



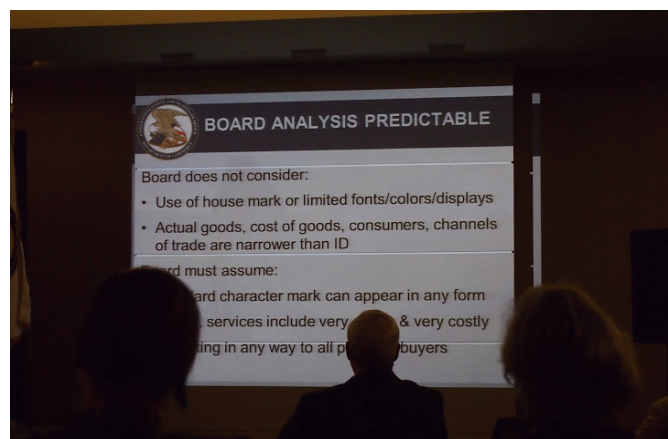
MEETING RECAP
THE PAULINE NEWMAN
IP AMERICAN INN OF COURT
TUESDAY, JANUARY 22, 2013

The first meeting in 2013 of the Pauline Newman IP American Inn of Court took place in the Auditorium in the Madison Building of the U.S. Patent & Trademark Office. As usual, it began with a reception. The subject of the program was trademarks.



Chief Judge Gerard Rogers of the Trademark Trial and Appeal Board spoke on Obviousness and Predictability. What is obvious to one person is often not obvious to another. The Board tries to have a process that is predictable, even if the results are not always obvious. He discussed the Opposition of Iowa to Southern Mississippi's registration of its Golden Eagle design as too similar to its Hawkeye design. *In re Creative Beauty Innovations, Inc.* upheld a design as inherently distinctive, based on accolades for the design,

that there were no other containers like it, and because it was difficult to make. Designs may be held not distinctive, if they resemble designs of other goods being marketed. Registration of the color teal for medical devices was denied in view of prior registrations of the color blue for catheters. The Board does not consider the use as a house mark or limited fonts, colors or displays, nor that actual goods, cost of goods, consumers or channels of trade are narrower than in the identification. The Board must assume that: a standard character mark can appear in any form; goods/services include very cheap through very costly; and marketing may be in any way to all potential buyers. In ex parte appeals, the rules are very clear, but are often ignored by the parties. 98% of inter partes cases are not tried, but focus on merits allows for process predictability.





Accelerated Case Resolution (“ACR”) is a more predictable process. Use as a summary bench trial predates the 2007 amended rules. Parties can stipulate to facts, and/or evidence to be considered and methods of introduction.

Sharon Marsh, Deputy Commissioner for Trademark Policy, and Cynthia Lynch, Administrator for Trademark Policy & Procedure, spoke on Non-Traditional Marks. They include product design (e.g., costume helmets and collectible toy helmets), product packaging (e.g., for edible oil in liquid form),

and three-dimensional marks. To be trademarkable, marks must not be functional, but must be distinctive. Functional and non-functional features of a mark may be weighed against each other in determining whether the mark is functional. Under the *Seabrook* test, factors to consider in determining whether packaging is inherently distinctive include: 1. Whether it is a common basic shape or design. 2. If it is unique or unusual in a particular field. 3. Whether it is a mere refinement of a commonly adopted and well-know form of ornamentation. 4. Whether it is capable of creating a commercial impression distinct from the accompanying words. Marks that consist solely of one or more colors used on particular objects or substances can serve as trademarks. A single color (e.g., on the sole of a shoe) can serve as a trademark in the fashion industry. Product design and color marks cannot be inherently distinctive. Sound marks identify and distinguish a product or service through audio rather than visual means. (The NBC chimes and MGM lion’s roar were played.) Sound marks cannot be a byproduct of ordinary operation of a device. Trade dress may serve as a service mark (e.g., the design of a store). Tactile marks that are felt by touch may identify goods or services. Motion marks can be shown in an application as a series of images. Scent marks have been registered on the Supplemental Register for lubricants for land vehicles and watercraft and for office supplies. A case involving a flavor mark is before the Board. Non-traditional marks are only a small portion of registered trademarks.



Robert Adams and Sherri DeLuca of Nixon & Vanderhye spoke on the Comparison of Trademark Litigation before the TTAB and/or in Federal/State Court. First, one must decide where to bring the litigation. Factors to consider include: How did you learn about the offending mark? Has a trademark application been filed for it? Has it been used? How important is the infringement? Should you talk before acting? Advantages and disadvantages of each forum include pressure, cost, time, the potential for a stay of proceedings, general early procedures and discovery, the availability of foreign depositions, motion, evidentiary and trial



practice, the availability of monetary and injunctive relief, post-judgment sanctions, and *res judicata* or collateral estoppel. The TTAB has a very predictable procedure, and it encourages parties to settle early. The TTAB allows depositions on written questions, which may be taken in foreign countries. Monetary and injunctive relief is not available in the TTAB. In *Hester v. Tyson*, there was a TTAB dismissal without prejudice, and a subsequent lawsuit. The mark was resurrected through later litigation.

Photographs by Michael Lew and Bill Stoffel.

Respectfully submitted,

Stephen Christopher Swift
Secretary-Treasurer