





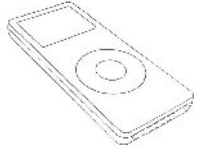


## Nontraditional Trademarks

Trademarks identify the source and quality of the trademark owner's goods or services and represent the goodwill associated with the trademark owner's business. Trademarks are most often thought of as words, names, symbols, or designs (or any combination thereof), but there are a variety of "nontraditional" trademarks that businesses can use, protect and enforce in the same way as traditional marks. Nontraditional marks include sounds, colors, trade dress consisting of product packaging or product design, architectural trade dress, scents, motion, and holograms.

### The Spectrum of Nontraditional Trademarks

A number of well known sounds, colors, designs and other nontraditional marks have already been registered with the U.S. Patent and Trademark Office ("PTO"). The following examples may be familiar to you:

Type of Nontraditional Trademark	Representative Examples
Sound	-NBC's 3-note chime ( <a href="http://www.uspto.gov/web/offices/ac/ahrpa/opa/kids/soundex/72349496.mp3">www.uspto.gov/web/offices/ac/ahrpa/opa/kids/soundex/72349496.mp3</a> ) -Warner Brothers' "Looney Tunes" theme song ( <a href="http://www.uspto.gov/web/offices/ac/ahrpa/opa/kids/soundex/75934537.mp3">www.uspto.gov/web/offices/ac/ahrpa/opa/kids/soundex/75934537.mp3</a> )
Color (identifying a color or series of colors that functions as the trademark <i>itself</i> (that is, the source identifier) rather than simply being a claimed feature of a traditional trademark)	-Pink for Owens-Corning fiberglass insulation -Chocolate brown for United Parcel Service's delivery services
Scent	-Strawberry for Manhattan Oil's lubricants and motor fuels -Strawberry for Lactona Corporation's toothbrushes

<b>Product Packaging</b>		Coca-Cola's bottle design for soft drinks
		Long John Silver's packaging for prepared seafood
<b>Product Design</b>		Apple's 3-dimensional design of its IPOD media player
		Hershey Chocolate's HERSHEY'S KISSES design for candy and confectionary bits for baking
<b>Architectural Trade Dress</b>		McDonald's building design for res-

The above examples demonstrate that some nontraditional marks are quite recognizable, but in order for a nontraditional mark to achieve consumer recognition and to be protectable and registrable, two conditions must be met: first, the nontraditional mark must be distinctive; and second, it must not be functional.

#### Distinctiveness

All trademarks, whether nontraditional or traditional, must be distinctive in order to warrant protection. Some marks are inherently distinctive, and therefore, warrant strong protection. But for those trademarks that lack inherent distinctiveness, protection and enforcement is still possible upon proof of secondary meaning (also known as acquired distinctiveness). If a mark has secondary meaning, then it has become distinctive over time through substantially exclusive and continuous use and/or through extensive amounts of advertising and sales and recognition among consumers.

Distinctiveness takes on a new meaning with respect to nontraditional marks because courts have developed different rules for the various types of nontraditional marks. For example, courts have determined that sound marks and product packaging marks are capable of being inherently distinctive, but color, scent, product design, and taste are all incapable of being inherently distinctive. Therefore, these marks require evidence of secondary meaning in order to be fully protectable and registrable at the PTO.

#### Functionality

Functional features (e.g., features that are either essential to the use or purpose of the product or that affect the cost or quality of the product) are difficult to protect as trademarks and are incapable of being registered with the PTO regardless of secondary meaning. The law considers functional features best left to patent protection because patent protection in the functional features would be granted for a limited duration, whereas trademark protection can provide indefinite rights in the functional features, and that would hinder competition.

There are four factors that courts use to determine whether a feature of a trademark is functional:

1. The existence of a utility patent for the design/feature;
2. Evidence of advertising on behalf of the trademark owner that touts the design's/feature's utilitarian or functional advantages;
3. The existence of alternative designs that perform the same function; and
4. Whether the design/feature was simple or inexpensive to manufacture.

Each factor need not be considered in every case if other factors provide strong evidence of functionality.

#### The Future of Nontraditional Trademarks

As evidenced by an increase in filings at the PTO in the last decade, nontraditional trademarks appear to be gaining popularity as businesses look for new ways to expand the scope of their intellectual property assets. Despite the distinctiveness and non-functionality obstacles that might hinder protection for nontraditional marks, businesses should explore the development and use of these novel brands as a way to better distinguish the businesses' goods and services from others. After all, a novel brand may more likely be memorable in the eyes of the consumer.

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#### **Dunner Law PLLC**

IP Practice specializing in trademark and copyright law; IP counseling, domestic and international protection of IP portfolios; internet-issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

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