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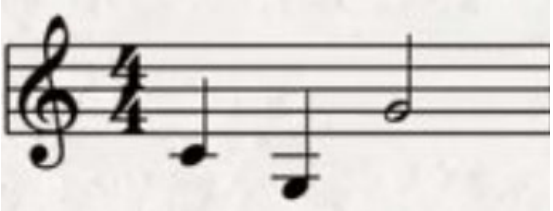
On My Mind Blog: Musical Notes Played Over Retail Store Speakers Held a Registrable Trademark Used in a Display Associated with the Goods

09.07.2023 By Dorothy Whitney



There have been few applications to register a sound as a trademark for goods (as distinguished from a mark for services). In a precedential case, Duracell U.S. Operations, Inc. ("Duracell") was successful in registering three musical notes, played at the end of announcements over retail store sound systems, as a trademark for batteries.

Generally, a trademark can be registered in the U.S. based on evidence of its use in commerce when it has been placed in any manner on the goods or their containers or the displays associated with them. Mere advertising for *goods* is not sufficient, although, as we previously have written, an advertisement can qualify as use of a mark for *services* when it is directly associated with the services.

Registrations of sounds as trademarks for goods are rare. Some well-known examples are toy action figures emitting the Tarzan yell, (Reg. No. 2210506 owned by Edgar Rice Boroughs, Inc.), and dolls emitting a childish giggle (Reg. No. 2692077 owned by The Pillsbury Company LLC).

The issued presented with Duracell's application was whether a sound mark used in "audio messaging" played in stores where DURACELL batteries are sold should be considered a point-of-sale display for the batteries as distinguished from mere advertising for them?

When Duracell applied to register its sound mark (referred to as the "slamtone") for batteries, claiming use since 1974, the Examining Attorney refused registration on the ground that the specimens of use were mere advertising commercials. She suggested that acceptable specimens might be displays playing the sound associated with the actual goods at their point of sale.

Duracell contended that the audio messaging was analogous to a shelf-talker. The message was played overhead repeatedly and could be heard in the section of the store where the goods were located. It had aired more than 100 million times with well over one billion customer impressions in stores selling more than a million DURACELL batteries.

Duracell appealed the Examining Attorney's decision to the Trademark Trial and Appeal Board (TTAB) which reversed the refusal of registration. The TTAB said that this case was analogous to two decisions by the U.S. Court of Customs and Patent Appeals, the predecessor to the current Court of Appeals for the Federal Circuit to which TTAB decisions may be appealed, that had approved registrations of trademarks for goods: *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823 (C.C.P.A. 1970) (HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for hair coloring preparations used on relatively large counter or window display cards) and *In re Marriott Corp.*, 459 F,2d 25 (C.C.P.A. 1972) (TEEN TWIST for a ham, cheese and tomato sandwich used on menus displaying the ingredients and pictures).

The TTAB said that the use of the sound mark in Duracell's audio messaging was consistent with the standard that "displays associated with the goods" must be:

> essentially point-of-sale material such as **banners, shelf-talkers**, window displays, menus, or similar devices which are **designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale** and which **prominently display the mark in question and associate it or relate it to the goods** in such a way that an association of the two is inevitable even though the goods may not be placed in close proximity to the display or, in fact, even though the goods may not physically exist at the time a purchaser views the display. *In re Bright of Am., Inc.*, 205 USPQ 63, 71 (T.T.A.B. 1979) (emphasis added).

The TTAB held that Duracell's audio messaging was a form of advertising, but at the same time constituted a use on a display associated with the goods in that it explained the benefits of the goods and was designed to induce in-store shoppers to consummate a sale. Accordingly, the TTAB reversed the refusal of registration.

***In re Duracell U.S. Operations, Inc.*, Application No. 90559208 (T.T.A.B. July 24, 2023)**

Author's Note:

It is interesting to contrast the *Duracell* decision with the *FMC* decision issued by the TTAB the very next day. ***In re FMC Technologies, Inc.*, Application No. 88705569 (T.T.A.B. July 25, 2023)**

An application to register the mark SUBSEA 2.0 for oil and gas drilling equipment was supported by a specimen showing its use on slides from a live sales presentation to potential customers to solicit orders. The applicant argued that this was like a trade show booth displaying the applicant's mark.

The TTAB held that the slide show was mere advertising because it did not provide the detailed information normally associated with ordering products of that kind including how and when the products could be ordered, pricing information or information about how to obtain a price quote,

product dimensions and weight, and whether outside power or control systems were needed. Furthermore, these slide presentations were marked “confidential,” and were not widely used within the relevant market, whereas trademark use is, by definition, a public use.

These decisions illustrate that the TTAB considers the specific facts of each case in deciding whether a trademark use, other than one affixed to the goods, constitutes mere advertising and/or is analogous to a point-of-sale display.

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Dorothy Whitney is mainly involved in supervising worldwide trademark registration programs for major corporations and in counseling and representing clients regarding trademark, licensing, and domain name issues and in handling opposition proceedings in the U.S. Trademark Office.