

**SOUNDS, SMELLS, SHAPES AND COLORS  
PROTECTION AND ENFORCEMENT OF NONTRADITIONAL TRADEMARKS  
IN THE U.S.**

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Traditionally, trademark protection in the United States was reserved for marks that are easily perceived as source identifiers, such as words, names, acronyms, logos, and graphic symbols.<sup>1</sup> However, gradually, the U.S. has extended trademark protection to other categories of marks that are not so easily perceived as source identifiers, such as product configurations<sup>2</sup>, colors<sup>3</sup>, sounds<sup>4</sup>, scents<sup>5</sup>, motions<sup>6</sup>, and holograms<sup>7</sup>.

**I. REGISTRATION REQUIREMENTS FOR NONTRADITIONAL MARKS.**

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<sup>1</sup> 15 U.S.C. § 1127 (the Lanham Act) defines a trademark and service mark as including “any word, name, symbol, or device, or any combination thereof” that identifies and distinguishes the goods and services of one person from those of another and indicates their source, even if that source is unknown.

<sup>2</sup> *See, e.g.*, U.S. Reg. No. 2876046 (applicant’s iMac computer configuration), U.S. Reg. No. 186,828 (configuration of a molded, conically shaped candy piece)

<sup>3</sup> *See, e.g.*, U.S. Reg. No. 1439132 (the color pink used throughout the entirety of home insulation fibers), U.S. Reg. No. 2390667 (the color “canary yellow” used throughout the surface of applicant’s stationary notes containing adhesive on one side for attaching to surfaces)

<sup>4</sup> *See, e.g.*, U.S. Reg. No. 1395550 (the sound of a lion’s roar used in connection with applicant’s movie production), U.S. Reg. No. 2692079 (the sound of a childlike human giggle used in connection with applicant’s grocery products)

<sup>5</sup> *See, e.g.*, U.S. Reg. No. 2463044 (the scent of cherry used in connection with applicant’s automotive lubricant), U.S. Reg. No. 2560618 (the scent of bubble gum used in connection with applicant’s metal cutting fluids)

<sup>6</sup> *See, e.g.*, U.S. Reg. No. 1928423 (computer generated sequence showing the central element from several angles as through a camera moving around the structure), U.S. Reg. No. 1946170 (three dimensional spray of water issued from the rear of a jet propelled watercraft that is generated during the operation of the watercraft)

<sup>7</sup> *See, e.g.*, U.S. Reg. No. 2710652 (holographic logo used in connection with baseball trading cards), U.S. Reg. No. 2730207 (holographic paper that reflects a spectrum of color in a pattern of oblique, parallel lines)

Nontraditional marks must overcome several hurdles in order to succeed in obtaining U.S. federal registration.

### **a. Product Configurations**

The drawing requirement for marks constituting product configurations presents unique issues. Often, the product configuration being registered utilizes two or three dimensions, or a unique combination or style of size. In these situations, the drawing must be submitted on a special form<sup>8</sup>. For three dimensional product configurations, “the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three dimensional<sup>9</sup>. Further, the drawing can be no larger than 8 cm high by 8 cm wide<sup>10</sup>. This can cause difficulty in adequately depicting a complex product configuration and identifying unique features, especially where the configuration is in three dimensions<sup>11</sup>.

### **b. Color**

For marks consisting solely of one color used in connection with goods or services, “the drawing must show the mark in color, and the applicant must name the color, describe where the color appear(s) on the mark and submit a claim that the color is a feature of the mark”<sup>12</sup>. Although the USPTO does not require a precise identification of the color, it has accepted Pantone Matching Systems color designations<sup>13</sup>.

### **c. Sound and Scent**

There is an exception to the drawing requirement for sound and scent marks<sup>14</sup>. “For these types of marks, the applicant must submit a detailed description of the mark”<sup>15</sup>. This requirement is most effectively satisfied by submitting a specimen, such as an audio cassette<sup>16</sup>.

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<sup>8</sup> 37 CFR § 2.52(b)

<sup>9</sup> 37 CFR § 2.52(b)(2)

<sup>10</sup> 37 CFR § 2.54(b)

<sup>11</sup> *See, e.g.*, U.S. App. Serial No 74-467938 (configuration of a motorcycle for motorcycles)

<sup>12</sup> 37 CFR § 2.52(b)(1)

<sup>13</sup> *See, e.g.*, U.S. Reg. No. 2256226 (“The orange color is approximately equivalent to Pantone 165C”)

<sup>14</sup> 37 CFR § 2.52(e)

<sup>15</sup> *Id.*

<sup>16</sup> 37 CFR § 2.56(d)(3)

However, submitting a specimen does not substitute for an attempt to describe the sound or the scent with particularity<sup>17</sup>.

An applicant seeking to register a sound mark may encounter a problem satisfying the requirement of definiteness due to the nature of the object creating the sound<sup>18</sup>. For example, in *Kawasaki Motors Corp., U.S.A. v. H-D Michigan, Inc. et al*, the applicant sought to register a mark consisting of “the exhaust sound of applicant’s motorcycles, produced by V-Twin, common crankpin motorcycle engines when the goods are in use”. The opposers argued that the description was indefinite because the exhaust sound varies depending upon the exhaust pipes used, the operating conditions, and the mode of use (i.e., idle, acceleration, deceleration, and vehicle drive-away). Although the court denied the opposers’ summary judgment motion on the definiteness issue, the applicant eventually withdrew its application in June of 2000 after a subsequent motion for summary judgment remained pending.

#### **d. Motion**

For marks involving motion, “the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement”<sup>19</sup>. The application must also describe the mark. The limitation of only presenting five freeze frames can cause a difficulty in describing a motion mark with sufficient particularity to present its unique features. Therefore, it is crucial that the written description of the mark adequately depicts the commercial impression<sup>20</sup>.

#### **e. Hologram**

In the area of holograms, the Trademark Board has noted that an applicant must be careful to properly limit the description of the mark to the context in which protection is being

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<sup>17</sup> See, e.g., U.S. Reg. No. 1639128 (“high impact fresh, floral fragrance reminiscent of plumeria blossoms”) (withdrawn), U.S. Reg. No. 2210506 (“the mark consists of the sound of the famous Tarzan yell. The mark is a yell consisting of a series of approximately ten sounds, alternating between the chest and falsetto registers of the voice as follows – 1) a semi-long sound in the chest register, 2) a short sound up an interval of one octave plus a fifth from the preceding sound, 3) a short sound down a Major 3<sup>rd</sup> from the preceding sound, 4) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 5) a long sound down one octave plus a Major 3<sup>rd</sup> from the preceding sound, 6) a short sound up one octave from the preceding sound, 7) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 8) a short down a Major 3<sup>rd</sup> from the preceding sound, 9) a short sound up a Major 3<sup>rd</sup> from the preceding sound, 10) a long sound down an octave plus a fifth from the preceding sound.”)

<sup>18</sup> See *Kawasaki Motors Corp., U.S.A. v. H-D Michigan, Inc. et al*, 43 U.S.P.Q.2d 1521 (T.T.A.B. 1997)

<sup>19</sup> 37 CFR § 2.52(b)(3)

<sup>20</sup> See, e.g., U.S. Reg. No. 2077148 (“the mark consists of an animated sequence of images depicting the silhouette of a portion of a planet with an upper case letter “N” straddling the planet and a series of meteorites passing through the scene...”)

sought<sup>21</sup>. In *The Upper Deck Co.*, the description of the mark identified the marks as a hologram device, in any size, shape, content or position on a trading card. The registration was refused on the grounds that a trademark application may only seek to register a single mark<sup>22</sup>. The Trademark Board rejected applicant's argument that the only device for which registration is sought is the presence of a hologram. The court reasoned that the description failed to provide the public with sufficient notice of what elements make up the mark.

## 2. Claiming Acquired Distinctiveness

### a. Product Configuration

In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the U.S. Supreme Court recently laid down the bright-line rule that product configurations can never be classified as "inherently distinctive"<sup>23</sup>. The Court reasoned that

"In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs--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 more appealing."<sup>24</sup>

As a result of this holding, applicants seeking to register or enforce product configuration trademarks must always prove acquired distinctiveness or "secondary meaning"<sup>25</sup>.

In *Wal-Mart*, the Supreme Court distinguished between product configurations, which can never be classified as inherently distinctive, and product packing (or things "akin to packaging") that can still be classified as inherently distinctive and registered without a showing of secondary meaning<sup>26</sup>. As a result, an applicant will be motivated to classify its mark as product packaging rather than product configuration. The courts, however, tend to classify trade dress as product configuration rather than packaging<sup>27</sup>.

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<sup>21</sup> In re *The Upper Deck Co.*, No. 75/064,130, 2001 TTAB Lexis 206 (T.T.A.B. February 14, 2001)

<sup>22</sup> See also *Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361 (Fed. Cir. 1999)

<sup>23</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 120 S. Ct. 1339 (2000)

<sup>24</sup> *Wal-Mart*, 120 S. Ct. at 1345

<sup>25</sup> *In re Encco Display Sys., Inc.*, 56 U.S.P.Q.2d 1279 (T.T.A.B. 2000)

<sup>26</sup> *Id.*

<sup>27</sup> See, e.g., *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25 (1st Cir. 2001) (appearance of decorative candle product line and catalog layout are product trade dress, not packaging), *McKernan v. Burek*, 118 F. Supp. 2d 119 (D. Mass. 2000) (novelty humorous bumper stickers which purport to be permits for an imaginary "Cape Cod Canal Tunnel" is a product, not a package), *Cont'l Lab. Prod., Inc. v. Medax Intern., Inc.*, 114 F. Supp.

In the USPTO, the burden of proving that a mark has acquired distinctiveness is on the applicant<sup>28</sup>. The amount and character of the evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered<sup>29</sup>. In the case of nontraditional trademarks, the amount of evidence required is substantial<sup>30</sup>. “Proof of substantially exclusive and continuous use” of a designation “as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made” may be accepted as *prima facie* evidence that the mark has acquired distinctiveness<sup>31</sup>. Also, the examining attorney may accept, as *prima facie* evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the same mark on the Principal Register<sup>32</sup>. Finally, evidence of long use of the mark, advertising expenditures, affidavits or declarations asserting recognition of mark as source indicator, survey evidence, market research, and consumer reaction studies, among other evidence, can be used to establish acquired distinctiveness<sup>33</sup>.

## **b. Color**

As with product configurations, the U.S. Supreme Court held in *Qualitex Co. v. Jacobsen Prods. Co.* that color marks can never be classified as inherently distinctive<sup>34</sup>. Thus, applicants who seek to register a color in connection with goods or services must overcome the obstacle of proving secondary meaning. The Trademark Trial and Appeal Board has stated that the burden to show acquired distinctiveness is even heavier in the case of color marks “because of the inherent non-distinctive nature of the applied-for mark. It is our view that consumers do not associate a single color of a product with a particular manufacturer as readily as they do a trademark product packaging trade dress.”<sup>35</sup>

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2d 992 (S.D. Cal. 2000) (holder for disposable laboratory pipette tips is product because it is “an integral part of the design of [plaintiff’s] pipette product” and “is physically and functionally inseparable from the whole of [plaintiff’s] pipette product...”)

<sup>28</sup> *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572 (Fed Cir. 1988)

<sup>29</sup> *See Roux Lab., Inc. v. Clairol Inc.*, 427 F.2d 823 (C.C.P.A. 1970)

<sup>30</sup> *Keating, Development of Evidence to Support Color-based Trademarks*, 9 J.L. & COMMERCE (1989), *see also In re Bongrain Int’l Corp.*, 894 F.2d 1316 (Fed. Cir. 1990)

<sup>31</sup> 15 U.S.C. § 1052(f), 37 C.F.R. § 2.41(b), TMEP § 1212.05

<sup>32</sup> 37 C.F.R. § 2.41(b), TMEP § 1212.04(b)

<sup>33</sup> TMEP § 1212.06(a)-(d)

<sup>34</sup> *Wal-Mart*, 120 S. Ct. at 1344, *citing Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300 (1995), *see also* TMEP § 1202.05

<sup>35</sup> *In re Ferris Corp.*, 2000 TTAB LEXIS 709 (T.T.A.B. 2000)

### **c. Sound, Scent, Motion, and Hologram**

Applicants seeking to register sound, scent, motion, or hologram marks may choose to register their marks under 15 U.S.C. § 1052(f) by showing acquired distinctiveness, but are not required to. A claim of distinctiveness under 15 U.S.C. § 1052(f) may be construed as conceding that the matter to which it pertains is *not* inherently distinctive<sup>36</sup>.

An applicant may face a unique obstacle in the context of claiming acquired distinctiveness for holograms<sup>37</sup>. In *In re The Upper Deck Co.*, the Trademark Trial and Appeal Board denied registration for a holographic image used in connection with trading cards. The Board found that companies often use holograms on credit cards, CDs, apparel, and various types of ticket as techniques of anti-counterfeiting. This fact led the court to conclude that consumers are more likely to view a hologram as such a protection device rather than as a source indicator. The Board found that the applicant's evidence of acquired distinctiveness, including extensive advertising, unsolicited customer testimonials, and expert opinion, was insufficient to overcome this "burden". However, a court may be less concerned with the public's tendency to view holograms as anti-counterfeiting devices where the hologram is located on things other than cards<sup>38</sup>.

## **3. Claiming Inherent Distinctiveness**

### **a. Sound**

The Trademark Trial and Appeal Board has held that sound marks *can* be classified as inherently distinctive<sup>39</sup>. More specifically, "unique, different or distinctive" sounds can be registered without proof of secondary meaning, but acquired distinctiveness must be shown to register "commonplace" sounds. In *In re General Elec. Broadcasting Co.*, the Board held that the sound of a ship's bell tolled at intervals as on shipboard as a service mark for the applicant's radio show was not inherently distinctive. Despite this holding, many sound marks have been subsequently allowed as inherently distinctive<sup>40</sup>.

### **b. Scent**

In the few decisions involving scent marks, the Trademark Trial and Appeal Board has not indicated whether a showing of secondary meaning is necessary to register marks consisting

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<sup>36</sup> TMEP § 1212.02(b)-(c)

<sup>37</sup> *In re The Upper Deck Co.*, No. 75/064,130, 2001 TTAB Lexis 206 (T.T.A.B. February 14, 2001)

<sup>38</sup> *See* Footnote 6

<sup>39</sup> *In re General Elec. Broadcasting Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978)

<sup>40</sup> *See, e.g.*, U.S. Reg. No. 1872866 (THX logo theme), U.S. Reg. No. 2607415 (the sound of a duck quacking the word "AFLAC")

of fragrance<sup>41</sup>. An application to register a “lemon fragrance” mark for laser printers, photocopiers and laser printers on intent to use basis was approved based on a finding that the mark could be inherently distinctive<sup>42</sup>. Nevertheless, registration of scent marks based on inherent distinctiveness is rare; the only scent mark currently on the principal register was approved only after evidence of secondary meaning had been provided<sup>43</sup>. The remaining scent marks are on the supplemental register.

The USPTO has held that the applicant has the burden of producing persuasive evidence of inherent distinctiveness if the subject matter comprises “something not ordinarily perceived as a trademark”<sup>44</sup>. The main type of proof used to prove inherent distinctiveness is expert opinion and third-party use<sup>45</sup>. Testimony concerning the claimant’s intent has also been relied on by the court when finding a mark inherently distinctive<sup>46</sup>.

Two tests have been routinely used in analyzing inherent distinctiveness in the trade dress arena: (1) the traditional *Abercrombie* test<sup>47</sup>; and (2) the *Seabrook* test<sup>48</sup>. The U.S. Supreme Court, while not explicitly adopting the latter test, noted that the application of the former test should be confined to the area of traditional word marks<sup>49</sup>. The analysis of the *Seabrook* test focuses on four factors: whether the proposed mark is (1) a “common” a basic shape or design; (2) unique or unusual in a particular field; (3) a mere refinement of a commonly-adopted a well-known form of ornamentation for a particular class of goods which consumers view as mere ornamentation;

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<sup>41</sup> See *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990), *Mike Mantel dba Manhattan Oil v. VP Racing Fuels, Inc.*, 2000 TTAB Lexis 730 (T.T.A.B. 2000)

<sup>42</sup> See Reg. Serial No. 75120036 (abandoned)

<sup>43</sup> See U.S. Reg. No. 2463044 (cherry scent for “synthetic lubricants for high performance racing and recreational vehicles)

<sup>44</sup> *In re Kwik Lok*, 217 U.S.P.Q. 1245, 1246-47 (T.T.A.B. 1983)

<sup>45</sup> See *Ashley Furniture v. Sangiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999), *Banff Ltd. v. The Limited Inc.*, 869 F. Supp. 1103 (S.D.N.Y. 1994)

<sup>46</sup> See, e.g. *P.E. Guerin, Inc. v. Nanz Custom Hardware Inc.*, 45 U.S.P.Q.2d 1524 (finding the plaintiff’s doorknob inherently distinctive based partly on claimant’s intent to establish a unique design consumers would identify with the claimant)

<sup>47</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d. Cir. 1976) (creating five categories to measure distinctiveness of marks: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; (5) fanciful)

<sup>48</sup> *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977) (holding that the inherent distinctiveness revolves around third-party uses of the claimed mark)

<sup>49</sup> *Wal-Mart*, 120 S. Ct. at 1343 (“In the context of word marks, court have applied the now-classic test originally formulated by Judge Friendly, in which word marks that are “arbitrary”, “fanciful”, or “suggestive” are held to be inherently distinctive [citing *Abercrombie*]”)

and (4) capable of creating a commercial impression distinct from the accompanying words<sup>50</sup>. Many courts have adopted the *Seabrook* test for analyzing inherent distinctiveness for nontraditional marks<sup>51</sup>.

### c. Motions and Holograms

Like scent marks, the Trademark Board has never indicated whether a showing of secondary meaning is necessary to register a motion mark or a hologram. However, a few motion marks<sup>52</sup> and a few holograms<sup>53</sup> have been registered on the basis of inherent distinctiveness.

## 4. Overcoming Issues of Functionality

A functional feature cannot be registered as a trademark regardless of the amount of secondary meaning<sup>54</sup>. When an opposer in an opposition case makes a *prima facie* case of functionality of the design for the goods claimed, the burden then shifts to the applicant to prove non-functionality<sup>55</sup>. The definition of functionality has been stated in many different ways. However, many courts analyze functionality evidence in light of four factors: (1) the existence of a utility patent which discloses the utilitarian advantages of the design is evidence of functionality; (2) the existence of any advertising or promotion of the proponent of trademark rights which touts the functional and utilitarian advantages of the very design aspect it now seeks to protect; (3) the existence of other alternative designs which perform the utility function

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<sup>50</sup> *Seabrook*, 568 F.2d at 1344

<sup>51</sup> See *I.P. Lund Trading ApS, Kroin Inc. v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998) (where the court cited *Seabrook* approvingly and found no inherent or acquired distinctiveness in faucet product trade dress), *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25 (1st Cir. 2001) (trade dress for common elements of candle labels was nondistinctive product packaging for which insufficient evidence of acquired distinctiveness was shown), *In re Hudson News Co.*, 39 U.S.P.Q.2d 1915, 1923 (T.T.A.B. 1996) (“for the ‘blue motif’ of a retail store to be registrable on the Principal Register without resort to Section 2(f), the trade dress would have to be immediately recognizable as a distinctive way of identifying the source of the store services”), *Ambrit Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986)

<sup>52</sup> See, e.g., U.S. Reg. No. 1928423, U.S. Reg. No. 1975999 (the mark consists of a moving image of a flash or light from which rays of light are emitted against a background of sky and clouds, the scene pans downward to a torch being held by a lady on a pedestal, the word “Columbia” appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady)

<sup>53</sup> See, e.g., U.S. Reg. No. 2730207, U.S. Reg. No. 2278307

<sup>54</sup> *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982), *In re Controls Corp. Of Am.*, 46 U.S.P.Q.2d 1308 (T.T.A.B. 1998), *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 121 S. Ct. 1255 (2001)

<sup>55</sup> *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002)

equally well; and (4) whether or not the design results from a comparatively simple, cheap or superior method of manufacturing the article<sup>56</sup>.

### **a. Product Configurations**

In the case of product configurations, many registrations have been denied based on the existence of advertisement or promotion emphasizing the utilitarian advantages of a feature<sup>57</sup>. Although the issue is mostly analyzed in the context of suits brought to enforce an unusual trademark, the Trademark Trial and Appeal Board, in considering registration of product configuration, will consider the existence of alternative designs that perform the utilitarian function equally well<sup>58</sup>.

### **b. Color**

The issue of functionality is a major focus in the registration of color marks. Traditionally, color marks were not protected as trademarks<sup>59</sup>. The traditional rule was often supported by the “color depletion” theory that there are only a few easily discernible colors and once they are taken in a market, people seeking to enter the market will be deprived of a level competitive field. Although the traditional rule was rejected by the Supreme Court in *Qualitex*<sup>60</sup>, the concern over color depletion still surfaces in the context of functionality analysis during the registration process<sup>61</sup>.

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<sup>56</sup> *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (Fed. Cir. 1982)

<sup>57</sup> *In re Caterpillar Inc.*, 43 U.S.P.Q.2d 1335 (T.T.A.B. 1997) (tractor sprocket design held functional in part because “applicant’s own promotional materials tout the utilitarian advantages of its elevated sprocket, the Board rejected claims that the advertisements were mere puffery and self-serving), *In re Gibson guitar Corp.*, 61 U.S.P.Q.2d 1948 (T.T.A.B. 2001) (registration refused in part because applicant’s advertisements promoted shape of the guitar as producing better music), *In re Babies Beat, Inc.*, 13 U.S.P.Q.2d 1729 (T.T.A.B. 1990) (registration of a baby bottle configuration denied where applicant’s advertisements claimed shape was designed to be suitable “for even the youngest and smallest babies’ hands to hold)

<sup>58</sup> *See, e.g., In re Zippo Mfg. Co.*, 50 U.S.P.Q.2d 1852 (T.T.A.B. 1999) (holding that while the ZIPPO cigarette lighter was originally functional because it was cheaper to manufacture, competitors have introduced many alternative designs since its creation so that protecting the configuration of applicant’s lighter will not hinder competition)

<sup>59</sup> *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990) (“as a rule color cannot be monopolized to distinguish a product”)

<sup>60</sup> *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300 (1995)

<sup>61</sup> *See, e.g., In re Howard S. Leight and Associates Inc.*, 39 U.S.P.Q.2d 1058 (T.T.A.B. 1996) (finding a reddish-orange hue of safety earplugs functional because such a bright color aided in monitoring for employee compliance with health and safety regulations and suggesting that the number of distinguishable colors useful for that purpose is limited), *In re Orange Commc’n Inc.*, 41 U.S.P.Q.2d 1036 (T.T.A.B. 1996) (where the court held orange and yellow functional in relation to telephone booths because registration would affect the ability of

### c. Scent

In the few cases where the registration of a mark consisting of a scent has been brought before the Trademark Board, the Board the argument has been made that the fragrance is functional in that the feature is aesthetically pleasing and makes the product more desirable<sup>62</sup>. However, the Trademark Board has rejected the argument that a designation should be denied registration simply because it may be pleasing<sup>63</sup>.

## II. ENFORCEMENT OF NONTRADITIONAL MARKS

The issues involved in the enforcement of unusual marks parallel the issues discussed in the context of registering unusual marks. For Federal protection, an applicant must plead and prove three elements: (1) validity; (2) functionality; and (3) infringement arising out of a likelihood of confusion.

First, an infringement plaintiff must prove that the trademark is recognized by customers to identify and distinguish source<sup>64</sup>, by showing that the mark is either inherently distinctive or has acquired secondary meaning<sup>65</sup>. As mentioned above, product configuration and sound marks can never be inherently distinctive and, therefore, proof of secondary meaning is required. Second, a federal trademark registration is *prima facie* evidence that a mark is not functional and distinguishes source<sup>66 67</sup>. In the absence of registration, a plaintiff asserting infringement of an unregistered mark has the burden of proving non-functionality<sup>68</sup>. Third, an infringement plaintiff must prove that customers or others will likely be confused as to source, sponsorship, connection or approval because of the similar shape or design.

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competitors to compete because they would have to devise other means of making telephone booths noticeable to the public)

<sup>62</sup> *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990), *Mike Mantel dba Manhattan Oil v. VP Racing Fuels*, Opposition No. 109.614, 2000 TTAB Lexis 730 (T.T.A.B. October 13, 2000)

<sup>63</sup> *Univesity Book Store v. University of Wisconsin Bd. Of Reagents*, 33 U.S.P.Q.2d 1385, 1405 (T.T.A.B. 1994) (“viewing a mark as aesthetically functional merely because it constitutes what the consumer wishes to purchase...is improper...”)

<sup>64</sup> 15 U.S.C. § 1051

<sup>65</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992)

<sup>66</sup> *Publications Int’l*, 164 F.3d at 337

<sup>67</sup> *Publications Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337 (7th Cir. 1998) (“registration creates a presumption of validity, implying that the defendant has the laboring oar on all issue relating to validity...”)

<sup>68</sup> Pub. L. 106-43, 113 Stat. 218 (August 5, 1999)

These elements of proof will be illustrated with a few recent cases involving the enforcement of nontraditional trademarks.

## 1. Product Configurations

A majority of the cases concerning enforcement of unusual trademarks involve product configuration marks. The issues most often litigated in this area are the presence or absence of secondary meaning and the issue of functionality.

In *Disc Golf Association, Inc., v. Champion Discs, Inc.*, 158 F.3d 1002 (9th Cir. 1998), the Ninth Circuit Court of Appeals affirmed the District Court's grant of summary judgment motion in favor of a defendant in a trademark infringement action<sup>69</sup>. Plaintiff was a disc golf target manufacturer who alleged that a competitor infringed its parabolic chain design on its disc golf target configuration. As the court explained:

Disc golf is played like conventional "ball golf", but with flying discs instead of clubs and golf balls. The devices manufactured by both parties serve as targets for the flying discs and constitute the "holes" on a disc golf course. A "hole" is completed when the target "catches" the disc, that is, when the disc hits the parabolic chain configuration and falls into a basket below<sup>70</sup>.

Plaintiff obtained U.S. Patent No. 4,039,189 for its disc golf target in 1977 and dominated the market. After the patent expired in 1994, defendant began to produce a disc golf target with a similar parabolic chain configuration. The Court dismissed plaintiff's infringement suit holding that the parabolic chain configuration was functional. The Court was persuaded by the fact that the patent disclosed the utilitarian advantages of the parabolic chain design, namely, "absorbing the kinetic energy of the disc". Plaintiff presented evidence of 15 alternative target designs currently available on the market. Nevertheless, the Court found that plaintiff's design clearly dominated the market, noting that 77 percent of disc golf courses currently used plaintiff's parabolic-design targets.

In contrast, a California District Court rejected an argument that an igloo-shaped doghouse was functional and granted plaintiff's motion for a preliminary injunction<sup>71</sup>. Plaintiff began marketing an igloo-shaped dog house made of structural foam in 1987 and obtained U.S. Trademark Registration No. 1,631,630 in 1991 for this pet shelter configuration<sup>72</sup>. Plaintiff brought a trademark infringement action after defendant began to market a similar igloo-shaped doghouse. The Court focused on the issue of functionality and whether or not plaintiff had established secondary meaning in its mark. On the issue of functionality, the plaintiff presented expert testimony and submissions of twelve drawing of configurations having the same

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<sup>69</sup> *Disc Golf Association, Inc., v. Champion Discs, Inc.*, 158 F.3d 1002 (9th Cir. 1998)

<sup>70</sup> *Id.* at 1004

<sup>71</sup> *Dogloo, Inc. v. Doskocil Manuf. Co, Inc.*, 893 F.Supp. 911 (C.D. Cal. 1995)

<sup>72</sup> *Id.* at 914

functional advantages as the plaintiff's doghouse. The court found that "hypothetical designs created by an expert witness designer" are sufficient to prove alternatives exist<sup>73</sup>. In response to arguments that plaintiff referred to advantages offered by the igloo shape in advertising, the court found that such qualities were either: (1) "a function of a characteristic other than its shape"; or (2) "capable of being attained without the use of an igloo shape"<sup>74</sup>.

In granting the preliminary injunction, the court also found that plaintiff showed a reasonable likelihood of success on the issue of secondary meaning. The court noted that plaintiff provided consumer testimony, extensive evidence of its continuous use of the igloo shape as well as local and national advertising efforts<sup>75</sup>. The court appeared to be particularly persuaded by the strong evidence of consumer confusion and actual market harm<sup>76</sup>.

## 2. Color Marks

As mentioned above in the context of registration of color marks, the fear of "color depletion" and the issue of functionality also arises in cases involving enforcement of such marks<sup>77</sup>. The plaintiff in *Sabert Corp. v. Ullman Co., Inc.* manufactured and sold disposable plastic serving platters with a "shiny silver look" and serving platters with a "shiny gold look". Plaintiff never obtained a trademark, copyright, or patent for their silver and gold colored wares. Plaintiff instituted an infringement action and moved for a preliminary injunction after a competitor began selling similar platters colored silver and gold.

The Court denied the motion holding that plaintiff failed to establish a reasonable likelihood of success on the merits. Specifically, the Court found that plaintiff would not be able to prove at trial that the color silver and the color gold used in connection with disposable serving platters is non-functional.

The Court noted that protection for colors have often been rejected "where the use of those colors is necessary for other to compete in the market". Here, reasoned the Court, plaintiff's use of silver and gold would foreclose competition in the market for platters because the effect of imitating real gold and silver "cannot practically be duplicated by the use of

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<sup>73</sup> *Id.* at 915

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 914

<sup>76</sup> *Id.* at 916; *But see* Carrol Shelby Licensing, Inc., et al v. Superformance Int'l, Inc., 251 F.Supp.2d 983 (D.Mass. 2002) (where the court found insufficient evidence of secondary meaning in plaintiff's Shelby Cobra car design)

<sup>77</sup> *Sabert Corp. v. Ullman Co., Inc., et al*, 53 U.S.P.Q.2d 1597 (S.D.N.Y. 1999)

alternative designs”<sup>78</sup>. The Court found that none of the alternative color schemes presented by the plaintiff were able to imitate the look of real gold or silver<sup>79</sup>.

In contrast, in *Keystone Consolidated Industrial, Inc. v. Midstates Distributing Co.*, 235 F. Supp.2d 901, 905-06 (C.D. Ill. 2002), the court held that the color red on the top of a barbed wire fence was not functional: “Field fencing is used to either retain objects or creatures within a set area or prevent entry of creatures into said area. It is clear to the Court that the addition of color does nothing to enhance the efficacy of [the plaintiff’s] wire fencing in this regards.”<sup>80</sup>

In another case involving the color red, *Forschner Group, Inc., et al v. Arrow Trading Co., Inc.*, the Second Circuit Court of Appeals focused on the issue of distinctiveness and secondary meaning rather than functionality<sup>81</sup>. Here, the plaintiff argued that defendant’s use of the color red on the handle of its multifunction pocketknives infringed plaintiff’s right to the color red in connection with their “Swiss Army” brand multifunction pocketknives<sup>82</sup>. However, plaintiff’s preliminary injunction motion was denied. The Court held that plaintiff failed to show a reasonable likelihood of success in showing that the color red had acquired secondary meaning in connection with its knives.

The court explained, “...color is never inherently distinctive, but is capable of identifying a product’s source and may be a protected trademark only when it has attained secondary meaning and has come to be associated in the consuming public’s mind with a *single* source of origin”<sup>83</sup>. The Court noted that for several decades at least two different Swiss companies have manufactured and sold “Swiss Army” knives with red handles. Further, for the same length or time, an American company also marketed a multifunction pocketknife with a red handle. Therefore, “the color red does not serve to primarily designate [plaintiff] as the single source of the product nor does it serve to distinguish [plaintiff’s] product from those of its competitors”<sup>84</sup>.

Color marks also suffer from the problem of generally being perceived as only ornamental or decorative rather than as source indicating. As the Supreme Court stated in Wal-

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<sup>78</sup> Quoting Restatement (Third) of Unfair Competition § 17, Comment c

<sup>79</sup> *But see* *Minn. Mining and Manuf. Co. v. Beautone Specialties, Co., Ltd., et al*, 82 F.Supp.2d 997 (D. Minn. 2000) (where the court, while granting a summary judgment motion for trademark infringement on grounds of laches, found a triable issue of fact as to functionality despite evidence that the color, “canary yellow”, used in connection with plaintiff’s brand of sticky notes would foreclose competition)

<sup>80</sup> *Keystone Consolidated Industrial, Inc. v. Midstates Distributing Co.*, 235 F. Supp.2d 901, 905-06 (C.D. Ill. 2002)

<sup>81</sup> *Forschner Group, Inc., et al v. Arrow Trading Co., Inc.*, 124 F.3d (2nd Cir. 1997)

<sup>82</sup> *Id.* at 404

<sup>83</sup> *Id.* at 408 (emphasis added)

<sup>84</sup> *Id.*

Mart, in the case of color marks “consumer predisposition to equate the feature with the source does not exist.”<sup>85</sup>

### 3. Sound Marks

Although the Trademark Board has held that sound marks can be classified as inherently distinctive for registration purposes<sup>86</sup>, a recent case emphasizes the fact that sounds reminiscent of everyday life will not be enforced without proof of secondary meaning<sup>87</sup>. In *Ride the Ducks, L.L.C. et al. v. Duck Boat Tours, Inc.*, the District Court denied plaintiff’s motion for a preliminary injunction claiming trademark infringement. Plaintiff asserted service mark rights in the “quacking” sound emitted from the duck call devices that it distributes to its patrons for use during sightseeing tours. The Court held that plaintiff failed to show a reasonable likelihood of success on its trademark claim to merit a preliminary injunction. In particular, the Court found: (1) the “quacking” sound was not inherently distinctive; and (2) plaintiff did not show that it had acquired secondary meaning in the sound. Plaintiff possessed U.S. service mark 2,484,276 dated September 4, 2001, that described the mark as the use “of a quacking noise made by tour guides and tour participants by the use of duck call devices throughout various portions of the tour”.

In July 2004, defendant began operating similar tours, in which it similarly provided duck quacking devices to its patrons. Plaintiff brought a trademark infringement action and moved the Court for injunctive relief.

In reviewing the protectability of sound marks, the Court noted that “as with a more visually perceptible kind of mark, a sound mark’s level of protection will depend on whether it is inherently distinctive, or more common-place and non-distinctive.” If the latter, the Court noted that *Ride the Ducks* would need to show secondary meaning. That is, plaintiff would need to show that purchasers, prospective purchasers and listeners recognize and exclusively associate the quacking sound with plaintiff’s services.

First, the Court found that plaintiff’s sound would not qualify as so inherently distinctive that proof of secondary meaning is not required to link the quacking noise to plaintiff’s services. Next, the Court found that *Ride the Ducks* did not produce enough evidence to support a finding that plaintiff’s quacking noise mark enjoyed secondary meaning in the Pennsylvania market at the time defendant started incorporating a similar noise in its tours. The Court found that the (at most) 10 months of prior use to the quacking sound by plaintiff is an insufficient amount of time to establish secondary meaning.

Interestingly, another recent case also involved the enforcement of a sound service mark for quacking<sup>88</sup>. In this case, the service mark was described as “the sound of a duck quacking the

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<sup>85</sup> Wal-Mart, 529 U.S. at 213.

<sup>86</sup> *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978)

<sup>87</sup> *Ride the Ducks, L.L.C. et al. v. Duck Boat Tours, Inc. et al*, No. 04-CV-5595, 2005 U.S. Dist. Lexis 4422 (E.D. Penn March 21, 2005)

<sup>88</sup> *American Family Life Ins. Co. v. Timothy Hagan, et al.*, 266 F. Supp. 2d 682 (N.D. Ohio 2002)

word ‘AFLAC’” used in connection with the sale of supplemental insurance products<sup>89</sup>. Plaintiff, in December of 1999, began a television advertising campaign, the centerpiece of which was a white duck quacking the name of the company (AFLAC) in response to people discussing the subject of supplemental insurance. The court acknowledged that the AFLAC duck enjoys high public recognition<sup>90</sup>. During the 2002 Ohio Governor campaign, the challenger began to broadcast commercials featuring an animated character referred to as “TaftQuack.” TaftQuack consists of the incumbent Governor’s head on the body of a white duck; a yellow duck’s bill sits where the Governor’s mouth should be. In some commercials, the TaftQuack character is asked questions; his response is to quack “TaftQuack”<sup>91</sup>.

Plaintiff moved for a preliminary injunction to enjoin the defendant from airing the TaftQuack commercials. The court denied the motion finding no reasonable likelihood of consumer confusion<sup>92</sup>.

#### 4. Scents

There are several reported cases involving luxury perfume manufacturers’ attempts to stop the sale of “copy-cat” perfumes. In *Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc.*<sup>93</sup>, the court vacated a preliminary injunction because the district court had erred in finding that the plaintiff had shown probably success on the merits; “The parties do not dispute that [defendant] may copy, if it can, the scent marketed as OBSESSION.”). Similarly, in *Smith v. Chanel, Inc.*,<sup>94</sup> the court reversed the grant of injunctive relief, noting that the appellant had the right to copy appellee’s scent and to tell potential purchasers that its product was equivalent. In contrast, the Second Circuit affirmed the issuance of a preliminary injunction in *Charles of the Ritz Group, Ltd. v. Quality King Distributors, Inc.*<sup>95</sup> where the “knock-off” perfume mimicked the trade dress and word mark of the original, as well as the scent. Thus, the case law relating to enforcement of scent marks provides little solace for the owner of a scent mark. Showing that consumers perceive a particular scent as a source-indicating trademark rather than simply as an appealing feature of the goods or services is an extremely difficult hurdle to overcome.

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<sup>89</sup> *Id.* at 686

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> *Id.* at 691

<sup>93</sup> *Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc.*, 815 F.2d 500 (8<sup>th</sup> Cir. 1987)

<sup>94</sup> *Smith v. Chanel, Inc.*, 402 F.2d 562 (9<sup>th</sup> Cir. 1968)

<sup>95</sup> *Charles of the Ritz Group, Ltd. v. Quality King Distributors, Inc.*, 832 F.2d 1317 (2d Cir. 1987)

## CONCLUSION

While applicants may successfully overcome the requirements for obtaining registration in the U.S. for nontraditional trademarks, enforcing such marks is an entirely different matter. Even though registration provides prima facie evidence of nonfunctionality and distinctiveness, registration alone will not suffice to succeed on a claim for trademark infringement or dilution. Thus, while the Lanham Act definition of a trademark is broad enough to encompass “almost anything at all that is capable of carrying meaning,”<sup>96</sup> the owner/enforcer of a nontraditional trademark must be ready to submit substantial proof of nonfunctionality and secondary meaning, and must also be able to prove a likelihood of confusion.

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<sup>96</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).