

WHAT IS THAT SMELL?
Protection for Non-traditional Trademarks

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October 24, 2013

Trademark?

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n Source identifier by distinguishing the goods and services of one person or company from those of another.

n Traditionally:

q Words

DELL®

q Logos



q Combination of both



Trademark?

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- n Non-Traditional Trademarks (aka: Trade Dress)
 - q Product packaging design
 - q Product design
 - q Color
 - q Sound
 - q Scent
 - q Taste
 - q Texture
 - q Motion
 - q Almost anything that “is capable of carrying meaning”

- n *Distinctiveness*: Must be recognized as a source indicator, meaning it must distinguish one's products and services from those of others (*secondary meaning*).
 - q Inherently Distinctive
 - q Acquired Distinctiveness
 - q Supplemental Register?
- n *Functionality*: The feature should not be essential to the use or purpose of the article, and it should not affect the cost or quality of the article.
 - q *Aesthetic Functionality*: Even if the feature does not provide a truly utilitarian advantage in terms of product performance, if it provides other competitive advantages, it may not be protected.

Product Packaging

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- n Capable of being inherently distinctive. Test:
 - q is it a common basic shape or design?
 - q is it unique or unusual in the field it is used?
 - q is it commonly-adopted and well-known form of ornamentation for a particular class of goods?
 - q is it capable of creating a commercial impression distinct from the accompanying words?

- n Non-functionality test:
 - q is there an utility patent that discloses the utilitarian advantages?
 - q does advertising tout the utilitarian advantages?
 - q are there alternative designs?
 - q does it result from comparatively simple or inexpensive method of manufacturing
 - § Aesthetic functionality test: Does it provide other competitive advantages?

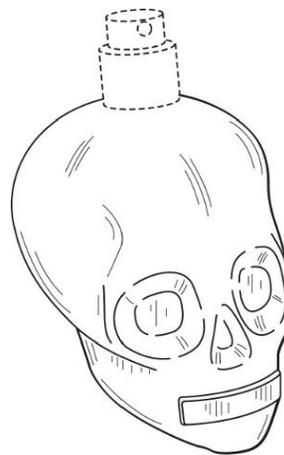
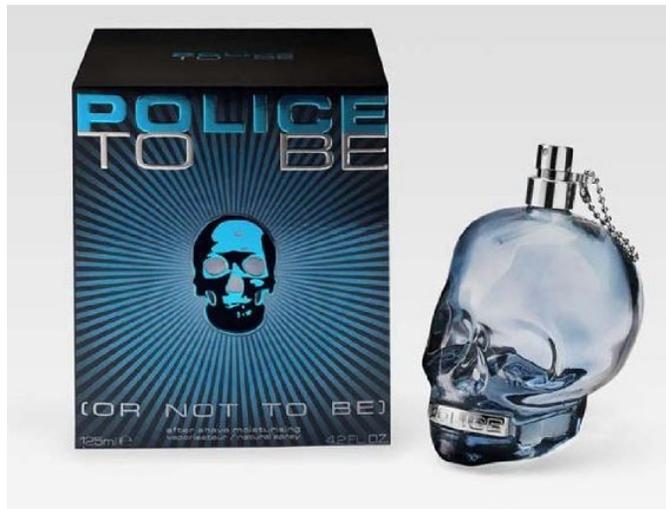
Product Packaging

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- Examples of inherently distinctive and non-functional product packaging:

Configuration of a glass bottle container for the goods in the shape of a human skull

Distinctively shaped contour, or confirmation and design of the bottle



Product Packaging

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- n Example:
 - q *Wax-like coating covering the cap of the bottle and trickling down the neck of the bottle in a freeform irregular pattern*
 - q Inherently distinctive and non-functional



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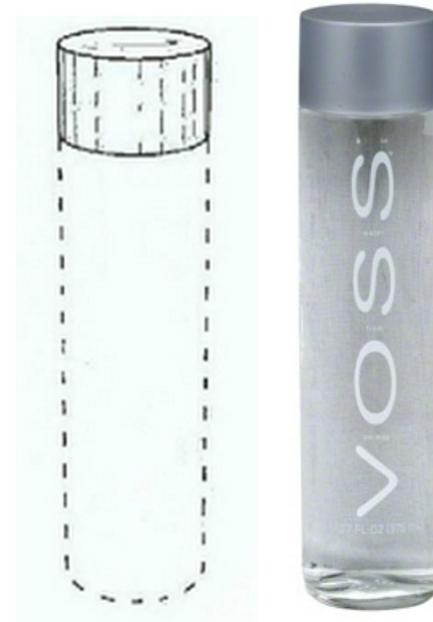
n Examples:

- q Not inherently distinctive but has acquired distinctiveness, non-functional

configuration of the container for the goods, namely, a cylindrical jar with a cylindrical lid having a double octagon nut-shaped handle



cylindrical lid of the same diameter as its container



Product Packaging

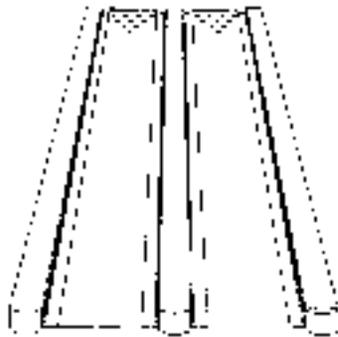
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- n For services: Capable of being inherently distinctive
- n Example:
 - q Mexican-themed décor in the chain restaurants – *inherently distinctive (and non-functional)*



n Example:

- q *The mark consists of tubular lights running length-wise down bowling lanes projecting over the gutters.*
- q Services: Bowling alley services.
- q Not inherently distinctive and was refused for failure to show acquired distinctiveness.
- q “novel tubular lights used in connection with bowling alley services would be perceived by customers as “simply a refinement of the **commonplace decorative or ornamental lighting** and would not be inherently regarded as a source indicator.”

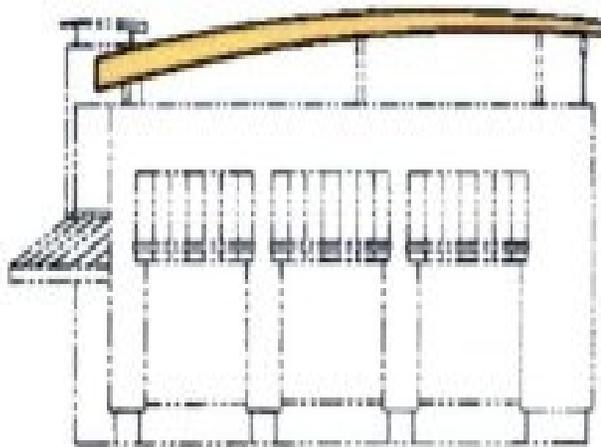


Product Packaging

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n Example:

- q Yellow arc design of the building for restaurant services
- q Not inherently distinctive
- q Registered at Supplemental Register because McDonald's could not show acquired distinctiveness.



Product Design

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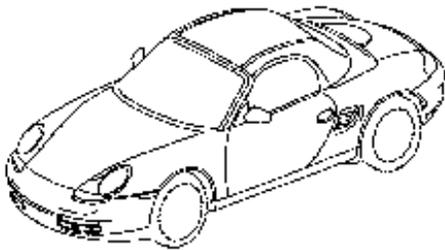
- n Not capable of inherent distinctiveness; must show acquired distinctiveness (secondary meaning).
 - q “Secondary meaning is acquired when the public views its primary significance as identifying the source of the product rather than the product itself”
 - q The Supreme Court noted that product design (e.g., shape/configuration) almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (such as a cocktail shaker shaped like a penguin) is intended not to identify the source, but to render the product itself more useful or appealing. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.* 529 U.S. 205, 120 S. Ct. 1339 (2000)
- n Must be non-functionality
- n Test for inherent distinctiveness and functionality is same as for product packaging design.

Product Design

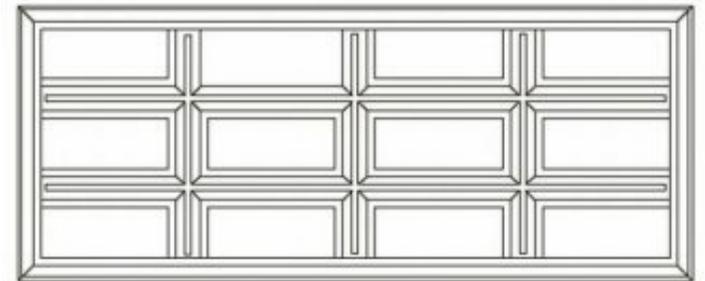
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- Examples of non-functional product design that has acquired distinctiveness

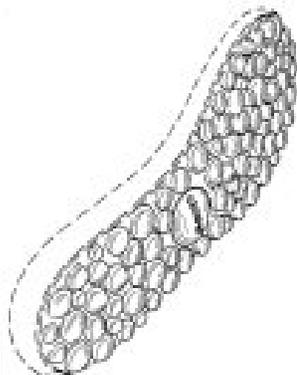
Configuration of an automobile



twelve (12) equally-sized recessed rectangular panels arranged in a four panel by three panel format with each panel having its own raised border within a large rectangle



configuration of a raised bubble design located on the outsole of a shoe



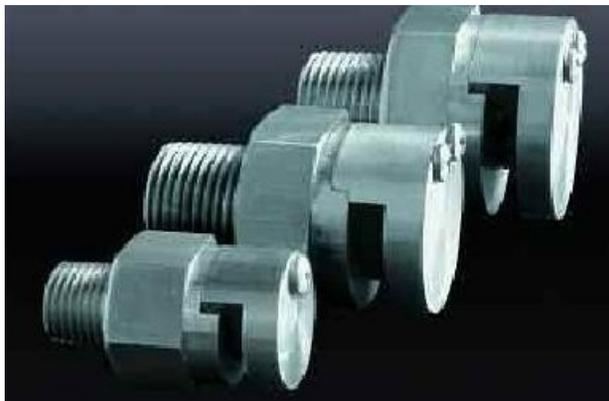
n Example of functional product design



Products: metal spray nozzles.

Mark: round disk head on sprayer nozzle.

Registration was refused on the ground that it is functional because round head is a preferred shape for metal spray nozzle tips, and because the round disc shape of the nozzle head was efficient and economic to manufacture.



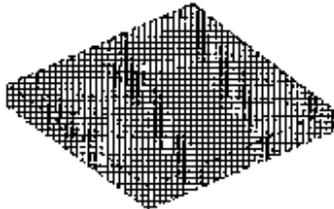
- n Not capable of inherent distinctiveness, acquired distinctiveness (secondary meaning) must be shown.
 - q Color, whether a single overall color or multiple color applied in a specific and arbitrary fashion, is usually perceived as an **ornamental** feature of the goods or services and does not function as a source indicator (secondary meaning).
 - q It is difficult to show acquired distinctiveness and that color has a “secondary meaning.”

- n Non-functional test
 - q Usually aesthetic functionality is found in lack of utilitarian functionality.

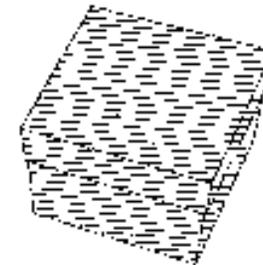
Color

- q Examples of registered color marks (i.e. non-functional and were acquired distinctiveness):

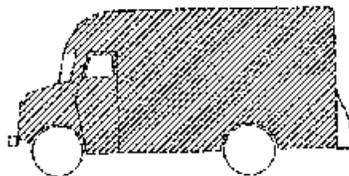
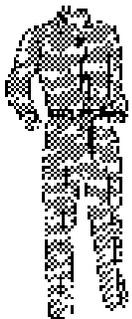
The mark consists of the color **canary yellow** used over the entire surface of the goods



The mark consists of a shade of blue often referred to as **robin's-egg blue** which is used on boxes



The mark consists of the color **brown** which is applied to the clothing



The mark consists of the color **brown** applied to the vehicles used in performing the services



q Example of color mark that was found functional:

Mark: color black as applied to a substantial portion of the outside surface of a box which serves as a container or packaging for flowers and in part forms a background to design and literal elements applied thereto.

Products: Flowers

Registration was refused on the ground that color black "serves an *aesthetic function*" when used for floral packaging; there exists a strong competitive need to use that color in order to convey a particular message to the recipient of the flowers: elegance or luxury, or may have significance "on somber occasions, such as in the context of death." And black is traditionally used in Halloween floral bouquets or arrangements.



- q Examples of color marks that were refused registration:
 - q *In Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995), the Federal Circuit affirmed the Trademark Trial and Appeal Board's determination that the **color black for outboard motors** was **functional** because, while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages – i.e., ease of coordination with a variety of boat colors and reduction in the apparent size of the engines.
 - q *In In re Hudson News Co.*, 39 USPQ2d 1915, 1916 (TTAB 1996), aff'd per curiam, 114 F.3d 1207 (Fed. Cir. 1997), the applicant sought to register the mark that it described as “distinctive trade dress consisting of the **color blue utilized as a motif** in association with the store name and other trade dress elements such as carpeting, neon lighting, publication(s) display panels and surrounds, shelving and employee uniforms.” The examining attorney found the color blue utilitarian (functional) because it has a calming affect. The Trademark Trial and Appeal Board disagreed but found that “blue motif” was “quite pedestrian” and therefore lacks inherent distinctiveness. Thus, the color mark could not register without the showing of acquired distinctiveness.

Color

- n *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, 778 F.Supp.2d 445 (S.D.N.Y. 2011)
 - q District Court found that color is *per se* functional in fashion industry
 - q Second Circuit interpreted Supreme Court's *Qualitex* ruling to forbid the implementation of a *per se* rule that would deny protection for single-color marks in particular industries.



Christian
Louboutin



- q Capable of being inherently distinctive, but...
 - q “commonplace” sound or sound made in the “normal course of operation” are not inherently distinctive and requires proof of acquired distinctiveness.
 - q Examples of registered inherently distinctive non-functional sound marks:



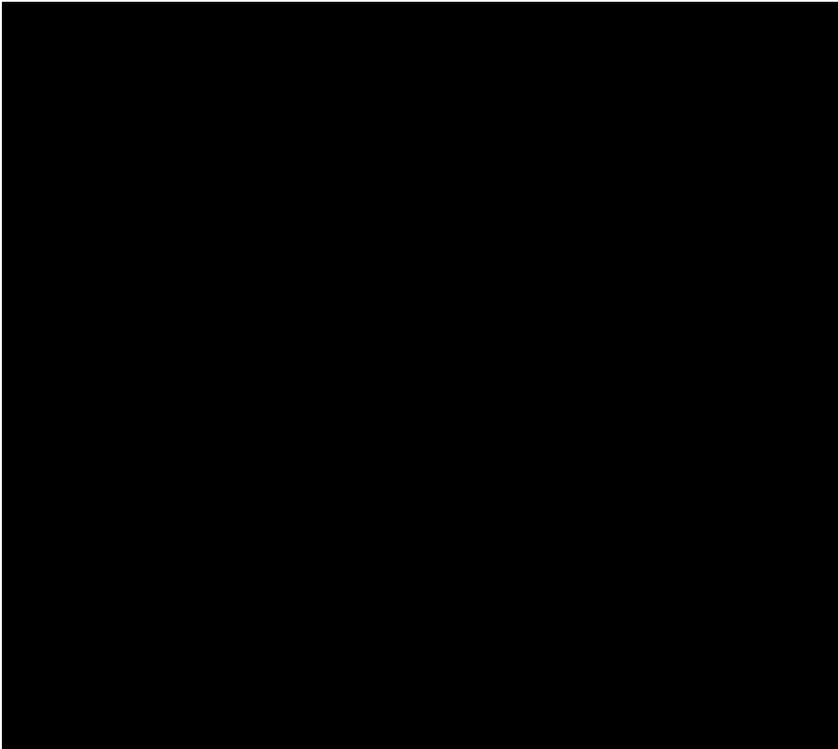
- q Examples of “commonplace” sound or sound made in the “normal course of operation”:
 - q *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393 (TTAB 2009): Cellular telephones that emit a “chirp” sound fall into the category of goods that make the sound in their normal course of operation.
 - q *Vertex*, 89 USPQ2d at 1700, 1702: Personal security alarm clock products that emit a sound pulse fall into the category of goods that make sound in the normal course of operation.

Sound

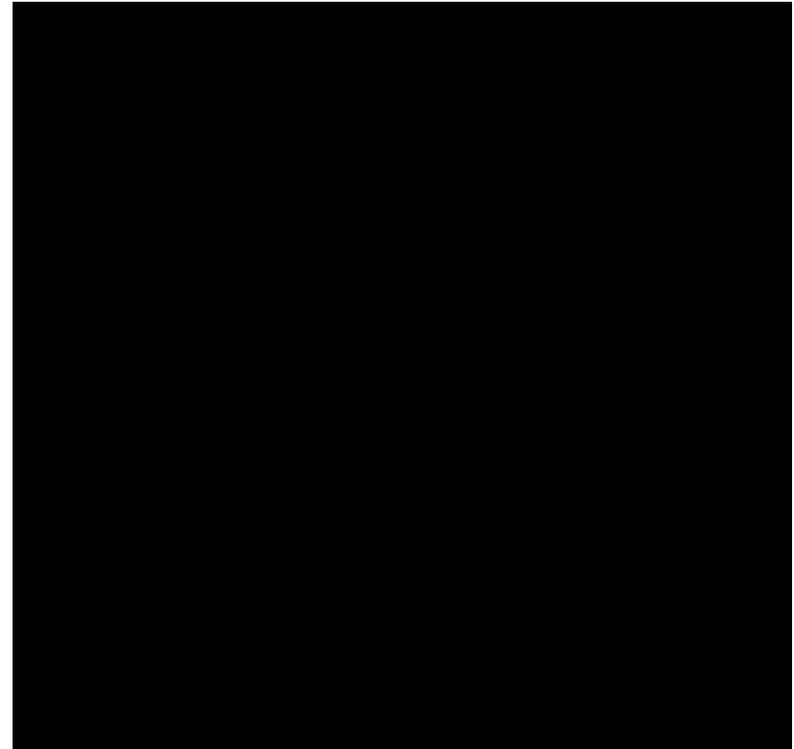
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Harley Davidson Engine Sound

Mark consists of exhaust sound of applicant's motorcycles, produced by V-Twin, common crankpin motorcycle engines when the goods are in use



Honda Engine Sound



- n Not capable of inherent distinctiveness, acquired distinctiveness must be shown:
 - q Examples:
 - n plumeria blossoms for “sewing thread and embroidery yarn registered in Supplemental Register
 - n scent of a pina colada for “ukuleles” registered in Supplemental Register.
 - n coconut scent or fragrance for “retail stores featuring flip flops” registered in Supplemental Register.
 - n rose oil scent or fragrance for “advertising and marketing services” registered in Supplemental Register.
- n It is functional if scent is inherent in the product itself (i.e. scent of perfumes, household products with fragrance).

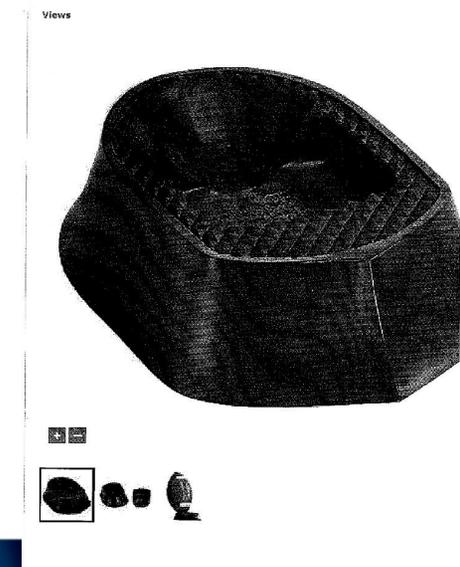
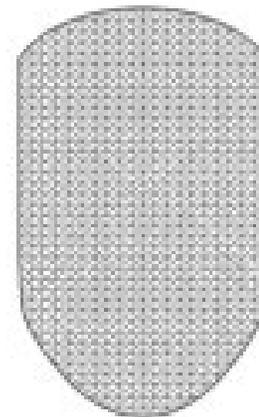
- n Not capable of inherent distinctiveness, acquired distinctiveness must be shown.
 - q The Trademark Trial and Appeal Board is unclear whether taste can be a source identifier at all because flavor or taste generally performs a utilitarian function and consumers generally have no access to a product's flavor or taste prior to purchase.
 - q 9 taste marks were filed for registration at the U.S. Patent and Trademark Office and all were denied due to lack of secondary meaning and functionality.
- n It is consistently found to be functional so far especially for pharmaceutical products.
 - q *Ex:* flavor (i.e. orange, peppermint etc.) functions to hinder the unpleasant taste of the drug.
 - q *Ex:* peppermint oil flavor increases the speed and effectiveness of nitroglycerin formulation because peppermint oil acts as a vasodilator, it has the effect of increasing the rate at which the nitroglycerin is absorbed into the bloodstream of the body.

Texture

- n If it is the texture of the product itself, it may not be capable of inherent distinctiveness, acquired distinctiveness must be shown.
- n Must be non-functional.
- n Examples of registered texture:

The mark consists of a velvet textured covering on the surface of a bottle of wine

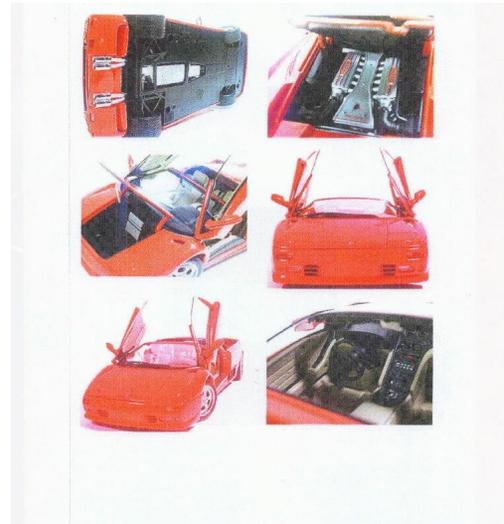
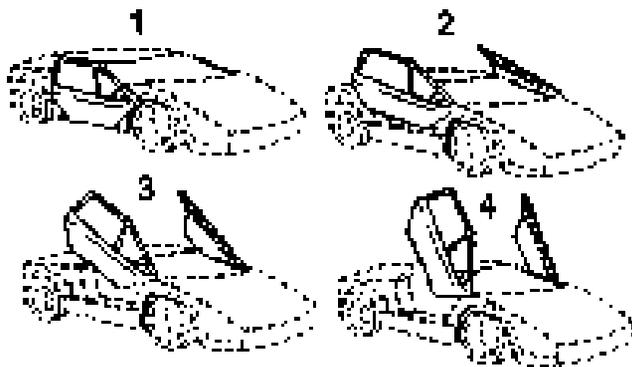
surface texture on a surface of a football kicking tee, the surface texture consisting of an array of 4-sided pyramid projections with respective bases of adjacent pyramid projections being contiguous with one another



Motion

- n If it is the product itself, it may not be capable of inherent distinctiveness, acquired distinctiveness must be shown.
- n Must be non-functional.
- n Example of a registered motion:

unique **motion** in which the door of a vehicle is opened



In Short...

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