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Registration and Enforceability of Non-Traditional Trademarks in the United States

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A trademark can be more than merely a word or device. Under the applicable federal statute, the Lanham Act, a trademark “includes any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”¹ Accordingly, this broad statutory definition of a trademark has been relied upon to register and enforce a number of non-traditional marks, including sounds, shapes, colors, and on a few occasions, smells. A taste mark has yet to be registered in the United States.

General Registration and Protection Principles

In order for such elements to be registrable and protected as trademarks, they cannot perform a utilitarian function and they must be distinctive.

In addition, according to the Trademark Manual of Examining Procedure (TMPEP), “all marks, other than sound and scent marks, require a drawing.”² (In light of the fact that there have been very few attempts to register taste marks, as well as the fact that taste marks are similar to sound and scent marks in that they cannot be

depicted in a visual and/or graphic format, taste marks should also be exempt from the drawing requirement.)

Mark Must Not Be Functional

In order to be registrable, a mark must not be functional.³ The US Patent & Trademark Office’s (PTO) TMPEP § 1202.02(a)(v) instructs trademark examiners to consider the following four criteria when analyzing whether the subject matter is functional with respect to the goods:

1. Whether there exists a utility patent that discloses the utilitarian advantages of the design sought to be registered;
2. Whether there is advertising by the applicant that “touts the utilitarian advantages of the design”;
3. Facts pertaining to the availability of alternative designs; and
4. Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

This four-factor test is not a strict formula for functionality, however, and courts have applied this test in various ways, with varying outcomes. A leading case is *Traffix Devices, Inc. v. Marketing Displays Inc.*,⁴ in which the US Supreme Court denied trade dress protection on the basis of functionality for a dual-spring designed to hold road and highway signs in an upright position.

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Relying on precedent, the court asked whether the dual-spring design was “essential to the use or purpose of the article” and whether the design “affects the cost or quality of the article.” The court found functionality based upon claims made in plaintiffs’ expired utility patents (“prevents canting or twisting of the sign around a vertical axis,” and “forces the sign frame to tip along the longitudinal axis . . .”). The court noted that, when the utilitarian features of the design are undisputed, “there is no need to engage in . . . speculation about other design possibilities.” This reasoning would seem to indicate that the four-factor test for functionality is a four-step test in which analysis begins with the question of whether the design features have any utilitarian value, and if the answer is affirmative, then there is no need to investigate the availability of alternative designs in the marketplace.

On the other hand, *In re Morton-Nonwich Products, Inc.*,⁵ is an illustration of how the Federal Circuit relied in part upon the availability of alternative designs to issue a finding of valid trade dress. In this case, the applicant appealed the denial of registration for the design of its spray-pump container, used as a container for its line of household cleaning products. The PTO refused registration on the basis of functionality, finding that the design was “no more than a non-distinctive purely functional container for the goods plus a purely functional spray trigger-controlled closure.” The court applied the four factor-functionality test and, with respect to the third and fourth factors, which address the question of whether “using this trade dress will hinder competition or impinge upon the rights of others to compete effectively in the sale of the goods,” found that the evidence on record was sufficient to show that spray-bottle containers “can take a number of diverse forms, all of which are equally suitable for the pump and spray mechanisms.” Accordingly, “competitors have had no need to simulate appellant’s trade dress, in whole or in part, in order to enjoy all of the functional aspects of a spray top container.”⁶

Mark Must Be Distinctive

As stated above, the Lanham Act defines a trademark very broadly. Many applicants have relied on this breadth to register a number of non-traditional marks, including sounds, shapes, color, and smells. The Supreme Court has stated that “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve the basic purposes [of identifying and distinguishing the goods to indicate source].”⁷

Accordingly, in order to obtain registration on the Principal Register, an applicant of a non-traditional

trademark must establish that its mark has acquired distinctiveness under § 2(f) of the Lanham Act. If a mark is not distinctive (*prima facie* distinctive or via “acquired distinctiveness”) and not functional, it is registrable only on the Supplemental Register.

Color Marks

As noted, a color that performs some utilitarian function in connection with a product cannot be protected as a trademark. Typically, examiners will raise ornamental and functional refusals during the prosecution of applications for color marks. For example, pink skin bandages and dressings to blend with skin tones have been held to be functional. In addition, the white uniforms and trucks of Good Humor ice cream vendors, which aids in visibility, have been deemed to be functional. Thus, it is important that a product’s packaging and literature refrain from touting the functionality of the color aspect of the product. Such information would be very damaging to a trademark claim as would third-party literature that discusses the functional aspects of the color sought to be claimed as a trademark.

A Color Is Never Inherently Distinctive

In addition, in the United States, a color is never inherently distinctive. Accordingly, to seek registration of a color mark on the Principal Register, it must be shown that the color mark in question has acquired distinctiveness. The TMEP specifically states: “The examining attorney must issue this refusal in all color mark applications where acquired distinctiveness has not been shown, regardless of the filing basis of the application.”⁸ Moreover, if the color is natural to the products/services applied for, it cannot even be registered on the Supplemental Register.

The courts and the Trademark Office examine several factors in attempting to ascertain whether a single color has achieved secondary meaning.

1. *Extent of Third Party Use.* If the use of a color is common in a field, it is difficult to demonstrate the distinctiveness of the color so as to be protectable by one party. For example, if several third-party companies manufacture computers in the color green, most probably no single company can claim protection of the color green as a trademark for such goods.
2. *Sales and Advertising.* While extensive sales and advertising of the product in question may prove helpful in demonstrating secondary meaning in the color of the product, such sales and advertising *must* direct the purchaser’s attention to the color of the product in question.

Such promotion is frequently referred to as look-for advertising, that is, “look for our XYZ catheter product in the distinctive color orange.” It would also be helpful to develop a slogan that highlights the color component to be used in conjunction with the product.

3. *Use of Trademark Legend.* Although not determinative, it may be helpful to include a legend on the product package and literature that states that “the color _____ is a trademark of _____.”
4. *Promotional Items.* It is a common practice for companies to distribute give-away items to promote their products. In such instances, give-away items should be in the color sought to be protected for the goods (*i.e.*, t-shirts, note pads in the color sought to be protected). In addition, such promotional items should bear the product slogan that reinforces the color aspect of the product (*i.e.*, the look-for slogan).
5. *Sales Calls.* A company should educate its sales force to stress to the consuming public that the color in question is a trademark of that company and should not talk to any functional aspect of the color.
6. *Monitoring Competition.* As indicated, third-party use of the color in question can be fatal to color protection. Accordingly, a company should request that its sales force report to the legal department and management any use of product colors by third parties.
7. *Consumer Studies.* Consumer studies and surveys can help to establish that a color is acting as a source indicator and thus as a trademark. While expensive, such a survey would most probably be required in litigation or possibly during a trademark prosecution to demonstrate that a particular color (used for a certain period of time and supported by substantial sales and targeted advertising) has acquired secondary meaning.
8. *Unsolicited Media Coverage of the Product that Highlights the Color in Question.* The company should monitor and collect evidence of such media coverage on a regular basis, perhaps via a clipping service.
9. *Consumer Letters and Inquiries.* The company should compile and file for future reference any such letters and inquiries that reference the color of the product. In addition, a review of several third-party color registrations indicates that the PTO gives great weight to this factual information in determining whether a particular color should be registered as a trademark.

Drawings Are Required for Color Mark Applications

Drawings are required for color mark applications.⁹ The PTO requires all drawings to be a “substantially exact representation” of the mark as used on the goods. Therefore, with respect to color marks, “a depiction of the object on which the color is used is needed.” In addition, the applicant must use a dotted line to show the positioning of the color and must include a worded description of the mark in the application.¹⁰ For example, in the case of an application for the color blue for grain elevator buckets, the description of the mark would read “the mark consists of the color blue as applied to the entirety of the goods. The dotted outline of the goods is intended to show the position of the mark and is not a part of the mark.” In addition, while the PTO required Pantone color references in the past, now an applicant must merely state which color it is seeking to register with no need to specify a specific Pantone number reference.¹¹

There are a number of important cases that address the registration of color as a trademark or element of a trademark. *In re Owens-Corning Fiberglas Corporation*¹² was the first case in which color marks were allowed to be registered. The PTO had denied registration for the color pink in connection with “fibrous glass residential insulation” on the grounds that the applicant had submitted insufficient evidence of secondary meaning. The Federal Circuit reversed the PTO’s denial of registration, however, finding that the applicant’s advertising expenditures in excess of \$42 million and 50 percent consumer recognition in the marketplace were sufficient to demonstrate secondary meaning.

In *Qualitex Co v. Jacobson Products Co.*,¹³ the Supreme Court held that the Lanham Act permits registration of a mark that consists purely of color. The Supreme Court found that a special shade of green-gold color that Qualitex used on the pads that it sold to dry cleaning firms for use on dry cleaning presses could be registered.

A district court ruled that color may be granted trademark protection if it is non-functional and has acquired secondary meaning in the case of *L.D. Kichler Co. v. Davoil, Inc.*¹⁴ The court explained that a functional inquiry looks to whether the product feature is essential to the use or purpose of the article or if it affects the cost or quality of the article.

In *In re Ferris Corp.*,¹⁵ a district court held that a pink color sought to be registered by the applicant as a trademark for wound dressings was *de jure* functional since flesh-colored wound dressings served the functional purpose of blending with the color of Caucasian skin and applicant’s competitors sold similar products with the same color. In addition, the court found that the

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applicant had not shown that the pink color for wound dressings had acquired distinctiveness.

The district court in *In re Thrifty Inc.*¹⁶ held that color is capable of registration only upon a showing of acquired distinctiveness. The court ruled that the Trademark Trial and Appeal Board (TTAB) had not erred in finding that the applicant's original application was directed to the color blue only, because the drawing submitted with the original application had showed the building in dotted lines having the upper wall lined for color.

Sound Marks

As stated previously, sounds are capable of acting as trademarks, but it is important to know when a sound is functioning as a trademark and when it constitutes the good itself.¹⁷ The TTAB has held that sound marks can be divided into the categories of inherently distinctive or non-inherently distinctive marks.¹⁸ Accordingly, "unique, different or distinctive sounds" would need no proof of secondary meaning, but sounds that resemble or imitate commonplace sounds would need evidence of secondary meaning to prove that they have become distinctive and identified with a single source. For example, in *In re General Electric Broadcasting Co., Inc.*,¹⁹ the applicant had attempted to register a mark "consisting of the sound made by a Ship's Bell Clock as a service mark for radio broadcast services." The TTAB affirmed denial of registration, stating that commonplace sounds, in order to be registrable as a trademark, required a showing of secondary meaning.

The PTO has allowed a number of sound marks to achieve registration, however. For example, Registration Number 916522 covers the distinctive NBC television broadcasting musical chime; Registration Number 1700895 covers the "Sweet Georgia Brown" theme of the Harlem Globetrotters basketball team; Registration Number 2827972 covers "a series of five chirps similar to the chirping sound of a cricket"; Registration Number 2827490 covers "7 musical notes as follows: notes E, G, G, G, G, A, C and C."²⁰

Sounds are capable of acting as trademarks, but it is important to know when a sound is functioning as a trademark and when it constitutes the good itself.

The PTO has allowed other prominent examples as well, including Application Serial Number 76/316851 for

a mark consisting of the sound of a human voice speaking "hello and welcome to moviefone;" Registration Number 2607415 for a mark consisting of a duck quacking the word "Aflac"; Registration Number 2692077 for a mark consisting of a sound of a child-like human giggle that represents the Pillsbury Doughboy giggle; Registration Number 2821863 for the spoken words "You've got mail;" and Registration Number 1395550 for the sound of a lion roaring (MGM Pictures). Although the PTO has not required that all registered marks comprising common place sounds show secondary meaning, an applicant seeking to register such a sound should expect an objection on this basis.

It is interesting to note that the PTO does not require graphical representations of sound marks, and in fact, if an applicant wishes to broaden the scope of its protection, it may wish to limit its application to a literal description of the mark. (Registration will require establishing use by filing specimens of use, however, which would probably include an aural representation of the sound mark.)

In *Kawasaki Motors Corp., U.S.A. v. H-D Michigan Inc.*,²¹ H-D Michigan Inc. (Harley Davidson) sought to register "the exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines when the goods are in use." The application was the subject of nine separate oppositions. In the above-noted case, Kawasaki Motors Corporation filed a motion for summary judgment seeking entry of judgment in its favor based on a claim that the application sought registration of more than one mark. The Kawasaki argued that the two specimens of record, one containing the recorded sound of the applicant's motorcycle equipped with "after-market exhaust pipes" and the other containing recorded sound of the applicant's motorcycle equipped with "stock exhaust pipes," essentially amounted to "the use of two discrete marks" and therefore rendered the application void *ab initio*.²²

The TTAB disagreed. Although the TTAB acknowledged that, for registrations covering sound marks, "the description of the sound is the only means for presenting, in any printed record, the essence of the mark," "it [did] not, however, follow that different sounds constitute different marks." More specifically:

When we compare each of the discrete recordings of the sound to the description of the mark, each recording can fairly be characterized as an aural presentation of the literal description, just as varying presentations of a word in different typefaces and typesizes all may be said to illustrate that word as set forth in plain typed form on the drawing of the mark.

Although the TTAB in *Kawasaki Motors* did not reach the issue of likelihood of confusion between two sound marks, it provides some guidance as to how to describe a sound sought to be registered.²³ It would be hard to imagine any court issuing a decision as to the likelihood of confusion between two sound marks without requiring each party to provide the court with a recording of its marks. The similarities and/or differences between two sound marks may require comparison of the sound recordings, however, as well as the literal description of each party's respective mark. If the literal description of the earlier mark is broad enough to encompass more than one aural presentation, the alleged infringer may face penalties notwithstanding that its sound mark differs from the plaintiff's mark in pitch, frequency, and rhythm, for example. Further, since the usual enforcement standard is one of likelihood of confusion, the protection of a sound mark may be broader than the literal description, although there are no cases applying this standard to sound marks.

Smell or Fragrance Marks

As stated, fragrances are capable of serving as trademarks to identify and distinguish products. The first smell mark was registered in 1990 when the TTAB directed the PTO to allow registration of "a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms" in connection with "sewing thread and embroidery yarn."²⁴ It is important to note that the applicant submitted copies of advertisements and promotional material touting the scented nature of her sewing thread and yarn, as well as customer reviews discussing this unique feature of the product. In addition, the applicant had submitted a declaration attesting to the fact that, to the best of her knowledge, no other company had ever offered any scented embroidery yarn or thread. This evidence weighed in favor of finding "that applicant has presented a *prima facie* case of distinctiveness of her fragrance mark."

Since the usual enforcement standard is one of likelihood of confusion, the protection of a sound mark may be broader than the literal description, although there are no cases applying this standard to sound marks.

In addition to the problem of having to demonstrate acquired distinctiveness, an applicant for a fragrance mark must show that the particular scent is not a functional characteristic of the product. TMEP § 1202.13

explicitly states: "The scent of a product may be registrable if it is used in a non-functional manner . . . Scents that serve a utilitarian purpose, such as the scent of perfume, would be functional and not registrable."

In addition to the "plumeria blossoms" scent mark, there have been several other successful attempts to register scent marks in the United States. At this time at least four scent marks are registered on the Principal and Supplemental Registers. For example, Registration Number 2463044 covers a "cherry scent" for "synthetic lubricants for high performance racing and recreational vehicles"²⁵ and Registration Number 2,560,618 covers the scent of "bubble gum" for "oil based metal cutting fluid and oil based removal fluid for industrial metal working." In that case, the registration was amended to the Supplemental Register.

Registration of fragrance marks differs from other types of trademarks or trade dress in three regards: the description, the drawing, and the specimen. Description of a fragrance mark is problematic because there is no unambiguous way to define a scent. Just because the description of the scent may be imprecise, however, it is something that the PTO can determine on a case-by-case analysis and should not prohibit overall fragrance mark registration.

In addition, fragrance mark applications differ from applications seeking to register more traditional trademarks because, as in the case of color marks, the applicant need only describe a scent in general terms. Applicants can describe fragrances to satisfy the drawing requirement needed for the application to the PTO in the same basic terms as are used for color. For example, the registrant in *In re Clarke* defined her scent as "plumeria blossoms." Therefore, a brief description of the scent should satisfy the drawing requirement.

Finally, fragrance marks differ in the presentation of specimens to the PTO. In each case noted above, the applicants submitted actual specimens of the scent to the Trademark Examiner. In the case of Registration Number 2643044, the applicant submitted a paper soaked in the scented product. In the case of Registration Number 2,560,618, the applicant submitted a small bottle of the fragrance.²⁶

Taste Marks

The PTO has yet to allow registration of a taste mark; however, one party has attempted to register the flavor orange for a pharmaceutical. In particular, N.V. Organon, a Netherlands corporation, has sought to register the flavor orange for "pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills."²⁷ The PTO refused the application under Trademark Act §§ 1, 2, and 45²⁸ because it found

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that the proposed mark did not identify or distinguish the goods of the applicant from those of others nor did it indicate the source of the goods. The Examining Attorney held that “orange flavor for orally administered pharmaceutical products is a standard feature of such goods and simply would not be perceived as an indicator of source.”

In addition, the PTO refused the application on the basis of functionality.²⁹ In particular, the Examining Attorney found that “the flavor orange is functional because fruit flavorings are added to pharmaceutical products in order to create an orange taste that covers the medicine taste of many pharmaceutical products. The flavor orange is also functional since it is a natural byproduct of the manufacturing process whereby the ingredient orange citrus is added to pharmaceutical products. Finally, the evidence establishes that the flavor orange is the preferred flavor for orally administered pharmaceutical products.” In supporting her case, the Examining Attorney provided 20 LEXIS-NEXIS story excerpts and numerous Web pages resulting from an Internet search and computerized database search.

At the time of the preparation of this article, the application remained pending.

In the absence of any precedent, an analogy perhaps can be made between taste marks and smell marks, and one might imagine that the same principles of registration would apply. As is the case with all non-traditional trademarks, registration would first require a demonstration of acquired distinctiveness; the applicant would almost certainly have to show that customers have come to associate the specified flavor or taste with its product. Furthermore, the PTO will also examine the specified taste with respect to functionality. Accordingly, in those cases in which the taste in question was typically associated with the underlying product, registration and trademark protection would be difficult. In cases in which a unique flavor has been added to a product, however, perhaps registration would be possible if the applicant could establish secondary meaning.

Shape Marks

The main difference with respect to registration of product shapes and product packaging is inherent distinctiveness. Under US trademark law, product designs and shapes are not inherently distinctive and therefore require a demonstration of secondary meaning. The leading case is *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,³⁰ in which the US Supreme Court distinguished between product design and product packaging and held that the former can never be found to be inherently distinctive. The Lanham Act clearly prohibits registration of nondistinctive trade dress³¹ and accordingly,

“the examining attorney must refuse to register, on the Principal Register, any mark that consists of a product design, unless the applicant establishes that the mark has acquired distinctiveness.”³²

An application to register a product shape will undergo a two-part analysis as to:

1. Whether the shape represents a functional feature of the product itself; and
2. Whether acquired distinctiveness exists.

The doctrine of functionality is of particular concern in the case of shape marks since courts often dissect shapes (as opposed to sound, scent, or taste) into individual parts when applying the doctrine of functionality. Shapes, therefore, are somewhat more vulnerable with respect to their ability to be registered.

Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP,³³ is one example of how the doctrine of functionality applies to product shapes. Plaintiff sued defendant for infringement and defendant alleged in its defense that plaintiff’s guitar shape design was functional and therefore not entitled to trademark protection. Noting that “the proof reflects a variety of horns of guitars” on the market, as well as the fact that guitar knobs, frets, and switches may “serve essential functions, but not as to their locations or arrangement on the guitar,” the district court concluded that the design elements contained in plaintiff’s guitar shape “collectively create[d] a unique guitar” that, together with a demonstration of acquired distinctiveness, were sufficient to preclude a finding of functionality and warrant protection as a trademark.

As noted above, product packaging is capable of being inherently distinctive and therefore capable of registration on the Principal Register in the United States without proof of secondary meaning.³⁴ Factors to consider when trying to determine whether inherent distinctiveness exists in product packaging are as follows:

1. Whether the packaging consists of a common basic shape or design;
2. Whether the packaging is unique or unusual in the field in which it is used;
3. Whether the packaging is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; and
4. Whether the packaging is capable of creating a com-

mercial impression distinct from the accompanying words.

It appears that shapes of containers or packaging have a greater chance at achieving registration than shapes that are applied to the goods themselves.

Conclusion

The protection of non-traditional trademarks (*i.e.*, color, sound, smell, taste, and shapes) appears to be limitless as long as the matter sought to be protected is not functional and is distinctive.

Notes

1. 15 U.S.C. § 1127.
2. TMEP § 807.
3. In 1998, the Congress amended the Lanham Act to prohibit registration of any matter that is functional. In 2001, in the case of *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 S. Ct. 1255, 1260, 58 U.S.P.Q. 2d 1001 (US 2001), the Supreme Court observed that it was a “well-established rule that trade dress protection may not be claimed for product features that are functional.” The functionality doctrine “ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration.” TMEP § 1202.02 (a) (ii).
4. *Traffix Devices, Inc. v. Marketing Displays Inc.*, 532 U.S. 23 (2001).
5. *In re Morton-Norwich Products, Inc.*, 213 U.S.P.Q. 9 (CCPA 1982).
6. *In re Morton-Norwich*, 213 U.S.P.Q. at 17.
7. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 34 U.S.P.Q. 2d 1161 (1995). In *Qualitex*, the Supreme Court held that a green-gold color for a dry-cleaning press pad was protectable as a trademark. The Supreme Court’s ruling settled the issue of whether a single color of a product is capable of being registered and protected by a trademark. The court reasoned that “it is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word or sign—that permits it to serve these basic purposes.” Several years later in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000), the Supreme Court held that appliqués for children’s clothing constituted unprotectable trade dress absent a showing of secondary meaning. The Supreme Court in *Wal-Mart* set certain limits on the ability to register product designs (in comparison to product packaging), declaring that product design, like color, is not inherently distinctive and therefore requires a showing of secondary meaning in the marketplace in order to be registrable.
8. TMEP § 1202.05(a).
9. TMEP § 1202.05(d).
10. “The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the applicant does not claim the shape of the product, or the shape of the package, as part of the mark.” TMEP § 1202.05(d)(i). In addition, the drawing should be accompanied by a description of the mark, “explaining the color(s) and where they appear on the mark.” TMEP § 807.09(c).
11. The description of the color should be in “ordinary language” . . . even if the applicant also describes the color using a commercial coloring system.” TMEP § 1202.05(e). Thus, color representations are not required; a drawing together with a description of the color, and where it appears on the product, will suffice. Although Pantone descriptions may be included in the description of the mark, an “ordinary” description such as “red,” “pink,” or “maroon” should also be included in the description of the mark. Likewise, applications to register scent marks and taste marks will also require verbal descriptions, such as “the mark is a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms,” or even just “orange flavor.”
12. *In re Owens-Corning Fiberglas Corporation*, 227 U.S.P.Q. 417 (Fed. Cir. 1985).
13. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).
14. *L.D. Kichler Co. v. Davoil, Inc.*, 52 U.S.P.Q. 1307 (CAFC 1999).
15. *In re Ferris Corp.*, 59 U.S.P.Q. 2d 1587 (TTAB 2000).
16. *In re Thrifty Inc.*, 61 U.S.P.Q. 2d 1121 (CAFC 2001).
17. *Oliveira v. Frito Lay Inc.*, 58 U.S.P.Q. 2d 1767 (2d Cir. 2001). Plaintiff singer brought infringement claim alleging unauthorized use of her “signature” 1964 sound recording “The Girl from Ipanema” in defendant’s television commercial. In her Lanham Act claim under § 43(a), plaintiff argued that use of her “signature” sound recording was used in a manner “likely to cause confusion or deceive as to the affiliation, connection or association of Defendants with Plaintiff.” Although the court acknowledged the plausibility of the use of musical sounds and recordings as trademark use, it dismissed plaintiff’s Lanham Act claims on the basis that trademark law does not accord trademark rights in one’s own performance or, to be more concise, marks consisting of musical sound recordings or performances cannot be used to designate the singer. In *GML Inc. v. Aubrey Mayhew*, 188 F. Supp. 2d 891 (D. Tenn 2002), the plaintiff corporation sued defendant under § 43(a) of the Lanham Act alleging false and misleading designation of origin. At the heart of the dispute was a sound recording entitled “Johnny Paycheck Little Darlin’ Masters.” The district court held that the sound recordings did not indicate the source of goods, but rather the sound recordings were the goods. The court was careful to point out, however, that there may be circumstances in which a sound recording functions as a trademark.
18. *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (TTAB 1978).
19. *Id.*
20. It should be noted that the PTO database is accessible on the Internet (*see www.uspto.gov*), but at this time the only way to listen to recordings of sound marks is to obtain the file wrapper (a copy of the actual, physical file with a specimen of use that may consist of the sound recording). The PTO allows public access to the files and will release them to third parties in order

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- to allow them to listen to sound recordings marks and/or make copies of them if such sound recordings were provided by registrant at the time of application. Of course, the original recordings must be returned to the PTO.
21. *Kawasaki Motors Corp., U.S.A. v. H-D Michigan Inc.*, 43 U.S.P.Q. 2d 1521 (TTAB 1997).
 22. *Id.* at 1523.
 23. As stated previously, sound, scent, and taste marks do not require a drawing and accordingly, the descriptions of these marks are crucial. For sound marks, the PTO would probably accept "musical notation, digital recordings on compact discs, provision of digital codes playable on computers, graphs, sonograms" as part of the application to register, but the PTO will also examine the verbal description of the mark, which must be published for opposition purposes and recorded in the PTO's online database (which currently does not have the capability to transmit audio recordings of registered marks). Fortunately, many sound marks have been registered in the United States, and registration details show that verbal descriptions of such marks often use simple, ordinary language (for example, "the mark consists of the spoken letters 'AT&T'," "the mark consists of the spoken term 'cha-ching'," and "the mark consists of the notes 'C, D, E, C, D, G,' accompanied by the words 'Radio Variedades'").
 24. *See In re Clarke*, 17 U.S.P.Q. 2d 1238 (TTAB 1990).
 25. As in the case of color marks, it appears that the submission of customer testimonials that highlighted the unique qualities of the fragrance sought to be registered was an important factor in securing registration.
 26. The applicant should replace specimens every five years to ensure the fragrance has not deteriorated.
 27. USPTO Ser. No. 76467774 (filed 2002).
 28. 15 U.S.C. § § 1051, 1052 and 1127.
 29. *See* 15 U.S.C. § 1052(e)(5).
 30. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000).
 31. *See* 15 U.S.C. §§ 1051, 1052, and 1127.
 32. TMEP § 1202 (b)(i).
 33. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, (M.D.Tenn. 2004).
 34. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 215 (2000). The court warned, however, in cases in which it is difficult to distinguish between product design and product packaging, it is better to err on the side of caution and find that the matter consists of product design, thereby requiring a demonstration of acquired distinctiveness.

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