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INTERNATIONAL CASE ROUND-UP

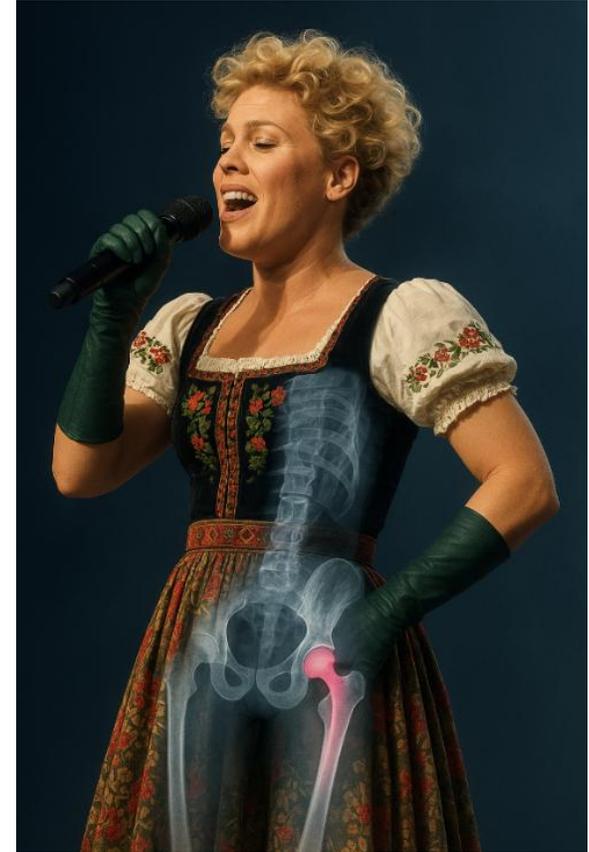
FALL 2025



PATTISHALL MCAULIFFE

Protecting Color For Devices and Medical Supplies

Functionality and Genericness





CeramTec v CoorsTek

124 F.4th 1358 (Fed. Cir. 2025) (Petition to Supreme Court filed August 2025)

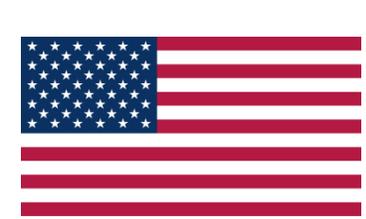


Registration No. 4319095
hip joint ball



Registration No. 4319096
acetabular shell or fossa

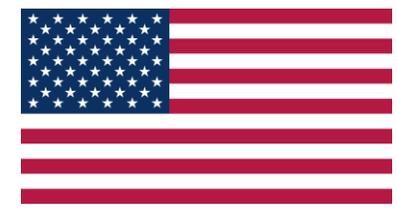
- Chemical composition of hip replacement subject to expired utility patent.
 - Patent stated that chromia provided unprecedented “hardness.”
 - Amount of chromia in patented product gave it a pink color.
- Prior to expiry of patent, CeramTec obtains registration for pink color for ceramic hip components on the Supplemental Register.
- CoorsTek makes a competing product, which also is pink.
 - Designed to match CeramTec color – intentional copying!



CeramTec v CoorsTek

124 F.4th 1358 (Fed. Cir. 2025) (Petition to Supreme Court filed August 2025)

- The Board finds the pink color functional.
 - Expired patent “strong evidence” that pink color is functional for ceramic hip replacements.
 - Advertising materials touted the benefits of chromia.
 - CeramTec argues that subsequent research showed that addition of chromia provided “no material benefit” to the product.
 - Other colors would be produced by different amounts of chromia.
- Petition to U.S. Supreme Court over impact of expired patent (No. 25-217).
 - CoorsTek – no response.



PT Medisafe

134 F.4th 1368 (Fed. Cir. 2025)

- “The color dark green (Pantone 3285c) as applied to the entire surface of the goods which consist of chloroprene examination gloves.”
- Must show acquired distinctiveness.
- Examiner finds mark generic – not even the Supplemental Register!
- TTAB affirms: “Color is so common in the chloroprene medical examination glove industry that it cannot identify a single source.”

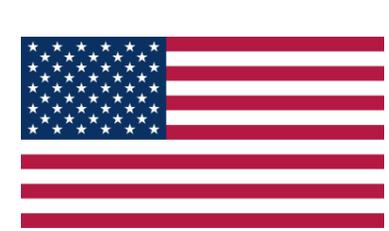




PT Medisafe

134 F.4th 1368 (Fed. Cir. 2025)

- Applicant attempted to narrow applicable market by amending application to gloves “sold only to authorized resellers.”
 - Argument rejected; applicant’s definition need not be accepted.
- Ten third parties found online selling gloves in a very similar color.
- Declarations from industry and evidence of gloves of different colors – not sufficient.
- Survey discounted – conducted by counsel, too small a subset of potential consumers and leading.



Takeaways – Protecting Color

- Plan ahead of product launch.
 - Work with relevant stakeholders early in product development cycle to avoid undercutting potential trademark protection.
 - Review promotional and advertising material.
- Consider the competitive landscape before expending significant resources on color mark registration.
 - Be prepared to seek competent evidence
 - Declarations from various sources (end-users, direct customers, etc.)
 - Surveys must still meet admissibility criteria.



Ceramtek v Coorstek

C-17/24 (June 19, 2025)

Three questions referred from French Supreme Court (Cour de Cassation).

- Are the absolute grounds in Article 7 independent from, and do not overlap with, the ground of bad faith?
 - Yes
- Can bad faith be assessed if functionality is not established?
 - Yes
- Can a later discovery (that the mark isn't functional) affect the assessment of bad faith at filing?
 - Sort of: can serve as supporting evidence of intent at time of filing, but not dispositive.



Ceramtek v Coorstek

C-17/24 (June 19, 2025)

- Article 7(1)(e)(ii) of Regulation No 207/2009, a sign which consists exclusively of the shape of goods which is necessary to obtain a technical result is to be refused registration.
- Article 52(1)(b) provides that an EU trade mark will be declared invalid where the applicant was acting in bad faith when they filed the application for registration.

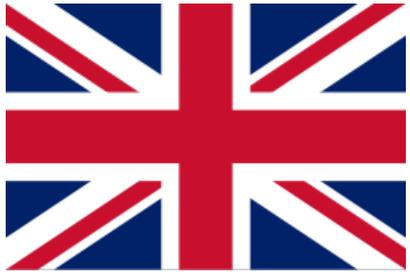


Post *SkyKick*
WISE Payments Ltd v With Wise Ltd.
EWHC 1722 (IPEC)

- TRANSFERWISE registered in bad faith because *computer software* and *application software* in Class 9 overbroad and WISE Payments failed to justify the breadth.

Claimant's trade marks	Defendants' Signs
	

- Court ordered amendment of identification to specify the type of software.



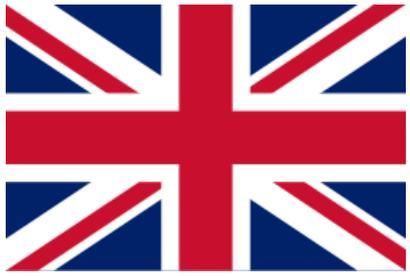
Post *SkyKick*

Unite the Union v Unite Faith

Workers' Fellowship (Anglican Foundation)

UKIPO 0/0369/25 (May 2025)

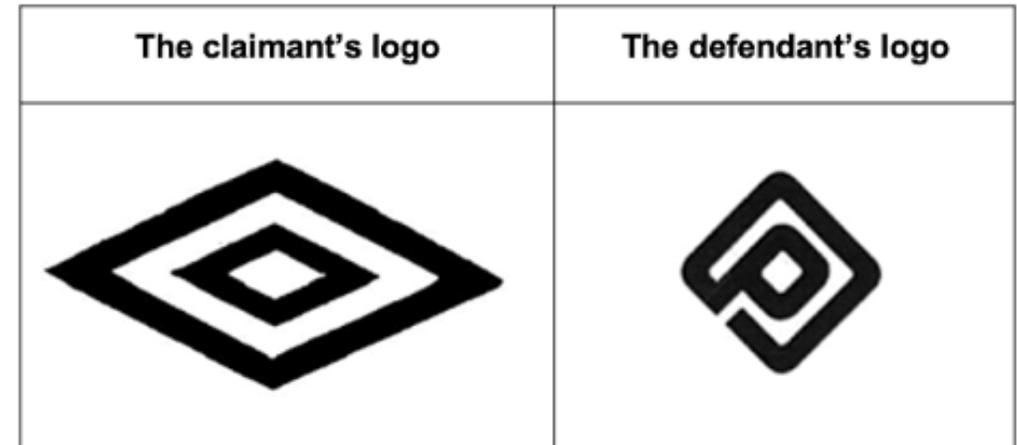
- Application for UNITE FAITH WORKERS' FELLOWSHIP in Class 35
 - 2,789 items
 - 16,268 words covering nearly entire class
- *Prima facie* case of bad faith
 - No explanation for breadth of application
 - Applicant's representative had criticized opponent concerning discrimination
- Entire application deemed in bad faith and rejected



Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc

UKSC 25 (June 2025)

- First instance court found no likelihood of confusion between Claimant Umbro's Logo and Defendant's logo. Court of Appeal reverses because of potential post-sale confusion based on viewing angle.
- UK Supreme Court: Reverses the reversal, reinstating the first instance court's holding because it was not "irrational," but confirming the Appellate court's point of law on post-sale confusion.



Parallel Imports in the EEA

The Meaning of Consent

- Contractual Restrictions on Resale
- Trademark Owner's Failure to Act





Maria Galland Group v UK Online Retailer

Higher Regional Court of Munich 6 U 2795/23e

- Appeal of finding of non-infringement rejected.
 - Restrictions in contractual agreement with distributor do not prevent finding of exhaustion.
- Plaintiff seller of MG-branded cosmetics restricts distribution by contract.
 - First sale in EEA is not “consented.”
- Defendant operates a website based in the U.K. and sells MG-branded products throughout Europe.
 - Bought genuine MG-branded goods from authorized retailer in Germany.
- Sale of goods by TM owner to authorized retailer exhausted rights in EEA.



Alimentación y Bebidas Díaz Cadenas et al v Barceló Comercial Internacional SA et al

SLSTS 3307/2025 (Sep. 11, 2025)

- Article 15 of the European Union Trade Mark Regulation 2017/1001 governs exhaustion of rights.
- Distributors brought non-infringement action against Barceló (owner of EUTM), having acquired products in the Netherlands.
- Burden of proof: if owner of mark proves that it first commercialized outside the EEA, burden shifts to parallel importer that owner consented to commercialization within the EEA.



Alimentación y Bebidas Díaz Cadenas et al v Barceló Comercial Internacional SA et al

SLSTS 3307/2025 (Sep. 11, 2025)

Consent

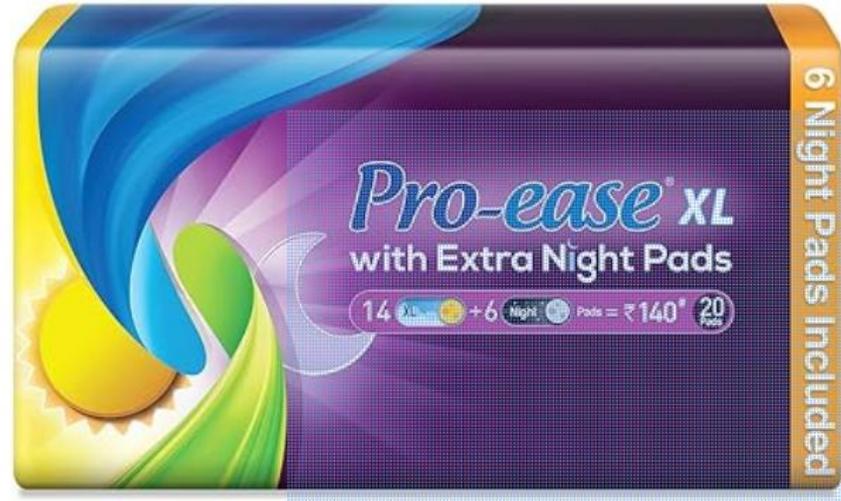
- May be implied by circumstances prior to, contemporaneous with, or subsequent to introduction into the EEA.
- But not through trademark owner's failure to act.





RSPL Health Pvt. Ltd. v. Sun Pharma Lab's Ltd.

FAO (COMM) 65/2025 & CM APPL. 12743/2025



PRO-EASE for feminine hygiene products (2012) v
PRUEASE for constipation relief medicine (2017)





RSPL Health Pvt. Ltd. v. Sun Pharma Lab's Ltd.

FAO (COMM) 65/2025 & CM APPL. 12743/2025

- Appeal from denial of “interim” injunction
 - Appellate court will not re-assess the evidence and will not disturb the findings of the lower court unless:
 - Discretion exercised arbitrarily, capriciously or perversely; or
 - Ignored settled principles of law.
- Nature of goods, trade channels, their purpose and target consumers are distinct – no likelihood confusion.
- It is common practice for manufacturers to use different marks for different goods.



Haoyisheng Pharm Group v. Ping An Health Supreme People's Court of China (2024)

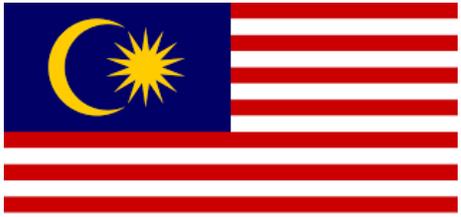
- Cross-class protection for well-known marks not assured
- Haoyisheng Pharma
 - Owner of “**好医生**” ("Good Doctor") mark
 - Well-known since 2010 (Class 5: pharmaceuticals)
- Ping An Health (平安健康, formerly “**平安好医生**” *Píng'ān Hǎo Yīshēng*, "Ping An Good Doctor")
 - Used for internet medical services (online consultations, health management)



Haoyisheng Pharm Group v. Ping An Health

Supreme People's Court of China (2024)

- Well-known status does not ensure cross-industry finding of infringement
 - Must prove actual confusion risk (not established)
 - Must show substantive harm to mark's distinctiveness
- Distinctive house mark can obviate dilution



Reflex Media, Inc & Anor v
Endeavor Standard Sdn Bhd & Anor
[2025] 9 MLJ 582

- Malaysian High Court: Is a party present in a jurisdiction through online sales, even without a physical presence?
 - Yes!
- Plaintiffs: SeekingArrangement.com
 - Singapore-based with U.S. affiliate
- Defendant: TheSugarBook.com
 - Malaysian company
- US Default Judgment awards \$4 million in statutory damages
- Plaintiffs seek to enforce judgment under Malaysian common law
 - Requirement of physical presence no longer reflects practical realities, but “carrying on business” can mean sustained online commercial activity.
- \$4 million judgment not contrary to public policy and can be enforced.



3D Marks and Godzilla

Judicial case no. Riewa6(Gyo-ke)10047
(Japan IP High Court)

- Toho applies to register 3D mark shown ---->
- JPO: Not distinctive, different from original appearance of Godzilla.
- High Court: not *inherently distinctive*; acquired distinctiveness through cultural significance.
- Popularity and recognition of the entire film series affects the determination of distinctiveness.



Practice Updates

- Canada
 - No longer giving preferred treatment to domestic applications using pre-approved terms.
 - Time to initial examination will be reduced to 9 months!
 - Had been 2.5 - 5 years.
- United Kingdom
 - Series marks no longer allowed
 - One application for up to six marks that “resemble each other in their material particulars” and “differ only in ways that do not substantially affect the identity of the mark.”

Practice Updates

- UKIPO Guidance issues June 27, 2025
 - Examiners may raise bad faith objections when a specification “manifestly and self-evidently broad.”
 - What may (not automatic) trigger a bad-faith objection:
 - Broad terms such as “pharmaceuticals”;
 - “Vast numbers of goods and services in large numbers of classes”; and
 - All goods in a class that is itself very broad, e.g., Class 9.
 - Potential response:
 - “Commercial rationale” for inclusion of goods/services concerned.
 - Restrict goods/services to appropriate specification.

Special Thanks

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FUKUDA, OKADA & PARTNERS

TORYS

 East IP



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Thank you!

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