Shapes, sounds and smells

Non-traditional trademarks explored

- **Nokia v HMRC**
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The marketing industry has always had a strong relationship with trademark law. This profession, comprised of highly creative individuals, is responsible for developing some of the most popular slogans, catch phrases and brand names of all time. Without their ingenuity, campaigns such as JUST DO IT (Nike) and GOOD THINGS COME TO THOSE WHO WAIT (Guinness) would not exist.

However, advertising and marketing campaigns are not restricted to words or phrases. Rather, these professionals have a long history of utilising all of the human senses to attract and retain consumer attention. From catchy musical tunes to distinctive three-dimensional designs, current marketing and advertising practices employ a vast array of gimmicks to entertain consumers.

As these marketing and advertising techniques have evolved, so too must the laws that protect these practices, namely trademark law.

History of the non-traditional mark

Modern non-traditional trademarks arguably trace their roots to their predecessor, trade dress.

With the advent of television and other modern media, advertisers quickly realised the value in visually capturing consumer attention through the use of distinctive product packaging. While certainly not the first attempt to attract consumers through the use of product configuration, a 1950s Pepsi campaign asked consumers “Who’s Got the Swirl?” Shortly thereafter, Pepsi launched a new soda bottle with unique grooves, forming a swirl around the bottle. Pepsi then answered its own question in subsequent advertisements with “Pepsi Has the Swirl!”

Pepsi applied for trade dress registration for the shape and grooved appearance of its new soda bottle. The Trademark Trial and Appeal Board (Board) allowed the registration of the new bottle, but the Board excluded the registration from the Principal Register, explaining instead that the proper location for this new registration was the Supplemental Register.

The evolution of trade dress continued to progress and eventually the Supreme Court issued an opinion in Two Pesos, Inc. v Taco Cabana, recognising that trade dress is capable of inherent distinctiveness.

Following on these early decisions, while not true for the rest of the world, non-traditional trademarks in the United States have continued to expand and now incorporate anything that consumers can see, hear, smell, and sometimes even touch.

Common burdens of registration

While every format is different and presents a unique set of obstacles, two universal issues, functionality and distinctiveness, often hinder potential registration of non-traditional trademarks.

Avoiding functionality

An obvious and well-established tenet of trademark law is that a trademark should never encompass a functional aspect of any product. Reserved for the realm of patent law, a trademark is not an appropriate tool to prevent third parties from using a functional aspect of a product. Furthermore, even if consumers recognise the functional aspect of...
the product as a source-identifying feature, the proposed mark is still barred from registration.

Demonstrating distinctiveness
One of the original purposes of the Supplemental Register was to house the large number of applications for trade dress. The Supplemental Register offered applicants a limited scope of protection and provided them with the opportunity to obtain foreign registration.

Today, the Supplemental Register serves a similar purpose for non-traditional trademarks. It is often the case that non-traditional trademarks are not inherently distinctive and require time to acquire distinctiveness before they are eligible for advancement to the Principal Register. Accordingly, the Supplemental Register serves as a temporary landing spot for some non-traditional trademarks until they acquire the necessary distinctiveness for elevation to the Principal Register.

Non-traditional registration and enforcement

Single and multi-colour trademarks
Colours add a creative element to any logo or design and are appealing to consumers. They are also fairly easy to incorporate into marketing and advertising campaigns. Accordingly, single and multi-colour trademarks are arguably the most common of all non-traditional trademarks. So much so, that they may no longer need the “non-traditional” label.

For example, the “robin’s-egg blue” colour for use with boxes, catalogues, and bags for a jewellery store suggests that someone will soon receive an elegant piece of jewellery from Tiffany & Company, while a “chocolate brown” delivery truck signifies that a package is on its way and will be delivered by the United Parcel Service.1

In Wal-Mart Stores, Inc. v. Samara Bros., Inc., the Supreme Court decisively ended any debate over the issue of distinctiveness for colour trademarks.2 The Court ruled that single-colour trademarks are never inherently distinctive and always require a showing of secondary meaning. Multi-colour trademarks are subject to the same standard.3

Applicants must avoid choosing colours which are functional. Common examples include black for outboard boat motors because the colour black minimizes the apparent size of the motor, specific colours used with pharmaceutical tablets because they may identify a type or dose of the drug, and white handles for cutlery because the white may assist in assessing the “cleanliness” of the products.4

There are a number of practical and policy issues which emerge with the enforcement of colour trademarks. At one time, colours were not eligible for trademark protection, for fear that registrants would deplete all available colours and prevent others from using colours altogether. Advocates of this view argued that courts would also be unable to discern the true owners of numerous shades of colours.

These concerns were resolved in the Supreme Court’s Qualitex Co. v. Jacobson Prods. Co., Inc., decision where the court found that the judicial system is fully capable of assessing similarities and differences among colours and that there is very little realistic chance that registrants will deplete all available colours.5 Unfortunately, while the Supreme Court may have found that the judiciary is capable of sorting through a vast array of shades of colours, the court’s opinion may not be the reality.

In litigation, the test is whether a reasonably prudent consumer would be likely to be confused between the parties’ use of two similar colours. If a party registered a shade of yellow for one product, and a second -comer uses a slightly different shade of yellow for a similar product, in reality, no matter what “shade” of yellow the second comer’s mark comprises, the second comer’s use of the colour yellow will likely be found to infringe upon the party’s mark.6

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If too many injunctions are relatively difficult to enforce where the court must determine the appropriate boundary for each party’s use of different shades of a colour. This has become such a problem that some courts even incorporate scientific colour detection techniques, such as the Pantone Matching System, to enforce injunctions.7

As parties consider the registration of colours, it is important to keep these issues in mind and, if possible, be the first to register.

Shapes and 3D designs
Similar to early product configurations and designs, three-dimensional shapes and designs are a natural expansion of traditional trade dress. As a result, while considered non-traditional, these three-dimensional marks are merely a natural expansion of the traditional.

Some great examples of modern three-dimensional trademarks are Porsche’s registration for its very popular BOXTER line of sports cars and the National Academy of Television Arts and Sciences for its Academy Award.8

A three-dimensional mark often faces challenges related to functionality. Similar to traditional trade dress, three-dimensional marks must not be functional.

Like trade dress, three-dimensional shapes or designs are capable of being inherently distinctive. However, similar to an argument of a “crowded field” in a traditional likelihood of confusion analysis, sometimes if too many third parties use the mark in a manner sufficient to strip any source-identifying capability of a particular shape, the shape does not possess the required distinctiveness among consumers, making it generic.

Borrowing from a traditional trade dress example, a grape leaf on a wine bottle is not distinctive and is in fact generic.9 As a result of numerous third-party uses in connection

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with wine, a grape leaf is simply not distinctive. Accordingly, just as with any other traditional word or phrase, applicants would be wise to select shapes or three-dimensional marks which are unique and not commonly associated with a particular product or service.

**Sound trademarks**

Sounds have a great deal of source identifying quality. They are easy to incorporate in television, radio, or internet marketing or advertising, often through catchy jingles or other tag lines. Well known examples of sound trademarks include the Metro-Goldwyn-Mayer lion roaring at the introduction of a movie and the chimes of the National Broadcasting Company before or after a television program.

Sound trademarks can be inherently distinctive. If a sound is unique or different, a trademark applicant need not demonstrate secondary meaning to obtain registration. Obviously, non-distinctive sounds require a showing of secondary meaning.

Even if the United States Patent and Trademark Office (PTO) stamps its seal of approval on an application by passing it along for review and opposition, some sounds are simply incapable of registration. For example, in the late 1990s Harley-Davidson attempted to register the sound of the exhaust from the engines of its motorcycles. The PTO published the mark for opposition. Harley faced opposition from other motorcycle manufacturers and spent several years before the Board in opposition proceedings. Harley eventually abandoned the application in 2000.

Sound trademarks also create an interesting intersection of trademark and copyright law. Importantly, just because copyright law may protect a proposed sound mark, this does not automatically prevent the sound from registration as a trademark, although, copyright law may not protect all sounds. Regardless, trademark law cannot serve as a substitute for copyright law.

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While not as common as other non-traditional trademarks, the sound trademark is eligible for protection in the United States, so long as it remains within the proper confines of trademark law and does not stray to the realm of copyright.

**Motion trademarks**

A trademark need not be static. While an extremely rare breed, motion trademarks are eligible for registration and protection. For example, car manufacturer Toyota registered the smiling face of a character which moves a hand and touches the top of its head and Columbia Pictures has a trademark for the moving view of a woman statue at the beginning of every movie.

Motion trademarks present a few different issues. Obviously, the proposed mark must be both distinctive and non-functional. In registering a motion trademark, the applicant should also use a drawing which depicts a single point in the movement or up to five freeze frames showing various movements, whichever does the better job of depicting the trademark.

**Fragrance trademarks**

Fragrances are very unique and could be a new way for marketing or advertising gurus to exploit the human senses in an attempt to distinguish their products within the marketplace. Once deemed unavailable for trademark registration, fragrance marks are now eligible for protection, with certain restrictions. Fragrance marks are not inherently distinctive and require a showing of secondary meaning.

The amount of evidence necessary to demonstrate that a fragrance or scent serves as a trademark must be “substantial”.

Further, trademark registration for fragrance trademarks is not permitted for scents or fragrances sold primarily for their fragrant features, such as perfumes or colognes. Even some scented household products, designed to mask their chemical odours, are prohibited from registration.

Those successful at registering fragrance marks are able to register a particular fragrance or scent for aspects which would not normally be viewed as incorporating traditional uses of a fragrance. For example, successful applications include fragrances for automobile oil and for a type of yarn.

Although, in all reality, many of these marks begin on the Supplemental Register. As a practical matter, those seeking registration of a fragrance mark should submit a specimen comprised of a paper sample with the fragrance affixed to the piece of paper. An often-used method of submitting fragrance specimens is to submit a “touch to activate fragrance” sample in which the examining attorney can activate the fragrance.

While there is no categorical denial of scents and fragrances, applicants should be especially aware of the heightened standards for both distinctiveness and functionality and expect that the mark will be registered on the Supplemental Register until they can prove acquired distinctiveness.

**Texture trademarks**

There is nothing which prohibits trademarks that are comprised of a specific texture or feel from receiving registration as a trademark. For example, a wine bottle consisting “of a velvet textured covering on the surface” is registered on the Principal Register.

In our opinion, these fascinating marks should be subject to the same standards as those employed with fragrance trademarks. That is, there should be a “substantial” connection between the texture and the product, such that the texture adequately functions as a trademark. Further, with fragrance marks, one can envision a number of issues wherein an applicant may seek to utilise a specific texture to enhance the functional aspects of a product, such as to enhance the grip of a product or perform some other functional purpose. These should be excluded as contrary to the principles of trademark law.

Therefore, while these texture trademarks are extremely rare, there is nothing which would expressly prohibit their registration.
**Flavour as a trademark**

While many have tried, at this time, trademarks consisting of flavours or tastes are unlikely to receive trademark registration or protection. A pharmaceutical company briefly attempted to demonstrate that a specific flavour associated with its line of products was eligible for trademark protection. However, the Board rejected these attempts.

The greatest obstacle for these proposed marks is their functionality. Even if these marks were to gain sufficient source-identifying recognition to withstand an argument against their distinctive nature, the purpose of a taste is largely functional, as it serves to appeal to a consumer’s palate.

This is not to say that at some point in the future, a marketing executive or other advertising guru will not create some new way to use flavour in a non-traditional manner, apart from the obvious. If possible, there is no reason why flavours should not be recognized as trademarks if they are non-functional and distinctive.

**Continued expansion**

It is inevitable that the marketing and advertising industries will generate new ways to identify their products and services. So long as these new proposed trademarks fall within the appropriate boundaries of trademark law, namely avoiding functionality and possessing a requisite level of distinctiveness, there is no reason why trademark law should not continue to evolve to protect these new and exciting marks.

**Notes**

17. Trademark Manual of Examination and Procedure § 807.11 – Marks with Motion.
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