

Trademark Protection for More Than Your Name and Logo

Protecting Sounds, Scents and Other Non-Mainstream Marks

When most people think about protecting their trademarks, they think about registering the names and logos associated with their business, products or services. Examples of some famous marks include "Coca-Cola"; "Nike", the U.S. Army's "Be All You Can Be" and McDonald's Golden Arches logo. However, other less mainstream forms of trademarks can also be registered and protected. Some examples include sounds, scents, three dimensional designs and marks with motion.

What is a trademark

Trademarks (for products) and service marks (for services) are words, symbols, slogans, images and other commercial symbols used by companies or individuals to identify (brand) their goods and services. Trademarks are used to identify and distinguish products and services of one manufacturer or seller from those manufactured or sold by others. For example, Apple, Inc., the company best known for the iPod, iPhone and Mac computers displays its famous partially eaten apple logo (shown below) on products to inform consumers that it is the source of the gadgets it manufactures.

A trademark can have significant value. It creates name recognition, customer loyalty, goodwill and can significantly increase the value of one's business.

Protecting your brands

Once a manufacturer or service provider picks a mark/brand (after researching to find out that it is available and not used by others), the next important step is to protect the mark.

Trademark rights in the U.S. generally fol-

low the axiom "first in use first in right". Specifically, whoever is the first to use a mark obtains priority over others as to the particular good or service identified by the mark. While trademark protection is obtained automatically through use, the protection one obtains without registration is limited. When a mark is not registered, the rights obtained are limited to the geography where the mark is used in commerce.

The simplest (and cheapest) way to protect your mark across the United States is to file and obtain a federal trademark registration in the U.S. Trademark Office. Once registered, a federal trademark registration provides several advantages. It provides notice to the public of the owner's claim of ownership to the mark. It provides a legal presumption of the owner's ownership of the mark nationwide. And finally, a registration provides a presumption of the owner's exclusive right to use the mark on or in connection with the goods or services described in the registration.

The benefits of a registration are numerous. A registration entitles the owner to seek the assistance of federal courts to stop infringers from using the same or similar mark. It entitles the owner to collect damages from infringers. It can be used as a basis for obtaining registration in foreign countries. Finally, a registration may be recorded with U.S. Customs Service to help prevent the importation of infringing foreign goods.

The more unusual forms

Just like names and logos; sounds, scents and three dimensional marks and marks with motion can also be registered in the U.S. Trademark Office if used to identify one's goods or services. These kind of marks can serve a very important function, by supplementing and providing an additional mecha-



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nism for businesses to advertise and communicate with consumers and to build name recognition for one's brand.

Some of the more widely known sound marks which are currently registered in the U.S. Trademark Office are Intel's "Intel Inside" jingle (Reg. No. 2,315,261), Yahoo, Inc.'s sound of a voice yodeling "YAHOO" (Reg. No. 2,442,140), NBC Entertainment's chimes (Reg. No. 916522), the AAMCO Transmission "Double A - TOOT TOOT - M C O" (Reg. No. 2144306), the America Online "You've got mail" slogan (Reg. No. 2821863), Time Warner Entertainment's "Looney Tunes Theme Song" (Reg. No. 2469365) and the Homer Simpson "D'OH" (Reg. No. 3411881) sound as a few examples. Sound marks can serve as an important identifier for products and services and can be used effectively either together with or without other more mainstream trademarks such as word marks and logos. Like other trademarks, sound marks can be used to enhance a company's name recognition, goodwill and branding efforts.

In addition to sound marks, there are other types of non-mainstream marks which can be protected. Scent marks are such an example. Some interesting scents which are registered as trademarks, include Lactona Corporation's strawberry scented toothbrushes (Reg. No. 3332910) and the Smead Manufacturing Company's scented office supply products, which come in apple cider, peppermint, vanilla, peach, lavender and grapefruit scent (Reg. Nos. 3140701, 3140700, 3143735, 3140694,

3140693 and 3140692, respectively). Scent marks provide another means by which businesses can enhance their brand cache by catering to a consumer's sense of smell in addition to the more customary sense of sight.

Not all scents are registrable, however. The Trademark Trial and Appeal Board (the government body within the U.S. Trademark Office responsible for hearing and deciding certain kinds of cases involving trademarks) has stated that scents that serve a utilitarian purpose, such as perfume or air fresheners, are considered functional and therefore not registrable. However, if the product serves a different function than primarily to provide a scent (such as office supplies or toothbrushes), then the mark can be registered. Scented goods may be the wave of the future, as businesses try to build name recognition and provide customers a fuller sensory experience when purchasing daily goods.

Flavored trademarks, a third type of lesser known marks, are perhaps the most difficult to protect. While in principle they can be registered, the Trademark Trial and Appeal Board has observed that it is unclear how a flavor could function as a source indicator because flavor or taste generally perform a utilitarian function and consumers generally have no access to the product's flavor or taste before purchase. If the consumer is not exposed to the flavor before purchasing the product, then by definition the flavor cannot serve as an indicator of the source of the product. Registering a flavor mark would therefore be an uphill battle, unless the flavor can be transmitted or communicated to the consumer before purchase.

Other interesting types of trademarks that may be registered are those that contain motion or three dimensions. An example of a motion trademark is Webroot Software's mark of a radar screen with a line that moves around the

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screen clockwise (Reg. No. 3469620), shown below.



An example of a registered three dimensional mark is the Laughing Cow® image shown below (Reg. No. 3426891).

Trademarks come in different shapes, sizes, and forms. The more atypical (albeit fun) types of marks are those that cater to our other



senses beside sight. With a more acute awareness of the types of branding opportunities available, companies may very well want to take steps to also protect their less mainstream types of marks, to enhance the value of their business, products and services even further.

Tal Grinblat is a shareholder of the firm Lewitt, Hackman, Shapiro, Marshall & Harlan in Encino. His practice emphasizes franchise and distribution law, trademarks and copyrights. Grinblat is chair of the California Bar Association's Franchise Law Committee. He is also a Certified Specialist in Franchise and Distribution law under the State Bar of California's Specialization Program.