

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 23, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re General Technologies, Inc.

Serial Nos. 77052472 and 77052485¹

John S. Egbert of Egbert Law Offices, PLLC for General Technologies, Inc.

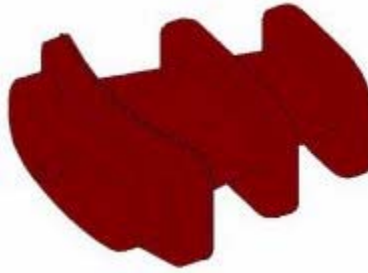
Linda M. Estrada, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Kuhlke, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, General Technologies, Inc., has filed applications to register as trademarks on the Principal Register based on acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), the following:

¹ Inasmuch as the issues raised by these appeals are similar, the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 77052472, unless otherwise noted; however, we have, of course, considered all arguments and evidence filed in each case.



for "maroon plastic encapsulated steel anchors for multi-strand post-tension systems" in International Class 6, claiming the color maroon as a feature of the mark and describing the mark as follows: "The mark consists of the color maroon applied to the plastic encapsulation, which entirely surrounds the sounds and configuration of the goods. The configuration of the goods including the rectangular and oval shapes of the goods are not features of the mark. The dotted lines show placement of the mark on the goods";² and



for "maroon plastic encapsulated steel anchors for monostrand post-tension systems" in International Class 6, claiming the color maroon as a feature of the mark and describing the mark as follows: "The mark consists of the color maroon applied to the plastic encapsulation, which entirely surrounds the sounds and the configuration of the goods. The configuration of the goods including the circular, triangular and rectangular shapes of the goods are not features

² Application Serial No. 77052472, filed November 28, 2006, alleging 1998 as the date of first use and first use in commerce.

of the mark. The dotted lines show placement of the mark on the goods.”³

The examining attorney refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1127, on the ground that applicant’s alleged marks are ornamental and not inherently distinctive and, thus, fail to function as trademarks. In maintaining the refusals under Sections 1, 2 and 45, the examining attorney also found that applicant did not make a sufficient evidentiary showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

When the refusals were made final, applicant appealed and requested reconsideration. On October 31, 2008 and February 26, 2009 the examining attorney denied the requests for reconsideration. The appeals were subsequently resumed and have been briefed. We affirm the refusals to register.

The examining attorney argues that the color marks are not inherently distinctive and the evidence submitted by applicant is insufficient to establish that the proposed marks have acquired distinctiveness under Section 2(f) of the Trademark Act.

³ Application Serial No. 77052485, filed on November 28, 2006, alleging June 1998 as the date of first use and first use in commerce.

In response to the refusal based on lack of inherent distinctiveness, applicant argues that its marks have been in use since 1998 and serve to distinguish its goods from others and to indicate their source. In support of its assertion of acquired distinctiveness, applicant relies on: (1) printouts from three third-party websites showing post-tensioning devices in colors other than maroon; (2) a printout from applicant's website showing its products displayed in a maroon color and the color maroon used in some lettering and outlines; (3) applicant's Supplemental Registration Nos. 2574631 and 2603027 for the color marks in the subject applications; and (4) applicant's specimen of use.

Color marks, as a matter of law, are not inherently distinctive and can only be registered upon a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1162-1163 (1995). See also *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). Refusals based on failure to function may be overcome by a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. The burden of proving a prima facie case of acquired distinctiveness in an ex parte

proceeding rests with applicant. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. See *In re Ennco*, 56 USPQ2d 1279, 1283 TTAB (2000). See also 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. updated 2009).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; however, the burden of proving that a color mark has acquired distinctiveness is substantial. In *re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). See also *Yamaha*, supra, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue).

After careful review of the evidence of record, we agree with the examining attorney that applicant's evidence of acquired distinctiveness is insufficient to permit registration of the claimed color under Section 2(f).

Although applicant may have sold its goods with the maroon color for ten years, in this case, given the nature of the proposed mark, a color on an industrial product, applicant's length of use is insufficient, in itself, to bestow acquired distinctiveness. Rather, further evidence is required to show the method of using the mark and the effectiveness of such use "to cause the purchasing public to identify the mark with the source of the product."

Owens-Corning, supra, 227 USPQ at 422. Cf. TMEP

§1212.05(a) ("For matter that does not inherently function as a mark because of its nature (e.g., ...overall color of a product, mere ornamentation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness.")

Applicant has not provided information as to the amount of sales or advertising associated with the proposed color marks. We note, in any event, mere figures of product sales and advertising, standing alone, are not

sufficiently probative of purchaser recognition of a color combination as an indication of source. Cf. *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) ("[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun."); *In re Bongrain Int'l (American) Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition of the asserted mark as denoting origin). It is well established that compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

As noted above, the more important question is how is the alleged mark being used, i.e., have consumers been exposed to the alleged mark in such a manner that we can impute consumer association between the claimed color and

the product producer. To determine whether the claimed color has acquired distinctiveness, advertisements must show promotion of that color as it appears on those goods as a trademark.

As noted by the examining attorney, there is nothing of record that shows that the alleged mark is being promoted as a source indicator. The examples in the record show a picture of the product in maroon. There is no mention or description of the product's color in any of the advertising displayed on its website, let alone any promotional effort that focuses upon the trademark significance of the color as applied to the product. Applicant's use of the color maroon as background and decorative color on its website and order forms, is not sufficient to support a showing of acquired distinctiveness of the color maroon as used on applicant's goods.

With regard to its Supplemental Registrations applicant argues:

[T]he existence of the mark on the supplemental register proves that the mark is registrable as a trademark on the principal register. Consumers will certainly view the color maroon as a source indicator for Applicant since it has been in continuous use since 1998. Since that time, competitors have also had to refrain from using the color maroon to identify their products due to Applicant's registration on the Supplemental

Register. Applicant argues that the evidence shows that competitors clearly have refrained from using the color maroon as a source identifier, that consumers have become accustomed to the color maroon as goods that are manufactured by applicant, and that the mark has, therefore, acquired distinctiveness under Section 2(f) of the Trademark Act.

Br. p. 3.

First, applicant may not base its claim of acquired distinctiveness on ownership of a Supplemental Registration. In re Canron, Inc., 219 USPQ 820, 822 n. 2 (TTAB 1983); TMEP §1212.04(d) (5th ed. 2007). Second, the existence of Supplemental Registrations does not prove that competitors do not use this color and the three third-party websites are not sufficient to prove such a broad assertion. Moreover, although such circumstantial evidence could show how a particular product stands out in an industry it is not proof of consumer perception.

With respect to consumer perception, we note that there are no news articles or any type of publicity identifying or recognizing applicant's maroon anchors.

Finally, applicant argues:

The color maroon is certainly not merely an ornamental or decorative feature since the whole purpose of Applicant's products is to make concrete stronger, ensuring that the color maroon will be encapsulated in concrete when it is used. There is simply no impetus to add color to the products for ornamental purposes...In support of this argument, Applicant points to the extensive

evidence produced by Applicant of the color of similar third party products. Each of the third party products depicted in these exhibits is colored in shades of silver, gray or black. Of course, all of these colors are various shades of concrete colors. Finally, it is clear that Applicant's maroon color mark would distinguish Applicant's goods from those of others, and indicate the source of the goods, in the hypothetical scenario where a building, bridge, or other structure collapses. In such a scenario, the identification of manufacturer would be helpful for engineers studying the cause of such accidents and would make it easy to determine the manufacturer of the products. Indeed, engineers investigating such events would undoubtedly be familiar with the maroon color mark of Applicant.

Br. pp. 4-5.

This unsupported argument is more directed to applicant's intent regarding its use of the maroon color rather than to consumer perception.

The record presented here is substantially different from the record in Owens-Corning where the evidence included advertising expenditures of \$42,421,000 in television, radio, newspapers and consumer magazines that featured the Pink Panther and included the advertising slogan "[a]dd another layer of pink." In addition, a further \$11,400,000 was expended on "brochures, displays and other promotional items that highlighted the 'pink' color *as applied to*

applicant's insulation." Owens-Corning, *supra*, 227
USPQ2d at 423 (emphasis added).

Accordingly, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the claimed color has acquired distinctiveness within the meaning of Section 2(f).

Decision: The refusals to register the color claimed as a mark in both applications on the grounds that each mark is not inherently distinctive and has not been shown to have acquired distinctiveness are affirmed.