

MAKING “SENSE” OF NON-TRADITIONAL MARKS

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Trademarks have existed as long as commerce has existed. The use of hallmarks—one of the earliest form of trademarks—dates back to at least the fourth century. In the Roman Empire, bricks were often stamped with a mark to identify the artisan and to ensure quality. During the Middle Ages, English law required bakers to mark their loaves so that any underweight goods could be traced to their sources. By the nineteenth century, this trend persisted as manufacturers began labeling wrappers and boxes with brand names and symbols.

Similar to modern day trademarks, early marks served several purposes, including:

- advertising;
- proving that goods were sold by a particular merchant, and thereby resolving ownership disputes;
- serving as a guarantee of quality;
- providing a remedy against counterfeiting.

While trademarks serve the same purposes as they did thousands of years ago, trademark law has evolved to keep pace with businesses’ desire to create distinctive and memorable symbols that consumers can associate with products.

Well into the twentieth century, many trademarks were pictures or stylized marks that were easy for customers to identify and recall. In fact, when the US established its first federal trademark law, applicants were required to provide a drawing of the design along with a description of the type of goods or services covered. This requirement posed a substantial barrier to the registration of non-visual marks and has hampered the progression of non-traditional marks.

The modern definition of a trademark, however, is no longer limited to words or symbols. Courts and the U.S. Trademark Office have recognized a more liberal construction of trademarks and there has been an increase in protection being sought for new forms of trademarks. These new forms of trademarks, described as “non-traditional trademarks” include audible, visual, tactile, and olfactory marks, and potentially other types of marks as well.

Akin to traditional word or symbol marks, these non-traditional marks also serve as source identifiers. The key to registering non-traditional trademarks federally is to convince an examiner in the U.S. Trademark Office that the average consumer associates a product’s attribute exclusively with a single source. To be registrable, a non-traditional mark must pass the same tests prescribed for traditional marks, namely, distinctiveness and non-functionality.

VISUAL CUES (Colors and shapes): Colors and color combinations play an important role in distinguishing products. For example, red and yellow have become synonymous

with McDonalds worldwide. Even before they are capable of reading, young children recognize the color combination and the stylized M.

The Supreme Court, however, did not recognize that colors could serve as a trademark until 1995 when a divided Supreme Court held that color alone can be registered only where it has become a distinctive feature of the applicant's goods. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995). Since the Court's seminal decision, other famous color marks that have registered are canary yellow for Post-it® Notes, pink for fiberglass insulation, and light blue for jewelry boxes.

Shapes also can be registered. For example, Coca-cola has registered the shape of its bottle, and Mercedes-Benz has registered its vehicle hood ornament.

VISUAL CUES (Holograms and moving marks): Other visual marks include holograms and moving marks. Registration for holograms and moving parts is available where the applicant can demonstrate that the use both serves as a mark and is not functional.

Holograms are particularly difficult to register because of the requirement to graphically define the mark. Holograms by their very nature possess multiple images or colors that are visible only when viewed from different angles. In a seminal case on holograms, the Trademark Trial and Appeals Board (TTAB) held that a hologram used on trading cards did not function as a mark, because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices, and there was no evidence that the public would perceive applicant's hologram as an indicator of source. *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001).

The requirements of a motion trademark involve the detailed description of the various components or elements of the trademarks and their interaction with each other explained in a sequence of steps. Famous moving marks include Microsoft's registration for an animation called a "flare logo" for use in Windows Vista computer operating system and Columbia's motion trademark for "moving image of a flash of light from which rays of light are emitted against a background of sky and clouds...[t]he scene then pans downward to a torch being held by a female figure on a pedestal...[t]he word "COLUMBIA" appears across the top running through the torch and then a circular rainbow appears in the sky encircling the figure."

VISUAL CUES (Trade dress): Trademarks are not the only way of protecting a product or a service. Trade dress, which generally refers to source-identifying characteristics of the visual appearance of a product or its packaging, protects consumers from deceptive packaging or product appearance even though a trademark is not used. The design of a magazine cover and the appearance and décor of a chain of Mexican restaurants are examples of protectable trade dress.

SOUND: Sounds, too, can create a unique impression and can be used to identify the origin of a product or services. Whether sound can serve as a trademark "depends on

[the] aural perception of the listener” and whether “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 struck.” *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. (BNA) 560 (TTAB 1978). For example, Harley Davidson was unable to register the sound of their engines, as the Trademarks Office—and the many companies who opposed the application—were not convinced that the sound was distinctive.

Some of the more famous registered marks that we know are NBC’s chimes and MGM’s lion’s roar. Sound marks can be represented by a series of musical notes or tones, with or without words. For example, there is a registration for “a rapid series of chime-like musical notes...comprising a progression of the musical notes C, D, F, G, C, and the combined notes A and D” for “providing multiple user access to computer networks.”

SMELL: Companies have been using fragrances to entice customers for decades. Stores like Abercrombie and Fitch and Pottery Barn use scents to market their brands by luring customers in to their stores. But, can these scents be trademarked? This is a complicated answer. In the US, scents may be trademarked only if they do not serve a functional purpose. The scent of a perfume is of course functional and therefore not able to be trademarked. Scent marks that have been registered include “lemon fragrance” for skin toner, “fresh grass” for tennis balls, “floral scent” for knitting yarn, “strawberry scent” for “lubricants and motor fuels for land vehicles, aircraft, and watercraft,” and “vanilla” for “office supplies, namely, file folders, hanging folders, paper expanding files.”

TOUCH: A product’s packaging makes it suited for creating not only visually attractive and distinctive vessels, but also for stimulating the sense of touch and creating an important and yet largely untapped point of differentiation between products. In order to be registered, a touchmark must: 1) not be functional; 2) be distinctive; and, 3) be perceived as an actual trademark, and not mere decoration or ornamentation. All three of these elements must be cleared before “touchmark” status can be granted.

Despite these challenges, toward the end of 2006, American Wholesale Wine & Spirits, Inc. obtained a federal trademark registration for “a velvet textured covering on the surface of a bottle of wine,” for Khvanchkara. This is one of the first federally registered touchmarks, as tactile marks are still in their infancy.

TASTE: Although the Trademark Office has taken a more liberal interpretation of trademarks that has paved the way for a myriad of non-traditional marks, there are not any registrations for taste. The problem is that taste—by its very nature—is functional. Because it is impossible for a consumer to distinguish between products by sampling before making a purchase, consumers cannot have exposure to a flavor or taste before purchase.

In a case of first impression, the TTAB not only affirmed the refusal of the Trademark Office to grant a registration for orange flavor for an antidepressant, but it also cast doubt

on whether any flavor or taste would ever be entitled to a federal registration. *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (TTAB 2006).

UPCs: In a recent case, the Second Circuit upheld the decision that removal of UPCs from trademarked products constitutes trademark infringement, potentially expanding the scope of non-traditional trademarks even further. *Zino Davidoff SA v. CVS Corp.*, 571 F.3d 238 (2d Cir. 2009). While this case does not confer registration rights in UPCs, which presumably cannot be registered because they serve a functional purpose, it reaffirms the principal that a trademark functions as a seal of approval from the brand owner, guaranteeing the public's quality expectations of the brand.

CONCLUSION

Trademarks—cues that enable consumers to recognize and identify a particular product—are inherently associated with expectations of quality. The core of a business is enveloped in its trademarks, as consistency in standards and quality engenders consumer loyalty.

Branding and the legal remedies associated with registered trademark incentivize companies to maintain the quality of their product or products, and encourages companies to promote products through advertising and marketing. Because of archaic registration requirements and lack of precedent, nontraditional trademarks have always faced a more difficult road to registration. Recently, however, there is a noticeable increase in registrations for nontraditional marks. As companies continue to innovate and devise new and exciting ways to generate and maintain consumer interest and brand loyalty, trademark law must continue to evolve to keep pace in this dynamic environment.

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