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Newsletter

IP Law Section of The State Bar of Georgia

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Angels Who Lost Their Wings

Federal Trademark Owner Loses to Local Organization

By Jeffrey R. Kuester
Thomas | Kayden

We have all seen small airplanes flying around, and I occasionally wonder if my law partner, Dan McClure, might be flying one of them. Though he obtained his pilot's license as a hobby, he surprised me a few years ago when he told me that he also donates time and money by flying patients and their families to distant hospitals for treatment. Dan's generosity was not the part that surprised me since we both are committed to regular giving to our churches and other organizations, but I was surprised that there existed an organization that would facilitate free flights for people with medical needs. Dan called them "Angel Flights," and as a trademark lawyer hearing that particular organizational name, I remember thinking that it was a good choice for a trademark. As it turns out, Angel Flight is indeed a good trademark according to a recent court decision.

Patent Committee Chair Bradley Groff and Jeffrey Kuester at the presentation on standing and pre-suit considerations.

For those of us who litigate trademark, false advertising, and unfair competition disputes in state and federal courts, as well as those of us who obtain trademark registrations for our clients, much can be learned from *Angel Flight of Georgia, Inc. v. Angel Flight America, Inc.*, 522 F.3d 1200 (11th Cir. 2008). In this case, a Georgia non-profit corporation successfully defended its common law right to use its trademark, Angel Flight, against a national organization that was armed with a federal trademark registration covering the same words. The Georgia company (Angel Flight of Georgia, "AFGA") demonstrated a likelihood of confusion resulting from the national organization (Angel Flight America, "AFA") moving into Georgia in recent years. In addition, AFGA also convinced the Eleventh Circuit Court of Appeals to cancel AFA's federal trademark registration, resulting in a complete victory for the local organization.

Volunteer pilots in Georgia began operating through AFGA in 1983 to provide free flights for patients and donated organs using the name Angel Flight. When AFA began promoting its own activities in Georgia in 2001 under the same name, donors and news media began confusing the two organizations. While the Eleventh Circuit Court of Appeals found that the District Court for the Northern District of Georgia had improperly relied upon hearsay in establishing evidence of actual confusion, the Court of Appeals considered that evidence to be largely superfluous in the overall finding of infringement. In essence, the other standard factors in the likelihood of confusion analysis clearly showed that there was common law trademark infringement, *e.g.*, the marks, services, consumers, and advertising media were all identical, and AFA's intent was also determined to be improper.

One interesting insight from this case is found in the intersection between Georgia common law trademark infringement and federal trademark law. While the federal trial and appellate courts in this case explicitly applied state common law, they looked instead to federal case law as persuasive authority in view of the "paucity of Georgia cases addressing common law trademark infringement," citing similar reliance on federal case law by Georgia courts. Consequently, litigation experience in federal trademark cases continues to be useful in determining Georgia common law trademark infringement.

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In addition, those of us who obtain federal trademark registrations for our business clients should note from this case that AFA's federal trademark registration was canceled because it was found to have been obtained through fraud. In keeping with a recent trend by courts in canceling federal trademark registrations on the basis of fraud for a variety of different reasons, this court found that AFA committed fraud on the U.S. Trademark Office by not disclosing the existence of other legitimate users of the Angel Flight mark, such as AFGA. Interestingly, this fraud finding was upheld even though AFA's first use (outside Georgia) occurred before AFGA's first use, making this another example of how a junior common law user may be able to cancel a senior user's federal trademark registration.

While this case ultimately shows that common law rights can overcome a federal registration in some instances, it should be remembered that common law rights never extend beyond their geographic areas of use. Consequently, while federal registrations are still useful in obtaining constructive nationwide protection if other uses have not yet begun, concurrent use federal registration applications should be used in other circumstances to avoid the risk of fraud since federal trademark registrations for concurrent use are typically limited by geography.

Furthermore, business law attorneys should also remember that the simple reservation of a corporate name through the Georgia Secretary of State's office never establishes trademark rights. In addition, unlike federal trademark registrations, it is settled law that Georgia trademark registrations also do not provide evidence of ownership rights. Consequently, enforceable trademark rights may be much more difficult to establish at trial without the benefit of a federal trademark registration.

In conclusion, it is unfortunate that these two worthwhile charitable organizations were unable to settle their territorial disagreements without resorting to our court system. Of course, these types of flights are desperately needed by people throughout our country, so we should all support their efforts. If you happen to be a pilot, please consider volunteering, and if you are not a pilot, please consider contributing. AFGA can be found online at www.angelflightsoars.org. ●

IP Member in Focus: Roger Frost

By Robert Neufeld
King & Spalding

As part of the continuing series profiling noteworthy members of the Section, in this issue of the newsletter we are focusing on Roger Frost. Mr. Frost is retiring from the practice of intellectual property law after more than forty years in the business. Mr. Frost graduated from the Georgia Institute of Technology in 1960 and received his law degree from Georgetown University Law Center in 1964. After working as an examiner at the U.S. Patent and Trademark Office ("PTO") and as in-house counsel at Lockheed Martin, Mr. Frost spent the majority of his career in private practice with the firm that came to be known as Jones & Askew. Mr. Frost developed a strong reputation among his colleagues as an expert in PTO procedure. Many members of today's Georgia Bar IP Section have had the opportunity to learn from Mr. Frost. The following are remarks from a few of the lawyers Mr. Frost influenced over the years.

Following the formation of Jones and Thomas in 1968 by Harold Jones and George Thomas, I was the first to join and Roger was the second. We lured Roger from Lockheed where he had practiced for many years as an in-house patent attorney. As a result, Roger was the fourth most senior member of the firm with Janet Peck following closely on his heels. Whenever we had airplane inventions (such as heads-up cockpit displays and landing gear tire pre-rotation), Roger could explain the fallacies with the ideas and the existence of a lot of prior art.

Roger had a knack for prosecuting our most humorous inventions (and Roger delighted in playing with the humor). Who can forget the famous bedside alarm clock that at the appointed hour displayed on a bedside wall a short film clip of a steaming locomotive headed right for the bed -- together with all of the approaching train sounds and noises -- and the groggy sleeper sitting up in bed with arms outstretched and eyes bulging? It is my recollection that the application sailed through the office on a first action allowance.

Roger is a great friend and a legendary patent lawyer -- we all learned a lot of patent law from him while enjoying our time with him.

- Tony Askew

Roger was one of my most influential mentors in learning patent drafting and prosecution. He is an excellent attorney and teacher. His techniques have served my clients well for decades, and I still routinely pass them on to young attorneys. Roger also set an excellent example as a professional of unquestioned integrity, and loyalty to clients and colleagues. Like so many of my colleagues, I owe my success in significant part to the preparation and values Roger imparted to me. I am very grateful, and wish Roger and Maxine an enjoyable retirement.

- Jeff Young

I first met Roger Frost on Thursday September 15, 1977. I remember that day well because it was the day I interviewed for a job with Jones, Thomas & Askew, which at that time was located in the Gas Light Tower of Peachtree Center. I received a phone call the next day from Tony Askew offering me a job and I reported for work the following Monday. I was the eighth lawyer in the firm, which at that time comprised Harold ("Deacon") Jones, George Thomas, Tony Askew, Roger Frost, Jeff Young, Gene Zimmer and Lou Isaf. I had no idea on that day