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The Hidden Persuader: Sound Marks as Sonic Indicators of Source

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Our living environment is controlled by electronic devices. Historically, we interacted with these devices visually, via computer, smartphone, and even smartwatch screens.¹ However, it appears that our capacity for such screens peaked as new technologies are being developed (and quickly adopted) for voice-activated controls and systems.² With the rising demand for hands-free (e.g., Apple's "Siri" and Microsoft's "Cortana") and screen-free electronics and personal assistants (e.g., Amazon Echo's "Alexa," Google Home powered by Google Assistant, Xfinity's voice-activated remote control, and home automation systems), the ability to effectively distinguish these products through the use of sound as an indicator of source will undoubtedly grow in importance. Do you recognize the sound of Netflix's timpani strikes when its streaming services are initiated,³ Apple's rapid two-tone repetition sound when Siri is engaged,⁴ or maybe Intel's five-note chime?⁵ These are prime examples of sound marks that are the result of effective sonic branding campaigns.

Developments in sound designations are also becoming more apparent as we create technologies that eliminate the familiar sounds of functioning machines—for example, electronic cars that start silently or even keyboards without a familiar clicking sound. While these technologies are celebrated, some consumers are still reassured by the familiar sounds, and companies are left with a blank canvas for creating new memorable nonfunctional sounds. As a result, companies have new opportunities for brand interaction with consumers. However, are major brands missing the mark?

Thinking Strategically about Sound Marks

Goodwill is the commercial value that companies derive from consumer perceptions of a brand representing a specific product or service, rather than from the actual product or service itself.⁶ Leading brands understand this concept and meticulously build and constantly reshape their own unique *visual* identities in connection with the provision of



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their respective goods or services. However, with the advent of voice-activated devices and silent technologies, are they failing to bolster their brand by not also crafting an *audio* identity?

Hearing is a very powerful human sense. On the most basic level, sound engenders the inherent ability to transcend languages. Further, listeners commonly associate a sound with a specific memory. With our increasingly audio-enabled environment, “congruent sound cues can increase the speed of a visual search for products (a key for success in both online and retail settings).”⁷ However, sonic branding is generally overlooked despite the fact that the “strategic use of sound can play an important role in positively differentiating a product or service, enhancing recall, creating preference, building trust, and even increasing sales.”⁸ With this in mind, nontraditional trademarks afford brand owners the ability to engage consumers in a meaningful manner across multiple media platforms.

As arguably one of the most amorphous forms of intellectual property, trademarks may be “almost anything at all that is capable of carrying meaning.”⁹ Sound marks, in particular, are broadly described as marks that “identif[y] and distinguish[] a product or service through audio rather than visual means.”¹⁰ While acting as an indicator of source, sound marks enable brands to instantly trigger a particular experience in the minds of consumers while simultaneously evoking specific consumer attitudes and perceptions. Dissimilar from traditional marks, this form of mark acts in such a unique fashion that it has the innate ability to reach consumers without requiring action by the listener. Sonic or auditory branding offers brand owners the inimitable opportunity to reach passive consumers, develop equity and awareness, drive value, and connect with consumers on a deeper level. Companies are constantly searching for new mechanisms to connect with consumers, and sound marks make it possible to reinforce brands through other senses while acting as a hidden persuader. In light of the development of voice-activated and even silent technologies, the use of sound as a means to distinguish products and services is the natural next step in branding. However, only a small number of sound marks mature to registration, and many companies fail to incorporate such sensory experiences into their marketing strategy.

Currently, a search for sound marks in the United States Patent and Trademark Office (USPTO) Principal Register identifies approximately 312 records for pending applications and registrations. While registrable, sound marks undergo substantial review and face unique impediments during the examination phase of the trademark application process as displayed by the low number of active sound mark applications and registrations.

Registrability of Marks Consisting Solely of Sound

While there is no international consensus as to whether a sound is registrable as a trademark, in many countries the definition of a trademark either includes sound as a mark or fails to exclude such marks.¹¹ Historically, the United States is the most flexible with regard to the recognition of nontraditional trademarks.

The US Supreme Court interpreted the Lanham Act to afford broad protection over trademarks by articulating that a mark’s “ontological status” or form is nearly irrelevant in comparison to its “source-distinguishing ability.”¹² In order to register a nontraditional mark on the USPTO Principal Register, the registration requirements for a standard trademark application apply.¹³ Therefore, the sound must be capable of functioning as an indicator of source.¹⁴ Because sound marks cannot be visually perceived and therefore the drawing requirement is waived, the applicant must submit a detailed description of the mark.¹⁵ For instance, the applicant may submit the musical notes that comprise the sound (e.g., NBC’s chimes sound mark consisting of the notes G, E, and C¹⁶) or simply describe the mark in layman’s terms (e.g., MGM’s sound mark comprising “a lion roaring”¹⁷). Applicants should also submit an audio file to supplement and clarify the description of the mark.¹⁸ While consumers are likely familiar with sound marks in the context of

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entertainment (e.g., Lucasfilm's THX sound mark,¹⁹ Twentieth Century Fox's fanfare²⁰ and D'OH sound marks,²¹ and ESPN's sports programming sound mark²²), a clear shift is occurring directed toward the field of computers and electronics (e.g., Cisco's teleconferencing sound mark,²³ Vorwerk's operating system sound mark,²⁴ and UnitedHealth Group's electronic claim processing sound mark²⁵).

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Distinctiveness as a Barrier for Sound Mark Registration

In order to be protectable, the sound must "assume a definitive shape or arrangement" and be able to generate an association in the minds of consumers between the sound and the goods or services.²⁶ Like traditional trademarks, a sound mark's level of protection will depend on whether it is inherently distinctive or more commonplace and nondistinctive.²⁷ Specifically, the Trademark Trial and Appeal Board (TTAB) explained that a sound mark depends on the awareness of the listener, "which may be as fleeting as the sound itself unless, of course, the sound is so 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."²⁸ Thus, a critical 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."²⁹ For example, "commonplace" sounds include those made by goods as part of their normal operation (e.g., alarm clocks, mobile phones, appliances with alarms).³⁰

Further, the criteria for assessing the distinctive character of a sound mark are no different from those to be applied to other types of marks.³¹ Sound marks that are unique may be registered on the Principal Register without submitting evidence of acquired distinctiveness; however, this is rather uncommon, as no concrete guidelines establishing what may qualify as inherently distinctive in the context of sound marks exist. In most cases, sound marks require a showing of acquired distinctiveness under 15 U.S.C. § 1052(f). As a result, in order to register a normal everyday sound, the application must be supported with evidence that purchasers or prospective purchasers recognize the sound and associate it with a single source.³²

In order to prove secondary meaning, applicants of such commonplace sound marks must prove buyer association. When making a determination of whether a mark meets the threshold for secondary meaning, courts have commonly considered: (1) the length and manner of use, (2) the nature and extent of advertising and promotion, and (3) other efforts at developing a conscious connection in the public's mind between the mark and the goods or services.³³ While case law addressing secondary meaning is abundant, there is no general consensus on the application of these elements in the context of sound marks.³⁴ In short, if the sound imitates "commonplace" sounds, is a sound to which consumers are exposed under different circumstances, or is made from the associated goods in their normal course of operation, the sound will likely face distinctiveness issues.

Functionality Doctrine as a Barrier to Sound Mark Registration

Assuming that the owner of a sound mark can overcome the hurdle of proving secondary meaning, the doctrine of functionality may nevertheless preclude registration. The functionality doctrine prevents applicants from stifling competition through the monopolization of a useful product feature.³⁵ The Supreme Court emphasized that the relevant inquiry is whether a product feature "'is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage."³⁶ The USPTO's *Trademark Manual of Examining Procedure* further cautions that an application to register a sound mark must be refused as functional if the applied-for mark would be "essential to the use or purpose of the goods" (e.g., "an application to register the sound of a ring tone for downloadable ring tones").³⁷ The reasoning behind this doctrine is that

the “Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”³⁸

When addressing the issue of functionality, courts commonly consider the following four factors: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials touting the design’s utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.³⁹ Here, if the sound comes from the workings of the machine or is essential to its purpose, the sound will likely face a functionality hurdle to registration. Further, it is critical to note that a refusal based on the doctrine of functionality cannot be overcome by a showing of acquired distinctiveness.

TTAB Decisions Regarding Sound Marks

The TTAB considered the issues of secondary meaning and functionality in sound marks in several trademark applications as outlined below.

In *In re Vertex Group LLC*, the TTAB considered the registrability of a sound pulse that can be heard from over a football field away used in connection with the “AmberWatch”—a personal security alarm emitted from a child’s bracelet used to prevent abductions.⁴⁰ In reviewing the refusal of Vertex’s application, the TTAB denied registration based on the two bases advanced by the examining attorney.

First, examining distinctiveness, the TTAB emphasized that when a sound is proposed for registration on the Principal Register for goods that make the sound in the normal course of operation, “registration is available only on a showing of acquired distinctiveness under Section 2(f).”⁴¹ However, the applicant did not resort to section 2(f) of the Trademark Act. In refusing registration, the TTAB noted that the alarm sound consisting of a series of sound pulses is “commonplace and the types of sounds to which prospective consumers of applicant’s products would have been exposed in various circumstances.”⁴² The TTAB reasoned that consumers are not predisposed to equate such sounds with the sources of the products that emit them.⁴³ Additionally, in refusing registration based on functionality, the TTAB noted that “quite simply, the use of an audible alarm is essential to the use or purpose of applicant’s products.”⁴⁴ For that reason alone, the TTAB affirmed the functionality refusal.

Likewise, in *Nextel Communications, Inc. v. Motorola, Inc.*, Motorola filed an application to register its “chirp” sound as a mark for cellular phones and two-way radios, which was opposed by Nextel.⁴⁵ In that case, the TTAB quickly noted that because the “chirp” lacks inherent distinctiveness, the chirp may be registered only upon a showing of acquired distinctiveness.⁴⁶ In support of a claim of acquired distinctiveness, Motorola argued that (1) it had been manufacturing cell phones that emit the chirp since 1996, (2) sales of these cell phone handsets were significant, and (3) it expended significant resources in advertising the chirp in connection with the handset.⁴⁷ In addition, Motorola relied on two consumer surveys commissioned by Nextel to determine whether the chirp had acquired distinctiveness. However, the TTAB followed *Vertex* and affirmed the denial of the application. The TTAB reasoned that cellular phones are the type of goods from which consumers would expect to hear various sounds as they indicate operational functions. Further, the TTAB noted that Motorola’s use of the chirp was not exclusive, as displayed by Nextel’s use, which strongly influenced the determination that the chirp had failed to acquire distinctiveness.

Similarly, in *In re Powermat, Inc.*, Powermat applied to register a sound mark for battery chargers consisting of five short electronic chirps, lasting less than half a second, with each chirp increasing slightly in pitch from the previous chirp.⁴⁸ Not surprisingly, the TTAB found that the applied-for sound fell squarely within the controlling precedent established by the TTAB in *Vertex* and *Nextel*. Additionally, Powermat did not dispute that its goods

emitted the sound in the normal course of operation and, therefore, the applied-for sound mark could not be inherently distinctive. Further, Powermat's advertising figures could not change the result as a claim of acquired distinctiveness cannot overcome the doctrine of functionality.

Conclusion

While sound trademark registrations appear to be a particularly rare occurrence, a sound is indeed capable of acquiring trademark protection and can pay dividends in the form of increased sales. Since *Vertex*, *Nextel*, and *Powermat*, the integration of screenless and voice-activated technologies has exploded in the United States. Thus, consumers are more predisposed to perceive sounds as source identifiers. In view of the unprecedented technological advancements eliminating functional sounds traditionally emitted from machines, differentiating products through the use of nontraditional trademarks is more commonplace. To that end, when developing sound marks, it is critical to adopt a sound that will not be perceived as nondistinctive or functional.

Sound could be the next frontier in creative branding, and a carefully developed audio identity can become one of a company's most powerful assets.⁴⁹ With careful development and creative attorneys, we should also see the registration of such sounds becoming more frequent at the USPTO.

Endnotes

1. GOOGLE, THE NEW MULTI-SCREEN WORLD: UNDERSTANDING CROSS-PLATFORM CONSUMER BEHAVIOR 18 (2012), https://services.google.com/fh/files/misc/multiscreenworld_final.pdf (finding that 90 percent of users move between devices sequentially to accomplish a task).
2. David Streitfeld, *Google Home: A Voice-Activated Device That Already Knows You*, N.Y. TIMES, May 18, 2016 (discussing the recent inundation of voice-activated home assistant devices such as Amazon Echo and Google Home). According to Google's chief executive, Sundar Pichai, Google Home—a voice-activated speaker powered by Google Assistant—performs functions through a simple voice request because “[w]e want users to have an ongoing two-way dialogue with Google.” *Id.*
3. Registration No. 5,194,272 (listen to the March 31, 2016, Specimen at http://tsdr.uspto.gov/#caseNumber=5194272&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch).
4. Registration No. 4,689,043 (listen to the April 26, 2012, Mark at http://tsdr.uspto.gov/#caseNumber=4689043&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch).
5. Registration No. 2,315,261 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/75332744.mp3>).
6. See, e.g., Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 550 (2006).
7. Laurence Minsky & Colleen Fahey, *What Does Your Brand Sound Like?*, HARV. BUS. REV. (Feb. 7, 2014).
8. *Id.*
9. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).
10. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1202.15 (Apr. 2017).
11. Issues & Policy Comm., Int'l Trademark Ass'n, Resolution: Protectability of Sound Trademarks (Feb. 25, 1997), <http://www.inta.org/Advocacy/Pages/ProtectabilityofSoundTrademarks.aspx>.
12. *Qualitex*, 514 U.S. at 164.

13. TMEP, *supra* note 10, § 1202.15.
14. *Id.* (emphasizing that sound marks function as source indicators when they “assume a definitive shape or arrangement” and “create in the hearer’s mind an association of the sound” with a good or service (quoting *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978))).
15. *Id.* § 807.09.
16. Registration No. 916,522 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/72349496.mp3>).
17. Registration No. 1,395,550 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/73553567.mp3>).
18. See 37 C.F.R. § 2.61(b); TMEP, *supra* note 10, § 807.09 (advising that the applicant should submit an audio reproduction of any sound mark). The function of this reproduction is to clarify the mark’s description. Further, the reproduction must be an electronic file in .wav, .wmv, .wma, .mp3, .mpg, or .avi format and should not exceed 5 MB in size due to the inability of the Trademark Electronic Application System (TEAS) to accommodate larger files.
19. Registration No 1,872,866 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/74309951.mp3>).
20. Registration No. 2,000,732 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/74629287.mp3>).
21. Registration No. 3,411,881 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/76280750.mp3>).
22. Registration No. 2,450,525 (listen to the sound mark at <https://www.uspto.gov/sites/default/files/75676156.mp3>).
23. Registration No. 3,792,268 (listen to the May 15, 2009, Mark at http://tsdr.uspto.gov/#caseNumber=3792268&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch).
24. Registration No. 5,130,818 (listen to the July 13, 2016, Evidence at http://tsdr.uspto.gov/#caseNumber=5130818&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch).
25. Registration No. 5,042,077 (listen to the March 16, 2015, Mark at http://tsdr.uspto.gov/#caseNumber=5042077&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch).
26. TMEP, *supra* note 10, § 1202.15.
27. *Id.* (stressing that sounds may be registered on the Principal Register when they are “arbitrary, unique or distinctive” in the mind of the listener).
28. *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. 560, 562–63 (T.T.A.B. 1978).
29. TMEP, *supra* note 10, § 1202.15.
30. *Id.*
31. *Id.*; see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (classifying marks as (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful).
32. *Gen. Elec. Broad.*, 199 U.S.P.Q. at 563; see also *Nextel Commc’ns, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393, 1408 (T.T.A.B. 2009) (sustaining opposition on the basis that the sound mark had not acquired distinctiveness, in part, because the applicant failed to provide supporting evidence that the mark was used in ads in such a manner that it would be recognized as a source identifier for mobile telephones).

33. *Am. Diabetes Ass'n, Inc. v. Nat'l Diabetes Ass'n*, 533 F. Supp. 16, 19 (E.D. Pa. 1981).
34. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991) (quoting *Am. Sci. Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 792 (9th Cir.1982)).
35. 1-2 JEROME GILSON & ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 2.11 (3d ed. 2013) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).
36. *Qualitex*, 514 U.S. at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).
37. TMEP, *supra* note 10, § 1202.02(a)(viii).
38. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001).
39. *In re Vertex Grp. LLC*, 89 U.S.P.Q.2d 1694, 1704 (T.T.A.B. 2009) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982)); see also *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002).
40. 89 U.S.P.Q.2d at 1695-96.
41. *Id.* at 1700.
42. *Id.* at 1702.
43. *Id.*
44. *Id.* at 1704.
45. 91 U.S.P.Q.2d 1393, 1395 (T.T.A.B. 2009).
46. *Id.* at 1401-02.
47. *Id.*
48. 105 U.S.P.Q.2d 1789 (T.T.A.B. 2013).
49. Jordan Passman, *Intel, Netflix, Apple and the Power and Influence of Sonic Branding*, FORBES (Nov. 2, 2016), <https://www.forbes.com/sites/jordanpassman/2016/11/02/intel-netflix-apple-and-the-power-and-influence-of-sonic-branding/#7d017ad34836> ("The Intel bong is one of the most powerful assets we have. We're always looking for ways to showcase the amazing experiences that Intel enables, and the Intel bong sound helps keep our messaging consistent.").