

ALERT

SYNOPSIS OF RECENT TRADEMARK-RELATED DECISION

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PAINT IT WHITE: TTAB PERMITS APPLICATION TO REGISTER THE COLOR WHITE FOR GUNPOWDER

Can you ever register the color white as a trademark for anything? Is white really a color in the first place?

The Trademark Trial and Appeal Board answered the first question and dodged the second in finding the color white can be registered as a trademark for gunpowder. *In re Hodgdon Powder Company, Inc.*, 119 USPQ2d 1254 (TTAB 2016) (June 30, 2016).

A summary of the relevant law may be helpful. The Supreme Court, has found that a single color can never be deemed to be inherently distinctive for trademark purposes. A single color *may* qualify for trademark protection and registration but only upon a demonstration of “acquired distinctiveness” through exclusive use and the development of consumer recognition over time (sometimes called “secondary meaning”) *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1162 (1995). *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000).

One type of evidence that can be particularly important in supporting a claim of acquired distinctiveness is advertising that attempts to build and reinforce an association in the consumer’s mind between the color and the source of the product. To be most effective, the product and the color mark should be displayed prominently in the advertising and the color should be expressly referenced as source designator. This is called “look for” advertising as in “look for the color xxx when you buy.”

Another impediment that can arise with would-be color marks is that a color often is “functional” in that it serves some utilitarian purpose or makes the product easier to manufacture. Examples: a bright reflective color that makes the product easier to see or when the final product is the same color as the natural color of its components or ingredients. If a color is functional it can never be protected as a trademark.

It is not easy to establish a single color trademark but it can be done. As the Supreme Court found:

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”). (Italics Added)

Qualitex Co. v. Jacobson Prods. Co., 34 USPQ2d at 1163.

In this case, Applicant sought to register the color white for “preformed gunpowder charges for muzzleloading firearms” claiming that the mark had acquired distinctiveness under Section 2(f) of the Lanham Act.

The drawing looked like this:



The United States Patent and Trademark Office refused registration finding Applicant's evidence was not sufficient to establish acquired distinctiveness. Applicant appealed to the TTAB.

In support of the argument for acquired distinctiveness, Applicant had submitted a declaration attesting to substantially exclusive and continuous use of the color white on gunpowder for the five years immediately prior to the filing date of the application. Applicant also submitted apparently unchallenged evidence demonstrating the color has no natural association with gunpowder including:

- The natural by-product of the manufacture of gunpowder is a black or grey product.
- Gunpowder is sometimes referred to as "black powder".
- Other than Applicant's use of the color white, there is no known use of the color white for gunpowder in the history of gunpowder.
- The color white for gunpowder serves no purpose other than to identify Applicant's gunpowder.

This evidence led the Board to conclude the color white is not functional for gunpowder. To the contrary, white gunpowder is "an anomaly contrary to consumers' expectations regarding the appearance of the product".

Applicant offered other evidence as well. This included proof that Applicant's has sold approximately \$3.5 million worth of white gunpowder since 2008 and has spent over \$250,000 advertising the product. More importantly, Applicant demonstrated that its sales and advertising referenced the color white. In particular:

- Applicant sells the product under the WHITE HOTS ® Mark.
- Applicant's product packaging and advertising promotes the product as "The Only White Gunpowder."

The Board, disagreeing with the Examining Attorney, found this to be effective "look for" advertising".

This decision represents one of the relatively rare instances where a single color will be found to qualify for trademark protection. White gunpowder indeed.

It also reinforces the importance of "look for" advertising. One of the best ways to create consumer association between a color and a source is to tell them...again and again and again.

Written by Dickerson M. Downing

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