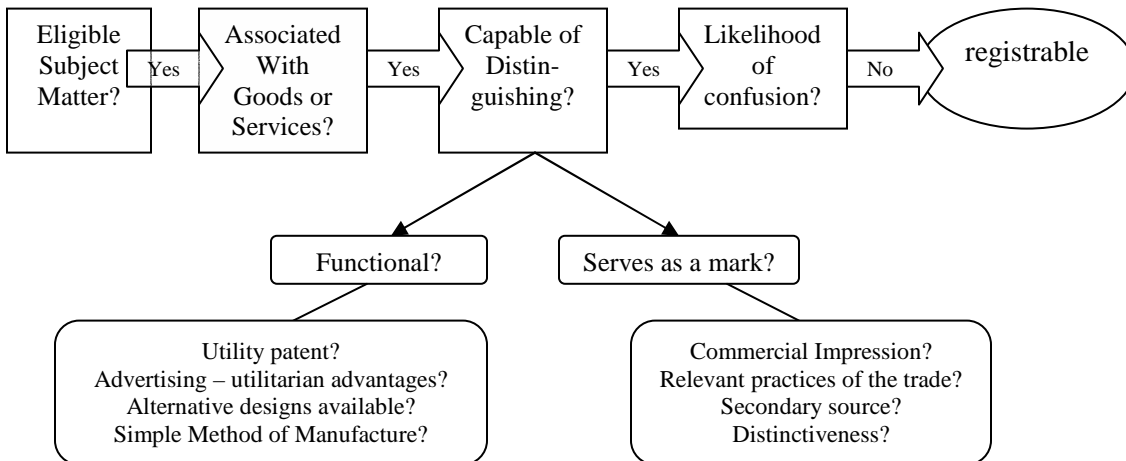


**NON-TRADITIONAL MARKS AT THE U.S. PATENT AND TRADEMARK OFFICE**

The World Trade Organization’s Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) defines eligible subject matter for trademark protection in WTO Members as “any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings....” (Article 15.1). However, TRIPS allows Members to require that signs be visually perceptible as a condition of registration. Yet there is no need to limit eligible subject matter to only those signs that are visually perceptible. The critical determination should be whether the sign is an indication of source. Signs that function as source identifiers to consumers, whether visually perceptible or not, are valuable and deserve protection against misappropriation.

The threshold issue of how to represent these “signs” graphically in an application and subsequently, how to search them when examining for conflicting applications and registrations, should not be the sole reason for not accepting these marks for registration. Sensory marks, as well as movement marks, color marks, holograms and configurations can all function as source identifiers and should not be precluded from registration merely because they may pose some specific challenges in searching and examination.

This paper and the following flowchart illustrate how the U.S. Patent and Trademark Office (USPTO) evaluates the registrability of these non-traditional signs.



**Drawing Requirements – “Graphic Representation”**

One preliminary issue that has generated a lot of questions is how to represent many of these non-traditional marks in an application drawing. In the United States, the “drawing” shows the mark sought to be registered. An applicant must submit a clear drawing with the original application in order to receive a filing date in any application for registration of a mark, except in applications for registration of sound, scent and other

non-visual marks. The drawing is used to reproduce the mark in the Trademark Official Gazette and on the registration certificate.

The main purpose of the drawing is to provide notice of the nature of the mark sought to be registered. Timely public notification of the filing of applications is important because granting a filing date to an application potentially establishes a date of constructive use of the mark. An application must be limited to only one mark. The examining attorney must determine whether the matter presented for registration is a single mark projecting a unitary commercial impression. The drawing allows the Office to properly code and index the mark for search purposes, indicates what the mark is, and provides a means for reproducing the mark in the *Official Gazette* and on the certificate of registration. Purely informational matter such as net weight, contents, or business addresses are generally not considered part of the mark.

Standard character drawings are coded in the Office's automated system as mark drawing code 4. Marks comprising only a design are coded as mark drawing code 2; marks comprising words plus a design are coded as mark drawing code 3; and marks comprising stylized letters and/or numerals with no design feature are coded as mark drawing code 5. All marks consisting of words, numerals and/or diacritical symbols for which no standard character claim has been submitted are coded as mark drawing code 5. "Drawings" of non-visual marks are coded as mark drawing code 6.

If necessary to adequately depict the commercial impression of the mark, the examining attorney may require the applicant to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include a written description of the mark, indicating that the matter shown by the dotted lines is not a part of the mark and that it serves only to show the position of the mark.

The drawing should clearly define the matter the applicant claims as its mark. The applicant is not required to submit a drawing if the applicant's mark consists *solely* of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark that clearly explains the sound or scent. In a paper application, the applicant should submit a page that indicates "NO DRAWING" in the place where the mark would otherwise appear. Then, in the description of the mark field, the applicant must set forth a detailed written description of the mark. If the mark is a composite comprising both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter.

Generally speaking, if a drawing cannot adequately depict all significant features of the mark, the applicant must also describe the mark. The examining attorney will require a description of the mark if:

- a significant element of a mark is unclear or ambiguous;

- the mark is three-dimensional, or a configuration of the goods or packaging;
- the drawing includes broken lines to show placement or to indicate a portion of the product or packaging that is not part of the mark;
- the mark includes color;
- the mark includes motion; or
- the mark is a sound, scent or non-visual mark.

### **Eligible Subject Matter?**

The United States Trademark Act of 1946 (the Lanham Act) encompasses non-traditional marks as eligible subject matter for trademark protection by not excluding them in the definition of a trademark: “any word, name, symbol, or device, or any combination thereof...used by a person...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicated the source of the goods, even if that source is unknown.” 15 United States Code §1127. In clarifying the eligibility of a single color as a mark in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995), the U.S. Supreme Court noted that “it is the source-distinguishing ability of a mark – not its ontological status as color, shape, fragrance, word or sign – that permits it to serve basic purposes” of a trademark.

### **Associated with Goods/Services?**

Eligible subject matter includes “signs” but those signs are not capable of distinguishing the goods/services of one enterprise with those of another unless the sign is used as a mark on specific goods or services. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a “trademark” as a “word, name, symbol, or device, or any combination thereof that is used or intended to be used in commerce to *identify and distinguish his or her goods* (emphasis added).” In the United States, before rights in a term as a trademark can be established, the subject matter to which the term is applied must be “goods in trade.” Incidental items that an applicant uses in conducting its business (such as letterhead, invoices and business forms), as opposed to items sold or transported in commerce for use by others, are not “goods in trade.” To be registrable as a service mark, the asserted mark must function both to *identify* the services recited in the application *and distinguish* them from the services of others, and to *indicate the source of* the recited services, even if that source is unknown. The activities recited in the identification must constitute services as contemplated by the Trademark Act.

### **Capable of Distinguishing?**

#### ***1) Does it serve as a mark?***

Matter may not be registered by the USPTO unless it is used as a mark, namely, “in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question.” *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). *See, e.g., In re Melville Corp.*, 228 USPQ 970, 970 n.2 (TTAB 1986) (“If matter proposed for registration does not function as a mark, it is not registrable in accordance with Sections 1 and 2 of the Act because the preambles of those sections limit registration to subject matter within the definition of a trademark.”)

If a proposed mark, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods, it will be refused on that basis. This analysis is particularly relevant to examination of non-traditional signs because they may not be used or perceived as source identifiers.

USPTO examining attorneys must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (*e.g.*, the specimens of use and any promotional material) of record in the application. Not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a party is necessarily a registrable trademark.

For example, subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not serve as a trademark. A decorative feature may include words, designs, colors, slogans or other trade dress. The examining attorney will consider factors to determine whether ornamental matter can be registered such as:

- (1) the commercial impression of the proposed mark;
- (2) the relevant practices of the trade;
- (3) secondary source, if applicable; and
- (4) evidence of distinctiveness.

When determining whether subject matter actually serves as a mark, the examining attorney will evaluate whether the overall commercial impression of the proposed mark is that of a trademark and whether consumers would perceive it as a mark. An examining attorney would also evaluate whether the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a common and well-known feature for a particular class of goods. Certainly, the practices of the trade may be relevant in assessing the applicant's burden of proving that the proposed mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of matter used so frequently in the relevant industry that consumers would be less apt to discern a source-indicating significance from its use. However, to show that a proposed mark that is used on the goods in a typically non-source identifying manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those identified in the application (*i.e.*, "secondary source").

### ***Distinctiveness***

For matter that does not inherently function as a mark because of its nature (*e.g.*, nondistinctive product container shapes, overall color of a product, mere ornamentation), actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness. The determination of whether or not a mark is distinctive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the

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goods or services in the marketplace. The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations.

If a proposed mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness, or "secondary meaning," that is, proof that it has become distinctive as applied to the applicant's goods or services in commerce. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services, then the mark is registrable on the Principal Register under §2(f) of the Trademark Act.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer. This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party.

## ***2) Is it functional?***

Even if a sign is used and can serve as a mark, it may not be "capable of distinguishing," as a public policy matter, if it is a functional feature of the goods, that is if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001). Examining attorneys will evaluate evidence from the industry as well as solicit information from the applicant to determine whether the claimed feature is functional, including inquiring as to whether a utility patent covers the feature.

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly

over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others - thus encouraging advances in product design and manufacture. In *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness:

The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

Thus, even where the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of these public policy reasons.

In order for a proposed mark to be held functional, the evidence need not establish that the configuration at issue is the very best design for the particular product or product packaging. Rather a finding of functionality is proven where the evidence indicates that the configuration at issue provides specific utilitarian advantages that make it one of a few superior designs available. On the other hand, where the evidence shows that the specific product or container configuration at issue provides no real utilitarian advantages to the user, but rather is one of many feasible, efficient and competitive designs, then the mark may be registrable.

As each of these non-traditional marks have different considerations, the applicability of the different tests by USPTO examining attorneys will vary. The following are examples of marks registered or applied for at the USPTO consisting of “non-traditional” subject matter. Where applicable, the USPTO Trademark Manual of Examining Procedure (TMEP) has specific examination guidelines on particular types of marks, very briefly paraphrased here. For more information, reference is made to the TMEP on the USPTO website where more information is included. Where no mark-specific information is included here, it is because the normal trademark examination procedures apply.

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**Visible Signs: *Three-dimensional marks or “configuration marks”***

If the mark is three-dimensional, the drawing should present the mark in three dimensions. The applicant must include a description of the mark indicating that the mark

is three-dimensional. The applicant must submit a drawing that depicts a single rendition of the mark. If the applicant believes that its mark cannot be adequately depicted in a single rendition, the applicant may file a petition requesting that the rule be waived.

In an application to register a mark with three-dimensional features, the applicant must submit a drawing that depicts the mark in a single rendition. If the mark comprises the design of only a portion of a product or container, broken lines should be used in the drawing to indicate that portion of the product or container that is not claimed as part of the mark. The matter that is shown in broken (dotted) lines does not have to be disclaimed, because it does not form part of the mark.

If an acceptable statement describing the mark is not in the record, the examining attorney must require the applicant to submit a description to clarify what the applicant seeks to register. The description of the mark should include a statement that the matter shown in broken lines is not part of the mark. The description is printed in the *Official Gazette* and on the registration certificate. Examples of acceptable language are, "The mark consists of the design of the blade portion of a flyswatter," and "The mark consists of the design of a perfume or cologne bottle and cap therefor, both having a 'V' shape as viewed from above." The description must adequately describe the mark, with unnecessary matter kept to a minimum. If applicable, the description must clearly indicate the portion of the product or container that the mark comprises. An example of acceptable language for this purpose is: "The mark consists of a red button positioned on the lower front area of a shirt. The dotted outline of the shirt is not part of the mark but is merely intended to show the position of the mark." As in this example, the description should make it clear what the dotted lines represent.

#### ***Configuration Marks – Serves as a Mark?***

The U.S. Supreme Court has distinguished between two types of trade dress - product design and product packaging. If the trade dress falls within the category of "product design," it can never be inherently distinctive. Moreover, the Court held that in close cases in which it is difficult to determine whether the trade dress at issue is product packaging or product design, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." If the trade dress is functional, it cannot be registered despite acquired distinctiveness.

The U.S. Supreme Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (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 appealing.

Unlike product design trade dress, trade dress constituting product packaging may be inherently distinctive for goods or services and registrable on the Principal Register without a showing of acquired distinctiveness. "[A] mark is inherently distinctive if '[its] intrinsic nature serves to identify a particular source.'" *Id.* at 210, 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081 (1992)). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977),

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although not applicable to product design trade dress, is still viable in the examination of product packaging trade dress. The examining attorney should consider the following "Seabrook" factors - whether the proposed mark is:

- (1) a "common" basic shape or design;
- (2) unique or unusual in the field in which it is used;
- (3) 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;
- (4) capable of creating a commercial impression distinct from the accompanying words.

***Configuration Marks - Functionality***

Trade dress is functional if it is essential to the use or purpose of a product or if it affects the cost or quality of the product. Factors generally considered in making functionality determinations include:

- (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.

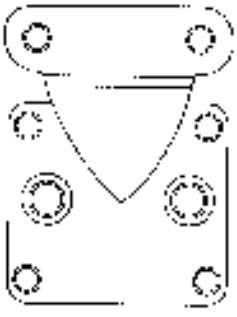
*In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (C.C.P.A. 1982).


When there is reason to believe the proposed mark may be functional, in the first Office action the examining attorney should require the applicant to provide information necessary to permit an informed determination concerning the registrability of the proposed mark. In addition to asking whether the proposed mark is or has been the subject of a utility patent or a pending or abandoned patent application, the examining attorney should require an applicant to provide advertising or promotional materials. The examining attorney should also inquire whether the feature makes the product easier or cheaper to manufacture and whether alternative designs are available. A design patent is a factor that weighs against a finding of functionality because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination.


For more information on shape and configuration marks, please see TMEP §1202.02.

The following are trademark registrations for configurations registered at the USPTO:



	<p>U.S. Trademark Registration No. 3,066,114</p> <p>Owner: Louis Vuitton Malletier</p> <p>Goods: For sunglasses, various leather goods, and various articles of clothing. [IC 009, IC 018 and IC 025]</p> <p>Description: The mark consists of a shape of a clasp made of two parts, the lower one being a square plate with one small rivet in each of the four corners and two bigger push buttons in the middle which function as a release mechanism, and the upper one being a triangular hasp with one small rivet in each top corner.</p>
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	<p>U.S. Trademark Registration No. 1,057,884</p> <p>Owner: Coca-Cola Company, The</p> <p>Goods: For soft drinks. [IC 032]</p> <p>Description: The mark consists of the three dimensional configuration of the distinctive bottle as shown.</p>
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	<p>U.S. Trademark Registration No. 3,028,381</p> <p>Owner: Hershey Chocolate &amp; Confectionery Corporation</p> <p>Goods: For candy; confectionery bits for baking. [IC 030]</p> <p>Description: The mark consists of the configuration of a conically-shaped chocolate piece approximately 12-16 mm high as measured from the base to the pinnacle and 14-18 mm in diameter as measured at the base of the chocolate piece.</p>
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**Visible Signs: Color Marks**

Applications for color marks must provide an accurate drawing of the mark. In most cases, the drawing will consist of a representation of the product or product package. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. Since color marks are visual, they should be depicted in a color drawing, accompanied by (1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement describing where the color(s) appear and how they are used on the mark. In addition, as similar to any other trademark application, an application for a color mark must be supported by a specimen that shows use of the mark on the goods as the mark is depicted in the drawing. The applicant would submit a specimen showing use of the color on the goods or a picture illustrating the use of the color on the goods.

***Color Marks – Serves as a Mark?***

Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services. However, color can function as a mark if it is used in the manner of a trademark/service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source. The United States Supreme Court has held that color alone may sometimes meet the basic legal requirements for a trademark. When it does, there is no rule that prevents color from serving as a mark. However, U.S. courts have found that color marks are never inherently distinctive.

***Color Marks - Functionality***

A color mark may be deemed to be functional, and therefore not registrable, if the color serves some utilitarian purpose or functional advantage such as the color yellow or orange for safety signs. In addition, a color mark may be deemed functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process. In such cases, the color mark is also deemed to be functional.


There is some confusion between what is known as the doctrine of "aesthetic functionality" versus utilitarian functionality versus distinctiveness, particularly in the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional (aesthetically) because it provides other real and significant competitive advantages and thus should remain in the public domain. For example, the U.S. Supreme Court has considered whether a green-gold color used on the pads for dry cleaning presses was barred from trademark protection under the functionality doctrine. While the Court ultimately concluded that the color at issue was not functional, the Court evaluated the proposed mark not only in light of the traditional "utilitarian" definition of functionality (*i.e.*, whether the proposed mark is essential to the use or purpose of the product or affects the cost or quality of the product), but also in terms of whether there was a competitive need for the color in that industry, stating that the color would be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage." *Qualitex*, 514 U.S. 165, 34 USPQ2d at 1163-65. *See also Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) (affirming the Board's determination that the color black for outboard motors was functional because while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages - *i.e.*, ease of coordination with a variety of boat colors and reduction in the apparent size of the engines).

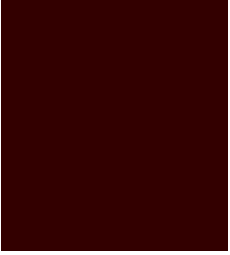
Moreover, confusion stems from widespread misuse of the term "aesthetic functionality" in cases involving ornamentation issues, with some courts having mistakenly expanded

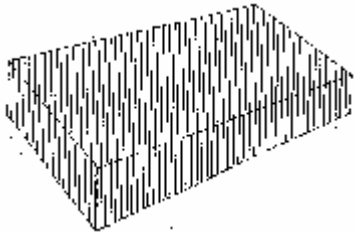
the category of "functional" marks to include matter that is solely ornamental, essentially on the theory that such matter serves an "aesthetic function" or "ornamentation function." Where the issue presented is whether the proposed mark is ornamental in nature, it is improper to refer to "aesthetic functionality," because the doctrine of "functionality" is inapplicable to such cases. The proper refusal is on the basis that the matter is ornamental and thus does not function as a mark under §§1, 2 and 45 of the Trademark Act.

For more information on color marks, please see TMEP §1202.05.

The following are examples of color marks that have been registered with the USPTO:

	<p>U.S. Trademark Registration No.: 2,990,778</p> <p>Owner: Orange Glo International, Inc.</p> <p>Goods: Shower, tub and tile cleaners [IC 003]</p> <p>Description: The color(s) purple is/are claimed as a feature of the mark. The mark consists of the color purple as applied to the bottle containing the goods. The mark consists of the color purple as applied to the entire surface of the bottle containing the goods. The matter on the drawing shown in broken lines serves to show positioning of the mark and is not part of the mark.</p>
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	<p>U.S. Trademark Registration No.: 2,901,090</p> <p>Owner: United Parcel Service of America, Inc.</p> <p>Services: Transportation and delivery of personal property by air and motor vehicle. [IC 039]</p> <p>Description: The mark consists of the color chocolate brown, which is the approximate equivalent of Pantone Matching System 462C, as applied to the entire surface of vehicles and uniforms. The mark consists of the color brown alone. The broken lines indicate the position of the mark and do not form part of the mark. The drawing is lined for the color brown.</p>
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	<p>U.S. Trademark Registration No.: 2,380,742</p> <p>Owner: Owens-Corning Fiberglas Technology Inc.</p> <p>Goods: Building insulation. [IC 017]</p> <p>Description: The mark consists of the color pink as applied to the entirety of the goods. The dotted outline of the goods is intended to show the position of the mark and is not a part of the mark. The drawing is lined to indicate the color pink.</p>
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**Visible Signs: Holograms**

For a mark that consists of or comprises a hologram, the applicant must ensure that the hologram does not show two or more views (*e.g.*, different subject matter in each view). If so, then the application may be refused on the grounds that the applicant is seeking registration of more than one mark in the application.

In addition to the required information an applicant must provide in filing a regular trademark application, the applicant must provide evidence that the hologram is indeed functioning as a trademark and is perceived as such by the public *i.e.*, as an indicator of source. In other words, a hologram used in varying forms does not function as a mark in the absence of evidence that consumers would perceive it as a trademark. In the case of *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001), the Trademark Trial and Appeal Board (TTAB) held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices and there was no evidence that the public would perceive applicant's hologram as an indicator of source. As a result, the TTAB noted "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." 59 USPQ2d at 1693.

More information regarding the examination of marks consisting of holograms can be found in TMEP §1202.14.

The following is an example of a U.S. Trademark registration for a trademark consisting of a hologram:

	<p>U.S. Trademark Registration No.: 3,045,251</p> <p>Owner: American Express Company</p> <p>Services: For charge and credit card services [IC 026]</p> <p>Description: The mark consists in part of a hologram image in the center of the mark. The stippling is a feature of the mark.</p>
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**Visible Signs: Slogans**

A slogan can function as a trademark if it is not merely descriptive or informational. Slogans or phrases used on items such as t-shirts and sweatshirts, jewelry, and ceramic plates have been refused registration as ornamentation that purchasers will perceive as conveying a message rather than indicating source of the goods. Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable.

To function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application. Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use.

More information regarding the examination of slogans can be found in TMEP §1213.05.

**Visible Signs: *Title of a Single Work***

In the United States, the title of a single creative work is not registrable because it does not function as a source identifier to distinguish the goods of one undertaking from those of others. Examples of "single creative works" include books, videotapes, films and theatrical performances. The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods. However, a term used in the title of a series of books is not registrable if it merely identifies a character in the books.

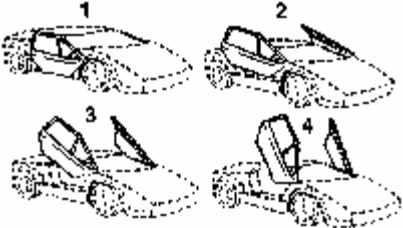
More information regarding the examination of marks consisting of titles of a single creative work can be found in TMEP §1202.08.

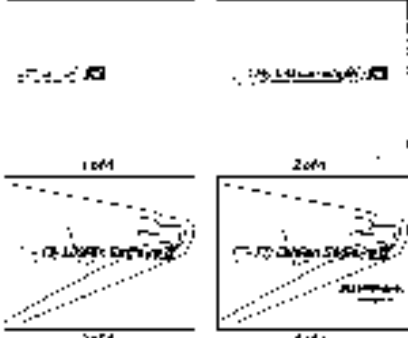
**Visible Signs: *Motion Marks***

Marks may consist of or comprise elements of motion. Applications for marks containing motion are filed in a similar fashion as a regular trademark application. The noted difference is in regards to the reproduction of the applied for mark in the drawing page that is required to accompany the application. If the mark includes motion (i.e., a repetitive motion of short duration) as a feature, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit a square drawing that contains up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also submit a detailed written description of the mark.

More information regarding the drawing requirements for marks consisting of movements can be found in TMEP §807.11.

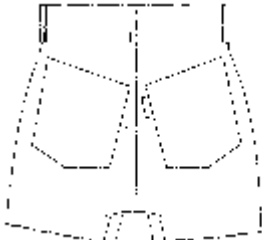
The following are examples of U.S. registered trademarks depicting motion:

	<p>U.S. Trademark Registration No.: 2,793,439</p> <p>Owner: Automobile Lamborghini Holding S.p.A.</p> <p>Goods: Automobiles [IC 012]</p> <p>Description: The mark consists of the unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised above the vehicle to a parallel position. The matter shown in dotted lines is not part of the mark.</p>
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	<p>U.S. Trademark Registration No.: 2,600,363</p> <p>Owner: United States Postal Service</p> <p>Goods &amp; Services: Sorting, handling, and receiving packages, envelopes, and letters. Pickup, transportation, and delivery of packages, envelopes and documents by various modes of transportation; electronic storage of messages and data. [IC 035, 036, 038, 039, 042]</p> <p>Description: The mark consists of an animated sequence of images in motion - an eagle design followed by a jet trail moving from left to right on a screen.</p>
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**Visible Signs: *Position Marks***

A label that is an ordinary shape cannot serve as a mark unless it creates a separate commercial impression upon the consumer and has acquired distinctiveness. A distinctive location of a label plus a definition of the shape of the label may serve as a mark, provided there is enough evidence that the particular shape and the particular location serves to indicate origin to consumers.

	<p>U.S. Trademark Registration No.: 1,157,769</p> <p>Owner: Levi Strauss &amp; Co.</p> <p>Goods &amp; Services: Trousers. [IC 025]</p> <p>Description: The mark consists of a small market or tab affixed to the exterior of the garment at the hip pocket.</p>
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**Nonvisible Signs: *Scent Marks***

The requirement for providing a drawing does not apply to scent marks. Instead, the applicant provides a written *description* of the mark, as well as a page that bears the caption “no drawing.” If the mark is comprised a scent *as well as* other, visual components, the applicant would be required to depict the visual components on a drawing.

Regarding the type of specimens that are submitted with a scent mark application, the scented product itself typically serves as the specimen. If filing an electronic application, the specimen should be filed immediately after the application, referencing the serial number of the application.

To determine whether a particular scent mark is confusingly similar to other marks, one may search the *description* field of the USPTO’s trademark database. Such searches should generate a list of any other scent marks that may be similar to the scent mark for which registration is sought. In addition, another possible way to search for applications/registrations containing scent marks would be by searching for mark drawing codes. For applied-for-marks that comprise of non-visual subject matter such as

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scent marks, the USPTO uses a drawing code of "6." In USPTO's TESS system, one could search in the advanced form with the search query: 6[md]. The search results would contain non-visually perceptible marks such as scent marks.

The scent of a product may be registrable if it is used in a non-functional manner. The Trademark Trial and Appeal Board has held that a scent functioned as a mark for "sewing thread and embroidery yarn." Scents that serve a utilitarian purpose, such as the scent of perfume, would be functional and not registrable. The amount of evidence required to establish that a scent or fragrance serves as a mark is substantial.

For more information on examination of scent marks, see TMEP §1202.13.

The following are examples of scent marks registered at the USPTO:

U.S. Trademark Registration No. 2,463,044
Owner: Mike Mantel
Goods: synthetic lubricants for high performance racing and recreational vehicles. [IC 004]
Description: The mark consists of a cherry scent.

U.S. Trademark Registration No. 2,560,618
Owner: Midwest Biologicals, Inc.
Goods: Oil based metal cutting fluid and oil based metal removal fluid for industrial metal working. [IC 004]
Description: The mark is a scent mark having the scent of bubble gum.

**Visible Signs: *Sound Marks***

The requirement for a drawing does not apply to sound marks. If the mark comprises music or words set to music, the applicant may submit the musical score for the record. In a TEAS application, the musical score should be submitted in .wav format. However, a .wav file cannot be sent as an attachment to a TEAS filing, because all TEAS attachments must be in .jpg format. Therefore, the Office has developed a special procedure for handling .wav files. The .wav file must be sent after the application is filed, as an attachment to an e-mail message directed to [PrinTEAS@uspto.gov](mailto:PrinTEAS@uspto.gov), with clear instructions that the .wav file should be associated with "the application filed under Serial No. <specify>."

To determine whether a particular sound mark is confusingly similar to other marks, one may search the *description* field of the USPTO's trademark database. Such searches

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should generate a list of any other sound marks that may be similar to the sound mark for which registration is sought. In addition, another possible way to search for applications/registrations containing sound marks would be by searching for mark drawing codes. For applied for marks that comprise of non-visual subject matter such as sound marks, the USPTO uses a drawing code of "6." In USPTO's TESS system, one could search in the advanced form with the search query: 6[md]. The search results would consist of non-visually perceptible marks such as sound marks.

A sound mark identifies and distinguishes a product or service through audio rather than visual means. Examples of sound marks include: (1) a series of tones or musical notes, with or without words, and (2) wording accompanied by music.

To show that the sound mark actually identifies and distinguishes the services and indicates their source, the specimen should contain a sufficient portion of the audio content to indicate the nature of the services. If the mark comprises music or words set to music, the applicant may also submit the musical score as a specimen.

More information regarding the examination of marks consisting of sounds can be found in TMEP §1202.15.

The following are examples of sound marks registered at the USPTO:


<p>U.S. Trademark Registration No. 2,442,140</p> <p>Owner: Yahoo!, Inc.</p> <p>Services: Computer services and online computer services, namely, creating indexes of information, of websites, and of other resources available on computer networks; Providing search engines for searching and retrieving information on computer networks; And providing a wide range of general interest information via computer networks. [IC 042]</p> <p>Description: The mark consists of the sound of a human voice yodeling "YAHOO".</p>
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<p>U.S. Trademark Registration No. 916,522</p> <p>Owner: National Broadcasting Company, Inc., The</p> <p>Services: Broadcasting of television programs. [IC 038]</p> <p>Description: The mark comprises a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C, the "G" being the one just below middle C, the "E" the one just above middle C, and the "C" being middle C, thereby to identify applicant's broadcasting service.</p>
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<p>U.S. Trademark Registration No. 2,607,415</p> <p>Owner: American Family Life Assurance Company of Columbus</p> <p>Services: Insurance underwriting services in the fields of dental, health, life, cancer, hospital intensive care, accident and disability, hospital indemnity, hospital confinement indemnity, Medicare supplement, sickness, home healthcare, long-term healthcare, and convalescent health care. [IC 036]</p> <p>Description: The mark consists of the sound of a duck quacking the word "AFLAC".</p>
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**Nonvisual signs: *Touch Marks***

	<p>U.S. Trademark Registration No.: 3,155,702</p> <p>Owner: American Wholesale Wine &amp; Spirits, Inc.</p> <p>Goods &amp; Services: Wines. [IC 033]</p> <p>Description: The mark consists of a velvet textured covering on the surface of a bottle of wine. The dotted line in the drawing is not a feature of the mark but is intended to show the location of the mark on a typical container for the goods; the dark/lower part of the container drawing shows the mark. The stippling in the drawing is not a feature of the mark, but a representation of how one type of velvet covering may appear in visual form. The mark is a sensory, touch mark.</p>
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**Nonvisual signs: *Taste Marks***

The USPTO has no taste marks currently registered, but the Trademark Trial and Appeal Board recently heard and an ex parte appeal of the examining attorney's refusal to register the flavor orange for quick dissolve pharmaceutical tablets. The TTAB affirmed the refusal to register on the grounds that the mark was functional and also "failed to function" as a mark, but did not rule out that taste could never function as a mark. The decision can be found at:

<http://ttabvue.uspto.gov/ttabvue/v?pno=76467774&pty=EXA&eno=15>

<p>U.S. Trademark <b>Application Serial No.</b> 76,467,774</p> <p>Owner: N.V. Organon</p> <p>Goods: Pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills. [IC 005]</p> <p>Description: This trademark application is for an orange flavor.</p>
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More information on USPTO law and practice can be found on the USPTO website at [www.uspto.gov](http://www.uspto.gov). The TMEP can be found at <http://tess2.uspto.gov/tmdb/tmep>.

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