

# Noli IP Newsletter

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## Repeating-Pattern Marks and Swatch-Type Drawings

By Judit Marai

A repeating-pattern mark is a mark composed of a single repeated element or a repeated combination of designs, numbers, letters, or other characters, forming a pattern that is displayed on the surface of goods, on

requirement of a mark, but the USPTO considers it as mere ornamental feature, and acquiring registration in the Principal Register needs special knowledge in this area. Here are a few signposts you can use to

*"Most of the time these repetitive designs do not function as source identifiers, that is the primary requirement of a mark, but the USPTO considers it as mere ornamental feature, and acquiring registration in the Principal Register needs special knowledge in this area."*

product packaging, or on materials associated with the advertising or provision of services. We mainly see these marks on household goods and clothing or accessories. The mark either covers the entire product or part of it. Most of the time these repetitive designs do not function as source identifiers, that is the primary

decide if your mark has special needs during the application or not.

Look at the repetitive word "DIOR" on the mascara below. This is a perfect example of a repeating-pattern mark, but it also could be a geometrical form being repeated on the product. Obviously, DIOR acquired wide

## Small Business Expo in San Diego

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Noli IP Solutions, PC cares about our community and its development.

The Small Business Expo is the nation's largest business-to-business trade show and networking event, drawing entrepreneurs from all over California and the country who are looking to connect, exchange information, entrench in new ways of thinking and generate new business leads.



We are proud and excited to attend the Small Business Expo this upcoming August 25, 2016 at the San Diego Convention Center. For more information, please visit the following website: <http://www.thesmallsbusinessexpo.com>

distinctiveness through the company's marketing efforts, but the latter might be mere ornamental representation.

Special requirements of the drawing: it needs to show the particular manner the mark appears on the product, and the place of it (showing the particular product with a broken line on the drawing, so the Examiner does not consider it as part of the mark). It means you need to either use the mark, or at least make the decision regarding which products will depict the mark in use before filing the application. The mark can be used on a single item, or in a similar manner on similar items. If the drawing does not show the particular placement of the mark, but shows only a sample of the repeating pattern displayed, so the mark is used in various ways or on various items that is a swatch-type drawing. The swatch-type marks are not acceptable as a source identifier, only if the applicant can show that 1) the applied-for mark is

actually used, or will be used, in various ways or on a variety of different items, but 2) it will nonetheless be perceived as a source indicator and create the same commercial impression across all uses.



The burden to prove the above mentioned circumstances is the same as the burden to prove acquired distinctiveness in general, but the bar is higher, since the applicant needs to prove that customers consider a common or everyday design (like a circle) a source identifier of the mark. Since the repeating pattern marks can only be used on a single or similar goods and/or services, you need to carefully consider the identification of goods in the application.

In case your application got rejected on the basis explained above and failure to function as a trademark, you can do the followings:

- Submit a substitute specimen showing use of the mark as a trademark or service mark,
- Amend to the Supplemental Register,
- Claiming acquired distinctiveness under Trademark Act Section 2(f),
- Delete the goods or services inconsistent with the drawing,
- Amend the drawing to depict the mark on a particular item (without facing to a material alteration rejection),
- For a swatch-type mark, submit evidence that the various uses of the repeating elements create the same commercial impression.

## *Nuances of US Design Patents: Multiple Embodiments*

*By Mariana Noli and Raouf Rizk*

It is safe to say that a case like **Apple Inc. v. Samsung Electronics Co.**, where

litigation primarily focused on the ornamental appearance of a front face for smartphones,

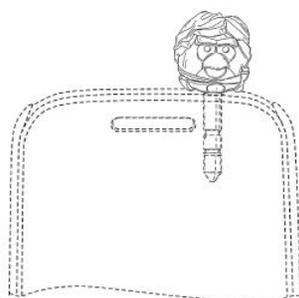
the overall appearance of a table, and the graphic design of the user interface, helped

the often relegated design patents become important and crucial assets in many companies' intellectual property portfolios.

Design patents protect the ornamental design of an item, as opposed to the functionality of an item protected by utility patents. A design patent protects the ornamental aspects of an article of manufacture (i.e., an article with a function), while utility patents protect the way an article is used or works, or material that makes up the article. The fact that an article works in a new and nonobvious way—the standard for patentability in a utility application—is not relevant against a rejection in a design application. Instead, the overall visual impression of the article must be new and not an obvious variation of prior designs.

While there are many differences between design and utility patents, some of the most important ones are the following: (1) Design patents protect the ornamental aspects of an article, **not** how the article is used or works; (2) Shorter Deadlines, for example for Foreign Filing six months to claim priority instead of twelve; (3) Design patents only have one claim; (4) Generally, U.S. design patent applications are not published; (5) Design patent

term is based on the issue date not the filing date; (6) Patent term adjustment is not necessary or available in the case of Design Patents; (7) Restriction requirements are quite common in the case of Design Patent Applications as opposed to Utility Patent Applications; (8) Since the claim is primarily the drawings, high-quality drawings are essential.



*Design Patent Embodiment #1*



*Design Patent Embodiment #2*

In the US, a design patent application may cover multiple embodiments of the same design. However, it is important to keep in mind that those multiple embodiments must still cover

**a single inventive concept** when submitting a design application that includes multiple ornamental designs for an article. Otherwise, the probability of receiving a restriction requirement becomes highly likely.

During prosecution, the Patent Office may require an applicant to select an embodiment of the invention when the Patent Office has deemed that the application includes multiple inventions. Thus, if the examiner determines that the claim is referencing more than one patentable distinct design, a restriction requirement will be issued.

If the examiner issues such restriction requirement, the applicant has two options: (1) to elect one of those ornamental designs for prosecution, and file additional design patent applications directed to each of these other ornamental designs; or (2) to elect one of the application's ornamental designs to be the subject of the remaining design patent prosecution without pursuing any of the remaining ornamental designs of the application.

As the US Court of Appeals for the Federal Circuit showed in **Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC**, there is a high risk of including too many

such examples in a single design patent application. Embodiments that are removed from an application in response to a restriction requirement and *not* claimed in a related *divisional* are in effect abandoned in the public domain. Protection for such non-chosen embodiments

therefore requires the filing of a *divisional* application.

Because of the shorter timelines and stricter application of some USPTO rules in design prosecution, it is important to hire counsel who is

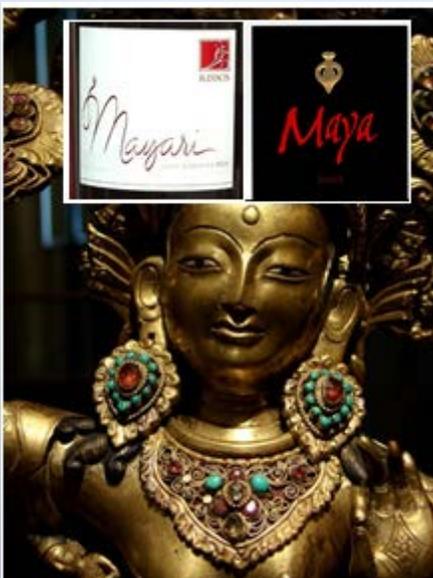
knowledgeable and intimately familiar with design practice and procedures to avoid losing valuable protection. Please feel free to contact us at [mail@noli-ipsolutions.com](mailto:mail@noli-ipsolutions.com).

## Trademark News: MAYA and MAYARI not the Confusingly Similar

*By Mariana Noli and Judit Marai*

MAYARI and MAYA are not confusingly similar, decided the United States Court of Appeals for the Federal Circuit on June 24, 2016. Oakville Hills Cellar, Inc. (“Oakville”), appealed the United States Patent and Trademark Office (“PTO”) Trademark Trial and Appeal Board’s decision dismissing its opposition to an application filed by Georgallis Holdings, LLC (“Georgallis”) to register a MAYARI mark for use on wine. The US Court of Appeals for the Federal Circuit affirmed the Board’s decision based on the substantial evidence supporting that Oakville’s registered mark MAYA and Georgallis’s applied-for mark MAYARI are sufficiently dissimilar.

Prior to issuing its decision regarding likelihood of confusion, the Board considered and evaluated the following Du Pont factors: (1) the similarity or dissimilarity of the marks in their entirety as to the appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity of the goods as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of trade channels; (4) the conditions under which, and buyers to whom sales are made; (5) the fame of the prior mark; (6) similar marks in use on similar goods; (7) the absence of actual confusion; (8) the right to exclude others from use; (9) the extent of potential confusion; and (10) other probative facts, in this case, federal labelling requirements applicable to wine.



According to the US Court of Appeals, the Board properly considered the marks in their entirety and found that MAYA is familiar to US consumers as a reference to the Mayan culture and as a popular female given name, whereas MAYARI is unfamiliar to US consumers, not having appeared in the top 1000 baby names for the past century on searches of the “Popular Baby Names” website of the Social Security Administration. The Court concluded that substantial evidence supports the Board’s finding that the marks at issue are sufficiently dissimilar as to appearance, sound, meaning, and commercial impression. In determining similarity or dissimilarity, the marks must be compared in their entirety. The Court affirmed the decision of the Board dismissing Oakville’s opposition. It goes to show that although it is hard to overcome a likelihood of confusion refusal, sometimes it is possible as in this case.