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NON-CONVENTIONAL TRADEMARKS IN THE EUROPEAN UNION AND THE UNITED
STATES OF AMERICA. COMPARATIVE ANALYSIS OF THE APPROACHES TO THE
REGISTRABILITY QUESTION

Master thesis

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INTRODUCTION

We are living in a time of a great variety of goods and services, which can be accessed instantly. At that time, price and quality are not the only decisive criterion for consumers. Purchasing certain products or using certain services may give them also some non-material value, e.g. contribution to their social status or improving their self-esteem. It can be so only when that goods and services are distinctive on the market and a few seconds spent in front of the shelf or a storefront are enough to tell the public about their origination. That is why businesses dedicate a significant part of their time to developing unique source indicators being able to establish an instant link between them and the potential consumers.

The main source indicator used to single out a product or a service is a trademark. Usually, trademarks have been understood as words, figurative elements or combinations thereof, which are capable of distinguishing the relevant goods or services and signal the public about their origination. Since words or figures may be perceived only by sight, manufacturers' abilities to make their goods and services distinctive have been considerably limited. But technology does not stand still and frontiers of perceptible are being broadened rapidly. That is the reason of new types of signs emergence, which are capable to distinguish goods and services of a certain manufacturer or provider alongside words and devices. That new types of marks are called non-conventional trademarks since they have unique nature, which appeal to all five basic senses of a human: taste, touch, sight, hearing and smell. These marks have greatly favored businesses since now consumers may recognize their goods and services even without seeing them.

Nevertheless, in order to monopolize usage of a certain mark and prevent competitors from unauthorized use of it, proprietors are required to obtain registration of the sign. The registration is conducted by a state body and has territorial nature, which means that a proprietor is granted with exclusive rights only within that state. Consequently, despite growing globalization and adoption of international treaties in the sphere trademark law, each state has its own approach as to registrable signs and the registration process, including the United States of America and Member States of the European Union. Among general registration requirements, representation of a mark in the application, distinctiveness and non-functionality requirements are considered as the main obstacles on the way of registration of non-conventional trademarks and directly influence registrability thereof. Content of these aspects differs not only from state to state, but also from one non-conventional mark to other.

Taking into account that the huge European Trademark Reform, which brought substantial changes to the whole European trademark system, took part in 2015 and the main provisions thereof are applying from 2017, it is relevant now to analyze the consequences thereof for registrability of non-conventional trademarks, in particular what may be registered and how. Moreover, the reform package made the EU trademark system somewhat similar to the one in the USA, especially, as regards the aforesaid three obstacles. Therefore, it is crucial to conduct a comparative analysis of both approaches to registrability of non-conventional marks so that to identify pros and cons of each of them and determine how registration of non-conventional trademarks may be made more efficient and accessible therein.

Problem of research

There are around 200 states in the world at the moment and probably most of them has trademark laws with its specifics. At the same time, some trademark law amendments and reforms may intentionally or not make one trademark system similar to the other. As one of the vivid examples is European trademark system after the European Trademark Reform and the existing US trademark system in the context of non-conventional trademarks registrability and registration process thereof. Still, it unclear to what extent the approaches of these systems are similar, what the differences are and what pros and cons each of the systems has. Having clarified that aspects, it is necessary to answer the following question: may the US and the EU approaches be improved so that to make registration of non-conventional marks more accessible and efficient?

Relevance of the final thesis

The EU Trademark Reform was an imminent step towards making the trademark legislation consistent with the needs of a modern business. Despite the fact that the main legal provisions are effective since 2017, there are still some shortcomings in both the regulation and its practical application. The thesis is particularly topical for identification such drawbacks and finding the ways of elimination thereof through comparison the EU system with the system operating in the US, which is now especially relevant in the context of non-conventional marks registrability and the registration process thereof. In addition, the thesis identifies drawbacks of the US system as well and proposes ways of elimination thereof.

Scientific novelty and overview of the research on the selected topic

The topic of the research is a comprehensive work which investigates the approaches of the US and EU to registrability of non-conventional marks through lens of three most burdensome requirements therefor: representation of marks in the application, non-functionality and distinctiveness requirements. The thesis further proceeds to comparative analysis of how the requirements are applied in both systems in practice using 4 visual and 4 non-visible marks as a basis for research. In the course of the investigation the work identifies certain advantages and drawbacks of each system and proposes ways of improvement thereof as regards registrability of non-conventional marks and the registration process thereof.

The topic is poorly investigated since there are scientific works which have analysed only certain fragments of the work, i.e. separate requirements in general or separate types of non-conventional marks without putting focus on comparison the US and the EU systems and identification pros and cons of the states' approaches as well as proposing certain amendments thereto. In particular, the works of the following authors contain analysis of separate requirements towards non-conventional marks in the US: Kenneth L. Port²⁵, Roxana Sullivan³⁰, Jerome Gilson and Anne Gilson LaLonde²⁴; at the same time, the following scientists have analyzed that aspect in the EU: Yaroslava Kudrina⁴⁸, Cesar J. Ramirez-Montes⁶⁵ and Luis H. Porangaba¹⁹. In addition, the following authors have conducted analysis of certain types of non-conventional marks in the US: Tyler M. Seling⁹⁹, Franco Galbo¹⁵⁶, Nick Greene¹⁵⁷ and Jay M. Burgett¹⁶⁶; and the following researchers have investigated that aspect as regards the EU system: Jekaterina Kudrjavceva²⁰⁴, Candida J. Hinton¹⁷⁷ and Eleonora Rosati²¹⁶.

Significance of research

The research pours the light on the issue of registrability of non-conventional marks in the US and the EU systems by investigating the main hurdles on the way of non-conventional marks registration, that are put by the legislation and how the requirements are applied in practice in general as well as in the context of four visual and four non-visible marks. Furthermore, the work determines advantages and shortcomings of the US and the EU approaches and purports to define the ways of elimination thereof.

The thesis creates a ground for further development of legislative and practical approaches to registrability of non-conventional marks in the US and the EU and the relevant registration process. It further describes which advantages of one system may be useful for

elimination of drawbacks of the other and why it is recommended to make the necessary steps towards improvement of these aspects. Moreover, the work is particularly helpful for businesses registering non-conventional marks in the US and the EU since it explains the main hurdles which may appear on the way of registration process. It also recommends how they may be resolved in general and in the context of the selected 8 non-conventional marks.

The aim of research

The aim of the research is to find ways of improvement of non-conventional trademarks position in the EU and the US by comparative analysis of their place in the relevant law systems from legislative and practical sides.

The objectives of research

The research seeks to achieve the following objectives:

1. to determine the level of harmonization of non-conventional marks regulation presented by the key international trademark treaties to which the EU and the US are members;
2. to analyze the domestic regulation of the marks in the US and the EU by determining and comparing what can be a trademark, how it must be represented in the application and how the non-functionality and distinctiveness requirements are applied;
3. to determine how non-conventional marks registration process takes place in practice in the US and the EU by analyzing registrability of 4 visual and 4 non-visible marks and comparing the approaches of the systems thereto.

Research methodology

In the present thesis, analytical method is used for the analysis of the relevant international and domestic legislation as regards non-conventional marks; description method is used for presenting the relevant case law; critical method is used for evaluation of legislative provisions and their practical application, consistency and effectiveness thereof; comparative method is used for comparison of the EU and the US` approaches to the issues analyzed in the thesis; systematic method is used for systematization of the collected data and drawing conclusions.

Structure of research

The thesis is divided into the two chapters, which are further split into smaller parts.

The first chapter introduces legal regulation of non-conventional marks on the international level and explains how key international agreements and the related acts regulate the non-conventional trademarks registrability issue. Further, the research presents the domestic non-conventional-trademark-related legislative provisions of the US and the EU and explains the main obstacles on the way of non-conventional trademarks registration: representation of the marks in the application, non-functionality and distinctiveness requirements. Throughout the analysis of the domestic provisions comparison of the US and the EU legislators' approaches is conducted revealing its pros and cons and determining reasons thereof.

The second chapter is dedicated to comparative analysis of practical application of the EU and the US legislative provisions as to registrability of non-conventional marks by the IP Offices, courts and trademark applicants. The research is conducted in the context of the obstacles scrutinized in the first chapter and grounded on the case law, doctrine, procedural rules and recommendations of the EU and the US IP Offices. Four visual and four non-visible non-conventional marks are used as a basis of this research. Throughout the analysis, advantages and drawbacks of both of the systems' practical approaches are revealed and reasons thereof are determined.

Defence statements

Having conducted the comparative analysis of the approaches to non-conventional trademarks registrability in the EU and the US, it can be inferred that both systems has certain advantages and shortcomings, which are either related to legislator's approach reflected in the domestic legislation or to practical application thereof. These shortcomings may be eliminated by amendment of the relevant legislative rules and further development of the practice.

LIST OF ABBREVIATIONS

CJEU	–	Court of Justice of the European Union
EUIPO	–	European Union Intellectual Property Office
EUTMIR	–	Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431
EUTMR	–	Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
IP	–	Intellectual property
OHIM	–	The Office for Harmonization in the Internal Market
TESS	–	Trademark Electronic Search System
TRIPS	–	The Agreement on Trade-Related Aspects of Intellectual Property Rights
TSDR	–	Trademark Status & Document Retrieval
TTAB	–	Trademark Trial and Appeal Board
USPTO	–	The United States Patent and Trademark Office
WIPO	–	World Intellectual Property Organization

1. REGULATION OF NON-CONVENTIONAL TRADEMARKS IN THE USA AND THE EU ON INTERNATIONAL AND DOMESTIC LEVELS

There are around 200 countries in the world and each of them has its own history, culture and law. This leads to the situation, where enormous number of trademarks law exists simultaneously with its own peculiarities and subject matter. Some of them accepts for registration only words and devices, others – also any other signs. In that patchwork trademark world one of the most important instruments in approximating and harmonizing trademark laws of states are international agreements. The US and the EU, as a specific *sui generis* organization, are members, among others, of the Paris Convention, the TRIPS and the Madrid Protocol. These acts aim to harmonize protection of trademarks worldwide and provide a framework for international trademark registration. Thus, the following chapter begins with analysis of the existing international trademark regulation in the context of non-conventional marks registrability and then proceeds to scrutinizing and comparing the place of these marks in the domestic trademark laws of the EU and the US, which are operating in accordance to aforementioned international instruments. While conducting the research of the domestic regulation, three main obstacles on the way of non-conventional marks registration will be used as a basis of the comparative analysis.

1.1. International Dimension

1.1.1. Non-conventional Marks in the TRIPS. Interconnection of the Agreement with the Paris Convention

One of the first attempts to articulate on international level what can constitute a trademark was the process of the Paris Convention adoption. However, it has not succeeded.¹ The reason behind absence of the definition in the Convention was later explained by representatives of the International Association for the Protection of Intellectual Property during the Congress of Washington in 1956. In particular, it was argued that it has not been appropriate

¹ Roberto Carapeto, “A Reflection About the Introduction of Non-Traditional Trademarks,” *Waseda Bulletin of Comparative Law* 34 (2016): 28.

under the circumstances of that time to introduce a general definition of a trade mark in the Convention.² That statement may also be corroborated by the fact that countries of that time had way too big differences in regulation of a trademark issue and understanding what can be a trademark. Thus, the very purpose of facilitating and streamlining the international registration of trademarks could be hampered by additional debates on that matter. At the same time, the Convention provides in article 6(1) the following: *“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation”*³. Thus, it does not exclude non-conventional trademarks from the protection granted thereunder and leaves it up to Member States to decide whether to grant protection to such marks or not.

Despite the fact that mechanism of trademark registration had been raised to the international level by Paris Convention more than a hundred of years ago and thereby had provided a legal framework for global trademark management, e.g. basic rules for the registration abroad, conventional priority for filing a trademark in a country other than a country of origin, etc., absence of a definition of a trademark still has been a lacking piece of puzzle, which was essential for efficient protection of non-conventional trademarks. The main objective of setting up such a generally accepted definition has been seen as creation of a concept that could encompass all types of trademarks eligible for protection within individual Member States.⁴

The indicated problem was solved only in 1994 with enactment of the Agreement on Trade-Related Aspects of Intellectual Property Rights. Article 15.1 of the said Agreement provides that *“Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark”*.⁵ That definition made clearer the understanding of what can be a trademark and indicated the main feature, which a trademark should have to be eligible for legal protection. Namely, a trademark should be capable of distinguishing the goods or services of one undertaking from those of other undertakings. Such capability can be inherent or acquired over time through usage. The verbal element *“any sign”* of the definition unambiguously shows that it could be any means capable of distinguishing one goods and services from others. As for me,

² “Should a definition of trade marks be introduced into the Convention?,” AIPPI, Accessed 26 November 2019, <https://www.aippi.fr/upload/Q1%20-%2089%20/rs6english.pdf>.

³ “Paris Convention for the Protection of Industrial Property,” WIPO, Accessed 27 November 2019, <https://wipolex.wipo.int/en/text/287556>.

⁴ Qian Zhan, “The International Registration of Non-traditional Trademarks: Compliance with the TRIPS Agreement and the Paris Convention,” *World Trade Review* 16(01):1-30 (2017): 113.

⁵ “Agreement on Trade-Related Aspects of Intellectual Property Rights,” WTO, Accessed 27 November 2019, https://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

such way of wording preserves actuality of the definition for the future, when new types of trademarks may appear due to rapid progress in technologies and other relevant spheres.

Article 15.1 also provides the list of signs that may constitute trademarks: “*Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks*”.⁶ The list contains only one type of non-conventional trademarks namely, “*combinations of colours*” and no other kinds are indicated. Thus, it is necessary to emphasize the presence of the element “*in particular*” which shows that the list should be treated as exemplary and non-exhaustive. In addition, absence of other kinds of non-conventional marks may mean that they are “weak signs”, which distinctiveness is generally not inherent, but that should not be understood as implying that Member States may refuse providing legal protection to these types of marks only because they are not listed in article 15.1 of the TRIPS.⁷ Therefore, any type of non-conventional marks is covered by article 15.1 of the TRIPS provided they are capable of distinguishing one goods and services from others.

As understood from wording of article 15 of the TRIPS, it provides a minimum set of requirements towards a sign to be eligible for trademark protection thereby leaves a room for Member States for further development of their national trademark laws taking into account specifics of the domestic legal systems. That discretion to elaborate own detailed rules for registration of marks should not contradict the established rules by the article. One of examples of such flexibility is the article 15.1. : “*Members may require, as a condition of registration, that signs be visually perceptible*”. According to that provision Member States may make trademark registrability contingent upon visual perceptibility thereof. As a consequence, non-visual signs, such as texture marks or taste marks, may be excluded from trademark protection *per se* and no level of distinctiveness will be even evaluated. Nevertheless, that rule is only optional and it is up to Member States to incorporate it in their domestic legislation or not. Moreover, the article also provides that Members has a discretion as regards introduction of acquired distinctiveness requirement where the signs are not inherently distinctive.⁸

In conclusion, it is necessary to underline that both the Paris Convention and the TRIPS are playing a crucial role in international protection of non-conventional trademarks. While Paris Convention does not directly mention the trademarks as a subject of its regulation, it does not exclude it either. Thus, all the provisions as to trademark protection are applicable to all

⁶ See note 5 above.

⁷ Zhan, “The International Registration of Non-traditional Trademarks”, 115.

⁸ TRIPS.

registrable signs in the relevant Member States. As for the TRIPS, it became the first international instrument that introduced the definition of trademark and emphasized that anything may be a trademark provided it is capable of distinguishing goods and services. Furthermore, the article 2 of the TRIPS stated that both instruments are operating together and each one serves a complementary role towards the other when it is necessary.⁹ Therefore, legal and natural persons can avail themselves of provisions of both the legal instruments in order to provide their non-conventional trademarks with a highest available level of protection not only in their home country, but also in other Member States.

1.1.2. Non-conventional Trademarks Under the Madrid System. Current Changes Regarding Non-Conventional Marks

Currently, a trademark owner desiring to register its trademark in different jurisdictions can either file a separate application in each country of interest or use the international system of trademark registration. The latter is established by Madrid Agreement Concerning the International Registration of Marks (the Madrid Agreement) and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Madrid Protocol). Notwithstanding the name, the Madrid Protocol is an autonomous instrument and not just a protocol to the Madrid Agreement. Moreover, the Madrid Protocol was established almost one hundred years after enactment of the Madrid Agreement (in 1989) and eliminated a lot of shortcomings of the latter. The EU and the US are members of the later.¹⁰ However, neither the Madrid Agreement nor the Madrid Protocol do not contain any specific provisions as to non-conventional marks.¹¹

At the same time, rule 9 of Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks contain references to a few non-traditional marks in the context of representation requirements concerning international applications. Among others, the rules as to three-dimensional marks, sound marks and color

⁹ See note 8 above.

¹⁰ Vicenç Feliú, "International Trademark Law – The Madrid System," Hauser Global Law School Program. Accessed 28 November 2019, https://www.nyulawglobal.org/globalex/International_Trademark_Law.html#_The_Madrid_Agreement.

¹¹ "New Types of Marks and New Means of Representation," WIPO, Accessed 28 November 2019, https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_16/mm_ld_wg_16_4.pdf.

marks are envisaged.¹² Thus, visual non-conventional marks are directly mentioned as the ones that may be applied. But what about non-visible ones?

The answer on that question can be found in reports of Working Group on the Legal Development of the Madrid System for the International Registration of Marks. Especially, the current tendencies were discussed on sixteenth and seventeenth sessions. During the sixteenth session the Delegations of the European Union and the Member States thereof underscored the necessity of new types of signs discussion and mediums for representation thereof since they are members of both the European Union and the Madrid Union and it is crucial for them to have the same rules and criteria for registration of international and European marks by means of the Madrid system. Such cruciality arose due to abolition of graphical representation requirement for registration of European Union trademark. In particular, modernization of Rule 9 of the above-mentioned Common Regulations was proposed so that to enable registration of non-conventional trademarks which are not capable of being properly represented in the international application form provided in the Rule 9. Such proposal was also supported by other Delegations such as the ones of Israel, Australia, Moldova, and Mexico. The US remained silent in the discussion.

The Chair of the Session proposed two ways of solving the situation above. The first was to conduct a survey in each Member State regarding domestic rules as to the representation of a mark in the application and discuss the collected information on the next session as well as possible amendment to Rule 9 of the Common Regulations. The second was to prepare proposals for amendments to the Rule 9 by the Members without conduction of the survey.¹³ Such proposals are to be related to introduction of rules as to types of trademarks other than those already present in the Rule and modification of the graphic representation requirement.¹⁴ The proposal concerning the questionnaire was supported given it would be useful to better understand the position of non-conventional marks in the domestic law of the Member States before introduction of any amendments to Rule 9.¹⁵ Additionally, the Working Group requested preparation of a document presenting possible amendments of Rule 9 by International Bureau of WIPO.

¹² “Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks,” WIPO, Accessed 28 November 2019, <https://wipolex.wipo.int/en/text/545522>.

¹³ “Report on Sixteenth Session,” WIPO, Accessed 28 November 2019, https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_16/mm_ld_wg_16_12.pdf.

¹⁴ “New Types of Marks and New Means of Representation”.

¹⁵ “Report on Sixteenth Session”.

The International Bureau received 82 replies to the survey and then prepared the document containing possible changes to Rule 9 on the basis of the questionnaire.¹⁶ That document proposed possible amendments pertaining to non-visual marks, which were mainly related to abolition of graphical representation or modification thereof.¹⁷

After the discussion of the proposals during the seventeen session of the Working Group, the Member States agreed with such changes and requested the International Bureau to prepare a document proposing concrete amendments to Rule 9 of the Regulations as regards: (1) new means of trademarks representation; (2) flexibilities that would enable applicants to comply with new requirements in relevant Designated States. In addition, the Working Group requested provision of information concerning proposals of solving the practical consequences of the aforesaid amendments for technology infrastructure of the International Bureau and of the Member States' Offices.¹⁸

The document will be presented for discussion on the next session of the Working Group in approximately July, 2020. If the amendments are supported by the Member States, they will be incorporated into the Regulations and, therefore, change the way how marks can be registered through the Madrid System and include non-visible marks as the registrable subject matter.

To sum up, it can be underlined that despite absence of the provisions related to non-conventional marks in the Madrid Agreement and the Madrid Protocol, there are also no provisions limiting the scope thereof only to conventional marks. Moreover, the Common Regulations mentions requirements as to content of international applications in relation to color, three-dimensional and sound marks thereby confirming that they are within the scope of the Madrid System. Nevertheless, there are still a number of uncertainties as to international registration of non-visible marks, the Working Group is seeking to solve.

1.2. Domestic Dimension

1.2.1. Registration of Non-conventional Trademarks in the USA. The sky is the limit?

¹⁶ "Findings of the Survey on Acceptable Types of Marks and Means of Representation," WIPO, Accessed 29 November 2019, https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_4.pdf.

¹⁷ "Possible Amendments to Rule 9 of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement." WIPO. Accessed 29 November 2019. https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_8.pdf.

¹⁸ "Summary by the Chair," WIPO, Accessed 29 November 2019, https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_11.pdf.

Comparing to traditional marks, non-conventional ones have specific nature since they appeal to all senses of human. Still, such marks have to meet requirements imposed by law in order to be registered. The same is also relevant for the United States, where the procedure is in hands of the USPTO. If a non-conventional mark owner desires to obtain the registration for his mark there, it should conform to the conditions provided by the Lanham Act. The Lanham Act was adopted on July 5, 1946 for fostering interstate commerce¹⁹ and serves now as the federal statute that governs trademarks, service marks and also issues related to unfair competition. The Lanham Act sets out rules as to registrable marks, the registration process on the federal level, indicates when trademarks` owners may be entitled to federal judicial protection against infringement of their trademark rights, and establishes other guidelines and remedies for owners of marks.²⁰ In particular, it indicates what can constitute a trademark:

“The term “trademark” includes 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”²¹.

Thus, according to the definition cited, the protection of marks is associated with the signs that can serve as source identifiers and thus it encompasses non-traditional marks as eligible for protection by means of not excluding them in the very definition.²² That conclusion was also supported in 1995 by the Supreme Court of the USA in the findings in the case *Qualitex v Jacobson Prods*, which was connected to protection of the color mark. In particular, the court stated that that *“The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks “includ[e] 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”*.²³

¹⁹ Luis H. Porangaba, “Acquired distinctiveness in the European Union: when nontraditional marks meet a (fragmented) single market,” *Trademark Reporter* 109 (2019): 659.

²⁰ Julian L. Bibb IV, “The Lanham Act Has Broader Scope Than Domestic and Foreign Trademark Owners May Realize,” *INTA*, Accessed 1 December 2019, https://www.inta.org/INTABulletin/Pages/Feature_01_7420.aspx.

²¹ “The Lanham act,” *Cornell Law School*, Accessed 2 December 2019, <https://www.law.cornell.edu/uscode/text/15/1127>.

²² “Non-Traditional Marks at the U.S. Patent and Trademark Office,” *WIPO*, Accessed 2 December 2019, https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf.

²³ “*Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995),” *JUSTIA*, Accessed 5 December 2019, <https://supreme.justia.com/cases/federal/us/514/159/>.

Such interpretation of the definition was considered as a stunning breakthrough for non-traditional trademarks at that time and drastically changed the ratio between conventional and non-conventional applied before the decision and after thereof.²⁴ In fact, in the first 48 years of the Lanham Act being in force, there were 93 filed non-traditional marks (approximately 2 per year). In the subsequent 14 years after the decision, the number increased to 688 applications for such marks (approximately 49 per year).²⁵ That fact shows us that an explosion of the interest in non-traditional trademarks happened and much more persons became concerned about protection of not only their word and device signs, but also other types of marks, which registrability was previously in doubt.

Still, in order to obtain protection for a non-conventional mark it is not enough only to apply it for registration. The Lanham Act does not contain a separate registration procedure for these marks; thus, they should meet the same conditions as conventional marks. For the purpose of clarity, it is necessary to underline that there are two separate registers in the USA: the Principal Register and the Supplemental Register (The main difference is that non-distinctive marks may be registered only on the Supplementary Register). The first one is the default option and all trademark applications are filed for registration thereon unless otherwise is directly stated in the application. Therefore, all the further procedure is mostly relevant for trademarks, which are filed on the Principal Register.²⁶

A. Representation of a non-conventional mark in the application

One of the first hurdles a non-conventional trademark application encounter with is representation of the mark in the application. The main purpose behind that is to provide information about nature of the applied mark to the appointed examiner and other interested parties. If a non-conventional mark is applied, the following rules are provided by U. S. Trademark Law Rules of Practice & Federal Statutes for their representation:

“(2) Three dimensional marks. If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three dimensional.

(3) Motion marks. If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the

²⁴ Jerome Gilson and Anne Gilson LaLonde, “Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks,” *TMR* 95 (2005):782, <https://www.brinksgilson.com/files/141.pdf>.

²⁵ Kenneth L. Port, “On Nontraditional Trademarks,” *38 Northern Kentucky Law Review* 1 (2012): 3.

²⁶ “The Lanham act”.

movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark’’²⁷

Having regard to sound, scent, and other non-visual marks, the drawing area is to be left empty. However, the applicant must submit a detailed description of the mark instead of a drawing.²⁸ In addition, it is necessary to prepare a description of the all other marks as well. The description must contain precise, accurate and relevant information as to what the mark comprises. It is especially relevant when a drawing is not capable of depicting all essential characteristics of the applied mark and the applicant must outline them in the description. Furthermore, the specimens are also required for showing how the mark is used or intended to be used as regards each applied class of goods and services.²⁹

If an application was accepted the standard examination procedure applies. Still, while registrable in theory, non-conventional signs undergo in-depth scrutiny and encounter unique obstacles during the examination, namely distinctiveness and non-functionality requirements.³⁰

B. Distinctiveness requirement

Distinctiveness of a mark is a quality of being able to distinguish goods and services of one undertaking from goods and services of the others. It can be inherent or acquired one. The first is present when the mark is *prima facie* registrable, for instance, contains a completely made-up or fanciful sign which has no meaning or such meaning is not descriptive for the relevant goods or services.³¹ The second one is when a mark does not have such intrinsic source-identifying nature and became distinctive in commerce due to usage thereof, and, thus, consumers associate it with a particular origin or source.³² The same is also indicated in Section 2 of the Lanham Act, which lies down the grounds for refusal in registration of a mark on the Principal Register. In particular the point (f) provides that “...*nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce*”.³³

²⁷ “U. S. Trademark Law Rules of Practice & Federal Statutes,” USPTO, Accessed 5 December 2019, https://www.uspto.gov/sites/default/files/documents/trademark_rules_statutes_2018-1-1.pdf.

²⁸ See note 27 above.

²⁹ “Non-Traditional Marks at the U.S. Patent and Trademark Office”.

³⁰ Roxana Sullivan, “Non-traditional trademarks through the lens of the USPTO,” IAM, Accessed 9 December 2019, <https://www.iam-media.com/non-traditional-trademarks-through-lens-uspto>.

³¹ Anita Mar, “Trademarks: Is The Standard of Distinctiveness The Same All Over The World?” Trademark angel, Accessed 28 December 2019, <https://trademarkangel.com/standard-of-distinctiveness-around-the-globe/>.

³² “Trademark Manual of Examining Procedure October 2018,” USPTO, Accessed 28 December 2019, <https://mpep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e10316.html>.

³³ “The Lanham act”.

Having regard to non-conventional marks, they usually do not have inherent distinctiveness since it is almost impossible to prove, for instance, that a particular color of boxes is capable of distinguishing them from boxes of other producers and identify the origin. Thus, in order to register such mark it is crucial to make a relevant indication in the application of applying the Section 2(f) of the Lanham Act, which shows that your mark's distinctiveness is based on the acquired recognition in commerce or it is possible to make such claim later during subsequent prosecution of the mark. The evidence proving it should be also provided.³⁴ The amount of evidence required depends on the nature of the mark and the character of the evidence, which can be direct (e.g. consumer surveys) or indirect (e.g. supply and distribution contracts, promotional materials).³⁵ Thus, for the instance indicated earlier, it is necessary to prove that that particular color of boxes is strongly associated with the particular source of origin and consumers perceive it not as merely a feature of the good, which makes the box more appealing, but as a sign referring to the manufacturer thereof.

C. Non-functionality requirement

The second issue, which poses an obstacle for registration of non-conventional mark, is functionality. Functionality is directly indicated in Section 2 of the Lanham Act as one of the grounds for refusal in registration: *"No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ...(e)(5) comprises any matter that, as a whole, is functional"*.³⁶

Moreover, functionality may still pose a danger even if the mark is not considered as functional by the examiner since it is also indicated in the Lanham Act as ground for oppositions to the mark registration, which may be filed by third parties and cancellation of the legal protection if initially granted.³⁷

Functionality doctrine works as a buffer between patent and trademark law by precluding players on the business field from monopolizing a useful feature of a product under façade of identifying that feature as the source of origin of such product.³⁸ As a rule, a feature of the mark

³⁴ Matthew D. Asbell, "Acquired Distinctiveness of Trademarks in the United States," Ladas, Accessed 29 December 2019, <https://ladas.com/education-center/acquired-distinctiveness-trademarks-united-states/>.

³⁵ Sullivan, "Non-traditional trademarks through the lens of the USPTO".

³⁶ "The Lanham act".

³⁷ See note 36 above.

³⁸ Sullivan, "Non-traditional trademarks through the lens of the USPTO".

is functional if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article”.³⁹.

There are two branches of functionality: utilitarian and aesthetic. Utilitarian functionality is necessary to avoid situations, when a manufacturer monopolizes useful features of the product and thereby puts other manufacturers of the same type of good into disadvantageous position and hinders a fair competition on the market.⁴⁰ In other words, that doctrine ensures that protection of utilitarian features of a product be sought through a limited in time utility patent (a type of patent which protects any useful process, manufacture, composition of matter, etc.⁴¹) under expiry of which it becomes available for public. Otherwise, the feature may be monopolized forever by perpetual prolonging the trademark registration.

If any owner of non-conventional sign seeks registration thereof as a trademark, there are factors which should be reviewed in order to determine whether a mark may be considered as functional in utilitarian way: (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered; (2) advertising by the applicant that touts the utilitarian advantages of the design; (3) facts pertaining to the availability of alternative designs; and (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

These factors were introduced in *In re Morton-Norwich Products, Inc.* case and they have detailed the conclusion of the court in *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, as to presence of utilitarian functionality. The case mentioned related to the dispute as to whether to grant protection to the dispenser-shaped three-dimensional mark. After assessment of the factors indicated above, the court eventually held that the design can be protected as a trademark due to availability of alternative forms that are not less advantageous.⁴² It is worth noting that these criteria are relevant for other types of marks as well.

The second type is called aesthetic functionality. It focuses on whether a product feature makes it more desirable due to the way it looks, and not how it performs as checked by the first functionality test.⁴³ For instance, when goods are bought largely for their aesthetic value, their

³⁹ “*Traffix Devices, Inc v. Marketing Displays, Inc.*, 532 U.S. 23 (2001),” JUSTIA, Accessed 29 December 2019, <https://supreme.justia.com/cases/federal/us/532/23/>.

⁴⁰ Gilson and Gilson LaLonde, “Cinnamon Buns, Marching Ducks”, 787.

⁴¹ Joe Runge, “The Utility Patent: What Is It and What Does It Protect?” Legal Zoom, Accessed 3 January 2019, <https://www.legalzoom.com/articles/the-utility-patent-what-is-it-and-what-does-it-protect>.

⁴² “*In re Morton-Norwich Products, Inc.*” Casetext, Accessed 3 January 2019, <https://casetext.com/case/in-re-morton-norwich-products-inc>.

⁴³ Robert D. Litowitz and Linda K. McLeod, “To Create and Own a Nontraditional Trademark, Just Follow Tradition,” American Bar, Accessed 5 January 2019, https://www.americanbar.org/groups/intellectual_property/law/publications/landslide/2017-18/january-february/create-own-nontraditional-trademark-just-follow-tradition/.

features may be considered functional if they mainly contribute to that value and aid selling the goods or services. In a case of a candy box in the shape of a heart, that shape may be functional because of significance thereof for a gift for beloved ones.⁴⁴

In order to better understand how aesthetic functionality works, it is appropriate to briefly review the dispute between *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, which arose over legality of registration of red color for marking the Louboutin's goods, in particular, soles of shoes. The claimant, Christian Louboutin S.A., tried to find the other party, Yves Saint Laurent fashion house, infringing the rights to the mentioned trademarks due to manufacturing of completely red shoes, including soles thereof. In response Saint Laurent tried to cancel the registration of the Louboutin's mark on aesthetic functionality ground stating that the mark is purely ornamental and poses a significant hinder for both the fashion and arts industries. The first instance court favored the defendant, but Louboutin then appealed.⁴⁵

The Second Circuit court revised the decision and indicated, in particular, that it was in conflict with the Supreme Court's endorsement of single-color marks in *Qualitex* and, thus, the protection of the Louboutin's red color was granted in accordance with the law and Saint Laurent can use red color only for coating a whole shoe, not exclusively the sole thereof. But more importantly, the court explained when aesthetic functionality is present. The court held that a mark is aesthetically functional and thus cannot be protected by trademark law if “(1) the design feature is essential to the use or purpose of the article, (2) the design feature affects the cost or quality of the article, and (3) protecting the design feature would significantly undermine a competitor's ability to compete”.⁴⁶

It is noteworthy that both branches of functionality are complementary and are checked while examining any trademark, especially non-conventional ones. Still, presence of both aesthetic and utilitarian functionality is not necessary for refusal in registration; it is enough to ascertain presence of at least one of them.

So by and large, it is important to reiterate that any sign may be registered as a trademark in the USA. However, it is necessary for it to meet all the requirements imposed by law and, moreover, the applicant should show his intention to use the filed mark or that it is already in use in commerce. Having regard to non-conventional marks, the requirements are identical as for

⁴⁴ “Trademark Functionality: Job's Daughters Has Risen Again!” Fish & Richardson, Accessed 5 January 2019, <https://www.fr.com/files/Uploads/attachments/trademark/20110505-TrademarkFunctionalityOutline.pdf>.

⁴⁵ “Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.” Casetext, Accessed 5 January 2019, <https://casetext.com/case/christian-louboutin-sa-v-yves-saint-laurent-am-inc>.

⁴⁶ “Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.” H2o, Accessed 5 January 2019, <https://h2o.law.harvard.edu/cases/4776>.

traditional marks. Nevertheless, it is vital for a non-conventional trademark owner to prepare a proper presentation of the applied mark in the application alongside with other elements taking into account all the requirements of law and recommendations of USPTO. Moreover, functionality and distinctiveness requirements also poses danger for non-traditional marks, which a huge part of mark do not overcome due to absence of either inherent nor acquired distinctiveness and/or because of being functional in utilitarian or aesthetic way. The extent to which a mark meets the registration requirements also influence the register on which it can be registered. It is either the Principal Register or the Supplementary Register.

1.2.2. Registration of Non-conventional Trademarks in the EU. Overcoming Exorbitant Requirements

Unlike the United States, the European Union is not a federation divided on states, but a *sui generis* international organization comprising 27 Member States, which “*have limited their sovereign rights and have thus created a body of law which binds both their nationals and themselves*”.⁴⁷ Such limitation has drastically influenced different spheres of life, including intellectual property area. As one of the results of that influence, the European Union trademark system was established in 1996. The system’s purpose was to produce an alternative for national trademark protection limited by boundaries of each Member State,⁴⁸ and the goal was achieved by creation of a European Union trademark, which is now regulated by European Trade Mark Regulation 2017/1001 (EUTMR). In addition, in order to harmonize substantive provisions of the Member States’ trademark laws and balance the trademark systems at national and Union level, the Trade Mark Directive 2015/2436 (TMD) has been enacted by the European Parliament and of the Council.⁴⁹ The both acts are currently governed by the European Union Intellectual Property Office (EUIPO).

It is crucial to note that the above-mentioned legal acts are a result of the recent European Trademark Reform which brought substantial changes to the whole European trademark system. The reform package contained a wide range of innovations, including those related to the

⁴⁷ “Flaminio Costa v ENEL, Case 6/64,” EUR-Lex, Accessed 9 January 2020, <https://eur-lex.europa.eu/legal-content/EN/ALL/?uri=CELEX%3A61964CJ0006>.

⁴⁸ Yaroslava Kudrina, “Non-Traditional Trade Marks And The Abolition Of The Requirement For Graphical Representation - EU Trade Mark Registration Process” (master thesis, Stockholm University, 2018), 14, <http://www.diva-portal.se/smash/get/diva2:1195299/FULLTEXT01.pdf>.

⁴⁹ “Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks,” EUR-Lex, Accessed 13 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32015L2436>.

trademark registration procedure.⁵⁰ Nevertheless, despite the changes, applicants of both traditional and non-traditional marks are obliged to follow the same procedural requirements. First, you file an application for registration of a mark, then it undergoes the examination, and, if the mark meets the requirements, the protection is granted. However, the main obstacles the marks encounter are specific. Similarly to the USA approach, it will be necessary for an owner of the mark to overcome the following hurdles: representation of the mark in the application, distinctiveness requirement and non-functionality test. Still, each of them has its own peculiarities, which are explained below.

First of all, it is paramount to understand what signs may now constitute a trademark in the EU and how the European Trademark Reform changed the approach to the very definition thereof. According to article 1 of the updated EUTMR (as well as to article 3 of TMD):

“An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”⁵¹

Thus, the EUTMR accept all signs which are capable to meet these two requirements as potentially registrable. In order to analyze the second requirement, it is necessary to compare the new trademark definition with the old one: *“A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”*.⁵² As evident now, the graphical representation requirement has been eliminated and the legislator adopted the new approach towards representation of marks, which is scrutinized further.

A. Representation of a non-conventional mark in the application

⁵⁰ “EU trademark reform – Issues,” DLA Piper, Accessed 13 January 2020, <https://www.dlapiper.com/en/russia/focus/eu-trademark-reform-issues/#0>.

⁵¹ “Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark,” EUR-Lex, Accessed 13 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>.

⁵² “Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark,” EUR-Lex, Accessed 14 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A32009R0207>.

First of all, the change as to elimination of graphical requirement occurred since it was no longer up-to-date due to development of new ways of filing a trademark application (e.g. e-filing, fax) and also appearance of novel types of trademarks, a part of which could not be graphically represented. For instance, if you were filing a sound mark, it was still possible to represent it by musical stave,⁵³ but if you were the owner of a tactile mark or olfactory mark, no possible way out could be found.

As for now, a filed mark may be represented in the application by any means, which would allow the mark to be represented on the Register, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. It is also necessary to underline that there is only one register for trademarks in the EU unlike the US with the two ones which provide substantially different benefits for a trademark owner.

Furthermore, as representatives of the European Commission have stated, the new definition is also meant to be not only flexible so that to make registration of non-conventional marks easier, but also “future-proof” since it does not contain an exhaustive list of signs, which may constitute a trademark thereby allowing new types of filings that may be possible in the future due to advancements in technologies.⁵⁴

Nonetheless, despite the apparent step towards non-traditional marks permitting usage of any appropriate form of representation created by generally available technology, and thus not necessarily by graphic means, the new legislation now requires that the representation should be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.⁵⁵

It is worth pointing out that the requirements are not new and they were in use since 2002 year, when the judgement of the Court of Justice of the European Union (CJEU) on *Sieckmann* case was handed down. The case related to an olfactory mark, which was represented in the application by odour sample in a container and accompanied by the description “balsamically fruity with a slight hint of cinnamon” as well as the chemical formula “C₆H₅-CH=CHCOOCH₃”. The German IP Office having received the application was doubtful, *inter alia*, whether it meets the requirement of graphical representation in order to be registered as a trademark. Thus, it asked the CJEU if the definition of a trademark encompasses marks both capable of being represented graphically and not.

⁵³ “Shield Mark BV v. Joost Kist h.o.d.n. Memex, Case C-283/01,” EUR-Lex, Accessed 15 January 2020, <https://eur-lex.europa.eu/legal-content/GA/TXT/?uri=CELEX:62001CJ0283>.

⁵⁴ Taras Kulbaba, “EU Trademark Law Reform Series: Implications for Nontraditional Marks,” INTA, Accessed 15 January 2020, https://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx.

⁵⁵ EUTMR.

In response, the CJEU stated that: “Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective”.⁵⁶

It is important to note that neither it has been ever explained why exactly that criteria are required for the representation of a mark to be appropriate, nor how they can be determined.⁵⁷

Later on, the question how non-conventional marks should be represented in the application after the reform was answered by the Commission Implementing Regulation (EU) 2018/626 (EUTMIR), which now contain detailed rules regarding implementation of certain provisions of the EUTMR, and it is also interpreted at length in the Guidelines⁵⁸ prepared by the EUIPO. The rules present in article 3 of the EUTMIR provides guiding principles as to representation of the following marks: shape marks, position marks, pattern marks, colour marks, sound marks, motion marks, multimedia marks and hologram marks. It is noteworthy that the fact that other types of non-conventional marks are not included in the list in no way limits the marks admissible for registration, since other signs not directly indicated in the article shall fall under the category “other”. Such mark should be represented according to *Sieckmann criteria* and may be accompanied by a description and a specimen as the ones indicated in the EUTMIR. For the sake of example, the following rules as regards sound marks are present in article 3 of the EUTMIR: “...the mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation”.⁵⁹

So representation of the sound mark, for instance, by notation may be accepted if they also follow the *Sieckmann criteria*. As an example, the following mark representation was accepted by the EUIPO:



⁵⁶ “Ralf Sieckmann v Deutsches Patent- und Markenamt, case C-273/00,” EUR-Lex, Accessed 16 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62000CJ0273>.

⁵⁷ Kudrina, “Non-Traditional Trade Marks”, 21.

⁵⁸ “Guidelines for Examination of European Union Trade Marks”.

⁵⁹ “Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431C/2018/1225,” EUR-Lex, Accessed 17 January 2020, https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=uriserv:OJ.L_.2018.104.01.0037.01.ENG.

⁶⁰ The EU sound trademark under the filing number 011051951 registered in the name of Apple Inc.

To briefly sum up, the approach to reproduction of non-conventional marks taken by the EU legislator is very similar now after the Reform to the one taken by the US. However, the additional requirements known as *Sieckmann criteria* are also put forward to all marks.

Furthermore, in addition to the reproduction of mark, an application for registration may contain a description of the applied mark. The EUTMIR provides that it is allowed only for position marks, pattern marks, colour combination marks, motion marks.⁶¹ Thus, it is not necessary for other marks.

If the application for the non-conventional trademark registration meets all the formal requirements, including representation of a sign, the next steps to overcome are non-functionality and distinctiveness requirements.

B. Non-functionality requirement. Unknown peril for non-conventional marks

Functionality of a sign has been indicated in the EU legislation prior to the Reform as an absolute ground for refusal in registration only as regards shape marks. Article 7(1)(e) of the existing then CTMR had the following wording:

“1. The following shall not be registered: ...

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

(ii) the shape of goods which is necessary to obtain a technical result;

(iii) the shape which gives substantial value to the goods.”⁶²

But it was decided during preparation of the new regulation to extend the rule to other types of signs as well. In particular, it was done by adding the phrase “or another characteristic”. Subsequently, the rule got the following formulation:

“7. Absolute grounds for refusal

1. The following shall not be registered: ...

(e) signs which consist exclusively of:

(i) the shape, or another characteristic, which results from the nature of the goods themselves;

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

(iii) the shape, or another characteristic, which gives substantial value to the goods.”⁶³

⁶¹ EUTMIR.

⁶² CTMR.

The change was supposed to be a counterbalance to the above-mentioned removal of the requirement as to graphical representation from the trademark definition. Nonetheless, that change is often considered as rather a serious threat to the registration of non-conventional mark then just a counterbalance.⁶⁴

Moreover, the meaning of what is “another characteristic” is still not articulated and it may include either all types of non-conventional mark thereby becoming similar to the US approach, where functionality ground is applicable to any mark, or only to a part of them. Thus, the existing interpreting principles, doctrine or case-law was developed solely as regards shape marks. However, now it is also relevant for other marks.

As evident from comparison of the old ground formulation and the new one, there are three types of functionality: natural functionality, technical (utilitarian) functionality and aesthetical functionality. Despite the different meaning and underpinning principles, all three share the same two-fold rationale, in particular “anti-monopoly” criteria and the “demarcation” criteria. According to the first one, non-functionality requirement is intended to prevent granting an establishment a monopoly on technical solutions or functional characteristics of product, especially where a particular object has been earlier protected by another IP right. The second one has an aim of keeping separate the subject matter of trademark protection from that provided by other limited in time IP rights.⁶⁵ Thus, although the EU regulation provides for three sub-types of functionality, they share the same purpose as the two-part functionality approach of the US trademark legislation, namely to ensure fair competition on the market and delimit subject matters of trademark protection and other IP rights.

Having regard to the natural functionality, that matter has not been raised much in the court practice. According to the formulation in article 7(1)(e)(i), it means that signs that consist solely of the shape or another characteristic that results from the nature of the goods themselves cannot be registered. For instance, the realistic shape of a pineapple cannot be registered for pineapples. The same can also be extrapolated to other non-conventional marks now. Let`s say if the smell of a gum was applied for gums, or sound of engine was applied as sound mark for engines.

Until the ruling of the CJEU in *Hauck*, the exact meaning of the criteria was vague. That case related to infringement of exclusive rights to a design of a chair for children “Tripp-Trapp”,

⁶³ EUTMR.

⁶⁴ Kulbaba, “EU Trademark Law Reform Series”.

⁶⁵ Cesar J. Ramirez-Montes, “Louboutin Heels and the Competition Goals of EU Trade Mark Law,” 19 *UIC REV. INTEL. PROP. L.* 38 (2019): 42.

which was protected not only by the trademark law, but also as an artistic copyright work. When the case was referred to the CJEU with a number of questions, the court clarified in particular, that article 7(1)(e)(i) prevents from registration not only marks, which consist of signs indicated there, but extends to “*a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors.*”⁶⁶

Moreover, the provision is also applicable to “regulated” products, which shape or other characteristic is prescribed by particular legal standards.⁶⁷ For example, this may be the case for such goods as milk products. Thus, the one should not be permitted to register a creamy white color for *edible caseins*.⁶⁸

As for the technical functionality it is similar to some extent to the one used in the USA legislation. In accordance with the EUTMR, signs that consist exclusively of the shape or another characteristic of goods that is necessary for obtaining a technical result are excluded from registration. That exclusion is the most commonly used hindrance for registration of (so far) shape marks. Moreover, it was also the main ground used by the CJEU for articulation of the EU functionality doctrine in general.⁶⁹

With regard to technical functionality, *Lego* and *Remington* are two the most important judgement that provide guidelines as to the examination of functional marks⁷⁰ which may be also used by applicants of other marks now.

It its preliminary ruling on the *Remington* case, the court ruled that a mark consists exclusively of a shape necessary to achieve a technical result “*where the essential functional characteristics of the shape of a product are attributable solely to the technical result.*” Moreover, as the court stated, availability of alternative designs should not influence the decision of the examiner if functionality has been identified.⁷¹ Subsequently, the same was confirmed in the *Lego* case. In particular, the court held that the word “exclusively” must be read in the light

⁶⁶ “Hauck GmbH & Co. KG v Stokke A/S, Stokke Nederland BV, Peter Opsvik and Peter Opsvik A/S, Case C-205/13,” Curia, Accessed 18 January 2020, <http://curia.europa.eu/juris/document/document.jsf?docid=157848&doclang=EN>.

⁶⁷ “Guidelines for Examination of European Union Trade Marks”.

⁶⁸ “Directive (EU) 2015/2203 of the European Parliament and of the Council of 25 November 2015 on the approximation of the laws of the Member States relating to caseins and caseinates intended for human consumption and repealing Council Directive 83/417/EEC,” EUR-Lex, Accessed 18 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015L2203&rid=5>.

⁶⁹ Ramirez-Montes, “Louboutin Heels and the Competition Goals”, 51.

⁷⁰ “Guidelines for Examination of European Union Trade Marks”.

⁷¹ “Koninklijke Philips Electronics NV v. Remington, Case C-299/99.” Curia. Accessed 18 January 2020. <http://curia.europa.eu/juris/document/document.jsf?jsessionid=725936182898B60C89DAE1BD06765679?text=&docid=47423&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=993490>.

of the finding provided in *Remington* case and added also that “*non-essential characteristics having no technical function does not prevent a shape from being caught by that absolute ground of refusal if all the essential characteristics of that shape perform such a function*”.⁷²

Having regard to presence of the protection of the same object as the one filed for registration as a trademark, the fact that the shape concerned is, or has been, registered as a patent, or at least is, or has been subject of a patent application gives *prima facie* evidence that the elements of the shape sign, which are also specified in the patent of the patent application are intended to achieve a technical result, thus, the sign can be considered as functional.⁷³

It is also important to underline that the EU courts took the narrow way of interpretation of the “technical result” wording in contrast to the colleagues from the US. In one of the relatively recent cases, the CJEU explained that the technical functionality exclusion is restricted to the manner in which the relevant goods function and extending the exclusion to the method of manufacturing of the goods is not supported by the wording of the ground. Thus, the only important issue to determine is how the relevant consumers perceive the relevant goods, and not how they were manufactured.⁷⁴ So it is not important how, for instance, a hologram mark was produced, but rather how it is perceived by consumers of the relevant goods.

Furthermore, the *Lego* case confirmed the principle firstly introduced in *Remington* that functionality doctrine in the EU is not based on competitive necessity, but rather on the principle of avoiding undue competitive advantages which are not related to competition grounded on price and quality.⁷⁵

Thus, unlike the US approach, availability of alternative trademark variations and method of manufacturing are not that relevant as necessity of proving that all essential characteristics of a sign are used with the purpose of achieving a particular technical result. Still, the ultimate goal of avoiding undue competitive advantages is crucial in both systems. Moreover, that is also corroborated by the fact that the functionality assessment methods developed by the US courts are being cited by the EU courts. For instance, while articulating importance of existing patent or industrial designs certificates for the relevant applied signs in assessing the functionality of the

⁷² “*Lego Juris A/S v. Mega Brands*, Case C-48/09.” Curia. Accessed 18 January 2020. <http://curia.europa.eu/juris/document/document.jsf?docid=82838&doclang=EN>.

⁷³ “Guidelines for Examination of European Union Trade Marks”.

⁷⁴ “*Société des Produits Nestlé SA v. Cadbury UK*, Case C-215/14.” Curia. Accessed 18 January 2020. <http://curia.europa.eu/juris/document/document.jsf?text=&docid=167821&doclang=EN>.

⁷⁵ Ramirez-Montes, “*Louboutin Heels and the Competition Goals*”, 51.

object, the EUIPO refers to assessment criteria developed by the US Supreme Court in the *TrafFix* case.⁷⁶

The third type of functionality, the aesthetic one, is the most controversial. It provides for that the signs which consist exclusively of the shape, or another characteristic, which gives substantial value to the goods, shall not be registered. Thus, the main purpose of the ground is delimiting the scope of protection under trademark law and industrial design law.

As an example of the controversial nature of the requirement, a study prepared by Max Planck Institute as regards the EU trademark system can be named. In particular, it states that the third ingredient of the functionality doctrine could hardly assist in achieving the general purpose of the non-functionality requirement and recommends either amend it so that to allow registration of shapes, which give substantial value to goods when such sign have acquired distinctiveness through use, or to delete it at all. The reason behind such contention is that it posed an insurmountable hindrance for registration of ambitious designs that substantially different in comparison with existing designs in a particular area.⁷⁷ More recently, Advocate General Szpunar argued in his separate opinion in the above discussed *Hauck* case that aesthetic functionality is not worded clearly and that is demonstrated by the large variance in the interpretation thereof.⁷⁸

As for the *Hauck* dispute itself, it was the first case that explained the scope of the provision and when it should be applicable. What about the scope, the wording “shape which gives substantial value to the goods” is not “limited to the shapes of products having only artistic or ornamental value, as there is otherwise a risk that products which have essential functional characteristics as well as a significant aesthetic element will not be covered”. Otherwise, the main purpose of the ground would not be fully realized.⁷⁹

Having regard to the concept “value”, it should not be understood as only commercial value (e.g. price), but also it covers the “attractiveness” of the good. In other terms, if there is a likelihood that the good will be bought primarily because of the shape⁸⁰ That approach therefore can be extrapolated to other types of non-conventional marks, e.g. colors, sounds or textures.

Furthermore, pleasing nature or attractiveness of the shape or other characteristic is not enough for justification of refusal in registration, since there is no product on the modern market

⁷⁶ “Lego Juris A/S v. Mega Brands, Case C-48/09, Opinion of Mr Advocate General Mengozzi,” EUR-Lex, Accessed 19 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62009CC0048>.

⁷⁷ Kulbaba, “EU Trademark Law Reform Series”.

⁷⁸ “Hauck GmbH & Co. KG”.

⁷⁹ “Hauck GmbH & Co. KG”.

⁸⁰ See note 79 above.

that has not been subject of the relevant studies and researches before its eventual launch.⁸¹ Hence, the court provided the guidance in assessing the applicability of the aesthetic functionality. In particular, the following criteria are to be taken into account: “*the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.*”. In addition, it also should be noted that “*presumed perception of the sign by the average consumer is not a decisive element when applying the ground*”.⁸² Therefore, the said criteria may be as well applicable *mutatis mutandis* to other types of non-conventional marks.

Thus, taking into account the scope of the ground as well as the assessment criteria provided by the *Hauck* case, it can be inferred that the approach of the EU courts are somewhat similar to the one of the US courts. However, the controversial nature and absence of the consistent and well-established rules for application of the aesthetic functionality test leaves a room for further development of the ground, which may clarify how it can be applied also to other types of non-conventional marks apart from shapes.

C. Distinctiveness requirement. The wrong turn?

The third obstacle on the way of registration of non-conventional marks is the distinctiveness requirement. The requirement is explicitly indicated in article 7(1)(e) of the EUTMR, which provides that trademarks “*which are devoid of any distinctive character*” shall not be registered. At the same time, para 3 of the said article envisages that “*Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it*”.⁸³ Hence, the registration can be provided to a trademark which is either inherently distinctive and, therefore, capable of distinguishing the relevant goods or services of the applicant, or to the marks that gained the distinctiveness through use.

Taking into account the fact that some non-conventional marks are rarely considered as inherently distinctive, the ability to prove acquired distinctiveness of a non-conventional mark is sometimes a cornerstone for registration thereof. Still, the approach of the EUIPO to examining a trademark distinctiveness has not been identical since the establishment of the EU Trademark

⁸¹ “Guidelines for Examination of European Union Trade Marks”.

⁸² “Hauck GmbH & Co. KG”.

⁸³ “Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.” EUR-Lex. Accessed 13 January 2020. <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>.

System and has been even subject to some drastic changes on the way to its current understanding.

Interestingly, since at least 1999, the EUIPO had systematically applied a substantial part standard for assessing acquired distinctiveness of non-conventional marks.⁸⁴ For instance, the First Board of Appeal in the *Pillow Pack* case has unequivocally stated that requiring assessment of market conditions in each Member State is not logical:

*“The issue of the geographical area over which acquired distinctiveness through use must be shown raises more complex questions. The requirements will vary depending on the type of mark that is in issue. ... In the case of a three-dimensional mark that lacks inherent distinctiveness the objection will not be confined to the territory of any particular Member State but will extend to the entire Community. In such a case it would not in the Board’s opinion be appropriate to require proof of use in every Member State. Instead, what must be shown is that the mark has acquired distinctiveness in the common market as a whole. The question that must be asked is whether a substantial proportion of consumers in the Community as a whole have been exposed to the mark and have, as a result of that exposure, come to recognise the mark as a sign that the products on which it appears emanate from a specific commercial source.”*⁸⁵

Thus, making an inference from the citation, it is not justifiable to demand the establishment of trademark recognition in each Member State. Rather, it is necessary to take case-by-case approach and assess each separate mark individually, taking into account all the relevant factors, including the geographical scope of the mark recognition. Moreover, according to the Board’s opinion, it is not appropriate to demand trademark distinctiveness in each Member State, but rather establishment thereof in a common market as a whole.

Still, due to rather ungrounded Opinion of the Advocate General in the *Storck* case, which was also supported by the CJEU, where the AG suggested that article 7(2) of the EUTMR should be read into article 7(3) despite the fact that the both paragraphs regulate separate subject matters.⁸⁶ In particular, the second paragraph of the article states that *“Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union”*,⁸⁷ and means in the context of trademark distinctiveness that if a mark cannot be considered as inherently distinctive in at least one Member State, it should not be registered at all. At the same time, earlier cited article 7(3) relates solely to the question of acquired distinctiveness.⁸⁸

⁸⁴ Porangaba, “Acquired distinctiveness in the European Union”, 626.

⁸⁵ “Pillow Pack, Case R 381/2000-1,” quoted in Luis H. Porangaba, “Acquired distinctiveness in the European Union: when nontraditional marks meet a (fragmented) single market,” *Trademark Reporter* 109 (2019): 626.

⁸⁶ “August Storck K.G. v. OHIM, Case C-25/05 P,” *Curia*, Accessed 19 January 2020, <http://curia.europa.eu/juris/showPdf.jsf?text=&docid=55760&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=1013904>.

⁸⁷ “Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark,” *EUR-Lex*, Accessed 13 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>.

⁸⁸ Porangaba, “Acquired distinctiveness in the European Union”, 627.

Nevertheless, such a misinterpretation entailed a number of decisions where the CJEU departed from substantial part standard, and started to require applicants to provide evidence of acquired distinctiveness in each Member State of the EU regardless of factual circumstances and portion of the EU population the missing Member State(s) represent(s) (e.g. Glaverbel S.A. v. OHIM⁸⁹).

The final blow has been done by the CJEU in the dispute between Nestlé and Mondelez over validity of the shape mark representing the four-fingered shape of a KIT KAT chocolate bar. In that dispute Cadbury (later bought by Mondelez) demanded invalidation of the shape mark registration due to lack of both inherent and acquired distinctiveness.⁹⁰

Although Nestle managed to provide market research for majority of the Member States except for Luxembourg⁹¹, proving that the relevant public in those countries identified Nestlé as the commercial origin of the product covered by the trade mark at issue, the decision was taken not in favour of the company. In particular, the CJEU stated the following:

“...the distinctive character acquired through use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of the territory of the European Union, and consequently, although such proof may be produced globally for all the Member States concerned or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the European Union, even a part consisting of only one Member State”⁹².

Thus, the court merely echoed the well-established practice without articulating why exactly the substantial part standard should not be applied while assessing provided materials showing the recognition of a particular mark at issue. It can be inferred that the CJEU established the threshold which is almost impossible to overcome for big international companies, not to mention small or medium enterprises. In addition, the court failed to substantiate such a decision and explain why the test used by the EUIPO in the relevant judgement is inappropriate and why a part of the EU could not be discounted as negligible or offset by other factors, as it had been successfully done before the decision in *Storck*.⁹³

⁸⁹ “Glaverbel S.A. v. OHIM, Case T-141/06,” Curia, Accessed 19 January 2020, <http://curia.europa.eu/juris/document/document.jsf?text=&docid=62767&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=1014796>.

⁹⁰ “Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd. and EUIPO, joined cases C 84/17 P, C 85/17 P and C 95/17 P,” Curia, Accessed 19 January 2020, <http://curia.europa.eu/juris/document/document.jsf?text=&docid=204401&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=1015589>.

⁹¹ “Société des produits Nestlé SA and Others v Mondelez UK Holdings & Services Ltd., joined cases C 84/17 P, C 85/17 P and C 95/17 P, Opinion of Advocate General Wathelet,” EUR-Lex, Accessed 19 January 2020, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62017CC0084>.

⁹² “Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd. and EUIPO”.

⁹³ Porangaba, “Acquired distinctiveness in the European Union”, 639.

Still, the court made a few hints for collection of the evidence. In particular, the court held that certain Member States may be grouped together if they are provided with some goods or services through the same distribution network and are treated by the “economic operator” as if they were one and the same national market. In addition, it is also possible to use the evidence collected in one Member State for proving distinctiveness in other. Such may be a case when *“due to a geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services that are present on the national market of the second.”*⁹⁴ Thus, the hints may ease to some extent collection of the materials for some trademark owners. Still, companies using such hints should indicate the relevant method and Member States directly in the relevant claims; otherwise, the competent authorities will find that Member State(s) missing.⁹⁵

Having regard to the materials appropriate for proving acquired distinctiveness, the Guidelines prepared by the EUIPO are of a great help. In particular, opinion polls and surveys are seen as the most direct evidence showing actual perception of the relevant public. In addition, information as to market share held by a trademark regarding the relevant good and/or services, advertising materials, declarations, affidavits and written statements can be also corroborate the acquired distinctiveness. The materials are to be relevant at the trademark’s application date.⁹⁶

As for comparison to the approach taken by the USA as regards assessing acquired distinctiveness, it shares mainly general principles regarding the relevant materials and assessment thereof. However, it is quite difficult to imagine that the USPTO may require providing evidence as to use of the trademark at issue in each state and in case the one is missing it refuses granting protection.

Conclusions of the chapter

Taking into account all the aforesaid, it can be summed up that despite harmonization of some rules regarding registration of trademarks at the international level, there are still differences in approaches to non-conventional marks in both the EU and the US. Although both systems acknowledge such marks as potentially registrable, they should overcome three main obstacles: representation of marks in the application, non-functionality and distinctiveness requirements. The recent European Trademark Reform brought a lot of changes for non-conventional trademarks in the European Union and, therefore, the EU system become similar to some extent in the legislative approach towards examination of non-conventional marks to the

⁹⁴ “Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd. and EUIPO”.

⁹⁵ “Nestlé SA, Opinion of Advocate General Wathelet”.

⁹⁶ “Guidelines for Examination of European Union Trade Marks”.

US. Consequently, elimination of graphical representation requirement permitted registration of non-visible marks, for which registration in the US has been available long time before that change and extension of non-functionality requirement to all marks (as it is so in the US) posed serious danger to all non-conventional mark and not only shapes. However, the *Sieckmann criteria* introduced into the legislation of the EU made the EU's approach significantly stricter than the one existing in the US, where no such requirements are put forward. As a separate issue, the EU does not require obligatory provision of specimens and a description unlike the US, where they must accompany each trademark application.

Having regard to the distinctiveness requirement, it has not been changed after the Reform, but rather it is subject to inconsistent application by the EU authorities due to existence of two opposite approaches to acquired distinctiveness assessment unlike the US, where the acquired distinctiveness is to be shown in general and without checking each separate state. That situation has appeared due to misinterpretation of the very wording of article 7 of the EUTMR thereby posing almost unsurmountable obstacle on the way of registration of all trademarks, not only non-conventional ones.

As a third main obstacle scrutinized while analyzing the domestic legislation of the EU and the US, the non-functionality requirement is present in both legislations and now after the EU Reform it covers all registrable signs. However, the ground is still scarcely articulated in the EU and all the existing information is based on functionality of shapes, as a sole mark for which the requirement was previously applicable. At the same time, the functionality in the US is a well-developed doctrine with clear and precise rules developed by the US courts. Thus, the EU's applicants may sometimes find it useful while applying non-conventional mark in the EU.

2. PRACTICAL ASPECTS OF NON-CONVENTIONAL TRADEMARKS REGISTRATION IN THE EU AND THE US

As evident from the provided above analysis, the USA and the EU took basically similar approach to registration of non-conventional marks after the Reform. Each mark should go through three main obstacles on the way towards obtain legal protection: representation of the mark in the application and afterwards in the state register, non-functionality and distinctiveness requirements. Still, there are considerable differences in the content of these requirements, especially in some particular aspects. Such divergence subsequently influences the examination procedure of the marks and thus leads to different results for a trademark owner. Therefore, the further comparative analysis is dedicated to founding out how non-conventional marks deal with these conditions of granting legal protection in both the EU and the USA, what are the divergences and convergences in the practical approaches taken by the countries and whether there are any ways to make a difference. It is also vital to emphasize that grouping of non-conventional trademarks on visible and non-visual ones, which was articulated in the SCT Report, will be used for the purpose of the further analysis.⁹⁷

2.1. Registration of Non-Conventional Mark in the USA in Practice

2.1.1. Registration of Visual Marks

A. three-dimensional marks

According to the Lanham Act, a three-dimensional mark is called a trade dress mark.⁹⁸ The concept of trade dress refers to entire image of a product with combination of various features, which include size, shape, color, texture or graphical elements.⁹⁹ Trade dress has initially included only packing of a product or in other words “dressing”, but in recent years has been expanded and include product designs.¹⁰⁰, which refer to the shape and appearance of a

⁹⁷ “New Types Of Marks,” WIPO, Accessed 20 January 2020, https://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf.

⁹⁸ Gilson and Gilson LaLonde, “Cinnamon Buns, Marching Ducks”, 808.

⁹⁹ Tyler M. Seling, “The Kit Kat Conundrum: Difficulties in Obtaining Trademarks for Shapes and Containers.” Michigan State International Law Review 25.2 (2017): 466.

¹⁰⁰ “Trademark Manual of Examining Procedure”.

products.¹⁰¹ The trade dress types differ not only because of the elements which may be encompassed therein, but also due to slightly different examination approach, which is stricter for product designs. When it is not clear whether the applied mark is a product design or product packing, the preference is usually given to product design.¹⁰²

In order to apply a trade dress mark an applicant shall prepare drawing thereof, which must depict a single rendition of the mark, and he must indicate that the mark is three-dimensional.¹⁰³ Moreover, the drawing may not contain any extraneous elements and if the mark includes only a part of product design or product packing, solid lines should be used on the drawing to show the elements that are claimed as part of the mark.¹⁰⁴

A drawing of a trade dress is often depicted as a three-dimensional image that gives the appearance of height, width, and depth to the mark. Thus, the drawing may be provided either as illustration of a mark or as a photo of the product design or the product packing. Both drawings undergo the same assessment and should fairly represent the mark.¹⁰⁵ As example, the following mark representing a real image of a packing was accepted for registration for confectionery:



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Each trade dress application must also contain an accurate description of the mark. The description must objectively describe the mark without inclusion of excessive details and unnecessary information. Moreover, there should be an explicit statement that the mark is three-dimensional and constitutes a product packaging, product design, container for goods, or similar. If the drawing includes dotted lines, the description may indicate which parts of the mark are claimed and which are not. The applicant may be also asked to amend the application, if some aspects thereof are not clear enough or if some discrepancies are found.¹⁰⁷ For instance, the following description of a trade dress was considered as appropriate and the mark was successfully registered for molded plastic taco holders:

Trade dress drawing	Description
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¹⁰¹ Seling, “The Kit Kat Conundrum”, 466.

¹⁰² “Trademark Manual of Examining Procedure”.

¹⁰³ “U. S. Trademark Law Rules of Practice”.

¹⁰⁴ “Trademark Manual of Examining Procedure”.

¹⁰⁵ See note 104 above.

¹⁰⁶ The trade dress mark registered under the registration No. 5326518 in the name of ZED CANDY (DUBLIN) COMPANY.

¹⁰⁷ “Trademark Manual of Examining Procedure”.

 108	Color is not claimed as a feature of the mark. The mark consists of a three-dimensional configuration of a food holding device stylized as a fanciful triceratops dinosaur. The top portion of the device is divided into two parts by three half circles extending upward from the back of the dinosaur.
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The second step to overcome is non-functionality. As determined in the previous chapter, a feature of a trade dress can be considered as functional if it is “*essential to the use or purpose of the article or if it affects the cost or quality of the article*”.¹⁰⁹ The examiner is obliged to take into account not only the elements of the application, e.g. the drawing or the relevant goods and/or services, but also conduct an independent investigation to obtain substantial proof that the mark is functional, otherwise the ground cannot be applied. If the examiner fails to do so, but there is a reason to believe that the mark may be functional, he may request to provide the applicant the argumentation to rebut the suspicion of the examiner. Furthermore, while assessing the trademark functionality, the functionality of the whole trade dress should be established, not only separate features. Still, there are cases when such separate features must be also scrutinized in order to help the examiner to make a correct finding.¹¹⁰ In that regard, the *Change Wind Corp.* case can be analyzed.

Change Wind Corp., the applicant, filed the following three-dimensional mark:



The mark was filed for such goods as “*Wind turbines; Wind-powered electricity generators*”. Having analyzed the application, the examiner refused the registration of the product design in particular, on the basis of functionality thereof. The applicant appealed the decision to the Appeal Board (hereinafter also – the TTAB), but the decision was subsequently upheld. Notably, the following argumentation was provided.

First of all, the TTAB underlined that the decision was guided by the analyses applied in *Traffix* and *Morton-Norwich* cases. Particularly, it was indicated that if presence of the relevant utility patent is established, the further consideration of the case is unnecessary, since that fact is

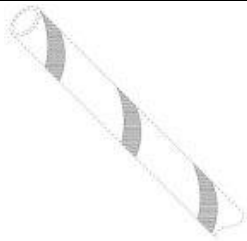
¹⁰⁸ The trade dress mark registered under the registration No. 5836478 in the name of UT Brands, LLC.

¹⁰⁹ “*Traffix Devices Inc.*”.

¹¹⁰ “*Trademark Manual of Examining Procedure*”.

one of the strongest evidence in favour of functionality of the applied mark. The case was also established in the present case. The applicant was the owner of a utility patent protecting basically the same subject matter as was applied for a trademark registration. The TTAB found that the patent reveals that the shape of the wind is not arbitrary, ornamental, or incidental, but serve an essential function in the invention and features thereof are necessary for its use. In further analysis, the TTAB compared elements of the patent with elements present on the drawing of the mark and held that “[t]he patent discloses the functional role of the three components disclosed and claimed in Applicant’s drawing of the mark”. Therefore, the appeal was refused on the basis of functionality of the elements of the applied sign.¹¹¹

The third hurdle is the distinctiveness requirement. There is big difference in examining product packaging and product designs. In the leading case on that regard, i.e. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the US Supreme Court pointed out that these two types of a trade dress mark are not the same and provided that the product design can never be found to be inherently distinctive, which echoed the decision in *Two Pesos* case handed out eight years earlier. In particular, the court stated that “...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.”¹¹² Therefore, in every case where a product design trade dress is involved, showing of secondary meaning is obligatory. In other words, the applicant must prove acquired distinctiveness of the design mark. In the opposite case, the registration on the Supplemental Register is the only possible way towards the mark registration. For instance, the following product design was successfully registered for hot melt adhesive hoses on the Principal Register:

Trade dress drawing	Description
	<i>Color is not claimed as a feature of the mark. The mark consists of product design for a hot melt adhesive hose in the nature of a spiral stripe encircling the hose. The dotted lines are merely to show placement of the mark on the goods and are not claimed as a feature of the mark.</i>¹¹³

Having regard to product packing trade dresses, they can be inherently distinctive. As the court outlined in the *Wal-Mart Stores* case, the attribution of inherent distinctiveness to product

¹¹¹ “Change Wind Corp.” Casetext. Accessed 20 January 2020. <https://casetext.com/admin-law/change-wind-corp>.

¹¹² “Wal-Mart Stores, Inc. v. Samara Brothers, Inc.” Justia, Accessed 21 January 2020, <https://supreme.justia.com/cases/federal/us/529/205/>.

¹¹³ The trade dress mark registered under the registration No. 5278419 in the name of Nordson Corporation.

packaging derives from the fact that the very purpose of encasing a certain product in a distinctive packaging is most often to identify the source of the product.¹¹⁴ Therefore, if the examiner held that the product packaging at issue is inherently distinctive, there is no need in assessing the secondary meaning.¹¹⁵

In assessing distinctiveness of a trade dress, the test adopted in the *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, is of a great help. In particular, the authority examining a trade dress should ascertain the following facts: (a) whether it is a “common” basic shape or design, (b) whether it is unique or unusual in a particular field, (c) whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or (d) whether it is capable of creating a commercial impression distinct from the accompanying words.¹¹⁶

One of the recent cases where the said test was applied is *In re Chippendales USA, Inc.* The case related to the following Cuffs Collar trade dress:



While applying the trade dress, the applicant provided evidence as to both inherent and acquired distinctiveness. Still, the examiner accepted only those showing the acquired one. After a certain period of time, the owner decided to file another application of the same mark on the basis of inherent distinctiveness and desired to resolve “*the underlying substantive issue as to whether the proposed mark is inherently distinctive*”. However, the registration was refused because the mark was not inherently distinctive under the *Seabrook* test. In particular, it was held that “*Cuffs Collar was not unique or unusual in the particular field of use, because costumes generally are common to the field of exotic dancing*”, and that “*the Cuffs Collar mark was a refinement of an existing form of ornamentation for the particular class of services*”.

In analyzing the arguments of the TTAB, the court concluded that if at least one of the *Seabrook* facts is present, the mark is not inherently distinctive. And that was the case in the matter at issue. Particularly, the court agreed with the TTAB that the third factor is present, namely the court determined that the applicant owns the Playboy mark, which includes the cuffs

¹¹⁴ “Wal-Mart Stores, Inc.”.

¹¹⁵ “Two Pesos, Inc. v. Taco Cabana, Inc.” Cornell Law School, Accessed 21 January 2020, <https://www.law.cornell.edu/supct/html/91-971.ZO.html>.

¹¹⁶ “Seabrook Foods v. Bar-Well Foods LTD.” Casetext, Accessed 21 January 2020, <https://casetext.com/case/seabrook-foods-v-bar-well-foods-ltd>.

and collar together with bunny ears. It was corroborated by the fact that *“the Playboy bunny suit, including cuffs and a collar, was widely used for almost twenty years before Chippendales’ first use of its Cuffs Collar trade dress”*. Thus, taking into account the fact that the Playboy mark was registered for homogeneous services, the elements present in the Cuffs Collar trade dress can be considered as a refinement of the existing form of ornamentation for the particular class of services. Therefore, the court had no choice but upheld the conclusion of the TTAB.¹¹⁷

In conclusion, it can be pointed out that trade dresses are widely registered and used in the USA. That is a common approach to divide the marks into two categories: product packages and product designs. Still, despite the fact that there are minor differences in conditions for registration, both of them can be registered if they were properly represented in the application, passed the non-functionality test and proved to be distinctive according to the rules developed by the US courts.

B. Color marks

A color is usually perceived as a decorative feature of goods or services. However, it may sometimes communicate certain information to consumers and help them distinguish one goods and services from others. Moreover, it may also point to the particular manufacturer of the goods or to the service provider. In such a case, the color may be registered as a trademark and be protected from misappropriations. The same inference was made in the *Qualitex* case where the court held that *“color alone can meet the basic legal requirements for use as a trademark”* and that there is no rule absolutely barring the color from being a trademark.¹¹⁸

In order to register a color as a trademark, it is necessary to file the application to the USPTO with appropriate representation of a color therein. As a general rule, a filed color mark must be depicted in the box allotted for a mark drawing. The drawing must consist of a representation of the product or product package and present the mark as it is actually used or intended to be used. The object indicated in the drawing must appear in broken or dotted lines, which makes clear that the very shape of the good or the package is not claimed. There is also a specific that if the goods for which color is to be used or actually used are not similar or unrelated, or the color is used in different ways on different goods, separate applications are to be filed, since in that case the requirement of substantially exact representation is not satisfied.¹¹⁹ For instance, the following representation of a color mark was considered as appropriate:

¹¹⁷ “In re Chippendales USA, Inc.” Casetext. Accessed 21 January 2020. <https://casetext.com/case/in-re-chippendales-usa-inc>.

¹¹⁸ “Qualitex Co.”.

¹¹⁹ “Trademark Manual of Examining Procedure”.



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As for representation of color marks filed as service marks, they should also be represented by a drawing. The drawing must represent the color as it is used or is intended to be used in connection with the relevant services. If a color is used in various ways, but in a setting that makes a single commercial impression, such as shops or bakeries, the drawing representing such settings must be submitted. If the color is to be used on various objects, a solid-colored square with a dotted peripheral outline must be submitted.¹²¹ As an example, the following mark was successfully registered for organizing sporting events on the Principal Register:



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Alone from the drawing, a color mark application must be accompanied by the relevant description which correspond to the representation depicted in the application. In particular, it must contain a claim that the color(s) is a feature of the mark; and a statement in the "Description of the Mark" field naming the color(s) and describing where the color(s) appear(s) and how they are used on the mark.¹²³ Each applicant of color marks must double-check whether the description actually describes what is shown on the drawing since in case of mismatches the registration of a mark will be refused.

Such a situation led to the dispute between Thrifty, Inc. and the TTAB. The dispute arose due to refusal in registration of the blue color mark for the following services: *“automobile, truck and recreational vehicle renting and leasing; parking place services; and transportation services by limousine or bus in int. cl. 39”*. The drawing of the application was showing a building, most likely depicting a Thrifty “vehicle rental center” in dotted lines having an upper wall that is lined for color. The application also contained the following description: “the color Blue”. Apparently, the registration of the mark was refused and the examined required submitting a concise description of the mark. Shortly, the applicant provided the amended description, which contained in particular, the following: *“The mark consists of the color blue used in connection with the services set forth in the application. The color blue is used on*

¹²⁰ The color trademark is registered under the registraton No. 5117747 in the name of The Ohio State University state university.

¹²¹ “Trademark Manual of Examining Procedure”.

¹²² The color mark is registered under the registration No. 5706644 in the name of Deutsche Telekom AG.

¹²³ “Trademark Manual of Examining Procedure”.

vehicle rental centers, signs, vehicles, uniforms, and in other advertising and promotional materials to show that the color blue identifies and distinguishes applicant's services". The description was not accepted again. It that time, it was done due to disagreement between the drawing and the description, which described more than one mark. The decision was subsequently also affirmed by the TTAB, which stated in particular, that there was no question that the drawing is appropriate, but the amendment was impermissible material alteration of the mark. The applicant then disputed the decision in the court.

Having analyzed the case materials, the court came to the same conclusion as the USPTO. In particular, it held that *"In contrast to the original application, Thrifty's proposed amendment describes the mark as including the color blue applied to a wide variety of objects (e.g., buildings, vehicles, uniforms, signs, keychains, pencils and pens, brochures, and playing cards). The multiple impressions created by the wide variety of objects sought to be covered under the proposed description differ significantly from the original mark of a color placed on a building."*¹²⁴ Therefore, the description described the multiple forms of the mark use, while the drawing depicted only the building. Such a description could have been appropriate only in case if the applicant had filed the application containing only a solid-color drawing, but not the building, which significantly narrowed the scope of the mark, and therefore the possible description thereof.

If a color mark was properly represented in the application, registration thereof may be still refused. In particular, it may occur when the mark is considered functional. It may be the case when a color serves some other purpose than identifying the source of the goods or services. For instance, registration of bright orange color for biohazardous waste disposal bags was denied since it served to alert people that the content of the bags is dangerous.¹²⁵ But are all color marks functional? The court responded negatively in the *Qualitex* case. Particularly, it was stated that *"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."*¹²⁶

¹²⁴ "In re Thrifty, Inc, 274 F.3d 1349 (Fed. Cir. 2001)" Court Listener, Accessed 21 January 2020, <https://www.courtlistener.com/opinion/775950/in-re-thrifty-inc/>.

¹²⁵ "AMERICAN HOSP. SUPPLY v. Fisher Scientific Co., 713 F. Supp. 1108 (N.D. Ill. 1989)," Justia, Accessed 21 January 2020, <https://law.justia.com/cases/federal/district-courts/FSupp/713/1108/1465527/>.

¹²⁶ "Qualitex Co.".

As an example of such a situation, the court made a reference to *Owens-Corning* case. The case related to registration of a pink color for fiberglass insulation and while the TTAB found the mark not appropriate for registration as a trademark since it fails to function as such, the court held that the TTAB erred in that conclusion and held that “*the pink color performs no non-trademark function and is consistent with the commercial and public purposes of trademarks*” since it “*does not confer a "monopoly" or act as a barrier to entry in the market*”, “*has no relationship to production of fibrous glass insulation*” and thus, “*serves the classical trademark function of indicating the origin of the goods.*”¹²⁷

Therefore, while examining a color mark, the examiner should determine whether allowing one company or one person exclusive of the color at issue would put other players on the relevant market at significant non-reputation-related disadvantage. Such an advantage is generally unrelated to recognition of the source of products or services, such as a manufacturer’s ability to make the products or services attractive for consumers or useful in any way.¹²⁸

Such disadvantage was found in the *Brunswick* case. The dispute arose from the application to register the black color for outboard engines by Mercury. At the time of the application, the applicant had other competitors on the market using also black color for outboard engines. After assessing the mark, the examiner allowed the registration since Mercury provided vast evidence regarding acquired distinctiveness. But shortly British Seagull Ltd. and Outboard Marine corp. filed the oppositions. Having analyzed the arguments of the opposing parties, the TTAB found the mark functional and sided with the claimants. In particular, the TTAB held that “[A]lthough the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors”. After losing the appeal, the case was brought to the court by the trademark owner, but the court came to the same conclusion as the TTAB did and subsequently upheld the decision thereof.¹²⁹

Therefore, while the mark was not *de facto* functional, it was functional *de jure*, since it would put other competitors in disadvantageous position by limiting their possibility to use black color for the relevant goods.

¹²⁷ “In re Owens-corning Fiberglas Corporation, 774 F.2d 1116 (Fed. Cir. 1985),” Justia, Accessed 21 January 2020, <https://law.justia.com/cases/federal/appellate-courts/F2/774/1116/10307/>.

¹²⁸ Gilson and Gilson LaLonde, “Cinnamon Buns, Marching Ducks”, 788.

¹²⁹ “Brunswick Corporation v. British Seagull Limited,” Open Jurist, Accessed 23 January 2020, <https://openjurist.org/35/f3d/1527/brunswick-corporation-v-british-seagull-limited>.

Having regard to aesthetic functionality, it may be found when the color in question provides specific competitive advantages that are not stemmed from utilitarian nature of the mark, but rather from appealing nature thereof. One of the leading examples of such a situation is *In re Florists' Transworld Delivery* case. It is related to registration of the black color mark for outside parts of boxes for floral arrangements. The examiner as well as the TTAB refused the registration on the basis of aesthetic functionality of the black color since there is a competitive need for others in the relevant industry to use the black color for their floral packages. In particular, it is necessary to convey particular messages, e.g. black floral arrangements may appropriate for stylish or formal events to convey luxury or elegance, or may show grief or condolence in the context of funerals.¹³⁰

The next hurdle to overcome for color marks is distinctiveness. In the *Qualitex* case, the Supreme Court of the U.S. despite indicating that color marks can be protected under the trademark law held that color can never be inherently distinctive.¹³¹ The same was also recently held as regards multiple color marks by the TTAB.¹³² Thus, it is obligatory for a color mark applicant to show secondary meaning of the mark, i.e. acquired distinctiveness. The reason behind such a severe approach is usually justified by the fact that the possible colors number is limited and therefore fair competition would be greatly hampered if the USPTO were to register color marks too easily.¹³³

However, it is still possible to prove the acquired distinctiveness. The suitable evidence thereof may include, among others, volume of sales, advertising expenditures, length of use and its exclusivity, media coverage and consumer studies, such as surveys.¹³⁴ The landmark case on that regard is the above cited *Owens-Corning* case. The company managed to prove advertising of its pink color for home insulation for around thirty years, from which more than \$42 million were spent on consumer advertising. Moreover, the company was also periodically present on billboards during major sports events, such as Super Bowl, the Rose Bowl, the U.S. Tennis Open, and the World Series. The mark was also promoted on the radio and TV shows, in different magazines and through real estate developers¹³⁵. As evident from the case, the burden

¹³⁰ “In re Florists' Transworld Delivery, Inc.” USPTO, Accessed 23 January 2020, <http://ttabvue.uspto.gov/ttabvue/ttabvue-77590475-EXA-41.pdf>.

¹³¹ “Qualitex Co.”.

¹³² “In re Forney Industries, Inc.” USPTO, Accessed 23 January 2020, <http://ttabvue.uspto.gov/ttabvue/ttabvue-86269096-EXA-19.pdf>.

¹³³ “Prince's purple: without rain or color trademark protection,” Sewelllaw, Accessed 23 January 2020, <https://sewellnylaw.com/princes-purple-without-rain-color-trademark-protection/>.

¹³⁴ John, Froemming et. al. “Lending Color to Trademarks: Protection and Enforcement of Color Marks in the U.S., EU, China and Japan,” INTA, Accessed 28 January 2020, https://www.inta.org/INTABulletin/Pages/ColorMarks_in_US_EU_China_Japan_7012.aspx.

¹³⁵ “In re Owens-corning Fiberglas Corporation”.

of proving that a color mark has acquired distinctiveness is substantial and a mere statement of prolonged usage of the mark is not enough. The applicant should be able to show that the mark has acquired source-indicating significance in the minds of consumers.¹³⁶

As for example, where a color mark was considered as not having acquired distinctiveness is *In re General Mills IP Holdings II, LLC* case. General Mills tried to register the following yellow color mark for its oat-based cereal:



However, the registration was refused due to the fact 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”*. Thus, the registration was refused due to the fact that it was common to use yellow background for manufacturers of breakfast cereals and it is unlikely that consumers would perceive yellow packing as originating from a particular source. Rather, consumers are likely to perceive it as merely eye-catching ornamentation which is customary in that sphere.¹³⁷

Reiterating the above-indicated, registration of color marks requires substantial efforts for preparation of proper representation of the mark, since it determines the scope of subsequent protection thereof and incorrect description and/or drawing may render the registration either almost impossible or fruitless. Furthermore, it is vital to prepare substantial evidence of secondary meaning of a color mark, which is never inherently distinctive. As for functionality of colors, both types of functionality may be found in certain circumstances.

C. Hologram marks

Holography is a photographic technique that records the light scattered from an object, and they presents it as a three-dimensional image. Holograms are actively used in movies, on credit cards, driver`s licenses and etc.¹³⁸ Similarly to photograph, a hologram is a permanent

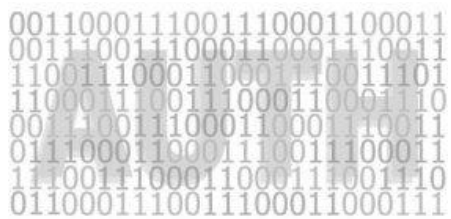
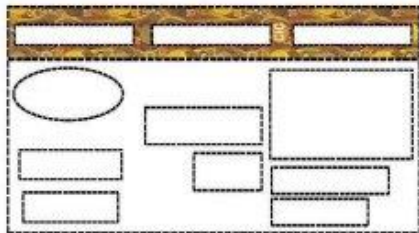
¹³⁶ “Trademark Manual of Examining Procedure”.

¹³⁷ “In re General Mills IP Holdings II, LLC.” Casetext, Accessed 29 January 2020, <https://casetext.com/admin-law/general-mills-ip-holdings-ii-llc>.

¹³⁸ Robert Workman, “What is a Hologram?” Livescience, Accessed 29 January 2020, <https://www.livescience.com/34652-hologram.html>.

record of the light which is reflected from the object.¹³⁹ Thus, persons sometimes try to register it as a trademark, since no limitations present in the wording of a trademark in the Lanham Act. The total amount of hologram mark application probably does not exceed 30 and there are currently only 9 live hologram trademarks present in the USPTO trademark register.

There are no separate rules concerning application of a hologram mark so in order to apply it, an applicant should follow common rules regarding representation of the mark in the drawing box and preparation of the precise and relevant description. There is also almost no relevant case-law or practice. Thus, the applicant may look onto the hologram marks that are already present on the register. For instance, the following marks can be analyzed:

No.	Drawing	Description
1. ¹⁴⁰		The color(s) gray and silver is/are claimed as a feature of the mark. The mark consists of gray and silver numbers "0" and "1" to form a geometric rectangular shape with gray and silver letters "A U T H", the overall mark impression is a holographic hologram. The color white represents the background.
2. ¹⁴¹		The color(s) gold is/are claimed as a feature of the mark. The mark consists of a hologram featuring a repeating pattern of circles, circles with laurel wreaths, the letters "CIC", the letters "OK", and wavy lines, all in the color gold. The pattern appears at the top of the coupons, and the broken lines indicate the mark's placement on the goods. The matter in dotted lines is not claimed as part of the mark.

As evident from the marks, the drawing may represent either the mark alone, or as it is to be used on the good. In the second case, the good must be present in dotted lines in order to show that the view of the good is not claimed. As for the description, it should precisely outline all the relevant information as to the elements present on the drawing at issue, including statement that the applied mark is a hologram, information about colors used and claimed (if any), letters and numerals present on the drawing, etc. Additionally, a hologram must have only one view, since two or more views, which show that there is no precise subject matter for registration, should not be registered.

¹³⁹ Harshada Wadkar, "Non-conventional marks," Lexology, Accessed 29 January 2020, <https://www.lexology.com/library/detail.aspx?g=4339efff-eba0-4339-a5f9-47f2d72ae7d1>.

¹⁴⁰ The hologram mark is registered under the registration No. 4189051 in the name of Interactiv Corporation.

¹⁴¹ The hologram mark is registered under the registration No. 5456238 in the name of Coupon Information Corporation.

However, representation of a hologram mark in the application is not the biggest challenge for the applicant. As the TTAB noted in the *In re Upper Deck Co.* case, “*the common use of holograms for non-trademark purposes means that consumers would be less likely to perceive applicant’s uses of holograms as trademarks*”. Thus, the applicant must first of all prove that his hologram is recognized by consumers as a mark. Otherwise, the examiner is obliged to refuse registration on the basis that the hologram does not function as a trademark. In particular, the cited case related to registration of a hologram used on trading cards and it was found that the hologram failed to operate as a trademark because other similar companies also used holograms on their cards and other products as anti-counterfeiting devices, and there was no proof that the public would perceive the applicant’s hologram as a source indicator.¹⁴²

In accordance with the U.S. approach in determination whether the applied mark is capable to function as a trademark, the key element is a specimen showing how a mark is used in commerce. Thus, the applicant should give this matter paramount attention.¹⁴³

Having regard to distinctiveness and non-functionality requirements, there is almost no relevant practice on that regard. Having analyzed the information about hologram marks in the USPTO’s Trademark Status & Document Retrieval (TSDR), it can be inferred that hologram marks can be inherently distinctive since a part of the marks that are currently registered were filed without provision of materials showing acquired distinctiveness along with the applications. Moreover, there was no relevant claim for assessing the acquired distinctiveness in whole or in part.¹⁴⁴ As for functionality, in opinion of the author a hologram is rather vulnerable to utilitarian non-functionality requirement, since keeping information secure and protection of certain objects from falsification and copying are among the main purposes of hologram images use. Anyway, the common rules regarding examination of an applied mark will be used by the examiner and any applicant of a hologram mark must be prepared for thorough and rigorous examination.

All in all, it can be reiterated that hologram marks are rather rare type of trademarks since the total amount of applied marks is very low and there is almost no relevant case-law or practice regarding how a hologram mark deals with main requirements towards trademarks in the U.S. Still, the hologram marks that have been already registered may be analyzed through the TSDR and the one may try to find answers on his questions there. Hence, it is better to prepare a vast amount of evidence that the mark is capable to function as a trademark, and only then deal with

¹⁴² “Trademark Manual of Examining Procedure”.

¹⁴³ Susan J. Keri et. al. “Moving with the Times: Motion Marks in Canada and the United States,” INTA, Accessed 1 February 2020, <https://www.inta.org/INTABulletin/Pages/MovingwiththeTimesMotionMarks.aspx>.

¹⁴⁴ For instance, the marks under the registration Nos. 3407662, 78470087, 85342651.

proving the distinctiveness and non-functionality of the mark in order to make registration thereof more plausible.

D. Motion marks

In 1957, the first motion trademark was registered by the USPTO. It was a coin spinning on top of a hand to connote a bank in Duluth, Minnesota. Since then the Office proceeded with registration of such trademarks and now they took their place in the US Trademark Register.¹⁴⁵ A motion mark is a mark which consists or comprises elements of motion. It is applied in the same way as regular mark, but there are still some peculiarities present.¹⁴⁶

In order to apply a motion mark, the applicant must ensure that the drawing thereof depict *“a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark.”*¹⁴⁷

Currently, there are at least 70 live motion marks registered by the USPTO and the majority is represented by freeze frames, Still, a single point image is also appropriate if it is able to sufficiently represent the mark. The following marks are the illustration of both methods use:



Furthermore, the applicant of a motion mark must also provide accurate and precise description of the trademark, including enlisting of the constituent elements and explanation of movement thereof.

Still, similarly to hologram marks, the applicant should prove that consumers may ascribe the mark to a certain origin. Taking into account the considerable graphic part of such mark, the requirements of distinctiveness and non-functionality cause less problems than proving that a motion mark (the order and composition of graphic, and, from time to time, literal and numeral, elements in motion) serves as a source identifier. In addition, it is crucial to pay attention to preparation of specimens, since it may significantly assist in supporting the registration. However, some problems may occur with preparation of a proper specimen for marks used for

¹⁴⁵ Port, “On Nontraditional Trademarks”, 42.

¹⁴⁶ “Non-Traditional Marks at the U.S. Patent and Trademark Office”.

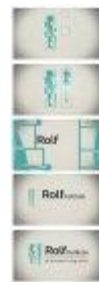
¹⁴⁷ “U. S. Trademark Law Rules of Practice”.

¹⁴⁸ The motion mark is registered under the registration No. 4664489 in the name of BlackRock Index Services, LLC.

¹⁴⁹ The motion mark is registered under the registration No. 5028039 in the name of STX Financing, LLC.

certain types of goods. That is so because the nature of a motion mark rarely permits it to be affixed to a relevant product due to the digital nature thereof. However, if the product is also digitized, such as a computer program, preparation of specimens is much easier. That was so for registration of a Microsoft Corporation motion mark for computer game consoles and software, where CD disc with representation of mark's use on the relevant product was accepted as appropriate.¹⁵⁰

As for distinctiveness and functionality of motion marks, no substantial case law or prevailing practice has been developed. With regard to distinctiveness, the one may analyze the applications and other relevant material in the TSDR concerning registered motion marks. In particular, it can be noted that a part of them was registered not on the basis of acquired distinctiveness and without indication of the relevant claim in the applications.¹⁵¹ Thus, that marks were registered in the basis of inherent distinctiveness and new applicants of motion marks may claim it as well. Having regard to functionality, that condition often may be readily met considering the nature and main use of motion marks which lie in identification of goods and services in digital sphere. As an instance of recent successful registrations, the registration of the following "Little Boy Motion Mark" can be named:



During the examining procedure, the examiner did not raise any serious substantive issues and the required amendments related only to the exclusion of descriptive word elements.¹⁵² Nonetheless, it is known how the mark was examined and what materials were provided by the applicant.

Thus, it can be summarized that the place of motion marks is similar to place of hologram ones since the main obstacle for them is to prove that they can actually be source identifiers and hence perform trademarks' primary purpose. With regard to distinctiveness, motion marks may be inherently distinctive and may acquire the distinctiveness through use. As for non-functionality requirement, it should not be a serious obstacle for motions. The applicant is better

¹⁵⁰ Keri et. al. "Moving with the Times".

¹⁵¹ For instance, the motion marks under the registration Nos. 5402348, 5436541, 5140450.

¹⁵² "Ollila Law Group, LLC Successfully Registers Motion Trademark for "Little Boy Logo," Olgip, Accessed 1 February 2020, <https://www.olgip.com/ollila-law-group-llc-successfully-registers-motion-trademark-for-little-boy-logo/>.

to prepare substantial amount of evidence of active use of the motion mark in practice if there is a possibility that the mark may be considered as not inherently distinctive and prove that consumers associate the motion with a certain manufacturer (place of origin).

2.1.2. Registration of Non-visible Marks

A. Scent marks

Scents were considered as powerful transporter of information in all times due to their ability to trigger human's memory. That ability has been always attracting businesses which are trying to capitalize it. It may be done so by adding specific smells to different goods when they are even not edible. The same is also relates to services which business players seek to tie with a particular smell in order to make them memorable and recognizable. Thus, persons which succeeded in doing so may try to trademark it so that to preclude any unfair practice by competitors. At the moment, around 12 scent marks are registered in the U.S.

In order to file a scent mark application, the one does not need to prepare drawing thereof since it is merely not possible to prepare such a drawing of the mark that can be readily perceived by consumers and competitors by owing to non-visibility of scents (however, chemical architecture of compounds may be depicted¹⁵³, but it will fail to perform the main purpose of publication of a mark – to inform the public about the scope of the right granted.). For that case, the USPTO permits the applicants to prepare only a detailed description of a smell mark, what is in opinion of the author is not enough to perceive such marks. A specimen must be provided in conjunction with a description.¹⁵⁴

In a paper application, there should be a clear indication that the applied mark is a non-visual mark. If the applicant is submitting the application online, scent mark should be indicated as the mark type. In addition, the detailed description should precisely and accurately provide information as to the applied object. The USPTO has yet to provide a clear guidance as to what type of information must be indicated and what kind of descriptive terminology is acceptable. The choice seems to be between submission of chemical formula to describe the smell or usage

¹⁵³ “The registration of Scent Trademark and its Issues,” STA, Accessed 1 February 2020, <https://www.stalawfirm.com/en/blogs/view/trademark-scent.html>.

¹⁵⁴ “U. S. Trademark Law Rules of Practice”.

of descriptive language to describe the aroma. Moreover, some scholars criticize the written description approach due to its subjectivity and differences in perception of a scent.¹⁵⁵

Furthermore, it is necessary to accompany the application with a specimen of the smell. There is no clear guidance regarding the matter and all is left for the discretion of the applicant. Still, absence of uniform approach negatively affects the chances of a scent mark. As an option, a sample of the smell may be provided. Still, some of them may lose their potency over time or may be mixed with external smells which can result into their ineligibility.¹⁵⁶ Anyway, a specimen of a scent mark has to be smelled by the examiner. As a U.S. trademark official told the Wall Street Journal, *“If an examiner’s nose isn’t working, the attorney would have to find a supervisor to do the sniffing.”*¹⁵⁷

As an example, the scent mark registered for modeling wax for dental purposes was described in the following way: *“[t]he mark consists of vanilla scent contained within wax for the manufacture of CAD/CAM milled dental wax patterns”*.¹⁵⁸

Nonetheless, the biggest hurdle is to prove that the applied scent is capable of being a source indicator. As it was indicated in *In re Pohl-Boskamp GmbH & Co KG* case, consumers are predisposed to view scents as mere attributes of the product itself. Thus, in order to demonstrate that public has come to perceive it as an indicator of the source of the goods, an applicant have the burden of producing a large amount of evidence showing the ability to overcome that predisposition.¹⁵⁹ If the examiner is persuaded that the mark is able to function as a trademark, the next steps to overcome are non-functionality and distinctiveness.

A product’s scent may be registerable if it is used in a nonfunctional manner.¹⁶⁰ According to the *TrafFix Devices* case a scent is functional if *“it is essential to the use or purpose of the article or if it affects the cost or quality of the article”*¹⁶¹. Thus, scents that serve utilitarian purpose, e.g. scents of air fresheners, should not be registered.¹⁶² The functionality doctrine itself bars also all olfactory marks for cleaning products, perfumes, and colognes from

¹⁵⁵ Michael A. Grow and James R. Davis, II, “USA: Trade Marks 2019,” ICLG, Accessed 1 February 2020, <https://iclg.com/practice-areas/trade-marks-laws-and-regulations/usa>.

¹⁵⁶ Franco Galbo, “Making Sense of the Nonsensical: A look at Scent Trademarks and their Complexities,” IPWatchdog, Accessed 1 February 2020, <https://www.ipwatchdog.com/2017/12/21/scent-trademarks-complexities/id=91071/>.

¹⁵⁷ Nick Greene, “The 10 Current Scent Trademarks Currently Recognized by the U.S. Patent Office,” Mentalfloss, Accessed 1 February 2020, <https://www.mentalfloss.com/article/69760/10-scent-trademarks-currently-recognized-us-patent-office>.

¹⁵⁸ The scent mark is registered under the registration No. 5940433 in the name of Harvest Dental Products, LLC.

¹⁵⁹ “*In re Pohl-Boskamp GmbH & Co KG*,” USPTO, Accessed 1 February 2020, <http://tabvue.uspto.gov/tabvue/ttabvue-85007428-EXA-11.pdf>.

¹⁶⁰ “Trademark Manual of Examining Procedure”.

¹⁶¹ “*Traffix Devices, Inc.*”.

¹⁶² “Trademark Manual of Examining Procedure”.

protection, since they serves the purpose of masking or inducing a scent. Furthermore, the doctrine precludes from registration the majority of other marks in unforeseen ways.¹⁶³ One of the first trademarked scents overcame that barrier was a “*high impact, fresh, floral fragrance reminiscent of Plumeria blossoms*” registered for “*sewing thread and embroidery yarn.*” In particular, the TTAB found that the applicant was the only person who has been selling threads and yarns with a fragrance at that time and it was a feature supplied by the applicant and not inherent attribute or natural characteristic to the goods at issue.¹⁶⁴ As for aesthetic functionality, scents are not perceived by sight, thus, that ground is not applicable.

Having regard to the distinctiveness, scent marks can never be inherently distinctive.¹⁶⁵ Therefore, a substantial amount of evidence is necessary to prove not only that the mark may function as a trademark, but also to show that it is able to distinguish goods and services of the manufacturer from other competitors. In other way, the scent mark may be registered only on the Supplemental Register. For instance, in an application to register a grape scent for marking lubricants and internal combustion engines, the applicant managed to show that he had used the scent for at least 5 years prior to the filing date, had annually sold at least 5,000 bottles of lubricants containing the grape smell and had advertised the product in various sources. Nevertheless, the evidence was found to be insufficient since the mark was used for less than 10 years, the volume of sales was relatively low for the five-year period and no specific figures were provided as to the advertising expenditures. The application was deemed abandoned in the end due to failure to respond to the Office Action.¹⁶⁶

As an example of successful registration of sent mark, the scent of bubble gum for shoes, sandals, flip flops and flip flop bags can be named. Initially, Grendene S.A., the owner of the mark, filed the application on the basis of inherent distinctiveness and sent a sandal bearing the sent to the USPTO as a specimen. In response the applicant amended the application`s basis and provided a substantial amount of evidence of acquired distinctiveness, i.e. numerous articles in magazines and on the Internet on 160 pages in total, which was subsequently accepted by the examiner and made the registration possible.¹⁶⁷

¹⁶³ Galbo, “Making Sense of the Nonsensical”.

¹⁶⁴ “In re Celia, dba Clarke’s Osewez,” IPmall, Accessed 1 February 2020, <https://ipmall.law.unh.edu/content/ttab-trademark-trial-and-appeal-board-1-re-celia-clarke-dba-clarke-osewez-serial-no-758429>.

¹⁶⁵ “In re N.V. Organon, 76467774 (Ttab 12-7-2005),” LexRoll, Accessed 2 February 2020, <https://trademarks.lexroll.com/2016/10/28/in-re-n-v-organon-76467774-ttab-12-7-2005/>.

¹⁶⁶ Jay M. Burgett, “Hmm...What’s That Smell? Scent Trademarks—A United States Perspective,” INTA, Accessed 2 February 2020, <https://www.inta.org/INTABulletin/Pages/Hmm%E2%80%A6What%E2%80%99sThatSmellScentTrademarks%E2%80%94AUnitedStatesPerspective.aspx>.

¹⁶⁷ The scent mark is registered under the registration No. 4754435 in the name of Grendene S. A.

To sum up, scent marks are rarely registered in the USA. In order to obtain the registration for scents, it is necessary to prove that they may function as a trademark since consumers are tend to perceive them as merely attributes of goods and services and not as source identifiers. It is also clear that scent marks may not be represented graphically in the application, thus, it is highly recommendable to prepare a description and specimens carefully so that they be able to show the examiner not only that the scent can be a trademark, but also what the applicant is seeking to register in accurate and precise manner. Furthermore, scent marks cannot be inherently distinctive. That is the reason why the applicant must persuade the examiner that his mark has acquired distinctiveness with help of relevant materials. The next problematic step is non-functionality. It may be overcome by marks for which the scent is not natural and/or essential element for functioning thereof.

B. Flavor marks

Flavor marks are marks which represent taste of a certain product. There are currently no flavor marks registered in the USA despite a few attempts.

The US approach to flavor marks is almost identical as the one taken as regards smell marks. In order to apply a flavor mark it is necessary to prepare only the description and a specimen which will help the examiner to grasp the subject matter of the application, since the mark cannot be represented graphically.¹⁶⁸ But the public may access only a description indicated in the register if the mark registered.

The above-analyzed *In re Pohl-Boskamp GmbH & Co KG* case that held that consumers do not tend to equate scents with the source of the product ingested, pointed out that the same relates also to flavors. Thus, flavors are usually viewed as attributes of the product and not as a trade mark. Still, unlike scent, flavors have not yet managed to deal with that predisposition.¹⁶⁹

A flavor cannot be registered if it is functional and non-distinctive. The case which show the threshold set for flavor marks is evident from the *In Re N.V. Organon* case. The case related to registration of the orange flavor for “*pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills*”. The examiner refused to register the mark on the ground of functionality, non-distinctiveness and also added that the mark fails to function as a trademark and cannot be a source identifier. In particular, it was held that “*orange flavor is commonly added to orally-administered pharmaceutical products to render the products more palatable, thereby increasing patient compliance, and that orange is a preferred flavor for these*

¹⁶⁸ “U. S. Trademark Law Rules of Practice”.

¹⁶⁹ “*In re Pohl-Boskamp GmbH & Co KG*”.

pharmaceuticals.” Additionally, monopolizing the flavor would humper the competition on the market and provide unreasonable advantage to the owner.¹⁷⁰

Moreover, in the context of distinctiveness, flavors are never inherently distinctive because they are generally seen as a characteristic of a product.¹⁷¹ Thus, the applicant should show that the mark has acquired the distinctiveness through use by providing a substantial amount of evidence. In the case of application of pepper mint flavor for “*medicines, namely, pharmaceutical formulations of nitroglycerin*” the examiner found the insufficiency of evidence despite the fact that the flavor was in use for more than 20 years due to the fact that there was also one other user of a peppermint flavor for similar goods and thus the use was not exclusive.¹⁷²

To summarize, it can be said that despite absence of legislative bars for registration of flavor marks, no taste managed to overcome the high threshold set therefor. That is so because flavors are treated by consumers as a characteristic of the product, which has nothing to do with distinguishing goods or indicating the source of origin. If one apply a flavor, it will be necessary to prepare a description and a specimen that would let the examiner grasp the essence of the mark and persuade that it is not functional and distinctive.

C. Texture marks

Texture marks are among least popular non-conventional marks. There is currently only one live touch mark and there are several three-dimensional marks, which include specific textures in their configuration.

In order to apply a texture mark no drawings are necessary (but may be provided). However, the applicant must prepare a description and provide a specimen of the mark. The description should include detailed and accurate information as to the mark. In particular, the information regarding what mark is claimed, which feel it transmits and where it is located. For instance, the sole currently live texture mark has the following drawing, description and specimen:

Drawing	Description	Specimen
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¹⁷⁰ “In re N.V. Organon”.

¹⁷¹ See note 170 above.

¹⁷² “In re Pohl-Boskamp GmbH & Co KG”.

 173	The mark consists of a leather texture wrapping around the middle surface of a bottle of wine. The mark is a sensory, touch mark.	
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First of all, a texture mark must be able to perform a function of source identifier. The majority of texture marks were refused in registration due to the fact that they failed to function as a trademark since they represented a pure ornamentation.¹⁷⁴ For instance, the touch mark filed for lip sticks with the following description was refused in registration on that basis: *“The mark consists of a sensory feel of a cashmere material. Color is not claimed as a feature of the mark. The mark is a sensory, touch mark.”* The examiner has indicated in the outgoing Office Action, among others, that *“There is nothing in any of applicant’s evidence that indicates that consumers will experience a cashmere sensation when applying the lipstick and then also associate that feeling with the source of applicant’s lip products.”* The applicant did not respond and the application was considered as abandoned.¹⁷⁵

The following obstacle is functionality. A touch mark must overcome both utilitarian and aesthetic functionality. For instance, the touch may be perceived as contributing to better functioning of a particular good, e.g. texture of a bottle with recesses may provide a better grasp thereof. On the other hand, floral design protuberances on the doll packaging may make it more appealing. For the sake of practical example of refusals on that basis the attempt to register the touch mark under serial No. 85426225 for cosmetic brushes can be analysed. The mark had the following description *“The mark consists of a scratched or etched texture on the metal neck of a cosmetic brush, connecting the handle and the brush head.”* After assessing the mark, the examiner refused registration due to utilitarian functionality thereof since the texture enhanced the grip of the metal neck and was used mainly for that purpose. In order to rebut that finding the examiner requested the applicant to provide the relevant information according to the *Morton-Norwich* functionality test. However, no response was provided and the application was considered as abandoned.¹⁷⁶

Texture marks can be also refused in registration on the basis of lack of distinctiveness. Having analyzed the materials regarding the only currently live touch mark, which was indicated above, it can be concluded that the mark was filed without claim of acquired distinctiveness.

¹⁷³ The touch mark is registered under the registration No. 3896100 in the name of The David Family Group, LLC.

¹⁷⁴ Christina S. Monteiro, “A Nontraditional Per-Spectrum: The Touch of Trademarks,” INTA, Accessed 2 February 2020, <http://www.inta.org/intabulletin/pages/anontraditionalperspectrum.aspx>.

¹⁷⁵ The touch mark was applied under the serial No. 87782210 by Shiseido Company, Limited.

¹⁷⁶ The touch mark was applied under the serial No. 85426225 by Hongwei Shan.

Thus, texture marks can have both inherent distinctiveness and the acquired one. Nevertheless, that requirement is the least burdensome for touch marks applicant in comparison to other conditions since the refusals found by the author in the TSDR were either on the ground of inability to function as a trademark or due to functionality of touch marks.

To sum up, it can be stated that texture marks are among the least popular non-conventional marks since textures are usually perceived as merely ornamental elements of goods and not as source identifiers. That is one of the reasons why there is only one currently live touch mark. Moreover, it is also difficult for texture marks to overcome the functionality requirement since it is necessary to prove that the mark is not an utilitarian or aesthetic feature of the goods. The distinctiveness criterion is the least burdensome requirement as compared to others. Still, in order to get to those steps, the applicant must prepare a proper representation of the mark in the first place.

D. Sound marks

Sounds have a great impact on human's perception of environment. Sound marks are in active use in the USA and the USPTO have registered the first sound 70 years ago. It was the sound for radio broadcasts of the National Broadcasting Company.¹⁷⁷ As for now, numerous sounds have been successfully registered as well (around 170 are live at the moment).

In order to apply a sound mark, the applicant is not required to provide a drawing. Instead of it, it is obligatory to submit a description and an audio reproduction of the mark so that to supplement and clarify the description. It should be noted that the said audio file is not a substitution of a specimen and the mark itself must be present thereon without other information.¹⁷⁸ A specimen is to be provided separately and show how the sound is used in connection to the relevant goods and/or services. Usually, both a specimen and an audio file with the mark must be provided in wav, .wmv, .wma, .mp3, .mpg, or .avi formats and should not exceed 5 MB in size.¹⁷⁹ It is also crucial to emphasize that if the mark contains music or words set to music, the applicant should generally provide the musical score sheet.¹⁸⁰ Sound marks are usually easily complying with those requirements. For the sake of example, the following mark's description can be named: *"The mark is a sound. The mark consists of Instrumental work performed by two pianos in the key of B-major that is comprised of a five-note melody of D#5, E5, F#5, B4, and*

¹⁷⁷ Candida J. Hinton, "In Your Ear! Trademarking a sound mark requires more than a good ear for music," INTA, Accessed 2 February 2020, <https://www.inta.org/INTABulletin/Pages/InYourEarTrademarkingasoundmarkrequir esmorethanagoodearformusic.aspx>.

¹⁷⁸ "Trademark Manual of Examining Procedure".

¹⁷⁹ See note 178 above.

¹⁸⁰ See note 178 above.

ending on the B4 and B5 octaves and accompanied by two B (tonic) chords.” The description was accompanied by the mp3 representation of a mark and wmw video showing how the sound is used.¹⁸¹

As a first step of the examination procedure, the examiner must ascertain whether the sound may function as a source indicator. It can be “*in those situations where they assume a definitive shape or arrangement and are used in such a manner so as to create in the hearer’s mind an association of the sound with a service [or a good].*”¹⁸² Such a test was applied, among others, in *GML, INC. v. Mayhew* case. It was related to granting protection to the compilation of master recordings of songs named “Little Darling` Masters”. Subsequently, the court held that musical recording does not signify the source thereof and are the product that is owned. That sound recordings did not signify anything other than themselves.¹⁸³

If sound marks are found as being able to be a source indicator, they still must be non-functional for obtaining the legal protection. As numerous pointed out above, a mark is functional if it is essential for the use or purpose of the product or if it affects the cost and quality thereof.¹⁸⁴ That is, if exclusive use of the feature would humper the competition on the market. That could be so in the context of sound marks when the mark is sought to be registered for goods or services from which consumers normally expect to be accompanied by a certain sound and monopolizing that sound may negatively affect the competitive abilities of other players on the relevant market. For instance, in *Vertex Group LLC* case, the applicant sought to register the alarm sound for security alarms. In that case, the court concluded that the sound is functional and cannot be registered since the ability of the applicant’s goods to emit a loud, pulsing sound is essential for the indicated goods. In particular, it was stated that the said sound “*involves alternating sound pulses and silence, which the CPSC paper and other evidence shows is a more effective way to use sound as an alarm than is a steady sound.*” In addition, the court reviewed the Morton-Norwich factors, the majority of which was found as present. Therefore, the sound was refused the registration because other competitors were in a serious disadvantage if that sound would be monopolized.¹⁸⁵ The same was found for registration of Harley-Davidson’s “chug” of their motorcycle engines. Apart from the distinctiveness question, a number of

¹⁸¹ The sound mark is registered under the registration No. 5905067 in the name of Brighthouse Services, LLC.

¹⁸² Jeffrey Cadwell, “What’s That Sound? It Might Just Be a Trademark,” Lexology, Accessed 4 February 2020, <https://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7>.

¹⁸³ “*GML, INC. v. Mayhew*, 188 F. Supp. 2d 891 (M.D. Tenn. 2002),” Justia, Accessed 4 February 2020, <https://law.justia.com/cases/federal/district-courts/FSupp2/188/891/2577009/>.

¹⁸⁴ “*Traffix Devices, Inc.*”.

¹⁸⁵ “*In re Vertex Group LLC.*” Casetext, Accessed 4 February 2020, <https://casetext.com/admin-law/vertex-group-llc-1>.

opposing parties argued that the mark is a functional noise, crucial to the use of the motorcycle. However, Harley abandoned the application and the dispute was never settled.¹⁸⁶

As for distinctiveness, sound marks may be inherently distinctive. Thus, according to the finding in the *Vertex Group LLC* case, which is citing *General Electric* case, sounds may be registered without proof of acquired distinctiveness if “*sounds are arbitrary, unique or distinctive and can be used in a manner so as to attach to the mind of the listener and be awakened on later hearing in a way that would indicate for the listener that a particular product or service was coming from a particular, even if anonymous, source*”. On the other side, if a sound relates to “*commonplace sounds, or those which individuals may have been exposed to under other circumstances*”, evidence of the distinctiveness acquired through use must be provided.¹⁸⁷ Thus, if the registration of a sound is sought for goods which make that sound in their normal course of operation, that sound may be granted protection only upon showing acquired distinctiveness. For instance, alarm clocks, appliances that include audible alarms or signals, telephones. As an interesting case, *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.* can be named. It is related to protection “*a quacking noise made by tour guides and tour participants by use of duck call devices*”. The sound was found as not inherently distinctive since quacking is the kind of familiar noise for consumers and thus substantial evidence of secondary meaning was to be provided to show that the noise was linked with the Plaintiff's provision of amphibious tours in the minds of the consumers.¹⁸⁸

In conclusion, it can be inferred that sound marks are the most popular type of non-visual marks in the USA. The sounds should not be represented graphically in the application and may be represented in various electronic formats with the accurate and precise description. Non-functional sound marks may be registered on the Principal Register if they are inherently distinctive. Otherwise, proof of acquired distinctiveness should be provided. In addition, the US courts have developed detailed rules as regards functionality assessment, which are to be followed by the applicants.

2.2. Registration of Non-conventional Marks in the EU in Practice

¹⁸⁶ “Apple Registers Startup Sound as a Trademark,” Lizerbramlaw, Accessed 10 February 2020, <https://lizerbramlaw.com/2013/01/03/apple-registers-startup-sound-as-a-trademark/>.

¹⁸⁷ “In re Vertex Group LLC.”.

¹⁸⁸ “Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.” Casetext, Accessed 10 February 2020, <https://casetext.com/case/ride-the-ducks-llc-v-duck-boat-tours>.

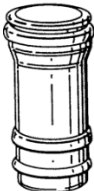
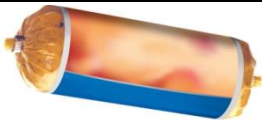
2.2.1. Registration of Visual Marks

A. Three-dimensional marks

In the EU, shape marks are defined as trademarks “*consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark).*”¹⁸⁹ As evident from the definition, shapes cover not only shapes of the product packaging, but also the shapes of goods itself. There are almost 5000 live shape marks registered by the EUIPO which makes them the largest category of non-conventional marks in the EU. In comparison to the US trade dress, there is no such category as product design, which is covered by a product packaging. However, the EU legislation may grant the protection to such a category as shape of products, which is not covered by the US trade dress.

In order to apply a shape mark in the EU, it is necessary to prepare, *inter alia*, an acceptable representation of the mark. Since neither prior commercial usage of the mark nor intent-to-use application is required, the applicant is not obliged to supply a specimen of the object for which the mark is applied. Moreover, a description of shape marks is not required. However, some of the applicants still use provide descriptions and/or specimens in order to clarify the subject matter of their applications.

According to the EUTMIR, a shape mark shall be represented by a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. Any of them may be used. The reproduction may contain different views of the marks. Still, there should not be more than 6 of them. For instance, the following representations were accepted by the EUIPO:

No.	Drawing	Description
1. ¹⁹⁰		none
2. ¹⁹¹		A roll, closed at both ends like a sausage, covered with a banderole from underneath which the ends of the roll are visible.

¹⁸⁹ EUTMIR.

¹⁹⁰ The shape mark is registered under trademark No. 000099895 in the name of Europe Brands S.à r.l.

¹⁹¹ The shape mark is registered under trademark No. 005220512 in the name of Meggle AG.

Having regard to functionality of shape marks, that aspect was analyzed in detail in the previous chapter since that ground for refusal in registration was initially created exclusively for shapes and thus all the relevant practice is built solely on them. *See subchapter 1.2.2(B) on that regard.*

As for the distinctiveness requirement to shape marks, it is basically the same as for other marks. However, for the purpose of assessing distinctiveness, the public's perception is different in comparison to word or figurative marks. Average consumers are not in habit to perceive shapes as source identifiers as in case of graphic or word elements. Thus, it may appear to be more difficult to establish distinctiveness as to shape marks.

Under the said conditions, *“the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of”* distinctiveness. Therefore, if a shape mark departs significantly from the norms or customs of the relevant sector, it has the highest chances of being considered as inherently distinctive.¹⁹²

As an example, the dispute between In Voss of Norway ASA and OHIM (now EUIPO) can be analyzed. Voss obtained registration for a transparent cylindrical bottle with a silver cap of the same diameter as the bottle for various drinks:



A few years later, the registration was invalidated by a competitor on the basis of non-distinctiveness of the shape and the case subsequently got to appeal hearing in the Sixth Chamber of the CJEU. In the first place, the court reiterated that the distinctiveness is to be assessed in subjective manner taking into account both the goods and services for which the mark was applied, and perception of the relevant public. Then, the court proceeded to the main question and held, *inter alia*, that it is correctly determined that the average consumer in the EU would perceive the shape in question as merely a variant of the shape of goods for which registration is sought and it does not depart significantly from the norms or customs of the relevant sector. Moreover, the court clarified that the attention is to be given to elements which are combined in the shape, since their form and arrangement convey the overall impression of

¹⁹² “Henkel KGaA v OHIM, Joined Cases C-456/01 P and C-457/01 P,” Curia, Accessed 10 February 2020, <http://curia.europa.eu/juris/showPdf.jsf?text=&docid=55401&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1&cid=666591>.

the mark and their distinctive character should be assessed in determining distinctiveness of the mark as a whole. In the present case a cylindrical basic shape and a non-transparent cap with the same diameter as that cylinder are “*in general commercial use for packaging the goods covered by the trade mark application and is therefore devoid of distinctive character in relation to those goods.*” In the end, the appeal was dismissed and the registration of the shape mark was left invalid.¹⁹³

As a last chance for shapes that are not inherently distinctive, acquired distinctiveness is to be shown. However, as it was clarified by the EUCJ in the case related to acquired distinctiveness of the shape of a four-fingered chocolate-coated KIT KAT bar, the distinctiveness should be shown throughout the whole EU.¹⁹⁴ That challenge sometimes is insurmountable for shapes. As a proof of that, according to the data in the EUIPO register, only 1/5 of live shape marks were registered on the basis of acquired distinctiveness.

Having regard to comparison of the EU approach to shape marks to the one taken in the US, it is more burdensome to apply a shape in the US since it is necessary there to prepare not only a proper reproduction of the mark, but also a specimen and a description thereof. However, a part of registered shapes still contain a description. In author's opinion, it assisted not only the examiners while examining the marks, but also it is helping interested market players to better understand the subject matter of such applications.

As for the distinctiveness requirement towards shape marks in the EU, it is common for all types of shapes unlike the US approach where there are separate tests for both product packaging shapes and for product designs. Furthermore, a shape trademark in the EU encompasses slightly different objects and does not include product designs into that category as it so in the US. However, the test which is applicable to products packaging in the US is similar to the common EU test, both of which require a shape mark to be different from what is customary on the relevant market in order to be inherently distinctive. In the opposite case, acquired distinctiveness must be shown. Still, the EU requires showing prove it in each Member State unlike the US shape marks, where evidence of distinctiveness is not tied to each State and is to be shown in general.

To sum up, shape marks are the largest category of non-conventional marks despite the fact that the functionality requirement was designed specifically and exclusively for them and it

¹⁹³ “Voss of Norway v OHIM, Case C-445/13 P,” Curia, Accessed 15 February 2020, <http://curia.europa.eu/juris/document/document.jsf?text=&docid=164150&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=1163708>.

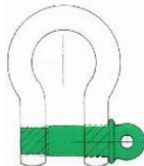
¹⁹⁴ “Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd. and EUIPO”.

precludes a lot of shapes from the registration. It is also not a difficult mission to properly represent a shape in the application since there are various means for that and neither the description nor the specimen is required.

B. Colour marks

The EUTMIR defines a colour mark as a mark that consists exclusively of a single colour or a combination of colours without contours. There are currently around 270 live colour marks in the EUIPO register.

There are two separate requirements as to representation of the mark in the application. If the mark consists exclusively of a single color, it *“the mark shall be represented by submitting a reproduction of the colour and an indication of that colour by reference to a generally recognised colour code.”* If the mark contains more than one color, it *“shall be represented by submitting a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by reference to a generally recognised colour code.”*¹⁹⁵ Thus, the reproduction of a color mark must be accompanied by the indication of a relevant colour code of any generally recognized systems unlike the US, where no such requirement is present. If there is no indication of the code or the code does not correspond to the representation, the examiner will issue a deficiency.¹⁹⁶ In addition, if an applied colour mark includes more than one colour, a description may be also provided. It would detail the systematic arrangement of the colours in the mark and explain how they are applied to the relevant goods and/or services.¹⁹⁷ For instance, the following representations of color marks were accepted as appropriate:

No.	Drawing	Description
1. ¹⁹⁸		The mark is being formed by the colour green as applied to the pin.

¹⁹⁵ EUTMIR.

¹⁹⁶ “Guidelines for Examination of European Union Trade Marks”.

¹⁹⁷ EUTMIR.

¹⁹⁸ The colour mark is registered under the trademark No. 002198083 in the name of Van Beest B.V.

2. ¹⁹⁹		The mark consists of a combination of the colours black and yellow as they are applied to or incorporated in the products mentioned in section 70 of this form.
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As evident from the examples, despite the fact that the possibility of the description provision is an option only for colour combination marks, it is also used in single colour marks. Moreover, the reproduction may show how and where the colour is applied on the relevant objects, not only a colour itself, although such a possibility is not envisaged in the EUTMIR.

Moreover, if the one seeks to register a colour combination, it is necessary to reproduce the mark in the systematic arrangement of the colour combination in a uniform and predetermined manner. That requirement means that the mark should make it possible to ascertain the exact way in which colours will be used if the registration is granted. If the applicant fails to do so through provision of a clear reproduction of the mark with or without description, the marks will be refused in registration. As an instance of such a situation, the court dispute between Red Bull and EUIPO can be named. The case related to lawfulness of invalidation of a colour combination marks representing silver and blue rectangles registered for energy drinks having the following descriptions: *“The ratio of the colours is approximately 50%- 50%”, “The two colours will be applied in equal proportion and juxtaposed to each other”*. Having analyzed the case, the court held that these descriptions *“allowed for the arrangement of those two colours in numerous different combinations, producing a very different overall impression.”* Thus, the marks were held as being not in line with the requirement as to systematic arrangement and were left invalid.²⁰⁰

After the Reform, colour marks may be refused in registration also on the basis of functionality thereof since they may fall under the wording “another characteristic” indicated in article 7(1)(e) of the EUTMIR. So the mark applied for registration of ink colour for inks may be refused in registration on the basis of natural functionality, the mark applied for registration of red-chameleon colour for cars may be refused on the basis of aesthetic functionality and red colour trademark applied for fire fighters` equipment may be refused on the basis of utilitarian functionality. Still, it is not clear how exactly that requirement will be applied in practice. If making a comparison to the US approach, where colours are treated as functional if they are

¹⁹⁹ The colour mark is registered under the trademark No. 001222561 in the name of the Black & Decker Corporation.

²⁰⁰ “Red Bull v EUIPO, Joined Cases T-101/15 and T-102/15,” Curia, Accessed 15 February 2020, <http://curia.europa.eu/juris/document/document.jsf?text=&docid=197307&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=1164606>.

essential to a product's use or purpose and/or affect cost or quality, basically the same sense is put in the non-functionality requirement in the EU. Thus, the relevant US practice may be of a great help for the applicants in the EU. Still, these two criteria should be checked also together with the potential effect of the registration on competitors on the relevant market. If the registration may put them into significant non-competitive disadvantage, the mark should not be registered.

If a color mark is found as being non-functional, it still may be refused in registration if it is not distinctive. According the EUCJ, “[c]onsumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element.” Thus, color *per se* is usually non-distinctive and showing of acquired distinctiveness is necessary. However, the court proceeds, a color may be inherently distinctive in exceptional cases “where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.”²⁰¹ Thus, colours in the EU may be inherently distinctive if they are applied where they are not normally used. For instance, if the one apply a purple colour for band-aids, which are usually white, the mark may obtain registration on the ground of inherent distinctiveness. That approach drastically differs from the one taken in the US, where even the applicant of the pink colour for home insulation was required to show evidence of acquired distinctiveness.²⁰²

It is also worth to point out that the same finding of the EUCJ as to inherent distinctiveness relates to color combinations, since a number of such marks are currently registered in the EUIPO register without showing acquired distinctiveness. However, the assessing distinctiveness of such combinations is more severe. When even one of the colours is not distinctive, the whole mark will be refused in registration.

If a colour mark lacks inherent distinctiveness, acquired distinctiveness is to be shown. As for now, the territorial scope of proving acquired distinctiveness is more-less clear due to the recent finding in the *Nestle* case²⁰³. Prior to it, as was analysed in the first chapter, that aspect was unclear and different institutions applied it differently. For instance, in *Whiskas* case, Mars Ltd managed to show acquired distinctiveness of the purple colour *per se* in a substantial part of

²⁰¹ “Libertel Groep BV v Benelux-Merkenbureau, Case C-104/01,” EUR-Lex, Accessed 15 February 2020, <https://eur-lex.europa.eu/legal-content/EN/ALL/?uri=ecli:ECLI:EU:C:2003:244>.

²⁰² “In re Owens-corning Fiberglas Corporation”.

²⁰³ “Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd. and EUIPO”.

the EU and the mark was registered ²⁰⁴ If that dispute arose now, the registration would be refused since the distinctiveness would be shown not in all parts of the EU.

To sum up, the requirements as to representation of colour marks in the EU are similar to the ones in the US. However, the EU applicant is not obliged to provide neither a description of the mark nor a relevant specimen to the examiner. Moreover, colours in the EU may be inherently distinctive and thus it becomes somewhat easier to register them. Still, if the mark was not considered as such, the acquired distinctiveness in the whole EU is to be shown in order to register it. Having regard to the non-functionality of colours, it is not clear how the requirement is applied in practice at the moment. Nevertheless, the case law developed in the US may be of a great help while preparing the application.

C. Hologram marks

According to the EUTMIR, hologram marks are marks consisting of elements with holographic characteristics. They show a three-dimensional and free-standing image which can be perceived without any extraneous means.

In order to apply a hologram mark in the EU, it is necessary to represent it either *“by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.”*²⁰⁵ Prior to the Reform, the requirement as to representation could be fulfilled either by photographic reproduction in multiple images that convey the holographic effect or by a description.²⁰⁶ Thus, since after the reform only 3 holograms were registered and there are only 6 live marks in total, a half of the currently registered holograms are represented graphically by a photographic reproduction, which is supplemented by a description, and the other half is reproduced by a video due to the fact that it represent a hologram more precisely. However, the later marks do not contain a description (it is not required by the law now), which would be of a great help in understanding the subject matter of marks for all interested parties.

Having regard to the non-functionality requirement, there are no relevant case law and practice since during the last three years only 4 holograms were applied and 3 of them were registered. The situation is similar to the one in the US, where also no such relevant cases which would pour the light on that aspect. Still, holograms in the EU are also vulnerable to utilitarian

²⁰⁴ Jekaterina Kudrjavceva “Issues surrounding registration of colour trade marks.” (master thesis. Riga Graduate School of Law, 2012), 31, <https://www.rgsl.edu.lv/uploads/research-papers-list/14/rp-9-kudrjavceva-final.pdf>.

²⁰⁵ EUTMIR.

²⁰⁶ Kudrina, “Non-Traditional Trade Marks”, 14.

non-functionality requirement, since they are used rather for protection from unauthorized copying and other illegal actions than for identifying the source of goods and/or services.

As for distinctiveness, all holograms that are live in the EU are registered on the basis of inherent distinctiveness. Moreover, the same related to all other hologram marks that were ever applied as EU trademarks. Nevertheless, holograms may be potentially registered on the ground of acquired distinctiveness. That situation is similar to the one in the US where holograms can be also inherently distinctive. However, the evidence as to the mark recognition should be provided as regards all Member States in the EU. Still, no relevant conditions for recognition holograms as inherently distinctive or case law has been ever articulated both in the EU and the US.

In conclusion, it can be inferred that EU hologram marks are as rare as the ones in the US. There are only a few registered and thus the rules as to their registration are scarce and relate mainly to the reproduction issue. As for functionality and distinctiveness, there are no relevant rules. However, the applicants may scrutinize the EUIPO register in order to find some useful hints.

D. Motion marks

The EUTMIR defines motion marks as trademarks “*consisting of, or extending to, a movement or a change in the position of the elements of the mark*”. Motion mark had been granted legal protection long before the Reform (since at least 2003 when Vattenfall AB has obtained the registration for its “*moving trademark consisting of the letter L with a light beam moving from right to left*”²⁰⁷).

However, the Reform contributed to the number of registered motions as to no other non-conventional mark. In particular, since 2017 the number all currently registered motion marks was registered after the Reform and only 2 out of 42 are represented by still images. That is so due to introduction by the Reform of the rule that motion marks may be represented not only by “*sequential still images showing the movement or change of position*” (the number of which is not limited as long as they fit in one single JPEG file or on one single A4 sheet²⁰⁸), but also by submitting a video file, which conveys the subject matter more precisely in comparison to still images. However, those using the old way may accompany their applications by a description.

²⁰⁹ At the same time the US legislator does not permit video representation and states that motions may be represented only by either a single point image or the drawing that depict up to

²⁰⁷ The motion mark under filing No. 001772615 was registered by Vattenfall AB.

²⁰⁸ “Guidelines for Examination of European Union Trade Marks”.

²⁰⁹ EUTMIR.

five freeze frames showing various points in the movement, accompanied by a description.²¹⁰ That approach cannot be considered as up-to-date since despite the mandatory provision of a description, neither a single image nor a number of them are able to convey the gist of motion marks as it can be done by a video file. Moreover, it is so taking into account the nature of a motion mark which is inherently connected with a video.

Having regard to the non-functionality and distinctiveness requirements, they are probably less problematic for the applicants as proving that a motion actually functions as a source indicator. If the applicant has managed to prove that, he may try to file a motion mark on the basis of inherent distinctiveness, otherwise acquired distinctiveness in to be shown in the whole EU. One of the convincing reasons to do so is that all currently registered motions are registered on the ground of inherent distinctiveness. At the same time, a number of motions were registered as distinctive through use. As for functionality, there are no clear guidelines on that regard. However, in 2003, Lamborghini motion mark application for registration of upwards-swiveling car door movement was refused in registration on the basis, *inter alia*, that the mark is three-dimensional in nature and “amounts to nothing more than a characteristic mechanical movement which in the opinion of the Board equates to a technical function of a car door.”²¹¹ Thus, the mark was refused since it depicted the movement that was necessary only for achieving a utilitarian purpose and not for identification of a source. However, the mark was applied as a motion and the non-functionality requirement could not be applicable to it at the time following the literal wording of Article 7(1)(e) ii) CTMR. Interestingly, the same mark was successfully registered in the US.²¹² The situation in the US with non-functionality and distinctiveness requirements is basically similar since no detailing rules have been developed and the applicants should follow the relevant general provisions of law.

To sum up, despite presence of registered motion marks in the EU since early 2000s, they literary thrived after the Reform due to permission of video file representation in the application. At the same time, the US still does not permit that way of motion mark reproduction. Having regard to non-functionality and distinctiveness requirements, the case-law and practice is still scarce. However, it is clear that motion marks may be registered on the basis of inherent distinctiveness and be sometimes functional.

²¹⁰ “U. S. Trademark Law Rules of Practice”.

²¹¹ “Automobili Lamborghini Holding S.p.A, Case R 772/2001-1,” OAMI, Accessed 17 February 2020, https://oami.europa.eu/copla/trademark/data/001400092/download/CLW/APL/2003/EN/20030923_R0772_2001-1.pdf?app=caselaw&casenum=R0772/2001-1&trTypeDoc=Human&sourceLang=de.

²¹² The motion mark is registered under the registration No. 2793439 in the name of Automobile Lamborghini Holding S.p.A.

2.2.2. Registration of Non-visible Marks

A. Scent marks

Scent marks are the marks representing a particular smell of goods and/or services. There is no smell marks registered at the moment, however they can be potentially registered since no limitation is present in the definition of a trademark. The reason behind that is the fact that smells cannot be currently represented in a clear, precise, self-contained, easily accessible, intelligible, durable and objective way as required by *Sieckmann criteria* test and article 3(1) of EUTMIR which incorporated that test.²¹³ Before the *Sieckmann criteria*, one scent mark was successfully registered – the smell of freshly cut grass for tennis balls. Nevertheless, ECJ stated that it was a pearl in the desert.²¹⁴ Afterwards, there were some attempts to bypass the requirement by different ways, but they did not succeed, e.g. the following representation was once used in the smell mark application:

The Trade Mark is the smell of tea tree oil applied to industrial safety gloves. ²¹⁵

Unlike the US, where smells are represented by a description and a specimen, the EU legislation does not permit trademarks to be represented by a description as well as by samples or specimens. Thus, scents will not obtain registration in the EU either until the current state of technology does not allow them to be represented in the register so that to meet the requirements under article 3(1) of EUTMIR or until the legislation is amended. As an option, some authors propose developing of smelling screen, which is an olfactory display system that can generate a smell distribution on a two-dimensional display screen.²¹⁶

The practical reason behind that bar is that smell of goods and/or services cannot be perceived without actually smelling, which may not be done without the relevant goods or services or technical means enabling that smelling. So the market players as well as state authorities would have substantial difficulties in accessing smell marks in the register. However, that practical reason does not bother the US authorities which consider a mere description of flavor marks as sufficient for perception of a smell mark.

²¹³ EUTMIR.

²¹⁴ Vasheharan Kanesarajah, “The taste of ripe strawberries: representing non-visual trademarks,” IPS, Accessed 17 February 2020, <http://ips.clarivate.com/m/pdfs/klnl/2008-03/taste.pdf>.

²¹⁵ The smell mark was applied under filing No. 012741401 by ATG Ceylon (Pvt) Limited.

²¹⁶ Eleonora Rosati, “Scents and trade marks - The EU reform of olfactory marks and advances in odour recognition techniques,” IPKitten, Accessed 18 February 2020, <http://ipkitten.blogspot.com/2018/01/scents-and-trade-marks-eu-reform-of.html>.

Having regard to the functionality and distinctiveness requirements, the exact content of them as regards smell marks will be established when at least one scent overcome the representation requirement and either is registered or refused on the other basis. As for the US, a smell may be registered if (1) it is capable of functioning a source indicator (2) it is not *“essential to the use or purpose of the article or if it affects the cost or quality of the article”*²¹⁷ (as was discussed in the 2.1.2. paragraph) and (3) if it has acquired distinctiveness prior to the application for registration, since smells are never inherently distinctive.

To put it all together, scent marks has a potential to be registered in the EU. However, they cannot be trademarked at the moment due to the requirement as to representation of marks introduced by Sieckmann case. What is left for business interested in such marks is waiting amendments of the requirement under article 3(1) of EUTMIR, which is hardly possible, or to contribute in Research and Development spheres, which may assist in discovering the ways to meet the requirement.

B. Flavor marks

Taste marks are in the same situation as scent marks. They may be theoretically registered. Still, the requirement of article 3(1) of EUTMIR precludes them from registration in practice. As a consequence, no flavor marks are currently registered in the EU (as well as in the US). Apart from granting protection in theory, the situation is similar on the practical dimension. Taste of goods cannot be perceived without tasting the goods at the moment. Moreover, taste of products may be felt only when the product is consumed which means that the consumer will get an access to it after the purchase.²¹⁸

So since neither a description nor a specimen is considered as a proper representation, the only way for applicants is to wait for changes. In the opposite case, they will get the similar result as Eli Lilly has got. The company was an applicant of the taste of artificial strawberry flavor for pharmaceutical preparations and received a refusal in registration on the basis of inappropriateness of a description as a way of representation the mark in the application. In addition, the mark was found as non-distinctive and used only in order to cover unpleasant taste of medicines (functional).²¹⁹

Having regard to distinctiveness and non-functionality, it is unclear how tastes would overcome that requirements. Nonetheless, as US courts emphasized that first of all it is necessary

²¹⁷ “Traffix Devices, Inc.”.

²¹⁸ Kudrina, “Non-Traditional Trade Marks”, 39.

²¹⁹ “Eli Lilly and Company, Case R120/2001-2,” Copat, Accessed 18 February 2020, <https://www.copat.de/markenformen/r0120-2001-2.pdf>.

to prove that consumers perceive it as a trademarks and not as a merely attribute of the goods, and only then deal with that two requirements. What about understanding how that conditions may be applied, the US court practice may also help. However, it introduces nothing new and states that if a taste is used for a particular utilitarian purpose or damages competition on the relevant market, that taste is to be refused as functional. If a taste is non-distinctive and commonly used by other competitors, the mark is to be refused on the basis of non-distinctiveness.

To sum up, despite the fact that tastes may be registered as a trademark, the current representation requirements bars that from registration in practice. Similarly to the situation with smells, all what is left for applicants is to wait for amendments of the requirement or emergence of new technologies enabling the public to perceive the taste without tasting the relevant goods. Having regard to the distinctiveness on non-functionality conditions, the US practice may be somewhat useful. However, no tastes were registered there either.

C. Texture marks

Texture marks are marks which protect tactile effects of certain goods. In the EU, texture marks fall under the category “other”. Thus, they should meet the general requirements put towards all EU trademarks, including the ones concerning representation of marks envisaged in article 4 of EUTMR. Since current level of technology does not permit to convey tactile feeling to the public without touching the relevant goods, no texture marks are eligible for registration at the moment.²²⁰

As an example of failed attempt, the dispute between the Procter & Gamble Company and OHIM (now EUIPO) can be named. The company sought to register “*the tactile feeling constituted by the imprinted embossed pattern on the smooth bottle surface*” for products like soaps and cosmetics. The registration was subsequently refused and while it was stated by the Board that textures may be potentially registered, the description and the photo of the relevant good did not suffice for proper representation of the texture. Additionally, as the examiner stated “*it is impossible to deduce from the image as filed to identify with certainty the claimed ‘tactile feeling.’*”²²¹ At the same time, it is sufficient to provide a description and a specimen of the texture in order to register it as a trademark in the US. However, as EU examiner indicated, that means can hardly be considered as acceptable for informing the public about exclusive rights

²²⁰ “Guidelines for Examination of European Union Trade Marks”.

²²¹ Roberto A. Jacchia and Giulia Beneduci, “Wind in the sails for atypical trademarks within the EU,” DeJalex, Accessed 19 February 2020, https://www.dejalex.com/wp-content/uploads/2017/11/20171016_Memorandum-sui-marchi-atipici.pdf.

granted to the proprietor, letting alone examiners for which a description and a specimen may be enough for assessing the applied object.

Having regard to the non-functionality requirement which may now be applicable also to texture marks, as the US practice shows textures can contribute to both aesthetic and utilitarian functionality of goods. Thus, if the examiner believes that the texture is used or is to be used mainly for other purposes than source identification, the mark should be refused in registration. As for distinctiveness, there are no either registered or refused tactile marks were found in the EUIPO register, thus it is yet to see how that requirement will be applied to textures. However, from the point of view of the US authorities, textures may be inherently distinctive as it was proved by a sole currently registered leather texture for bottles of wine.

Summarizing the said above, texture marks cannot be currently registered since the current state of technologies do not permit to convey a texture to the public in order to meet the requirement as to the representation of a texture. As to the non-functionality and distinctiveness requirements, there are no guiding principles on that regard at the moment. Still, the US practice may clarify some general aspects.

D. Sound marks

Sounds were always recognized as an important element in business sphere for distinguishing one goods and services from the ones of other competitors. Thus, there were attempts to trademark them in order to make such use exclusive. The EUTMIR defines sound trademarks as marks “*consisting exclusively of a sound or combination of sounds*”.²²² While the first sound mark in the US was registered back in 1950 (sound for radio broadcasts of the National Broadcasting Company²²³), the first sound mark obtained legal protection on the EU level in 1990. The reason of that are the limited options for representation of sounds in the application, namely only graphical representation was acceptable. Subsequently, that requirement could be satisfied also by music notation, lyrics accompanied by music notation or a sonographic image together with a sound file²²⁴.

After the Reform, a sound mark must be represented by submitting either an audio file reproducing the sound or an accurate representation of the sound in musical notation.²²⁵ without provision of any description. The first option is available only for e-filings and the size of the audio file should not exceed 2 megabytes without streaming or looping the sound. If the second is used, musical notations must be submitted in one single JPEG file or on one single A4 sheet

²²² EUTMIR.

²²³ Hinton, “In Your Ear!”.

²²⁴ Kudrina, “Non-Traditional Trade Marks”, 23.

²²⁵ EUTMIR.

(appropriateness of that mean was confirmed by the CJEU in *Shield Mark* case²²⁶) In case the applicant filed both representations, he will be asked to choose only one of them.²²⁷

Having analyzed the EUIPO register, it can be inferred that after the Reform sound mark applicants greatly benefited from abolition of graphic representation requirement since 80% of sound marks registered afterwards were represented by an audio file.

At the same time, in the US it is obligatory to submit the description and an audio reproduction of the mark and there is no such an option as provision of a musical notation. From one side, it can be considered as a logical move since average person is likely not capable to fully understand what sound is registered from a mere notation image. For instance, the following representations are present in the EU register:



At the same time, while both a description and an audio file are required, the TESS does not permit listening registered sound marks and provides access only to the description. What about the TSDR, the one can find a mp3 file in the distant corners of the correspondence files. In contrast, an audio reproduction of sound marks in the EUIPO register is readily accessible.

Having regard to the non-functionality requirement, no sounds were refused on that basis after the reform. However, as the US example shows, sounds may be functional. For instance, it may be so when the applicants seeks to register a sound for goods or services from which consumers normally expect to be accompanied by a certain sound and monopolizing that sound may negatively affect competitiveness on the market (as was shown in *Vertex Group LLC* case for alarm clocks and in *Harley-Davidson* case for engines). However, how that requirement will be applied in practice in the EU is yet to see.

As for distinctiveness, the EUCJ did not say his word on that regard. Nevertheless, EU scholars think that sounds may serve as naturally distinctive source indicators.²³⁰ The same is also confirmed by sound marks registered without claim of acquired distinctiveness and present

²²⁶ “Shield Mark BV”.

²²⁷ “Guidelines for Examination of European Union Trade Marks”.

²²⁸ The sound mark is registered under trademark No. 000907527 in the name of European Broadcasting Union (EBU).

²²⁹ The sound mark is registered under trademark No. 004610986 in the name of Intel Corporation.

²³⁰ Garry Trillet, “Registrability of smells, colors and sounds: how to overcome the challenges dressed by the requirement of graphical representation and distinctiveness within European Union law?” SSRN, Accessed 19 February 2020, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2340431.

in the EUIPO register. The US sound marks are in a similar position and also may be inherently distinctive. However, the US courts provide clear guidance on the assessing the distinctiveness. In particular, in *Vertex Group LLC* case. Thus, the one may expect his sound to be registered without showing secondary meaning when is *arbitrary, unique or distinctive. At the same time, if the sound is commonplace or when individuals may have been exposed to it under other circumstances*”, evidence of the distinctiveness acquired through use must be provided. Thus, if the registration of a sound is sought for goods which make that sound in their normal course of operation, that sound may be granted protection only upon showing acquired distinctiveness.²³¹ For instance, the clicking sound of Zippo lighters was refused in registration probably due to the fact that the application was based on inherent distinctiveness and the sound was subsequently considered by the examiner as a commonplace for lighters.²³²

In conclusion, it can be summarized that despite wide presence of sound marks in the EUIPO register, there are no clear guiding principles as to assessing distinctiveness and functionality of sounds applied as it is so in the US. Nevertheless, the Reform managed to clarify how sounds are to be represented in the application and that can be considered as a positive move on the way of articulation of precise and clear rules as regards sound marks registration.

Conclusions of the chapter

To sum up, it can be inferred that analysis of four visual and four non-visible marks showed that due to introduction of *Sieckmann criteria* the EU's approach to representation of marks in the application became stricter and now it precludes scents, textures and flavors from registration owing to absence of technology permitting properly represent such marks. At the same time, the EU trademark database is more developed technologically than in the US and give access to all trademark representations that overcame the criteria. As for the US, the legislator does not put any additional requirements towards non-conventional marks registration and it is generally acceptable that even non-visible marks may be represented by images and a description. Speaking of the description, it, however, often helps to grasp the subject matter of trademark application since it may sometimes prove to be hardly possible to perceive all elements of the mark applied solely through images, as it is with motion marks and holograms. By contrast, the EU does not have clear and consistent rules and practice as to description of marks since the legislation permits only separate marks to be accompanied by a description when it is considered by the applicant as necessary. However, some other non-conventional marks in the trademark register are still accompanied by a description despite absence of a rule permitting

²³¹ “In re Vertex Group LLC.”.

²³² The sound mark was applied under filing No. 017894271 by Zippo Manufacturing Company.

it. Furthermore, a description is absent alongside marks, which subject matter is not clear enough and it would be of a great help if the description was present.

Having regard to the non-functionality issue, it is well-developed practice in the US to apply that requirement to all marks unlike the EU, where historically it was relevant only for shapes. However, after the Reform, the wording “another characteristic” has extended the rule to all marks. Nevertheless, there are not clear rules as to interpretation of this new rule in the context of other non-conventional marks than shapes in the EU since no information as regards its practical utilization by the EUIPO or the courts has been found so far. At the moment, the EU applicants may use the US practice on that regard as a way of interpretation of this concept. In addition, practice of application of the non-functionality requirement for shape marks examination is also of a great help since proliferation of some practical approaches on other non-conventional marks is still possible.

As for the distinctiveness requirement, it is applied similarly in the US and the EU as regards the analyzed non-conventional marks and the main difference lays in approaches towards distinctiveness of color marks, which are always non-distinctive in the US unlike the situation in the EU, and shape marks, which are divided into always non inherently distinctive product design and potentially distinctive packing of a product in the US, while the EU does not make such a division and treats all shapes as potentially distinctive. Nonetheless, when the situation comes to assessing acquired distinctiveness, the systems divergence drastically as regards all non-conventional marks, since, as it was analyzed in the previous chapter, the EU turned to requiring presence of secondary meaning in each Member State for all not inherently distinctive marks, unlike the US, where secondary meaning is to be shown in general.

CONCLUSIONS

1. The EU and the US are members of the Paris Convention, the TRIPS and the Madrid Protocol. Thus, the provisions of the acts are obligatory for them. Article 15 of the TRIPS provides that members shall permit registration of all signs capable of distinguishing the goods or services of one undertaking from those of other undertakings. Therefore, all signs that meet the requirement should be registrable in every Member State, even if they are not words and devices. Moreover, the TRIPS works in collaboration with the Paris Convention which also cover non-traditional marks and provide a basis for trademark registration abroad. Having regard to Madrid Protocol, it regulates international registration of visual mark only, including non-conventional ones. Still, the substantial changes to the Madrid System as to means of representation are underway and non-visible marks may become registrable internationally too.

2. With regard to non-conventional marks in the domestic laws of the EU and the US, they follow rules of the TRIPS and accepted the marks as a registrable subject matter. The requirements towards such marks are the same as for conventional ones in both systems. However, there is a difference in approaches regarding representation of the marks in the applications. The EU legislator is stricter and puts forward additional *Sieckmann criteria* requirements. That criteria serves as a filter, which permits granting the protection only to those marks, the representation of which may be accessed by interested parties by means of the register unlike the US, where such filter is absent. Moreover, the EU does not require provision of a trademark description and relevant specimens unlike the US. Having regard to the second obstacle on the way of non-conventional marks, non-functionality requirement, the US has developed clear and predictable rules unlike the EU, where functionality doctrine is a relatively new ground for refusal for all trademarks except shape marks and, thus, it is still to be articulated. The third obstacle, the distinctiveness requirement, is used in both systems similarly in the context of inherent distinctiveness. However, when it comes to proving acquired distinctiveness, the EU legislator requires proving secondary meaning in every single Member State and when even one small state is not covered, the mark will not be registered. That approach cannot be considered as appropriate and aligned to the letter of law since the EUTMIR requires presence of only inherent distinctiveness in every part of the EU, and not the acquired one. At the same time, the US does not require proving acquired distinctiveness in every state and it is to be shown as a whole.

3. Furthermore, the practice shows that the wide variety of possible ways of marks representation positively affects effectiveness of the EU trademark register, since all of them can be easily accessed by interested persons. At the same time, while accepting similar ways of representation, the US trademark register does not recognize such kind of representation as a video file, and, moreover, it does not give access to sound representations since only images accompanied by a description are reflected in the TESS. However, it is possible to find out more information about a certain mark in the TSDR, which still may prove to be too sophisticated for an average user. As a separate issue, the US legislator requires also to provide a description of the mark in each application, which sometimes significantly helps to grasp the subject matter of certain trademarks. By contrast, the EU does not have clear and consistent rules and practice as to description of marks since the legislation permits only separate marks to be accompanied by a description when it is considered by the applicant as necessary. Nonetheless, some other non-conventional marks are still accompanied by a description despite absence of a rule permitting it. At the same time, a description is absent alongside marks, which subject matter is not clear enough and it would be of a great help if the description was present. Analysis of non-conventional marks representation practice also reveals that the EU's stricter approach to representation of marks in the application significantly influences registrability of non-visual marks and practically precludes registration of a part of them due to absence of technologies capable of transmitting them to the public. The situation is different in the US, where legislator consider a description and images as a sufficient representation, e.g. for smells or textures.

4. Having regard to the non-functionality issue, since the EU legislator has extended functionality as a ground for refusal to all types of signs, now all non-conventional marks may be refused in registration on that basis. However, there are no relevant cases at the moment where the EUIPO or courts have applied it in practice after the Reform as to any non-conventional mark except shapes. In that situation, the US practice is of a huge help since the functionality doctrine is well-established as regards non-conventional marks and USPTO manual in conjunction with court practice provide clear guidelines for application of the doctrine. Shortly put, a trademark owner may receive the refusal in registration if the main function of a mark is not source identification, but making the relevant goods and services more appealing or contribution to performance of the relevant goods.

5. The third obstacle, the distinctiveness requirement, is envisaged in the legislations of both systems similarly. Both the EU and the US provides that all marks may either inherently distinctive or gain distinctiveness through use. Both systems also approach similarly to non-conventional marks and accept that some of them may be inherently distinctive. However, the

approaches divergence when a non-conventional mark has been found non-distinctive. The US in that situation requires showing secondary meaning in general and without checking each state. By contrast, while the EU legislation does not explicitly requires proving acquired distinctiveness in all Member States, the practice took other way and now, especially after the decision in *Nestle*, if the applicant fails to show secondary meaning in at least one Member State, the mark will not be registered. Thus, the majority of non-conventional mark owners prefer using inherent distinctiveness as a basis for application since the chances to successfully prove secondary meaning in every single Member State are rather low.

RECOMMENDATIONS

On the ground of the foregoing analysis, it can be recommended for the EU legislator:

1. To streamline the rules regarding description of marks in the application by introducing mandatory requirement of providing a description for all trademark applicants due to inconsistency in application thereof;
2. To amend article 7 of the EUTMR so as to clarify how the acquired distinctiveness rule should be applied and what standard should be used while assessing the presence of secondary meaning. For instance, it can be done by indicating that the distinctiveness acquired through use should be established in the EU as a whole, without checking each Member State;
3. To elaborate on what the wording “another characteristic”, which is present in article 7(1)(e) of the EUTMR, means in the context of non-functionality assessment and articulate guidelines for application of the requirement towards non-conventional marks so that to ensure uniform application thereof.

At the same time, the US legislator can be advised to take the following steps:

1. To revise the approach towards acceptable means of representation for motion marks, holograms, smells, tastes and textures. In particular, it is recommended to permit representation of holograms and motions also by a video file since a video may sometimes better reflect the subject matter of the application, and limit registration of smells, tastes and textures until technological means for preserving and transmitting thereof are developed;
2. To initiate all-round modernization of the trademark search system so that to allow the trademark registers to truly fulfill their main role – to make all information about trademarks readily accessible for the public and the competent authorities. For instance, it may include uniting the TSDR and the TESS so as to keep all the information related to a particular mark in one source, and, the most important, reflection of all acceptable means of representation in the register, and not only images accompanied by a description.

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ABSTRACT

The research presents comparative analysis of non-conventional marks position in the EU and the US by determining the level of non-conventional marks regulation harmonization presented by key international trademark instrument to which they are members, scrutinizing the relevant domestic trademark regulation and practical implications thereof in the context of three main obstacles on the way of non-conventional marks registration, namely, representation of the marks in the application, non-functionality and distinctiveness requirements.

In result, advantages and drawbacks of the systems' approaches as regards registrability of non-conventional marks are established. On that basis, recommendations as to further improvement of the approaches are made.

Keywords: non-conventional trademarks, the European Union, the United States of America, functionality, distinctiveness.

SUMMARY

NON-CONVENTIONAL TRADEMARKS IN THE EUROPEAN UNION AND THE UNITED STATES OF AMERICA. COMPARATIVE ANALYSIS OF THE APPROACHES TO THE REGISTRABILITY QUESTION

There are around 200 countries in the world with its own specifics in domestic legislations, which include trademark legislation as a part of it. Since the legislation is not static and always tries to correspond to the needs of society, legislative reforms are now our reality. The recent EU Trademark Reform has brought some major changes to the trademark legislation, some of which related mainly to non-conventional marks. Due to the Reform, the approach of the EU to such marks become somewhat similar to the one taken by the US. However, as it always happens, the similarity may be present only on the first sight. The approaches of the EU and the US may be not that similar in some aspects and that differences may be either the advantage of the system or the drawback thereof. Thus, the thesis aims to finding ways of improvement of non-conventional marks position in both systems and the registration process thereof there by comparative analysis of the approaches of the US and the EU to non-conventional marks from legislative and practical sides. In view of this, the thesis is divided into two chapters, which are further split into smaller parts.

The first chapter has the objective of determining regulation of non-conventional marks in legal acts at the international and domestic levels in the EU and the US. The international regulation analysis is conducted in the context of such key instruments as the Paris Convention, the TRIPS and the Madrid System acts. It is established that these acts consider non-conventional marks as their subject matter and thus create certain obligatory legal framework for Member States. The further research intends to determine the place of non-conventional marks in the domestic laws of the US and the EU. It is conducted by the way of comparative analysis of the systems approaches to registrability of non-conventional marks in the frame of three main obstacles on the way of registration process thereof, namely, representation of the mark in the application, non-functionality and distinctiveness requirements. The analysis reveals that the EU`s approach became similar to the one existing in the US after the Reform, however, with its own specifics, which are either advantages or drawbacks of the system in comparison to the US.

The second chapter is devoted to comparative analysis of practical application of the non-conventional-trademark-related legislative provisions of the EU and the US by the Trademark Offices, courts and trademark owners. The research is performed in the context of registrability of four visual and four non-visible non-conventional trademarks. The chapter determines how

the main three obstacles analyzed in the previous chapter are applied in practice, what are their specifics in both systems and thus reveals pros and cons of the systems in that regard.

In result of the research the conclusions are made and recommendations as to further development and improvement of legislative and practical approaches of the US and the EU systems to registrability of non-conventional marks as well as the relevant registration process are put forward.

HONESTY DECLARATION

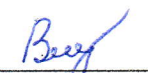
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I, Vladyslav Ruchkin, student of Mykolas Romeris University (hereinafter referred to University), Mykolas Romeris Law School, European and International Business Law, confirm that the Master thesis titled “Non-Conventional Trademarks in the European Union and the United States of America. Comparative Analysis of the Approaches to the Registrability Question”:

1. Is carried out independently and honestly;
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