

Bar Talk

People and Practices



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A BREED APART: Canine counsel Roy Gordet (left) and Leo Siegel — with Champion Lin-Kai Ko-Je-Ko — boned up on intellectual property law in scoring rare PTO recognition of the Kyi-Leo® breed.

'Honey, Can You Walk the ®?'

You might call it a case of dogged determination.

Roy Gordet set out in June 1995 to apply for a so-called certification mark from the Patent and Trademark Office for a rare breed of dog. His chances of succeeding were a long shot.

"The trademark examiner basically took the position that this mark was not registerable because it was a breed of a dog, that it was a descriptive or generic term," says Gordet, a San Francisco solo practitioner who represents the Concord-based Kyi-Leo Club.

The mission was made even more difficult when a rogue member of the club, which breeds the dog, left to breed a similar dog she sold under the same name.

Gordet and Walnut Creek solo practitioner Leo Siegel, who

specializes in canine law, had their hands full. While battling for 22 months with the PTO over the merits of registering the name Kyi-Leo, the two attorneys sued the defecting club member.

But by settling the suit and, in April, receiving the certification mark, the two attorneys have pulled off what many trademark attorneys thought was impossible.

A distant cousin to trademarks, a certification mark attests that goods or services sold under the mark meet certain standards. The Underwriters Laboratories logo is one of the better-known examples.

John Benassi, an intellectual property partner in the La Jolla office of Los Angeles' Lyon & Lyon, said the certification appeared novel.

"The dog situation is a bit

unusual from a logical standpoint," he said.

Still, he added, as long as the dog club controls the use of the mark, does not market the dogs and agrees to certify all dogs meeting its Kyi-Leo criteria, the breed name is eligible for the protection.

Gordet, for one, is happy others are finally coming around to what he has been saying all along.

"I looked at the Lanham Act and it appeared to me that everything [the Kyi-Leo Club] did conformed to the requirements for getting a certification mark," he said. "I was not going to allow this one trademark examiner to deny our client a statutory right that under the trademark office's practices and the First Amendment the client was entitled to."

— Dan Goodin