Recent Developments in the Protection of Non-Traditional Trademarks

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In recent years, the domain of trademark law and the scope of trademark protection has grown exponentially. Today, a wide variety of non-traditional marks, including colour, sound, smell, and shape marks, can be registered in many jurisdictions. However, this expansion of trademark protection has led to heated discussions and controversies about the impact of the protection of non-traditional marks on freedom of competition and, more generally, on socially valuable use of these or similar signs in unrelated non-commercial contexts. These debates have also led to increasing litigation in this area across several jurisdictions.

This book provides an overview of the debate and state of the law surrounding non-traditional marks at the international, regional, and national level. In particular, this book addresses relevant international treaties administered by the World Intellectual Property Organization (WIPO) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), as well as several regional and national legislations and leading judicial decisions in order to examine current law and practice, culminating in critical reflections and suggestions on the topic.
Recent Developments in the Protection of Non-Traditional Trademarks
Terminology

Non-traditional trademarks?

Non-conventional trademarks?

New types of marks?

Types of Marks
<table>
<thead>
<tr>
<th>Pattern mark</th>
<th>Color (single) mark</th>
<th>Colour (combination) mark</th>
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</thead>
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<table>
<thead>
<tr>
<th>Word mark</th>
<th>Figurative mark</th>
<th>Figurative mark containing word elements</th>
<th>Shape mark</th>
</tr>
</thead>
<tbody>
<tr>
<td>Shape mark containing word elements</td>
<td>Colour per se</td>
<td>Sound mark</td>
<td>Multimedia mark</td>
</tr>
<tr>
<td>Position mark</td>
<td>Motion mark</td>
<td>Pattern mark</td>
<td>Hologram mark</td>
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</table>
Examples of Non-Traditional Trademarks 
(registered, applied, attempted to be registered, revoked, etc.)
NON-VISUAL PLAY-DOH SCENT MARK

Reg. No. 5,617,889
Registered May 15, 2018

Int. Cl. 28

Trademark

Principal Register

Mark:軟泥, the mark is a cartoon, slightly smudgy, cartoon figures, with slight structures of

Registration:

Mark: Play-Doh, the mark is a cartoon, slightly smudgy, cartoon figures, with slight structures of

Certificate:

Mark: PLAY-DOH SCENT MARK, the mark is a cartoon, slightly smudgy, cartoon figures, with slight structures of

Registration:

Mark: NON-VISUAL PLAY-DOH SCENT MARK, the mark is a cartoon, slightly smudgy, cartoon figures, with slight structures of

Certificate:
United States of America
Trade Mark and Trademark Office

Reg. No. 5149328
Registered Feb. 5, 2008
Int. Cl. 29
Trademark
Principal Register

FCA US (Jeep) automobiles
U.S. Reg. No. 3199299

Coca-Cola bottle
U.S. Reg. No. 0696147

Mrs. Butterworth’s container
U.S. Reg. No. 1138877

Crocs footwear
U.S. Reg. No. 5149328

Europe court rules Lego figures are ‘protectible shapes’

Top Stories

CRUSINE NOT EXCLUSIVE OWNER OF ‘CRUSINE’ TRADEMARK

Coca-Cola launches ‘share a Coke’ campaign

Mrs. Butterworth’s container

EXPRESS

DAILY DEALS
Non-traditional trademarks

Scope of this Presentation
Why non-traditional trademarks?

The context of non-traditional trademarks

Legal context

Business context

Competition context

Public policy context

Very broad definition of what type of signs can be protected as trademarks

Low threshold of the concept of trademark distinctiveness

Advantages of trademark protection, notably duration and protection for non registered marks
The context of non-traditional trademarks

Legal context

TRIPS Art. 15: Any sign … capable of distinguishing [products], shall be capable of constituting a trademark. 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. … Members may require, as a condition of registration, that signs be visually perceptible.

Singapore Treaty on Trademarks (WIPO) allows (even though it does not impose) for the registration of non-conventional marks such as holograms, scent marks, sound marks, motion marks and three-dimensional (“3D”) marks.
Almost anything is capable of registration and protection if the trademark or trade dress is **distinctive, not functional**, and the markholder has priority based on use or registration:

- Words, including descriptive words and popular phrases
- Names, including the names of historical figures
- Symbols
- Colors, including single colors
- Product packaging
- Product configurations
- Retail store designs and restaurant décor
- Look and feel of a website
- Other non-traditional marks such as sounds, scents, tastes, textures, holograms, and movements
- Artistic works currently or formerly protected by copyright
- Designs currently or formerly protected by patent

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**EU Trade Mark Directive Article 3 (2015)**

**Signs of which a trade mark may consist**

A 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 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.
EU Trade Mark Directive Article 3
Signs of which a trade mark may consist
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(a) distinguishing the goods or services of one undertaking from those of other undertakings; and
(b) being 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.

EU Trade Mark Directive Article 2
Signs of which a trade mark may consist
A 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.
CERTIFICATE OF REGISTRATION

This Certificate of Registration is hereby issued by the OHIM, the Office for Harmonization in the Internal Market (Trade Marks and Designs), pursuant to Article 9 of Section 8 of the Regulation of the Board of Management of OHIM.

Director General

Enregistrement / Registered 21/08/2008
No: 004378804

Dior

Le Président / The President

HAFM - HAARMCIEGMGANTI FOR DEN INNREDLINGSMARKET

Amtsblatt der Wirtschaftskommission

DEIREREGULSURUBEK

The President / Der Präsident

Antonio Campillo
C-421/13, Apple Inc. v Deutsches Patent- und Markenamt

Motion mark – EUTM 017852187

Cl. 30 (desserts)
EUTM No 017280264, 017280249, 017280281 – movement marks

CL. 9 (audiovisual appliances)

Signing: To sign light, take your strong hand and raise above and to the side of your head. Take your fingers from being extended and together to extended outward. The sign looks like a light is flicking on, spreading out it's rays.

EUTM No 017280264, 017280249, 017280281

How Google’s gesture control technology could revolutionise the way we use devices:

Unlike cameras, which are used in other motion sensing technologies, laser has a high positional accuracy, and thus works better in this context. Laser sensors would be able to pick up even smaller movements better.
Classes 1 (hydraulic fluids), 4 (lubricants, engine oils) and 37 (lubricating services).
EUIPO registered in 1999, as a three-dimensional EU trade mark, the following cubic shape in respect of ‘three-dimensional puzzles’
What Can Be Protected as a Mark?

  - Trademarks: [any] word, name, symbol, or device, or any combination thereof, used in commerce to **identify** and **distinguish** “products” and to indicate source

- Restatement (Third) of Unfair Competition (1995):
  - “A trademark is a word, name, symbol, device, or other designation … that is **distinctive** of a person’s goods or service and that is used in a manner that identifies those goods and distinguishes them from th[ose] of others …”
**USPTO TM 1,928,424:** computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four “stills” from the sequence.

**USPTO TM 1,975,999:** moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word “COLUMBIA” appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.
Legal context

Sign/Mark

Distinctive
- Almost anything is capable of registration and protection if the trademark or trade dress is **distinctive, not functional**, and the markholder has priority based on use or registration
  - Words, including descriptive words and popular phrases
  - Names, including the names of historical figures
  - Symbols
  - Colors, including single colors
  - Product packaging
  - Product configurations
  - Retail store designs and restaurant décor
  - Look and feel of a website
  - Other non-traditional marks such as sounds, scents, tastes, textures, holograms, and movements
  - Artistic works currently or formerly protected by copyright
  - Designs currently or formerly protected by patent
Potentially perpetually protection (as long as product in “some” use)

Low costs of registration (protection also for unregistered marks based on use)

Malleable tool instead of, or in addition to, other forms of IP protection
Distinctive Signs of Trade?

Distinctive Designs?

Distinctive Products?
Product Features
Marketing

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Business context

Competition context

Public policy context

Intellectual Property

- Trade marks
- Geographical indications
- Copyrights
- Plant Varieties
- Designs
- Patents
Competition context

Non-traditional trademarks may create undesired monopolies on functional/aesthetic product features

Are non-traditional marks in line with the public policy at the basis of the trademark system?
Rosetta Stone loses claim to yellow in court

A German court has ruled that the color yellow can be protected as a trademark. But it cannot be widely associated with a specific company. The case highlights just how important color alone can be for company branding.

Germany’s top administrative court in Ulm has rejected a claim by US software publisher Rosetta Stone to win exclusive protection of the color yellow as a trademark. Rosetta Stone is a relatively brand-famous color in the bilingual education and online language learning markets used by students of German in many nationalities.

Germany’s Federal High Court has ruled last year that Rosetta Stone’s color trademarked yellow was not enough to stand alone. The ruling was in line with earlier German federal court decisions that had held that colors alone were too subjective and too closely associated with the general use of color. The court determined that Rosetta Stone is a relatively brand-famous color in the bilingual education and online language learning markets used by students of German in many nationalities.
Cadbury’s attempt to trademark Dairy Milk purple blocked

Appeal court rules usage of colour was not specific enough and would give Cadbury unfair competitive advantage

Cadbury has lost a five-year court battle to register a distinctive shade of purple as a trademark for its chocolate bars.

Lawyers for rival Nestlé managed to overturn a previous judgment that would have prevented other manufacturers from wrapping their products in the same Dairy Milk tone.

The row revolved around a specific shade of purple - defined as Pantone 2685C - which the Birmingham-based manufacturer maintains it has used since the first
KitKat goes unprotected as European court rejects trademark case

Nestlé failed to convince European court of justice that four-fingered version of its chocolate bar should be protected by law.

Nestlé has failed in its attempt to convince European judges to let it trademark the shape of the four-fingered version of a KitKat bar in the UK.

The European court of justice ruled that the KitKat’s shape was not distinctive enough for consumers to associate it with the chocolate-covered wafer. Nestlé is not seeking to trademark its two-fingered versions of KitKat.

Nestlé had argued that even without its red and white packaging or the word KitKat embossed on the chocolate, the shape of the bar should be regarded as distinct.

The dispute between Nestlé and Cadbury, which has fought to prevent Nestle from using a similar shape for its own chocolate bar, could continue in the UK in the future.

Court of Appeal confirms London Taxi Company’s trade mark for the shape of the “black cab” is invalid

The trade mark for the three-dimensional shape of the traditional London taxi has been invalid since the Court of Appeal of England and Wales ruled in favour of the London Taxi Company. The decision means that other taxi operators cannot copy the shape of the iconic black cab.

The case was brought by the London Taxi Company against two other taxi operators who were offering vehicles that resembled the traditional London taxi. The court ruled that the distinctive features of the London taxi, such as its shape and size, are protected by the trade mark.

The decision is significant for the taxi industry, as it establishes that the shape of a vehicle can be protected by a trade mark. This means that other taxi operators cannot copy the shape of the London taxi without permission from the London Taxi Company.

The Trainline launches new service to Americas

The Trainline, the online rail booking platform, has launched a new service to the Americas. The service will allow customers to book train tickets to destinations such as New York, Los Angeles, and Chicago.

The Trainline has partnered with a range of American train operators to offer this service, including Amtrak and Amtrak's City Link.

Customers can book tickets for trains that run on Amtrak's Northeast Corridor, which connects Washington, D.C., with New York City, Boston, and other major cities in the Northeast. The service also includes tickets for Amtrak's Coast Starlight service, which runs from Los Angeles to Seattle.

The Trainline's new service to America marks a significant expansion of its international operations. The company already offers train booking services in Europe, Asia, and Australia.
Are Non-Traditional Marks, marks in the “traditional” sense of the term “mark” as distinctive sign in the course of trade?
Are NTTMs Necessary to Identify the Products?
Existing Limitations
Absolute Grounds in the EU (art 4 TMD)

no registration for signs that comprise of
a shape, or another characteristics
– Resulting from the nature of the goods
– That is necessary to obtain a technical result
  • Utilitarian functionality
– That gives substantial value to the goods
  • “A sort of” aesthetic functionality

What Cannot Be a “Mark” in the US

- Lanham Act § 2(e)(5)
  - No trademark … shall be refused registration … unless it –
  - (e) Consists of a mark which, … (5) **comprises any matter that, as a whole, is functional**
- BUT the Lanham Act does not define what is a “functional mark”
- The interpretation of what is “functional” in the context of trademark rests primarily within the courts
- The doctrine of functionality started primarily as a judicial doctrine
  • Utilitarian Functionality
  • Aesthetic Functionality
Are Non-Traditional Trademarks Aesthetically Functional?

Are they essential to the use of the product?
Do they give substantial value to the products?
Like the packaging for the Seretide Accuhaler, the AirFluSal Forspiro packaging is also purple and white. Glaxo was, it seems, displeased. Its trademark infringement action failed when GSK's EUTM for the colour purple was revoked on summary judgment. No passing off either.
EUTM: live
US: Was registered but cancelled/invalidated and removed

US: Live
EUTM: Made 4-5 attempts, but application withdrawn
“The mark consists of a configuration of a medical device, namely, an inhaler with an overall rounded shape featuring an indented mouthpiece on the top with an overall semi-circular shape. The inhaler also features an exterior movable closure with three curved lines and an overall triangular shape, which rests towards the bottom and side of the inhaler when the inhaler is opened. The mark includes six curved lines on the side of the device. The counter box and vent at the center front of the inhaler and indented mouthpiece at the top are not claimed as a feature of the mark.”

- Owned by GlaxoSmithKline, US Registration No. 75977595, EU Registration No. 017652074
Are NTTMs Necessary to Identify the Products?
Are these signs valuable?
What role should IP Offices have in balancing the protection of non traditional trademarks with competition and public interest concerns?

What role should the courts have in balancing the protection of non traditional trademarks with competition and public interest concerns?

Red Bull GmbH v. EUIPO

- Two trademarks on the same color combination and specimen
- Mark 1 Description: Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%.
- Mark 2 Description: The two colours will be applied in equal proportion and juxtaposed to each other. Blue (Pantone 2747C), silver (Pantone 877C).

EUTM002534774
EUTM009417668
Red Bull GmbH v. EUIPO

- Both marks were held invalid—although it acquired distinctiveness in the EU, it failed to meet the requirements of a trademark for being too broad.
- Red Bull failed to meet their burden of providing third parties that are inspecting the mark that their sign was perceived “unambiguously, uniformly, and durably.”
- In layman’s term, the description allowed numerous combinations and was too imprecise.
- Court used the standard that “constitute a systematic arrangement associating the colours in a predetermined and uniform way, producing a very different overall impression and preventing consumers from repeating with certainty a purchase experience.”
Simba Toys GmbH & Co. KG v EUIPO ( Judgment in Case C-30/15 P

• Simba Toys appealed to the Court of Justice
• In November 2016, the CJEU found that the essential characteristics of the cubic shape must be assessed in the light of the technical function of the actual goods represented.
• The General Court should have considered the non-visible elements of the graphic representation of the shape, such as the rotating capability of the three-dimensional ‘Rubik’s Cube’-type puzzle.
• The CJEU annulled the EUIPO decision that confirmed registration of the shape in question as an EU trade mark.
• It will be a matter for EUIPO to adopt a new decision taking into account the findings set out by the Court in the present judgment.

KitKat goes unprotected as European court rejects trademark case

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Nestlé had argued that even without its red and white packaging or the word KitKat emblazoned on the chocolate, the shape of the bar should be regarded as distinct.

The dispute between Nestlé and Cadbury, which has fought to prevent Nestlé
Societe Des Produits Nestle SA and Another v. International Foodstuffs Co. and Others (100/2014), (2014 ZASCA 187); (2015 1 All SA 492 (SCA) (27 November 2014))

Societe Des Produits Nestle SA and another v. Petra Foods Ltd. and another (2014 SGHC 252)

Christian Louboutin v. Van Dalen Footwear BV (Brussels Court of Appeal, 18 November 2014, 2014/AR/843)

BREAKING: CJEU rules that Louboutin red sole mark does NOT fall within absolute ground for refusal

In the present case, the Court of First Instance of the European Union (CJEU) has issued a much-awaited judgment in Christian Louboutin C-671/14, ruling that a mark consisting of a colour applied to the sole of a shoe is NOT covered by the prohibition of the registration of shapes. Such a mark does not consist "exclusively of the shape".

The question that the Richter Court heard referred to the CJEU was the following:

Is the Louboutin red sole mark a valid trade mark or not? At last - the moment allIP aficionados were waiting for was here.

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As readers will remember, this case has featured a first Opinion of Advocate General sirkós (IPKat here), the reappearance of the one procedure and the assignment of the case to the Grand Chamber, so that the CJEU would rule with a greater (sic) number of judges than the ordinary chamber procedure (1 or 3 judges), in consideration of the topicality of the issues underlying this reference for a preliminary ruling, and a second Opinion of Advocate General sirkós which has sparked some controversy regarding its actual interpretation.
On 7 February 2017 the Swiss Federal Court confirmed that the positional trademark IR 1’031’242 registered by Christian Louboutin is not sufficiently distinctive (Decision of 7 February 2017, 4A_363/2017). The trademark protection in Switzerland was denied.
Thank You

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