

Hearing:
February 12, 2004

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
May 28, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Texaco Inc

v.

The Pennzoil-Quaker State Company

Opposition No. 91120520
against Application Serial No. 75247806

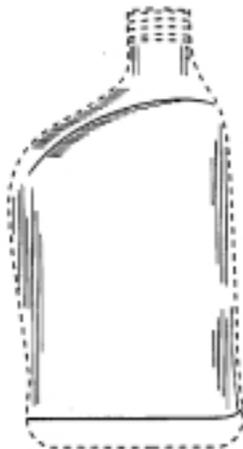
William G. Pecau of Pennie & Edmonds L.L.P. for Texaco Inc.

Margaret A. Boulware of Jenkins & Gilchrist for The Pennzoil-
Quaker State Company.

Before Hohein, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

The Pennzoil-Quaker State Company seeks registration on
the Principal Register of the design mark shown below:



for goods identified, as amended, as "motor oils" in International Class 4.¹

On September 11, 2000, registration was opposed by Texaco Inc. on the ground that applicant's clear container design is functional in a utilitarian sense and, furthermore, that if not functional, such clear container design is not distinctive as a source indicator for applicant's motor oils.

Applicant, in its answer, has denied all the salient allegations of the notice of opposition.

The Record

The record includes the pleadings; the file of the involved application; applicant's stipulated Exhibits 1 - 93 containing photographs of motor oil containers as well as photographs of a range of automotive products in yellow containers; opposer's stipulated exhibits identifying thirty-three automotive and other consumer products sold in clear bottles, opposer's HAVOLINE bottle and an engine treatment product sold in a shrink-wrap package with applicant's motor

¹ Application Serial No. 75247806 was filed on February 25, 1997 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Applicant described the mark as consisting "of the color clear used on containers for motor oil." The solid lines in the drawing represent the contours of the bottle and the "matter in broken lines on the drawing serves to show positioning of the mark." No claim is made to the overall configuration of the bottle.

oil; opposer's stipulated Exhibit No. 94 comprising an Interbrand study for Texaco/Havoline; applicant's stipulated Exhibit No. 95 consisting of copies of all the documents and evidence that were put before the Trademark Examining Attorney during the *ex parte* prosecution of the involved application; opposer's first notice of reliance containing excerpts of its discovery deposition, with exhibits, of William W. Tucker, former Vice President of Marketing and President of applicant's advertising agency, and excerpts of opposer's discovery deposition, with exhibits, of Steven William Hanson, applicant's Senior Vice President of Marketing; opposer's second notice of reliance containing portions of the Handbook of Packaging Engineering, interrogatory answers of applicant and certified copies of opposer's HAVOLINE trademark registrations; applicant's first notice of reliance on certified copies of various federal trademark registrations and examples of applicant's national advertising of the clear container for motor oils; applicant's second notice of reliance, containing "Attorney's Eyes Only" and confidential materials under seal; and the trial testimony depositions, with accompanying exhibits, of the following individuals: William W. Tucker, former Vice President of Marketing and President of applicant's advertising agency; Steven William

Hanson, applicant's Senior Vice President of Marketing; and Tom Seboldt, Senior Product Manager of O'Reilly's, an automobile parts retailer.

Functionality

The first issue before us is whether applicant's design consisting simply of a clear container is functional when it is used with motor oils. 15 U.S.C. §1052(e)(5). Our precedent in the area of functionality teaches us the importance of the factual context in which one is constrained to make such a public policy determination. Accordingly, it behooves us to examine the record closely in order to determine the exact types of motor oils being marketed in this container, and to understand the issues surrounding applicant's choice of a clear plastic² container.

The record demonstrates that, from a marketing standpoint, the viability of a clear bottle is inextricably tied to the coming of age of synthetic motor oils. For example, under the corporate value of "High Technology,"

² While the application refers to clear containers without limiting the material composition of such containers, the record shows that for practical reasons, the only serious option is plastic. Given the added weight and breakability of glass (Handbook of Packaging Engineering, pp. 242, 302 (March 1998)), the record shows no producer of automotive fluids having considered seriously the use of glass bottles to derive the advantages of packaging transparency.

applicant's mission statement emphasizes that: "Our synthetic formulas and their clear bottle delivered a *High Technology* statement." (Applicant's exhibit #129) Consistent with this corporate-level statement, William W. Tucker testified that he was personally instrumental in repositioning applicant's products (e.g., creating segmentation among applicant's higher-end quality oils into 4 x 4, high performance and high mileage engines, stressing themes of "sensible technology," etc.) and in launching its "clear bottle" line of synthetic and synthetic-blend motor oils.

According to industry-wide point-of-sale data on motor oils sold to do-it-yourselfers through mass merchandisers, the market share of synthetic motor oils and synthetic blends doubled between 1995 and 2000 (Applicant's exhibit #126) as did applicant's volume of synthetics and blends (Applicant's exhibits #124, Bates PQS000334, and #134, Bates PQS001453-59). While conventional motor oils are refined from petroleum or crude oil that is pumped from the ground, fully synthetic motor oils contain non-conventional, high-performance fluids along with a proprietary system of additives.

Perhaps a change in containers was inevitable owing to the fact that full synthetic motor oils tend to be lighter in color than are conventional motor oils. Blends of synthetic

and conventional oils will be somewhere between a honey brown and dark brown depending upon the blend, the additives, etc.³

In fact, studies done by both of the parties to this proceeding suggest a strong connection between the type of container and the color of the motor oils. Opposer's research shows that in terms of the perceptions of customers, motor oil in opaque containers is thought to be darker in color than it is in reality.⁴ From applicant's marketing research, among men in particular, there are reasons why manufacturers would want to seek out the lighter to mid-range colors for newly-released synthetic blends of motor oils.⁵ However, optimal product coloration becomes a marketing asset only when its color is visible through a clear container.

We turn then, briefly, to review packaging for motor oils. Over the past several decades, packaging for motor oils has evolved through a number of distinct stages. For years, motor oil producers packaged motor oils in one-quart metal cans, which then gave way to cardboard cans having metal tops and bottoms. The first plastic bottles for motor oils were

³ Seboldt testimony at pp. 39 - 40.

⁴ Interbrand study for Texaco/Havoline, Exhibit No. 94 (Bates T00186).

⁵ Applicant's exhibit #133; Bates PQS001027, 1047, 1049-50.

cylindrical,⁶ but have uniformly morphed into shapes similar to the bottles involved herein - taller, four-sided bottles having a center fill or an offset neck. (Seboldt Trial Deposition at 134 - 135; Hanson Trial Deposition at 54 - 55) Until the introduction of applicant's clear container, all these plastic bottles for motor oils have been made of opaque plastics. These containers have been manufactured in a variety of colors.⁷

According to the standard industry reference on packaging materials and engineering,⁸ the annual growth rate for plastic packaging materials continues at four times that of all other packaging materials.⁹ Applicant's involved plastic containers are made of polyethylene terephthalate (PET). This is the same plastic material commonly used in soft drink or mouthwash bottles.¹⁰ PET's properties include clarity, strength and toughness. However, PET costs more per pound than high density polyethylene (HDPE) - the material from which most opaque plastic containers for motor oils would be

⁶ According to one of applicant's advertisements, Quaker State was the first oil brand to introduce the plastic bottle, in 1984. (Applicant's exhibit #129)

⁷ Most colors of opaque containers for motor oil are non-proprietary, although the record does show that applicant owns several federal registrations claiming the color yellow as a source-indicator for its Pennzoil brand conventional motor oils.

⁸ Handbook of Packaging Engineering (March 1998).

⁹ *Id.* at 207.

¹⁰ *Id.* at 241 - 242.

manufactured. (Seboldt Trial Deposition at 58; Tucker testimony at 82; Hanson Trial Deposition at 8) HDPE, however, has poor clarity, and hence, will be limited to use in manufacturing opaque or translucent bottles.¹¹

This record demonstrates that clear, plastic containers have been used for years in packaging a wide variety of consumer items for use in the household,¹² as well as for many types of automotive products in the nature of appearance products¹³ and functional fluids.¹⁴ Opposer points out that these automotive products, oil treatments, and two-cycle engine oil products¹⁵ that are packaged in clear containers are sold through the same stores in adjacent areas of those stores

¹¹ *Id.* at 243.

¹² For example, the record shows clear, plastic containers used for a household window cleaner, liquid hand soap, mineral oil, a shower cleaner, a mouth rinse, cough medication, several brands of household disinfecting cleaners, vegetable oil and soft drinks.

¹³ Appearance products "make your car look better" (Seboldt testimony at 17) and would include products depicted in exhibits in the record such as an automotive windshield de-icing and degreasing preparation, preparations for cleaning and shining tires, water repellent surface coating compositions for use on windshields, car washes and leather cleaners.

¹⁴ Functional fluids "perform a function" (Seboldt testimony at 17) and would include products depicted in exhibits in the record such as antifreeze, diesel fuel catalysts, engine oil stop leak and conditioner, fuel system cleaners, oil treatments, gas treatments, smoke treatments, engine treatments, an oil system flush and gear oil.

¹⁵ Based on this record, we construe applicant's involved "motor oils" to be motor oils for four-cycle engines. Hence, we do not deem applicant's involved goods, as identified, to include two-cycle engine oil (e.g., for personal watercraft, motor scooters, chainsaws, boat engines, etc.). Rather, we place two-cycle engine oil into the related category of other petroleum-based fluids that

to the same kinds of customers as purchase automotive motor oils. Several of these products will often be added to the crankcase at the same time that the do-it-yourself consumer changes the motor oil.

In assessing the additional costs incurred by applicant in choosing to market its synthetic motor oils in clear plastic bottles, the record points to a number of other costs associated with this choice. In addition to the added cost of the clear PET bottles (as contrasted with opaque HDPE bottles), applicant has had to incur additional formulation and filling costs to make motor oils marketable in clear bottles. These relate to ensuring consistent filling, maintaining the proper color, avoiding chemical changes and sedimentation with long shelf life and exposure of the motor oil to ultraviolet and fluorescent lighting, etc.

On the other side of the equation, according to the trial testimony of Mr. Tucker and Mr. Hanson, applicant's sales of full synthetic and synthetic blend motor oils increased dramatically with the introduction of the clear containers.¹⁶

assist the basic functioning of engines and related mechanical equipment, including lubes, gear oils, transmission fluids, etc.

¹⁶ Tucker deposition at 20; Hanson deposition at 70, 98 - 99.

We begin our analysis by identifying exactly what it is applicant is claiming to be its mark. In the application itself, applicant described the mark as consisting "of the color clear used on containers for motor oil." Conceding that clear may not be a specifically identifiable color on the color spectrum, applicant nonetheless argues that is it a protectible color. On this point, we agree with opposer that applicant is not trying simply to claim a single color. According to dictionary definitions, "clear" is the total absence of color. Clear means "transparent" - not found anywhere on the color spectrum, but rather a characteristic that is contrasted with "opaque."¹⁷ Hence, despite applicant's focus on "color," it seems obvious that applicant is trying to carve out transparent plastic containers as a source identifier for its automotive motor oils. If permitted to protect this identity, all of applicant's competitors in the market for automotive motor oils would henceforth be required to use opaque containers.

Having clarified the categorization of applicant's claims herein, we are not, however, inclined to deny protection under the Lanham Act based solely upon the "ontological status" of

¹⁷ Webster's New Collegiate Dictionary (1987); Webster's Third New International Dictionary (1993); and The Random House Dictionary Of The English Language (2nd Ed. 1987).

the matter, to use applicant's terminology. That is, our determination is based upon the specific technology, design and industry customs of this case, but does not purport to set out a *per se* rule about whether or not there may be other circumstances under which a clear container could indeed function as a source indicator.

Opposer argues in the instant case that the clearness of a container is an important and desirable functional attribute. According to opposer, applicant adopted this clear container for its functional benefits, namely that the transparency of the container reveals important information about the product inside. In fact, opposer points out that Quaker State included the functional benefits of a clear container in its promotions. For example, a trade advertisement contains the following headline: "Consumers preferred our see-through bottle 2-to-1 over any conventional motor oil bottle." (Opposer's deposition exhibit 11, Bates PQS000184) Videos that applicant created for do-it-for-me sales greeters at quick lube centers ties the clear bottles to the purity and quality of the synthetic motor oils or

synthetic blend products the consumer would be encouraged to purchase.¹⁸

Finally, opposer argues that the clearness of applicant's containers affords other competitive advantages to Quaker State. For example, opposer points out from applicant's own consumer research that do-it-yourselfers like the ease with which one can tell how much of the volume of oil remains in the container. This is much easier to determine in a clear bottle than is the case with opaque bottles, including those that may have a "vis strip."¹⁹

In response, applicant claims that the clear container is not functional, and that opposer has failed to demonstrate that it is functional. Applicant claims that it is the first and only company to manufacture and sell a transparent container for motor oils. See Tone Brothers Inc. v. Sysco Corp., 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) [clear,

¹⁸ "Another unique Quaker State innovation is the clear bottles that the synthetic line comes in.

"The result of even more research, the packaging epitomizes Quaker State Synthetics' cutting edge technology and provides customers with a difference they can see.

"With clear bottles, consumers know first hand just what they're paying for.

"They can observe for themselves the pure quality of the synthetic motor oil they're purchasing."

(Hanson testimony at p. 80; applicant's exhibit No. 138)

¹⁹ Mr. Seboldt referred to the "vis strip" as a clear window in opaque oil bottles to see the level of oil in a partially emptied bottle. (Seboldt testimony at 57).

plastic container for herbs and spices was the first of its kind in the food service channel]. Moreover, applicant points to media coverage of applicant's clear container, such as the January 1998 issue of Motor Trend that says: "Quaker State has taken a new approach to selling motor oil with three premium formulas targeted to specific market niches and all packaged in clear bottles that should jump out from the usually drab motor oil shelves"

Any discussion of utilitarian functionality should begin with the recent decision in TraFFix Devices Inc. v. Marketing Displays Inc., 523 U.S. 23, 58 USPQ2d 1001 (2001) [involving traffic sign stands having a dual-spring feature that keeps the signs upright in high winds], wherein the Supreme Court found that product design trade dress may be deemed to be functional because it is "essential to the use or purpose of the article" or "affects the cost or quality of the article," citing to Inwood Laboratories, Inc. et al. v. Ives Laboratories, Inc., 456 U.S. 844, 214 USPQ 1 (1982). The Court of Appeals for the Federal Circuit has held that this decision does not alter the oft-cited case of its predecessor in the area of functionality, In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). The Morton-Norwich case, cited by both parties to this proceeding,

clarified that in determining whether the configuration of a plastic spray bottle container was *de jure* functional, one needs to look to the competitive need to copy the claimed design feature.²⁰ The Morton-Norwich decision listed four "factors" to help in determining whether a particular product design is *de jure* functional: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. The Federal Circuit applied the teachings of TraFFix in Valu Engineering Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002). In Valu Engineering, the Federal Circuit reaffirmed the continuing viability of the four Morton-Norwich factors to demonstrate "competitive necessity." The Court also concluded that the Supreme Court in TraFFix had clearly retained the third Morton-Norwich factor (i.e., alternative designs) as a legitimate source of

²⁰ Similarly, the Court affirmed the USPTO's finding that the overall design of appellant's pistol grip water nozzle was not protectable as a trademark. In re R. M. Smith, Inc., 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). As in Morton-Norwich, the public policy underlying a *de jure* functional refusal to register is the need to copy those articles in order to compete *effectively*.

evidence "to determine whether a feature is functional in the first place." The Federal Circuit noted that if the opposer demonstrates that a design is functional based upon one of the other factors, the design is not registrable merely because there may be a number of alternative designs available.

Similarly, trade dress cases involving a single color have developed like those of product and packaging design. Applying a public policy analysis similar to that of Morton-Norwich, the Court of Appeals for the Federal Circuit determined that the color pink was entitled to registration for insulation because it was not necessary for competitors to adopt this color in order to compete in this industry. In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). This balancing of public policy interests was later approved by the Supreme Court in Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 34 USPQ2d 1161 (1995). In Qualitex, the Supreme Court asked whether there was a competitive need for the green-gold color of dry-cleaning pads to remain available in the trade. The Court decided, based upon all the facts in that case, that affording protection of a single color would not interfere with legitimate competition.

The parties herein seem to agree that the overall record shows that clear containers are ubiquitous for packaging liquids sold at retail to consumers. These goods range from beverages to household cleaning products, from automobile appearance products to two-cycle engine oil. There is also no contradiction in the record to applicant's claim that it is the first and only manufacturer to market motor oils in a clear container.

Consistent with years of earlier jurisprudence in the lower courts, the Supreme Court has treated product-packaging trade dress differently than product-design trade dress. See Wal-Mart Stores Inc. v. Samara Brothers Inc., 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000). See also Duraco Products Inc. v. Joy Plastic Enterprises Ltd., 40 F.3d 1431, 32 USPQ2d 1724 (3rd Cir. 1994). However, part of the logic underlying this different treatment is that permutations of individual features making up product-packaging trade dress are practically inexhaustible, and hence, that "an exclusive right to a particular overall presentation generally does not substantially hinder competition in the packaged good ..." Duraco, supra at 1738.

However, what applicant is claiming herein is not a single combination of design features from among an infinite

variety of such choices. Rather, this case involves only two choices - opaque containers or transparent containers - and applicant seeks recognition of exclusive rights to one of these two alternative forms of packaging for motor oils. The potential impact of recognizing such a property right in applicant is heightened because the involved goods are synthetic motor oils - a relatively new type of product creating new marketing possibilities. We have seen that advances in the technology of motor oils have made the visibility of the actual liquid in the container more feasible and more desirable.

To the extent we analogize herein to single color cases, the specific facts of the goods and the contextual nuances of the marketplace play a key part in the outcome. For example, while the color pink was not necessary for rival producers of residential fibrous glass insulation, Owens-Corning Fiberglas, *supra*, a different result is mandated when the colors orange or yellow make public telephones demonstrably more visible, In re Orange Communications Inc., 41 USPQ2d 1036 (TTAB 1996), when farmers want farm implements to be painted "John Deere green" in order to match the color of their tractors, Deere & Co. v. Farmhand, Inc., 560 F.Supp. 85, 217 USPQ 252, 261 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983), and when black

outboard marine engines are desirable because they are most compatible with boat colors and make engines appear smaller, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

In the context of an opposition proceeding, the question is whether opposer has made a *prima facie* showing of the functionality of clear containers for motor oils. We find that opposer has made such a showing.

In applying the Valu Engineering/Morton-Norwich factors, the record is silent on the presence or relevance or any utility patents, and the clear container is not the result of a cheaper manufacturing process. However, the record does speak to the remaining factors two and three.

We have seen that applicant has on occasion included in its promotional materials to the trade the utilitarian features of the clear bottle, i.e., consumers prefer it because they can see what they are buying, it gives consumers the impression that the oil is pure and clean, consumers can tell exactly how much oil has been used, etc. To the extent that applicant has touted these advantages of the clear container in advertisements directed to the trade, it undercuts its arguments in this proceeding that there are only trademark-related reasons for choosing this bottle.

More damaging, however, to applicant's position herein, is the analysis under factor three. The record shows that applicant introduced its clear container after it determined there was an obvious competitive advantage to displaying the coloration of its full synthetic oils and synthetic blends in a transparent bottle. Even though the clear plastic bottle is more expensive to manufacture than opaque bottles, and despite the fact that there are other costs associated with using clear plastic containers, applicant's sole motivation is not just to create a distinguishing package for its motor oils. Rather, opposer has pointed out numerous non-reputation related reasons for adopting a clear container, and these are competitive reasons that should not be denied to applicant's competitors. Applicant has not rebutted opposer's showing on this point, and so we find that applicant does not have a right to appropriate from the public domain the use of a clear container for its motor oils.

Distinctiveness

For the sake of completeness, in case our decision with respect to functionality is reversed on appeal, we consider the question of whether, if applicant's clear container should be found not to be *de jure* functional, it has been shown to be distinctive for motor oils.

As to applicant's arguments of inherent distinctiveness, we agree with opposer that in light of the fact that applicant seeks registration based upon acquired distinctiveness, the absence of inherent distinctiveness is established. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Accordingly, we turn to the question of whether applicant has established, on this entire record, the requisite acquired distinctiveness to support registration of the applied-for mark. See Qualitex Co. v. Jacobson Products Co., *supra*; and In re Owens-Corning Fiberglas Corporation, *supra*.

Although this application was filed under the intent-to-use provisions of the Trademark Act, an amendment to allege use was filed on August 23, 1997, claiming first use anywhere and in commerce as of August 7, 1997. As part of the *ex parte* application file, and then as supplemented during the opposition proceeding, the record contains evidence as to the levels of promotion and sales of applicant's synthetic motor oils as advertised and sold in clear bottles. The question before us, then, is whether this evidence is sufficient to demonstrate acquired distinctiveness.

We note at the outset that, although not required, the record contains no objective empirical or other direct

evidence in the nature of surveys or any other indicators of applicant's success in demonstrating consumer recognition of applicant's clear container as a trademark.

Opposer claims that Quaker State has not promoted clearness as an indication of source. However, we find that the record suggests otherwise. The record shows extensive promotion and advertising of applicant's full synthetic and synthetic blends of motor oils, for which applicant incurred annual advertising and promotional expenditures in the 1997 to 2000 time period around twenty million dollars.²¹ This promotional activity resulted in untold hundreds of millions of separate visual impressions, many of which depicted one or more of applicant's clear containers of motor oils. During this period, applicant enjoyed substantial sales of the products with which the container has been used. Most print ads and many of the video and television spots include a line-up of three formulations of Quaker State motor oils depicted in clear bottles. In conjunction with print advertisements having repeated, pictorial images of applicant's motor oils in clear packaging, applicant has used prominently such slogans as "The Difference is Clear," "The Choice is Clear,"²²

²¹ Applicant's answer to opposer's Interrogatory No. 7.

²² Applicant's exhibit ##4, 5 and 6, Bates PQS000316, 318, 320.

"Introducing a motor oil so different you can see it,"²³ a "clear bottle" having a "clearer choice,"²⁴ etc. It has produced television advertisements that show a backlit clear bottle and print ads showing a bottle without any labels. (Applicant's Exhibit Bates PQS001404) Applicant has produced radio advertisements directed to drivers of "Those cars [having high performance engines]," assuring such drivers "... that's why there's Quaker State High Performance in the clear bottle." (Applicant's exhibit #129, Bates PQS000599) The bottles themselves make the explicit claim that "CLEAR BOTTLE IS A TRADEMARK OF PENNZOIL QUAKER STATE COMPANY." Similarly, some of applicant's print ads contain the statement that "Clear bottle is a trademark of Quaker State." (Applicant's exhibit #9, Bates PQS001731) Consumer research and free publicity in magazines and newspapers show consumers have called the clear container "unique"²⁵ and comment that "it jumps out at you."

²³ *Id.*

²⁴ "... All three oils are formulated using Micro-Q Filtration and packaged in clear bottles for a difference you can see..." (Applicant's exhibit #115, Bates PQS000283); "Announcing a clearer choice for vehicles with higher mileage." (Applicant's exhibit #116, Bates PQS000285).

²⁵ "Most consumers found the clear bottle unique, and regarded it as an attractive way to display the product." Positioning Research memorandum of March 16, 2000. (Applicant's exhibit #130; Bates PQS000824). See also Peregrine Marketing Research Final Report on Motor Oil for Higher Mileage Vehicles Positioning Research, February 2000 (Applicant's exhibit #133; Bates PQS001027, 1047-49, 1056).

Nonetheless, the ultimate burden of persuasion on the issue of acquired distinctiveness rests with applicant. *Cf. Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988), and when compared with a descriptive term, a slogan, or a label, the required showing for the acquired distinctiveness of a clear container is going to be much greater. That is, the burden placed on any applicant is tied to the scope of what that applicant is trying to protect. The nature of what applicant is trying to protect here is to be contrasted with, for example, a case where an applicant wants to protect a detailed and arbitrary arrangement of the elements of a label:

The tone and layout of the colors, the style and size of the lettering, and, most important, the overall appearance of the bottle's labeling, are undeniably arbitrary. They were selected from an almost limitless supply of patterns, colors and designs.

The Paddington Corp. v. Attiki Importers & Distributors Inc., 996 F.2d 577, 27 USPQ2d 1189 (2nd Cir. 1993). In contrast to the Paddington label, if forced, by analogy, to place applicant's clear container along the continuum of generic-merely descriptive-suggestive-arbitrary/fanciful often used to

categorize verbal symbols,²⁶ it would clearly have to be placed on the generic/highly descriptive end of the spectrum.²⁷

In reality, widespread usage of a non-verbal device increases the challenge for the proponent of trade dress *qua* trademark to demonstrate acquired distinctiveness. We acknowledge, based on this record, that there are no other competing motor oils for four-cycle gasoline engines for automobiles currently on the market being sold in clear bottles. On the other hand, we agree with opposer that we cannot ignore the ubiquity of nearly identical packaging for many related automotive products. The record shows that two-cycle engine oil, maintenance fluids, functional fluids and appearance chemical products are packaged in clear, plastic bottles of the same general shape. These items are frequently displayed in adjoining sections of auto parts stores. Some of these products are actually poured into the crankcase at the same time as motor oil. Several specific functional fluids and automobile appearance products have been shrink-wrapped

²⁶ *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F.2d 4, 189 USPQ 759 (2nd Cir. 1976).

²⁷ We note that opposer argues that "the clearness of a container is equivalent to a generic term." While we find this to be a helpful analogy in the context of our *de jure* functionality analysis of "competitive need," and again here in determining the burden of persuasion placed upon applicant in establishing acquired distinctiveness, we certainly do not view it as a separate statutory basis for denying applicant a registration or even as a separate conceptual point requiring significant discussion.

and sold as a package with multiple bottles of motor oil. In short, the fact that clear containers are such a common form of trade dress for all kinds of related automotive fluids raises the ultimate burden of persuasion placed on applicant herein. See Blue Coral Inc. v. Turtle Wax Inc., 664 F.Supp.1153, 3 USPQ2d 1581 (N.D. Ill. 1987).²⁸

In addition to the fact that there is no natural predisposition on the part of consumers in the marketplace to look to something like a clear plastic container as a source indicator, in substantially all the advertisements picturing the product, the visual presentations of the bottles of motor oils contain several prominent, easily-recognized source indicators - Quaker State's name and "flying Q logo" displayed against "Quaker State green" trade dress.



Moreover, as we learn from the testimony of Messrs. Tucker and Hanson, the advertising dollars spent to promote Quaker States's motor oils during the period in question

²⁸ "... It was only a matter of time before other makers of wheel cleaners ventured on to the shelf with clear bottles. Turtle Wax had previously used different shaped clear bottles for a number of its automotive appearance chemical products, as had other manufacturers, including Blue Coral. It would be dangerous precedent to allow the first user of a particular type of packaging to forever bar second comers from using it..." Blue Coral Inc. v. Turtle Wax Inc., *supra* at 1588-89.

cannot all be seen as promoting the clear bottle. Quaker State was repositioning its products and hoping to increase its share of the burgeoning market for synthetic motor oils. Accordingly, its promotional efforts focused primarily on the benefits of full synthetic motor oils and synthetic blends for consumers in several distinct market segments. The promotional efforts included themes that ranged from "sensible technology" to "purity," "reliability" to "special formulations," and various print advertisements featured other catchy tag lines such as "Stay tuned," etc.

Hence, we find that much of this expenditure was only tangentially promoting the clear bottle. Even considering those advertisements employing prominently the explicit slogans such as "The Difference is Clear," given the play on the word "clear" in its meaning of "obvious," the allusion to the transparency of the container may not be obvious to all prospective purchasers.

We also agree with opposer that the small type ["CLEAR BOTTLE IS A TRADEMARK OF PENNZOIL QUAKER STATE COMPANY" and "Clear bottle is a trademark of Quaker State"] on bottles and print ads, respectively, will be overlooked by most, and what that means may well not be understood by many others who do notice these statements.

Accordingly, we find that applicant has not met its burden of persuasion on the issue of acquired distinctiveness. The clear bottle is featured in some of applicant's promotional activities to the trade and directly to consumers. However, it is usually part and parcel of other themes. Hence, only a small portion of the advertising and other promotional expenditures can be tied into direct promotion of the clear container. The explicit claims on the bottle and in print ads are of limited value to applicant in pressing its claim of acquired distinctiveness. Applicant's large promotional expenditures for Quaker State's full synthetic motor oils and synthetic blends resulted in an increase in the sales of these goods, but there is no evidence tying this increase in the volume of sales to that portion of the promotions that highlighted the clear bottle. Absent a stronger showing that an association was created in the minds of consumers between the clear bottle, on the one hand, and Quaker State's synthetic motor oils and synthetic blends, on the other, we find that applicant has not demonstrated such an association.

Decision: The opposition is sustained on the ground of *de jure* functionality, and in the alternative, on the ground that applicant's clear container has not acquired

distinctiveness as a trademark for applicant's motor oils, and hence registration to applicant is hereby refused.