A. SUBJECT MATTER OF TRADEMARK PROTECTION

Restatement (Third) of Unfair Competition*

§ 9. DEFINITIONS OF TRADEMARK AND SERVICE MARK

A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person’s goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others. A service mark is a trademark that is used in connection with services.

Comment:

b. Historical origins of trademarks. The use of identifying marks on goods dates to antiquity. The original purpose of such marks was to indicate ownership. With the development of commercial trade the marks came to serve a different function—identification of the source of goods offered for sale in the marketplace.

The use of trademarks was well-known in Roman times, although it was apparently left to the defrauded purchaser to bring an action against a trademark infringer. The guild system of medieval England produced the first widespread use of trademarks. Distinctive production marks were required on goods manufactured by the local guilds. The purpose of such compulsory marking was primarily regulatory since the marks fixed responsibility for defective merchandise and facilitated enforcement of the territorial monopolies enjoyed by the guilds. The geographic expansion of markets and the development of more complex distribution systems eventually resulted in a new function for production marks. The marks served to identify the source of the goods to prospective purchasers who could then make their selections based upon the reputation, not merely of the immediate vendor, but also of the manufacturer. Manufacturers began to adopt marks expressly for the purpose of identifying their goods to prospective customers. The medieval production mark thus evolved into the modern trademark used by manufacturers, distributors, and other sellers to identify their goods and services in the marketplace.

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CHAPTER 2 WHAT IS A TRADEMARK?

g. **Subject matter.** The subject matter of trademark law was initially limited to fanciful or arbitrary words and symbols. This limitation excluded not only descriptive words and symbols, but also other devices that could identify the source of goods, such as the physical appearance of the goods or the appearance of labels, wrappers, containers, or advertising materials that accompany the goods in the marketplace. When such features in fact served to distinguish the goods of a particular producer, they were protected, together with descriptive marks, in an action for unfair competition. As the distinctions between the actions for trademark infringement and unfair competition diminished, the law of trademarks eventually subsumed descriptive designations that had acquired significance as indications of source. Although the protection of product and packaging designs that are indicative of source remains subject to special limitations not applicable to other marks, they too have now been subsumed under the law of trademarks.

The definition of “trademark” adopted in this Section does not incorporate any technical limitations on the nature of the subject matter that may qualify for protection. Words remain the most common type of trademark, such as the word FORD used in connection with the sale of automobiles or KODAK used in connection with cameras. Numbers, letters, and slogans are also eligible for protection as trademarks, as are pictures, symbols, characters, sounds, graphic designs, product and packaging features, and other matter capable of identifying and distinguishing the goods or services of the user.

**Kellogg Co. v. National Biscuit Co.**
305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938).

Mr. Justice Brandeis delivered the opinion of the Court:

This suit was brought in the federal court for Delaware by National Biscuit Company against Kellogg Company to enjoin alleged unfair competition by the manufacture and sale of the breakfast food commonly known as shredded wheat. The competition was alleged to be unfair mainly because Kellogg Company uses, like the plaintiff, the name shredded wheat and, like the plaintiff, produces its biscuit in pillow-shaped form.

Shredded wheat is a product composed of whole wheat which has been boiled, partially dried, then drawn or pressed out into thin shreds and baked. The shredded wheat biscuit generally known is pillow-shaped in form. It was introduced in 1893 by Henry D. Perky, of Colorado; and he was connected until his death in 1908 with companies formed to make and market the article. Commercial success was not attained until the Natural Food Company built, in 1901, a large factory at Niagara Falls, New York. In 1908, its corporate name was changed to “The Shredded Wheat Company,” and in 1930 its business and goodwill were acquired by National Biscuit Company.

Kellogg Company has been in the business of manufacturing breakfast food cereals since its organization in 1905. For a period commencing in
1912 and ending in 1919 it made a product whose form was somewhat like the product in question, but whose manufacture was different, the wheat being reduced to a dough before being pressed into shreds. For a short period in 1922 it manufactured the article in question. In 1927, it resumed manufacturing the product.

In 1935, the District Court dismissed the bill. It found that the name “Shredded Wheat” is a term describing alike the product of the plaintiff and of the defendant; and that no passing off or deception had been shown. It held that upon the expiration of the Perky patent No. 548,086 issued October 15, 1895, the name of the patented article passed into the public domain. In 1936, the Circuit Court of Appeals affirmed that decree. Upon rehearing, it vacated, in 1937, its own decree and reversed that of the District Court, with direction “to enter a decree enjoining the defendant from the use of the name ‘Shredded Wheat’ as its trade-name and from advertising or offering for sale its product in the form and shape of plaintiff's biscuit in violation of its trade-mark; and with further directions to order an accounting for damages and profits.”

The plaintiff concedes that it does not possess the exclusive right to make shredded wheat. But it claims the exclusive right to the trade name “Shredded Wheat” and the exclusive right to make shredded wheat biscuits pillow-shaped. It charges that the defendant, by using the name and shape, and otherwise, is passing off, or enabling others to pass off, Kellogg goods for those of the plaintiff. Kellogg Company denies that the plaintiff is entitled to the exclusive use of the name or of the pillow-shape; denies any passing off; asserts that it has used every reasonable effort to distinguish its product from that of the plaintiff; and contends that in honestly competing for a part of the market for shredded wheat it is exercising the common right freely to manufacture and sell an article of commerce unprotected by patent.

First. The plaintiff has no exclusive right to the use of the term “Shredded Wheat” as a trade name. For that is the generic term of the article, which describes it with a fair degree of accuracy; and is the term by which the biscuit in pillow-shaped form is generally known by the public. Since the term is generic, the original maker of the product acquired no exclusive right to use it. As Kellogg Company had the right to make the article, it had, also, the right to use the term by which the public knows it. Ever since 1894 the article has been known to the public as shredded wheat. For many years, there was no attempt to use the term “Shredded Wheat” as a trade-mark. When in 1905 plaintiff’s predecessor, Natural Food Company, applied for registration of the words “Shredded Whole Wheat” as a trade-mark under the so-called “ten year clause” of the Act of February 20, 1906, c. 592, § 5, 33 Stat. 725, William E. Williams gave notice of opposition. Upon the hearing it appeared that Williams had, as early as 1894, built a machine for making shredded wheat, and that he made and sold its product as “Shredded Whole Wheat.” The Commissioner of Patents refused registration. The Court of Appeals of the District of Columbia affirmed his decision, holding that “these words accurately and
aptly describe an article of food which . . . has been produced . . . for more than ten years . . . .” *Natural Food Co. v. Williams*, 30 App. D.C. 348.

Moreover, the name “Shredded Wheat,” as well as the product, the process and the machinery employed in making it, has been dedicated to the public. The basic patent for the product and for the process of making it, and many other patents for special machinery to be used in making the article, issued to Perky. In those patents the term “shredded’” is repeatedly used as descriptive of the product. The basic patent expired October 15, 1912; the others soon after. Since during the life of the patents “Shredded Wheat” was the general designation of the patented product, there passed to the public upon the expiration of the patent, not only the right to make the article as it was made during the patent period, but also the right to apply thereto the name by which it had become known. As was said in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185:

“It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly . . . . To say otherwise would be to hold that, although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly.”

It is contended that the plaintiff has the exclusive right to the name “Shredded Wheat,” because those words acquired the “secondary meaning” of shredded wheat made at Niagara Falls by the plaintiff’s predecessor. There is no basis here for applying the doctrine of secondary meaning. The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff’s factory at Niagara Falls. But to establish a trade name in the term “shredded wheat” the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer. This it has not done. The showing which it has made does not entitle it to the exclusive use of the term shredded wheat but merely entitles it to require that the defendant use reasonable care to inform the public of the source of its product.

The plaintiff seems to contend that even if Kellogg Company acquired upon the expiration of the patents the right to use the name shredded wheat, the right was lost by delay. The argument is that Kellogg Company, although the largest producer of breakfast cereals in the country, did not seriously attempt to make shredded wheat, or to challenge plaintiff’s right to that name until 1927, and that meanwhile plaintiff’s predecessor had
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expended more than $17,000,000 in making the name a household word and identifying the product with its manufacture. Those facts are without legal significance. Kellogg Company's right was not one dependent upon diligent exercise. Like every other member of the public, it was, and remained, free to make shredded wheat when it chose to do so; and to call the product by its generic name. The only obligation resting upon Kellogg Company was to identify its own product lest it be mistaken for that of the plaintiff.

Second. The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. The patented machines used were designed to produce only the pillow-shaped biscuits. And a design patent was taken out to cover the pillow-shaped form. Hence, upon expiration of the patents the form, as well as the name, was dedicated to the public. As was said in *Singer Mfg. Co. v. June Mfg. Co.*, supra, p. 185:

“It is self evident that on the expiration of a patent the monopoly granted by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may, therefore, dismiss without further comment the complaint, as to the form in which the defendant made his machines.”

Where an article may be manufactured by all, a particular manufacturer can no more assert exclusive rights in a form in which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than a particular producer, than it can in the case of a name with similar connections in the public mind. Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff.

Third. The question remains whether Kellogg Company in exercising its right to use the name “Shredded Wheat” and the pillow-shaped biscuit, is doing so fairly. Fairness requires that it be done in a manner which reasonably distinguishes its product from that of plaintiff.

Each company sells its biscuits only in cartons. The standard Kellogg carton contains fifteen biscuits; the plaintiff's twelve. The Kellogg cartons are distinctive. They do not resemble those used by the plaintiff either in size, form, or color. And the difference in the labels is striking. The Kellogg cartons bear in bold script the names "Kellogg's Whole Wheat Biscuit" or "Kellogg's Shredded Whole Wheat Biscuit" so sized and spaced as to strike the eye as being a Kellogg product. It is true that on some of its cartons it had a picture of two shredded wheat biscuits in a bowl of milk which was quite similar to one of the plaintiff's registered trademarks. But the name
Kellogg was so prominent on all of the defendant’s cartons as to minimize the possibility of confusion.

Some hotels, restaurants, and lunchrooms serve biscuits not in cartons and guests so served may conceivably suppose that a Kellogg biscuit served is one of the plaintiff's make. But no person familiar with plaintiff’s product would be misled. The Kellogg biscuit is about two-thirds the size of plaintiff’s; and differs from it in appearance. Moreover, the field in which deception could be practiced is negligibly small. Only 2½ per cent of the Kellogg biscuits are sold to hotels, restaurants and lunchrooms. Of those so sold 98 per cent are sold in individual cartons containing two biscuits. These cartons are distinctive and bear prominently the Kellogg name. To put upon the individual biscuit some mark which would identify it as the Kellogg product is not commercially possible. Relatively few biscuits will be removed from the individual cartons before they reach the consumer. The obligation resting upon Kellogg Company is not to insure that every purchaser will know it to be the maker but to use every reasonable means to prevent confusion.

It is urged that all possibility of deception or confusion would be removed if Kellogg Company should refrain from using the name “Shredded Wheat” and adopt some form other than the pillow-shape. But the name and form are integral parts of the goodwill of the article. To share fully in the goodwill, it must use the name and the pillow-shape. And in the goodwill Kellogg Company is as free to share as the plaintiff. Compare *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 528, 530. Moreover, the pillow-shape must be used for another reason. The evidence is persuasive that this form is functional—that the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.

Kellogg Company is undoubtedly sharing in the goodwill of the article known as “Shredded Wheat”; and thus is sharing in a market which was created by the skill and judgment of plaintiff’s predecessor and has been widely extended by vast expenditures in advertising persistently made. But that is not unfair. Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested. There is no evidence of passing off or deception on the part of the Kellogg Company; and it has taken every reasonable precaution to prevent confusion or the practice of deception in the sale of its product.

**QUESTIONS**

1. The “Shredded Wheat” decision concerned the trademark protection available to the design of a product, and to its name, following expiration of patents covering the product and the processes and special machinery needed to manufacture it. Is the court holding that once such a patent expires, neither the product’s shape nor its name can ever be the subject of
a trademark? If not, under what circumstances is the assertion of trademark rights permissible?

2. Is trademark protection available for a word that accurately describes an article? For one that partially describes an article?

3. Is trademark protection available for a design for which a patent still subsists? For an unpatented design?

4. Justice Brandeis acknowledges that by adopting its predecessor’s name and design the second-comer “is undoubtedly sharing in the goodwill of an article known as ‘Shredded Wheat’; and thus is sharing in a market which was created by the skill and judgment of plaintiff’s predecessor and has been widely extended by vast expenditures of advertising persistently made. But that is not unfair. Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.”

In other words, one may share in the goodwill of the product, but not in that of the producer. What is the difference between these two kinds of “sharing”? How would you demonstrate the difference?


1. Word Marks

Coca-Cola Co. v. Koke Co. of America
254 U.S. 143, 41 S.Ct. 113, 65 L.Ed. 189 (1920).

Mr. Justice Holmes delivered the opinion of the Court:

This is a bill in equity brought by the Coca-Cola Company to prevent the infringement of its trade-mark Coca-Cola and unfair competition with it in its business of making and selling the beverage for which the trademark is used. The District Court gave the plaintiff a decree. 235 Fed. 408. This was reversed by the Circuit Court of Appeals. Koke Co. v. Coca-Cola Co., 255 Fed. 894, 167 C. C. A. 214. Subsequently a writ of certiorari was granted by this Court. It appears that after the plaintiff’s predecessors in title had used the mark for some years it was registered under the Act of Congress of March 3, 1881, and again under the Act of February 20, 1905. Both the Courts below agree that subject to the one question to be considered the plaintiff has a right to equitable relief. Whatever may have been its original weakness, the mark for years has acquired a secondary significance and has indicated the plaintiff’s product alone. It is found that defendant’s mixture is made and sold in imitation of the plaintiff’s and that the word “Koke” was chosen for the purpose of reaping the benefit of the advertising done by the plaintiff and of selling the imitation as and for the plaintiff’s goods. The only obstacle found by the Circuit Court of Appeals in
the way of continuing the injunction granted below was its opinion that the trade-mark in itself and the advertisements accompanying it made such fraudulent representations to the public that the plaintiff had lost its claim to any help from the Court. That is the question upon which the writ of certiorari was granted and the main one that we shall discuss.

Of course a man is not to be protected in the use of a device the very purpose and effect of which is to swindle the public. But the defects of a plaintiff do not offer a very broad ground for allowing another to swindle him. The defense relied on here should be scrutinized with a critical eye. The main point is this: Before 1900 the beginning of the good will was more or less helped by the presence of cocaine, a drug that, like alcohol or caffeine or opium, may be described as a deadly poison or as a valuable item of the pharmacopoeia according to the rhetorical purposes in view. The amount seems to have been very small, but it may have been enough to begin a bad habit and after the Food and Drug Act of June 30, 1906, if not earlier, long before this suit was brought, it was eliminated from the plaintiff’s compound. Coca leaves still are used, to be sure, but after they have been subjected to a drastic process that removes from them every characteristic substance except a little tannin and still less chlorophyll. The cola nut, at best, on its side furnishes but a small portion of the caffeine, which now is the only element that has appreciable effect. That comes mainly from other sources. It is argued that the continued use of the name imports a representation that has ceased to be true ... and that thus the very thing sought to be protected is used as a fraud.

The argument does not satisfy us. We are dealing here with a popular drink not with a medicine, and although what has been said might suggest that its attraction lay in producing the expectation of a toxic effect the facts point to a different conclusion. Since 1900 the sales have increased at a very great rate corresponding to a like increase in advertising. The name now characterizes a beverage to be had at almost any soda fountain. It means a single thing coming from a single source, and well known to the community. It hardly would be too much to say that the drink characterizes the name as much as the name the drink. In other words “Coca-Cola” probably means to most persons the plaintiff’s familiar product to be had everywhere rather than a compound of particular substances.... (It has acquired a secondary meaning in which perhaps the product is more emphasized than the producer but to which the producer is entitled. The coca leaves and whatever of cola nut is employed may be used to justify the continuance of the name or they may affect the flavor as the plaintiff contends, but before this suit was brought the plaintiff had advertised to the public that it must not expect and would not find cocaine, and had eliminated everything tending to suggest cocaine effects except the name and the picture of the leaves and nuts, which probably conveyed little or nothing to most who saw it. It appears to us that it would be going too far to deny the plaintiff relief against a palpable fraud because possibly here and there an ignorant person might call for the drink with the hope for incipient cocaine intoxication. The plaintiff’s position must be judged by
the facts as they were when the suit was begun, not by the facts of a
different condition and an earlier time.

SLOGANS

The Lanham Act’s predecessor, the Trademark Act of 1905, made no
provision for registration of slogans. Decisions construing this statute
routinely refused registration on the premise that slogans were merely
descriptive advertising features. See generally Beran, Protection of Slogans
in the Patent Office and the Courts, 57 Trademark Rep. 219 (1967). The
turning point came after adoption of the Lanham Act, in American Enka
that the prior cases disfavoring registration defied the traditional trade-
mark logic that a combination of words capable of distinguishing goods or
services possesses trademark significance, and is therefore registrable. The
Marzall court, holding registrable on the Principal Register the phrase
“THE FATE OF A FABRIC HANGS BY A THREAD,” noted that “certain
combinations of words, albeit that they are also slogans, may properly
function as trademarks.”

The Commissioner of Patents adopted the Marzall approach in Ex
parte Robbins & Myers, Inc., 104 U.S.P.Q. 403 (1955), and held the slogan
“MOVING AIR IS OUR BUSINESS” registrable on the Principal Register.
Rejecting the Trademark Examiner’s position that the phrase was merely
descriptive for electric fans for circulating air, Assistant Commissioner
Leeds stated that the phrase had “a certain double entendre which removes
it from [the merely descriptive] category.” The Commissioner also stressed
that section 2 of the Lanham Act made clear that so long as a term is
distinctive, it shall not be refused registration “on account of its nature.”
Thus, assigning slogans to second-class status violated the Lanham Act’s
nondiscrimination principle. Moreover, section 23 of the Lanham Act
explicitly provides that slogans are registrable on the Supplemental Regis-
ter. A slogan’s descriptive feature, therefore, does not automatically dis-
quailify it from registration.

What if the slogan is straightforwardly descriptive? Like other descript-
tive terms, a descriptive slogan can acquire secondary meaning through
extensive, continuous and substantially exclusive use, and thus may achieve
the secondary meaning requisite to protectable status. One such slogan was
the court dismissed an opposition to registration on the Principal Register
of the slogan “HAIR COLOR SO NATURAL ONLY HER HAIR DRESSER
KNOWS FOR SURE” for “hair tinting, dyeing and coloring preparation.”
(The student may recall that in the advertisements for applicant’s “Miss
Clairol” product, the inquiry “Does she … or doesn’t she?” preceded the
disputed slogan. Another memorable slogan from this period for a similar
product plaintively declared, “IF I HAVE ONLY ONE LIFE TO LEAD,
LET ME LIVE IT AS A BLONDE!”) In rejecting opposer’s mere descrip-
tiveness challenge, the court emphasized the pervasiveness of applicant’s
advertising and sales: from 1956–66, applicant sold over 50 million dollars
worth of the product, and expended 22 million dollars in advertising containing the disputed slogan. "Conservatively estimated, there have been more than a billion audio impressions of this slogan on network television in the United States (one impression being one household having a TV set tuned to a given program at a given time)." The court thus held "we do not think the board erred in concluding that Clairol's slogan has made an impact upon the purchasing public separate from and in addition to the impact of its 'Miss Clairol' mark."

PERSONAL NAMES

Peaceable Planet v. Ty, Inc.
362 F.3d 986 (7th Cir. 2004).

Posner, J.

Like the defendant, the much larger and better known Ty Inc., Peaceable Planet makes plush toys in the shape of animals, filled with bean-like materials to give the toys a soft and floppy feel. Ty's plush toys are, of course, the famous "Beanie Babies."

In the spring of 1999, Peaceable Planet began selling a camel that it named "Niles." The name was chosen to evoke Egypt, which is largely desert except for the ribbon of land bracketing the Nile. The camel is a desert animal, and photos juxtaposing a camel with an Egyptian pyramid are common. The price tag fastened to Niles's ear contains information both about camels and about Egypt, and the Egyptian flag is stamped on the animal.

A small company, Peaceable Planet sold only a few thousand of its camels in 1999. In March of the following year, Ty began selling a camel also named "Niles." It sold a huge number of its "Niles" camels—almost two million in one year—precipitating this suit. The district court ruled that "Niles," being a personal name, is a descriptive mark that the law does not protect unless and until it has acquired secondary meaning, that is, until there is proof that consumers associate the name with the plaintiff's brand. Peaceable Planet did not prove that consumers associate the name "Niles" with its camel....

The reluctance to allow personal names to be used as trademarks reflects valid concerns.... One of the concerns is a reluctance to forbid a person to use his own name in his own business. [Citations omitted.] Supposing a man named Brooks opened a clothing store under his name, should this prevent a second Brooks from opening a clothing store under his own (identical) name even though consumers did not yet associate the name with the first Brooks's store? It should not. [Citations omitted.]

Another and closely related concern behind the personal-name rule is that some names are so common—such as "Smith," "Jones," "Schwartz," "Wood," and "Jackson"—that consumers will not assume that two prod-
ucts having the same name therefore have the same source, and so they will not be confused by their bearing the same name. [Citations omitted.] If there are two bars in a city that are named “Steve’s,” people will not infer that they are owned by the same Steve.

The third concern, which is again related but brings us closest to the rule regarding descriptive marks, is that preventing a person from using his name to denote his business may deprive consumers of useful information. Maybe “Steve” is a well-known neighborhood figure. If he can’t call his bar “Steve’s” because there is an existing bar of that name, he is prevented from communicating useful information to the consuming public. [Citations omitted.] ...

The personal-name “rule,” it is worth noting, is a common law rather than statutory doctrine. All that the Lanham Act says about personal names is that a mark that is “primarily merely a surname” is not registrable in the absence of secondary meaning. 15 U.S.C. §§ 1052(e)(4), (f). There is no reference to first names. The reason for the surname provision is illustrated by the Brooks example. The extension of the rule to first names is a judicial innovation and so needn’t be pressed further than its rationale, as might have to be done if the rule were codified in inflexible statutory language. Notice too the limitation implicit in the statutory term “primarily.”

In thinking about the applicability of the rationale of the personal-name rule to the present case, we should notice first of all that camels, whether real or toy, do not go into business. Peaceable Planet’s appropriation of the name “Niles” for its camel is not preventing some hapless camel in the Sahara Desert who happens to be named “Niles” from going into the water-carrier business under its own name. The second thing to notice is that “Niles” is not a very common name; in fact it is downright rare. And the third thing to notice is that if it were a common name, still there would be no danger that precluding our hypothetical Saharan water carrier from using its birth name “Niles” would deprive that camel’s customers of valuable information. In short, the rationale of the personal-name rule is wholly inapplicable to this case.

What is more, if one wants to tie the rule in some fashion to the principle that descriptive marks are not protectable without proof of second meaning, then one must note that “Niles,” at least when affixed to a toy camel, is a suggestive mark, like “Microsoft” or “Business Week,” or—coming closer to this case—like “Eor” used as the name of a donkey, or the proper names in Circuit City Stores, Inc. v. CarMax, Inc., supra, 165 F.3d at 1064, rather than being a descriptive mark. Suggestive marks are protected by trademark law without proof of secondary meaning. [Citations omitted.] Secondary meaning is not required because there are plenty of alternatives to any given suggestive mark. There are many more ways of suggesting than of describing. Suggestive names for camels include “Lawrence [of Arabia]” (one of Ty’s other Beanie Babies is a camel named “Lawrence”); “Desert Taxi,” “Sopwith” (the Sopwith Camel was Snoopy’s World War I

If “Niles” cannot be a protected trademark, it must be because to give it legal protection would run afoul of one of the purposes of the common law rule that we have identified rather than because it is a descriptive term, which it is not. But we have seen that it does not run afoul of any of those purposes. “Niles” is not the name of the defendant—it’s not as if Peaceable Planet had named its camel “Ty Inc.” or “H. Ty Warner.” It also is not a common name, like “Smith” or “Jackson.” And making Ty use a different name for its camel would not deprive the consumer of valuable information about Ty or its camel.

2. Service Marks


Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

What is a “Service”?

Examples of service marks that we have already encountered in this casebook include Sears Roebuck & Co. (retail services) and Stork Restaurant (restaurant services). Neither the Lanham Act nor its legislative history defines “services.” The Federal Circuit has noted that the term was “intended to have a broad scope” and was not defined because of “the plethora of services that the human mind is capable of conceiving.” In re
Advertising & Marketing Development Inc., 821 F.2d 614 (Fed.Cir.1987). The Federal Circuit has broadly defined a “service” as “the performance of labor for the benefit of another.” Id. at 2914. In order to constitute a service, therefore, it is necessary that it be for another. Services performed only for the benefit of the owner of the mark, such as advertising the owner’s own goods, are not considered a service. See, e.g., In re Dr. Pepper Co., 836 F.2d 508 (Fed.Cir.1987). What if instead of advertising one’s own goods, the mark owner offers advertising space to others? See In re Forbes, 31 U.S.P.Q.2d 1315 (T.T.A.B.1994) (offering advertising space under mark NO GUTS, NO STORY found to be a service even though the advertising was placed in applicant’s own publications such as Forbes magazine). What if a family-owned investment company engages in financial activities intended to benefit the family, but incidentally solicits co-investors, arranges joint ventures and advises U.S. individuals about investments in Asia; do these activities constitute a service? See Morainside Group Ltd. v. Morningside Capital Group, L.L.C., 182 F.3d 133 (2d Cir.1999).

Unlike a trademark, a service mark is “used” when it is displayed in the advertising of services, as well as in their sale or offering. Nonetheless, courts have determined that the first use of a service mark for purposes of securing registration must be in connection with the offering, rather than the announcement, of the services. Hence, an advertising announcement that a service will shortly be available (for example, that a restaurant will be opening) will not constitute “use” for registration. The services must have been rendered in commerce. See, e.g., In re Port Authority of New York, 3 U.S.P.Q.2d 1453 (T.T.A.B.1987); TMEP § 1301.08(a).

3. COLLECTIVE AND CERTIFICATION MARKS


Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this Chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


Collective Mark

The term “collective mark” means a trademark or service mark—
(1) used by the members of a cooperative, an association, or other collective group or organization, or


4. TRADE DRESS

Qualitex Co. v. Jacobson Products Co., Inc.

JUSTICE BREYER delivered the opinion of the Court:

The question in this case is whether the Lanham Trademark Act of 1946 (Lanham Act), 15 U.S.C. §§ 1051–1127 (1988 ed. and Supp. V), permits the registration of a trademark that consists, purely and simply, of a color. We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.

I

The case before us grows out of petitioner Qualitex Company's use (since the 1950's) of a special shade of green-gold color on the pads that it makes and sells to dry cleaning firms for use on dry cleaning presses. In 1989 respondent Jacobson Products (a Qualitex rival) began to sell its own press pads to dry cleaning firms; and it colored those pads a similar green-gold. In 1991 Qualitex registered the special green-gold color on press pads with the Patent and Trademark Office as a trademark. Registration No. 1,633,711 (Feb. 5, 1991). Qualitex subsequently added a trademark infringement count, 15 U.S.C. § 1114(1), to an unfair competition claim, § 1125(a), in a lawsuit it had already filed challenging Jacobson's use of the green-gold color.

Qualitex won the lawsuit in the District Court. 21 U.S.P.Q.2d (BNA) 1457 (C.D.Cal.1991). But, the Court of Appeals for the Ninth Circuit set aside the judgment in Qualitex's favor on the trademark infringement claim because, in that Circuit's view, the Lanham Act does not permit Qualitex, or anyone else, to register "color alone" as a trademark. 13 F.3d 1297, 1300, 1302 (1994).

The courts of appeals have differed as to whether or not the law recognizes the use of color alone as a trademark. Compare NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 1028 (C.A.7 1990) (absolute prohibition against protection of color alone), with In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1128 (C.A.Fed.1985) (allowing registration of color pink for fiberglass insulation), and Master Distributors, Inc. v. Pako Corp., 986 F.2d 219, 224 (C.A.8 1993) (declining to establish per se prohibition against protecting color alone as a trademark). Therefore, this Court granted certiorari. 512 U.S. (1994). We now hold that there is no rule
absolutely barring the use of color alone, and we reverse the judgment of the Ninth Circuit.

II

The Lanham Act gives a seller or producer the exclusive right to “register” a trademark, 15 U.S.C. § 1052 (1988 ed. and Supp. V), and to prevent his or her competitors from using that trademark, § 1114(1). Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks “include any word, name, symbol, or device, or any combination thereof.” § 1127. Since human beings might use as a “symbol” or “device” almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive . . .

A color is also capable of satisfying the more important part of the statutory definition of a trademark, which requires that a person “use” or “intend to use” the mark

“to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127.

True, a product’s color is unlike “fanciful,” “arbitrary,” or “suggestive” words or designs, which almost automatically tell a customer that they refer to a brand. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9–10 (C.A.2 1976) (Friendly, J.); see Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. ___ (1992) (slip op., at 6–7). The imaginary word “Suntost,” or the words “Suntost Marmalade,” on a jar of orange jam immediately would signal a brand or a product “source”; the jam’s orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—i.e. to “indicate” their “source”—much in the way that descriptive words on a product (say, “Trim” on nail clippers or “Car-Freshner” on deodorizer) can come to indicate a product’s origin. See, e.g., J. Wiss & Sons Co. v. W. E. Bassett Co., 59 C.C.P.A. 1269, 1271, 462 F.2d 567 (Pat.), 462 F.2d 567, 569 (1972); Car-Freshner Corp. v. Turtle Wax, Inc., 268 F. Supp. 162, 164 (S.D.N.Y.1967). In this circumstance, trademark law says that the word (e.g., “Trim”), although not inherently distinctive, has developed “secondary meaning.” See Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851, n. 11, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982) (“secondary meaning” is acquired when “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself”). Again, one might ask, if trademark law permits a descriptive word with secondary meaning
to act as a mark, why would it not permit a color, under similar circumstances, to do the same?

We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained "secondary meaning" and therefore identifies and distinguishes a particular brand (and thus indicates its "source"). In principle, trademark law, by preventing others from copying a source-identifying mark, "reduces the customer's costs of shopping and making purchasing decisions," 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition § 2.01[21], p. 2–3 (3d ed. 1994) (hereinafter McCarthy), for it quickly and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby "encourages the production of quality products," ibid., and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer's inability quickly to evaluate the quality of an item offered for sale. See, e.g., 3 L. Altman, Callmann on Unfair Competition, Trademarks and Monopolies § 17.03 (4th ed. 1983); Landes & Posner, The Economics of Trademark Law, 78 T. M. Rep. 267, 271–272 (1988); Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 198, 83 L. Ed. 2d 582, 105 S. Ct. 658 (1985); S. Rep. No. 100–515, p. 4 (1988). It is the source—distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes. See Landes & Posner, Trademark Law: An Economic Perspective, 30 J. Law & Econ. 265, 290 (1987). And, for that reason, it is difficult to find, in basic trademark objectives, a reason to disqualify absolutely the use of a color as a mark.

Neither can we find a principled objection to the use of color as a mark in the important "functionality" doctrine of trademark law. The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). See Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 119–120, 83 L. Ed. 73, 59 S. Ct. 109 (1938) (Brandeis, J.); Inwood Laboratories, Inc., supra, at 863 (White, J., concurring in result) ("A functional characteristic is 'an important ingredient in the commercial success of the product,' and, after expiration of a patent, it is no more the property of the originator than the product itself") (citation omitted). Functionality doctrine therefore would require, to take an imaginary example, that even if customers have come to identify the
special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition—not by protecting the reputation of the original bulb maker, but by frustrating competitors’ legitimate efforts to produce an equivalent illumination-enhancing bulb. See, e.g., Kellogg Co., supra, at 119–120 (trademark law cannot be used to extend monopoly over “pillow” shape of shredded wheat biscuit after the patent for that shape had expired). This Court consequently has explained that, “in general terms, a product feature is functional,” and cannot serve as a trademark, “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. Inwood Laboratories, Inc., 456 U.S. at 850, n. 10. Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not. And, this latter fact—the fact that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality—indicates that the doctrine of “functionality” does not create an absolute bar to the use of color alone as a mark. See Owens–Corning, 774 F.2d at 1123 (pink color of insulation in wall “performs no nontrademark function”).

It would seem, then, that color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm’s goods and identifies their source, without serving any other significant function. See U.S. Dept. of Commerce, Patent and Trademark Office, Trademark Manual of Examining Procedure § 1202.04(c), p. 1202–13 (2d ed. May, 1993) (hereinafter PTO Manual) (approving trademark registration of color alone where it “has become distinctive of the applicant’s goods in commerce,” provided that “there is [no] competitive need for colors to remain available in the industry” and the color is not “functional”); see also 1 McCarthy §§ 3.01[1], 7.26 (“requirements for qualification of a word or symbol as a trademark” are that it be (1) a “symbol,” (2) “used . . . as a mark,” (3) “to identify and distinguish the seller’s goods from goods made or sold by others,” but that it not be “functional”). Indeed, the District Court, in this case, entered findings (accepted by the Ninth Circuit) that show Qualitex’s green-gold press pad color has met these requirements. The green-gold color acts as a symbol. Having developed secondary meaning (for customers identified the green-gold color as Qualitex’s), it identifies the press pads’ source. And, the green-gold color serves no other function. (Although it is important to use some color on press pads to avoid noticeable stains, the court found “no competitive need in the press pad industry for the green-gold color, since other colors are equally usable.” 21 U.S.P.Q.2d (BNA) at 1460.) Accordingly, unless there is some special reason that convincingly militates against the use of color alone as a trademark, trademark law would protect Qualitex’s use of the green-gold color on its press pads.
III

Respondent Jacobson Products says that there are four special reasons why the law should forbid the use of color alone as a trademark. We shall explain, in turn, why we, ultimately, find them unpersuasive.

First, Jacobson says that, if the law permits the use of color as a trademark, it will produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use. Because lighting (morning sun, twilight mist) will affect perceptions of protected color, competitors and courts will suffer from “shade confusion” as they try to decide whether use of a similar color on a similar product does, or does not, confuse customers and thereby infringe a trademark. Jacobson adds that the “shade confusion” problem is “more difficult” and “far different from” the “determination of the similarity of words or symbols.” Brief for Respondent 22.

We do not believe, however, that color, in this respect, is special. Courts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers. They have had to compare, for example, such words as “Bonamine” and “Dramamine” (motion-sickness remedies); “Huggies” and “Dougies” (diapers); “Cheracol” and “Syrocol” (cough syrup); “Cyclone” and “Tornado” (wire fences); and “Mattress” and “1-800-Mattres” (mattress franchisor telephone numbers). See, e.g., G. D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 389 (C.A.7 1959); Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd., 774 F.2d 1144, 1146–1147 (C.A.Fed 1985); Upjohn Co. v. Schwartz, 246 F.2d 254, 262 (C.A.2 1957); Hancock v. American Steel & Wire Co., 40 C. C. P. A. of New Jersey, 931, 935 (Pat.), 203 F.2d 737, 740–741 (1953); Dial-A-Mattress Franchise Corp. v. Page, 880 F.2d 675, 678 (C.A.2 1989). Legal standards exist to guide courts in making such comparisons. See, e.g., 2 McCarthy § 15.08; 1 McCarthy §§ 11.24–11.25 (“Strong” marks, with greater secondary meaning, receive broader protection than “weak” marks). We do not see why courts could not adopt those standards to a color, replicating, if necessary, lighting conditions under which a colored product is normally sold. See Ebert, Trademark Protection in Color: Do It By The Numbers, 84 T. M. Rep. 379, 405 (1994). Indeed, courts already have done so in cases where a trademark consists of a color plus a design, i.e., a colored symbol such as a gold stripe (around a sewer pipe), a yellow strand of wire rope, or a “brilliant yellow” band (on amulets). See, e.g., Youngstown Sheet & Tube Co. v. Tallman Conduit Co., 149 U.S.P.Q. (BNA) 656, 657 (TTAB 1966); Amsted Industries, Inc. v. West Coast Wire Rope & Rigging Inc., 2 U.S.P.Q.2d (BNA) 1755, 1760 (TTAB 1987); In re Hodes–Lange Corp., 167 U.S.P.Q. (BNA) 255, 256 (TTAB 1970).

Second, Jacobson argues, as have others, that colors are in limited supply. See, e.g., NutraSweet Co., 917 F.2d at 1028; Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (C.A.3 1949). Jacobson claims that, if one of many competitors can appropriate a particular color for use as a trademark, and each competitor then tries to do the same, the supply of colors will soon be depleted. Put in its strongest form, this argument would
concede that “hundreds of color pigments are manufactured and thousands of colors can be obtained by mixing.” L. Cheskin, Colors: What They Can Do For You 47 (1947). But, it would add that, in the context of a particular product, only some colors are usable. By the time one discards colors that, say, for reasons of customer appeal, are not usable, and adds the shades that competitors cannot use lest they risk infringing a similar, registered shade, then one is left with only a handful of possible colors. And, under these circumstances, to permit one, or a few, producers to use colors as trademarks will “deplete” the supply of usable colors to the point where a competitor’s inability to find a suitable color will put that competitor at a significant disadvantage.

This argument is unpersuasive, however, largely because it relies on an occasional problem to justify a blanket prohibition. When a color serves as a mark, normally alternative colors will likely be available for similar use by others. See, e.g., Owens-Corning, 774 F.2d at 1121 (pink insulation). Moreover, if that is not so—if a “color depletion” or “color scarcity” problem does arise—the trademark doctrine of “functionality” normally would seem available to prevent the anticompetitive consequences that Jacobson’s argument posits, thereby minimizing that argument’s practical force.

The functionality doctrine, as we have said, forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is “essential to the use or purpose of the article” or “affects [its] cost or quality.” Inwood Laboratories, Inc., 456 U.S. at 850, n. 10. The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation-related product features. For example, this Court has written that competitors might be free to copy the color of a medical pill where that color serves to identify the kind of medication (e.g., a type of blood medicine) in addition to its source. See id., at 853, 858, n. 20 (“Some patients commingle medications in a container and rely on color to differentiate one from another”); see also J. Ginsburg, D. Goldberg, & A. Greenbaum, Trademark and Unfair Competition Law 194–195 (1991) (noting that drug color cases “have more to do with public health policy” regarding generic drug substitution “than with trademark law”). And, the federal courts have demonstrated that they can apply this doctrine in a careful and reasoned manner, with sensitivity to the effect on competition. Although we need not comment on the merits of specific cases, we note that lower courts have permitted competitors to copy the green color of farm machinery (because customers wanted their farm equipment to match) and have barred the use of black as a trademark on outboard boat motors (because black has the special functional attributes of decreasing the apparent size of the motor and ensuring compatibility with many different boat colors). See Deere & Co. v. Farmhand, Inc., 560 F. Supp. 85, 98 (S.D. Iowa 1982), aff'd, 721 F.2d 253 (C.A.8 1983); Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1532 (C.A.Fed.1994), cert. pending, No. 94-1075; see also Nor–Am Chemical v. O. M. Scott & Sons Co., 4
U.S.P.Q. 2d (BNA) 1316, 1320 (E.D.Pa. 1987) (blue color of fertilizer held functional because it indicated the presence of nitrogen). The Restatement (Third) of Unfair Competition adds that, if a design's "aesthetic value" lies in its ability to "confer a significant benefit that cannot practically be duplicated by the use of alternative designs," then the design is "functional." Restatement (Third) of Unfair Competition § 17, Comment c, pp. 175–176 (1995). The "ultimate test of aesthetic functionality," it explains, "is whether the recognition of trademark rights would significantly hinder competition." Id., at 176.

The upshot is that, where a color serves a significant nontrademark function—whether to distinguish a heart pill from a digestive medicine or to satisfy the "noble instinct for giving the right touch of beauty to common and necessary things," G. K. Chesterton, Simplicity and Tolstoy (1912)—courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient. That examination should not discourage firms from creating aesthetically pleasing mark designs, for it is open to their competitors to do the same. See, e.g., W. T. Rogers Co. v. Keene, 778 F.2d 334, 343 (C.A. 7 1985) (Posner, J.). But, ordinarily, it should prevent the anticompetitive consequences of Jacobson's hypothetical "color depletion" argument, when, and if, the circumstances of a particular case threaten "color depletion."

Third, Jacobson points to many older cases—including Supreme Court cases—in support of its position. In 1878, this Court described the common-law definition of trademark rather broadly to "consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another." McLean v. Fleming, 96 U.S. 245, 254, 24 L. Ed. 828. Yet, in interpreting the Trademark Acts of 1881 and 1905, 21 Stat. 502, 33 Stat. 724, which retained that common-law definition, the Court questioned "whether mere color can constitute a valid trade-mark," A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166, 171, 50 L. Ed. 710, 26 S. Ct. 425 (1906), and suggested that the "product including the coloring matter is free to all who make it." Coca-Cola Co. v. Koke Co. of America, 254 U.S. 143, 147, 65 L. Ed. 189, 41 S. Ct. 113 (1920). Even though these statements amounted to dicta, lower courts interpreted them as forbidding protection for color alone. See, e.g., Campbell Soup Co., 175 F.2d at 798, and n. 9; Life Savers Corp. v. Curtiss Candy Co., 182 F.2d 4, 9 (C.A. 7 1950) (quoting Campbell Soup).

These Supreme Court cases, however, interpreted trademark law as it existed before 1946, when Congress enacted the Lanham Act. The Lanham Act significantly changed and liberalized the common law to "dispense with mere technical prohibitions," S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946), most notably, by permitting trademark registration of descriptive words (say, "U-Build-It" model airplanes) where they had acquired "sec-
ary meaning.” See Abercrombie & Fitch Co., 537 F.2d at 9 (Friendly J.). The Lanham Act extended protection to descriptive marks by making clear that (with certain explicit exceptions not relevant here),


This language permits an ordinary word, normally used for a nontrademark purpose (e.g., description), to act as a trademark where it has gained “secondary meaning.” Its logic would appear to apply to color as well. Indeed, in 1988, the Federal Circuit considered the significance of the Lanham Act’s changes as they related to color and held that trademark protection for color was consistent with the jurisprudence under the Lanham Act developed in accordance with the statutory principle that if a mark is capable of being or becoming distinctive of [the] applicant’s goods in commerce, then it is capable of serving as a trademark.” Owens–Corning, 774 F.2d at 1120.

In 1988 Congress amended the Lanham Act, revising portions of the definitional language, but left unchanged the language here relevant. § 134, 102 Stat. 3946, 15 U.S.C. § 1127. It enacted these amendments against the following background: (1) the Federal Circuit had decided Owens–Corning; (2) the Patent and Trademark Office had adopted a clear policy (which it still maintains) permitting registration of color as a trademark, see PTO Manual § 1202.04(e) (at p. 1200–12 of the January 1986 edition and p. 1202–13 of the May 1993 edition); and (3) the Trademark Commission had written a report, which recommended that “the terms ‘symbol, or device’ . . . not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark,” The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 T. M. Rep. 375, 421 (1987) (hereinafter Trademark Commission); see also 133 Cong. Rec. 32812 (1987) (statement of Sen. DeConcini) (“The bill I am introducing today is based on the Commission’s report and recommendations”). This background strongly suggests that the language “any word, name, symbol, or device,” 15 U.S.C. § 1127, had come to include color. And, when it amended the statute, Congress retained these terms. Indeed, the Senate Report accompanying the Lanham Act revision explicitly referred to this background understanding, in saying that the “revised definition intentionally retains . . . the words ‘symbol or device’ so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks.” S. Rep. No. 100–515, at 44. In addition, the statute retained language providing that “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration . . . on account of its nature” (except for certain specified reasons not relevant here). (15 U.S.C. § 1052 (1988 ed., Supp. V)).
A. Subject Matter of Trademark Protection

This history undercuts the authority of the precedent on which Jacobson relies. Much of the pre-1985 case law rested on statements in Supreme Court opinions that interpreted pre-Lanham Act trademark law and were not directly related to the holdings in those cases. Moreover, we believe the Federal Circuit was right in 1985 when it found that the 1946 Lanham Act embodied crucial legal changes that liberalized the law to permit the use of color alone as a trademark (under appropriate circumstances). At a minimum, the Lanham Act’s changes left the courts free to reevaluate the pre-existing legal precedent which had absolutely forbidden the use of color alone as a trademark. Finally, when Congress re-enacted the terms “word, name, symbol, or device” in 1988, it did so against a legal background in which those terms had come to include color, and its statutory revision embraced that understanding.

Fourth, Jacobson argues that there is no need to permit color alone to function as a trademark because a firm already may use color as part of a trademark, say, as a colored circle or colored letter or colored word, and may rely upon “trade dress” protection, under § 43(a) of the Lanham Act, if a competitor copies its color and thereby causes consumer confusion regarding the overall appearance of the competing products or their packaging, see 15 U.S.C. § 1125(a) (1988 ed., Supp. V). The first part of this argument begs the question. One can understand why a firm might find it difficult to place a usable symbol or word on a product (say, a large industrial bolt that customers normally see from a distance); and, in such instances, a firm might want to use color, pure and simple, instead of color as part of a design. Neither is the second portion of the argument convincing. Trademark law helps the holder of a mark in many ways that “trade dress” protection does not. See 15 U.S.C. § 1124 (ability to prevent importation of confusingly similar goods); § 1072 (constructive notice of ownership); § 1065 (incontestable status); § 1057(b) (prima facie evidence of validity and ownership). Thus, one can easily find reasons why the law might provide trademark protection in addition to trade dress protection.

IV

Having determined that a color may sometimes meet the basic legal requirements for use as a trademark and that respondent Jacobson’s arguments do not justify a special legal rule preventing color alone from serving as a trademark (and, in light of the District Court’s here undisputed findings that Qualitex’s use of the green-gold color on its press pads meets the basic trademark requirements), we conclude that the Ninth Circuit erred in barring Qualitex’s use of color as a trademark. For these reasons, the judgment of the Ninth Circuit is

REVERSED.

QUESTIONS

1. Color can be a highly distinctive feature of a product or its packaging. Hawaiian Punch® fruit juice drink, Pepto Bismol® medicine and Windex® glass cleaner are examples of products with distinctive coloration; Philadel-
Philadelphia Cream Cheese and Coca-Cola® are examples of products with widely recognized package colors. Color may also, however, function as a high-efficiency symbol for conveying important information about the product. Sprite® soda is only one example of a citrus-flavored soft drink that has long been sold in a green can; over-the-counter drugs promoted as especially effective for night-time use, like Vick’s NyQuil® and Tylenol® PM, are sold in boxes adorned with soothing blue tones, and unscented dishwashing liquids, like Dawn® Free and Palmolive® Sensitive Skin are commonly sold in colorless bottles in clear, colorless bottles. The Court in Qualitex determined that “color may sometimes meet the basic legal requirements for use as a trademark...” How would you articulate the test to determine whether a particular use of color in fact meets those legal requirements?

2. In Justice Breyer’s view, can color alone ever qualify as a trademark without first acquiring secondary meaning?

Qualitex may have encouraged attempts to register single-color marks, but the Trademark Trial and Appeal Board has not always been receptive. In In re Orange Communications Inc., 41 U.S.P.Q.2d 1036 (T.T.A.B.1996), the Board upheld the refusal to register a bright orange color for pay telephones, on the ground that the color was designed to be highly visible by passing motorists even in poor weather, and therefore was functional. In support of this determination, the Board cited its decision in In re Howard S. Leight, 39 U.S.P.Q.2d 1058 (T.T.A.B.1996), in which the Board had held that the bright and highly visible coral color of safety ear plugs was functional.

The color blue has spawned a relatively extensive and somewhat inconsistent caselaw. In In re Hudson News Co., 39 U.S.P.Q.2d 1915 (T.T.A.B.1996), the Board sustained the refusal to register the color blue for newsstand and store decor. The Examiner had held the blue trade dress “de jure functional because it creates a soothing, calming environment which competitors should be free to create in their stores as well.” The Board rejected this ground for refusal: “we do not see why a blue interior necessarily is beneficial to a retail newsstand. In this connection, there is no evidence to even suggest that a newsstand (or any other store) with a blue interior would attract more customers, and/or increase sales.” Nonetheless, the Board upheld the Examiner’s finding that the color was not inherently distinctive: the color “is quite pedestrian,” and there was no evidence that the applicant had promoted the color as a service mark. By contrast, in 3M v. Intertape Polymer Group, 423 F.Supp.2d 958 (D.Minn. 2006), the PTO had registered the color blue for painter’s tape, and the district court declined to grant the defendant summary judgment, holding that there remained disputed fact issues concerning the distinctiveness and functionality of the color. See also Unique Sports Prods., Inc. v. Babolat VS, 403 F.Supp.2d 1229 (N.D.Ga.2005)(light blue tennis racquet overgrip; denying summary judgment because material fact issues to resolve regarding


5. OTHER IDENTIFYING INDICIA

If the protection of visual marks is well established, what about marks that appeal to the other senses? Can a musical chime serve as a trademark? What about a scent? A flavor? A touch? As Justice Breyer observed in Qualitex, the statutory definition of trademarks is not limited to words, logos or pictures, but extends to "any word, name, symbol, or device" used to indicate the source of goods. So long as a symbol or device in fact functions as a trademark in the marketplace, in the sense that it distinguishes a product from products of other producers and is perceived by consumers as an indicia of product source, is there any reason why it should not be protected as a trademark under the Lanham Act? The preamble of Section 2 of the Lanham provides that:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature . . . . (Emphasis added).

The Trademark Review Commission of the United States Trademark Association, in its review of the Trademark Act of 1946, "determined that the terms 'symbol, or device' should not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark." The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TMR 375, 421 (Sept.–Oct. 1987).

Courts interpret this flexible definition of a trademark as protecting non-graphic marks that have come to identify and distinguish the source of a service or a product. The registrability of an arbitrary, nonfunctional
scent was addressed in *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B.1990). The Trademark Examining Attorney refused to register a mark for “sewing thread and embroidery yarn” that comprised “a high impact, fresh floral fragrance reminiscent of Plumeria blossoms.” The examining attorney claimed that the “fragrance mark is analogous to other forms of product ornamentation in that it is not the type of matter which consumers would tend to perceive as an indication of origin.” Analogies were made to other products that contain scents, such as cosmetics and cleaning products, where there is no showing that consumers regard the scent as an indication of source as opposed to a mere “pleasant feature of the goods.” The Trademark Trial and Appeal Board held that the scented fragrance did function as a trademark for thread and embroidery yarn and found that:

> It is clear from the record that applicant is the only person who has marketed yarns and threads with a fragrance. That is to say, fragrance is not an inherent attribute or natural characteristic of applicant’s goods but is rather a feature supplied by applicant. Moreover, applicant has emphasized this characteristic of her goods in advertising, promoting the scented feature of her goods. Applicant has demonstrated that customers, dealers and distributors of her scented yarns and threads have come to recognize applicant as the source of these goods.

The T.T.A.B. limited this holding to exclude “scents or fragrances of products which are noted for those features, such as perfumes, colognes or scented household products.” *Compare In re Star Pharmaceuticals, Inc.*, 225 U.S.P.Q. 209 (T.T.A.B.1985) (where applicant failed to demonstrate that the features (colors) sought to be registered had been promoted as a source indicator).

Marks directed to the sense of taste have fared less well. See, e.g., *Perk Scientific, Inc. v. Ever Scientific, Inc.*, 77 U.S.P.Q.2d 1412 (E.D.Pa.2005) (lack of carbonation and flavor selection held functional for glucose tolerant beverage products); *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (T.T.A.B.2006) (orange flavor for antidepressants in quick-dissolving tablets and pills held functional for masking the unpleasant tastes of certain medicines). In *Organon*, the Board also held that consumers would not perceive the flavor as feature of the product rather than as an indicator of source. The Board expressed considerable doubt that flavor would ever be capable of serving as a trademark:

> [W]e are not blind to the practical considerations involved in the registration of flavor marks. Flavor perception is very subjective; what applicant considers to be a unique and distinctive orange flavor may be considered by patients as simply an orange flavor. Moreover, the Office’s examination of flavor marks, not to mention litigation at the Board, would be very problematic.10

10. In the abstract, we see some difficulty in how a taste could function as a trademark. As stated by Ms. Clarke in her law review article;
Further, it is not clear how taste would as a practical matter function as a trademark. A consumer generally has no access to the product's flavor prior to purchase. A trademark is defined as a word, name, symbol, or device that is used by a person "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods." Section 45 of the Trademark Act, 15 U.S.C. § 1127. Unlike color, sound and smell, there generally is no way for consumers routinely to distinguish products by sampling them before they decide which one to purchase. Generally, it would not be expected that prescribed antidepressants would be tasted prior to purchase so that a consumer, in conjunction with a physician, could distinguish one antidepressant from another on the basis of taste. Thus, the consumer, in making a purchasing decision involving either a prescribed medication or an over-the-counter medication, is unable to distinguish one pharmaceutical from another based on flavor. Consequently, it is difficult to fathom exactly how a flavor could function as a source indicator in the classic sense, unlike the situation with other nontraditional trademarks such as color, sound and smell, to which consumers may be exposed prior to purchase.

By contrast, the Trademark Office has registered a "sensory, touch mark," consisting of a "velvet textured covering on the surface of a bottle of wine." See Registration Number 3155702 (October 17, 2006).

Finally, with respect to sound marks, in an early decision, the T.T.A.B. refused a radio station's service mark application for "the sound made by a Ship's Bell Clock" consisting of "a series of bells tolled during the four, hour sequences, beginning with one ring at approximately a first half hour and increasing in number by one ring at approximately each half hour thereafter." In re General Electric Broadcasting Co., 199 U.S.P.Q. 560 (T.T.A.B.1978). The Examining Attorney claimed that the radio station "is doing no more than telling its listeners the time by broadcasting the traditional maritime bells ringing in the traditional maritime sequence," and as such, the sequence is not a service mark. General Electric Broadcasting asserted that the sequence of maritime bells ringing served as a mark and not merely as a time-telling mechanism. There were instances where the sound would be made two minutes before or after the actual hour or half hour, showing the use of the tones as identification rather than solely time-telling devices. The T.T.A.B. agreed that the Lanham Act takes a "flexible approach toward the concept of what constitutes a service mark or a trademark, a flexibility that is required in order to keep up with

A flavor's subjectivity derives principally from its complexity. Flavors consist of three elements: aroma, taste (sweet, acid, bitter, or saline), and feeling. Numerous factors influence taste acuity, among them age, disease, and, for certain tastes, temperature. In addition, one's taste perception varies with practice, increasing the subjectivity of this sense. Thus, because of the subjectivity of flavor perception, the risk of inconsistent results would be substantial if the PTO examined flavors for trademark protection, or if a flavor trademark owner sought to enforce his rights in court. (footnotes omitted).

the ever-changing ramifications brought about by ... changing technologies." Generally, sounds may act as trademarks "where they assume a definitive shape or arrangement and are used in such a manner so as to create in the bearer's mind association of the sound with a service." However, the T.T.A.B. found that different standards apply for registration of sound marks because:

... [U]nlike, the case of a trademark which is applied to the goods in such a manner as to create a visual and lasting impression upon a purchaser or prospective purchaser encountering the mark in the marketplace, a sound mark depends upon aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck.

The T.T.A.B. held that "arbitrary, unique or distinctive marks are registrable as such on the Principal Register without supportive evidence," but commonplace sounds can only be registered after a showing "that purchasers, prospective purchasers and listeners do recognize and associate the sound with services offered and/or rendered exclusively with a single, albeit anonymous, source." General Electric Broadcasting Co. had provided insufficient evidence to find that the sound mark had become distinctive of the radio station's services. By contrast, later efforts to register sound marks have proved more fruitful. AT&T has registered a sound mark consisting of the spoken letters "AT&T." The Harlem Globetrotters have registered the melody to the song "Sweet Georgia Brown" as a service mark. Intel recently registered the five note sequence "D flat, D flat, G, D flat, A flat" as a trademark for computer hardware.

A number of companies have registered cartoon characters as trademarks. See, e.g., Viacom International v. Komm, 46 U.S.P.Q.2d 1233 (T.T.A.B.1998) (Mighty Mouse). Courts have also given trademark or trademark-like protection to a broad array of non-traditional source designators ranging from the design of golf courses to performers' voices and likenesses under the rubric of false designation of origin. See infra, Chapters 7, 10, 12.

TRADEMARK ACTIONS BEFORE THE TRADEMARK TRIBUNALS AND BEFORE THE FEDERAL JUDICIAL COURTS

The previous note referred several times to the Trademark Trial and Appeal Board (T.T.A.B. or "Board"). This is a specialized body within the Patent and Trademark Office, an administrative agency. Claims arising out of trademark registration proceedings must first be brought before the T.T.A.B. If a Trademark Examiner has refused to register a mark, the applicant may appeal the refusal to the Board, 15 U.S.C. § 1070 (Lanham Act § 20). If this tribunal sustains the examiner's decision, the applicant may further appeal to the United States Court of Appeals for the Federal
Circuit (Fed. Cir.) or may have the Board’s decision reviewed by a federal district court, 15 U.S.C. § 1071(a) (federal circuit), (b) (district court) (Lanham Act § 21(a), (b)). Before creation of the Federal Circuit in 1982, a substantially equivalent appellate tribunal was known as the Court of Customs and Patent Appeals (C.C.P.A.).

If the Examiner accepts the mark, it is published in the “Official Gazette” of the Patent and Trademark Office. At this point, owners of trademarks who believe the mark proposed for registration is likely to be confused with their marks may initiate opposition proceedings before the T.T.A.B. 15 U.S.C. § 1067 (Lanham Act § 17). The Board’s decision may be appealed either to the Federal Circuit, or to any United States District Court that has jurisdiction over the parties. In addition, petitions to cancel a trademark registration, for example on the ground that the mark has become generic (see Chapter 5.A) or been abandoned (see Chapter 5.B), are brought to the T.T.A.B., whose decision may be appealed either to the Federal Circuit or to the appropriate U.S. District Court.

Trademark infringement actions may be initiated before federal district courts, if a federally registered mark is at issue or if the claim alleges a violation of Section 43 of the Lanham Act, a broad liability provision covering, inter alia, unregistered marks. In addition, federal courts hear state based trademark and unfair competition claims, either as claims joined to the federal trademark claim, see 28 U.S.C. § 1338(b), or, in the absence of a federal claim, pursuant to their diversity jurisdiction, if the amount in controversy exceeds $75,000, see 28 U.S.C. § 1332. Federal courts do not have exclusive jurisdiction over federal trademark infringement claims, unlike patent and copyright claims. See 28 U.S.C. § 1338(a). State courts therefore may also hear federal trademark infringement claims, as well as state based trademark and unfair competition claims.

As this summary indicates, the role of the Federal Circuit in trademark adjudication is far more limited than its role in patent adjudication. Not only does the Federal Circuit have exclusive jurisdiction over all appeals from patent tribunals, its exclusive jurisdiction also extends to all appeals of patent infringement decisions emanating from United States District Courts of general jurisdiction. Congress provided for the concentration of patent appeals in the Federal Circuit, and the elimination of appellate review by federal courts of general jurisdiction in the 1982 law creating the Court of Appeals for the Federal Circuit. Congress expressed concern that patent appeals to general federal appellate courts produced docket overload, discrepancy in legal doctrine, and conflict among the circuits. See S. Rep. No. 275, 97th Cong., 2d sess. 1–5 (1982). The Federal Circuit will also adjudicate a trademark appeal from a federal district court of general jurisdiction when the trademark claim was joined with a patent claim. Indeed, the Federal Circuit hears the trademark appeal even if the trademark claim is the only subject of the appeal. However, when the Federal Circuit hears a trademark appeal from a federal district court, the Federal Circuit does not rule on the basis of its own trademarks precedents, but applies the trademark law as developed in the circuit comprising the
district court. See, e.g., Cicena Ltd. v. Columbia Telecommunication Group, 900 F.2d 1546 (Fed.Cir.1990).

Should appeals of trademark infringement decisions also be restricted to the Federal Circuit? If not, why are general federal (or state) courts more competent to adjudicate trademark claims than patent claims?

B. DISTINCTIVENESS

1. ARBITRARY, FANCIFUL, SUGGESTIVE AND DESCRIPTIVE TERMS

Abercrombie & Fitch Co. v. Hunting World, Inc.
537 F.2d 4 (2d Cir.1976).

— FRIENDEL, Circuit Judge.

[Abercrombie & Fitch claimed trademark rights in SAFARI for a variety of clothing items and accessories. The trial court found the term failed to distinguish Abercrombie’s goods from other retailers’ similar apparel. The Second Circuit upheld the lower court with respect to certain items, notably hats, but reversed as to others, for example, shoes and boots.]

It will be useful at the outset to restate some basic principles of trademark law, which, although they should be familiar, tend to become lost in a welter of adjectives.

The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different one for another, because a term may shift from one category to another in light of differences in usage through time, because a term may have one meaning to one group of users and a different one to others, and because the same term may be put to different uses with respect to a single product. In various ways, all of these complications are involved in the instant case.

A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species. At

6. To take a familiar example, “Ivory” would be generic when used to describe a product made from the tusks of elephants but arbitrary as applied to soap.

7. See, e.g., Halter Elevator Co. v. Seeberger, 85 U.S.P.Q. 80 (1950), in which the coined word “Escalator,” originally fanciful, or at the very least suggestive, was held to have become generic.


common law neither those terms which were generic nor those which were merely descriptive could become valid trademarks, see Delaware & Hudson Canal Co. v. Clark, 80 U.S. (13 Wall.) 311, 323 (1872) (“Nor can a generic name, or a name merely descriptive of an article or its qualities, ingredients, or characteristics, be employed as a trademark and the exclusive use of it be entitled to legal protection’’). The same was true under the Trademark Act of 1905, Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446 (1911), except for marks which had been the subject of exclusive use for ten years prior to its enactment, 33 Stat. 726. While, as we shall see, ... the Lanham Act makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, see § 2(f), 15 U.S.C. § 1052(f), it offers no such exception for generic marks. The Act provides for the cancellation of a registered mark if at any time it “becomes the common descriptive name of an article or substance,” § 14(c).* This means that even proof of secondary meaning, by virtue of which some “merely descriptive” marks may be registered, cannot transform a generic term into a subject for trademark. As explained in J. Kohnstam, Ltd. v. Louis Marx and Company, 280 F.2d 437, 440 (C.C.P.A. 1960), no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name. See, accord, Application of Preformed Line Products Co., 323 F.2d 1007 (C.C.P.A. 1963); Weiss Noodle Co. v. Golden Cracknel and Specialty Co., 290 F.2d 845 (C.C.P.A. 1961); Application of Searle & Co., 360 F.2d 650 (C.C.P.A. 1966). We have recently had occasion to apply this doctrine of the impossibility of achieving trademark protection for a generic term, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11 (1975). The pervasiveness of the principle is illustrated by a series of well-known cases holding that when a suggestive or fanciful term has become generic as a result of a manufacturer’s own advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue. Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y.1921) (L. Hand, D.J.); DuPont Cellophone Co. v. Waxed Products Co., 85 F.2d 75 (2 Cir.) (A. N. Hand, C.J.), cert. denied, 299 U.S. 601 (1936); King-Seeley Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577 (2 Cir.1963). A term may thus be generic in one market and descriptive or suggestive or fanciful in another.

The term which is descriptive but not generic11 stands on a better basis. Although § 2(e) of the Lanham Act, 15 U.S.C. § 1052, forbids the

* Eds. note: After the 1988 amendments to the Lanham Act, § 14(3) provides for cancellation “at anytime if the registered mark becomes the generic name for the goods or services . . . .”

11. See, e.g., W. E. Bassett Co. v. Revlon, Inc., 435 F.2d 659 (2 Cir.1970). A commentator has illuminated the distinction with an example of the “Deep Bowl Spoon”:

“Deep Bowl” identifies a significant characteristic of the article. It is “merely descriptive” of the goods, because it informs one that they are deep in the bowl portion. . . . It is not, however, “the com-
registration of a mark which, when applied to the goods of the applicant, is "merely descriptive," § 2(f) removes a considerable part of the sting by providing that "except as expressly excluded in paragraphs (a)–(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce" and that the Commissioner may accept, as prima facie evidence that the mark has become distinctive, proof of substantially exclusive and continuous use of the mark applied to the applicant's goods for five years preceding the application. As indicated in the cases cited in the discussion of the unregistrability of generic terms, "common descriptive name," as used in §§ 14(c) and 15(4), refers to generic terms applied to products and not to terms that are "merely descriptive." In the former case any claim to an exclusive right must be denied since this in effect would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell. In the latter case the law strikes the balance, with respect to registration, between the hardships to a competitor in hampering the use of an appropriate word and those to the owner who, having invested money and energy to endow a word with the good will adhering to his enterprise, would be deprived of the fruits of his efforts.

The category of "suggestive" marks was spawned by the felt need to accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other— a need that was particularly acute because of the bar in the Trademark Act of 1965, 33 Stat. 724, 726, (with an exceedingly limited exception noted above) on the registration of merely descriptive marks regardless of proof of secondary meaning. See Orange Crush Co. v. California Crushed Fruit Co., 297 F. 392 (D.C.Cir.1924). Having created the category the courts have had great difficulty in defining it. Judge Learned Hand made the not very helpful statement:

It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends when suggestion ends and description begins.

Franklin Knitting Mills, Inc. v. Fashionitt Sweater Mills, Inc., 297 F. 247, 248 (2 Cir. 1923), aff’d per curiam, 4 F.2d 1018 (2 Cir.1925)—a statement amply confirmed by comparing the list of terms held suggestive with those held merely descriptive in 3 Callmann, Unfair Competition, Trademarks and Monopolies § 71.2 (3d ed.). Another court has observed, somewhat more usefully, that:

A term is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods. A descriptive name" of the article (since) the implement is not a deep bowl, it is a spoon. . . . "Spoon" is not merely descriptive of the article—it identifies the article—and therefore the term is generic.  

Fletcher, Actual Confusion as to Incontestability of Descriptive Marks, 64 Trademark Rep. 252, 260 (1974). On the other hand, "Deep Bowl" would be generic as to a deep bowl.
term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.

Stix Products, Inc. v. United Merchants & Manufacturers, Inc., 295 F. Supp. 479, 488 (S.D.N.Y.1968)—a formulation deriving from General Shoe Corp. v. Rosen, 111 F.2d 95, 98 (4 Cir.1940). Also useful is the approach taken by this court in Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp., 259 F.2d 314 (2 Cir.1958), that the reason for restricting the protection accorded descriptive terms, namely the undesirability of preventing an entrant from using a descriptive term for his product, is much less forceful when the trademark is a suggestive word since, as Judge Lumbard wrote, 259 F.2d at 317:

"The English language has a wealth of synonyms and related words with which to describe the qualities which manufacturers may wish to claim for their products and the ingenuity of the public relations profession supplies new words and slogans as they are needed.

If a term is suggestive, it is entitled to registration without proof of secondary meaning. Moreover, as held in the Season—All case, the decision of the Patent Office to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is suggestive or arbitrary or fanciful rather than merely descriptive.

It need hardly be added that fanciful or arbitrary terms12 enjoy all the rights accorded to suggestive terms as marks—without the need of debating whether the term is "merely descriptive" and with ease of establishing infringement.

In the light of these principles we must proceed to a decision of this case.

"TECHNICAL TRADEMARKS"

Arbitrary, fanciful and suggestive marks are sometimes called "technical trademarks." As discussed in Abercrombie, supra, these marks may be registered without proof of "secondary meaning," that is, without demonstration that the public in fact recognizes these terms or symbols as indications of the source of the goods or services. On secondary meaning, see infra, section B.2.

One might inquire why technical trademarks are endowed with trademark significance ab initio. Why should the proprietor of a term used in the marketplace, once she has shown the term to be arbitrary, fanciful, or suggestive, not be required to make a further showing that the term, as

12. As terms of art, the distinctions between suggestive terms and fanciful or arbitrary terms may seem needlessly artificial. Of course, a common word may be used in a fanciful sense; indeed one might say that only a common word can be so used, since a coined word cannot first be put to a bizarre use. Nevertheless, the term "fanciful" as a classifying concept, is usually applied to words invented solely for their use as trademarks. When the same legal consequences attach to a common word, i.e., when it is applied in an unfamiliar way, the use is called "arbitrary."
used, has developed a public following? Several considerations favor the rule conferring immediate trademark status on arbitrary, fanciful or suggestive terms. First, the nature of the term indicates that the public will inevitably perceive it as a trademark. We expect the public to conclude that a non-descriptive term associated with goods or services (e.g., CREST toothpaste; CENTURY 21 real estate services) is intended to designate source. Second, one provider's appropriation of a non-descriptive term for use as a trademark does not disable competitors from describing their goods or services. The first user has not depleted the language of terms useful or necessary to the provision of information about the goods or services.

Third, and for many most importantly, first users, and potential competitors, require certainty regarding the trademark status of the term. If the term is inherently distinctive, and therefore not necessary for competition, the value of certainty outweighs whatever additional safeguard proof of actual source association might provide. As Judge Learned Hand observed in *Waldes v. International Mfrs. Agency, Inc.*, 237 F. 502, 505 (S.D.N.Y.1916), given a technical trademark, "it is the priority of use alone that controls, even though, when the defendant comes into the field, [the mark] may not be fully established, or may not even be enough established to have associated largely in the public mind with the plaintiff's make. Were it not so, it would be of extreme difficulty to show at just what point in time the mark became associated with the maker in enough of his customers' minds to justify the inference that the defendant's use might have become confusing. Therefore, once his use begins, the rest of the public must avoid his fanciful mark."

Are Judge Hand's observations persuasive? Does it make a difference that, at the time of the *Waldes* decision, technical trademarks included arbitrary and fanciful terms, but not suggestive terms?

**In The Matter of the Application of Quik-Print Copy Shops, Inc.**

616 F.2d 523 (C.C.P.A.1980).

**MILLER, J:**

The only issue before the board was the correctness of the examiner's refusal to register under section 2(e)(1) of the Lanham Act on the ground that the mark as applied to the stated services is merely descriptive thereof. The board, in affirming the examiner, said (203 U.S.P.Q. at 627):

In the instant case, applicant is claiming use of the mark "QUIK-PRINT" for printing and duplication, which falls within the general category of "printing" [See: "The Random House College Dictionary"]. Thus, the question is what meaning, if any, does the term "QUIK-PRINT" invoke as to these services. There is no doubt but that "QUIK-PRINT" is the equivalent of "QUICK-
PRINT” and would be readily recognized as such, the word “QUICK” obviously would be equated with fast and promptly and when used with the word “PRINT” would immediately convey to customers that applicant’s printing or duplication services will be rendered or completed in a short time or quickly. And since the “SAME DAY SERVICE” offered by applicant through its advertising material emphasizes this quick service and attempts thereby to capitalize on it, it is obvious this is a desirable service and a desirable aspect of applicant’s services that is conveyed to applicant’s customers and potential customers by the term “QUIK-PRINT”. Thus, “QUIK-PRINT” is equated with “FAST-PRINT” and therefore constitutes a term that others in the trade should be free to utilize in describing the speed in which they render their services. The aptness or desirability of the use of this term is demonstrated by the some twenty users of the same or a similar mark in connection with similar services noted by applicant in its application. Applicant has attempted to demigrate such use by urging that such use, as in its case, merely reflects a suggestive use of the term. However, it is believed that the widespread use of the term “QUIK-PRINT” throughout the United States by others including a number in the same state tends to establish that the term has lost whatever suggestiveness it may have possessed and has taken on and projects a descriptive significance of quick or fast printing services to the general public.

The board further said that a registration on the supplemental register of QUIK PRINT, along with the other registrations of record, indicates that the practice of the PTO is to treat QUIK-PRINT as merely descriptive and to allow registration on the principal register only after a showing of secondary meaning under section 2(f) of the Lanham Act. It found “nothing in this record to establish that applicant has achieved a recognition or a secondary meaning in the mark ‘QUIK-PRINT’ in its marketing area.” 203 U.S.P.Q. at 627.

OPINION

A mark is merely descriptive if it immediately conveys to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used; whereas, a mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services. In re Abcoor Development Corp., 588 F.2d 811, 813–14, 200 U.S.P.Q. 215, 217–18 (CCPA 1979). Registration will be denied if a mark is merely descriptive of any of the goods or services for which registration is sought. In re American Society of Clinical Pathologists, 58 CCPA 1240, 442 F.2d 1404, 169 U.S.P.Q. 800 (1971). Therefore, the dispositive question is whether the mark QUIK-PRINT is merely descriptive of any of appellant’s services.

Appellant argues that although the words “quick” and “print” used individually are well-known, mundane words useful to the trade, the term QUIK-PRINT is a fanciful and distinctive term not ordinarily usable in the
trade to describe any quality, characteristic, or ingredient of the service; that, at most, the mark suggests to the consumer, after perception and analysis, that appellant can perform printing services within a short period of time; and that the board’s use of perception, logical analysis, and mental gymnastics to prove that QUIK-PRINT is merely descriptive actually demonstrates that the mark is suggestive.

We do not agree. One of the services provided by appellant is printing. Clearly the term “QUIK” describes one of the qualities or characteristics of this service, namely: the speed with which it is done. Such speed is emphasized in appellant’s advertising brochure, which offers a “SAME-DAY SERVICE.” Because this quality or characteristic of appellant’s service comes immediately to mind, we are satisfied that the mark QUIK-PRINT is merely descriptive. The board, contrary to appellant’s argument, did not make use of perception, logical analysis, and mental gymnastics to prove that QUIK-PRINT is merely descriptive. Rather, it set forth a reasonable explanation in support of its finding that QUIK-PRINT would immediately convey knowledge of the essential character of appellant’s service.

The decision of the board is affirmed.

In re Oppedahl & Larson, 373 F.3d 1171 (Fed. Cir. 2004). In affirming the refusal to register “patents.com” for software that tracks patent records, the court nonetheless rejected the contention that the addition of the “.com” suffix made the composite term inherently distinctive.

The PTO ... argue[s] that “.com” possesses no source-identifying characteristics just as “Co.” and “Corp.” did not affect registrability in Goodyear’s Rubber Manufacturing Co. v. Goodyear Rubber Co., 128 U.S. 598, 602, 32 L. Ed. 535, 9 S. Ct. 166, 1889 Dec. Comm’r Pat. 257 (1889) ... which held that adding terms such as “Corp.,” “Inc.,” and “Co.” to a generic term does not add any trademark significance to an otherwise unregistrable mark.... Although not a perfect analogy, the comparison of TLDs (i.e., “.com,” “.org,” etc.) to entity designations such as “Corp.” and “Inc.” has merit. The commercial impression created by “.com” is similar to the impression created by “Corp.” and “Co.,” that is, the association of a commercial entity with the TLDs, however, can convey more than simply the organizational structure of the entity that uses the mark. For example, TLDs immediately suggest a relationship to the Internet. Thus, the per se rule in Goodyear that “Corp.” etc. never possess source-indicating significance does not operate as a per se rule, but more as a general rule, with respect to TLDs.

Appellant offers [a] hypothetical, Amazon.com, to argue that the addition of “.com” will generally, if not always, add source-identifying significance. According to appellant, saying the word “Amazon” to a person on the street may conjure images of a river or a fierce female warrior. In the hypothetical, however, the entire mark Amazon.com changes the impression to invoke an online retailer. This hypothetical,
however, has a serious flaw in the context of this case. The Board must, of course, determine the commercial impression of a mark in the proper context of the goods or services associated with that mark. In its proper context, appellant's proposed hypothetical yields a different result. In context, appellant's hypothetical would state, "I bought this book from Amazon," and "I bought this book from Amazon.com." In that setting, the addition of ".com" adds no source-identifying significance, which is likely to be the case in all but the most exceptional case.

The "Amazon" hypothetical also illustrates another principle that the Board properly recognized, namely that TLD marks may obtain registration upon a showing of distinctiveness. Thus Amazon.com may well denote the source of services of an on-line retailer (rather than a used car dealer or some other association) because the mark has acquired that secondary meaning. The Board properly left that door open for this patents.com mark as well.

... [T]his court declines to adopt a per se rule that would extend trademark protection to all Internet domain names regardless of their use. Trademark law requires evaluation of a proposed mark to ascertain the commercial impression conveyed in light of the goods or services associated with the mark, not a simple check for ownership of an Internet address.

Appellant's goods include patent tracking software by means of the Internet. The term patents.com merely describes patent-related goods in connection with the Internet. The two terms combined do not create a different impression. Rather, the addition of ".com" to the term "patents" only strengthens the descriptiveness of the mark in light of the designation of goods in the application...

As the Abercrombie court indicated, a term's distinctiveness depends on its context. Consider the following example. Labrador Software claimed trademark rights in the term "Labrador" for search engines, contending that the term was inherently distinctive. The product had not been marketed long enough to have acquired secondary meaning at the time that Labrador Software brought its infringement action against Lycos, who was using the image of a black Labrador dog for its rival search engine service. In Labrador Software, Inc. v. Lycos, Inc., 32 F.Supp.2d 31 (D.Mass.1999), the court observed:

Under an abstract comparison of marks to product, a few of Plaintiff's marks appear, at first blush, to be suggestive. For example, without additional information, a consumer would likely have to use some imagination to conclude that the mark "LABRADOR" refers to a computer intranet service company.

The events giving rise to this lawsuit did not occur in a vacuum, however. Defendant proffers evidence showing that several other
internet-related companies use (1) the word “retrieve,” or some derivative thereof; and (2) images of Labrador dogs (or other dogs), in connection with their product/service. The proliferation of marks identical or similar to Plaintiff’s marks in the internet industry indicates that Plaintiff’s marks are descriptive, rather than suggestive. See, e.g., Calamari [Fisheries Inc. v. The Village Catch, Inc.], 698 F.Supp. 994 ([D.Mass.1988]) at 1008 (“In determining whether a particular word has a descriptive or suggestive significance as applied to a field of merchandise or service, it is proper to take notice of the extent to which it has been used in trademarks by others in the same field.”); 2 J. Thomas McCarthy, McCarthy ON TRADEMARKS AND UNFAIR COMPETITION § 11:69 (4th ed. 1996) (“If others are in fact using the term to describe their products, an inference of descriptiveness can be drawn.”).


QUESTIONS

1. The Abercrombie decision supplies an often quoted enumeration and description of the four categories of terms in trademark law. Are you satisfied with the court’s elaboration? What does the court mean when it denominates a generic term as “referring to the genus of which the

2. Defendant provided exhibits of the following products/services: (1) “Bess, Internet retriever for kids, families, and schools,” (words quoted from web page), whose web page includes a large picture of what appears to be a chocolate Labrador dog; (2) “Retrieve It!,” an internet search product from Macintosh whose web page includes a small picture of what appears to be a golden Labrador dog next to the words “Retrieve It!”; (3) “Black Lab Micro,” a computer equipment seller/lessor whose web page includes a small picture of an indeterminate breed of dog, and two larger pictures of dog paws; (4) “SuperDog,” a product designed to commerce-enable web sites, whose web page includes a large picture of what appears to be the head of a chocolate Labrador dog next to the name “SuperDog;” (5) “Nethound,” a catalog of internet resources for a limited geographic area whose web page includes three pictures of a dog of indeterminate breed, plus pictures of a dog paw and a bone; (6) “Retriever!,” an internet sales tool whose web page includes a picture of a black dog of indeterminate breed next to the word “Retriever;” (7) “Retriever,” a computer file searcher whose web page includes a picture of a yellow dog next to the product name; (8) “Retriever” and “Retriever Reader,” two products designed to facilitate internet downloading, whose web site includes the product names; (9) “Retriever for Windows 95/98/NT,” a product designed to download files from the internet, whose web page includes two pictures of dogs of indeterminate breed; (10) “Retriever communications,” an Australian mobile applications service provider whose web site includes pictures of what appear to be black dogs.

3. Evidence that numerous other internet-related companies use similar or identical marks is highly useful, given that “[t]he line between descriptive and suggestive terms is often blurred, and [that] the categorization of a name as ‘descriptive’ or ‘suggestive’ is frequently ‘made on an intuitive basis’ rather than as a result of a logical analysis susceptible of articulation.” Calamari, 698 F.Supp. at 1008.
International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.
846 F.2d 1079 (7th Cir.1988).

Coffey, Circuit Judge:

Plaintiff-appellee International Kennel Club of Chicago, Inc. (“IKC”), brought this action against the defendants-appellants Mighty Star, Inc. (“Mighty Star”) and DCN Industries, Inc. (“DCN”), alleging that the defendants’ use of the plaintiff’s “International Kennel Club” name violates section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), as well as state statutory and common law. The district court granted the plaintiff’s motion for a preliminary injunction against the defendants’ use of the name. The defendants appeal. We affirm in part, reverse in part, and remand.

I.

A. Plaintiff’s use of the “International Kennel Club” name

The IKC is an Illinois business corporation that sponsors dog shows in Chicago, and is a “show giving member club” of the American Kennel Club
("AKC"), a nationwide organization devoted to furthering the "sport" of showing purebred dogs. In addition to giving dog shows, the IKC serves as an information source for AKC activities in Chicago and provides assistance in the pedigree registration of purebred dogs with the AKC.

The IKC sponsors two major dog shows each year, with the annual spring show having an attendance of between 20,000 to 30,000 people. An average of 1,500 to 2,000 dogs are entered in plaintiff's shows, and for the spring 1986 show, entries came from 36 different states and various Canadian provinces. Persons who attend the plaintiff's shows are often interested in canine-related paraphernalia. While the IKC does not sell such items, private vendors rent booth space at plaintiff's shows at prices ranging from $600 to $800 per booth and sell dog-related items, including stuffed dogs. In 1985 and 1986, the annual revenue from the rental of booth space averaged $60,000.

In an effort to promote its activities, the IKC spent approximately $60,000 of its total revenue of $231,226 for fiscal year 1986 to hire a full-time staff person to handle the advertising of the dog shows and public relations. The paid advertising of the IKC, consisting of advertisements in magazines with a nationwide circulation such as the American Kennel Club Gazette and Dog World Magazine, as well as advertisements in the Chicago-area media, is primarily designed to reach canine enthusiasts (the dog "fancy" in trade parlance). The activities of the IKC have also been covered in a variety of national and local publications.

B. Defendant's decision to market toy dogs under the name "International Kennel Club"

For almost three decades, defendants DCN and its wholly-owned subsidiary Mighty Star have sold stuffed toys in the United States, Canada, England, Australia and Asia... In the later part of 1985, the defendants decided to add to their product line of stuffed animals a line of stuffed "pedigreed" dogs representing different breeds. The defendants state that at the time they had never heard of the plaintiff, and that they chose the name "International Kennel Club" in part because of the international scope of their business, and also because the products were toy dogs. The defendants utilized a marketing strategy whereby purchasers could "register" their dogs with the "International Kennel Club" and receive an "official International Kennel Club membership and pedigree certificate."

Part of the defendants' registration strategy was to emphasize that the stuffed canines represent breeds "sanctioned by the International Kennel Club."... Defendants' in-store advertising included plaques, buttons and

2. For instance, the IKC points to a poll conducted by Kennel Review Magazine, listing the International Kennel Club's show as one of the best in the country. A review of the plaintiff's activities between 1936 and 1984 in Kennel Review Magazine concluded that: "The International Kennel Club, after forty-five years, still remains a show of prestige and education and still follows the original premise-that is to provide a showcase for the best of purebred dogs." The editor of Kennel Review also commented that "the International Kennel Club has long been a prestigious event, but in the last few years it has really put forth effort to become one of the most important events of the year."
counter displays, all of which referred to the "International Kennel Club Center," the "International Kennel Club," or the "IKC"……

After choosing the IKC name for its line of toy dogs, Mighty Star’s counsel conducted a search of trade directories in major cities as well as a search of federally registered trademarks. The search disclosed two telephone directory listings in Chicago—one for "International Kennel" and one for the "International Kennel Club of Chicago." Nevertheless, counsel advised the defendants that the use of the International Kennel Club name would not infringe upon the plaintiff’s name given the local scope of the plaintiff’s operations and the fact that the plaintiff did not directly compete with Mighty Star or DCN. Thus, the defendants proceeded to market their line of stuffed dogs under that name without contacting the plaintiff to determine if the use of the International Kennel Club name would present a problem of infringement.

C. Evidence of confusion allegedly caused by the marketing of the defendants’ toy dogs under the "International Kennel Club" name

In late March 1986—six months after learning of the plaintiff’s existence—the defendants placed a full-page advertisement for their line of stuffed dogs in the April edition of the Good Housekeeping magazine. This advertisement was followed by ads in the June issues of Better Homes and Gardens, Vogue, and Cosmopolitan magazines that reached the public in mid-May. Following the publication of these ads, IKC officials began receiving telephone calls (at a rate of about one per day), letters, and personal inquiries from people expressing confusion as to the plaintiff’s relationship to the International Kennel Club stuffed dogs……

The IKC learned of the defendants’ line of International Kennel Club toys at the plaintiff’s spring dog show on March 29 through 30, 1986. Mr. Auslander, the Secretary and Treasurer of the IKC, testified that a vendor at the show brought one of the defendants’ ads to his attention, and asked "why I was involved or why our club was involved in a venture of that type." Thereafter, in early April, the IKC began to receive letters of inquiry concerning the defendants’ toy canines … [one of which was from a vendor who expressed concern that the plaintiff’s apparent selling of toy dogs] “conflicts with the stated aims of your involvement as a purebred dog club.” The defendants’ Executive Vice-President Sheldon Bernstein testified that neither Mighty Star nor DCN received any letters indicating confusion as to their relationship with the plaintiff.

After the plaintiff’s spring 1986 dog show, Mr. Auslander attended between 15 and 20 other dog shows throughout the country during 1986. Auslander testified that at about half of these shows—including the shows in Florida, Wisconsin, Nebraska, Colorado, Massachusetts, California and Illinois—he was questioned about the relationship between the IKC and Mighty Star’s toy dogs. Auslander further recounted that members of the board of directors of the American Kennel Club consulted him, expressing concern that the International Kennel Club might be involved in their sale…… Thereafter, at the request of the American Kennel Club, the
plaintiff placed an ad disclaiming any relationship to the defendants' toys in the July issue of the American Kennel Club Gazette.

D. **Plaintiff files suit and moves for a preliminary injunction**

Confronted with the complaints and inquiries noted above, the IKC filed the instant trademark infringement action on May 23, 1986, and simultaneously filed a motion to preliminarily enjoin Mighty Star and DCN's use of the International Kennel Club name. In response to the lawsuit, the defendants cancelled almost all of their advertising of the products bearing the plaintiff's name. One of the defendants' advertisements—placed in the September issue of Good Housekeeping—used the International Kennel Club name but contained a disclaimer of any relationship to the plaintiff's dog shows. This was the last advertisement that DCN and Mighty Star placed for their line of toy canines.

On July 14–16, 1986, the trial court held a hearing on the plaintiff's motion for injunctive relief and on July 21, 1986, ruled from the bench that the plaintiff was entitled to a preliminary injunction.

II.

A. **Likelihood of success on the merits**

In order to prevail in its action under section 43(a) of the Lanham Act, the IKC must establish: (1) that it has a protectable trademark, and (2) a "likelihood of confusion" as to the origin of the defendant's product. [Citations omitted].

The first step in determining whether an unregistered mark or name is entitled to the protection of the trademark laws is to categorize the name according to the nature of the term itself. Trademarks that are fanciful, arbitrary [i.e. made-up terms like "Kodak"] or suggestive are fully protected, while "descriptive words (e.g. 'bubbly' champagne) may be trademarked only if they have acquired secondary meaning, that is, only if most consumers have come to think of the word not as descriptive at all but as the name of the product." *Blau Plumbing, Inc. v. SOS Fix-It, Inc.*, 781 F.2d 604, 609 (7th Cir.1986). Hence, although a term's "primary" meaning is merely descriptive, if through use the public has come to identify the term with a plaintiff's product or service, the words have acquired a "secondary meaning" and would become a protectable trademark. *Gimix, Inc. v. J S & A Group, Inc.*, 699 F.2d 901, 907 (7th Cir.1983); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir.1977), cert. denied, 434 U.S. 1025, 54 L. Ed. 2d 772, 98 S. Ct. 751 (1978). In other words, " secondary meaning" denotes an association in the mind of the consumer between the trade dress [or name] of a product and a particular producer." *Vaughan Manufacturing Co. v. Briham Intern., Inc.*, 814 F.2d 346, 348 (7th Cir.1987). We agree with the district court that the phrase "International Kennel Club" fits within the category of descriptive words in that it "specifically describes a characteristic or ingredient of an
article [or service]." Miller Brewing Co., 561 F.2d at 79. Thus, the "International Kennel Club" name is entitled to trademark protection only if the name has acquired "secondary meaning," i.e. has become distinctive of the plaintiff's goods and/or services.

The defendants claim that the plaintiff's evidence introduced at the preliminary injunction hearing is insufficient to demonstrate that the plaintiff has better than a negligible chance of establishing that the "International Kennel Club" name acquired secondary meaning among the consuming public. "The factors which this court has indicated it will consider on the issue of secondary meaning include 'the amount and manner of advertising, volume of sales, the length and manner of use, direct consumer testimony, and consumer surveys.'" Gimix, Inc., 699 F.2d at 907 (quoting Union Carbide Corp. v. Ever-ready, Inc., 531 F.2d 366, 380 (7th Cir.), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91 (1976)). Consumer testimony and consumer surveys are the only direct evidence on this question ... the other factors are relevant in a more circumstantial fashion." Id. Not surprisingly, the defendants attack the absence of a consumer survey in the evidence produced by the plaintiff at the preliminary injunction hearing.

Despite this attack, we are not persuaded that the absence of a consumer survey is per se fatal to the plaintiff's request for a preliminary injunction. As noted previously, the trial court merely granted a preliminary injunction; it did not decide the case on the merits after allowing for full discovery. The IKC may be in a better position to produce a survey at a full trial on the merits. Thus, while the lack of survey evidence fails to support the plaintiff's request for preliminary relief, we are convinced that it does not necessarily destroy the plaintiff's entitlement to that relief....

The remaining factors articulated in Gimix as material to the issue of secondary meaning weigh in favor of the trial court's conclusion that the International Kennel Club of Chicago "has acquired a secondary meaning like that among a small but very well-defined group of people in Chicago and elsewhere." In particular, the "amount and manner of advertising" and the "length and manner of use" of the International Kennel Club name yields a better than negligible chance of establishing secondary meaning. With respect to advertising, the plaintiff introduced evidence supporting the inference that the International Kennel Club has developed and maintained its reputation among canine enthusiasts through advertising carefully targeted to reach persons interested in the sport of showing purebred dogs. It has advertised in publications with a continent-wide circulation that are of interest to dog fanciers, including the American Kennel Club Gazette, Kennel Review, and Dog World. And because its shows are held in Chicago, the plaintiff advertises in regional publications of a more general appeal, including the major Chicago newspapers and magazines, as well as various local periodicals. Moreover, the plaintiff mails out as many as 15,000 "premium lists" prior to each show to persons on its mailing lists, and also employs a full-time public relations professional. In its most recent fiscal year, these advertising and public relations expenses
have amounted to almost $60,000, or more than 42 percent of the club’s total administrative and operating expenses. Viewed another way, these expenses come to more than 25 percent of the club’s total revenues; further, the club’s activities are often given extensive free publicity. As an example, both major Chicago newspapers have highlighted the plaintiff’s dog shows and have designed and promoted special advertising supplements around those columns.

As evidence of secondary meaning, the International Kennel Club also introduced evidence that the club received a number and a variety of letters and phone calls asking about the defendants’ toy dogs. The correspondence directed to the plaintiff provides support for the inference that when dog fanciers see the “International Kennel Club” name, they think of the plaintiff. Finally, the plaintiff has operated under and advertised the “International Kennel Club” name continuously for over 50 years. In our view, the club’s half-century use of the name, combined with their advertising, substantial free publicity, and wide-ranging activities in support of dog groups, clearly renders the plaintiff’s chances of establishing that the International Kennel Club name has acquired secondary meaning better than negligible.

... 

CUDARY, CIRCUIT JUDGE, dissenting:

This seems to me a strange case of trademark infringement where likelihood of success on the merits and irreparable harm to the plaintiff are both exceedingly unclear. And the majority’s rather selective statement of the facts does little to clarify the picture.

There is a loss to society in permitting one user to appropriate a descriptive term to the exclusion of others through the establishment of “secondary meaning.” See R. Calhmann, 3 The Law of Unfair Competition Trademarks and Monopolies § 19.29, at 109 (1983). Courts should therefore be adequately demanding in setting secondary meaning standards before issuing injunctions in aid of such appropriations.

In the present case, the majority finds that the plaintiff, “International Kennel Club of Chicago,” had “better than a negligible chance” of showing that its name has acquired a secondary meaning by virtue of its use for many years, its advertising of semi-annual dog shows directed to a limited group of dog enthusiasts and its maintenance of a 15,000-person mailing list. The plaintiff spent less than $60,000 on advertising and public relations last year. Here the demands on the plaintiff have been so minimal that in the future almost anything will be susceptible to being claimed under the secondary meaning rubric.

The likelihood of confusion is equally uncertain. The plaintiff, a sponsor of live dog shows in Chicago, seeks to enjoin a national manufacturer of stuffed toy dogs. The plaintiff does not manufacture or distribute toy dogs, or goods of any kind. The closest the plaintiff comes to stuffed dogs is to rent booth space at its shows to merchants who may sell them along with a variety of other dog-related items. Thus, although the defen-
dant's mark bears a high degree of similarity to the plaintiff's name, their respective products and services do not compete and are related only by their connection to the broad theme of "dogs." Further, evidence of actual consumer confusion about the origin of the toy dogs is, in the words of the district court, "hardly overwhelming."

The plaintiff has not suggested any economic harm it may be suffering as a result of confusion with the defendant's operation. There is no complaint, for example, of diminishing participation, by either dog breeders or vendors, in its dog shows. And evidence of potential harm to its reputation seems to center on a few letters and conversations inquiring into its connection with defendant's sales campaigns. The plaintiff alleges in effect that the inquiries are mildly embarrassing (or perhaps gently demeaning) because they taint it with commercialism. It is surely not clear to me, however, how any real harm is being done. In contrast, the defendant has expended hundreds of thousands of dollars advertising its line of stuffed dogs and thus will suffer considerable economic harm from this injunction.

To establish secondary meaning (and the right to appropriate descriptive terms from the public domain) it should be requisite either to show substantial expenditures for advertising—a real investment in the claimed secondary meaning—or actual evidence that consumers associate the descriptive term with the product or service, or both. In lieu of consumer surveys, letters or conversations might be acceptable if genuinely relevant and produced in sufficient volume. Here none of these paths has been followed in any kind of persuasive way. We are thus blazing an uncertain trail, which may allow prior users of the most descriptive of terms to win wide-ranging injunctions with only nominal showings of either harm or confusion. If this case can be a winner, it is difficult to imagine one that could lose.

Restatement (Third) of Unfair Competition*

§ 13. DISTINCTIVENESS; SECONDARY MEANING

A word, name, symbol, device, or other designation, or a combination of such designations, is "distinctive" under the rules stated in §§ 9–12 if:

(a) the designation is "inherently distinctive," in that, because of the nature of the designation and the context in which it is used, prospective purchasers are likely to perceive it as a designation that, in the case of a trademark, identifies goods or services produced or sponsored by a particular person, whether known or anonymous, or in the case of a trade name, identifies the business or other enterprise of a particular person, whether known or anonymous, or in the case of a collective mark, identifies members of the collective group or goods or services produced or sponsored by members, or in the case of a certification mark, identifies the certified goods or services; or

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(b) the designation, although not "inherently distinctive," has become distinctive, in that, as a result of its use, prospective purchasers have come to perceive it as a designation that identifies goods, services, businesses, or members in the manner described in Subsection (a). Such acquired distinctiveness is commonly referred to as "secondary meaning."

Comment:

e. Secondary meaning. A designation that is not inherently distinctive, such as a word that describes the nature of the product on which appears, nevertheless may become, as a result of its use by a specific person, uniquely associated with that person’s goods, services, or business. Such acquired distinctiveness is called "secondary meaning." Secondary meaning does not connote a subordinate or rare meaning. It refers instead to a subsequent significance added to the original meaning of the term. Secondary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a particular kind of good, service, or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous entity. The concept of secondary meaning is also applicable to designations such as graphic designs, symbols, packaging features, and product design. In these contexts, secondary meaning denotes that the feature, although not inherently distinctive, has come through use to be uniquely associated with a particular source. A designation that has acquired secondary meaning thus distinguishes the goods, services, or business of one person from those of others.

When a designation has become distinctive through the acquisition of secondary meaning, it is protected under the same principles applicable to inherently distinctive designations. Protection extends, however, only to the secondary meaning that has attached to the designation. The trademark owner acquires no exclusive right to the use of the term in its original, lexicographic sense.

Rock & Roll Hall of Fame and Museum v. Gentile Productions
134 F.3d 749 (6th Cir. 1998).

Ryan, Circuit Judge:

I.

In 1986, The Rock and Roll Hall of Fame Foundation registered the words, "THE ROCK AND ROLL HALL OF FAME," as its service mark, on the principal register at the United States Patent and Trademark Office. In 1991, the Foundation commissioned I.M. Pei, a world famous architect, to design a facility for The Rock and Roll Hall of Fame and Museum in Cleveland, Ohio. Pei’s design was brought to life on the edge of Lake Erie,
in the form of The Rock and Roll Hall of Fame and Museum which opened in September 1995.

The Museum states that its building design is "a unique and inherently distinctive symbol of the freedom, youthful energy, rebellion and movement of rock and roll music." Whatever its symbolism, there can be no doubt that the Museum's design is unique and distinctive. The front of the Museum is dominated by a large, reclining, triangular facade of steel and glass, while the rear of the building, which extends out over Lake Erie, is a striking combination of interconnected and unusually shaped, white buildings. On May 3, 1996, the State of Ohio approved the registration of the Museum's building design for trademark and service-mark purposes. The Museum has similar applications pending with the United States Patent and Trademark Office.

Charles Gentile is a professional photographer whose work is marketed and distributed through Gentile Productions. In the spring of 1996, Gentile began to sell, for $40 to $50, a poster featuring a photograph of the Museum against a colorful sunset. The photograph is framed by a black border. In gold lettering in the border underneath the photograph, the words, "ROCK N' ROLL HALL OF FAME," appear above the smaller, but elongated word, "CLEVELAND." Gentile's signature appears in small blue print beneath the picture of the building. Along the right-hand side of the photograph, in very fine print, is the following explanation: "(C)1996 Gentile Productions ... Photographed by: Charles M. Gentile; Design:
In reaction to Gentile's poster, the Museum filed a five-count complaint against Gentile in the district court. The Museum's complaint contends that the Museum has used both its registered service mark, "THE ROCK AND ROLL HALL OF FAME," and its building design as trademarks, and that Gentile's poster infringes upon, dilutes, and unfairstly competes with these marks. The Museum's somewhat unusual claim regarding its building design, then, are quite unlike a claim to a service mark right in a building design that might be asserted to prevent the construction of a confusingly similar building.

The Museum submitted several exhibits in support of its motion. Of particular concern in the present dispute is a poster the Museum sells for $20. Although the Museum's poster, like Gentile's, features a photograph of the Museum at sunset, the photographs of the building in the two posters are very different. Gentile's photograph is a ground-level, close-up view of the Museum taken at a time when the building appears to be closed. It is an artistically appealing photograph of the Museum and virtually nothing else. In contrast, the Museum's poster features a photograph of the Museum, taken from an elevated and considerably more distant vantage point, on the Museum's opening night, when red carpet stretched from the Museum's front doors, and interior lights highlighted its dramatic glass facade. There is a great deal of detail in the foreground of the Museum's photograph including the full esplanade in front of the building, and even a portion of the highway adjacent to the property. It, too, is an artistically pleasing photograph of the Museum and its surrounding environment, but it is a very different picture than Gentile's.

The Museum's poster is framed by a white border, in which the words, "The Rock and Roll Hall of Fame and Museum—Cleveland," appear beneath the photograph. To the left of these words is a small circular designation, which appears to be a trademark (the "composite mark"). In the center of this composite mark is a triangle formed by six lines fanning out from a single point. The triangle is intersected by three horizontal lines, contains two dots running vertically, and may be intended to be evocative of the Museum's building design. In a circle around this triangular design are the words, "ROCK AND ROLL HALL OF FAME & MUSEUM."

In addition to the parties' posters, the record on appeal contains color copies of photographs of several items produced by the Museum; specifically, an advertisement for the Museum's opening, a paper weight, several postcards, and two T-shirts. One postcard features the same photograph which appears in the Museum's poster, one features a photograph of the rear of the Museum, and the third features six different close-up photographs of various parts of the Museum. One of the T-shirts bears a detailed drawing of the front of the Museum, a small drawing of the back of the
Museum, the composite mark, and the words, "The house that rock built." The other T-shirt features a similar drawing of the front of the Museum, set in front of several other buildings, and the words "Cleveland: Home of the Rock and Roll Hall of Fame + Museum." The paperweight is a "snow dome" that contains a three-dimensional rendition of the Museum, and bears the words, "Rock and Roll Hall of Fame," on its base. The advertisement for the opening night concert features a man reaching skyward with one of the Museum’s paperweights. The composite mark appears on the bottom of the advertisement, and the triangular design from that mark appears on the left breast of the man holding the paperweight.

On May 30, 1996, the district court concluded that the Museum had "shown a likelihood of success in proving its federal and state claims," and it granted the Museum’s motion for a preliminary injunction. Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Prods., 934 F. Supp. 868, 872–73 (N.D.Ohio 1996). The district court explained, inter alia, that "as a result of the extensive advertising and promotional activities involving the Museum's "ROCK AND ROLL HALL OF FAME" and building design trademarks, the public has come to recognize these trademarks as being connected with or sold by the Museum, its official licensees and/or official sponsors."

Id. at 871. The district court found that the Museum’s building design was a fanciful mark, and that Gentile’s use of the Museum’s building design and the words, "ROCK N’ ROLL HALL OF FAME," was likely to cause confusion. Id. at 871–72. It then determined that the balance of equities favored granting the injunction, and it ordered Gentile to refrain from further infringements of the Museum’s trademarks and to "deliver ... for destruction all copies of defendants' poster in their possession." Id. at 872–73.

II.

A trademark is a designation, "any word, name, symbol, or device, or any combination thereof," which serves "to identify and distinguish [the] goods [of the mark’s owner] ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127. Although some marks are classified as inherently distinctive and therefore capable of protection, see generally Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768–69 (1992), it is not the case that all inherently distinctive symbols or words on a product function as trademarks. [Citations omitted]. Rather, in order to be protected as a valid trademark, a designation must create "a separate and distinct commercial impression, which ... performs the trademark function of identifying the source of the merchandise to the customers." In re Chemical Dynamics, Inc., 839 F.2d 1569, 1571 (Fed.Cir.1988); see also 1 J. McCarthy § 3:3.
At the hearing on the Museum’s motion, Gentile showed the district court a poster of an illustration of the Cleveland skyline, produced by another artist, that included the Museum as one building among many. Gentile also referred to a quilt or blanket which apparently depicts “all kinds of landmarks of Cleveland,” again including the Museum among several others. In response to these exhibits, the Museum stated that “they illustrate something [that the Museum does not] think . . . [is] a problem because they show a whole collage of downtown buildings and scenes around Cleveland. That’s not what [the Museum is] trying to stop.” However, the Museum argued that Gentile’s poster features nothing but the Museum and a sunset. According to the Museum, Gentile’s production of his poster was like “going into a store, getting a bottle of [C]oke, taking a picture, [of it and] putting . . . [C]oke underneath.”

Although we are mindful that we are called upon to settle only the present dispute, we have found the foregoing exchange from the hearing on the Museum’s motion a helpful guidepost for our discussion.

On the one hand, although Gentile’s exhibits, which depict the Museum as one landmark among others or as one of several buildings in the Cleveland lakefront skyline, present easier cases, their significance is consonant with our initial impression of Gentile’s poster. That is to say that, when we view the photograph in Gentile’s poster, we do not readily recognize the design of the Museum’s building as an indicator of source or sponsorship. What we see, rather, is a photograph of an accessible, well-known, public landmark. Stated somewhat differently, in Gentile’s poster, the Museum’s building strikes us not as a separate and distinct mark on the good, but, rather, as the good itself.

On the other hand, the import of the Museum’s Coke bottle example is not lost upon us. Indeed, the Museum’s example is not entirely concocted, see Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972), and we accept that a photograph which prominently depicts another person’s trademark might very well, wittingly or unwittingly, use its object as a trademark. However, after reviewing the record before us with this possibility in mind, we are not persuaded that the Museum uses its building design as a trademark. Thus, we are not dissuaded from our initial impression that the photograph in Gentile’s poster does not function as a trademark.

The district court found that the Museum’s building design is fanciful, that the Museum has used its building design as a trademark, and that “the public has come to recognize [the Museum’s building design] trademark[] as being connected with or sold by the Museum.” Rock and Roll Hall of Fame, 934 F. Supp. at 871. There are several problems with these critical findings. First, we find absolutely no evidence in the record which documents or demonstrates public recognition of the Museum’s building design as a trademark. Such evidence might be pivotal in this case, but it is lacking. Indeed, we are at a loss to understand the district court’s basis for this significant finding of fact.
Second, although no one could doubt that the Museum's building design is fanciful, it is less clear that a picture or a drawing of the Museum is fanciful in a trademark sense. Fanciful marks are usually understood as "totally new and unique combination[s] of letters or symbols" that are "invented or selected for the sole purpose of functioning as a trademark." 1 J. McCarthy § 11:5. Although the plaintiffs "invented" the Museum, the Museum's existence as a landmark in downtown Cleveland undermines its "fancifulness" as a trademark. A picture or a drawing of the Museum is not fanciful in the same way that a word like Exxon is when it is coined as a service mark. Such a word is distinctive as a mark because it readily appears to a consumer to have no other purpose. In contrast, a picture of the Museum on a product might be more readily perceived as ornamentation than as an identifier of source.

We recognize, of course, that a designation may serve both ornamental and source-identifying purposes, see, e.g., WSM, Inc. v. Tennessee Sales Co., 709 F.2d 1084, 1087 (6th Cir.1983), and this brings us to our principal difficulty with the Museum's argument and the district court's judgment. As we described supra, although the Museum has used drawings or pictures of its building design on various goods, it has not done so with any consistency.... Several items marketed by the Museum display only the rear of the Museum's building, which looks dramatically different from the front. Drawings of the front of the Museum on the two T-shirts in the record are similar, but they are quite different from the photograph featured in the Museum's poster. And, although the photograph from the poster is also used on a postcard, another postcard displays various close-up photographs of the Museum which, individually and perhaps even collectively, are not even immediately recognizable as photographs of the Museum.

In reviewing the Museum's disparate uses of several different perspectives of its building design, we cannot conclude that they create a consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship. To be more specific, we cannot conclude on this record that it is likely that the Museum has established a valid trademark in every photograph which, like Gentile's, prominently displays the front of the Museum's building, "no matter how dissimilar." Even if we accept that consumers recognize the various drawings and pictures of the Museum's building design as being drawings and pictures of the Museum, the Museum's argument would still fall short. Such recognition is not the equivalent of the recognition that these various drawings or photographs indicate a single source of the goods on which they appear. Consistent and repetitive use of a designation as an indicator of source is the hallmark of a trademark. Although the record before us supports the conclusion that the Museum has used its composite mark in this manner, it will not support the conclusion that the Museum has made such use of its building design.

In the end, then, we believe that the district court abused its discretion by treating the "Museum's building design" as a single entity, and by
concomitantly failing to consider whether and to what extent the Museum's use of its building design served the source-identifying function that is the essence of a trademark. As we have noted, we find no support for the factual finding that the public recognizes the Museum's building design, in any form, let alone in all forms, as a trademark. In light of the Museum's irregular use of its building design, then, we believe that it is quite unlikely, on the record before us, that the Museum will prevail on its claims that Gentile's photograph of the Museum is an infringing trademark use of the Museum's building design.

III.

For all of the foregoing reasons, we VACATE the judgment of the district court, and REMAND for further consideration.

BOYCE F. MARTIN, JR., CHIEF JUDGE, dissenting.


A trademark is not only a symbol of an existing good will, although it is commonly thought of only as that. Primarily it is a distinguishable token devised or picked out with the intent to appropriate it to a particular class of goods and with the hope that it will come to symbolize good will.

Id. Because I believe that the Museum has devised a distinguishable token, appropriated that token to a particular class of goods and plainly demonstrated quantifiable good will, I respectfully dissent.

The majority could have scarcely chosen a better analogy to adopt than that of the Coca-Cola bottle. Doubtless no symbol in the world is so readily recognized. This famous form serves two purposes: it allows the consumer to identify immediately what's inside the bottle; it also serves a utilitarian function by containing the Coca-Cola Company's primary product—Coca-Cola. Just as with a Coca-Cola bottle, more than one mark can serve to identify a single item. For example, the words "Coca-Cola", the signature script and the distinctive bottle shape are all trademarked. See, e.g., Coca-Cola Co. v. Alma-Lec U.S.A., Inc., 719 F. Supp. 725, 726 (N.D.Ill.1989) (noting trademark of bottle shape); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1186–87 (E.D.N.Y.1972) (noting trademarks in product name and stylized script). All can be found on one product.

The Coke bottle analogy is significant for another reason. The trademarked shape of the bottle has three dimensions. Regardless of the angle from which it is viewed, it is still recognizable as a Coke bottle. When a Coke bottle is photographed it loses a dimension, but the subject of the picture remains recognizable as one of a trademarked, three dimensional figure. If a photograph of a trademark—for example, one of a Coke bottle—can be sold by the owner of the trademark in a poster form, that poster
naturally must be recognized as one of the owner’s "goods," albeit a derivative good.

In this case, the physical structure of the Museum, the I.M. Pei-designed building, is "the Coke bottle." Webster's defines token as "an outward sign or expression; symbol, emblem." Webster's New Collegiate Dictionary 1227 (1977). The Museum claims, as I am persuaded, that its building symbolizes something unique and protectable under the trademark laws of the United States. What that something is will arouse different feelings in whomever views the Museum, whether in person or through artists' renderings or photographs. Beyond embodying "the freedom, youthful energy, rebellion and movement of rock and roll music," the Museum building serves a utilitarian function. Like the Coke bottle, the building is also a container. Instead of containing a soft drink, the Museum envelops an array of tangible and intangible elements. It embraces nostalgia; it shelters memorabilia from one of this century's cardinal art forms; it also harbors a bazaar selling snow domes and postcards, T-shirts, baseball caps, and posters—souvenirs for the pilgrims of popular culture. It is this amalgam, of which posters are but a part, that is "the good itself." In short, it is the Coca-Cola in the bottle.

There is no meaningful legal distinction between a three-dimensional and a two-dimensional trademark. I believe the Museum has a valid trademark in its building, and that a photographic image of the museum building could qualify as a trademark on merchandise. I do not read the Lanham Act to mean that simply because a trademark is also the subject of a poster it should enjoy any less protection.

I therefore respectfully dissent.

QUESTIONS

1. Is the showing required for secondary meaning different when the mark is a trade dress mark rather than a word mark? Should it be different? Why or why not? Should it matter whether the trade dress is the packaging of the product, or the shape ("configuration") of the product itself? See Wal-Mart Stores v. Samara Brothers, infra, Chapter 7.B.


3. Georgi brand vodka has introduced a new orange-flavored product; the label features a large "O" rendered as a vertical oval, with the outline of the "O" slightly wider along the sides (about one quarter inch thick) and narrowing at the top and bottom (about one eighth inch thick); the outline
of the “O” is colored orange and decorated with two thin gold lines bordering the inside and one bordering the outside of the outline. Bacardi, a second-comer in the orange-flavored spirit market, also sports an orange “O” on the “Bacardi O” label. Georgi’s sales have not been sufficient to build secondary meaning in its “O” design, but Georgi’s opposition against Bacardi claims the design is inherently distinctive. Is Georgi’s design inherently distinctive, or rather merely descriptive? See Star In v. Bacardi, 412 F.3d 373 (2d Cir.2005).