



Acquired Distinctiveness: Turning Garbage into Gold

One of the first things a trademark attorney evaluates when presented with a trademark for registration is the [strength of the proposed trademark](#). Is it a strong, distinctive mark that will pass muster under trademark law, or a weak, non-distinctive mark that will inevitably be rejected by the U.S. Patent and Trademark Office? Let's look at a real-world example of how distinctiveness plays a role in the trademark registration process.

Apple owns one of the world's most valuable brands. Yet when it sought to register APP STORE as a trademark, the application encountered a significant problem. The issue was not whether consumers recognized APPLE but whether consumers viewed APP STORE as a trademark identifying a single source of goods (i.e., software sold by Apple) or merely as the common name for a place where software applications are sold. The examining attorney refused registration because, in her opinion, the mark was merely descriptive of the applicant's goods. Apple subsequently filed an amendment to its application asserting that, even though the mark may be descriptive, it had acquired distinctiveness, or secondary meaning. The Trademark Examiner was unpersuaded and again refused registration. Apple appealed to the Trademark Trial and Appeal Board, which affirmed the decision of the Trademark Examiner. In other words, APP STORE was neither inherently distinctive nor shown to have *acquired* sufficient distinctiveness to function as a trademark. Let's examine the underlying legal principle of "acquired distinctiveness". You can read more about the App Store case [here](#).

1. WHAT IS ACQUIRED DISTINCTIVENESS?

Not all trademarks begin life as distinctive brands. Some may be highly descriptive, incorporate common designs or other elements, which consumers do not recognize as trademarks, that is, as a source identifier of goods and services. Yet, over time, with an investment of marketing resources, a trademark may “acquire” distinctiveness. This occurs when consumers stop viewing a trademark as a description and instead come to recognize it as identifying a single source of goods and services. This is what acquired distinctiveness, or secondary meaning, is all about.

It is important to remember that the key to determining whether a trademark has acquired distinctiveness is not what the applicant or even the Trademark Examiner thinks; it is what consumers think. The analysis must be from the consumer’s point of view. For example, consumers may understand that the name AMERICAN AIRLINES refers to an airline operating in America, but after years of marketing and advertising, the American Airlines Group has caused consumers to associate the name with a particular company. As a result, despite its admittedly generic form, the mark has acquired distinctiveness.

2. SOME MARKS NEVER START OUT AS INHERENTLY DISTINCTIVE

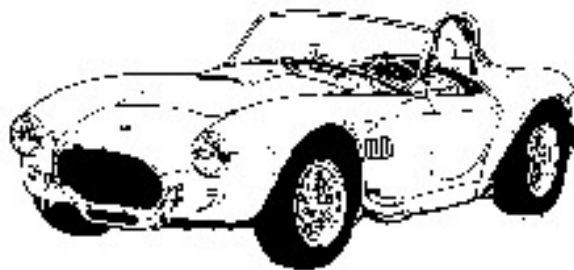
Personal Names. Personal names are ordinarily refused registration. The reason, of course, is that many people may share the same surname. Surnames may acquire distinctiveness when consumers recognize the name as identifying a single commercial source rather than an individual or family. Such distinctiveness comes from extensive use and public recognition. FORD and McDONALD’S are familiar examples of names that have acquired major distinctiveness. See [Trademark Circular No. 6](#), Using Personal Names as Trademarks for a more in-depth discussion.

Colors. Like personal names, colors are never inherently distinctive. In fact, colors were once considered only functional. It was not until 1995 that the U.S. Supreme Court definitively held in [Qualitex Co. v. Jacobson Products Co., Inc.](#), that a color, by itself, could serve as a legally protected trademark provided it met certain criteria. Before this landmark case, the courts were confused. Some considered color to be functional. Under trademark law, functional features are those essential to a product’s use or that affect cost or quality and cannot be trademarked. For example, a bright color used to increase visibility or imply sterility in a medical product would likely be considered functional. Second, there was concern that allowing color trademarks could lead to color depletion. If companies could monopolize individual hues, it might unfairly limit competitors from using ordinary colors in packaging or product design.

Nevertheless, under [current trademark law](#), a color may acquire distinctiveness through long, consistent use. Tiffany Blue and UPS Brown are classic examples. In each case, consumers have come to associate a particular color with a single company. When that association exists, the color may function as a trademark.

Product Shapes and Designs. Product shapes and designs may fall into the category of trade dress, which we discussed in greater depth in [Trademark Circular No. 7](#). Trade dress is the overall commercial image projected by a product. It may include a product's unique design, look, and feel, such as shape, packaging, size, and color. In general, trade dress protects a product's image and what makes it identifiable to consumers. It is not the same as a company's logo or trademark, which is a word or symbol.

A product's shape or configuration, which may not be trade dress, can also function as a trademark. Product designs are not considered inherently distinctive and must acquire distinctiveness before they are protectable. The dispute involving the iconic [Cobra 427 SC race car](#) illustrates this principle.



In that dispute, the Carroll Hall Shelby Trust (Shelby) filed a trademark application to register the distinctive shape of the Cobra 427 S/C race car as seen above. Upon publication, in November 2001, Factory Five Racing, Inc. (Factory Five) immediately opposed the application on several grounds, including that the Shelby design had not acquired distinctiveness. Factory Five manufactures and sells Shelby kits for recreating the famous race car. The Trademark Trial and Appeal Board agreed with Factory Five, noting that not only were Shelby's own kits not heavily marketed since the 1970s, but nearly 200 other parties had also marketed unlicensed Cobra kits. The Shelby design, therefore, had not acquired distinctiveness.

Scents, Sounds, and Other Nontraditional Marks. Trademark law may protect nontraditional marks such as scents, sounds, and other sensory indicators. However, consumers rarely perceive these features as trademarks when first introduced. If a trademark applicant wishes to register a scent, it must, first, provide evidence that the scent is not a natural or inherent feature of the goods, that is, it does not provide any utilitarian advantage. And, second, the applicant must prove that the scent is distinctive as a source identifier.

3. TURNING GARBAGE INTO GOLD

A trademark owner can certainly transform a descriptive trademark into a distinctive gold mine, but it takes strategic planning and perseverance. The owner must focus on long, exclusive use; consistent branding; advertising; sales success; and media recognition, among other factors. This hard work will come to fruition during the trademark application process when the trademark owner must prove acquired distinctiveness. Rigorous recordkeeping is therefore critical.

Courts and the USPTO apply a totality-of-the-circumstances analysis for determining acquired distinctiveness. For example, in [Converse, Inc. v. International Trade Commission](#), the Federal Circuit identified several factors relevant to this inquiry:

Today we clarify that the considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. While the ITC's test set forth length, degree, and exclusivity of use as separate factors, we think that these considerations are substantially interrelated and should be evaluated together. All six factors are to be weighed together in determining the existence of secondary meaning.

Acquired distinctiveness does not happen overnight. It grows as consumers come to recognize a mark and associate it with a particular source. Owners of descriptive marks, personal names, colors, product designs, and other nontraditional marks should use their marks consistently and keep good records of consumer recognition. Over time, that effort can turn a mark once considered weak or nondistinctive into a valuable, legally protectable asset.

— Adam G. Garson, Esq.