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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glaxo Group Limited

Serial No. 74/602,027

Thomas J. Moore of Bacon & Thomas for Glaxo Group Limited.

Teresa M. Rupp, Trademark Examining Attorney, Law Office
110 (Christopher Peterson, Managing Attorney).

Before Simms, Hohein and Seeherman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Glaxo Group Limited (applicant), a corporation of the
United Kingdom, has appealed from the final refusal of the
Trademark Examining Attorney to register the asserted mark
shown below:

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for medical inhalers for use in conjunction with an aerosol can, in Class 10.¹ In the application, the mark is described as follows:

The mark consists of the colors light green and dark green which cover the entire surface of the goods. The configuration shown in dotted lines is used to show the positioning of the mark and no claim is made to it.

The drawing is lined for color as follows: the closely spaced diagonal lining indicates the color dark green; and the widely spaced diagonal lining indicates the color light green. Color is claimed.

The Examining Attorney has refused registration under Sections 1, 2 and 45 of the Act, 15 USC §§ 1051, 1052 and 1127, arguing that the asserted mark does not function as a trademark but is merely an ornamental feature of applicant's goods. Briefs have been filed and an oral hearing was held.

The only issue briefed by applicant and argued at the oral hearing is whether applicant's asserted mark is

¹ Application Serial No. 74/602,027, filed November 22, 1994, based upon applicant's bona fide intention to use the mark in commerce. After applicant's asserted mark was published for opposition, no opposition having been filed, a notice of allowance was issued. Thereafter, and in accordance with Trademark Rule 2.88, applicant filed a statement of use, asserting use of the mark since March 31, 1994. See TMEP § 1105.05. Upon examination of applicant's statement of use, including the specimens of use, the Examining Attorney made the refusal now on appeal.

inherently distinctive -- that is, whether potential purchasers will immediately recognize applicant's green coloring scheme as a distinctive way of identifying the source of its goods. It is the Examining Attorney's position that applicant's combination of two shades of the color green is not inherently distinctive of medical inhalers because another manufacturer makes inhalers in two shades of a single color. Also, other companies produce inhalers of two colors --usually white and another color. Accordingly, the Examining Attorney argues, brief, 5, that applicant's two-shaded inhaler is not unique or unusual but a "mere refinement" of what is available in the marketplace:

There is ample evidence in the file that the use of color on inhalers is not unique to the applicant. The colored pages excerpted from the *Physicians Desk Reference* show numerous instances in which color is used by the applicant's competitors. The evidence shows the following:

- Astra USA RHINOCORT nasal inhaler in purple and blue;
- Boehringer Ingelheim ATROVENT inhalation aerosol in green and white;
- Boehringer Ingelheim ALUPENT inhalation aerosol in blue and white;
- Cibageneva Pharmaceuticals BRETHAIRE inhaler in yellow and white;

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- Forest Pharmaceuticals AEROBID inhaler system in purple and white;
- Forest Pharmaceuticals AEROBID-M inhaler system in green and white;
- Rhone Poulenc Rorer INTAL inhaler in blue and white;
- Schering Corporation VANCERIL inhaler in dark pink and light pink;
- Schering Corporation PROVENTIL inhalation aerosol in dark yellow and light yellow;

In view of this evidence, the Examining Attorney argues that applicant's color combination would not be perceived as a trademark.

Stating that trade dress may be protected upon a finding of inherent distinctiveness, without proof of secondary meaning, applicant argues, on the other hand, that its color combination is inherently distinctive. First, applicant argues that the combination of two shades of the color green is arbitrary in connection with medical inhalers because these colors have no meaning or significance in relation to the goods except as a trademark. Applicant concedes that the use of two-color trade dress for inhalers is common because six other companies are using two-color trade dress for nine

different inhalers.² Applicant argues, however, that its color combination is different from the color combinations that are used by competitors for other goods in the relevant market. Applicant notes that these other color combinations are dark pink and light pink, dark yellow and light yellow, purple and white, green and white, blue and white, and yellow and white. It is applicant's position that consumers are likely to perceive the differences between its trade dress and other trade dress as indicating the source of applicant's goods.

First, the marketing of the goods emphasizes the light green and dark green trade dress, and reinforces it by using these colors in advertisements. Second, Applicant's trade dress for two other medical inhalers has been recognized as a trademark for years. Third, the use of two color trade dress is common in the relevant trade. Fourth, Applicant is not using a single color as a trade dress, which may be subject to a more stringent legal standard.

Applicant's brief, 9-10.³ Applicant also argues that, because these are medical products, a careful purchasing

² In its brief, applicant states:

A trade dress comprising two colors is commonly used for medical inhalers. (p.10)

* * * * *

The use of trade dress comprising two colors for medical inhalers is common in the relevant trade. (p.14)

³ It is applicant's position that its two trademark registrations, covering the colors light and dark blue and light

decision will be made and consumers will study not only the goods but the related trademarks before making a purchasing decision. According to applicant, such scrutiny increases the likelihood that its trade dress would be immediately perceived as a trademark. Applicant argues that its green color combination is unique in the trade and that, because customers evaluate the purchase of medical inhalers based upon safety and efficacy of treatment and not on ornamentation, its color combination would not be considered a mere refinement of a commonly adopted form of ornamentation.

Color may be the subject of a trademark. *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300, 34 USPQ2d 1161 (1995). Trade dress, including color, is registrable if it is not *de jure* functional and if it is distinctive, either inherently so or by virtue of acquired distinctiveness. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 112 S.Ct. 2753, 23 USPQ2d 1081 (1992), *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1426 (1995), *In re Sunburst Products Inc.*, 51 USPQ2d 1843, 1847

and dark brown for medical inhalers, have conditioned consumers to immediately understand that the instant color combination is also a trademark.

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(TTAB 1999), and *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996). See also *Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

While it may be true that applicant's particular color scheme may be said to be "unique" because no other company uses applicant's precise color scheme, this does not necessarily mean that applicant's asserted mark is inherently distinctive. In *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992), involving the configuration of a floor mat for use under chairs, the applicant therein likewise also argued that its asserted mark was "unique" because there was no evidence that others used the *identical* configuration for their floor mats. However, there was evidence showing uses of similar third-party chair mats. The Board concluded that, while such design might be said to be unique in the sense that it was a "one and only," the design was not unique in the sense that it was "original, distinctive, and peculiar [in] appearance." The Board commented that, if inherent distinctiveness meant simply "one and only," then one could obtain a registration which differed only slightly from the designs of other competing products. See also *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140-141 (CCPA 1960).

In cases involving the alleged inherent distinctiveness of trade dress, the Board has in the past looked to *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). In that case, the Court stated that, in determining whether a design was inherently distinctive, it:

has looked to whether it was a "common" basic shape or design, whether it was unique or unusual in a particular field, [or] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods[.]

See also *Tone Brothers Inc. v. Sysco Corp.*, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994).

In the case before us, applicant has admitted that it is common in the field to color inhalers with two colors (or with two shades of the same color). Accordingly, it cannot be said that applicant's trade dress is unique or unusual, but rather appears to be a variation or "mere refinement" of a basic color scheme for inhalers. As such, we do not believe that purchasers would immediately recognize or perceive applicant's asserted mark as a source indicator. That is to say, we believe that applicant's color scheme would be viewed by purchasers and prospective

purchasers as only a slightly different ornamentation of medical inhalers.

Concerning applicant's ownership of two other registrations, what the Examining Attorney has stated, brief, 9, 10, is persuasive:⁴

It is well established that each case must be decided on its own facts. The applicant's other two color trademarks were registered because of the applicant's long use, extensive sales and advertising, and evidence of public recognition of the colors as trademarks. The factors present in the previous application files are not present herein. The applicant herein does not argue that the light green/dark green inhalers have become distinctive. Rather the applicant would have one believe that as soon as an applicant registers a two color mark, use of any two colors immediately transforms what would otherwise be an ornamental mark into an inherently distinctive mark...

... Additionally, there is no evidence in the record that the public makes the leap from perceiving a color as a mark after long use and substantial promotion to perceiving any color as [a] mark as soon as the color is first used on the goods.

⁴ The Examining Attorney has noted that, although applicant's registrations do not show Section 2(f) notations, there were showings of acquired distinctiveness in those application files. The Examining Attorney notes that the Office has recently changed its policy concerning Section 2(f) claims, now requiring them to

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Decision: The refusal of registration is affirmed.

R. L. Simms

G. D. Hohein

E. J. Seeherman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

be specifically stated and subsequently printed on the
registration certificates. See TMEP Section 1202.02(b)(iv).