

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Grypmat, Inc.

Serial No. 90181331

Jeffrey J. Banyas of Edwin A. Sisson, Attorney at Law LLC,
for Grypmat, Inc.

William Verhosek, Trademark Examining Attorney, Law Office 114,
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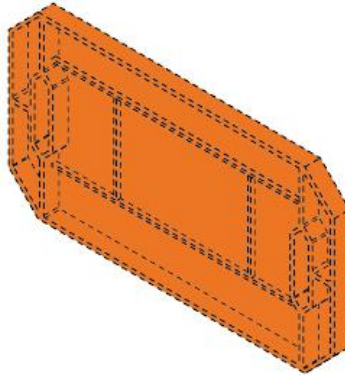
Before Wellington, Lynch, and Allard,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Grypmat, Inc. (“Applicant”) filed an application to register the color orange as a mark on the Principal Register for “tool and tool accessory trays not made of metal sold empty and parts and fittings therefor,” in International Class 20. Applicant

claims that the orange color mark, as applied to its goods, has acquired distinctiveness under Trademark Act (“the Act”) Section 2(f), 15 U.S.C. § 1052(f).¹

The mark, as depicted in the drawing page of the application, appears as:



and described as:

The mark consists of solely the color orange as applied to the entirety of a tool accessory tray. The broken outline of the goods is intended to show the position of the color on the goods and forms no part of the mark serving as positional reference only.

Registration was finally refused on the basis that the color orange is not inherently distinctive and, thus, does not function as a trademark under Sections 1, 2, and 45 of the Act, 15 U.S.C. §§ 1051, 1052, and 1127, and Applicant has not made a sufficient showing that it has acquired distinctiveness pursuant to Section 2(f) of the Act.

Applicant appealed. The appeal has been fully briefed. We have considered all arguments and evidence. We affirm the refusal to register.

¹ Application Serial No. 90181331, filed on September 15, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as July 15, 2016.

I. Preliminary Issue

The Examining Attorney raised an objection to Applicant's attachment of different exhibits to its appeal brief because this "necessitates a comprehensive review of applicant's Brief of material that may not have been previously made of record."² In response, Applicant asserts that "each of the exhibits attached to the Appeal Brief were previously made of record during prosecution and prior to appeal," and identifies the purported locations within its responses to Office Actions for the attached materials.³

It is not the Board's task to verify that Applicant is correct and we will not cross-reference materials attached to its brief with that submitted previously. Rather, we give consideration to all evidence previously and properly submitted by Applicant and the Examining Attorney. To the extent that any of the evidentiary materials attached to Applicant's brief were not previously and properly submitted, they are untimely and have not been considered. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (record in the application should be complete prior to the filing of an appeal).

We emphasize that the practice of attaching evidentiary materials to trial or appeal briefs, even if that evidence was previously submitted and thus properly of record, is discouraged. As the Board has explained:

Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the

² 6 TTABVUE 2.

³ 7 TTABVUE 2.

entire record is readily available to the panel. Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.

In re Michalko, 110 USPQ2d 1949, 1950-51 (TTAB 2014).

We also remind Applicant that, pursuant to Rule 2.142(b)(3), “[C]itation to evidence in briefs should be to the documents in the electronic record for the subject application or registration by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.” 37 C.F.R. § 2.142(b)(3); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.01 (2022) (“[w]hen referring to the record, the applicant and examining attorney should cite to the prosecution history for the application, currently the [Trademark Status & Document Retrieval (TSDR)] database” and “[w]here appropriate, reference to the TTABVUE entry and page number, e.g., 1 TTABVUE 2, should also be used.”).

In sum, attaching previously-submitted evidence to briefs is unnecessary and discouraged, and any materials not previously and properly submitted are not of record. References to the evidentiary record should be made by providing the date of Office Action or response as well the corresponding page number(s) in the downloadable .pdf version within TSDR or, if appropriate, TTABVUE.

II. Evidence of Record

The application file and prosecution history are of record.

Specifically, during the prosecution of the application, the Examining Attorney submitted the following:

- Internet printouts from the Google website showing various tool trays and organizers in different colors, including orange;⁴ and
- Printouts from eight different third-party websites offering tool trays and organizers in different colors being promoted under word marks;⁵ and
- Printout from Wikipedia entry for “Safety orange,” identifying this “hue” as being used to set objects apart from their surroundings” and is used in “construction sites ... to help ensure the safety of others.”⁶

Applicant submitted the verified declaration of Mr. Tom Burden, Applicant’s CEO, with accompanying exhibits that include:⁷

- Screenshots of television show “Shark Tank,” featuring Applicant’s orange-colored tool tray organizer;
- Printouts or screenshots from Time and Forbes magazines;
- Printouts from a website for “2018 Edison Best New Product Awards”;
- Printouts from website for “Core77 Design Awards 2018”;
- Screenshot of what Mr. Burden describes as a “video interview at the 2017 SEMA Show”;
- Printouts from “Virgin” website with article featuring Applicant’s product on TV show “Shark Tank”; and
- Printouts from a “Mark Cuban Companies” website discussing Applicant and its tool tray/organizer.

⁴ Attached to Office Action issued on November 10, 2020, at TSDR pp. 2-16.

⁵ Attached to Office Action issued on August 1, 2021, at TSDR pp. 2-43.

⁶ *Id.* at TSDR p. 51.

⁷ Attached to Applicant’s response filed on February 9, 2021, at TSDR pp. 11-97.

Applicant also submitted the “Expert Report of Kimbley Laird Muller, Esq.”⁸ However, no materials are attached to the report and, although it is signed by Mr. Muller, it was not submitted under oath or supported by a declaration pursuant to Trademark Rule § 2.20, 37 C.F.R. § 2.20. Thus, we only have Mr. Muller’s uncorroborated and unsworn statement and this is not reliable evidence. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (disregarding outside counsel’s conclusory unverified statements regarding marketing of goods).

Furthermore, Mr. Muller does not proclaim to be a witness with relevant personal knowledge of Applicant’s use of the color orange or consumer perception of the color in connection with Applicant’s goods. Rather, he provides his understanding of the relevant law as applied to evidence submitted, concluding ultimately that Applicant’s applied-for mark “should be registered on the Principal Register” and that “potential and putative consumers of these accessory tool trays will recognize the color orange as coming from a single source.”⁹ He also takes issue with certain evidence submitted by the Examining Attorney and “conclude[s] that the results of the Google Search for all tool holders and accessories in general was far broader in scope than the goods defined in this application, i.e., tool accessory trays in the color orange not made of metal.”¹⁰

⁸ Attached to Applicant’s Response filed August 10, 2021, at TSDR pp. 13-33.

⁹ *Id.* at TSDR p. 14.

¹⁰ *Id.*

Mr. Muller is not an “expert witness,” as contemplated by Fed. R. Evid. 702,¹¹ and, even if he was, we point out that ultimate questions of law are based on the evidence of record and decided by the Board, not by a witness or conclusions made by an “expert” attorney. *Alcatraz Media Inc.*, 107 USPQ2d at 1755 (opinion of expert witness cannot “serve as a substitute for the Board’s judgment on the legal claims before us”). *See also Burkhart v. Washington Metro. Area Transit Auth.*, 324 U.S. App. D.C. 241, 112 F.3d 1207, 1213 (D.C. Cir. 1997) (“[e]ach courtroom comes equipped with a ‘legal expert,’ called a judge.”).

In sum, the “expert report” prepared by Mr. Muller is not actual probative evidence but is tantamount to additional attorney argument, albeit from an attorney who is not counsel of record.

Finally, the Burden declaration and Muller purported “expert report,” as well as Applicant’s appeal brief, contain hypertext links and website addresses. Providing only a web address or a hyperlink without attaching any material that can be found in the corresponding websites is not sufficient to introduce it into the record, as Applicant was advised by the Examining Attorney during prosecution.¹² *See* TBMP § 1208.03 (involving proper submission of Internet materials); *see also In re ADCO Industr. Tech., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re*

¹¹ FRE 702 provides for “[a] witness who is qualified as an expert ... may testify in the form of an opinion or otherwise if: (a) the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue.”

¹² Office Action issued on February 18, 2021, at TSDR p.1.

Aquitaine Wine USA, LLC, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided). To the extent that none of the materials or printouts corresponding to the hypertext links or web addresses were provided, those links or addresses are meaningless.

III. Color Marks and Distinctiveness – Applicable Law and Analysis

Pursuant to Sections 1, 2, and 45 of the Act, a mark may be registered on the Principal Register for goods only if it is distinctive and distinguishes an applicant's goods from those of others by indicating the source of the goods.¹³ *See In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.”)

It is settled law that marks consisting of a single color applied to the product itself, as is the case here, are not inherently distinctive and can only be registered upon a showing of acquired distinctiveness (or secondary meaning). *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1162-63 (1995)). *See also In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). *Cf. In re Forney Indus., Inc.*, 955 F.3d 940, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020) (Multi-color “marks can be inherently distinctive when used on product packaging, depending upon the character of the color design.”).

¹³ Section 1 of the Act concerns the requirements for filing a trademark application; Section 2 lists grounds on which the USPTO may refuse registration; and Section 45 provides the definition of a “trademark,” requiring it “identify and distinguish [an applicant’s] goods ... from those manufactured or sold by others and to indicate the source of the goods”

Because Applicant is seeking registration on the Principal Registration on the basis that the mark has acquired distinctiveness, pursuant to Section 2(f) of the Act, it must make a sufficient showing that the relevant members of the public — here, consumers of non-metal tool and tool accessory trays — have come to understand the primary significance of the color orange as identifying the source of Applicant’s goods rather than as merely an ornamental feature of the goods. *See Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *19 (TTAB 2019) (in a case of an alleged color mark on a product, the question is whether the “primary significance of the ... mark to the relevant public ... is as a source-indicator” or simply as “ornamentation”) (citing, *inter alia*, *Wal-Mart v. Samara*, 54 USPQ2d at 1069), *civil action filed*, No. 1:20-cv-00902-RGA (D. Del. Feb. 3, 2020); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1145 (TTAB 1990) (same); *see generally In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (“To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.”).

Applicant may show acquired distinctiveness by direct or circumstantial evidence. *GJ & AM*, 2021 USPQ2d 617, *38 (TTAB 2021) (citing *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018)). “Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind,” while “[c]ircumstantial evidence . . . is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive

amount of sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers.” *Id.* at *38-39 (citations omitted). However, we hasten to add that a declaration from an employee or a person with a possible self-serving motive is entitled to less weight in determining acquired distinctiveness. *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusionary declaration from applicant’s vice-president insufficient without the factual basis for the declarant’s belief that the design had become distinctive); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991) (declarations from marketers of oil products who have business relationships with the applicant “lack persuasiveness on the issue of the primary significance of the [proposed mark] to the purchasing public.”).

Ultimately, Applicant bears the burden of establishing that its proposed mark has acquired distinctiveness. *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *2 (TTAB 2020) (quoting *In re La. Fish Fry Prods.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (internal quotation omitted)). In addition, “[b]y their nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character.” *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985). *See also Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1434 (TTAB 2007).

Our Section 2(f) determination is based on all of the evidence “considered as a whole,” *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *2, and guided by weighing the following six interrelated factors:

1. Association with a particular source by actual purchasers (usually demonstrated by customer surveys);
2. Length, degree, and exclusivity of use;
3. Amount and manner of advertising;
4. Amount of sales and number of customers;
5. Intentional copying; and
6. Unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. ITC, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018) (“*Converse* factors”).¹⁴ “All six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate*, 2020 USPQ2d 10869, at *3 (quoting *Converse*, 128 USPQ2d at 1546).

1. Association with a Particular Source by Actual Purchasers

In terms of identifying the relevant class of purchasers for non-metal tool and tool accessory trays, Applicant has asserted that “[i]n general, consumers of these goods are limited to mechanics, which amounts to a relatively small sector of the consuming public.”¹⁵ However, as the Examining Attorney points out, the Applicant’s identification of goods is not restricted in this regard. As the evidence bears out, non-

¹⁴ “While *Converse* concerned an appeal from a decision issued by the International Trade Commission, the Federal Circuit’s clarification of the factors in determining acquired distinctiveness is equally applicable to any Board proceeding that necessitates a showing of secondary meaning.” *In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1005 n.8 (TTAB 2018).

¹⁵ Applicant’s August 10, 2021 response, at TSDR p. 5.

metal tool trays are sold alongside toolboxes and advertised as “a customizable solution for homeowners and DIYers.”¹⁶

In any event, and regardless of the scope of the relevant class of consumers, the record is void of any direct evidence showing consumers associate the color orange with a particular source of these goods. As mentioned, such a showing is “typically measured by consumer surveys.” *Converse*, 128 USPQ2d at 1546. The Board also recognizes that declarations from actual purchasers attesting to their belief that a proposed mark identifies the source of the goods may also be useful and probative. *GJ & AM*, 2021 USPQ2d 617, at *38-39. Here, we have no such evidence before us.

2. Length, Degree, and Exclusivity of Use; Alleged Intentional Copying

Applicant began using the color orange applied to its tool accessory trays “at least as early as” July 25, 2016.¹⁷ According to Applicant’s CEO, Tom Burden, there were “no other comparative products — regardless of [Applicant’s proposed trademark] or trade dress considerations — exist[ing] in the market” when Applicant began selling orange tool trays.¹⁸ Mr. Burden further states that Applicant’s use of the color orange on its goods has “remained a constant element of various marketing campaigns throughout [Applicant’s] life and continues today with the overwhelming majority of

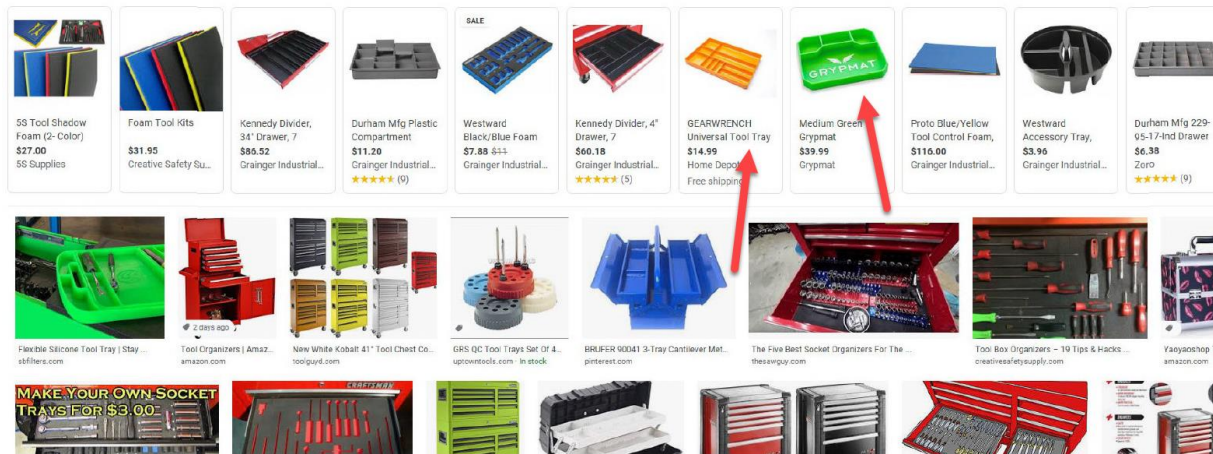
¹⁶ See printouts from the Stanley tools website (www.stanleytools.com) listing various “organizers” including plastic tool and parts trays with separate compartments. Attached to August 23, 2021 Office Action, at TSDR pp. 20-26.

¹⁷ Burden Dec. ¶ 4, Response filed February 9, 2021, at TSDR p. 9.

¹⁸ *Id.* at TSDR pp. 9-10.

[Applicant's] advertising expenditures and resulting revenue being derived from tool accessory trays having the distinctive orange color.”¹⁹

The Examining Attorney, however, counters that “there are numerous tool trays by many different manufacturers in various colors.”²⁰ In support, he points to evidence of such third-party use.²¹ For example:



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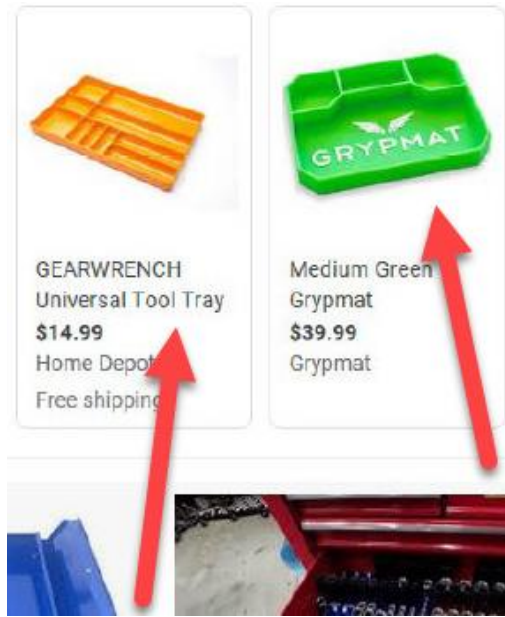
A close-up excerpt from the above printout shows a green tool tray with Applicant's word mark GRYPMAT, with logo, alongside an orange tool tray sold by Home Depot under the mark GEARWRENCH:

¹⁹ *Id.* at TSDR p. 10.

²⁰ 6 TTABVue 9.

²¹ Printouts attached to Office Actions issued on November 10, 2020 and August 1, 2021.

²² Office Action issued on November 10, 2020, at TSDR p. 2.



In its response to the Examining Attorney’s evidence of third-party use of tool trays in different colors, Applicant acknowledges that “tool accessory trays are available from other manufacturers in many other colors including red, green, blue, grey, black, white, and yellow.”²³ Applicant further admits that “on occasion — [Applicant] has sold small quantities of products bearing other colors including green and grey (both of which are currently available on [Applicant’s] website).”²⁴ While pointing out that several of the products in the evidence are indeed Applicant’s own products, Applicant does not claim ownership of the GEARWRENCH-branded tool tray sold at Home Depot.²⁵ We find that Applicant’s use of the color orange as applied to tool trays is not substantially exclusive.

²³ Applicant’s response filed February 9, 2021, TSDR p. 5.

²⁴ *Id.* at TSDR p. 7.

²⁵ The evidence also shows the same tool tray being sold by “Circle C Supply.” Office Action issued on November 10, 2020, at TSDR p. 8.

In terms of any intentional copying by third parties, as an indication that Applicant's use of orange has become distinctive as a source identifier, Applicant relies entirely on the report prepared by Mr. Muller and contends that it has provided "extensive direct evidence of creation of intentional parodies and copies sufficient to support a finding of secondary meaning and acquired distinctiveness."²⁶ In his report, Mr. Muller refers to "at least three companies [that] have appropriated or misappropriated applicant's trade dress presumably to their pecuniary advantage."²⁷ Specifically, he states that a "search on Amazon.com using the key words 'orange tool tray accessories' demonstrates three such sellers who found it to their pecuniary advantage to use the proprietary color orange for their look-alike tool trays, that serve the exact function as the Grypmat® [Applicant's] trays."²⁸

Despite the statements made by Mr. Muller regarding others intentional copying Applicant's putative mark, and as repeated by Applicant in its brief, there is no documentary evidence to support these statements. That is, no corroborating Internet printouts or other materials from those companies, which is evidence we would expect to see to support this argument, were attached to the Muller report. Mr. Muller's statements are essentially only a continuation of attorney argument and unsupported factual allegations from counsel are rarely, if ever, found to be persuasive. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018)

²⁶ 4 TTABVue 19.

²⁷ Applicant's August 10, 2021 response, at TSDR p. 30 (Muller Decl. p. 19).

²⁸ *Id.*

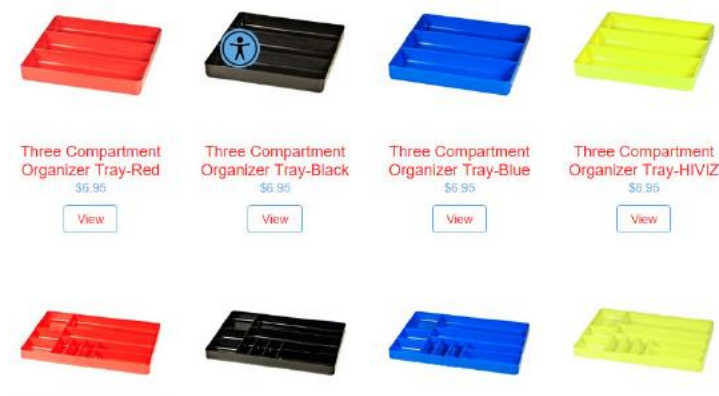
(“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki*, 109 USPQ2d at 2006 (finding that there was no proof to support the statements in the record by counsel). To be clear, the Amazon website evidence to which Mr. Muller refers is not of record. In any event, Mr. Muller’s conclusions regarding intentional copying appear to be based solely on the third-parties’ goods having similar product specifications, price points, and appearing in the marketplace after Applicant’s alleged first use of the color orange on tool trays. We cannot find that this third-party use of the color orange constitutes intentional copying of the kind that may evidence distinctiveness. *See In re Odd Sox LLC*, 2019 USPQ2d 370879, at *11 (TTAB 2019). “Nor is there any evidence that Applicant has attempted to stop any such alleged misuse, or to enforce its claimed trademark rights against these or any other third parties.” *Id.* at **11-12.

Applicant also argues that any “competitor’s use of different colors (other than the claimed orange color) on tool trays is wholly irrelevant to Grypmat’s [Applicant’s] claim of acquired distinctiveness.”²⁹ We disagree. Where, as here, there is evidence showing that the use of colors is common in a field, an applicant has a more difficult burden in demonstrating distinctiveness of its claimed color. *See Edward Weck Inc.*, 17 USPQ2d 1142; *see also In re Howard S. Leight and Assocs. Inc.*, 39 USPQ2d 1058, 1060 (TTAB 1996) (“This record demonstrates that earplugs come in many colors. In fact, applicant also makes earplugs in blue and green. Where the use of colors is

²⁹ 7 TTABVue 3.

common in a field, an applicant has a difficult burden in demonstrating distinctiveness of its claimed color.”). The evidence demonstrates that consumers are accustomed to encountering tool trays in various different colors and this decreases the likelihood that a consumer will perceive any one color, such as orange, as source identifying. This makes the bar higher for establishing that a particular color has become distinctive as a source-identifier.

For example, the Examining Attorney submitted evidence of one company, Ernst Manufacturing, touting itself as “The Leader In Tool Organization,” and offering the following products in an array of colors:³⁰



A consumer familiar with the tool trays pictured above who then encounters Applicant’s orange tool trays will find this neither unusual or unique. Rather, the consumer will attribute the choice of color as merely ornamental. This makes the consumer less inclined to attribute any source-identifying significance to Applicant’s choice of color.

³⁰ Attached to Office Action issued on August 1, 2021, at TSDR pp. 28-29.

In sum, although Applicant has been selling non-metal, orange-colored tool and tool accessory trays for over five years, we find that its application of the color orange has not been substantially exclusive during this period. In addition, we find no evidence of third parties intentionally copying Applicant's use of the color orange in connection with the tool trays.

3. Amount and Manner of Advertising; Sales and Number of Customers; Media Attention

In his declaration, Mr. Burden avers, *inter alia*, that:

- As of 2019, Applicant spent over \$ 500,000 per year “advertising and promoting its tool accessory trays bearing the distinctive orange color of [Applicant’s] trade dress” and that this represents “approximately 20% of [Applicant’s] annual revenue of approximately” \$ 2.5M;³¹
- In 2019, Applicant sold \$ 2.73M of tool accessory trays “bearing the distinctive orange color” and, for 2020, sales increased to approximately \$4.1M;³²
- In 2020, Applicant’s “advertising and promotion expenditures” were approximately \$ 1.1M;³³
- Applicant has sold approximately 55,000 units per year — “all featuring the distinctive orange color”;³⁴
- Applicant’s tool and tool accessory trays have been advertised in various trade magazines and trade shows across the country, and includes video productions “which are accentuated across paid advertising on multiple social media platforms including Facebook, Instagram, and Youtube” with the “overwhelming majority” of such advertising featuring the “orange colored tool trays”;³⁵

³¹ Burden Decl. ¶ 5; Applicant’s response filed February 9, 2021, at TSDR p. 10.

³² *Id.* at ¶ 11; at TSDR p. 12.

³³ *Id.* at ¶¶ 6-7; at TSDR p. 10.

³⁴ *Id.* at ¶ 10; at TSDR p. 12.

³⁵ *Id.*

- Applicant’s orange-colored tool trays were featured “on at least two episodes of the popular ABC television program ‘Shark Tank’ ... to a national audience” and these episodes “are regularly rerun in syndication on ABC and MSNBC” [screenshots were submitted as exhibits];³⁶
- Applicant’s orange tool trays were featured in a November 28, 2018 edition of Time Magazine as one of the “Best Inventions of 2018,” with the product appearing on the cover;³⁷
- Applicant and its founder, himself, were featured in a Forbes magazine article in November 2019;³⁸ and
- Applicant’s orange tool trays received several awards, including the “2018 Edison Best New Product Awards” and “Core77 Design Awards 2018.”³⁹

Applicant argues that the Examining Attorney “commits reversible error by failing to properly consider” the aforementioned evidence.⁴⁰ Specifically, Applicant complains that the Examining Attorney “summarily dismisses [Applicant’s] direct evidence of large-scale expenditures in promoting and advertising goods under the Mark.”⁴¹

However, as the Examining Attorney aptly points out, there is one major shortcoming with respect to all of Applicant’s advertising and media attention:

There is no evidence in the television show, video and news stories that the personalities, interviewer or the writers ever acknowledge the color orange as an indicator of

³⁶ *Id.* at ¶ 8; at TSDR pp. 10-11.

³⁷ *Id.* at ¶ 9; at TSDR pp. 11 (Burden Exs. C-D).

³⁸ *Id.* at ¶ 8; at TSDR p. 11 (Burden Ex. E).

³⁹ *Id.* at ¶ 8; at TSDR pp. 10-11.

⁴⁰ See, e.g., 4 TTABVUE 8, 10, 14.

⁴¹ *Id.* at 12. Applicant specifically refers to the Examining Attorney’s retort, in the Office Action issued on February 2021 Office Action, at TSDR p. 4, wherein the Examining Attorney states, “Applicant’s extensive sales and promotion may demonstrate the commercial success of applicant’s goods, but not that relevant consumers view the matter as a mark for these goods.”

source, much less the color orange on the product itself. Advertising evidence should promote the identified color as a mark. The applicant's advertising nor the unsolicited media coverage provides the look-for color evidence. There is nothing in the advertisements and media coverage directing the consumer to the mark, especially, as here, where it is seen on the surface of the goods. Consumers and users can look at a thing many times and not see it for what is intended or perhaps one day intended to be, i.e., a trademark.⁴²

We agree with the Examining Attorney's assessment of the record. As to the "look for" evidence, this has been described as:

... refer[ing] to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.

Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp., 94 USPQ2d 1549, 1572. (TTAB 2009). In other words, "look for" advertising helps direct a consumer's attention to an otherwise non-inherently distinctive feature of a product, such as the color of the product, so that it becomes distinctive in the mind of the consumer and helps the consumer identify the source product. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) (applicant characterizes its advertisement as "look for advertising -- the kind that pulls out of an overall article a few features to catch the viewer's attention."); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1517 (TTAB 2017) ("Look for' advertising refers to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising

⁴² 9 TTABVUE 12.

that simply includes a picture of the product or touts a feature in a non-source identifying manner.”) (internal quotation marks omitted). Here, there is no such demonstrated effort by Applicant to point the consumer’s attention to the color orange or promote this color as a distinctive source-identifying quality.

Nevertheless, the lack of any “look for” advertising is not always fatal to a showing of acquired distinctiveness, and an applicant may make a sufficient showing through other probative evidence. *See Stuart Spector*, 94 USPQ2d at 1574; *see also In re Dimarzio, Inc.*, 2021 USPQ2d 1191, *26 (TTAB 2021). In *Stuart Spector*, for example, the Board ultimately did not find a guitar body configuration had acquired distinctiveness, but treated “the absence of ‘look for’ advertising [as] just one more piece added to an avalanche of evidence that obliterates any claim to source-identifying significance of the [proposed configuration mark].” *Stuart Spector*, 94 USPQ2d at 1574.

The number of tool and tool accessory trays sold by Applicant in the previous 5-6 years, as well as its expenditures in promoting these goods over that same period, are impressive. However, high sales and advertising figures do not always equate to a finding that mark has acquired distinctiveness, especially when, as here, there is a higher burden for making such a showing. *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); *see also In re Boston Beer Co.*, 198 F.3d 1370, 1371 (Fed. Cir. 1999) (Court held, “considering the highly descriptive nature of the proposed mark, [the applicant] has not met its burden to show that the proposed mark has acquired secondary meaning,” despite evidence of “annual advertising

expenditures in excess of ten million dollars and annual sales under the mark of approximately eighty-five million dollars.”). Moreover, although we find the numbers for Applicant’s sales and advertising to be impressive on their face, there is no evidence putting these figures into context within the relevant marketplace. *In re GJ & AM*, 2021 USPQ2d 617, at *43 (“Applicant’s sales and advertising figures, without any context in the trade, are not so impressive as to support a finding that Applicant’s highly descriptive [mark] has acquired distinctiveness.” Thus, “we cannot accurately gauge Applicant’s level of success without additional evidence as to Applicant’s market share or how [its tool trays] rank in terms of sales in the trade.” *Id.* at *42-43.

The fact that Applicant’s orange-colored tool and tool accessory trays have been twice featured on the nationally televised program “Shark Tank,” and this show is in syndication, also reflects that Applicant’s goods have received significant consumer exposure. The attention to its goods in Time and Forbes magazines also adds to this exposure. However, again, we find it troublesome that there is no mention within this evidence of any particular significance given to the orange color as a source-indicating feature of Applicant’s goods. Thus, despite all of the media attention, we are without any probative evidence showing that consumers have come to view the color orange as having source-identifying significance for Applicant’s goods, as opposed to this color simply being an ornamental feature and one of several other possible bright colors for tool trays.

4. Conclusion

Based on the entirety of the record and upon weighing the *Converse* factors, we find Applicant falls short of carrying the high burden of showing that its proposed color mark has acquired distinctiveness pursuant to Trademark Act Section 2(f) for non-metal tool and tool accessory trays.

Decision: The refusal to register Applicant's proposed color mark is affirmed on the ground that it is not inherently distinctive, and has not acquired distinctiveness, and thus fails to function as a trademark.