

## ALERT

### SYNOPSIS OF RECENT TRADEMARK-RELATED DECISION

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#### DON'T PAINT IT GREEN

You can register a color mark.

But most of the time you probably can't.

This point was made once again by the Trademark Trial and Appeal Board in a decision refusing to register six design marks claiming the color green as used in combination with contrasting colors for lawn sprinklers. *In re Orbit Irrigation Products, Inc.*, Serial Nos. 85945749 *et al.* (January 31, 2017) (not precedential.)

Each application described the mark as consisting of the color green as applied to a top portion of the sprinkler head, contrasting with an adjoining non-green portion of the sprinkler head.

Here is what one of them looked like (the shape of the product was not claimed):



The Trademark Examining Attorney refused registration of the marks on the grounds: (1) they are functional, and (2) they are not inherently distinctive and have not acquired distinctiveness. The Board agreed.

### Functionality

Section 2(e)(5) of the Lanham Act prohibits registration of a proposed mark if it “comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). This functionality doctrine prevents trademark law from inhibiting legitimate competition by allowing a producer to control a useful product feature.

Product colors often are functional – such as a bright color that makes something easier to see – but not always. Sometimes a color can be source-indicating. See *In re Hodgdon Powder Company, Inc.*, 119 USPQ2d 1254 (TTAB 2016) - white for gunpowder; *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) -pink for fiberglass insulation.

Here Applicant argued the color green is not essential to the use or purpose of the sprinkler heads, and does not affect their cost or quality (citing the functionality definition in *Inwood Labs. Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982)). Applicant also argued that the factors typically indicating utilitarian functionality were not present. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 14 (CCPA 1982).

The argument was not without at least some support. Among other things, the use of the color apparently made the product more expensive to manufacture and the sprinkler would function just as well in any other color. But it was not enough.

The fundamental problem is this. The product is a lawn sprinkler. Lawns tend to be green. A green lawn sprinkler blends in with the lawn. People like that. That is probably why some of Applicant’s competitors also use the color green for their lawn products. Indeed, the Board found use of green, either alone or with a contrasting color, is common in the lawn care field including on sprinkler heads

As the Board noted, even if a feature is not functional under the *Inwood* and *Morton Norwich* tests, it will still be barred from registration “if the exclusive appropriation of that feature would put competitors at a “significant non-reputation related advantage.” In this case, green is functional for lawn sprinklers because there is a competitive need for lawn care product manufacturers to use the color to help their products blend in with the landscape. Granting exclusive rights in green to Applicant would unfairly disadvantage Applicant’s competitors who also use the color to blend their products into the landscape.

The Board also rejected Applicant’s argument that the situation was similar to the *Christian Louboutin* case where the Second Circuit Court of Appeals found that the red-lacquered outsole on high heels served as a source indicator so long as it contrasted with the color of the adjoining upper portion of the shoe See *Christian Louboutin S.A. v. Yves Saint Laurent America Holding Inc.*, 697 F.3d 206, 103 USPQ2d 1937 (2d Cir. 2012). See:



As the Board found, sprinklers, unlike high heels, commonly are found with green tops and contrasting sides, which helps them to blend with the landscape that has a green leafy background above darker earth. Unlike *Louboutin*, the contrast in color in lawn sprinklers enhance the function of the sprinkler heads.

#### Acquired Distinctiveness

The finding of functionality was fatal to the application but for the sake of “completeness”, the Board also considered (and rejected) Applicant’s claim that the color had acquired distinctiveness through use under Section 2(f). 15 U.S.C. § 1052(f).

Color marks, like product configuration marks, can never be inherently distinctive, and must acquire distinctiveness to be registered. This is not an easy burden particularly for a color. To establish acquired distinctiveness, Applicant must demonstrate consumers of lawn sprinklers view green as identifying the source of its sprinkler products rather than the products themselves.

Applicant did offer supporting evidence of longstanding use, not insubstantial sales, advertising including advertising touting the color (so called “look for” advertising) and even declarations from third party distributors. But it was not enough to overcome the significance of the third party use.

As a basic proposition, the third party use meant Applicant failed to demonstrate its use of green had been “substantially exclusive” as required by the statute in order to demonstrate acquired distinctiveness. 15 U.S.C. § 1052(f). In any event, as the Board concluded, “[g]iven the ubiquity of use of the color green on lawn care products in general, and on competitors’ sprinkler heads in particular, Applicant’s lengthy use of the same color does not transform it into a source indicator.”

Written by Dickerson M. Downing

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