

## **A NEW PAGE IN THE PLAYBOOK: NONTRADITIONAL TRADEMARKS IN THE SPORTS INDUSTRY**

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### **I. INTRODUCTION**

Winning coaches and athletes know that opportunism and adaptation in the heat of competition can be the key to victory. Likewise, trademark-savvy companies in the sports industry should exploit new marketing opportunities to compete effectively in the marketplace.<sup>4</sup> Now more than ever, nontraditional trademarks present an opportunity for sports-industry “players” to protect and leverage colors, sounds, scents, and other unique source identifiers to promote and differentiate their products in an increasingly competitive market.

### **II. THRESHOLD REQUIREMENTS OF NONTRADITIONAL MARKS: NONFUNCTIONALITY AND DISTINCTIVENESS**

The United States has taken a comparatively expansive view of what can qualify as a protectable trademark. The federal trademark act (the Lanham Act) uses the broadest possible

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<sup>4</sup> The term “sports industry” is used in this article in a broad sense to include mainstream “ball” sports (e.g., football, basketball, tennis) as well as motor sports (e.g., auto racing), outdoor sports (e.g., hunting and fishing), pub sports (e.g., darts), and other relevant activities.

terms to delineate the range of trademark subject matter.<sup>5</sup> Still, two key criteria must be met before trademark protection is granted. The matter must be (1) nonfunctional and (2) distinctive (either inherently or through an acquired “secondary meaning”).

**A. Functionality**

Matter is considered functional if it (1) is essential to the use or purpose of the device, or (2) affects the cost or quality of the device.<sup>6</sup> The functionality doctrine prevents trademark owners from stifling competition by obtaining perpetual patents. As explained by the Supreme Court, functionality balances the trademark law’s goal of promoting “competition by protecting a firm’s reputation,” against the patent law’s goal of encouraging “invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation.”<sup>7</sup> Once found functional, matter is not protectable as a trademark under any circumstances.<sup>8</sup>

**B. Distinctiveness**

A trademark may be distinctive in one of two ways: it may be “inherently distinctive,” or it may have acquired distinctiveness through what is known as “secondary meaning”—consumer recognition that the mark identifies a product’s source, rather than the product itself or a feature of the product.<sup>9</sup>

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<sup>5</sup> See 15 U.S.C.A. § 1125(a) (defining a trademark to include “any word, term, name, symbol, or device, or any combination thereof.”)

<sup>6</sup> See *TrafFix Devices, Inc. v. The Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982)).

<sup>7</sup> *Qualitex v. Jacobsen Prods. Co.*, 514 U.S. 159, 164-65 (1995).

<sup>8</sup> See *TrafFix*, 532 U.S. at 33.

<sup>9</sup> See *Inwood*, 456 U.S. at 851, n.11.

The inherent distinctiveness of “traditional” word marks is examined by placing the term along a spectrum with the following categories: fanciful, arbitrary, suggestive, descriptive, or generic.<sup>10</sup> Nontraditional trademarks, however, do not fit neatly into these categories, if at all. Consequently, for some matter, such as color, taste, and scent, a bright-line rule has been established that inherent distinctiveness cannot exist. For other matter, such as sound, there is hope, as these marks can be considered inherently distinctive.

The burden of proving the secondary meaning of nontraditional marks is high. Courts and the Patent and Trademark Office often look to the following in determining whether a particular mark has acquired secondary meaning: (1) long use, (2) sales success, (3) substantial advertising expenditures, (4) advertising stressing the source-identifying function of the mark, (5) unsolicited media coverage, (6) requests from third parties for licenses, (7) intentional copying by a defendant or other competitors, and (8) survey evidence.<sup>11</sup>

### **III. COLOR MARKS**

Colors hold a special place in sports. After all, without established uniform colors, for example, athletes might be forced to rely solely on the less-than-ideal “shirts and skins” system of team differentiation.<sup>12</sup> And college football’s Famous Idaho Potato Bowl would not be the same without Boise State University’s trademark bright-blue Bronco Stadium turf.<sup>13</sup>

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<sup>10</sup> Generic terms can never be protected as trademarks, descriptive terms can only be protected if they have acquired “secondary meaning,” and suggestive, arbitrary, and fanciful terms are considered inherently distinctive and entitled to immediate protection. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992).

<sup>11</sup> See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 15:30 (4th ed. 2001).

<sup>12</sup> See *Univ. of Alabama Board of Trustees v. New Life Art Inc.*, 677 F. Supp. 2d 1238, 1247 n.15 (N.D. Ala. 2009) (uniform colors serve functional purpose of team differentiation similar to “shirts and skins”).

<sup>13</sup> U.S. Reg. No. 3,707,623. See registration chart in Section III (E) below.

Historically, however, courts refused to grant trademark protection to color marks.<sup>14</sup> Courts rejected attempts to protect colors such as red for the bottom portion of soup cans,<sup>15</sup> green for farm machinery,<sup>16</sup> and red stripes for fishing tackle boxes,<sup>17</sup> for fear of “color depletion”<sup>18</sup> and/or “shade confusion.”<sup>19</sup>

This changed in 1985, when the U. S. Court of Appeals for the Federal Circuit held that the color pink was protectable for Owens-Corning’s “Pink Panther” fiberglass insulation.<sup>20</sup> Shortly after *Owens-Corning*, the Eighth Circuit protected the color blue for leader splicing tape for photographic development.<sup>21</sup> But not all courts followed. In *NutraSweet Co. v. Stadt Corp.*, the Seventh Circuit denied protection of the color blue for single-serving sugar substitute packets, holding that “as a rule, color cannot be monopolized to distinguish a product.”<sup>22</sup> And in

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<sup>14</sup> *Id.* at § 7:41.

<sup>15</sup> *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795 (3d Cir. 1949) (“If [plaintiffs] may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out.”).

<sup>16</sup> *Deere & Co. v. Farmhand Inc.*, 560 F.Supp. 85 (S.D. Iowa 1982) *aff’d*, 721 F.2d 253 (8th Cir. 1983).

<sup>17</sup> *James Heddon’s Sons v. Millsite Steel & Wire Works*, 128 F.2d 6, 9 (6th Cir. 1942) (“Color, except in connection with some definite, arbitrary symbol or in association with some characteristics which serve to distinguish the article as made or sold by a particular person is not subject to trademark monopoly.”).

<sup>18</sup> The concern over “color depletion” is that if one of many competitors can appropriate a particular color as a trademark, the supply of colors will soon be depleted. *See Leshen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 172 (1906) (“[Y]ou can not register a mark of which the only distinction is the use of a color, because practically, under the terms of the act, that would give you a monopoly of all the color of the rainbow.”).

<sup>19</sup> The concern over “shade confusion” is that slight variations between color shades and tones (caused, for example, by lighting conditions) make it difficult to properly adjudicate the likelihood of confusion between color marks.

<sup>20</sup> *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

<sup>21</sup> *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993).

<sup>22</sup> *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990).

*Qualitex*, the Ninth Circuit similarly held that the Lanham Act does not permit the registration of “color alone” as a trademark.<sup>23</sup> With circuits split on the issue of whether color *per se* is protectable, the stage was set for Supreme Court intervention.

In 1995, the Supreme Court resolved the split by holding that a single product color could be registered and protected as a trademark.<sup>24</sup> Interestingly, the case that shepherded the issue did not involve a color mark recognizable to the general public. Rather, it involved a special shade of green-gold for dry cleaning press pads, which had been used since the 1950’s and which apparently had acquired distinctiveness in the dry cleaning industry.<sup>25</sup> In finding this and other colors capable of protection, the Court noted that both the language of the Lanham Act, “which describes that universe [of protectable marks] in the broadest of terms,” and the basic underlying principles of trademark law, would seem to include color, particularly given that the PTO and the courts have protected things such as the shape of a Coca-Cola bottle,<sup>26</sup> the sound of NBC’s three chimes,<sup>27</sup> and the scent of plumeria blossoms on sewing thread.<sup>28</sup> The Court addressed the concern over “shade confusion” by noting that courts “traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse, buyers,” and thus can apply the same standards to color, “replicating, if necessary,

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<sup>23</sup> *Qualitex Co. v. Jacobsen Prods. Co.*, 13 F.3d 1297 (9th Cir. 1994).

<sup>24</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>25</sup> *Id.* at 166.

<sup>26</sup> Reg. No. 696,147 (Apr. 12, 1960).

<sup>27</sup> Reg. No. 916,522 (July 13, 1971). *See* discussion *infra* Part III (discussing sounds as trademarks).

<sup>28</sup> *In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990). *See* discussion *infra* Part IV (discussing scents as trademarks).

lighting conditions under which a colored product is normally sold.”<sup>29</sup> The Court also addressed the concern over “color depletion” by noting that when “a color serves as a mark, normally alternative colors will likely be available for similar use by others.”<sup>30</sup> Further, if a problem of “color depletion” or “color scarcity” arises, the Court noted that the doctrine of functionality would apply and prevent the anticompetitive consequences of protecting a particular color.<sup>31</sup>

**A. Functionality of Color Marks**

In *Qualitex*, the Supreme Court noted that “sometimes color plays an important role (unrelated to source identification) in making a product more desirable.”<sup>32</sup> In such cases, courts have found colors functional, sometimes under the doctrine of “aesthetic functionality.”<sup>33</sup> For example, in *Brunswick Corp. v. British Seagull Ltd.*, the court held that the color black on outboard motors created a “competitive need” because it had the visual effect of decreasing the apparent size of the motor and because it was compatible with many different boat colors.<sup>34</sup> In another case, the Trademark Trial and Appeal Board found there was a competitive need for a color because it was the natural by-product of an industry’s manufacturing process.<sup>35</sup> There, the

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<sup>29</sup> *Qualitex*, 514 U.S. at 167.

<sup>30</sup> *Id.* at 168.

<sup>31</sup> *Id.* at 169.

<sup>32</sup> *Id.* at 165.

<sup>33</sup> Under the doctrine of aesthetic functionality, visually attractive designs that serve no source-identifying function, and which are necessary for competition, are categorized as “functional,” and thus unprotectable. MCCARTHY, *supra* note 8, § 7:79.

<sup>34</sup> *Brunswick Corp. v. British Seagull Ltd.*, 35 F.2d 1527 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995).

<sup>35</sup> *Saint-Gobain Corp. v. 3M Co.*, 2007 WL 2509515 (T.T.A.B. Aug. 31, 2007) (finding that the applicant had failed to demonstrate acquired distinctiveness and non-functionality for the color purple).

Board held that the color purple was functional and unregistrable for sandpaper because a dark color, such as purple, was a natural by-product of the abrasive manufacturing process, and was often used in the industry to fill in uneven color patterns and for product coding.<sup>36</sup>

Where a color improves product safety, mostly through enhanced visibility, courts have deemed the color functional. For example, in *In re Orange Communications, Inc.*, the Trademark Trial and Appeal Board held that the colors yellow and orange for public telephones and telephone booths were functional because they were “more visible under all lighting conditions in the event of an emergency.”<sup>37</sup> And in *In re Howard S. Leight & Associates Inc.*, the Board held the color coral functional for earplugs, because its increased visibility made safety checks easier.<sup>38</sup> In the sports context, a specific bright color for referee uniforms might face a high functionality hurdle based on safety considerations.

A recent case examined the functionality of a color mark in the sports industry. In *Unique Sports Prods., Inc. v. Ferrari Importing Co.*<sup>39</sup>, the court held that plaintiff’s light-blue color mark for tennis-racket grip tape<sup>40</sup> was nonfunctional and thus protectable.<sup>41</sup> The court analyzed functionality under the traditional test discussed above as well as the “competitive necessity” test. Under the competitive necessity test, a product feature is functional if the exclusive use of that feature would put competitors at a “significant non-reputation-based

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<sup>36</sup> *Id.* at \*31 (citing *Qualitex*).

<sup>37</sup> 41 U.S.P.Q.2d 1036 (T.T.A.B. 1996).

<sup>38</sup> 39 U.S.P.Q.2d 1058 (T.T.A.B. 1996).

<sup>39</sup> 2011 WL 284442 (N.D. Ga. Jan. 24, 2011).

<sup>40</sup> U.S. Trademark Reg. No. 2428076. See registration chart in Section III (E) below.

<sup>41</sup> *Id.* at \*2-3.

disadvantage.”<sup>42</sup> The court held that the light-blue color of plaintiff’s racket-grip tape was nonfunctional under both tests. First, under the traditional test, the court held that there was no evidence that the light-blue color improved the performance of racket-grip tape.<sup>43</sup> Second, under the competitive necessity test, the court held that the mere popularity of the color light blue for racket-grip tape “does not indicate that the color itself is functional,” especially because other colors of racket-grip tape were among defendant’s best-selling products.<sup>44</sup> Finally, the court held that genuine issues of material fact remained on the questions of secondary meaning and infringement.<sup>45</sup>

## **B. Distinctiveness of Color Marks**

Once the Supreme Court settled that color can be protectable, the question still remained as to whether color could be inherently distinctive. Some read the Court’s *Qualitex* opinion as ambiguous on this issue.<sup>46</sup> The Supreme Court resolved any doubt in the subsequent *Wal-Mart v. Samara* case by noting that single-color marks should not be considered inherently distinctive, and therefore can be protected and registered only upon a showing of secondary meaning.<sup>47</sup> The Court reasoned that “with product design, as with color, consumers are aware of the reality that, almost invariably, a feature is intended not to identify the source, but to render the product itself

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<sup>42</sup> *Id.* citing *Dippin’ Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1203 (11th Cir. 2004).

<sup>43</sup> *Id.* at \*3.

<sup>44</sup> *Id.*

<sup>45</sup> *Id.* at \*5-8; *see also* discussion of subsequent decision in *Unique* case at p. 10 *infra*.

<sup>46</sup> MCCARTHY, *supra* note 8, § 7:44. *See, e.g.,* Jordan & Jordan, *Qualitex Co. v. Jacobson Products Co., The Unanswered Question: Can Color Ever Be Inherently Distinctive?* 85 TRADEMARK REP. 371, 298 (1995) (arguing that, “The Supreme Court’s decision cannot be read to summarily deny the possibility that color can ever be inherently distinctive”).

<sup>47</sup> *Wal-Mart Stores Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

more useful or more appealing.”<sup>48</sup>

### C. Color Cases in the Sports Industry

In an early color-mark case in the sports industry, the Southern District of New York blocked the American Basketball Association’s (“ABA”) shot at injunctive relief against a basketball manufacturer for copying its red, white, and blue color-scheme for basketballs.<sup>49</sup> The court blew the whistle on the ABA’s alleged color mark, holding that the red, white, and blue-colored basketball panels were mere ornamentation and decoration of the ordinary basketball design.<sup>50</sup> The court further held that the ABA could not establish secondary meaning of its alleged color mark for a number of reasons. First, the ABA dropped the ball on its secondary-meaning survey—the court rejected the survey as too flawed to be given substantial weight.<sup>51</sup> Second, the court held that the manufacturers’ logos on the basketballs, rather than the ABA’s color scheme, identified the source of the balls. Finally, the court found that the ABA never held itself out as the source of the products.<sup>52</sup> Accordingly, the court denied the ABA’s request for injunctive relief.

A recent case served up the issues of acquired distinctiveness and infringement of a single-color mark used for tennis-racket grip tape. In the “second set”<sup>53</sup> of *Unique Sports*

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<sup>48</sup> *Id.* at 205.

<sup>49</sup> *American Basketball Association v. AMF Voit, Inc.*, 358 F. Supp. 981 (S.D.N.Y. 1973).

<sup>50</sup> *Id.* at 985.

<sup>51</sup> The court held that the survey universe was “too narrow to allow the survey to be given any substantial weight” because it was limited to males between the ages of 12 and 23 who had played basketball within the last year, and did not make any attempt to include “those who would actually purchase basketballs.” *Id.* at 986.

<sup>52</sup> *Id.* at 985-87.

<sup>53</sup> See discussion of earlier decision in *Unique* case, *supra* pp. 7-8.

*Products, Inc. v. Ferrari Importing Co.*,<sup>54</sup> the Northern District of Georgia held following a non-jury trial that Unique’s light-blue racket-grip tape had acquired distinctiveness, but that it was not likely to be confused with defendant’s different shade of blue racket-grip tape. Specifically, the court found that Unique’s light-blue grip tape had acquired distinctiveness based on decades of use, large advertising expenditures, advertising emphasizing the light-blue color of the tape, and high-profile endorsements.<sup>55</sup> The court held that defendant’s blue grip tape was not likely to cause consumer confusion, however, because defendant’s tape was a “very distinguishable” shade of blue, the two tapes had a very different “feel” (i.e., smooth v. “woven”), and the parties’ tapes served different purposes (i.e., plaintiff’s “overgrip” tape provided thick cushioning and absorbed moisture while defendant’s “gauze” tape was intended solely to improve grip).<sup>56</sup> Accordingly, the court entered judgment in favor of Unique on Ferrari’s affirmative defenses that Unique’s single-color mark was invalid and unenforceable, but in favor of Ferrari on Unique’s claim of infringement.<sup>57</sup>

Color-mark litigation in the sports industry raced beyond the realm of sports equipment in two recent cases addressing sports uniform and/or team colors. In *Bd. of Supervisors of LA State Univ. v. Smack Apparel Co.*,<sup>58</sup> the Fifth Circuit held that unauthorized use of school colors, together with other indicia (e.g. the Universities’ sports accomplishments or geographic location) constitutes trademark infringement, even if the school is not named and no other school-related

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<sup>54</sup> 2011 WL 5156798 (N.D.Ga. Oct. 27, 2011).

<sup>55</sup> *Id.* at \*2-3.

<sup>56</sup> *Id.* at \*3-4.

<sup>57</sup> *Id.* at \*5.

<sup>58</sup> *Bd. of Supervisors of LA State Univ. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008).

marks or logos are included.<sup>59</sup> Several universities (namely, Louisiana State University, University of Oklahoma, Ohio State University, and the University of Southern California) brought a trademark infringement action against Smack Apparel Company alleging that Smack’s use on t-shirts of the respective school-color schemes, together with other facts about each school, created a likelihood of confusion.<sup>60</sup> The Universities, each with established and successful athletic programs, particularly football, argued that Smack’s t-shirts impermissibly competed with the Universities’ own licensed shirts and other merchandise.<sup>61</sup> The District Court agreed, granting summary judgment to the Universities and holding that Smack’s use of the color schemes and other indicia constituted trademark infringement.<sup>62</sup> The Fifth Circuit affirmed the district court’s decision.<sup>63</sup> Notably, however, the court did not rule on the use of team/uniform colors *per se*. As such, this was not a pure color-marks case. Instead, the court evaluated the use of colors together with the other indicia, and held that this combination was both protectable and infringed, even where neither the name of the school nor any other trademark was used.<sup>64</sup>

In *Univ. of Alabama Board of Trustees v. New Life Art Inc.*<sup>65</sup>, the Northern District of Alabama held that the University of Alabama held “weak” trademark rights in its football team uniform colors, but that defendant’s unlicensed paintings using the colors to depict historic

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<sup>59</sup> *Id.* at 471.

<sup>60</sup> *Id.* at 471-72.

<sup>61</sup> *Id.* at 472.

<sup>62</sup> *Id.* at 473-74.

<sup>63</sup> *Id.* at 471.

<sup>64</sup> *Id.*

<sup>65</sup> *New Life*, *supra* note 11.

scenes of plaintiff's football team were not infringing as protected artistic expression under the First Amendment.<sup>66</sup> The court in *New Life* rejected the University's position that the uniform color mark was inherently distinctive and strong, allowing only that it may have acquired secondary meaning "in some quarters."<sup>67</sup> The court noted that crimson is a common variation of the red color used by many sports teams and that the colors serve a functional purpose of distinguishing the team from its opponent.<sup>68</sup>

On appeal, the Eleventh Circuit affirmed the district court's First Amendment holding, avoiding any affirmative ruling on the strength of plaintiff's uniform-color mark.<sup>69</sup>

The *Smack Apparel* and *New Life* decisions cast doubt on whether a team's uniform colors, standing alone, can acquire sufficient distinctiveness such that strong trademark rights arise. Accordingly, brand owners seeking to protect uniform-color marks *per se* should take the field at the PTO or the courts with their game face on.

#### **D. Registration of Color Marks**

The PTO permits the registration of color marks, including single color marks that cover the entire surface of the goods, a portion of the goods, or all or part of the packaging for the goods. This includes service marks, which may consist of color applied to all or part of materials used in the advertising and rendering of the services. The TMEP notes that color, whether a single color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as

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<sup>66</sup> *Id.* at 1259.

<sup>67</sup> *Id.* at 1246.

<sup>68</sup> *Id.* at 1247.

<sup>69</sup> *University of Alabama Board of Trustees v. New Life Art, Inc.*, \_\_\_ F.3d \_\_\_, 2012 WL 2076691, at \*9 (11th Cir. June 11, 2012).

an ornamental feature of the goods or services. As such, the PTO never views a color mark as inherently distinctive, and Examining Attorneys are instructed to refuse registration on the Principal Register unless the applicant establishes that the color mark has acquired distinctiveness.<sup>70</sup>

The burden of proving that a color mark has acquired distinctiveness is substantial. If distinctiveness is not proven (or cannot be proven), a color mark may be registerable on the Supplemental Register.<sup>71</sup>

**E. Examples of Color-Mark Registrations in the Sports Industry**

The following are examples of color marks in the sports industry that have been registered with the U.S. Patent and Trademark Office:

<b>Color Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
Blue	Entertainment services, namely, the presentation of intercollegiate sporting events and sports exhibitions rendered in a stadium, and through the media of radio and television broadcasts and the global communications network	3,707,623	11/10/2009	Boise State University
Yellow	Plastic baseball bats	3,579,003	2/24/2009	The Wiffle Ball, Inc.
Red	Parts for recreational	3,096,959	5/23/2006	Clark Seals, Ltd.

<sup>70</sup> See TMEP § 1202.05(a); see also *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985) (the color pink, as uniformly applied to fibrous glass residential insulation, shown to have acquired distinctiveness as a trademark for the goods); *In re Benetton Group S.p.A.*, 48 U.S.P.Q.2d 1214 (T.T.A.B. 1998) (evidence insufficient to establish that green rectangular background design had acquired distinctiveness as applied to clothing and footwear); *In re Am. Home Prods. Corp.*, 226 U.S.P.Q. 327 (T.T.A.B. 1985) (tri-colored, three-dimensional circular-shaped design found to have become distinctive of analgesic and muscle relaxant tablets); *In re Star Pharm., Inc.*, 225 U.S.P.Q. 209 (T.T.A.B. 1985) (evidence found insufficient to establish that two-colored drug capsules and multi-colored seeds or granules contained therein had become distinctive of methyltestosterone).

<sup>71</sup> See TMEP § 1202.05(a).

	vehicles, namely fork seals in bicycles and motorcycles			
Purple	Land vehicle suspension parts, namely, coil springs for use on racing vehicles	2,984,371	8/9/2005	Draco Spring Manufacturing Company, Inc.
Dark green	Ammunition, namely, shotshells	2,673,478	1/14/2003	RA Brands, L.L.C.
Light blue	Grip tape for sports rackets	2,428,076	2/13/2001	Unique Sports Products, Inc.

**F. Examples of Color-Mark Registrations in Other Industries**

The following are examples of color marks in other industries that have been registered with the U.S. Patent and Trademark Office:

<b>Color Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
Green-gold	Dry-cleaning pads	1,633,711	2/5/1991	Qualitex Company
Pink	Fibrous glass residential insulation	1,439,132	5/12/1987	Owens-Corning Fiberglas Corp.
Robin's Egg Blue	Jewelry, watches and clocks	2,416,794	1/2/2001	Tiffany and Co.
Canary yellow	Stationery notes containing adhesive on one side for attachment to surfaces	2,390,667	10/3/2000	3M Company
Pink	Gloves for medical and dental use	3,172,669	11/14/2006	Top Quality Manufacturing Inc.
Brown	Transportation and delivery of personal property by air and motor vehicle	2,901,090	11/9/2004	United Parcel Service
Blue	Transportation of passengers and/or goods by air, namely, aircraft charter services	3,128,225	8/8/2006	Helicopter Consultants of Maui, Inc.
Gray	Herbicides for domestic use	2,950,645	5/10/2005	Oms Investments, Inc.
Orange	Promoting public awareness of at-risk animals	3,153,771	10/10/2006	Rational Animal
Yellow	Food delivery services	3,123,698	8/1/2006	Schwan's IP, LLC
White	Reciprocating saw blades	1,456,144	9/8/1987	Irwin Industrial Tool Company
Black and Orange	Power tools, namely, saws	2,942,284	4/19/2005	The Black & Decker Corporation

#### IV. SOUND MARKS

Some sounds familiar to sports fans may not be considered pleasing to the ear (e.g., the shrill whistle of a referee, or the buzzing *vuvuzela* horns played in the stands at the 2010 FIFA World Cup in South Africa) and thus might not make for attractive trademarks. Nevertheless, sound marks can become valuable and unique assets for brand owners in the sports industry.

The standards for the protection of sound marks were articulated in the oft-cited case *In re General Electric Broadcasting Co., Inc.*<sup>72</sup> That case involved an application to register a mark consisting of the sound made by a ship's bell clock, which was used to toll time in radio broadcasts.<sup>73</sup> The Board noted that, consistent with the Lanham Act's broad definition of a service mark, sounds can be registered so long as they "identify the services of one person and distinguish them from the services of others."<sup>74</sup> The Board explained, however, "a distinction must be made between unique, different, or distinctive sounds and those that resemble or imitate 'commonplace' sounds or those to which listeners have been exposed under different circumstances."<sup>75</sup> That is, "unique, different or distinctive" sounds require no proof of secondary meaning, but sounds that resemble or imitate "commonplace" sounds require such proof. The Board ultimately held that questions of fact remained as to whether the sound of a ship's bell clock had acquired secondary meaning for radio broadcasting services.<sup>76</sup>

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<sup>72</sup> *In re Gen. Elec. Broad. Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978).

<sup>73</sup> *Id.* at 561.

<sup>74</sup> *Id.* at 562.

<sup>75</sup> *Id.* at 563.

<sup>76</sup> *Id.*

Recently elaborating on the standards set forth in *General Electric*, the court in *Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, examined whether the quacking sound of duck-call devices, used by the tour guide and participants of plaintiff’s amphibious city tours, was protectable and whether a competitor infringed this mark by using duck calls in its own amphibious tours.<sup>77</sup> The court explained that the “aural perception of the listener” divides sound trademarks into two categories reminiscent of the inherently distinctive/descriptive classification used for traditional trademarks.<sup>78</sup> The first type of sound is so “inherently different or distinct 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.”<sup>79</sup> The second type is a sound that “resemble[s] or imitate[s] ‘commonplace’ sounds or those to which listeners have been exposed under different circumstances.”<sup>80</sup> The court found the quacking noise of the tours resembled a familiar sound under the latter category and accordingly, because it was not inherently distinctive, required proof of secondary meaning.<sup>81</sup> Finding that plaintiff used the quacking noise exclusively for only one full tourist season, and that plaintiff did not direct its advertising toward this sound, the court held the alleged mark non-protectable for lack of secondary meaning, and thus not infringed.<sup>82</sup> The court emphasized that there was no evidence that a person hearing a quacking noise on the streets of Philadelphia would “reflexively” think of

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<sup>77</sup> *Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, No. Civ.A.04-CV-5595, 2005 WL 670302, at \*1 (E.D. Pa. March 21, 2005).

<sup>78</sup> *Id.* at \*7.

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> *Id.* at \*8.

plaintiff's "Ride the Ducks" tours.<sup>83</sup>

In another case, coincidentally also involving ducks, a court examined whether a politician infringed or diluted plaintiff's registered sound trademark of a duck quacking "AFLAC," in a commercial that portrayed the incumbent governor Taft as a timid duck that quacked "TaftQuack."<sup>84</sup> The court noted that the "AFLAC Duck enjoys very high public recognition" and that plaintiff had an interest in protecting its investment by registering service marks, trademarks, and copyrights for its AFLAC duck commercials.<sup>85</sup> Nonetheless, the court held on a motion for preliminary injunction that plaintiff was not likely to succeed on its infringement claim. The court noted that "in only one aspect are the artistic expressions of the AFLAC Duck and TaftQuack acutely similar: the sound they make" and "whenever the TaftQuack character quacks its name, a cartoon speech balloon appears containing the word 'TaftQuack.'"<sup>86</sup> This balloon, the court reasoned, "makes it even more clear to a reasonable viewer that TaftQuack is not saying 'AFLAC' and is not the AFLAC Duck."<sup>87</sup> Finally, the court factored the lack of "competitive proximity" based on the unique nature of defendant's use of the mark in a political ad.<sup>88</sup> The court also rejected plaintiff's dilution claim on the ground that AFLAC and TaftQuack were not "virtually identical." The court did, however, find the AFLAC

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<sup>83</sup> *Id.* at \*9.

<sup>84</sup> *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682 (N.D. Ohio 2002).

<sup>85</sup> *Id.* at 686.

<sup>86</sup> *Id.* at 691.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

sound mark famous.<sup>89</sup>

In its first case analyzing sound marks after the Supreme Court's decision in *Qualitex*, the Trademark Trial and Appeal Board considered the registrability of an application for a loud, pulsating alarm sound that emanated from a child's safety bracelet.<sup>90</sup> The Board first found that *Qualitex* did not overturn *General Electric*'s holding that truly unique sounds, as opposed to commonplace sounds, could still be inherently distinctive.<sup>91</sup> Because the applied-for sound was emitted during the normal course of operation of applicant's safety bracelet, the Board held that it was the commonplace type of sound that required a showing of acquired distinctiveness for registration.<sup>92</sup> The Board further found that the applicant had failed to show that it used its sound in a source-identifying trademark manner at all.<sup>93</sup> Even though the sound was heard in applicant's advertisements, it merely emanated from the bracelets in its normal way—one that indicated imminent danger to a child.<sup>94</sup> Thus, the Board found that consumers would not perceive the sound as an indicator of source.<sup>95</sup> On these grounds alone the Board denied registration.<sup>96</sup>

The Board also considered whether the sound was functional. In so doing, it applied two

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<sup>89</sup> *Id.* at 693.

<sup>90</sup> *In re Vertex Group LLC*, 2009 WL 398091 (T.T.A.B. Feb. 13, 2009).

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

alternate tests of functionality: (1) whether the product feature was essential to the use or purpose of the product, or affected the cost or quality of the product, so that exclusive right to use it would put a competitor at a disadvantage, citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982), and (2) the four-factor test enunciated in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982).<sup>97</sup> The Board held that the loud, pulsating alarm sound was functional under either test. Applying the *Inwood* test, the Board found that the ability of applicant's products to emit a loud, pulsing sound was essential to its use as an alarm, thereby increasing its effectiveness.<sup>98</sup> Further, the Board found that competitors used loud, pulsing sounds as alarms, demonstrating competitor need.<sup>99</sup> Applying *Morton-Norwich*, the Board found that (1) applicant's utility patent application for its watch specified a decibel range for the audible alarm, (2) applicant's advertising materials clearly highlighted the loudness of the alarm, (3) registration of the sound and its broad decibel range would deprive competitors of many useful combinations of frequencies for their alarms, and (4) the sound of the alarms had no bearing on their cost or ease of manufacture (a neutral fact).<sup>100</sup> Accordingly, the Board held that the loud, pulsating sound was functional for alarm bracelets and was thus unregistrable.<sup>101</sup>

#### **A. Songs**

In addition to short sounds, advertisers have used "songs, tunes and ditties" as trademarks

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<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

in commercials on television and on the radio.<sup>102</sup> In *Oliveira v. Frito-Lay*, the singer of “The Girl from Ipanema” sought to protect that song as her “signature song” and prevent its use in a television commercial for the defendant’s “Baked Lays” potato chips.<sup>103</sup> Although it recognized that musical compositions can serve as symbols to identify the source of goods or services, the court held that a musical composition could not serve as a trademark for itself.<sup>104</sup> The court noted that expanding the scope of trademark rights to include the signature songs of artists lacked any judicial justification, particularly since the desired protection could be secured through copyright and/or contract law.<sup>105</sup>

## **B. Registration of Sound Marks**

The PTO permits the registration of sound marks.<sup>106</sup> The TMEP notes that a “sound mark identifies and distinguishes a product or service through audio rather than visual means,” and identifies the following two types of sound marks: (1) a series of tones or musical notes, with or without words, and (2) wording accompanied by music. The regulations say little else about sound marks and refer to the discussion in *In re General Electric Broadcasting Co., Inc.* for the criteria for registration of sound marks.<sup>107</sup>

The PTO does not require a formal drawing for sound marks. A specimen, however, is

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<sup>102</sup> *Oliveira v. Frito-Lay*, 251 F.3d 56, 61, n.1 (2d Cir. 2001) (noting numerous examples of advertising songs, tunes, and ditties); see MCCARTHY, *supra* note 8, § 7:104.

<sup>103</sup> *Id.* at 58 (describing commercial, which starred the famed Muppet “Miss Piggy”).

<sup>104</sup> *Id.* at 61-62 (“The fact that musical compositions are protected by the copyright laws is not incompatible with their also qualifying for protection as trademarks.”).

<sup>105</sup> *Id.* at 63.

<sup>106</sup> To listen to a broad sampling of sound marks registered with the USPTO, see <http://www.uspto.gov/web/offices/ac/ahrpa/opa/kids/kidsound.html>.

<sup>107</sup> See TMEP 1202.15.

required and may be submitted on an audio cassette, compact disk, or DVD for paper filings, or as an electronic file for applications filed online.<sup>108</sup> To show that a sound mark actually identifies and distinguishes the services and indicates their source, the specimen should contain a sufficient portion of the audio content to indicate the nature of the services. If the mark comprises music or words set to music, the applicant may also submit the musical score as a specimen.<sup>109</sup>

**C. Examples of Sound Mark Registrations in the Sports Industry**

The following are sports-industry examples of some sound marks (including songs) that have been registered with the U.S. Patent and Trademark Office:

<b>Sound Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
The SportsCenter melody	Production and distribution of television and radio entertainment and sports programs	2,450,525	5/15/2001	ESPN, Inc.
The melody “Sweet Georgia Brown”	Entertainment services in the nature of basketball exhibitions	1,700,895	1/14/1992	Harlem Globetrotters International, Inc.

**D. Examples of Sound Mark Registrations in Other Industries**

The following are other examples of some sound marks (including songs) that have been registered with the U.S. Patent and Trademark Office:

<b>Sound Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
The Pillsbury Doughboy giggle	Watches, non-metal key chains, cookie jars, Christmas tree ornaments, and dolls	2,692,077	9/4/2003	The Pillsbury Co.
The sound of a duck quacking the word	Insurance underwriting services	2,607,415	7/13/2002	AFLAC

<sup>108</sup> TMEP § 904.03(f).

<sup>109</sup> See 37 C.F.R. §§ 2.52(e), 2.56(d)(3).

“AFLAC”				
The sound of a deep male, human-like voice saying “Ho, ho, ho” in intervals with each “ho” dropping in pitch	Canned and frozen vegetables	2,519,203	12/18/2001	General Mills Marketing, Inc.
The words “STOP AT THE GREEN” superimposed over a musical jingle comprised of four notes in the key of E-flat, in the sequence of F, E-flat, C, F, and any relative equivalent thereof	Automobile service station services	2,308,299	1/18/2000	Amerada Hess Corp.
A lion roaring	Motion picture films and prerecorded video tapes	1,395,550	1/3/1986	Metro-Goldwyn-Mayer Lion Corp.
A sequence of chime-like musical notes 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	Broadcasting of television programs	916,522	1/13/1971	The National Broadcasting Company, Inc.
The audio and visual representation of a coin spinning on a hard surface	Banking services	641,872	1/19/1957	Northwestern Bank of Commerce, Inc.
The theme music for the LONE RANGER radio, film, and television series, resembling portions of the overture to the 1829 opera “William Tell,” composed by Gioacchino Rossini	Entertainment services, namely, a continuing drama show distributed over television, satellite, audio, and video media	2,155,923	5/12/1998	Classic Media, Inc.

## V. SCENT MARKS

While it seems unlikely that the pungent fragrance of a locker room will ever be registered as a trademark, you might be surprised. Indeed, the “strong smell of bitter beer” has been registered as a scent mark in the United Kingdom for flights for darts.<sup>110</sup> No matter the aroma, scent marks can be a powerful addition to the trademark lineup.

In *In re Clarke*, the Trademark Trial and Appeal Board opened the door for the protection and registration of scent marks in the U.S.<sup>111</sup> There, the Board allowed the registration of “[a] high impact, fresh, floral fragrance reminiscent of Plumeria blossoms” for “sewing thread and embroidery yarn.”<sup>112</sup> The Board found that the applicant had demonstrated that her fragrance functioned as a trademark because (1) she was the only person who marketed yarns and threads with the fragrance (and thus fragrance was not an inherent attribute or natural characteristic of her goods, but rather a feature that she supplied), (2) she emphasized and promoted the scented feature of her goods in advertising, and (3) dealers and distributors recognized scented yarns as coming from applicant.<sup>113</sup> The Board contrasted this case with one involving products noted for their fragrance, such as perfumes, colognes, or scented household products.<sup>114</sup> Indeed, in other cases, luxury perfume-makers have met with mixed results in their attempts to stop the sale of copycat perfumes.<sup>115</sup>

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<sup>110</sup> UK Reg. No. 2000234. See registration chart in Section V (B) below.

<sup>111</sup> 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990).

<sup>112</sup> *Id.*

<sup>113</sup> *Id.* at 1239-40.

<sup>114</sup> *Id.* at 1239, n.4.

<sup>115</sup> See *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968) (reversing a preliminary injunction and holding that a manufacturer could market its perfume as a duplicate of plaintiff’s perfume so long as defendant did not create a likelihood of confusion as to the source of the perfume); *Charles of the Ritz*

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**A. Registration of Scent Marks**

The PTO permits the registration of a product’s scent, so long as it is used in a non-functional manner and has acquired distinctiveness. The TMEP notes that scents that serve a utilitarian purpose, such as the scent of perfume, are functional and not registerable. The PTO will not consider a scent mark as inherently distinctive, so secondary meaning is always required. And the amount of evidence needed to establish that a scent or fragrance functions as a mark is substantial. If acquired distinctiveness is not proven, a scent may be registered on the Supplemental Register (if, of course, it is non-functional).<sup>116</sup>

**B. Examples of Scent-Mark Registrations in the Sports Industry**

The following are examples of some sports-industry scent marks that have been registered with the U.S. Patent and Trademark Office or foreign trademark offices:

<b>Scent Mark</b>	<b>Goods</b>	<b>Reg. No.(s)</b>	<b>Reg. Date(s)</b>	<b>Owner</b>
Grape; strawberry	lubricants and motor fuels for land vehicles, aircraft, and watercraft	2,568,512 2,596,156	5/7/2002 7/16/2002	Mantel, Mike dba Manhattan Oil
Cherry	Synthetic lubricants for high performance racing and recreational vehicles	2,463,044	6/26/2001	Mantel, Mike dba Manhattan Oil
“The smell of fresh cut grass”	Tennis balls	CTM No. 000428870  (European Union)	11/10/2000	Senta Aromatic Marketing

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*Group, Ltd. v. Quality King Distribs., Inc.*, 832 F.2d 1317, 1321 (2d Cir. 1987) (using the similarity of the parties’ scents as a piece of evidence to establish the similarity of the parties’ products, and affirming the lower court’s issuance of a preliminary injunction); *see also Saxony Prods., Inc. v. Guerlain, Inc.*, 513 F.2d 716 (9th Cir. 1975).

<sup>116</sup> *See* TMEP § 1202.13. The requirement for a drawing does not apply to scent marks. *Id.*; 37 C.F.R. §2.52(e).

“Strong smell of bitter beer”	Flights for darts	UK Reg. No. 2000234  (United Kingdom)	5/3/1996	Unicorn Products, Ltd.
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**C. Examples of Scent-Mark Registrations in Other Industries**

The following are examples of some other scent marks that have been registered with the U.S. Patent and Trademark Office or foreign trademark offices:

<b>Scent Mark</b>	<b>Goods</b>	<b>Reg. No.(s)</b>	<b>Reg. Date(s)</b>	<b>Owner</b>
Vanilla; apple cider; peppermint; peach; lavender; grapefruit	Office supplies, namely, file folders, hanging folders, paper expanding files	3,143,735 3,140,701 3,140,700 3,140,694 3,140,693 3,140,692	9/15/2006 9/12/2006	The Smead Manufacturing Company
Bubble gum	Oil based metal cutting fluid and oil based metal removal fluid for industrial metal working	2,560,618	9/9/2002	Midwest Biologicals, Inc.

**VI. OTHER TYPES OF MARKS**

**A. Flavor Marks**

As with the other senses, flavor sweetens the emotional appeal of sports. For example, the taste of Cracker Jack popcorn may whisk you back in time to memories of attending your first ballgame as a child.

Flavor marks, however, have not fared as well as other nontraditional marks. Recently, in a case of first impression, the Trademark Trial and Appeal Board rejected an attempt to register the flavor orange for quick-dissolving antidepressant medication on the grounds that it is

both functional and that it fails to serve as a source identifier.<sup>117</sup> The Board’s thorough discussion highlights the significant hurdles of protecting flavor marks.

Regarding functionality, the Board found that the applicant’s orange flavored antidepressants possessed utility based on “applicant’s touting of the functional nature of its orange flavor, and the lack of evidence of acceptable alternatives.”<sup>118</sup> The Board noted that applicant’s own website boasted that its product’s “pleasant orange taste” provided an “important advantage over conventional antidepressants.”<sup>119</sup> From this admission, the Board found “because the orange flavor of applicant’s medication leads to patient compliance, the orange flavor indirectly increases the efficacy of the medication.”<sup>120</sup> The Board also found that the orange flavor represented one of a “few superior designs for its de facto purpose,” such that competition would be hindered by its protection.<sup>121</sup> Noting that certain flavors are better suited to “masking the particular tastes of certain medicinal agents,”<sup>122</sup> the Board put orange, along with cherry and grape, on a “short list of most popular flavors” for pharmaceuticals and thus held that true

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<sup>117</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1643 (T.T.A.B. 2006).

<sup>118</sup> *Id.*

<sup>119</sup> *Id.* at 1645.

<sup>120</sup> *Id.* at 1644 (“It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation.”). *Cf. William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924) (holding that the use of chocolate in liquid quinine was functional because it made the preparation peculiarly agreeable to the palate” and “[w]hile it is not a medicinal element in the preparation, it serves a substantial and desirable use, which prevents it from being a mere matter of dress.”).

<sup>121</sup> *Id.*, see *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339-40 (C.C.P.A. 1982) (holding that total elimination of competition is not necessary).

<sup>122</sup> *Organon*, 79 U.S.P.Q.2d at 1646.

alternatives did not exist to orange flavor for antidepressants.<sup>123</sup> In the end, the Board held that even though the orange flavor did not make applicant's pharmaceutical any more effective in treating depression, the increase in patient compliance provided a competitive advantage.<sup>124</sup>

The Board next examined the failure of applicant's orange flavor to function as a source identifier. The Board applied the Supreme Court's reasoning from *Walmart v. Samara Bros.*, that customers are not predisposed to view product features—such as taste—as source indicators, but rather as appealing benefits of that product.<sup>125</sup> Accordingly, the Board held that consumers would not likely recognize an orange flavor as a trademark unless they were educated through advertising or other means.<sup>126</sup> Noting that the record was “completely devoid of any evidence of consumer recognition of applicant's ‘orange flavor’ as a trademark,” the Board held that the applicant did not prove the substantial showing of acquired distinctiveness necessary to overcome consumers' predisposition to not perceive flavors as marks.

## **B. Motion Marks**

Sports are, at their best, poetry in motion. Motion marks thus seem tailor-made for the sports industry. For instance, is Tiger Woods' golf swing or Kareem Abdul-Jabbar's “sky hook”<sup>127</sup> protectable as a trademark?<sup>128</sup> Though there are no cases that specifically analyze the

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<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 1648. *Cf. Brunswick Corp. v. British Seagull Ltd.*, 35 F.2d 1527 (Fed. Cir. 1994) (holding that black, as a color for motorboat engines, was functional, because, though it did not improve engine performance, it reduced the apparent size of the motor and was compatible with more colors of boats, thus providing a competitive advantage).

<sup>125</sup> *Wal-Mart Stores Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000).

<sup>126</sup> *Organon*, 79 U.S.P.Q.2d at 1650.

<sup>127</sup> Two abandoned U.S. trademark applications depicted the fabled “sky hook.” These marks were not, however, motion marks. See U.S. App. Serial Nos. 74/593,669 and 74/593,488.

protection of motion trademarks, the PTO has registered a number of motion marks, particularly in the entertainment and Internet fields. In fact, the TMEP specifically discusses motion marks and provides guidelines and rules for their registration.<sup>129</sup>

**1. Example of Registered Motion Mark in the Sports Industry:**

The following is an example of a motion mark that has been registered by the U.S. Patent and Trademark Office.

<b>Motion Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
Unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised above the vehicle to a parallel position.	Automobiles	2,793,439	12/16/2003	Automobile Lamborghini Holding S.p.A

**2. Examples of Registered Motion Mark in Other Industries:**

The following are examples of other motion marks that have been registered by the U.S. Patent and Trademark Office.

<b>Motion Mark</b>	<b>Goods/Services</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Owner</b>
Pre-programmed rotating sequence of a plurality of high intensity columns of light projected into the sky to locate a source at the base thereof.	High intensity search lights	2,323,892	2/29/2000	Ballantyne Of Omaha Inc.
The numeral “0” that begins as a whole frame and shrinks into the size of a number on a bank	Banking services	2,756,210	8/26/2003	National City Corp.

(continued from previous page)

<sup>128</sup> For more on the potential intellectual property protection of sports “moves,” see F. Scott Kieff, *It’s Your Turn, But It’s My Move: Intellectual Property Protection for Sports “Moves,”* 25 Santa Clara Computer & High Tech. L. J. 765 (April 2009).

<sup>129</sup> See TMEP § 807.11. Among other things, the applicant’s “drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark.” Further, the applicant must submit a “detailed written description of the mark.” *Id.*; 37 C.F.R. §2.51.

check and grows to a full size frame on the screen.				
An approximately five second visual sequence depicting a city skyline, sky and water, enclosed in two concentric circles containing the words "Broadway Video." As the city skyline comes into view the words "Broadway Video" rotate clockwise within the circles surrounding the city. The image concludes with a red lightning bolt entering the circle and forming a "V."	Entertainment services, namely production and distribution of – motion pictures, videotapes, television programming, CD-ROM and computer software	2,092,415	9/2/1997	Broadway Video
A moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word "Columbia" appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.	Motion picture film, prerecorded video cassettes, video discs and laser discs featuring full length motion pictures for general release; and digital, analog and microchip based storage and/or retrieval devices	1,975,999	5/28/1996	Columbia
An animated sequence of images depicting the silhouette of a portion of a planet with an upper case letter "N" straddling the planet and a series of meteorites passing through the scene, all encompassed within a square frame.	Computer software for various purposes	2,077,148	7/8/1997	N (Netscape)

**C. Hologram Marks**

Because they are often used as an anti-counterfeiting device, hologram marks face a special hurdle for protection. But any child with a baseball-card collection knows that holograms already play a role in the sports industry.

The TMEP specifically addresses the registration of hologram marks, following the TTAB's decision in *In re The Upper Deck Company*.<sup>130</sup> In that case, the Board refused an application for a hologram shown on baseball trading cards on two independent grounds.<sup>131</sup>

First, because the applicant sought to register a hologram generally, irrespective of “any content which may be represented within the hologram device,” the Board held that the applied-for device violated the prohibition against the registration of phantom marks that could “have a myriad of shapes, sizes, contents and the like.”<sup>132</sup> Specifically, the Board noted that Applicant's hologram “design may be a baseball field, a racing flag, or whatever applicant adopts for that particular card.”<sup>133</sup> Permitting the registration of such a design, the Board reasoned, would frustrate the goal of constructive notice to the public because the mark would “cover too many combinations and permutations to allow an effective search of the register.”<sup>134</sup>

The Board also refused registration on the ground that Applicant's hologram failed to function as a mark.<sup>135</sup> Pointing to evidence that Applicant and “other companies use hologram devices on trading cards, as well as on other products such as credit cards, CDs, apparel, and various types of tickets” frequently for anti-counterfeiting purposes, the Board held that

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<sup>130</sup> TMEP § 1202.14. *See In re The Upper Deck Co.*, 59 U.S.P.Q.2d 1688 (T.T.A.B. Feb. 14, 2001).

<sup>131</sup> *Upper Deck*, 59 U.S.P.Q.2d at 1693.

<sup>132</sup> *Id.* at 1690. *See* U.S. Serial No. 75/064,130 (“The mark consists of a hologram device applied to the goods, trading cards. The mark is discrete from and does not constitute a part of subject matter of the trading card. Neither the size nor the shape of the hologram device, nor any content which may be represented within the hologram device, nor the positioning of the hologram device on the trading card are claimed as features of the mark.”).

<sup>133</sup> *Id.*

<sup>134</sup> *Id.*

<sup>135</sup> *Id.* at 1693.

consumers would not perceive an Applicant’s hologram, per se, as a source identifier.<sup>136</sup> In so holding, the Board rejected Applicant’s evidence of secondary meaning, which demonstrated the anti-counterfeiting function of Applicant’s hologram device.<sup>137</sup>

## **VII. CONCLUSION**

The plain language of the Lanham Act, as interpreted by the Supreme Court, gives courts and the Patent and Trademark Office wide latitude to grant trademark protection of various “nontraditional” subject matter. Thus, as marketing practices evolve to emphasize different product elements as source indicators, and as consumer perceptions and behaviors follow, the legal mechanism is in place to protect these new assets.

Sports industry “players” are not exempt from this reality. Indeed, businesses in the sports industry, like other businesses, can realize significant value from nontraditional trademarks. One cannot escape, however, the fundamental requirements that no matter the type of mark, it must be non-functional, in both a utilitarian and aesthetic sense, and it must be perceived as a source identifier, either as a result of its inherent distinctiveness or through the acquisition of secondary meaning. Once these fundamentals are mastered, a brand owner is free to swing for the fences.

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<sup>136</sup> *Id.* at 1691.

<sup>137</sup> *Id.* at 1693.