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TTAB Has No Taste For Flavor Marks

In re N.V. Organon (Serial Number 76467774), the TTAB affirmed the refusal to register an orange flavor for pharmaceuticals and set the bar very high for any future attempts to register a flavor, providing that “any registration of a flavor requires a substantial showing of acquired distinctiveness.”

This Board first concluded that orange flavor was functional since flavors are a standard addition to pharmaceutical products to increase palatability and patient compliance. The board next noted that this particular flavor is unable to function as a trademark because it is likely to be considered merely “another feature of the medication, making it palatable” and not an indicator of source. Moreover, practical difficulties would arise in examination and from the fact that consumers generally have no access to a flavor before purchasing a product.

Cat’s Domain Name Gets Nipped for Bad Faith

In a recent Domain Name UDRP decision, Complainant, Morgan Stanley, was successful in obtaining a transfer of the domain name “mymorganstanleyplatinum.com” from feline Respondent, Meow, Baroness Penelope Cat of Nash DCB.

Morgan Stanley alleged that the disputed domain name is confusingly similar to its MORGAN STANLEY trademark. Meow registered the domain name through its owner, Michael Woods, a business consultant, as a means to teach a seminar to demonstrate how large companies fail to register obvious domain names. The Panel found that, in addition to the domain name being confusingly similar to Complainant’s mark, the Respondent was not using the disputed domain name in connection with a *bona fide* offering of goods or services. Since a cat cannot speak, read, or write, a common cat could not have submitted a Response or register the disputed domain name. Therefore, the Panel found the third necessary element of bad faith, by Respondent’s assertions that it is a cat, and providing incorrect WHOIS information. Having established the required elements of a domain name dispute, the domain name was ordered to be transferred to the Complainant.

Section 44(e) basis does not survive assignment to a US successor

In *Karsten Manufacturing Corporation v. Editoy AG; Editoy B.V.; Pingu V.V.; and Joker, Inc.*, (91101408 and 91108831) the TTAB held that an assignee of an application originally filed by a foreign corporation under Section 44(d) could continue to claim the benefit of the priority filing date, even though the assignee’s country of origin is the United States. The assigned application, however, could not proceed to registration under Section 44 (e).

The original foreign based Section 44 applicant assigned the mark to a subsequently incorporated United States subsidiary. Even though the new United States company was foreign owned and controlled, it did not have bona fide commercial facilities outside of the United States and so it was not a “foreign applicant” for the purposes of 44(e). On the other hand, the assignment did not invalidate the 44(d) priority claim since the claim was properly made by the original applicant. An applicant stands in the shoes of its assignor and since applicants can amend or add a substitute basis for registration before or after publication, the 44(d) priority claim survives the assignment provided that the applicant also amends the application to assert a proper Section 1 basis for registration.

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