

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATIONS

Applicant(s) : Lidl Stiftung & Co. KG
 For : THREE DIMENSIONAL MARK OF BOTTLE DESIGN
 Serial No. : 76/189,870
 Filed : January 4, 2001
 Examining Attorney : Mark Rademacher, Esq.
 Law Office 101
 Office Action : August 9, 2002



02-10-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

BOX TTAB FEE
 Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, VA 22202-3513

NOTICE OF APPEAL

Sir:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

Applicant also had submitted, on February 10, 2003, a Request for Reconsideration directed to the Examining Attorney, a copy of which is attached as Exhibit 1. Accordingly, Applicant respectfully requests that this appeal be suspended pending the Examining Attorney's consideration of Applicant's Request for Reconsideration.

Respectfully submitted,
 MORGAN & FINNEGAN, LLP

Maria C.H. Lin
 Reg. No. 29,323

Date: February 10, 2003

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EXPRESS MAIL CERTIFICATE

Express Mail Label No. EV 245 483 445US

Date of Deposit February 10, 2003

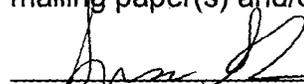
I hereby certify that the following attached paper(s) and/or fee

1. Notice of Appeal;
2. Copy of Response to Final Rejection as Exhibit 1;
3. Check of \$100.00 for appeal fee;
4. Postcard - self addressed and stamped.

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, Arlington, VA 22202-3513

Susan Shen

(Typed or printed name of person
 mailing paper(s) and/or fee)


 (Signature of person mailing
 paper(s) and/or fee)

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IN THE UNITED STATES P/
TRADEMARK EX



Applicant(s) : Lidl Stiftung & Co. KG
For : Three Dimensional Mark of Bottle Design
Serial No. : 76/189870
Filed : January 4, 2001
Examining Attorney : Mark Rademacher, Esq.
Law Office 101
Office Action : August 9, 2002

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Box: RESPONSES – NO FEE

RESPONSE

Sir:

This is in response to the Office Action dated August 9, 2002 for which a response is due February 10, 2003, February 9, 2003 being a Sunday.

AMENDMENT

Please amend the application by adding a description of the mark to be registered.

Description of Mark: The mark consists of a bottle for the goods wherein the cross section of the bottle is trapezoidal and having etched on one side of the bottle, a shield and a rectangle.

RESPONSE

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE SUBJECT MARK & CITED REGISTRATIONS

The Examiner has finally rejected the application on the grounds that the subject mark of a trapezoidal bottle design with shield and markings shown in the drawing as used in connection with the recited potable spirits is confusingly similar to

the triangular bottle design of the mark of Registration No. 2,258,388 for alcoholic beverages, namely scotch whiskey and gin.

Applicant respectfully traverses this ground for refusal to register.

As pointed out by the Examiner, the leading case on likelihood of confusion is Application of E. I. duPont deNemours & Co., 476 F. 2d 1357 (CCPA 1973). The Court identified thirteen factors for determining likelihood of confusion. In the present case, the goods of the registered mark and the goods of the cited mark are in different classes. The cited mark is a bottle with an essentially triangular cross section and is used with hard liquor, whisky and gin. The present mark is a bottle with a trapezoidal cross section and is used with potable wine.

THE MARKS ARE SUBSTANTIALLY DIFFERENT

The bottle design of the cited mark has a cross section that is triangular in shape. Further, the bottle is smooth without any markings thereon.

As stated above, the bottle design of the subject mark has a cross section that is trapezoidal in shape as clearly shown by the bottom view of the bottle. Further, there are markings of a shield and a rectangular shape on the bottle body. These features are distinctive and different from the cited mark. Since the marks are different visually and in feel, there is little or no likelihood of confusion.

This is acknowledged by the owner of the cited mark, William Grant & Sons Limited, who explained that their well known mark is triangular in shape. William Grant & Sons also distinguished the bottle design of the present application as being 'trapezoidal' in shape. Enclosed herewith is a copy of the proposed co-existence agreement. It is clear based on the terms of the agreement that the owners of the marks agree that the two bottle designs are distinguishable and different and would not result in likelihood of confusion.

The refusal to register on this ground should be withdrawn.

THE CONFIGURATION OF THE BOTTLE

The Examiner also refused registration on the grounds that the bottle configuration for a container is nondistinctive.

It is the contention of the Examiner that a triangular design of a bottle is nondistinctive and is a commonly used design.

Applicant respectfully traversed. Firstly, as pointed out previously and shown in the drawings, the bottle configuration of the present application is not a triangular shaped bottle. It is trapezoidal in shape as shown in the originally submitted and substitute drawings. A trapezoidal shaped bottle design is distinctive and unusual. The Examiner has not shown that a trapezoidal bottle design is a common design for packaging.

Secondly, the Examiner cited a registration wherein the bottle design is clearly triangular. Such registration shows that a triangular shaped bottle was regarded as distinctive and can be registered.

Thirdly, the Examiner contends that the present mark is a triangular shaped bottle, which it is clearly not. It appears that the Examiner has ignored the drawing of the cross section of the mark that clearly shows that the bottle has a trapezoidal cross section. It is wrong for the Examiner to ignore such a clear depiction of the mark as a trapezoidal bottle.

None of the materials provided by the Examiner shows a trapezoidal shaped bottle. They all point to a triangular shaped bottle. Therefore, the Examiner has only shown that a triangular shaped bottle may be a common design. However, he has not met his burden of showing that the trapezoidal shaped bottle is common.

It is Applicant's belief that a trapezoidal bottle design is distinctive since the Examiner has failed to appreciate that the present application is for a trapezoidal shaped bottle and has not provided any evidence to support his contention that the trapezoidal shaped bottle is common and non-distinctive. Furthermore, there are no requirements that the shape of the bottle be uncommon before it is registrable. A bottle design merely has to be distinctive. A common design may be distinctive when no one has used the shape to depict the goods specified.

Since the Examiner has not met his burden, refusal to register on this ground should be withdrawn.

III. THE DRAWING

The Examiner further rejected the drawing as non-conforming in that the mark is shown in two drawings instead of one as stated in 37 C.F.R. §2.52(a)(2)(iii) and that a description of the design is not furnished in the application.

Applicant has now provided a description of the mark as a trapezoidal shaped bottle with a design of a shield and a label on one side of the bottle.

No new matter is presented by the description. Entry thereof is requested.

The Examiner requires the bottle design to be presented in one single drawing. However, Applicant believes that the additional drawing of the cross-section of the bottle is also important for an accurate depiction of the design to be registered. For this reason, a petition enclosed herewith is being submitted under 37 C.F.R. §2.146 requesting waiver of the rule.

Applicant requests the withdrawal of the rejection on this basis.

The Examiner has also pointed to the drawing in the home registration of the mark as being different from the drawing of the present application. Applicant wishes to point out that the present drawings corresponds to the front view and bottom view of the drawings in the home registration and are substantially the same as the design depicted in the home registration. The only markings are the dotted lines showing the trapezoidal shape of the bottle and a bottom perspective drawing to better represent the trapezoidal shape of the bottle. The Examiner had objected to the originally submitted drawings which correspond exactly to the drawings of the bottle design in the home registration. The substitute drawings were prepared in the response to the Examiner's objections. Therefore, the present objections to the substitute drawings as not corresponding to the home registration is not understood.

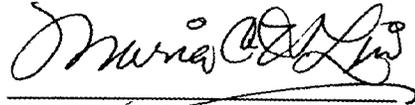
Applicant is willing to resubmit the original drawings in the alternative.

CONCLUSION

No other issue has been raised by the Examiner. It is believed that the application is in condition for allowance. An early allowance is requested.

Since this is a final rejection. Applicant also enclose herewith a Notice of Appeal requesting suspension of the appeal pending the Examiner's review.

Respectfully submitted,
MORGAN & FINNEGAN, LLP



Maria G.H. Lin

Date: February 10, 2003

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Box: RESPONSES – NO FEE

PETITION UNDER 37 C.F.R. §2.146(5)

Sir:

Applicant hereby petitions for a waiver of rule under 37 C.F.R. §2.52(a)(2)(iii). Please charge the required fee of \$100.00 under 37 C.F.R. §2.6(15) to Deposit Account No. 13-4500, Order No. 4086-4046. A DUPLICATE COPY OF THIS SHEET IS ATTACHED..

Applicant request the waiver of the rule requiring one depiction of a design mark. The subject mark of the present application is a bottle design wherein the cross-section of the bottle is in the shape of a trapezoid. Since the cross section on the bottle design cannot be shown in one single depiction of the bottle design, Applicant has submitted originally a front view, a bottom view and a side view of the bottle design. However, such a depiction was objected to by the Examiner who required a drawing with solid lines and the remainder in dotted lines.

Applicant, therefore, amended the drawing to show the front view and bottom perspective view of the bottle design in order to clearly depict the trapezoidal shape of the bottle. Applicant believes that only through two views

can the trapezoidal shape of the bottle design be clearly depicted. Applicant, therefore, request the waiver of the rule under 37 C.F.R. §2.52(a)(2)(iii).

If the presentation of the bottle design in two drawings is regarded as being substantially not the same as that of the home registration, i.e., the originally submitted drawings, Applicant requests that this petition be amended to waive the requirement with respect to the originally submitted drawings.

Respectfully submitted,
MORGAN & FINNEGAN, LLP



Maria C.H. Lin

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nicoday fax notes

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From: CHRISTINE

Company: _____ Tel No: _____

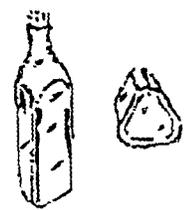
No. of pages: 3 Date: 2/11 No.122498

43

William Grant & Sons Limited ("William Grant") has, by letter, raised objection to registration in the United States of a trademark by Lidl Stiftung & Co. ("Lidl") consisting of a bottle design configuration as shown in United States Patent and Trademark Office application Serial No. 76/189,870 (the "'870 Application"), which bottle design is depicted in the '870 Application as follows:



William Grant's objections are based upon the similarities of the bottle design shown in the '870 Application to William Grant's well-known triangular bottle design as depicted in United States Patent and Trademark Office trademark Registration No. 2,258,388 (the "'388 Registration"), thus:



Lidl maintains that the depiction of its bottle design mark as shown in the '870 Application is intended to be "trapezoidal" in shape whereas the William Grant bottle design depicted in the '388 Registration is more "triangular" in shape.

In order to avoid doubt and confusion, Lidl has agreed, and herein confirms its agreement, to withdraw the '870 Application and, should Lidl decide to re-file a U.S. trademark application for the bottle design as depicted in the '870 Application or colourably similar thereto, to clearly depict any such bottle design as trapezoidal in shape in all perspectives, including any drawing, specimen or other presentation of the bottom portion of the bottle design.

Further, Lidl will never assert or represent that its bottle design is triangular in shape, nor will Lidl rely upon any commercial or other relationship with, or past practice, omission, or failure to act by, William Grant

to support Lidl's use or application to register a predominantly triangular bottle design in the United States or elsewhere, including any bottle design with an appearance similar to that shown in the '870 Application. In all other respects, to the extent allowed by law, Lidl will not seek to cancel or otherwise challenge or take any action at law or in equity against the rights of William Grant in and to the bottle design depicted in the '888 Registration.

Lidl and William Grant agree that the terms of this letter agreement are confidential and shall not be disclosed to third parties except to the extent that disclosure may be required by law or regulation or ordered by a court or administrative tribunal. Where practicable, any required disclosure of this letter agreement shall be made only pursuant to a suitable protective order or other method established by the applicable jurisdiction to preserve the confidentiality of the terms hereof.

This letter agreement and its terms and conditions shall be binding upon the parties and their successors and assigns and all others acting by, through, or with them or under their authority or direction or in privity with them.

The parties shall each bear their own costs and attorneys' fees in this matter, including any costs and attorneys' fees incurred by Lidl to withdraw the '870 Application and file a new trademark application in the United States Patent and Trademark Office for a trapezoidal bottle design that conforms to Lidl's undertaking herein.

The parties indicate their agreement to the terms contained in this letter through the signatures of their authorized representatives, below:

WILLIAM GRANT & SONS LTD.

LIDL STIFTUNG & CO. KG

(Signature)

(Signature)

(Printed Name)

(Printed Name)

(Title)

(Title)

(Date)

(Date)