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# A delight for the senses: identifying and protecting non-traditional marks

Non-traditional marks present creative ways to engage consumers, but their registration can be complex and present unique challenges for rights holders

A growing number of rights holders are taking bold, innovative steps in advertising and marketing to distinguish themselves and their valuable brands from others. In addition, they are seeking to protect 'non-traditional' trademarks. In the United States and elsewhere, applications to register such marks – distinctive motions, sounds, colours, textures, scents, flavours, product and store designs and product packaging – can be complex and present unique challenges for rights holders and trademark practitioners.

Examples of registered non-traditional marks include UPS's rights in the colour 'brown', the unique Coca-Cola classic bottle design and Nokia's famous ringtone. New, innovative marks of all kinds are being developed and registered in many different industries (eg, the rectangular glass storefront design and interior layout of Apple Inc's retail stores and the quacking sound of the American Family Life Assurance Company of Columbus's famous duck). Federal trademark protection for non-traditional marks can often be difficult to obtain without considerable investment in advertising and marketing, but sophisticated rights holders recognise that such protections can be extremely valuable.

When preparing an application for a non-traditional mark, careful attention must be given to:

- the description of the mark;
- the drawing (for motion, colour, product design and product packaging marks);
- the specimen of use;
- whether evidence of acquired distinctiveness is necessary; and
- functionality issues.

These elements should be considered carefully, as they can impact on registrability, the scope of protection and the long-term strength of the mark.

## Description of the mark

An application for a non-traditional mark must include a description of the mark. The description should identify the significant, non-functional characteristics and features of the mark. Often, an artfully worded description of the mark can ease the path to registration. Hershey Chocolate and Confectionery Corporation recently sought to register a product design for its chocolate bars; the application was initially refused, in part, on grounds that the flat rectangular shape and the scoring of the candy bar into smaller pieces were functional. On appeal, the Trademark Trial and Appeal Board carefully examined the description of the mark and found the mark to comprise four elements: a rectangular bar divided into 12 segments, each with a certain size and shape, arranged in a particular way, and each having a design of a raised border within a large rectangle. The unique combination of these elements was found to be protectable.

In another board decision, the description of the respective marks was instructive on the issue of likelihood of confusion between a teal mark and a registered blue colour mark used on medical devices. After considering various definitions of 'teal' (most describing it as 'greenish-blue' or 'blue-green'), the board concluded that the registrant's blue mark covered all shades of blue, including 'greenish-blue', and found the marks to be confusingly similar.

## Drawing of the mark

For motion, colour, product design and product packaging marks (those with a 'visual' aspect to them), an applicant must submit exacting drawings of the applied-for mark. Such renderings are critically important because they help to define the scope of protection to which the mark is entitled. They also guide third parties evaluating

whether their own marks are sufficiently distinguishable to avoid confusion.

Motion marks in particular have fairly rigid drawing requirements, designed to ensure that the mark is properly defined. The drawing must depict a single point of the motion or up to five freeze frames – whichever best depicts the commercial impression of the mark

For a colour mark, the drawing must show the mark in colour and the applicant must:

- name the colour(s) for which protection is being sought;
- describe where the colour(s) appear on the mark; and
- submit a claim that the colour(s) is a feature of the mark.

For three-dimensional product design and product packaging marks, the applicant must submit one drawing depicting all aspects of the applied-for mark and indicate that the mark is three-dimensional. If the applicant believes that the mark cannot adequately be depicted in a single rendition, it must file a petition to request a waiver of this requirement.

Occasionally, a court will remedy an inconsistency between the description of the mark and actual use of a mark in commerce. For example, the Louboutin red-sole mark (Reg no 3361597), the subject of recent litigation, was originally described and registered as "a lacquered red sole on footwear". However, when Louboutin sought to enforce its red-sole mark against red monochromatic footwear, the Second Circuit found that confusion was unlikely and, consistent with the bulk of the evidence that Louboutin had submitted to the court of its actual use, required Louboutin to narrow the scope of its registration by amending the description of the mark to "red lacquered outsole on footwear *that contrasts with the*

color of the adjoining ('upper') portion of the shoe" (emphasis added).

### Acceptable specimen

Before a registration will be issued, an applicant for a non-traditional mark must submit a specimen of the mark as it is used in commerce on or in connection with the relevant goods and/or services.

Unlike other applicants, those seeking to register scent and texture marks will generally be required to ship a physical specimen to the US Patent and Trademark Office (USPTO) for actual examination.

For motion marks, a specimen can be in electronic form, but it must show the entire repetitive motion, as opposed to only parts of it, in order to convey the commercial impression of the mark. Demonstrating use of a motion mark on goods presents a potential issue because the applicant may need to submit a webpage display – rather than product packaging or a photograph of the product – as a specimen. In December 2012 the USPTO issued Examination Guide 1-13 to clarify the requirements for such specimens. Essentially, an acceptable webpage display associated with goods must:

- contain a picture or description of the goods;
- show the mark in (close) association with the goods; and
- contain ordering information.

Another important consideration for non-traditional mark applicants is to avoid submitting a specimen or supporting advertising materials that tout one or more utilitarian features of the mark. This can inadvertently trigger a refusal of the application on grounds that the mark is functional.

### Inherent and acquired distinctiveness

Certain types of non-traditional mark (eg, product packaging, motion marks and unique sound marks) are capable of being "inherently" distinctive and may in some cases be registrable without a showing of acquired distinctiveness. Conversely, product design, colour, scent and commonplace sound marks can never be inherently distinctive and must be accompanied by evidence of acquired distinctiveness. Failure to provide such evidence is a basis for refusal of the application.

Sometimes it is unclear whether a mark constitutes product packaging (which can be inherently distinctive) or product design (which always requires a showing of acquired distinctiveness). In cases of uncertainty, the USPTO typically will classify ambiguous



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marks as product design, rather than product packaging, and require a showing of acquired distinctiveness, so applicants should be prepared for this contingency.

In some cases, the USPTO will require substantial proof of acquired distinctiveness to support an application for a non-traditional mark. This can occur when an applicant applies to register a colour that is fairly common in a certain field or when one is attempting to register a common scent.

### Lack of functionality

Another important consideration when preparing an application for a non-traditional mark is the issue of functionality. A completely utilitarian or functional mark can never be registered, regardless of the amount of acquired distinctiveness. The functionality doctrine is designed to promote competition and prevent parties from registering functional matter as trademarks, which, unlike patents, may be renewed in perpetuity.

Functionality refusals are common obstacles to registration of non-traditional marks. For example, the colour black was found to be functional for outboard motors because it was aesthetically pleasing and provided a competitive advantage, in that it was compatible with a wide variety of boat colours and made an engine appear smaller. The colour coral was found to be functional for earplugs, as such a bright colour made it easier to monitor compliance with health and safety regulations. Scents which have a utilitarian purpose with respect to the goods in a trademark application (eg, perfumes or air fresheners) are functional and not registrable. Also, an application to register the flavour orange for pharmaceutical pills was refused on grounds that the flavour was functional because it made medication palatable.

Again, it is important to be certain that the client's own advertising materials, social media pages and websites – regardless of whether they are being submitted to the USPTO with an application – do not directly or indirectly suggest that a non-traditional mark is functional or describe its features as utilitarian. This could prevent the client from securing a registration or be used in a cancellation action or lawsuit to invalidate an existing registration.

Non-traditional marks present creative ways for brand owners to communicate with and engage consumers. With proper attention to filing requirements and an awareness of issues that can arise from the client's use of such marks in advertising and marketing, these marks can be registered and leveraged to provide lasting value and goodwill. **WTR**