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### Did You Hear that Trademark? Considering Broad Trademark Protection Under the Lanham Act

by Ron Oines, Partner, Rutan & Tucker

Every day, we are bombarded by hundreds, maybe thousands, of trademarks. The vast majority of these marks consist of words (or abbreviations of words) that conjure up an image of a particular business and/or its products or services. When we see "UPS" on the truck next to us on the freeway, we know immediately that we are looking at a United Parcel Service delivery truck. But what if that truck had no "UPS" or other identifying word or logo on it? Most of us would still know that the truck is a United Parcel Service delivery truck because it is painted that particular shade of brown to which we are accustomed.

As a business person trying to distinguish your company, products and services from all other companies and their products and services, you should keep in mind that the Federal trademark law, the Lanham Act, protects much more than mere words. A successful branding campaign can include not only words and logos, but also packaging and product shapes, colors, sounds and perhaps more, all of which may be protectable under the Lanham Act.

The essential purpose of a trademark is to identify and distinguish the source of goods or services. In the example above, "UPS" identifies the source of the delivery services, as does the particular shade of brown consistently used by UPS. United Parcel Service owns federal trademark registrations for both.

The law provides protection for a trademark only if it is "distinctive." Distinctiveness is simply another way to say a mark is capable of identifying and distinguishing goods or services. Some marks are inherently distinctive, which means the mark is capable immediately of distinguishing goods or services. Examples of inherently distinctive marks include "Kodak" and "Exxon." These marks are inherently distinctive because they do not describe the goods to which they are applied. Other marks become distinctive (or acquire "secondary meaning") only after a certain amount of use in the marketplace. For example, the mark "Windows" for an operating system that includes "windowing" on a computer screen is likely somewhat descriptive, but there can be no doubt "Windows" has acquired distinctiveness, and is a strong and protectable mark. As explained below, certain categories of marks can be inherently distinctive, but other categories are protectable only after acquiring distinctiveness.

#### Words

These are the most common trademarks. "Nike" is an inherently distinctive word mark. But if you name your shoe company "The Shoe Palace," you will not have trademark protection until you are able to show that you have acquired distinctiveness through use, advertising, etc. Note also that the same word can be descriptive for one business, but not another. "Apple" for a computer company is not descriptive. But "Apple" for a fruit stand is likely descriptive.

#### Logos

Like word marks, logos can be inherently distinctive or descriptive, depending on the particular logo. The Nike swish, for example, is inherently distinctive. On the other hand, a logo that includes an image of a home for a home builder is not inherently distinctive.

#### Colors

Color marks are never inherently distinctive. Thus, to obtain trademark protection for a color, one has to establish acquired distinctiveness. Companies desiring to build a strong brand around a color often incorporate the color prominently in marketing campaigns. You may recall the UPS advertising campaign "What can brown do for you?" or Owens-Corning's use of the Pink Panther character in its campaign for its pink fiberglass insulation. These companies own federal trademarks for brown and pink, respectively. Other well-known color trademarks include John Deere (green), Caterpillar (yellow) and Tiffany (blue).

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Rutan & Tucker represents a broad spectrum of clients, from major multinational

#### Sounds

Unlike colors, sound marks can be inherently distinctive if they are arbitrary and unique. But if the sound is a common sound, you may need to establish distinctiveness. Well-known examples of sound marks include MGM's roaring lion, NBC's three note jingle (the notes G - E - C) and Twentieth Century Fox's "D'oh," as expressed by Homer Simpson. Several years ago, Harley Davidson sought to obtain a trademark registration for the distinctive sound of its V-Twin engine, but after years of opposition and legal wrangling, Harley decided to drop its application.

#### Product designs and packaging

Product designs and packaging are potentially protectable as trade dress, a type of trademark. Trade dress involves the total image of the product and can include features such as size, shape, colors or color combinations, texture, and/or graphics. Under applicable law, product packaging trade dress can be inherently distinctive. However, trade dress relating to the design of the product itself cannot be inherently distinctive. Moreover, one cannot obtain trade dress protection for functional aspects of a design.

#### Other trade dress

Courts have held trade dress protection can extend beyond product design and packaging, and can protect, for example, the total image and overall appearance of a business, such as a restaurant or other service establishment. Such trade dress may be inherently distinctive under certain circumstances. Again, however, functional aspects of that which makes up the total image and overall appearance are not protectable.

#### Pushing the limits of trademark protection

If we can hear a trademark, can we smell or taste a trademark? Maybe. Although these types of trademarks are very rare, more than 20 years ago, the USPTO allowed a registration for a scent reminiscent of plumeria blossoms to a company that makes sewing thread. More recently, a registration issued for a peppermint scent for office supplies. An applicant for one of these non-traditional trademarks must establish acquired distinctiveness and non-functionality. One could not, for example, obtain trademark protection for the natural scent of a product.

#### Conclusion

Of course, not every business needs all of these different categories of marks. But it is useful to remember that the protections of the Lanham act are potentially very broad, and limited only by the imagination of your marketing department.

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