



# THINK FORWARD

## Funky trademark trend continues as Procter & Gamble files trademark request for Old Spice whistle

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*Pig calls and reality show catch phrases also aim for trademark protection*

**ANN ARBOR, MICH** – The familiar Old Spice whistle is a decades-old jingle, but owner Procter & Gamble has just now applied to federally register the sound as a trademark. The consumer products giant is joining companies and universities of all sizes in the trend toward registering non-traditional trademarks, according to Michael Spink, an intellectual property attorney who blogs (<http://funkymarks.wordpress.com/>) and tweets (@funkymarksblog) about unusual trademarks for motion, sound, color, scent, texture, and shape.

While unusual, Spink says the whistle trademark seems less so when considering both historical and recent non-traditional mark registrations for sound. For example, the NBC chime (the three notes G, E and C) has been used for more than 50 years, and was registered with the United States Patent and Trademark Office in 1971.

More recently, the University of Arkansas' famous 'hog call', a distinctive crowd cheering "'Woooooo. Pig. Sooie! Woooooo. Pig. Sooie! Woooooo. Pig. Sooie! Razorbacks!'" was recently registered with the trademark office, according to Spink, who is a shareholder in the Ann Arbor office of Brinks Gilson & Lione, one of the nation's largest intellectual property law firms. "In overcoming an initial rejection, the University submitted a substitute specimen, along with evidence of continuous and exclusive use for at least 5 years preceding the application, in order to obtain the trademark registration."

Spink notes that while most types of non-traditional marks are registerable in the U.S., they can be more difficult to register than traditional marks, mainly due to the requirement that non-traditional marks be distinctive and non-functional.

"The first hurdle is that all trademarks must be distinctive, that is, capable of distinguishing the owner's goods from those of others; however, certain non-traditional marks such as product configuration, color, scent, flavor and some sound marks can never be inherently distinctive," said Spink. "In these cases, secondary meaning, which is distinctiveness acquired through consumer recognition, must be shown for registration on the Principal Register, which is the primary register of trademarks maintained by the United States Patent and Trademark Office (USPTO)."

As an example, Spink notes that a recent trademark application for the catch phrase, "Right Here" from the reality television show, Storage Wars, was recently rejected by the USPTO as not being source-identifying, rather considered by consumers simply as dialogue. Still, Spink notes that rejection doesn't mean the TV show couldn't seek a different mark in the category of 'Entertainment in the nature of live radio personality performances,' perhaps in the auction calling segment of the show.

When non-traditional marks are merely appealing aspects of a product, or simply inherent features, they

can only be registered on the principal register with proof of secondary meaning. For example, the sound emitted by a device in its normal course of operation requires secondary meaning to be accepted for trademark consideration.

Even when a non-traditional mark is sufficiently distinctive, the functionality doctrine may present a barrier to trademark registration. The functionality doctrine prevents the owner from limiting competition by trademarking a useful product feature to extend patent-like protection. Generally, the question asked by the Trademark Office is whether aspects of the design are essential to the use or purpose of the article, or affect the cost or quality of the article.

'If a shape of a product enables it to operate, or improves on another design in some way (i.e. cheaper, faster, lighter, stronger), then it cannot be trademarked,' said Spink. 'Similarly, if a particular color makes a device more visible in an industry where visibility is desired, it cannot be trademarked.'

Whistles, pig calls and catch phrases notwithstanding, product packaging is still the most common type of non-traditional trademark registered in the U.S., followed by product configuration, sound and color. What's next on the trademark horizon?

'Scent, texture and flavor trademarks, while increasing, are still fairly rare in the U.S., but I expect that to change over the next five to ten years,' said Spink.

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