

CINNAMON BUNS, MARCHING DUCKS AND CHERRY-SCENTED RACECAR EXHAUST: PROTECTING NONTRADITIONAL TRADEMARKS*

By Jerome Gilson** and Anne Gilson LaLonde***

“In order to have a viable future,
brands will have to incorporate a brand platform
that fully integrates the five senses.”****

I. INTRODUCTION

You can see, smell, taste, touch and hear them. You can even store your firewood in them, feed your dog with them, sit on them, clean your pool with them and, if hunger strikes, eat them. What, if anything, do they have in common?

Actually, they are all nontraditional trademarks, often skirting the outer limits of trademark protection and, in some cases, evoking head-scratching, eye-rolling or just plain chuckling. For examples of this singular legal genre, take the Cinnabon cinnamon bun,¹ the Peabody Hotel daily March of the Ducks,² Manhattan Oil’s cherry fragrance additive to race car fuel³ and even the sound of tourists quacking while riding in amphibious vehicles.⁴

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**** Martin Lindstrom, *BRAND sense: Build Powerful Brands Through Touch, Taste, Smell, Sight, and Sound* 3 (2005).

1. See § VIII.A. *infra* for a picture of the registered cinnamon roll.
2. See § VII. *infra* for more on this intriguing motion mark.
3. See § III. *infra* for more on this and other scent marks.
4. *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, 2005 U.S. Dist. LEXIS 4422 (E.D. Pa. Mar. 21, 2005).

Most trademarks are readily perceived as source identifiers: word marks, design marks, logos, acronyms and slogans. The same is true of most forms of trade dress, *i.e.*, packaging colors and designs. However, three-dimensional marks, such as product and packaging configurations, we classify along with scent, sound, color and taste as nontraditionals, those that are not so readily perceived as identifiers.

In the United States, the owner of a nontraditional trademark may register it or prove that it is valid if it distinguishes one source from another and is not functional or descriptive. There is no legal requirement that these marks, or indeed any marks, be clever, profound, amusing or thought-provoking. Still, it can fairly be said that many nontraditional marks are inspired.

The broad Lanham Act definition of “trademark” encompasses nontraditional marks by not excluding them: The term “includes 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.⁵ In short, according to a Supreme Court watershed in modern American trademark law, a trademark may be “almost anything at all that is capable of carrying meaning.”⁶ As Cole Porter wrote, “Anything Goes.”

A. Marketplace Alarms: Lindstrom’s Code Red

Branding guru Martin Lindstrom warns that “if branding wishes to survive another century it will need to change track. More communication in an already overcrowded world simply won’t do it.”⁷ Even distinctive brands need more than traditional television or print advertising in order to reach consumers. The new track would have brands go beyond sight and sound to reach consumers through smell, touch and taste.

5. 15 U.S.C. § 1127. The Senate Report on the Trademark Law Revision Act of 1988 states that the amendments kept the words “symbol, or device” “so as not to preclude the registration of colors, shapes, smells, sounds or configurations where they function as trademarks.” S. Rep. No. 515, 100th Cong., 2d Sess. 44 (1988), *reprinted at* Gilson & LaLonde, 9 *Trademark Protection and Practice*, p. 45-55.

6. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). An excerpt from *Qualitex* appears in Appendix A *infra*.

7. Lindstrom at 3. *See also* Marc Gobé, *Emotional Branding: The New Paradigm for Connecting Brands to People* 68-69 (2001) (“Sensory experiences are immediate, powerful, and capable of changing our lives profoundly, but they are not used to their full extent in branding initiatives. . . . Given the competition among today’s corporations, it is my feeling that no business can afford to neglect the five senses.”); Bernd H. Schmitt, *Experiential Marketing: How to Get Customers to Sense, Feel, Think, Act, and Relate to Your Company and Brands* 109 (1999) (“Sensory marketing can be a powerful strategic and tactical tool for motivating customers directly, for adding value to customers, and for differentiating the product (internally and externally). . . .”).

Lindstrom's novel ideas do not come from thin air. He relies on a market research study that began with focus groups in thirteen countries exploring the role of the senses in creating brand loyalty to ten global brands and additional local brands.⁸ The study also involved an online interview with over 2000 people in the United States, the UK and Japan providing information on their sensory associations, purchase intent and more, for eighteen brands.⁹

According to Lindstrom, multisensory branding done right engages consumers emotionally. He notes that “[s]ight may convey information well, but even at best it creates a less deeply felt emotional response.”¹⁰ An emotional connection to a brand makes the brand more compelling and engenders consumer loyalty, Lindstrom says.¹¹

Lindstrom urges brand owners to conduct a sensory audit: Is the brand using all available sensory touch points? Is the sensory experience of the brand strong, consistent and distinctive? To what extent does the consumer associate these sensory signals with this brand and how authentic do they perceive these signals to be?¹² He notes, for example, that the “smell and taste of major toothpaste brands could be extended to encompass dental floss, toothbrushes, and toothpicks” instead of just extending “the use of the brand name and the corporate colors.”¹³

Under the Lindstrom teaching, using nontraditional trademarks and other off-beat stimuli to differentiate and reinforce a brand is imperative. Brand owners *must* pursue multisensory ways to entice consumers and get their message across.

B. Registration and Enforcement: Penguin-Shaped Cocktail Shakers

Neither statutory reason nor public policy prohibits registering nontraditional trademarks that communicate source to any of the five senses, including color, scent, sound, motion, three-dimensional, flavor and tactile marks. As the Court declared, “It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word or sign—that permits it to serve [the] basic purposes” of a trademark.¹⁴

8. Lindstrom at 219-20.

9. *Id.* at 220.

10. *Id.* at 161.

11. *Id.* at 139-48.

12. *Id.* at 110-22.

13. *Id.* at 96.

14. *Qualitex*, 514 U.S. at 164.

Enforcing nontraditional marks is a different matter. Although not desperate, the outlook is unpredictable at best. Nontraditional trademarks lack a track record in infringement and dilution cases as well as before the Board; there are few court or Board decisions on point. They also face obstacles that traditional word marks and logos do not. Several types of nontraditional marks cannot be inherently distinctive—color, scent, product designs, some sound marks and almost certainly tactile and flavor—and will therefore be difficult to register on the Principal Register because the United States Patent and Trademark Office will require proof of secondary meaning.¹⁵ These marks may also lack sufficient marketplace strength to be enforceable, either in an infringement or a dilution case. Registration will help, but registration alone will not win an infringement, dilution or opposition case. The owner of a nontraditional trademark may register it or prove it to be valid before a court, but to obtain an injunction or damages it still must meet the rigorous requirements of likelihood of confusion¹⁶ or actual dilution,¹⁷ legal tests that pose enormous logistical problems where scent and sound, for example, are concerned.

Unlike word marks, some nontraditional marks may be difficult to describe with precision and may for that reason alone face enforcement problems. For example, describing a scent or flavor as “mint,” “cinnamon,” “strawberry” or a “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms” may suffice when a mark is to be registered. However, such descriptions may be simply too vague when it comes to enforcement. (Color marks may avoid this particular problem by specifying the appropriate PANTONE Color number.¹⁸) In enforcement actions, courts may have difficulty determining the similarity of two flavor or scent trademarks, for example. In traditional word trademark enforcement, courts have the luxury of simply comparing sound, appearance and meaning for similarity. However, in nontraditional trademark enforcement, there are so far no such benchmarks. A court in a scent infringement case, for example,

15. Undistinctive nontraditional trademarks may be registered on the Supplemental Register.

16. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, Chapter 5 for a full treatment of likelihood of confusion.

17. See § X. *infra* for more on dilution of nontraditional trademarks and Gilson & LaLonde, 2 *Trademark Protection and Practice*, Chapter 5A for a full treatment of dilution.

A bill that passed the House of Representatives on April 19, 2005 would not limit relief to marks harmed by actual dilution; it would allow a court to grant injunctive relief where another mark was “likely to cause dilution.” H.R. 683, 109th Cong. § 2 (2005).

18. See § II.A. *infra* for more on the PANTONE MATCHING SYSTEM.

will be faced with devising a different yardstick for determining similarity for likelihood of confusion purposes.

Another major problem with enforcement in this context is that consumers may not perceive certain nontraditional marks as trademarks at all. They may see them as merely decorative, as an inherent part of the product or as an attempt to amuse rather than to indicate the source of the goods. As the Supreme Court declared in *Wal-Mart Stores*:

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.¹⁹

Owners of color, scent, flavor or tactile trademarks as well as product designs and buildings must thus convince a court or the Board that consumers view their marks as source indicators.²⁰ Producers of penguin-shaped cocktail shakers and the like can probably save their money.

II. COLOR MARKS

A. In General

Supreme Court imprimatur accords color marks special status. If it has acquired distinctiveness for goods or services and is not functional, color alone can be registered and protected in the same manner as a traditional word or logo trademark. (By “color marks” we do not mean marks with other features that also include a color, like a word mark presented in red. When the trademark is color *and* other features of a product, such as size, shape and logo, then it is considered either a traditional trademark or trade dress.) Color marks consist exclusively of one color (or, rarely, more than one color) on a certain product, on all or part of the product itself or on all or part of its packaging.²¹

As Lindstrom notes: “Color is essential to the brand-building process because it’s the most visible first point of

19. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000) (emphasis added). See also *Qualitex*, 514 U.S. at 163 (“The imaginary word ‘Suntost,’ or the words ‘Suntost Marmalade,’ on a jar of orange jam immediately would signal a brand or a product ‘source’; the Jam’s orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand.”).

20. For more on ornamentation and nontraditional marks, see § II.F. *infra*.

21. See TMEP § 1202.05.

communication.”²² Several color marks are registered with the USPTO, for example, for tools and construction materials,²³ and some are registered for medical equipment.²⁴ More familiar consumer products also enjoy color registration protection. The eye-catching robin’s-egg blue color is registered for Tiffany’s boxes and bags²⁵ and the unexpected green color is registered for ketchup.²⁶

A service mark, too, can be color alone where the color is used when the services are rendered or in advertising for the services. United Parcel Service, for example, holds a registration for “the color chocolate brown, which is the approximate equivalent of PANTONE 462 C, as applied to the entire surface of vehicles and uniforms” for the service of transporting and delivering personal property.²⁷ And UPS broadcasts the source-identifying function of its pervasive use of brown with the registered slogan “What can brown do for you?”²⁸

There is an extremely helpful aid for those working in colors: The PANTONE Color system, used by United Parcel Service in describing its color mark in its federal registration, is a commercial system that designates specific shades numerically and is used by graphic designers, printers and plastics producers.²⁹ Unlike the quaint and now-defunct USPTO color lining system, which depicts

22. Lindstrom at 47.

23. On the Principal Register, see, *e.g.*, the color white for woodworking and metalworking machines (Reg. No. 2893180); the color gold for woodworking and metalworking machines (Reg. No. 2886324); the color burgundy for gas compression equipment (Reg. No. 2876976); the color orange for “concrete-forming plywood panels” (Reg. No. 2804751); the color orange for “barrels and barrel-like packaging liners for plungers and polished rods for oil well and water well pumps” (Reg. No. 2691224); and the color pink for roofing shingles (Reg. No. 2695673).

On the Supplemental Register, see, *e.g.*, the color blue for router bits (Reg. No. 2861791) and the color green for “water filtering units for use in filtering storm water at construction sites and . . . preventing soil erosion” (Reg. No. 2837508).

24. On the Principal Register, see the color purple for “foam sheeting for use during sterilization of medical and surgical implements using steam or gas sterilization medium” (Reg. No. 2655910) and the color orange for protective sheaths for covering medical needles (Reg. No. 2745908). On the Supplemental Register, see the colors blue and transparent for certain surgical and medical equipment and accessories (Reg. No. 2728317), the colors blue, white and transparent “with the color blue predominant” for “certain surgical and medical equipment and accessories” (Reg. No. 2728316).

25. Reg. No. 2359351 (boxes); Reg. No. 2416795 (bags).

26. Reg. No. 2661572.

27. Reg. No. 2901090.

28. Reg. No. 2649286.

29. See www.pantone.com for more on this system. PANTONE and PANTONE MATCHING SYSTEM are the property of Pantone, Inc. PANTONE MATCHING SYSTEM, Pantone Inc. 2003.

twelve colors,³⁰ the PANTONE MATCHING SYSTEM contains over a thousand colors, set up in strips like paint specimen cards, with seven colors per card. The PANTONE System is a useful day-to-day tool for the trademark lawyer for making color comparisons between two products or logos.³¹ In settlement agreements, one party may agree to restrict the colors it uses to a certain group of PANTONE Colors or never to use certain PANTONE Colors.³² When entering into such an agreement, be aware of the appearance of the finished product; even if a party agrees to use a certain PANTONE Color number for a specific item, that item may be combined with other components that give a different look to the goods as a whole, and the PANTONE Color number agreement may not be sufficient protection.

Courts will have to consider whether a particular color mark is weak or strong and examine whether a shade of blue, for example, is likely to cause source confusion with a shade of blue-green. White might be generic for toasters or dishwashers, for example, while unexpected colors like dark purple or sunshine yellow just might be arbitrary.

How might color protectability issues play out in real life? Say the owners of a new chain of grocery stores—Cheery Cherry Groceries—heed Lindstrom and open stores in the United States with a cherry red theme. The logo is cherry red, as are the shopping carts, coupon fliers, store trucks, shelves, employees' uniforms, and even the cash registers.

Clearance: How can the owners' trademark lawyers clear the mark cherry red?³³ A good first step is to search the USPTO's database of trademark applications and registrations or have a search firm do so. Because the USPTO does not collect information in its database as to whether a mark is a color mark, one must search in the mark descriptions given by applicants to try to find such marks, which may not catch all of them. At a minimum, the mark owners would certainly search mark descriptions for "red"

30. See § II.G. *infra* for more on the USPTO's old color lining system.

31. See *Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, 369 F.3d 1197, 1206 n.9, 70 U.S.P.Q.2d 1707 (11th Cir. 2004) (noting plaintiff's (unsuccessful) argument that defendant infringed by copying "the identical Pantone™ colors" of its ice cream).

32. See *Capri Sun, Inc. v. Beverage Pouch Sys., Inc.*, 2000 U.S. Dist. LEXIS 10966 (N.D. Ill. 2000) (defendants proposed that the parties "agree upon a set of Pantone shades . . . that are off limits to defendants"); *National Presto Indus. v. Dazey Corp.*, 1994 U.S. Dist. LEXIS 4093 (N.D. Ill. 1994) (in settlement agreement, defendant agreed not to use "Pantone Black C or equivalent" for its frying pots; court denied defendant's motion for a declaration that it did not violate the settlement agreement by using the color "Brilliant Charcoal"); *Newborn Bros. & Co. v. Dripless, Inc.*, 2002 T.T.A.B. LEXIS 537 (T.T.A.B. 2002) (*not citable as precedent*) (opposer agreed in settlement agreement not to sell non-drip caulking guns in certain PANTONE shades of yellow).

33. See § II.C. for more on clearance of color marks.

where the class was related to grocery stores and would search for “consists of the color red” to try to find as many red color marks as possible.

Assuming that the mark is cleared to the satisfaction of the lawyers and client, is the color cherry red registrable or a valid mark for retail grocery store services?³⁴ Here are the hoops through which it must jump.

Functionality: Would exclusive use of the color cherry red for grocery store services by Cheery Cherry disadvantage competitors? Doubtful, because it seems to have no utilitarian purpose. Perhaps if scientific research establishes that an abundance of the color cherry red makes people hungry or more likely to spend money, however, a competitor might be able to argue successfully that the color is functional.³⁵

Ornamentation or Source Indication: Would the ordinary purchaser believe that the cherry red color is merely ornamental or would he see it as a source indicator? Cheery Cherry would need particularly convincing survey evidence that consumers see the color as an indicator of source rather than pleasing decoration. If other grocery stores use the color—or similar colors—in their trade dress, consumers would be less likely to see it as a source indicator for Cheery Cherry.³⁶

Distinctiveness: Has cherry red acquired distinctiveness? Color marks are not protectable unless they have acquired distinctiveness, so a court or the USPTO would look at whether it has acquired distinctiveness for the Cheery Cherry stores. It would examine how long the mark has been in use, how much promotion the store has done emphasizing its color mark and whether consumers associate the color with the stores.³⁷

Assume Cheery Cherry’s color mark is registrable or protectable as a valid mark. Is it enforceable? Several years later Fuchsia Fine Wine & Liquors opens a store a few blocks from a Cheery Cherry store. Inspired by Lindstrom, Cheery Cherry, or both, Fuchsia’s logo, shelves, floors, fliers, employee vests and neckties, signage and check-out stands are dominated by the hot pink color fuchsia. Is there a likelihood of consumer confusion?³⁸ A great deal would depend on the commercial impression of the two trademarks. The consumer base would likely be similar for a grocery store and a liquor store, but cherry red and fuchsia make

34. For more on registering color marks, see § II.G. *infra*.

35. For more on the functionality of color marks, see § II.E. *infra*.

36. For more on whether color marks are ornamental, see § II.F. *infra*.

37. For more on color marks and acquired distinctiveness, see § II.D. *infra*.

38. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, Chapter 5 for a full treatment of likelihood of confusion.

distinctly different visual impressions. (Compare the hypothetical to a real lawsuit filed in Great Britain by mobile phone company Orange against mobile phone company easyMobile arguing that easyMobile's use of the color orange in its branding infringes Orange's use of the same color.³⁹)

Does Fuchsia's mark actually dilute Cheery Cherry's mark?⁴⁰ Cheery Cherry's mark would have to be famous, which is a high hurdle. If the case were in the Second Circuit, Cheery Cherry could not prevail because color is only protectable with a showing of acquired distinctiveness and only marks with inherent distinctiveness are eligible for dilution protection there.⁴¹ If Cheery Cherry could prove fame, it might be able to show (in another circuit) that Fuchsia's color mark actually reduced the uniqueness and distinctiveness of Cheery Cherry's color mark,⁴² but it would be very difficult. Consumers would have to have more than a mental association between the two marks; they would need to "form [a] different impression" of Cheery Cherry's mark to show dilution because of Fuchsia's mark.⁴³

An overriding factor in such cases would tend to make proof of likely confusion before the courts daunting: Color trademark infringement litigation is not likely to involve a simple comparison of two colors. No company is going to use *only* a color to identify its goods or services. UPS, for example, is not going to drop UNITED PARCEL SERVICE and let the color brown be its exclusive trademark. (UPS also has a registration for the word mark BROWN.⁴⁴) Nor would Tiffany & Co. eliminate TIFFANY and use its blue bags and boxes exclusively. Color will probably not be viewed in isolation from other indicia of source, as it is frequently used as an accompaniment to word marks, logos or other trade dress. A court is likely to look at whether the name Cheery Cherry Groceries is similar to the name Fuchsia Fine Wine & Liquors and

39. See Timmons, *In a British Mobile Phone Suit, the Color of Money is Orange*, N.Y. Times, Feb. 19, 2005, at C3; *Orange Color Clash Set for Court*, BBC News, Feb. 20, 2005, at <http://news.bbc.co.uk/2/hi/business/4281845.stm>.

40. See § X. *infra* for more on dilution of nontraditional trademarks and Gilson & LaLonde, 2 *Trademark Protection and Practice*, Chapter 5A for a full treatment of dilution.

41. *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 93, 57 U.S.P.Q.2d 1969 (2d Cir. 2001). See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5A.01[4][c][i][B] for more on whether a mark with acquired distinctiveness can be famous.

A bill that recently passed the House of Representatives, however, provides that a famous mark is entitled to dilution protection where it is "distinctive, inherently or through acquired distinctiveness." H.R. 683, 109th Cong. § 2 (2005). See § X. *infra*.

42. Note that under the provisions in the House bill, see *id.*, a court could grant injunctive relief where another mark was "likely to cause dilution" and not only where it had actually diluted the famous mark. *Id.*

43. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003).

44. Reg. No. 2688340.

comparing the style of the marks and logos, the overall trade dress of the stores and perhaps their websites and any differences in their patronage, not just examining whether the color cherry red is similar to the color fuchsia, to assess likelihood of confusion.

This potential complication will not exist in the USPTO, however, because subject matter outside the particular mark or marks being considered is essentially irrelevant. Trademark examining attorneys in effect wear blinders and would not consider, in comparing two color marks in applications or registrations, other marks, trade names, logos and other indicia of origin used by the parties. Similarly, in an opposition or cancellation proceeding, the Trademark Trial and Appeal Board typically applies a narrow analysis in reviewing the mark or marks in issue and deciding likelihood of confusion. Thus, a color registration should be of enormous help in preserving color trademark rights in the USPTO.

B. The Qualitex Doctrine

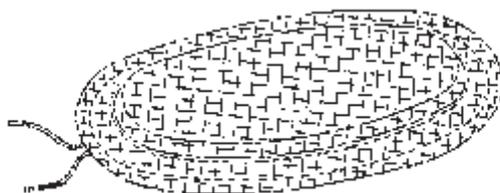
The stunning breakthrough for nontraditional marks came in a landmark Supreme Court decision inspired by an exceptionally mundane product. The Court explicitly and unanimously concluded that when a color meets “ordinary legal trademark requirements,” “no special legal rule prevents color alone from serving as a trademark.”⁴⁵ At issue in that case, *Qualitex Co. v. Jacobson Products Co.*, was the validity of a federal registration issued under Section 2(f) (based on acquired distinctiveness) for “machine parts; namely, press pads and covers for press pads for commercial and industrial presses.”⁴⁶ The applicant described the mark as “a particular shade of green-gold applied to the top and side surfaces of the goods” and noted that “[t]he representation of the goods shown in phantom lining [is] not a part of the mark and serves only to indicate position.” The drawing is lined for the color gold, according to the color lining scheme in use by the USPTO at the time of the mark’s registration.⁴⁷ The following is the drawing in the registration:

45. *Qualitex*, 514 U.S. at 161.

Before the 1995 *Qualitex* decision, the courts were split over whether color alone could be registered and protected as a trademark. Compare *Owens-Corning*, 774 F.2d 1116 (holding that the color pink was registrable as a trademark with the USPTO for home insulation) and *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219, 224, 25 U.S.P.Q.2d 1794 (8th Cir. 1993) (refusing to establish *per se* rule against protecting color alone as a trademark) with *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1028, 16 U.S.P.Q.2d 1959 (7th Cir. 1990) (holding that color alone could never be protected as a trademark; case involved color pastel blue on packets of sugar substitute) (case is no longer good law on this point), *rev’d sub silentio* by *Qualitex*, 514 U.S. 159.

46. See Reg. No. 1633711.

47. See § II.G. *infra* for more on the old color lining scheme.



The registrant had sued a competing supplier of dry-cleaning press pads; the Ninth Circuit held the registration invalid; and the Supreme Court reversed.

The Court began with the view that the Lanham Act had virtually no trademark subject matter limitation in the Section 45 definition of “trademark”: “any word, name, symbol, or device, or any combination thereof. . . .” It recognized the broad scope of the phrase, giving as examples shapes (the Coca-Cola bottle), sounds (NBC chimes) and scents (plumeria blossoms on thread). From there, it was simple to hold that color was included in the broad definition and that there was no policy or legal reason to hold otherwise.

The *Qualitex* doctrine stands for the fundamental premise that color is capable of distinguishing goods or services. Without distinctiveness there is no trademark, but a color on a product or its packaging can certainly signify a source, whether it is pink on home insulation or red on the head of an industrial bolt, examples given by the Court.

The case also recognized that color that has some particular function in relation to a product must be available to competitors and that the functionality doctrine could well result in depriving a color of trademark protection in a given case.⁴⁸ However, the functionality doctrine does not entirely bar the use of color alone as a trademark because “sometimes color is not essential to a product’s use or purpose and does not affect cost or quality.”⁴⁹ In the case at bar, green-gold had no function other than identifying Qualitex as the source of the press pads.

Reflecting a potent viewpoint favoring the protection of trademarks, the Court addressed and rejected several arguments against protecting color *per se* as a trademark.

First, it rejected the “shade confusion” argument, which suggests that courts will face impossible challenges resolving disputes about what shades of color a competitor may lawfully use that will not infringe on the color mark. It held that courts are

48. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][f] for more on trade dress functionality and § II.E. *infra* for more on the functionality of color marks.

49. *Qualitex*, 514 U.S. at 165.

equipped to decide questions of likelihood of confusion in cases involving all types of trademarks, and there is no reason why they cannot handle the same questions involving color.

Second, it was not persuaded by the “color depletion” argument, which posits that there are a limited number of colors and if courts begin to grant exclusive rights in colors soon there will not be enough to go around. This finding eradicated a line of authority that demonstrated judicial reluctance to enforce color trademarks because the number of colors is limited.⁵⁰ The Court concluded that the color depletion issue would rarely arise and could be resolved, if necessary, by applying the functionality doctrine to prevent anticompetitive results.

Third, pre-Lanham Act authority holding color unprotectable in principle had been replaced by the broad language of the Act; furthermore, in enacting the Trademark Law Revision Act of 1988, Congress explicitly intended to include color as a trademark.⁵¹

Fourth, the fact that colors could be protected under established trade dress law when they appear in combination with other elements does not prevent additional protection under trademark law.

All told, *Qualitex* stands at the apogee of nontraditional trademark protection in the United States. The decision is clear, forceful, and without a single dissent or even concurrence. It will no doubt have a lasting impact on trademark law in general and nontraditional marks in particular for years to come.

C. Clearance of Color Trademarks

Clearing nontraditional marks for client use or registration is not easy. Even search firm Thomson & Thomson confines its United States nontraditional mark search to federal applications and registrations because there are not yet any reliable databases for common law nontraditional trademarks.⁵²

For clearance of color trademarks in the United States, one must look at the USPTO’s Trademark Electronic Search System

50. See, e.g., *NutraSweet Co.*, 917 F.2d at 1024 (“It is likely . . . that if each of the competitors presently in the tabletop sweetener market were permitted to appropriate a particular color for its product, new entrants would be deterred from entering the market.”); *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1302, 29 U.S.P.Q.2d 1277 (9th Cir. 1994) (“As many cases have noted, under the color depletion theory, no person should have a monopoly on a primary color.”), *rev’d*, 514 U.S. 159 (1995); *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798, 81 U.S.P.Q. 430 (3d Cir. 1949) (“If [plaintiffs] may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out.”).

51. See note 5 *supra*.

52. Conversation with John Ala, Corporate Counsel, Thomson & Thomson, Mar. 23, 2005.

(TESS).⁵³ The USPTO's database cannot be searched for color marks exclusively because the USPTO does not require that applicants state in uniform language that they are registering a color mark. In other words, there is no language in the database common to all color trademarks so that a single search would result in a list of all registered color trademarks. The same is true for scent, motion, sound, flavor and tactile trademarks.

Users can search the TESS database with certain design search codes. Code 29.02 stands for a single color that is used for the entire goods and services, and subcategories include red or pink (29.02.01), brown (29.02.02) and black (29.02.11). A search for red, for example, results in a few marks that are only color marks but also contains several marks that simply contain the color red.

Users should also search within the descriptions of the marks given by the applicants. To do so, at the TESS home page, click on "Structured Form Search (Boolean)"; under "Field," choose "Description of Mark." Add "Live" as the Search Term for Field "Live/Dead Indicator" to eliminate trademarks that have been abandoned or cancelled (although an investigation of continued use may be warranted). Be sure the Operator is set for "AND." Under "Search Term," some possible searches include: (1) the word "Pantone," which will include some color marks but also some traditional marks that include color along with other elements; (2) the name of the color being cleared; or (3) the phrase "consists of the color". Remember that none of these searches will retrieve all color marks in the USPTO database, but they should garner a good portion of them.

D. Color and Acquired Distinctiveness

Color *per se* cannot be inherently distinctive.⁵⁴ In order to receive trademark protection, therefore, a color must gain acquired distinctiveness, otherwise known as secondary meaning.⁵⁵ For purposes of trademark registration, the Trademark Trial and

53. Find TESS online by going to the USPTO's main screen at www.uspto.gov and clicking on "Search" under "Trademarks" on the left-hand column.

54. *Wal-Mart Stores, Inc.*, 529 U.S. at 211 ("[W]ith respect to at least one category of mark—colors—we have held that no mark can ever be inherently distinctive."); *Qualitex*, 514 U.S. at 162-63 (A "product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost *automatically* tell a customer that they refer to a brand. . . . But, over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand.").

See also TMEP § 1202.05 ("Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f)."); TMEP § 1202.05(a).

55. *See* Gilson & LaLonde, 1 *Trademark Protection and Practice*, § 2.09 for more on secondary meaning.

Appeal Board has declared that the burden to show acquired distinctiveness is heavier in the case of a color mark “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 or product packaging trade dress.”⁵⁶

Courts share the Board’s skepticism about finding that color marks have acquired distinctiveness.⁵⁷ Proving acquired distinctiveness for color marks will be a significant obstacle in an infringement case. In a dilution case, a color mark must not only have acquired distinctiveness, it must also be famous, an extremely high hurdle.

It is, however, possible for a color mark to attain secondary meaning. In a 1985 landmark case allowing registration of a color mark, the Federal Circuit found that Owens-Corning had done everything right.⁵⁸ The company made an overwhelming showing of acquired distinctiveness, having advertised its color pink mark for home insulation for approximately thirty years and having spent over \$42 million on consumer advertising, much of which emphasized the distinctive pink color of the product. From August 17, 1980 to March 30, 1981, Owens-Corning had bought nearly two hundred blocks of network time during major sporting events such as the Super Bowl, the Rose Bowl, the U.S. Open tennis tournament and the World Series, as well as during prime time network series. Many of these commercials featured the Pink Panther to promote the use of the pink insulation and used the slogan “Put your house in the pink.” During this time, Owens-Corning also advertised in major consumer magazines, including *Better Homes and Gardens* and *Popular Mechanics*, using slogans such as “Love that Pink,” “Pink Power,” “America’s Favorite Pink Product” and “Plant Some Pink Insulation in Your Attic.”⁵⁹ *Owens-*

56. *In re Ferris Corp.*, 2000 TTAB LEXIS 709 (T.T.A.B. 2000).

57. *Mana Products, Inc. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070, 36 U.S.P.Q.2d 1176 (2d Cir. 1995) (“While there is no fixed rule for the amount of proof necessary to prove secondary meaning, in the case of a color mark for a trade dress the burden is heavy because color marks by their very nature are not generally distinctive.”) (finding no secondary meaning for black trade dress for makeup compact); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 U.S.P.Q. 417 (Fed. Cir. 1985) (“By their nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character.”).

58. *Owens-Corning*, 774 F.2d at 1124-28.

59. See also *Minnesota Mining and Mfg. Co. v. Beautone Specialities Co.*, 82 F. Supp. 2d 997, 1003, 53 U.S.P.Q.2d 1878 (D. Minn. 2000) (finding genuine issue of fact as to secondary meaning of canary yellow for sticky notes where survey evidence showed consumers strongly associated canary yellow sticky notes with plaintiff, where for several years plaintiff was the exclusive producer of canary yellow sticky notes and where plaintiff’s advertising promoted the color); *In re Royal Appliance Mfg. Co.*, 1996 TTAB LEXIS 64 (T.T.A.B. 1996) (finding that color red for hand-held vacuum cleaners had acquired

Corning is, without a doubt, the “pink” standard of color trademark protection.

When the trademark sought to be protected is color *in addition to* other features of a product, such as size, shape and logo, the trade dress as a whole need not have acquired secondary meaning in order to be protected, *unless* it is a product design, which the Supreme Court has also held is not inherently distinctive.⁶⁰

E. Color as Functional

Color *per se* is not protectable if it is functional.⁶¹ The functionality doctrine in trademark law prevents mark users from stifling competition by monopolizing a useful product quality.⁶² If a color is functional on a certain product, trademark protection for that color would harm competitors who wish to use it. The functionality inquiry looks to whether a product feature “is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.⁶³

1. In General

Colors that serve some useful purpose on products will be found to be functional and unprotectable. For example, a court denied trademark protection to bright orange for biohazard bags because orange served to alert the user that the contents of the bags were hazardous.⁶⁴ Courts and the Trademark Trial and Appeal Board have also denied protection to colors that serve some other sort of function in relation to the product, where white alerted users to the cleanliness of cutlery handles,⁶⁵ pink for

distinctiveness with evidence of extensive advertising that emphasized the color red, declarations from buyers for store chains and a consumer survey where 76% of respondents identified the product as applicant’s).

60. *Wal-Mart Stores, Inc.*, 529 U.S. 205. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][d] for more on inherent distinctiveness of product designs.

61. *Wal-Mart Stores*, 529 U.S. at 164-65 (functional product features cannot serve as trademarks); TMEP § 1202.05(b) (“A color mark is not registrable on the Principal Register under § 2(f), or the Supplemental Register, if the color is functional.”).

62. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][f] for more on functionality in the context of trade dress law.

63. *Qualitex*, 514 U.S. at 165.

64. *American Hospital Supply Corp. v. Fisher Scientific Co.*, 1988 U.S. Dist. LEXIS 11000 (N.D. Ill. 1988), *reh’g denied*, 713 F. Supp. 1108 (N.D. Ill. 1989).

65. *Russell Harrington Cutlery, Inc. v. Zivi Hercules, Inc.*, 25 U.S.P.Q.2d 1965 (D. Mass. 1992).

surgical dressings was compatible with Caucasian skin color,⁶⁶ black for outboard motors was compatible with a wide variety of boat colors and caused the motor to appear smaller⁶⁷ and orange for pay telephones made them more visible.⁶⁸

Of course, not all uses of color on products are functional. As the Court noted in *Qualitex*:

Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not. And, this latter fact—the fact that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality—indicates that the doctrine of “functionality” does not create an absolute bar to the use of color alone as a mark.⁶⁹

The ultimate question determining whether a color is functional is whether allowing one party exclusive use of that color would put its competitors “at a significant non-reputation-related disadvantage.”⁷⁰ A “non-reputation-related disadvantage” is a disadvantage that is unrelated to consumer recognition of the source of a product, such as a manufacturer’s ability to make its product as appealing or useful as possible. Good will, on the other hand, is a reputation-related advantage protected by trademark law. Trademarks tell consumers that certain items are made by a

66. *In re Ferris Corp.*, 2000 TTAB LEXIS 709 (T.T.A.B. 2000) (affirming refusal of registration).

67. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994).

68. *In re Orange Communications, Inc.*, 41 U.S.P.Q.2d 1036 (T.T.A.B. 1996) (affirming refusal of registration on Supplemental Register).

See also, e.g., Dippin’ Dots, Inc. v. Frosty Bites Distribution, LLC, 369 F.3d 1197, 1203-04, 70 U.S.P.Q.2d 1707 (11th Cir. 2004) (holding that the color of ice cream is functional because it indicates flavor); *Sylvania Electric Prods., Inc. v. Dura Electric Lamp Co.*, 247 F.2d 730, 114 U.S.P.Q. 434 (3d Cir. 1957) (denying protection to a blue dot on a photographic flashbulb because it was both functional and considered descriptive of the product; the dot functioned as an air leakage indicator, changing to pink if the bulb was defective and suffered from air leakage); *Specialty Surgical Instrumentation Inc. v. Phillips*, 844 F. Supp. 1211, 30 U.S.P.Q.2d 1309 (M.D. Tenn. 1994) (denying protection for color gray in product catalog because gray highlights design of products advertised in catalog); *In re Howard S. Leight and Assocs.*, 39 U.S.P.Q.2d 1058 (T.T.A.B. 1996) (affirming refusal of registration for color coral for ear plugs; color is functional because it is “more readily visible, allowing for easier and quicker safety checks”).

69. *Qualitex*, 514 U.S. at 165 (holding that green-gold on dry cleaning press pads serves no function other than to indicate source).

70. *Id.* *See Minnesota Mining and Mfg. Co. v. Beautone Specialities Co.*, 82 F. Supp. 2d 997, 53 U.S.P.Q.2d 1878 (D. Minn. 2000) (refusing to grant summary judgment on whether canary yellow is functional for sticky notes, focusing on question whether canary yellow “truly offers sticky note producers a significant non-reputation-related competitive advantage”).

single producer, so that they may choose items from the producer whose products they liked in the past.⁷¹

The Supreme Court gave as an example the color of a pill that identifies the type of medication;⁷² other companies' inability to use that color would put them at a competitive disadvantage unrelated to consumer trademark recognition. The disadvantage in that case is the inability to indicate the type of medication quickly and easily. In another case, where fly-fishers were shown to prefer fishing rods in a limited range of colors, a court held that manufacturers had a competitive reason to choose only those colors and thus the color used was likely functional.⁷³ As the Trademark Trial and Appeal Board put it, "If exclusive use permits one competitor to interfere with legitimate competition, then protection should not be afforded."⁷⁴

Where competitors would not be harmed by one company's ability to use a certain color mark, the mark is not functional. The Trademark Trial and Appeal Board held that the color blue for newsstands had no "utilitarian purpose" and its registration would not "hinder competition."⁷⁵ A district court similarly 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 regard."⁷⁶

2. Aesthetic Functionality

The controversial doctrine of aesthetic functionality may apply where the use of color (or other ornamentation) provides a competitive advantage resulting from an aesthetic appeal to consumers rather than a utilitarian purpose.⁷⁷ If a color is aesthetically functional, it must be available for use by all

71. Cf. *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989, 70 U.S.P.Q.2d 1386 (7th Cir. 2004) (describing concerns behind the reluctance to allow personal names to be used as trademarks, one of which being that "preventing a person from using his name to denote his business may deprive consumers of useful information") (Posner, J.).

72. *Qualitex*, 514 U.S. at 169.

73. *R.L. Winston Rod Co. v. Sage Mfg. Co.*, 838 F. Supp. 1396, 29 U.S.P.Q.2d 1779 (D. Mont. 1993).

74. *In re Orange Communications, Inc.*, 41 U.S.P.Q.2d 1036 (T.T.A.B. 1996) (affirming refusal of registration on Supplemental Register).

75. *In re Hudson News Co.*, 39 U.S.P.Q.2d 1915 (T.T.A.B. 1996) (registrations ultimately refused because not inherently distinctive).

76. *Keystone Consolidated Industrial, Inc. v. Midstates Distributing Co.*, 235 F. Supp. 2d 901, 905-06, 65 U.S.P.Q.2d 1492 (C.D. Ill. 2002).

77. For a complete discussion of aesthetic functionality, see Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][f][iii].

competitors. Several circuits have rejected or sharply limited application of the doctrine, though in 2001 the Supreme Court legitimized aesthetic functionality by declaring—incorrectly—that it had been the “central question” in an earlier Court decision and explaining how to discern aesthetic functionality.⁷⁸

3. Color-Coding Systems

Because they are frequently functional, color coding systems in general are not protected as trademarks.⁷⁹ A color coding system can indicate product characteristics enabling customers to choose the appropriate product quickly and allow store displays to be restocked easily. Some courts, however, have found color coding nonfunctional and protectable, reasoning that the colors themselves are arbitrary and do not improve the product’s ability to perform.⁸⁰ The better view holds that, in the typical case, such

78. The Court in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), declared mistakenly that aesthetic functionality was the “central question” in *Qualitex*, 514 U.S. 159 (1995). See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][f][iii] to find out why the Supreme Court was in error. It also declared that it “is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of aesthetic functionality.” *Traffix*, 532 U.S. at 33.

79. *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1329, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (holding that “color coding cannot act as an indicator of source because it is primarily functional”); *Spraying Sys. Co. v. Delevan, Inc.*, 762 F. Supp. 772, 781, 19 U.S.P.Q.2d 1121 (N.D. Ill. 1991) (holding that “color coding as an identification system is clearly functional”), *aff’d*, 975 F.2d 387, 24 U.S.P.Q.2d 1181 (7th Cir. 1992); *Kasco Corp. v. Southern Saw Serv., Inc.*, 27 U.S.P.Q.2d 1501 (T.T.A.B. 1993) (color coded wrappers for saw blades functional because they “enable purchasers and users of the blades to quickly identify and distinguish one blade type from another”). See also *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 227 U.S.P.Q. 598 (9th Cir. 1985) (finding that evidence presented to the jury was sufficient for it to find that color coding of springs was functional), *overruled in part on other grounds in Bellevue Manor Assocs. v. United States*, 165 F.3d 1249 (9th Cir. 1999).

See Gilson & LaLonde, 1 *Trademark Protection and Practice*, § 2.03[4][a] for more on grade, color and style designations.

80. *Barnes Group, Inc. v. Connell Ltd. Partnership*, 793 F. Supp. 1277 (D. Del. 1992) (holding that color coding on die springs was not functional because the colors were arbitrary and there is no relationship between the colors and the mechanical function of the spring except as the manufacturer used them to denote load class); *Scan-Plast Indus., Inc. v. Scanimport Am., Inc.*, 652 F. Supp. 1156, 2 U.S.P.Q.2d 1337 (E.D.N.Y. 1986) (finding a genuine issue of fact as to whether color coding of widths of storage system components is non-functional because they are not “essential to the use of the product or impact upon the quality or cost of the product. . . . [and] there is arguably no functional aspect to the particular colors used by the plaintiffs”); *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 213 U.S.P.Q. 568 (W.D. Pa. 1981) (color coding system for thickness of shims nonfunctional; “The use of a specific color scheme by [plaintiff] bears no relationship to the shim’s ability to perform as a spacer in milling machinery. A shim can be any color. Any color can designate thickness.”); *Biocraft Labs., Inc. v. Merck & Co.*, 532 F. Supp. 1068 (D.N.J. 1980) (“Color coding, per se . . . has a functional aspect, but in the absence of a general standard specifying what colors are to be used for what purpose, the selection of an arbitrary group of colors unique to a particular manufacturer designates source and origin and is not functional.”).

systems are functional because they save time and money for customers and retailers. Just because the individual colors are chosen arbitrarily does not mean that the overall color scheme does not have an important practical function.

In contrast, the Second Circuit applies a nuanced approach, allowing even functional color coding to be protected. It balances “(1) the degree of functionality of the similar features of the product, (2) the degree of similarity between the non-functional (ornamental) features of the competing products, and (3) the feasibility of alternative designs that would not impair the utility of the product.”⁸¹ In the color coding context, the court held that “[a] color or color code, even one that contributes to the function of the product, may be protected under the Lanham Act unless the costs to competition of precluding competitors from using the color are too high.”⁸² In that case, the court concluded that there were genuine issues of fact precluding summary judgment on the protectability of exercise stretch bands color-coded to indicate resistance level. It found that it was insufficient simply to decide whether the color is important to the product’s usefulness because that did not acknowledge that “the competitive benefits of protecting the source-identifying aspects of the feature under the Lanham Act may outweigh the competitive costs of precluding competitors from using the feature.”⁸³

F. Color as Ornamental or Decorative

Ordinarily, consumers perceive color on products or packaging as *only* ornamental and decorative, rather than as source-indicating.⁸⁴ When that is the case, it is not a trademark.⁸⁵ The Supreme Court has stated that, in the case of color marks,

81. *Fabrication Enterprises, Inc. v. Hygenic Corp.*, 64 F.3d 53, 59, 35 U.S.P.Q.2d 1753 (2d Cir. 1995).

82. *Id.* at 58.

83. *Id.* at 59.

84. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1124, 227 U.S.P.Q. 417 (Fed. Cir. 1985) (“color is usually perceived as ornamentation”).

For more on “ornamental” trademark use, see Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5.05[9].

85. TMEP § 1202.03 (“Subject matter that is merely a decorative feature does not identify and distinguish the applicant’s goods and, thus, does not function as a trademark.”). See also *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1153 (C.D. Cal. 1998) (noting plaintiff’s failure to show that its pink and white color combination “are anything more than decorative colors”); *American Basketball Ass’n v. AMF Voit, Inc.*, 358 F. Supp. 981, 985, 177 U.S.P.Q. 442 (S.D.N.Y. 1973) (finding that colors on sections of basketball were “merely a decoration or embellishment” rather than a trademark).

“consumer predisposition to equate the feature with the source does not exist.”⁸⁶

While owners of color marks face an uphill battle in proving that their marks in fact function as source indicators, it is nevertheless possible for even ornamental colors to serve as trademarks. When the Federal Circuit ruled that pink could be registered as a trademark for home insulation, it found that “even if the ‘pink’ color is considered to be ornamental, this does not prevent it from acting as a trademark.”⁸⁷ Whether a color is merely ornamental or is both ornamental and source-indicating depends upon “the impression likely to govern the ordinary purchaser in the marketplace.”⁸⁸ And the Federal Circuit has warned that “convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark which identifies the source of the goods.”⁸⁹ Owners of color marks carry a “difficult burden in demonstrating distinctiveness and trademark character.”⁹⁰

The USPTO considers the following factors in determining whether to register arguably ornamental matter, such as color: “(1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness”:⁹¹

- First, would consumers perceive the color as a trademark or just as a decorative feature of the goods? The TMEP suggests that a “small, neat and discrete word or design feature” may be more likely to be seen as a trademark than the same matter “emblazoned across the front of a garment (or a tote bag, or the like).”⁹²
- Second, is the proposed trademark “a type of ornamental matter used so frequently in the relevant industry that

86. *Wal-Mart Stores, Inc.*, 529 U.S. at 213. See also *Qualitex*, 514 U.S. at 163 (“The imaginary word ‘Suntost,’ or the words ‘Suntost Marmalade,’ on a jar of orange jam immediately would signal a brand or a product ‘source’; the Jam’s orange color does not do so.”).

87. *Owens-Corning*, 774 F.2d at 1122. Cf. *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 826, 184 U.S.P.Q. 348 (C.C.P.A. 1975) (“Ornamentation will not prevent registration so long as a mark with the color(s) used in a particular manner primarily indicates source.”).

88. *Owens-Corning*, 774 F.2d at 1123, quoting *In re Swift & Co.*, 223 F.2d 950, 954, 106 U.S.P.Q. 286 (C.C.P.A. 1955). Consumer perception can be placed into evidence either through direct consumer testimony or, more typically, through a survey. For more on consumer surveys, see Gilson & LaLonde, 3 *Trademark Protection and Practice*, § 8.11.

89. *Owens-Corning*, 774 F.2d at 1124, quoting *In re David Crystal, Inc.*, 49 C.C.P.A. 775, 296 F.2d 771, 773, 132 U.S.P.Q. 1 (C.C.P.A. 1961).

90. *Id.* at 1127.

91. TMEP § 1202.03.

92. TMEP § 1202.03(a).

consumers would be less apt to discern a source-indicating significance from its use”⁹³ If so, the applicant will have a higher burden of proving acquired distinctiveness.

When competitors use the same or similar color for their products, courts and the Trademark Trial and Appeal Board will find that it serves as ornamentation rather than a source indicator.⁹⁴ As the USPTO asks in determining whether to register ornamental matter such as color, is the alleged mark “unique or unusual in a particular field or [is it] a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods?”⁹⁵

- Third, would the proposed trademark be recognized as a trademark because of its use with goods and services other than those in the application?⁹⁶ The Board found that the mark MORK & MINDY was registrable for decals because the applicant had previously registered that mark for other goods and services. This part of the test is not relevant to color marks.
- Fourth, is the mark distinctive?⁹⁷ Marks with acquired distinctiveness may be registered on the Principal Register.

G. Registration of Color Trademarks

The USPTO will not register a color mark on the Principal Register unless the applicant proves that the mark has acquired distinctiveness under Section 2(f).⁹⁸ If the color mark is not distinctive, however, then it may still be registered on the Supplemental Register. According to the USPTO, the burden of

93. TMEP § 1202.03(b).

94. *Owens-Corning*, 774 F.2d at 1127 n.11 (“A color which is employed by others in the industry acts not as an indicator of source but as mere ornamentation.”); *Edward Weck, Inc. v. IM, Inc.*, 17 U.S.P.Q.2d 1142 (T.T.A.B. 1990) (“Since others have used this same color, albeit a different shade . . . , the relevant public is less likely to view the color as an indicator of origin than as mere ornamentation lacking in trademark function.”).

95. TMEP § 1202.03(b). *See In re Glaxo Group Ltd.*, 53 U.S.P.Q.2d 1920 (T.T.A.B. 2000) (finding applicant’s color scheme for its inhalers to be only slightly different than ornamentation on other inhalers; affirming refusal of registration); *In re Sunburst Prods.*, 51 U.S.P.Q.2d 1843 (T.T.A.B. 1999) (finding that applicant’s trademark “is nothing more than a mere refinement of a common or basic color scheme for sports watches and therefore would not immediately be recognized or perceived as a source indicator. That is to say, we believe that applicant’s design would be viewed by prospective purchasers as just a slightly different ornamentation.”).

96. TMEP § 1202.03(c).

97. TMEP § 1202.03(d).

98. TMEP § 1202.05(a). For more on color marks and acquired distinctiveness, see § II.D. *supra*.

proof on the applicant to prove acquired distinctiveness is “substantial.”

An intent-to-use application for a color mark is sure to fail because the applicant cannot prove acquired distinctiveness for a mark that has not yet been used. Those seeking to register a color mark should wait until use begins, filing a use-based application alleging Section 2(f) after perhaps three or four years of use and a great deal of advertising emphasizing color.

The USPTO will refuse registration to functional color trademarks, including those that give some utilitarian advantage or make a product easier or cheaper to produce or use.⁹⁹ If consumers would perceive the color as merely an ornamental feature of the goods, the USPTO will not register it as a trademark. If, however, the mark is used to signify source and consumers perceive it as distinguishing the source of the goods, it can function as a trademark.¹⁰⁰

Applicants seeking to register color marks must submit a special form drawing.¹⁰¹ The applicant must name the color that is a feature of the mark and should describe the mark and where the color appears on the mark. Some applicants note the PANTONE Color number from the system that designates specific shades numerically,¹⁰² but the applicant must indicate the common name for the color as well.¹⁰³ The drawing will typically be a representation of the product or packaging on which the color is to be placed.¹⁰⁴

As of November 2, 2003, color marks must be filed in color. The USPTO now does not accept black and white drawings where there is a color claim and no longer accepts drawings that show color using the USPTO’s discontinued color lining system.¹⁰⁵ The following system is therefore obsolete:

99. TMEP § 1202.05(b). For more on functionality and color marks, see § II.E. *supra*.

100. TMEP § 1202.05. For more on ornamentation and color marks, see § II.F. *supra*.

101. 37 C.F.R. § 2.52(b). See TMEP § 1202.05(d) (“An application for a color mark that is filed without a drawing will be denied a filing date.”).

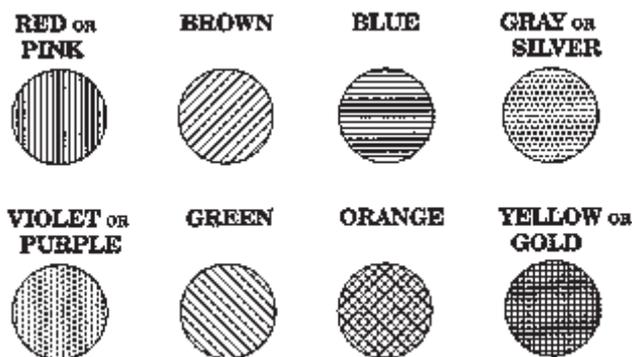
102. See, e.g., registration for plastic piping for transporting ultrapure fluids where the mark consists of “the translucent shade of the color blue, PANTONE 2783 C, which extends homogeneously throughout the identified goods” (Reg. No. 2875761).

See § II.A. *supra* for more on the PANTONE MATCHING SYSTEM.

103. TMEP § 1202.05(e).

104. TMEP § 1202.05(d)(i).

105. USPTO Exam Guide No. 1-03, I.B.1.



Still, practitioners need to be familiar with the defunct color lining system when searching trademark applications and registrations filed before November 2, 2003.

III. SCENT MARKS

General Motors, with the help of focus groups and a laboratory, recently created a scent it called Nuance. It is the “ethereal scent of factory freshness,” a.k.a. new car smell, that since 2003 has been infused into the leather seats of every new Cadillac put on the road.¹⁰⁶ Strolling by a Cinnabon airport franchise, one is met by the intoxicating aroma of baking buns. And researchers in France found that customers stayed longer and spent more in a restaurant infused with the scent of lavender, concluding that “scents could influence many consumption environments.”¹⁰⁷ Scent is indeed an incredibly powerful marketing tool.

Scent marks have decisional precedent on their side. Distinctive, non-functional scents are eligible for federal trademark registration.¹⁰⁸ The Trademark Trial and Appeal Board,

106. Lindstrom at 94, in a section called “Eau de Car.”

107. Nagourney, *Sensations: A Hint of Lavender and the Scent of Money*, N.Y. Times (July 5, 2005).

108. TMEP § 1202.13 (“The scent of a product may be registrable if it is used in a non-functional manner.”). See Hammersley, *The Smell of Success: Trade Dress Protection for Scent Marks*, 2 Marq. Intell. Prop. L. Rev. 105, 106 (1998) (arguing that “the expansive nature of modern trade dress law suggests courts will accept a wider range of [scent mark] registrations, particularly in light of the color mark case”); Chai, *Protection of Fragrances under the Post-Sale Confusion Doctrine*, 80 TMR 368, 371 (1990) (“Scents should be accorded trademark status.”); Hawes, *Fragrances as Trademarks*, 79 TMR 134, 137 (1989) (“The scope of the Lanham Act surely seems to encompass fragrances.”).

But see Churovich, *Intellectual Property: Policy Considerations from a Practitioner’s Perspective: Scents, Sense or Cents? Something Stinks in the Lanham Act. Scientific Obstacles to Scent Marks*, 20 St. Louis U. Pub. L. Rev. 293, 293-94 (2001) (stating that “the landmark *In re Clarke* decision was ill-advised since it was founded upon a poor, if not non-existent, understanding of osphresiology and the misguided application of legal principles

in a landmark decision, held that there was no reason that a scent could not identify and distinguish certain types of products. Thus, the Board allowed registration of an arbitrary, nonfunctional scent (“high impact, fresh, floral fragrance reminiscent of Plumeria blossoms”) for sewing thread and embroidery yarn.¹⁰⁹ In an unusual Supreme Court tip of its hat to the Trademark Trial and Appeal Board, the Court in *Qualitex* essentially approved the holding in this Board decision.¹¹⁰ Scent marks can be affixed directly to or infused into the product, like the Plumeria blossom-scented yarn or hypothetical raspberry-scented upholstered furniture, or could even be affixed as a scratch-and-sniff or scented card.

Because so few of them are registered, clearing a scent mark by searching the USPTO database should not be difficult. For example, one could search for the words “scent,” “smell,” “fragrance,” “odor” or “aroma” in the descriptions of marks.¹¹¹ Beyond federal applications and registrations, however, would prospective scent mark owners have to go on a field trip sniffing products similar to theirs? No common law database of scent marks exists. A broad knowledge of the client’s industry should help in knowing whether other, similar goods are also scented.

Without acquired distinctiveness scent marks are not registrable on the Principal Register. A non-functional scent may be registered either on the Principal Register under Section 2(f), meaning that the scent has acquired distinctiveness, or on the Supplemental Register if it has not.¹¹² The USPTO cautions that “[t]he amount of evidence required to establish that a scent or fragrance functions as a mark is substantial.”¹¹³ In the *Clarke* case, the Board observed that the applicant had promoted the scent of her product in advertising and shown that customers and dealers had come to recognize her as the source of the goods.¹¹⁴

that fail to apply to scents”); Elias, *Do Scents Signify Source? An Argument Against Trademark Protection for Fragrances*, 82 TMR 475, 475 (1992) (“Fragrances only rarely, if ever, function as trademarks in the market place and, in those few cases in which fragrances do arguably indicate a product’s source, their trademark protection remains doctrinally problematic and potentially impossible to implement and enforce in a consistent fashion.”).

109. *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990). The yarn registration was cancelled on September 29, 1997 for failure to file a statement of use.

110. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (acknowledging with approval the Board’s “authoriz[ation]” of a fragrance in *Clarke* “for use as a mark”).

111. Cf. § II.C. for clearance of color marks and how to use the USPTO’s TESS database.

112. TMEP § 1202.13.

113. TMEP § 1202.13.

114. *In re Clarke*, 17 U.S.P.Q.2d 1238.

Where the scent is functional, as with a perfume, cologne, or air freshener, the USPTO will refuse registration.¹¹⁵ In its decision in *Clarke*, the Board drew the line between perfumes, colognes and scented household products, on the one hand, and products like scented yarn and thread, on the other. In the former category, the products are “noted for these features,” stated the Board. In the latter, the scent is not an inherent attribute or natural characteristic of the product, and hence is an arbitrary feature.¹¹⁶

One scent mark currently registered on the Principal Register gets high marks for ingenuity. The mark, a “cherry scent,” is for “synthetic lubricants for high performance racing and recreational vehicles.”¹¹⁷ The same registrant owns two registrations on the Supplemental Register for “lubricants and motor fuels for land vehicles, aircraft, and watercraft”: “the grape scent of the goods” and “the strawberry scent of the goods.”¹¹⁸ It abandoned “the almond scent of the goods,” “the citrus scent of the goods,” “the bubble gum scent of the goods” and “the tutti-frutti scent of the goods,” all for “lubricants and motor fuels for land vehicles, aircraft and watercraft.”¹¹⁹ Could the following online ad highlighting scent added to the registrant’s oil give rise to a claim of functionality?

Why deal with the nauseous exhaust fumes from your race vehicle, when you could be sniffing root beer, piña colada, or bubble gum instead? Manhattan Oil fuel fragrances eliminate unpleasant exhaust fumes and the eye, nose, and throat irritation that come with them. They’re available in 19 different fragrances.¹²⁰

The possibilities are unlimited. For example, picture a mile-long oval on a summer afternoon, with thousands of boisterous NASCAR fans inhaling a rich bouquet of racecar exhaust scents.

Also on the Supplemental Register for “[o]il based metal cutting fluid and oil based metal removal fluid for industrial metal working” is “a scent mark having the scent of bubble gum.”¹²¹ At the very least, this scent appears undeniably arbitrary and nonfunctional.

115. TMEP § 1202.13. *But see* Reg. No. 2644707 (mark is “composed of a fragrance intended to evoke the scent of various orchard fruits” for “fragrances sold as an integral component of preparations for cleaning, polishing, moisturizing and protecting furniture, paneling, wood and other hard surfaces”) (Supplemental Register).

116. *In re Clarke*, 17 U.S.P.Q.2d 1238.

117. Reg. No. 2463044.

118. Reg. No. 2568512 (grape); Reg. No. 2596156 (strawberry).

119. Ser. No. 75404020 (almond); Ser. No. 75360105 (citrus); Ser. No. 75360103 (bubble gum); Ser. No. 75360106 (tutti-frutti).

120. *See* www.stedis.com/products.html.

121. Reg. No. 2560618.

The applicant for a scent trademark does not submit a drawing to the USPTO when applying to register the mark.¹²² Instead, the applicant “must submit a detailed written description of the mark that clearly explains . . . the scent” and should submit a page indicating “NO DRAWING” where the mark would otherwise have appeared.¹²³ As for specimens, the specimen for the oil-based fluid with a bubble gum scent, for instance, is a bottle containing the product.¹²⁴

The response to one application at the USPTO demonstrates many of the obstacles a scent mark must overcome. An application for a paint and varnish stripper where the mark was “a fresh fruity fragrance reminiscent of oranges” was refused for three reasons: orange scent is functional for cleaners that contain orange acid as a cleaning ingredient, the scent merely described an ingredient of the goods, and the scent did not function as a trademark because it did not distinguish applicant’s goods from those of others.¹²⁵ The application was abandoned for failure to respond to the Office Action.

Mark owners should note that even if a scent mark is registered, enforcement will likely be difficult.¹²⁶ Because scent marks cannot be inherently distinctive, they will probably lack strength in a likelihood of confusion determination. It will be difficult for the owner of a scent mark to prove fame in a dilution case and impossible for the mark to be inherently distinctive as

122. 37 C.F.R. § 2.52(a)(3); TMEP § 807.09.

123. TMEP § 807.09.

124. See <http://portal.uspto.gov/external/portal/tow> for the USPTO’s Trademark Document Retrieval system where a user can search by serial number or registration number to view official trademark application files, including specimens.

125. See Ser. No. 76504152.

126. In a series of related cases, luxury perfume manufacturers have had mixed results in trying to stop the sale of knock-offs. For example, *compare Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc.*, 815 F.2d 500, 2 U.S.P.Q.2d 1285 (8th Cir. 1987) (vacating injunction because district court erred in finding that plaintiff showed probable success on the merits; “The parties do not dispute that [defendant] may copy, if it can, the scent marketed as OBSESSION.”); *Smith v. Chanel, Inc.*, 402 F.2d 562, 159 U.S.P.Q. 388 (9th Cir. 1968) (reversing grant of injunctive relief; noting appellant’s right to copy appellee’s scent and to tell potential purchasers that its product was equivalent to appellee’s) *with Charles of the Ritz Group, Ltd. v. Quality King Distributors, Inc.*, 832 F.2d 1317, 4 U.S.P.Q.2d 1778 (2d Cir. 1987) (finding similarity between luxury perfume and knock-off perfume where knock-off mimicked scent (and trade dress and word mark) of original; affirming issuance of preliminary injunction); *Saxony Prods., Inc. v. Guerlain, Inc.*, 513 F.2d 716, 185 U.S.P.Q. 474 (9th Cir. 1975) (finding genuine issue of material fact as to whether defendant falsely represented that its knock-off perfume was similar to plaintiff’s luxury perfume; plaintiff submitted affidavit of a chemist and perfume specialist stating that the fragrances were not alike as well as a laboratory test of the fragrances finding them dissimilar and the court itself had a “sniff test”).

required in the Second Circuit.¹²⁷ And showing that consumers perceive a particular scent as a source-indicating trademark rather than merely an appealing feature of the goods or services will be daunting. In addition, the descriptions of scent marks registered with the USPTO are relatively vague and a court may have difficulty enforcing the scent of “bubble gum,” “cherry,” “grape” or “strawberry.”

Suppose that Cheery Cherry’s president reads that test results show a forty percent improvement in our mood when we are exposed to a pleasant fragrance.¹²⁸ She promptly finds a perfumer who develops a palpable cherry scent that can be incorporated into scent strips for magazine advertisements. The company launches a multi-million dollar ad campaign built around the strips and the slogan “Follow Your Nose to Cheery Cherry—It Makes Good Scents!” Not to be outdone, Fuchsia Fine Wine and Liquors six months later comes up with grape scent strips for advertising its retail store services, featuring the slogan “Come Sniff The 2000 Bordeaux at Fuchsia!”¹²⁹

Angry Cheery Cherry executives hire a prominent trademark litigation law firm to protect their company’s rights. Ultimately, though, the parties agree to arbitrate the narrow issue of whether the Fuschia grape scent trademark is likely to cause confusion. They choose as arbitrator a Nose, Jacques Montand, from L’Alliance de Parfum Française, who is highly trained in detecting certain categories and types of scent. Cheery Cherry submits the

127. See *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 93, 57 U.S.P.Q.2d 1969 (2d Cir. 2001). Note, however, that a bill that has passed the House of Representatives provides that a famous mark is entitled to dilution protection where it is “distinctive, inherently or through acquired distinctiveness.” H.R. 683, 109th Cong. § 2 (2005). See § X. *infra* for more on dilution of nontraditional marks.

128. Lindstrom at 92.

129. The wine industry is conspicuous in its ability to identify and describe scents, and in the many colorful ways it can wax poetic. Young wines have an *aroma*, a smell often associated with grapes in general or those with a recognizable smell, such as the heady, perfumy Muscat. Over time in the cellar the wine aroma is replaced by its *bouquet*, the smell that develops through an aging and fermentation process. See Jeff Cox, *Cellaring Wine* 55-57 (2003). Cox describes opening a 1918 Haut-Brion and discovering “a bouquet of fine old leather, rose petals, tea, a bit of old tobacco, and many other lovely, if ineffable, aromas.” Perhaps the high point in scent identification came from sensory evaluation research conducted by now-retired Professor Ann Noble of the Department of Viticulture and Enology at the University of California at Davis, a school at the forefront of training winemakers and conducting wine industry research. See MaryAnn Worobiec Bovio, *The Degrees of Davis*, *Wine Spectator* 86 (July 31, 2005). Noble developed the influential Wine Aroma Wheel, reproduced in Cox at 233, a lexicon of wine aromas and beyond, widely used by consumers and in the industry. Her dominant category is “Fruity,” a descriptor that pervades Cox’s list of “Characteristic Varietal Wine Aromas” for white wines. For example, he describes Chardonnay and white Burgundies as “Fruity (apple, peach, citrus, pineapple), spicy (cloves), vanilla, butter,” and Sauvignon Blanc similarly. See also Maynard Amerine, *Wines: Their Sensory Evaluation* (1965).

report of a distinguished scientific expert based on the latest instrumentation in gas chromatography and the arrays of sensors comprising electronic noses. She concludes that the molecular structures and odor signatures are closely similar, and that most people would associate grape scent with the source of cherry scent. On the other hand, Fuschia submits the respective strip advertisements and the affidavits of two of its best wine customers, who claim that the scents are clearly distinguishable and that they would never associate grape with Cheery Cherry. Arbitrator Montand scoffs at the scientific report, ritualistically sniffs the respective strips, and rules unequivocally for Fuschia. There is no appeal.¹³⁰

IV. FLAVOR MARKS

Unlike sound and color marks, flavor marks have not yet caught on in the marketing community. Lindstrom acknowledges that incorporating the sense of taste into a brand is “tricky” but “brands that can incorporate taste can clearly build a very strong brand platform.”¹³¹ Many people could likely identify the distinctive flavors of Juicy Fruit gum, Gatorade or Coca-Cola, but the producers have not rushed out to register those flavors. Searching the USPTO’s database to clear the mark, then, will not give significant results; one must investigate the industry to determine whether similar products are flavored.

There is at present one pioneering flavor application pending before the USPTO. Filed on November 18, 2002, it seeks registration for “antidepressants in quick-dissolving tablets” where the mark is “an orange flavor.”¹³² In that case, a final Office Action denied registration on June 6, 2004, stating that the mark was a standard feature of the goods that would not be perceived as a source indicator and also that the mark was functional because it covered the medicinal taste of the pharmaceutical product. The applicant appealed the refusal to register and, as of this writing, the matter was before the Board.

One substantial impediment to enforcement of flavor marks is functionality. Certain flavors may be found to be functional

130. The authors are grateful for the assistance of Dr. Kathleen Martin of McCrane Associates, Inc., Westmont, IL, in the development of this paragraph. In her view, because scent is an olfactory phenomenon that triggers a sensory response, a trained human Nose is the most reliable judge of scent differences and similarities.

131. Lindstrom at 30.

132. Ser. No. 76467774. *But see* Clarke, *Issues in the Federal Registration of Flavors as Trademarks for Pharmaceutical Products*, 1993 U. Ill. L. Rev. 105 (arguing that “trademark status should not be granted to the flavors of pharmaceutical products” due to functionality concerns).

because they need to be available to the competition. Mint toothpaste for adults and bubble gum toothpaste for kids, for instance, are likely to be found functional because they are refreshing and appealing. Or those flavors may be found to be generic because they are used so frequently by different manufacturers. Courts are more likely to find flavor marks to be nonfunctional when they are added to products that are not meant to be consumed. For example, an unusual flavor—like melon or caramel or peanut butter—added to a toothbrush or dental floss would be more likely to be protected than the same flavors for cookies or bread if food manufacturers would be more likely to have a competitive need for flavors than those who make dental hygiene products.

Consumers may not see flavor in a product as a trademark. To them, it may be just another feature of the goods. Artichoke-flavored thermometers, for example, may be just another interesting invention and not one that indicates that the products come from a particular source. The penguin-shaped cocktail shaker casts a long shadow.

Flavor marks are almost certainly not protectable without acquired distinctiveness, just as color and scent marks cannot be inherently distinctive. This status puts such marks at a decided disadvantage in enforcement actions, particularly in dilution actions where the mark must be famous and not just distinctive.

V. TACTILE MARKS

The sensation of touch can be healing, relaxing, or stimulating. In terms of a brand, the feeling and textures of a product can play on a consumer's emotions and can also relate directly to his or her perception of quality.¹³³

To date, there are no known application or enforcement activities for tactile marks in the United States. Perhaps some enterprising marketer will attempt to overcome the functionality problem and register the sensation of bubble wrap for a soft drink, the sensation of fur for a perfume or the sensation of sandpaper for a computer printer.

VI. SOUND MARKS

Sound marks are probably the most memorable nontraditional trademarks. One's memory bank contains hundreds of melodies, songs and tone combinations. These are definitely capable of identifying and distinguishing goods and can be registered if

133. Lindstrom at 26-28, 86-88.

consumers associate them with the source of goods.¹³⁴ They can include musical tones, spoken or sung words, animal noises or any other sound. It is surprising that more are not registered.

Sound is “emotionally direct,” as Lindstrom notes.¹³⁵ Music can affect purchasers in stores and restaurants, just as the piped-in sound in Disney World can improve the mood of visitors.

There is nothing new about protecting audio marks. The granddaddy of all sound marks is the NBC chimes. First registered as a service mark for radio just after passage of the Lanham Act and later re-registered for television, the well-known mark is “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. . . .”¹³⁶ And in the twenty-first century, the Intel audio logo for computer hardware and software, microprocessors, integrated circuits and semiconductor devices has become widely-known and registered.¹³⁷ Here is just a sampling of some other sound marks registered with the USPTO:

- For software for notifying consumers of weather alerts, “a series of five chirps similar to the chirping sound of a cricket” (Reg. No. 2827972)
- For “Medicated transdermal patches, plasters, pads, gels and sprays for the temporary relief of the aches of rheumatoid arthritis,” “the word ‘HISAMITSU’ sung over the sound of four musical tones, e, a, e, and f sharp. The first three notes being quarter notes and the final note being a tied quarter and half note” (Reg. No. 2814082)
- For watches, non-metal key chains, cookie jars and Christmas tree ornaments and dolls, “the sound of a childlike human giggle which represents the Pillsbury Doughboy giggle” (Reg. No. 2692077)
- For canned and frozen vegetables, “the sound of a deep, male, human-like voice saying ‘Ho-Ho-Ho’ in even intervals with each ‘Ho’ dropping in pitch” (Reg. No. 2519203)
- For “automatic produce misting units for delivering a timed water mist to fruits and vegetables in display cases,” “the sounds of thunder and rain” (Reg. No. 2203470)

134. TMEP § 1202.15.

135. Lindstrom at 72.

136. Reg. No. 0916522. *See also* Reg. No. 0523616 (registered April 4, 1950) (not renewed).

137. Reg. No. 2315261 (“The mark consists of a five tone audio progression of the notes D FLAT, D FLAT, G, D FLAT and A FLAT.”).

- For insurance underwriting services, “the sound of a duck quacking the word ‘AFLAC’” (Reg. No. 2607415)
- For beer, “the sound of a howling wolf” (Reg. No. 2207874)
- For “Commercial and residential building construction; building repair; installation of siding,” “the sound of a kiss made when, for example, one is ‘blowing a kiss’ to another person, as exemplified in the sound recording included with this application” (Reg. No. 2524758)

Clearing sound marks will be challenging because there are so few in the USPTO database; many more are in use but their owners have not attempted to register them and there is no common law database of sound marks.¹³⁸ Therefore, sound marks may be the most difficult nontraditional, albeit the most recognizable, marks to clear. Search the USPTO TESS database for “sound” or “melody” or “music” or “musical” or “noise” or “audio” within the description of the marks to see some of the sound marks that are registered or have been applied for. Beyond that database, however, clearing a particular melody or sound will be quite difficult.

Melodies and songs are good candidates for registration and enforcement.¹³⁹ For example, “Sweet Georgia Brown,” the Harlem Globetrotters’ theme song, often accompanied by whistling and finger-snapping, is registered for “entertainment services in the nature of basketball exhibitions”¹⁴⁰ and has been associated with stars of yore such as Curly Neal and Sweetwater Clifton and the popular barnstorming team for decades. And segments of George Gershwin’s masterpiece “Rhapsody in Blue” have become, through consistent and substantial advertising over many years, intimately associated with United Air Lines. Melodies and musical arrangements often are or become source indicators when used as theme songs of radio or television programs or of performers. However, source indication must be proved. Just because the first four notes of Beethoven’s Fifth Symphony are widely recognized does not mean they are associated with any product or service, although they may become so.

Beethoven’s Fifth and noisy duck calls appear to have little in common, but they could both be classic nontraditional marks. However, a recent district court opinion determined that the sound of duck calls made during “amphibious tours” was not inherently

138. Cf. § II.C. for more on clearing nontraditional trademarks and using the USPTO’s TESS database.

139. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61, 58 U.S.P.Q.2d 1767 (2d Cir. 2001) (holding that musical compositions may serve as trademarks).

140. Reg. No. 1700895.

distinctive and lacked secondary meaning.¹⁴¹ The plaintiffs in that case own a registration for “a quacking noise made by tour guides and tour participants by use of duck call devices throughout various portions of the tours.” The services for which the mark is registered are “tour guide services over land and water by amphibious vehicles.”¹⁴² In denying a motion for a preliminary injunction, the court relied on the Trademark Trial and Appeal Board’s vintage *General Electric* decision in holding that the sound of quacking was too familiar a noise to qualify as inherently distinctive.¹⁴³ The court went on to find that the plaintiffs had not used the mark long enough for it to have achieved secondary meaning, that their advertising did not emphasize the sound mark and that they “presented no evidence that a person apprehending a quacking noise on the streets of Philadelphia would reflexively think of the services provided by [plaintiffs].” One can only envision with wonderment a consumer survey interviewer stopping Philadelphia citizens on Broad Street and inquiring of their quacking noise association, if any.

Still, the duck noisemaker case is an important case of first impression. To date there is no other reported case involving a claim of sound trademark infringement, and even though it was not decided after trial on the merits the court’s handling of the issues is likely to be influential as future such cases develop. The case also gives new authority to the Board’s differentiation between sound marks and typical marks that are applied directly to goods: a sound mark “depends upon aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck.”¹⁴⁴

Sound marks that are unique or different may be registered on the Principal Register without evidence of acquired distinctiveness, but sounds “that resemble or imitate ‘commonplace’ sounds or those to which listeners have been exposed under different circumstances” must, in order to be registered, be accompanied by evidence that purchasers or prospective purchasers recognize the sound and associate it with a

141. *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, 2005 U.S. Dist. LEXIS 4422 (E.D. Pa. Mar. 21, 2005). A duck was an amphibious military truck in World War II. American Heritage Dictionary of the English Language 552 (4th ed. 2000).

142. Reg. No. 2484276.

143. *Ride the Ducks*, 2005 U.S. Dist. LEXIS 4422, *21, citing *In re General Electric Broadcasting Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978).

144. *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978).

single source.¹⁴⁵ This distinction is similar to the categorization of word marks, from generic to fanciful. In one case, the Board required evidence that the sound of a ship's bell had become distinctive to the average person and identified and distinguished the applicant's radio broadcasting services "to those exposed to such services."¹⁴⁶

Applicants for sound marks need not submit a drawing of the mark,¹⁴⁷ but may submit audio cassettes, compact disks or a musical score as specimens.¹⁴⁸ In addition, where the sound mark is comprised of music or words set to music, applicants may submit the specimen in .wav format. Because .wav files cannot be sent as an attachment to a TEAS filing, the applicant must send a .wav file after filing the application, as an attachment to an e-mail message to TEAS@uspto.gov, with instructions that the .wav file should be associated with "the application filed under Serial No. ____."¹⁴⁹ Applicants must also describe the sound mark clearly on the application.¹⁵⁰

In an infringement case, sound marks will fare just as regular word and logo marks. Courts will likely find the highly distinctive ones to be stronger and the more commonplace ones to be weaker just as the court in the duck noisemaker case found that the sound of a duck quacking was too familiar to be inherently distinctive.¹⁵¹ Courts should be able to categorize and compare sound marks just as they do for more traditional marks. Note that enforcement of musical sound marks may also raise a copyright infringement claim along with the trademark or service mark infringement claim, and that copyright claims carry statutory penalties that trademark law (except for counterfeiting) does not have.¹⁵²

Dilution claims are going to be difficult for those sound marks that lack acquired distinctiveness. As for the others, however, a plaintiff may show that they are famous just as distinctive word and logo marks are. The NBC chimes, and Intel's audio logo, for example, are surely famous under dilution standards, and the use

145. *Id.*

146. *Id.*

147. 37 C.F.R. § 2.52(a)(3), TMEP §§ 807.09, 1202.15.

148. 37 C.F.R. § 2.56(d)(3); TMEP § 1202.15. Specimens for the AFLAC duck sound and the kiss sound for building construction, for example, are each presented on a cassette tape.

149. TMEP § 904.02(a).

150. *Kawasaki Motors Corp. v. H-D Michigan, Inc.*, 43 U.S.P.Q.2d 1521 (T.T.A.B. 1997) ("[W]hen registration of a sound mark is sought, the sound itself is not on the copy of the drawing sheet . . . nor will the sound be on the registration certificate that may eventually issue. Thus, the description of the sound is the only means for presenting, in any printed record, the essence of the mark.").

151. *Ride the Ducks*, 2005 U.S. Dist. LEXIS 4422.

152. *See* 17 U.S.C. § 504(c)(1).

of an identical or very similar sound mark could well dilute the distinctive quality of the chimes or the audio logo.

VII. MOTION MARKS

A trademark may identify and distinguish goods by using images in motion, perhaps on a television, movie or computer screen.¹⁵³ These marks are typically the closest to traditional logo marks of all the nontraditional trademarks; they just add the dimension of movement.

The USPTO has registered several motion marks, including the following:

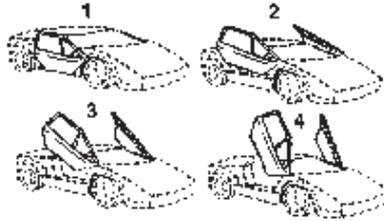
- For high intensity search lights, the mark “consists of a pre-programmed rotating sequence of a plurality of high intensity columns of light projected into the sky to locate a source at the base thereof” (Reg. No. 2323892)
- For banking services, the mark “consists of the numeral ‘0’ that begins as a whole frame and shrinks into the size of a number on a bank check and grows to a full size frame on the screen” (Reg. No. 2756210)
- For “promoting public awareness of the negative effects of smoking,” the mark “consists of a stylized capital letter ‘Y’ within a loosely defined circle orbited clockwise by a second, smaller, loosely defined circle containing a stylized question mark.” (Reg. No. 2709214) The following is the drawing for the mark:



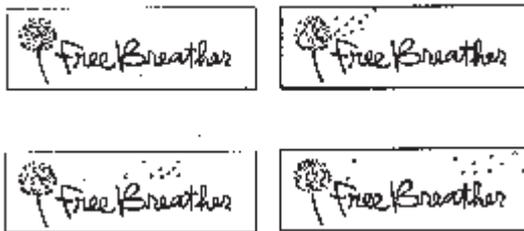
- For automobiles, the mark “consists of the unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised

153. For a suggestion that goes beyond the outer limits of motion mark protection, see Kunststadt et al., *Are Sports Moves Next in IP Law?* Nat'l L.J. (May 20, 1996), C1 (arguing that “trademark rights also might extend to protect a three-dimensional, real-time movement of a sports figure”).

above the vehicle to a parallel position.”¹⁵⁴ (Reg. No. 2793439) The following is the drawing for the mark:



- For “providing an information service on the subjects of asthma and allergies via . . . the internet,” the mark “consists of the stylized words ‘FREE BREATHER’ appearing in a fixed position on the right side of the logo, with a fanciful representation of a dandelion flower in its ‘puff ball’ stage of life, on the left side of the logo. The motion feature of the mark consists of the individual seeds dispersing off the puff ball several at a time in a wind blown effect over the words. The drawing consists of four freeze frames showing the mark at various points in its movement.” (Reg. No. 2708718) The following is the drawing for the mark:



- For telecommunications services, the mark “consists of a pair of stylized eyes that move horizontally back and forth. The drawing consists of four freeze frames showing the mark at various points in its movement, pursuant to 37 C.F.R. 2.52(a)(2)(iv).”¹⁵⁵ (Reg. No. 2490649) The following is the drawing for the mark:



154. The specimens for this mark consist of photographs showing the door opening in motion.

155. The specimens for this mark are Internet screen shots depicting the mark at various points in its movement. 37 C.F.R. § 2.52.

The most attention-getting and funniest registered motion mark is for hotel services. The mark “consists of the live visual and motion elements of The Peabody Duck March as performed at The Peabody Hotels.” Is it possible to imagine a more distinctive mark? “The motion elements include the red carpet being rolled out, the appearance of the ducks and uniformed Duckmaster at the elevator door, and the march of the ducks down the red carpet, up the steps, and into the fountain where they begin swimming. The mark also includes the fanfare in reverse sequence.”¹⁵⁶

Clearance of motion trademarks will generally be similar to clearance for traditional logo trademarks. A trademark search firm can search the USPTO database in the description of the mark for the features of the proposed motion mark just as one would search for a logo mark, using a verbal description and the design search codes. As with the other nontraditional trademarks, there is no common law database for motion marks.

According to Rule 2.52(3), applicants must describe the motion mark as well as provide a drawing that either shows a single point in the movement or “up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark.”¹⁵⁷

Enforcing motion marks in infringement and dilution cases should be much like enforcing traditional word and logo marks. The very distinctive marks will be more likely to prevail in a likelihood of confusion claim and plaintiffs will be able to show that a given motion mark is famous if it meets dilution law criteria.

VIII. THREE-DIMENSIONAL MARKS

Three-dimensional product shapes and product packaging are protected under the Lanham Act as trade dress, which means the total image of a product, or even a service.¹⁵⁸ Trade dress can include product features such as design, size, shape, color, labels or graphics, or service features such as retail decor, architectural

156. Reg. No. 2710415. The specimens for this mark are still photos of different stages of the Duck March. In the application, the applicant also referred the Examiner to its website to view a video clip of the Duck March (the video is no longer on that site, but another video appears at www.peabodyorlando.com/asp/meT_duckMarch.asp?page=DuckMarch). The Peabody Orlando is advertised as “Orlando’s Only 5-Duck Meeting Hotel.” See also www.peabodymemphis.com and www.peabodylittlerock.com for more promotion of this mark.

157. 37 C.F.R. § 2.52(3); TMEP § 807.11.

158. Lindstrom gives as examples of distinctive product shapes Hershey’s Kisses, Toblerone candy bars and the Beetle (85-86), and he ranks the Coca-Cola bottle and Absolut vodka bottles as classics of distinctive packaging (39-40, 48).

features, menu and layout.¹⁵⁹ Protection and enforcement of trade dress is now fully accepted by the courts and trade dress is swiftly becoming less of a nontraditional trademark. Where trade dress is functional, it will not be protected; the owner of unregistered trade dress must prove in court that its trade dress is nonfunctional.¹⁶⁰

Clearance of trade dress is confined to federal applications and registrations; there are currently no reliable databases of common law trade dress. Trademark search firms will search the USPTO TESS database using design search codes that correspond to specific design elements. In addition, the TMEP requires applicants to include in their description of the mark an indication that the mark is three-dimensional,¹⁶¹ so one can search mark descriptions for that word as well.

In order to register a three-dimensional mark, an applicant must submit a special form drawing.¹⁶² The drawing “must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.”¹⁶³ The applicant should submit a drawing that depicts the mark in three dimensions.¹⁶⁴

A. Product Shapes

The owner of a nonfunctional unregistered product design or configuration mark must still show that it has attained secondary meaning under the Supreme Court’s holding that product designs are not inherently distinctive.¹⁶⁵ In *Wal-Mart Stores*, the Court emphasized that consumers believe that even the most uncommon product design, “such as a cocktail shaker shaped like a penguin,” is meant to make the product itself more appealing or useful rather than to identify its source.¹⁶⁶

Note that design patents may be granted for any new and nonobvious ornamental product design. They protect the item’s appearance from being copied by others for their fourteen-year

159. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7] for a full treatment of trade dress protection.

160. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][f] for more on trade dress functionality, including burden of proof, the relevance of expired utility patents and aesthetic functionality.

161. TMEP § 807.10.

162. 37 C.F.R. § 2.52(b).

163. 37 C.F.R. § 2.52(b)(2); TMEP § 807.10.

164. *In re Schaefer Marine, Inc.*, 223 U.S.P.Q. 170 (T.T.A.B. 1984) (finding drawing submitted “inadequate” because it is a two-dimensional representation where the applicant sought to register a three-dimensional configuration).

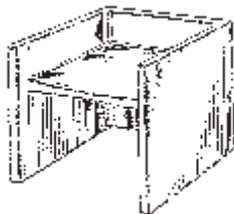
165. *Wal-Mart Stores, Inc.*, 529 U.S. 205. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][d] for more on inherent distinctiveness of product designs.

166. *Wal-Mart Stores*, 529 U.S. at 213.

terms.¹⁶⁷ They may cover the shape or configuration of a product, its surface ornamentation, or a combination of the two.¹⁶⁸

Many three-dimensional product shapes are registered as trademarks with the USPTO. For example:

- Registered for children's desks and chairs (Reg. No. 2903181):



- Registered for a desk chair (Reg. No. 2754826):



- Registered for pet food (Reg. No. 2833430) (Supplemental Register):



- Registered for bakery goods where the mark "consists of a cylindrical configuration of a cinnamon roll having a height of about two and one-half inches and a width of about four

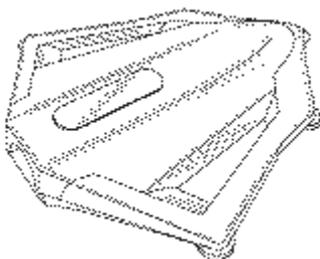
167. 35 U.S.C. §§ 171, 173.

168. See www.uspto.gov/web/patents/types.htm.

inches; and having a spiral wrap of five and one-half to six and one-half layers of baked dough with a melted cinnamon/brown sugar/margarine layer between overlapping portions of the wrap, with the inner portion of the wrap being slightly elevated above the outer portions of the wrap, and with the top and portions of the side of the wrap being covered by melted frosting” (Reg. No. 2098432):



- Registered for “AUTOMATIC POOL CLEANERS” where the mark “consists of the three-dimensional configuration of an automatic pool cleaner” (Reg. No. 2860058):



- Registered for shoes where the mark “consists of A THREE-DIMENSIONAL SHOE CONFIGURATION AS SHOWN. THE DOTTED LINES ARE NOT PART OF THE MARK BUT MERELY INDICATE THE POSITION OF THE SHOELACES” (Reg. No. 2827576):



B. Product Packaging

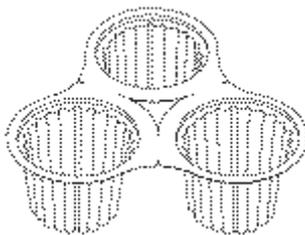
An applicant seeking a trademark registration for product packaging must prove either that the trade dress is inherently

distinctive or has attained secondary meaning and that it is not functional.¹⁶⁹

- Registered for firewood where the mark “consists of the trade dress characterizing the packaging for the applicant’s wood fuel . . . products, namely, a natural fiber bag with characteristic natural coloring, fabric texture, and irregular shape when filled, with string or ribbon tying the neck of the bag, with package tag affixed via string or ribbon” (Reg. No. 2915965):



- Registered for milk, cheese and other dairy products where the mark “consists of a configuration of the packaging for the goods of this application containing a three-sided base configuration having three equal cup portions with ribbed side walls” (Reg. No. 2908255):

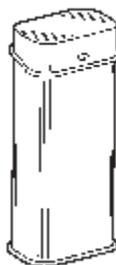


- Registered for bath oil, lip gloss, moisturizing cream, astringents, eye make-up remover, hair gel, perfumery and cosmetics, among others, where the mark “consists of the shape of the packaging in which the goods are packaged and sold, such design consisting of the outline of two human feet” (Reg. No. 2900547):

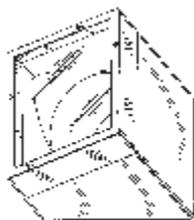
169. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][d] for more on inherent distinctiveness of product packaging and § 7.02[7][f] for more on the functionality of trade dress.



- Registered for chewing gum where the mark “consists of the configuration of a cylindrical tin can for use as packaging for the goods” (Reg. No. 2596381):



- Registered for watches where the mark “consists of the overall design of packaging for watches” (Reg. No. 2898342):



C. Buildings

Architectural trade dress is protectable when distinctive and nonfunctional, and often acts as a service mark for franchises.¹⁷⁰

170. For more on architectural trade dress, see Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][h]. See also *New York Stock Exchange, Inc. v. New York, New York Hotel, LLC*, 293 F.3d 550 (2d Cir. 2002); *Rock 'N Roll Hall of Fame and Museum, Inc. v. Gentile Productions*, 134 F.3d 749 (6th Cir. 1998); Christ, *Edifice Complex: Protecting Landmark Buildings as Intellectual Property—A Critique of Available Protections and a*

Owners of landmark buildings are also getting in on the action, registering those buildings as service marks (see the Wrigley Building, the Chrysler Building and the Space Needle, below). Note that these landmarks are not registered as marks for the buildings themselves, so one with a trademark registration of a landmark building should not expect automatically to prevent the building of a look-alike. A court would still have to look at the functionality factors and the likelihood of confusion factors to determine if there would be consumer confusion. If the building were sufficiently famous, like perhaps a traditional McDonald's restaurant, the owner might be able to stop someone from erecting a very similar building, even if it were an office building and not a restaurant, because it could dilute the famous mark.

Buildings are registered for services such as the following:

- Registered for restaurant services (Reg. No. 1045615) (McDonald's restaurant):



- Registered for “social clubs; providing banquet and social function facilities for special occasions” (Reg. No. 2037109) (Wrigley building, Chicago, IL):



- Registered for “leasing office space and attendant services to tenants” (Reg. No. 11268880) (Chrysler building, New York, NY):



- Registered for motel services where the mark “consists of the configuration of the exterior building design of a motel featuring a buttress comprised of flared corners and columns” (Reg. No. 2908230) (Baymont Inns):

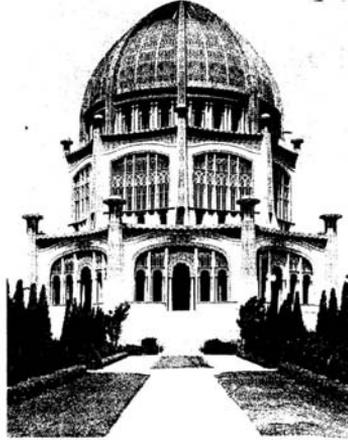


- Registered for restaurant services “and providing banquet facilities for special occasions” where the mark “consists of the architectural design of the building in which the services are provided” (Reg. No. 2775235) (Space Needle, Seattle, WA):



And building representations may also be registered for goods:

- Registered for publications, “namely, books, pamphlets, house organs, and circulars” (Reg. No. 0798811) (Baha’i House of Worship, Wilmette, IL):



D. Decor

Restaurant and other retail decor may be protectable trade dress.¹⁷¹ For example, the Ninth Circuit upheld an injunction prohibiting use by competitors of the following combination of a restaurant’s elements: (1) Broadway font for logo, advertising, promotions, souvenirs or menus; (2) red and white with green accents as predominant in advertising, promotions, souvenirs or decor; (3) Broadway show posters as a predominant feature of decor; and (4) stage or movie style lighting fixtures in its decor.¹⁷²

IX. SALES TECHNIQUES

Trade dress “involves the total image of a product and may include features such as size, shape, color or color combinations,

171. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (finding proof of secondary meaning not required where restaurant trade dress was inherently distinctive); *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257, 58 U.S.P.Q.2d 1881 (9th Cir. 2001) (“It is well settled that restaurants and similar establishments may have a total visual appearance that constitutes protectable trade dress.”). See also Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 7.02[7][h][v] for more on restaurant trade dress.

172. *Jerry’s Famous Deli, Inc. v. Papanicolaou*, 383 F.3d 998, 1002 (9th Cir. 2004). See also *Prufrock, Ltd. v. Lasater*, 781 F.2d 129, 132, 228 U.S.P.Q. 435 (8th Cir. 1986) (“A restaurant’s trade dress can include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior floor plan, the appointments and decor items, the equipment used to serve the food, and the servers’ uniforms.”) (citations omitted).

texture, graphics, or even particular sales techniques.”¹⁷³ For example, adoption procedures for Cabbage Patch Dolls were found to be protectable trade dress¹⁷⁴ as were the layout and overall appearance of mail-order catalogs¹⁷⁵ and a sales brochure, car service reminder letters and the “combination and arrangement” of features in a sales report.¹⁷⁶ Advertisements for sunglasses with actors posing as vampires—and other vampire-related marketing—were found to be protectable trade dress,¹⁷⁷ as was the overall image of Marlboro cigarette advertising.¹⁷⁸

Even in this broad scheme there are limits. The contents of an advertisement for vacuum cleaners were found not to be trade dress,¹⁷⁹ and the use of a Scandinavian theme to market premium ice cream was not protectable.¹⁸⁰ The Eighth Circuit refused to protect the idea of informal country dining as the overall theme for

173. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983), quoted by, e.g., *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 808 n.13, 69 U.S.P.Q.2d 1257 (9th Cir. 2003); *Superformance, Int'l, Inc. v. Hartford Casualty Insurance Co.*, 332 F.3d 215, 223, n.*, 67 U.S.P.Q.2d 1040 (4th Cir. 2003); *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 977, 64 U.S.P.Q.2d 1321 (10th Cir. 2002); *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 629, 61 U.S.P.Q.2d 1769 (6th Cir. 2002); *Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 171, 57 U.S.P.Q.2d 1125 (3d Cir. 2000); *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 636, 52 U.S.P.Q.2d 1035 (7th Cir. 1999); *Pebble Beach Co. v. Tour 19 I Ltd.*, 155 F.3d 526, 536, 48 U.S.P.Q.2d 1065 (5th Cir. 1998).

174. *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 215 U.S.P.Q. 745 (11th Cir. 1982).

175. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 632-33, 61 U.S.P.Q.2d 1769 (6th Cir. 2002) (“[T]he Quarterly is an item containing a specific method of presenting products in conjunction with an identifiable photographic motif and editorial content addressing a lifestyle consistent with—perhaps spawning a lifestyle emulative of—the image Abercrombie intentionally associates with its clothing. We regard the configuration of the catalog as trade dress because the Quarterly is a freestanding product that has its own trade dress, an objectively observable ‘particular sales technique’ used to sell clothing, or packaging of the products it depicts.”); *Tools USA & Equip. Co. v. Champ Frame Straightening Equip.*, 87 F.3d 654, 39 U.S.P.Q.2d 1355 (4th Cir. 1996).

But see *Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244, 15 U.S.P.Q.2d 1053 (8th Cir. 1990) (finding elements of magazine and magazine subscription solicitation mailer do not constitute protectable trade dress).

176. *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063, 25 U.S.P.Q.2d 1020 (7th Cir. 1992).

177. *Kleck v. Bausch & Lomb, Inc.*, 145 F. Supp. 2d 819 (W.D. Tex. 2000).

178. *Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379, 383, 35 U.S.P.Q.2d 1178 (S.D.N.Y. 1995) (trade dress in advertisements of plaintiff’s Marlboro cigarettes, evoking the American West through “Marlboro Country” and “Marlboro Man” images, was inherently distinctive and protectable).

179. *Murphy v. Provident Mutual Life Ins. Co.*, 923 F.2d 923, 929, 17 U.S.P.Q.2d 1299 (2d Cir. 1990) (“Although in a proper case a particular sales technique might be treated as part of a product’s trade dress, the contents of Murphy’s advertisements, standing alone, cannot be considered as trade dress for his services.”) (citation omitted).

180. *Haagen-Dazs, Inc. v. Frusen Gladje, Ltd.*, 493 F. Supp. 73, 210 U.S.P.Q. 204 (S.D.N.Y. 1980).

a restaurant,¹⁸¹ and in the *Abercrombie & Fitch* case the Sixth Circuit declared that even a broad reading of trade dress protection

should not be taken to mean that a company can protect a product's marketing theme or any other incorporeal aspects of the good incapable of being perceived by the senses. The aura about a product, the cachet that ownership or display of it creates, and the kind of appeal it has to certain consumers do not dress a good in trade. Rather, those intangible "things" emanate from the good, its dress, and the marketing campaign that promotes the dressed good. Trade dress is tangible or otherwise objectively observable by the senses; its constitution is a matter of subjective interpretation.¹⁸²

Only concrete expressions of general marketing schemes may be protectable—if they are distinctive and not functional, that is.¹⁸³

X. DILUTION OF NONTRADITIONAL TRADEMARKS

If they are famous, nontraditional trademarks may be eligible for dilution protection, but they face some obstacles that word marks and logos do not.¹⁸⁴ A showing of fame for purposes of the federal dilution law must be quite strong.¹⁸⁵ For many nontraditional trademarks, it may be difficult for consumers to recognize that they are, in fact, trademarks, rather than decoration or an appealing aspect of the product, particularly color, scent, flavor or three-dimensional product designs like the penguin-shaped cocktail shaker.

181. *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 131-32, 228 U.S.P.Q. 435 (8th Cir. 1986) ("A franchisor does not have a business interest capable of protection in the mere method and style of doing business."). See also Restatement (Third) of Unfair Competition § 16, cmt. a ("Although sales techniques that contribute to the 'image' of a product are sometimes protected as trade dress, courts do not permit the monopolization of general marketing schemes.").

182. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 630-31, 61 U.S.P.Q.2d 1769 (6th Cir. 2002). See also *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868, 31 U.S.P.Q.2d 1481 (8th Cir. 1994) ("Trade dress is the 'total image of a product, the overall impression created, not the individual features.' But the mere method and style of doing business is not protectable. . . . Trade dress does not protect one from a competitor's imitation of one's marketing concept.") (citations omitted).

183. See *Abercrombie & Fitch*, 280 F.3d at 633 ("[We] do not mean to suggest that Abercrombie can acquire a monopoly on being 'cool' or 'hip' in a certain manner. The 'image' . . . is visual, e.g., the shape of a Ferrari Daytona, rather than conceptual, e.g., a notion of unimpeded swiftness associated with an aerodynamic auto body design or a notion of 'coolness,' trendiness, or 'hipness' predominant in the zeitgeist.").

184. For a full discussion of dilution law, see Gilson & LaLonde, 2 *Trademark Protection and Practice*, Chapter 5A.

185. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5A.01[4][a].

In order to merit dilution protection, a trademark must be distinctive at the outset. The Second Circuit alone holds that only marks with *inherent* distinctiveness are eligible for dilution protection.¹⁸⁶ However, a bill that passed the House of Representatives on April 19, 2005 would overrule the Second Circuit's opinion; it provides that "the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction" when another's mark is likely to cause dilution.¹⁸⁷ Nevertheless, nontraditional trademarks that cannot be inherently distinctive—color, scent, product designs, some sound marks and probably flavor—cannot currently receive dilution protection in the Second Circuit. And no matter what the outcome of the pending legislation, those marks would not have an easy time of it in any circuit; the basis of a dilution cause of action is the claim that the defendant's actions cause dilution "of the distinctive quality of the mark,"¹⁸⁸ so it is critical to be able to demonstrate the mark's distinctiveness.¹⁸⁹ While the Supreme Court did not explicitly answer the question of whether inherent distinctiveness is required for dilution protection, it did indirectly suggest, in a lengthy footnote, that arbitrary marks should be given a greater degree of dilution protection than descriptive terms that have acquired distinctiveness.¹⁹⁰

The owner of trade dress may face a unique obstacle to dilution protection in the Seventh Circuit, which has suggested that the Federal Trademark Dilution Act may not apply to trade dress. It did not address the question head on because the issue had not been before the district court, but it concluded that it could *not* say "that the contention that the statute is inapplicable to trade dress is totally without merit."¹⁹¹

Ultimately, just as the owner of a logo or word mark, the owner of the nontraditional trademark would have to show, for dilution protection, that consumers had changed the mental

186. *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 93, 57 U.S.P.Q.2d 1969 (2d Cir. 2001). See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5A.01[4][c][i][B] for more on whether a mark with acquired distinctiveness can be famous.

187. H.R. 683, 109th Cong. § 2 (2005).

188. 15 U.S.C. § 1125(c)(1).

189. The First, Second and Fifth Circuits all require a showing of distinctiveness as a separate element from fame. *TCPIP Holding Co.*, 244 F.3d at 93; *Advantage Rent-A-Car, Inc. v. Enterprise Rent-A-Car Co.*, 238 F.3d 378, 380, 57 U.S.P.Q.2d 1561 (5th Cir. 2001); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 46, 49 U.S.P.Q.2d 1225 (1st Cir. 1998). The First Circuit also makes clear its reluctance to find that distinctiveness based on secondary meaning would suffice for dilution protection. *Id.*

190. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 n.10 (2003). See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5A.01[4][c][i][B].

191. *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 639, 52 U.S.P.Q.2d 1035 (7th Cir. 1999).

conception they had of the famous mark and associate the famous mark “less strongly or exclusively” with the goods connected to the famous mark.¹⁹² This showing is extremely demanding for any mark.

XI. CONCLUSION

Nontraditional trademarks pose not only challenges but also opportunities. The *Qualitex* “anything goes” doctrine has had an enormous impact on the USPTO, which has broadly interpreted the Supreme Court’s message and granted numerous registrations for types of trademarks that are not always initially recognized as marks.

As a means of strengthening their intellectual property rights and enlarging their trademark portfolios, businesses would do well to scour their products, services and advertising and marketing programs for nontraditional marks to be registered. They might also follow the Lindstrom admonition and encourage their marketing teams to explore the cutting edge world of multisensory branding. And even though few at present use scent, flavor or color alone as marketing tools, they often use musical themes or jingles in advertising. Why not register?

Nontraditional marks can stir the imagination, and many (like marching ducks, duck calls and scented exhaust fumes) are just plain funny. If consumers in fact see these as trademarks they are registrable and protectable, although future courts and the Trademark Trial and Appeal Board will have to agree. Such marks can be or can become strong, memorable and long-lasting. Moreover, the difficulties of proving that consumers do not view them simply as unusual product features or as marketing gimmicks may be overcome as the public becomes more trademark-educated over time. Who knows? Some day martini connoisseurs may find that penguin-shaped cocktail shakers come from a single, though anonymous, source.

192. *Moseley*, 537 U.S. at 434. See Gilson & LaLonde, 2 *Trademark Protection and Practice*, § 5A.01[7][a] for more on proof of actual dilution. The bill that passed the House of Representatives would not limit relief to marks harmed by actual dilution; it would allow a court to grant injunctive relief where another mark was merely “likely to cause dilution.” H.R. 683, 109th Cong. § 2 (2005).

APPENDIX A

**Excerpt from *Qualitex Company v.
Jacobson Products Company*, 514 U.S. 159 (1995)**

JUSTICE BREYER delivered the opinion of the Court.

The question in this case is whether the Trademark Act of 1946 (Lanham Act) . . . permits the registration of a trademark that consists, purely and simply, of a color. We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.

I

The case before us grows out of petitioner Qualitex Company's use (since the 1950's) of a special shade of green-gold color on the pads that it makes and sells to dry cleaning firms for use on dry cleaning presses. In 1989, respondent Jacobson Products (a Qualitex rival) began to sell its own press pads to dry cleaning firms; and it colored those pads a similar green-gold. In 1991, Qualitex registered the special green-gold color on press pads with the Patent and Trademark Office as a trademark. . . . Qualitex subsequently added a trademark infringement count, 15 U.S.C. § 1114(1), to an unfair competition claim, § 1125(a), in a lawsuit it had already filed challenging Jacobson's use of the green-gold color.

Qualitex won the lawsuit in the District Court. . . . But, the Court of Appeals for the Ninth Circuit set aside the judgment in Qualitex's favor on the trademark infringement claim. . . .

[T]his Court granted certiorari. . . . We now hold that there is no rule absolutely barring the use of color alone, and we reverse the judgment of the Ninth Circuit.

II

The Lanham Act gives a seller or producer the exclusive right to "register" a trademark, 15 U.S.C. § 1052 (1988 ed. and Supp. V), and to prevent his or her competitors from using that trademark, § 1114(1). Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks "include any word, name, symbol, or device, or any combination thereof." § 1127. Since human beings might use as a "symbol" or "device" almost anything at all that is

capable of carrying meaning, this language, read literally, is not restrictive. The courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread). . . . If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?

A color is also capable of satisfying the more important part of the statutory definition of a trademark, which requires that a person "use" or "intend to use" the mark "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127.

True, a product's color is unlike "fanciful," "arbitrary," or "suggestive" words or designs, which almost *automatically* tell a customer that they refer to a brand. . . . The imaginary word "Suntost," or the words "Suntost Marmalade," on a jar of orange jam immediately would signal a brand or a product "source"; the jam's orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—*i.e.*, "to indicate" their "source"—much in the way that descriptive words on a product (say, "Trim" on nail clippers or "Car-Freshner" on deodorizer) can come to indicate a product's origin. . . . In this circumstance, trademark law says that the word (*e.g.*, "Trim"), although not inherently distinctive, has developed "secondary meaning." . . . Again, one might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same?

We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained "secondary meaning" and therefore identifies and distinguishes a particular brand (and thus indicates its "source"). . . . It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes. . . . And, for that reason, it is difficult to find, in basic trademark objectives, a reason to disqualify absolutely the use of a color as a mark.

Neither can we find a principled objection to the use of color as a mark in the important "functionality" doctrine of trademark law. The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to

control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). . . . Functionality doctrine therefore would require, to take an imaginary example, that even if customers have come to identify the special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition—not by protecting the reputation of the original bulb maker, but by frustrating competitors' legitimate efforts to produce an equivalent illumination-enhancing bulb. . . . This Court consequently has explained that, "in general terms, a product feature is functional," and cannot serve as a trademark, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. . . . Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not. And, this latter fact—the fact that sometimes color is not essential to a product's use or purpose and does not affect cost or quality—indicates that the doctrine of "functionality" does not create an absolute bar to the use of color alone as a mark. . . .

It would seem, then, that color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function. . . . Indeed, the District Court, in this case, entered findings (accepted by the Ninth Circuit) that show Qualitex's green-gold press pad color has met these requirements. The green-gold color acts as a symbol. Having developed secondary meaning (for customers identified the green-gold color as Qualitex's), it identifies the press pads' source. And, the green-gold color serves no other function. (Although it is important to use *some* color on press pads to avoid noticeable stains, the court found "no competitive need in the press pad industry for the green-gold color, since other colors are equally usable." . . . Accordingly, unless there is some special reason that convincingly militates against the use of color alone as a trademark, trademark law would protect Qualitex's use of the green-gold color on its press pads.

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IV

Having determined that a color may sometimes meet the basic legal requirements for use as a trademark and that respondent Jacobson's arguments do not justify a special legal rule preventing color alone from serving as a trademark (and, in light of the District Court's here undisputed findings that Qualitex's use of the green-gold color on its press pads meets the basic trademark requirements), we conclude that the Ninth Circuit erred in barring Qualitex's use of color as a trademark. For these reasons, the judgment of the Ninth Circuit is

Reversed.

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