

UNUSUAL TRADEMARKS

**INTERNATIONAL ASSOCIATION OF DEFENSE COUNSEL
2022 MIDYEAR MEETING
SCOTTSDALE, ARIZONA
FEBRUARY 2022**

**Neville H. Boschert
Partner
Jones Walker LLP
190 E. Capitol St., Ste. 800
Jackson, MS 39201
www.joneswalker.com
nboschert@joneswalker.com**

Introduction

A trademark is any word, name, symbol, device, or any combination thereof used by a person to identify and distinguish that person's or company's goods or services and indicate the source of the goods or services. *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Trademarks help the public find the particular products and services they are seeking and help the owners of trademarks promote and protect the reputation of their products and services. The first person or company to use a trademark in the marketplace as a source of origin acquires the right to prevent others from using the same or similar mark that is likely to cause confusion in the marketplace. *See Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 217 (5th Cir. 1985). Trademark law protects a consumer from being misled into buying an inferior product by a copycat seller when she thinks she is purchasing a quality product from a reputable seller. Trademark law protects a seller and the reputation of its business and products by preventing other sellers from pretending to be the seller and selling inferior products and stealing customers.

The goal of trademark law is to protect consumers and sellers by helping ensure that sellers are actually who consumers think they are. Trademarks protect product branding. Other types of intellectual property rights such as those granted by patents and copyrights promote ingenuity and originality by protecting the value of the created property.

Trademarks often consist of words in a logo with a distinctive shape. But trademarks can come in other formats as well. We have all heard sounds that we instantly associate with a particular brand of a product. We can tell the brand of some stores and restaurants merely by the appearance of the buildings. Colors of some products indicate the source of origin.

Trademark Infringement Actions

Trademark infringement actions can be asserted as both state and federal law claims. Trademark infringement is a type of unfair competition under the common law of many states

and some states have statutory trademark claims available. Sections 32, 34 and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114, 1116 and 1125(a), provide federal causes of action for trademark and trade dress infringement claims. Trade dress is a product's "total image and overall appearance." *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989). "The whole, in trademark law, is often greater than the sum of its parts." *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 (5th Cir. 1991), *aff'd*, 505 U.S. 763 (1992). "Total image" includes size, shape, color, color combinations, textures, graphics, and even sales techniques of a product. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966 (11th Cir. 1983).

Protection of trade dress, no less than of trademarks, serves the Act's purpose to "secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."

Two Pesos Inc., 505 U.S. at 774 (1992) (citing *Park n' Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1989)).

In an action for trademark infringement, the owner of a valid mark, whether registered or unregistered, may enforce the right to prevent others from using the same or a similar mark that is likely to cause confusion in the marketplace. *See Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 236 n.8 (5th Cir. 2010). The same standards apply to claims of infringement of registered and unregistered marks. *Id.*

To prevail on a trademark infringement claim, a plaintiff must show, by a preponderance of the evidence, (1) ownership in a legally protectable mark, and (2) infringement resulting from a likelihood of confusion. *Bd. of Supvrs. for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 475 (5th Cir. 2008). The same standards apply to claims for infringement

under state law and for unfair competition. *E.g., Viacom Int'l Inc. v. IJR Capital Invs., LLC*, 242 F. Supp. 3d 563, 568 (S.D. Tex. 2017).

To be legally protectable, a mark must be either (a) inherently distinctive or (b) have acquired distinctiveness through secondary meaning. In assessing the distinctiveness of a word mark, the Fifth Circuit relies on the categories set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976): (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful. *See Nola Spice Designs, L.L.C. v. Haydel Enters., Inc.*, 783 F.3d 527, 537 (5th Cir. 2015) (noting that the Fifth Circuit relies on the spectrum set forth in *Abercrombie* to determine the distinctiveness of a word mark).

“Likelihood of confusion means more than a mere possibility; the plaintiff must demonstrate a probability of confusion.” *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 226 (5th Cir.2009) (citing *Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co.*, 550 F.3d 465, 478 (5th Cir. 2008)). Courts employ a non-exhaustive list of eight “digits of confusion” to evaluate whether there is a likelihood of confusion: (1) strength of the plaintiff’s mark, (2) similarity the defendant’s use to the plaintiff’s mark, (3) similarity of the products, (4) identity of the retail outlets and purchasers, (5) identity of the advertising media used, (6) intent to infringe, (7) evidence of actual confusion, and (8) degree care exercised by potential consumers. *Id.* No one digit is dispositive and the analysis of the digits, including whether to consider other evidence, varies based on the context of the case. *Id.* Under this analysis, courts must be mindful of the relevant marketplace and market conditions a potential consumer is likely to encounter. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 197 (5th Cir. 1998).

Sound Marks

A sound can be a trademark if the sound qualifies as an identifier of source. With the evolution of electronic media, sound marks will likely become more common. Examples of trademark sounds are the Intel tone, NBC chimes, Jolly Green Giant laugh, the AFLAC duck and the MGM lion roar. Examples of sound marks are posted on the United States Patent and Trademark Office site at <https://www.uspto.gov/kids/sound.html>.

For a sound to be a trademark, it must be inherently distinctive or have become distinctive by secondary meaning. Advertising jingles are among the more common sound marks. *See Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61 (2d Cir. 2001) (listing various sounds given trademark status). But a song or performance generally cannot be a trademark in and of itself because it is not an identifier of source. “Copyright law, not trademark law, is the primary vehicle for protecting the rights of a song’s composer.” *EMI Catalogue Partnership v. Hill, Holiday, Connors, Cosmopulos Inc.*, 228 F.3d 56 (2d Cir. 2000).

Colors as Trademarks

Colors can be components of trademarks. For example, a court entered an injunction to preclude an agricultural manufacturer from using green and yellow colors on agricultural equipment confusingly similar to the colors used by *John Deere. Deere & Company v. FIMCO Inc.*, 302 F. Supp. 3d 837 (W.D. Ky. 2017), *modified*, 301 F. Supp. 3d 704 (W.D. Ky. 2018). An injunction was issued precluding use of red knobs on cooking appliances when Wolf had a registered trademark for the red knobs. *Wolf Appliance, Inc. v. Viking Range Corp.*, 686 F. Supp. 2d 878 (W.D. Wis. 2010).

In *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995), the United States Supreme Court clarified that a single color can constitute and be registered as a trademark. In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), the United States Supreme Court

clarified that while a single color can be a trademark, it cannot be considered inherently distinctive and can be a trademark only when there is proof of secondary meaning. In *Christian Loubouton S. A. v. Yves Saint Laurent American Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012) the court found that a red sole on a woman's shoe had acquired secondary meaning sufficient to be a trademark, but found that there was no infringement.

Scents as Trademarks

Scents can be registered as trademarks in limited circumstances where the scent is an indicator of source. The scent of products sold for their scents generally cannot be a trademark because the scent is functional. In those situations, the scent must be protected as a different type of intellectual property. The TTAB refused to grant a trademark for the peppermint smell (and taste) of a heart medication because the product had not been marketed because of its smell and it had not acquired distinctiveness to give it secondary meaning. *In re Pohl-Boskamp GmbH & Co.*, 106 U.S.P.Q.2d 1042 (T.T.A.B. 2013).

When a scent can be shown to have acquired secondary meaning to indicate the product source, a trademark for the scent can be issued. For example, Hasbro obtained a trademark for the scent of PLAY-DOH in 2018 where it supported its claims of distinctiveness by evidence of more than sixty years of sales of the product. *See* U.S. Reg. No. 5467089.

Buildings as Trademarks

A building design can be a trademark if the design is used to denote the source of the product. For example McDonald's has a registered trademark for its buildings with the golden arches. McDonald's was able to enjoin a copycat burger chain for unfair competition where the competitor copied its design even though it was unable to prove that customers had actually been confused to think the competitor's restaurant was a McDonald's. *See McDonald's Corp. v. Moore*, 243 F. Supp. 255 (S.D. Ala. 1965), *aff'd per curiam*, 363 F.2d 435 (5th Cir. 1966).

In *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), the United States Supreme Court found that a Mexican style restaurant was entitled to protect its trade dress in the appearance of its restaurants where the combination of the building and décor was inherently distinctive.

Conclusion

Trademarks are not limited to logos and words. They can exist in many forms so long as they are appropriately distinctive and indicate source.