

Outline- February 2017 TMA Roundtable

“Non-Traditional Marks and the Traditional Practice”

Note: *It is recommended that the host have access to a computer and audio visual equipment to more effectively present the examples that accompany this topic.*

Clients most often seek legal advice for trademark protection for marks that are easily perceived as source identifiers, such as words, names, acronyms, logos, and images. These are often called the “traditional” marks.

Sometimes, however, they will ask for advice for protection of other types of marks that are not so easily perceived as source identifiers, such as product configurations, colors, sounds, and other non-traditional marks. How do you develop a strategy to address a mark that is non-traditional?

1. Identify the Non-traditional Mark

- a. Breakdown the proposed mark to separate out the elements.
 - i. What are the visual elements?
 - ii. Are there any non-visual elements?
 - iii. Is there more than one mark?
 - iv. How will the mark be used by the client?

2. Trade Dress Marks

- a. What is trade dress?
 - i. The definition has become broad to encompass not only how the product is “dressed” (packaged) but includes “total image and overall appearance” of a product, or the totality of the elements, and “may include features such as size, shape, color or color combinations, texture, graphics.” Two Pesos, Inc. v. Taco Cabana, Inc., USPQ2d 1081 (1992).
 - ii. Trade dress creates a visual impression which functions like a word or 2 dimensional design trademark. Examples include
 1. Shapes – (Coca Cola Bottle - Registration No. 1057884)
 2. The interior of a business (Pot Belly restaurants - Registration No. 3494208)

3. Colors (Pink for insulation by Owens-Corning – Registration No. 1439132)

b. Assessing the protectability of trade dress?

- i. If the proposed trade dress is "functional."
- ii. If it is not functional then is trade dress is "distinctive".

- 1. Is it inherently distinctive; has it acquired secondary meaning.
- 2. How do you address this question with the client.

c. Is Trade Dress the proper protection?

- i. Do you consider design patents?
- ii. Do you consider copyright protection
- iii. How would these affect your Trade Dress application?

3. Collective Membership / Certification Marks

a. What is a Collective Membership mark?

- i. A Collective Membership mark is used by an organization (such as an association or a union) by the members of the “collective” to distinguish their membership and goods and services from non-members. An example would be a local Chamber of Commerce or a social organization such as the Elks Club.

b. What is a Certification Mark?

- i. A Certification Mark is a mark used to identify goods or services that meet certain standards or specifications. An example would be the Underwriter’s Laboratory “UL” or the Good Housekeeping Seal.

c. Both marks are meant to exclude other parties from using the marks and inform the public as to status. How does this affect how you approach the marks as opposed to advising on traditional marks?

4. Color Marks

- a. The right to exclusive use of a single color or combination of colors requires showing of acquired distinctiveness and non-functionality.
- b. Functionality: a mark is functional if it is essential to the purpose of an article or affects the cost or quality of that article.

- i. How do you show non-functionality?
 - ii. How do you avoid an aesthetic functionality defense?
 - iii. How do you prove acquired distinctiveness?
 - iv. How do you represent the color for filing?
 - 1. A solid block of color?
 - 2. Do you provide the pantone or a generic description, e.g. Purple vs. Pantone 2685C? (Pantone is required as part of the *Sieckmann* criteria in EU)
 - 3. Do you show it represented in a drawing as part of the product?
 - 4. How do you account for varying shades of the color on the product?
- c. How or what do you protect when it comes to color in the fashion industry after *Louboutin v YSL*?
 - i. *Christian Louboutin SA v. Yves Saint Laurent America Holding, Inc.* – US Court of Appeals (2nd Cir.) addressed “whether a single color may serve as a legally protected trademark in the fashion industry and, in particular, as a mark for a particular style of high fashion women’s footwear.” Upheld that trademark protection for a color is not protectable in the fashion industry.
- d. United States – right to an exclusive color as a trademark has been met with a mixed response by US court cases.
 - i. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 161 (1995) – found that a shade of green-gold functioned as a trademark for dry cleaning pads.
 - ii. *Life Savers v. Curtiss Candy Co.*, 82 F.2d 4 (7th Cir. 1950) – denied protection for a series of stripes or multiple colors on candy packages.
- e. EU – courts have held that color marks are registrable based on acquired distinctiveness. Must clearly represent the color mark and must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. Known as the *Sieckmann* criteria.
- f. There is no international consensus on whether color alone is protectable as a trademark.
 - i. NAFTA, EU Harmonization Directive and the EU Regulation support single color trademarks
 - ii. Andean Pact exclusively precludes protection
 - iii. How do you extend/seek protection for color beyond those jurisdictions that allow it?

- iv. What are some creative ways to file for marks?
- g. Interesting case:
 - i. Invalidation action against Cadbury UK Limited's Purple Pantone 2685C trademark in UK for chocolates by Societe des Produits Nestle SA. Nestle ultimately won, barring Cadbury's claim over the color purple in the chocolate industry. Even though Cadbury proved it acquired distinctiveness, the decision was based on the language used in the original application which was deemed as insufficient in describing the scope of the protection.

5. Sound Marks (Sensory Mark)

- a. What is a Sound Mark?
 - i. A sound that uniquely identifies the commercial origin of the product or service.
 - ii. A sound mark identifies and distinguishes a product or service through audio rather than visual means. Examples of sound marks include: (1) a series of tones or musical notes, with or without words, and (2) wording accompanied by music."
- b. What is the litmus test for determining if a sound can be registered?
 - i. "A sound mark depends upon aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck." *In re General Electric Broadcasting Co.*, 199 U.S.P.Q. 560, 562-63 (T.T.A.B. 1978).
- c. What elements are needed to apply for a Sound Mark?
 - i. Application/Registration
 - ii. Description of the mark describing the notes, instruments, etc used to make the sound
 - iii. Sheet Music stating the notes of the sound with or without words
 - iv. The mark as played in MP3 format
 - v. If use based, specimen of use at time of filing
- d. What are acceptable specimens of use?
 - i. Manner or mode of use of the mark on or in connection with the goods where the sound is recorded with the good directly or inserted directly (i.e. TV or Movie Credits)

- ii. Point of Sale (PoS) materials where the sound is played at the time of purchase
- e. What are examples of specimens that have not been accepted?
- i. TV Commercials/Advertisements where the sound is part of a larger thought or is not distinguishable from other matter in the specimen. *In re C.R. Anthony Company*, 3 USPQ2d 1894 (TTAB 1987); *See also Ipco Corporation v. Blessings Corporation*, 5 USPQ2d 1974 (TTAB 1988); *In re Wakefern Food*, 222 USPQ 76 (TTAB 1984); *In re Niagara Frontier Services, Inc.* 221 USPQ 284 (TTAB 1983); *In re Royal Line*, 216 USPQ 795 (TTAB 1982).
 - ii. Sound not distinctive enough (Harley Davidson's sound of its V-Twin engines (thumping of a revving Harley was not distinct enough)
- f. What are some registered Sound marks in the US? (Partial list taken from <https://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>)
- i. NBC Chime - <https://www.uspto.gov/trademarks/soundmarks/72349496.mp3>
 - ii. Del's Lemonade & Refreshments - Carryout Food Mobile Truck (Horn) - <https://www.uspto.gov/trademarks/soundmarks/73391897.mp3>
 - iii. AOL's "You've Got Mail" - <https://www.uspto.gov/trademarks/soundmarks/75528557.mp3>
 - iv. MGM Lion roar - <https://www.uspto.gov/trademarks/soundmarks/73553567.mp3>
 - v. 20th Century Fox Fanfare - <https://www.youtube.com/watch?v=0qDdYlyLRol>
 - vi. Harlem Globetrotters Theme - <https://www.uspto.gov/trademarks/soundmarks/74158626.mp3>
 - vii. Mattress Discounters - <https://www.uspto.gov/trademarks/soundmarks/74219263.mp3>
 - viii. LucasFilms THX Deep Note - <https://www.uspto.gov/trademarks/soundmarks/74309951.mp3>
 - ix. Mister Softee - ice cream trucks - <https://www.youtube.com/watch?v=zZKQUNe9Xjk>
 - x. Lone Ranger classic media (2) - <https://www.uspto.gov/trademarks/soundmarks/74639801.mp3>
 - xi. Ginsburg Entertainment [OOH IT'S SO GOOD]- <https://www.uspto.gov/trademarks/soundmarks/74684280.mp3>
 - xii. Edgar Rice Burroughs, Inc (Tarzan Yell) - <https://www.uspto.gov/trademarks/soundmarks/75326989.mp3>
 - xiii. Elorg Company (Tetris video game - electronic Russian folkstyle tune) 2 - <https://www.uspto.gov/trademarks/soundmarks/75389198-1.mp3>
 - xiv. Intel Sound Mark (a.k.a. Intel Bong) - <https://www.uspto.gov/trademarks/soundmarks/75332744.mp3>

- xv. Federal Signal Corporation (Fire truck sirens) (2) -
<https://www.uspto.gov/trademarks/soundmarks/75823257a.mp3>
- xvi. AAMCO Transmission -
<https://www.uspto.gov/trademarks/soundmarks/75208671.mp3>
- xvii. Yahoo Yodel –
<https://www.uspto.gov/trademarks/soundmarks/75807526.mp3>
- xviii. Del's Lemonade & Refreshments - Carryout Food Mobile Truck (Horn) -
<https://www.uspto.gov/trademarks/soundmarks/73391897.mp3>
- xix. Looney Tunes Theme Song -
<https://www.uspto.gov/trademarks/soundmarks/75934538.mp3>

g. Considerations before filing a sound mark

- i. What is an alternative to registering a sound mark?
- ii. What are some issues surrounding worldwide implementation of Sound Mark protection?
- iii. what types of issues/objections commonly come up, how does the law vary from jurisdiction to jurisdiction, what jurisdictions allow it?

6. Trends in Non-Traditional Marks – 3D

- a. 3D trademarks have become a topic of conversation lately and have become increasingly more popular. Have you been successful in applying for a 3D trademark, have you been unsuccessful?
- b. If your application for a 3D was denied, what was the reason?
- c. Have you been successful in one country for a 3D registration but denied in others?

