

# Trademark Counsel in the Federal Government - A Practitioner's Perspective

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## **I. INTRODUCTION**

Over the course of my fifteen years of practicing law with the U.S. Department of Commerce, I have witnessed a growing awareness on both the legal and policy front as to the need for effective counsel in the areas of trademark law and an increasing recognition as to the many benefits that the creative use of this form of intellectual property can bring. Agencies are behaving more and more like private sector entities, in terms of marketing, branding, and entrepreneurship; and are offering more products and services to the public. They are also engaging in partnerships and other activities with the private sector, some of which have lost funding as a consequence of the privatization of government programs. As a result, agencies are developing new names, logos, slogans, and other marks; registering and disputing domain names; establishing countless Web sites; and otherwise are engaging in numerous activities that give rise to intellectual property implications. In this Article, I hope to give a practitioner's perspective on trademark practice in the Federal Government and also touch on copyright issues as they arise within this and other contexts.

As stated above, more and more federal agencies are learning the value of their trademarks and are learning to license or "leverage" them to the private sector, similar to the manner in which they might engage in "technology transfer" relating to patents. Correspondingly, agencies are also recognizing the need for vigilance with respect to protection of their trademarks and copyright interests and have become more active in the areas of registration and enforcement. Given the huge amount of IP work that the proliferation of the Internet and Information Technology boom have created, agencies and their general counsel's offices are devoting more time and attention to IP issues. Indeed, trademark and copyright practice at the federal level has taken off.

It has not always been so. In this writer's estimation, for many years the majority of Federal Government intellectual property law practitioners, if there were any, were patent attorneys first and trademark and copyright lawyers second, more out of necessity than design. Agencies would address trademark or copyright issues only when they arose, usually in the area of trademark infringement (often, with Uncle Sam as the alleged infringer). With the exception of the U.S. Postal

Service and my own agency, the U.S. Department of Commerce, not many federal agencies gave much thought to trademarks on a large scale.<sup>2</sup>

But this began to change in the 1990s, due to a number of reasons, including, but not limited to: (1) the dramatic growth of the Internet; (2) the privatization of federal programs, bringing about the need for public-private partnerships and royalty-generating activities such as trademark licensing; (3) the increased capabilities offered by desktop publishing and graphics (including clipart) at the staff level, giving rise to the creation of new and varied logos to represent agency programs, products, and services; and (4) a growing awareness on the federal level as to the importance of marketing, image, "branding," and advertising.

As mentioned above, I hope to give an overview of my agency's trademark and copyright practice. I will try to cover the panorama of issues beginning with the first encounter with a client to discuss a new mark; performing a trademark search; assessing the mark's registrability; registration of the mark as a federal trademark and/or service mark (including the examination process) and follow up with client; accompanying domain name registration; the monitoring of trademarks; enforcement against infringement (including domain name disputes); licensing; and related issues. I will also go through a typical public-private partnership, such as a Web site, and discuss issues raised therein, such as ownership of trademarks, copyright as to content, Web site design, patent issues (such as software)

I will focus on trademark practice, as that is my main area of activity, nevertheless I will address copyright and related IPR issues as they come up. In some ways this will be a primer on trademark practice for government attorneys, but should also provide some observations and suggestions of use to practitioners outside the Government.

## **II. OPENING COMMENTS**

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<sup>2</sup> At the time of this writing, both the U.S. Postal Service and the U.S. Department of Commerce have registered approximately 200 trademark and service marks.

Notwithstanding my observations as to the increasing savvy of government agencies with respect to trademarks, there are still far too many people out there, both in the government and private sector, who believe that there is no such thing as a government trademark, that government agencies are precluded from owning trademarks (I have had to explain this, indeed, prove this to other federal attorneys ), that all government names, logos, and other marks are in the public domain, free for anyone to use. It is possible that people are confusing trademarks with copyright, which is not uncommon. Indeed, the terms patent, trademark, and copyright are commonly used interchangeably by lawyers and laypersons, alike. This continuing degree of naivete, for want of a better term, is a challenge to any government trademark practitioner, and is the primary reason for my recommendations, below, about educating the client.

**A. Know the Client**

Like any lawyer in general, a successful government trademark practitioner should know the client and know as much about the agencies, offices, programs, products, and services that is possible. Often, the work does not come to the attorney, the attorney has to proactively go to the work and recommend to the client that, say, a given trademark should be registered, or a particular offending domain name or infringement should be challenged.

As for my clients, under the U.S. Department of Commerce umbrella are many individual agencies, including (1) the National Oceanic and Atmospheric Administration® (NOAA®) (which includes the National Weather Service, the National Hurricane Center, the National Marine Fisheries Service, the National Ocean Service, the National Marine Sanctuaries® Program, and other programs and sub-agencies); (2) the Economics and Statistics Administration (which includes the Census Bureau, Bureau of Economic Analysis, and Stat-USA® programs); (3) the International Trade Administration (which includes the U.S. & Foreign Commercial Service® and Office of Trade Development); (4) the Technology Administration (including the National Institute of Standards and Technology (NIST®), National Technical Information Service® (NTIS®), and National Medal of Technology®); (5) the National Telecommunications and Information Administration (NTIA); (6) the Minority Business Development Administration (MBDA); (7) the Economic Development Administration (EDA); (8) the Bureau of Information and Security (BIS) (formerly the Bureau of

Export Administration, or BXA); and, of course, (9) the U.S. Patent & Trademark Office (USPTO or PTO).

The Commerce Department employs approximately 40,000 workers located around the globe. It also produces and disseminates a wide variety of goods and services. The job of being its trademark counsel is very much like that of an in-house counsel to a large global conglomerate in many aspects.

**B. In-House Counsel or Contracted Out?**

Within the Commerce Department's Office of the Chief Counsel for Technology, which serves as intellectual property counsel to the Department, we handle the vast majority of our trademark and copyright work in-house, while we contract out much of our patent prosecution work to private sector law firms. It may well be that other agencies, with more of a patent-heavy emphasis, might do things in the reverse. I only wish to point out that either service may be contracted out, as budgetary and other perspectives dictate.

**C. Educate the Client**

The process often begins at the beginning of the mark itself, when you meet with an agency contact to discuss a new program, its name, the logos and slogans (also called "taglines"), and other identifiers that the programmatic activity will use. Perhaps I have gotten ahead of myself: I may have jumped to the conclusion that this meeting would have ever taken place and that the client is even aware of these issues or the attorney's existence.

Indeed, as I discussed above, although government agencies are becoming more cognizant of the importance of marketing, branding, etc., to say that they are as savvy in these respects as the private sector may be an exaggeration. Many offices might proceed with a new program name, logo, or slogan with no thought of seeking legal counsel and if any thought is given to doing a trademark search, it might be done on a "do-it-yourself" basis. As such, my first advice to trademark practitioners in the Government and anywhere, for that matter, would be to educate your clients as best you can, and make them know of your existence, make them aware of the importance of timely and comprehensive trademark counsel.

How to do this? From my own experience, I have learned that it is invaluable to have good working relationships with attorneys in other offices within the General Counsel's Office. Attorneys who might assist a client in specialty areas such as administrative law,

ethics, procurement, grants/cooperative agreements, litigation, legislative affairs, or general practice attorneys representing particular agencies, all serve as a first line of defense in terms of spotting IPR issues. They also direct clients with new or existing programs and field inquiries from the outside with respect to IPR issues. I mentioned earlier the many agencies under the Department of Commerce umbrella, each agency or program has legal counsel, and I have endeavored to have good working relationships with each office, and to help them help me get the word out to the clients.

I also recommend a large amount of proactive, direct contact with the clients, both new and existing. Consider using an all-hands e-mail to employees, to educate them as to the importance of trademarks, of trademark counsel, etc. The last thing any trademark lawyer wants to hear, whether private sector or government, is that poor decisions have been made which could have been avoided if only they had contacted their IP lawyers, indeed, if only they knew they existed. Make use of any venue for client contact, such as employee roundtables, brown bag lunches, and other means formal or informal. I cannot stress enough the importance of this sort of proactive approach to educate the client and increase its level of awareness.

Of course, there are instances when you do not come in at the beginning of a program, in fact, you are introduced to the mark when it has already been out there for a number of years. Sometimes this is a good thing, since the mark has gotten some use before the public, gained some goodwill, and even more importantly, established priority of rights over other marks with identical or similar names. Or has it? I have had to deal with more than one situation where the client adopted a name, say, ten years ago, and never asked me to register the name as a trademark. Several years later, someone else registered the name for use on similar services. When that mark was brought to our attention, it appeared as if we might end up on outside looking in, in danger of losing our mark to a mark with lesser priority but one that "beat us to the Trademark Office."

We resolved the issue by contacting the owner of the registered mark, pointing out our priority, and asking if perhaps a compromise could be worked out so that we could both own registrations as long as we occupied separate "turf." In carrying out these negotiations, we subtly suggested that we could, if we so desired, file to cancel their mark based on our prior use, but that we would be

amenable to allowing it to stand provided they allowed our mark to become registered. We ended up with a favorable outcome for both parties. We were fortunate that the registered mark was not yet five years old, and had not yet filed for "incontestability" under section 15 of the Trademark Act.<sup>3</sup>

### **III. MEET THE TRADEMARK**

#### **A. The First Meeting**

So, you are sitting across from the client who is telling you about a new program the agency is preparing to launch. Or, it could be a program that has been in place for ten years. Let's say that the program involves working with local and state government, as well as non-profit organizations, to increase the export of American goods and services abroad, thereby aiding the domestic economy as well as lessening the trade deficit. There will be a Web site, where information on exporting can be found (e.g., how to obtain export licenses, information on foreign markets, shipping, and barriers to trade/tariffs). There will be a monthly magazine offering success stories, and information of use to exporting companies. There will be a CD-ROM product with similar content and there will be promotional items, such as T-shirts and hats, as well as coffee mugs. Finally, there will be an educational element: work shops and seminars on exporting and foreign trade. The program will have a name, possibly an acronym, a logo, and a tagline (hereinafter "marks"). The client might even have picked out a possible domain name, such as blank.gov. My first thought is to perform a trademark search on the name, including domain name alternatives, to advise the client as to the availability of the mark(s) they have chosen.

During this initial meeting, I will also assess the possibilities surrounding registration of the mark(s) as a U.S. trademark. Using the list of International Classes found in *Basic Facts About Trademarks*, for example, we will consider registering the mark in Classes 9 (CD-ROMs), 16 (print media products), 21 (coffee mugs, glassware), 25 (clothing, hats), 41 (educational services, such as seminars and workshops, as well as educational services and information offered online), 35 (business services, including online) and 42 (research services). We will also discuss whether or not it is necessary to register all or any of the marks in all available classes of goods and

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<sup>3</sup> 15 U.S.C. § 1065 (2000).

services. Often, this is determined by the client's budget, a smaller budget limiting the registrations to the "bread and butter" classes of goods and services. To file a trademark application costs \$335 for each class. Our discussion will include the possibility of requesting a fee waiver from the USPTO, which is granted on an occasional basis to federal agencies (see below).

**B. Intent-to-Use or Use Based?**

For many years, a trademark application could only be filed after use of the mark had been made in interstate commerce. The Trademark Act was amended in 1988 to allow the filing of trademark applications based on a bona fide intention to use the mark, called an Intent-to-Use (ITU) application.<sup>4</sup> Generally, the ITU process works like this: the ITU application is filed just like any other application (more on this, below). It is assigned a serial number and an examiner, who does a trademark search, reviews the description of goods/identification of services language, and otherwise determines whether the mark is registrable (assuming it is not generic, descriptive, or confusingly similar to another mark). When the examination process has been completed, the USPTO issues a Notice of Allowance, basically telling the applicant "we intend to grant a registration to this ITU application once you start using the mark in interstate commerce on the goods or services and once you provide a Statement of Use showing such use." This is what I call the "Show Me" portion of the ITU process. Once a Statement of Use is filed, the USPTO issues the registration.

If the mark has already been in use, obviously, the ITU process is not an issue. However, if the client is making preparations to launch a program at a future date, this does come into play. The first thought is to get to the Trademark Office as soon as you can, by filing an ITU application, in order to get your foot in the door and establish a priority claim as to that mark. Sometimes this is the sound view, sometimes not.

Why not? Well, let's just say that I have had many experiences where clients behave like a grocery shopper with an empty stomach. They go a bit overboard in terms of filing ITU applications that cover the waterfront. Of course we are going to have a Class 9 product, and Class 16, 21, and 25 products, and did I mention key chains? And we will have Web-based services in this and that class.

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<sup>4</sup> 15 U.S.C. § 1051(b) (2000).

What often happens is that you file these many ITU applications, and endure the rigors of the examination process for each, and when you get to the five yard line, when the USPTO has issued a Notice of Allowance and you advise the client that the time has come to show use, you will often find that a) the client has lost interest in this mark, b) has lost funding for many of the components of the "full suite of products and services" they had envisioned in their starry-eyed early days, or c), in the case of stylized marks and designs, they have materially changed the "look" of the mark.

This latter occurrence is perhaps the most vexing. If the client, say, has abandoned its plans to offer a CD-ROM product, fine, you simply allow the Class 9 application to lapse. However, if the client has made material changes to the mark (such as a logo), then you not only have to allow the application in which you have invested over a year to lapse, but then you also have to file a new one to cover the new-look mark. As this is a lesson I have learned the hard way, I strongly recommend that trademark attorneys make it very clear to clients that the mark that is applied for and the mark that goes into use must be consistent. They cannot make modifications to the mark and expect the application to stay valid. Of course, this has a "tail wagging the dog" sound to it. Should the client be forced to stick to the original version of the mark just because it is the one that is on file with the USPTO? Perhaps not. Nevertheless, the client must be aware of the consequences of modifying the mark and proceed carefully.

Similarly, when the mark has attained registration, when advising the client as to the correct use of the mark, the ® symbol, and maintenance requirements, it is also important to remind the client that if material changes are made to the mark and the original version is abandoned, then this newly-registered version is no longer valid.

#### **IV. THE TRADEMARK SEARCH**

##### **A. Searching for the Trademark**

In most ways, the Internet has made trademark searching much easier. The U.S. Patent & Trademark Office's database of registered, pending, and canceled/abandoned trademarks and applications, known as TESS, is easy to search. The PTO's main Trademarks page is located at <http://www.uspto.gov/main/trademarks.htm>. Simply click on "Search Trademarks" to search the database using a variety of search types (basic, Boolean, free form). As a general plug for PTO, I strongly recommend that any practitioner become very familiar with the PTO's trademark pages, including TESS, because they offer a great deal in terms of resources and information. The PTO primer known as Basic Facts About Trademarks, available online, is an invaluable source of general information on trademark registration, the benefits of registration, application and drawing requirements, the examination process, and other issues.

When performing the search, it's important to consider all possible "variations on the theme," all possible spellings, pluralizations, tenses, etc. For example, if the mark in question were "QuickSearch," a thorough search would include variations on the spelling of "quick," including "quik," "qwik," "kwik," "qwick," and "kwick." You would not want to declare a mark as being available and later on discover, by means of a cease and desist letter, that the mark was not available if spelled slightly differently.

Since I work in close proximity to the USPTO's Trademark Search Room, located in Crystal City, Virginia, I usually perform a manual search, in addition to the TESS and common law (which I will get to below) searches. However, the manual search is gradually becoming somewhat obsolete, as the Search Room files are no longer being updated.

As for the common law search, I make great use of Internet search engines such as Google.com and NorthernLight.com. One has to remember that the USPTO search will only determine if a given mark has been filed with the USPTO. A USPTO search will not tell you if the name is in use in commerce, with common law rights accruing on such use. During the early days of the Internet, countless start-ups jumped into business, using names, slogans, and other marks without doing anything more than registering the domain name. In many cases, filing to register the name with PTO never happened. As a result, there are countless names out there, old and new, that are in use and are legitimately considered common law

trademarks and they pose every bit as much a challenge as the marks that have been registered with the USPTO.

My next step (and in some cases my first step, when a very common name has been selected) might be to see if the name has already been registered as an Internet domain name in one of the generic Top-Level domains, i.e., .com, .net, .org, .info, .biz, as well as relevant country code domains, notably .us. In some cases, a knockout punch can be delivered to a proposed name at this stage. If there already is a proposedname.com out there, engaging in a use that might pose a problem to the agency, the name is quickly abandoned.

On this latter point, the Government, as is the case on many fronts, must be extremely careful to avoid the appearance of affiliation, endorsement, or authorization of a private sector entity. This issue goes beyond the avoidance of infringement. Indeed, if a government registers a domain name in .gov, and provided a suite of services at that the address ChosenName.gov, in addition to worrying about infringing the trademark rights of ChosenName.com, or .net the agency must also worry about creating the appearance that the agency endorses or has any connection with ChosenName.com or anything similar thereto, especially if that site is in any way related to the activities of the Government's site.

Further, the Government must be particularly sensitive to avoiding infringement or the likelihood of confusion, especially my own department. It would not look good in the press or elsewhere if the Department of Commerce, which is the agency responsible for protecting trademarks, is engaging in activity that arguably infringes someone's trademark.

Getting back to the trademark search, having access to the vast resources of the Internet makes finding other users of marks much easier and for that matter it is easier to share the results with the client. Often, I will find a similarly or identically named product or service, copy and paste the URL of that product or service into an e-mail to the client, and basically say to them, "Look, I found this other use of this name you have chosen, nevertheless, this does not mean that we cannot use the name. Just as there are multiple users of marks such as Delta (airline and faucets), Outback (car and steakhouse), Life (board game, cereal, and magazine), Thunderbird (car and cheap wine), and Sunbeam (small appliances, sliced bread, as well as vintage sports car), there could be peaceful coexistence of this name, provided we can distinguish between our products and/or services and those of the other owner(s). Check it

out and get back to me."

Although the Internet makes many aspects of the trademark search easier, in some respects, particular with respect to domain names that have been registered during the domain space land rush of the late 1990s, making a determination as to availability can be a challenge. Federal government agencies are generally going to give their products or services names that require little imagination on the part of the customer, names that tell what the product or service are. In trademark parlance, of course, this is called "descriptiveness." Indeed, the Government generally avoids creative, fanciful, coined, or nonsensical names such as Amazon.com, Monster.com, Dreft, or Exxon. Government names must tell the customer what the subject of the activity is or at least give them a good hint.

As a result, many government names are not the most original things you'll ever see. Consequently, many of the names that agencies decide on have already been snapped up as Internet domain names. Suppose our client's export-related Web-based suite of services were to be called Widgets America. Because of the popularity of these two terms (play along with me), there would be a high likelihood that WidgetsAmerica.com, WidgetsAmerica.net, .org, .biz, .info and .us have already been registered.<sup>5</sup>

Many registered domain names do not resolve or "point" to active Web sites. They have been registered by entrepreneurs who are either hopeful of having someone purchase the domain name from them or perhaps they have good faith designs on the name themselves for later use. Or, of course, they are cyber squatters, meaning they registered the domains in bad faith, aware that the domain name is "riding the coattails" of a name associated with someone else (more on this later). As such, when you have discovered that ChosenName.Net has already been registered, and your client wants to use it in the .gov domain, and the domain name does not lead to an active site, you have an uncertain situation to assess. While it is likely that the owner of ChosenName.Net will never use the name, there is a chance that a site will be launched tomorrow. How can you know? The safety net, so to speak, is that trademark rights are based on use of a mark in commerce, not the mere registration of a domain name. So, as long as you commence

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<sup>5</sup> As an aside, I am shocked, shocked to report that at the time of this writing, all of these domain names are available.

your use prior to that of any other user, you will have that in your back pocket, notwithstanding any previously registered domain names.

This is somewhat analogous to an Intent-to-Use (ITU) trademark application, to be discussed below, to the extent to which the party doing the trademark search will often have to "sweat it out" waiting for the party who filed the ITU application to either make use of the name or allow it to lapse.

**B. Results of Search - Trademark Availability/Clearance Memo**

After the trademark search results have been compiled, I recommend sitting down with the client to discuss them. Remember, the client knows his/her product or service better than you do. If you have located an identical or similar mark but on different goods or services, perhaps your client's prospective use is okay, perhaps you can distinguish and reconcile the two uses and argue that they can peacefully coexist. The client's assistance in this process is indispensable. The attorney should warn the client that no trademark search is perfect: even though a good faith argument can be made to distinguish possibly conflicting marks, there is never a guarantee that the other party, or a party as yet unknown, might object to the client's use of the mark. It is important that the client understand the risks. This can be conveyed both in person and in writing, in the form of a memo to the client outlining how the search was conducted, the notable results, distinguishing arguments, and possible ramifications in the event of a challenge.

**V. TO REGISTER OR NOT TO REGISTER**

**A. To Register or Not to Register**

Not every agency or program name, slogan, logo, or other mark deserves or requires a trademark registration. I generally will register a mark if I feel that it is especially visible and/or vulnerable and if the agency is making an appreciable investment in the mark. Of course, if the client insists on having a trademark registration, I will likely oblige. Whether or not we decide to apply to register the mark as a U.S. trademark or service mark, I will recommend to the client that the TM symbol be used adjacent to the mark, to the upper right of the word or design mark. This puts the public on notice that the owner of the mark considers it to be its trademark or service mark, and also, in my view, encourages the client to think in terms of branding and marketing and to recognize and appreciate the value of agency marks as intellectual property

Often, of course, the client will ask why it is necessary or advisable to register the trademark. The USPTO's excellent booklet, *Basic Facts About Trademarks*, offers good advice on the matter. Registration offers the following advantages:

1. Constructive notice to the public of the registrant's claim of ownership of the mark. This effectively precludes an infringing party from claiming "innocent infringement," i.e., that he did not know of the existence of your mark. This is also important, as discussed above, with respect to cases where the client has used a mark for ten years, never thought to come to me to register the mark, and then was aghast to receive a cease and desist letter from the owner of a registration on an identical mark, in spite of the fact that the client's use of the mark predated that of the registered mark by a number of years! If that subsequent user and registrant of the identical mark had known about the client's mark, say, if the client's mark had been registered, the owner of the registered mark likely would not have chosen that name and, indeed, the USPTO likely would not have registered the mark if your client had a prior registration. As a result, the owner of a common law trademark could be in the position of having to challenge (by filing to cancel which is expensive) an inferior mark simply because that mark's owner beat him to the Trademark Office;

2. Legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;

3. The ability to bring an action concerning the

mark in federal court;

4. The use of the U.S. registration as a basis to obtain registration in foreign countries; and,

5. The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

Add to this the fact that an Internet domain name dispute (explained below) will likely have a better chance of succeeding if the mark is registered. Further, and this is peculiar to federal agencies, having the registered trademark ® symbol adjacent to the mark will help dispel the notion that government marks are in the public domain and free for anyone to use as they see fit.

Regardless of whether or not you apply to register, it is important that the client understand that the mark is a trademark either way. Explain the concept of common law trademarks, i.e., as long as continuous use of a mark is made, common law trademark rights accrue. I often analogize this to marriage, you can live with someone for a certain amount of time but never marry, and even though there is no official marriage certificate, there might be marital rights.

With this in mind, encourage the client to use the ™ or K symbols adjacent to the mark. Of course, this is recommended whether or not you file to register the mark. After all, these symbols simply serve to tell the world that you consider the mark to be your trademark or service mark, they do not necessarily suggest that an application is pending. I cannot stress enough the importance of notifying the public as to a claim of trademark, if anything to dispel the notion that the mark is not protected and is in the public domain.

#### **B. Filing to Register Overseas**

The Commerce Department owns approximately twenty registrations in foreign countries, all of which were registered with the assistance of local counsel operating under contract. The bulk of these marks are owned by the National Technical Information Service, which sells a significant number of government information products in foreign countries. We chose to register certain marks abroad in order to protect our interests therein.

#### **C. Consider Parallel, Preventive Registration of Marks as Domain Names**

Regardless of whether or not the client applies to register a new name as a trademark, I generally recommend that the client strongly consider registering the name as a domain name in all relevant generic Top-Level and Country Code Domains, namely .com, .net, .org, .biz, .info, and .us. I recommend this course of action when the mark is considered "visible and vulnerable," in other words, a name that the agency is investing in heavily, and a name that might fall prey to cyber squatters. I need only refer clients to the unfortunate situation presented by whitehouse.com, the adult-oriented Web site that is anything but the official Web site of the White House, which is located at [www.whitehouse.gov](http://www.whitehouse.gov).

Similarly, when new or reconstituted domains come along, such as .biz, .info, and .us have in the past two years, I contact all of my trademark clients to let them know about the "Sunrise Period" or pre-registration periods afforded trademark owners, to allow them to protect trademarks from registration by others who might be operating in bad faith.

Of course, I also recommend that any domain registrations in any domain other than .gov should be done in consultation with the agency's Chief Information Officer (CIO), since some CIOs have, for policy reasons, frowned on agencies registering names in non-.gov domains. It is felt that agencies should not be tying up names that the private sector might peacefully use and also that if agencies maintain Web sites at .com or other non-.gov addresses, it might create confusion before the public that the site is not an official government site.

Notwithstanding these policy considerations, I firmly believe that registration of government names in domains other than .gov should be strongly considered. In addition to the cyber squatting concern, doing so increases the ability of users to find the site. Indeed, if our example Web site located at [WidgetsAmerica.gov](http://WidgetsAmerica.gov) were to also have registered that name in all gTLDs, they could all "resolve" or point to the .gov site and it would not need to be a .com site at all. In other words, if the user typed in [WidgetsAmerica.com](http://WidgetsAmerica.com) or .net, the user could be redirected to the .gov site, the official site, without the user even noticing, a seamless transition. This is what we've done with NOAA's official Web site, located at [www.noaa.gov](http://www.noaa.gov). If a user points his/her Web browser to [www.noaa.com](http://www.noaa.com), [www.noaa.net](http://www.noaa.net), or [www.noaa.org](http://www.noaa.org), they will be redirected to [www.noaa.gov](http://www.noaa.gov). Thus, we've quadrupled the number of NOAA's "windows on the Web."

As I noted, however, your agency's CIO might have a policy against non-.gov domain name registrations. As such, I strongly recommend that you coordinate your efforts with your CIO and request a waiver of that policy in situations that merit a waiver. As with trademarks, I recommend that non-.gov domain names be registered when the underlying government name is "visible and/or vulnerable." In other words, if the Government has made a significant investment in the mark and values its visibility and if the agency believes that the mark is vulnerable to cyber squatters, then I strongly recommend the preventive registration of the mark in all available non-.gov Top-Level domains, as well as the .us domain.

As for the www.noaa.com domain, it was originally registered by an unauthorized third party, using it in a way that we believed to be confusing and playing off of NOAA's trademark rights in the acronym. However, we were able to have the domain name transferred to the Department of Commerce by filing a domain name dispute. Similarly, we have prevailed in domain name disputes against FedWorld.com, Stat-USA.com, StatUSA.com, InterNIC.com, and several other domains, all of which are based on the Department of Commerce trademarks. Preventive registration of these and other domains before they fell into the hands of unauthorized third parties would have made the expensive (\$1,500 or more each) and time consuming filing of domain name disputes unnecessary. I will address the subject of domain name disputes in more detail, below.

**D. The Application, Generally**

A Federal trademark application consists of:

1. Name and address of the applicant;
2. Name and address for correspondence;
3. The drawing (what the mark looks like, be it a logo or simple words);
4. Description/Identification of goods/services (how mark is used, such as "the mark is used in International Class 16 on print media information products concerning international trade," or "the mark is used in Class 35 in association with the provision of information and consulting services in the area of fisheries management, including the provision of such services on a global computer network." Note, this is how the USPTO refers to the Internet);
5. Basis for filing, statement that mark has been used in interstate commerce as of a certain date, or that the applicant has a bona fide intent-to-use the mark in interstate commerce in the near future;

6. Specimen, i.e., an example of how the mark is used (a copy of a publication, a CD-ROM, etc.);

7. A "Declaration" by the signer that all the information is true and correct based on the signer's information and belief, that the mark does not infringe any other mark, and other statements; and

8. Signature of person authorized to sign the application, such as the owner of the mark, or an officer or director in the corporation, or the attorney for the applicant.

**E. Drafting and Filing the Application - General Tips**

In addition to familiarizing myself with all of the resources located at the USPTO.GOV Web site, such as *Basic Facts About Trademarks* and the online version of the *Trademark Manual of Examining Procedure (TMEP)*, I would offer the following tips to anyone drafting a trademark application:

1. File a separate application for each class of goods and services and do not file multiple-class applications. Why? In my opinion, it is easier to keep track of separate files for separate classes, especially in terms of maintenance of the mark (explained below). But the main reason is this, when you have multiple classes in an application, there is a higher likelihood of having defects in the application, and this can slow down the registration process for one of the classes that might not have any defects at all. In other words, say you have an application covering Classes 9, 16, 35, and 42. Suppose everything has been done perfectly with respect to the above requirements in Classes 9 and 16, however, in Class 35 there is a problem with the specimens and in Class 42 the examiner has asserted that the mark is confusingly similar to another mark in that Class. As a result, the Class 9 and 16 portions of the application have to wait until the defects are overcome in Classes 35 and 42. If filed separately, they would be speeding toward registration, but not if they were filed as part of a multiple class application.

2. Keep the description of goods/identification of services as broad but also as simple as possible. The broader it is written, the more coverage the registration will have. If I give a description that says "software that pertains to assessing the health and population of farm-raised, saltwater redfish stocks in the Gulf of Mexico," I will have less coverage than one that is simply

written, "software for use in fisheries management." Less is more in a description, the more words you throw in there, the more likely the Examiner will find things over which to quibble.

3. If you are not filing electronically, mail the application by certified mail, return receipt requested, in order to prove your mailing date in the event the application gets lost after it is received by the PTO Mail Room.

4. If filing an application on a stylized name, i.e., in fancy lettering or built within a logo (such as the Coca-Cola script or the rendering of McDonald's with the "M" as arches), file separate applications for the plain text name and for the stylized name. Why? Because, as I mentioned above, the client can be fickle and change the "look" of the mark. If all of your registration rights are riding in a stylized rendering of a mark and the client abandons that version, you no longer have enforceable trademark registration. Always have the plain text version of a name as your foundation. Logos and "looks" change often, names less so.

5. Resist the temptation to sign the application yourself as attorney for the applicant or to have a lower level agency official sign it. Instead, have the highest ranking person at the agency sign it. Why? Two reasons, one, examiners have been known to reject signatories as not being qualified to sign (such as an Assistant Secretary on one occasion). Two, probably more important, it is smart to have higher-ups in the client agency know that the application is being filed. For one, they might not want the name to be registered (I have had that happen, when an Assistant Secretary or even Under Secretary shot down an application because he plainly hated the name). Also, it helps your own prestige, exposure, and reputation in the department if the top brass knows who you are and the fine work you are doing. There is nothing wrong with getting a little positive exposure for your office.

Of course, the paragraph above presupposes that you are filing a print and not an electronic application. If you do file electronically, draft a paper application anyway and send it to the signatory, get it signed, keep that copy in the file, and file the application electronically with yourself as "signatory." Again, this merely serves to inform the agency higher-ups of your actions.

6. Make sure the specimen matches the drawing page! I have said it before and I will say it again, the client can be fickle and can change the look of a mark. If the

drawing looks different than the specimen, even if by a hair, it will be rejected and could pose a fatal flaw to the application.

7. Verify that the date of first use provided by client is accurate. Often, clients will mistakenly provide a date of a use of the mark that does not qualify as a "use in commerce." For example, if the name was merely coined or announced within internal staff meetings or the logo designed in March of 2000, this is irrelevant. You must provide the actual date that the mark was first used in commerce. Do your homework.

8. Consider Requesting a Fee Waiver! Section 31(b) of the Trademark Act (15 U.S.C. § 1113(b)) states that "(T)he Commissioner may waive the payment of any fee for any service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof." As I said above, I limit my fee waiver requests to one or two per agency per year and always recite the language in my cover letter. Further, as a backup in case the Petition for Fee Waiver is denied, I give the number of our PTO Deposit Account and request that the filing fees be charged to that account. Also, indicate that it has been X months since your last fee waiver request, so as to improve your odds of receiving the waiver.

As an aside, PTO Deposit Accounts are invaluable in managing the payment of fees. We use a system whereby the client can contact the PTO's Deposit Accounts Division directly (telephone: 703-308-4636, fax: 703-308-6778) and request that the filing fees be charged to their office credit card and transferred to the account for a soon-to-be-filed application or maintenance/renewal filing.

#### **F. The Examination Process**

Much has been written about the application and examination process and I will only endeavor to provide a few pointers on the process. I have registered over 200 marks and have found that applications can take anywhere from eleven months to two years, or longer, to attain registration.

In a nutshell, the process is as follows:

1. The application is filed, either in paper form or electronically. Electronic applications are filed using the USPTO's eTEAs electronic filing service, found at <http://www.uspto.gov/teas/index.html>.

2. PTO receives the application, assigns a serial number, and sends a filing receipt. Using an electronic

application, this is all done electronically and is faster.

3. Within a few months, the examiner to whom the application has been assigned assesses the application and does a trademark search. If the application has no flaws (description/identification is acceptably written, if specimens match, if there is no confusion issue, and if mark is not generic or descriptive), the examiner sends the mark to be "published for opposition" in the *Official Gazette* (OG). The OG comes out every Tuesday, and serves to put the world on notice that the PTO will grant these marks a registration unless it hears an objection from an interested party within 30 days. If no objection (or request for more time to file one) is received, the mark will be registered within twelve weeks of the publication date.

Of course, if there are defects in the application, and this is common, the examiner issues an Office Action, giving the applicant six months to cure the defects. Once the defects have been cured, the application is moved to the Publication stage, described above.

Intent-to-Use (ITU) applications follow a similar course, until the point they are published for opposition. If no opposition or extension is filed, then the PTO will issue Notice of Allowance, giving the applicant six months to show use. This six month period can be extended in some circumstances up to thirty-six months. Once use is finally made, the registration is issued.

#### **G. Typical Bases for Refusal to Register Raised by Examiners, and Typical Responses**

In my experience, trademark applications are usually (at least preliminarily) refused by a Trademark Examiner for one of two reasons: (1) the mark is confusingly similar to a previously registered or pending mark, or (2) the mark is merely descriptive. There are other reasons, however these seem to be the most common. Generally, Section 2 of the Trademark Act recites the grounds on which PTO may refuse to register a trademark.<sup>6</sup> They are often referred to as "2(d)" or "2(e)" refusals. When, say, a trademark application's defect is identified as a "(2)(d) refusal," this means that it is being refused on the basis of 15 U.S.C. § 1052(d), since Section 1052 is Section 2 of the Trademark Act. What follows is more detail on the two more common grounds for refusal.

Section (2)(d): Confusingly similar. The applied for mark "(c)onsists of or comprises a mark which so resembles

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<sup>6</sup> 15 U.S.C. § 1052 (2000).

a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."

This can be a major problem (infringement, failure on part of trademark search) or it can be merely a minor obstacle. What to do? Simply argue that sufficient differences exist between the marks and/or between the respective goods and services. As a last resort, contact the owner of the other mark and negotiate a "Consent to Register and Use Agreement." Of course, if there are indeed problems and a bona fide confusion issue, you might have to abandon the application as well as the mark, itself.

Section 2(e)(1): Descriptiveness. The applied for mark "(c)onsists of a mark which when used on or in connection with the goods of the applicant is merely descriptive . . . of them." What this means is that the Examiner believes the mark to be one step away from being generic, that the mark requires no imagination to tell the user what the goods or services are.

What to do? Argue that the mark has the required distinctiveness and offer proof that the using public has come to recognize the mark and identify it with the source of the goods. If the mark has been used more than five years, you can make a prima facie case for acquired distinctiveness. If distinctiveness cannot be proved since it is too new a mark (less than a year or two), argue that it does require some degree of imagination in order to ascertain the nature of the goods or services. Dream up some other goods or services that might be offered under that name using different definitions of the names within the mark, or different contexts.

If you cannot persuade the examiner that the mark is not descriptive, you should be able to fall back on the Supplemental Register, get your registration on this second-tier (far better than nothing) register, and re-file on the Principal Register after a few years have passed and a better argument for distinctiveness can be made.

If, while drafting the application, you suspect that it might be refused for descriptiveness and you either have the five years of use for a prima facie case for distinctiveness or otherwise believe you can show distinctiveness, then go ahead within the application and make your case for distinctiveness. This is known as a

Section 2(f) application,<sup>7</sup> where the mark's distinctiveness can serve to trump the inherent descriptiveness. It saves a great deal of time to raise the mark's distinctiveness in the application, rather than in an Office Action response, which could add months to the process.

**H. Keep the Client Informed as to Application's Status**

Make your best efforts to keep tabs on the status of the mark . The TARR (Trademark Applications and Registrations Retrieval) database on the PTO Web site is great for this, located at <http://tarr.uspto.gov/>, as is the Trademark Status Line (703-305-8747). Notify the client when the mark has received a publication date, when it has been published for opposition, when the registration has been issued (often, the official certificate takes several weeks to arrive), and explain the meaning of each step in the registration process.

**I. Advising the Client as to Registration of Mark, Maintenance, and Proper Use**

As I noted above, it is important to notify the client as to the registration of the mark and to provide counsel as to the care and maintenance of trademarks. When a new registration has been received, I send the head of the agency (or appropriate official) a memo notifying the new registration, identifying the name of the employee(s) and division(s) with which I worked, and how the mark is/will be used. A copy is sent to the primary "client," i.e., the staff level contact person . I also include a master list of all the agency's active registrations, in order to keep all interested persons apprised of all the marks registered to that agency. Again, it helps in terms of letting the client's top brass know the sort of work you are doing for the agency.

This memo also gives advice on the correct use of the ® symbol, that its use is recommended but not necessary, and used with discretion. I also point out that the registration is valid for ten years, renewable indefinitely as long as the mark is used continuously in interstate commerce. As a final point, as I mentioned above, I stress that material modifications cannot be made to the mark unless the agency intends to file new applications to register the new version.

With respect to all trademarks in an agency's "portfolio," it is recommended that some sort of system(s)

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<sup>7</sup> 15 U.S.C. § 1052(f) (2000).

be created to manage the various maintenance requirements, due dates for filing Statements of Use under Affidavits 8 & 15,<sup>8</sup> for example, or renewal of the registration at the ten year mark.<sup>9</sup> There are proprietary software products available for this task or a home made system can be established.

#### **VI. MONITORING MARKS AGAINST INFRINGEMENT**

It is important that both the attorney and the client share the responsibility of monitoring the mark against infringement and/or unauthorized use. Encourage the client to report all instances of unauthorized third-party use to you and to also encourage vendors and others in the private sector to do so. Similar to the way a piece of real property can fall prey to "squatters" in adverse possession, trademarks can be lost if the owner acquiesces to such use.

I recommend the following methods of monitoring against unauthorized use and infringement:

##### **A. The Official Gazette**

As was stated above, the PTO publishes the *Official Gazette* each Tuesday, to notify the public as to the marks it is on the verge of registering. Our office has a subscription to the OG and we try to peruse it on a regular basis to ensure that no Department of Commerce marks are compromised by a pending registration. The OG is available online, at <http://www.uspto.gov/web/trademarks/tmog/>.

We have filed for an Extension of Time to Show Use on several occasions to investigate whether or not an opposition is mandated. In some cases, the pending mark appears to pose a problem at first blush, but upon further review it is allowed to proceed toward registration. On at least two occasions, when it was believed that a pending mark infringed a Department of Commerce mark or at least would create problems for registered or pending Department of Commerce marks, we have filed oppositions and have successfully blocked the registration of the mark, or at least used the opposition as a means of forcing negotiations on points that would settle any possible disputes down the road.

For example, suppose the Government has a common law trademark on a given name. Suppose further that a pending trademark was published for opposition that was identical

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<sup>8</sup> Required by 15 U.S.C. §§ 1058 and 1065 (2000).

<sup>9</sup> Required by 15 U.S.C. § 1059 (2000).

or very similar to the government mark and on somewhat similar goods or services. If it is possible to have peaceful coexistence between the two marks, say, the government mark will pertain to this type of goods and the pending mark will cover other types of goods, then perhaps a Consent to Register and Use Agreement is a good solution. The opposition period can be used to get and hold the attention of the pending mark's owner while a Consent Agreement is hammered out (including appropriate amendments to the identification/description of the pending application). While you need not "threaten" an opposition, you can make it clear that you will agree not to oppose the pending mark if they agree on a compromise with you as to a peaceful coexistence between the two marks.

In fact, we have found another vehicle to be extremely useful in voicing our concerns over a pending application prior to the time that it gets to the publication for opposition phase of the examination. PTO will accept something known as a Letter of Protest with respect to a pending trademark that might pose trademark or other concerns to a third party (including a government agency). The Letter of Protest need not be formal, it is merely a means by which a party may notify the Assistant Commissioner for Trademarks that there may exist grounds for refusing the pending mark's registration. If the Assistant Commissioner believes that the Protest Letter raises legitimate issues, he will ask the Examining Attorney to pay heed to them.

The beauty of the Letter of Protest is that it is free. The filing fee for a Notice of Opposition is \$300. Further, it allows you more than one bite at the apple. You can always file full-blown opposition if satisfactory results are not obtained from the Protest Letter. Additionally, it allows the matter to be addressed between the PTO and the applicant and not between the applicant and the party complaining about the pending mark. In this manner, it defers and in many cases obviates the need for confrontation between these two parties.

**B. Internet Search Engines Seeking General (Mis)Use**

Similar to the way I use the Internet in doing a trademark search, it is invaluable in terms of monitoring our marks, seeing how other are using them. For example, if I go to [www.google.com](http://www.google.com) and type in the name of the mark, I should expect to see not only the agency's use of the mark, but also any unauthorized use. Granted, there is a considerable amount of fair use in the area of trademarks, on the Internet and off, which I will address below, but you have to first find the unauthorized uses of your marks before you can assess whether or not it is infringement, fair use, or something in between. When perusing a Web site where your clients marks are being used, take a look at the metatags (see discussion below).

**C. Internet Search Engines Seeking Domain Name (Mis)Use**

Web sites such as [DomainSurfer.com](http://DomainSurfer.com), [NetNames.com](http://NetNames.com), and the WHOIS services of domain name registrars serve as tremendous resources in monitoring third party use and in determining the identity of the user. I can go to [DomainSurfer.com](http://DomainSurfer.com) and type in an agency name, acronym, or other mark and within seconds learn of all domain names registered in the gTLD's .com, .net, and .org that include that mark. For example, if I am concerned that third parties might be registering and using domain names that relate to my client NIST (National Institute for Standards and Technology), I can simply type in the letters "NIST" and hit enter. Unfortunately, this search strategy yields over 30,000 domains, many of them completely irrelevant, since domains that include the word "administration" and "Afghanistan" would be caught in the dragnet. To avoid this, I can limit the search, using the ^ symbol, to limit the front end ("prepend") of the search, to only glean those results that begin with the letters "NIST." Similarly, [NetNames.com](http://NetNames.com) serves to provide information on domain names registered in global TLDs or other country codes. This is important in monitoring marks with worldwide significance.

**D. Professional Monitoring Services.**

Such companies exist, however we do not avail ourselves of their services for budgetary and other reasons.

**VII. ENFORCEMENT**

**A. Generally**

There are different ways in which government marks can be used by unauthorized third parties and not all of them are infringement or otherwise problematic. Often, when a third-party use is discovered the knee-jerk reaction is to object, a position often agreed on by attorney and client, alike. It is important to assess the third-party use carefully in order to determine whether or not it is infringement or otherwise objectionable and to what extent you might take action. Acquiescence can ultimately render a trademark unenforceable, so it is important to be vigilant in protecting them against unauthorized use.

In my mind there is a spectrum of third-party uses, from 1) good faith fair use, to 2) good faith use that exceeds fair use and causes confusion/appearance of endorsement problems (sort of a "Road to Hell Paved by Good Intentions" scenario), to 3) marginal/questionable bad faith use that definitely causes problems, to 4) out and out bad faith infringement.

The first category, good faith fair use, occurs when a third party refers to the mark in a nominative way, as a means of describing his own goods or services. For example, the manufacturer of camera lenses might indicate on the packaging that the lens was for use on a Nikon® camera, notwithstanding that the lens was made by, say, Vivitar®. Similarly, a generic product such as ibuprophen might claim that it compares to Advil®.

In the government arena, examples abound. Let's say an agency distributes a popular information product or data set on CD-ROM and a vendor takes that (non-copyrighted) information and adds value to it or even reproduces it intact, an identical copy of the government product. As long as the private sector product is not using the proprietary government trademark as the name of the product or otherwise using the agency logo on the packaging in a way that creates the impression that the product is the official United States Government (USG) product, this sort of use should be acceptable. Ideally, the vendor will give the product a new name and simply refer to it as being based on, of, and for use with the government product, giving its name.

The second and third categories occurs when a private sector entity, perhaps with good intentions, establishes a business that is based on or complements the government product or service, however, there is such a reliance on the government trademarks that the consumer might be confused as to the source of the goods or services and may mistakenly believe that they are the official USG goods or services. Although the intentions of the party may have

been good, there is an appearance of endorsement or affiliation problem that must be addressed. Ideally, you convince the party that a proprietary name be adopted and the government marks may only be used in a nominative or reference context. Kid gloves must be used in these situations, since what you often have are vendors who think they are doing Uncle Sam a great service, making the good USG product even better or cheaper. It is fine, provided the customer understands what it is (a private sector product) and what it is not (a USG product).

**B. Trademark(s) Can Offer Degree of Control Over Non-Copyrightable Work**

It is important to note the extent to which a government trademark can serve to offer a means of protecting something that previously could not be unprotected. As is noted below, most government publications and information products are in the public domain and cannot be copyrighted pursuant to 17 U.S.C. § 105. As a result, a private sector entity can make wholesale copies of a government publication without permission and disseminate it as he/she sees fit. In some cases, this does not pose any problem at all, in instances where the agency want to get as much circulation as possible. But what if the reproduction is a poor one? Or what if the agency relies on sales revenues to fund updates of the publication? Indeed, there are occasions where an agency might want to get some sort of copy protection over an unprotectable work and that is where a trademark can play a role.

Since the Government can register trademarks, if a non-copyrighted work bears the agency's trademark(s), then the wholesale reproduction and redistribution of the work is likely a trademark infringement. Having control of the trademark accordingly gives the agency some degree of control over the work itself, control which did not exist without the trademark.

**C. Bad Faith, Infringement, and Deceptiveness**

The fourth category concerns bad faith, deceptiveness, and infringement where the party is consciously trying to create the appearance that its goods or services are in some way connected with the USG or that it has some sort of USG approval. This is common in the Internet domain name area, wherein a cyber squatter will register a government-sounding domain name, for example, to bring customers to its site.

In closing, I simply want to stress that it is important to carefully review the situation with the client, thoroughly review the third party's use of the agency's mark(s), and try to glean from that use the intentions or good or bad faith of that party.

Once you have decided to take action, it is important that you preserve as much proof as you can. Obtain copies of advertising which shows how the marks are misused, collect statements from persons who have been deceived and print screen shots from the offending Web site. In the Internet arena, there are software applications, such as Camtasia or SnagIt, which will record the sequence of events as proof. For example, suppose that "AgencyName.com" has been registered by a cyber squatter who is using it as a pornography site. Certainly, you could merely print screenshots of their home page, which might show the offending domain name. Then again, this could be fabricated on your part. As such, better proof would be in the form of a recording, using Camtasia, SnagIt, or some other software. The recording would show you typing in the letters AgencyName.com into your browser and would then show the offending Web site opening up.

Above all, make sure your client, at the highest levels, are comfortable with your course of action and any and all possible ramifications.

#### **D. The Cease and Desist Letter**

Once it has been determined that an unauthorized third party use is objectionable, you should consider sending a cease and desist letter or, in cases where circumstances merit, something less formal, such as a phone call or quick e-mail. Indeed, there are times when a matter will have a better chance for an amicable outcome if it is handled on an informal basis. Often, an "angry" cease and desist letter simply gets things off on the wrong foot, placing the matter immediately into an adversarial context. Give this first step considerable thought.

If you have decided to send a cease and desist letter, however firm, thought should also be given as to who should send the letter. Often, in cases where the objectionable use is being made by a vendor with whom the agency has dealings, it might be better if the client contact the vendor. The letter can be (co)-written by counsel, of course, but there are certainly times when a letter from a program person in the agency will be better and more constructively received than from a lawyer. After all, as noted above, a letter from a government lawyer might start things off on an adversarial note, complicating the chances

of an amicable resolution.

The typical cease and desist (C&D) letter will begin by telling the recipient who you are and that you are trademark counsel for such and such agency. It has come to your attention that the recipient is engaging in use of the agency's trademark(s) that is objectionable and you are requesting that they immediately cease and desist. Ideally, the agency has specific authority prohibiting unauthorized use of its name, acronym, and logos. Nevertheless, other authorities may be relied on, as follows:

1. False Advertising or Misuse of Names to Indicate Federal Agency, 18 U.S.C. § 709.

This is a frustrating however ultimately useful authority. It is frustrating because when you initially see the name of the section, "False advertising or misuse of names to indicate [f]ederal agency," you think, "Great, this is what I need." Unfortunately, upon reading it you end up giving with the initial impression that it is merely a list of specific agencies with protected names and offering no assistance to general instances of a party passing itself off as a USG agency if you are not one of those chosen "protected" agencies. However, if you carefully read and distill this section, you can in fact extract language for use in general situations. Indeed, 18 U.S.C. § 709 prohibits the intentional use of:

[A]ny device or symbol or other means, reasonably calculated to convey the false impression that such name or business has some connection with, or authorization from . . . the Government of the United States, or any agency thereof, which does not in fact exist, or falsely advertises or otherwise represents by any device whatsoever that his or its business, product, or service has been in any way endorsed, authorized, or approved by the . . . Government of the United States, or any agency thereof . . . .

2. Section 32 of the Lanham Act (codified at 15 U.S.C. § 1114).

This is the bread and butter, general authority on trademark infringement. Section 32 reads in pertinent part as follows:

§ 1114 - Remedies; Infringement; Innocent Infringers

(1) Any person who shall, without the consent of the registrant -

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

3. Section 43 of the Lanham Act (codified at 15 U.S.C. § 1125), including the Federal Trademark Dilution Act (codified at 15 U.S.C. § 1125(c)).

This latter section should only be used in instances where the government mark that is being infringed can be claimed to be a "famous" mark. This section reads in pertinent part as follows:

§ 1125 - False Designation of Origin,  
False Descriptions, and Dilution  
Forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false

or misleading description of fact, or false or misleading representation of fact, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(c) Remedies for dilution of famous marks

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection.

4. Anti-cyber squatting Consumer Protection Act (ACPA), codified at (15 U.S.C. § 1125)(d)(1)(A)).

Enacted in 1999, this authority pertains to instances wherein you are objecting to a registered Internet domain name. This authority reads as follows:

Cyberpiracy Prevention.

(d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is

protected as a mark under this section, if, without regard to the goods or services of the parties, that person--

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that--

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36, United States Code.

5. Unfair Method of Competition, Unfair Trade Practice, Section 5 of Federal Trade Commission Act (15 U.S.C. § 45). This act simply states that "[u]nfair methods of competition in or affecting commerce, and unfair or deceptive acts or practices in or affecting commerce, are hereby declared unlawful." In such circumstances, your letter might warn that you would consider reporting the matter to Federal Trade Commission (FTC). Of course, you are advised to discuss the matter with the FTC beforehand.

6. In the case of Internet domain names, you should also warn that failure to cease and desist might result in your filing a domain name dispute, which is explained in more detail, below.

**E. In the Event Cease and Desist Request Is Ignored**

In a perfect world, the unauthorized user of your mark would immediately cease and desist its offending use in accordance with your wishes. Of course, this does not always happen. What to do next? Of course, much depends on the context. If it is a domain name that is the problem, then the next step might be to file a domain name dispute (see below). If it is a pending trademark application that is causing concern, your next step might be to file a "Letter of Protest," at any point during the examination process, as well as a "Trademark Opposition," after the mark has been published for opposition. In other situations, the only remaining recourse is to consider litigation.

It is my understanding that cases of trademark infringement litigation brought by federal agencies are handled by the Civil Division of the U.S. Department of Justice. Additional relief or assistance may also be provided by the U.S. Attorney's Office, as well as the Federal Trade Commission. Of course, I recommend that you confer with all three entities in the event of persistent trademark infringement.

#### **F. Domain Name Disputes**

The 1990s, of course, witnessed an explosion in the growth and popularity of the Internet and many trademark owners awakened to the fact that their trademarks were being used by others on the Internet in a variety of ways. One particularly offensive use of government names comes in the form of what has come to be known as "cyber squatting," i.e., the bad faith registration Internet domain names identical to or incorporating proprietary trademarks.

The term "cyber squatter" presupposes bad faith. Not all domain name registrations on or incorporating another person's trademark are rightfully considered infringement or instances of cyber squatting. In addition to fair use, which we will explore below, there is also concurrent or coincidental use. Indeed, the world of trademark law, with its system of classification, contemplates "peaceful coexistence" among trademark owners sharing identical names, acronyms, and designs. For example, Delta, in addition to being a letter in the Greek alphabet, is a proprietary mark used by an airline, a faucet company, and other entities. It is also a generic term describing a topological feature, i.e., where a river meets the sea, as well as a particular region of the United States (the Mississippi Delta), and a style of blues music, among other things. "Life" is a well-known trademark shared by many,

including "Life Magazine/Time-Life Books," "Life Cereal," and the board game "Life." "Outback" is a steak house as well as an automobile and like "Delta," is also the name of a geographical region.

With respect to good faith, it can be presumed that owners of marks such as "Delta," "Life," "Outback," and other shared marks adopted and used such marks in good faith and not with a prior mark in mind. In other words, we presume that the owner of the "Outback Steakhouse" brand did not choose that name in bad faith, with the idea of riding the coattails of Subaru's "Outback" (the prior mark) in mind, hopeful of deceiving customers into thinking that the two brands were affiliated. Because the mark is common or "weak" enough, it is capable of being shared by others so long as no confusion results. As we turn to the Internet and specifically to generic Top-Level domain names, we have seen that the notion of peaceful coexistence is not always as easily accomplished (after all, there could not be more than one Delta.com or Outback.com) and bad faith was often alleged or implied. The world seemed to settle on .com as the premier gTLD and correspondingly, battles over domain space on that turf have been common.

What can an agency do if AgencyName.com or AgencyAcronym.com is registered as an Internet domain name? First of all, an assessment must be made as to whether or not it is indeed a conscious infringement or if it is coincidental. For example, NOAA.COM was originally registered to a private sector party. If the domain name was the legitimate address for the Web site of the New Orleans Athletic Association and there was no intention on the part of the registrant to "ride the coattails" of the National Oceanic and Atmospheric Administration, then perhaps you do nothing. At most, perhaps you ask the owner of the site to have a link on their home page that says something like, "If you are looking for the National Oceanic and Atmospheric Administration, located at NOAA.GOV, click here."

Similarly, the name could be one of those names that can be shared among multiple owners, just as "Delta" or "Outback" are shared. "TIGER" is a well-known trademark of the U.S. Bureau of the Census, however, many other entities have rights in that name, including a professional golfer who might be even more well known. Another example, the National Institute of Standards and Technology, a Department of Commerce agency, is known by the acronym NIST, a registered trademark. However, NIST is also a surname, and NIST.NET is a Web site of a fellow named Chuck Nist, of Jacksonville, Florida.. He has photos of his

family and vacations. Without any encouragement, he also placed a notice and link to the NIST.GOV site. Of course, the only thing that might be of concern with respect to this sort of arrangement is the possibility that an appearance of endorsement or affiliation might result, so take care.

However, if it is clear that the domain name was registered in bad faith, then you must object. If no relief is gained from the initial contact, such as a C&D letter, addressed above, you should consider filing a domain name dispute using the Uniform Domain Name Dispute Resolution Policy ("UDRP"), which was implemented in late 1999 by the Internet Corporation for Assigned Names and Numbers (ICANN). The UDRP, which can be found at <http://www.icann.org/udrp>, is a dispute process for contested generic Top-Level domain names (.com, .net, .org, .info, and .biz), allowing a successful complainant to bring about the transfer, cancellation, or alteration of a contested domain name.

One important aspect should be noted with respect to the ICANN UDRP. There is no need for the complainant to own a registered trademark, although it helps its case if one is indeed owned.

Section 4 contains the meat of the UDRP, setting forth the three-prong test that must be alleged in a UDRP complaint (Section 4(a)), outlining how one of the prongs can be proven (Section 4(b)), and how one of the prongs can be challenged (Section 4(c)). To satisfy the three-prong test of Section 4, a trademark owner (called a "complainant") must show that:

1. The offending domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. The domain name registrant has no rights or legitimate interests in respect of the offending domain name; and
3. The offending domain name has been registered and is being used in bad faith.

I have successfully filed a number of domain name disputes to have domain names transferred to the Department of Commerce, including StatUSA.com, Stat-USA.com, InterNIC.com, InternicRegistrations.com, .net and .org, InternicRegistration.com, .net and .org, NOAA.com, FedWorld.com, and others. In all these cases, the Department of Commerce owned a registered trademark that had been incorporated into a domain name registered by a private sector company.

**G. Other Internet Hijinks: Framing, Metatags, Protest Sites, Typosquatting, and Mousetrapping**

In addition to the registration of offending domain names based on or incorporating government trademarks and the general unauthorized use of government marks on the Web sites of others, there are yet other improper uses lurking on the Web. For example, in order to be recognized by search engines, many Web sites use what are known as "metatags." Metatags are hidden codes identified by some search engines to determine the content of websites in order to direct searchers to relevant sites. For example, if the name "NOAA" were to be imbedded in the metatags of a particular site, not apparent to the eye but discernable by search engines, the search engines would detect the metatag and list the site as a "hit" when someone was using the engine to search for the term "NOAA." How can you determine if your agency's marks are included in a Web site's metatags? When on the Web site and using the Explorer Web browser, click on "View" and then on "Source," and you will see the behind-the-scenes aspects of the Web site.

There have been a number of notable cases on the subject of metatags<sup>10</sup> and to a large degree they have become a thing of the past, as Internet search engines have become more sophisticated. Nevertheless, they are worth investigating as they are valuable in terms of determining whether or not the Web site owner is acting in good faith.

Framing is another Internet practice that can infringe a trademark or copyright. Framing occurs when the Web content of one person is "framed" by content of the framer, so that it might appear that the content belongs to or originates from the framer. This could happen with government content and is problematic to the extent to which government trademarks are misused or otherwise the appearance is created that there is some connection, endorsement, or affiliation existing between the owner of the Web site and the owner of the framed content/trademark.

Typo squatting occurs when a cyber squatter registers a domain name that is an intentional misspelling of the trademark. For example, a typo squatter might intentionally register a domain name using the misspelled "Volkswagon," when the correct spelling is "Volkswagen," in hopes that accidental traffic will come to its site. Similarly, typo squatters have been known to register

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<sup>10</sup> See *Playboy Enter. Inc. v. Calvin Designer Label*, 985 F. Supp 1220 (N.D. Cal. 1997); *Brookfield Communications Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999).

domain names that conveniently "forget" to include the "dot" after the "www." One notable case concerned the investment firm Paine Webber, whose Web site is located at [www.painewebber.com](http://www.painewebber.com). Of course, the typo squatter could simply have registered the name with only one "b" in "Webber," however, this one had a different twist. In this case, the typo squatter relied on the user hurriedly typing in [www.painewebber.com](http://www.painewebber.com), forgetting the "dot" after the "www," and was taken to a site offering pornography.<sup>11</sup>

Cases such as these have prompted some vigilant companies to preemptively register misspellings, as well as domain that might be used by angry customers as a protest site. For example, when Bell Atlantic became Verizon, Verizon was very careful to register [VerizonSucks.com](http://VerizonSucks.com), among other variations on that theme. Unfortunately, they did not think to register [VerizonTotallySucks.com](http://VerizonTotallySucks.com) and that domain is now the address of a protest site.

If a government name becomes the subject of a protest site, take heed that some such sites and domain names have prevailed under First Amendment freedom of speech theories when challenged under the UDRP. For example, a disgruntled former employee of tire maker Firestone prevailed in a domain name dispute for the name [Bridgestone-Firestone.net](http://Bridgestone-Firestone.net).<sup>12</sup>

Often, a typo squatter or other Web miscreant will use another ploy known as "mousetrapping." This is a practice that disables the user's ability to leave the site. For example, it will deactivate the browser's "back" and "close" buttons, thus preventing the user from exiting the offending site and instead being sent to additional sites in an unavoidable, seemingly endless loop. The Federal Trade Commission has taken a strong stand against this practice and I recommend that you consult with that agency in the event it takes place with a government mark.

The Federal Trade Commission's Web site, located at [www.ftc.gov](http://www.ftc.gov), contains a wealth on information on mousetrapping and is illustrative of their commitment to prosecuting offenders. See, in particular, press releases

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<sup>11</sup> See *PaineWebber, Inc. v. WWWPAINEWEBBER.COM*, No. 99-0456-A, 1999 U.S. Dist. LEXIS 6552, at \*1 (E.D. Va. Apr. 19, 1999).

<sup>12</sup> *Bridgestone Firestone, Inc., et al. v. Myers*, WIPO Dispute No. D2000-0190 (2000), at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0190.html>.

at the following addresses:

<http://www.ftc.gov/opa/2001/10/cupcake.htm>

<http://www.ftc.gov/opa/2002/05/cupcake.htm>

#### **H. Closing Comments on Enforcement**

As I intimated above, one must be careful when enforcing government trademarks. You do not want the agency to appear as a bully and end up with a black eye. Consider the intentions of the unauthorized user, whether or not it is acting in good or bad faith, with good intentions gone awry, and acknowledge that in some cases the private sector entity might be furthering the agency's mission, albeit in a manner that makes the agency uncomfortable. With this in mind, perhaps a licensing scheme might be employed or some other creative method of resolving the dispute. Additionally, sending the cease and desist letter and getting a promise of compliance is not the end of the saga. Be sure to follow up with the party, monitor their activities from time to time, and ask that the client do the same.

#### **I. Claim of Infringement Levied Against Agency**

Until recently, the Federal Government was shielded against liability for trademark infringement and the reasoning for this immunity was expressed in the lawsuit *Preferred Risk Mutual Insurance Co. v. United States*.<sup>13</sup> The holding clearly proclaimed that "the Lanham Act does not apply to the [F]ederal [G]overnment."<sup>14</sup> In this case, the Federal Emergency Management Agency (FEMA) used the term "preferred risk" on forms related to reduced-risk, low premium flood insurance. Preferred Risk® was a registered trademark of Preferred Risk Mutual Insurance Company. The company complained to FEMA, which apparently failed to address the company's concerns. The company sued for trademark infringement and the District Court ruled in favor of the company. FEMA appealed and the Eighth Circuit Court of Appeals, on June 13, 1996, reversed the lower court ruling and found in favor of FEMA, holding that the 1992 amendment to the Lanham Act abrogated the waiver of federal sovereign immunity. In other words, the Lanham Act's waiver of sovereign immunity applied only to the States.

*Preferred Risk* was controlling law until the passage of the Trademark Amendments Act of 1999. Section 4 of the Trademark Amendments Act of 1999 expanded the definition of

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<sup>13</sup> 86 F.3d 789 (8th Cir. 1996).

<sup>14</sup> *Id.* at 790.

"any person" who could be held liable for trademark infringement to include government agencies.<sup>15</sup>

Specifically:

As used in this subsection, the term 'any person' also includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

Frankly, prior to the passage of the Trademark Amendments Act of 1999, the Department of Commerce never relied on *Preferred Risk's* immunity. Indeed, perhaps because the Department of Commerce is the federal agency responsible for protecting trademarks, we did not feel comfortable "thumbing our noses at" a party whose trademark we were infringing, hiding behind sovereign immunity. It simply would not look good in the press, at the very least. Of course, it is academic now, as a result of the Trademark Amendments Act of 1999.

#### VIII. LICENSING

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<sup>15</sup> Codified at 15 U.S.C. § 1114(1)(b)(2003).

As I indicated above, the Department of Commerce is very active in the licensing of its trademarks, using both formal and informal arrangements and agreements. While often the subject of debate, it is our view that the Department requires no specific statutory authority to generally engage in the licensing of its marks, as it is among the bundle of rights of accorded to trademark owners. However, specific authority would be required in order to license exclusively or to license in exchange for a royalty payment (I will get to this in more detail, below).

Licensing arrangements run the gamut from the basic to the complex. An example of a basic licensing arrangement would be if an outside organization were to hold a conference, with some sort of involvement on the part of a government agency. As a feather in their cap to show off the legitimacy of their event, they will naturally want to use various "sponsoring organization" logos on their brochure, Web site, and other marketing items. The Department of Commerce happens to have a Department Administrative Order (DAO 201-1) that controls the use of its seals, emblems, logos, and insignia. It also has a clearance process for use by an outside entity, nevertheless, I would recommend a similar process regardless of any requirement. The Department of Commerce clearance process is simple: in order to give permission to an outside organization to use one of our marks, we require the clearance of the head of the agency (or a delegate), as well as two components of the General Counsel's Office. One office (mine) checks on the trademark implications (the use of ® or ™ symbols and the use of ownership notice or disclaimer, as appropriate) and the other office reviews the proposed use with respect to avoidance of appearance of endorsement, affiliation, or authorization.

There typically would not be a license agreement per se for an arrangement such as this, but rather an e-mail or letter providing them with basic guidelines, requesting the use of symbols or notice language.

At this sort of informal level, we recognize that not all outside uses of our marks require any clearance at all, since they might be considered a "fair use" of the mark. For example, if a news agency wanted to do a story about a Department of Commerce agency and wanted to use that agency's logo, we would consider it a fair use and would not require clearance. Similarly, if a publisher were preparing a text book or Web based resource, providing information on government programs, we would also consider it a fair use and not requiring approval.

An example of a licensing relationship requiring a

license would be something of a more lasting nature, such as the following examples.

1. The Technology Administration operates the National Medal of Technology® program, awarded to companies and individuals who have made outstanding contributions to technology of benefit to the United States. When a company, such as 2001 Medal recipient Dow Chemical, wins the Medal, they typically want to brag about it and use a likeness of the Medal in their advertising. Our basic license contains the standard clauses, such as scope and duration, quality control (right to approve proposed uses and inspect ongoing uses), prohibition against assignment or sublicense, and requirements for use of mark (such as use of symbols, disclaimer, or notice).

2. The National Oceanic and Atmospheric Administration does a considerable amount of licensing, primarily of its NOAA® emblem, under license agreements such as the one described above. However, NOAA also is blessed with statutory authority to engage in royalty-generating licensing for its National Marine Sanctuaries Program. Pursuant to its statutory authority, NOAA may collect, retain and use revenues generated through a trademark licensing program. The subject of the license is the distinctive National Marine Sanctuaries "whale's tail" logo, which may be used on "products to promote the national marine sanctuary program . . . ." <sup>16</sup>

3. One of the more creative licensing arrangements we ever had also occurred with NOAA, this time concerning its National Severe Storms Laboratory, which is responsible for NOAA's efforts in tracking and studying tornadoes and other severe weather phenomena, among other things. You might recall that the 1996 blockbuster film "Twister" involved two severe weather researchers, played by Helen Hunt and Bill Paxton. In the film, they were both employees of NOAA's National Severe Storms Laboratory® ("NSSL").

To follow up on the success of the film, Universal Studios built a "Twister" theme park attraction at their Orlando, Florida location. It features a simulated tornado, wherein the visitor to the attraction stands in one spot with the tornado swirling around him. At various points during the "ride," a white "storm chasing" van is shown on video driving past. On the side of that van is the NSSL logo. NOAA licensed the logo to Universal for

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<sup>16</sup> See 16 U.S.C. §§ 1445b(a)(5) & 1445b (2000).

this purpose, and as part of the agreement, Universal was also given permission to use the logo on clothing, coffee mugs, and other merchandise, sold at the theme park's gift shops. In order to avoid the appearance that NOAA was selling its image, Universal agreed to include with all merchandise an "educational element," such as a hang-tag on the garment to give information and tips on severe weather preparedness. As an added bonus to this arrangement, in lieu of a royalty payment to NOAA, which NOAA was not authorized to accept, Universal made two gifts of \$20,000 apiece to the severe weather laboratory of a national university.

One intriguing aspect of this agreement with Universal involves something we ended up not doing, but may do some time in the future. Before it was decided that Universal Studio's "gift" would be made to the university, it was debated whether or not Universal could make a "gift in lieu of a royalty" to the Department. Indeed, the Secretary of Commerce, as is true with many federal agency heads, is "authorized to accept, hold, administer, and utilize gifts and bequests of property, both real and personal, for the purpose of aiding or facilitating the work of the Department of Commerce."<sup>17</sup> As such, it is open to debate as to whether or not a trademark licensing agreement could generate revenues in the form of a "gift in lieu of a royalty." As I advise my counterparts in other agencies, this is a question for the Ethics and General Law divisions of their respective General Counsel's Offices. In these days of budget cuts, it is certainly worth giving some serious thought.

It is important to note that government agencies must be especially careful to avoid the appearance of endorsement, affiliation, and authorization when entering into license agreements with the private sector. Not to cast aspersions, but given the fact that private sector companies are in competition with each other, they're always looking for an edge, including some sort of "seal of approval" or imprimatur from Uncle Sam.

This concern often frustrates agency officials who entertain visions of marketing campaigns such as the successful "Intel Inside®" commercials. In that campaign, commercials for personal computer makers such as Dell® often end with the Intel jingle and the appearance of the popular "Intel Inside" logo, to indicate that Dell is proud to use the Intel Pentium IV processor in their PC's. Agencies sometimes envision similar campaigns, wherein

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<sup>17</sup> See 15 U.S.C. § 1522 (1998).

private sector value added information products or software containing U.S. Government data, charts, or statistics could bear a logo (perhaps a certification mark, to be covered in more detail, below) that proudly proclaims that the product contains the agency's content. While this sounds like a great idea, and it is not to say that it is not workable, it is not without its challenges. In order to implement such a regime, an agency would be advised to draft and publish criteria for authorized users of the government mark, to endeavor to ensure that shoddy products were not out there bearing what could be taken to be a federal seal of approval. Arguably, it might also need to do follow up monitoring of the products, with the same concern in mind. I look at this as an example of creative thinking in government running up against the standard constraints agencies have always faced. Like I said, though, these are not insurmountable challenges.

**A. Consider a Trademark Use Policy**

In the case of an agency with a number of popular marks that are often used by the public, I strongly consider the use of a Trademark Use Policy. Most corporations have them, located on their Web sites. The policies simply give guidance as to the proper/acceptable and improper/unacceptable ways in which the company's marks may be used. At present, we are in the process of clearing a draft policy for one Department of Commerce agency, however, I recommend you look at corporate sites for comparison.

**B. Certification Marks**

Indeed, there exist a number of U.S. Government certification marks, such as the USDA's "Grade A" and "USDA Prime" marks used on beef. Similarly, the Department of Commerce agencies have several certification marks, such as the NVLAP® logo (indicating that a laboratory has received accreditation from NIST's National Voluntary Laboratory Accreditation Program), as well as a suite of marks from NOAA's National Marine Fisheries Service (such as a mark to indicate that a frozen seafood product was "Processed Under Federal Inspection." As was discussed above, the respective agencies have developed criteria and standards with which users of the marks must comply.

**C. IPR Aspects of Ventures with Private Sector**

With the rapid growth of the Internet, our office has been called upon to assist agencies deal with the IPR aspects of Web pages and other public-private ventures in the Internet context. What follows is a checklist of the sorts of issues such an arrangement might raise:

1. What names, logos, and slogans will be used? Who will own trademarks and domain names? Who will do trademark search on marks and domains? Who will register? Will there be a need to cross-license existing proprietary marks, domain names, and to-be-developed marks/names? Because the PTO will accept jointly-owned and jointly-filed applications, would this be a good route? Indeed, if a mark is co-owned, it allows the sort of exclusivity that is not afforded a regular U.S. Government-owned mark, which cannot be licensed exclusively without specific authority.

This first issue has been the cause of a large number of trademark problems for government agencies, wherein a contractor seeks to claim trademark ownership or in some cases registers the name of the resulting product as a U.S. trademark. Since all relationships eventually come to an end, the agency is sometimes surprised to learn that the soon-to-be-replaced contractor owns the name of the product or service notwithstanding the fact that the agency considers it to be a government program with a government name. With this in mind, I strongly recommend that agencies address the ownership issue with specific provisions in the agreement.

2. What happens to marks and domains upon termination?

3. What about copyright? Who designs Web page, rights in look, and feel? If a contractor designs the site, can the contractor assign the copyright to the United States, as is contemplated in 17 U.S.C. § 105? With this in mind, should the Special Works Clause of the Federal Acquisition Regulation be used?<sup>18</sup> To what extent will copyright licenses or releases be required? On termination, can the Government retain a license to use the Web site design?

4. What about copyright and patent rights in any software developed for the site? If the partner uses proprietary or commercial off-the-shelf (COTS) software, the agency might need licenses or a clarification of rights upon termination. What about jointly developed software or business methods that might be protectable under copyright or patent? In case of joint inventions, the U.S. Government can patent inventions of its employees, even if

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<sup>18</sup> FAR 52.227-17.

joint, and federal inventors and agencies entitled to share of royalties. You must make sure that these rights are addressed in the agreement(s).

5. What about rights in any data that are collected, including user data? Specifically, how should you address the Freedom of Information Act (FOIA)? Should the data be not within the control of the agency, so as not to render it subject to FOIA? Similarly, what about privacy? Make sure that whatever is done with data complies with policies of the Office of Management and Budget (OMB) and your agency's Chief Information Officer. The OMB Web site contains information the government's policies with respect to privacy, cookies, and related topics. See this link: <http://www.whitehouse.gov/omb/query.html?col=omb&qt=cookies>

6. What about rights in data upon termination? Again, there might be a need for a provision with respect to this issue.

7. Who gets the revenue from product sales or advertising fees generated by the site? Can the agencies recoup and retain some of the revenues using existing authority in order to recover costs? Can the partner make charitable gift to a foundation or other organization of the agency's choice or accept a gift in lieu of a royalty?

These are just an example of the IPR issues lurking in an ordinary venture. Often, the client has no idea of the extent to which IPR issues drive an agreement of this nature. As much as it can be eye-opening for the client, it can also make him/her very appreciative of the importance of competent IPR counsel.

#### **IX. USE OF TRADEMARKS ON NON-COPYRIGHTED FEDERAL CONTENT**

The Federal Government is the source of a great deal of valuable goods and services. It is not uncommon for private sector entities to create products or services that include a federal component, such as data, information, and navigational charts or a service provided by the Government, such as food inspection, the exact time, laboratory accreditation, and the like. Often, because of the popularity or brand recognition that the government activity possesses, the private sector will want to use a government name and/or logo to tell the end consumer the Government's role in the good or service. Often, however, the private sector might not be inclined to recognize the government role and might not want to share the credit. Both scenarios present opportunities and challenges, opportunities in terms of getting better "brand recognition" or acknowledgment for the great work performed by federal agencies and challenges in terms of how such use is made by commercial entities, so as to avoid trademark infringement, appearance of endorsement or affiliation, and related issues, all of which I discussed above. An additional challenge is raised by the fact that most government produced content is not protected by copyright and is in the public domain. This section will briefly discuss these opportunities and challenges, and offer insight as to dealing with them.

**A. Government Works Generally Not Protected by Copyright**

As was mentioned above, pursuant to Section 105 of the Copyright Act (17 U.S.C. § 105), copyright protection is not available for any work of the United States Government. As a result, an agency cannot compel a private sector entity to give attribution or acknowledgment on a product containing public domain U.S. Government ("USG") content. For example, a private sector publisher could reproduce a NOAA nautical chart or its popular Coast Pilot® aid to navigation without worrying about permission, acknowledgment, or copyright infringement because the content is not copyrighted. However, if the publisher reproduces the NOAA emblem on the chart or the Coast Pilot® name or logo on the cover in a way that suggests that the product itself was the original from NOAA and not a copy, then the publisher might have committed trademark infringement. Again, the content is not protected by copyright, but the names and logos are protected by trademark. Agencies often use their trademark rights to make up for the copyright protection they lack, as a means of protecting or receiving acknowledgment for their work.

Often, private sector publishers will take USG content, add value to it, and claim copyright on the resulting compilation. This is entirely permissible and is even contemplated under Section 403 of the Copyright Act (17 U.S.C. § 403). Although the Copyright Act prohibits an agency from claiming copyright on its works and from requiring a subsequent user to acknowledge the USG content, there are incentives, both legal and practical, that might induce a re-publisher of USG content to so acknowledge. One is a legal consideration, arising from the above referenced Section 403. Section 403 deals with private sector compilations "consisting predominantly of one or more works of the United States Government," on which the private entity claims copyright. While Section 403 does not necessarily require that the publisher acknowledge the USG content and disclaim it from the protection of its copyright, it does encourage such acknowledgment and disclaimer, in that it gives the copyright holder more evidentiary weight in prosecuting a claim against a would-be innocent infringer.

The other incentive is the hope that the USG content is recognized by consumers as a thing of value. In other words, if the USG content is respected and valued by the user community, the provider of a product or service containing such content is more likely to advertise the USG content's inclusion in the end product or service.

A recent Supreme Court decision speaks to the issue of repackaging a non-copyrighted work with respect to certain trademark law implications. In Dastar v. Twentieth Century Fox Film Corp., 123 S.Ct. 2041 (June 2, 2003), the Court ruled that Section 43(a) of the Lanham Act does not prevent the unaccredited copying of an uncopyrighted work. In this case, Dastar took a television series on World War II and produced a series of videos. The copyright on the television series had lapsed, however Fox owned the video rights on an earlier video series. Arguably, Dastar had violated Fox's copyright by reintroducing the television show, now in the public domain, into the video market, on which Fox's copyright was still valid. But in addition to claiming copyright infringement, Fox also asserted that Dastar had violated Section 43(a) of the Lanham Act (also known as the Trademark Act), claiming that Dastar's video offering constituted "reverse passing off."

As background, "passing off" occurs when a party produces a product and tries to pass it off as the product of someone else, i.e., if a party were to make a counterfeit "alligator" shirt and sell it as a genuine Izod

Lacoste®. "Reverse passing off" is the act of taking the work of another and passing it off as your own work product (akin to plagiarism). Although the copyright had expired on the television series, Fox hoped to use 43(a) of the Lanham Act, which prohibits "false designation of origin," to breathe life into the dead copyright, presumably under the theory that Dastar should have given credit, or should have used the Fox trademark.

The Supreme Court ruled that Section 43(a) of the Lanham Act could not be used to prevent the unacknowledged copying of a public domain work and that the scope of the Trademark Act can not intrude into the scope of the Copyright Act so as to give protection to an expired copyright. It may follow that federal agencies cannot compel an outside party to acknowledge, via use of our trademark, the inclusion of our non-copyrighted work within the outside party's work, nevertheless that is open to interpretation.

#### **X. CLOSING COMMENTS**

Admittedly, I have covered a large amount of matter here in an attempt to cover as many of the various IPR (primarily trademark) issues that I deal with on a regular basis. I hope that my comments and observations not only assist other counsel in dealing with similar issues, but also serve to make counsel and client alike aware of the depth and breadth of IPR and the importance of counsel in maximizing and protecting the agency's interest in its IPR.