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Bottle Design and Bottle Cap Design Are Both Entitled to Trademark Registration

The US Patent and Trademark Office's ("PTO") Trademark Trial and Appeal Board ("TTAB") held that the design of the container and cap of Scope Outlast mouthwash by Procter & Gamble ("P&G") are each entitled to trademark protection. P&G sought to register the following container shape and cap design:

The Examining Attorney at the PTO refused registration, finding that the marks were non-distinctive product packaging and merely ornamental.

The TTAB considered whether the overall product packaging and cap design are each inherently distinctive. Based on the Supreme Court decision in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), the TTAB presumed that retail customers are "predisposed" to regard packaging, containers and other trade dress features as signals of the source of the product. Further, the TTAB found evidence in the record that bottle designs serve as source indicators in the retail market for mouthwash products.

As to the cap design, the TTAB found that it is (1) "clearly not a common geometric shape;" (2) unusual for mouthwash caps because of its "flared, asymmetrical sides on the top portion of the bottle cap that terminate in an undulating wave pattern around a recessed central core;" and (3) not a mere refinement of or variation on existing mouthwash caps. Thus, the Board found the cap design meets the test of inherent distinctiveness.

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The TTAB also found the design of the bottle to be inherently distinctive, and neither a common geometrical shape nor a common shape for oral care products. The Board determined that the Examining Attorney did not establish that the design is a mere refinement or variation of other mouthwash bottle designs.

P&G owns several design patents for the bottle design in which P&G expressly claimed the design as ornamental. The Examining Attorney relied upon those design patents to support her refusal that the designs are merely ornamental. The TTAB found that use of the term "ornamental" under the Patent Act has a different meaning than under the Trademark Act and that the existence of the design patents neither supports nor disfavors registration of the designs as trademarks. Accordingly, the TTAB held that the designs are inherently distinctive, and ordered a reversal of the refusal to register.

In re *The Procter & Gamble Company* (TTAB November 2012)

Disney Owns Winnie-the-Pooh Trademarks

Stephen Slesinger, Inc. filed twelve opposition and cancellation proceedings with the TTAB, opposing Disney's registration of various trademarks derived from the Winnie-the-Pooh works. Slesinger argued that Slesinger, not Disney, owned the marks. Disney argued that the issue of ownership of the marks had already been determined by a district court in a prior lawsuit between the parties. The TTAB granted Disney's motion for summary judgment and dismissed the case, finding that Disney's ownership of the marks had been previously determined by a district court. Slesinger appealed the ruling to the Federal Circuit Court of Appeals.

The earlier lawsuit between Slesinger and Disney involved a royalty dispute between the parties. The district court in that case found that Slesinger granted its rights in the Winnie-the-Pooh works to Disney and could not claim infringement of any retained rights. Slesinger argued that the district court did not actually decide whether there was an assignment or a mere license of rights to the works because that determination was not necessary to its judgment.

The Federal Circuit agreed with the TTAB that the district court in the previous lawsuit extensively analyzed the ownership of the marks as an essential issue in the royalty dispute and issued a judgment that addressed all of Slesinger's present arguments. Accordingly, the Federal Circuit affirmed the TTAB dismissal of the opposition and cancellation actions.

Stephen Slesinger, Inc. v. Disney Enterprises, Inc. (Fed. Cir. Dec. 21, 2012).

Apple Loses Claim Against Amazon for Use of Appstore

A California federal judge dismissed Apple, Inc.'s false advertising claim against Amazon.com Inc. in which Apple alleged that Amazon's use of "Appstore" infringes Apple's rights in its "App Store" mark. The court found Apple had not produced any evidence that consumers who access the Amazon Appstore would expect that it would be identical to the Apple App Store, particularly because the Apple App Store sells applications solely for Apple devices, while the Amazon Appstore sells applications solely for Android and Kindle devices.

Apple, Inc. v. Amazon.com Inc., Case No. CV 11-01327 PJH (N.D. Cal. Jan. 2, 2013)

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