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Trademark Boundaries: The Geography of Non-Conventional Marks

*Constance R. Lindman, Esq.**

SUMMARY

This article addresses the use and protection of non-conventional trademarks; in particular, the basis for protection of non-conventional trademarks in the United States. Non-conventional trademarks include visually perceptible marks such as color and product shape, and non-visually perceptible marks including sound, scent, and texture marks. This article further discusses the critical role of secondary meaning in establishing rights in non-conventional marks. Finally, this article considers the effect of consumer history and geography on establishing secondary meaning in non-conventional marks.

I. INTRODUCTION

Today's modern consumers would easily recognize the earliest marks adopted in the eastern and western worlds as trademarks. During China's Song Dynasty in the 13th Century, symbols were applied to porcelain and other goods to identify their maker.¹ Around the same time in Italy, paper producers began applying designs known as "watermarks" to identify their origin from a particular papermaker or trade guild.² These early trademarks, just like today's marks, were associated with the quality of the marked goods and came to denote good will.³

While conventional marks comprised of letters, numbers, or designs (or some combination of these) still dominate the trademark universe, the variety of "signs" or "devices" protectable as trademarks in much of the world has expanded in a manner that would be unrecognizable to purchasers of dishware in China or paper in Italy nine centuries ago. Non-conventional trademarks encountered by modern consumers may include visible signs such as colors, shapes, and moving images, as well as non-visible signs including sounds, scents, tastes, and textures. Examples include the blue color

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1. Charles L. Miller II, *A Cultural and Historical Perspective to Trademark Law Enforcement in China*, BUFF. INTELL. PROP. L.J. 103, 114 (2004).
2. *Water Marks*, MCKINNEY ENG'G LIBRARY, <http://www.lib.utexas.edu/engin/trademark/timeline/ren/watermarks.html> (last visited Jan. 28, 2018).
3. See Miller, *supra* note 1, at 115 n.56; see also *The Renaissance of Trademarks*, MCKINNEY ENG'G LIBRARY, <http://www.lib.utexas.edu/engin/trademark/timeline/ren/ren.html> (last visited Jan. 28, 2018).

of a robin's egg,⁴ the shape of a bottle,⁵ the sound of a lion's roar,⁶ the scent of bubble gum,⁷ and the texture of velvet.⁸

II. CONVENTIONAL TRADEMARKS AND THE SPECTRUM OF DISTINCTIVENESS

The United States has extended trademark protection to product shapes for over fifty years. Indeed, the United States Patent and Trademark Office (USPTO) granted a trademark registration for the Coca-Cola bottle shape in 1960.⁹ Companies doing business in the United States have continued to push the boundaries of trademark protection in recent decades to include visually perceptible marks (colors, holograms, moving images) and non-visually perceptible marks (sound, scent, texture). But, more than a vivid imagination is required to protect non-conventional trademarks in the United States. Non-conventional marks must perform the same function as conven-

4. The drawing is lined for the color blue, and color is a feature of the mark. The drawing of the box is outlined in dotted lines. The mark consists of a shade of blue often referred to as robin's egg blue, which is used on catalog covers, TIFFANY AND COMPANY, Registration No. 2416794; the mark consists of a shade of blue often referred to as robin's egg blue, which is used on bags, TIFFANY AND COMPANY, Registration No. 2416795; the mark consists of a shade of blue often referred to as robin's egg blue, which is used on boxes, TIFFANY AND COMPANY, Registration No. 2359351; and the mark consists of the color blue as applied to the top face of a fastener, where the diameter of the blue circle is about one half the diameter of the face of the fastener, TIFFANY AND COMPANY, Registration No. 4177892.
5. The trademark consists of the distinctively shaped contour, or confirmation, and design of the bottle as shown, COCA-COLA, Registration No. 0696147; the mark consists of the three dimensional configuration of the distinctive bottle as shown, COCA-COLA, Registration No. 1057884. The mark consists of a bottle design featuring a series of alternating vertical panels on the lower half of the bottle. One set of panels has a slightly textured surface and features the "Coca-Cola" trademark, and the other features a surface filled with multiple raised circular bubbles. A vertical wavy line of varying width separates the two panels. The dotted outline of the screw top closure and the bottle base are for positioning only and do not comprise a feature of the mark, COCA-COLA, Registration No. 3510996.
6. The mark comprises a lion roaring. METRO-GOLDWYN-MAYER, Registration No. 1395550.
7. The mark consists of the scent of bubble gum, Registration No. 4754435.
8. The mark consists of a velvet textured covering on the surface of a bottle of wine, Registration No. 3155702 (the registration was subsequently cancelled for failure to file a declaration of continued use of the mark in commerce).
9. The trademark consists of the distinctively shaped contour, or confirmation, and design of the bottle as shown, COCA-COLA, Registration No. 0696147.

tional marks; namely, they must distinguish the owner's goods or services from the goods or services of others.

Some signs can never function as trademarks because they will never serve the critical role of distinguishing the goods or services. For example, a generic term such as "apple" cannot serve as a trademark for apples because it can never distinguish the apples of one supplier from the apples of another supplier. On the other hand, some signs can function as trademarks the instant they are adopted because they immediately function to distinguish the goods or services. For example, "Xerox" is a fanciful term with no prior meaning. It is considered a strong mark and, immediately upon being adopted, it distinguished the owner's copiers from other copiers. Generic (unprotectable) signs and fanciful (strong) marks lie at opposite ends of the trademark spectrum. Most U.S. marks lie in between these two extremes, and are classified (from strongest to weakest) as arbitrary, suggestive, and descriptive marks.¹⁰

Like fanciful marks, arbitrary and suggestive marks serve to distinguish the owner's goods immediately upon use. Stated another way, these marks are inherently distinctive. Arbitrary marks are terms that have an accepted meaning, however, their meaning is not associated with the goods or services. As mentioned above, the term "apple" used in connection with apples is generic, and cannot be protected. However, the term "apple" as used by Apple Inc. in connection with computers and mobile phones is an arbitrary mark. A suggestive mark is a term that is associated with the goods or services, but only weakly. A suggestive mark merely alludes to some attribute of the product, but does not directly describe the product or its features. The term "Mustang" used as the model of car brings to mind the qualities of a wild mustang horse such as speed and power, but does not describe a car or its particular qualities.

In contrast to fanciful, arbitrary, and suggestive marks, descriptive terms do not automatically function as trademarks. Descriptive terms describe an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services.¹¹ Descriptive terms can be protected as trademarks in the United States, but only if they acquire distinctiveness or "secondary meaning" as an identifier of source.¹² For example, the term "national" describes car rental services that are offered throughout the country or nation, yet "National" is entitled to protection as a trademark in the United States for car rental services because it has developed secondary meaning to the public

10. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (establishing the distinctiveness spectrum and relative strength of marks, from fanciful to generic).

11. 15 U.S.C. § 1052(e)(1) (2012).

12. *Abercrombie*, 537 F.2d at 9.

through long and extensive use by National Car Rental.¹³ Proof of secondary meaning is required so that competition is not improperly stifled.¹⁴

III. NON-CONVENTIONAL MARKS AND DISTINCTIVENESS

Like conventional signs, in order to function as a mark non-conventional signs must distinguish the goods or services on which they are used from other goods or services. So, non-conventional signs may be entirely unprotectable (like generic terms), immediately protectable (like fanciful, arbitrary, and suggestive terms), or protectable only after acquiring secondary meaning (like descriptive terms).

Functional aspects of a product or service are treated the same as generic terms; they are not capable of distinguishing the producer's goods or services and therefore cannot be protected.¹⁵ For example, a loud alarm consisting of alternating pulses was found to be functional for personal security alarms because a loud alarm was essential to the use or purpose of security alarms, and alternating pulses were more effective than a steady sound.¹⁶ Harley Davidson's attempt to register "the exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines when the goods are in use" was strongly opposed by Kawasaki and Honda, who argued that the sound was purely functional because it was nothing more or less than that produced by any engine of that type.¹⁷

A product's colors and shape are treated like descriptive terms; they can only be protected upon showing that they have become distinctive by developing secondary meaning.¹⁸ Other types of non-conventional signs, including sounds and textures, may be either immediately distinctive (such as fanciful, arbitrary, and suggestive conventional marks) or require proof of secondary meaning (such as descriptive conventional marks). But, non-conventional marks are seldom found to be inherently distinctive, thus their owners would be wise to anticipate a need to show proof of secondary meaning.

13. NATIONAL CAR RENTAL, Registration No. 1540913.

14. Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 214 (2000).

15. Traffix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001).

16. *See In re Vertex Grp. L.L.C.*, 89 U.S.P.Q.2d 1694 (T.T.A.B. 2009).

17. *Kawasaki Motors Corp. v. H-D Mich., Inc.*, 43 U.S.P.Q.2d 1521, 1522 (T.T.A.B. 1997); *see also* *Honda Gikenogy Kabushiki Kaisha v. H-D Mich. Inc.*, 43 U.S.P.Q.2d 1526 (T.T.A.B. 1997) (Harley Davidson abandoned the application before a decision was issued).

18. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Wal-Mart Stores, Inc.*, 529 U.S. at 205.

Comparing the quack of feuding duck-boat operators with the quack of the AFLAC duck is illustrative.¹⁹ “Duck” boats are amphibious vehicles developed during World War II. Some of these vehicles are still in use, but rather than conveying soldiers, they now convey tourists. In one case Ride the Ducks provided duck calls to their guides and customers to use during tours, and registered the sound of the duck calls for “tour guide services over land and water by amphibious vehicles.”²⁰ Ride the Ducks sued its competitor, Duck Boat Tours, to stop them from also providing duck calls to their guides and customers.²¹ The court analyzed whether Ride the Ducks was required to show proof of secondary meaning.²² If the “quack” of the duck call was a “unique, different, or distinctive” sound, then it was inherently distinctive and could be protected without proof of secondary meaning.²³ If the sound was “commonplace,” then it could only be protected if Ride the Ducks was able to show that it had developed secondary meaning.²⁴ In this instance, the court found that the duck call sound was commonplace.²⁵ And because Ride the Ducks failed to establish that the sound had acquired secondary meaning, Ride the Ducks could not prevent Duck Boat Tours from also using the duck calls.²⁶

Unlike the commonplace “quack” of Ride the Ducks, the quack of the AFLAC duck was registered by the U.S. Trademark Office without proof of secondary meaning.²⁷ The difference being that an actual duck will never utter the AFLAC duck quack. The AFLAC quack sounds like the word “AFLAC” pronounced by a person with a terribly sore throat.²⁸ It is a unique, different, or distinctive sound, and is therefore inherently distinctive and protectable without proof of secondary meaning.²⁹

19. See *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, No. Civ.A. 04-CV-5595, 2005 WL 670302 (E.D. Pa. 2005), *reh’g denied*, 2005 U.S. Dist. LEXIS 8162 (E.D. Pa. Apr. 22, 2005), *aff’d*, 138 Fed. Appx. 431 (3d Cir. 2005).

20. The mark consists of a quacking noise made by tour guides and tour participants by use of duck call devices throughout various portions of the tours, Registration No. 2484276.

21. See *Ride the Ducks*, 2005 WL 670302, at 1269.

22. *Id.* at 1274.

23. *Id.*

24. *Id.*

25. *Id.*

26. *Id.*

27. The mark consists of the sound of a duck quacking the word “AFLAC,” Registration No. 2607415.

28. See *Ride the Ducks*, 2005 WL 670302, at 1274 (U.S. Trademark Reg. No. 2607415 is owned by American Family Life Assurance Company of Columbus (AFLAC)).

29. See *id.*

IV. ESTABLISHING SECONDARY MEANING FOR NON-CONVENTIONAL MARKS

As discussed above, establishing secondary meaning is often critical for protecting non-conventional marks. Certain signs (i.e. colors and product shapes) cannot be protected without proof of secondary meaning, and other types of non-conventional signs are likely to require proof of secondary meaning. The Lanham Trademark Act expressly provides for registration of a mark that has acquired distinctiveness and permits (but does not require) the Trademark Office to accept substantially exclusive and continuous use for at least five years as proof of secondary meaning.³⁰ In practice, the Trademark Office only accepts substantially exclusive and continuous use for five years as sufficient when the mark is not highly descriptive. Highly descriptive conventional marks and certain categories of non-conventional marks (product design, color, and sounds made by a product during normal operation) require further proof of secondary meaning.³¹ The further proof could be a long-term use in commerce, extensive advertising expenditures, declarations establishing recognition of the sign as a source indicator, or market research and survey evidence.³²

While the same types of evidence may be used to show secondary meaning for conventional and non-conventional marks, proving secondary meaning for non-conventional marks may prove more difficult. As a conceptual matter, “secondary meaning” is achieved when purchasers view the sign as an indication of source; that is, when consumers recognize the sign as a trademark.³³ Conventional signs consisting of visual letters, numbers, and symbols have been used for thousands of years. Consumers that encounter a fanciful, arbitrary, or suggestive conventional sign used in a conventional way (Xerox, Apple, Mustang) will be inclined to immediately view the sign as a mark. Consumers that encounter a descriptive sign used in a conventional way (National Car Rental) will naturally view the sign as a mark when they begin associating the sign with the goods or services. In contrast, consumers encountering a non-conventional sign must first accept that it is possible for the non-conventional sign to function as a mark and, second, actually view the sign as indicating the source of the goods or services.

As certain categories of non-conventional signs become more common, consumers will be more likely to recognize them as marks. For example, the proliferation of sound marks and their relatively long history compared to other non-conventional marks arguably means that consumers are more

30. Lanham Trademark Act, 15 U.S.C. § 1052(f) (2012).

31. TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212.05(a) (2017).

32. *Id.* § 1212.06.

33. *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 253 (1995).

likely to recognize new sound marks.³⁴ Either the Trademark Office or courts may require less proof of secondary meaning or proof may become easier to acquire. Signs that are highly non-conventional with less consumer history, such as scent marks and texture marks, arguably will require more evidence of secondary meaning to establish trademark rights. Indeed, consumers' acceptance of non-conventional marks, and the level of proof for secondary meaning required to establish trademark use, may vary not only with the type of mark, but also with geography.

Consumers in countries where the use and protection of non-conventional marks was previously prohibited or is simply less well-established may be less likely to view a non-conventional sign as a distinctive mark indicating the source of the goods or services. Stronger proof of secondary meaning may be required in this situation, compared to where consumers have grown used to such non-conventional marks. As goods and services cross from one country to another, their trademarks cross along with them. Trademark owners must of course consider whether the laws of a particular country allow protection of the mark. Assuming protection is legally available, owners are wise to also consider the levels and types of proof necessary to show that a sign functions as a mark for particular consumers where they are located, taking into account their familiarity with non-conventional marks.

V. CONCLUSION

The history of conventional marks goes back thousands of years. While non-conventional marks are not so ancient, they are likely to become increasingly important as the pace of global trade increases. Companies seeking to stand out from the crowd of competitors may more often turn to non-conventional marks. As the use of non-conventional marks grows, consumers around the world will more readily recognize and accept non-conventional marks. Nevertheless, the analysis of which non-conventional signs may function as marks and whether those signs actually do function as marks will remain an intensely local question.

34. Metro-Goldwyn-Mayer registered its "lion roaring" sound mark in 1986 claiming use since 1924. The mark comprises a lion roaring. METRO-GOLDWYN-MAYER, Registration. No. 1395550. NBC registered its "chimes" sound mark in 1971 claiming use since 1961. The mark comprises a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C—the "G" being the one just below middle C, the "E" the one just above middle C, and the "C" being middle C—thereby to identify applicant's broadcasting service. NATIONAL BROADCASTING COMPANY, Registration. No. 0916522. *Trademark "Sound Mark" Examples*, USPTO, <https://www.uspto.gov/trademark/sound-marks/trademark-sound-mark-examples> (last visited Jan. 28, 2018) (for other registered sound marks).