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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Chun Kee Steel & Wire Rope Co., Ltd.

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Serial No. 75/510,018

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John M. Adams of Price & Adams for Chun Kee Steel & Wire  
Rope Co., Ltd.

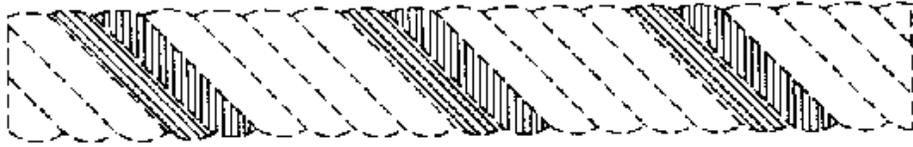
Ann Kathleen Linnehan, Trademark Examining Attorney, Law  
Office 114 (Margaret Le, Managing Attorney).

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Before Seeherman, Chapman and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Chun Kee Steel & Wire Rope Co., Ltd. (applicant) filed  
an application to register the mark shown below on the  
Principal Register for "wire rope" in International Class  
6.



The application (Serial No. 75/510,018) was filed on June 29, 1998, and it claimed a date of first use and a date of first use in commerce of July 1993. The mark is lined for the colors red and green and the mark consists of the colors red and green applied to two adjacent strands of the rope.

The examining attorney ultimately refused registration on the ground that the mark is not inherently distinctive under Sections 1, 2, and 45 of the Trademark Act (15 U.S.C. §§ 1051, 1052, and 1127) and, furthermore, the examining attorney found that applicant had not demonstrated that the mark has acquired distinctiveness under the provision of Section 2(f) of the Trademark Act (15 U.S.C. § 1052(f)). The examining attorney argues that under Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065 (2000), "the Supreme Court unequivocally asserted that color marks can never be inherently distinctive." Brief at 2. Furthermore, the examining attorney maintains that "the use of color on wire rope is a relatively common practice in the trade ... [and] applicant has a heavy burden to

establish public recognition of its colors as a trademark." Brief at 4. The examining attorney found that applicant's evidence of secondary meaning did not meet this burden.

Applicant argues that its mark is not a color mark because it has other elements besides color, i.e., the strands of wire. Furthermore, applicant argues that "[c]olored strands, by custom, immediately signal the source of wire rope to members of the wire rope industry." Brief at 8. In addition to asserting that its design is inherently distinctive, applicant argues alternatively that its evidence of more than six years use, its sales, and the declarations from its customers demonstrate that the mark has acquired distinctiveness.

When the examining attorney made the refusal to register final, applicant filed a notice of appeal.

Regarding the issue of inherent distinctiveness, we agree with the examining attorney that applicant's mark is not inherently distinctive. The Supreme Court has explained that "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." Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 34 USPQ2d 1161, 1162 (1995) (emphasis in original). Later, the Court explicitly held that "design, *like color*, is not

inherently distinctive." Wal-Mart Stores, 54 USPQ2d at 1068 (emphasis added). However, even before the Qualitex case involving a mark consisting of a single color, marks that consisted primarily of color combinations, such as applicant's, were often held to be not inherently distinctive. While ornamentation is not incompatible with trademark function, "unless the design is of such nature that its distinctiveness is obvious, convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark which identifies the source of the goods." In re Owens-Corning Fiberglas Corporation, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985), quoting, In re David Crystal, Inc., 296 F.2d 771, 132 USPQ 1, 2 (CCPA 1961) (registration denied for red and blue bands on white socks). See also Plastilite Corp. v. Kassnar Imports, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975) (yellow and orange fishing floats neither inherently distinctive nor registrable under Section 2(f)).

The design in this case is similar to other color marks that have traditionally been found to be not inherently distinctive. One test for whether a design is inherently distinctive is whether a "buyer will immediately rely on it to differentiate the product from those of

competing manufacturers." In re Hudson News Co., 39 USPQ2d 1915, 1922 (TTAB 1996), aff'd w/o opinion, 114 F.3d 1207 (Fed. Cir. 1997). Applicant's evidence does not convince us that buyers "will immediately rely" on its design to distinguish its products from those of other wire rope producers. While there is evidence that wire rope producers may use color and color combinations to distinguish their wire rope, this evidence does not establish that prospective purchasers will immediately recognize all use of color on wire rope as a trademark. Because color is often used to perform a non-trademark function, we cannot assume that color will automatically be perceived as performing a trademark function in the wire rope industry. Furthermore, applicant's design is not "of such a nature that its distinctiveness is obvious." Owens-Corning, 227 USPQ at 422. Thus, we cannot find that consumers, upon first seeing the colored wire rope, would immediately recognize the color as a trademark, and consequently we cannot find that applicant's color combination mark is inherently distinctive.

While we have found that applicant's design is not inherently distinctive, applicant argues alternatively that its mark has acquired distinctiveness, and it is thus registrable under the provisions of Section 2(f) of the

Trademark Act. Applicant has the burden of proving that its mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

However, the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Id. (quotation marks, brackets, and citations omitted).

In this case, we first note that the question of color and its use as a trademark is not a new issue in the wire rope industry. See A. Leshen & Sons Rope Co. v. Bascom Rope Co., 201 U.S. 166 (1906) (Question of whether a streak

of any color functioned as a trademark for wire rope). The examining attorney argues in the case now before us that "the use of color on wire rope is a relatively common practice in the trade ... [and] applicant has a heavy burden to establish public recognition of its colors as a trademark." Brief at 4. However, unlike other industries that use color merely to color or decorate products, the wire rope industry has historically, to some degree, used color on ropes to identify the source of wire rope and not simply for ornamentation.

Insofar as the nature of the use of colored strands in the wire products field is concerned, it is not disputed that it is the custom, as previously indicated, for manufacturers to use different colors for application to their wire rope or cable for identification purposes and that purchasers do recognize the individual colors as source indicia. Considering, however, the limited number of prime colors available for use, it is apparent that a new manufacturer of wire rope, if he is to follow the practice in the trade as he has a right to do, is obligated to utilize secondary colors or combinations of colors, as applicant has done, to identify and distinguish his goods in the trade. If the latter course is chosen, it is likely that one of the colors would be that previously adopted and utilized by itself by a competitor on its goods. This color selection process would normally be known to purchasers and prospective purchasers of wire rope who, because of the very character of the product and the uses to which it is generally applied, would be informed and knowledgeable persons making their selection with care and deliberation.

Wire Rope Corp. of America, Inc. v. Secalt S.A., 196 USPQ 312, 315 (TTAB 1977). See also Amsted Industries Inc.

v. West Coast Wire Rope & Rigging Inc., 2 USPQ2d 1755, 1757 (TTAB 1987) (“[T]here is no doubt, on opposer’s record, that a number of suppliers of wire rope utilize one or more distinctively colored wire rope strands to serve as indications of origin and have registered these indicia as trademarks”).

The record in the present case is consistent with the prior cases in that there is evidence that different sources of wire rope use different colors and combinations of colors to distinguish their products from each other. See “Know the Origin of Your Steel Wire Rope” (“Our ‘Made in USA’ mark is joining these - reel markings, - colored strands, - core markings as your guidance to the origin and expressed quality and responsibility found in wire rope made in the U.S.A.”).

“As with all trademarks, practices in the industry and competitive needs may require recognition.” Owens-Corning, 227 USPQ at 420. Against this background of an industry in which consumers are aware that color and color combinations may be used as trademarks, we examine the evidence of secondary meaning that applicant has submitted. The evidence consists primarily of: a declaration of applicant’s managing director stating that applicant has substantially continuously and exclusively used its design

since 1993 and it has had more than \$1.8 million in sales involving 3,000,000 feet of red and green wire rope; shipping invoices for its goods in which the goods are referred to as red and green; and declarations from two customers recognizing the red and green colored adjacent strands as identifying applicant's wire rope.

While this evidence is hardly overwhelming, we find that, in an industry where sophisticated purchasers could expect color to serve a source-identifying function, applicant has met its burden of establishing that its mark has acquired distinctiveness. In re Amsted Industries, Inc., 972 F.2d 1326, 24 USPQ2d 1067, 1068 (Fed. Cir. 1992) ("Sophistication of wire rope purchasers" considered in determining that there was no likelihood of confusion between wire rope with an orange and black strand and orange-sheathed wire rope).

Decision: The examining attorney's refusal to register applicant's design on the Principal Register on the basis that it is not inherently distinctive is affirmed, but the examining attorney's refusal to register applicant's mark under the provision of Section 2(f) is reversed.