

## SUBMISSION OF THE UNITED STATES OF AMERICA

### GROUND FOR REFUSAL OF TRADEMARK REGISTRATION

Examples of refusals to register sound and scent marks at the United States Patent and Trademark Office (USPTO)

#### SOUND MARKS

1.) U.S. Trademark Application Serial No. 76681788. Applicant sought to register the following sound mark for use in connection with pet toys:

“an audio waveform of a nominal square wave of 6.1 KHz that increases to 11.4KHz over a period of approximately 140 msec.”

Upon reviewing the accompanying sound file (containing the sound of a mouse squeak) which serves to clarify the description of the mark and which is made part of the application, the USPTO Trademark Examining Attorney refused registration under the Trademark Act because the realistic and authentic nature of the mouse squeak sound serves a utilitarian or functional advantage for applicant. The examining attorney noted applicant’s admission that the “authentic real-mouse squeak” is protected by a number of U.S. patents, as well as applicant’s responses to the refusal, in which applicant touts the “realistic” and “authentic” nature of the sound. The examining attorney also noted that applicant’s competitors would be at a disadvantage if their pet toys made unrealistic or non-authentic mouse squeaks. Relying on evidence made of record, *the examining attorney explained the utilitarian advantage of a sound replicating the sound of a realistic mouse is that pets will be more likely to regard the toy as actual prey, since cats and dogs often prey on mice and small rodents. As pets have a propensity to prey on mice, and would be more interested in a toy that emits such a sound, a realistic mouse sound is a functional aspect of applicant’s goods.* Because the realistic mouse sound is a functional aspect of the applicant’s goods, the mark is refused registration.

2.) U.S. Trademark Application Serial No. 77418246. The applicant sought to register the following sound for use in connection with eye glasses, optical glasses, and sun glasses:

The mark consists of a series of three, regularly spaced, repeated clicks, wherein the clicks resemble the sound of a small metal object striking another metal object.

The specimen on record shows the sound emanating when the hinges of the glasses are opened or closed. As explained by the USPTO trademark examining attorney, *the sound serves the function of sending an audible signal to the consumer that the glasses are locked into the open or closed position.* The examiner further explained that having small metal objects strike each other is an inexpensive way to provide resistance to the hinges opening and closing. As the mark merely served as a functional aspect of the

goods, alerting the consumer that the glasses are locked into the open or closed position, registration was refused under the Trademark Act.

## SCENT MARKS

3.) U.S. Trademark Application Serial No. 78483234. Applicant sought to register the scent of mint for use in connection for face masks for medical use.

The USPTO Trademark Examining Attorney refused registration because the particular features of this proposed mark, namely, a mint scent, are functional for the goods as it makes the use of a face mask more pleasing to use and/or compliance with use of such a mask is more likely. The examining attorney provided evidence by attaching medical articles, journals and letters noting that the use of scented face masks increases compliance with inhalational anesthesia in children. Moreover, the examining attorney attached evidence taken from applicant's own website catalog touting the usefulness of the mint scent in the face masks as delivering "a constant breath of fresh air." **Such a scent was functional in that it made many unpleasant medical tasks more palatable to those wearing the mint scented face masks.** Because the mint scent served as a functional aspect for the goods, registration was refused under the Trademark Act.

4.) U.S. Trademark Application Serial No. 77179347. Applicant sought to register the scent of grapes for use in connection with lubricants for an internal combustion engine.

The USPTO Trademark Examining Attorney refused registration because the applicant failed to provide sufficient evidence that the proposed mark, the scent of grapes, had acquired distinctiveness in relation to the goods, engine lubricants. The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. In general, the following factors are considered when determining whether a mark has acquired distinctiveness: (1) length and exclusivity of use by applicant of the mark in the United States; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts, such as unsolicited media coverage and consumer studies, in the United States to associate the mark with the source of the goods and/or services identified in the application. According to U.S. case law, the amount of evidence required to establish that a scent or fragrance functions as a mark is substantial.

Accordingly, the examining attorney determined that the applicant had not submitted sufficient evidence which could substantiate the claim of acquired distinctiveness. The mark, according to the declaration submitted in the application, had been in use for less than 10 years. The volume of sales (5,000 bottles sold per year) was relatively low for over a five year period. In addition, although the applicant indicated that it advertised the goods in three publications, advertising figures were not submitted as part of the record. **Taking this information into account, the examining attorney determined that the**

*submitted evidence failed to show the purchasing public had come to view the proposed mark as an indicator of origin.* As such, the proposed mark was refused registration for not acquiring distinctiveness.