

### Identifying Information

Name:	Ramsey, Lisa
School:	University of San Diego School of Law

### Paper Information

Title:	Protectable Trademark Subject Matter in Common Law Countries and the Problem with Flexibility
Abstract:	<p>Distinctive words, names, and logos used as trademarks can provide consumers with useful information about a product's source or qualities. Examples include BILLABONG for clothing, TIM HORTONS for restaurant services, WHITTAKER'S for chocolate, SINGAPORE AIRLINES for airline travel services, and Starbuck's mermaid logo for coffee. Product packaging, product features, and other types of "trade dress" of goods and services can also be registered and protected as a trademark when they function as a source-identifying mark and meet the other requirements in the trademark law. This includes the three-dimensional shape of packaging or products, and other "non-traditional" marks that are non-verbal or non-visual such as colors, sounds, scents, flavors, textures, and the exterior or interior design of a store. Examples include a skull-shaped glass bottle for alcoholic beverages sold under the brand name Crystal Head Vodka, LEGO's Minifigure shape for toy figures; the color pink for Owens-Corning's fibrous glass residential insulation; the sound of a lighter opening, igniting, and closing for Zippo's lighters used by smokers; the scent of Play-Doh for Hasbro's toy modeling compound; the texture of leather wrapping around bottles of wine sold by the David Family Group; and the design of Apple's retail store for various electronics. This Chapter evaluates how the common law countries of Australia, Canada, New Zealand, Singapore, and the United States determine what subject matter or "signs" are eligible for trademark registration and protection. One important feature of the trademark laws in these jurisdictions is the flexibility in what types of signs can qualify as a trademark. The broadness of the definitions may be due in part to international obligations in treaties and trade agreements regulating trademarks. For example, Article 15(1) of the Trade-Related Aspects of Intellectual Property (TRIPS) Agreement provides that any sign can qualify as a trademark if it is capable of distinguishing one trader's goods or services from those of others. Some people may believe this flexibility is an advantage of the common law approach to trademark protection. However, this Chapter argues that such flexibility is more likely to stifle fair competition and the dissemination of truthful commercial speech.</p>