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"DING" YOU ARE NOW FREE TO REGISTER THAT SOUND

By Kevin K. McCormick [*]

I. INTRODUCTION

For years, the sound of an airplane cabin intercom was little more than a signal for airline passengers to use the lavatory, turn on electronics, or remove a seatbelt. Enter Southwest Airlines and now that same "Ding" signals much more.

In early July 1997, Southwest Airlines launched a new ad campaign, which included commercials ending with a "Ding" and the tagline "You Are Now Free to Move About the Country," which has produced unimaginable returns. By March 2004, the Southwest "Ding" and tagline had become so prevalent that the airline decided to register the sound as an inherently distinctive service mark, and rightfully so.[1] Only a month earlier, Southwest launched another ad campaign to announce its new service into Philadelphia, with one spot simply consisting of people saying "Ding," while two others consisted of consumers and Southwest employees repeatedly saying "Ding," and then touting the benefits of flying Southwest.[2]

On February 28, 2005, Southwest introduced "DING!" computer software, which informs customers with the same "Ding" sound and a small desktop icon that new "DING!" fares are available for sale at Southwest.com.[3] Simply put, the sound of "Ding" has become one of the most identifiable designations of Southwest Airlines' services.

In a display of true one-upmanship, or perhaps pure competitive imitation, American Airlines announced, in July 2005, the introduction of a six-note signature sound that evolved from the theme music of American's recent "We Know Why You Fly" campaign.[4] The six-note sound can be heard at the American

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1. U.S. Trademark Reg. No. 2927617.

2. Mindy Charski, *GSD&M Introduces Southwest to Philadelphia*, Adweek.com, January 22, 2004; Lewis Lazare, *The Ding's The Thing In Latest Southwest Ad*, Chicago Sun-Times, Jan. 27, 2004, at 51.

3. Joe Sharkey, *Memo Pad*, N.Y. Times, Mar. 1, 2005, at C8.

4. Lewis Lazare, *5-Year-Old Tiger Too Cute For 60-Second Ad*, Chicago Sun-Times, July 15, 2005, Financial Section.

Airlines website, within in-flight entertainment systems, and by customers on hold with reservations operators.[5]

The use of sound is not restricted to the commercial airline industry, nor is it restricted to the United States. Intel, Yahoo! and McDonald's have registered sound marks in numerous countries throughout the world.[6] European airline EasyJet has introduced its "Come on, let's fly!" melody to every customer contact location and electronics company Siemens has developed a sound following the Fibonacci sequence of numbers for every aspect of its business.[7]

The reality is that sound is everywhere. Whether it be through ring tones, pop-up ads, television, movies, or music via mobile devices, considerable money is spent so that products and services can be seen and *heard*.

Although Southwest found immediate and lasting success in creating and using "Ding" as an indicator of source, and numerous others have followed suit by introducing sound marks, such use of sound cannot be considered revolutionary. Sound in advertising has been around since the introduction of electronic media.

MGM began using the roar of a lion to signal the beginning of its movies in 1924.[8] NBC radio first used its chimes in 1927.[9] Award-winning jingle composer and producer Steve Karmen notes that on December 24, 1928, "Have You Tried Wheaties?" was the first time U.S. radio audiences heard an advertising jingle, or as Karmen describes it, "an original happy melody written about a product or service that extols the benefits, qualities, and excitement that come[s] from owning or using that product."[10]

On the most basic level, sound transcends languages. The crow of a rooster sounds exactly the same even if the word

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5. *Id.*; Eric Torbenson, *American Goes Sonic With Signature Jingle*, The Dallas Morning News, July 22, 2005, at 2d.

6. *See, e.g.,* Australian Trademark Reg. No. 827728, CTM Reg. No. 1772086, New Zealand Trademark Reg. No. 610421, U.S. Trademark Reg. No. 2442140 (Yahoo!'s signature "yodel" sound); Australian Trademark Reg. No. 844282, CTM Reg. No. 3481744, U.K. Trademark Reg. No. 2147828, New Zealand Trademark Reg. No. 283397, U.S. Trademark Reg. No. 2315261 (Intel Corp.'s signature sound for its microchips); Australian Trademark Reg. No. 1019361, CTM Reg. No. 3903101, New Zealand Trademark Reg. No. 714400, U.S. Trademark Reg. No. 3034331 (musical score of McDonald's Corp.'s "I'm Lovin' It" ad campaign).

7. Ruth Mortimer, *Sonic Branding: Branding the Perfect Pitch*, Brand Strategy, Feb. 7, 2005, 2005 WLNR 1805102. The Fibonacci sequence is a series of numbers in which each number is the sum of the two preceding numbers. Siemens' sound mark uses notes and pitch to replicate that sequence.

8. *See* U.S. Trademark Reg. No. 1395550.

9. *See* Expired U.S. Trademark Reg. No. 523616.

10. Steve Karmen, *Who Killed the Jingle? How a Unique American Art Form Disappeared* 9, 21 (Hal Leonard Publishing 2005) (quoting an unnamed source who was a long-time agency music director).

describing that sound has numerous translations.[11] Sound is the only human sense that causes activity in both hemispheres of the brain, and can influence how people react and behave.[12] In Las Vegas, the sound of dropping coins can be heard everywhere—even though electronic, credit-vouching slot machines replaced coin-operated slots years ago—because the sound of players winning entices more people to play.[13]

Choosing to adopt a sonic indicator of source seems to be a smart choice because "sound can immediately convey source-indicating qualities."[14] Imagine the mid-1960s, with millions of homes filled with millions of eager viewers watching one of three network television broadcasts, and the impact of a jingle, tagline, or unique sound. A company's advertisement would be seen by the entire nation and within the span of a week the sonic indicator of source would be ingrained into everyone's mind. Such well-known sounds as the "Nationwide Is on Your Side" musical sequence,[15] the Green Giant's "Ho-Ho-Ho,"[16] the Pillsbury Doughboy's "Hee-Hee,"[17] and AAMCO Automotive's "Double A [Honk Honk] M C

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11. *See generally*, notes 50-53 and accompanying text.

12. Mortimer, *supra* note 7 (citing a recent study using sound to affect behavior in which French or German style music were played in the wine aisles of supermarkets, and whichever type of music was played, that type of wine outsold the other considerably).

13. *Id.*

14. Erik W. Kahn, *On the 'Net, Unusual Marks Gain in Importance*, Nat'l L.J., Oct. 19, 1998, at C13 (stipulating that sound may be inherently distinctive as compared to scent and color because consumers cannot tell at the outset of a product whether the scent and/or color is being used as a trademark).

15. U.S. Trademark Reg. No. 2827490 (owned by Nationwide Mutual Insurance Company, used for insurance, financial, lending, and brokerage services). Nationwide Insurance commercials vary as to content, depending upon the type of service the advertisement is aimed at promoting. All advertisements end, however, with the musical sequence above.

16. U.S. Trademark Reg. No. 2519203 (owned by General Mills Marketing, Inc., used for canned and frozen vegetables and entrees consisting primarily of rice, pasta, or vegetables). The "Green Giant" is the representative character for Green Giant Brand vegetables. He is a large, green-skinned man with hair made of leaves wearing a toga, also made of leaves, who says nothing but "Ho-Ho-Ho" in a deep, low voice at the end of advertisements.

17. U.S. Trademark Reg. No. 2692077 (owned by The Pillsbury Company, used for various consumer products including watches, key chains, cookie jars, and Christmas tree ornaments and dolls). The Pillsbury Doughboy is the representative character for Pillsbury Brand baking items. He is a tiny but pudgy baker, made entirely of white dough. He wears a bandana around his neck and a baker's cap. Throughout Pillsbury commercials, the Doughboy walks and talks with humans while extolling and enjoying the products. Typically at the end of the commercial, the human extends an index finger and playfully pushes the Doughboy in the stomach, causing the Doughboy to smile and giggle "Hee-Hee" like a child that has been tickled.

O"[18] entered living rooms in the United States this way, and they all have remained unchanged since their initial airings.

Consider the modern situation; global media sums it up nicely. Digital technology allows proprietors to confront consumers with advertisements promoting their products or services from across the globe. The use of sound as a method of distinguishing one's products or services is an obvious progression. Surprisingly, however, recognizing sounds as trademarks has really only occurred in recent years, and as a result, only a small number of these sounds have been registered as trademarks.

II. THE REGISTRATION PROBLEM

In the past, the absence of recognizing sounds as trademarks could be blamed on technology. Until the 1970s, when innovations like multi-track tape machines became readily available to advertisers, sounds were original, custom-made, and typically jingles.[19] As a result, copyright law provided the primary, and for most of the world only, form of protection.

A 1960 report for the Benelux countries vaguely but succinctly stated the reality of the era: the legislature did not yet intend to include sounds into the definition of a trademark because of the technological difficulties present in registering and publishing such marks; however, the definition was left broad and without any restrictive language so that upon the development of the technology, sounds could be considered as marks.[20]

By 1978, ten sound mark applications had been filed in the world, all in the United States, but these applications had little effect on other countries recognizing sounds as trademarks. Even the introduction of the electronic synthesizer in the 1980s could not change this phenomenon; only 14 sound mark applications were filed during the entire decade, only one of which occurred outside the United States.[21] By the 1990s, however, the rise of

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18. U.S. Trademark Reg. No. 2144306 (owned by AAMCO Transmissions, Inc., used for automobile repair services). AAMCO Automotive commercials describe in detail the need to have the transmission of personal automobiles checked regularly, all ending with the tagline above.

19. *See, e.g.,* Karmen, *supra* note 10, at 19, 97-98.

20. *Shield Mark BV v. B. Kist*, 1999 WL 1400066 (Hof (NL)), [2000] E.T.M.R. 147 Case No. 95/260, Court of Appeal, The Hague, (May 27, 1999).

21. *See* Canadian Trademark Reg. No. 359318 (owned by Capital Records, Inc., used for records, audio and video tapes, motion picture film, and professional electronic and engineering services in the field of sound monitoring and duplication for others). Oddly enough, this trademark was filed in Canada based off of the U.S. registration for the mark, registered in 1986. *See* U.S. Trademark Reg. No. 1413137. Surprisingly, however, the Canadian trademark was automatically expunged on March 24, 2005 due to failure to renew.

digital media, coupled with the adoption of several new trademark systems, brought about an explosion of sound mark applications.[22]

By the mid-1990s, two[23] significant sound mark legal systems began to develop: descriptive representation systems[24] and graphic representation systems.[25] Within these systems, only two types of sound marks were recognized, if any: unique, different, or distinctive sounds, and commonplace sounds that have acquired distinctiveness.[26] As long as these sounds serve to indicate a source, then trademark protection should be granted. And while many countries now offer trademark protection for sounds, they still represent a minute fraction of registered trademarks throughout the world.

This article is not a procedural guide for the registration of sound marks throughout the world. Several such sources already exist.[27] Rather, this article attempts to provide an overview of sound protection, because sound, unlike other nontraditional trademarks, has been widely used to indicate source and distinguish goods, and yet has only recently been granted protection. Accordingly, this article offers a description of the basic legal frameworks for trademark protection of sounds as reflected through the treatment of sounds in the United States, the European Union, and several exemplary nations.

III. THE UNITED STATES' DESCRIPTIVE REPRESENTATION SYSTEM

The United States has been the most liberal nation in regards to recognizing the registration of sounds. Under the Lanham Act, a trademark consists of "any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish . . . goods

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22. *See infra* note 41 and accompanying text (providing the breakdown of U.S. sound mark applications and registrations since 1990); *see also infra* notes 54-56 and accompanying text (providing the breakdown of European Union sound mark applications and registrations).

23. *See infra* Part V.A. (discussing the other sound mark legal systems that exist).

24. *See infra* Part II (describing the United States and the descriptive representation system).

25. *See infra* Part III (describing the European Union and the graphic representation system).

26. *See infra* Parts II and III (explaining the differences in types of marks).

27. *See* Jerome Gilson and Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks, and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TMR 773 (2005) (providing an in-depth procedural guide for sounds as well as other nontraditional marks in the United States); *Trademarks Throughout the World Database on Westlaw* (2005) (providing the trademark procedural guidelines for almost every nation of the world); *World Trademark Law & Practice Database* on LEXIS (2005) (providing trademark procedural guidelines for almost every nation of the world).

. . . [or] services."[28] This definition has traditionally been applied to marks consisting of words, logos, and designs, and yet it has commonly been understood that due to the flexibility allotted by U.S. trademark law, as long as a mark (including sound marks) performs as an indicator of source and otherwise complies with statutory requirements, trademark protection should be granted.[29]

Sound marks are defined by the U.S. Trademark Manual of Examining Procedure (TMEP) § 1202.15 as marks that "identify and distinguish[] a product or service through audio rather than visual means," thus no drawing need be submitted with the application, only a specimen, a description of the mark, and proof of use.[30] Taken together, this represents a descriptive representation system, in which the description of the mark as applied to the goods or services controls for the registration of the mark.

Put another way, because the actual sound cannot be represented visually, the U.S. system recognizes the description of the sound in the application as the accepted scope of the mark being sought.[31] Accordingly, sound marks have been registered with descriptions using onomatopoeia, listed musical notes, and simple declaratory phrases, but generally there is no preferred method for the description of a sound.

What is generally accepted, however, is that sound marks represent a slight departure from traditional trademark law because:

> . . . unlike the case of a trademark which is applied to the goods in such a manner as to create a visual and lasting impression upon a purchaser or prospective purchaser encountering the mark in the marketplace, a sound mark depends upon aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so

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28. 15 U.S.C. § 1127.

29. *In re General Electric Broadcasting Co.*, 199 U.S.P.Q. 560, 562-63 (T.T.A.B. 1978). Nontraditional marks include product designs, product configurations, trade dress, color, scent, taste, touch, and sound. Many types of nontraditional marks have been extensively discussed elsewhere. *See* Thomas P. Arden, *Protection of Nontraditional Marks* 1 (2000); Jeffrey S. Edelstein and Cathy L. Lueders, *Recent Developments in Trade Dress Infringement Law*, 40 IDEA 105 (2000); Joseph J. Ferretti, *Product Design Trade Dress Hits the Wall . . . Mart:* Wal-Mart v. Samara Brothers, 42 IDEA 417 (2002); Gilson and Gilson LaLonde, *supra* note 27.

30. *See generally* TMEP §§ 807.09, 808, 1202.15.

31. *See, e.g., Kawasaki Motors Corp. v. H-D Michigan, Inc.*, 43 U.S.P.Q.2d 1521 (T.T.A.B. 1997) (stating succinctly the descriptive representation system): "[W]hen registration of a sound mark is sought, the sound itself is not on the copy of the drawing sheet that is placed in the index of pending applications; nor will the sound be on the registration certificate that may eventually issue. Thus, the description of the sound is the only means for presenting, in any printed record, the essence of the mark."

> inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck.[32]

In other words, because of their nature, sound marks require proof of distinctiveness, or in the alternative, proof of secondary meaning, before being entitled to registration. But a different spectrum of distinctiveness than that applied to traditional marks is followed. The U.S. Trademark Trial and Appeal Board (TTAB) has defined the spectrum as the distinction between "unique, different, or distinctive" sounds on the one hand and "commonplace" sounds on the other hand.[33] It must be noted that no explanation of this distinction has been made in the United States, only that the former are inherently distinctive and thus do not require secondary meaning, while the latter require secondary meaning.[34]

In addition, although the TTAB has explained the basic requirements for sound marks, it has merely stated how sounds *may* function as indicators of source, without providing examples of proper sound marks or providing reasons to deny sounds trademark protection.

Several U.S. tribunals have provided examples of what constitutes a proper sound mark as well as reasons to deny sounds trademark status, but only in a very limited fashion. As to the latter, two such cases have stated that a musical composition could

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32. *General Electric Broadcasting*, 199 U.S.P.Q. at 563.

33. *Id.*

34. *Id. See infra* Part IV.A. (providing Australia's attempt to define the distinction between commonplace and inherently distinctive sounds). The only other U.S. tribunal to address the distinction between the two types of sound as established by the TTAB was the United States District Court for the Eastern District of Pennsylvania in *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, in which, among other things, Ride the Ducks asserted trademark infringement for its service sound mark consisting "of a quacking noise made by tour guides and tour participants by the use of duck call devices throughout various portions of the tour" by Duck Boat Tours. 2005 U.S. Dist. LEXIS 4422, *8, 75 U.S.P.Q. 2d 1269 (E.D. Pa. 2005), *reconsideration denied by Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, 2005 U.S. Dist. LEXIS 8162 (E.D. Pa., Apr. 22, 2005), *affirmed by Ride the Ducks of Phila. LLC v. Duck Boat Tours, Inc.*, 2005 U.S. App. LEXIS 13554 (3d Cir., July 6, 2005); U.S. Trademark Reg. No. 2484276. Despite the apparent opportunity to further delineate the distinction between "unique, different, or distinctive" sounds and "commonplace" sounds, the District Court simply found that "Quacking is the kind of familiar noise that would not . . . qualify as so inherently distinctive that proof of secondary meaning is not necessary. . . ." *Ride the Ducks*, 2005 U.S. Dist. LEXIS 4422 at *23-24. Regardless of the fact that the *Ride the Ducks* court created a seemingly higher burden of proof by stating the burden as "*so* inherently distinctive," such a finding provides little guidance for sound mark applicants or opposers regarding inherently distinctive sounds (emphasis added).

not serve as a trademark for itself,[35] while two others found that a signature song performed by a single person cannot serve as a trademark for that performer.[36]

The most thorough of these cases, *Oliveira v. Frito-Lay, Inc.*, also asserted that there was no reason why a musical composition could not serve as an indicator of source.[37] Citing the U.S. Supreme Court's reference to NBC's chimes in *Qualitex Co. v. Jacobson Products Co.*,[38] the circuit court characterized the chimes as a brief musical composition consisting of three sounds, set to a specific tempo, in a specific order, and played by a specific instrument.[39] Extrapolating those characteristics, the circuit court recognized that jingles were common advertising tools that certainly served as indicators of source and thus deserved protection.[40]

Notwithstanding the long presence of sound in American media, there have been a mere 276 sound mark applications filed in the United States under the Lanham Act since 1947, 254 since 1990, of which there are 99 live registered sound marks, 85 of which have been registered since 1995, and 93 of which have been registered since 1990.[41] Nationwide, Pillsbury and AAMCO, despite establishing use in the 1960s and 1970s, have only applied

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35. *EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopolous Inc.*, 228 F.3d 56, 64 (2d Cir. 2000); G.M.L., Inc., v. Mayhew, 188 F. Supp. 2d 891, 897 (Mid. Dist. Tenn. 2002).

36. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2001); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970).

37. *Oliveira*, 251 F.3d at 61.

38. 514 U.S. 159 (1995).

39. *Oliveira*, 251 F.3d at 61.

40. *Id.* at 61-62, n.1 (referencing the William Tell Overture for the Lone Ranger, *see* U.S. Trademark Reg. No. 2155923; "Sweet Georgia Brown" for the Harlem Globetrotters, *see* U.S. Trademark Reg. No. 1700895; "My Beer is Rheingold the Dry Beer," "See the U.S.A. in Your Chevrolet," "You Deserve a Break Today—At McDonalds," "Double your pleasure, double your fun with . . . Doublemint Gum," "Um, Um, good; Um, Um, good; that's what Campbell's soups are, um, um, good," "Try Wildroot Cream Oil, Charley. Start using it today," "When you see the three-ring-sign, Ask the man for Ballantine," "Chock Full o' Nuts is that heavenly coffee," "National Shoes ring the bell," Alka-Seltzer's "Plop, plop, fizz fizz, oh what a relief it is," "Spud cigarettes are cooler than cool," as well as the theme songs of the "I Love Lucy" show, "The Honeymooners," "Sesame Street," "Mr. Rogers' Neighborhood," and "The Sopranos."). Although the *Oliveira* court went to great lengths to reference these memorable advertising jingles that deserved protection, only two of those jingles have actually been registered.

41. *See also* Trademark Electronic Search System (TESS) (search under "6[md]," which is the mark drawing code for situations in which no drawing is possible). The figures provided herein are approximates. First, because numerous sound marks are currently applied for, so the figures rise consistently. Thus, the figures represented above are only accurate as of April 23, 2006. Second, sound marks are not always catalogued accurately and categorically by the USPTO, so the actual number of sound-based marks may be higher than the number of marks found while searching under the mark drawing code for situations in which no drawing is possible.

for and been granted registrations for their sounds since the late 1990s.[42] NBC waited 20 years to register the chimes for radio[43] and almost 25 more to register the same chimes for NBC television.[44] MGM waited over 60 years to register the lion roar.[45] American Airlines has yet to even submit an application for registration. A similar phenomenon occurs abroad as well.

IV. THE EUROPEAN UNION'S GRAPHIC REPRESENTATION SYSTEM

Over the past 100 years, concerted efforts have been made to synchronize the intellectual property laws of the various countries of the world. These efforts have successfully led to international treaties and conventions on intellectual property, including trademarks, aimed at making as close to a uniform system of registration as possible.[46] However, because the intellectual property laws of each country developed domestically at first, the process of harmonization has been a long and constant struggle. Numerous countries recognize sounds as trademarks, albeit for various reasons and to varying degrees, while others simply do not or may not. And while the move to recognizing sounds as trademarks should be applauded, such variety creates complications because all efforts to harmonize must remain subservient to the disparate ways sounds are treated domestically.

In that regard, the European Union can be considered a microcosm. Different national standards of trademark law slowed the free flow of products and ideas and perpetuated a lack of competition in pre-EU Europe. In response, the European Union went to great lengths to harmonize the trademark laws of its member states and created an independent and autonomous

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42. AAMCO applied for registration in 1996, which was granted in 1998. Pillsbury applied for registration of "Ho-Ho-Ho" in 1999 (granted in 2001), and filed for the "Hee-Hee" in 2000 (granted in 2003). Nationwide did not apply until 2003, obtaining registration in 2004. *See* U.S. Trademark Reg. Nos. 2144306, 2519203, 2692077, 2827490, respectively. Pillsbury recently assigned its interest in the "Ho-Ho-Ho" mark to General Mills Marketing Inc., on May 14, 2004. U.S. Trademark Reg. No. 2519203.

43. *See* Expired U.S. Trademark Reg. No. 523616. Registered as the first ever sound mark in 1947.

44. U.S. Trademark Reg. No. 916522. Registered in 1971. The description of the mark is actually "a sequence of chime-like musical notes which are in the key of C and 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." *Id.*

45. U.S. Trademark Reg. No. 1395550. MGM applied for registration in 1985 and was granted registration in 1986.

46. *See, e.g.,* The Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement; the 1994 Trademark Law Treaty (TLT); the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks; the Madrid Protocol; and the Paris Convention of 1883.

Community Trade Mark (CTM) system, to which it now accords direct access by acceding to the Madrid Protocol as a unitary contracting party. Complications have arisen regarding sounds, however, because of the adoption and disparate interpretations of the term "graphic representation" by the European Court of Justice (ECJ), the Office of Harmonization for the Internal Market (OHIM), and national trademark offices.

Very similar to the Lanham Act in breadth, the First Council Directive to Approximate the Laws of the Member States Relating to Trade Marks ("Directive") and the Community Trade Mark Regulation (CTMR) both define trademarks as "any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings."[47]

In the CTM and the national systems within the European Union, trademark rights are acquired by registering the graphic representation of the sign.[48] The purpose of graphic representation within the Directive and CTMR is twofold: first, to define the mark with clarity and precision so that the national and Community trade mark offices can properly examine the mark in comparison to previously registered marks and thus create a relatively precise register of trademarks; second, to make the mark self-contained, easily accessible, and intelligible to competitors and the public, thus delineating the rights held by each trademark.[49]

Such a purpose openly supports the goals of trademark and unfair competition law, but does not define a generally accepted method for the graphic representation of a sound. It could be argued that any written representation of a sound is a graphic representation of the mark because sound is aurally perceived by the public. The ECJ and OHIM, however, have taken a much more stringent line of thinking.

Graphic representation of sounds under the CTM system must be made by either "a stave divided into bars and showing, in particular, a clef . . ., musical notes and rests whose form . . . indicates the relative value and, where appropriate, accidentals,"[50]

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47. First Council Directive 89/104/EEC of 21 Dec. 1988 to Approximate the Laws of the Member States Relating to Trade Marks, Art. 2; Council Regulation (EC) No 40/94/ of 20 Dec. 1993 on the Community Trade Mark, Art. 4.

48. Institut pour la Protection des Fragrances (I.P.F.)'s Application, Case R 186/2000-4, [2005] E.T.M.R. 42, para. 15, 4th Bd. App. (Jan. 19, 2004).

49. *Sieckmann v. Deutches Patent und Markenamt*, Case C-273/00, [2003] E.T.M.R. 37, paras. 48-53 (Dec. 12, 2002).

50. *Shield Mark BV v. Joost Kist*, Case C-283/01, [2004] E.T.M.R. 33, at para. 62.

or by a sonogram with a timescale and a frequency scale.[51] Although not immediately intelligible by looking at them, both the stave and sonogram are considered clear, precise, self-contained, easily accessible, intelligible, durable, and objective because the marks are clearly defined and are intelligible with a certain amount of training and practice.

In contrast, written descriptions such as "the first nine notes of *Für Elise*" or "the sound of a cockcrow" lack precision and clarity, and thus make it impossible to determine the scope of the mark.[52] A sequence of musical notes does not provide pitch or duration, therefore defining the mark itself is impossible. Onomatopoeic representations inherently lack consistency between the onomatopoeia and the actual sound, such that it is impossible to determine if the sound is the onomatopoeia as pronounced or the actual sound. Moreover, onomatopoeic sounds can be perceived differently depending on the language in which the onomatopoeia is written.[53]

Within this framework, 52 sound CTM applications have been filed, out of which thirty-one currently sit as registered sound marks.[54] Eight applications have been filed with detailed sonograms, including four of the last five, however no sonogram-based sound mark applications have been granted registration.[55] Even more interesting, however, is the disparity that exists

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51. *Metro Goldwyn-Mayer Lion Corp's Application*, Case R-781/1999-4, 2003 WL 23721403 (TR (Stockholm)), [2004] E.T.M.R. 24, 4th Bd. App. (Aug. 25, 2003). A sonogram of this sort must not be confused with an oscillogram, which is a two-dimensional depiction of the volume of a sound; a spectrum, which is a two-dimensional depiction of the frequency changes in a sound; or a sound spectrogram, also known as a sonogram, which does not contain an analysis of the pitch, relative volume, and progression over time of the sound.

52. *See generally Shield Mark*, [2004] E.T.M.R. 33 (these were the two main trademarks that were at issue in the case).

53. *See, e.g., Shield Mark BV v. Joost Kist*, 2003 WL 100628 (ECJ), [2003] E.T.M.R. 64, Case C-283/01, Op. Advocate Gen., Apr. 3, 2003, at n.11 (noting that the onomatopoeia of a cockcrow, which was at issue in the case, has various pronunciations among languages, including: *kikeriki* (German), *kikeli-ki* (Danish), *quiquiriqul* (Spanish), *kukkokiekuu* (Finnish), *cocorico* (French), *kokoriko* (Greek), *cock-a-doodle-do* (English), *chicchirichi* (Italian), *kukeleku* (Dutch), *cocorococo* (Portuguese), and *kukeliku* (Swedish)).

54. As of April 21, 2006.

55. *See* CTM Nos. 4987178, 4983128 (both owned by Comptoir Francais de L'Interphone SAS, used for apparatuses made for the recording, transmission, and reproduction of sounds and images; telecommunications devices); 4928371 (owned by Mast-Jägermeister AG, used for alcoholic beverages, advertisement and promotional services, telecommunications, as well as film, video, and television production and publication services), 4901658 (owned by Inlex Conseil, used for subscription services, communications services, and legal services), 3886471, 3699204 (both owned by Hexal Aktiengesellschaft, used for pharmaceutical and veterinarian products), 3661329 (owned by Edgar Rice Burroughs, Inc., used for wide range of products and services in Classes 9, 16, 25, 28, 38, 41, and 42), and 2919967 (owned by Head Sport Aktiengesellschaft, used for tennis racquets and tennis balls (application withdrawn)).

between the national and CTM systems in recognizing sounds, despite the fact that the CTM system and national systems were intended on being mirror images of one another.[56]

In accordance with the Directive, EU member states began amending their trademark laws in the early and mid-1990s, but due to the nature of EU membership, the implementing legislations of the member states produced various trademark systems based on the general definition of a mark from the Directive. For instance, the German, French, and Italian responses to the Directive all explicitly stated that sounds may be registered as trademarks, whereas the United Kingdom's implementing legislation did not specifically enumerate sound at all (although it certainly provided the possibility of registering sounds by stating that use of a mark may be by means other than graphic representation).[57] Irrespective of these differences, sounds were accepted as registrable throughout the EU member states and registrations began throughout the European Union.[58]

Germany maintains by far the largest number of national sound mark registrations, with approximately 166 since 1995.[59] Interestingly enough, Germany had originally accepted sonograms as a permissible method of graphic representation for sound mark applications, but due to the *Sieckmann* decision, sonograms are no longer recognized as proper.[60] Such is the nature of trademark law in the European Union.

Due to the autonomy of the CTM system, OHIM's decision in *MGM* regarding the use of sonograms is inapplicable to the national systems because the holding of the *MGM* decision has not

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56. An EU directive merely binds member states to the results to be achieved by the directive, and thus the exact terms used in a directive are not required to be a part of each member states implementing legislation. In the case of the Directive, a uniform trademark system based on graphic representation was sought to be achieved, with each member state given the autonomy to write the precise language of the legislation. An EU regulation, on the other hand, directly binds all member states to the exact terms of the regulation, and is directly applicable to all member states. Thus, even though the CTMR and the Directive were passed by the EU with the exact same language, so as to be mirror images of one another, that certainly has not been the result.

57. *See* United Germany Trademark Law, Art. 3 (enacted January 1, 1995); French Trademark Law No. 91-7 (enacted January 4, 1991); Italian Trade Mark Law, Royal Decree 929 of June 21, 1942, as revised by Legislative Decree 480 of December 4, 1992, Art. 16; U.K. Trade Marks Act 1994, §§ 1(1), 103(2). The Italian, Portuguese, Greek, and Austrian implementing legislations also expressly provided for the registration of sounds.

58. *See, e.g.,* Finnish Trademark Reg. No. 136107 (owned by Ingman Foods OY AB, registered in 1995); French Trademark Reg. No. 94543458 (owned by Metro-Goldwyn-Mayer Corp, registered in 1998); Spanish Trademark Reg. No. 2466884 (owned by Galletas United Biscuits S.A., registered in 2002).

59. As of April 23, 2006.

60. *See* http://www.dpma.de/veroeffentlichungen/mitteilungen/mittlg2003_08.html (providing a notice from the President of the German Patent and Trademark Office indicating that sonograms would no longer act as proper graphic representation for sounds).

been adopted by the ECJ. Moreover, the *Shield Mark* court was unable to address the issue of sonograms because Shield Mark had not applied for a sound mark in the form of a sonogram.[61] Therefore, two separate and distinct systems currently exist in the European Union in spite of all efforts to harmonize.

Take, for instance, the United Kingdom, which has five registered sound marks. This number could fall because one registration preceded the *Sieckmann* and *Shield Mark* holdings that established the scope of graphic representation, and the mark now fails under those holdings because the representation is merely a written description.[62] This mark could not be saved with an amendment because there would be no way to represent the mark graphically. However, the proprietors could alternatively file for a CTM based on a sonogram and receive EU-wide protection. Such a result cannot be what was intended by implementing the Directive and the CTMR, but such a result need be respected under the current EU systems.

V. THE PRACTICAL GUIDE

As noted, sounds represent an almost infinitesimal number of registered trademarks throughout the world. Nonetheless, sounds can immediately indicate source and have a lasting impact on consumers. The choice to adopt a sonic signature should therefore not be taken lightly. Regardless of the type of representation system, a sound will fail as a mark if it does not satisfy the basic legal requirements of a mark as established by each state. Generally speaking, this means distinguishing goods or services and not succumbing to one of the many grounds for refusal of registration. With that in mind, practitioners should be advised of the following issues and concerns regarding sounds.

A. International Law

Because of the universal nature of sound and the advent of digital technology, sounds can be heard all over the world. Globalization has allowed advertising for goods and services to reach far beyond the markets in which those products and services currently are available. Therefore, knowing which states recognize sounds as marks, and the best method for obtaining protection in

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61. *Shield Mark BV v. Joost Kist*, Case C-283/01, 2003 WL 99949 (ECJ) [2004] E.T.M.R. 33, para. 54 (Nov. 27, 2003).

62. *See, e.g.,* United Kingdom Trademark Reg. No. 2007456 (the sound of a dog barking)(owned by Imperial Chemical Industries PLC, used for paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants and raw natural resins).

those states, will be important to anyone using a sonic signature. In this era of globalization, merely knowing that a state does or does not recognize sound marks will not be determinative on where to apply for a sound mark. International, regional, and even bilateral trade agreements often determine if, and sometimes when, a country may recognize sound as a mark.

It should be noted that there are technically more than just two legal systems that recognize and/or deal with sounds as trademarks throughout the world. A third legal system, the so-called "visible-sign" system, requires that all trademarks be two- or three-dimensional signs that can be perceived visibly by consumers. Such a trademark system can be imposed according to TRIPS Article 15.1.

Many visible-sign countries, like Egypt, China and Saudi Arabia, expressly prohibit the registration of sounds in their trademark laws because a sound cannot be a visible sign in and of itself. Other countries, like Brazil and Iceland, arguably prohibit the registration of sounds by maintaining a strict definition of "perceived visibly." Some visible-sign states, interestingly enough, have recently executed bilateral trade agreements with the United States, which state that either sound marks will be recognized as valid marks entirely, or that the requirement that marks be "visually perceived" will be removed from the domestic trademark law.[63] What is of more interest, however, is that because these are bilateral agreements, this new recognition of sounds as trademarks does not have to be given to other foreign trademark applicants.

A fourth type of legal system can be found in Australia. Australia requires the submission of both a graphic representation and a description of the mark for registration. This hybrid representation system has been one of the more active in recognizing sounds: fifty-six sound mark applications have been

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63. The United States, for instance, has executed bilateral trade agreements with several visible-sign countries, which state that either sound marks will be recognized as valid marks (Chile, Dominican Republic, Costa Rica, El Salvador, Guatemala, Honduras, and Nicaragua) or that the requirement that marks be visually perceived will be removed from the trademark laws of the signatory countries (Peru, Bahrain, Morocco). *See generally* United States-Chile Free Trade Agreement; Agreement Between the Government of the United States of America and the Government of the Kingdom of Bahrain on the Establishment of a Free Trade Area of June 18, 2004; The Central America-Dominican Republic-United States Free Trade Agreement of August 5, 2004 (Central America includes Costa Rica, El Salvador, Guatemala, Honduras, and Nicaragua); The U.S.-Peru Trade Promotion Agreement of December 7, 2005; and The U.S.-Morocco Free Trade Agreement of March 8, 2004. Some of these countries, like Morocco, have gone so far as to completely amend their trademark laws to explicitly recognize the registrability of sound marks. Law No. 31-05 amends and supplements Law No. 17-97 on the Protection of Industrial Property in Morocco. Morocco has chosen, it should be noted, to follow a strict graphic representation system, requiring the submission of a musical composition for sound marks. *Id.*

filed in Australia since the passage of the Trade Marks Act 1995, 25 of which have been registered.[64] What makes Australia even more interesting is its interpretation of graphic representation.

Graphic representation rather generically means represented by symbols in the form of diagrams and/or writing.[65] In other words, the graphical representation of a sound mark may be a simple verbal description of the sound,[66] the sound written out via musical stave,[67] or even, oddly enough, the name of a specific piece of music, if accompanied with additional information.[68] The definition of graphical representation is rather lax in that most Australian sound mark applications and registrations merely state "The Trade Mark is as described in the endorsement," with the endorsement containing the required written description of the mark.[69] In fact, the Australian system is so lax that often the graphic representation and the description together provide little guidance as to what comprises the sound mark.[70]

Outside of these other sound mark systems, applicants should be cognizant of the many regional trademark and intellectual property agreements that specifically address sound that could determine where to file for a sound mark. The only regional agreements to actually create uniformity with regard to sounds

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64. As of April 23, 2006.

65. *See* Australian Trademark Examination Manual Part 21(5.1), *available at* http://xeno.ipaustralia.gov.au/D:Exmanual/pt20_29/part21.htm (explaining that because graphic representation is not defined judicially or statutorily, the most appropriate definition should then come from the common, ordinary meaning of the term, which, according to the *Macquarie Dictionary* defines "graphical" as the equivalent of "graphic," which means "2. pertaining to the use of diagrams, graphs, mathematical curves, or the like; diagrammatic. 3. pertaining to writing: graphic symbols," and defines "represent" as "1. to serve to express, designate, stand for, or denote, as a word, symbol, or the like; symbolise. 2. to express or designate by some term, character, symbol or the like: to represent musical sounds by notes").

66. *See, e.g.,* Australian Trademark Reg. No. 759707 (AH MCCAIN (PING) YOU'VE DONE IT AGAIN, owned by McCain Foods, used for frozen vegetables and fruits and other prepared frozen foods).

67. *See, e.g.,* Australian Trademark Reg. No. 844282 (owned by Intel Corp., used for computer hardware and software products).

68. *See* Australian Trademark Examination Manual Part 21(6.1), *available at* http://xeno.ipaustralia.gov.au/D:Exmanual/pt20_29/part 21.htm (providing an example of a suitable endorsement of a graphic representation that merely names a specific piece of music).

69. *See, e.g.,* Australian Trademark Reg. No. 738848 (owned by Pacific Brands Clothing Pty, used for floor coverings and underlay).

70. *See, e.g.,* Australian Trademark Reg. No. 876931 (containing the following endorsement: "The trade mark is a SOUND mark. The musical notation contained in schedule 1 is a representation of the piece of music which comprises the sound mark. The sound mark is used in the course of trade. The pitches and approximate tempo are indicated in the musical notation contained in schedule 1. The sound mark will consist of a loop recording of a performance of the piece of music as annotated in schedule 1 and as captured on the diskette in schedule 2.").

have been in the European Union, and even that system still contains several disparities. The Andean Community of Nations explicitly recognizes sounds as trademarks, but filing must be done in each member state; all registration grants is the right to priority based on the first registration.[71] The African Intellectual Property Organization (OAPI) explicitly refuses to recognize sounds as trademarks altogether.[72] The Banjul Protocol for the African Regional Industrial Property Organization (ARIPO) recognizes audible signs, but only a few members of ARIPO have acceded to the Protocol.[73] Three of the four members of MERCOSUR explicitly recognize sounds as trademarks, while the fourth, Brazil, may assent to these types of marks, depending on the Brazilian interpretation of "perceived visibly," but MERCOSUR has not even contemplated recognizing sounds.[74]

Last, but certainly not least, is the effect international agreements, most notably the Madrid System for the International Registration of Marks, have on sound mark registration decisions. While the Madrid Agreement and the Madrid Protocol do not make substantive changes in trademark law, their procedural effect is what causes concern for sound mark registrations. For instance, whereas the recent accession to the Madrid Protocol by the United States and European Union has been praised by proponents of trademark unification, the efficiency and ease by which international registrations may be sought is not commonly found with sound marks.

The primary concern for sound mark applicants is the requirement under the Madrid Protocol that the reproduction of the mark be *identical* to the reproduction in the basic application

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71. Andean Community members include: Bolivia, Colombia, Ecuador, Peru, and Venezuela. *See* Cartagena Agreement, preamble.

72. OAPI members include: Benin, Burkina Faso, Cameroon, Central Africa, Congo, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, Senegal, Chad, and Togo. *See* Bangui Agreement revising the Libreville Agreement of 1972, signed March 2, 1977. For more information on the OAPI, *see* www.oapi.wipo.net.

73. ARIPO members include: Botswana, The Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe. *See* Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO), Art. IV. For more information on ARIPO, *see* www.aripo.org. Banjul Protocol on Marks members include: Botswana, Lesotho, Malawi, Namibia, Swaziland, Tanzania, Uganda and Zimbabwe. *See* Banjul Protocol on Marks, preamble. Under the Banjul Protocol on Marks, audible signs "include sounds transcribed in musical notes or other symbols[,] e.g. [t]he cry of a cow." *See* Marks Registrable under the Banjul Protocol, *available at* http://www.aripo.org/Marks.html. Potential member states who now have observer status but are not controlled by any ARIPO protocols are: Angola, Algeria, Burundi, Egypt, Eritrea, Ethiopia, Liberia, Libya, Mauritius, Nigeria, Rwanda, Seychelles, South Africa, and Tunisia. *See* Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO), Art. VI.

74. MERCOSUR members include: Argentina, Brazil, Paraguay, and Uruguay. *See* Treaty of Asunción, signed March 16, 1991.

or basic registration. Because the Madrid Protocol did not alter any domestic trademark laws, the representation system of each state will control for international registrations. Taken as a whole, therefore, choosing to file a sound mark registration outside of one's home state means a decision will have to be made as to how the sound will be represented in the home application in comparison to the countries in which the sound is sought to be registered. The question thus arises as to what "identical" really means.

In the European Union, audio recordings are not accepted as part of the application, whereas Australia requires eight (8) separate recordings for distribution to each Australian sub-office, and Norway requires a sample in MP3 format. Morocco requires fifteen (15) prints of the mark, not to exceed 8x8 centimeters.[75] The written description defines the scope of protection in the United States, however, nothing within the U.S. trademark system would prohibit an application including the representation of a sound via a stave, it would merely be superfluous information to the USPTO examination.

If an applicant is considering registering internationally, the domestic application would require much more reflection and analysis to complete compared to registering domestically only. In a system based on priority, filing a complete application is necessary, but so too is making the most out of one's budget and proposed needs. A U.S.-based applicant, for instance, would have to determine whether to file with just a written description or include a graphic representation, if available; whether to submit a sample recording, in what form of media, and in what format; and whether to describe the mark in broad terms, by onomatopoeia, or by a simple declaratory name or phrase.

The odds are simply against a U.S.-based sound mark application seeking international registration in numerous countries via the Madrid Protocol. The more likely result would be filing several applications: a CTM application for protection in any EU member state, an international application in descriptive representation states, and national applications in all other states that recognize sounds.

Notwithstanding the hassle of determining which type of application to file for each state, the concern here is that multiple applications with different representations actually defeats the purpose of these trademark agreements. The goal of the Madrid Protocol and the other agreements is to provide efficiency,

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75. Law No. 31-05 amending and supplementing Law No. 17-97 on the Protection of Industrial Property in Morocco.

uniformity, and specificity in the registration of trademarks. Having applicants file selectively is undoubtedly a step backward.

B. Distinctiveness

The ability of a mark to distinguish the goods or services of one against another lies at the heart of trademark law. As noted, sounds have been used since the introduction of electronic media to distinguish products and services, but to garner trademark protection, a sound must also be distinctive, either inherently or through secondary meaning. In the United States, secondary meaning for sounds has been described as whether consumers "recognize and associate the sound with the offered services . . . exclusively with a single, albeit anonymous, source."[76] In the European Union, secondary meaning has not been defined specifically for sounds, but it is generally understood that acquired distinctiveness under Article 3(3) of the Directive is whether a mark identifies the product or service as originating from a particular source.[77]

What is not wholly clear is what exactly constitutes an inherently distinctive sound. In the United States, sounds are distinguished as "unique, different, or distinctive" or "commonplace" but no delineation of the two categories has ever been provided. The sound of a quacking noise made by duck call devices and the ringing of a ship's bell have been found to be commonplace, but without discussion.[78] Moreover, neither the ECJ nor OHIM has determined whether sounds can be inherently distinctive, despite the fact that every registered sound CTM has registered without proof of secondary meaning. Australia has defined commonplace sounds as those "which other traders are likely to want to use for their similar goods," and has even gone so far as to provide cogent examples of what constitutes commonplace. However, Australia has not elaborated on the amount of evidence needed to show acquired distinctiveness.[79]

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76. *In re General Electric Broadcasting Company, Inc.*, 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978).

77. Joint cases C-108/97 and C-109/97, May 4, 1999, *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v. Boots-und Segelzubehor Walter Huber (C-108/97) and Franz Attenberger (C-109/97)*, [1999] ECR I-2779.

78. *See General Electric Broadcasting*, 199 U.S.P.Q. at 563; *Ride the Ducks, L.L.C. v. Duck Boat Tours, Inc.*, 2005 U.S. Dist. LEXIS 4422, *8, 75 U.S.P.Q. 2d 1269 (2005).

79. *See* Australian Trademark Examination Manual Part 21(6.2.3), *available at* http://xeno.ipaustralia.gov.au/D:Exmanual/pt20_29/part 21.htm (referencing the following examples of commonplace sounds that would require secondary meaning to be registered: Strauss Waltzes of Tango music for dancing tuition; combination of barnyard sounds for farming services, stock food, and pet food; sound of a child giggling or laughing for childcare services or pediatric medical services; sound of a ringing cash register with words "best value, lowest prices" for retailing services; three blasts on a referee's whistle for sporting

For the most part, applicants should not be wary that the distinction between "unique, different, or distinctive" and "commonplace" remains amorphous. Traditional trademark law shares a similar distinction between suggestive and descriptive marks. Several commentators have gone so far as to suggest that because non-traditional marks, such as sounds, have been rarely used, consumers will not look at them as indicators of source on their own, and thus should always require secondary meaning.[80] Such an argument has merit but is misplaced.

Whereas other nontraditional marks have only recently been used to distinguish goods and indicate source, sound has been used to do so for most of the past century. A distinction should be made between trademark use and seeking trademark protection. As noted, due to technological limitations and acceptable trademark subject matter according to domestic trademark systems, sound mark protection was nearly unobtainable until the 1990s throughout the world, especially when excluding the United States from the analysis. That says nothing as to how sounds have been used in the marketplace. Sounds that can immediately convey the source of a product or service to consumers should certainly be considered inherently distinctive, even if defining them is presently difficult.[81]

C. Functionality

As with all other trademarks, sounds can distinguish and be distinctive yet still fail as marks if the sound falls under one of the many grounds for refusal found under trademark law. Outside of likelihood of confusion, functionality is the only refusal worth mentioning for sounds.[82]

The functionality doctrine actually comprises two theories, utilitarian functionality and aesthetic functionality, both of which are keys to understanding nontraditional marks.[83] Utilitarian functionality defeats a mark containing a product feature that "is

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goods and bags; and sound of vehicle motor starting up and running, with descriptive words for vehicle sales, automotive repair, and maintenance).

80. *See, e.g.,* Mark Lawry and Jeremy Dickerson, *The Curse of Invisibility*, Trademark World 26 (2004); Seiko Hidaka, et al., *A Sign of the Times? A Review of Key Trade Mark Decisions of the European Court of Justice and Their Impact upon National Trade Mark Jurisprudence in the EU*, 94 TMR 1105 (2004); Ilanah Simon, *ECJ Decisions Reveal Tension Over Registrability*, 149 Managing Intell. Prop. 55 (2005).

81. *See* Kahn, *supra* note 14 and accompanying text.

82. Likelihood of confusion is mere conjecture at this stage. Not only is there a dearth of case law but also a small number of sound marks that are registered. As a result, there is as of yet no structure in place to define what elements of a sound are used to determine similarity.

83. *See generally* Allan Zelnick, *The Doctrine of Functionality*, 73 TMR 128 (1983).

essential to the use or purpose of the article or . . . affects the cost or quality of the article."[84] An aesthetically functional mark does not focus on the utility of a product, but rather on an aesthetic element that makes the product more attractive to consumers yet is essential to the commercial success of the product.[85] Both are intended to ensure fair competition, whether for utility or for attraction.

Harley-Davidson applied to register "the exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines when the goods are in use" in the United States, and was opposed by nine other motorcycle companies.[86] The opposing parties argued that the exhaust sound was purely functional, merely the sound produced by any engine of that type.

The question of whether the Harley exhaust sound was functional was never decided. Harley abandoned its application in June 2000, after spending hundreds of thousands of dollars in litigation.[87] Regardless, the issue of functionality should give one pause when contemplating a sound mark. There are many products and services that create a unique sound that consumers recognize as indicating source. The question then becomes how functional is that sound when produced.

Southwest's "Ding" comes from the sound of its airplane intercom system. That "Ding" heard over a radio or television commercial identifies Southwest Airlines rather clearly and concisely. Do consumers think of Southwest when pressing the intercom while riding in an American Airlines airplane? In fact, while airplane manufacturer Boeing customizes various elements

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84. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, n.10 (1982). Factors often used to evaluate the utilitarian functionality of a mark were first enunciated by Judge Rich in *In re Morton-Norwich Products Inc.*, 671 F.2d 1332 (C.C.P.A. 1982), as follows: 1. The existence of a utility patent which discloses the utilitarian advantages of the design is evidence of "functionality;" 2. The existence of any advertising or promotion of the proponent of trademark rights which touts the functional and utilitarian advantages of the very design aspect it now seeks to protect; 3. The existence of other alternative designs which perform the utility function equally well; and 4. Whether or not the design results from a comparatively simple, cheap or superior method of manufacturing the article.

85. Chad T. O'Hara, *Product Configuration, Dilution, and Fair Use*, SG080 ALI-ABA 469, 471 (2002).

86. *See Kawasaki Motors Corp. v. H-D Michigan, Inc.*, 43 U.S.P.Q.2d 1521 (T.T.A.B. 1997); *Honda Giken ogyo Kabushiki Kaisha v. H-D Michigan Inc.*, 43 U.S.P.Q.2d 1526 (T.T.A.B. 1997).

87. Joseph Diamante and Darren W. Saunders, *If Harley-Davidson Has its Way, the Resounding Roar that its Motorcycles Make Could Become a Registered, Protected Sound Under the U.S. Trademark Act*, Nat'l L.J., Nov. 6, 1995, at B5. David A. Kessler and Steven J. Wadyka, Jr., *You've Got Mail*: *Protecting Synthesized Speech From Unauthorized Exploitation*, Intell. Prop. Strategist, Sept. 2001. Interestingly, however, the Australian Trademark Office advises that the sound of a motorbike engine is a functional sound, seemingly deciding the Harley-Davidson case against the sound. *See* Australian Trademark Examination Manual Part 21(6.2.1).

of its aircrafts, it does not currently offer a customized sound for the cabin intercoms.[88] Thus, the Southwest "Ding" sounds exactly like an American "Ding," but it is tenuous at best to argue that Southwest has appropriated an element of airline services that is necessary for competitors to compete.

Car manufacturers are also cognizant of how their products sound. Whether it be the sound of the horn, the doors closing, or the engine revving, sound plays an integral role in the development and sale of automobiles. Again, if the sound leads to consumer recognition of source, sound mark status may arise. But out of these sounds, which one would give the holder a monopoly over an element that is necessary for competitors to compete? Which sound has a utility? Most of these sounds are actually made to be distinct from competitors, or are not integral to the product or services provided. Recognizing the difference is the key to avoiding considerable registration and opposition costs.

VI. CONCLUSION

This article has provided an explanation and overview of the different types of systems for registering sound marks, and the inherent difficulties with international systems and harmonization. The fact remains that "sound can immediately convey source-indicating qualities,"[89] and as globalization and digitization grow accordingly, proprietors must ensure their products and services are distinguished from competitors. As more and more countries begin to recognize nontraditional trademarks, the methods of distinguishing products and services increase. A likely, and seemingly obvious, evolution is using sound as an indicator of source. Knowing how and where sound marks fit within these legal systems can help you find your own "Ding."

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88. Interview with Cindy Wall, Boeing Commercial Airplanes Representative, August 9, 2006.

89. Kahn, *supra* note 14, at C13.