
Non-Traditional Marks and their enforcement:
shapes, bottle embossings, label shapes, colours

Patents for closures, wine in a can, carbonic
maceration bags, wine kits

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I. Non-Traditional marks

- a. The guiding principles of trademarks in a nutshell
- b. Traditional and Non-Traditional marks

II. Registrability of Non-Traditional marks: The sample and its methodology

- a) Shapes
- b) Bottle embossing
- c) Label shapes
- d) Colours
- e) (Sounds, smells)

III. Enforcement of Non-Traditional marks

- a) The use requirement
- b) Likelihood of confusion

Agenda (2/2)

IV. Patents – The guiding principles of patent law in a nutshell

V. Examples

- a) Closures
- b) Wine in a can
- c) Carbonic maceration bags
- d) Wine kits

VI. Take-aways

I.a. Non-Traditional marks – guiding principles (1/2)

1. **Protectable subject matter: sign**, or any combination of signs, in particular words, personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs
2. **Distinctiveness:** sign (a) being inherently capable of distinguishing the relevant goods and services from those of other undertakings or (b) having acquired distinctiveness through use
3. **Absence of "absolute grounds of refusal"**, such as for signs (a) serving, in trade, to designate the kind, quality, quantity, intended purpose, values, place of origin, i.e. descriptiveness; or having become customary in current language; (b) contrary to morality or public order; (c) deceiving the public

Categories: fanciful, arbitrary, descriptive, generic, suggestive

4. **Visual perceptibility**

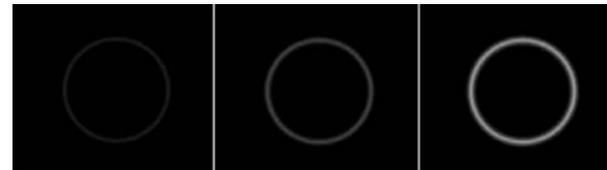
I.a. Non-Traditional marks – the guiding principles (2/2)

5. **Use:** requirement for registrability or requirement for validity and enforceability (mostly after five years)
6. **Scope of protection:** likelihood of confusion (protection of origin and quality function, to some extent even communication, investment, advertising function), dilution (blurring, tarnishment)
7. **Principle of speciality** (exception for famous marks)
8. **Territoriality**

I.b. Traditional and Non-Traditional marks



"The present circle appears, the contours become stronger and a completely visible circle forms, which then dissolves again (blinking circle, duration: 3-4 seconds)."



three-dimensional, colour, slogans, holograms, motions, positions, olfactory and haptic marks and textures

II. Registrability of Non-Traditional marks

The sample:

- › Wine industry (some examples for spirits)
- › 2015 – 2019
- › IR, EU, USA, plus most well-known wine producing countries
- › Top ten wine producers
- › Some older examples

Disclaimer:

- › not comprehensive, personal choice
- › no statement as to validity

Shapes



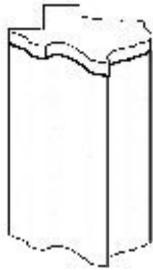
- › US 87435527
- › 05/18
- › E. & J. Gallo Winery
- › The mark consists of a three-dimensional configuration of a wine bottle, on the top third of which appears an American mercury head dime. Within the dime there is a profile of the winged head of the female Roman god Mercury. The head partially overlaps the word "LIBERTY" and to the bottom left of the head is the wording "IN GOD WE TRUST," and below the head is the number "1942"
- › Alcoholic beverages except beer



- › US 87643346
- › 10/18
- › Berne Selection, SARL
- › The mark consists of a three dimensional configuration of a bottle with a square base with sides that tapers in then flare out at the bottom. The bottle also features a raised design of an arch on one of the four sides of the bottle, and a raised letter "B" near the mouth of the bottle, and the wording "BERNE" in raised letters along the bottom of the bottle
- › Wine



- › US 87898240
- › 11/18
- › E. & J. Gallo Winery
- › The mark consists of a three-dimensional configuration of a bottle for the goods, with a round body that stops sharply at the neck; there is a 90 degree angle where the bottle meets its neck. The bottle's neck has a screw top, and a covering at the top extending halfway down the neck. On the neck covering is an image of a pattern of four rows of semi-circles next to each other with a row of broken lines below. Imposed in the center of the bottle is a circular shape containing the stylized word "RUMHAVEN" with some filigree shown above and below the word. To the upper left of the circular shape is part of an open coconut half with a splash of water shown above it and part of a palm frond shown below. To the right of the circular shape is part of a palm frond with a larger open coconut half shown below. Next to the open coconut half is another palm frond with a splash of water. Below is a banner with a semi-circle type design, lines, and filigree
- › Alcoholic beverages except beer



- › US 86684328
- › 08/17
- › Morales Beverage Company, LLC
- › The mark consists of a three-dimensional configuration of a container having a cross-sectional profile in the shape of the state of texas
- › Alcoholic beverages except beer



- › US 87540735
- › 04/19
- › VVMC, LLC
- › The mark consists of a 3-dimensional configuration of a container having a cross-sectional profile in the shape of the letter "C" positioned around a smaller circle
- › Alcoholic beverages except beer, Whisky



- › US 86816679
- › 10/18
- › Starr African Rum, LLC
- › Red is claimed as a feature of the mark
- › Alcoholic beverages except beer

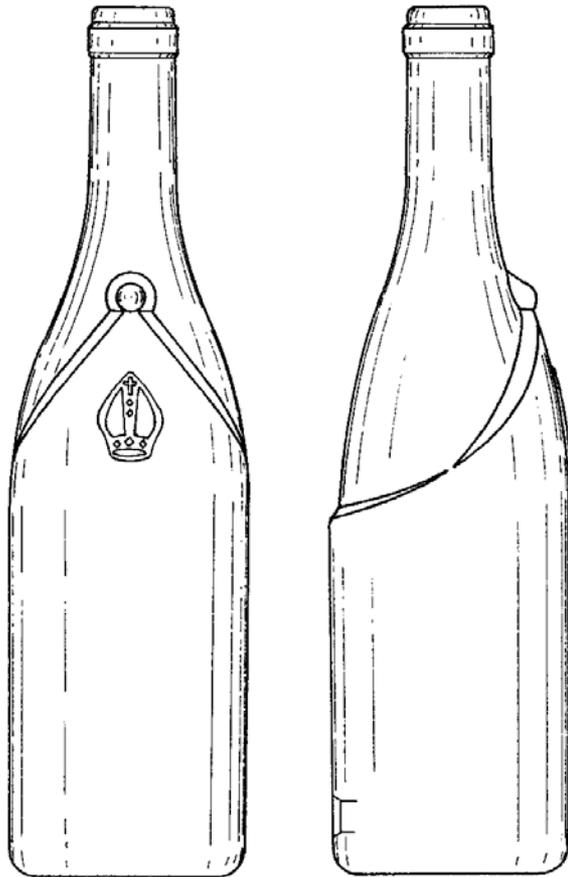


- › US 87225250
- › 06/18
- › Stillhouse, LLC
- › Red and silver are claimed as a feature of the mark
- › Alcoholic beverages, namely, distilled spirits

Bottle embossing



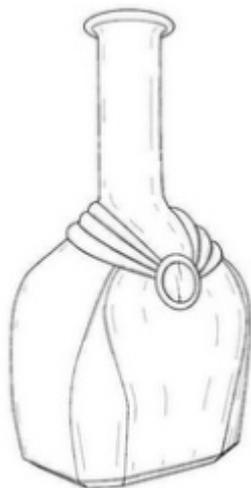
- › US 88163608 (Application)
- › 10/18 (Application)
- › Constellation Brands U.S. Operations, Inc. Corporation (Applicant)
- › The mark consists of the top of container for the goods with a design of berries, leafs and vines formed into the bottle material
- › Alcoholic beverages except beer, wine



- › EUTM 002801454
- › 10/03
- › Association la Mitrale de Chateuneuf-Du-Pape
- › Bottles or flasks in circular or elliptical horizontal cross section, mitre
- › Wines with controlled designation of origin



- › US 87722953
- › 07/18
- › Proud Pour, Inc.
- › The mark consists of three-dimensional product packaging, which is dried flowers that are attached to the neck of a wine bottle. The flowers are attached by a rubber band, string, or other similar item. The wine bottle and the item or method used to attach the flowers are not part of the mark
- › Wine

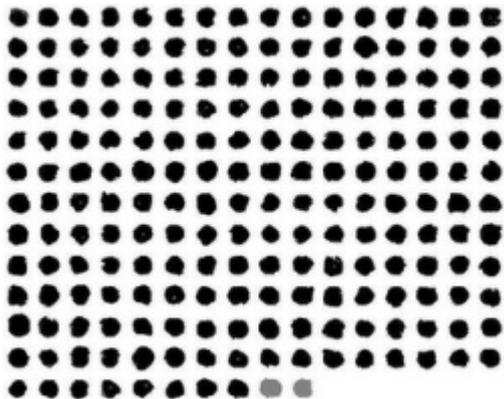


- › US 88173551
- › 06/19
- › Elite Beverage International, Inc.
- › The mark consists of a three-dimensional configuration depicting a ribbon and medallion design draped on a bottle
- › Distilled blue agave liquor



- › US 77002392
- › 08/08
- › Moët Hennessy USA, Inc.
- › The mark consists of two ribbons, which are applied and attached, hanging vertically from the neck and cap of a bottle, with the ribbon ends falling free
- › Sparkling wine

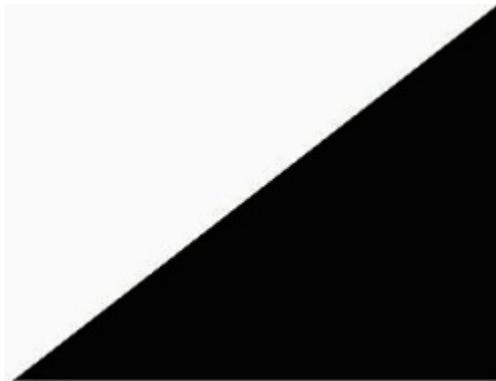
Label shapes



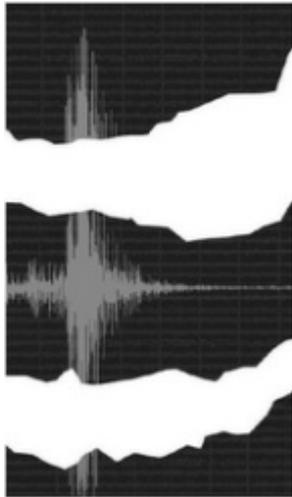
- › US 87313562
- › 12/18
- › Rooney Holdings, Inc.
- › The mark consists of a pattern of dots forming an incomplete rectangle, with the end two dots on the incomplete side shown as lighter saturation of pigment
- › Wine



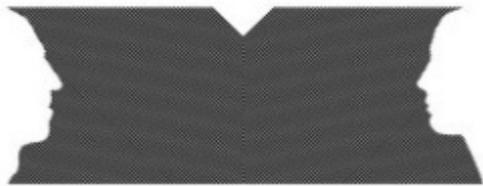
- › US 87357438
- › 01/18
- › Azar Distilling, LLC
- › Blue and white are claimed as a feature of the mark
- › Gin



- › US 86686544
- › 02/16
- › Justin Vineyards & Winery, LLC
- › The mark consists of a triangle
- › Wine, Alcoholic beverages except beer; Wineclub services, namely, shipment of wine to wine club members; Conducting entertainment events in the nature of wine harvest festivals and wine festivals, grape growing and winemaking seminars for wine club members, entertainment services, namely, wine tastings, guided tours of a winery



- › US 87156941
- › 06/17
- › Michael-David, LLC
- › The mark consists of a design made up of a series of amplitude waves that are recorded by a seismograph and measure the magnitude of an earthquake superimposed over stylized rock strata
- › Wine



- › US 86848214
- › 07/16
- › Merryvale Vineyards, LLC
- › The mark consists of a rectangle design created by multiple Vs with a notch at the top center and the silhouette of a human face at both ends
- › Alcoholic beverages except beer



- › US 87061328
- › 08/17
- › Cayuse Vineyards, LLC
- › The mark consists of a map of the snake-like shape of the river Marne in France, consisting of a dark central brushstroke with a lighter silhouette around its edges, commencing with a head facing left, then, left to right, a slight dip, a steep curve downward to the right and back upward, tapering to a peak, another slight dip, finally tapering to end in a tail that sweeps upwards in brushstrokes that become narrower, less distinct, fading to a faint streak
- › Wine, champagne



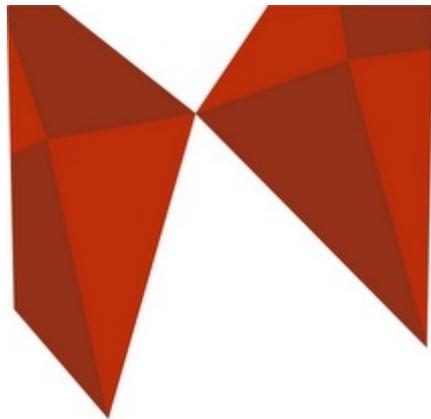
- › US 87624300
- › 04/18
- › DenHoed Wine Estates, LLC
- › The mark consists of a triptych consisting of three rectangular images aligned in a row, which all together form one depiction of a vineyard on a hillside overlooking a river
- › Alcoholic beverages except beer, wine



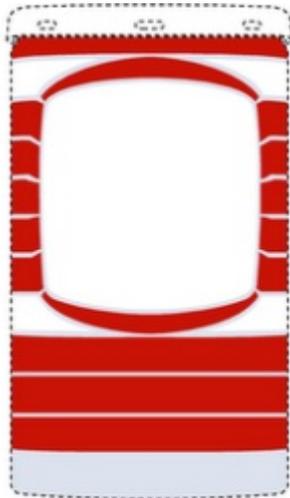
- › US 87598517
- › 03/18
- › E. & J. Gallo Winery
- › The mark consists of an image of a lake covered in fog with a forest in the background
- › Alcoholic beverages except beer



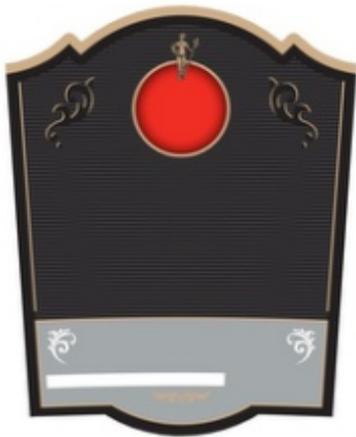
- › US 87856172
- › 04/19
- › The Wine Group LLC
- › The mark consists of a circle design with plants, animals, insects, the moon, and the sun
- › Alcoholic beverages except beer, wine



- › US 87929432
- › 06/19
- › Schrader Cellars, LLC
- › Red and dark red are claimed as a feature of the mark
- › Alcoholic beverages except beer, wine



- › US 86888972
- › 05/17
- › Kikusui Sake Co., Ltd.
- › Red, white and silver are claimed as a feature of the mark
- › Canned sake



- › US 87750196
- › 08/18
- › Havana Club Holding, S.A.
- › Red, gold, black, gray and white are claimed as a feature of the mark
- › Cuban rum



- › US 85589147
- › 11/13
- › Moët Hennessy USA, Inc.
- › Green, black, gold, red and off-white are claimed as a feature of the mark
- › Sparkling wines, champagne wines

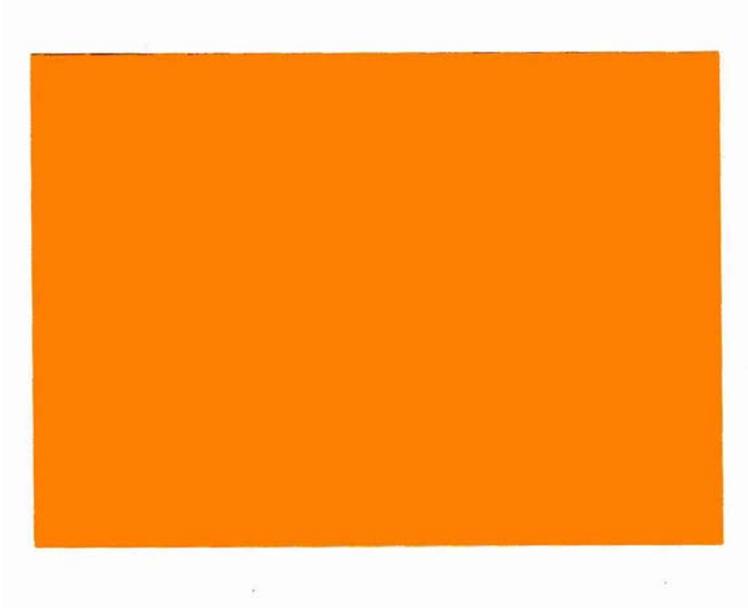


- › EUIPO 016966392
- › 10/17
- › Pernod Ricard Winemakers Spain, S.A (Applicant)
- › Brown, white, red, gold are claimed as a feature of the mark
- › Wines

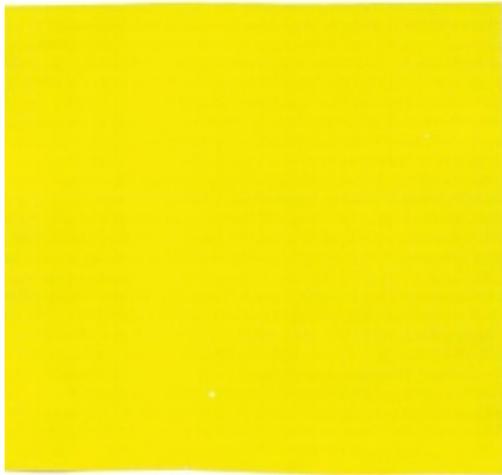


- › US 88411773 (Application)
- › 05/19 (Application)
- › E. & J. Gallo Winery (Applicant)
- › The mark consists of a three-dimensional configuration of product packaging consisting of imagery on a label that is printed on a box. In the middle of the top third of the box appears a stylized footprint. Directly underneath the footprint appears the word BAREFOOT in capitalized stylized letters, with the O's in BAREFOOT overlapping. Directly under BAREFOOT are the words, in small letters, wine-to-go. At the bottom of the package and separated by a thin line is a fanciful design containing flamingos, leaves, a flower, and sunglasses. This design is repeated around the entire bottom of the box
- › Alcoholic beverages except beer

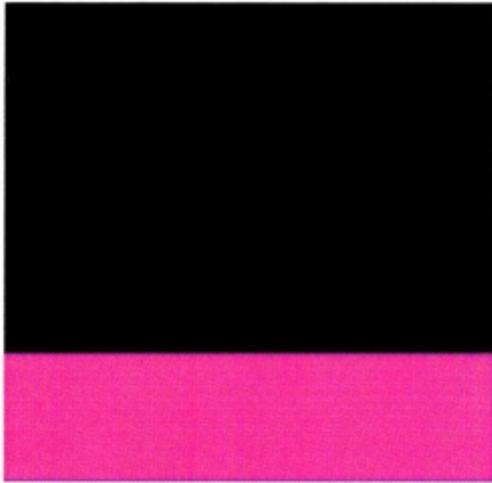
Colours



- › EUTM 000747949
- › 03/07
- › MHCS, SCS
- › Protection is claimed for the colour orange for which the scientific definition is as follows:
trichromatic co-ordinates / colour characteristics: x 0.520, y 0.428 - diffuse reflectance 42.3% - dominant wavelength 586.5 nm - excitation purity 0.860 - colorimetric purity: 0,894
- › Champagne wines
- › (acquired distinctiveness, cancellation proceedings pending)



- › FR 3146367
- › 02/02 (Application)
- › Champagne Charles Lafitte, Successeur de George Goulet, Maison fondé en 1834, SAS
- › The mark consists of the shade of the yellow colours obtained by a mixture of: Yellow P (500 gr) Rubine Red (36 gr) Lacquer (300 gr)
- › Wines of French origin, especially champagne



- › FR 3488117
- › 03/07 (Application)
- › Fauchon, SAS
- › Two predominant colours
- › Alcoholic beverages except beer

Smell



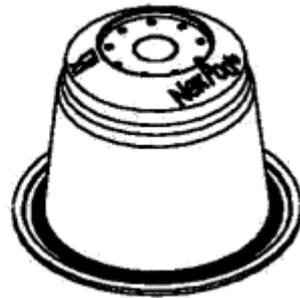
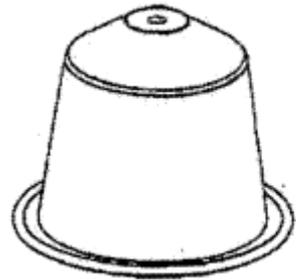
- › Judgment of the European Court of Justice case C-310/17
- › Levola Hengelo BV v. Smilde Foods BV

III. Enforcement of Non-traditional marks

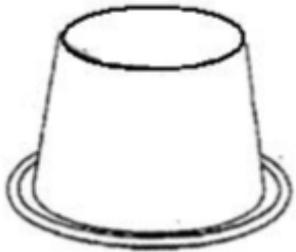
- a. The use requirement: How is a Non-Traditional mark used?
 - in commerce
 - seriousness
 - "as a trademark" (i.e. as a sign distinguishing the commercial origin of the goods/services, not "just" as an ornament)

- b. Likelihood of confusion (general impression, letters, sound, meaning; average consumer's perspective)
 - direct confusion
 - indirect confusion
 - examples (see next slides)

Example (1/2): Nestlé v. Denner



- › Judgment of the Commercial Court of the Canton of St. Gallen (21/5/13)



Example (2/2): Sparkasse v. Santander

- › Judgment of the German Supreme Court case I ZR 78/14 (09/15)



IV. Patents – the guiding principles in a nutshell

1. Protectable subject matter: invention, whether product or process...
2. ...in all fields of technology...
3. ...new...; ... involving an inventive step.....capable of industrial application...
4. ...disclosing the invention well enough for the person having ordinary skill in the art
5. Excluded (mostly): if against ordre public, morality; diagnostic, therapeutic and surgical methods for the treatments of humans and animals; plants and animals other than microorganisms and essentially biological processes for the production of plants and animals
6. Direct infringement, doctrine of equivalents
7. Plant varieties protectable by patents or sui generis systems (such as, e.g., UPOV, International Union for the Protection of New Varieties of Plants, plant breeders rights)

Screw-capsule for wine bottles

› Claim 1

An apparatus for sealing a container, comprising: a threaded capsule; and means associated with said capsule for sealing a liquid within a container of the type having an opening with threads adjacent the opening

› WO 2011/022307 A2

› 02/11 (Publication)

› William Gardner (Inventor and Applicant)

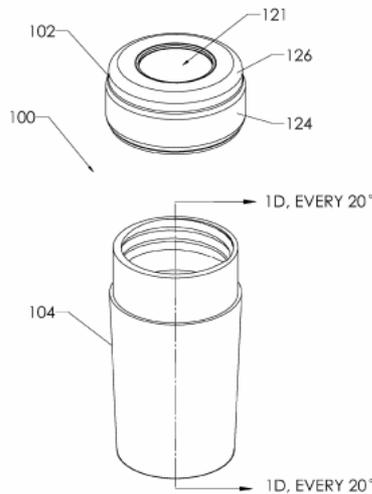


FIG. 1A

Method for producing a glass stopper for sealing bottles

> Claim 1

- > Verfahren zum Herstellen eines mit einem Kopfteil versehenen Glasstopfens zum Verschluss von Flaschen, insbesondere von Wein- und Schaumweinflaschen, wobei eine Oberform und eine Unterform bereitgestellt werden, und wobei die Unterform ein unteres Unterformteil umfasst, dadurch gekennzeichnet, dass die Unterform ein ringförmiges oder einteiliges oberes Unterformteil zum Formen zumindest eines Hauptbereichs des Kopfteils oder eines Bereichs des Kopfteils umfasst, und dass die Unterform zumindest ein zwischen dem unteren Unterformteil und dem oberen Unterformteil angeordnetes mittleres Unterformteil zum Formen zumindest eines Teils der Stopfenlänge umfasst, wobei das mittlere Unterformteil ein erstes Formteil und zumindest ein zweites Formteil umfasst, wobei flüssiges Glas in die Unterform gegeben wird, wobei der Glasstopfen aus dem flüssigen Glas durch im Wesentlichen vertikales aufeinander Zufahren der Oberform und der Unterform gepresst, oder blankgepresst wird, und wobei das erste Formteil und das zweite Formteil anschließend im Wesentlichen horizontal auseinandergefahren werden

> WO 2014/177239 A2

> 11/14 (Publication)

> Docter Optics SE (Applicant)

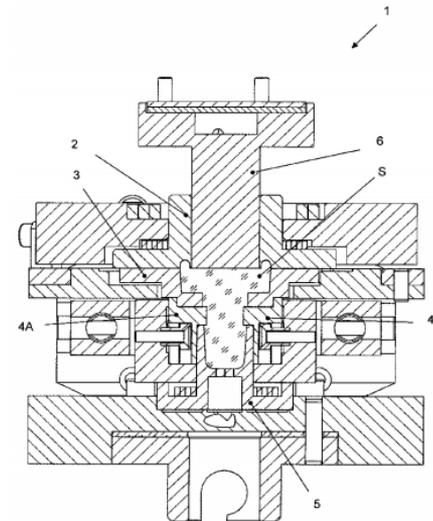


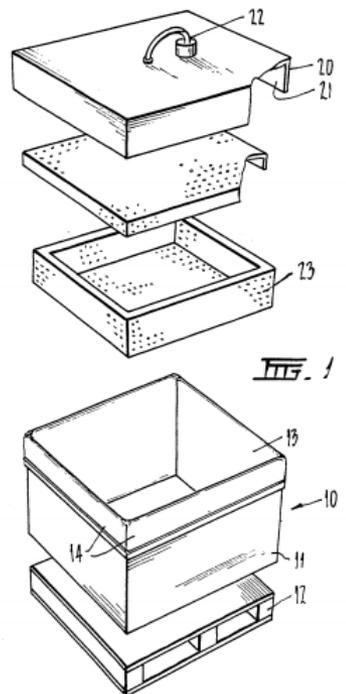
Fig. 1

Method for producing wine by full carbonic maceration

> Claim 1

1. A method of producing wine by full carbonic maceration including the steps of:

- (a) placing whole grapes into a closable container containing sufficient solid CO₂ to substantially purge the air therein,
- (b) closing the container to prevent entry of air,
- (c) expelling by vaporization of the solid CO₂ the air within the container prior to commencement of carbonic maceration, and
- (d) by continual vaporization of the solid CO₂ maintaining a sufficiently low concentration of gaseous oxygen in the container for a time effective to initiate intracellular fermentation, the handling of the grapes, the depth of the grapes in the closable container and the conditions under which the full carbonic maceration is carried out being such as to ensure that more than 85% of the grapes remain whole up to the time that the full carbonic maceration steps (a) to (d) are completed



> US 4.615.887

> 10/86

> Hickinbotham Winemakers Pty. Ltd.
(Assignee)

Wine packaged in aluminium containers

> Claim 1

A filled aluminium container containing a wine characterised in that the maximum oxygen content of the head space is 1 % v/v and the wine prior to filling is micro filtered and dissolved oxygen levels throughout the aluminium container filling process are maintained up to 0.5 mg/L and final levels of dissolved CO₂ are from 50 ppm for white and sparkling wines and from 50 ppm to 400 ppm for red wines, prior to filling the container, wherein the filled aluminium container of wine has a molecular sulphur dioxide content of between 0.4 and 0.8 mg/L

> EP 2607471 B1

> 05/14 (Publication and grant of the patent)

> Barokes PTY Ltd.

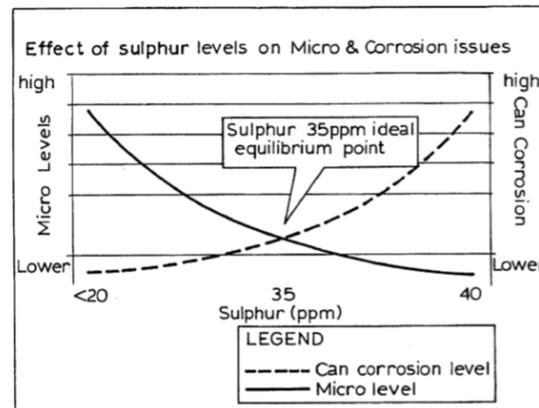
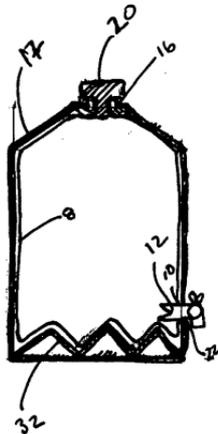


Figure 1

Wine kit and method for making wine

> Claim 1

A wine kit apparatus comprising a flexible bag containing juice concentrate, said flexible bag having a first opening with a pour spigot mountable thereon and a second opening with a coupling means for receiving alternatively a fermentation lock and sealing cap; there also being a container for containing and supporting the flexible bag within the container, said container having a front opening through which can extend the spigot and a top opening at which the bag may be mounted via a coupling ring to depend from the top of the container therewithin; in use, water and yeast may be added to the concentrate through the top opening after removing the sealing cap, and then, after the water and yeast have been added, the top opening can be sealed from the outside air with a fermentation lock to permit fermentation within the bag and container, with the gas thereby produced being permitted to escape through the fermentation lock and the bag being restrained in shape by the walls of the container.



- > US 2005/0284884 A1 (Abandoned)
- > 12/05 (Publication)
- > Aline Roy-Wedderburn (Inventor)

VI. Take-aways

1. The wine sector has started registering Non-traditional marks, such as shapes, bottle embossings, colours etc.
2. The reality test for these marks will be the enforcement stage. Enforcing Non-Traditional marks could be more complex than the enforcement of traditional marks.
3. The patent system offers multiple possibilities to create property rights on new forms of product presentation (e.g. closures) or consumption (e.g. wine in a can) but not so much on the wine itself (novelty requirement, confidentiality issues).
4. Whether these patents survive the reality test, especially with regard to the requirements of novelty and inventive step can be doubtful; an assessment is only possible on a case-by-case basis.

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