

# Donald J. Lenkszus, P.C.

REGISTERED PATENT ATTORNEY

P.O. BOX 3064

CAREFREE, AZ 85377-3064

FEBRUARY 27, 2009

Via Email

don@azpatent.com

TEL.: 602-463-2010

FAX: 480-595-7695

Google  
1600 Amphitheatre Parkway  
Mountain View, CA 94043

Re: [#395313991] Google AdWords Trademark Complaint

This is in response to your email of 2/20/2009 directed to Theresa Franks and me.

You state, inter alia:

2) FINE ART REGISTRY: We're unable to process for your trademark FINE ART REGISTRY at this time because your trademark has been marked 2(F) by the U.S. Patent and Trademark Office. This designation means that there are potentially descriptive or generic uses of your term. Descriptive and generic terms are free for all to use, and therefore we cannot process or prevent all relevant instances of this term.

Global Fine Art Registry, LLC provided a copy of the Registration for Fine Art Registry. That word mark was registered on the principal Trademark register.

Section 7(b) (15 U.S.C. § 1057(b)) of trademark laws make it clear that the issuance of a “certificate of registration of a mark upon the principal register ... shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.”

Section 22 (15 U.S.C. § 1072) of the trademark laws clearly states that: “Registration of a mark on the principal register ... shall be constructive notice of the registrant’s claim of ownership thereof.

Your statement that: “This [2(f)] designation means that there are potentially descriptive or generic uses of your term” is wrong and finds no support in law.

Perhaps it would be helpful for you to read the actual statutory language:

**§ 2 (15 U.S.C. § 1052). Trademarks registrable on the principal register; concurrent registration**  
**No trademark** by which the goods of the applicant may be distinguished from the goods of others **shall be refused registration on the principal register on account of its nature unless it—**

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, **nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the**

## Donald J. Lenkszus, P.C.

applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act. A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be canceled pursuant to a proceeding brought under either section 14 or section 24. (emphasis added)

Section 2[f] only states that a mark is registerable if it acquired distinctiveness. Global Fine Art Registry, LLC did not and does not acquiesce in the assertion that FINE ART REGISTRY is either descriptive or generic.

The designation of 2(f) is set out in the Trademark Manual of Examining Procedure as follows:

### **817 Preparation of Case for Publication or Registration**

When a case is ready to be approved for publication or registration, the examining attorney must carefully review the application file to ensure the accuracy of the information contained therein and to ensure that all information that should be printed in the *Official Gazette* and on the certificate of registration has been properly entered into the TRAM database. The type of information that should be printed includes:

- (1) Disclaimer statements ([TMEP §§1213 et seq.](#));
- (2) Notations of acquired distinctiveness, *i.e.*, “2(f)” or “2(f) in part as to . . .,” as appropriate ([TMEP §§1212 et seq.](#));

### **1212.10 Printing “§2(f)” Notations**

Currently, when a mark is registered under §2(f), the Office prints a “2(f)” notation in the *Official Gazette* and on the certificate of registration.

There is absolutely no basis in trademark law for the position that you have taken.

FINE ART REGISTRY is a service mark of Global Fine Art Registry, LLC.


When the search words “Fine Art Registry” are entered into the advance search of Google, the following screen came up on February 24, 2009:

# Donald J. Lenkszus, P.C.

"fine art registry" - Google Search 2/24/09 4:29 PM

[Web](#) [Images](#) [Maps](#) [News](#) [Video](#) [Gmail](#) [more](#) [Sign in](#)

---

   [Advanced Search](#)  
[Preferences](#)

---

**Web** Results 1 - 10 of about 19,400 for "fine art registry". (0.19 seconds)

<p><b><a href="#">Fine Art Registry</a></b> <span style="float: right;">Sponsored Link</span> <a href="#">FineArtAdvocacy.ParkWestGallery.com</a> Park West is Defending Itself From Baseless Accusations. Visit Today.</p> <p><b><a href="#">Fine Art Registry - The World's first Online Permanent Registry ...</a></b> <b>Fine Art Registry</b> – The World's first Online Permanent Registry and Marketplace for Fine Art and Collectibles! <a href="#">www.fineartregistry.com/</a> - 53k - <a href="#">Cached</a> - <a href="#">Similar pages</a></p> <p><a href="#">Forum</a> <a href="#">Join FAR</a> <a href="#">Artist Search</a> <a href="#">Featured Artists</a> <a href="#">Art Gallery &amp; More</a> <a href="#">HOT</a> <a href="#">About Us</a> <a href="#">Our Columnists</a></p> <p><a href="#">More results from fineartregistry.com &gt;</a></p>	<p style="text-align: center;">Sponsored Links</p> <p><b><a href="#">Online Arts Database</a></b> Mid Atlantic Arts Foundation Search for artists/organizations <a href="#">www.MidAtlanticArts.org</a></p>
---	---

[History of the Fine Art Registry](#) [About FAR](#) [Testimonials](#) [Press ...](#)  
**Fine Art Registry**: History of the **Fine Art Registry**: About FAR, Testimonials, Press Room, Advertising, FAR Policies.  
[www.fineartregistry.com/about\\_FAR/](#) - 25k - [Cached](#) - [Similar pages](#)

[National Fine Arts Title Registry](#)

The first “Fine Art Registry” is the Google sponsored ad from Park West Gallery. The next two shown are from Global Fine Art Registry, LLC.

It is clearly evident that the Google sponsored ad incorporates the service mark of Global Fine Art Registry, LLC and is a clear attempt to utilize the Federally Registered service mark of Global Fine Art Registry LLC. It is a clear attempt to deceive the public. The deceptive intent is furthered by the use of the sub-domain “fineartadvocacy” which is a domain of Global Fine Art Registry, LLC as well as a play on the federally protected common law trademark “Fine Art Advocacy” also owned by Global Fine Art Registry, LLC.

Since Park West Gallery is in a service that is related to the service provided by Global Fine Art Registry, LLC it is clear that they are attempting to deceive the public. Google, accepting and placing the ad with Global Fine Art Registry, LLC’s registered mark is likewise deceiving the public.

Both Google and Park West Gallery are utilizing the Global Fine Art Registry, LLC mark FINE ART REGISTRY to identify the source of Park West Gallery’s products and services.

In short, (1) Global Fine Art Registry, LLC owns a valid and protectible trademark, (2) Google has used the mark, (3) in commerce, (4) in connection with the sale or advertising of goods or

**Donald J. Lenkszus, P.C.**

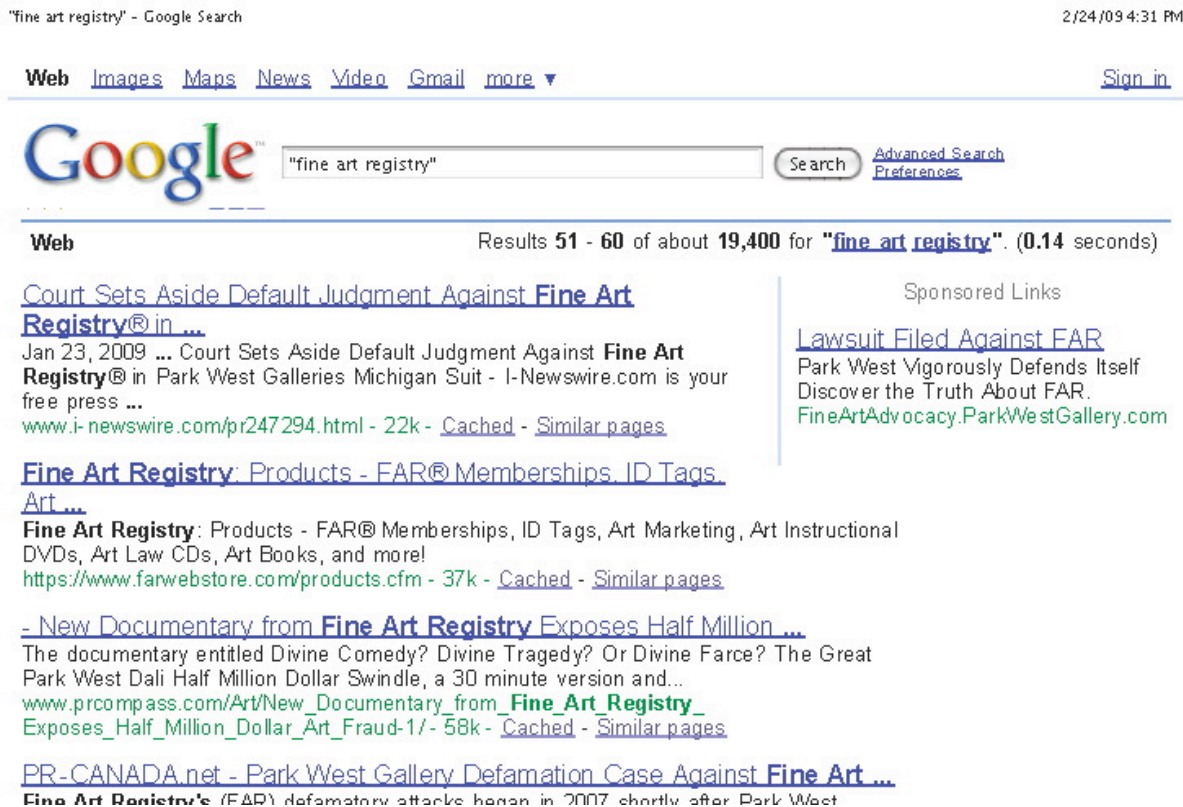
services, (5) without consent or authorization from Global Fine Art Registry, LLC, and (6) the use is likely to cause consumer confusion.

Global Fine Art Registry, LLC demands that Google immediately cease and desist from all use of the service mark FINE ART REGISTRY except in direct reference to Global Fine Art Registry, LLC 's web sites and services.

You further state:

1)FAR: As it is likely to be incredibly difficult to locate the ads using this term in reference to the your goods and services, please send us the ads of concern in order to expedite our investigation.

With respect to Global Fine Art Registry, LLC's registered mark FAR, that mark also appears when an advanced search for FINE ART REGISTRY is executed on Google's search engine:



The clear use of Global Fine Art Registry, LLC's registered service mark FAR is in the sponsored ad on the right side of the page.

## **Donald J. Lenkszus, P.C.**

If this were the only use of a Global Fine Art Registry, LLC mark, perhaps it might be considered to be a “fair use.”

However, in what can only be characterized as a wholesale attack on all of Global Fine Art Registry, LLC’s service marks, Park West Gallery and Google have utilized both Federally registered service marks FAR and FINE ART REGISTRY and the common law mark FINE ART ADVOCACY in an attempt to harm the valuable good will developed by Global Fine Art Registry, LLC.

You also state:

3)FINE ART ADVOCACY: We will not be able to process for your trademark FINE ART ADVOCACY at this time because your trademark is not registered and appears to have a descriptive and/or generic meaning. As mentioned above, descriptive and generic terms are free for all to use, and therefore we do not prevent advertisers from using these terms. If you disagree with the advertiser's use of this term, you may contact the advertiser directly to resolve the dispute.

The Lanham Act does not preempt common law trademarks. To the contrary, the Lanham Act recognizes a common law trademark right.

Global Fine Art Registry, LLC’s common law service mark FINE ART ADVOCACY is a protectable mark whether registered or un-registered. The use of “FineArtAdvocacy” by Park West Gallery is a clear attempt to deceive the public into going to the Park West Gallery web site rather than the web site of Global Fine Art Registry, LLC.

The collective use by Park West Gallery in cooperation with Google of the Registered marks FINE ART REGISTRY and FAR and the common law mark FINE ART ADVOCACY are all trademark infringements and unfair competition that are not only are likely to confuse the public as to the source or origin of the services associated therewith, but to deliberately deceive the public.

Google’s use of Global Fine Art Registry, LLC’s marks within titles and text that Google posts as part of Park West Gallery’s “Sponsored Links” misleadingly communicates to consumers that such links are endorsed or sponsored by Global Fine Art Registry, LLC or that such websites are official Global Fine Art Registry websites.

Google’s unauthorized use in commerce of Global Fine Art Registry, LLC’s marks generates profits for Google and its advertisers that are directly attributable to the unauthorized exploitation of the value and name recognition associated with the Global Fine Art Registry, LLC marks.

Google’s use of Global Fine Art Registry, LLC’s marks is an intentional trafficking in the infringement and dilution of Global Fine Art Registry, LLC marks. These practices cause consumer confusion, erode the distinctiveness of the Global Fine Art Registry, LLC marks, and

## Donald J. Lenkszus, P.C.

cause Global Fine Art Registry, LLC to lose, in part, control over the commercial use of its marks.

Google's own trademark policy states:

**Google recognizes the importance of trademarks.** Our AdWords Terms and Conditions with advertisers **prohibit intellectual property infringement by advertisers.** They make it clear that advertisers are responsible for the keywords they choose to generate advertisements and the text that they choose to use in those advertisements.

Google takes allegations of trademark infringement very seriously and, as a courtesy, we're happy to investigate matters raised by trademark owners. Trademarks are territorial and apply only to certain goods or services of the trademark owner. Therefore, different parties can own the same mark in different countries or different industries. Accordingly, in processing complaints, Google will ask the trademark owner for information regarding where the mark is valid and for what goods or services. Please note the advertisers, particularly following about our complaint process:

The trademark owner doesn't need to be a Google AdWords advertiser in order to send a complaint.

Any such investigation will only affect ads served on or by Google.

Google's trademark policy does not apply to search results, only to sponsored links. For trademark concerns about websites that appear in Google search results, the trademark owner should contact the site owner directly.

In the case of an AdSense for Domains trademark complaint, an investigation will affect only the domain names of sites in our AdSense for Domains program.

Because Google is not a third-party arbiter, we encourage trademark owners to resolve their disputes directly with them because the advertisers may have similar ads running via other advertising programs.

Global Fine Art Registry, LLC has provided information that demonstrates the validity and importance of its marks. Google has no basis to challenge the prima facie validity of the service mark registrations or its common law mark. It appears that contrary to Google's own policy, no investigation was made, only conclusions that are not supported by any fact and which are contrary to the facts presented.

It is demanded that Google do more than pay lip service to recognizing "**the importance of trademarks**" and actually enforce its or AdWords Terms and Conditions with advertisers that "**prohibit intellectual property infringement by advertisers.**"

**Donald J. Lenkszus, P.C.**

Global Fine Art Registry again demands that Google immediately cease and desist from its unauthorized use in commerce of Global Fine Art Registry, LLC's marks.

Global Fine Art Registry again demands that Google immediately cease and desist from allowing Park West Gallery or any other third party from using the marks of Global Fine Art Registry from linking to Park West Gallery or third party websites.

Global Fine Art Registry, LLC again demands that Google cease and desist any linking to the sub domain/domain "FineArtAdvocacy.parkwestgallery.com"

Your prompt confirmation that Google complies with the foregoing is also demanded. The continued failure to do so causes increasing harm to Global Fine Art Registry, LLC.

Sincerely yours,

*/Donald J. Lenkszus/*

Donald J. Lenkszus  
Attorney for Global Fine Registry, LLC

cc T. Franks