

TrademarkThoughts

Demonstrating "Acquired distinctiveness" in Descriptive Marks

Trademark use
in strategic
business policy

Number 9 in
a series

January 2001

Published by
Fish & Richardson

Trademark
and
Copyright
Group

Intellectual
property and
technology law

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Trademarks are categorized as falling somewhere along a spectrum of distinctiveness, ranging from inherently distinctive marks that are protectible immediately upon use to unprotectible generic terms. Examples of inherently distinctive marks include fanciful marks such as KODAK for film, arbitrary marks such as CAMEL for cigarettes, and suggestive marks such as COPPERTONE for suntan lotion. Generic terms immediately identify the class of goods or services to which the term is applied, such as BREAD for bread.

Between inherently distinctive marks and unprotectible generic terms lies the murky middle area of descriptive marks. A mark is merely descriptive if it immediately conveys to the relevant buying class information concerning a quality, characteristic, function, ingredient, attribute, or feature of the product or service for which the mark is used. Marks that have been found merely descriptive include PM for an analgesic/sleep aid designed for nighttime use, 5-MINUTE for glue that sets in five minutes, BURGER for cooking utensils, and VENTURE LENDING ASSOCIATES for investment services. Marks that are "self-laudatory," such as DELUXE, AMERICA'S BEST, SUPREME, or BLUE RIBBON, are also often considered descriptive.

The meaning of a word to the "relevant buying class" may be different than the meaning of the word to the ordinary consumer. For example, if a product is sold to highly skilled buyers who have their own lexicon to describe their field of expertise, the unique meaning of words to those buyers is the proper measure of whether a mark is "descriptive."

Unlike inherently distinctive marks, descriptive marks are not protectible immediately upon use. They may be protected only if, through use, they acquire in the minds of a substantial number of members of the relevant buying class a new source-identifying meaning beyond the mere descriptiveness of the words. This new meaning is called "acquired distinctiveness" (sometimes also referred to as "secondary meaning" because it comes second in time).

In addition to descriptive marks, acquired distinctiveness is also required to protect marks that are geographically descriptive (CALIFORNIA WINE COOLERS), primarily

a surname (MRS. FIELD'S COOKIES), or consist of product configurations or color. However, acquired distinctiveness will not render protectible terms or designs that are generic, deceptive, disparaging, immoral, primarily geographically deceptively misdescriptive, or that consist of functional trade dress.

It is not necessary that consumers be able to name the source for acquired distinctiveness to exist, only that they believe there is such a unique source, whether or not known to them or anonymous. Once acquired distinctiveness is proven, a descriptive mark is as fully protectible as an inherently distinctive mark, though in general the stronger the evidence of acquired distinctiveness, the greater the scope of protection. Indeed, some of the best known and strongest marks today, such as BUFFERIN, GENERAL MOTORS, and even the world's most valuable trademark, COCA-COLA, began their lives as arguably merely descriptive terms with uncertain futures.

There are three basic methods for demonstrating acquired distinctiveness before the Patent and Trademark Office ("PTO"). *First*, in "appropriate circumstances" an applicant may claim ownership of one or more prior registrations on the Principal Register of a mark that is the same as the mark in question for closely related goods or services, although more evidence may be required in any particular case. *Second*, an applicant may submit a verified statement that the mark has become distinctive due to substantially exclusive and continuous use for five years, though the PTO has the discretion to accept a shorter period of use or to require more. In general, such evidence will suffice where the mark is a surname, but not where the mark does not inherently function as a mark (such as a product container, color, or mere ornamentation). *Third*, and if necessary in combination with either of the first two methods, the applicant may submit actual evidence of acquired distinctiveness. If the applicant cannot rely on either of the first two methods for demonstrating acquired distinctiveness, it must rely on this third category.

Types of Actual Evidence Of Acquired Distinctiveness

There is no magic formula to follow to determine exactly when a mark has acquired distinctiveness. About the most that can be said is that the more descriptive the term, the greater the level of proof that will be required. Whether a

mark has acquired distinctiveness or not is generally a question of fact, not of law, with the burden of proof on the party claiming rights in the mark.

The intent of the user of a mark to establish acquired distinctiveness is not proof that his efforts have succeeded. Similarly, evidence of advertising expenditures, sales figures and gross revenues, while probative of the extent of use of a mark and the public's exposure to it, are generally insufficient by themselves to establish acquired distinctiveness without credible evidence linking those numbers to the public's association of a term with a single source. The more that advertisements feature the source-identifying nature of the descriptive term, the greater the inference that the term has acquired distinctiveness, whereas use of the term in a merely descriptive or non-trademark sense does not support a finding of acquired distinctiveness. Absent evidence of a connection between such figures and the creation of an association between the term and a single source, mere recitation of numbers off of balance sheets does not demonstrate that acquired distinctiveness exists.

a. Use As A Mark Required

Actual evidence of acquired distinctiveness generally includes showing the method of use of the mark and proof of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product. Where there is no evidence that a descriptive term has been used as a mark, it cannot be protected despite long and substantially exclusive use. Consideration of how the mark has been used is thus an important element in determining the existence of acquired distinctiveness.¹

b. Use Must Be Substantially Exclusive

In order to establish protectible rights in a descriptive mark, Section 2(f) of the Lanham Act requires "substantially exclusive and continuous use thereof as a mark by the applicant." Long and continuous use alone is insufficient to show acquired distinctiveness where the use is not substantially exclusive.

The Lanham Act is somewhat ambiguous as to whether the "exclusive use as a mark by the applicant" means that the applicant must be the exclusive user of the term *as a mark*, and thus whether *non-mark* uses by others should detract from such exclusive use, or whether the language only refers to the requirement that the *applicant's* use must have

been "as a mark" and not in a non-mark sense.

In general, though, proof that others are using a descriptive term for similar goods or services as the would-be mark owner is accepted as evidence that may rebut alleged acquired distinctiveness. As stated by the Federal Circuit, "[w]hen the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration [and thus protection of a mark] under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."²

When called upon to address the question of whether the slogans USE ARRID . . . TO BE SURE and TO BE SURE were protectible, the Ninth Circuit Court of Appeals held that one factor militating against a finding of acquired distinctiveness was the "lack of exclusivity, i.e., other deodorant and kindred products have also utilized the term 'sure' in connection with their advertising." The Ninth Circuit reasoned that such use by others "indicate[s] the obvious: that the term 'sure' is an oft-used one with no special characteristics or distinctiveness of its own."³

In finding that the word DROWNPROOF had not been used in an exclusive fashion, the Eastern District of California noted the word was used by others in a non-mark fashion in various national magazines and by many organizations to describe water survival training and techniques.⁴ Finally, the TTAB, in holding that the term HONEY WHEAT had not been used exclusively for bread so as to create acquired distinctiveness, reviewed copies of pages from six cookbooks, articles from the NEXIS computerized database, and printouts of the "Foods Adlibra" database of Dialog Information Services, ultimately concluding that "long and continuous use alone is insufficient to show secondary meaning [under Section 2(f)] where the use is not substantially exclusive."⁵

c. Length And Timing Of Use

Although the Lanham Act generally allows for five years of substantially exclusive and continuous use to suffice as *prima facie* evidence of acquired distinctiveness, a court or the PTO may accept less or require more, depending on the circumstances. Pre-sales publicity may also count towards such "use," particularly where an adverse party

intentionally seeks to usurp the mark owner's goodwill. While some cases speak in terms of a heavy media blitz creating acquired distinctiveness in a matter of months or even less, other cases say that despite decades of advertising the mark in question never achieved acquired distinctiveness. In general, however, the longer the use, the greater the likelihood that consumers have come to associate the descriptive term as a mark that identifies a single source of goods or services.

The PTO allows an applicant to rely on any period of use up to the point at which the claim of acquired distinctiveness is made. Thus, an applicant theoretically could file an application, receive an office action rejecting the mark as merely descriptive of the goods or services, file a response arguing that the mark is not merely descriptive but rather inherently distinctive, receive a final refusal, and at that point, perhaps a year or more after the initial filing date, seek to establish acquired distinctiveness for the first time based on prior use up to that point. If an initial application contains a claim that the mark has acquired distinctiveness, that will be treated as an admission that the mark is not inherently distinctive, unless the applicant expressly reserves the right to argue otherwise.

In an opposition action, the applicant can seek to demonstrate acquired distinctiveness based on use of the mark up to the point in time that the issue is to be determined, whereas in a cancellation action the issue is whether the mark had acquired distinctiveness as of the registration date. In an infringement action, most courts require the plaintiff to demonstrate the existence of acquired distinctiveness at the time the junior user first began use of the mark.

d. Declarations From Customers

Declarations from customers and potential customers can be powerful evidence of the perception of the mark in the marketplace, and the more declarations that can be submitted the better. The submission of form declarations is acceptable, since each declarant is averring to the truth of the substance of the declaration, though some older cases reveal an uneasiness over their use. However, the viewpoints of long-term, friendly customers are not necessarily persuasive. For example, where a trademark applicant submitted affidavits from certain customers regarding their

perceptions of the words "PAINT PRODUCTS CO.," the TTAB held that

[b]ecause the affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer perceives the words "PAINT PRODUCTS CO." in conjunction with paints and coatings. For us, the unambiguously descriptive meaning of the words that make up applicant's mark is more convincing evidence of public perception than the customer affidavits or other evidence offered by applicant.⁶

The fact that consumers indicate they know and refer to a would-be mark owner's goods and services by its chosen descriptive mark is not particularly probative of anything. Adopting a descriptive mark leaves consumers with little other choice. It does not mean, however, that no one else is using the same descriptive term or that the mark has acquired distinctiveness. Thus, declarations stating only that consumers know particular goods by a descriptive mark is not probative of whether the relevant buying class associates the mark exclusively with a single source. In addition, declarations of a would-be mark owner's personnel are generally not very probative of the existence of acquired distinctiveness, either.⁷

Finally, even more probative than customer declarations, survey evidence can also demonstrate the meaning that a descriptive term has in the marketplace. However, the high cost of conducting a thorough survey renders this approach cost-prohibitive in many situations.

e. Evidence Of Actual Confusion

Evidence of actual consumer confusion can be strong evidence that a mark has acquired distinctiveness. After all, how could consumers be confused if they did not associate a particular term with a unique source?

f. Evidence Of Copying

Some courts accept evidence of copying as evidence that competitors are seeking to capitalize on existing acquired distinctiveness. The problem with this approach is that competitors are free to copy any descriptive word, design, or trade dress that does not have acquired distinctiveness

and that is therefore not protectible. Trying to determine when such copying is evidence of the existence of acquired distinctiveness and when it is evidence of the copier's belief that acquired distinctiveness was lacking is a difficult task. However, if the evidence shows that the copier intended to confuse customers by his copying, that would tend to support a finding of acquired distinctiveness. In addition, many courts give greater latitude to copiers of product design trade dress, believing it is more likely competitors are merely trying to compete than to infringe some as-yet unproven acquired distinctiveness in the alleged mark.

The PTO's Supplemental Register

The Supplemental Register is reserved for marks that are merely descriptive and do not yet have acquired distinctiveness. If a mark is inherently distinctive, it is not eligible for the Supplemental Register, and if a mark is generic, it is of course not registrable at all.

Although a Supplemental Registration is not *prima facie* evidence of the owner's exclusive right to use the mark, it does entitle the owner to use the ® symbol, and it can still be relied upon by the PTO to block subsequently filed applications. Thus, a Supplemental Registration can be useful in helping to deter others from using a confusingly similar mark, perhaps clearing a path to the exclusive use necessary to establish acquired distinctiveness. Once the mark has acquired distinctiveness, a new application can be filed seeking registration of the mark on the Principal Register. Seeking registration on the Supplemental Register does not estop the mark owner from arguing that the mark has acquired distinctiveness. However, it might be construed as an admission against interest that the mark did not have acquired distinctiveness, at least at the time of registration, if the mark is ever the subject of litigation.

Conclusion

For better or worse, the law of trademarks pigeon-holes all marks into one of only a few categories, each with distinct legal ramifications. The only way out of the legal purgatory of "mere descriptiveness" is to establish that the mark in question has acquired distinctiveness. Although there are some general rules of thumb that can be followed (e.g. five years of substantially exclusive and continuous use), there are no definitive means of proving acquired distinctiveness. Accordingly, if a credible argument can be made that a

mark is in fact inherently distinctive rather than merely descriptive, it is almost always best to devote significant legal resources to doing so in order to avoid the uncertainties of seeking to prove acquired distinctiveness.

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Endnotes

¹See, e.g., *in re E.I. Kane, Inc.*, 221 U.S.P.Q. 1203, 1206 (TTAB 1984).

²*Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403 (Fed. Cir. 1984); see also *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 U.S.P.Q.2d 1355, 1357-58 (TTAB 1989) (holding that "the existence of numerous third-party users of a mark, even if junior, might well have a material impact on the Examiner's decision to accept a party's claim of distinctiveness"); *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855 (CCPA 1962) (finding that use of a descriptive term by others on the same or similar products precludes the possibility that the term could indicate origin in only one producer).

³*Carter-Wallace, Inc. v. Proctor & Gamble Co.*, 167 U.S.P.Q. 713, 719 (9th Cir. 1970).

⁴*Hamm v. Knocke*, 182 USPQ 525, 527 (E.D. Cal. 1973).

⁵*Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1582, 1588-89 (TTAB 1987).

⁶*In re Paint Products Co.*, 8 USPQ2d 1863, 1865 (TTAB 1988).

⁷*Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995) (quoting *Norm Thompson Outfitters, Inc. v. General Motors Corp.*, 448 F.2d 1293, 1297 (9th Cir. 1971)); see also *Fuddrucker, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 846-47 (9th Cir. 1987) (holding that a "jury was entitled to disbelieve evidence of actual confusion because it was presented primarily through Fuddrucker's employees"); *In re Gray Inc.*, 3 U.S.P.Q.2d 1558, 1560 (TTAB 1987) (affidavit of counsel expressing his belief that a mark had acquired distinctiveness would be given "no probative value whatsoever").