

# Capturing Consumer Attention – 3D and Non-Traditional Trademarks

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- Increased activity in protection sought for non-traditional marks--color, shape, smell, motion, vibration
- Scope of protection
- Layers of protection may be available and not limited to trademark or design patent – see *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 580 U.S. \_\_\_\_ (2017) (designs of cheerleading uniform separable from function of uniform, copyrightable)



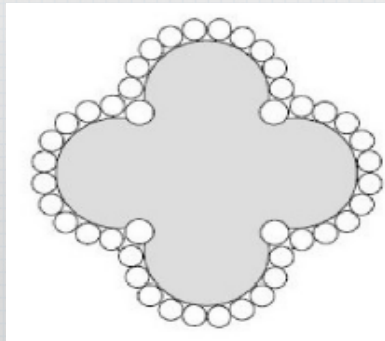
# Lanham Act - Definitions



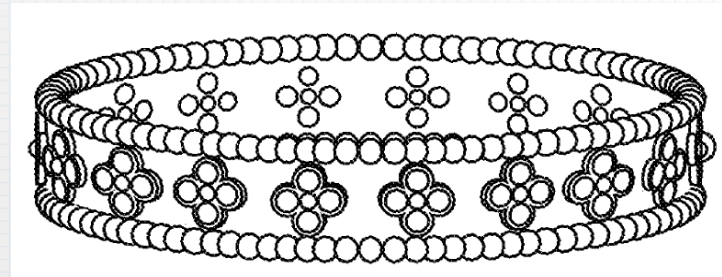
- **15 USC 1091(c):** For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word...numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.
- **15 USC 1127:** The term "trademark" includes any word, name, symbol, or device, or any combination thereof...
  - (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register...to identify and distinguish...goods, from those manufactured or sold by others and to indicate the source of the goods...



- Consumer brands - increased interest in product design/packaging and securing protection of non-traditional marks--color, shape, smell, motion, texture, sound and vibration
- Availability of more than one species of protection—trademark, trade dress, design patent, copyright



U.S. Regs. 4,653,258; 4,037,174



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- Definiteness – is the mark capable of being defined, sufficient to provide notice to the public of the subject matter
- Distinctiveness – may be inherent; if not, then must be acquired through pervasive use of mark to achieve consumer recognition, demonstrated through evidence of secondary meaning
- Functionality – **fatal** to registration as a trademark



- **15 USC 1125(a)** – creates a federal cause of action for unfair competition
- **15 USC 1125(a)(3)**: In a civil action for trade dress infringement for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.





- Case law recognizes package trade dress as a trademark
- Configuration of a product may also be trade dress, can include size, shape, color, color combinations, texture, graphics
- Trade dress must be non-functional
- Individual elements of trade dress may be protected as non-traditional trademarks

# Trade Dress Protection



- Trade dress – involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).
- Product packaging may be inherently distinctive; product design always requires proof of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).
- Must be non-functional - matter claimed in prior utility patents incapable of trademark protection. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001)
- Duration: Valid as long as use continues





- To receive protection, trade dress/trademark must be BOTH
  - Distinctive – through either
    - Inherent distinctiveness or
    - Acquired distinctiveness (e.g., secondary meaning – namely, consumer recognition that the trade dress identifies the product source rather than the product itself or feature of the product); and
  - Non-Functional
    - Absence of utility patents
    - Presence of competitive designs



Courts look to the following factors in determining whether a particular trademark or trade dress has acquired secondary meaning

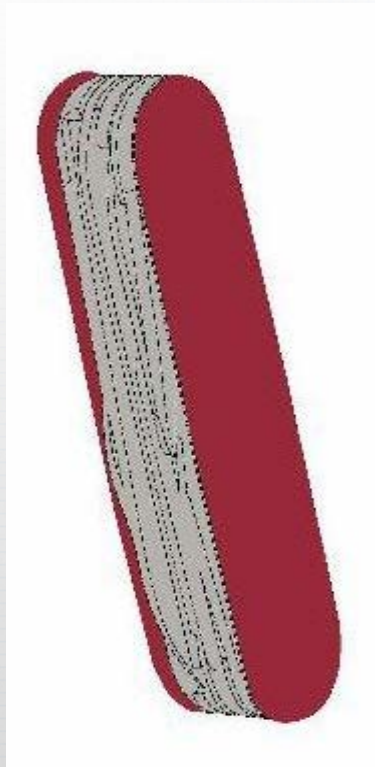
- Duration of substantially exclusive use
- Sales success
- Substantial advertising expenditures
- Advertising stressing the design features (“look for”)
- Unsolicited media coverage
- Requests from third parties to license design or mark
- Survey evidence
- Intentional copying of the trade dress by competitors



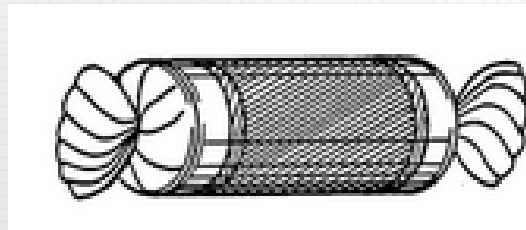
# Color Marks



- Famous and familiar



U.S. Reg. 3,546,920



U.S. Reg. 1,516,573



U.S. Reg. 3,361,597



- Color marks can never be classified as inherently distinctive
- Evidence of secondary meaning must be demonstrated
- Colors to show size, strength, capacity or other characteristic of the quality or performance of the goods will not be registered
- Color of a liquid is usually not protectable

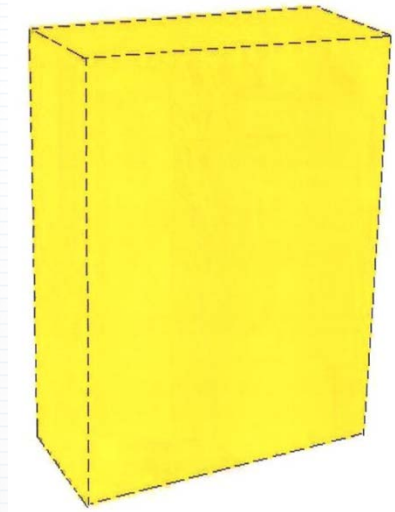


# Color Marks - Recent Decisions

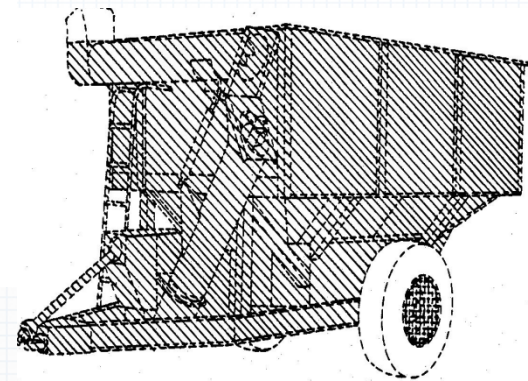
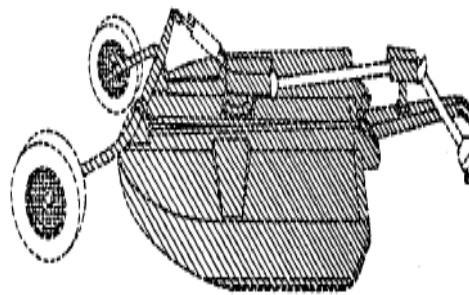


- *In re General Mills IP Holdings II LLC*, U.S. Ser. No. 86/757,390 (TTAB Aug. 22, 2017)

Protection of “yellow” on product packaging for CHEERIOS brand “toroidal-shaped, oat-based breakfast cereal” denied, Board found issues with survey evidence; colored background was not distinctive, merely “eye-catching ornamentation”; evidence of third party use of yellow for cereal product packaging showed yellow not exclusively used by General Mills for cereal.



# Color Marks – Recent Decisions



*Deere & Co. v. FIMCO Inc.*, 5:15-cv-00105 (W.D. Ky Oct. 13, 2017)

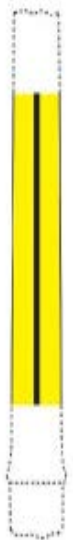
Following bench trial, green-and-yellow color scheme featured on John Deere tractors found to be famous, based on evidence dating back to 1905 showing use and advertisement about colors; strength of these trademark rights diluted by competitors, but relevant consumers (farmers) still likely to be confused by rival's use of green/yellow colors on pesticide sprayers; decision and order of permanent injunction in favor of John Deere.



# Color Marks – Promote as Mark in Advertising



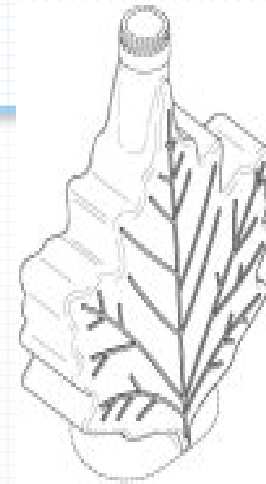
- Advertising must educate consumer that the design feature should stand out in their mind as performing the role of a trademark
- Mark consists of a 3-dimensional configuration of a tool handle having longitudinally extending stripe of a color which contrasts with the principal color of the tool handle. Dotted lines in application drawing illustrative of a tool handle example, serve only to show position or placement of the mark on the product



## 3-D Marks – Product Shapes, Containers



U.S. Reg. 3,976,324



- Must be distinctive – through either:
- Inherent distinctiveness or
- Acquired distinctiveness (e.g., secondary meaning – namely, consumer recognition that the trade dress identifies product source, rather than product itself or feature of the product)
- Non-functional
- Cannot be the subject of prior utility patent
- Presence of alternative competitive designs
- Drawing – three-dimensional representation / dotted lines for unclaimed elements (ghosting)



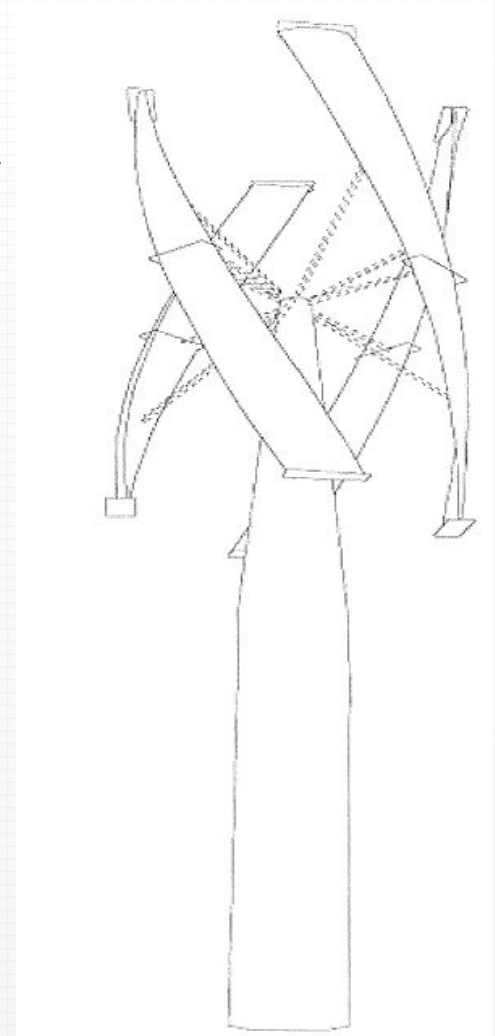
# 3-D Marks – Registration Challenges



- *In re Change Wind Corp.*, 123 USPQ2d 1453 (TTAB 2017)

Refusal to register product configuration for “wind turbines; wind powered electricity generators” affirmed by the Board, due to functional nature of design that was

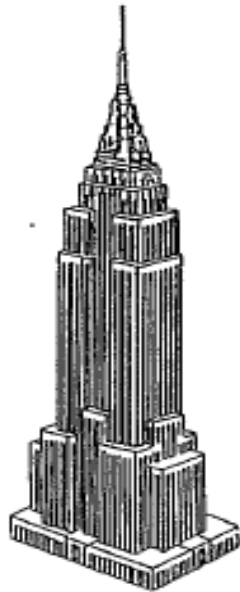
“essential to the use and purpose of the product”; Applicant’s expired utility patent set out the functional aspects of the three components shown in the trademark application drawing – conical tower, helical wings and boundary fences affixed to the wings; components were shown to be essential to product function.



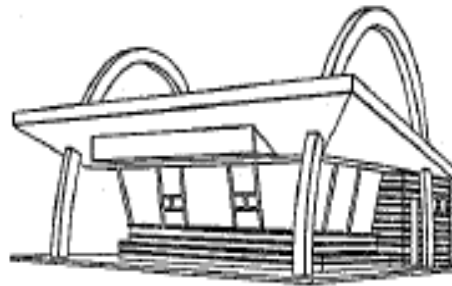
# 3-D Building Exteriors / Interiors



U.S. Reg.  
1,126,888



U.S. Regs.  
2,429,297  
2,430,828  
4,775,666



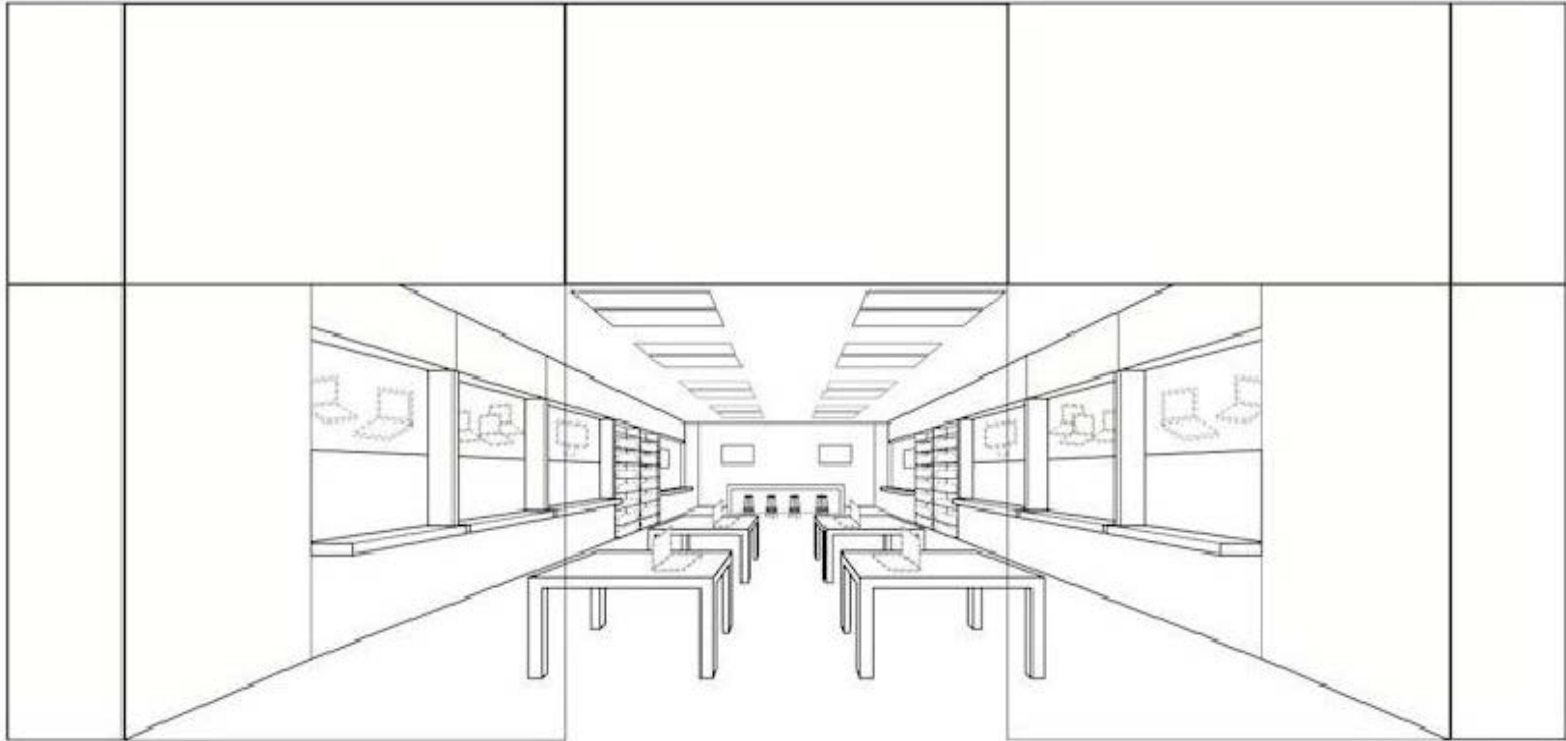
U.S. Reg. 764,837



U.S. Reg. 3,917,411



# 3-D Building Exteriors / Interiors



“The mark consists of the design and layout of a retail store, the store features a clear glass storefront surrounded by a paneled façade consisting of large, rectangular horizontal panels over the top of the glass front, and two narrower panels stacked on either side of the storefront, within the store, rectangular recessed lighting units traverse the length of the store’s ceiling, there are cantilevered shelves below recessed display spaces along the side walls and rectangular tables arranged in a line in the middle of the store parallel to the walls...”

U.S. Reg. 4,277,914

# Sound Marks



U.S. Regs. 4,462,890,  
2,210,506  
For online fan club services  
- “Tarzan yell”



U.S. Regs. 4,689,365,  
4,689,044  
For computers,  
hardware, software,  
electronic devices  
- Apple Siri chime



U.S. Reg. 4,753,453  
For electronic devices, software,  
computers  
- Samsung sound of bubbling water



U.S. Reg. 4,558,864  
For providing collegiate  
athletic sporting events  
- U. Of Arkansas cheer



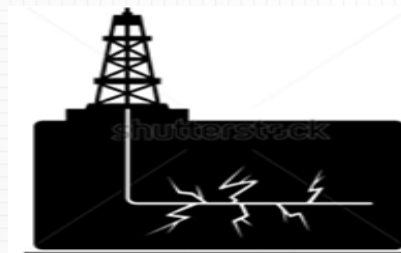
# Sound Marks – Achieving Registration



- Capable of being inherently distinctive
- If not inherently distinctive, secondary meaning/acquired distinctiveness must be shown
- Essential to have specificity in description of mark
- May overlap with copyright protection
- **Latest Filings** - *Vibrations* for e-commerce authentication services; U.S. Ser. Nos. 87/711,064-066 (filed Dec. 6 by Visa Int'l); marks consist of 3 successive vibrations, first and third of equal duration, and a second shorter vibration

# Smell/Scent Marks

- U.S. Reg. 4,754,435 - flip flops
- U.S. Reg. 4,144,511 - ukuleles
- U.S. Reg. 4,618,936 - retail store services
- U.S. App. 86/293,496 -  
chemical additives for fracking  
(Examiner objection, abandoned Dec. 2015)



- U.S. App. 87/335,817:  
scent of modelling clay scent  
(first use 1955, pub'd Feb. 27, 2018); claim of protection for “a unique  
scent formed through the combination of sweet, slightly musky, vanilla-  
like fragrance, with slight overtones of cherry, and natural smell of a  
salted, wheat-based dough”; extensive declarations, evidence filed to  
support claim of acquired distinctiveness.



# Smell/Scent Marks – Challenges

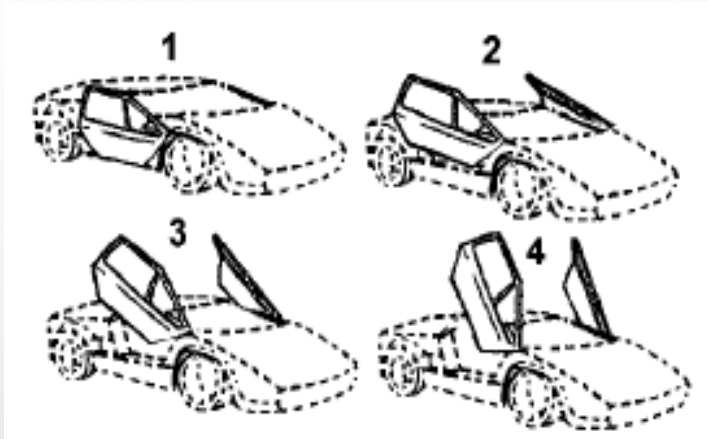


- First grant of registration - 1990
- Secondary meaning/acquired distinctiveness must be shown
- Inherent distinctiveness - RARE
- Perfume fragrances - never accepted for registration
- Sense of smell highly varied from person to person
- Smell is 10,000 times more sensitive than all other senses, linked to part of the brain used for memory and emotions

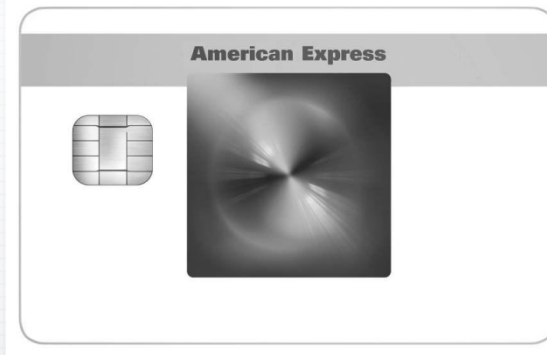
# Motion and Holograms



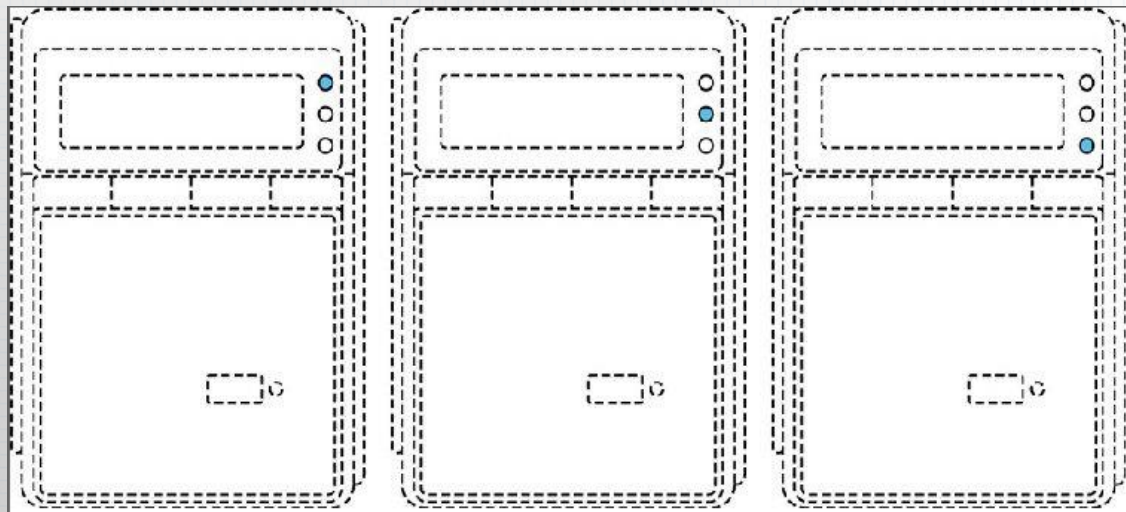
U.S. Reg. 2,793,439



U.S. Reg. 3,045,251



U.S. Reg.  
2,710,415



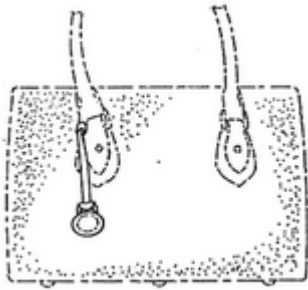
U.S. Reg.  
3,352,247



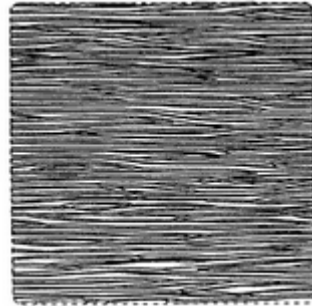


- Detailed description/definiteness required
- Limited to maximum of 5 “freeze frame” images in application
- Capable of being inherently distinctive
- Special challenges for holograms in the context of credit cards, perceived by consumers as protection method

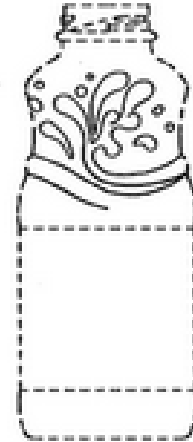
# Touch / Texture



U.S. Reg.  
2,252,278



U.S. Reg.  
2,263,903

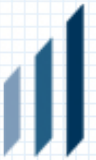


U.S. Reg.  
2,204,387



U.S. Reg. 3,495,230





- Touch or texture marks are RARE, but possible
- Must not be mere ornamentation
- **Latest Filings** - *Vibrations* for e-commerce authentication services; U.S. Ser. Nos. 87/711,064-066 (filed Dec. 6 by Visa Int'l); marks consist of 3 successive vibrations, first and third of equal duration, and a second shorter vibration

# International View – 3D Trademarks



- Protectable in the EU, if distinctive; gauged by how it is perceived by the relevant public (average buyer)
- Distinctiveness of 3D shape perceived differently from a word mark--only if the shape deviates significantly from the norm or what is common in the product sector will it be viewed as source identifying and distinctive
- *Mag Instrument Inc. v. OHIM* (Case C-136/02 P) (2004)
- Strict examination by EUTM
- Must not be mere ornamentation



# International View – 3D Trademarks



- *Bang & Olufsen A/S v. OHIM* (Case T-508/008)(2011)  
– marks devoid of any distinctive character and signs which consist exclusively of the shape that gives substantial value to the goods are not registrable; refused registration based on obvious aesthetic characteristics of loudspeakers.
- Article 7(1)(e), Reg. No. 40/94 – The following shall not be registered:...signs which consist of: (i) the shape which results from the nature of the goods themselves; or (ii) the shape of the goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods



# AIPPI – Association Internationale pour la Protection de la Propriété Intellectuelle

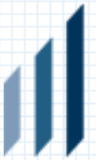


- Founded in 1897, Vienna Congress
- Only 7 countries recognized protection for designs/models: the U.S., the U.K., France, Germany, Italy, Belgium, Austria/Hungary; only 4 afforded protection to foreign applications
- Foreign applicant trademark filings were only accepted in the U.K., Argentina, Chile, Italy, the Netherlands, Spain, Uruguay
- Bilateral treaties resulted in uneven patchwork
- Aim of AIPPI – focused study of questions relating to trademarks, industrial designs and inventions, to achieve harmonized approach to protection





- Membership of 9000, from 125 countries
- Annual Congress convenes to develop resolutions on harmonization of IP laws; resolutions sent to IP Offices, other government bodies, NGOs and interested parties
- Methodology:
  - (1) Study Questions on focused IP issues chosen, guidelines provided
  - (2) National Groups prepare detailed responses to Study Questions
  - (3) comparative global summary developed
  - (4) proposed resolution debated in Working Session
  - (5) revised resolutions sent to Plenary Session for debate and vote
  - (6) final resolutions available at [www.aippi.org](http://www.aippi.org)



- **2018 Sept. 23-26, Cancun, Mexico - Study Questions:**
  - ☐ - Protection of 3D trademarks – registrability and scope of protection
  - ☐ - Partial Designs – is a part or portion of a product suitable subject for independent design protection, and if so, what are the requirements and scope of protection
  - ☐ - Conflicting patent applications – how do applications with an earlier filing or priority date, but which are not yet published, affect patentability of a later filed application
  - ☐ - Joint Liability for IP infringement – in what situations may a party be jointly liable for infringement, or be solely liable for joint infringing acts





Thank you for your attention

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