

# Non-traditional Trade-marks in Canada

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## Introduction

I am going to speak today about the registrability of non-traditional trade-marks in Canada. In doing so I shall look south to compare the Canadian situation with the American landscape.

What do we mean by non-traditional trade-marks? If we think of trade-marks generally, what usually comes to mind are words, phrases, slogans and/or graphics. Some we call word marks; others design marks. We may also think of marks which consist of a combination of words and designs, or words graphically oriented in a particular way, or having a unique stylistic element such as a particular font or colour. These are what we call word and design marks.

Examples:

- TWITTER (Twitter Inc.), for telecommunications services
- IPHONE (Apple Inc.), for mobile devices
- WHERE DO YOU WANT TO GO TODAY (Microsoft Corp.), for software



(Nike Inc.) for shoes, etc.

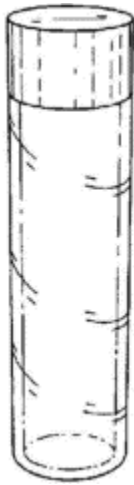
 **BlackBerry**

(Research in Motion Ltd.)  
for electronic handheld  
units, etc.

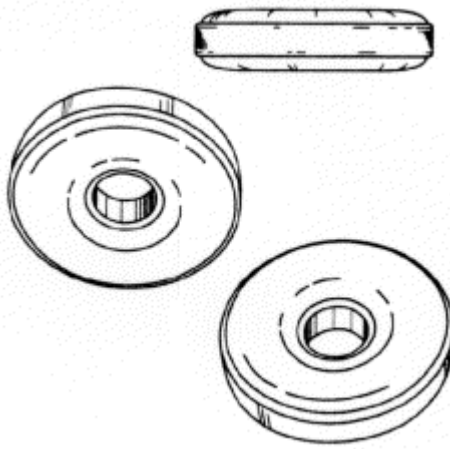


(TiVo Inc.) for computer  
hardware and software  
for use in connection with  
personalized, interactive  
television programming,  
etc.

Trade-marks can also be obtained for a distinguishing guise, which is a distinctive shaping of the wares themselves or their wrapping, for example the shapes of bottles, or candy. These are registrable if the guise is shown to be distinctive at the time of filing:



Voss water bottle  
TMA751978  
(Voss of Norway ASA)



Life Savers candy  
TMA562616  
(Kraft Foods Holdings, Inc.)



Coca-Cola bottle  
UCA044193  
(COCA-COLA LTD.)

Non-traditional trade-marks are trade-marks consisting of such things as:

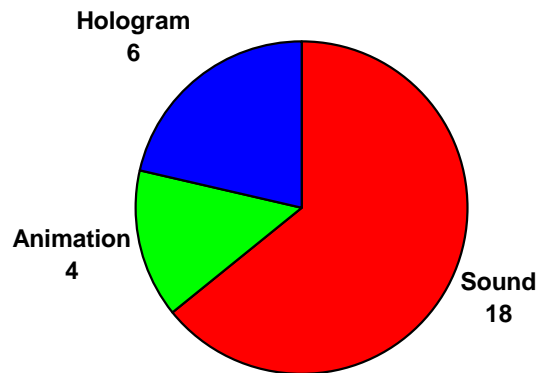
- Sound
- Smell
- Taste
- Touch
- Holograms
- Kinetic marks

Kinetic marks refer to animations or moving images, for example a computerized image, a television sequence, or as we shall see later, the animated sequences shown in the opening seconds of a film.

So how many applications for non-traditional trade-marks are filed with CIPO each year? Very few actually, and we shall see that the reason for this is CIPO's systematic refusal to process most non-traditional trade-marks. By contrast, the USPTO processes many more applications for non-traditional trade-marks.

In fact, we found a total of only 28 trade-mark applications ever filed with CIPO for sound, animation, or hologram marks. The breakdown is as follows:

### **Non-traditional TM applications in CIPO**



With that in mind, let us go over the statutory requirements for a trade-mark.

### What is a trade-mark?

The term “trade-mark” is defined very broadly in the Trade-marks Act, R.S.C.

1985, c. T-13 (the “Act”) as:

“trade-mark” means, inter alia,

(a) a mark that is used by a person for the purposes distinguishing or so as to distinguish wares or services manufactured , sold, leased, hired, or performed by him from those manufactured , sold, leased, hired, or performed by others

### Sound Marks

In 1985, Capitol Records filed for a sound mark consisting of 11 musical notes for use in association with phonograph records, tapes, motion picture films and related services. The mark was registered in 1989 for a 15 year term and expunged in 2005 for non-renewal. Since then, many applications for sound marks have been filed with CIPO but none proceeded to registration.

Let us look at what Capitol Records filed:

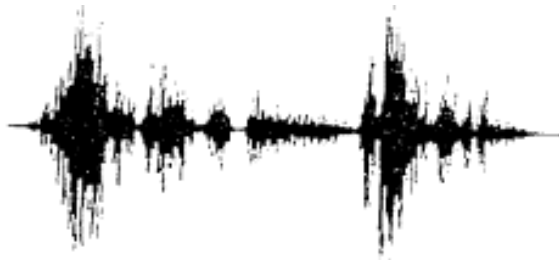
Owner: Capitol Records  
Registration no.: TMA359318  
For: Phonograph records



The mark consists of 11 musical notes comprising the notes:  
NOTES: C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> E<sub>4</sub> G<sub>4</sub> C<sub>5</sub>  
FREQUENCIES: 261.5 277 293.33 309 325 341 356.76 372.9 389.1 405.3 421.5

Some subsequent filings:

1. Applicant: MGM  
Application no.: 0714314  
For: Motion pictures films and video  
Description: Roaring Lion



2. Applicant: INTEL  
Application no.: 0858570  
For: Computer hardware

Description: The trade mark consists of a five tone audio progression of the notes D FLAT, D FLAT, G, D FLAT and A FLAT.



3. Applicant: CTV Television  
Application no.: 1435197  
For: recording and broadcast of hockey games

**Hockey Theme (Opening)  
SOUND mark as  
represented by the sheet  
music, attached**

CIPO's objections were maintained despite sometimes relentless prosecution by applicants. The usual arguments made by applicants are that the *Playboy* case is irrelevant or wrong; sound marks are allowed in other countries including the U.S., and the state of the register evidence, which basically argues that Capitol Records obtained a sound mark so sound marks must be registrable. The Examiner's response to the last argument is always that just because the Office erred in the past does not mean it should err again. In one case, MGM's Roaring Lion, the application was filed in 1992 and their agents are still pressing hard for its allowance – one of their responses being 54 pages long!

Thus some applicants voluntarily withdraw their application after the first objection, and others simply ask for repeated extensions of time hoping for a change in the law that will allow sound marks.

My personal view is that applicants would be better served by appealing the Examiner's refusal to the Federal Court. To date, no one has appealed.

### Smell

Scents can serve to distinguish wares or services as well; however there will be hurdles that must be overcome:

- The scent cannot serve a functional purpose, for example to mask an otherwise unpleasant odour, or to create a certain ambience, or even



as a relaxant. So the smell of a perfume, for example would not be registrable as a trade-mark.

- For wares, it must be apparent to the consumer at the time of the transfer or possession of the wares and marked on the wares themselves. How does one “mark” a smell on wares? This is less of a problem for services, if for example your services are provided in a fixed location in which the air is scented with the subject trade-mark, that should satisfy this requirement.
- It must be capable of being accurately and precisely described on the trade-marks Register?

As an exercise, query whether the famously distinctive new car smell can be registrable as a smell trade-mark? To date we have not found any Canadian applications for smell marks. However, even if one can overcome the practical hurdles, the application will likely be rejected by CIPO on the basis that it is “non-visible” and therefore contrary to CIPO’s interpretation of the Playboy case.

The U.S. has several scent marks on the Register. Some examples are:

- 3140701 (The Smead Manufacturing Company) for an apple cider scent or fragrance in association with office supplies, filed June 13, 2005, registered September 5, 2006;
- 3589348 (Hisamitsu Pharmaceutical Co.) for a minty scent by mixture of highly concentrated methyl salicylate (10wt%) and menthol (3wt%)

in association with Medicated transdermal patches, filed March 13, 2008, registered March 10, 2009;

- 2463044 (Mike Mantel d.b.a. Manhattan Oil) for a cherry scent in association with synthetic lubricants for high performance racing and recreational vehicles, filed August 25, 1995, registered June 26, 2001;

What we found by going through the U.S. files was that the US examiners typically required the applicant to show distinctiveness (if distinctiveness cannot be shown the trade-mark will be listed on the Supplemental Register) and non-functionality. Also, the applicant had to submit a specimen, such as a photograph, of how the mark is being used on the wares, packaging, or documents related to sale (e.g. invoices).

### Taste

Trade-marks consisting of a taste possess the same hurdles as that for smell, i.e. cannot be functional; must be apparent at the time of transfer (or advertisement if for services); and must be capable of being precisely described.

If for wares, it is difficult to imagine a situation where the consumer tastes it before it is actually purchased, yet if done, it should be registrable as a trade-mark.

We have not come across any applications filed with CIPO for taste marks. We found some applications in the U.S. however they were objected to for the reasons described above, namely that there is no way the consumer can taste it

before purchasing it, and because the flavour was seen as having utility, apart from distinguishing the wares.

### Touch/sensory

Touch trade-marks distinguish the wares with a particular feel or texture. As we could not find any Canadian applications for these types of marks it is unclear what CIPO's position would be with respect to registrability. We did find such marks in the U.S., however, including one that was registered.

For example, Registration No. 3155702 in association with wines covers "a velvet textured covering on the surface of a bottle of wine." In this case the applicant was required to overcome a distinctiveness objection and submit a sample bottle of wine with its textured surface so the examiner could see and feel the applied for trade-mark.

We also found application no. 85007641 in association with medicines, namely, pharmaceutical formulations of nitroglycerin, which is described as "the distinctive touch and feel of a glass pump spray bottle with a plasticized surface. The pump spray bottle has a smooth surface with a weightiness, thickness and durability imparted by the glass; simultaneously the bottle has a lightness and rubber-like quality imparted by the plasticized coating." This was filed in April 6, 2010 and has not yet received an Office Action.

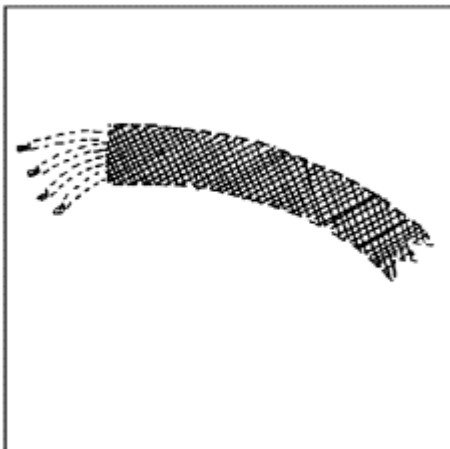
## Colour

CIPO currently will allow a trade-mark consisting of a colour applied to a surface of a 3-D object, but will not allow a mark for colour per se, that is, independent of the object to which it is applied. For example:

1. Owner: Owens-Corning  
Registration no.: TMA577805  
For: the colour pink applied to foam insulation



2. Owner: 2881403 Canada Inc.  
Registration no.: TMA480533  
For: the colour orange as applied to an electronic cable



Current TM Office practice is to require the application to include a drawing showing the object to which the colour is applied demarcated by a dotted line.

### Holograms

We can think of holograms as 2D or 3D images on a metallic film backing that change shape and/or colour when viewed from different angles. Holograms are commonly used to prove authenticity or to prevent unauthorized duplication. If used as such, can the hologram also function as a trade-mark and be registrable as such?

The big challenge with holograms as trade-marks in Canada lies in how to portray them on paper in a trade-mark application in a way that is acceptable to CIPO. We found six trade-mark applications for holograms filed with CIPO but only two that proceeded to registration, both to Mastercard:

1. Applicant: Mastercard International  
Application no.: 815400  
Filed: 1996  
Status: Registered



Mark Descriptive Reference:  
MASTERCARD GLOBE HOLOGRAM  
DESIGN

2. Applicant: Mastercard International  
Application no.: 1020894  
Filed: 1999  
Status: Registered



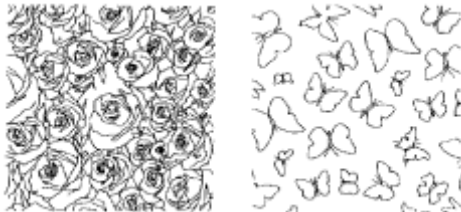
Mark Descriptive Reference:  
1997 MASTERCARD GLOBE  
HOLOGRAM DESIGN

3. Applicant: Smithkline Beecham Inc.  
Application no.: 0835927  
Filed: 1997  
Status: Abandoned



Description: The trade-mark consists of a hologram reflecting all colours, or any colour, of the light spectrum (an example of which appears in the graphic representation of the mark which is attached hereto and which forms part of this application) which is applied to the packaging of wares stated in the specification of wares. A formal drawing, the purpose of which is to depict the background design of the hologram, is attached hereto; the square shape shown in dashed outline does not form part of the trade-mark.

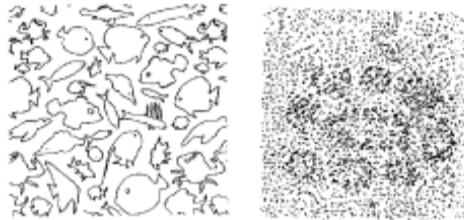
4. Applicant: Jeanne Lottie's Fashion Inc.  
Application no.: 1002075  
Filed: 1999  
Status: Abandoned



Description: The trade-mark consists of

a hologram applied to the wares, and as viewed from one angle depicts a repeating pattern of roses, and from another angle a repeating pattern of butterflies, with these patterns being superimposed in whole or in part when viewed from still other angles. A graphic representation of the mark illustrating the separate repeating patterns is attached to form a part of the application

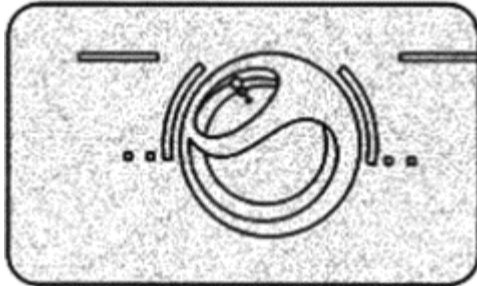
5. Applicant: Jeanne Lottie's Fashion Inc.  
Application no.: 1002079  
Filed: 1999  
Status: Abandoned



Description: The trade-mark consists of a hologram applied to the wares, and as viewed from one angle depicts a repeating pattern of fish, and from another angle a repeating pattern of coral, with these patterns being superimposed in whole or in part when viewed from still other angles. A graphic representation of the mark illustrating the separate repeating patterns is attached to form a part of the application



6. Applicant: Sony Ericsson  
Application no.: 1404448  
Filed: 2008  
Status: In examination



Description: The stippling in the mark represents the hologram with iridescent effect superimposed on the design elements

The Mastercard hologram appears to be the first Canadian filing for a trade-mark comprising a hologram. No objections were raised with respect to the hologram component, and the mark proceeded to registration. However none of the subsequent filings by other applicants made it to registration.

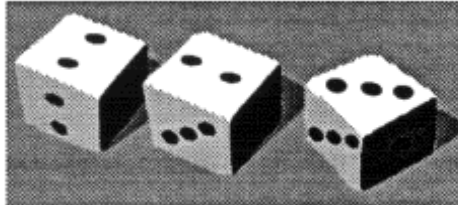
We have not seen the same type of objections raised in the U.S. for hologram trade-marks, of which there are many.

### Kinetic marks

Kinetic marks are also called animated marks or moving marks.

We found four Canadian trade-mark applications, none of which proceeded to registration:

1. Applicant: Open Master Limited  
Application no.: 1026843  
Filed: 1999  
Status: Withdrawn



Description: The trade mark consists of an animated sequence of images depicting a spinning die, which has three three-dotted faces and three two-dotted faces. The trade mark is not lined for colour and colour is not claimed as a feature of the trade mark. The drawing is lined for shading purposes only.

2. Applicant: Yell Limited  
Application no.: 1079243  
Filed: 2000  
Status: Abandoned



Description: The moving image design mark consists of an animated visual sequence depicting a square with rounded corners and the letters Y, E, L and L. After the initial display of the empty square dot with rounded corners for a few seconds, the letters Y, E, L and L appear in succession inside the square, so as to spell the word YELL. The letters are separated by a brief display of the empty square. The drawing consists of eight stills that make up the animated sequence.

3. Applicant: RKO Pictures  
Application no.: 1142591  
Filed: 2002  
Status: Abandoned



Description: The mark consists of the words RKO PICTURES, with a radio tower standing atop an Earth-like globe, against a background of clouds and an atmosphere. The mark is displayed as a moving image sequence in which seven concentric circles representing radio waves appear one at a time as they are "broadcast" from the tower. The moving image is synchronized with a melodic musical phrase and a rhythmic monotone phrase calling to mind a fanciful Morse code signal.

4. Applicant: Deutsche Telekom  
Application no.: 1150481  
Filed: 2002  
Status: Abandoned



Description: The trade-mark consists of a unique animated sequence of images in motion whereby the letter "T" is depicted as the final position of a movement bringing one hand and arm into a vertical position and the second hand and arm into a horizontal position, with the fingertips of the vertical hand and arm touching the palm of the horizontal hand and arm at a right angle. In particular, the right hand (from the spectator's point of view) moves from the bottom left portion of the screen to the center of the screen. The fingertips point up and only the ridge of the hand is visible. At the same time, the left hand moves from the top right portion of the screen into the center of the screen. Again, the fingertips point up and only the ridge of the hand is visible. Both hands meet in the center of the screen. The tips of the right hand touch the palm of the left hand at a right angle. The spectator watches the left hand move from top to center coming to rest on the fingertips of the right hand and recognises the letter "T" formed by the two hand, as the result of the movement. The "T" formation is illustrated in the attached photographs showing the start and the end of the animation sequence.

As with holograms, CIPO uses the Regulations and the Trade-marks Act to deny these marks on the basis that an animation is a multiplicity of marks, and cannot be accurately represented with drawings.

#### Is CIPO's hard-line stance justified?

As we have seen, CIPO takes a very restrictive approach as to what qualifies as a registrable trade-mark, contrary to the U.S. approach which is much more relaxed. However, CIPO clearly recognizes the trend towards business adopting non-traditional trade-marks and the antiquated Canadian approach.

In a letter to the profession dated February 24, 2005, entitled "Proposals for Comment Relating to Modernization of the Trade-Marks Act", CIPO solicited comments on, among other things, the acceptability of non-traditional trade-marks. The letter indicates their view that the current Act, when read in conjunction with the Playboy case, does not allow for registration of non-traditional trade-marks and needs to be modernized.

If we compare the Canadian definition of "trade-mark" with the U.S. definition, they are not so different.

The Canadian definition, once again, is:

"a mark that is used by a person for the purposes distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired, or performed by him from those manufactured, sold, leased, hired, or performed by others"

The U.S. definition is:

"any word, name, symbol, or device, or any combination thereof, used by a person...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods..." (Lanham Act, s. 45)

The U.S. Act also has a provision in s. 2 which states that unless a trademark falls within one of six enumerated grounds for refusal, no trademark shall be refused registration on account of its nature:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to

(1) the earliest of the filing dates of the applications pending or of any registration issued under this Act;

(2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or

(3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant

which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act. A mark which when used would cause dilution under section 43(c) may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which when used would cause dilution under section 43(c) may be canceled pursuant to a proceeding brought under either section 14 or section 24.

In the U.S. case of *Re General Electric Broadcasting* 199 USPQ 560 (TTAB, 1978), the applicant appealed the Examiner's refusal to register the sound of a ship's bell clock in association with radio broadcasting services. The Appeal Board affirmed the refusal on the basis that there was no evidence that it had become distinctive of the applicant's service, but had it been shown to be distinctive they would have allowed it. They noted that the drafters of the Act did not define "service mark" because they were mindful of the various different types of marks, devices, symbols, and the like that are and may be used to identify services rendered in commerce. They said:

In view of this flexible approach toward the concept of what constitutes a service mark or a trademark, a flexibility that is required in order to keep up with the ever-changing ramifications brought about by the changing technology that accompanies the growth of a nation and creates goods, services, and concepts unheard of in the past, the Patent and Trademark Office has recognized that a mark need not be confined to a graphic form.

The U.S. Court said this 10 years before the Playboy case!

## Conclusion

To sum up, the status quo in Canada is that non-visual marks such as sound, smell and taste are currently not registrable because of the TMO's rigid interpretation of the *Playboy* case. Likewise, colour per se is unregistrable because of comments made in the *Parke, Davis & Co.* and *Smith, Kline & French* cases. Holograms have so far been unregistrable because CIPO considers them a "multiplicity of marks", and kinetic marks have thus far been unregistrable because CIPO maintains they cannot be accurately depicted in a single drawing. What the Federal Court of Canada would say, however, if anyone took these issues on appeal, I do not know.



# **SIM** & **McBURNERY** **LOWMAN ASHTON & MCKAY** LLP

Sim & McBurney, Patent & Trade-mark Agents | Sim Lowman Ashton & McKay LLP, Barristers & Solicitors

Protecting Ingenuity Everywhere™



# **NON-TRADITIONAL TRADE-MARKS IN CANADA**

**Toni Polson Ashton  
Sim & McBurney  
Toronto, Canada**

# Overview

1. Trade-marks generally
2. What is a trade-mark?
3. Non-traditional trade-marks and CIPO's position
  - Sound
  - Smell
  - Taste
  - Touch/Sensory
  - Colour per se
  - Holograms
  - Kinetic Marks
4. Is CIPO's stance justified?
5. Conclusion

# Word Marks

**TWITTER**

Twitter Inc.

**IPHONE**

Apple Inc.

**GOOGLE**

Google Inc.

**WHERE DO YOU WANT TO GO TODAY**

Microsoft Corp.

# Design Marks



Nike Inc.



Apple Inc.



Ferrari S.p.A.

# Word and Design Marks

**Bell**

Bell Canada

Wii

Nintendo of America Inc.

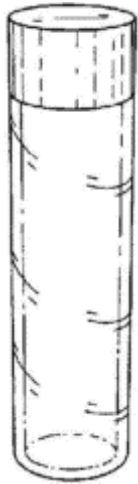


TiVo Inc.

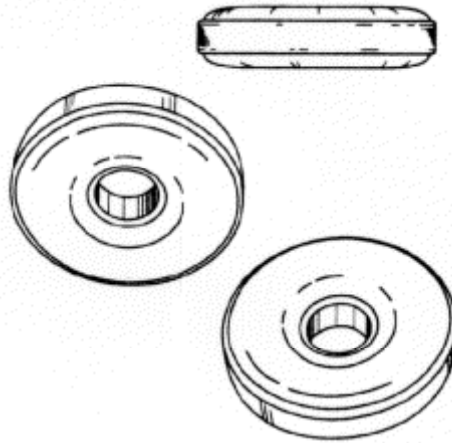
 **BlackBerry**

Research in Motion Ltd.

# Distinguishing Guises



Voss water bottle  
TMA751978  
(Voss of Norway ASA)



Life Savers candy  
TMA562616  
(Kraft Foods Holdings, Inc.)

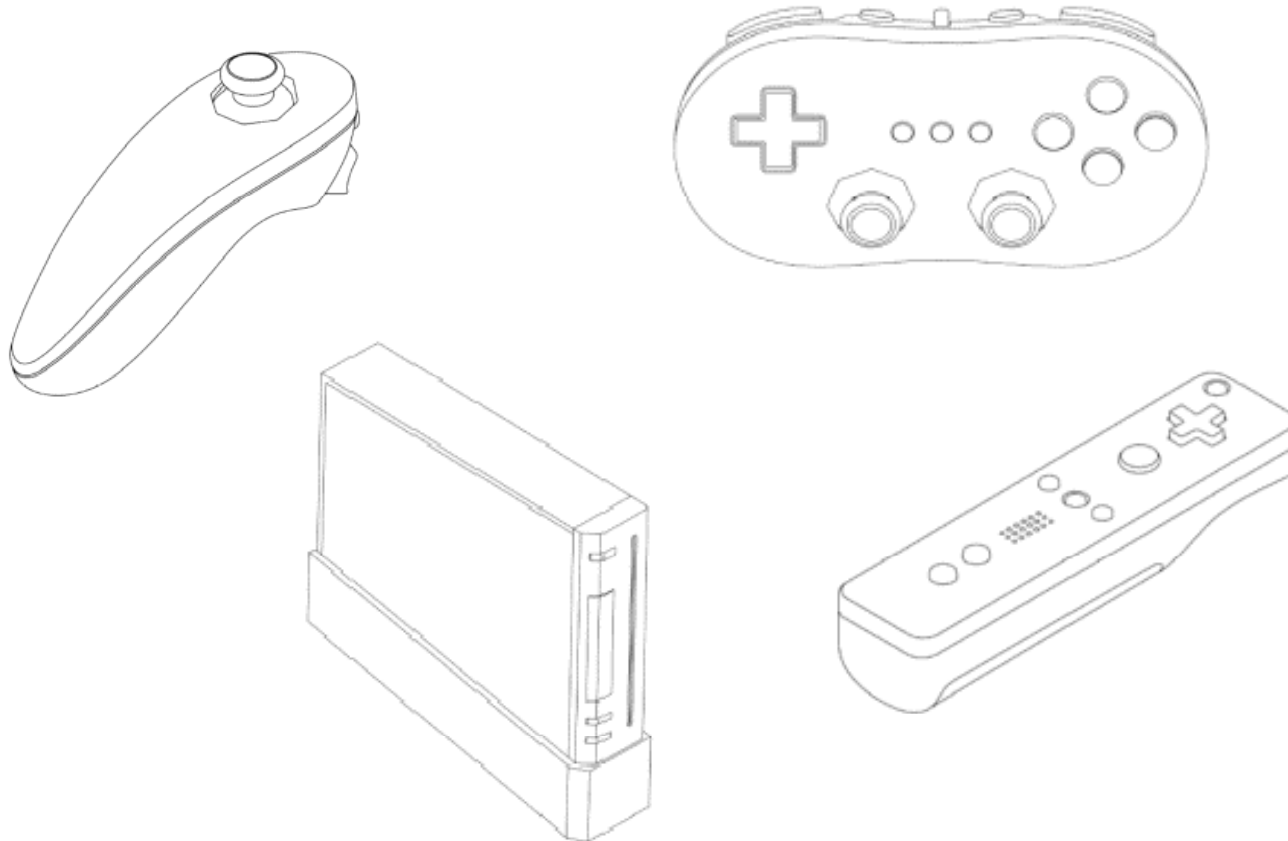


Coca-Cola bottle  
UCA044193  
(Coca-Cola Ltd.)

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# Distinguishing Guises

Game console and controllers by Nintendo of America, Inc. (not yet registered):

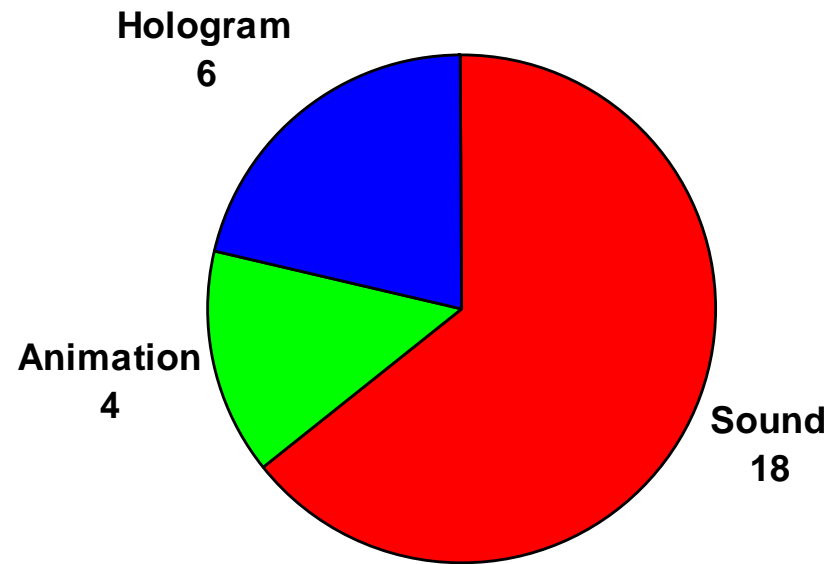




# Non-traditional trade-marks

- Sound
- Smell
- Taste
- Touch
- Colour?
- Hologram
- Kinetic (moving)

# Non-traditional TM applications in CIPO



# Trade-mark

The term “trade-mark” is defined in the Trade-marks Act, R.S.C. 1985, c. T-13 (the “Act”), as

"trade-mark" means, inter alia,

- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others, or
- (b) a distinguishing guise.

# Trade-mark

Three elements to a trade-mark:

1. “Mark” – not defined in the Act
2. “Used” – at the time of transfer or possession of property; advertisement or performance of service
3. “For the purpose of distinguishing” – must not serve a functional purpose

# Trade-mark

Additional administrative requirement:

- Must be accurately and precisely described

# Sound Marks

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The mark consists of 11 musical notes comprising the notes:  
WAVE: C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> C<sub>4</sub> E<sub>4</sub> G<sub>4</sub> C<sub>5</sub>  
FREQUENCY: 425 425 425 425 425 425 425 425 425 425 425

## REGISTRANT:

CAPITOL RECORDS, INC.,

## MARK DESCRIPTIVE REFERENCE:

**MUSICAL NOTES DESIGN**

## WARES:

- (1) Phonograph records, magnetic tapes, audio and video tapes, audio and video cassettes and motion picture film.
- (2) Pre-recorded audio tapes and phonograph records.

## SERVICES:

- (1) Professional electronic and engineering services in the field of sound monitoring and duplication for others.

## APPLICATION NUMBER:

0553825

## REGISTRATION NUMBER:

TMA359318

## STATUS:

EXPUNGED – non renewal

## FILED:

1985-12-06

## REGISTERED:

1989-08-11

# Sound Marks

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**TRADE-MARK:**

**YAHOO! Sound Mark**

**APPLICATION NUMBER:**

1051714

**STATUS:**

ABANDONED

**FILED:**

2000-03-22

**APPLICANT:**

YAHOO! INC.,

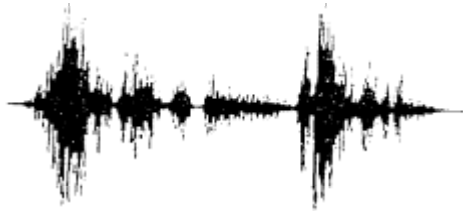
**TRADE-MARK: YAHOO! Sound Mark**

**SERVICES:**

- (1) Promoting the goods and services of others by placing advertisements and promotional displays in an electronic ... etc.
- (2) Computer services and online computer services, namely creating indexes of information, websites, and other ... etc.

# Sound Marks

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**APPLICATION NUMBER:**

0714314

**STATUS:**

In examination

**FILED:**

1992-10-06

**APPLICANT:**

METRO-GOLDWYN-MAYER LION CORP.,

**MARK DESCRIPTIVE REFERENCE:**

**ROARING LION (SOUND ONLY) DESIGN**

**WARES:**

(1) Motion pictures films and pre-recorded video tapes.

**SERVICES:**

(1) Motion picture services; entertainment services by distribution of motion pictures.

(2) Entertainment services, namely, production and distribution of motion pictures and providing film and tape entertainment for viewing through the media of television, cinema and other media.



# Sound Marks

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**TRADE-MARK:**  
**SOUND MARK**

**APPLICATION NUMBER:**

1229348

**STATUS:**

ABANDONED

**FILED:**

2004-09-03

**APPLICANT:**

TELLME NETWORKS, INC.

**TRADE-MARK:** SOUND MARK

**TRADE-MARK DESCRIPTION:**

The mark consists of a musical jingle in the key of C, comprised of two notes in sequence of F, C and any relative equivalent thereof.

**SERVICES:**

(1) ONLINE AND TELEPHONE PROVISION OF CONTENT, NAMELY, BUSINESS NEWS, BUSINESS INFORMATION, ELECTRONIC COMMERCE INFORMATION, ..etc.

# Sound Marks

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**TRADE-MARK:**  
**MISTER SOFTEE MUSIC**

**APPLICATION NUMBER:**

1464830

**REGISTRATION NUMBER:**

not registered

**STATUS:**

In examination

**FILED:**

2009-12-30

**APPLICANT:**

MISTER SOFTEE INC.

**TRADE-MARK: MISTER SOFTEE MUSIC**

**TRADE-MARK DESCRIPTION:**

The sound mark consists of a musical jingle composed of sixteen notes in the key of E flat, in the sequence of Bb-C-Bb-G-F-Eb-F-Eb-C-Eb-D-Eb-F-Bb-G-Eb.

**SERVICES:**

(1) Sale of soft ice cream and products containing ice cream, namely, milk shakes, sundaes, ice cream cones, frozen fruit confections on a stick and ice drinks, by roving vehicles.

# Sound Marks

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**NUMBER:**

0858570

**REGISTRATION NUMBER:**

not registered

**STATUS:**

ABANDONED

**FILED:**

1997-10-14

**APPLICANT:**

INTEL CORPORATION

**MARK DESCRIPTIVE REFERENCE:**

**SOUND DESIGN**

**TRADE-MARK DESCRIPTION:**

The trade mark consists of a five tone audio progression of the notes D FLAT, D FLAT, G, D FLAT and A FLAT.

**WARES:**

(1) Computer hardware and software, namely microprocessors, integrated circuits, integrated circuit chips, semiconductor devices, security devices, ..etc.

# Sound Marks

---

**TRADE-MARK:**

Hockey Theme (Opening)  
**SOUND** mark as represented  
by the sheet music.

**APPLICATION NUMBER:**

1435197

**REGISTRATION NUMBER:**

not registered

**STATUS:**

In examination

**FILED:**

2009-04-20

**APPLICANT:**

CTV Television Inc.

**TRADE-MARK:** Hockey Theme (Opening) **SOUND** mark as represented by the sheet music

**SERVICES:**

(1) Entertainment services, namely the production, recording and broadcast of hockey games through the media of television and through the media of a global computer network via the Internet on the World Wide Web.

## *Playboy Enterprises Inc. v. Germain (1987)*

“use of a verbal description is not use of a trade mark within the meaning of the *Trade Marks Act*...a ‘mark’ must be something that can be represented visually... the trade mark must be something that can be seen”

- 16 C.P.R. (3d) 517 (Federal Court of Canada – Trial Division)

# Sound Marks

---

## Procedural objections:

- Mark is not accurately described e.g. tempo, stress, volume
- No administrative procedures for searching, analyzing, or advertising sound marks
- Unable to determine whether the mark is confusing with any other co-pending sound mark

# Sound Marks

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“Not accurately described”:

-Which instrument?

-How many musicians?

-Professional or amateur?



# Sound Marks

---

“the Registrar would be prepared to accept a statement describing the marks as follows:  
The trade-mark consists of the following representation of the sound, and does not consist of the sound itself””



Applicant: Intel

Application no.: 0858570

Filed: 1997

Status: Abandoned



# Smell as a Trade-mark

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- scent cannot serve a functional purpose
- for wares, must be apparent to the consumer at the time of the transfer or possession of the wares and marked on the wares themselves
- must be capable of being accurately and precisely described in the trade-marks Register

# Smell Marks (U.S.)

---

**Registration Number:** 3140701

**Filing Date:** June 13, 2005

**Registration Date:** September 5, 2006

**Owner:** The Smead Manufacturing Company

**Description of Mark:** The mark consists of an apple cider scent or fragrance.

**Goods and Services:** Office supplies, namely, file folders, hanging folders, paper expanding files.



# Holiday warmth™

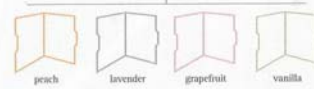
APPLE CIDER SCENTED

## 12

SCENTED  
FILE FOLDERS  
LETTER SIZE



SCENTS  
ALSO  
AVAILABLE



. 11982  
mum 10% Post-Consumer  
cled Content



Holiday Warmth is a trademark of The Smead Manufacturing Company.  
©Smead and the three bars are all registered trademarks  
of The Smead Manufacturing Company, Hastings, MN.  
www.smead.com

# Smell Marks (U.S.)

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**Registration Number:** 3589348

**Filing Date:** March 13, 2008

**Registration Date** March 10, 2009

**Owner:** Hisamitsu Pharmaceutical Co., Inc.

**Description of Mark:** The mark is a scent mark having a minty scent by mixture of highly concentrated methyl salicylate (10wt%) and menthol (3wt%).

**Goods and Services:** Medicated transdermal patches for the temporary relief of aches and pains of muscles and joints associated with arthritis, simple backaches, strains, bruises and sprains.

**SALONPAS**  
**PAIN RELIEF PATCH**  
 PAIN RELIEVING PATCH

Press  
 Open

minty scent  
 Package not child resistant.  
 Keep out of reach of children.

**Drug Facts**

**Active ingredients (in each patch)**

Active ingredients (in each patch)	Purpose
Menthol 3%.....	Topical analgesic
Methyl salicylate 10%(NSAID)*.....	Topical analgesic *nonsteroidal anti-inflammatory drug

**Uses**

Temporarily relieves mild to moderate aches & pains of muscles & joints associated with:  
 ■ strains ■ sprains ■ simple backache ■ arthritis ■ bruises

**Warnings**

For external use only

**Stomach bleeding warning:** This product contains an NSAID, which may cause stomach bleeding. The chance is small but higher if you:  
 ■ are age 60 or older ■ have had stomach ulcers or bleeding problems ■ take a blood thinning (anticoagulant) or steroid drug ■ take other drugs containing an NSAID (aspirin, ibuprofen, naproxen, or others) ■ have 3 or more alcoholic drinks every day while using this product ■ take more or for a longer time than directed

**Do not use**

■ on the face or rashes ■ on wounds or damaged skin ■ if allergic to aspirin or other NSAIDs ■ with a heating pad ■ when sweating (such as from exercise or heat) ■ any patch from a pouch that has been open for 14 or more days ■ right before or after heart surgery

**Ask a doctor before use if**

■ you are allergic to topical products ■ the stomach bleeding warning applies to you ■ you have high blood pressure, heart disease, or kidney disease ■ you are taking a diuretic

**When using this product**

■ wash hands after applying or removing patch. Avoid contact with eyes. If eye contact occurs, rinse thoroughly with water. ■ the risk of heart attack or stroke may increase if you use more than directed or for longer than directed

**Stop use and ask a doctor if**

■ you feel faint, vomit blood, or have bloody or black stools. These are signs of stomach bleeding. ■ rash, itching or skin irritation develops ■ condition worsens ■ symptoms last for more than 3 days ■ symptoms clear up and occur again within a few days ■ stomach pain or upset gets worse or lasts

**If pregnant or breast-feeding**, ask a doctor before use during the first 6 months of pregnancy. Do not use during the last 3 months of pregnancy because it may cause problems in the unborn child or complications during delivery.

**Keep out of reach of children.** If put in mouth, get medical help or contact a Poison Control Center right away. Package not child resistant.

**Directions**

**Adults 18 years and older:**

■ clean and dry affected area ■ remove patch from backing film and apply to skin (see illustration) ■ apply one patch to the affected area for up to 8 to 12 hours ■ if pain lasts after using the first patch, a

**Drug Facts (Continued)**  
**Other information**  
 ■ some individuals may not experience pain relief until several hours after applying the patch ■ avoid storing product in direct sunlight ■ protect product from excessive moisture ■ store at 20-25°C (68-77°F)

**Inactive ingredients**  
 atactic polypropylene, hydrocarbon resin, backing film, mineral oil, polyisobutylene, polyisobutylene-styrene-isoprene-styrene block copolymer, synthetic silicone

# Smell Marks (U.S.)

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**Registration Number:** 2463044

**Filing Date:** August 25, 1995

**Registration Date:** June 26, 2001

**Owner:** Mike Mantel d.b.a. Manhattan Oil

**Description of Mark:** The mark consists of a cherry scent.

**Goods and Services:** Synthetic lubricants for high performance racing and recreational vehicles.

Specimen for  
14/120993

# Taste Marks (U.S.)

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**Serial Number:** 77317342

**Filing Date:** October 30, 2007

**Applicant:** Herbal Water, Inc.

**Description of Mark:** The NON-VISUAL MARK is for the distinctive flavor combination of lavender, mint, lemon grass, and thyme.

**Goods and Services:** Non-alcoholic flavored beverages



# Taste Marks (U.S.)

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**Serial Number:** 76467774

**Filing Date:** November 18, 2002

**Applicant:** N.V. Organon

**Description of Mark:** This trademark application is for an orange flavor.

**Goods and Services:** Pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills

# Touch/Sensory Marks (U.S.)

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**Registration Number:** 3155702

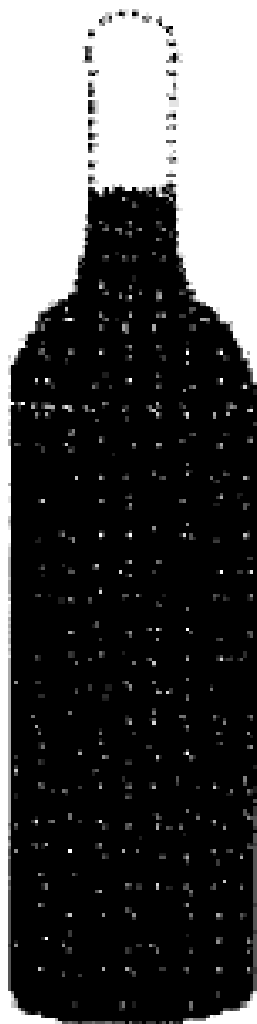
**Filing Date:** March 23, 2005

**Registration Date:** October 17, 2006

**Owner:** American Wholesale Wine & Spirits, Inc.

**Description of Mark:** The mark consists of a velvet textured covering on the surface of a bottle of wine. The dotted line in the drawing is not a feature of the mark but is intended to show the location of the mark on a typical container for the goods; the dark/lower part of the container drawing shows the mark. The stippling in the drawing is not a feature of the mark, but a representation of how one type of velvet covering may appear in visual form. The mark is a sensory, touch mark.

**Goods and Services:** Wines



# Touch/Sensory Marks (U.S.)

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**Serial Number:** 85007641

**Filing Date:** April 6, 2010

**Applicant:** G. Pohl-Boskamp GmbH & Co. KG

**Description of Mark:** The mark consists of the distinctive touch and feel of a glass pump spray bottle with a plasticized surface. The pump spray bottle has a smooth surface with a weightiness, thickness and durability imparted by the glass; simultaneously the bottle has a lightness and rubber-like quality imparted by the plasticized coating.

**Goods and Services:** Medicines, namely, pharmaceutical formulations of nitroglycerin.



NDC 38930-300-20

**Nitrolingual® Pumpspray**

(nitroglycerin lingual spray)

400 mcg per Spray, 200 Metered Sprays

12 g Net Contents

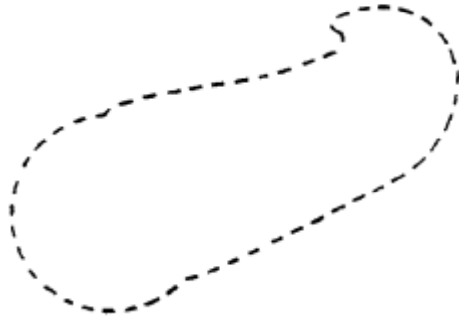
Rx Only

Manufactured for  
Sciele™ Pharma, Inc.,  
Atlanta, GA 30328

by G. POHL-BOSKAMP GmbH & Co. KG, Germany

# Colour Marks

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**REGISTRANT:**

Owens-Corning Canada Inc.

**MARK DESCRIPTIVE REFERENCE:**

**PINK (COLOUR)**

**TRADE-MARK DESCRIPTION:**

The trade-mark consists of the colour pink as applied to the whole of the visible surface of the particular slug of polyurethane foam sealant shown in dotted outline in the attached drawing.

**WARES:**

(1) Polyurethane foam sealant.

**APPLICATION NUMBER:**

1086788

**REGISTRATION NUMBER:**

TMA577805

**STATUS:**

REGISTERED

**FILED:**

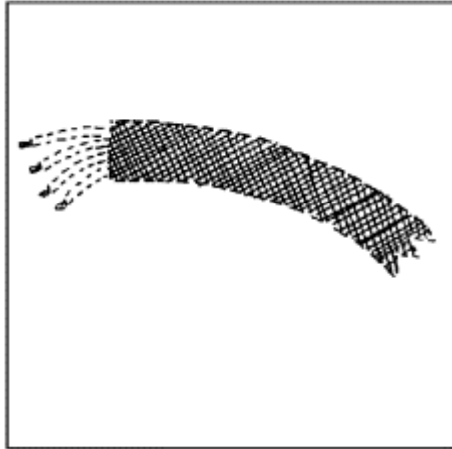
2000-12-19

**REGISTERED:**

2003-03-20

# Colour Marks

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**APPLICATION NUMBER:**

0818239

**REGISTRATION NUMBER:**

TMA480533

**STATUS:**

REGISTERED

**FILED:**

1996-07-18

**REGISTERED:**

1997-08-14

**REGISTRANT:**

2881403 CANADA INC.

**MARK DESCRIPTIVE REFERENCE:**

**ORANGE CABLE DESIGN**

**COLOUR CLAIM:**

The mark consists of the colour orange as applied to an electronic cable used in the building automation industry namely for heating, ventilation and air conditioning and the colour orange is claimed as a feature of the trade-mark.

**TRADE-MARK EXCLUSION:**

The representation of the wares shown in dotted outline does not form part of the trade-mark.

**WARES:**

(1) Electronic cables used in the building automation industry namely for heating, ventilation and air conditioning.

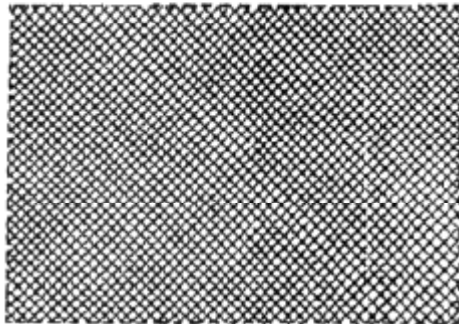
# Colour Marks

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- Colour per se unregistrable because of obiter comments in *Parke, Davis & Co. v. Empire Laboratories Ltd.*, [1964] Ex. C.R. 399, and in *Smith, Kline & French Canada Ltd. v. Canada (Registrar of Trade-marks) (No.2)* [1987] 2 F.C. 633
- In both cases the subject trade-mark was not a colour per se mark, but the Court said if it were it would have been invalid



# Colour Marks



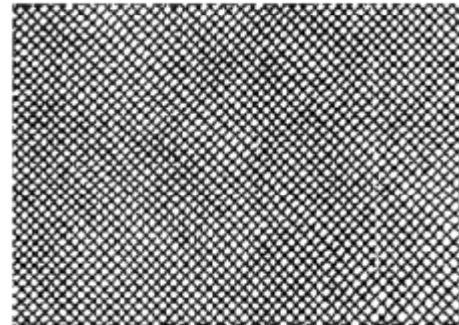
**APPLICATION NUMBER:**  
1028879  
**REGISTRATION NUMBER:**  
TMA577002  
**STATUS:**  
REGISTERED  
**FILED:**  
1999-09-14

**REGISTRANT:**  
HERSHEY CANADA INC.,

**MARK DESCRIPTIVE REFERENCE:**  
**ORANGE DESIGN**

**TRADE-MARK DESCRIPTION:**  
The trade-mark consists of the colour orange applied to the whole of the visible surface of the particular packaging as shown in the attached drawing. The orange colour is approximately equivalent to Pantone\*165C. \*Registered Trade-mark.

**WARES:**  
(1) Candy.



**APPLICATION NUMBER:**  
1046966  
**REGISTRATION NUMBER:**  
TMA576619  
**STATUS:**  
REGISTERED  
**FILED:**  
2000-02-16

**REGISTRANT:**  
HERSHEY CANADA INC.,  
**MARK DESCRIPTIVE REFERENCE:**  
**ORANGE DESIGN**

**TRADE-MARK DESCRIPTION:**  
The trade-mark consists of the colour orange applied to the whole of the visible surface of the particular packaging as shown in the attached drawing.

**WARES:**  
(1) Ice cream toppings.  
(2) Peanut butter.

# Holograms



**APPLICATION NUMBER:**

0815400

**STATUS:**

REGISTERED

**REGISTRATION NUMBER:**

TMA515834

**FILED:**

1996-06-14

**APPLICANT:**

MASTERCARD INTERNATIONAL  
INCORPORATED

**MARK DESCRIPTIVE REFERENCE:**

**MASTERCARD GLOBE HOLOGRAM DESIGN**

**SERVICES:**

(1) Financial services, namely providing credit card, debit card, charge card, cash disbursement and transaction authorization and settlement services.



**APPLICATION NUMBER:**

1020894

**STATUS:**

REGISTERED

**REGISTRATION NUMBER:**

TMA545538

**FILED:**

1999-06-30



**APPLICANT:**

MASTERCARD INTERNATIONAL  
INCORPORATED

**MARK DESCRIPTIVE REFERENCE:**

**1997 MASTERCARD GLOBE HOLOGRAM  
DESIGN**

**SERVICES:**

(1) Financial services relating to the issuance and use of bank type cards, namely credit and debit cards; providing credit card, debit card, ... etc.

# Holograms

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**APPLICATION NUMBER:**

0835927

**STATUS:**

ABANDONED

**FILED:**

1997-02-10

**APPLICANT:**

SMITHKLINE BEECHAM INC.

**MARK DESCRIPTIVE REFERENCE:**

**HOLOGRAM DESIGN**

**TRADE-MARK DESCRIPTION:**

The trade-mark consists of a hologram reflecting all colours, or any colour, of the light spectrum (an example of which appears in the graphic representation of the mark which is attached hereto and which forms part of this application) which is applied to the packaging of wares stated in the specification of wares. A formal drawing, the purpose of which is to depict the background design of the hologram, is attached hereto; the square shape shown in dashed outline does not form part of the trade-mark.

**WARES:**

(1) Non-medicated toilet preparations; dentifrices; mouthwashes; dental floss; toothbrushes.

# Holograms



**APPLICATION NUMBER:**

1002075

**STATUS:**

ABANDONED

**FILED:**

1999-01-14

**APPLICANT:**

JEANNE LOTTIE'S FASHION  
INCORPORATED

**MARK DESCRIPTIVE REFERENCE:**

**BUTTERFLIES/ROSES DESIGN**

**TRADE-MARK DESCRIPTION:**

The trade-mark consists of a hologram applied to the wares, and as viewed from one angle depicts a repeating pattern of roses, and from another angle a repeating pattern of butterflies, with these patterns being superimposed in whole or in part when viewed from still other angles. A graphic representation of the mark illustrating the separate repeating patterns is attached to form a part of the application.

**WARES:**

(1) Handbags.



**APPLICATION NUMBER:**

1002079

**STATUS:**

ABANDONED

**FILED:**

1999-01-14

**APPLICANT:**

JEANNE LOTTIE'S FASHION  
INCORPORATED

**MARK DESCRIPTIVE REFERENCE:**

**FISH/CORAL DESIGN**

**TRADE-MARK DESCRIPTION:**

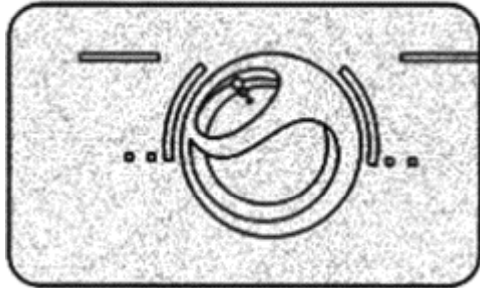
The trade-mark consists of a hologram applied to the wares, and as viewed from one angle depicts a repeating pattern of fish, and from another angle a repeating pattern of coral, with these patterns being superimposed in whole or in part when viewed from still other angles. A graphic representation of the mark illustrating the separate repeating patterns is attached to form a part of the application.

**WARES:**

(1) Handbags.

# Holograms

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**APPLICATION NUMBER:**

1404448

**STATUS:**

In examination

**FILED:**

2008-07-23

**APPLICANT:**

Sony Ericsson Mobile Communications AB

**MARK DESCRIPTIVE REFERENCE:**

**Hologram DESIGN**

**TRADE-MARK DESCRIPTION:**

The stippling in the mark represents the hologram with iridescent effect superimposed on the design elements

**WARES:**

- (1) Accessories for cellular or mobile phones in the nature of batteries.
- (2) Accessories for cellular or mobile phones in the nature of headsets; accessories for cellular or mobile phones in the nature of devices for hands-free phone use; ...etc.

# Holograms

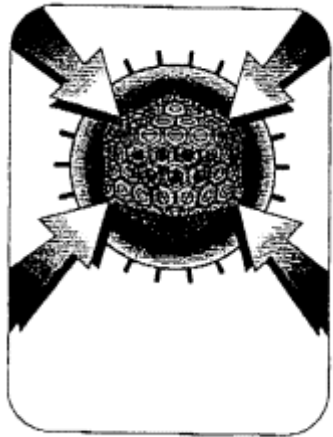
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What it looks like:



# Holograms

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**APPLICATION NUMBER:**

0725806

**STATUS:**

ABANDONED - SECTION 40(3)

**FILED:**

1993-03-29

**APPLICANT:**

THE WELLCOME FOUNDATION LIMITED

**MARK DESCRIPTIVE REFERENCE:**

**HOLOGRAM DEVICE DESIGN**

**WARES:**

(1) Anti-viral pharmaceutical and medicinal preparations and substances.

# Kinetic Marks (U.S.)

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**Registration Number:** 1928424

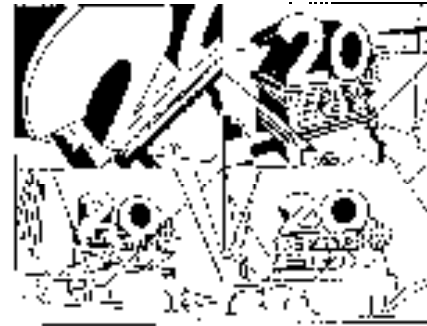
**Filing Date:** December 2, 1994

**Registration Date:** October 17, 1995

**Owner:** Twentieth Century Fox Film Corporation

**Description of Mark:** The trademark is a computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four "stills" from the sequence.

**Goods and Services:** Production and distribution of motion picture films, pre-recorded video tapes, pre-recorded video cassettes, and pre-recorded videodiscs.





# Kinetic Marks

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**APPLICATION NUMBER:**

1142591

**STATUS:**

ABANDONED

**FILED:**

2002-05-31

**APPLICANT:**

RKO Pictures, Inc.

**MARK DESCRIPTIVE REFERENCE:**

**RKO - Moving Image of Globe & Tower Design**

**TRADE-MARK DESCRIPTION:**

The mark consists of the words RKO PICTURES, with a radio tower standing atop an Earth-like globe, against a background of clouds and an atmosphere. The mark is displayed as a moving image sequence in which seven concentric circles representing radio waves appear one at a time as they are "broadcast" from the tower. The moving image is synchronized with a melodic musical phrase and a rhythmic monotone phrase calling to mind a fanciful Morse code signal.

**WARES:**

- (1) Prerecorded optical and magnetic media featuring motion pictures films.
- (2) Prerecorded optical and magnetic media featuring television films, animation, live action, comedy and music.
- (3) Prerecorded audio cassettes.
- (4) Prerecorded video tapes; prerecorded electronic media featuring motion picture and television films, animation, live action, comedy and music; computer software in the field of entertainment features.
- (5) Prerecorded compact discs, laser discs, CD-ROMs, DVDs and DVD-ROMs.
- (6) Prerecorded compact discs, laser discs, CD-ROMs, DVDs, DVD-ROMs, ...etc.

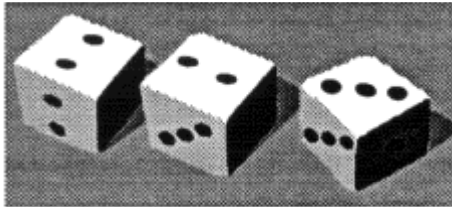
**SERVICES:**

- (1) Entertainment services, namely producing, marketing, exhibiting, ...etc.
- (2) Entertainment services, namely producing, marketing, exhibiting, leasing and distributing television films.
- (3) Recording and distributing audio cassettes, videotapes, laser discs, ...etc.
- (4) Producing, marketing, exhibiting, leasing and distributing multi-media entertainment.



# Kinetic Marks

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**APPLICANT:**

OPEN MASTER LIMITED

**MARK DESCRIPTIVE REFERENCE:**

**SPINNING DICE DESIGN**

**TRADE-MARK DESCRIPTION:**

The trade mark consists of an animated sequence of images depicting a spinning die, which has three three-dotted faces and three two-dotted faces. The trade mark is not lined for colour and colour is not claimed as a feature of the trade mark. The drawing is lined for shading purposes only.

**WARES:**

(1) Computers, computer hardware, computer software, computer programs, computer peripheral devices, computer hardware and software for multimedia and interactive computer games, games and playthings; dice.

**SERVICES:**

(1) Computer games services; provision of information relating to computer games; ...etc.

**APPLICATION NUMBER:**

1026843

**STATUS:**

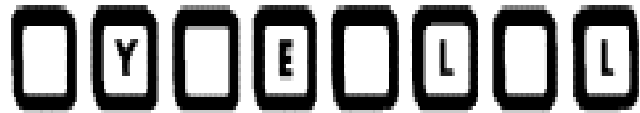
ABANDONED

**FILED:**

1999-08-25

# Kinetic Marks

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**APPLICATION NUMBER:**

1079243

**STATUS:**

ABANDONED

**FILED:**

2000-10-18

**APPLICANT:**

Yell Limited

**MARK DESCRIPTIVE REFERENCE:**

**Animated YELL & Design**

**TRADE-MARK DESCRIPTION:**

The moving image design mark consists of an animated visual sequence depicting a square with rounded corners and the letters Y, E, L and L. After the initial display of the empty square dot with rounded corners for a few seconds, the letters Y, E, L and L appear in succession inside the square, so as to spell the word YELL. The letters are separated by a brief display of the empty square. The drawing consists of eight stills that make up the animated sequence.

**WARES:**

(1) Telecommunications goods; data communications goods; ...etc.

**SERVICES:**

(1) Business advisory, consultancy, research and information services; compilation, provision, ...etc.

# Kinetic Marks

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**APPLICATION NUMBER:**

1150481

**STATUS:**

ABANDONED

**FILED:**

2002-08-22

**APPLICANT:**

DEUTSCHE TELEKOM AG

**MARK DESCRIPTIVE REFERENCE:**

**T (Animation Mark) Design**



**TRADE-MARK DESCRIPTION:**

The trade-mark consists of a unique animated sequence of images in motion whereby the letter "T" is depicted as the final position of a movement bringing one hand and arm into a vertical position and the second hand and arm into a horizontal position, with the fingertips of the vertical hand and arm touching the palm of the horizontal hand and arm at a right angle.

In particular, the right hand (from the spectator's point of view) moves from the bottom

left portion of the screen to the center of the screen. The fingertips point up and only the ridge of the hand is visible. At the same time, the left hand moves from the top right portion of the screen into the center of the screen. Again, the fingertips point up and only the ridge of the hand is visible. Both hands meet in the center of the screen. The tips of the right hand touch the palm of the left hand at a right angle. The spectator watches the left hand move from top to center coming to rest on the fingertips of the right hand and recognises the letter "T" formed by the two hand, as the result of the movement. The "T" formation is illustrated in the attached photographs showing the start and the end of the animation sequence.

**WARES:**

- (1) Electric, electronical, optical, measuring, signalling, controlling or teaching apparatus ...etc.
- (2) Printed matter, namely stamped and/or printed note cards of cardboard or plastic; ...etc.

**SERVICES:**

- (1) Telecommunication services, namely network services, namely network call waiting services, ...etc.

# Definitions of “trade-mark”

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## Canada:

“a mark that is used by a person for the purposes distinguishing or so as to distinguish wares or services manufactured , sold, leased, hired, or performed by him from those manufactured , sold, leased, hired, or performed by others”

## U.S.:

“any word, name, symbol, or device, or any combination thereof, used by a person...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods...” (Lanham Act, s. 45)

# Some definitions of “device”

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- a thing made for a particular purpose; an invention or contrivance, esp. a mechanical or electrical one.
- a plan or scheme for effecting a purpose.
- something elaborately or fancifully designed.
- a representation or design used as a heraldic charge or as an emblem, badge, trademark, or the like.

-Random House Dictionary

.... - a technique or means....

-American Heritage Dictionary

# ***Re General Electric Broadcasting,***

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“In view of this flexible approach toward the concept of what constitutes a service mark or a trademark, a flexibility that is required in order to keep up with the ever-changing ramifications brought about by the changing technology that accompanies the growth of a nation and creates goods, services, and concepts unheard of in the past, the Patent and Trademark Office has recognized that a mark need not be confined to a graphic form.”

- 199 USPQ 560 (1978) (U.S. Patent and Trademark Trial and Appeal Board)

## ***Qualitex Co. v. Jacobson Products Co. Inc.***

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“it is the source-distinguishing capacity of a proposed mark that is significant, not its ontological status as color, shape, fragrance, word, or sign”

- 514 U.S. 159 (U.S. Supreme Court)



## ***In Re Vertex Group LLC***

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- sounds that are emitted by the wares in the normal course of operation are only registrable upon a showing of acquired distinctiveness
- 89 USPQ 2d 1694 (U.S. Patent and Trademark Trial and Appeal Board)

# Summary

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- Non-visual marks i.e. sound, smell and taste not registrable because of *Playboy*
- Colour per se not registrable because of *Parke, Davis & Co.* and *Smith, Kline & French*
- Holograms considered “multiplicity of marks” and unregistrable
- Kinetic marks “cannot be accurately depicted” and unregistrable
- What about Touch/Sensory? Never tested

# **Final Thoughts**

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**What would the Federal Court say?**

# **SIM** & **McBURNERY** **LOWMAN ASHTON & MCKAY** LLP

Sim & McBurney, Patent & Trade-mark Agents | Sim Lowman Ashton & McKay LLP, Barristers & Solicitors

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