

Recognition, Protection and Registration of Non-Traditional Marks

15 November 2021

SPONSORING COMMITTEE: Non-Traditional Marks Committee

RESOLUTION:

WHEREAS, the recognition of and the protection afforded to trading indicia as trademarks other than word and/or design trademarks (collectively, “Non-Traditional Marks”) often vary from country to country;

WHEREAS, such variation makes the scope of protection available to rightsholders uncertain as a wider variety of such “non-traditional” trading indicia are being more frequently used to distinguish the goods and services of one business from another;

WHEREAS, the Board of the International Trademark Association adopted resolutions titled “Protectability of Color Trademarks,” dated November 20, 1996, “Protectability of Sound Trademarks,” dated February 25, 1997, “Protectability of Three-Dimensional Marks,” dated May 7, 1997, and “Protectability of Touch Marks,” dated November 8, 2006 (collectively, the “Resolutions”), and a document entitled Model “Trademark” Law Guidelines, as amended up to and including 2019 (the “Model Law Guidelines”) in the interest of urging the recognition, protection and registration in respect of certain species of trading indicia as Non-Traditional Marks;

WHEREAS, many countries continue to maintain or are enacting independent legislation and standards with respect to Non-Traditional Marks that, in many cases, render certain types of Non-Traditional Marks either explicitly or practically unprotectable or unenforceable in some jurisdictions, which in turn, is increasing worldwide inconsistency and uncertainty in the recognition of Non-Traditional Marks;

WHEREAS, there has been a proliferation of electronic commerce marketplace models and online third-party retailers in recent years, and their providers often set their own intellectual property standards whereby their users and vendors must meet certain criteria, including applying for and maintaining protection for their trading indicia, including, in many cases, Non-Traditional Marks, which can create certain insurmountable obstacles to rights holders who are unable to obtain protection for their Non-Traditional Marks on account of inconsistent and uncertain worldwide standards;

WHEREAS, various governmental authorities have asked Non-Traditional Marks Committee personnel for a clear statement of position on and for training related to the protection and

enforcement of Non-Traditional Marks to assist them in both adopting and implementing legislative, regulatory and practice changes related to Non-Traditional Marks;

WHEREAS, the position of INTA as a stakeholder can be used as a tool for the purposes of advocating legislative, regulatory, and practice changes before various governmental authorities and electronic commerce businesses in an effort to help combat international worldwide inconsistency in the recognition of Non-Traditional Marks;

WHEREAS, despite INTA having stated its position on the registrability and enforceability of Non-Traditional Marks through the adoption of the Resolutions and the Model Law Guidelines, there is no single, clear, and consolidated statement setting out the position of INTA in respect of the registrability and enforceability of Non-Traditional Marks as reflected across the Resolutions and the Model Law Guidelines;

BE IT RESOLVED, that it is the position of INTA that non-traditional marks may consist of any trading indicia, or “sign,” that is capable of distinguishing the goods and/or services of one trader from the goods and/or services of its competitors, and, under appropriate circumstances, should be entitled to trademark recognition, protection, and registration, including but not limited to:

- Alphanumeric configurations, including those not pronounceable;
- Figurative designs or devices, such as logos or still images;
- Sounds;
- Scents;
- Tastes;
- Color or combination of colors;
- Moving images;
- Holograms;
- Modes of packaging or packaging configurations;
- Shapes or product configurations;
- Positioning of a sign;
- Textures; and,
- Combinations of any of the foregoing.

BE IT FURTHER RESOLVED, that non-traditional marks, under appropriate circumstances, can meet standards for the recognition, protection and registration of traditional trademarks, namely:

- Affixation or connection requirements, which should be permissively defined so as to be satisfied as long as a sign is used in a manner that will directly connect or associate it with a product or service;
- Graphical representation and search requirements, which can be met through the adoption of digital technologies by trademark registries;
- Functionality exclusions and limitations, which should apply equally to traditional marks and non-traditional marks;
- Enforceability standards, whereby assessing confusion between two non-traditional marks, regardless of the type of sign in question, can be dealt with using the reasoning and logic presently applied to traditional marks; and,
- Examination standards, whereby assessing inherent or acquired distinctiveness of a non-traditional mark, regardless of the type of sign in question, can be dealt with using the reasoning and logic presently applied to traditional marks

BACKGROUND:

There is no international consensus on what specific species of signs are protectable as trademarks. Most conventions and national statutory provisions contemplate a wide variety of different types of signs that are capable of functioning as trademarks, and in recent years, the nature, protectability, and enforceability of many different types of Non-Traditional Marks have become the focus of much debate in a number of countries. However, in only a very few countries have any standards or requirements for obtaining registration of such non-traditional trademarks been developed and clearly articulated.

Typically, these standards evolve based on the cases prosecuted, and in many countries, the number of applications prosecuted, registered, and ultimately enforced have been very limited, thus many guidelines are not consistent. In several countries, recent amendments to intellectual property legislation expressly contemplate a wide variety of protectable Non-Traditional Marks, although the enumerated types of marks can vary widely from country to country. Furthermore, many countries have established bars that are elevated to the point of being impractical, as they require highly detailed and, in some cases, unclear description requirements and significant evidence of acquired distinctiveness that can be prohibitively difficult and expensive to provide.

The complications of this international inconsistency have been compounded in recent years as a result of the proliferation of online marketplace models and electronic commerce retailers, many of which set independent standards and requirements for their users and vendors to apply for and maintain certain intellectual property protection in order to participate in their respective forums. These requirements can, in some cases, have the unintended effect of rendering certain users' and vendors' products incompatible with certain online marketplaces and online retailers, as certain intellectual property cannot be protected as Non-Traditional Marks in some jurisdictions and cannot meet the standards set by the providers of these various forums. Further, online marketplaces are often inconsistent in their recognition of rights in Non-Traditional Marks and capricious in their willingness to assist Non-Traditional Marks owners in enforcing those rights through standard takedown methods and procedures.

A clear and succinct statement of the position of INTA regarding the protectability and registrability of Non-Traditional Marks is needed and can be used for the purposes of advocating for and presenting what INTA believes to be "best practices" in its efforts to promote international consistency in law, practice, and policy. While the position of INTA having been set out across various resolutions of the Board of Directors and the Model "Trademark" Law Guidelines, there is not currently a single document expressing the position as it relates to the various types of Non-Traditional Marks currently recognized by INTA. There is therefore a need to have a clear, concise, and consolidated expression of the position of INTA in respect of Non-Traditional Marks for use by INTA and others in advocacy, training and legislative activities, and the Non Traditional Marks Committee recommends and requests that the Board of Directors adopt a resolution consolidating and restating the position of INTA regarding the protectability and registrability of Non-Traditional Marks. In developing this Resolution, the Non-Traditional Marks Committee established a Task Force (the "**Task Force**") to review the state of the legislation across various jurisdictions to ensure that the categories of Non-Traditional Marks set out herein as well as the substantive and procedural guidelines for applications for and examination of such marks reflect those that are being recognized in jurisdictions with well-developed legislation concerning Non-Traditional Marks. The Task Force completed its review of 18 jurisdictions around the world in

March, 2021 and, drawing guidance from the results of that review, the Task Force developed the categories as set out in this resolution.

The proposed resolution not only clearly and concisely consolidates INTA's position on the protectability of a wide-range of Non-Traditional Marks, but forms the basis and lays the ground work for further development and expansion of the examination guidelines for Non-Traditional Marks, which can be used to assist and advise government agencies and authorities in developing their own practices for treating Non-Traditional Marks. The proposed board resolution will provide a framework for the forthcoming review and amendment of the examination guidelines, a project the Trademark Office Practices Committee plans to undertake in the coming term.

Relatedly, from time to time, issues surrounding Non-Traditional Marks are raised whereby certain fundamental principles of trademark law and practice are argued to be incompatible with certain types of Non-Traditional Marks, such as the manner in which the mark needs to be used in association with goods or services, and in particular the principles of "connection" and "affixation," articulation of the mark for registration, distinctiveness including functionality and consistency in use, and assessment of confusion. In the interests of further supporting the position of INTA as expressed herein, the Non-Traditional Marks Committee has considered the problems and issues and believes that the foregoing problems are neither insurmountable nor unique and can be addressed by using carefully articulated guidelines.

There are certain principles that must be recognized when dealing with all kinds of trademarks, i.e., including non-traditional marks:

- **Connection**: Affixation or connection requirements should be permissively defined so as to be satisfied as long as a sign is used in a manner that will directly connect or associate it with a product or service. As national trademark laws differ in their affixation or connection requirements, the Committee does not propose a defined affixation standard for international implementation. Instead, a general "product connection" requirement is proposed, so that a mark, which fulfils the source identifying function of a trademark and is directly connected with the product or service, will not be barred from registrability because of physical affixation requirements so strict that certain signs would automatically be precluded from protection. Having established the general standard, related implementation issues governing how it is put into practice should be left to the domain of individual jurisdictions.
- **Graphic Representation and Search Problems**: As indicated by the practice in some countries, search problems can be addressed by the use of digital representations of non-traditional marks, such as audio and video recordings and/or detailed descriptions. Such representations will become more common as soon as online technologies such as streaming and embedded recordings become more widely available. However, since different jurisdictions will wish to adapt articulation requirements to their own systems, implementation issues relating to articulation also should be left to the domain of individual jurisdictions.
- **Functionality**: The functionality doctrine, in order to preclude adverse effects on competition, bars protection for something that is essential to the use and purpose of the article or which inherently effects its character or quality. Functionality presents a challenge for Non-Traditional Marks, but it is important to note that all signs, whether they are traditional marks or Non-Traditional Marks, should be subject to the same functionality exclusions or limitations.

- **Enforceability:** Assessing confusion between two marks, regardless of the type of sign in question, can be dealt with using the reasoning and logic presently applied to other types of marks. Judging the aural or visual impact of, and similarity between, marks already forms part of the assessment of trademark confusion and registrability in most jurisdictions and, in the case of non-verbal marks, is not confounded by language barriers. By applying fundamental principles, any vagueness or undue breadth in the description which renders the scope unclear, would render the mark unregistrable or the registration invalid or unenforceable. The onus should be on the applicant to ensure that the mark is represented sufficiently to enable the mark to be clearly articulated. Competitors would have means to oppose or invalidate a registration for sound on the same grounds as other trademarks, e.g. functionality.

Accordingly, the Non-Traditional Marks Committee requests that the Board of Directors' resolution as set out herein states that Non-Traditional Marks consisting of any signs that are connected with products or services should be recognized, protectable and registrable, and subject to the same standards as traditional trademarks.