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**Non-traditional trademarks through the lens of the USPTO**

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## United States

# Non-traditional trademarks through the lens of the USPTO

By **Roxana Sullivan**, Denne Meyer & Associates, LLC

The Lanham Act codifies the idea that trademarks serve three primary functions:

- operating as source identifiers by distinguishing the goods or services of one business or individual from those of another;
- facilitating consumers' purchasing decisions; and
- acting as an economic and reputation-based incentive for mark owners.

Pursuant to 15 USC §1127, trademark protection in the United States is commonly associated with marks that are easily perceived as source identifiers – for example, “any word, name, symbol, or device, or any combination thereof... used by a person... to identify and distinguish his goods”. Thus, the term ‘trademark’ seems to be all-encompassing. Over time, the United States has gradually granted trademark protection to additional non-traditional elements or devices that serve as source identifiers for particular goods and services. In *Qualitex v Jacobson Prods, Co* the Supreme Court stated that “[t]he language of the Lanham Act describes [the universe of things that can qualify as a trademark] in the broadest of terms... Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally is not restrictive” (514 US 159 (1995)). The *Qualitex* court granted trademark protection to colour after it decided that colour in that particular instance had acquired secondary meaning in the market.

In a market that is accelerating towards saturation, creative brand owners are continually searching for novel means to

identify and safeguard their brands. In order to enhance the scope of mark owners' rights by engaging in creative branding, many seek to obtain protection through registration of non-traditional trademarks. Highlighting a trademark's plasticity, non-traditional marks come in many different formats, which include colour, sound, olfactory, taste, motion and three-dimensional (3D) trademarks.

### Registration of non-traditional trademarks

In order to register a non-traditional mark on the Principal Register, the registration requirements for a standard application apply. The mark must be distinctive and serve as an indicator of source, and a proper drawing (except for sensory marks) and specimen of use must be provided. However, while registrable in theory, non-traditional marks undergo substantial scrutiny and unique impediments during the examination phase of the trademark application process. Although every type of trademark poses different complications for registration, non-traditional trademarks face two common issues: distinctiveness and functionality.

### Acquired distinctiveness

In order to be registrable on the Principal Register, a mark must be distinctive and serve to identify a particular source of the goods or services. While some types of mark can be inherently distinctive through their intrinsic source-identifying nature, others must acquire distinctiveness before they are entitled to registration. A mark may acquire distinctiveness when consumers begin to

## “ The Supplemental Register plays an important role as an incubator where many non-traditional trademarks reside until they acquire sufficient distinctiveness necessary to advance to the Principal Register ”

associate it with a particular seller over time. The amount of evidence required to satisfy the burden of acquired distinctiveness depends on the nature of the trademark and the character of the evidence. Over time, a non-traditional mark may acquire secondary meaning if consumers begin to associate it with a single source. Accordingly, evidence of acquired distinctiveness may be either direct (eg, consumer surveys) or indirect (eg, promotional materials).

### **Functionality**

The functionality doctrine also acts as an obstacle during the examination stage of a non-traditional mark application. This doctrine acts as a buffer between patent and trademark law by precluding a business from monopolising a useful product feature under the façade of identifying the feature as the source of the product. This can occur when the examining attorney concludes that the mark is utilitarian or aesthetically functional.

Under the utilitarian test, a mark is functional when it is essential to the purpose or use of the product or affects the cost or quality of the product. Alternatively, a mark may also be denied registration when it is deemed aesthetically functional. Aesthetically functional features do not contribute to the utilitarian function, but their appearance or ornamentation contributes to consumer demand for a product. In effect, this forbids the use of a product's feature as a trademark if this will place a competitor at a significant, non-reputation-related disadvantage. Most importantly, the determination that a proposed mark is functional constitutes an absolute bar to registration on either the Principal or Supplemental Register, regardless

of evidence showing that the proposed mark has acquired distinctiveness.

To determine functionality, the US Patent and Trademark Office (USPTO) will consider:

- the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- advertising by the applicant that touts the utilitarian advantages of the design;
- facts pertaining to the availability of alternative designs; and
- facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

### **Colour trademarks**

If an applicant is filing a trademark application that consists solely of colours employed in connection with specific goods or services, it must submit a drawing that displays the mark in colour, as well as:

- a colour location statement in the description of the mark field, which names the colours of the mark and where they appear; and
- a claim that the colours are a feature of the mark.

Colour marks cannot be categorised as inherently distinctive and applicants seeking to register a colour must satisfy the high burden of proving secondary meaning. In order to navigate these registration requirements, applicants must attach Section 2(f)-based evidence demonstrating distinctiveness. Although applicants may typically prove acquired distinctiveness through evidence of five years' use, in the context of colour marks this alone is insufficient to show acquired distinctiveness. When reviewing Section

2(f) evidence to determine whether a single colour has acquired distinctiveness, the USPTO will look at factors such as duration of use, promotion of the colour in advertising, consumer recognition of the colour as a mark and use of colour by competitors.

Although difficult to clear, many colour marks have passed for registration by satisfying these requirements. For example, jewellery company Tiffany & Co has successfully registered the robin's egg colour "Tiffany blue" for boxes and bags (Registrations 2,359,351 for boxes, 2,416,795 for shopping bags and 2,416,794 for catalogue covers). Further, shoe designer Christian Louboutin has registered the lacquered red outsole on women's footwear only when it contrasts with the colour of any visible portions of the remainder of the shoe (Registration 3,361,597).

### Sound trademarks

Under 37 CFR §2.52(e), sound marks may also function as source indicators when they are fixed in a definitive shape or arrangement while creating a strong connection between the sound and a good or service in the listener's mind. For the Principal Register, sound marks must be unique or distinctive. Sound marks must be used in a way that registers in the subliminal mind of the hearer – the listener must be able to recall the mark later on a subsequent hearing in a manner that signals that a certain product or service is associated with a specific source.

Further, a mark's form or ontological status is almost irrelevant in comparison to its source-distinguishing ability. As with a more visually perceptible type of mark, a sound can be utilised as a source indicator; thus, the mark need not be in graphic form. A sound mark depends on the listener's aural perception. Therefore, a distinction must be made between distinctive sounds and those that resemble commonplace sounds. Commonplace sounds made in the normal course of operation may be registered only when supported by evidence that purchasers identify the sound and associate it with a single source. For instance, in *Ride the Ducks, LLC v Duck Boat Tours, Inc* the court noted that the quacking sound made by ducks is the

kind of familiar noise that would not qualify as so inherently distinctive that evidence of secondary meaning is not necessary to link the noise to the plaintiff's provision of an amphibious boat tour (04-CV-5595, 2005 WL 670302 (ED Pa March 21 2005)).

Registration of a sound mark requires the submission of a detailed description of the mark. The applicant must describe the sound with sufficient particularity, which may be achieved by submitting the musical notes associated with a particular sound or describing it in layman's terms (eg, "the mark comprises a lion roaring"). Applicants should also submit a specimen in audio form. Further, commonplace sounds require proof of acquired distinctiveness, whereas inherently unique or distinctive sound marks need no additional showing of secondary meaning.

Despite these complications, many sound marks have passed for registration – notably, the Metro-Goldwyn-Mayer lion roar (Registration 1,395,550) and Homer Simpson's 'D'oh' exclamation (Registration 3,411,881) are both live on the Principal Register.

### Olfactory and taste trademarks

#### Olfactory marks

Addressing additional sensory marks, scent and taste may also act as source identifiers in limited circumstances when considerable evidence is provided. Recognising the trend of expanding trademark protection to encompass additional non-traditional elements, the first olfactory mark was registered only in 1991 after an appeal before the Trademark Trial and Appeal Board. Originally unavailable for registration, scent is now registrable only when used in a non-functional manner as a source identifier. Moreover, substantial proof is needed to prove secondary meaning because scents cannot be deemed inherently distinctive. Registration is barred when the applied-for olfactory mark is used in connection with goods that are sold primarily for their utilitarian purposes (eg, products designed to conceal chemical odours).

For olfactory marks, no drawing is necessary; however, the applicant must submit a detailed written description in addition to a specimen of the scent. The

physical specimen should be submitted in the form of a paper sample containing the scent that can be activated by the examining attorney. While many olfactory marks start out on the Supplemental Register due to an inability to prove acquired distinctiveness, successful scent registrations are used in connection with products that employ the scent for its qualities in a manner that would not be seen as the customary use of the scent. For example, the scent of plumeria blossoms for sewing thread and embroidery yarn (Registration 1,639,128) and a cherry scent used in connection with synthetic lubricants for vehicles (Registration 2,463,044) both function as marks.

### Taste marks

Taste marks also require substantial evidence and are confronted by a seemingly insurmountable burden because taste is not inherently distinctive and is generally viewed as a characteristic of the goods. Rarely are there attempts to register taste marks because of the difficulty of successfully proving a non-functional purpose. For instance, a pharmaceutical company attempted to register a peppermint taste mark for pharmaceutical formulations of nitroglycerin, which was promptly rejected based on utilitarian grounds. Since medicine has a disagreeable taste, giving it a different taste serves functional purposes and protection would hinder competition. In addition, addressing culinary creations, the primary aspect of food is comprised of its underlying taste. Most recently, a New York pizzeria attempted to claim trademark protection in a suit over the taste of its baked ziti and aubergine parmesan, which the court dismissed as a “half-baked” claim. Although taste can convey meaning, that entitles a mark to protection only if it acts as a source identifier.

While no court has previously interpreted the Lanham Act to ban taste as a trademark altogether, it is extremely problematic when determining exactly how a taste could serve other than as a functional element of the product, since taste affects quality. Further, if the taste of a dish were protectable, the first to popularise that taste could obtain perpetual rights preventing all others from imitating that dish. In turn, this would stifle

culinary innovation. Although protection for taste as a trademark is difficult, those in the culinary world can rely on trade secret law to safeguard recipes.

### Moving image trademarks

In some instances, moving image marks are available for protection because a trademark need not be in static form. Analogous to the non-traditional trademarks previously discussed, the applied-for motion mark must have achieved acquired distinctiveness while serving non-functional purposes. Unlike for olfactory, taste and colour marks, these two requirements pose fewer complications for motion trademarks. The applicant must submit a drawing depicting a single point in the moving image or up to five freeze frames displaying the movement. The applicant must



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also submit a detailed written description of the mark. As a specimen showing use, the applicant must submit a specimen that depicts the motion sufficiently to show how the mark is used on or in connection with the goods or services, and that matches the required description of the mark. An acceptable specimen should show the entire repetitive motion and can include a video clip, a series of still photos or a series of screen shots.

For instance, Lamborghini successfully registered the unique motion in which the door of a vehicle is opened (Registration 2,793,439). This motion mark protects doors that move parallel to the body of the vehicle, but are gradually raised above the vehicle to a parallel position. Yamaha also enjoys motion mark protection which consists of the vertical spray of water from the back of a watercraft generated during operation (Registration 1,946,170).

### 3D designs and shapes

Although non-traditional, 3D marks act as the logical progression of trade dress protection. 3D marks protect product design, product configuration and trade dress. The applicant must represent a single rendition of the mark in three dimensions and include a description of the mark indicating that the mark is 3D. Further, if a single rendition of the mark is not possible, the applicant may petition the director to waive the requirement and accept a drawing featuring multiple views of the mark. Finally, the applicant must also traverse the previously discussed issues of acquired distinctiveness and functionality.

The distinctiveness of a 3D product design may be distinguished from that of product packaging. Features of a product's configuration can never be inherently distinctive. Therefore, a showing of secondary meaning is required because a product's design traditionally serves purposes other than acting as a source indicator. Consumers are aware that even the most uncommon product configurations are integrated not for source identification purposes, but to make the product itself more

appealing or functional. Alternatively, it is well established that product packaging can be inherently distinctive because normally it is taken by the consumer to indicate origin.

Noteworthy registrations of 3D marks include the distinctly shaped contour and design of the Coca-Cola bottle (Registration 1,057,884) and the design and layout of Apple retail stores (Registration 1,060,320).

### Moving forward

Recognising the movement of increasing trademark protection to encompass additional non-traditional devices, the Supplemental Register plays an important role as an incubator where many non-traditional trademarks reside until they acquire sufficient distinctiveness necessary to advance to the Principal Register. When seeking to build acquired distinctiveness in the minds of consumers for non-traditional marks, a rights holder should:

- engage in extensive advertising;
- create advertising that causes consumers to equate the mark with the source of goods or services;
- advertise in a manner that makes clear that the mark is not simply ornamental, decorative or a feature; and
- be careful not to advertise functional or utilitarian aspects of a mark. *iam*

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