "mattress.com" was properly refused.

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## COPYRIGHTS



### **SINCE COPYRIGHT PROTECTION EXISTS WHEN THE WORK IS CREATED, IS IT NECESSARY TO APPLY FOR COPYRIGHT REGISTRATION?**

Even though copyright protection is secured automatically upon creation of a "work of authorship," there are definite advantages to copyright registration. Registration establishes a public record of the copyright claim. Before an infringement suit may be filed in court, registration is necessary for works of U.S. origin. If made before or within five years of publication, registration establishes *prima facie* evidence in court of the validity of the copyright and of the facts stated in the certificate. If registration is made within three months after publication of the work or prior to an infringement of the work, statutory damages and attorney's fees may be available to the copyright owner in court actions. Also, registration allows the owner of the copyright to record the registration with the U.S. Customs Service for protection against importation of infringing copies.

### **Minimal Originality Requirement.**

In order to be afforded copyright protection, a work must possess some element of originality. However, the threshold of originality is rather minimal and is usually satisfied if it can be shown that "the 'author' contributed something more than a merely trivial' variation, something recognizably 'his own.'" *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991).

In the recent case of *Utopia Provider Systems, Inc. v. Pro-Med Clinical Systems, LLC*, 596 F.3d 1313 (11th Cir. 2010) the court decided the issue of whether Utopia's registered system of templates for use in hospital emergency rooms had the requisite amount of originality to be afforded copyright protection. Utopia had obtained a copyright registration for various templates which consisted of two- or three-page charts useful for a particular type of ailment, and included a series of headings or questions with space to record information for the patient. Utopia sued the defendant Pro-Med for, among other things, copyright infringement related to Pro-Med's unauthorized use of the registered templates. The Eleventh Circuit noted that blank forms that do not convey information or contain original pictorial expression are not copyrightable, and thus upheld the lower court's finding of noninfringement. Utopia argued that the Supreme Court in *Feist* modified the Eleventh Circuit's standard of "conveying information," and that only minimal creativity is required. The Eleventh Circuit disagreed with Utopia, distinguishing *Feist* on the basis that factual compilation, not blank forms, were at issue in *Feist*, and stated that nothing in *Feist* indicated that a different standard was to be applied to blank forms. Thus, the Eleventh Circuit held that the headings and questions posed in the templates at issue, including the selection and arrangement thereof, did not to contain the requisite originality to merit copyright protection.

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