

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Examination of Non-Traditional Marks and Acquired Distinctiveness at USPTO

Leigh Lowry
Tomas Vlcek
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Defining “Trademark” - What is Eligible Subject Matter?

The U.S. Trademark Act sets out a broad definition of “trademark” essentially encompassing non-traditional marks by NOT excluding them:

“any word, name, symbol, or device, or any combination thereof”

Section 45 of the Trademark Act, 15 U.S.C. §1127

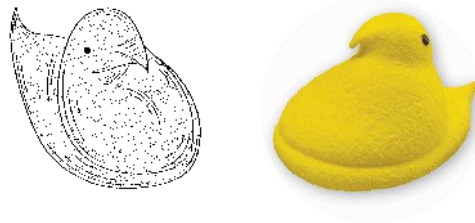


3D Trade Dress: Product Design

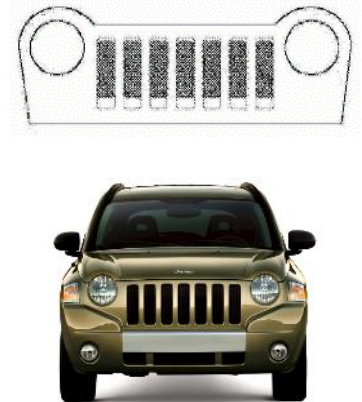
Crocs footwear
U.S. Reg. No. 5149328



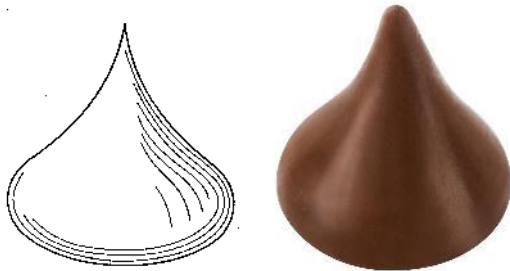
Peeps marshmallow candies
U.S. Reg. No. 2185581



FCA US (Jeep) automobiles
U.S. Reg. No. 3199299



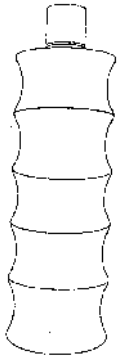
Hershey Kiss candies
U.S. Reg. No. 1986822



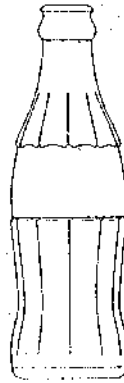
Pepperidge Farm Goldfish crackers
U.S. Reg. No. 1640659



3D Trade Dress: Product Packaging



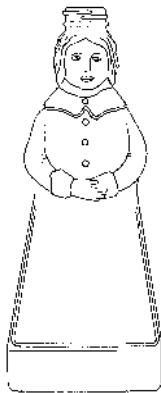
U.S. Reg. No. 3303036



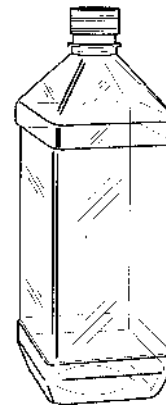
U.S. Reg. No. 0696147



U.S. Reg. No. 3303036



U.S. Reg. No. 1138877

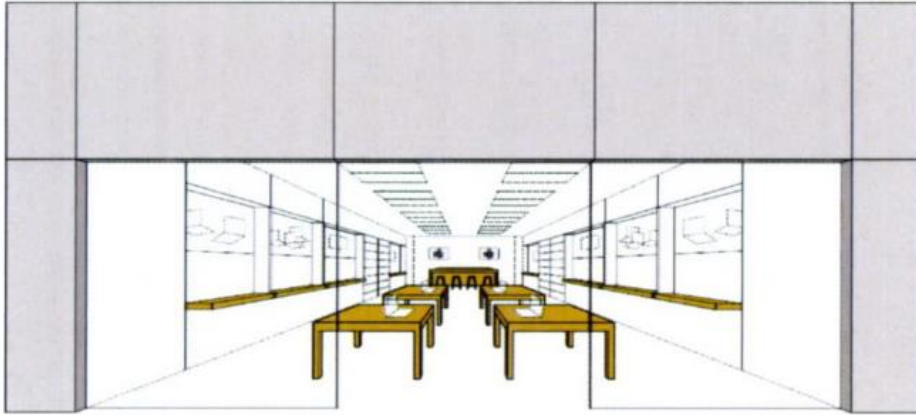


U.S. Reg. No. 2911918

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3D Trade Dress: Services

Three-dimensional items used in connection with services, *e.g.*, a building design, a building interior, a uniform or a vehicle used in rendering the service.



Apple Retail Store Design and Layout
U.S. Reg. No. 4277913



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Color Marks



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Examination Process: Common Steps

- Applicant applies for registration
- Examiner evaluates whether the mark is registrable and issues a first Office action
 - Is it functional?
 - Is it inherently distinctive or non-distinctive?
 - Requests additional information from applicant
- Applicant responds with arguments, amendments, evidence, and any required information
 - Applicant may argue the merits of the refusal and/or amend to claim acquired distinctiveness under Trademark Act Section 2(f)

Examination Process: Common Steps

- Examiner may accept the amendment claim acquired distinctiveness or issue a new refusal because the evidence is insufficient
- Applicant responds with additional arguments and evidence in support of acquired distinctiveness
- Examiner may approve the application or issue a final refusal on all outstanding issues
- Applicant may appeal final refusal to Trademark Trial and Appeal Board
 - Applicant may also request reconsideration by the examiner for one last opportunity to provide arguments or evidence
 - Examiner will respond to a request for reconsideration by withdrawing the refusal or providing additional evidence or arguments
 - Appeal resumes if examiner maintains the refusal

Registration of Trade Dress

When an applicant applies to register product design, packaging, or other trade dress, the examiner must consider two separate issues:

1) FUNCTIONALITY

- *Functional trade dress is not registrable*

2) DISTINCTIVENESS

- *Trade dress that is **inherently distinctive** may be registrable*
- *Trade dress that is non-distinctive may be registrable with evidence of **acquired distinctiveness***

To be registered, the trade dress must be both non-functional and distinctive. An examiner may refuse trade dress on either or both of these grounds.

Functionality: Test

- U.S. Supreme Court has held that a feature of a proposed mark is functional if it is “essential to the use or purpose of the product or if it affects the cost or quality of the product.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001).
- Mere fact that a product design or packaging has some purpose or function does not necessarily mean that the mark should be refused as functional.

Functionality: Four Factors to Consider

An examiner's determination of functionality generally involves consideration of one or more of the following factors:

- 1) The existence of a **utility patent** that discloses the utilitarian advantages of the design sought to be registered;
- 2) Advertising by the applicant that **promotes the utilitarian advantages** of the design;
- 3) The availability of **alternative designs**; and
- 4) Whether the design results from a comparatively **simple or inexpensive method of manufacture**.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

Functionality: Information Requests

- The burden of proving functionality is on the examiner, but the applicant has better access to the relevant information.
- The examiner will require the applicant to provide information necessary to permit an informed determination concerning registrability, including:
 - *Relevant patents*
 - *Promotional materials*
 - *Alternative designs*
 - *Methods/costs of manufacture*

Distinctiveness

- To be registrable, a mark must be able to identify and distinguish the applicant's goods or services from the goods or services of others.
- Even if it is determined that the product's design or packaging is not functional, it cannot be registered unless it is distinctive.

Distinctiveness: Product Design and Packaging

U.S. Supreme Court distinguished between two types of trade dress. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

- **Product design**

- May never be inherently distinctive
- Must show evidence of acquired distinctiveness



- **Product packaging**

- Though uncommon, may potentially be inherently distinctive
- Must show evidence of acquired distinctiveness if not inherently distinctive

Distinctiveness: Color

- Marks consisting solely of color are **registrable** if they are not functional. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).
- However, they are **never inherently distinctive** and may be registered only with evidence of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

Inherent Distinctiveness

U.S. Reg. No. 3825320

- Considered for **product packaging** *only*.
- Four factors considered to determine whether inherently distinctive:
 1. Is the proposed mark a “**common**” **basic shape or design**?
 2. Is it **unique or unusual** in the field in which it is used?
 3. Is it a **mere refinement** of a commonly-adopted and well-known form of ornamentation for a particular class of goods?
 4. Is it capable of creating a **commercial impression distinct from the accompanying words**?



Acquired Distinctiveness

- “An evidentiary showing of secondary meaning...includes evidence of the **trademark owner’s method of using the mark**, supplemented by evidence of the **effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.**” *In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417 (Fed. Cir. 1985).
- An acquired distinctiveness claim may be supported by evidence such as:
 1. Ownership of prior registrations
 2. An assertion of 5 years substantially exclusive and continuous use in commerce
 3. “Other evidence”

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).



Acquired Distinctiveness

- **Non-traditional marks typically require substantial “other evidence.”**
 - Prior registrations may be adequate only if acquired distinctiveness was established in those cases with sufficient evidence.
 - “5 years use” by itself is never considered adequate evidence of acquired distinctiveness for non-traditional marks.
- **The kind or amount of evidence necessary to establish acquired distinctiveness depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. Non-traditional marks require a more significant evidentiary showing.**
- **Evidence showing use of the non-traditional mark with wording or designs will generally be insufficient.**

Acquired Distinctiveness: Circumstantial Evidence

Evidence that demonstrates general exposure of the mark to the purchasing public but not that the public views the mark as a source indicator may be relevant but is not conclusive.

- Long use of the mark in commerce
- Prior registrations
- Product advertising materials and expenditures
- Sales figures
- Unsolicited media coverage

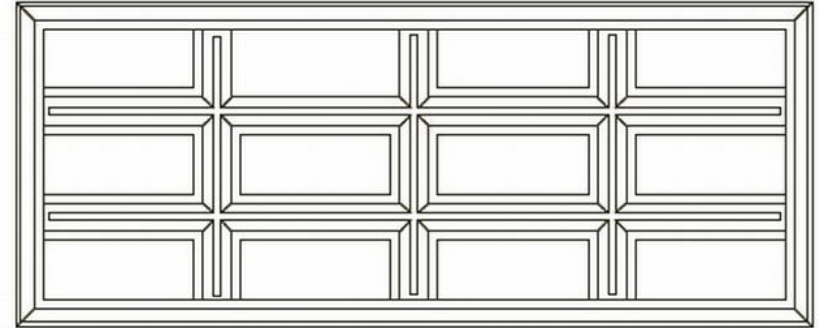
Acquired Distinctiveness: Direct Evidence

Applicant should provide evidence specifically demonstrating that the applicant has been successful in educating the public to associate the proposed mark with a single source.

- Affidavits or declarations by the consuming public asserting recognition of the mark as a source indicator
- Surveys or market research showing that the consuming public views the proposed mark as an indication of the source of the product or service
- Advertisements promoting the mark, rather than promoting the goods generally
 - “Look for” advertising highlighting the mark as identifying the source

Example: U.S. Reg. No. 4322502

The mark is a configuration of a candy bar that consists of twelve (12) equally-sized recessed rectangular panels arranged in a four panel by three panel format with each panel having its own raised border within a large rectangle.



Candy; chocolate

International Class 30

First Use: 12/31/1968

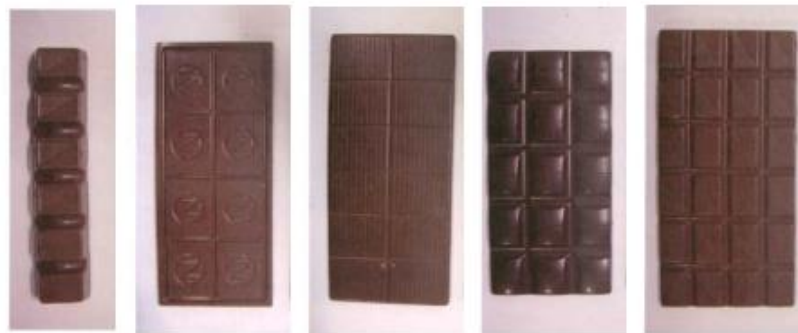
Use In Commerce: 12/31/1968



Example: U.S. Reg. No. 4322502

In re Hershey Chocolate & Confectionary Corp., Serial No. 77809223 (6/28/12).

- Design held to be not functional
 - Scoring serves a useful purpose, but applicant is not claiming a segmented candy bar of no particular design – must consider overall appearance
 - Record shows a variety of shapes and decorative designs for candy bars
 - No evidence that this particular combination of recessed rectangles with a raised border is used by others or is functional

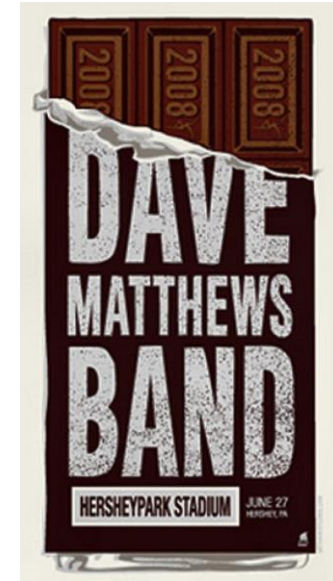


Example: U.S. Reg. No. 4322502

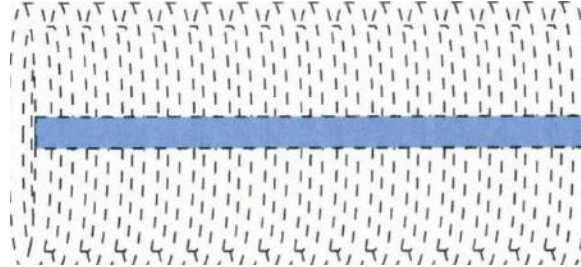
In re Hershey Chocolate & Confectionary Corp., Serial No. 77809223 (6/28/12).

- Design held to have acquired distinctiveness
- Direct evidence
 - Survey – 42% recognized Hershey as the source of the product design
- Circumstantial evidence
 - Use since 1968
 - Sales of \$4 billion in last 12 years
 - Advertising expenditures of \$186 million in last 24 years
 - No “look for” advertisements but some ads displayed configuration prominently
 - Third-party copying of design

Example: U.S. Reg. No. 4322502



Example: U.S. Reg. No. 4434259



The mark consists of a blue stripe applied to the length of the goods. The broken lines form no portion of the mark and are provided only to illustrate placement of the mark on the goods.

Flexible non-metal corrugated pipes for drainage and sewage purposes, but not for irrigation purposes, and fittings couplings therefor; *in International Class 17*

First Use: 01/01/2007 Use In Commerce: 01/01/2007

Non-metal storm water treatment units comprised of chambers, pipes and fittings and couplings therefor, risers, baffles, baffle plates, and weir plates; rigid non-metal corrugated pipes and conduits for drainage and sewage purposes, but not for irrigation purposes, and fittings and couplings therefor; *in International Class 19*

First Use: 07/12/2006 Use In Commerce: 07/12/2006



Example: U.S. Reg. No. 4434259

Applicant's evidence of acquired distinctiveness:

- Over 6 years use
- Advertisements referencing “Blue Stripe,” including direct evidence
 - \$120,000 in advertising literature through Lowe’s
 - \$100,000s in trade publication advertising
- Over \$640 million in sales (\$100 million annually)
- Mark prominently displayed on entire length of the goods
- Common use of color as a source indicator in the industry

Example: U.S. Reg. No. 4434259

IMPROVE YOUR
Return on Investment
by using Hancor® drainage products on every project



HDPE corrugated pipe from Hancor is the ideal choice for residential, commercial and recreational drainage needs. We offer the most comprehensive product selection in the industry featuring industry-leading product quality standards.

Look for the blue stripe at Lowe's for quality assurance meeting all your drainage project needs.



Call today or visit our website for more details.

Hancor corrugated pipe is available at Lowe's in a variety of lengths to meet your every need.



BLUE STRIPE® LEADING THE WAY.

Hancor, Inc.
401 Olive St., Findlay, OH 45840
1-800-567-8331
www.hancor.com



Hancor® is a registered trademark of Hancor, Inc. © 2007 Hancor, Inc.



Direct Evidence

"Look for the blue stripe at Lowe's..."

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Example: U.S. Reg. No. 4434259

Direct Evidence

"The next time you take delivery of **Hancor pipe**, you might notice something different: **The Blue Stripe**. That simple blue stripe is our **signature**. It represents a promise to our customers..."



THE EVOLUTION OF DRAINAGE

The next time you take delivery of Hancor pipe, you might notice something different. The Blue Stripe. That simple blue stripe is our signature. It represents a promise to our customers. Hancor will combine the focus on innovation that you've come to expect with a world-class commitment to customer service. We know that in today's market we have to raise the bar every day to earn your trust, and we have to reach new heights in service in order to keep it. That's why we're delivering additional value by adding more plants and distribution centers, more staff and more products. Together with our customers as partners, we'll continue to lead the industry.

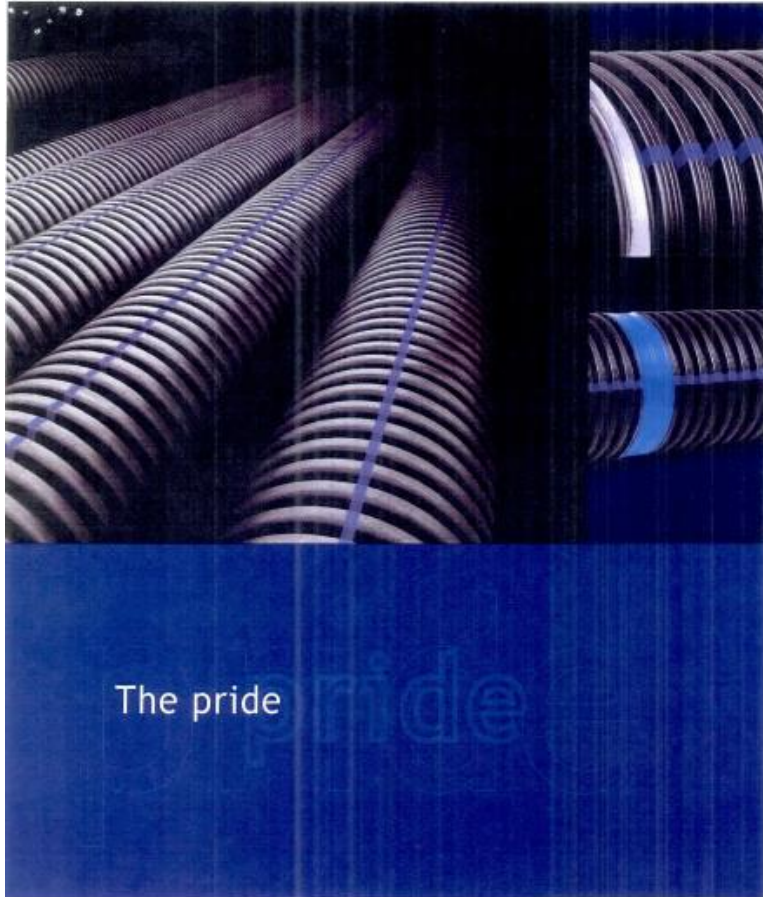
Circle #270 or use InfoDirect at www.cenews.com

BLUE STRIPE. LEADING THE WAY.

Call customer service at 1-888-FOR-PIPE (367-7376).
Or visit us on the web: www.hancor.com

Hancor
Technology · Innovation · Excellence

Example: U.S. Reg. No. 4434259



As we roll out Hancor pipe with the Blue Stripe over the next year, you'll have the opportunity to experience the new Hancor. New synergies and partnerships will allow us to deliver even greater levels of customer service. You can expect more:

- Unmatched sales, engineering and customer service support with a relentless passion for growing the business
- The most comprehensive product selection in the industry featuring industry-leading product quality standards
- Enhanced resources including more plants and distribution centers
- Significant investment in state-of-the-art manufacturing equipment and technology
- The industry's largest trucking fleet providing unparalleled delivery service

The Blue Stripe is who we are.



Direct Evidence



"As we roll out Hancor **pipe with the Blue Stripe** over the next year, you'll have an opportunity to experience the new Hancor..."

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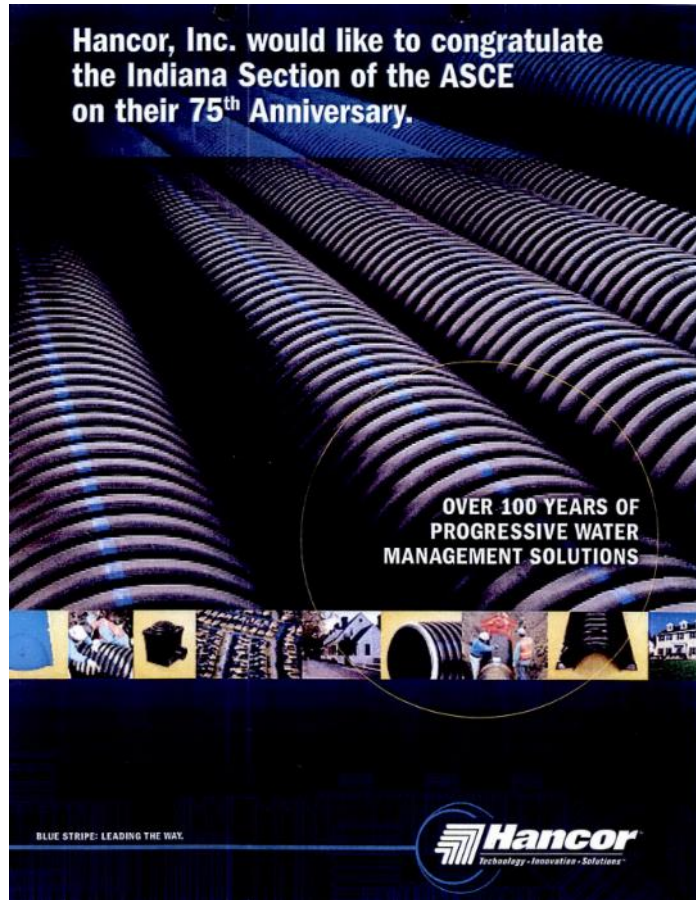
Example: U.S. Reg. No. 4434259

Direct Evidence

"**The Blue Stripe** is who we are...
That's what **the Blue Stripe** stands for."

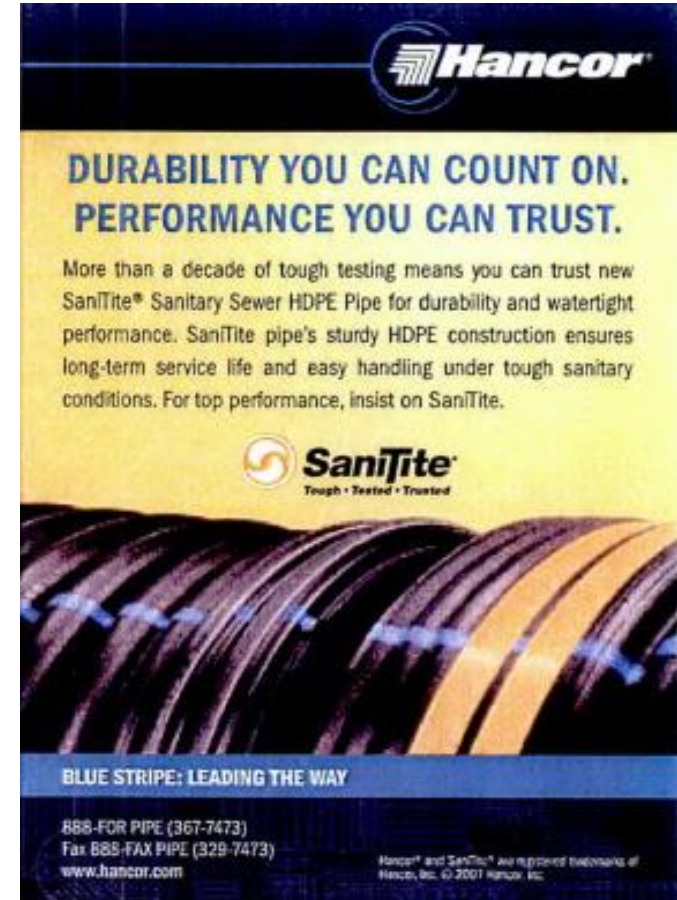


Example: U.S. Reg. No. 4434259

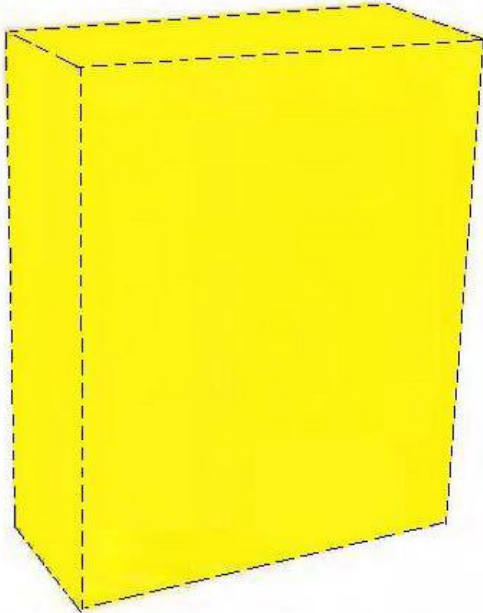


Circumstantial Evidence

“Blue Stripe: Leading the Way”



Example: U.S. Serial No. 86757390



The mark consists of the color yellow appearing as the predominant uniform background color on product packaging for the goods. The dotted outline of the packaging shows the position of the mark and is not claimed as part of the mark.

Toroidal-shaped, oat-based breakfast cereal; in International Class 30

First Use: 05/03/1941

Use In Commerce: 05/03/1941



Example: U.S. Serial No. 86757390

Applicant summarized their evidence of acquired distinctiveness as:

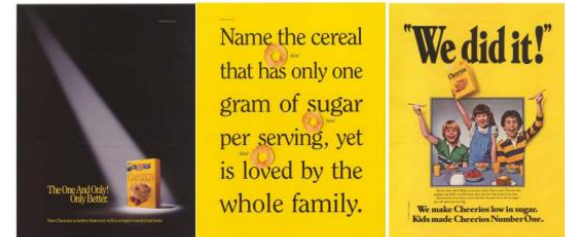
- Over 75 years of use and substantially exclusive use
- Over \$4 billion in sales over the last decade



Example: U.S. Serial No. 86757390

Applicant summarized their evidence of acquired distinctiveness as:

- Over \$1 billion in advertising expenditures over the last decade through various means, including a Super Bowl commercial
- Evidence of pervasive and extensive use of the color of Applicant's cereal box in various advertising materials, and advertising focusing on Applicant's box
- Evidence of "look for" advertising of yellow box [Television commercials stating "the big yellow box that everyone knows" and "that yellow box"]



Example: U.S. Serial No. 86757390

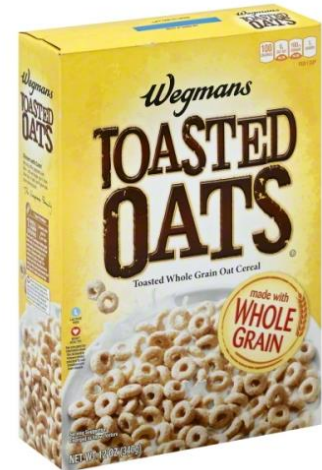
Applicant summarized their evidence of acquired distinctiveness as:

- Website evidence of unsolicited media stories and consumer statements regarding “iconic,” “distinctive,” “trademark,” and “signature” status of yellow box
- Survey evidence showing at least 48.3% consumer association of yellow box with applicant

- An Associated Press article appearing in many different news outlets, including USA Today, CBS News, and the Denver Post, stating “*The answer, of course, is Cheerios. The iconic cereal, known by its distinctive yellow box...*”
- An article published by the Huffington Post stating “...when compared to the single gram that sits in each serving of the original Cheerios that come in **that iconic yellow box.**”
- An article published by Answers.com stating “Chances are good that you grew up eating Cheerios. **That iconic yellow box** brings out feelings of nostalgia in many people.”
- An article published by New York Magazine stating “The De Blasios welcomed the comparison; a post on Bill’s campaign website entitled ‘Cheerios’ features the family posed around the cereal’s **signature yellow box.**”
- An article published by ESPN stating “Think about how brand loyalty usually works. Let’s say you like Cheerios. **Sure, you’ve internalized a positive emotional association with the yellow box** and logo, but your loyalty is ultimately based on how much you like the cereal.”
- An article published by the Midland Reporter-Telegram stating “**Cheerios are easy to find on store shelves: Just look for the big yellow box.**”
- An article published by the New York Daily News stating “The ad ends with the word ‘Love’ emblazoned over **the cereal’s trademark yellow box...**”
- An article published by LA Weekly stating “There now are 13 types of Cheerios on grocery store shelves, which some fans of the original in the **iconic yellow box** think are 12 too many.”
- An article published by Huliq stating “Today the popular cereal packaged in a **distinctive yellow box** celebrates its 70th birthday.”
- An article published by Stealing Share stating “Basically, Trix didn’t have the cover of the overall Cheerios brand....**Its yellow box is instantly recognizable** (and even nostalgic for some).”

Example: U.S. Serial No. 86757390

Examiner argued that the color yellow on packaging for cereal is not distinctive because of common use.



Example: U.S. Serial No. 86757390

In re General Mills IP Holdings II, LLC, 124 USPQ2d 1016 (TTAB 2017):

Applicant has proven that relevant customers are familiar with the yellow color of the CHEERIOS box; but the record also indicates that the color yellow is only one aspect of a more complex trade dress that includes many other features that perform a distinguishing and source-indicating function.

When we consider the industry practice of ornamenting breakfast cereal boxes with bright colors, bold graphic designs, and prominent word marks, and the fact that customers have been exposed to directly competing products (toroidal oat cereals) and closely related products (other forms of breakfast cereal) in packages that are predominantly yellow, we are not persuaded that customers perceive Applicant's proposed mark, the color yellow alone, as indicating the source of Applicant's goods.

