

# GOODSILL

ANDERSON QUINN & STIFEL

1878

A LIMITED LIABILITY LAW PARTNERSHIP

## TRADITIONAL AND NONTRADITIONAL TRADEMARKS: ILLUSTRATED BY FOOD WARS, CHEF EGOS AND THE MALASADA TRUCK

*By Martin S. Loui*

Intellectual Property Practice  
mloui@goodsill.com  
(808) 547-5600



*This republication was first published in the Hawaii Bar Journal (the official publication of the Hawaii State Bar Association), September, 2011, is informational in purpose and is not intended to be legal advice. Independent advice of counsel should be sought for questions about this topic. © 2011 Martin S. Loui. All rights reserved.*

*A Tradition of Client Service and Integrity*

## INTRODUCTION

A challenge restaurateurs and chef-owner entrepreneurs face is the mastering of the secret sauce for building a base of return customers and expanding that base.

Developing new and interesting cuisine is part of a chef's and restaurateur's repertoire. This is especially important in a competitive industry where there is no shortage of food service establishments or initiatives by chefs and restaurant goers eager for new culinary experiences. In its simplest characterization, the goal of the secret sauce is to cover the dichotomy of capturing return diners who savor a particular dish, and diners seeking out new culinary creations.

Enter that new breed of food and beverage entrepreneur; new to the food scene and seeking market penetration. More and more common, they may be launched by fundraising from investors looking for a return on investment ("ROI"). Other food service establishments, such as franchises, may be looking to expand operations. Whether there is in fact a recipe for the secret sauce that is applicable to everyone is debatable but one mechanism that nearly every business relies upon, whether consciously or subconsciously, is brand development and placement to capture market share. Brand development forces chef-owners and restaurateurs to go beyond their duties in the kitchen and exercise business acumen in utilizing intellectual property ("IP") to create value for their business. Usually, that type of IP facilitates ROI and involves the field of trademark law.

IP may be used to highlight and monetize the technical and creative culinary skills of the chef or restaurateur.

This article is a basic introduction to traditional and non-traditional trademark law. Examples of trademarks used in the food industry illustrate concepts that may be applicable to other channels of trade. The concepts and techniques described here may help entrepreneurs build a brand by distinguishing themselves, expand their base of customers using traditional and nontraditional trademarks, and create an intellectual property portfolio attractive to investors

Part I will introduce basic concepts of trademark law. Part II will describe the general landscape comprising the types of nontraditional trademarks. Part III will provide several examples of such marks seen in the Hawaiian topography. Part IV will discuss additional tools for the culinary entrepreneur having claims to fame marks, licensing opportunities and signature dishes. Part V will conclude with the secret sauce comprising at least one part business acumen and one part strategic exploitation of opportunities for brand building.

## TRADEMARK BASICS

Trademarks and service marks are traditionally known to be made up of "any word, name, symbol, device or any combination thereof"<sup>1</sup> that the public associates with a single source for goods and services, respectively. Both trademarks and

service marks are sometimes collectively referred to herein as "marks" or "trademarks." They are both source indicators. Those marks containing words may consist of ordinary words that can be found in a dictionary or be coined words or phrases and they may include letters and/or numerals. When the mark is a design, it may, for example, include an abstract illustration, a reproduction of an object, or an image or some stylization, typically serving as a logo.

The Lanham Trademark Act of 1946 governs trademark rights under federal law.<sup>2</sup> The source of Congressional power to regulate trademark rights is derived from the Commerce Clause, which does not create exclusive federal rights for trademark laws. Accordingly, various state laws for the protection of trademarks may be pertinent,<sup>3</sup> as well as common law rights. In Hawaii, state statutes serve to regulate trademarks, unfair methods of competition, deceptive trade practices, trademark dilution, and trademark counterfeiting, by way of examples.<sup>4</sup> Outside of Hawaii and the United States, various countries may grant registration for various types of marks; while some countries may not grant registrations at all for certain types of marks.<sup>5</sup>

## TYPES OF NON-TRADITIONAL TRADEMARKS

The Lanham Act has been interpreted to encompass nontraditional marks by implication, that is, due to their non-exclusion from the definition of

“trademarks.”<sup>6</sup> In 1995, the Supreme Court’s landmark *Qualitex* case “trumpeted that a trademark could be ‘almost anything at all that is capable of carrying meaning.’”<sup>7</sup> Fast forward to 2011, where one commentator has remarked, “in the exotic world of the nontraditional and beyond, . . . , when it comes to registering such marks[,] the United States Patent and Trademark Office (USPTO) is your friend.”<sup>8</sup>

Within this context, nontraditional trademarks “are [relative] newcomers.”<sup>9</sup> They may take various forms, such as color, motion, sound, scent, taste (flavor), touch (texture) and three-dimensional configurations in the nature of product design or shape and packaging. The nature of some nontraditional marks may be characterized by their appearance, wherein one or more colors may be applied to the products or packaging, or the look and feel of a business in the case of retail establishments.<sup>10</sup> Their applications may arise within the context of trade dress, which covers the “overall appearance and impression of a product, . . . , and even some product marketing schemes.”<sup>11</sup> In the restaurant trade, “[t]rade dress can [further] include service features such as retail décor, architectural features [of the exterior of the retail business], menu and layout.”<sup>12</sup> Examples of several types of nontraditional marks follow.



Color may be protectable as a trademark, not where it is

merely functional,<sup>13</sup> but where it is capable of distinguishing goods or services.<sup>14</sup> “Color *per se* cannot be inherently distinctive.”<sup>15</sup>



Therefore, acquired distinctiveness, also known as secondary

meaning, must be attained for a color mark to be protectable and enforceable.<sup>16</sup> For example and as shown, the color purple has been applied to a packaging (box) for brownies.<sup>17</sup> Phillips Foods, Inc., famous for Maryland blue crab meat, has trademark protection for the black color applied to the surface of its packaging, a can containing crab meat.<sup>18</sup> Labatt Brewing Company Limited has protected the color blue applied to the pull tab of its aluminum cans containing beer.<sup>19</sup> Color marks typically arise where a single color has become a source indicator.



Trademarks that include **motion** may also be protectable. “These marks are typically the closest to traditional logo marks of all the nontraditional trademarks; they just add the dimension of movement.”<sup>20</sup> Motion marks may include moving images, which can combine colors, sounds and aspects of product designs.<sup>21</sup>

**Sound** embodied as a jingle, an ordinary sound heard in everyday life, a piece of music, a short extract from a musical work, the full length musical work, or other sounds may be protectable as a trademark,<sup>22</sup> provided it is “capable of identifying and distinguishing goods and can be registered if consumers associate it with the source of goods.”<sup>23</sup> For example, a Costa Rican company has registered the sound mark of an eagle’s squeal for beer,<sup>24</sup> while the restaurant chain owned by Red Robin International, Inc. has protected the acapella sound of YUMMM.<sup>25</sup> Additionally, the Taco Bell Corp. has protected the “bong” sound for its carryout restaurant services.<sup>26</sup>

**Various scents** may also be added to and associated with products and services.<sup>27</sup> “Distinctive, non-functional fragrances are eligible for federal trademark registration.”<sup>28</sup> For example, the scent of strawberry “impregnated” within toothbrushes has been protected as a scent mark,<sup>29</sup> and the scent of peach for file folders has also been protected via a federal registration.<sup>30</sup> There is presently an application for the coconut scent used in connection with retail store services, that include the sale of various merchandise such as water bottles and lip balm.<sup>31</sup>

In 2006, the trademark application for the orange flavor of antidepressant tablets was finally refused by the Trademark Trial and Appeal Board.<sup>32</sup> That application had been considered groundbreaking in the field of **taste marks** and commented upon by many trademark practitioners. Despite the failure

of this application, flavor marks are still eligible for trademark protection; however, strong evidence of consumer source recognition is presently required to overcome the scrutiny of being deemed merely functional.<sup>33</sup> Flavor marks cannot be inherently distinctive and must gain secondary meaning, and to this end, it has been suggested that unusual flavors associated with products that are not meant for consumption stand a better chance of being perceived as non-functional.<sup>34</sup>



**Sensory touch marks** provide “[t]actile sensations, [and] if sufficiently distinctive, may function as trademarks.”<sup>35</sup> Tactile trademarks are eligible for protection, as demonstrated by the leather texture wrapping (label) around the wine bottle,<sup>36</sup> and the

flocked texture on a label for a bottle of wine.<sup>37</sup> “It is possible for products to be manufactured in such a way that the product itself or its packaging may have a particular sensation to the touch, which can distinguish it from those of its competitors.”<sup>38</sup>

“Three-dimensional product shapes and product packaging are protected under the Lanham Act as trade dress, and may entail the total image of a product, or even a service.”<sup>39</sup> A three-dimensional representation of a product, its packaging, or the architectural business design, interior look and feel, signage, label shape and/or tag may form a nontraditional mark.<sup>40</sup> Examples

follow of several types of three-dimensional nontraditional marks which may be applicable to the food and food service channels of trade.



Three dimensional aspects of **product packaging** are eligible for trademark protection as a source indicator if they are non-functional and

distinctive.<sup>41</sup> “An applicant seeking protection or a trademark registration for product packaging must prove either that the trade dress is inherently distinctive or has attained secondary meaning and that it is not functional.”<sup>42</sup> In one example shown, the packaging for food in the form of a box of chocolates, having particular shape, color, ribbon, printing and design element, has received federal trademark registration.<sup>43</sup> In another example depicted, the three-sided base configuration having equal-cup portions with ribbed sides has been protected as product packaging.<sup>44</sup>



**Product shape trade dress** (aka product designs) pertaining to food entails the appearance of the actual

food itself, and may be protectable if the shape is distinctive and nonfunctional.<sup>45</sup> Four examples are shown. Known by the **GOLDFISH** brand, the shape of cheese-flavored crackers has been protected under trademark law since April 9, 1991.<sup>46</sup> As of

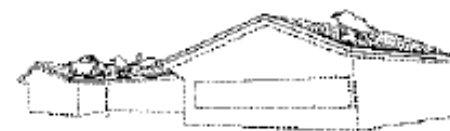


August 31, 2010, Frito-Lay North America, Inc. has received a federal registration protecting the shape of spiral-shaped corn chips.<sup>47</sup> With another example, in addition to color, the shape of a cake in the form of a gift box complete with the ribbon has also been federally registered.<sup>48</sup> Still



further, Cinnabon, Inc. has a federal registration for the configuration of the cinnamon roll, specified by size, shape and ingredients.<sup>49</sup>

**Architectural marks** expand the breath of nontraditional marks, may embody exterior trade dress of buildings, and may be “protectable when distinctive and nonfunctional.”<sup>50</sup> These nontraditional marks have been registered by food establishments, such as that shown for a “rectangular shaped one-story building with



a square tower with a pyramidal red canopy roof” by Fazoli’s System Management, LLC,<sup>51</sup> and for goats grazing on a grasstop roof.<sup>52</sup>

Turning to the interior of the retail establishment, “[r]estaurant and other retail decor may be protectable trade dress.”<sup>53</sup> For



example, the interior of the restaurant for Chipotle Mexican Grill, Inc. includes décor comprising unpainted galvanized or stainless steel metal finishes on tables and bar tops, light-colored natural wood finishes, and an exposed kitchen and grill area, among other elements, collectively combined to create a total look and feel as shown.<sup>54</sup> The look and feel of the restaurant’s interior décor may be created by other décor elements,<sup>55</sup> including a restaurant menu that may be entitled to trade dress protection,<sup>56</sup> the combination of logo font, color accents in advertisements and souvenirs, and lighting fixtures.<sup>57</sup>

### EXAMPLES OF HAWAII’S NON-TRADITIONAL MARKS RELATED TO FOOD

Nontraditional marks are not new to Hawaii businesses. In 1999, a well-known business applied for a configuration mark with the

USPTO, to protect the shape of its trailer (and color striping)<sup>58</sup> used to sell malasadas,



a “local” pastry. This cultural icon, the “malasada trailer truck,” which many raised in Hawaii have frequented since childhood and possibly taken for granted is the quintessential



“Hawaiian version of an ice cream truck”<sup>59</sup> – a source indicator under trademark standards in its purest form. A search of the trademark database at the USPTO revealed other nontraditional marks used with food items. For example, the packaging of foods has also been protected, as depicted, in a federal

registration for a water bottle having flat geometric shapes, a product configuration mark.<sup>60</sup> In 2003, a Hawaii-based business sought protection for the shape of a cookie that looks like a pineapple cutout.<sup>61</sup>



From 1996 and as of the drafting of this article, it appears that very few businesses with a Hawaii address have sought federal trademark protection for food items or for food establishment services with “nontraditional” marks. For example, no motion marks, taste marks, sensory touch marks or other product configuration marks (i.e., three dimensional shape) were uncovered related to food or restaurant services.<sup>62</sup>

During a recent inquiry made to the Hawaii Department of Commerce and Consumer Affairs concerning the registration of color and scent marks, the response received was that only graphics and words would be protected,<sup>63</sup> the implication being that trademarks or service marks filed for nontraditional marks might not be protected. Those receiving similar feedback ought to contact a trademark legal specialist concerning the protection of non-traditional marks.

### CLAIM TO FAME MARKS, CHEF BRANDING, AND THE SIGNATURE DISH

Restaurants often tout that they are the first to invent certain food dishes, and guard that claim to fame closely, as in the case of food wars concerning the



original or first to invent, such as in one example, the New York cheese cake, and in another example, the Philadelphia “Philly” cheese steak sandwich.<sup>64</sup> In the latter case, a well-known food establishment obtained federal trademark protection for the depicted mark, PAT’S KING OF STEAKS ORIGINATORS OF THE STEAK SANDWICH (and design).<sup>65</sup> In doing so, this business literally incorporated the first to invent claim into its design mark, namely, “ORIGINATORS OF THE STEAK SANDWICH.” It would be understandable that the owners of the business back in 1968, the date of first use of the mark, would probably not have anticipated that the claim to fame would become a valuable IP asset and enable marketing leverage in modern day times. It is interesting that the incorporation of a claim to fame aspect into a design mark would be a nontraditional way to utilize trademark law to obtain relief against third parties making a confusingly similar claim to fame assertion. Ironically, the claim to fame mark would appear to also support the advertising puffery and ego associated with the invention of the Philly cheese steak sandwich.

Several Hawaii-based businesses have used a similar strategy to stake their claims to fame by incorporating them into its design marks. Doing so enables restaurant owners to assert a claim for trademark infringement, if evidence should be deficient



to support a false advertising or other cause of action against third parties making a confusingly similar claim to fame. In one example shown, a design mark which included the terms, “HAWAII’S ORIGINAL MALASADAS”, is a claim to fame for pastry.<sup>66</sup> In another similar example depicted, although more limiting, the year associated with the claim to fame (to “Hawaiian Barbecue”) was embedded into the design mark, namely “SINCE 1976” by L&L Franchise, Inc.<sup>67</sup>



Those who follow the FOOD NETWORK® cable television programs<sup>68</sup> over the years have witnessed the rise of up and coming chefs to the status of celebrity chefs. Capitalizing on this movement, not only are chefs and restaurant owners protecting their service marks for restaurant services (i.e., “traditional” trademark protection), they are also registering “their names for use in connection with ... food preparation and food demonstration, television shows, spices and dinnerware”,<sup>69</sup> not to mention ancillary food products and merchandise such as those under the MORIMOTO and GIADA names, by way of examples.<sup>70</sup> Doing so enables the chef-owner opportunities for licensing of the name, and the restaurant, which might hire

the chef, the ability to exploit the chef’s name.

In one example, a local celebrity chef has protected the mark, ROY’S FUSION COOKWARE, for “[h]ousehold cookware, namely, pots, metal frying pans, glass frying pans, skillets, roasters, metal grill pans, stock pots.”<sup>71</sup> Chefs who have reached this well-known status, typically have retained or partnered with a business facilitating the manufacturing, merchandising, branding, distribution of products and chef name promotion in commercial markets.<sup>72</sup> Obtaining a license to the chef’s name is vital to support the ability to brand a chef, and to anticipate and withstand due diligence by investors during fund-raising activities, particularly for early-stage or mid-level restaurant businesses.<sup>73</sup> This strategy signals to investors that the business could be still viable even if the chef parted ways from the restaurant, and helps protect the business from possible subsequent attempts by the chef to thwart the restaurant’s continued use of that chef’s name.



It would not be a far leap if a chef has a claim to fame in a culinary creation, along with the ego to promote such creation. Interestingly, a signature dish may be protected by the combination of trademarks and trade dress. In one approach, “the name of a signature dish may be protected as a trademark if it is not merely descriptive of

the dish and otherwise serves to identify it, distinguish it, and indicate its source.”<sup>74</sup> Following the line of the Pepperidge Farm’s **GOLDFISH** trademark and the configuration mark owned by Cinnabon, Inc., the legal theory supports the idea that the shape of a signature dish may be protectable if it is non-functional, distinctive and marketed in a way to be a source indicator.<sup>75</sup> An example of this is where “a chef would never be able to trademark a piece of lasagna in the shape of a square, [however,] trademark principles suggest that a chef should be able to trademark lasagna that is shaped, for example, like a car,” provided such aforesaid criteria can be established and the shape is not merely ornamental.<sup>76</sup> Pushing the boundaries of nontraditional marks further, a commentator has proposed that the chef would have a further right to protect the trade dress of packaging by creating an unusual appearance of the lasagna (shaped like a car) with, by way of example, the addition of a glob of grape jelly so that the visual appearance would “identify and distinguish the signature dish and its source.”<sup>77</sup>

### **SECRET SAUCE – ONE PART BUSINESS ACUMEN, ONE PART BRAND BUILDING, ...**

Although the food industry was discussed by way of illustration, the concepts introduced are applicable across various trade channels. Those businesses, either established or start-ups and those aspiring to expand with ancillary products and other services, should initially protect their mark in the traditional manner, i.e., in word and logo (two-

dimensional) formats, for the primary goods and services. In the case of the food establishment industry, this would be for restaurant services in International Class 42, preferably federally and at a minimum locally through state agencies.<sup>78</sup> Thereafter, these businesses with the entrepreneur mindset have a multitude of resources available to brand themselves using nontraditional marks either alone or in combination, to supplement the traditional methods of trademark protection. For example and with one brand strategy, by adopting a single color on certain products, its packaging or within the décor of the retail establishment, consumers can be “conditioned” to recognize the goods or services emanating from a single source. In another example, by using a motion mark on the retail establishment’s website or social networking account, and in its advertising campaigns, this nontraditional mark may offer the business a branding tool that is exclusively visual<sup>79</sup> and beneficial for attracting customers. The retail business may create and trademark an icon for their App that runs on a smartphone or tablet-computer (e.g., Apple iPhone, iPad, etc.).<sup>80</sup>

Many new businesses have a period of design and building. During this stage, there may be aspects of the exterior architecture and interior décor that could be examined for trade dress protection to the extent such nontraditional mark could provide source recognition and be of value to the business model. Counseling from a trademark legal specialist should be sought on how to

develop secondary meaning if the trade dress is not inherently distinctive.<sup>81</sup> The entrepreneur’s business acumen would include other considerations that encompass menu names,<sup>82</sup> the product shape, its three-dimensional packaging and product name possibly qualifying for trademark protection, if certain criteria are met.<sup>83</sup> Should the business expand to sell ancillary products and merchandise, trademark protection for these goods might be sought, as well as service marks to promote the core underlying business services.<sup>84</sup> Where a person will be featured by and branded with the underlying business, a license to use that person’s name<sup>85</sup> should be sought to enable strategic exploitation of branding opportunities, and the right to obtain trademark protection in that name. Where that featured person creates a signature product, there may be three potential elements to protect: the name of the product, its shape and three-dimensional trade dress packaging.<sup>86</sup> Where the business has a claim to fame assertion in being the first to invent a product, the tactic of registering the claim to fame in a trademark is a strategy to consider.<sup>87</sup> These aspects of brand building collectively contribute to the secret sauce.

While it may appear that an intellectual property portfolio assembled with a strategy of incorporating traditional and nontraditional marks is limited by the entrepreneur’s imagination and creativity, “cleverness alone does not ensure legal protection”<sup>88</sup> or success. Satisfying the requirements for registering a nontraditional

trademark is logistically technical in nature and can be an uphill battle, given the hurdles of the non-functionality, distinctiveness and proper usage requirements of the USPTO. "Trademarks in general need to meet certain requirements in order to be considered eligible for protection and registration."<sup>89</sup> Thus, it is prudent to consult a trademark legal specialist for further interpretation of the principles introduced here.

Moreover, few businesses, especially start-ups, believe that they can afford to assemble a marketing and legal team to create innovative branding strategies using many types of nontraditional marks, let alone register for trademark protection in every country worldwide.<sup>90</sup> While often true, many businesses fail to fully value and appreciate the opportunities and options that nontraditional marks provide, especially techniques for developing a brand that should be coordinated with the business mission to capture market share by expanding a base of return customers and building one for new customers; and which can also be strategically used to unlock the keys to an investor's heart.

*Martin S. Loui is Counsel and Head of Intellectual Property Practice, Goodsill Anderson Quinn & Stifel, A Limited Liability Law Partnership LLC, Honolulu, Hawaii. He is a member of the International Trademark Association (INTA); The Licensing Executive Society International (LES); American Intellectual Property Law Association (AIPLA), a former Trademark*

*Examining Attorney and Patent Examiner (U.S. Patent and Trademark Office); and a registered patent attorney. The views expressed in this article are that of the author and should not be attributed to that of the firm, the sponsoring organization publishing this article, or the institutions that the author is affiliated. The author gratefully acknowledges Richard L. Sherman and Lenne N. Omuro for helpful insight, as well as the research assistance of Andrey N. Krez.*

©2011 Martin S. Loui. All rights reserved.

<sup>1</sup> 15 U.S.C. §1127 (2010).

<sup>2</sup> 15 U.S.C. §§ 1051 *et seq.*

<sup>3</sup> Anne Haring, *Basic Principles of Trademark Law*, in UNDERSTANDING TRADEMARK LAW 51, 56 (Practising Law Institute, N.Y. 2008).

<sup>4</sup> Haw. Rev. Stat. §§ 482-1 *et seq.*, 480-2, 481A-3, 482-32, and 708-875 (2010).

<sup>5</sup> Jon O. Webster, *Creating a Trademark Protection Program in the United States and Abroad*, *supra* note 4, at 184.

<sup>6</sup> Jerome Gilson, *et al.*, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TMR 773, 774 (2005); and *see also*, Global Trademark Research, Facts Sheets Types of Protection, Nontraditional Trademarks, at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx> ("Outside of the U.S., [d]ifferent countries grant them with varying levels of protection").

<sup>7</sup> Jerome Gilson, *et al.*, *supra* note 7, at 774 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995)).

<sup>8</sup> Anne Gilson LaLonde, *et al.*, *Getting Real with Nontraditional Trademarks: What's Next After Red Oven Knobs, The Sound of Burning Methamphetamine, and Goats on a Grass Roof?*, 101 TMR 186, 193 and note 3 (2011).

<sup>9</sup> *Id.* at 187.

<sup>10</sup> *See* Global Trademark Research, *supra* note 7.

<sup>11</sup> *See* Anne Gilson LaLonde, Gilson on Trademarks § 2A.01, and text accompanying note 8 (LEXISNEXIS 2011).

<sup>12</sup> *Id.* at § 2.11 and text accompanying note 139.

<sup>13</sup> *Id.* and text accompanying note 52.

<sup>14</sup> Gilson on Trademarks, *supra* note 12, § 2.11.

<sup>15</sup> *Id.* and text accompanying note 45.

<sup>16</sup> *Id.* and text accompanying note 46.

<sup>17</sup> U.S. Reg. No. 3,110,845 (July 4, 2006).

<sup>18</sup> U.S. Reg. No. 3,629,229 (June 2, 2009).

<sup>19</sup> U.S. Reg. No. 3,037,003 (Jan. 3, 2006).

<sup>20</sup> *See* Gilson on Trademarks, *supra* note 12, § 2.11.

<sup>21</sup> *See* Global Trademark Research, *supra* note 7.

<sup>22</sup> *Id.*

<sup>23</sup> *See* Gilson on Trademarks, *supra* note 15.

<sup>24</sup> U.S. Reg. No. 3,502,115 (Sept. 16, 2008).



<sup>25</sup> U.S. Reg. No. 3,720,772 (Dec. 8, 2009) (“The mark consists of a quartet of male voices singing “YUMMM,” as a whole-note chord consisting of G2, D3, B3, and D4.”).

<sup>26</sup> U.S. Reg. No. 3,736,968 (Jan. 12, 2010) (“The mark consists of the “bong” sound produced by striking a large bell once, with a fundamental pitch of approximately “e” below middle “c.”).

<sup>27</sup> Global Trademark Research, *supra* note 7.

<sup>28</sup> See Gilson on Trademarks, *supra* note 12, § 2.11.

<sup>29</sup> U.S. Reg. No. 3,332,910 (Nov. 6, 2007).

<sup>30</sup> U.S. Reg. No. 3,140,694 (Sept. 5, 2006).

<sup>31</sup> U.S. Ser. No. 85/063,625 (Filed June 15, 2010).

<sup>32</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (TTAB 2006); and see U.S. Ser. No. 76/467,774 (Filed Nov. 18, 2002).

<sup>33</sup> Jerome Gilson, *et al.*, *supra* note 7, at 800-801; and see Anne Gilson LaLonde, *et al.*, *supra* note 9, at 209; and Gilson on Trademarks, *supra* note 15, and text accompanying note 116.3.

<sup>34</sup> See Jerome Gilson, *et al.*, *supra* note 7, at 801.

<sup>35</sup> Gilson on Trademarks, *supra* note 15, and text accompanying note 116.13.

<sup>36</sup> U.S. Reg. No. 3,896,100 (Dec. 23, 2010) (“Color is not claimed as a feature of the mark. The mark consists of a leather texture wrapping around the middle surface of a bottle of wine. The mark is a sensory, touch mark.”). See also, <http://www.davidfamily.com/index.php?option>

[=com\\_content&view=article&id=77&Itemid=78](#) (leather label from Spain, cut, stamped, printed and applied all by hand with adhesive that allows the label to be removed and saved).

<sup>37</sup> U.S. Reg. No. 2,751,476 (Aug. 12, 2003).

<sup>38</sup> See Global Trademark Research, *supra* note 7.

<sup>39</sup> See Gilson on Trademarks, *supra* note 15.

<sup>40</sup> See Global Trademark Research, *supra* note 7.

<sup>41</sup> Anne Gilson LaLonde, *et al.*, *supra* note 9, at 193.

<sup>42</sup> See Gilson on Trademarks, *supra* note 15, and text accompanying note 149.

<sup>43</sup> U.S. Reg. No. 2,910,405 (Dec. 14, 2004) (“The mark of this application consists of a packaging design having an oval outer configuration with a ribbon extending about the packaging which is tied in a bow. The ribbon including the wording LA MAISON DU CHOCOLAT and a design element which repeat along the entire length of the ribbon. The top surface of the packaging including the wording LA MAISON DU CHOCOLAT and the same design element. The container portion is a tobacco brown color with a dark brown border extending about the top surface of the packaging. The ribbon portion is a beige color with tobacco brown imprinting.”).

<sup>44</sup> U.S. Reg. No. 2,908,255 (Dec. 7, 2004).

<sup>45</sup> Anne Gilson LaLonde, *et al.*, *supra* note 9, at 195.

<sup>46</sup> U.S. Reg. No. 1,640,659 (April 9, 1991).

<sup>47</sup> U.S. Reg. No. 3,839,907 (Aug. 31, 2010).

<sup>48</sup> U.S. Reg. No. 3,788,865 (May 11, 2010) (“The color(s) red and white is/are claimed as a feature of the mark. The mark consists of a configuration of a red and white cake. A thick white ribbon appears crossing over the width and length of the top surface of the cake with a thick white ribbon placed on top of the intersection of the large plus sign design on the top surface of the cake simulating a large bow on top of the cake. The base of the cake contains a series of connected textured scalloped designs appearing in white. The color black appears within the ribbon, bow and scalloped designs to show texture and depth in the mark but is not claimed as a feature of the mark. The dotted lines represent the outline of the square shape and representation of the cake and are not claimed as a feature of the mark.”).

<sup>49</sup> U.S. Reg. No. 2,098,432 (Sept. 16, 1997) (“The mark consists of a cylindrical configuration of a cinnamon roll having a height of about two and one-half inches and a width of about four inches; and having a spiral wrap of five and one-half to six and one-half layers of baked dough with a melted cinnamon/brown sugar/margarine layer between overlapping portions of the wrap, with the inner portion of the wrap being slightly elevated above the outer portions of the wrap, and with the top and portions of the side of the wrap being covered by melted frosting. The stippling in the drawing is for shading purposes only.”).

<sup>50</sup> See Gilson on Trademarks, *supra* note 15, § 2.11 and text accompanying note 150.

<sup>51</sup> U.S. Reg. No. 2,302,979 (Dec. 21, 1999).

<sup>52</sup> U.S. Reg. No. 2,007,624 (Oct. 15, 1996).

<sup>53</sup> See Gilson on Trademarks, *supra* note 15, § 2.11 and text accompanying note 151 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992)).

<sup>54</sup> U.S. Reg. No. 3,128,649 (Aug. 15, 2006).

<sup>55</sup> Lisa K. Krizman, *Trademark Protection for Restaurant Owners: Having Your Cake and Trademarking It, Too*, 99 TMR 1004, 1010 (2009).

<sup>56</sup> *Vasquez v. Ybarra*, 150 F.Supp.2d 1157 (D. Kan. 2001).

<sup>57</sup> Jerome Gilson, *et al.*, *supra* note 7, at 816.

<sup>58</sup> U.S. Reg. No. 2,377,375 (Aug. 15, 2000).

<sup>59</sup> Hawaii is not known for its ice cream trucks.

<sup>60</sup> U.S. Reg. No. 1,986,583 (July 16, 1996).

<sup>61</sup> U.S. Reg. No. 2,934,375 (Mar. 22, 2005).

<sup>62</sup> As of July 3, 2011, there does not appear to be other Hawaii applicants filing for federal protection of nontraditional marks (including three-dimensional trade dress) for foods or food establishment services on the USPTO database, Trademark Electronic Search System (TESS), at <http://tess2.uspto.gov/bin/gate.exe?f=search&state=4004:2gd2qj.1.1>; but see *e.g.*, U.S. Ser. No. 76/472,363 (filed Dec. 5, 2002, now abandoned) (configuration of retail kiosk as a shark cage for selling diving equipment).

<sup>63</sup> Phone call to Department of Commerce and Consumer Affairs, Business Registration Division, (808) 586-2744 (July 7, 2011).

<sup>64</sup> See Lisa K. Krizman, *supra* note 56, at 1022-1023.

<sup>65</sup> U.S. Reg. No. 2,614,975 (Sept. 3, 2002).

<sup>66</sup> U.S. Reg. No. 3,913,491 (Feb. 1, 2011).

<sup>67</sup> U.S. Reg. No. 3,041,811 (Jan. 10, 2006).

<sup>68</sup> U.S. Reg. No. 2,791,044 (Dec. 9, 2003).

<sup>69</sup> See Lisa K. Krizman, *supra* note 56, at 1024.

<sup>70</sup> See *e.g.*, U.S. Reg. No. 2,893,977 (Oct. 12, 2004) and U.S. Ser. No. 77/219,173 (Filed June 29, 2007).

<sup>71</sup> U.S. Reg. No. 3,087,968 (May 2, 2006).

<sup>72</sup> See *e.g.*, Become a HSN Partner, at [http://www.hsn.com/become-an-hsn-partner\\_at-4682\\_xa.aspx?nolnav=1](http://www.hsn.com/become-an-hsn-partner_at-4682_xa.aspx?nolnav=1).

<sup>73</sup> See Lisa K. Krizman, *supra* note 56, at 1024.

<sup>74</sup> *Id.* at 1025.

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* at 1027.

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* Qualification is made to “preferably” due to compliance with the “use in commerce” criteria. 15 U.S.C. §1127.

<sup>79</sup> Lesley Matty, *Note: Rock, Paper, Scissor, Trademark? A Comparative Analysis of Motion as a Feature of Trademarks in the United States and Europe*, 14 *Cardozo J. Int’l & Comp. Law* 557, 562 (2006).

<sup>80</sup> The description of goods would be computer software for providing the applicable function. See *e.g.*, U.S. Reg. No. 3,886,206 (Dec. 7, 2010).

<sup>81</sup> See Lisa K. Krizman, *supra* note 56, at 1028.

<sup>82</sup> The application of “menu,” as used here, refers to a catalog listing products for sale. See Merriam-Webster Collegiate® Dictionary (11<sup>th</sup>

ed. 2003) (“a comparable list or assortment of offerings”), at <http://www.merriam-webster.com/dictionary/menu>.

<sup>83</sup> See Lisa K. Krizman, *supra* note 56, at 1028.

<sup>84</sup> See *id.* at 1015 (EGG MCMUFFIN and SAUSAGE MCMUFFIN service marks).

<sup>85</sup> This article does not address the other intellectual property rights that should also be considered, such as the right of publicity.

<sup>86</sup> See Lisa K. Krizman, *supra* note 56, at 1028.

<sup>87</sup> *Id.*

<sup>88</sup> See LaLonde, *et al.*, *supra* note 9, at 187.

<sup>89</sup> See Global Trademark Research, *supra* note 7.

<sup>90</sup> Paul W. Reidl, *Understanding Basic Trademark Law: A Primer on Global Trademark Protection*, in UNDERSTANDING TRADEMARK LAW 205, 217 (Practicing Law Institute, New York, N.Y. 2008).