

Nontraditional Marks

Kenneth Port

William Mitchell College of Law

Working thesis

- Nontraditional marks receive a lot of attention, but given their very small numbers, it isn't worth it.
- Because of those small numbers, we really shouldn't impose this on others.

- Nontraditional trademarks are functional.
- Nontraditional trademarks are subjective, what one person perceives of the sensory mark is not what others perceive.
- As such, there can be no reliable test for when the nontraditional mark is infringed or diluted.

Trademark Defined

- US: “Any word, name, symbol or device” that identifies source.
 - Has to have secondary meaning
 - Has to be capable of being graphically displayed (usually in words or musical notes, etc.)

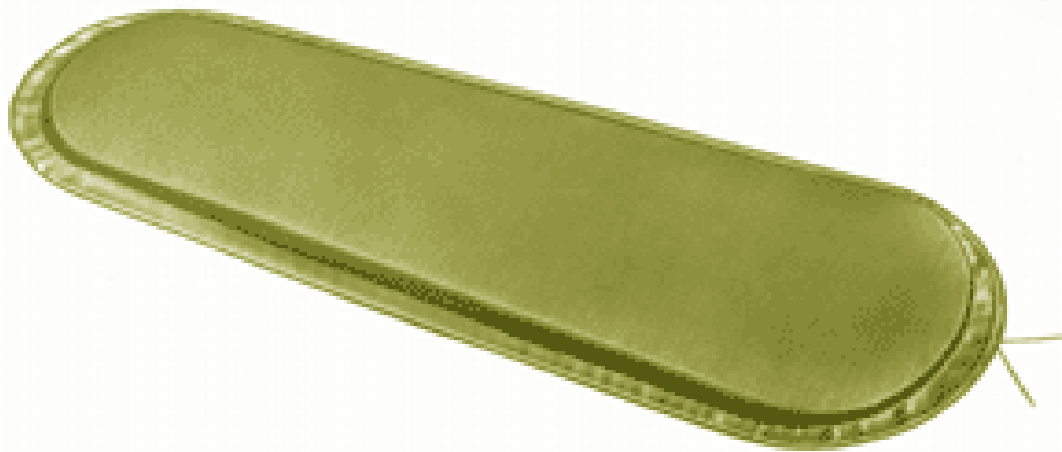
Oldest (?) Nontraditional Mark

- Serial No. 71691883 (Registered July 25, 1957).
- Granted for the motion of a coin spinning on top of a hard surface to connote a particular Bank in Duluth, Minnesota



In the US, “any” means “any”

- Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159 (1995).
- Held that color alone could be a trademark.
- That press pad’s color, devoid of any product, is Qualitex’s trademark.



Sound — NBC Chimes



United States Patent Office 916,522
Registered July 13, 1971

**PRINCIPAL REGISTER
Service Mark**

Ser. No. 349,496, filed Jan. 23, 1970

**THE MARK COMPRISES
THE MUSICAL NOTES
G, E, C PLAYED ON
CHIMES**

National Broadcasting Company, Inc (Delaware corporation)
30 Rockefeller Plaza
New York, N.Y. 10020

For: BROADCASTING OF TELEVISION PROGRAMS, in CLASS 104 (INT. CL. 38).

First use at least as early as Sept. 9, 1961; in commerce at least as early as Sept. 9, 1961.

The mark comprises a sequence of chime-like musical notes which in the key of C sound the notes G, E, C, the "G" being the one just below middle C, the "E" the one just above middle C, and the "C" being middle C, thereby to identify applicant's broadcasting service.

Owner of Reg. No. 523,616.

Scent — Plumeria Scented Yarn

- Plumeria scented yarn that came in a sealed kit to knit a skunk, In Re Clark, 17 U.S.P.Q.2d (BNA) 1238 (TTAB 1990).



Sound — Potato, Potato, Potato...

- The sound of a Harley Davidson motorcycle while on idle.
- Summer 2009 — Harley announces a deal to license the sound to Honda.



Sound — D'OH!



Other — Anthropomorphic Flowers



teleflora.

Motion — Lamborghini Doors



Sound — MGM Lion



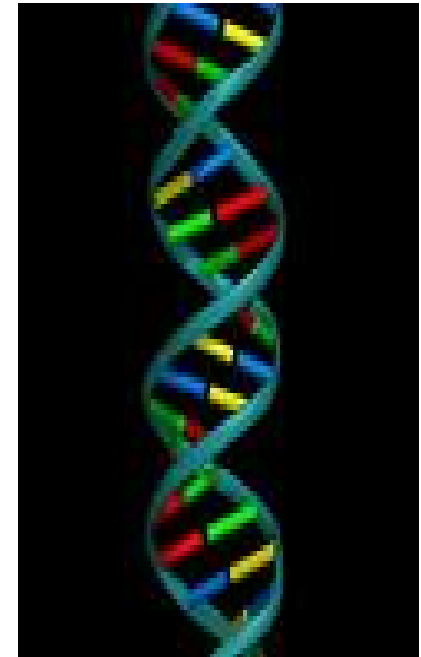
Motion — Yamaha WaveRunner Personal Watercraft Spray



Color – Boise State Blue Football Field



Other — Frank Ogden “Dr. Tomorrow”



In Frank's words:

- “I THOUGHT THAT JUST THE LOOKING AT A PERSON AND BE WILLING TO PENETRATE THEIR DNA WOULD REMOVE A LOT OF CONTROL OVER ANY TAXPAYER. I WANTED TO GET THERE BEFORE SOME BUREAUCRAT GOT A BILL PASSED FOR THAT CONTROL.”

Nontraditional applications since 1947

- **Applied 780**
- **Currently registered 452**
- **57.89%**

Abandoned Nontraditional Trademarks since 1947

- Applied for: 780
- Abandoned: 252

- 32.31%

Nontraditional Trademarks Cancelled since 1947

- Applied for: 780
- Cancelled: 90
- 11.54%

Years Pending

- **Sound: 1.97**
- **Scent: 2.2**
- **Color: 3.11**
- **Tactile: 1.57**
- **Motion: 1.67**
- **Hologram: 2.47**
- **Total average pendency: 2.59**

Litigation

- 2762 reported dispositive cases
- 30 (1.08%) of these were nontraditional marks

Success Rate

- All trademark cases since 1947: 50%
- All nontraditional trademarks: 36%

Litigation by type

- Color: 25
 - Infringed: 10
 - Not infringed: 15
- Sound: 4
 - Infringed: 1
 - Not infringed: 3
- Tactile: 1
 - Infringed 0
 - Not infringed: 1

Qualitex' (1995) Effect on Application Nos.

- Pre-Qualitex: 93
- Post-Qualitex: 687

- Per year:
 - Pre: 2
 - Post: 49

Qualitex' Effect on Litigation

- Pre: 19
- Post: 10
- Per year:
 - Pre: 2.5
 - Post: 1.5

So,

- Qualitex was a huge motivating force for trademark applications of nontraditional marks
- But had a slight chilling effect on the number of reported cases

Why?

