

Recognition of the Distinctiveness of Non-traditional Trademarks

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Abstract: Non-traditional trademarks have been developing rapidly since the 1990s, and have been accepted by many countries all over the world. But in the legislation and judicial practice, the recognition of the acquired distinctiveness of non-traditional trademarks is still rather confused. Through literature review and qualitative analysis, this paper analyzes the basic theory of the recognition of the distinctiveness of non-traditional trademarks from the definition of non-traditional trademarks, the standards for the recognition of the distinctiveness of trademarks, and the particularity of the recognition of the distinctiveness of non-traditional trademarks. This paper also summarizes the relevant provisions of the determination of non-traditional trademark distinctiveness, and puts forward suggestions for the improvement of the rules for the determination of non-traditional trademark distinctiveness, including increasing the forms of evidence recognized by the relevant public, attaching importance to the objective environmental evidence for the use of trademarks by relevant operators and Clarification of Limitations on Acquired Distinctiveness for Non-traditional Marks.

Keywords: acquired distinctiveness, non-traditional trademark, recognition of distinctiveness, second meaning

1. Introduction

With the development of commerce and technology, the traditional trademark cannot meet the needs of commercial subjects, so the concept of non-traditional trademark has emerged and attracted wide attention.

Non-traditional trademarks are the protection and extension of traditional trademarks. Compared with traditional visible trademarks, non-traditional trademarks are not flat and sensory, so consumers generally will not use them as a mark indicating the source of goods or services.

Currently, the identification of the distinctiveness of non-traditional trademarks has become the focus of legislation and judicial practice in many countries. Therefore, the aim of this paper is to discuss the criteria and challenges of recognition of distinctiveness in non-traditional trademarks. Through studying the criteria of acquired distinctiveness and the particularity of non-traditional trademarks, this research aims to reveal the complexity of evaluating the distinctiveness of non-traditional trademarks. In addition, this paper tries to synthesize the relevant rules for the recognition of non-traditional trademark distinctiveness in various countries, and gives some suggestions to perfect the recognition rules.

2. Basic Theories on the Recognition of the Distinctiveness of Non-traditional Trademarks

2.1. Non-traditional Marks

Nontraditional trademarks are those types of trademarks that are not traditional words, devices or combinations of words and devices. The World Intellectual Property Organization (WIPO) divides non-traditional trademarks into visible signs and non-visible signs according to whether they can be perceived by the human visual sense. Visible signs include signs that are three-dimensional, colored and dynamic, etc., and non-visible signs include signs that involve sound, smell, taste, touch, etc. With the continuous development of business and technology, the traditional trademark forms cannot meet the needs of business subjects for trademark protection, so the concept of non-traditional trademark gradually appears and attracts wide attention. However, because it is different from traditional trademark forms and difficult to specifically describe and identify, there are certain international challenges and controversies concerning the protection of non-traditional trademarks [1].

2.2. Standards For Recognition of Acquired Distinctiveness

Acquired distinctiveness means that the trademark itself is not distinctive, but after a long period of use, it acquires distinctiveness and can be registered as a trademark. This “acquired distinctiveness” is also known as a “second meaning” [2].

2.2.1. Relevant public perceptions

The formation of trademark distinctiveness shows that the relevant public associates the trademark with the goods or services it offers, so the cognition of the relevant public is the essence of determining trademark distinctiveness.

According to the *Paris Convention* and the legislation of the World Intellectual Property Organization, the relevant public includes two kinds of subjects: the ordinary consumers of the relevant goods or services and the relevant practitioners in the field of business. Thus, the cognition of the relevant public should be examined comprehensively to determine the cognition level of ordinary consumers and other business operators [3].

According to the nature of the product or service itself, the relevant public can be divided into different groups by the criteria of age, gender, education level, economic status, and so on. For example, as a product of razors, the relevant public is divided into male consumers, because generally only men need beard trimming. And the evaluation of the degree of public recognition should consider brand awareness, recognition, use and publicity in a comprehensive assessment.

2.2.2. Actual Use of Trademark by Applicant

To obtain distinctiveness, a trademark needs to be used, and such use must be in accordance with the meaning of trademark law. The use in the meaning of trademark law needs to meet certain use intention, use behavior and use time.

First, the intent to use the trademark needs to be considered. In the process of trademark use, the trademark owner needs to proactively inform consumers that the logo is a trademark. Otherwise it may be determined that there is no intention to use the logo as a trademark. In practice, it is common to place the trademark prominently in advertising and packaging so as to distinguish it from other elements. For example, bold and capital letters can be used to highlight the logo.

Secondly, more attention should be paid to the use of trademarks. Simply speaking, the use of trademarks is one of the various behaviors of business operators using trademarks in the market.

Sales records, advertising expenditures, and honorary certificates provided by the applicant can be used as evidence for trademark use. At the same time, the way a trademark is used should be considered. In practice, attention should be paid to distinguishing between “real use” and “symbolic use”. Symbolic use refers to the use of a trademark as a symbol or sign to distinguish the source of goods or services, which is not directly related to the actual use of the specific goods or services themselves. In this case, the existing person may pre-emptively register the trademark, and then sell it to others and make a business of it. This kind of advertising to prevent the trademark from being cancelled is symbolic use, and obviously not effective in helping to establish a specific association between the trademark and the goods in the minds of the public, thereby helping consumers to save the cost of finding the goods. At the same time, it cannot become a goodwill to attract consumers to purchase. Actual use refers to the trademark as a symbol actually applied to goods or services, requiring the trademark holder to associate its trademark with the goods or services actually sold or provided. Actual use can provide useful information to the public, so it is more reasonable to adopt the standard of “real use” when judging whether the behavior is use in the sense of trademark [4].

Finally, the age of a trademark needs to be considered. Since trademarks lacking inherent distinctiveness acquire the ability to indicate the source of the goods through use, a relatively long period of use is required to acquire distinctiveness. As the trademark law of the United States clearly stipulates, that five years of continuous and exclusive use can be one of the bases for a trademark to acquire a second meaning.

2.3. Particularity of Rules on Recognition of Distinctiveness of Non-traditional Trademarks

In general, the rules of protection for non-traditional trademarks are the same as those for traditional trademarks. Only those with distinctiveness can be protected by trademark law. But different from traditional trademarks, the acquired distinctiveness of non-traditional trademarks is more difficult to identify and needs stricter requirements to prevent monopolies caused by the abuse of trademark rights. The specific performance is that the “use” has particularity and an indirect relationship with the goods or services it represents.

2.3.1. Particularity in “Use” of Non-traditional Trademarks

When determining whether a traditional trademark has acquired distinctiveness, the first thing to be considered is whether the trademark meets the threshold of “actual use”. The same applies to non-traditional trademarks. The first step in determining whether a trademark has acquired distinctiveness is the act of “use”. However, the “use” of non-traditional trademarks has its own peculiarities as compared to traditional trademarks [5].

First of all, unlike traditional trademarks, most non-traditional trademarks cannot be separated from the goods or services as traditional trademarks can; therefore, theoretically speaking, according to the principle of trademark functionality, protection of certain non-traditional trademarks may result in a de facto monopoly of a certain appearance, color, sound, smell, etc [6]. Therefore, in order to prevent a right holder from granting permanent monopolistic protection through the trademark system to a utility function that should be protected by the patent system, the degree of use of non-traditional trademarks should be determined more rigorously than that of traditional trademarks [7]. However, the exact standard of determination is uncertain. Due to the unique characteristics of non-traditional trademarks, when they are used in the market, the method of use, the time of use, and the scope of use should be distinguished from traditional trademarks. For example, advertising enables the relevant public to establish a connection between the trademark and the product or service, which is an important method for the use of a trademark. However, currently, advertising still mainly relies on visual means, and the relevant public is rarely

informed about the product or service through hearing or smell. Therefore, in individual cases, it is uncertain to what extent the “use” of a non-traditional trademark can achieve to prove that the trademark has acquired distinctiveness [8].

Secondly, when submitting evidence for the “use” of a non-traditional trademark, more emphasis shall be placed on the “use of a non-traditional trademark”. Even if the product has been on the market for a long time, it is difficult to determine whether the non-traditional trademark has acquired distinctiveness if the actual manufacturing and sales activities of the business operator have not used the non-traditional logo as its trademark [9].

2.3.2. Non-traditional marks indirectly connected with the goods or services they represent

Traditional visible trademarks can be closely combined with the goods or services represented by the trademarks by such means as labels and packages, and consumers can directly and naturally establish the relationship between the trade symbol and their goods or services by means of the goods themselves or in the course of receiving the services. So, it is relatively easy to prove whether consumers can use such traditional trademarks as a sign indicating the source of their products. However, since there is an indirect relationship between the non-traditional trademark and the goods or service it represents. For example, the shape of the goods is used as a sign indicating the origin of the goods by the three-dimensional trademark. The smell of the odor trademark is used as a sign indicating the origin of the goods. Sound trademarks are to be communicated by other media in such a manner as to associate the sound with the goods or services it represents. Under normal circumstances, consumers will not directly recognize these three-dimensional shapes, smells, sounds, etc. as trademarks of a product or service. Therefore, the lack of a one-to-one relationship between a non-traditional trademark and a designated product or service in the consumer’s mind leads to great uncertainty in the public perception survey [10].

3. Suggestions on the Improvement of the Rules on the Recognition of Distinctiveness of Non-traditional Marks

3.1. Increasing the forms of evidence recognized by the relevant public

The consumer association standard is an important criterion in all countries to judge whether a non-traditional mark has acquired distinctiveness. Only when consumers regard the non-traditional mark as the mark of the source of goods or services will the mark have a second meaning. Evidence to prove the acquisition of distinctiveness is divided into direct evidence and indirect evidence. The direct evidence shall directly reflect the opinion of the consumers on the symbol and mainly includes testimony of consumers and result of questionnaire survey of consumers. Consumer testimony refers to the testimony provided by buyers randomly sampled and presented in court. It is very important to prove the secondary meaning of a non-traditional trademark, but consumer testimony usually cannot represent the views of consumers; therefore, the questionnaire was designed. In Europe, Germany and Austria were the first countries to use research and study as legal evidence. In order to determine the acquired distinctiveness of a non-traditional mark, the typical way to measure the recognition of the mark among consumers in Germany is to use a questionnaire to survey the percentage of consumers who regard the mark as a sign indicating the source of goods [11].

3.2. Attaching importance to the objective environmental evidence for the use of trademarks by relevant operators

When verifying the “second meaning” of a non-traditional trademark, the evidence of the objective circumstances involved in the use of the trademark shall also be taken into consideration, because the determination of the “second meaning” is a determination of facts that requires the combination of subjective evidence and objective evidence.

Firstly, there are different standards to be met for determining whether a non-traditional trademark has acquired distinctiveness depending on whether that non-traditional mark is used on its own or together with other marks. The standard for proving secondary meaning will be higher if the said non-traditional mark is used as part or parcel of a trademark together with other types of trademarks.

Secondly, in terms of the time for use of a trademark, a longer period of exclusive use does not necessarily lead to the emergence of the second meaning. It is also necessary to judge whether the public has regarded such a sign as a trademark, because the public may regard such a sign as merely a characteristic of certain commodities or services.

To a large extent, the development of non-traditional trademarks has benefited from a variety of publicity methods and technological developments that have kept pace with the times, because operators can use technology to form a multi-sensory marketing approach rather than only using visual stimulation to stimulate consumers to form an impression and understanding of a certain trademark.

3.3. Clarification of Limitations on Acquired Distinctiveness for Non-traditional Marks

Different from the traditional trademark, the non-traditional trademark is not generally regarded as a trademark in the consumer’s mind, but as a kind of utility function or an improvement of its function, with the functional trademark is not allowed to be registered. This is mainly to balance individual interests and the public interest and to avoid unfair market competition. Therefore, when determining the distinctiveness of a non-traditional trademark, either through inherent distinctiveness or to prove “secondary meaning”, the “functional element” must be the first thing to be excluded [12].

4. Conclusion

The recognition of non-traditional distinctiveness is a complicated and developing field in trademark law. This paper discusses the rules of trademark distinctiveness, the particularity of the rules of non-traditional distinctiveness and the suggestions to perfect the rules of recognition of non-traditional distinctiveness. From the analysis of trademark law in many countries, it can be seen that the evaluation of non-traditional distinctiveness needs careful analysis of consumer recognition and actual use.

As companies continue to explore new and innovative forms of trademarks, it is critical that the law and practice adapt to the challenges and needs posed by non-traditional trademarks. By increasing the forms of evidence in the subjective perceptions of the relevant public and emphasizing evidence of the objective circumstances of the the relevant operators’ use of the trademarks, the manner in which non-traditional trademarks acquire distinctiveness will be clarified. This will facilitate the supportive legal environment for non-traditional trademarks and provides effective protection for trademarks in the rapidly changing global market.

In this paper, due to space constraints, the author focuses on the more complex part in the determination of distinctiveness of non-traditional trademarks- acquired distinctiveness, without discussing inherent distinctiveness in depth. In order to address this issue, the author will follow up

on the study of the inherent distinctiveness of non-traditional trademarks later, to provide more comprehensive suggestions for the rules of recognition of the distinctiveness of non-traditional trademarks.

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