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Non-traditional trademark protection in the digital age

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Trademarks traditionally are logos or words that identify the source of a brand, good or service. Trademark and trade dress protection, however, can also extend to sounds, scents, flavors, colors, textures and the appearance of a product.

Examples of sound trademark registrations include ESPN's "DaDa-Da-DaDaDa," (Reg. No. 2,450,525), Netflix's "Da Dum" sound (Reg. No. 5,194,272), and even the sound of Darth Vader's breathing (Reg. No. 3,618,322, described as "the sound of rhythmic mechanical human breathing created by breathing through a scuba tank regulator.") Other non-traditional registrations include the canary yellow color of Post-it notes (Reg. No. 2,390,667), and the shape of the Hershey chocolate bar (Reg. No. 4,322,502). In rare cases, scents are registerable, such as the scent of Play-Doh (Reg. No. 5,467,089, described as "a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough.")

In the digital age, trademark and trade dress protection can protect the visual elements of videogames and the design or "look and feel" of an app on a smartphone or website. While copyright law might also provide protection, these non-traditional forms of trademark and trade dress protection may offer broader protection.

Traditional trademark registrations protect the names of well-known video game brands such as ATARI and KONAMI. Non-traditional trademark and trade dress protection, however, may extend to individual elements of a video game, when the owner can show that consumers identify those video game elements to a particular source (secondary meaning), and where those elements are not functional, meaning they are not essential to the use or purpose of the product, and do not affect the cost or quality of the product.

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One example is the well-known "Tetris" video game, which was found to have protectable trade dress in "the brightly-colored Tetriminos, which are formed by four equally-sized, delineated blocks, and the long vertical rectangle playfield, which is higher than wide." T*etris Holding, LLC v. Xio Interactive, Inc.*, 863 F. Supp. 2d 394, 415 (D.N.J. 2012). The color and style of the "Tetris" pieces and the game board were found not functional because they were not mandated by the use or purpose of the game, and because there were numerous other choices available that would work equally well and would not affect the cost or quality of the game.

Recently, in December 2018, Atari brought suit against retailer Target in the Central District of California for trade dress infringement for the design of the "Pong" video game, first released in 1972. The "Pong" trade dress includes: the rectangular playing field, the vertical "paddles," the small ball that can be volleyed, and the scoreboard. Atari alleges infringement based on Target's "Foot Pong" game, which projects a playing field onto the floor rather than through a television or mobile device screen.

Claims of trade dress infringement in the digital age can also extend to assertions that a video game designer improperly used the third party's trade dress as elements in their own original game. For example, modern video games often incorporate an open-world digital 3D environment. Such games may be based on real-life locations, such as Rockstar Games' "Grand Theft Auto: San Andreas," in which artists worked off of photographs of real-world Los Angeles locations, including the Play Pen club. In a well-publicized case, the Play Pen club sued Rockstar for trademark and trade dress infringement based on a club in the game called the "Pig Pen." Ultimately, the 9th U.S. Circuit Court of Appeals held that the use in the game was not explicitly misleading and was protected speech under the First Amendment.

Trademark and trade dress protection can also extend to the layout of a website (e.g., *Ingrid & Isabel, LLC v. Baby Be Mine, LLC*, 70 F. Supp. 3d 1105 (N.D. Cal. 2014) (the "look and feel" of a website featuring maternity waist bands can constitute protectable trade dress)), and to the visual design of a mobile app (e.g., *Diamond Foods, Inc. v. Hottrix, LLC*, 14-CV-03162-BLF (N.D. Cal. July 18, 2016) (mobile app depicting popcorn popping can be protected under trade dress law)).

Finally, the appearance of a tablet or smartphone app icon can potentially be protected. Examples include the stylized icon for the "Candy Crush" game app (Reg. No. 4,527,880), stylized icons for social media apps (Reg. Nos. 5,700,266 and 5,577,439) and a stylized icon for a blood pressure monitoring app (Reg. No. 5,150,023). Apple has received several registrations for app icons displayed on iPhone and iPad devices, and on its Apple desktop and laptop computers, including the Apple music app (Reg. Nos. 4,521,983 and 5,021,538), Apple finder icon (Reg. No. 5,023,285), and the Apple watch app (Reg. No. 4,955,490).

Such protection is open to challenge. In the well-known *Apple v. Samsung* case, Apple asserted a registration to the trade dress of a rectangular configuration of a smartphone with rounded corners having a depicted array of 16 apps (Reg. No. 3,470,983). *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 786 F.3d 983 (Fed. Cir. 2015), rev'd and remanded on other grounds, 137 S. Ct. 429 (2016). Applying 9th Circuit law, the Federal Circuit overturned the jury's verdict of infringement and dilution of the registered trade dress and held that the registration was invalid as functional. The Federal Circuit described how the icons were visual shorthand for the functionality provided by the apps (such as a maps app icon depicting roads, a pin, and a road sign), and that Apple failed to show how other design possibilities offered exactly the same features as the registered trade dress.

Companies are more often considering including non-traditional trademarks in their trademark portfolios, which can provide the ability to exclude competitors from using confusingly similar designs (or smells), the ability to further differentiate a product or brand, and increased notoriety. This must be weighed against the costs involved in seeking protection, and that it is often difficult to obtain protection for certain designs.

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