



SCHOOL OF LAW
TEXAS A & M UNIVERSITY

Texas A&M University School of Law
Texas A&M Law Scholarship

Faculty Scholarship

2018

Introduction to The Protection of Non-Traditional Trademarks: Critical Perspectives

Irene Calboli

Texas A&M University School of Law, irene.calboli@gmail.com

Follow this and additional works at: <https://scholarship.law.tamu.edu/facscholar>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Irene Calboli, *Introduction to The Protection of Non-Traditional Trademarks: Critical Perspectives*, 1 (2018).

Available at: <https://scholarship.law.tamu.edu/facscholar/1358>

This Book Section is brought to you for free and open access by Texas A&M Law Scholarship. It has been accepted for inclusion in Faculty Scholarship by an authorized administrator of Texas A&M Law Scholarship. For more information, please contact aretteen@law.tamu.edu.

Introduction

Irene Calboli and Martin Senftleben

I. Expansion of the Trademark Domain

During the past decades, the domain of trademark law and the scope of trademark protection have been expanded significantly.¹ The flexible application of prerequisites for registration has paved the way for the recognition of a wide variety of signs as subject matter eligible for trademark protection. This includes single colors, shapes, sounds, smells, video clips, holograms, and even gestures.² With the elastic conceptual contours drawn in the trademark section of the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS),³ this remarkable growth of the trademark universe—the inclusion of so-called “non-conventional” or “non-traditional” types of marks—has become a worldwide phenomenon. While not establishing an obligation to accept non-traditional types of marks at the national level, the 2006 Singapore Treaty on the Law of Trademarks reflects the willingness of policymakers across all continents to facilitate the registration of traditional and

¹ Cf. Irene Calboli, *Chocolate, Fashion, Toys and Cabs: The Misunderstood Distinctiveness of Non-Traditional Trademarks*, 49 INT'L REV. INTELL. PROP. & COMPETITION L. 1 (2018); Martin R.F. Senftleben, *Trade Mark Protection—A Black Hole in the Intellectual Property Galaxy?*, 42 INT'L REV. INTELL. PROP. & COMPETITION L. 383 (2011).

² With regard to the debate on non-traditional types of marks at the beginning of the new millennium, see Ivo Lewalter and Paul T. Schrader, *Die Fühlmarke*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 476 (2005); Felix Hauck, *Aktuelle Entwicklungen bei der Eintragung von Farbmarken*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 363 (2005); Annette Kuf, *Alles oder Nichts im Formmarkenschutz?*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT—INTERNATIONAL TEIL 755 (2004); Adrien Bouvel, *Qu'importe le flacon ... Le droit des marques malmené par les emballages*, PROPRIÉTÉS INTELLECTUELLES 863 (2004); Ruth Ainet, *Markenschutz für Formen*, SIC 829 (2004); Jochen Pagenberg, *Trade Dress and the Three-Dimensional Marks—The Neglected Children of Trademark Law?*, 35 INT'L REV. INTELL. PROP. & COMPETITION L. 831 (2004); Markus Bölling, *Der EuGH und die abstrakte Farbmarke—Von der bewussten Entwertung einer Markenform*, MARKENRECHT 384 (2004); Senta Bingener, *Das Wesen der Positionsmarke oder Wo die Positionsmarke hingehört*, MARKENRECHT 377 (2004); Alison Firth, Ellen Gredley, & Spyros M. Maniatis, *Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception*, EUR. INTELL. PROP. REV. 86 (2001).

³ TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights art. 15(1), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS].

non-traditional marks alike.⁴ Recent bilateral and plurilateral international trade agreements continue on the same path.

The extension of the domain of trademark protection to non-traditional marks can be placed in the context of modern branding and marketing strategies. Today's marketers seek to create a brand experience for all senses that has the potential to become a product in its own right and a core asset of the trademark owner's business.⁵ For this purpose, traditional word and figurative marks are supplemented with non-traditional brand insignia that are often more abstract and conceptual. Modern advertising campaigns may have success in educating consumers to make a connection between a specific color, design feature, or smell, and a particular origin of goods and services. Interestingly, trademark law and practice follow and support this trend in branding and marketing even though it blurs the concept of "trademark" by going far beyond traditional word and figurative signs.

This far-reaching support for modern branding and marketing strategies is not an international obligation. International law offers national legislators the opportunity to draw hard boundary lines and set limits to the expansion of the realm of trademark protection. For instance, WTO Members are free to make it a condition that trademarks be "visually perceptible".⁶ Nonetheless, countries hesitate to avail themselves of this option to categorically exclude sound and smell from the circle of registrable signs. Additional room for an outright exclusion of certain categories of signs could follow from the invocation of traditional notions of trademark law, such as the distinction between the mark and the product. In theory, a trademark is a sign attached to the product. It should not constitute the product itself. Otherwise, indefinitely renewable trademark protection may impede the continuous evolution of new products in the marketplace. For the protection of products and product features, the intellectual property system offers innovation-based systems with a limited term of protection, such as patent, industrial design, and copyright law. Applying a strict mark/product dichotomy, trademark protection could be confined to signs that are attached to goods. In consequence, signs that form part of the goods themselves, such as product shape and other design features, would fall outside the domain of trademark law from the outset. In practice, however, lawmakers and judges have abandoned the traditional distinction between mark and product in many countries.⁷ Apparently, it is deemed preferable to keep the doors to trademark

⁴ See Rule 3, Regulations Under the Singapore Treaty on the Law of Trademarks (as in force on Nov. 1, 2011), <http://www.wipo.int/treaties/en/ip/singapore/>, which deals with a wide variety of non-traditional types of marks.

⁵ J.E. Schroeder, *Brand Culture: Trade Marks, Marketing and Consumption*, in TRADE MARKS AND BRANDS—AN INTERDISCIPLINARY CRITIQUE 161 (Lionel Bently et al. eds., 2008); D. Scott, A. Oliver, & M. Ley-Pineda, *Trade Marks as Property: a Philosophical Perspective*, in TRADE MARKS AND BRANDS—AN INTERDISCIPLINARY CRITIQUE 285, 296 (Lionel Bently et al. eds., 2008); Ralph S. Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 108 YALE L.J. 1619, 1622–34 (1999); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1706–07 (1999).

⁶ TRIPS art. 15(1).

⁷ Article 3 of the EU Trade Mark Directive 2015/2436, for instance, provides the following illustrative list of signs that are eligible for trademark protection in EU Member States: 'personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds.'

protection open, leave the filtering of inappropriate signs to trademark offices and tribunals, and the regulation of the scope of protection to decisions on infringement.

In the absence of clear-cut exclusions from trademark protection, open-ended legal instruments form the center of gravity in the regulation of non-traditional marks. On both sides of the Atlantic, courts are struggling with the application of the concept of technical and aesthetic functionality as a tool to police the borders of trademark protection and prevent encroachments upon freedom of competition and freedom of expression. To this day, however, neither U.S. judges nor their EU colleagues have found the sorcerer's stone for applying the functionality doctrine in a consistent manner.⁸

The kingpin of the trademark protection system—the basic requirement of distinctiveness—does not necessarily offer more satisfactory solutions. With regard to non-traditional types of marks, courts may make an attempt to pose additional obstacles by holding that consumers are not in the habit of making assumptions about the commercial origin of goods and services on the basis of product shape or color.⁹ To establish distinctive character, brand owners will thus have to prove the acquisition of distinctive character through use in trade. Inherent distinctive character seems unlikely in the absence of exceptional circumstances. It remains to be seen, however, whether this configuration of the test of distinctive character is a robust normative correction or a mere empirical assumption. If it is based on the empirical observation that consumers are not used to non-traditional marks, then the assumption becomes weaker and weaker with every non-traditional identifier of commercial source which brand owners imprint in the minds of consumers.¹⁰ With advertising campaigns educating consumers to understand shape, color, sound, and smell as indications of commercial origin, the argument of consumers having difficulty with the source-identifying function of these signs loses its power of persuasion.

Instead of functioning as a robust bulwark against the continuous expansion of the domain of trademark protection, the pinnacles and towers of the test of distinctive character are thus in danger of being demolished on the basis of empirical findings. Its remnants may be surmounted rather easily. In the context of trademark registration, distinctiveness has come to mean little more than “recognizable” by the human senses when it is applied to individual features of the signs for which

⁸ Cf. Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 685–91 (1999); Annette Kur, *Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality* (Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 11-16, 2011).

⁹ See, e.g., Case C-218/01, *Henkel v. DPMA*, 2004 E.C.R. I-1725, ¶ 52; Joined Cases C-53/01 to 55/01, *In re Linde & Others*, 2003 E.C.R. I-3161, ¶ 48; Case C-104/01, *Libertel Groep v. Benelux-Merkenbureau*, 2003 E.C.R. I-3793, ¶ 65.

¹⁰ Cf. Lotte Anemaet, *The Public Domain is Under Pressure: Why We Should Not Rely on Empirical Data When Assessing Trademark Distinctiveness*, 47 INT'L REV. INTELL. PROP. & COMPETITION L. 303 (2016); Martin R.F. Senftleben, *Public Domain Preservation in EU Trademark Law—A Model for Other Regions?*, 103 TRADEMARK REP. 775, 801–03 (2013); Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1150 (2003); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 170 (1982).

trademark protection is sought. In line with the TRIPS Agreement,¹¹ signs only need to be “capable of distinguishing” commercial source under most legal definitions today. Even in countries, such as the U.S., that require secondary meaning to register certain categories of non-traditional marks, the bar to prove distinctiveness is low. This development seems to be a corollary of the international preference for a registration-based grant of protection. Following this approach, it is sufficient that a sign appears capable of fulfilling the basic trademark function of identifying commercial source to grant exclusive rights and afford the trademark proprietor the opportunity to develop genuine use activities in the coming years. Instead of focusing on whether the sign has already proven to function as a badge of origin, it is sufficient that the sign has the capacity of distinguishing products *per se*. Trademark applicants may thus argue that a sign is distinctive because it constitutes a specific, recognizable product feature. If trademark offices accept this focus on product features and refrain from establishing a high threshold for demonstrating a specific source-identifying effect, trademark protection will become widely available for non-traditional marks.

II. Problems Inside and Outside Trademark Law

In other words, the current system is in danger of becoming circular in the sense that any recognizable sign, including products and product features, is eligible for trademark protection. This could include the shape of Kit-Kat and Toblerone chocolates, the Lego manikin, the Rubic’s cube, the red sole of Louboutin shoes, the shape of Bottega Veneta bags, and the shape of the London cabs—which are all recognizable design features (if not the products as such), but have never been intended to serve as identifiers of commercial source, but rather constitute designs or creative works which, as such, deserve protection under industrial design or copyright legislation.

In many jurisdictions, this risk of circularity following from an elastic concept of distinctiveness is coupled with a weak system of counterbalances—both in terms of absolute grounds for refusal and trademark defenses. For example, historically, shape marks could not be registered, at all, in several countries, including the United Kingdom and Germany. These categorical exclusions are long gone and have been replaced, in several countries, with more flexible registration criteria that prevent trademark registration to a much lesser extent. These include the aforementioned exclusions of signs are that “functional” from a technical or aesthetic perspective. In fairness, courts have increasingly resorted to these provisions to deny protection of non-traditional trademarks.¹² But these cases appear as the tip of the iceberg when

¹¹ TRIPS art. 15(1).

¹² Developments in the EU can serve as an example in this regard. See the decisions Case C-299/99, *Philips v. Remington*, 2002 E.C.R. I-5475, ¶ 82 and Case C-48/09 P, *Lego v. OHIM*, 2010 E.C.R. I-8403, ¶¶ 45, 53–58, about technical functionality which lead to a far-reaching exclusion of technical subject matter even if alternative technical solutions exist. In addition, the potential of the doctrine of aesthetic functionality has been enhanced significantly in Case C-205/13, *Hauck v. Stokke*, 2014 E.T.M.R. 60, ¶¶ 19–20, where the Court developed a list of flexible factors for the identification of signs that are to be excluded from trademark protection for this reason.

considering the numerous cases that are settled. Moreover, no sound defenses have been crafted to date to limit the use, and potential abuse, of exclusive rights relating to non-traditional marks. For example, it remains difficult to invoke the defense for using a mark in a descriptive or decorative manner in these contexts.¹³

Not surprisingly, the inclusion of non-traditional marks in the canon of protected signs raises severe problems within the system of trademark protection. The erosion of the traditional mark/product dichotomy, the risk of exhausting the spectrum of attractive signs and granting anti-competitive control over important signs in a given category, the tendency of over-protecting non-traditional marks in the absence of well-developed defenses, and the deterrent effect of excessive trademark infringement claims and related litigation costs are examples of legal-doctrinal and practical challenges. Courts across the world seem to share these concerns. Several courts have invalidated prominent non-traditional marks in recent years.¹⁴

Nonetheless, it seems safe to assume that these cases are just a small fraction of the claims that are brought (at times arbitrarily) by trademark owners. Most of the claims lead to settlements in secret, and often involve licensing or coexistence agreements, or simply acceptance by third parties of the prohibition to use signs coming close to a registered non-traditional mark. As only defendants with “deep pockets” can afford expensive and lengthy litigation, the potential chilling effect of protecting non-traditional marks should not be underestimated. Even though prominent marks have been cancelled, many are still registered.

The repercussions of the decision to protect non-traditional marks, however, go far beyond the trademark system itself. As the various chapters in this Book describe in detail, the recognition of new types of marks substantially broadens the areas of overlap between trademark, industrial design, and copyright protection. Three-dimensional objects may serve as shape marks. A short melody may constitute a sound mark. A computer animation may qualify as a motion mark. Even single colors—the raw material of paintings—are registrable. With this broader range of signs qualifying as trademarks, right holders obtain unprecedented opportunities to acquire an amalgam of trademark, industrial design, and copyright protection. New areas of overlap emerge with regard to applied art and other forms of cultural expression, in particular sculpture and plastic art, musical compositions, and audio-visual creations.

Given the different configuration of copyright and industrial designs law on the one hand, and trademark law on the other, it is not surprising that the cumulation

¹³ For instance, see Case C-408/01, *Adidas v. Fitnessworld*, 2003 E.C.R. I-12537, ¶¶ 39–41, where the Court established an ambiguous test by holding that “the fact that a sign is viewed as an embellishment by the relevant section of the public is not, in itself, an obstacle to the protection conferred by Article 5(2) of the Directive where the degree of similarity is none the less such that the relevant section of the public establishes a link between the sign and the mark.” For decisions illustrating the weakness of the descriptive use defence in this context, see Case C-102/07, *Adidas v. Marca*, 2008 E.C.R. 2439, ¶¶ 47–49; Case C-48/05, *Adam Opel v. Autec*, 2007 E.C.R. I-1017, ¶ 44; Case I ZR 175/09, “*Medusa*,” German Federal Supreme Court, ¶¶ 19–20 (Nov. 24, 2011).

¹⁴ The list of decisions in this respect is lengthy. We thus refer, here, to the cases cited and discussed in the various chapters published in this Book and the cases cited therein.

of rights leads to tensions and inconsistencies within the system of intellectual property protection: indefinitely renewable trademark rights may thwart the objectives underlying copyright and industrial designs law, in particular the aim to ensure the free availability of designs and literary and artistic works after the expiry of the limited term of copyright and industrial design protection.¹⁵ Trademark rights that remain after the end of copyright and industrial design protection have the potential to seriously impede the cycle of innovation in product design and literary and artistic creations which the rule of a limited term of protection supports. Additional interferences with cyclic cultural innovation may follow from the fact that infringement criteria and limitations of protection are not harmonized across trademark, industrial design, and copyright law. A right holder enjoying cumulative protection may have success in bringing a trademark claim even though the allegedly infringing use would not amount to infringement in the light of copyright or industrial designs infringement standards.¹⁶

The proliferation of non-traditional trademark registrations, applications, and the recent wave of litigation in this area is thus symptomatic of a larger disease of intellectual property maximization on the basis of an accumulation of rights. Not surprisingly, some of the most heralded law suits in this area involve companies trying to prolong their exclusive rights on valuable products through trademark protection, as trademark law offers a relatively low barrier to protection at comparably low costs, and the prospect of potentially high rewards once protection is granted. Trademark rights, however, are supposed to relate to signs that are needed to distinguish products in the marketplace. They should not be available for every recognizable product feature just because an additional layer of trademark protection can benefit the manufacturers.

From the bird's eye perspective of fundamental rights, these problems can be placed in the context of freedom of competition and freedom of expression. The extension of trademark protection to non-traditional types of marks can have serious effects on market competition as these marks often protect products, or parts of products, per se. In addition, the protection of non-traditional marks can prevent socially and culturally valuable uses. The potential harm that the protection of these signs can entail for market competition as well as freedom of expression is even more dramatic when one considers that the protection granted to trademarks

¹⁵ Cf. Martin R.F. Senftleben, *Vigeland and the Status of Cultural Concerns in Trade Mark Law—The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain*, 48 INT'L REV. INTEL. PROP. & COMPETITION L. 683 (2017); Irene Calboli, *Overlapping Rights: The Negative Effects of Trademarking Creative Works*, in THE EVOLUTION AND EQUILIBRIUM OF COPYRIGHT IN THE DIGITAL AGE 52 (Susy Frankel & Daniel J. Gervais eds., 2014); Annette Kur, *Funktionswandel von Schutzrechten: Ursachen und Konsequenzen der inhaltlichen Annäherung und Überlagerung von Schutzrechtstypen*, in GEISTIGES EIGENTUM IM DIENST DER INNOVATION 23 (Gerhard Schricker et al. eds., 2001); D.W. Feer Verkade, *The Cumulative Effect of Copyright Law and Trademark Law: Which Takes Precedence?*, in INTELLECTUAL PROPERTY AND INFORMATION LAW—ESSAYS IN HONOUR OF HERMAN COHEN JEHORAM 69 (Jan J.C. Kabel & Gerard J.H.M. Mom eds., 1998).

¹⁶ For a discussion of this risk, see Martin R.F. Senftleben, *Overprotection and Protection Overlaps in Intellectual Property Law—the Need for Horizontal Fair Use Defences*, in THE STRUCTURE OF INTELLECTUAL PROPERTY LAW: CAN ONE SIZE FIT ALL? 136–81 (Annette Kur & Vytautas Mizaras eds., 2011).

may last in perpetuity. In the case of non-traditional marks that acquire the status of well-known¹⁷ or famous marks (U.S.), or the status of marks with a reputation (EU), trademark law enhances the corrosive effect of protection by extending the scope of protection to dissimilar goods and services and use in non-competitive situations. Trademark offices should thus (continue to) apply appropriate safeguards against registration, and trademark courts should (continue to) develop sufficient safeguards against over-enforcement of rights in non-traditional marks. This is crucial to ensure undistorted market competition and support freedom of expression, and ultimately prevent abuses of the trademark system.

III. Taking Stock

Against this background, the purpose underlying this Book, and the collection of essays published in it, clearly comes to light: as non-traditional marks have found their way into trademark registers worldwide, the time has come to take stock. Which law and practice has evolved with regard to these marks during the last decades? How do trademark offices and courts address the wide variety of issues—ranging from legal-doctrinal to competition-based and cultural concerns—that are raised by the inclusion of non-traditional marks in the trademark system? Which positions have evolved in the debate on the continuous expansion of the domain of trademark protection? Which repercussions does this expansion have on other branches of intellectual property protection and the intellectual property system as a whole?

Offering a fresh, critical, and interdisciplinary analysis of the questions raised by the acceptance of non-traditional marks, the contributions to this Book provide an insightful academic—and at the same time practical—review of the topic. Across different jurisdictions, trademark offices and courts have rendered decisions on non-traditional marks against the background of their individual national and regional doctrines and traditions. This pool of decisions serves as a starting point for a discussion and comparison of different approaches to non-traditional marks. Providing a comprehensive overview of the status quo in different regions and countries, the chapters in the Book offer a cutting-edge discussion of legal problems and solutions in the field of non-traditional marks. As Editors, we are confident that, given the richness and diversity of the contributions, the Book can offer a careful and comprehensive analysis of the legal-doctrinal, competition-related, and cultural issues arising from the protection of non-traditional types of marks.

The Book is divided in two Parts. The first Part assesses the status quo reached in the legal treatment of non-traditional trademarks, including the history leading to the current international and national protection, and the unresolved legal challenges that still affect the protection of these marks, especially the boundaries of trademark protection. Denis Croze's chapter opens this Part with a historical reconstruction of the international negotiations and protection of

¹⁷ TRIPS art. 16(3).

non-traditional trademarks, with particular attention to the work of the WIPO Standing Committee on the Law of Trademarks and the WIPO treaties. This historical reconstruction is followed by a detailed empirical study by Michell Adams and Amanda Scardamaglia, which offers a twenty-year retrospective on non-traditional trademarks, using the European Union, the United Kingdom, Singapore, Japan, and Australia as case studies.

Several doctrinal chapters follow this empirical study. First, Dev Gangjee analyzes the current legislation and the changes that have been applied to the registration of non-traditional trademarks, primarily in the EU. In particular, he addresses the question whether the current legislative system can successfully manage the tensions that the registration of these marks generates. He suggests that an equivalent of prosecution history estoppel may be needed in trademark law to resolve several of these tensions. A comprehensive review authored by Annette Kur follows. It addresses the leading case law in Europe from the adoption of the First European Trademark Directive to date. Kur devotes specific attention to the reform of EU trademark law and new safeguards against overbroad protection of non-traditional marks that have arisen in this context, in particular the new limitation of protection which exempts fair use of non-distinctive signs and indications. This European analysis is followed by an exhaustive review of the leading and current cases and applicable law in the U.S. by Justin Hughes. This chapter addresses and criticizes, in particular, the birth and developments of the judicial doctrine of aesthetic functionality in the U.S. The following chapter also addresses the U.S., but from a different angle. Notably, Deven Desai turns to branding and the analysis of marketing practices to explain the rise of the expansion of trademark protection and the recent wave of registration of non-traditional trademarks. Ultimately, Desai argues against the protection of non-traditional marks.

The following chapter, authored by Ng-Loy Wee Loon, devotes attention to the dilemma surrounding the international community's attitude toward the protection of non-traditional trademarks and the acceptance of the functionality doctrine as a ground for refusal and important counterbalance, particularly in respect of shape marks. Ng-Loy highlights that the *travaux préparatoires* of the Paris Convention indicate that Paris Union members could not agree on a definition of a "trademark," particularly whether product shape marks could constitute trademarks. However, this resistance was later overcome with the definition that was inserted into the text of the TRIPS Agreement. Nonetheless, she sees room for the categorical exclusion of shape marks on the basis of functionality considerations—without violating international law. The following chapter by Michael Handler focuses on the infringement analysis in cases arising from the protection of non-traditional trademarks. The chapter focuses on the requirement that, in order to find trademark infringement, a sign should be "used as a trademark" and the possibility to use this requirement as a suitable safeguard against overbroad protection that would stifle free speech and free competition. Exploring the potential of the trademark use requirement, Handler's analysis sheds light on an important balancing tool at the infringement stage that may supplement—and potentially even substitute—functionality considerations at the registration stage.

Part I is concluded by the chapter authored by Haochen Sun, which addresses a series of cases litigated by Hermès in China with emphasis on the decision by the Chinese courts to reject Hermès' request to register the shape of its Kelly bag as a three-dimensional trademark in China.

Building upon this analysis, the second Part of the Book focuses on assessing the impact of the protection of non-traditional trademarks on market competition, culture, and freedom of expression. The first chapter of this Part is authored by Gustavo Ghidini, who provides a doctrinal review of the problems which the protection of non-traditional trademarks can cause with regard to market access to similar signs by competitors. In the following chapter, Glynn Lunney uses an analysis based on law and economics to argue against the protection of non-traditional marks, again based on the concern that they may lead to perpetual monopolies on product features that were not supposed to be protected as trademarks when trademark laws were originally adopted in a variety of jurisdictions. Lavinia Brancusi brings the analysis of market access and the challenges created by non-traditional trademarks within the realm of competition law in her chapter. In particular, she examines several leading cases from the EU in this context. This economic analysis is continued in the contribution authored by Carolina Castaldi, an innovation economist, who offers the first systematic empirical analysis of the extent of filings of non-traditional trademarks using data from the USPTO. Arul Scaria and Kaya Mannen conclude the series of chapters dedicated to the challenges that non-traditional trademarks bring to market competition with a contribution focusing on a specific angle of this phenomenon: the impact of this protection on the marketing of generic pharmaceuticals. Notably, the chapter shows that protection for non-traditional marks in the pharmaceutical sector could pose significant barriers to access to medicine, particularly by increasing transaction costs and creating new barriers to generic entry.

Moving beyond the analysis of challenges that non-traditional trademarks may have on market competition, Irene Calboli's chapter focuses on the impact that the protection of these marks may have on product creativity and innovation. She argues that, by recognizing and protecting as marks elements that are product design and aesthetic product features, the protection of non-traditional marks supports a system that promotes standardization and repetition of the same features. The following chapter, authored by Martin Senftleben, warns that non-traditional trademarks may have a corrosive effect on cultural follow-on innovation. As a solution, Senftleben argues for a broader application of public interest-related grounds for refusal which lead to a categorical exclusion of non-traditional signs from trademark protection. This focus on the public interest is continued in the chapter that follows, which is authored by Lisa Ramsey. In particular, Ramsey argues that the right to freedom of expression may be harmed by granting trademark rights in certain non-traditional marks. She explains that non-traditional trademarks may intrinsically convey information, ideas, or other messages unrelated to the trademark. Therefore, trademark laws regulating this inherently valuable expression should have a sufficient justification, and governments should repeal or revise laws protecting non-traditional marks when they do not directly further trademark law's goals and harm expressive

values more than necessary. Katya Assaf-Zakharov, in her conclusive chapter, argues that protecting non-traditional trademarks may become a form of cultural control, which supports cultural dominance by a certain privileged few—the trademark owners and those who can afford their products—at the expense of the rest of society which is deprived of freedom to use imitations of these signs and, in turn, their cultural meaning.