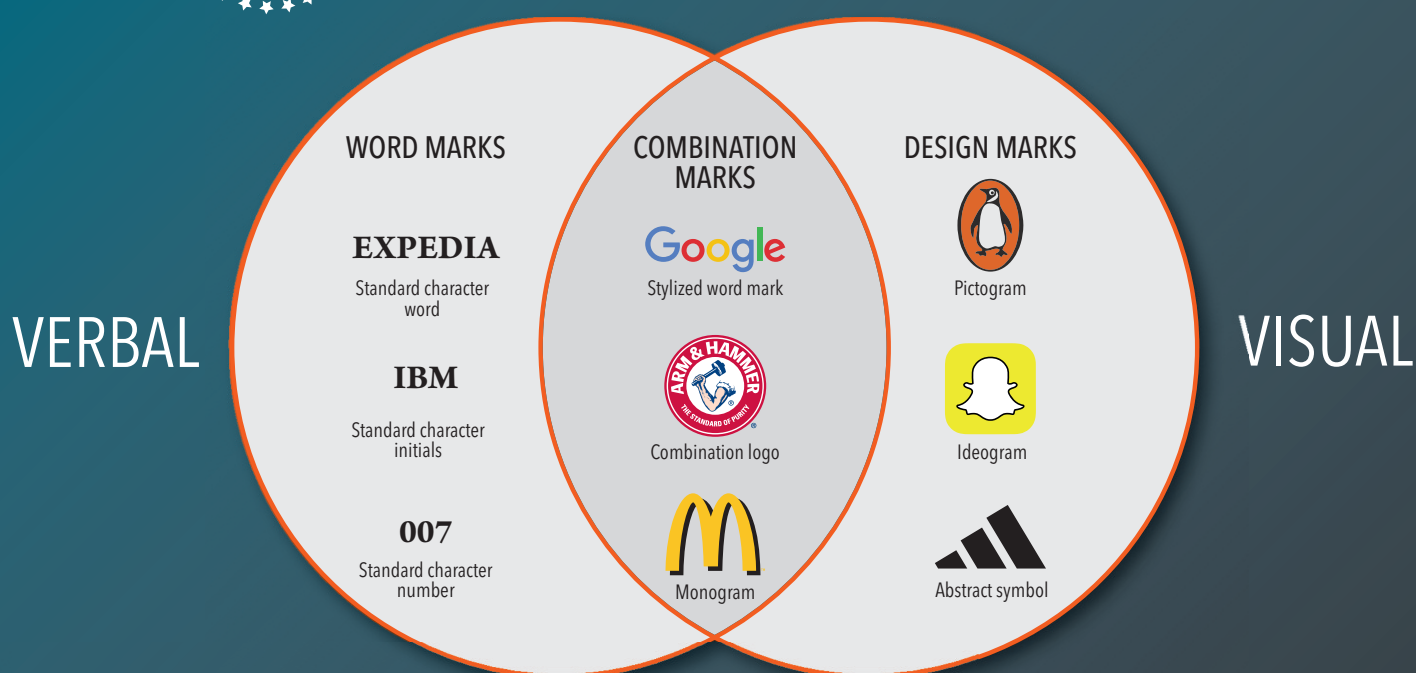


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HOW TO PROTECT AND ENFORCE UNIVERSAL SIGN MARKS

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The universal language of non-verbal design marks

Numerous global brands have adopted design marks without words as their primary branding device. These universal sign marks can transcend cultural and language barriers. What challenges do they present from a trade mark perspective? [Lisa Pearson](#), [Jill Tomlinson](#) and [Sam Kilb](#) investigate the position in the United States

Most attempts to create a universal language have failed miserably. One has succeeded. It is the universal language of commerce, expressed in the iconic design marks of global brands. These symbols are instantly recognised by consumers, regardless of their native tongues. Indeed, many are instantly recognised by children too young to read or make a purchase, as one designer proved in a decidedly unscientific experiment with his five-year-old daughter (see Adam Ladd, *Fresh Impressions on Brandmarks (from my 5-year-old)*). Little wonder, then, that such global brands as Shell Oil, Starbucks and Twitter have adopted iconic design marks that function as universal signs without words to identify their products and services (figure 1).



Figure 1: Universal sign marks

Non-verbal design marks are hardly a new phenomenon. Many hallmarks used by craftsmen, chops used by artisans and brands used by cattle ranchers — progenitors of modern day trade marks — fall into this category. Today's designers have rediscovered the economy and beauty of non-verbal symbols, and today's marketers appreciate their immediate global accessibility. "If effectively produced and executed," one design authority writes, "your brain instantly links the symbol with the word. You don't see a picture of a check mark, you see the word Nike, even

1 MINUTE READ

Brand owners are increasingly using design marks as universal signs to represent their brands, forgoing use of any words or names. Because trade mark rights inure through use in the US, failing to use a word mark could theoretically lead to abandonment of trade mark rights in that term. There are legal theories that can be advanced to avert that result, particularly for pictograms depicting the brand name and for famous brand symbols. Brand owners adopting universal sign marks to identify their brands can further mitigate their risks by reviewing the best practices in this article with counsel and tailoring a strategy to maximise protection for their brands.

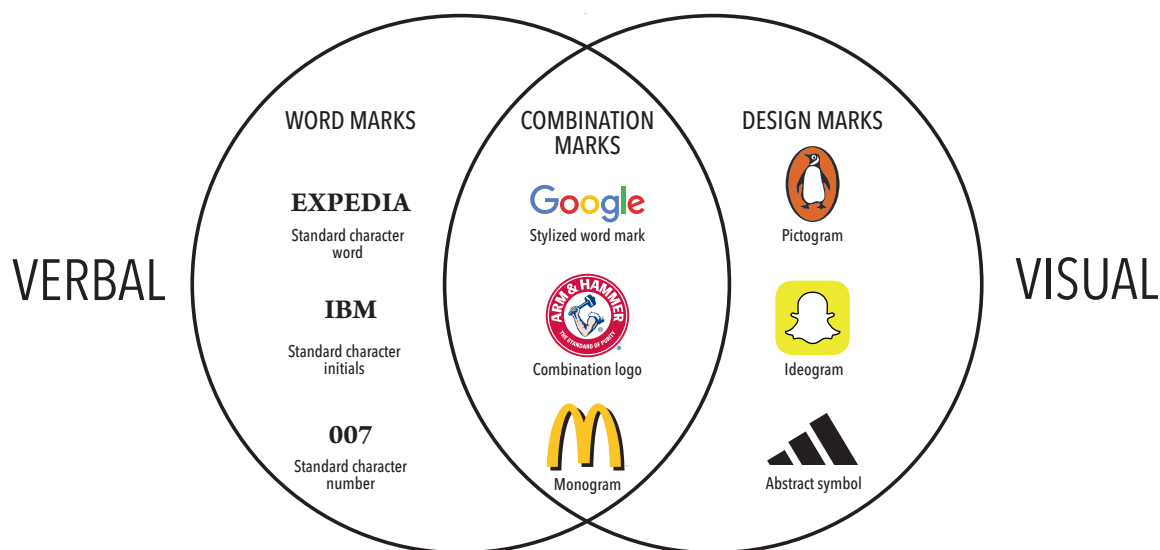


Figure 2: Classification and labelling system

if it's not explicitly written out" (Joshua Johnson, *Twitter's New Logo: The Geometry and Evolution of Our Favorite Bird*, DESIGN SHACK, June 11 2012).

In their provocative blog post *Logos Are Dead?*, Laura Savard and Mark Gallagher persuasively demonstrate how much easier it is for us to recognise purely visual logos such as the Playboy bunny than logotypes such as the Microsoft mark. They explain: "As brand signals, logos are visual icons providing two basic, yet necessary functions for brands: identification (a marker for finding a specific offering) and differentiation (how to tell that offering apart from others). Over time, they directly equate to their given brands. Whether you view them from a distance, or out of the corner of your eye, you equate these visual icons with the brands they represent. For this same reason, when driving in another country, you understand that a red octagonal sign means STOP, even if you don't speak the language."

In a global economy, a picture is worth a thousand words in a thousand languages – provided that consumers recognise the symbol as a mark and know how to find the brand owner's products or services in the marketplace.

The Abercrombie spectrum of trade mark distinctiveness

Clearly, the best design to use as a universal sign mark is a truly distinctive one. In *Abercrombie & Fitch Co v Hunting World*, 537 F.2d 4 (2nd Cir 1976), Judge Friendly, writing for the influential Court of Appeals for the Second Circuit, established a classification system for word marks that has become a cornerstone of US trade mark law. Analysing the protectability of the term "safari" for a variety of clothing items, Judge Friendly identified a spectrum of trade mark distinctiveness: "Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful." Generic terms never qualify for trade mark

protection as word marks; descriptive terms can qualify upon proof that they have acquired so-called "secondary meaning" as source identifiers and are not merely descriptive; and suggestive, arbitrary or fanciful marks are considered inherently distinctive, qualifying for protection without proof of secondary meaning. Of course, the strength of the mark will depend upon the goods or services in connection with which it is used; for example, while a generic term for a fruit, Apple is a strong, arbitrary mark for electronics.

Many US courts and the USPTO apply the same spectrum to evaluate design marks. This approach has been roundly criticised because it is often so difficult to apply to designs. After all, if presented in a sufficiently stylised design presentation, even a generic word can be registered as a trademark in the United States, although a disclaimer of the word may be required. Nevertheless, common experience dictates that certain designs (say, a simple heart or the universal peace sign) are so prevalent, they are akin to generic terms, while others are so illustrative or commonly used in a given industry (say, an olive on a can of olive oil), they are akin to descriptive terms that do not warrant protection absent proof that the public perceives them as source identifiers.

The Shell, Starbucks and Twitter design marks shown above all fall on the strong end of the *Abercrombie* spectrum. None was a pre-existing symbol in general use. None is a simple depiction of the product or service itself or one of its primary ingredients or attributes. Each is arbitrary or fanciful as an identifier of the products and services offered under that mark.

Classifying design marks

Unfortunately, we have no generally accepted spectrum or classification system to differentiate between one kind of design mark and another – a word presented in a distinctive font from a word-free visual image. In other words, there is no commonly accepted way to articulate the difference between the design marks Google and .

People often refer to design marks as “logos”, but that term is not ideal for our topic. The word logo is short for logotype, an old printing term referring to a single piece of type bearing two or more uncombined letters, a syllable or a word. A logotype is typically a stylised presentation of a word mark like the multi-coloured Google mark. Moreover, many well-known “logos” include both verbal and visual components like Arm & Hammer’s time-honoured insignia.

Here, we are interested in design marks that are purely visual, with no verbal matter. Figure 2 opposite presents our own classification and labelling system for design marks.

Within the category of the purely visual design marks shown on the far right — the signs without words that can become universal sign marks — there are at least three subcategories relevant for purposes of our legal analysis:

- 1) **Pictograms**, which visually depict a literal brand name, such as the penguin of Penguin Books, or the apple of Apple, Inc.
- 2) **Ideograms**, which communicate a brand attribute without indicating the sounds used to name the brand or the attribute. As examples, new media enthusiasts can think of the Snapchat ghost, which evokes the ephemeral nature of messages exchanged on that app, while those who still remember watching black and white TV may prefer to visualise the NBC peacock, flaunting the promise of colour television.
- 3) **Abstract symbols**, which tell you literally nothing about the brand name or attributes. For example, adidas uses the three-stripes design, while Nike competes with its Swoosh. These symbols are like coined word marks (Kodak, Xerox). They are inherently strong, arbitrary designations for the goods that bear them.

Trending towards visual

Lately, it seems, more companies are moving away from word and combination marks, emphasising universal sign marks, uncluttered with verbal matter. The reasons for this branding trend are fairly intuitive. As previously noted, the brain processes symbols more quickly than words; symbols are a universal language crossing cultural and linguistic borders; and even non-readers can “read” them. There is also the psychological power of symbols. An MIT study found that “separate visual symbols used as logos tend to be more effective than brand names at creating a sense of emotional connection with consumers. ... However, despite the commonly understood benefits of symbols versus text, surprisingly few companies take advantage of separate visual symbols. Logos with separate visual symbols thus represent a largely untapped opportunity in reaching out to consumers” (C Whan Park, Andreas B Eisingerich and Gratiana Pol, *The Power of a Good Logo*, MIT Sloan Management Review, October 22 2013).

Universal sign marks work exceptionally well in certain contexts. A driver racing down a highway can process the sign mark on the left as quickly as the highway sign on the right (figure 3).

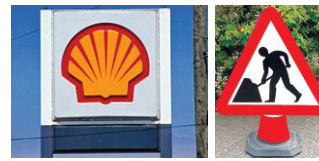


Figure 3: Highway signs

For the same reason, universal sign marks work well for brick and mortar storefronts dedicated to the branded merchandise, like the examples from the streets of New York (figure 4).



Figure 4: Store signs

And sign marks are critical for handheld mobile devices, with their limited screen real estate. Imagine how cluttered the screen of a smartphone would look if had we not adopted the convention of using symbols as app icons (figure 5).

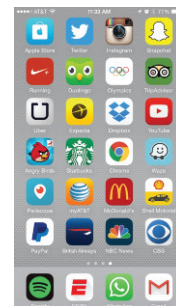


Figure 5: App icons

Choosing a strong universal sign mark to identify a global brand can make a lot of sense to marketers, but can they get it by their trade mark lawyers?

Legal issues

From the legal perspective, the biggest risk of shifting to a universal sign mark, at least theoretically, is the risk of losing the word mark. In the United States, trade mark rights arise from use, and if you stop using a mark, you may be deemed to have abandoned it. In other words, a brand owner who jettisons its word mark in favour of a purely visual mark could conceivably lose its word mark. As a practical matter, the brand owner can eliminate that risk by continuing to make some use of its word mark. And there are some legal theories that could be pressed into service to prevent third party registration and use of a word mark that has been supplanted by a universal sign mark, and also to protect the popular name for the sign mark itself.

There are some legal theories that could be pressed into service to prevent third party registration and use of a word mark that has been supplanted by a universal sign mark

The doctrine of legal equivalents provides that, for purposes of analysing likelihood of confusion under US trade mark law, a visual representation of a thing may be deemed equivalent to the words generally used to describe that thing. The current USPTO Trademark Manual of Examining Procedure (TMEP) describes the doctrine in Section 1207.01(c)(i), saying that a design mark may be found to be confusingly similar to a word mark consisting of the design's literal equivalent. The rationale is that "a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers". The doctrine has contributed to the USPTO's refusal to register an image of a jockey riding a horse due to the earlier registered word mark Jockey, an image of a squirrel due to the earlier registered word mark Squirrel Brand, and an image of a seagull due to the earlier registered word mark Seagull.

The federal courts, too, recognise the doctrine of legal equivalents. The most famous case is *Mobil Oil Corp v Pegasus Petroleum Corp*, 818 F2d 254 (2nd Cir 1987), in which the Second Circuit held that defendant Pegasus Petroleum's use of the word mark Pegasus constituted unfair competition and trade mark infringement of Mobil's flying horse design mark, even though Pegasus Petroleum never used an image of a flying horse. The Second Circuit Court of Appeals endorsed the district court's factual finding of similarity: "[W]e find that the similarity of the mark exists in the strong probability that prospective purchasers of defendant's product will equate or translate Mobil's symbol for 'Pegasus' and vice versa. We find that the word 'Pegasus' evokes the symbol of the flying red horse and that the flying horse is associated in the mind with Mobil. In other words, the symbol of the flying horse and its name 'Pegasus' are synonymous."

In an earlier decision, *Beer Nuts, Inc v King Nut Co*, 477 F2d 326 (6th Cir 1973), the Court of Appeals for the Sixth Circuit affirmed a district court finding that use of a design of an overflowing beer stein on a bag of nuts infringed the registered word mark Beer Nuts owned by a rival supplier of nuts in the tavern trade.

In these examples, the US courts and trade mark office equated visual symbols with the words normally used to describe those symbols, effectively permitting the trade mark holder to protect both the image and word despite its use of only one.

Yet the scope of the legal equivalents doctrine depends on consumer perception (or at least judicial perception of consumer perception). For example, a federal court held that a silhouette of a moose was not equivalent to Moose Creek, because the latter evokes a place and not an animal. The Trademark Trial and Appeal Board (TTAB) of the USPTO has similarly rejected claims that an image of what could have been perceived as a ram's

head was confusingly similar to the word mark Ram's Head (because consumers could just as easily think of the term "sheep" or "mountain goat") and that an image of what could have been perceived as an old mill was confusingly similar to the word mark Old Mill (because consumers could just as easily think of the term "old farmhouse" or other farm country building).

So the doctrine of legal equivalents provides solid ground to protect a pictogram design mark against use or registration of the equivalent brand name or, in the case of Pegasus, the symbol's name. But what about ideograms and abstract symbols, which are not pictorial representations of a word adopted as a brand name? We believe that an extension of the doctrine would be warranted in certain situations where the ideogram or abstract symbol has achieved a high level of public recognition as a source identifier. For example, consumers seeing the famous Starbucks sign mark probably do not just translate the image as "siren" or "mermaid". A significant percentage of consumers immediately translate the image into the brand name "Starbucks".

On such facts, a brand owner could seek to invoke a "doctrine of visual equivalents" analogous to the doctrine of foreign equivalents under US law. Under the doctrine of foreign equivalents, if it is likely that the ordinary person would translate a foreign word into its English equivalent, the foreign word may be held to be confusingly similar to its English equivalent; for example, Buenos Días was held to be confusingly similar to Good Morning. The word mark Buenos Días looks and sounds nothing like Good Morning, but an appreciable segment of American consumers understands them to be the same anyway. By the same token, if the ordinary person would translate a visual image as the brand name (even if the image is not a pictogram), then the symbol could be held to be the visual equivalent of the brand name. Instead of translating from a foreign language, the consumer would be translating from the universal language of symbols.

Notably, in the United States, a brand owner may not need to use or register the name by which its design mark is popularly known in order to protect it. There is a line of US cases holding that if the public abbreviates your mark, or gives you a nickname – like Coke for Coca-Cola, or Big Blue for IBM – that abbreviation or nickname may be protected as a trade mark, even if you don't use or promote it yourself. Accordingly, if a brand uses a purely visual mark that gains a nickname in common public use, the public use of that nickname could be enough to constitute trade mark use. For example, Starbucks calls its mark a "siren" but others may call it a "green mermaid". Based upon the *Pegasus* case, Starbucks might be able to prevent use and registration of the word mark Green Mermaid for coffee, even though it owns no registration for that mark. Here, the argument would be that the public perceives the verbal nickname for the sign mark and the sign mark as equivalents identifying the same source of origin, so the use of the nickname is likely to create consumer confusion in violation of federal and state unfair competition law.

Best practices

For brand owners gravitating toward universal sign marks, here are some guidelines and best practices to consider and tailor to your circumstances.

1. Choose a unique symbol with character

The USPTO routinely rejects applications for design marks on the ground that the design is generic or merely descriptive. This frequently occurs where the mark is a commonly used symbol such as an awareness ribbon or recycling symbol. So make sure the symbol you choose is unique and striking, and consumers will immediately recognise it as a symbol identifying your brand and none other.

2. Avoid “The artist formerly known as Prince” problem

The artist formerly known as Prince is now known as Prince again. But for a period of time no one knew what to call him, or, for that matter, what to call the symbol he adopted in lieu of a name (figure 6).



Figure 6: The glyph

(Ultimately, the consensus was a “glyph”.) So here is a simple way to enhance the source identification function of your symbol: give it a distinctive name. The Michelin Man. The Golden Arches. The Nike Swoosh.

The Swoosh is a particularly good example. Nike owns incontestable US word mark registrations for the standard character mark Swoosh for footwear and clothing (numbers 1,200,529 and 2,164,810) as part of a robust portfolio of registrations for the  symbol alone and in combination with verbal matter. According to the dictionary, “swoosh” is a verb meaning to move with or make a rustling, swirling, or brushing sound, and a noun meaning that sound or movement. On the *Abercrombie* spectrum, the word “swoosh” would most likely be deemed arbitrary as applied to the stylised check mark that appears on Nike’s footwear and clothing. Over time, this verbal designation of the Nike symbol has probably become as well known, if not better known, than the dictionary definition. For a significant percentage of the population, the term Swoosh, like the symbol , has become synonymous with Nike.

3. Register (and maintain) the symbol as a separate mark

A registration for a symbol alone will provide broader protection than a combination mark registration incorporating both the symbol and wording. Just as a standard character word mark registration provides the broadest possible protection for that term in any presentation, a design mark registration for the symbol without added verbal matter provides the broadest possible protection for the symbol.

When a word is incorporated into a design presentation, both the word and the design are elements of the combination mark and a junior user’s mark employing just one of those elements might not be deemed confusingly similar to the combination mark. Accordingly, to maximise enforcement potential, you should use and register the word and design elements of a combination mark as separate standalone marks where possible.

4. Prioritize registration of a black and white version of the sign mark

Register your symbol in black and white to enhance your ability to enforce it against any colour combination. In the United States, the broadest trade mark protection comes from registering a design mark in black and white, as the claim of a colour is limiting. As a result, even if the mark is typically presented in a specific colour (Starbucks’ green siren, or Target’s red target, for example), it is wise to register a black and white version. From an enforcement perspective, it can also be beneficial to have a design mark with a colour claim registered as well, because it may provide a stronger basis for challenging a later third-party design that is arguably less graphically similar but has the same colour scheme.

5. Registering a combined word and design mark is sometimes appropriate

Of course, incorporating a word and symbol into a combination mark has its benefits. Combining words and symbols can help brand owners build consumer association between a word and a design that in time can allow the owner to migrate from the combination mark to a universal sign mark. This approach may work particularly well for ideograms and abstract symbols, and in jurisdictions where the foreign language description of a pictogram is not the same as the associated word mark. In this way, after the connection between the brand name and the design is established through extensive use, a consumer might see a  and immediately call the word Nike to mind, even when the term is nowhere in sight. At that point, separate registrations would clearly be warranted.

6. Continue to use the word mark

Trade mark lawyers typically advise: use it, and continue using it, or risk losing it. Subject to limited exceptions, US trade mark rights inure and are maintained through bona fide use of the mark in the ordinary course of trade. If you identify your goods and services with your universal sign mark alone, you may put your word mark at risk.

While we heartily endorse a doctrine of equivalents for universal sign marks and the names by which they are known by the general public, US courts have not yet recognised such a doctrine for marks other than pictograms of the brand name. Accordingly, it is advisable not to phase out use of the word mark entirely, but to continue to use it at least to the extent necessary to maintain your rights under applicable law.

Universal sign marks are the purest example of trade marks that traverse national boundaries and promote universal understanding of the brands they represent

7. Beware of material alterations of the sign mark

For marketing purposes, trade mark owners sometimes refresh their marks after a particular look becomes dated. US law makes some limited allowances for this through the concept of tacking. Tacking allows a trade mark owner to modernise and update its mark over time and maintain the priority of the original mark, provided that the new mark retains the same commercial impression as the old mark and does not materially differ from it. This concept applies equally to word and design marks.

In one extreme example, *Dreyfus Fund, Inc v Royal Bank of Canada*, 213 USPQ 872 (SDNY 1981), an influential district court permitted tacking where the owner changed its design mark from an image of a realistic lion to a stylised lion (see figure 7).



Figure 7: The Dreyfus Fund case: Tacking

Early in 2015, the US Supreme Court resolved a split in US case law by ruling that tacking is an issue of fact, not an issue of law, in *Hana Financial, Inc v Hana Bank*, 135 S Ct 907, 574 US ____ (2015). Accordingly, after many years of uncertainty, tacking is a question to be decided by the fact-finder. As a result, there is probably just as much unpredictability now, particularly in jury cases, where lay people will decide whether the new mark conveys the same impression as the old. The takeaway is that you should proceed with caution when refreshing your marks to reduce the risk of losing advantageous priority dates based upon use or registration of earlier versions.

8. Secure the copyright

Certain symbols (such as the Penguin books logo) meeting the minimum originality standard qualify for copyright protection under US law. Copyright law can provide another avenue for enforcement for graphic symbols that is broader than trade mark protection in some respects. For example, there is no use requirement to obtain and maintain a copyright, copyright protection is not limited to any particular goods or services in connection with which the work is used, and a copyright may be protected across borders in all Berne Convention countries

without an onerous filing programme. However, there is a potential risk that the creator of a copyrightable sign mark could prevent the brand owner from making new uses of that mark after a period of time under the termination provisions of the US Copyright Act.

The copyright rights in a work vest automatically in the author upon fixation in any tangible medium of expression. Individual authors have a statutory right to terminate any copyright assignment or licence after a set period of time (typically 35 years). After termination, the transferee can continue to use derivative works based on the copyrighted work under the terms of the original transfer but cannot create new derivative works. The termination provisions do not apply to “works made for hire”, as to which the employer or commissioning party is considered the author.

Accordingly, explore whether any sign mark you commission from an independent contractor in the United States may qualify for copyright protection and, if so, whether the work is eligible for work for hire status. If it is, endeavour to secure a work for hire agreement with the independent contractor, with a written assignment as a fallback.

Our visual lingua franca

Numerous brands are gravitating toward universal sign marks as their primary marks. This can be an extremely effective global branding strategy for the right symbol, presented in the right context, with the right support. Paul Rand, the American graphic designer who created the iconic UPS, IBM and Westinghouse corporate logos among many others, observed half a century ago:

In commerce the trademark is a language understood by all. It can traverse national boundaries and is as intelligible to an American as it is to a Japanese. In its small way, the trademark demonstrates the possibilities not only of a universal language but, more important, of universal understanding.

Universal sign marks are the purest example of trade marks that traverse national boundaries and promote universal understanding of the brands they represent. Along with non-commercial universal signs like peace, stop and no smoking signs, these commercial signs without words form the core of our growing visual lingua franca. We predict we will be seeing many more universal sign marks. They are the quintessential signs of our times.



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