

USPTO: Registration of Non-Traditional Trademarks

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While trademark protection is most commonly associated with source identifiers such as individual words, logos, slogans, and a combination of these elements, trademark protection in the United States can also extend to colors, sounds, smells, and other non-traditional source identifiers. Brands appeal to consumers in varied ways, and trademark protection is often available for many types of consumer marketing efforts that are not immediately thought of as trademarks. Diageo, for example, has obtained trademark registration for the purple and gold pouch bag that houses Crown Royal Whisky. The registration, which claims acquired distinctiveness, describes the mark as a “three dimensional design of a purple cloth pouch bag with gold stitching and drawstring” and claims the colors purple and gold as a feature of the mark.



U.S. Reg. No. 3,137,914

The Lanham Act (the U.S. trademark statute) defines a trademark broadly enough that it can theoretically be anything that can be perceived by a consumer's five senses, and that can be used to identify and distinguish the source of goods/services. There are, however, several unique hurdles to clear in order to register a non-traditional trademark in the U.S. The mark cannot be functional, and if the mark is not inherently distinctive (a color mark, for example) it must have acquired distinctiveness in order to be registered on the U.S. Principal Register.

Functionality

The functionality doctrine is intended to preclude a business from monopolizing a useful product feature under the guise of identifying the feature as the source of the product. The determination that a proposed mark is functional constitutes an absolute bar to registration on either the Principal or Supplemental Register in the U.S., regardless of evidence showing that the proposed mark has acquired distinctiveness.

A feature is functional as a matter of law if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001).

To determine functionality, the U.S. Patent and Trademark Office will consider:

- the existence of utility patent that discloses the feature's utilitarian advantages;
- advertising by the applicant that promotes that utilitarian advantages of the design;
- facts pertaining to the availability of alternative designs; and
- facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

Examples of non-traditional marks that have been found to be functional include:

- the color green for John Deere forestry machines because "John Deere green" was found to be aesthetically functional as "farmers prefer to match their loaders to their tractor" *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982); aff'd 721 F.2d 253 (8th Cir. 1983);

- the color black for packaging for floral arrangements because it is associated with an elegant classic look, and is also a color to communicate grief or condolence as well as a color associated with Halloween. *In Re Florists Transworld Delivery, Inc.*, 105 U.S.P.Q.2d 1377 (T.T.A.B. Mar. 28, 2013);



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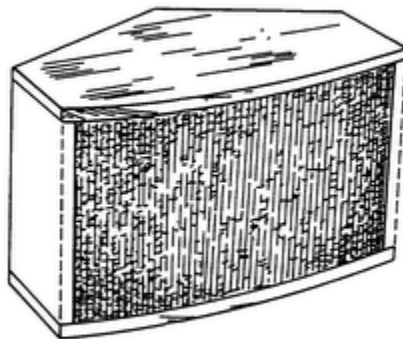
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- the pentagonal and curved design of a Bose speaker because “Bose’s utility patent, which expressly claims a loudspeaker system with angled baffles and a pentagonal cross-section provides ‘strong evidence’ of the functionality of Bose’s loudspeaker design.” *In re Bose*, 772 F.2d 866 (Fed. Cir. 2006).

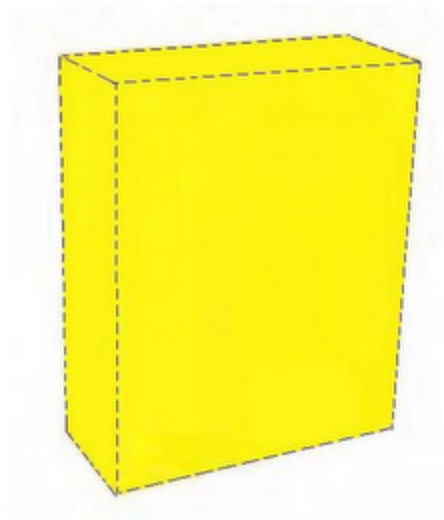




Acquired Distinctiveness

In addition to proving that the mark is not functional, acquired distinctiveness must frequently be proved for non-traditional marks that lack inherent distinctiveness. Color marks, scent marks, three-dimensional shape marks, and flavor/taste marks can never be inherently distinctive, and thus, proof of acquired distinctiveness is always required for registration on the Principal Register. Sound marks, motion marks, and touch marks could be inherently distinctive, in which case no proof of acquired distinctiveness would be required for registration.

An example of a non-traditional mark that was found not to have acquired distinctiveness is the color yellow, applied for by General Mills in connection with its Cheerios brand toroidal-shaped oat-based cereal. The TTAB held that “the presence in the market of yellow-packaged cereals from various sources—even cereals that are not made of oats or are not toroidal in shape—would tend to detract from any public perception of the predominantly yellow background as a source-indicator pointing solely to Applicant.” *In re General Mills IP Holdings II, LLC*, Serial No. 86/757,390 (T.T.A.B. August 22, 2017).

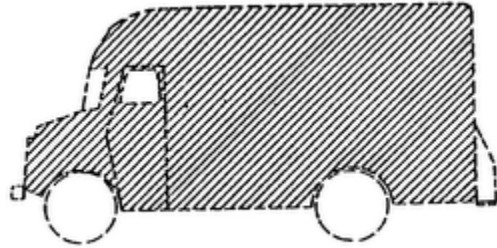


Forms of Non-Traditional Trademarks

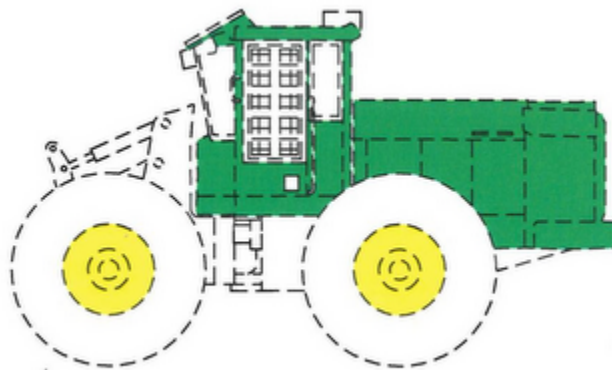
Color

Examples of colors that have successfully been registered as a trademark include the color brown, registered by UPS for motor vehicle transportation and delivery of personal property; a green and

yellow combination, registered by John Deere for forestry machines; the color canary yellow, registered by 3M for stationary notes; and the color robin's-egg blue, registered by Tiffany's for goods such as boxes, bags, and catalog covers.



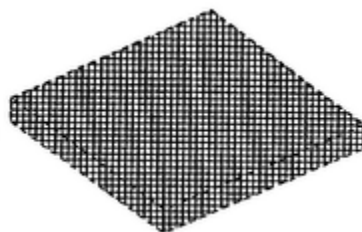
U.S. Reg. No. 2,131,693

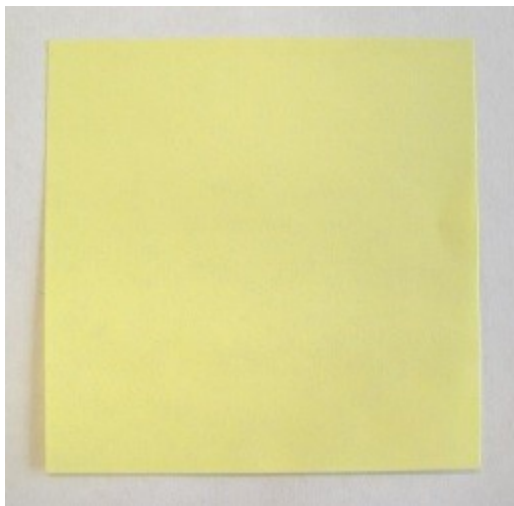




Thursday, April 28, 2016 1:55:44 PM - Wheel loader (843) | John Deere US - Internet Explorer

U.S. Reg. No. 4,084,102





U.S. Reg. No. 2,390,667





U.S. Reg. No. 5,176,498





U.S. Reg. No. 2,184,128

Scent

Examples of scents that have successfully been registered as a trademark include the scent of Play-Doh for toy modeling compounds and described as “a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough” (U.S. Reg. No. 5,467,089); the scent inside of a Verizon store and described as “a flowery musk scent” (U.S. Reg. No. 4,618,936); and the scent of bubble gum for “shoes, sandals, flip flops, and accessories, namely, flip flop bags” owned by Grendene S.A. (U.S. Reg. No. 4,754,435).

Interestingly, the Verizon scent mark is registered on the Supplemental Register because acquired distinctiveness was not shown. During the prosecution of this mark, the Examiner held that “[p]rospective consumers are unlikely to perceive a scent as a service mark for ‘retail store services featuring communication products and services, consumer electronics, and demonstration of products’ because . . . stores commonly use scents to create ambiance in stores.”

Submitting a specimen for a scent mark requires some creativity and could include sending the Examiner a scented product or a vial of scent oil to demonstrate use of the mark.

Shape

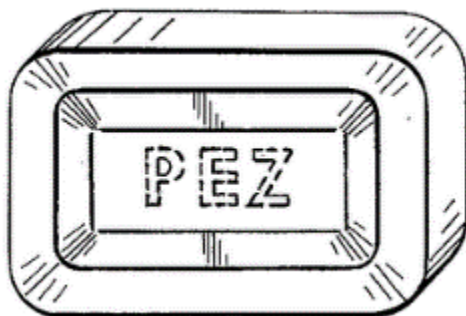
Examples of three-dimensional shapes that have successfully been registered as trademarks include the contour of a Coca-Cola bottle, the shape of a Toblerone candy bar, the shape of Pez candy, and the shape of the LEGO minifigure (which is also covered by U.S. Reg. No. 4,520,327, for the shape and color of the yellow toy figure head, on top of a yellow cylindrical neck).



U.S. Reg. No. 696,147



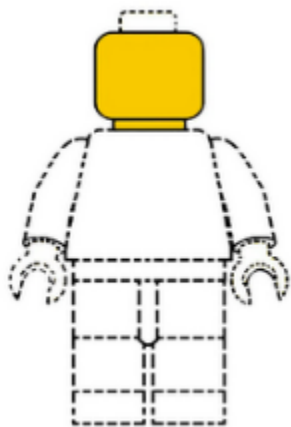
U.S. Reg. No. 911,237



U.S. Reg. No. 4,036,685



- U.S. Reg. No. 4,903,968



- U.S. Reg. No. 4,520,327



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Flavor

While trademark protection for a flavor is technically fathomable, realistically, it would be very unlikely. There are currently no registered flavor trademarks and the Trademark Trial and Appeal Board (“TTAB”) and federal courts have consistently held against affording trademark protection to flavors.

Products made for human consumption, such as foods and beverages that have a pleasing taste, would likely be disqualified from protection of the flavor or taste based on the functionality doctrine. In *In re N.V. Organon*, for example, the TTAB denied a pharmaceutical company a trademark in the orange flavor of its pills on functionality grounds. The TTAB explained that because medicine generally has “a disagreeable taste,” flavoring medicine serves a “utilitarian function that cannot be monopolized without hindering competition in the pharmaceutical trade.”

If a product were not made for human consumption and for some reason had a flavor, that product would be a more likely candidate for trademark protection because it could overcome the functionality hurdle.

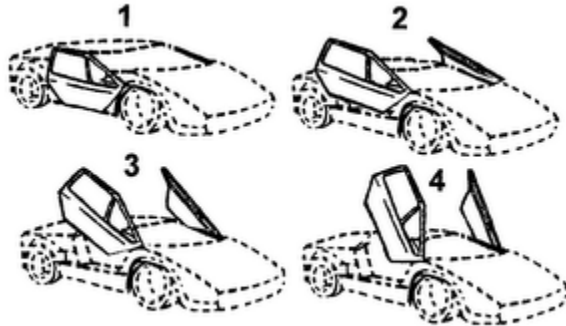
Sound

Examples of sound trademarks that have successfully been registered include the Tarzan yell sound for toy action figures (U.S. Reg. No. 2,210,506), slot machines (U.S. Reg. No. 3,841,800), and online retail store services, online fan club services, and publication of electronic fan magazines (U.S. Reg. No. 4,462,890); chimes for NBC entertainment services (U.S. Reg. No. 916,522); drums, trumpets, and strings for Twentieth Century Fox entertainment services and motion picture films (U.S. Reg. No. 2,000,732); a duck quacking the word “AFLAC” for American Family Life Assurance insurance services (U.S. Reg. No. 2,607,415); and Homer Simpson saying “D’OH” for Twentieth Century Fox for entertainment services (U.S. Reg. No. 3,411,881).

Motion

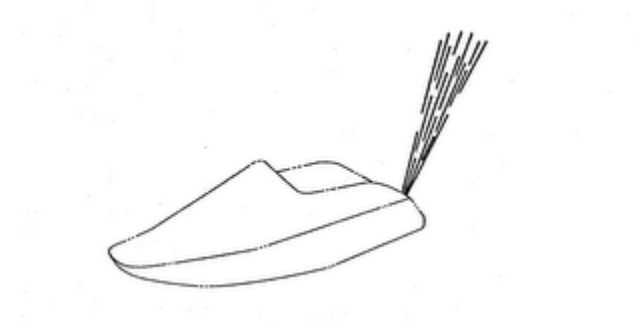
Examples of motion trademarks that successfully have been registered include:

- The motion in which the door of a vehicle is opened, owned by Automobil Lamborghini S.p.A. and registered on the Principal Register with a claim of acquired distinctiveness (Reg. No. 2,793,439);



<https://youtu.be/oZEFbVgkBnw>

- The motion of a three dimensional spray of water issuing from the rear of jet propelled watercraft, owned by Yamaha Hatsudoki Kabushiki Kaisha and registered on the Principal Register with a claim of acquired distinctiveness (Reg. No. 1,946,170);



- The live visual and motion elements of The Peabody Duck March as performed at The Peabody Hotels, registered on the Principal Register (Reg. No. 2,710,415). The registration notes that only one segment of the visual and motion elements is depicted and includes “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 stair, and into the fountain where they begin swimming. The mark also includes the fanfare in reverse sequence.”



Touch/Texture

- Fresh Inc. owns a registration for cotton-texture paper wrapped around oval-shaped soap and tied with a silver-colored wire that is coiled around and fastened to a semi-precious stone bead. While this is not exclusively a texture trademark, the cotton-textured paper is protected by the registration.





U.S. Ser. No. 2,682,410

- The David Family Group LLC owns a registration for a leather texture wrapping around the middle of a bottle of wine.





U.S. Reg. No. 3,896,100

Determining whether non-traditional trademark protection is available will depend on the specific circumstances, including the nature of the trademark to be protected, whether it is functional, and whether it has acquired distinctiveness. We routinely assist clients in strategizing and selecting the best forms of trademark protection, recognizing that intellectual property rights often overlap and function collectively to offer the broadest protection. Traditional and non-traditional trademark rights can be very effective when used in tandem, as their protections are complementary, not mutually exclusive. As brand identity is often created by using a combination of marketing efforts, non-traditional trademark protection offers a way to protect innovative source-identifiers and the consumer goodwill associated with them.