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## U.S. and EU Trademark Protection

A United States trademark allows a company to distinguish its goods and services in the U.S. market. But in order to distinguish goods and services in the European Union (EU), a company must obtain separate EU trademark protection. The fact that a company has successfully acquired a trademark in the U.S. does not guarantee that it will also receive a trademark in the EU. Indeed, there are dramatic differences between what can be trademarked in the United States and the EU.

In the U.S., any mark that identifies the source of a product and distinguishes the product from other goods can receive a trademark. This determination is left largely to the subjective discretion of individual trademark examiners and judges. Over time, judges have found that a wide variety of marks can receive U.S. trademark protection, including slogans, shapes, sounds, colors, and even smells.

In the EU, however, trademark law is not as broad. The EU has adopted minimum standards for trademarks that are applicable in every EU nation. These standards do not allow for the type of subjective evaluations that have facilitated the expansion of U.S. trademark law. Indeed, some marks that are eligible for protection in the U.S.—such as smells—are not covered by EU standards. Moreover, each EU nation also has its own national trademark laws which, particularly in countries that use “civil law” judicial systems, can further restrict the scope of trademark protection.

This note examines in detail the reach of trademark law in the United States as compared to the EU. The note concludes that the differences in trademark protection in the U.S. and the EU are important factors for a U.S. company to consider when deciding whether to expend time and resources pursuing EU trademark protection.

### U.S. Trademark Law

#### *Trademark Law in the United States is Flexible and Broad*

The United States is a common law country. U.S. laws are interpreted by judges and judicial decisions become binding precedent. This process of judge-made law allows great flexibility and discretion.<sup>1</sup> A judge confronting a particular set of facts and equities can determine that protection is warranted even if it is not explicitly set forth in a statute.<sup>2</sup> Trademark law reflects this principle.

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The U.S. trademark statute states that “any word, name, symbol, or device,” may receive trademark protection. The mark must simply be used to identify the source of goods and distinguish those goods from goods sold by others.<sup>3</sup> An applicant in the U.S. can also receive protection for a mark that identifies and distinguishes services (rather than goods). For example, the “McDonalds” mark refers to food services. Such marks are referred to as “service marks,” and receive the same protection as trademarks.<sup>4</sup>

The determination of what trade and service marks sufficiently “identify” and “distinguish” goods is often left to the subjective determination of judges and trademark examiners. Under U.S. law, marks that are merely “descriptive” of a product cannot receive trademark protection.<sup>5</sup> For instance, an apple-seller cannot obtain a trademark on the name “Tasty.”<sup>6</sup> However, U.S. law also states that if an applicant can prove to a trademark examiner or judge that a descriptive mark has become distinctive of the applicant’s particular product—referred to as obtaining “secondary meaning”—the mark *is* eligible for protection.<sup>7</sup> For example, the “All Bran” breakfast cereal mark began as merely descriptive of a product that included bran. Over time, however, customers associated the mark with a particular brand.<sup>8</sup> “All Bran” is now a protected trademark. Whether a descriptive mark has become distinctive is a fact-specific analysis that hinges on the subjective determination of a judge or examiner.

Similarly, under U.S. law, judges are responsible for determining whether a trademark that has issued should be canceled because it has become “generic.”<sup>9</sup> Xerox is the most common example. After Xerox became popular, the public began to use the term “xerox” as a verb or a noun to refer generally to photocopying, rather than to particular products and services offered by Xerox. It was common to ask for “a xerox” of a document, or to ask someone “to xerox” a document. In an effort to avoid the loss of trademark protection, Xerox has launched a public relations campaign to encourage the public to use the term “Xerox” only as an adjective, as in: “Make me a photocopy using that Xerox copier.”<sup>10</sup>

### *Types of Marks that Can Be Protected in the U.S.*

Under the flexible, judge-made standards of U.S. trademark law, a wide variety of marks can receive trademark protection, including:

- *Slogans*, such as “The Skin You Love to Feel.”<sup>11</sup>
- *Symbols*, such as the Nike Swoosh.<sup>12</sup>
- *Alphanumeric phone numbers*, such as “1-800-MATTRES.”<sup>13</sup>
- *Shapes*, such as the Coca-Cola bottle.<sup>14</sup>

The U.S. has also extended trademark protection to the following types of unconventional marks:

**Colors:** In *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995), the United States Supreme Court found that a color can be trademarked. The Court explained that just like a slogan, a color can distinguish goods and identify their source.<sup>15</sup> The Court extended trademark protection to the green-gold color of a press pad.<sup>16</sup>

**Sounds:** As long as the applicant submits a sufficient description of the sound, a distinctive sound can receive trademark protection.<sup>17</sup> For example, the sound of the roar of the MGM lion has been trademarked.<sup>18</sup> NBC’s three-chimes is also protected.<sup>19</sup> Even the sound of Tarzan’s yell has been trademarked.<sup>20</sup>

*Smells*: Applicants have received U.S. trademarks on distinctive smells applied to products. For example, in *In re Clark*, the Patent and Trademark Office's Trademark Trial and Appeal Board allowed a trademark on a fresh floral scent applied to yarn.<sup>21</sup>

Even *tastes* can be trademarked.<sup>22</sup>

In short, because the U.S. allows judges to expand the scope of trademark protection, U.S. trademark law has been extended to cover a wide variety of marks.<sup>23</sup>

## EU Trademark Law

### *Trademark Law in the EU Is Narrow*

Trademark law in the EU is much less flexible than U.S. law. Two overarching factors drive this difference. First, the EU sets minimum standards that govern EU trademark law and do not leave room for subjective interpretation.<sup>24</sup> While the application of U.S. trademark principles varies according to the judge assigned to a particular case, the EU's minimum standards are purposively designed to apply uniformly across the EU irrespective of discretionary tastes or perceptions.<sup>25</sup> Second, some EU countries are "civil law" nations; their national laws are set forth in statutes and judges are not given discretion to extend the law. This further curtails the expansion of trademark protection.

### *EU Minimum Standards Lead to Strict Trademark Laws*

One function of the EU is to establish minimum protections and standards that all member nations must observe.<sup>26</sup> While the EU has failed to establish minimum standards in some areas of intellectual property (for instance, with respect to most substantive aspects of patent protection), it has successfully developed standards for trademarks. Through the "First Council Directive" of 1988 and the "Regulation on the Community Trademark" of 1993, the EU enacted trademark standards that must be incorporated into the national laws of every EU nation.<sup>27</sup> Thus, while individual nations in the EU still have different trademark laws and can issue their own trademarks, the EU's minimum standards must be observed throughout the EU. The EU has also established its own "community trademark," which is enforceable throughout the EU and is administered through a central EU processing office.<sup>28</sup>

To ensure consistent and objective application, the EU's minimum standards set forth inflexible criteria. Under the EU standards, an applicant seeking a trademark must demonstrate that its mark: (i) shows that goods or services bearing the mark originate from a single source; and (ii) is capable of being "represented graphically."<sup>29</sup> As is the case in the U.S., "service marks" can also be protected in the EU.<sup>30</sup>

The EU trademark requirements differ from U.S. law in several key respects. In particular, the EU's graphic representation requirement sets forth an objective requirement (not present in U.S. law) that does not leave room for subjective evaluations. Simply put, if a mark cannot be depicted graphically, it is not eligible for trademark protection in the EU. The result is that certain types of marks that can be protected in the U.S. are not eligible in the EU, including:

*Smells*: While there is no explicit EU agreement on smell, as a practical matter a smell cannot be represented graphically. Consider the floral scent on a ball of yarn that was granted a trademark in

the U.S. A floral scent cannot be represented visually.<sup>31</sup> This was recently confirmed by a case decided by the EU court—The Court of Justice of the European Communities (“ECJ”). In *Sieckmann v. Deutsches Patent-und Markenamt*, the ECJ found that none of a chemical formula, written description, scent sample, or combination thereof satisfy the graphic representation requirement.<sup>32</sup>

**Sounds:** Sound marks are permitted in the EU, but not through written descriptions, as is allowed in the U.S.<sup>33</sup> A written description of a sound is too subjective and imprecise to satisfy the objective criteria of the EU. The EU therefore allows sound marks only if the applicant submits a musical notation describing the sound. This way, different notations can be compared to determine distinctiveness.

**Colors:** Similarly, with respect to color marks, a simple written description is not sufficient. Instead, an applicant in the EU must submit a sample of the color and designate the color according to internationally adopted color identification codes. Again, this ensures objective evaluations concerning the distinctiveness of the mark.<sup>34</sup>

**Case study: United Kingdom** Trademark law in the U.K. demonstrates the narrow approach to trademark protection proscribed by the EU. If left to its own devices, the U.K. would likely gravitate towards the broad U.S. approach to trademark protection. Indeed, there are many similarities between the trademark laws of the two nations:

- Like the U.S., the U.K. is a common law system that allows judges to make discretionary determinations.
- Like U.S. law, U.K. law allows an applicant who submits a descriptive mark to gain protection by proving to an examiner or judge that the mark has acquired “secondary meaning.”<sup>35</sup>
- Like U.S. law, U.K. law provides that if a registered mark becomes generic, it can be canceled.<sup>36</sup>

Therefore, just like the U.S., the U.K. has historically protected non-conventional marks. For example, the U.K. has granted a trademark to the sound of dog barking.<sup>37</sup> The U.K. has also granted trademark protection to smells. Judges in the U.K. reasoned that if a smell is described with sufficient particularity, it should be protected. For example, a floral smell used on car tires was granted trademark protection in the U.K.<sup>38</sup>

However, as a member of the EU, the U.K. has had to modify its approach to trademark protection to conform to the EU’s minimum standards. In 1994, the U.K. amended its laws to require that a trademark not only distinguish goods and services, but also be capable of graphic representation.<sup>39</sup> Since this modification, U.K. courts have taken a more narrow approach to trademark protection. For instance, since the ECJ’s decision in *Sieckmann*, U.K. courts have not granted trademark protection to smells. Previously-approved marks protecting smells may also be challenged and found invalid under the EU’s standards. In light of the EU’s requirements, U.K. courts have also not extended protection to other non-conventional marks, such as tastes. Some commentators believe that U.K. courts will even begin to change their approach to sound marks following a 2003 ECJ opinion finding that sound marks have to include not only musical notations, but also a representation of the sound on a stage with identified timings.<sup>40</sup> In short, the more the U.K. aligns its trademark laws with the EU’s minimum standards, the more narrow U.K. trademark protection becomes.

### *The Civil Law Systems of Many EU Countries Lead to Inflexible Trademark Laws*

The second reason for the EU's more narrow approach to trademarks is that many EU countries are civil law nations. In these countries, laws are made by statute, not by judicial decisions.<sup>41</sup> This approach curtails subjective determinations and prevents the expansion of trademark protection to new and unconventional types of marks.

**Common v. Civil Law Systems** In common law nations, abstract rules come from judicial decisions. Thus, in the U.S., "trademark law" evolves as judges hear new cases and make new rulings. In civil law nations, however, rules guide judicial decisions. Judges in civil law systems, therefore, do not interpret the law; they merely apply it.<sup>42</sup> For instance, while a judicial decision in the U.S. can be tens of pages long and include detailed explanations of the facts, the law, and the application of the law to the facts, in civil law nations, judicial rulings can be just a paragraph long. The rulings simply state that pursuant to a particular provision of statutory code, the court has reached a decision.<sup>43</sup> Like the minimum standards established by the EU, civil law systems therefore emphasize objective standards that are applied consistently regardless of the judge that happens to hear a particular case. Civil law judges, unlike their U.S. counterparts, cannot unilaterally stretch the reach of trademark protection.

**Case study: France** French law exemplifies the approach to trademark protection of a civil law nation within the EU. France's trademark laws aim to set forth concrete standards that can be applied objectively and do not leave room for judicial discretion.

Article L711-1 of the French Civil Code provides that a trademark must distinguish the marked goods or services and must be capable of graphic representation.<sup>44</sup> The French Code does not allow for subjective determinations. For example, there is no notion of "secondary meaning" in French trademark law.<sup>45</sup> If a mark is descriptive, there is no further inquiry. In other words, there is no opportunity under French law to convince a judge that while the "All Bran" mark initially was merely descriptive, it slowly became distinctive. Similarly, if a mark is properly registered under French law, it cannot be canceled if it becomes "generic."<sup>46</sup> French trademark law operates in absolutes—once a mark is protected, the analysis is complete. Further, as is the case in all EU nations, the requirement that marks be capable of graphic representation further curtails the ability of applicants to obtain protection over certain types of marks.<sup>47</sup> For example, smells cannot be registered as trademarks in France.<sup>48</sup> Other unconventional marks, such as tastes, are also outside the protection of French law.

## Conclusion

Before spending time and money attempting to extend a U.S. trademark into the EU, a company should consider the differences between U.S. and EU trademark law. In the U.S., trademark law is flexible and subjective. Sounds, smells, and even tastes are eligible for trademark protection. In the EU, however, objective standards that require trademarks to be capable of graphic representation restrict the type of marks that can be protected. A company with a U.S. trademark on a smell, for instance, will have difficulty obtaining protection in the EU. Moreover, a company seeking EU trademark protection must contend with the national trademark laws of individual EU nations. In some EU countries, civil law systems further prevent the extension of trademark protection to non-conventional marks. Whether it makes business sense to pursue a trademark in the EU therefore depends on the type of mark at issue and the country in which a company seeks protection.

## Endnotes

<sup>1</sup> See *Funk v. U.S.*, 290 U.S. 376, 383 (1933) (“the common law is not immutable but flexible, and by its own principles adapts itself to varying conditions”).

<sup>2</sup> Suzanne B. Goldberg, “Constitutional Tipping Points: Civil Rights, Social change and Fact-Based Adjudication,” *Columbia Law Review* (December 2006) (noting that courts use common law principles to change and advance U.S. law); Melissa A. Waters, “Creeping Monism: The Judicial Trend Toward Interpretive Incorporation of Human Rights Treaties,” *Columbia Law Review* (April 2007) (courts in U.S. ensure that the common law remains flexible).

<sup>3</sup> See 15 U.S.C. § 1127 (mark must be used “to identify and distinguish...goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”).

<sup>4</sup> See 15 U.S.C. § 1053.

<sup>5</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>6</sup> See *Custom Vehicles, Inc. v. Forest Rivers, Inc.*, 476 F.3d 481, 483 (7th Cir. 2007).

<sup>7</sup> Ethan Horwitz, *World Trademark Law and Practice*, Vol. 5, “United States” § 2.03 (2nd ed. 2007).

<sup>8</sup> See *Custom Vehicles*, 476 F.3d at 483.

<sup>9</sup> Horwitz, at § 3.02.

<sup>10</sup> See, e.g., *Union Nat. Bank of Texas, Laredo, Texas v. Union Nat. Bank of Texas, Austin, Texas*, 909 F.2d 839, 845 FN 15 (5th Cir. 1990)

<sup>11</sup> See *Houbigant, Inc. v. Federal Ins. Co.*, 374 F.3d 192, 198 (3rd Cir. 2004).

<sup>12</sup> See *id.*

<sup>13</sup> See *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 678 (2nd Cir. 1989).

<sup>14</sup> See *Texas Tech. Univ. v. Spigelberg*, 461 F.Supp.2d 510, 518 (N.D. Tex. 2006).

<sup>15</sup> See 514 U.S. at 165-66.

<sup>16</sup> See *id.* at 166.

<sup>17</sup> Melissa E. Roth, “Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Non Traditional Trademark Registrations,” *Cardozo Law Review* (Oct. 2005).

<sup>18</sup> Kevin K. McCormick, “‘Ding’ You Are Now Free to Register That Sound,” *The Trademark Reporter* (Sept-Oct. 2006).

<sup>19</sup> *Id.*

<sup>20</sup> See Roth.

<sup>21</sup> See 17 U.S.P.Q. 1238 (Trademark Tr. & App. Bd. 1990).

<sup>22</sup> See Patent and Trademark Office Trademark Manual of Examining Procedure, § 1202.13 (2007).

<sup>23</sup> See *In re Paramount Pictures Corp.*, 213 U.S.P.Q. 1111, 1113 (Trademark Tr. & App. Bd. 1982) (U.S. trademark law is “very liberal – perhaps the most liberal in the world”).

<sup>24</sup> See McCormick.

<sup>25</sup> See Roth.

<sup>26</sup> See Jerry Cohen, "The Ws of Intellectual Property Practice – Who, What, When, Where, Why and Web," *Rhode Island Bar Journal* (May/June 2002).

<sup>27</sup> Nick Pisarsky, "Potayto-Potahto – Let's Call the Whole Thing Off: Trademark Protection of Product Sounds," *Connecticut Law Review* (Feb. 2008).

<sup>28</sup> The E.U.'s central trademark processing office is the "Office for Harmonization in the Internal Market"; see also, Sebastian Eurand, "Trademark Law in the European Union: An Overview of the Case Law of the Court of Justice and Court of First Instance," *Columbia Journal of European Law* (Fall 2002).

<sup>29</sup> See Eurand.

<sup>30</sup> Leslie Williams, "Current Legal Developments in the European Union," *Whittier Law Review* (Winter 1997).

<sup>31</sup> See Eurand.

<sup>32</sup> Sieckmann v. Deutsches Patent-und Markenamt, ECJ Case No. C-273/00.

<sup>33</sup> See Roth.

<sup>34</sup> *Id.*

<sup>35</sup> Horwitz, Vol. 5, "United Kingdom" at § 2.03.

<sup>36</sup> *Id.* at § 3.02.

<sup>37</sup> *Id.* at § 3.01.

<sup>38</sup> Anne Hiaring, "An International Perspective on Trade Dress Protection," *Practising Law Institute* (Oct.-Nov. 1998).

<sup>39</sup> Anne-Laure Covin, *Trademarks Throughout the World*, 5<sup>th</sup> Ed. at § 170.4 (2008).

<sup>40</sup> Seiko Hidaka et al., "A Sign of the Times? A Review of Key Trademark Decisions of the European Union Court of Justice and Their Impact Upon National Trade Mark Jurisprudence in the EU," *The Trademark Reporter* (Sept.-Oct. 2004).

<sup>41</sup> *Id.*

<sup>42</sup> Mary Angell, "What a System!" *Wyoming Lawyer* (February 1998).

<sup>43</sup> John Henry Merryman, *The Civil Law Tradition*, at Ch. 16 (2nd ed. 1985) (explaining that common law judges have far more discretion to apply subjective analysis than do civil law judges).

<sup>44</sup> Covin, at § 58.4.

<sup>45</sup> Horwitz, Vol. 2, "France" at § 2.02-04.

<sup>46</sup> *Id.* at § 3.02.

<sup>47</sup> See Hiaring.

<sup>48</sup> Horwitz, Vol. 2, "France" at § 3.01.