



## USPTO Registers Unique "Non-Traditional" Service Mark: A 109-Word Narrative Story – Registration of The Peabody Hotels' "Legend of the Ducks" Follows Earlier Motion Mark Registration of its Iconic Duck March

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The famous Peabody Hotels in Memphis, Orlando and Little Rock are known for their iconic March of The Peabody Ducks, in which trained mallard ducks, guided by the "Duckmaster," delight audiences twice-daily. A red carpet is rolled out, and the ducks leave their rooftop "penthouse," proceed down an elevator, and march across the red carpet, up steps and into the beautiful fountains in The Peabody Hotels' lobbies. The ducks spend their days leisurely swimming in the fountain, and at day's end perform the March in reverse and retire for the night. The Ducks have appeared on numerous television broadcasts, including *Oprah* and numerous travel programs, and received enormous print publicity.

Knowing that the Duck March had become synonymous with The Peabody Hotels, the Hotels' owner recognized the importance of protecting the valuable intellectual property of both the Duck March and "The Legend of the Ducks" – the 109-word story about how decades ago the Ducks came to march daily to The Peabody fountain.

Already faced with several infringing "copyduck" march activities, The Peabody Hotels wanted to protect these rights. For intellectual property counsel, the question was not so simple. How could we protect such a non-traditional brand icon, but use traditional intellectual property law? Existing registrations for the Hotels' duck logo were not enough. So I sought to register both the Duck March and the Legend of the Ducks as "non-traditional" trademarks with the United States Patent and Trademark Office ("USPTO").



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With the recent registration of the Legend, The Peabody Hotels now owns two of the most unique marks on the U.S. Trademark Register for its hotel and related services.

First, in 2003, I successfully registered the Peabody Duck March itself as a motion mark, described on the Register as follows:

*The mark consists of the live visual and motion elements of the The Peabody Duck March as performed at The Peabody Hotels, only one segment of which is depicted in line art in the drawing. The motion elements include the red carpet being rolled out, the appearance of the ducks and uniformed Duckmaster at the elevator door, and the march of the ducks down the red carpet, up the steps, and into the fountain where they begin swimming. The mark also includes the fanfare in reverse sequence.*

U. S. Reg. No. 2,710,415. Currently, only a very small number of motion marks exist on the Register, most relating to animated computer graphics. The Duck March is believed to be the sole motion mark on the Register consisting of live motion.

After registering the motion mark, the next step in protecting Peabody's rights in the Duck March was to register the Legend behind the Duck March. The Legend was written in two versions. The shorter, 109-word version reads:

*The legend of the ducks how did the tradition of the ducks in The Peabody fountain begin? Back in the 1930's Frank Shutt, General Manager of The Peabody, and a friend, Chip Barwick, returned from a weekend hunting trip to Arkansas. The men had a little too much Tennessee sippin' whiskey, and thought it would be funny to place some of their live duck decoys (it was legal then for hunters to use live decoys) in the beautiful Peabody fountain. Three small English call ducks were selected as "guinea pigs," and the reaction was nothing short of enthusiastic. Thus began a Peabody tradition which was to become internationally famous.*

The effort to register the Legend lasted 10 years, and involved two applications and an appeal of the first application's final refusal to the Trademark Trial and Appeal Board ("TTAB"). The first application was for the longer, 182-word version of the Legend that The Peabody Hotels uses in its marketing materials. (The additional words discuss more current information about the Duck March). Upon review by the USPTO Commissioner's Office, the first application was refused registration as "just a story" that failed to function as a service mark.

The TTAB affirmed the refusal to register, but left open a window for registration. It recognized the technical right to register a long narrative, as the Trademark Act fundamentally provides that a mark can consist of "any word . . . or any combination thereof." 17 U.S.C. § 1127 (emphasis added). Instead, the Board focused on the specimens (brochures and web pages), which it found insufficient to show source-identifying service mark use:

[C]onsumers likely would perceive The Legend as advertising or promotional information about an event at applicant's hotels rather than as a source identifier for applicant's services of "providing facilities for business meetings" and "providing facilities for banquets" and for "hotel services; and hotel catering and concierge services." That is to say, applicant's specimen does not show use of The Legend to identify the services for which applicant seeks registration; to the contrary, The Legend conveys history and current information in the nature of an advertisement for the Duck March.

*In re Peabody Management, Inc.*, Serial No. 76/068,295 (TTAB June 30, 2005).

We believed the Board's ruling was erroneous, because the evidence showed the story was clearly associated with the Hotels' services. We filed a new application on behalf of The Peabody Hotels for the shorter version of the Legend that took into account the TTAB analysis of the specimens.

We selected the Hotels' napkins as the specimens for the second application because the Legend is imprinted on every napkin used in the Hotels' rooms, restaurants, bars, banquet rooms, and meeting facilities. The evidence demonstrated that the Hotels had distributed over 60 million napkins featuring the Legend over 25 years. Undeniably, the Hotels made this use *directly* in connection with its provision of hotel and related services. Nevertheless, the Commissioner's Office again directed the Examining Attorney to refuse registration on the same ground as asserted previously – that the Legend failed to function as a service mark.

We made arguments comparing the existence of several other "lengthy word" marks, but the comparisons were rejected. Most were rejected as not comparable because they were trademarks on decorative bottle or packaging labels, rather than service marks. Even a comparison to the service mark registration for the shorter "I Wanna Be a Toys R Us Kid" song was rejected as not instructive, since it included the tune as well as lyrics.

Peabody's response to the refusal ultimately entailed our filing of responses to multiple office actions and the submission of vast evidence showing use and repetition of the Legend by, not only the Hotels, but also the Hotels' visitors on their own web sites, on personal blogs, and in news articles. I also sought and was granted a personal interview with the USPTO Deputy Commissioner for Trademark Examination Policy. Through this multi-stage advocacy, we were able to demonstrate that the second application and its napkin specimen met the criteria outlined by the TTAB in its opinion on the first application. Persistence paid off. The Commissioner's Office thereafter approved the mark for publication. The registration issued on September 28, 2010 as Reg. No. 3,853,633.

The Legend is believed to be, by far, the lengthiest narrative service mark on the United States Principal Register.

Little did Mr. Shutt and his duck-hunting and drinking buddy know that their exploits would lead, more than 75 years later, to such valuable marketing assets, let alone, two of the most famous non-traditional marks on the United States Trademark Register. Of course, don't look for any duck on the menu in The Peabody Hotels' many fine restaurants; today, the only ducks you will find at

The Peabody are the pampered kind that spend their days marching and swimming in the Hotels' fountains and retiring at night to their penthouse.

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