

# Recent Developments in the Protection of Non-Traditional Trademarks

Prof. Dr. Irene Calboli

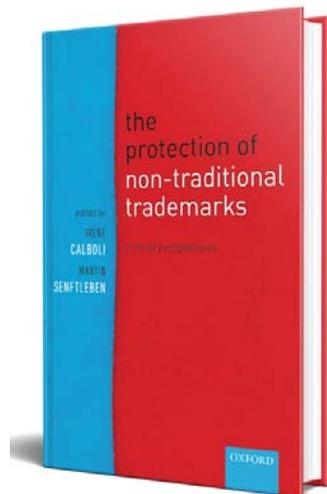
*Professor, Texas A&M University School of Law  
Visiting Professor, Nanyang Business School, Nanyang Technological University  
Academic Fellow, School of Law, University of Geneva  
Hanken Distinguished Fellow, Hanken School of Economics*

IPKey SEA Conference on Trademarks

15-16 October 2019, Bangkok, Thailand



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*Edited by*

**Irene Calboli** is Professor of Law at Texas A&M University School of Law, and Transatlantic Technology Law Forum Fellow at Stanford Law School.

**Martin Senftleben** is Professor of Intellectual Property, Centre for Law and Internet, Vrije Universiteit Amsterdam, and Of Counsel, Bird & Bird.

In recent years, the domain of trademark law and the scope of trademark protection has grown exponentially. Today, a wide variety of non-traditional marks, including colour, sound, smell, and shape marks, can be registered in many jurisdictions. However, this expansion of trademark protection has led to heated discussions and controversies about the impact of the protection of non-traditional marks on freedom of competition and, more generally, on socially valuable use of these or similar signs in unrelated non-commercial contexts. These tensions have also led to increasing litigation in this area across several jurisdictions.

This book provides an overview of the debate and state of the law surrounding non-traditional marks at the international, regional, and national level. In particular, this book addresses relevant international treaties administered by the World Intellectual Property Organization (WIPO) and the Agreement on Trade-Related Aspects to Intellectual Property Rights (TRIPS) as well as several regional and national legislations and leading judicial decisions in order to examine current law and practice culminating in critical reflections and suggestions on the topic.

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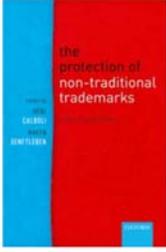
Overview

Description

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Reviews and Awards



Google Preview

### The Protection of Non-Traditional Trademarks

Critical Perspectives

Edited by Irene Calboli and Martin Senftleben

- Detailed analysis of the issues related to the protection of non-traditional marks including colour, sound, smell, and shape marks
- Overview of the debate and state of the law surrounding non-traditional marks at the international, regional, and national level
- Addresses relevant international treaties administered by the World Intellectual Property Organization (WIPO) and the Agreement on Trade-Related Aspects to Intellectual Property Rights (TRIPS) as well as several regional and national legislations and leading judicial decisions

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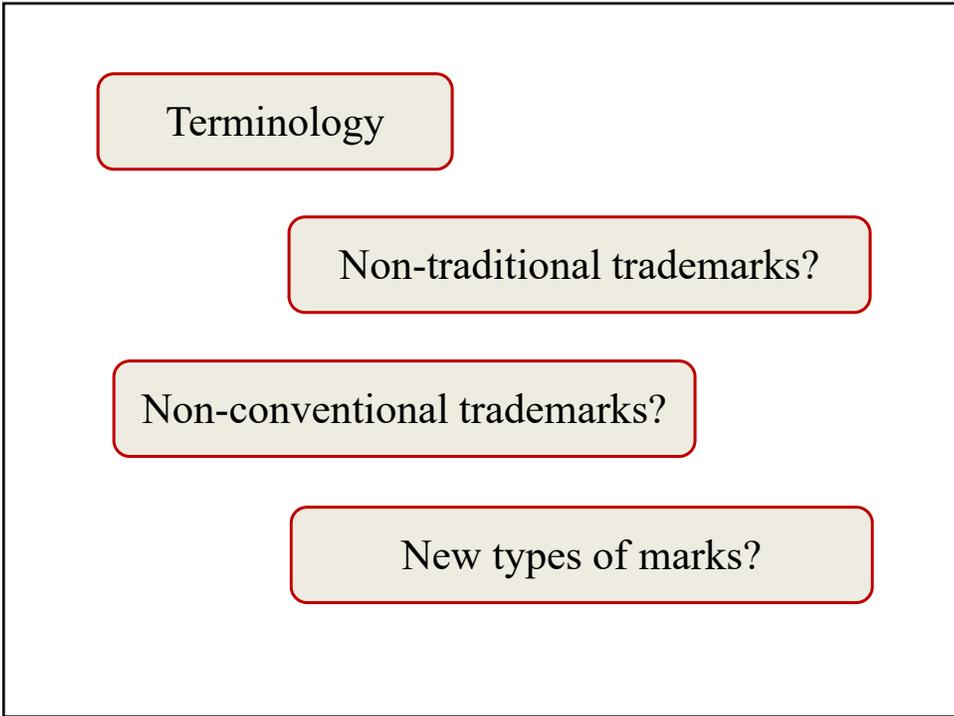
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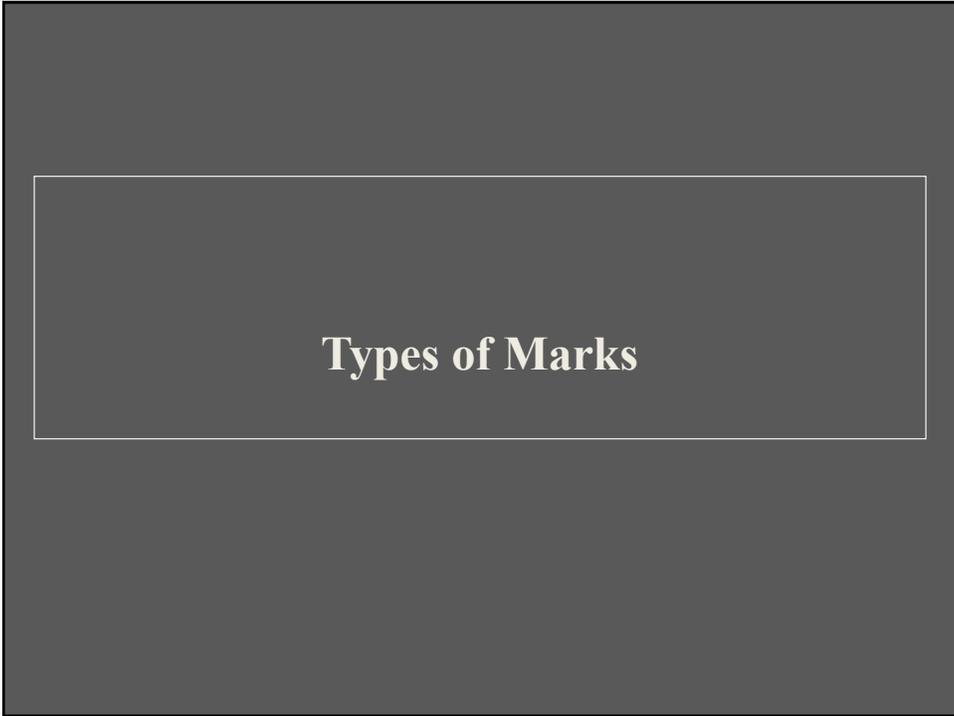
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# Recent Developments in the Protection of Non-Traditional Trademarks

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**Figurative Trademark**



**Word Trademark**

ADIDAS PHILIPS JUST DO IT VOLVO

**Combined Trademark**



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**Shape Mark**



**Shape Mark containing word elements**



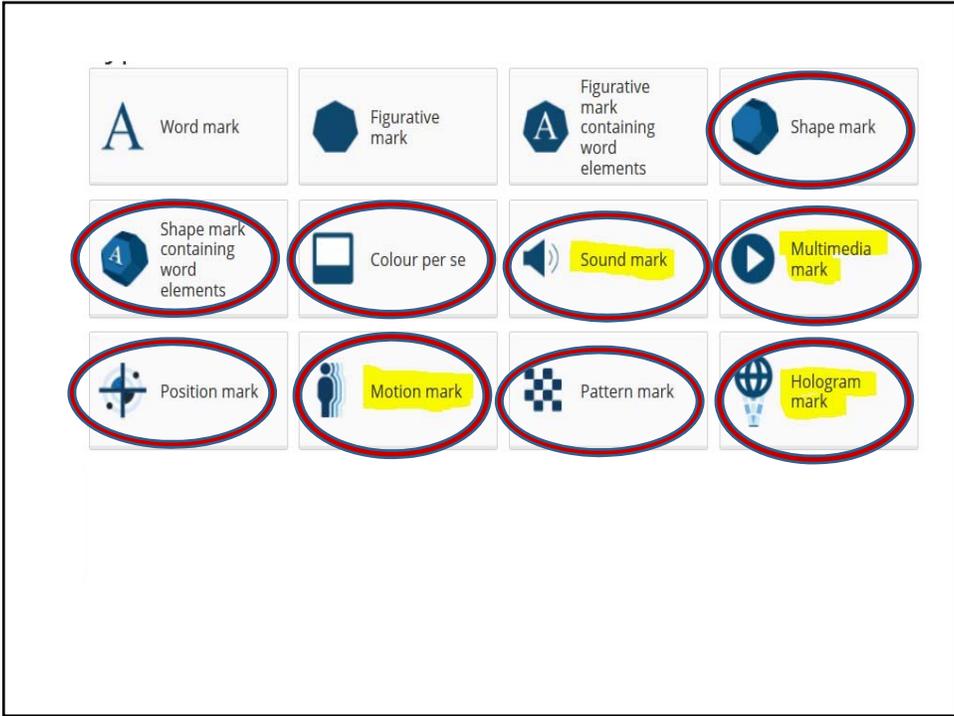
**Position mark**



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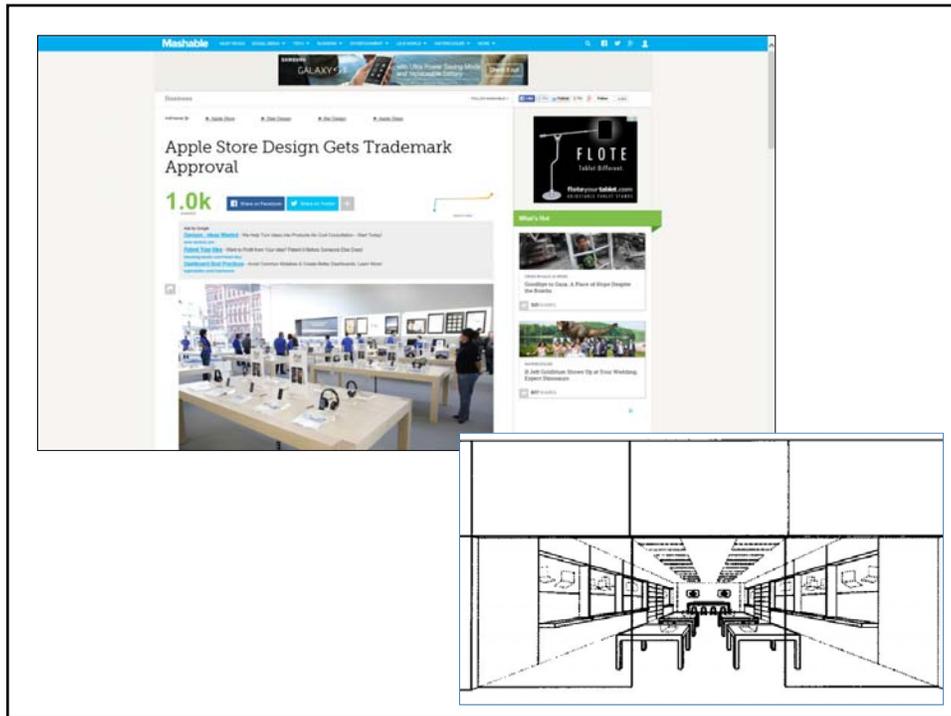
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**Examples of  
Non-Traditional Trademarks  
(registered, applied, attempted  
to be registered, revoked, etc.)**

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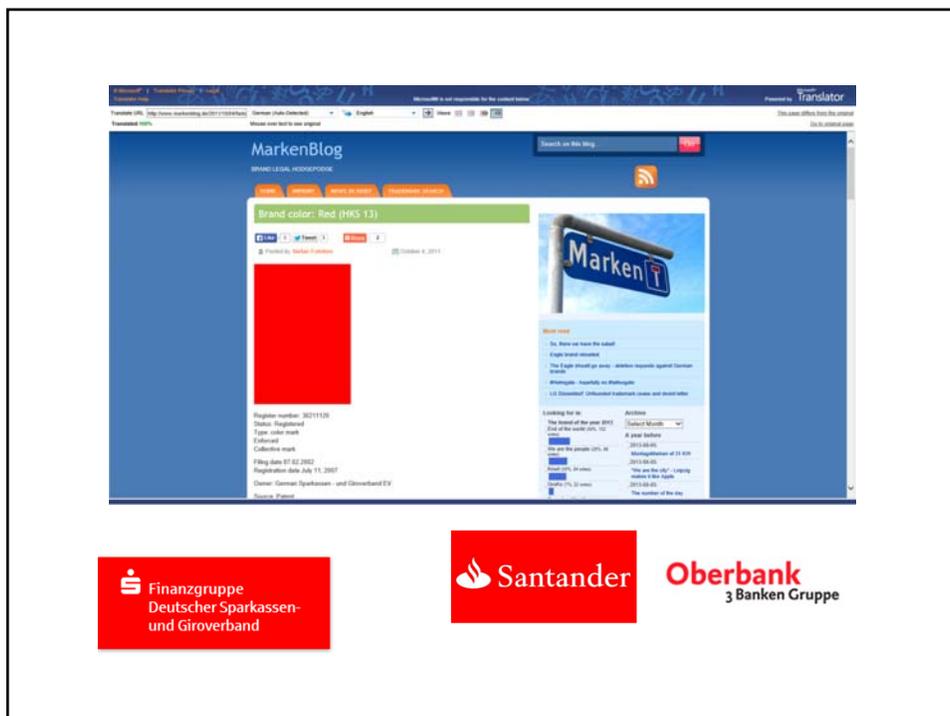


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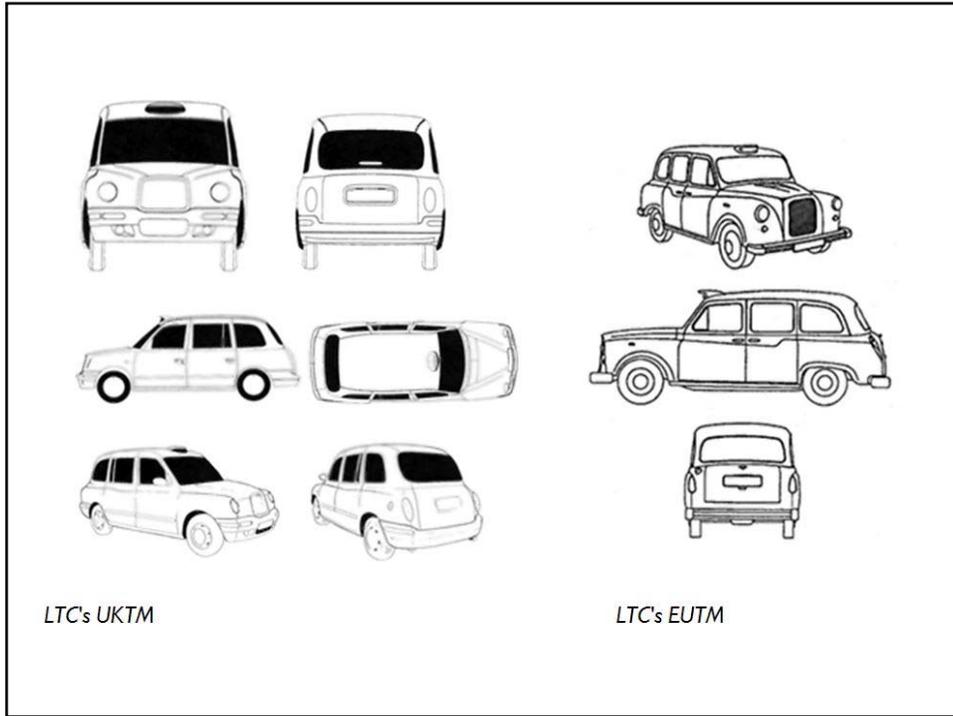




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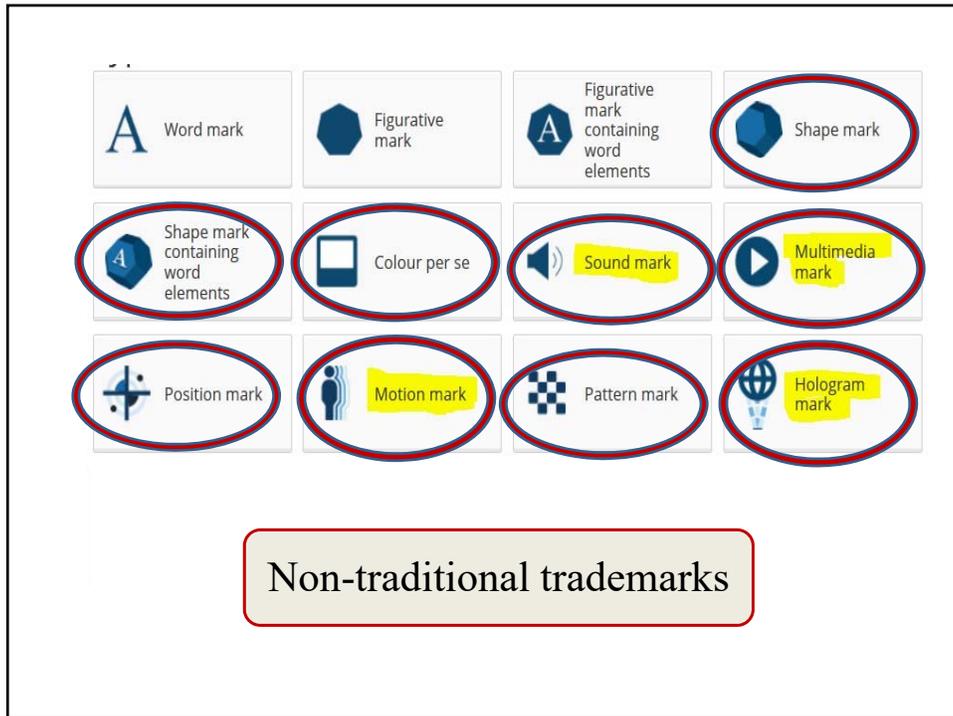
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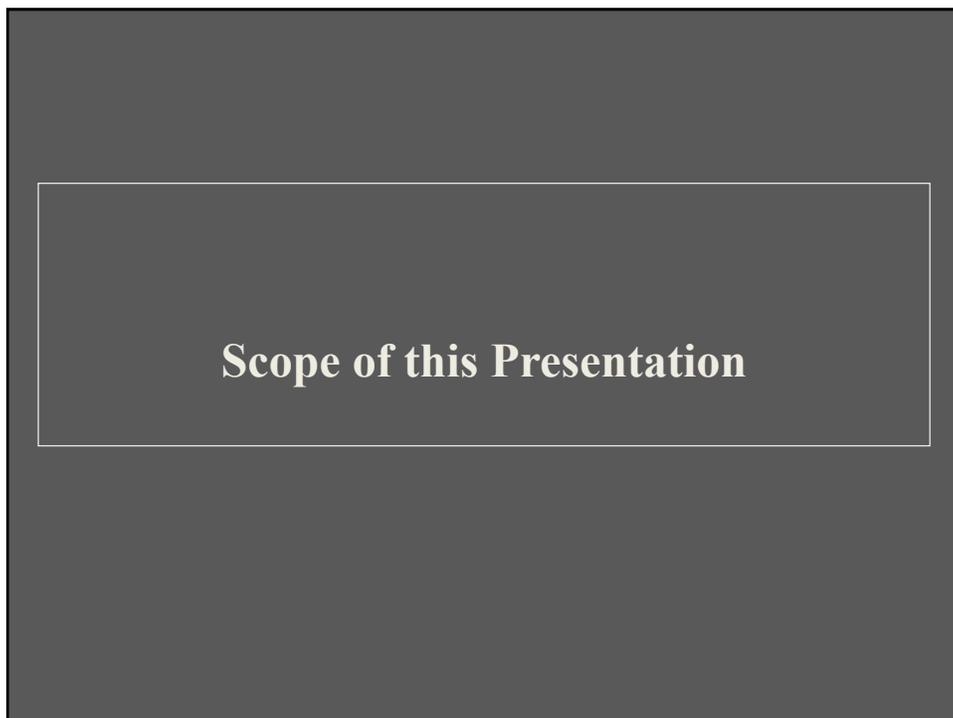
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Why non-traditional trademarks?

The context of non-traditional trademarks

Legal context

Business context

Competition context

Public policy context

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Why non-traditional trademarks?

Very broad definition of what type of signs  
can be protected as trademarks

Low threshold of the concept of  
trademark distinctiveness

Advantages of trademark protection,  
notably duration and protection for non  
registered marks

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## The context of non-traditional trademarks

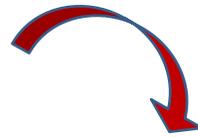
Legal context

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TRIPS Art. 15: Any sign ... capable of distinguishing [products], ***shall*** be capable of constituting a trademark.

Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, ***shall*** be eligible for registration as trademarks.

*... Members may require, as a condition of registration, that signs be visually perceptible.*



Singapore Treaty on Trademarks (WIPO) allows (even though it does not impose) for the registration of non-conventional marks such as holograms, scent marks, sound marks, motion marks and three-dimensional (“3D”) marks.

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- Almost anything is capable of registration and protection if the trademark or trade dress is **distinctive, not functional**, and the **markholder has priority based on use or registration**
  - Words, including descriptive words and popular phrases
  - Names, including the names of historical figures
  - Symbols
  - Colors, including single colors
  - Product packaging
  - Product configurations
  - Retail store designs and restaurant décor
  - Look and feel of a website
  - Other non-traditional marks such as sounds, scents, tastes, textures, holograms, and movements
  - Artistic works currently or formerly protected by copyright
  - Designs currently or formerly protected by patent

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## What Can Be Protected as a Mark?

EU Trade Mark Directive *Article 3 (2015)*

### **Signs of which a trade mark may consist**

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are **capable of**:

- (a) **distinguishing** the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

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EU Trade Mark Directive *Article 3*

**Signs of which a trade mark may consist**

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

EU Trade Mark Directive *Article 2*

**Signs of which a trade mark may consist**

A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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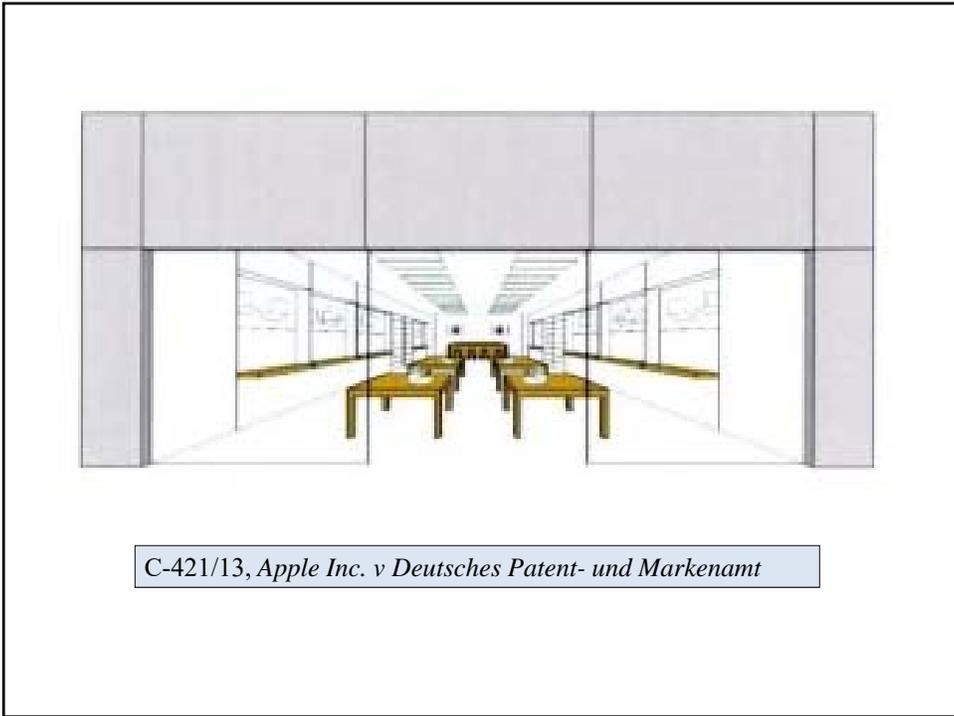
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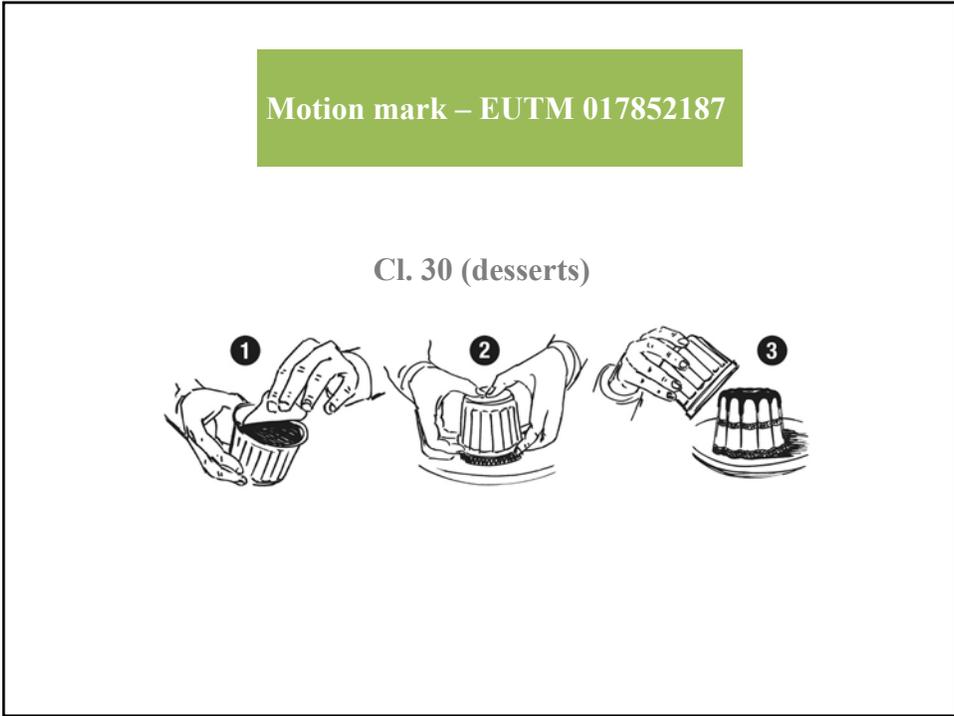
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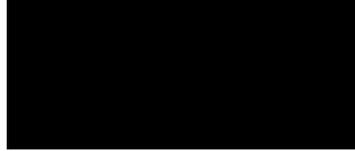


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EUTM No 017280264, 017280249, 017280281 – movement marks



Cl. 9 (audiovisual appliances)

43

EUTM No 017280264, 017280249, 017280281

**Signing:** To sign *light*, take your strong hand and raise above and to the side of your head. Take your fingers from being extended and together to extended outward. The sign looks like a *light* is flicking on, spreading out it's rays.



Soon users would be able to interact with their smartwatch without touching the device. Image: Google

Unlike cameras, which are used in other motion sensing technologies, radar has a high positional accuracy and thus works better in this context than cameras would. It's able to pick up on slight movements better.

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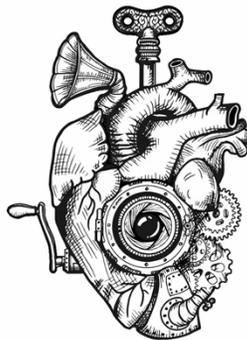
**EUTM 17492513 - Motion mark**



Classes 1 (hydraulic fluids), 4 (lubricants, engine oils) and 37 (lubricating services).

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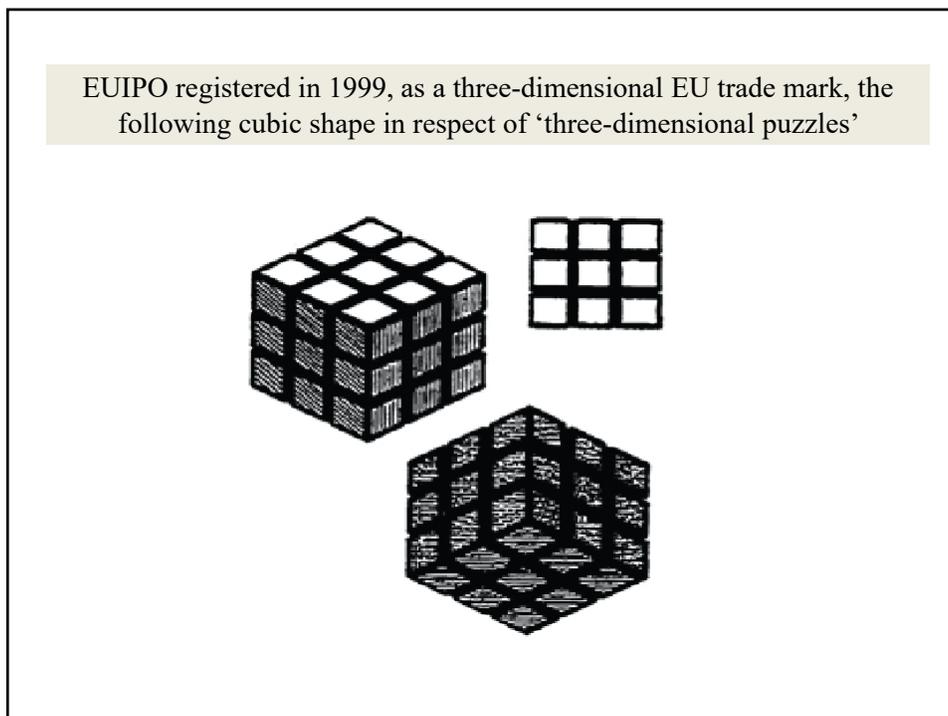
**EUTM 17279704- Multimedia mark**



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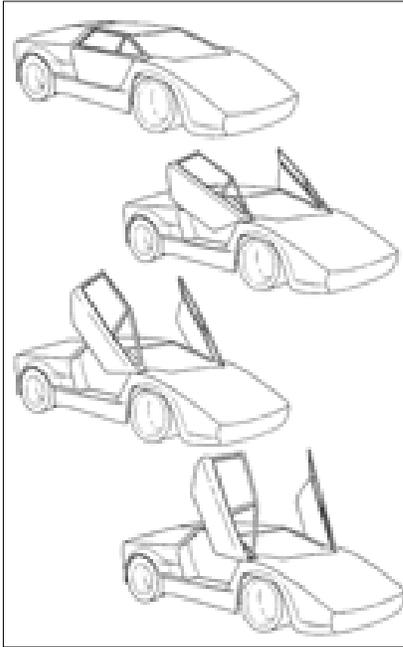


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CTM 1400092:  
Lamborghini  
moving image  
for car doors  
opening and  
turning upward.

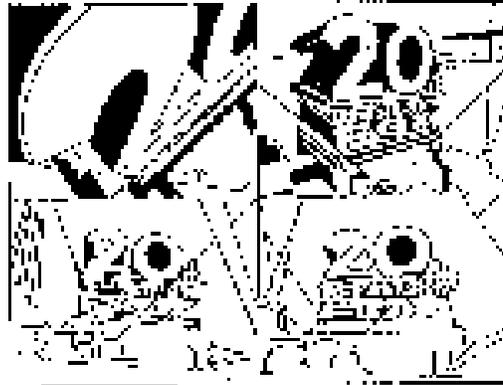


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## What Can Be Protected as a Mark?

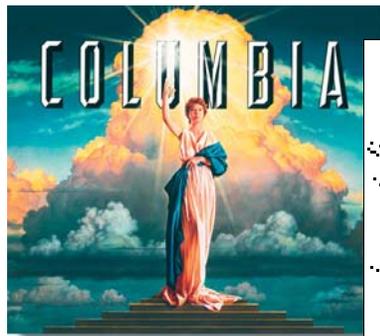
- Lanham Act (15 U.S.C. § 1127):
  - Trademarks: [any] word, name, symbol, or device, or any combination thereof, used in commerce to **identify** and **distinguish** “products” and to indicate source
- Restatement (Third) of Unfair Competition (1995):
  - “A trademark is a word, name, symbol, device, or other designation ... that is **distinctive** of a person’s goods or service and that is used in a manner that identifies those goods and distinguishes them from th[ose] of others ...”

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*USPTO TM 1.928.424*: computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four "stills" from the sequence.

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*USPTO TM 1.975.999*; moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word "COLUMBIA" appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.

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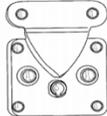
Int. Cl.: 18

Prior U.S. Cls.: 1, 2, 3, 22 and 41

Reg. No. 3,617,909

United States Patent and Trademark Office Registered May 12, 2009

TRADEMARK  
PRINCIPAL REGISTER



LOUIS VUITTON MALLETIER (FRANCE CORPORATION)  
2, RUE DU PONT-NEUF  
75001 PARIS, FRANCE

OWNER OF U.S. REG. NOS. 1,650,162 AND 2,828,919.

FOR: LEATHER AND IMITATION LEATHER PRODUCTS, NAMELY, TRAVEL TRUNKS, TRAVEL BAGS, TRAVEL CASES, TRAVEL GARMENT BAGS, SUITCASES, LUGGAGE, TOILETRY CASES, SOLID EMPTY, BACK PACKS, HANDBAGS, BEACH BAGS, LEATHER SHOPPING BAGS, SHOULDER BAGS, ATTACHE CASES, BRIEFCASE-TYPE PORTFOLIO CASES, BRIEFCASES, SCHOOL BAGS, UNDERARM BAGS, MANUFACTURED LEATHER GOODS, NAMELY, WALLETTS, UMBRELLAS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

THE MARK CONSISTS OF A SOLID BRASS LOCK COMPRISED OF A HASP WITH A RIVET ON EITHER SIDE, A LOCK PLATE WITH FOUR RIVETS, ONE ON EACH CORNER AND TWO RELEASE MECHANISMS, ONE ON EITHER SIDE OF THE POINT WHERE THE HASP ATTACHES TO THE LOCK PLATE AND A LOCK HOUSING.

SEC. 2(F)

SER. NO. 76-572,393, FILED 1-29-2004.

FIRST USE 1-1-1986; IN COMMERCE 1-1-1986.

DANIEL CAPSHAW, EXAMINING ATTORNEY

LOUIS VUITTON



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Int. Cl.: 18

Prior U.S. Cls.: 1, 2, 3, 22 and 41

Reg. No. 2,075,141

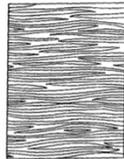
United States Patent and Trademark Office

Registered July 1, 1997

Corrected

OG Date May 26, 1998

TRADEMARK  
PRINCIPAL REGISTER



LOUIS VUITTON MALLETIER  
(FRANCE CORPORATION)  
54, AVENUE MONTAIGNE  
75008 PARIS, FRANCE

OWNER OF FRANCE REG. NO. 9147982, DATED 1-3-1993, EXPIRES 1-3-2002.

OWNER OF U.S. REG. NO. 1,931,144  
THE COLOR YELLOW IS CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF RAISED DARK YELLOW WAVY LINES ON A LIGHTER YELLOW BACKGROUND.

FOR: TRUNKS FOR TRAVELLING, SUITCASES, TRAVELLING BAGS, HANDBAGS, LUGGAGE, COSMETIC CASES, SOLID EMPTY, VANITY CASES, SOLID EMPTY, TOILETRY CASES, SOLID EMPTY, BACK PACKS, SHOULDER BAGS, TOTE BAGS, LEATHER SHOPPING BAGS, WAIST PACKS, BRIEFCASES, ATTACHE CASES, BRIEFCASE-TYPE PORTFOLIOS, PURSES, CHANGE PURSES, WALLETTS, KEY CASES, DOCUMENT CASES, BUSINESS CARD CASES AND BILLETS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

SER. NO. 75-034621, FILED 12-18-1995.



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Int. Cl.: 18  
 Prior U.S. Cls.: 1, 2, 3, 22 and 41  
 United States Patent and Trademark Office **Reg. No. 2,071,273**  
Registered June 17, 1997

**TRADEMARK**  
**PRINCIPAL REGISTER**




LOUIS VUITTON MALLETER (FRANCE CORPORATION)  
 84 AVENUE MONTAIGNE  
 75008 PARIS, FRANCE

FOR: TRUNKS FOR TRAVELLING, SUIT CASES, TRAVELLING BAGS, HANDBAGS, LOGGAGE, COSMETIC CASES (GOLD EMPTY), VANITY CASES (GOLD EMPTY), TELETYPE CASES (GOLD EMPTY), BACK PACKS, SHOULDER BAGS, TOTE BAGS, LEATHER SHOPPING BAGS, WAIST PACKS, BRIEFCASES, ATTACHE CASES, BRIEFCASE-TYPE PORTFOLIOS, PURSES, CHANGE PURSES, WALLETTS.

KEY CASES, DOCUMENT CASES, BUSINESS CARD CASES AND BELLFOLDS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).  
 OWNER OF FRANCE REG. NO. 9471962, DATED 12-20-1993, EXPIRES 12-20-2004.

**THE MARK CONSISTS OF RAISED DARK GOLD WAVY LINES ON A LIGHTER GOLD BACKGROUND. THE COLOR GOLD IS CLAIMED AS A FEATURE OF THE MARK.**

REG. NO. 75-01445, FILED 11-18-1995.  
 THERESA M. RUFF, EXAMINING ATTORNEY

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Int. Cl.: 18  
 Prior U.S. Cls.: 1, 2, 3, 22 and 41  
 United States Patent and Trademark Office **Reg. No. 2,098,630**  
Registered Sep. 23, 1997

**TRADEMARK**  
**PRINCIPAL REGISTER**




LOUIS VUITTON MALLETER (FRANCE CORPORATION)  
 84 AVENUE MONTAIGNE  
 75008 PARIS, FRANCE

FOR: TRUNKS FOR TRAVELLING, SUIT CASES, TRAVELLING BAGS, HANDBAGS, LOGGAGE, COSMETIC CASES (GOLD EMPTY), VANITY CASES (GOLD EMPTY), TELETYPE CASES (GOLD EMPTY), BACK PACKS, SHOULDER BAGS, TOTE BAGS, LEATHER SHOPPING BAGS, WAIST PACKS, BRIEFCASES, ATTACHE CASES, BRIEFCASE-TYPE PORTFOLIOS, PURSES, CHANGE PURSES, WALLETTS, KEY CASES, DOCUMENT CASES, BUSINESS CARD CASES AND BELLFOLDS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

PROPERTY CLAIMED UNDER SEC. 1203 ON FRANCE APPLICATION NO. 95-56304, FILED 3-20-1995. REG. NO. 95-765704, DATED 3-20-1995, EXPIRES 3-20-2002.

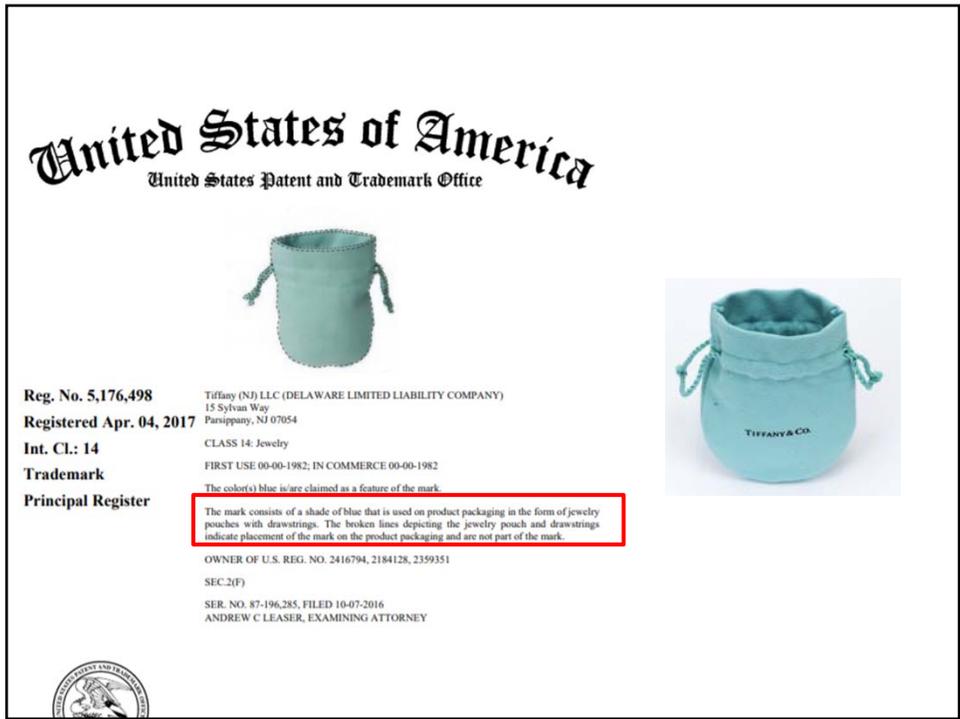
**COLOR IS CLAIMED AS A FEATURE OF THE MARK.**  
**THE MARK CONSISTS OF RAISED BLACK WAVY LINES ON A BLACK BACKGROUND.**

REG. NO. 74-75194, FILED 9-18-1995.  
 ANNE PHILLIPS, EXAMINING ATTORNEY

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Int. Cls.: 3, 8, 14, 16, 18, 20, 21, 25, 28 and 35  
 Prior U.S. Cls.: 1, 2, 3, 4, 5, 6, 13, 22, 23, 25, 27,  
 28, 29, 30, 32, 33, 37, 38, 39, 40, 41, 44, 50, 51, 52,  
 100, 101 and 102

Reg. No. 2,184,128

United States Patent and Trademark Office Registered Aug. 25, 1998

TRADEMARK  
 SERVICE MARK  
 PRINCIPAL REGISTER



TIFFANY AND COMPANY (NEW YORK CO.  
 REGISTRATION)  
 37 FIFTH AVENUE  
 NEW YORK, NY 10022

FIRST USE 0-0-1987, IN COMMERCE  
 0-0-1987  
 FOR: TABLEWARE, NAMELY, KNIVES,  
 FORKS AND SPOONS, POCKET KNIVES, NEED-  
 LES, AND RAZORS, IN CLASS 8 (U.S. CLS. 23,  
 24 AND 44)

FOR: FRAGRANCE PRODUCTS, NAMELY,  
 PERFUME, COLONDS, TOILET WATERS,  
 TOILET SOAP, BABY POWDER, BODY  
 CREAM, BATH GEL, SHOWER GEL, BODY  
 LOTION AND PERSONAL DEODORANT, IN  
 CLASS 3 (U.S. CLS. 1, 4, 6, 30, 31 AND 32)

FIRST USE 0-0-1993, IN COMMERCE  
 0-0-1993  
 FOR: JEWELRY, WATCHES AND CLOCKS,  
 PRECIOUS AND SEMI-PRECIOUS STONES,  
 DECORATIVE ART OBJECTS MADE IN

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United States of America  
 United States Patent and Trademark Office



Reg. No. 4,000,067

Registered July 26, 2011

Int. Cls.: 3, 14, 18, 25  
 and 35

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

HERDIS INTERNATIONAL (FRANCE SOCIETE EN COMMANDITE PAR ACTIONS)  
 12 RUE DE CALVADOS SAINT GERVAISE  
 PARIS, FRANCE 75008

FIRST USE 0-0-1999, IN COMMERCE 0-0-1996  
 FOR: BOTTLES, SHOPS, TOILET WATER, SHOWER GEL, SHOWER CREAM, BODY  
 LOTIONS, DEODORANTS FOR PERSONAL USE, IN CLASS 3 (U.S. CLS. 1, 4, 6, 30, 31 AND  
 32)

FIRST USE 0-0-1979, IN COMMERCE 0-0-1966  
 FOR: BIRTHDAY CLOCKS AND WATCHES, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 30)

FIRST USE 0-0-1979, IN COMMERCE 0-0-1966  
 FOR: HANDBAGS, WALLET AND LUGGAGE, IN CLASS 18 (U.S. CLS. 1, 2, 11, 22 AND 41)

FIRST USE 0-0-1979, IN COMMERCE 0-0-1966  
 FOR: CLOTHING, NAMELY, SHIRTS, HATS, CAPS, SCARVES, SHOES, GLOVES, TIES  
 AND BELTS, IN CLASS 25 (U.S. CLS. 23 AND 39)

FIRST USE 0-0-1979, IN COMMERCE 0-0-1966  
 FOR: RETAIL STORE FEATURING CLOTHING, NAMELY, SHIRTS, HATS, CAPS, SCARVES,  
 SHOES, GLOVES, TIES, BELTS AND OTHER RETAIL STORE SERVICES FEATURING  
 JEWELRY, WATCHES, CLOTHING, FASHION ACCESSORIES, PERSONAL CARE  
 PRODUCTS, BABY PRODUCTS AND TOYS, GAMES AND TOYS, BOOKS, AUDIO RECORDS,  
 TRAVEL MARKS AND ACCESSORIES, PAPER PRODUCTS, MONEY CLIPS OF COMMON  
 METAL, CUTTING AND PREPARING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102)

FIRST USE 0-0-1979, IN COMMERCE 0-0-1973  
 FOR: THE MARK CONSISTS OF THIS SHADE OF THE COLOR ORANGE, WHICH IS APPLIED  
 TO THE EXTERIOR OF METAL (SHINY) BOTTLES FOR THE GOODS AND SERVICES CONNec-  
 TION WITH THE SERVICES, THE DOTTED LINES OF THE MARK INDICATE THAT  
 THE MARK IS NOT BEING CLAIMED AS PART OF THE MARK AND THAT THE DOTTED  
 LINES ARE USED MERELY TO SHOW PLACEMENT OF THE MARK.



David J. Kappas

THE COLOR ORANGE IS NOT CLAIMED AS A FEATURE OF THE MARK.

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United States of America  
United States Patent and Trademark Office



Reg. No. 3,936,105 HERMES INTERNATIONAL (FRANCE SOCIÉTÉ EN COMMANDITE PAR ACTIONS)  
24 RUE DE LA FAUCONNERIE MONT HIRIBORD  
F-75008 PARIS, FRANCE

Int. Cl.: 18 FOR: HANDBAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41)

TRADEMARK FIRST USE 6-6-1986; IN COMMERCE 6-6-1986.

PRINCIPAL REGISTER OWNER OF U.S. REG. NOS. 1,806,107 AND 2,847,192.

THE MARK CONSISTS OF THE CONFIGURATION OF A HANDBAG HAVING RECTANGULAR SIDES A RECTANGULAR BOTTOM AND A TRAPEZOIDAL TRIANGULAR FRONT; THE TOP OF THE BAG CONSISTS OF A RECTANGULAR FLAP HAVING THREE PROTRUDING LINES BETWEEN WHICH ARE TWO KEYHOLE-SHAPED OPENINGS THAT SURROUND THE BASE OF THE HANDLES; OVER THE FLAP IS A HORIZONTAL RECTANGULAR STRAP HAVING AN OPENING TO RECEIVE A PADLOCK EYE; A LOCK IN THE SHAPE OF A PADLOCK FORMS THE CLASP FOR THE BAG AT THE CENTER OF THE STRAP; THE BROKEN LINES IN THE DRAWING REPRESENT THE LOCATION OF THE HANDLES AND ARE NOT PART OF THE MARK.

SEC. 2(f)

SER. NO. 76-70,120, FILED 10-28-2009.

LEF MARTIN, EXAMINING ATTORNEY



David J. Kappas  
Attorney of the United States Patent and Trademark Office

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United States of America  
United States Patent and Trademark Office



Reg. No. 4,197,020 CARTIER INTERNATIONAL S.A. (SWITZERLAND CORPORATION)  
BUNDESTRASSE 22, POSTFACH 14  
3112 STEINHAUSEN, SWITZERLAND

Int. Cls.: 14 and 35 FOR: JEWELRY AND WATCHES, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 56)

TRADEMARK FIRST USE 2-6-1977; IN COMMERCE 2-6-1977.

SERVICE MARK FOR: RETAIL STORE SERVICES FEATURING JEWELRY AND WATCHES, ONLINE RETAIL STORE SERVICES FEATURING JEWELRY AND WATCHES, IN CLASS 35 (U.S. CLS. 396, 401 AND 402)

PRINCIPAL REGISTER FIRST USE 2-6-1977; IN COMMERCE 2-6-1977.

THE MARK CONSISTS OF THREE-DIMENSIONAL PRODUCT PACKAGING COMPOSED OF AN ASSEMBLY BOX AND LID IN THE COLOR RED WITH GOLD MARKINGS. THE FOUR CORNERS OF THE BOX ARE CHAMFERED. THE TOP HORIZONTAL EDGE OF THE LID IS COMPLEMENTED WITH A SERIES OF EQUALLY SPACED GOLD ANDS IN THE COLOR GOLD. A GOLD LINE GOES AROUND THE PERIMETER OF THE LID. THE VERTICAL SIDES OF THE PACKAGING FEATURE A GOLD HORIZONTAL CHANNEL-LIKE PATTERN, POSITIONED ON THE UPPER SIDES OF THE LID AND THE LOWER SIDES OF THE BOX. THE VERTICAL SIDES OF THE PACKAGING ALSO FEATURE A LINE OF GOLD DOTS ON THE LOWER SIDES OF THE LID AND THE UPPER SIDES OF THE BOX. THE COLORS RED AND GOLD ARE CLAIMED AS FEATURES OF THE MARK. THE PROPORTIONAL RELATIONSHIP BETWEEN THE WIDTH, HEIGHT, AND DEPTH IS NOT A FEATURE OF THE MARK, AND THE PROPORTIONAL RELATIONSHIP BETWEEN THE HEIGHT OF THE LID AND DEPTH OF THE BOX IS NOT A FEATURE OF THE MARK. THE PROPORTIONAL RELATIONSHIPS ARE SHOWN IN BROKEN OR DOTTED LINES, WHICH INDICATE THAT THEY ARE NOT A PART OF THE MARK.

SEC. 2(f)

SER. NO. 46-30,806, FILED 7-12-2011.

SEAN CROWLEY, EXAMINING ATTORNEY



David J. Kappas  
Attorney of the United States Patent and Trademark Office

64

United States of America  
United States Patent and Trademark Office



Reg. No. 4,487,142 CARTIER INTERNATIONAL A.G. (SWITZERLAND CORPORATION)  
Registered Feb. 25, 2014 HENTZBERGSTRASSE 22, POSTFACH 61  
4022 STENNINGEN, SWITZERLAND

Int. Cl.: 14 FOR WATCHES, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50)

FIRST USE: 4-6-2007; IN COMMERCE: 4-6-2007

**TRADEMARK**  
**PRINCIPAL REGISTER** THE MARK CONSISTS OF A THREE-DIMENSIONAL CONFIGURATION OF A PORTION OF A WATCH CASE WITH AN INTEGRATED CROWN PROTECTOR, WINDING CROWN, AND CROWN-OPERATOR; THE BROKEN LINES IN THE MARK INDICATE PLACEMENT AND ARE NOT PART OF THE MARK.

SEC. 2(f)

SER. NO. 85-788,589, FILED 11-27-2012

ELLEN PERKINS, EXAMINING ATTORNEY



Michelle K. Lee  
Deputy Director of the United States  
Patent and Trademark Office



65

Int. Cl.: 14

Prior U.S. Cls.: 2, 27, 28 and 50

United States Patent and Trademark Office

Reg. No. 3,282,846

Registered Aug. 21, 2007

**TRADEMARK**  
**PRINCIPAL REGISTER**



CARTIER INTERNATIONAL N.V. (NETHERLAND ANTEILS COMPANY)  
CORVAACH, NETHERLAND ANTEILS

FOR HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS, NAMELY, WATCHES, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50)

FIRST USE: 6-15-1996; IN COMMERCE: 6-15-1996

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE REPRESENTATION OF THE NUMBER 12 OF THE WATCH HANDS, APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF A CONFIGURATION OF A WATCH CASE WITH A SQUARE FACE. THE CASE FRAMING THE WATCH CONSISTS OF THIN, HORIZONTAL BRANCAARDS AND THICK, TONGUE-SHAPE VERTICAL BRANCAARDS, BOTH FORMED OF THE CASE METAL AT EACH CORNER. THE VERTICAL BRANCAARDS ARE ELONGATED BEYOND THE BOTTOM AND TOP OF THE WATCH

CASE, AND END IN INWARDLY ANGLED CORNERS. THE VERTICAL BRANCAARDS ARE BEVELLED TO SLOPE DOWNWARD LATERALLY FROM THE INSIDE TO THE OUTSIDE. THEY ARE SOMETIMES DECORATED WITH JEWELS. THE ELONGATED BRANCAARD CORNERS FRAME THE END LINES IN THE BRACELET CHAIN OR THE END OF THE WATCH STRAP. ART DECO ROMAN NUMERALS INCLINE CONFORM TO THE ANGLE DIRECTION OF THE WATCH HANDS AT SUCH TIME AS THE HANDS ARE Juxtaposed TO THAT NUMERAL. AN OCTAGONAL WINDING CROWN WITH CABOCHON, AND A CHAPTER RING-MINUTE GUIDE ON THE WATCH FACE LOCATED BETWEEN THE CENTER OF THE DIAL AND THE NUMERALS.

SEC. 2(f)

SER. NO. 78-033,190, FILED 4-4-2006

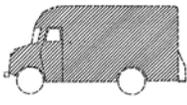
ERNEST SHOEN, EXAMINING ATTORNEY



66

Int. Cl.: 39  
 Prior U.S. Cls.: 100 and 105  
 United States Patent and Trademark Office  
 Reg. No. 2,131,693  
 Registered Jan. 27, 1998

SERVICE MARK  
 PRINCIPAL REGISTER



UNITED PARCEL SERVICE OF AMERICA, INC. (DELAWARE CORPORATION)  
 55 GLENLAKE PARKWAY, NE  
 ATLANTA, GA 30328

FOR MOTOR VEHICLE TRANSPORTATION AND DELIVERY OF PERSONAL PROPERTY, IN CLASS 39 (U.S. CLS. 100 AND 105). FIRST USE 0-0-1917, IN COMMERCE 0-0-1917.

THE DRAWING IS LINED FOR THE COLOR BROWN.  
 THE MARK CONSISTS OF THE COLOR BROWN APPLIED TO THE VEHICLES USED IN PERFORMING THE SERVICES.  
 SEC. 207.

SER. NO. 75-009,313, FILED 12-26-1995.  
 TERESA M. RUPP, EXAMINING ATTORNEY

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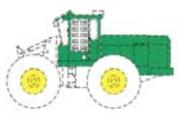


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67

United States of America  
 United States Patent and Trademark Office




Reg. No. 4,084,102  
 Registered Jan. 10, 2012  
 Int. Cl.: 7  
 TRADEMARK  
 PRINCIPAL REGISTER

DEERE & COMPANY (DELAWARE CORPORATION)  
 GLOBAL INTELLECTUAL PROPERTY SERVICES  
 ONE JOHN DEERE PLACE  
 Moline, IL 61201

FOR: FORESTRY MACHINES, NAMELY: FELLER BUNCHERS, SKIDDERS, HARVESTERS AND FORWARDERS, KNICKLEBOOM LOADERS, IN CLASS 7 (U.S. CLS. 13, 14, 21, 23, 31, 34 AND 35). FIRST USE 12-31-2009; IN COMMERCE 12-31-2005.

OWNER OF U.S. REG. NOS. 1,254,019, 1,303,576, AND 1,372,124.

THE COLORS GREEN AND YELLOW (AS CLAIMED AS A FEATURE OF THE MARK). THE MARK CONSISTS OF THE COLOR COMBINATION GREEN AND YELLOW IN WHICH GREEN IS APPLIED TO AN EXTERIOR SURFACE OF THE MACHINE, AND YELLOW IS APPLIED TO THE WHEELS. THE BROWN LINE OUTLINING IS TO SHOW THE POSITION OF PLACEMENT OF THE MARK ON THE GOODS. THE OUTLINING AND THE SHAPE OF THE MACHINE ARE NOT CLAIMED AS PART OF THE MARK.  
 SEC. 207.

SER. NO. 85-80,306, FILED 8-22-2011.  
 LINDA ESTRADA, EXAMINING ATTORNEY

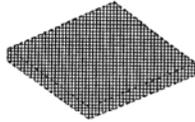


David J. Kappas  
 Director of the United States Patent and Trademark Office

68

Int. Cl.: 16  
 Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50  
 United States Patent and Trademark Office  
 Reg. No. 2,390,667  
 Registered Oct. 3, 2000

TRADEMARK  
 PRINCIPAL REGISTER



MINNESOTA MINING AND MANUFACTURING  
 COMPANY (DELAWARE CORPORATION), AKA  
 3M  
 3M CENTER  
 SAINT PAUL, MN 551441000

THE MARK IS LINED FOR CANARY YELLOW,  
 AND THE APPLICANT CLAIMS COLOR AS THE  
 MARK.  
 THE MARK CONSISTS OF THE COLOR CANARY  
 YELLOW USED OVER THE ENTIRE SURFACE OF  
 THE GOODS. THE MATTER SHOWN IN BROKEN  
 LINES SHOWS THE POSITION OF THE MARK AND  
 IS NOT CLAIMED AS PART OF THE MARK.

FOR: STATIONERY NOTES CONTAINING ADHESIVE  
 ON ONE SIDE FOR ATTACHMENT TO SUR-  
 FACES, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29,  
 37, 38 AND 50).

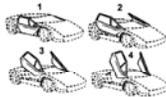
SER. NO. 75-087,575, FILED 4-5-1996.  
 TERESA M. RUPP, EXAMINING ATTORNEY

FIRST USE 0-0-1978; IN COMMERCE 0-0-1978.

69

Int. Cl.: 12  
 Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44  
 United States Patent and Trademark Office  
 Reg. No. 2,793,439  
 Registered Dec. 16, 2003

TRADEMARK  
 PRINCIPAL REGISTER



AUTOMOBILE LAMBORGHINI HOLDING S.P.A.  
 (ITALY CORPORATION)  
 VIA MODENA, L.B.  
 40019 SAINT AGATA BOLOGNESE  
 BOLOGNA, ITALY

THE MARK CONSISTS OF THE UNIQUE MOTION  
 IN WHICH THE DOOR OF A VEHICLE IS  
 OPENED. THE DOORS MOVE PARALLEL TO THE  
 BODY OF THE VEHICLE BUT ARE GRADUALLY  
 RAISED ABOVE THE VEHICLE TO A PARALLEL  
 POSITION.

FOR: AUTOMOBILES, IN CLASS 12 (U.S. CLS. 19,  
 21, 23, 31, 35 AND 44).

SEC. 2(P).  
 SER. NO. 75-483,661, FILED 12-28-1999.

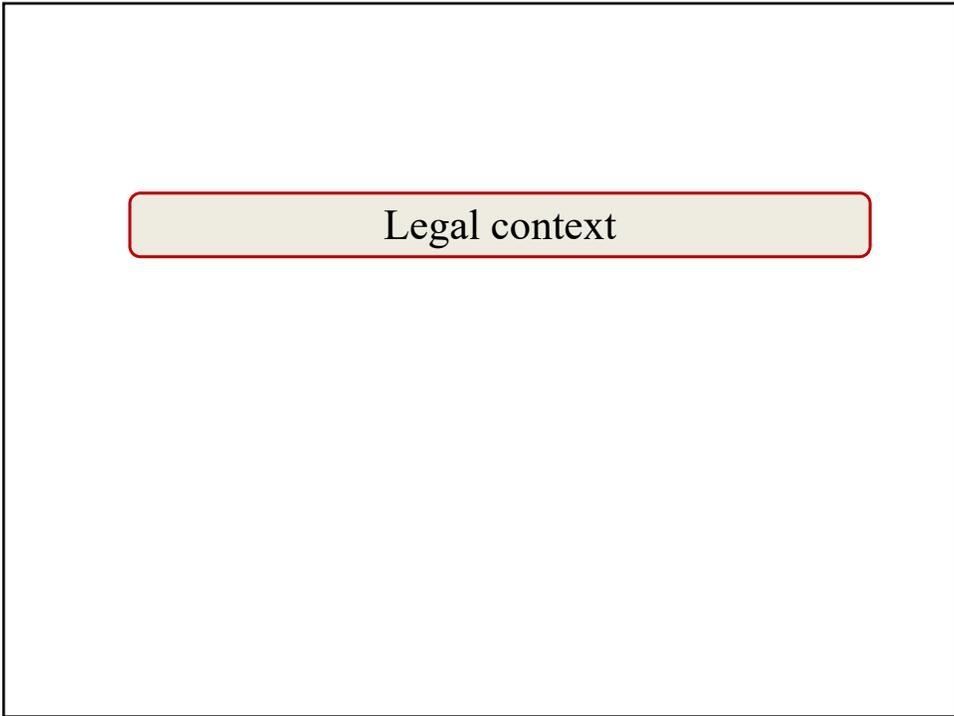
FIRST USE 0-0-1980; IN COMMERCE 0-0-1980.

VIVIAN MICZNIK FIRST, EXAMINING ATTORNEY

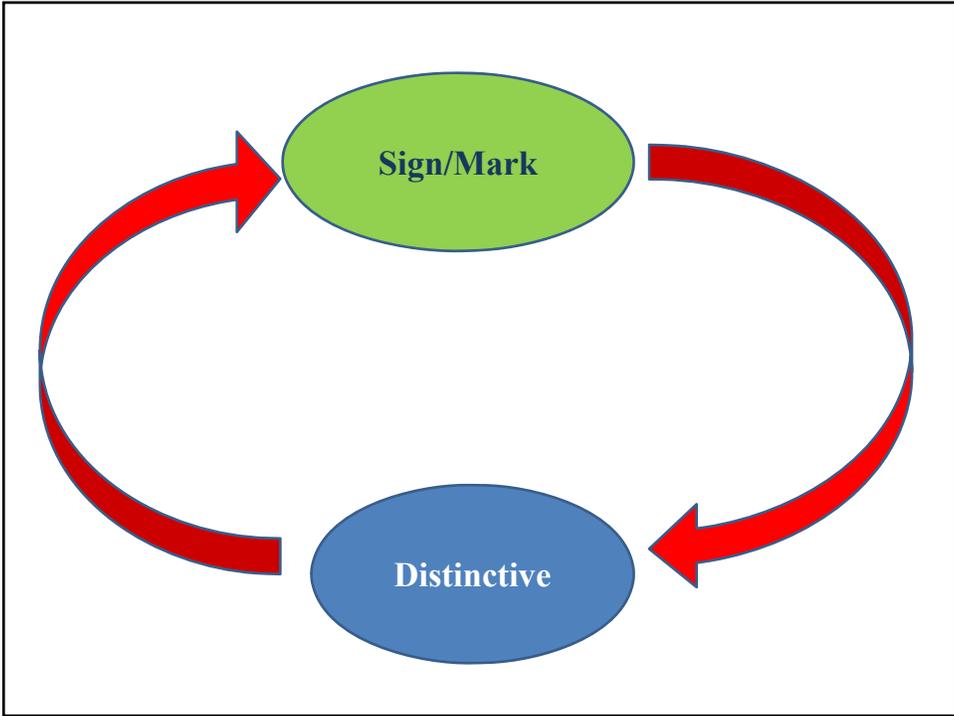
THE MATTER SHOWN IN DOTTED LINES IS  
 NOT PART OF THE MARK.



70



71



72

- Almost anything is capable of registration and protection if the trademark or trade dress is **distinctive, not functional**, and the **markholder has priority based on use or registration**
  - Words, including descriptive words and popular phrases
  - Names, including the names of historical figures
  - Symbols
  - Colors, including single colors
  - Product packaging
  - Product configurations
  - Retail store designs and restaurant décor
  - Look and feel of a website
  - Other non-traditional marks such as sounds, scents, tastes, textures, holograms, and movements
  - Artistic works currently or formerly protected by copyright
  - Designs currently or formerly protected by patent

73



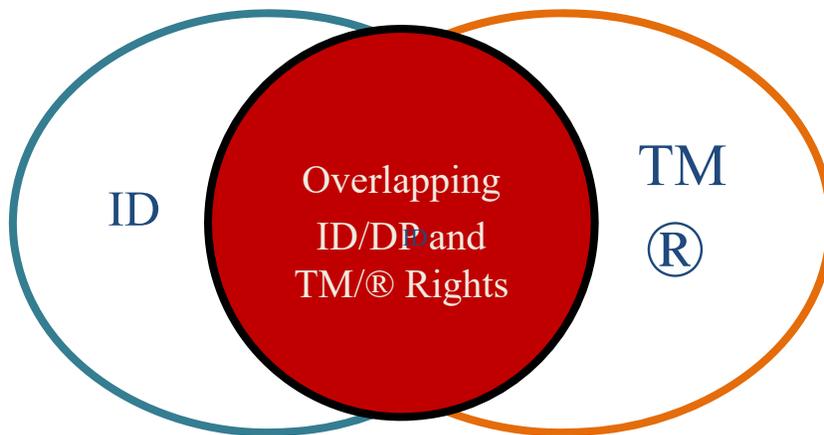
74

Potentially perpetually protection (as long as product in “some” use)

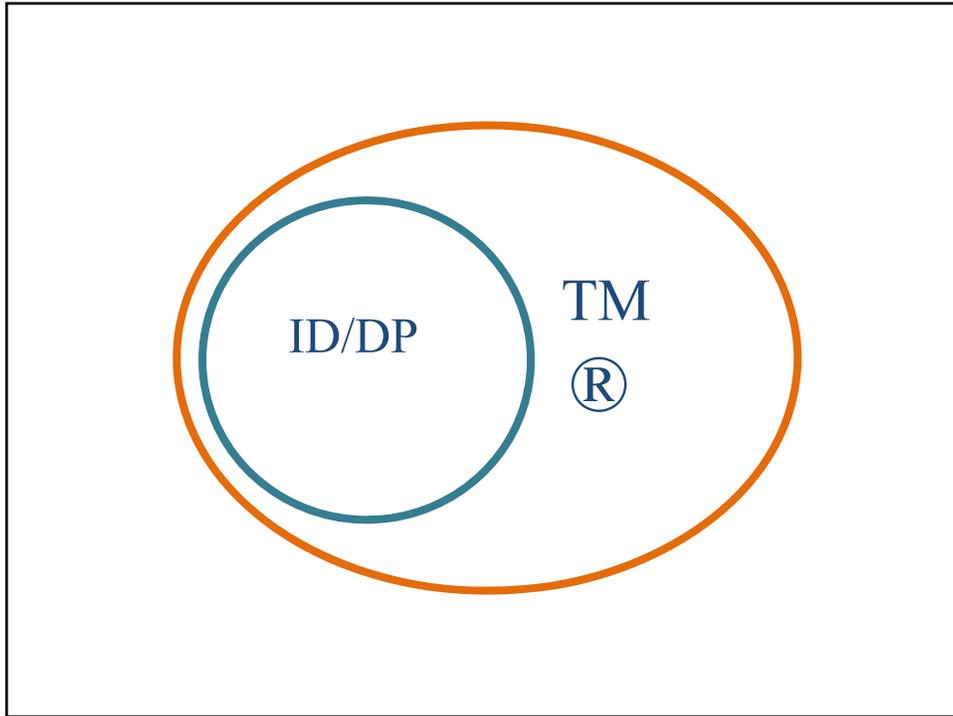
Low costs of registration (protection also for unregistered marks based on use)

Malleable tool instead of, or in addition to, other forms of IP protection

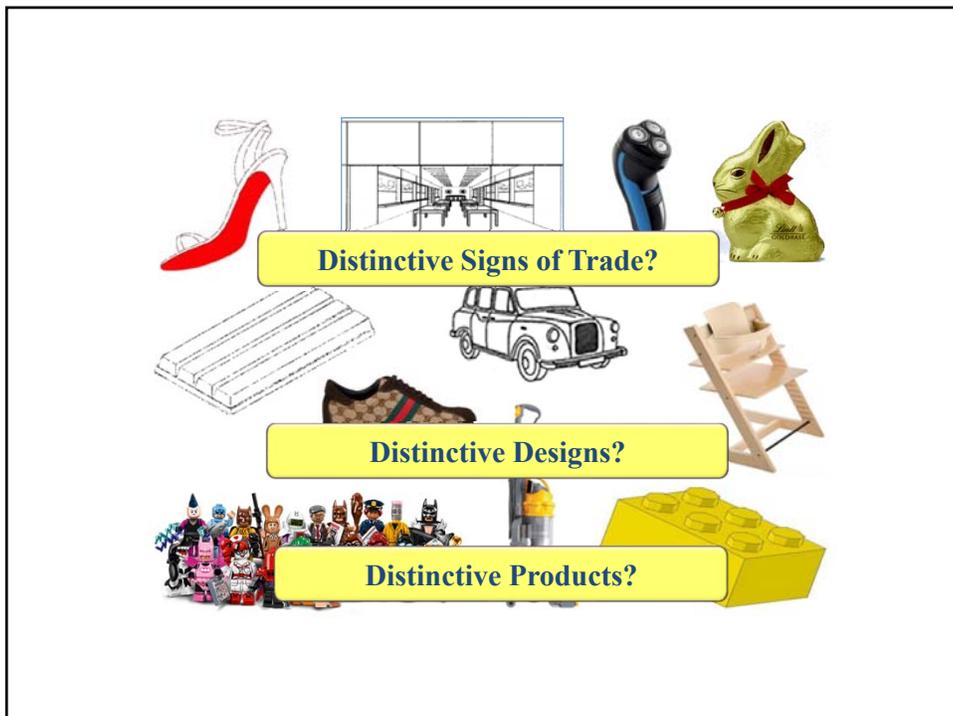
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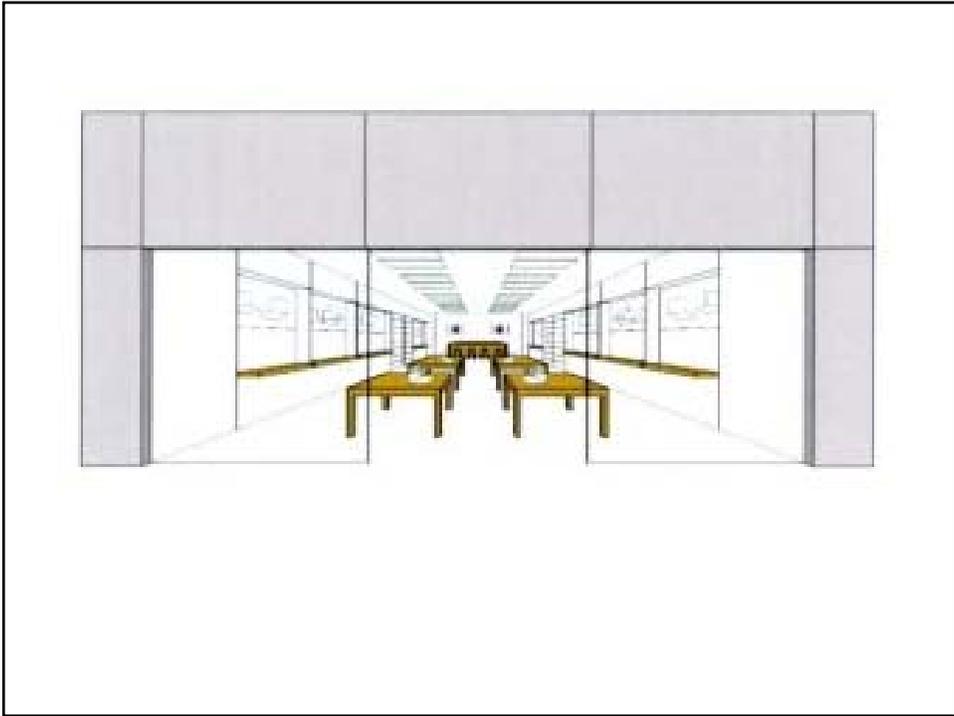
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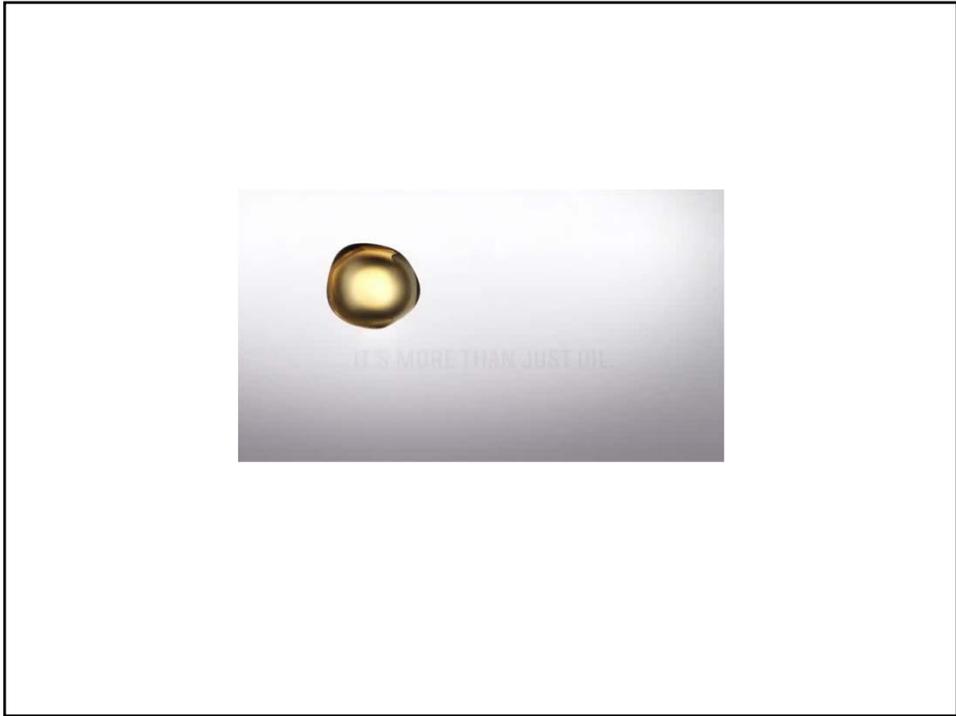
79



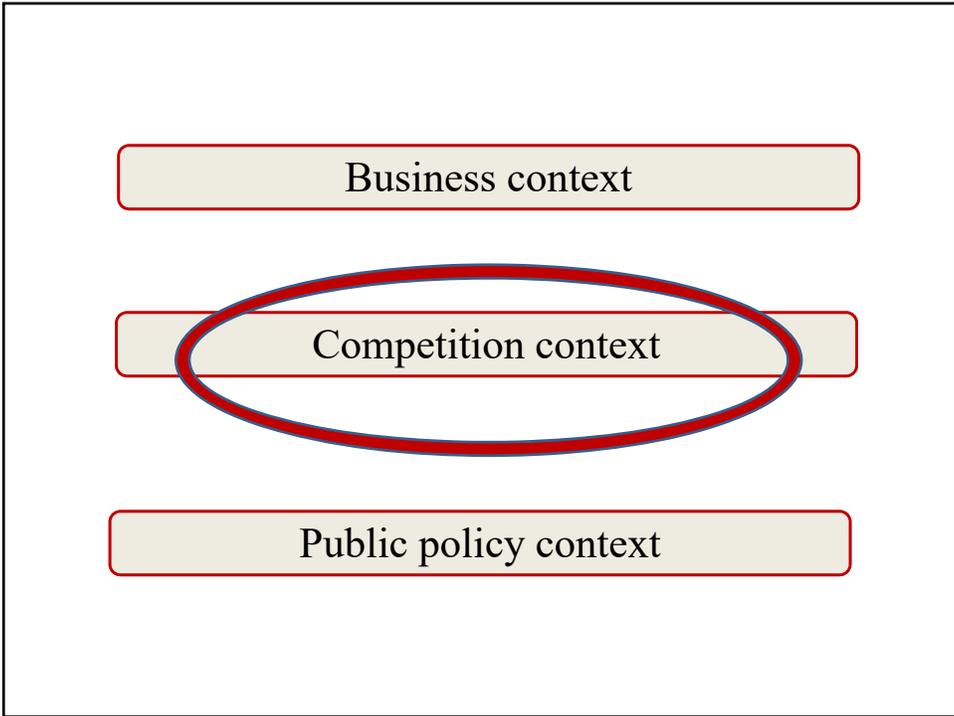
80



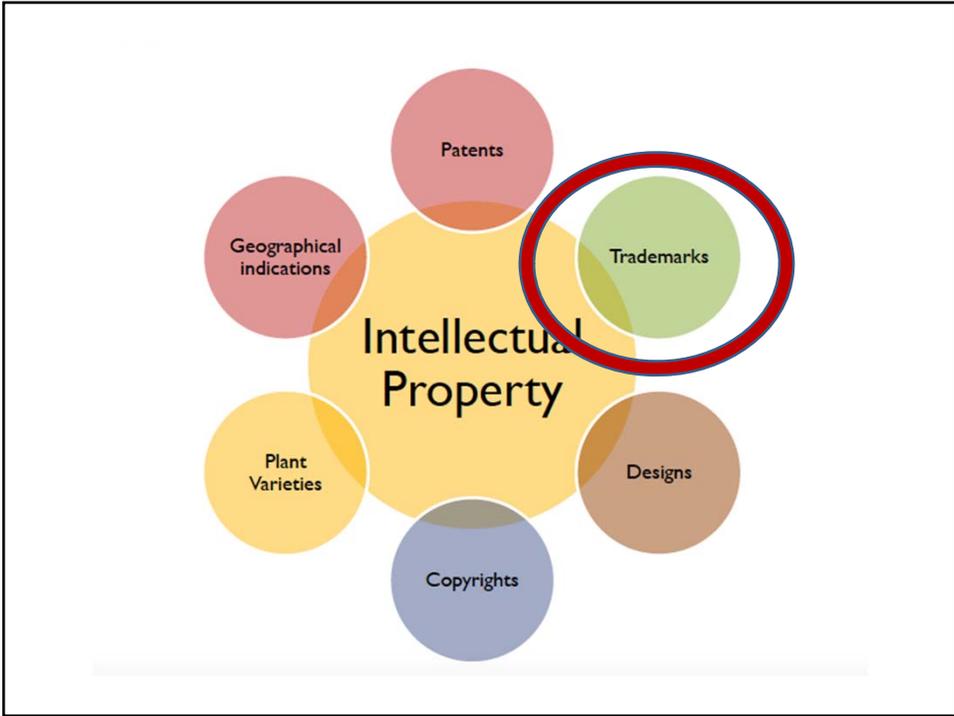
81



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84

## Competition context

Non-traditional trademarks may create undesired monopolies on functional/ aesthetic product features

Are non-traditional marks in line with the public policy at the basis of the trademark system?

85



86

ABOUT DW DW.R

**DW**

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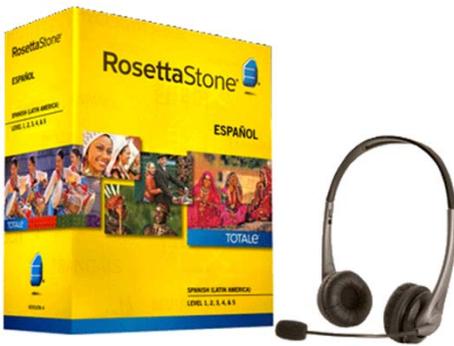
GERMANY WORLD BUSINESS SCI-TECH ENVIRONMENT CULTURE SPORTS

TOP STORIES BUSINESS

LITIGATION

### Rosetta Stone loses claim to yellow in court

A German court has ruled that the color yellow can be protected as a trademark. But it must be widely associated with a specific company. The case highlights just how important color alone can be for company branding.

PICTURED: ROSETTA STONE V4 SPANISH AND OPTIONAL HEADSET

Germany's top administrative court on Thursday rejected a claim by US software publisher Rosetta Stone to veto dictionary publisher *Langenscheidt's* exclusive registration of the color yellow as a trademark. Langenscheidt is a Munich-based publisher of yellow-bound bilingual dictionaries and other language-learning aids used by students of German in many nations.

*Rosetta Stone*, which sells language-learning software in yellow cartons, was appealing an earlier verdict banning it from using yellow. Germany's federal high court has ruled last year that confused buyers wanting Langenscheidt products, might accidentally purchase Rosetta Stone's yellow-bound

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the guardian

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business economics sustainable business diversity & equality in business small business

Cadbury

## Cadbury's attempt to trademark Dairy Milk purple blocked

Appeal court rules usage of colour was not specific enough and would give Cadbury unfair competitive advantage

Ben Bowcott, legal affairs correspondent  
@owenbowcott  
May 4 October 2013 09:42 EDT

Shares: 0

Save for Later

Cadbury commissioned a dress made of 1,000 Dairy Milk wrappers to celebrate the colour - Pantone 2685C - at London fashion week. Photograph: Advert

Cadbury has lost a five-year court battle to register a distinctive shade of purple as a trademark for its chocolate bars.

Lawyers for rival Nestlé managed to overturn a previous judgment that would have prevented other manufacturers from wrapping their products in the same Dairy Milk tone.

The row revolved around a specific shade of purple - defined as Pantone 2685C - which the Birmingham-based manufacturer maintains it has used since the first

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Nestlé

## KitKat goes unprotected as European court rejects trademark case

Nestlé failed to convince European court of justice that four-fingered version of its chocolate bar should be protected by law

Sean Farrell

Wednesday 16 September 2015 10:28 EDT

1,082 Shares 211 Comments

Save for later



Nestlé argued that even without its red and white packaging the shape of the four-fingered KitKat should be regarded as distinct. Photograph: Roger Tooth for the Guardian

Nestlé has failed in an attempt to convince European judges to let it trademark the shape of the four-finger version of a KitKat in the UK.

The European court of justice ruled that the KitKat's shape was not distinctive enough for consumers to associate it with the chocolate covered wafer. Nestlé is not seeking to trademark its two-finger version of KitKat.

Nestlé had argued that even without its red and white packaging or the word KitKat embossed on the chocolate, the shape of the bar should be regarded as distinct.

The dispute between Nestlé and Cadbury, which has fought to prevent Nestlé

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91

## Court of Appeal confirms London Taxi Company's trade mark for the shape of the "black cab" is invalid

Gowling WLG



United Kingdom November 16 2017

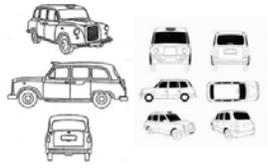
The trade marked three-dimensional shape of the traditional London taxi has been found invalid by the Court of Appeal of England and Wales.

The London Taxi Company (LTC), successor in title to the manufacturer of various London taxi models, sued Ecotive and Frazer Nash Research Limited (FNR) for trade mark infringement and passing off based on goodwill in the shapes of the Fairway, TX1, TXII and TX4 London taxi models. Ecotive and FNR are the manufacturers of the "Metrocab", a new hybrid taxi.

Ecotive and FNR denied infringement and challenged the validity of the trade marks, contending that they lack distinctive character and consist exclusively of the shape giving substantial value to the goods.

**The Trade Marks**

On 5 October 1998, London Taxi Company ("LTC") registered a Community trade mark (as shown below on the left) for "motor vehicles" in Class 12, consisting of a three-dimensional mark influenced by the appearance of the Fairways taxi model. LTC also registered a UK trade mark based on the TXI and TXII taxi models on 1 December 2006, for taxis in class 12 (as shown below on the right).



The Defendants' Metrocab at the centre of the dispute is shown below:



92



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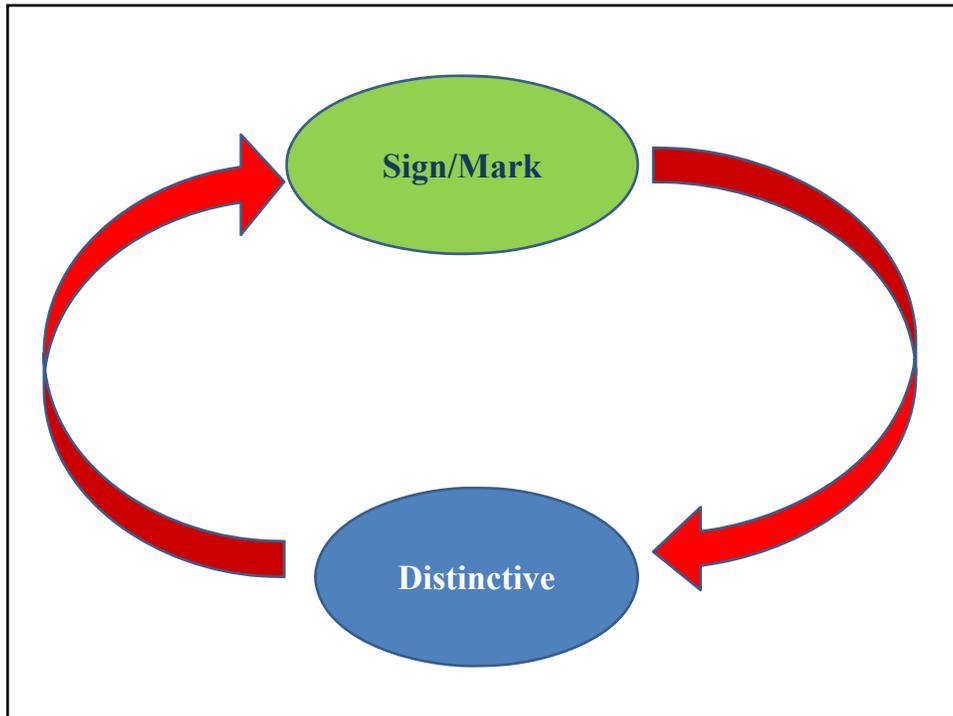
95



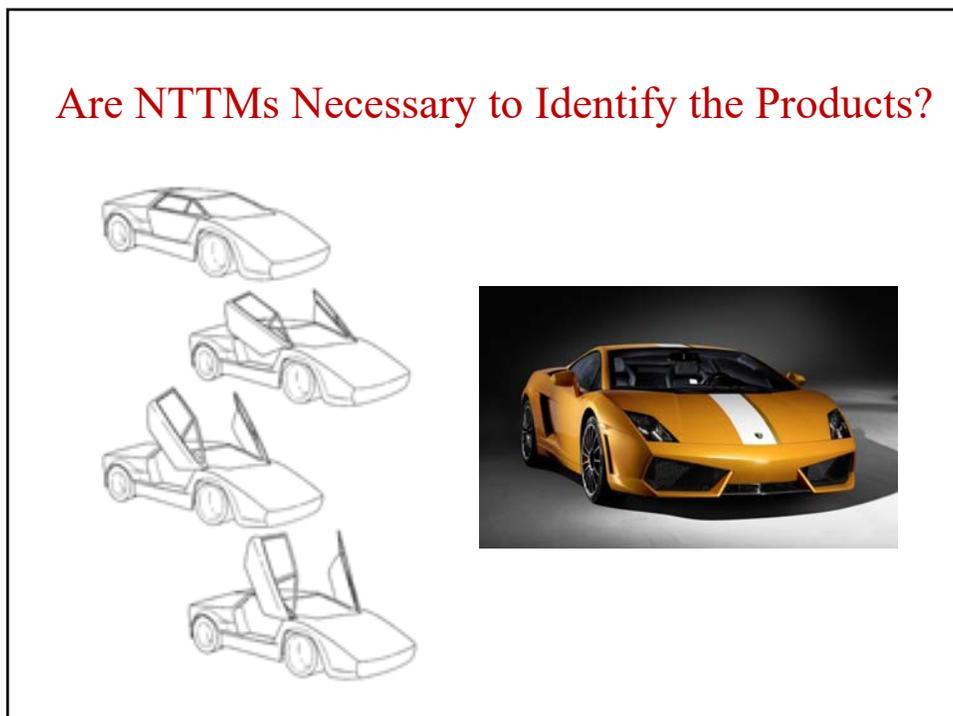
Are Non-Traditional Marks, marks in the “traditional” sense of the term “mark” as distinctive sign in the course of trade?



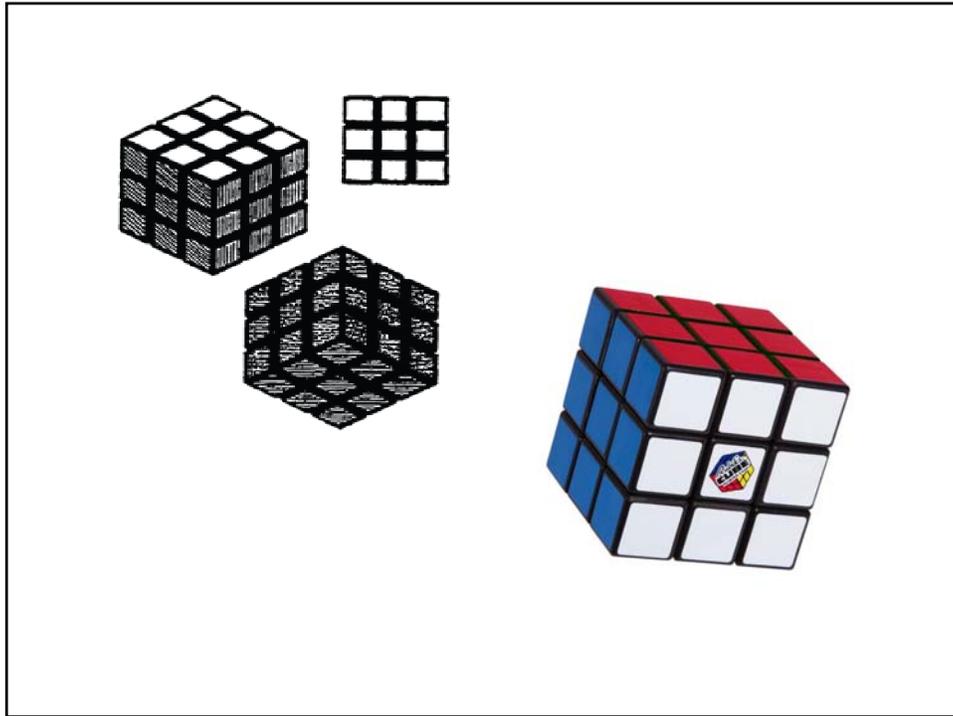
96



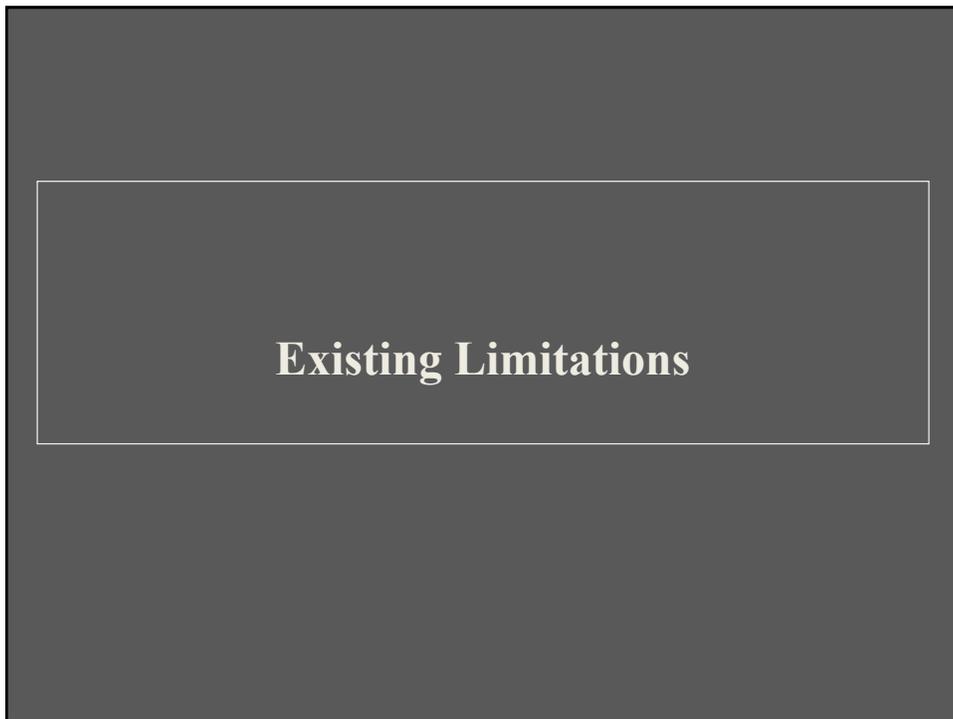
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100

## Absolute Grounds in the EU (art 4 TMD)

no registration for signs that comprise of a shape, or another characteristics

- Resulting from the nature of the goods



- That is necessary to obtain a technical result

  - Utilitarian functionality

- That gives substantial value to the goods

  - “A sort of” aesthetic functionality



101

## What Cannot Be a “Mark” in the US

- Lanham Act § 2(e)(5)
  - No trademark ... shall be refused registration ... unless it –
  - (e) Consists of a mark which, ... (5) **comprises any matter that, as a whole, is functional**
- BUT the Lanham Act does not define what is a “functional mark”
  - The interpretation of what is “functional” in the context of trademark rests primarily within the courts
- The doctrine of functionality started primarily as a judicial doctrine
  - Utilitarian Functionality
  - Aesthetic Functionality

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Are Non-Traditional Trademarks Aesthetically Functional?

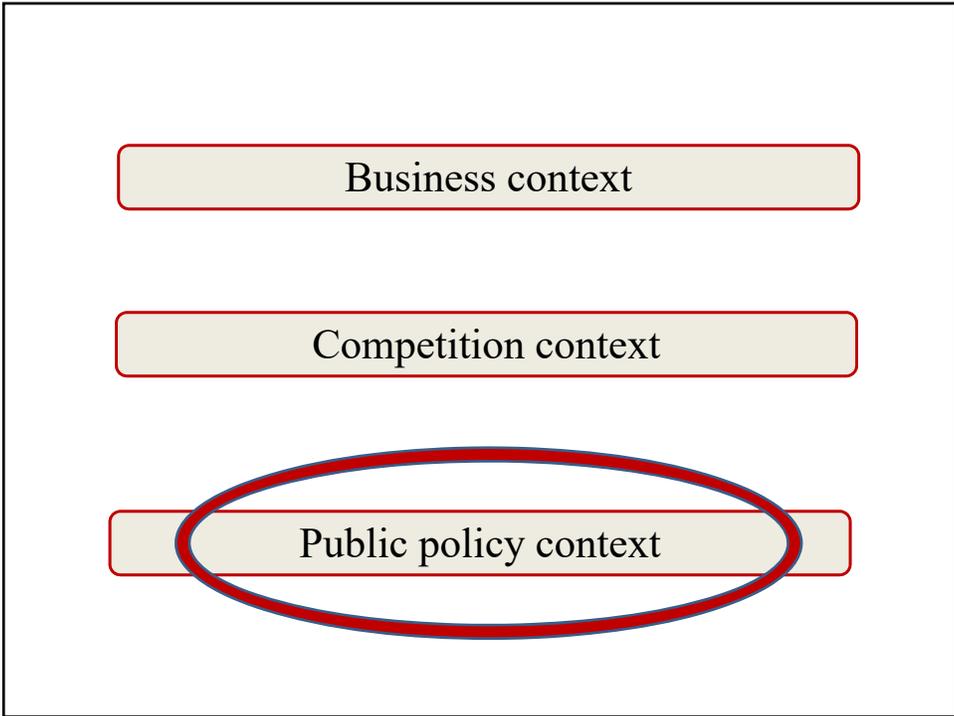
Are they essential to the use of the product?

Do they give substantial value to the products?

103



104



105



106



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 This image is identical to the one above, showing the Seretide Accuhaler and AirFluSal Forspiro inhalers.
 

Like the packaging for the Seretide Accuhaler, the AirFluSal Forspiro packaging is also purple and white. Glaxo was, it seems, displeased. Its trademark infringement action failed when GSK's EUTM for the colour purple was [revoked on summary judgment](#).

No passing off either

108

**United States of America**  
United States Patent and Trademark Office



Reg. No. 5,018,105  
Registered Aug. 09, 2016  
Int. Cl.: 5  
Trademark  
Principal Register

*Michelle R. Lee*  
Director of the United States  
Patent and Trademark Office

**EUIPO**  
EUROPEAN UNION INTELLECTUAL PROPERTY  
OFFICE  
**CERTIFICATE OF REGISTRATION**

Registered / Enregistré 02/01/2017  
No 015794688

OFFICE DE L'UNION EUROPÉENNE POUR LA  
PROPRIÉTÉ INTELLECTUELLE  
**CERTIFICAT D'ENREGISTREMENT**

The Executive Director / Le Directeur  
exécutif  
*António Campino*  
António Campino



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**United States of America**  
United States Patent and Trademark Office



Reg. No. 5,018,106  
Registered Aug. 09, 2016  
Int. Cl.: 5  
Trademark  
Principal Register

*Michelle R. Lee*  
Director of the United States  
Patent and Trademark Office

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EUROPEAN UNION INTELLECTUAL PROPERTY  
OFFICE  
**CERTIFICATE OF REGISTRATION**

Registered / Enregistré 20/02/2017  
No 015794671

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**CERTIFICAT D'ENREGISTREMENT**

The Executive Director / Le Directeur  
exécutif  
*António Campino*  
António Campino



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Droits - Droits de l'Union Européenne de Marque de l'Union Européenne  
Droits - Droits des États-Unis d'Amérique de l'Union Européenne

**CERTIFICAT D'ENREGISTREMENT**

Le présent certificat d'enregistrement est délivré pour le usage commercial des produits et services, les mentions de la marque sont et il appartient au titulaire de signer les marques correspondantes.

**CERTIFICATE OF REGISTRATION**

This Certificate of Registration is hereby issued to the Community mark which is hereby shown. The corresponding entries have been entered in the Register of Community Trade Marks.

N° 002226173



Conception/Registered 11/11/2007

Le Président/Le Président

N. de l'Etat

**I**

**Int. Cl.: 5**  
**Prior U.S. Chs: 6, 18, 44, 46, 51, and 52**

**Reg. No. 2,606,231**  
Registered Aug. 6, 2002

**United States Patent and Trademark Office**

**TRADEMARK SUPPLEMENTAL REGISTER**



SANDOZ/ENTRELABO (FRANCE) CORPORA-TION  
174 AVENUE DE FRANCE  
PARIS, FRANCE 75013

PRIORITY CLAIMED UNDER SEC. 405 OF FRANCE APPLICATION NO. 0608067, FILED 11-24-2006, SER. NO. 808067, EXCISED 11-20-2006

FOR: PHARMACEUTICAL PREPARATIONS, NAMES, PREPARATIONS FOR TREATMENT AND PREVENTION OF DENTAL, DERMATOLOGICAL AND INTERNAL MEDICINE CONDITIONS, DISEASES AND CONDITIONS, IN CLASS 1 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

SER. NO. 9184073, FILED P.R. 1-24-2006, AM. S.R. 10-26-2002.

LEIGH CAROLINE CAIRL, EXAMINING ATTORNEY

EUTM: live

US: Was registered but cancelled/invalidated and removed

111

US: Live

EUTM: Made 4-5 attempts, but application withdrawn



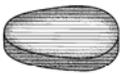
**I**

**Int. Cl.: 5**  
**Prior U.S. Chs: 6, 18, 44, 46, 51, and 52**

**Reg. No. 2,679,181**  
Registered Jan. 21, 2002

**United States Patent and Trademark Office**

**TRADEMARK SUPPLEMENTAL REGISTER**



GILEAD SCIENCES, INC. (DELAWARE COR-PORATION)  
333 LAKESIDE DRIVE  
FOSTER CITY, CA 94504

FOR: PHARMACEUTICAL PREPARATIONS FOR THE TREATMENT OF INFECTIOUS CONDITIONS, IN CLASS 1 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 2-22-2002, IN COMMERCE 2-22-2002.

THE DRAWING IS LINED FOR THE COLOR BLUE. THE STIPPLING ON THE DRAWING IS USED TO INDICATE SHADING AND IS NOT USED TO DENOTATE COLOR.

THE MARK CONSISTS IN PART OF THE CON-FIGURATION OF THE DOSE, CONSISTING OF A DOUGH TABLET IN AN ALMOND SHAPE, CHAR-ACTERIZED BY ONE END BEING NARROWER THAN THE OTHER, AND THE COLOR BLUE AS APPLIED TO THE ENTIRETY OF THE GOODS.

SER. NO. 3611328, FILED P.R. 8-28-2001, AM. S.R. 10-28-2002.

JENNIFER CHOCORL, EXAMINING ATTORNEY

US: Live

EUTM: Made 4-5 attempts, but application withdrawn

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- “The mark consists of a configuration of a medical device, namely, an inhaler with an overall rounded shape featuring an indented mouthpiece on the top with an overall semi-circular shape. The inhaler also features an exterior movable closure with three curved lines and an overall triangular shape, which rests towards the bottom and side of the inhaler when the inhaler is opened. The mark includes six curved lines on the side of the device. The counter box and vent at the center front of the inhaler and indented mouthpiece at the top are not claimed as a feature of the mark.”
- Owned by GlaxoSmithKline, US Registration No. 75977595, EU Registration No. 017652074




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**EUIPO**  
EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

OPERATIONS DEPARTMENT  
D112

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This is to certify that the attached document is an exact copy of the application for a European Union trade mark bearing the number and date of filing indicated below.

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Núm./Nr. / Num./n.	Fecha/Dateum. / Date/Date/Data
017652074	02/01/2018

Alocarte: 14/10/2019

*f. fall*

Karin KUHL

Departamento de Operaciones  
Heizstrahlung Kammerzell  
Operations Department  
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Application for a European Union trade mark



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Page 3 of 3

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NIM 017652074

Alicante, 14/10/2019

*f. fall*

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## United States of America

United States Patent and Trademark Office



Reg. No. 5,435,196  
Registered Mar. 27, 2018  
Int. Cl. 5  
Trademark  
Supplemental Register

Teva Respiratory, LLC (FLORIDA LIMITED LIABILITY COMPANY)  
41 Mason Road  
Parsippany, PENNSYLVANIA 19355

CLASS 5 Inhalers containing halocarbon propellants and adapted for the treatment of asthma  
FIRST USE 4-24-2017; IN COMMERCE 4-24-2017

The color(s) yellow and white is/are claimed as a feature of the mark.  
The mark consists of the colors yellow and white on the inhaler goods where the color yellow is located on the base of the inhaler and the color white is located on the upper portion of the inhaler. The dotted lines are intended to show the position of the mark and are not part of the mark as shown.  
SER. NO. 87-601309, FILED P.R. 09-11-2017, AM. S.R. 01-31-2018



Director of the United States  
Patent and Trademark Office



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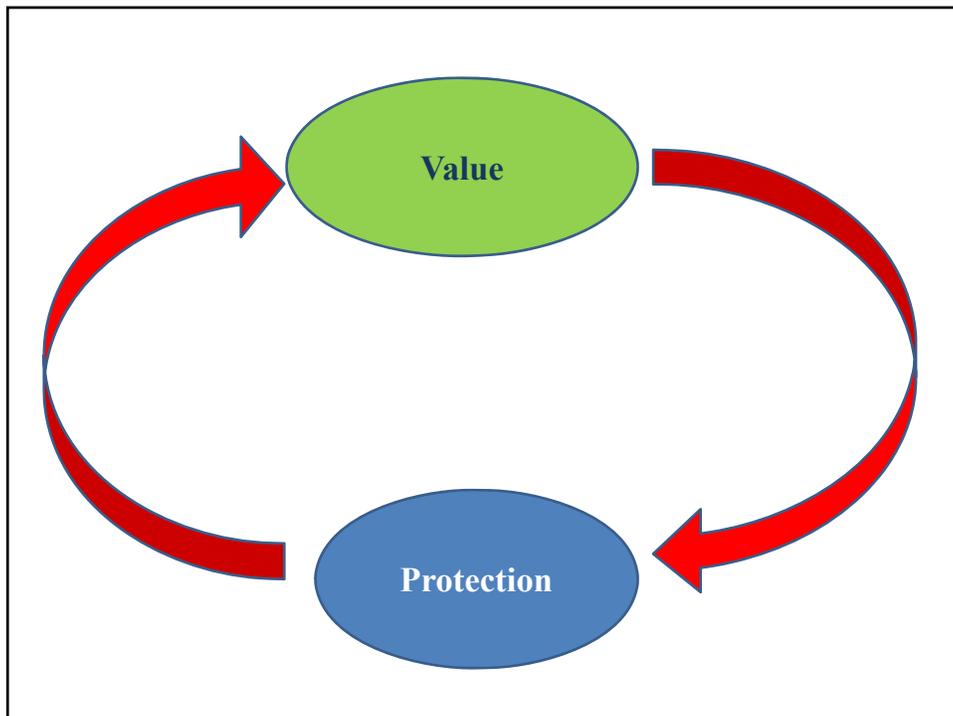
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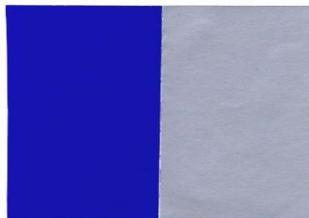
What role should IP Offices have in balancing the protection of non traditional trademarks with competition and public interest concerns?

What role should the courts have in balancing the protection of non traditional trademarks with competition and public interest concerns?

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## *Red Bull GmbH v. EUIPO*

- Two trademarks on the same color combination and specimen
- Mark 1 Description: Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%.
- Mark 2 Description: The two colours will be applied in equal proportion and juxtaposed to each other. Blue (Pantone 2747C), silver (Pantone 877C).



• [EUTM002524774](#)

&

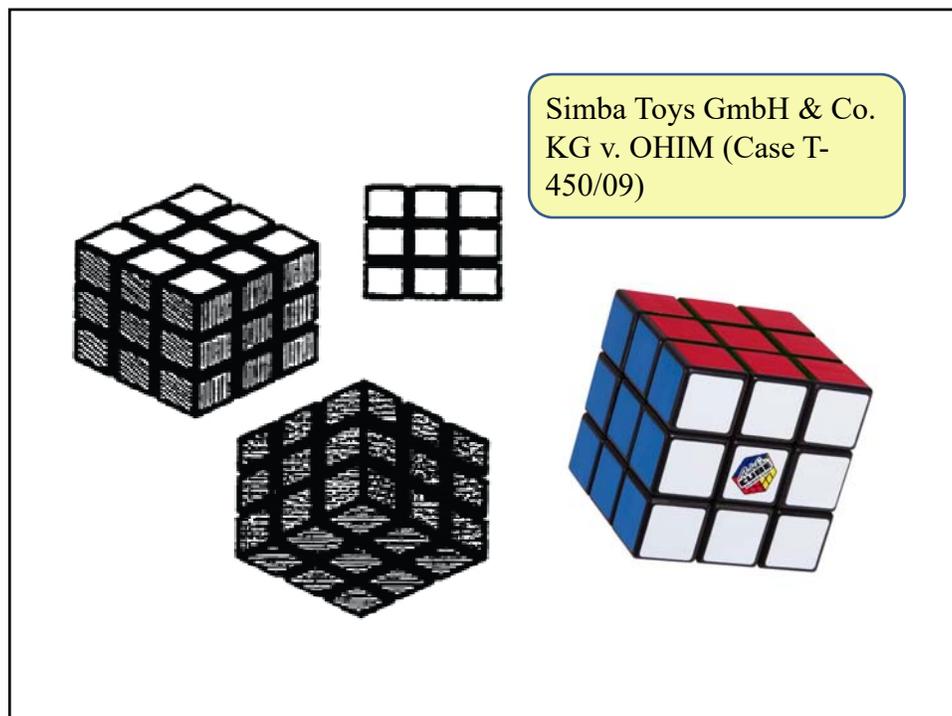
[EUTM009417668](#)

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## *Red Bull GmbH v. EUIPO*

- Both marks were held invalid—although it acquired distinctiveness in the EU, it failed to meet the requirements of a trademark for being too broad.
- Red Bull failed to meet their burden of providing third parties that are inspecting the mark that their sign was perceived “unambiguously, uniformly, and durably.”
- In laymans term, the description allowed numerous combinations and was too imprecise.
- Court used the standard that “constitute a systematic arrangement associating the colours in a predetermined and uniform way, producing a very different overall impression and preventing consumers from repeating with certainty a purchase experience.”

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## Simba Toys GmbH & Co. KG v EUIPO (Judgment in Case C-30/15 P)

- Simba Toys appealed to the Court of Justice
- In November 2016, the CJEU found that **the essential characteristics of the cubic shape must be assessed in the light of the technical function of the actual goods represented.**
- The General Court should have considered the non-visible elements of the graphic representation of the shape, such as the rotating capability of the three-dimensional 'Rubik's Cube'-type puzzle.
- The CJEU **annulled the EUIPO decision that confirmed registration of the shape in question as an EU trade mark.**
- It will be a matter for EUIPO to adopt a new decision taking into account the findings set out by the Court in the present judgment.



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US world opinion sports soccer tech arts lifestyle fashion business travel environment science

home business economics sustainable business diversity & equality in business small business

### KitKat goes unprotected as European court rejects trademark case

Nestlé failed to convince European court of justice that four-fingered version of its chocolate bar should be protected by law

Sean Farrell

Wednesday 16 September 2015 10:28 EDT

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Nestlé argued that even without its red and white packaging the shape of the four-fingered KitKat should be regarded as distinct. Photograph: Roger Tooth for the Guardian

Nestlé has failed in an attempt to convince European judges to let it trademark the shape of the four-finger version of a KitKat in the UK.

The European court of justice ruled that the KitKat's shape was not distinctive enough for consumers to associate it with the chocolate covered wafer. Nestlé is not seeking to trademark its two-fingered version of KitKat.

Nestlé had argued that even without its red and white packaging or the word KitKat embossed on the chocolate, the shape of the bar should be regarded as distinct.

The dispute between Nestlé and Cadbury, which has fought to prevent Nestlé

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Societe Des Produits Nestle SA and Another v. International Foodstuffs Co. and Others (100/2014), (2014 ZASCA 187); (2015 1 All SA 492 (SCA) (27 November 2014)



127



Societe Des Produits Nestle SA and another v. Petra Foods Ltd. and another (2014 SGHC 252)



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*Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012)



Christian  
*Louboutin*



YSL

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Christian  
*Louboutin*

ZARA



French Supreme Court, Commercial Chamber, Decision of 30 May 2012, *Christian Louboutin v. Zara France*.



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*Christian Louboutin v. Van Dalen Footwear BV* (Brussels Court of Appeal, 18 November 2014, 2014/AR/843)



Christian  
Louboutin

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Home / absolute grounds / CJEU / Louboutin C-163/16 / red sole mark / shapes / substantial value / trade marks / BREAKING: CJEU rules that Louboutin red sole mark does NOT fall within absolute ground for refusal

## BREAKING: CJEU rules that Louboutin red sole mark does NOT fall within absolute ground for refusal

▲ Eleonora Rosati Tuesday, June 12, 2018 - absolute grounds CJEU Louboutin C-163/16 red sole mark shapes substantial value trade marks

Is the Louboutin red sole mark a valid trade mark or not? At last - the moment all IP aficionados were waiting for has come!

The Court of Justice of the European Union (CJEU) has just issued its much-awaited judgment in *Louboutin C-163/16*, ruling that **a mark consisting of a colour applied to the sole of a shoe is NOT covered by the prohibition of the registration of shapes**. Such a mark does not consist 'exclusively of the shape'.

The question that the Rechtbank Den Haag referred to the CJEU was the following:

“ Is the notion of ‘shape’ within the meaning of Article 3(1)(e)(iii) of [the 2008 Trade Mark Directive, ie the absolute ground for refusal concerning signs consisting exclusively of “the shape which gives substantial value to the goods”] (“Form”, ‘vorm’ and ‘forme’ in the German, Dutch and French language versions of the Trade Marks Directive respectively) limited to the three dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non three-dimensional) properties of the goods, such as their colour? ”

As readers will remember, this case has featured: a **first Opinion** of Advocate General (AG) Szpunar **reported by The IPKat here**; the reopening of the oral procedure and the assignment of the case to the Grand Chamber, so that the CJEU would rule with a greater (13) number of Judges than the ordinary chamber procedure (3 or 5 Judges), on consideration of the topicality of the issues underlying this reference for a preliminary ruling; and a **second Opinion** of AG Szpunar **which has sparked some controversy regarding its actual interpretation: see Katpost here**.



The Louboutin mark

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\* Listed as "Top Legal Blog" in The Times Online, March 2011.

\* One of the only two non-US blogs listed in the **Blawg 2010 ABA Journal** 100.

\* Court Reporter Top Copyright Blog award winner, November 2010.

\* Number 1 in the 2010 **Top Copyright Blog** list compiled by the Copyright Litigation Blog, July 2010.

\* Selected by United States Library of Congress for inclusion in its historic collections of Internet materials related to Legal Blawgs 2010.

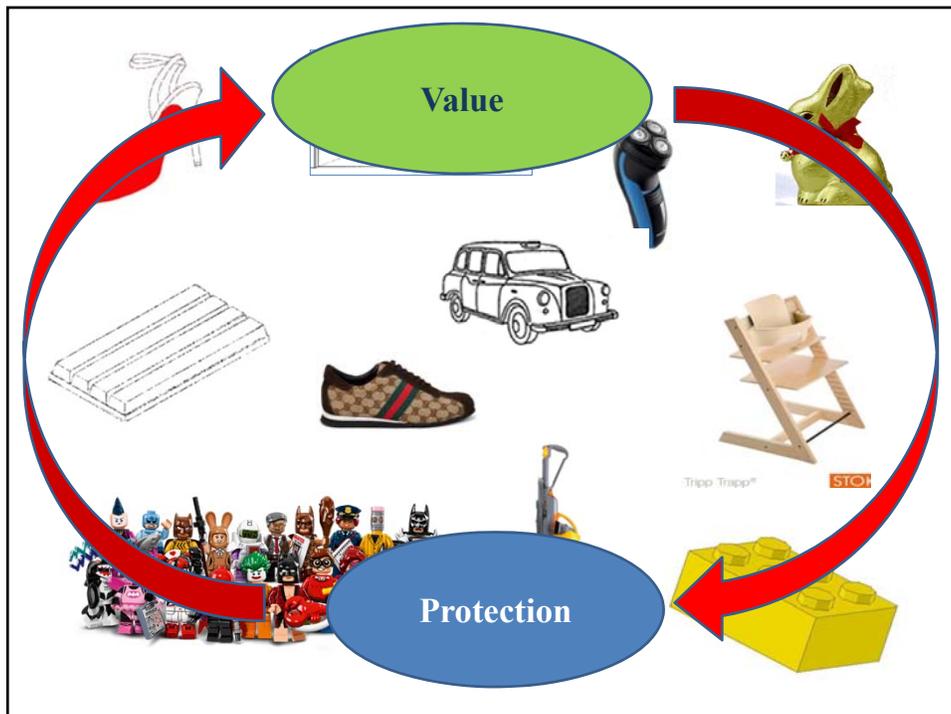
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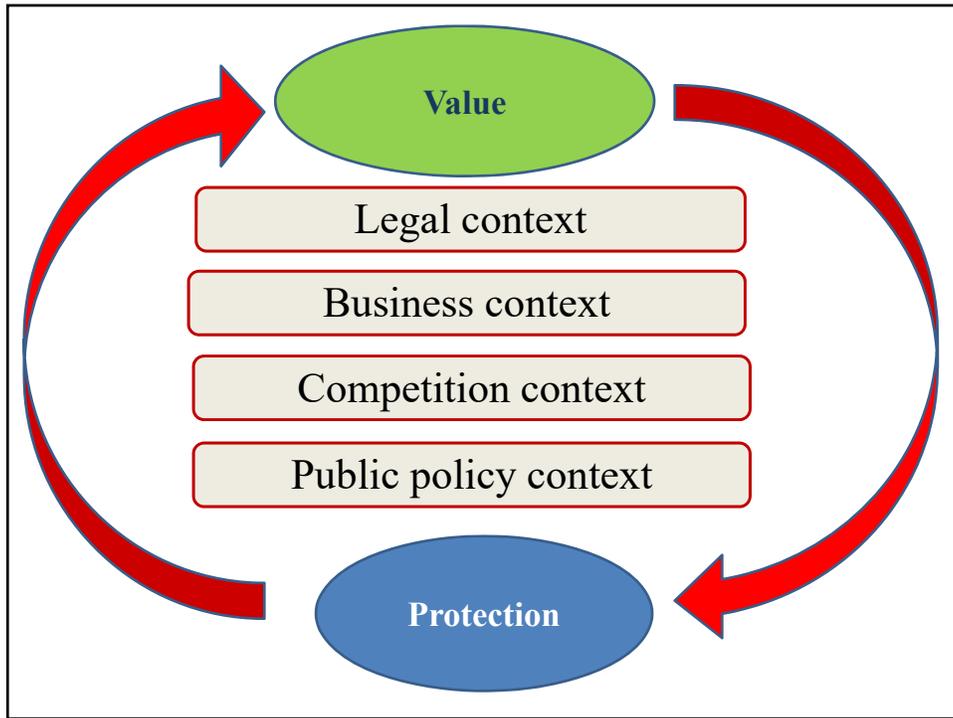
Christian  
*Louboutin*

On 7 February 2017 the Swiss Federal Court confirmed that the positional trademark IR 1'031'242 registered by Christian Louboutin is not sufficiently distinctive ([Decision of 7 February 2017, 4A\\_363/2017](#)). The trademark protection in Switzerland was denied.

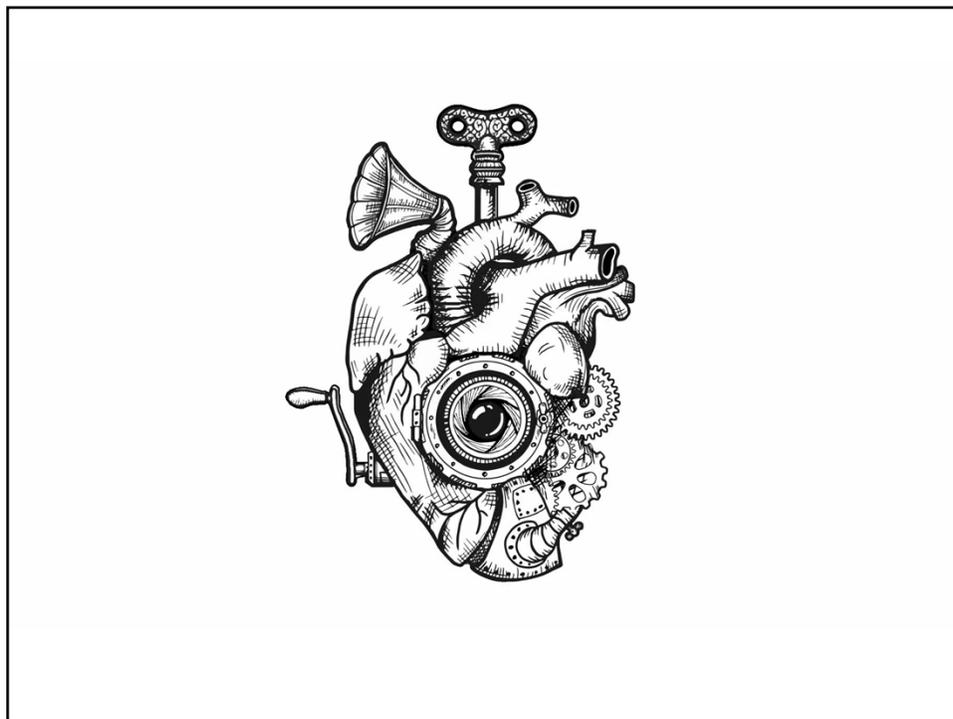
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Thank You

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