THE TRADEMARK REGISTRABILITY OF THE HARLEY-DAVIDSON ROAR: A MULTIMEDIA ANALYSIS

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I. INTRODUCTION

If motorcyclists are a unique breed, Harley-Davidson motorcyclists must be considered a cult unto themselves. They have transformed the hobby of motorcycling into a lifestyle, replete with clubs, clothing, and a distinct “biker culture.” [1] The official Harley-Davidson web page describes the Harley history and allure:

In 1903, three Davidson brothers and their friend, Bill Harley, started a rumble heard ‘round the world. Their first motorcycle was the start of a unique combination of people and machines. Through the decades, Harley-Davidson motorcycles have had the ability to generate emotion. The excitement of racing, the peacefulness of a ride down a country lane, the pleasant symphony of a handful of bikes rumbling down Main Street, the exhilaration of switchbacks on a mountain road, but most of all, the camaraderie of the people who share the same love for Harley-Davidson motorcycles. The Brotherhood. The Sisterhood. The Family. It's time to come home. [2]

The Harley-Davidson corporation's ability to evangelize the Harley lifestyle-- as on the company's website--without alienating a customer-base which prides itself on being free-spirited and countercultural has been a testament to its marketing shrewdness. However, in a business expansion which probably irked the hardcore Harley faithful, the company now manufactures or licenses jewelry, watches, clothing, and a chain of “lifestyle” restaurants called the Harley-Davidson Cafe. [3]

In every commercial enterprise Harley-Davidson has undertaken, the company has ensured that the integrity of its trade name and various trademarks in the marketplace is vigilantly protected. Indeed, Harley has successfully litigated trademark infringement cases in federal courthouses across the country. [4] Interestingly, much of this litigation has taken place within the past five to ten years. This development has a purely economic reason. Since the 1980’s, when the U.S. motorcycle market was dominated by Japanese manufacturers such as Honda, Yamaha and Suzuki, Harley-Davidson has enjoyed a remarkable resurgence of business--to the tune of approximately $1.5 billion in revenues. [5] This cash has enabled Harley to pursue trademark infringers with a renewed zeal.

Harley-Davidson's most recent endeavor to secure trademark protection is not only its most unconventional, it is also arguably, the most unusual and provocative trademark application ever filed with the U.S. Patent and Trademark Office (PTO). On February 1, 1994, Harley filed a registration for a trademark, then already in use, with the following description: “THE MARK CONSISTS OF THE EXHAUST SOUND OF APPLICANT'S MOTORCYCLES, PRODUCED BY V-TWIN, COMMON CRANKPIN MOTORCYCLE ENGINES WHEN THE GOODS ARE IN USE.” [6] Put simply, Harley was attempting to trademark the sound of its motorcycles; which, of course, begs the question, can a manufacturer trademark the exhaust roar of its motor vehicle?

II. V-TWINS AND CRANKPINS

To address this question, it is essential to know a bit about the motorcycle engine mentioned in Harley's application to the PTO. First, a “V-Twin” motorcycle engine refers to an engine that fires on two cylinders which are joined at a 45 degree angle. [7] A “common crankpin” design means that the connecting rods to the cylinders share one crankpin. [8] The common crankpin V-twin motorcycle engine has powered most Harley models since 1909. Of course, from 1909 through today, Harley has designed and manufactured several generations of V-Twin engines with a common crankpin. [9] According to Tim Hoelter, Harley-Davidson's vice president and general counsel, “We've been designing, manufacturing and selling our motorcycles with the unique Harley-Davidson sound for decades in the United States, but our competitors have not been, and in fact they have made fun of us for maintaining the tradition and heritage that is so interwoven within our brand.” [10] These details are critical because the “unique” Harley-Davidson sound owes its existence to the common

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crankpin V-Twin engine design. Joseph Bonk, Harley's trademark attorney, has noted that the design results in a syncopated, uneven idle which, when simulated verbally, sounds like “potato-potato-potato,” as demonstrated in Figure 1. [11]

**Figure 1: The Harley Idle**

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III. THE HARLEY SOUND AS INTEGRAL TO THE OWNERSHIP EXPERIENCE

Accountant Laura Weiner sometimes thunders, late at night, through the New River Tunnel in Fort Lauderdale, Fla., revving her Harley's engine. “I love that sound,” she says. [12] Harley enthusiasts believe that their bikes sound different from anything else on the road, and are instantly recognizable. “I'd know it with my eyes closed,” said Larry Shay of Tallahassee, who rides a $20,000 touring Harley. “You can ask anyone, and they'll all say the same thing: Nothing else sounds like it.” [13]

Although the basic sound is the same on every Harley with V-Twin engines, individual riders can tweak their exhaust systems to change the tone and volume. For example, the thundering roar common to many Harleys is produced by attaching straight exhaust pipes to the engine and skipping the muffler entirely. Dennis Hendrix, director of Orlando's Motorcycle Mechanics Institute, insists that the tradition behind the Harley sound is one of the reasons the brand will always enjoy a loyal following. [14] Harley-Davidson apparently agrees in sufficient measure to seek a trademark for the sound.

A question at the outset thus emerges: is a Harley with an aftermarket or modified exhaust system still a Harley? Dennis Hendrix's customers, of course, would insist that the answer is yes, but it seems intuitively obvious that Harley-Davidson would not, as the company is seeking a trademark in the sound of the motorcycles it produces in the factory. Interestingly enough, Harley-Davidson tacitly answered this question in the affirmative, by submitting audio recordings to the USPTO of Harley motorcycles fitted with both stock and aftermarket exhaust systems. [15]  

IV. THE PRECEDENTS

Harley-Davidson is not the first company to seek a trademark in a sound. The National Broadcasting Co. Inc. set the precedent nearly a half-century ago. In 1950, NBC successfully registered the musical notes G, E, C played on chimes as a trademark for its radio broadcasting services. [16] Other aural trademarks include the MGM lion's roar, the song “Sweet Georgia Brown” for the Harlem Globetrotters basketball team, the spoken letters “AT&T” with a distinctive musical flourish in the background, and the Beneficial financial services jingle (“At Beneficial, toot, toot, you're good for more.”) [17] Despite the successful registration of trademarks in sounds, the PTO reports that only 23 of the more than 729,000 trademarks in force in the United States are sounds. [18] And, since 1946, there have only been 71 applications to register sounds as trademarks or service marks. [19]  

Of late, the PTO has been willing to permit registration of other nontraditional marks. For example, in 1990, the PTO approved the registration of scents in cases where the fragrance identified or distinguished a certain type of product. [20] The United States Supreme Court recently held in *Qualitex Co. v. Jacobson Products Co.* that color per se is registrable as a federal trademark. [21] In considering the trademark registration requirements under the Lanham Act, the Court's reasoning in *Qualitex* may provide the most persuasive support for the registrability of Harley's trademark.

V. THE NAYSAYERS

Based on press accounts printed subsequent to Harley's filing of its trademark, the business and legal communities appear united in arguing that Harley's trademark application should be rejected. In fact, there was found to be no company or commentator, other than those on Harley's payroll, who supported the grant of Harley's trademark.
Nine of Harley-Davidson's competitors, including Japanese manufacturers Suzuki, Kawasaki, Yamaha, and Honda, as well as American manufacturer Polaris, have filed oppositions with the PTO against the registrability of Harley's trademark. [22] These companies are in opposition for several reasons. Most fundamentally, all of these companies manufacture cruiser-style motorcycles employing a common crankpin V-Twin engine, which, the competitors argue, sounds identical to the Harley engine. According to Yamaha spokesman Bob Starr, “Yamaha has been building V-twin engines since the early ’80s, and there’s no difference between the sound their engine makes and the sound our engine makes .... All V-twins, by their nature, have two pistons. The pistons go up and down, and they all sound the same.” [23]

Likewise, Honda contends it has long sold heavyweight bikes that produce an exhaust sound similar to that of the Harley motorcycles. The sound does not identify and distinguish Harley's motorcycles from others or “indicate the source of the motorcycles,” Honda claims in its notice of opposition. [24] The truth or falsity of this claim represents the crux of the entire issue. David Makous, a Los Angeles lawyer who represents Honda Motor Co., adds, “It’s very difficult to imagine a world where the sound of a running engine is an exclusive property right.” [25]

Legal practitioners in the trademark area have also expressed an unmistakable aversion to Harley's trademark claim. “Should Harley win, other manufacturers could attempt to trademark their product sounds,” said Los Angeles trademark law specialist Stan Sokoloff. [26] Critics such as New York trademark expert Darren Saunders contend that, for example, Hoover Co. might try to trademark the sound of its vacuum cleaner, or Waring Products Co. could ask the government to protect the whirring sound of its blender blades. [27] Critics caution that companies could use broad trademark laws to stifle competition by making it exceedingly difficult for competitors to work around their trademarks.

VI. THE LAW: QUALITEX AND THE LANHAM ACT

To predict how the PTO or a federal court will decide the novel legal question posed by Harley's trademark application, one must consider the federal trademark statute, the Lanham Act. The Lanham Act gives a seller or producer the exclusive right to register a trademark, and to prevent its competitors from using that trademark. [28] The Act defines a trademark as “including any word, name, symbol, or device, or any combination thereof.” [29] As noted earlier, the PTO and courts have interpreted the term “symbol” quite broadly so as to allow non-traditional trademarks such as sounds, colors, and fragrances.

Generally, the PTO permits the registration of non-traditional marks that are either inherently distinctive and unique (i.e., fanciful, arbitrary or suggestive) or those that have acquired secondary meaning in the minds of purchasers. [30] Non-traditional marks such as sound have not been considered inherently distinctive; therefore, in order to function as a trademark, the sound must indicate clearly to consumers, based on its use in the marketplace, the source of the product. [31] The ability of consumers to recognize a trademark's secondary meaning is also critical in infringement actions, because consumer recognition of a trademark must be present before a court can determine whether a competing trademark is likely to confuse a purchaser. [32]

With these criteria in mind, the Supreme Court in Qualitex provided a convenient framework, in the form of a three-step analysis, within which the validity of Harley's trademark registration may be assessed. [33] First, the Court addressed whether the proposed trademark constituted a “symbol” or “device” for purposes of the Lanham Act. [34] If the trademark was found to be a “symbol” or “device,” the Court would next determine whether the proposed trademark had developed secondary meaning in the marketplace. [35] Finally, the Court addressed whether the element to be trademarked served another function, such that granting the trademark would subvert competition by allowing a manufacturer to control a useful product feature by way of trademark law. [36]

1. The “Symbol”

Unlike the Court in Qualitex, the PTO or a federal court will probably not have to address whether Harley's desired sound trademark is a “symbol” or “device” for purposes of the Lanham Act. [37] Justice Breyer commented that “[s]ince human beings might use as a “symbol” or “device” almost anything at all that is capable of carrying
meaning, this language, read literally, is not restrictive.” [38] Moreover, sounds have already been accepted as trademarks, and Harley's exhaust roar classifies as a sound.

There is one potential stumbling-block facing Harley in this initial stage. Unlike the NBC chimes, or Beneficial Company jingle, the Harley exhaust roar is not a fixed sound. The tape recordings of exhaust noise that Harley provided to the PTO are fixed, but the company is not seeking a trademark for these particular exhaust noises. In fact, if Harley wanted to protect its rights in particular recordings of exhaust noises, they could seek a copyright on the sound recording with relatively little difficulty. [39]

Instead, the company is seeking a trademark for its engine and exhaust noise generally; a noise which varies infinitely depending on the particular motorcycle, exhaust system, and, naturally, the rider's use of the motorcycle's throttle. While this noise may be considered a “symbol” by which consumers recognize Harleys, its variability was a point of challenge by Harley's competitors to the putative trademark registration. [40]

Acknowledging this difficulty, Harley will most likely be able to convince a court that its proposed trademark is a symbol, based on the expansive reading that the PTO and the U.S. Supreme Court have given to the term.

2. Secondary Meaning

In Qualitex, the Court accepted that color may attain “secondary meaning”; i.e., to identify and distinguish a particular brand, thus indicating its source. The Court found that the green-gold color of Qualitex's dry cleaning press pads had developed such secondary meaning. [41] By preventing others from copying a source-identifying mark, trademark law is said to “reduce the customer's costs of shopping and making purchasing decisions” by assuring a potential customer that an item with an identifying trademark is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. [42] At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby “encourages the production of quality products and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer's inability quickly to evaluate the quality of an item offered for sale.” [43]

One threshold question therefore is whether the Harley exhaust note allows consumers to distinguish its source. Based on the comments noted earlier by Harley devotees and mechanics, it is certainly possible that knowledgeable purchasers can, by its sound alone, identify a Harley-Davidson motorcycle from among other bikes on the market. Harley public relations coordinator Nola Vander contends that “Harley-Davidson has been in existence since 1903, and the exhaust sound has become identified with our motorcycle. It's a distinctive brand identifier all on its own.” [44] Harley-Davidson additionally has supplied the PTO with studies showing that consumers identify the unique V-Twin engine sound with Harley-Davidson bikes. [45]

Of course, opponents say “ hogwash” to Harley's claim of “you know a Harley when you hear one.” They feel that any V-twin, common crankpin engine can make a similar sound. [46] Witness the demonstration below in Figure 2. The bike pictured on the left in Figure 2 is Harley-Davidson's “Fatboy” model; on the right is Honda's competing Shadow Ace 1100. Aside from color, their physical design appears remarkably similar (a subject for an entirely different paper!). Each motorcycle employs a V-Twin engine with common crankpin design. Now click on each picture to play a recording of the exhaust note of each motorcycle. Do you hear a difference? If you did not have the pictures (or filenames) indicating which motorcycle produces each sound, would you know that one exhaust note belonged to a Harley and one did not? (While these questions implicate a “likelihood of confusion” analysis as much as they do secondary meaning, they will certainly be raised in any court or PTO challenge of the proposed trademark.)

Figure 2: Has the Harley Roar Acquired Secondary Meaning?

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purchaser, or aficionado, and therefore, the sort of consumer on whom Harley is relying to satisfy the secondary meaning requirement for its trademark. On the other hand, the PTO, or a federal judge, is most likely in a similarly “uninformed” position. Therefore, the studies that Harley supplied to the PTO are essential, but careful attention must be paid to the methodology of the survey. For instance, if Harley engineers or mechanics were surveyed, one would expect that they could identify the motorcycle by sound. Even if “lay” purchasers were surveyed, unless the survey was performed in a “blind” format where participants did not know which motorcycle was being “revved” aside from the sound, there is room to be skeptical of Harley's data.

For these reasons, it is entirely possible, if not likely, that Harley's exhaust note has not achieved secondary meaning in the market. In fact, it is plausible that most people might assume that a motorcycle that sounds like either a Harley Fatboy or a Honda Shadow is a Harley. If that is true, then Harley has achieved dominant name recognition in the market, but not in the specific way that secondary meaning demands.

It is important to add that the Qualitex Court's reasoning with respect to secondary meaning seems inapposite to the situation presented by Harley-Davidson's application. Namely, a trademark in Harley's exhaust noise will not, in the parlance of Qualitex, “reduce the customer's costs of shopping and making purchasing decisions.” Harley's trademarked logos and any protected trade dress already confer secondary meaning or inherent distinctiveness in the marketplace, thereby ensuring that the consumer is aware of the source of his or her motorcycle. [47]

3. Functionality

The “functionality” doctrine prevents trademark law, which seeks to promote competition by protecting a company's reputation, from inhibiting legitimate competition by allowing a producer to control a useful product feature. [48] The Qualitex Court explained, “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.” [49] The Court reasoned that if a product's functional features could be used as trademarks, a monopoly over such features could be obtained without regard to whether they are patentable and, moreover, could be extended forever because trademarks may be renewed in perpetuity. [50]

Applying this reasoning in the realm of color, the Court concluded that a trademark in the green-gold coloring of Qualitex's dry cleaning press pads did not violate the functionality doctrine, because the color served no function in the product's operation other than as a source-identifying symbol. [51]

The Court stressed, however, that, “[i]n general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” indicating that exclusive use of the feature would put competitors at a significant disadvantage unrelated to their reputations. [52] In the case of Harley-Davidson's application, unlike the situation in Qualitex, Harley's proposed trademark is a function of its V-Twin, common crankpin engine design, which is, in turn, essential to the “use or purpose” of the motorcycle.

Harley-Davidson does not claim a patent on this century-old engine technology. However, through the attempted registration of its distinctive exhaust roar as trademark, Harley-Davidson attempts to use trademark law to obtain a patent-like monopoly on the engine technology itself. Therefore, the applicability of the functionality doctrine weighs most decisively against the grant of Harley-Davidson's trademark.

VII. CONCLUSION

Harley-Davidson will likely argue that they have no intention of preventing other motorcycle manufacturers from building bikes with V-Twin, common crankpin designs. Rather, Harley simply wants to prevent manufacturers from producing bikes which sound like Harleys. This argument, which Harley will likely raise in response to the functionality doctrine, may inadvertently demonstrate that its exhaust noise trademark, if granted, would be valueless.

The major concern for the defendant in such a suit would be how the court perceived Harley's trademark.
Analogous to theories in copyright, the Harley trademark might be seen as “thick”—i.e., easily infringed based on the confusing similarity test. If this is the case, any company producing a V-Twin, common crankpin motorcycle which sounds even vaguely like a Harley, might be liable for infringement. Of course, the jury has some input into determining likelihood of confusion, but the judge's instructions, i.e., whether to view the trademark as “thick” or “thin,” may direct the jury to a particular factual determination.

The eventually outcome, however, may well be this: Harley's competitors will continue building motorcycles with common crankpin V-Twin engines, and any infringement lawsuits will likely be unsuccessful. Based on the Supreme Court's reasoning in *Qualitex*, Harley's proposed trademark soundly fails the critical functionality test. That the trademark not be functional is of paramount importance to the courts because of the real fear of creating an unearned monopoly. This concern will, in all likelihood, prevent Harley from trademarking its motorcycles’ exhaust sound.

Perhaps, instead of pursuing this quirky, highly controversial trademark, Harley-Davidson should have been paying closer attention to protecting its trademarks in other media. Despite the company's keen awareness of the value of its trademarks, Harley evidently failed to register the World Wide Web domain name “Harley.com” ahead of an obscure author of computer books named Harley Hahn.

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[8]. *Id.*

[9]. See *Id.*


[14]. Id.


[16]. Id. The G-E-C note combination stemmed from the fact that, at the time, General Electric Corporation owned NBC.

[17]. Id.

[18]. Miller, supra note 12. Note: as of the date of this publication there are 25 registered sound trademarks.


[20]. Id.; See also In re Clarke, 17 U.S.P.Q.2d 1238, 1240 (TTAB 1990).


[22]. O'Dell, supra note 5.

[23]. Id.

[24]. Dejonge, supra note 11.

[25]. O'Dell, supra note 5.

[26]. Miller, supra note 12.


[29]. Id. See Erik W. Kahn & George Stephanopoulos, Starting To Register: Moving-Image Marks, 18 Nat'l L.J. (May 20, 1996), at C5.

[30]. Id.

[31]. See Id.

[32]. Qualitex, 54 U.S. at 168.

[33]. Id.

[34]. Id. at 1303.

[35]. Id. at 1304.

[36]. See Qualitex, 54 U.S. at 169.

[37]. See Id.
[38]. Id.


[40]. Kawasaki Motors, 1997 TTAB LEXIS 11 at *4 (TTAB held that the mark to be registered is the mark as recited in the written description).

[41]. Qualitex, 54 U.S. at 169.

[42]. Id.

[43]. Id.

[44]. Miller, supra note 12.

[45]. See O'Dell, supra note 5.

[46]. See Kawasaki Motors at *12.

[47]. Qualitex, 54 U.S. at 170.

[48]. Id.

[49]. Id.

[50]. Id.

[51]. Id.

[52]. Id.