

Report Q181

in the name of the United States Group
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Conditions for registration and scope of protection of non-conventional trademarks

Introduction

The United States of America has a broad and flexible approach to the registration and protection of “non-conventional” trademarks and service marks. Any word, name, symbol or device that is used in trade with goods or services to indicate their source and distinguish them from the goods or services of others is eligible for protection. Accordingly, the limits of what can be considered either a proper trademark or service mark are significantly broader than in many jurisdictions. Nevertheless, prospective users of non-conventional marks still face various challenges both securing protection for their marks and seeking to enforce their rights against others. While some of the obstacles facing these prospective users are amplified, such as non-functionality, the majority are often identical to those faced by users of traditional marks, namely, descriptiveness, and genericness.

Questions

1. *How is the scope of what constitutes a registrable trademark defined? Does that definition list specific examples of permissible types of trademark?*

A trademark is defined, under 15 USC §1127, as “any word, name, symbol, or device, or any combination thereof - (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, 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.” Accordingly, the definition provides guidance as to which types of marks are registrable, namely, words, names, symbols or devices, yet does not provide specific examples therefor.

2. *What categories of signs are capable of registration as a trademark? Are any categories of signs excluded from registrability as a trademark?*

As noted above, words, names, symbols and devices are the defined categories of signs that are capable of registration as a trademark. While U.S. regulations do not exclude specific *categories* of signs from eligibility for protection, there are specific prohibitions against registration of marks that do not function as trademarks, such as trade names, functional indicia, ornamental marks, informational marks, goods in trade, columns or sections of publications, titles of single creative works, names of artists and authors, model or grade designations, background designs and shapes, and varietal and cultivar names, as well as geographic designations, surnames, flags, coats of arms, insignia of the United States, states, municipalities and foreign nations. See, generally Trademark Manual of Examining Procedure (“TMEP”), §1200.

3. *Where applications to register a colour per se or a combination of colours per se may be accepted for registration:*

As color marks are never considered inherently distinctive, they can only be registered on the Supplemental Register unless the applicant can make a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Color per se trademarks are protectable if there is required distinctiveness proven. See *Qualitex v. Jacobson Products*, 514 U.S. 159 (U.S. Supreme Court, 1995).

3.1 *In relation to goods, is such an application acceptable if it does not specify the outline, contours or proportions in which or the shape or object to which the colour is to be applied?*

Generally speaking, yes, all marks, other than sound and scent marks, require a drawing. An applicant must provide a substantially exact representation of the object on which the color is used or intended to be used on the goods. 37 C.F.R. §2.51. The drawing should appear in broken lines to show where and how color is used on the product or package and the applicant should indicate that the shape of the product, or the shape of the package, is not claimed as part of the mark. That being said, if a color is to be applied to different but similar goods, an applicant may rely on a drawing of only one of the goods if the goods, or the portions of the goods on which color appears, are similar enough in form and function that one picture is sufficient to provide a substantially exact representation of the mark as used on all of the products.

The Trademark Manual of Examining Procedure (TMEP) provides the following example, “if the mark is the color purple used on refrigerators and freezers, a drawing of a freezer (in broken lines, with a description of the mark indicating the color purple is used on the mark) would be sufficient. Or, if the mark is the color pink used on the handles of rakes, shovels and hoes, a drawing of any of those items (in dotted lines with a description of the mark stating the handle is pink) would be sufficient. Or, if the mark consists of packaging for various food items that is always blue with a pink circle, a drawing of any one of the packages (in dotted lines with a description of the colors) would be sufficient.”

Finally, if the mark is used on unrelated goods, the applicant must file multiple applications with different drawings, each of which is a substantially exact representation of the mark as used on each of the goods.

3.2 *Is such an application registrable in relation to services and, if so, under what conditions?*

Yes, however, no service mark registrations have issued for a single color per se. While applicants have attempted to secure protection for a color *per se*, there are special evidentiary problems associated with demonstrating that a specific mark has acquired distinctiveness in this context. Rather than decide the issue, the courts thus far have stated that the drawing controls the application. Service marks however do not face the same drawing requirements as the color is not applied to any particular good. A claim to color *per se* still needs to be specific as to use and include evidence of acquired distinctiveness for each claimed use. As with all applications, except those for scent, a drawing, supplemented with a written description, is required. The description should provide notice of the nature of the mark and the drawing must display the manner in which the mark is used in connection with the services. The mark depicted on the drawing must, as used on the specimens, make a separate and distinct commercial impression to be considered one mark. See *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988).

Further if color is used in a variety of ways in a single setting that makes a single commercial impression, the applicant must submit a broken-line drawing of the setting with a detailed description of the color or colors. If an Applicant seeks protection for a color as applied

to a variety of items that are not necessarily viewed simultaneously by purchasers, the applicant should provide a solid-colored square with a dotted peripheral outline and a detailed description of the mark.

3.3 *Is an applicant required to file a sample of the colour(s) applied for and/or a colorimetric reference or other colour code?*

The drawing of an application for color must include a sample of the color for which protection is sought and may include a colorimetric reference, though one is not required.

3.4 *Can the mark be considered inherently distinctive in relation to certain goods or services?*

As stated above, a single color mark may never be considered inherently distinctive for either goods or services. An examining attorney is required to refuse to register a single color mark on the Principal Register unless the applicant demonstrates that it has acquired distinctiveness.

3.5 *Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?*

The provisions of the U.S. Code regarding the Supplemental Register suggest that the USPTO may accept proof of five years worth of substantially exclusive and continuous use as a mark by the applicant in commerce as prima facie evidence that the mark has become distinctive. Accordingly, an application for registration of a single color mark does not appear to require evidence of de facto distinctiveness through use in order to achieve registration.

3.6 *Are certain colours denied registration on the basis that there is a need to keep them free for general use?*

No, generally speaking, color marks will be denied registration on the grounds that the color is not inherently distinctive and therefore does not function as a trademark or does not function as a service mark not on the color depletion theory. That being said, color marks may still be denied registration to the extent that they are functional and this ground for refusal is premised on the fact that a particular color in relation to a particular good or service is useful and, therefore, must be kept free for general use only in respect of that certain good and/or service.

3.7 *To what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*

As with all marks, an applicant may only receive protection for a mark based on the elements of the mark that make a separable commercial impression. Accordingly, if a proposed mark incorporates additional visual aspects that function as a trademark or a service mark, these aspects in conjunction with the color elements of the mark may be sufficient to demonstrate inherent distinctiveness.

4. *Where applications to register three-dimensional signs may be accepted for registration:*

Applications for registration of three-dimensional signs may be accepted for registration on either the Supplemental Register or on the Principal Register. In the latter case, the application must include a showing of acquired distinctiveness.

4.1 *What form of representation of the three-dimensional sign is accepted as part of the application for registration?*

An applicant who seeks protection for a three-dimensional sign must include a drawing that presents the mark in three dimensions. *In re Schaefer Marine, Inc.*, 223 USPQ 170, 175 n. 1 (TTAB 1984). Further, the drawing must include a description of the mark indicating that

the mark is three-dimensional. If the Applicant believes a single drawing is incapable of capturing the mark, he or she may petition for waiver of the requirement that only one drawing can be submitted.

4.2 *What are the criteria for assessing whether the three-dimensional sign can be considered capable of distinguishing the goods or services of one undertaking from those of another?*

As with all marks, the examining attorney will confine his or her review of a three-dimensional sign to those non-functional elements of the proposed mark that create a distinct commercial impression.

4.3 *What are the criteria for assessing whether the three-dimensional sign can be considered inherently distinctive in relation to certain goods or services?*

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 54 USPQ2d 1065 (2000) the Supreme Court noted that product design presents certain problems for those who wish to claim trade or service mark protection for said designs, as consumers believe that even the most unusual product design is not meant to identify the source of a product, but rather to enhance its utility or appeal. Accordingly, examining attorneys are instructed to refuse to register, on the Principal Register, any mark that consists of a configuration of a product or portion thereof, absent a showing of acquired distinctiveness. That having been said, three-dimensional marks that meet the definition of a trademark or service mark and are not part of a product's design could still be considered arbitrary, fanciful or suggestive.

4.4 *Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?*

As discussed above, there is no per se rule that prevents three-dimensional marks from being considered inherently distinctive.

4.5 *Are certain shapes denied registration on the basis that there is a need to keep them free for general use?*

No, though three-dimensional signs may still be denied registration to the extent that they are functional. As discussed with color marks, this ground for refusal is premised on the belief that particular shapes in relation to particular goods and services are useful and, therefore, must be kept free for general use in respect of said goods and/or services.

4.6 *To what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*

See the answer to 3.7 above.

4.7 *To what extent do technical or functional considerations prevent registration?*

Functionality is an absolute ground for refusal to register any mark.

5. *Where applications to register smells may be accepted for registration:*

Applications to register smells may be accepted on either the Supplemental or Principal Register provided the smell for which registration is sought is used on a product in a non-functional manner. See *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990).

5.1 *What form of representation or description of the smell is accepted as part of the application for registration?*

If the applicant's mark consists *solely* of a smell the applicant must submit a detailed written description of the mark that clearly explains the smell. 37 C.F.R. §2.52(a)(3).

5.2 *How is the capacity of the smell to function as a trademark and/or its distinctiveness assessed?*

As with other non-conventional marks, the capacity of the mark to function as a trademark will be determined, assuming the smell is non-functional, based on the ability of the smell to create a consumer impression and to identify the source or origin of the goods or services for which registration is sought.

5.3 *How is the mark made available to the public on publication of the trademark application and thereafter?*

The mark will be made available through publication of the written description referenced in 5.1 above.

6. *Where applications to register a sound mark may be accepted for registration:*

Applications to register sounds, much like smells, may be accepted on either the Supplemental or Principal Register, provided the sound for which registration is sought is used on a product or in connection with a service in a non-functional manner.

6.1 *What form of graphical representation of the mark applied for is required as part of the application for registration?*

If the applicant's mark consists *solely* of a sound the applicant must submit a detailed written description of the mark that clearly explains the sound. 37 C.F.R. §2.52(a)(3). If the mark comprises music or words set to music, the applicant may also submit the musical score for the record. For example, the description on the registration for the roar of the MGM lion, Registration Number 1,395,550, (a mark which is still debated in Canada) states, "THE MARK COMPRISES A LION ROARING." Whereas the description for a theme which included music and words must include a score.

6.2 *Can audio recordings of a sound mark be filed as part of the application for registration?*

Audio recordings may be accepted as specimens for sound marks however, the recording should contain enough of the content to actually identify and distinguish the services and indicate their source.

6.3 *If such audio recordings are filed as part of the application for registration, how are these recordings made available to the public on publication of the trademark application and thereafter?*

The recordings will be made available directly through the USPTO.

7. *Where applications to register moving images or holograms may be accepted for registration:*

Provided the applicant can demonstrate that the use of a hologram or moving image both serves as a mark and is not functional, an application for such a mark may be made to either register. That being said, Examining Attorneys are instructed to refuse an application for registration of a hologram if the applicant does not provide evidence of consumer recognition of the hologram as a mark.

7.1 *What form of representation of the moving image or hologram is accepted as part of the application for registration?*

An applicant for seeking registration for a mark that includes motion can submit either a drawing that depicts a single point in the movement, or a square drawing that contains up to five freeze frames showing various points in the movement. As with three-dimensional marks, the applicant seeking registration of a hologram must submit a drawing of the mark

that captures the dimensions thereof. Further, Examiners are instructed to refuse registration of any holograms that show two different images on the grounds that the application is seeking protection for two separate marks. For both holograms and moving images, the application must also include detailed written description of the mark.

7.2 *How is the moving image or hologram made available to the public on publication of the trademark application and thereafter?*

During publication the drawing pages for these marks are published and thereafter the drawing page is incorporated into the registration certificate which is made available at the USPTO as well as the USPTO website.

8. *How is the scope of protection of “non-conventional” trademarks assessed? In particular, are registrations for “non-conventional” trademarks treated any differently than registrations for “traditional” forms of trademark either in substantive or procedural terms?*

The scope of protection for non-conventional trademarks is assessed in the same way as the scope of protection for “traditional” trademarks, i.e. is the conflicting mark so similar as to create a likelihood of confusion, or to cause mistake or to deceive. See, 15 U.S.C. §1114(b). The substantive and procedural differences in terms of registration are discussed above. In terms of enforcement, there are no significant differences.

9. *To what extent is assessment of the registrability of “non-conventional” trademarks influenced by issues relating to enforcement and the scope of protection which should be afforded to those marks?*

The registrability of “non-conventional” marks is determined solely with reference to their ability to properly fit into the broad definition of both trademarks and service marks as defined under the Lanham Act.

10. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that there may be a limited number of certain “non-conventional” marks (such as colours or shapes) available for general use?*

As we have discussed above, the registrability of “non-conventional” marks does not rely on an analysis of their potential for depletion. Rather, their registrability is premised on their ability to indicate source or origin.

11. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that consumers may be less used to understanding “non-conventional” marks as an indicator of origin?*

As discussed above, this understanding influences the USPTO’s current stance on registrability of holograms. As yet this understanding has not been incorporated into legislation. Accordingly, as consumers and trademark users become more accustomed to non-functional uses of holograms their registrability will be affected accordingly.

Summary

The reply of the U.S. Group addresses the broad and flexible approach the United States of America has taken regarding the registration and protection of “non-conventional” trademarks and service marks. As U.S. treatment of the issue of “non-conventional” marks centers on an expansive definition of a trademark, namely, any word, name, symbol or device that is used in trade with goods or services to indicate their source and distinguish them from the goods or services of others, the body of U.S. law which governs registration and protection of these marks is both complex and continually evolving. At present, U.S. practice regarding “non-conventional” marks re-

flects the international debate surrounding treatment of these marks and their inherent registrability. While aural and visual marks are generally registrable, the inherent registrability of single color marks and holographic images is still debated. Treatment of smells, tastes and touch marks is equally varied. While smell marks are accepted if the smells are non-functional, as yet there are no precedents for taste or touch.

Nevertheless, as US trade and service mark owners become increasingly creative in their attempt to compete for market share the ability of the general public to accept and identify novel indicia of source expands. Accordingly, those “non-conventional” marks which are considered insufficiently distinctive today may well become the trade and service marks of tomorrow. Thus it is the absence of categorical prohibitions against specific marks which allows the US to remain in the forefront of debate on “non-conventional” marks. In theory, therefore, the U.S. can protect all types of “non-conventional” trademarks as long as they are distinctive and function as trademarks since the definition of “trademark” in the U.S. is comprehensive.

Resumé

La réponse du Groupe U.S. traite de l'approche libérale et flexible que les Etats-Unis d'Amérique ont adoptée en ce qui concerne l'enregistrement et la protection de marques de fabrique et de marques de service “non conventionnelles”. Etant donné que l'approche du problème des marques “non conventionnelles” est centrée sur une définition non exhaustive d'un marque, en l'occurrence tout mot, nom, symbole ou signe qui est utilisé dans le commerce pour des biens ou services afin d'indiquer leur source et les distinguer des biens et services d'autrui, les lois américaines qui gouvernent l'enregistrement et la protection de ces marques sont à la fois complexes et en constante évolution. Actuellement, la pratique américaine concernant les marques “non conventionnelles” reflète le débat international entourant le traitement de ces marques ainsi que leur capacité inhérente d'enregistrement. Alors que les marques sonores et visuelles sont en général capables d'enregistrement, la capacité inhérente d'enregistrement de marques d'une couleur déterminée et d'hologrammes est toujours débattue. Le traitement des odeurs, des goûts et des marques de toucher est également divers. Alors que les marques olfactives sont acceptées si les odeurs sont non fonctionnelles, il n'existe actuellement pas de précédents pour le goût ou le toucher.

Néanmoins, comme les propriétaires de marques de fabrique et de service deviennent de plus en plus créatifs dans leurs efforts pour conquérir des parts de marché, la capacité du grand public d'accepter et d'identifier de nouveaux indices de provenance augmente. Dès lors, ces marques “non conventionnelles” qui sont considérées insuffisamment distinctives aujourd'hui peuvent tout à fait devenir des marques de fabrique et de service demain. Par conséquent, c'est l'absence d'interdictions par catégories contre des marques spécifiques qui permet aux Etats-Unis de rester au premier rang du débat sur les marques “non conventionnelles”. En théorie, donc, les Etats-Unis peuvent protéger tous types de marques “non conventionnelles” dans la mesure où elles sont distinctives et fonctionnent comme des marques, puisque la définition d'une “marque” aux Etats-Unis est large.

Zusammenfassung

Die Antwort der US-amerikanischen Gruppe spricht die breite und flexible Herangehensweise an, die die Vereinigten Staaten von Amerika hinsichtlich der Registrierung und dem Schutz von “unkonventionellen” Warenzeichen und Dienstleistungsmarken genommen hat. Während die US-amerikanische Behandlung der Frage von “unkonventionellen” Warenzeichen sich auf eine weite Definition von Warenzeichen konzentriert, insbesondere Worte, Eigennamen, Symbole oder Mittel, die im Handel mit Gütern und Dienstleistungen zur Bezeichnung deren Ursprungs und zu deren Unterscheidung von Gütern und Dienstleistungen von anderen benutzt wird, ist der Teil des

US-amerikanischen Rechts, das die Registrierung und den Schutz dieser Warenzeichen regelt, sowohl komplex als auch sich fortwährend entwickelnd. Gegenwärtig spiegelt die US-amerikanische Praxis in bezug auf "unkonventionelle" Zeichen die internationale Debatte zur Behandlung dieser Zeichen und deren inhärenten Registrierbarkeit. Während aurale und visuelle Zeichen generell registrierbar sind, wird die inhärente Registrierbarkeit von einfarbigen Zeichen und holografischen Abbildungen noch immer diskutiert. Die Behandlung von Geruchs-, Geschmacks- und Berührungszeichen ist gleichermassen vielfältig. Während Geruchsmarken akzeptiert werden, gibt es noch keine Präzedenzfälle für Geschmack oder Berührung.

Nichtsdestotrotz, so wie US-Warenzeichen und Dienstleistungszeicheneigentümer in ihrem Versuch, Marktanteile zu erkämpfen, zunehmend kreativer werden, nimmt die Fähigkeit der breiten Öffentlichkeit, neue Ursprungskennzeichen zu akzeptieren und identifizieren, zu. Entsprechend kann es sein, dass diese "unkonventionellen" Zeichen, die heute noch als unzureichend unterscheidbar angesehen werden, die Waren- und Dienstleistungszeichen von morgen sein werden. Folglich ist es das Fehlen von kategorischen Verboten gegen besondere Zeichen, das es den USA erlaubt, an der Spitze der Debatte über "unkonventionelle" Zeichen zu bleiben. Theoretisch kann daher die USA alle Typen von "unkonventionellen" Warenzeichen schützen, solange sie unterscheidbar und als Warenzeichen dienen, da der Begriff des "Warenzeichen" in den USA umfassend ist.