

Oral Hearing Held:
August 24, 2005

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailing Date:
September 12, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Armament Systems and Procedures, Inc.

Serial No. 75107678

Gerald T. Shekleton and Brett M. Tolpin of Welsh & Katz, Ltd. for
Armament Systems and Procedures, Inc.

Glenn G. Clark, Trademark Examining Attorney, Law Office 115
(Tomas Vlček, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Armament Systems and Procedures, Inc. has filed an
application to register on the Supplemental Register the proposed
mark shown below



as a trademark for "hand-held nonfunctioning plastic training
equipment in the shape of knives, radios, flashlights, pistols,

rifles, handguns and shotguns for use in training law enforcement personnel."¹ Applicant states in the application that:

The mark consists of the color [r]ed as applied to the entire surface of the goods. The phantom outlining of the configuration of the goods forms no part of the mark but is merely intended to show position.

Registration on the Supplemental Register has been finally refused under Sections 23(c) and 45 of the Trademark Act,² 15 U.S.C. §§1091(c) and 1127, on the ground that the proposed mark is functional and thus is incapable of registration.³

¹ Ser. No. 75107678, filed on the Principal Register on May 21, 1997, based on an allegation of a date of first use anywhere and in commerce of October 1990, and amended to the Supplemental Register on May 14, 2002. The drawing is lined for the color red. In addition, applicant claims ownership of Reg. No. 1,906,917, which issued on the Supplemental Register on July 18, 1995, for the mark "RED GUN" (with a disclaimer of the word "GUN") for "molded synthetic products in the nature of nonfunctional training equipment for law enforcement personnel including knives, flashlights and radios" and sets forth a date of first use anywhere and in commerce of March 1, 1991; renewed.

² In a footnote to his brief, the Examining Attorney correctly notes that in several Office Actions, including the final refusal, he "properly identified the refusal as a refusal to register on the Supplemental Register because the proposed mark is functional and incapable of registration," but that "Trademark Act Sections 1, 2 and 45 were improperly referenced as the statutory basis for the refusal" when "[t]he correct reference should have been to Sections 23(c) and 45 of the Trademark Act." However, as the Examining Attorney further observes, "applicant did not object to this error, and the substance of the refusal remains unchanged." Therefore, the refusal to register has been treated as based on Sections 23(c) and 45 of the statute.

³ As such, the proposed mark is unregistrable, irrespective of applicant's alternative claim of acquired distinctiveness. See, e.g., In re R.M. Smith, Inc., 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) [it is well settled that "[e]vidence of distinctiveness is of no avail to counter a de jure functionality rejection"]. It is pointed out, moreover, that a claim of acquired distinctiveness is applicable solely to registrability of a mark on the Principal Register rather than the Supplemental Register. Consequently, in view of applicant's amendment of its application from the former to the latter, no consideration will be given to the arguments in its initial brief concerning its alternative claim of acquired distinctiveness.

Applicant has appealed. Briefs have been filed⁴ and an oral hearing was held. We affirm the refusal to register.

Preliminarily, however, there are a couple of issues which need to be addressed. To begin, in its initial brief, applicant raises for the first time in the lengthy prosecution of

⁴ The Examining Attorney, in his brief, "requests that this Statement be accepted as timely filed due to the fact that timely notice of the requirement for the submission of the statement was not provided to the Examining Attorney." Specifically, the Examining Attorney maintains that while "[t]he Applicant's brief was filed on July 5, 2004, and the order issued by the TTAB to the Examining Attorney requiring the submission of the brief was dated July 14, 2004," "such order was not received until October 6, 2004." Accordingly, and inasmuch as applicant has raised no objection thereto in its reply brief, the request by the Examining Attorney that "the Statement be accepted as timely filed under Trademark Rule 2.142(b)(1)" is approved.

In addition, the Examining Attorney in his brief "objects to the evidence the applicant submitted with its [initial] brief as untimely," arguing that:

Specifically, the applicant submitted for the first time twenty-five web pages from the Internet with its brief. Trademark Rule 2.142(d) states that the record in the application should be complete prior to the filing of an appeal. The ... Board will ordinarily not consider additional evidence filed with the Board by the appellant ... after the appeal is filed. After an appeal is filed, if the appellant ... desires to introduce additional evidence, the appellant ... may request the Board to suspend the appeal and to remand the application for further examination, as the applicant has already done on two previous occasions. The applicant has not complied with these requirements; thus, this new evidence should not be considered as a part of the record.

Applicant, however, not only has failed in its reply brief to respond to the Examining Attorney's objection, but has attached thereto, as further new evidence, a "*Color Visibility Chart found using the Google® Search Engine on December 23, 2004*" and has requested that the Board "take special notice that the color red ranked among the four (4) *least visible colors* in the attached color visibility chart" (italics in original). Inasmuch as the new evidence attached to both applicant's initial and reply briefs is untimely under Trademark Rule 2.142(d), the Examining Attorney's objection is sustained and such evidence will not be further considered. See TBMP §1207.01 (2d ed., 1st rev. March 2004). Nonetheless, even if such evidence were to be considered, it would make no difference in the disposition of this appeal.

its application the contention that an alleged procedural violation by the U.S. Patent & Trademark Office in the early stage of the examination process was an error which has continuously and unduly prejudiced applicant. Specifically, unlike several of its applications to register the term "RED GUN," which matured into registrations on the Supplemental and Principal Registers, applicant asserts that in this case:

Thomas Vlcek was the Senior Trademark Attorney of Law Office 105. Mr. Vlcek withdrew the allowance issued by Mr. Leahy of Law Office 104 and issued a non-final action dated July 7, 1997. To date, no explanation has been given on how or why the USPTO reassigned the jurisdiction of the application to a different law office and reversed the initial examining attorney's previous determination of registrability. No determination of "clear error" committed by Mr. Leahy has or was addressed or demonstrated, as required. TMEP § 702.03(a). Procedurally, there has not been a reason or justification given under the co-pending application or special mark rules that existed at that time for the withdrawal from publication and reassignment of the application to a different law office and ... to a Senior Trademark Attorney. It is the applicant's belief that ... intra-office rules were violated and the original approval for publication by Mr. Leahy in Law Office 104 should be affirmed. See TMEP § 702.03 *et al* [for companion application rules].

TMEP § 702.03(a)(ii) states that examining attorneys should act consistently in companion cases unless it would be "clear error" to do so. "Clear error" means an error that, if not corrected, would result in issuance of a registration in violation of the Act. TMEP § 1109.08. U.S. Registration Nos. 1,906,917, 2,339,696 and 2,677,038 for the mark RED GUN were examined by multiple attorneys from different law offices. Mr. Leahy's approval of this application for publication was consistent with past office determinations resulting in these three (3)

registrations and the Qualitex decision, which had been just decided by the U.S. Supreme Court. The TMEP states that Examining Attorney Leahy's approval for publication should be withdrawn only if a failure to make a functionality refusal was a clear error. This clear error standard is met only if reasonable minds could not differ as to the propriety of the refusal. TMEP § 1109.08 [definition of clear error].

Given the totality of the applicant's legal arguments and evidence to date, the original examining attorney's determination of registrability regarding this application and three determinations of registrability by various examining attorneys in companion cases, it would be difficult for the TTAB to find that reasonable minds could not differ as to the propriety of the refusal in 1997 or today The record reflects that this application should have never been withdrawn from publication and assigned to Senior Attorney Thomas Vlcek in then Law Office 105 due to the clear error standard not being met. TMEP § 1109.08. Furthermore, even if an unknown but excusable reason exists for the unusual change of jurisdiction, law offices and Examining Attorney's Vlcek's withdrawing this application from publication and issuing the refusal, [such] was not "clearly" appropriate. TMEP § 713.01. Because of this office error and abuse of discretion, registerability [sic] should be decided in favor of the applicant and all substantive determinations inferred in favor of the applicant consistent with past determinations of registerability [sic] and intra office policy.

As the currently assigned Examining Attorney acknowledges and explains in a footnote to his brief:

The originally assigned examining attorney failed to raise the issue of non-registrability and[,] following a first Office action, approved the mark for publication. When the error was discovered, the file was reassigned to a new examining attorney and prior to publication the approval of the application was withdrawn in accordance with Office policy. Until

publication of a mark in the *Official Gazette*, an examining attorney has jurisdiction over the application and can issue a refusal or a requirement without the approval of the Director. 37 C.F.R. §2.84(a); TMEP § 1504.01.

Moreover, contrary to applicant's unfounded speculation, applications are routinely the subject of administrative quality review and, when it clearly appears that further examination is appropriate, the application is either returned to the examining attorney who authorized publication of the mark for opposition or reassigned to another examining attorney, which may include a senior examining attorney, if the examining attorney who allowed publication has left the Office or is otherwise unavailable (as would appear to be the case herein). In addition, a more fundamental fallacy in applicant's desperate argument lies in the unwarranted assumption that the present application, which seeks to register as a mark the color red as applied to the entire surface of various items of law enforcement training equipment, is simply a "companion application" to applicant's other applications which resulted in registrations for the term "RED GUN." The former is plainly not the same as nor even substantially equivalent to the latter, which should be evident by the fact that a refusal on the ground of functionality pertains to the configuration of a product or its trade dress and is inapplicable to a mere word mark.⁵ Applicant's assertion of

⁵ See, e.g., *In re Ruffin Gaming, LLC*, 66 USPQ2d 1924, 1932 n.7 (TTAB 2002), in which the Board carefully pointed out that:

We are mindful, in so noting, that care is obviously required in extending the spectrum of categories of words as

being prejudiced by violation of Office policy is thus without merit.

With respect to the other preliminary issue, applicant asserts in its reply brief that it "objects to the newly raised ground for refusal by the Examining Attorney wherein he states [in his brief] that the color red serves the functional purpose to make the goods highly visible." Applicant contends in this regard that the Examining Attorney has "made and sustained the functionality refusal under the premise that the color red serves the functional purpose of indicating that Applicant's goods are non-functioning firearms" and that, citing TBMP §§1209 and 1217 (2d ed. rev. 2004), the Examining Attorney "may not raise a new ground for refusal of registration during Appeal, except upon remand by the Board for this purpose." Contrary to applicant's contentions, however, the Examining Attorney has not raised a new ground for refusal of registration; rather, the ground for

marks into the realm of shapes and images which words can describe or suggest. As Professor McCarthy has cautioned (*emphasis added*):

A few courts have tried to apply to trade dress the traditional spectrum of marks categories which were created for word marks That is, these courts have tried to apply such categories as "arbitrary," "suggestive," and "descriptive" to shapes and images. Only in some cases does such a classification make sense. For example, a tomato juice container in the shape of a tomato might be classified as "descriptive" of the goods. While a commonly used, standard sized can used as a tomato juice container is not "descriptive" of the goods, it is hardly inherently distinctive. *The word spectrum of marks simply does not translate into the world of shapes and images.*

1 J. McCarthy, McCarthy on Trademarks & Unfair Competition §8:13 (4th ed. 2002).

refusal is still the same as it has been throughout the prosecution of the application, namely, that the mark which applicant seeks to register is functional and hence is unregistrable. Although TBMP §1217 does indeed provide in relevant part that, "while the examining attorney may not raise a new ground for refusal of registration during appeal, except upon remand by the Board for the purpose," such section further states that "the examining attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is a subject of the appeal."

Moreover, it is clearly the case herein that, rather than even raising a new argument, the contention by the Examining Attorney in his brief that the color red serves the utilitarian purpose of making applicant's goods highly visible is part of his longstanding position that such color is functional because it serves as a safety feature which enables the instant recognition of an item as a piece of training equipment instead of an actual knife, radio, flashlight, pistol, rifle, handgun or shotgun. Applicant, it also appears, has in fact so recognized the Examining Attorney's contention regarding a bright red color, having argued in its initial brief that, among other things, while "[a] bright color can have a desirable result for a plastic training device of being more visible to the eye whereas a darker color can have the desirable result of looking like a 'real' gun," it is the case that "[n]o one particular bright color,

included [sic] the color red, is essential to the use or purpose of applicant's goods and[,] therefore the product feature of red is not functional" Accordingly, applicant's assertion that the Examining Attorney has raised a new ground for refusal of registration is without merit.

Turning, now, to the merits of the refusal to register, applicant insists in its initial brief that:

For registration on the Supplemental Register, the color red need only be capable of distinguishing the goods of Applicant. *In re Milk Foundation*, 170 U.S.P.Q. 50 (TTAB 1971) and *In re Brass-Craft Mfg. Co.*, 49 U.S.P.Q.2d 1849 n.3 (TTAB 1998). The ... Board has stated that "the mere possibility of trademark significance, no matter how remote, may not be disregarded if it could be possible, under certain circumstances, that the mark possesses the capacity to distinguish one's goods.["] *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 U.S.P.Q.2d 1534 (TTAB 1987).

Applicant, in light thereof, further maintains that "multiple and opposite meanings of the color red, and other colors being equally feasible[,] negate an assertion that the color red as applied to the entire surface of applicant's product 'as a whole' is functional." Pointing, among other things in this regard, to the 11 form declarations which it has made of record from various police officers and training officials, applicant argues in particular that: "Evidence of trademark recognition by the sworn testimony of law enforcement persons recognizing ...

[applicant's] red police training weapons by color and visually distinguishing them from competing products demonstrates the color red as a capable trademark." Each of the declarants in

such declarations states, among other things, that applicant's "red police training weapons ... first became known to me in" a specific year or by a certain time and that:

People operating in my line of work tend to be visually aware, and I recognize the product and distinguish it from competing products available for purchase by its appearance. To me, that appearance denotes origin of the product with ... [applicant].

In addition, citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 115 S.Ct. 1300, 34 USPQ2d 1161 (1995), applicant contends that "the Supreme Court ruled [that] there is no absolute rule barring the use of color alone." Citing, also, *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 121 S.Ct. 1255, 58 USPQ2d 1001 (2001), applicant asserts that a product feature, including color, is functional only "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." Applicant argues, in view thereof, that (emphasis in original):

The color red is not essential to the use or purpose of the plastic training equipment due to the availability of all other colors which have equivalent desired results of visibility. Bright colors include, but are not limited to, white, yellow, orange, green, red, blue, purple and grey. Darker colors of green, blue, purple, grey and black can also be desirable colors for lower visibility from a distance to give the training device a more realistic appearance to an actual weapon. Actual or real weapons such as guns generally come in dark colors, while real knives can come in equally all different colors. Green can mean safety; orange and yellow high visibility.

A bright color can have a desirable result for a plastic training device of being

more visible to the eye whereas a darker color can have the desirable result for looking like a "real" gun. No one particular bright color, included [sic] the color red, is essential to the use or purpose of applicant's goods and[,] therefore, the product feature of red is not functional
.... Moreover, the color red has no bearing on the cost or quality of the applicant's goods. As explained above, bright or dark colors can be desirable for the manufacturer or seller of training implements depending on whether the manufacturer or seller wants the weapon to appear like a real or a fake weapon used for training. More importantly, if makers of training implements want to maximize visibility, they would choose brighter colors of fluorescent orange or yellow rather than red.

.... The examining attorney asserts that the color red is important because it indicates to users and non-users that they are nonfunctioning firearms, firearm look-alikes, or merely toys. Due to the plethora of brighter colors available for use on training implements such as white, yellow, orange, green, blue and purple, no special reason exists against allowing ... [applicant's] use of this single color red since other colors are equally usable.

....

In this matter, the examining attorney insists that red or other unusual colors applied to guns and gun look-alikes function to demonstrate that they are not harmful or non-functioning weapons. Other unusual colors applied to guns [un]equivocally convey the same non-harmful function because by their nature they are mock weapons. The argument that a single color is functional based on color depletion has been expressly rejected by the Supreme Court in Qualitex and[,] furthermore, the existence of a multitude of other bright or dark colors available for use on the same goods demonstrates that the color red is nonessential to the use or purpose of the article. Choosing alternative colors to red, such as other bright colors, does not put competitors at a significant non-reputation-

related disadvantage. All colors can be said to have some advantage and multiple meanings per color. Darker colors have the desirable effect of looking more like a genuine weapon and brighter colors look less like a weapon.

In consequence thereof, applicant further argues that "[e]ven if it is found that the specific color red is desirable, due to its distinguishing color that differentiates the mock weapon from a standard issued real weapon, trade dress protection should only be denied if it puts competitors as [sic] a significant non-reputation related disadvantage." As indicated above, applicant insists that there is no competitive need for others to use the color red, pointing out among other things that the record reflects that its competitors "use or have used the single colors white, blue and black on their training implements." Thus, according to applicant, "[n]o *de jure* functionality can exist with the existence of equally feasible alternatives," citing *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050, 115 S.Ct. 1426 (1995), given that "the color red does not take from the goods that [which is] of substantial value." Alternative colors, applicant maintains, "have equivalent desirable results of higher or lower visibility."

With respect to whether the color red signifies safety when used in connection with its goods, applicant urges that:

A single color has multiple possible meanings in some cases. One cannot disregard the incongruous polarity that the color red means danger in general but still believe that in the area of weapons training people specifically view it to mean safety (or that

of a nonfunctioning gun). . . . The training weapons industry is directly and inextricably linked to the real weapon[s] industry as well as the general meaning of colors within society. Case law and Applicant's evidence shows [sic] the desirability of the color green, yellow and orange to indicate safety while the color red can mean danger for live weapons . . . (or stop and danger in the case of traffic lights).

These multiple meanings blur any one specific meaning that can be attributed to the color red for training implements. Due to the high volume of multiple meanings that different consumers can attribute to any given color, the color red for training implements should be viewed synonymously with "pink" insulation. See [*In re*] *Owens-Corning [Fiberglas Corp.]*, 774 F.2d [1116,] . . . 1123, [227 USPQ 417, 421 (Fed. Cir. 1985)]. Furthermore, even if one meaning of the color red is indicative of a nonfunctioning weapon, red would not comprise matter that[,] "as a whole," is functional due to its other meaning.

Finally, as to the evidence offered by the Examining Attorney to show "a prevalent past practice in the weapons training industry of the use of the color red," applicant asserts that (emphasis in original):

The vast majority of the evidence supporting this notion is merely widespread recognition of Applicant's mark as used on its goods. . . . The examining attorney offers no support that the color red as applied to the entire surface of the applicant's goods has special significance other than that good will incurring to applicant's benefit as a result of its use of the subject marks [sic]. Furthermore, if the evidence of record shows the occasional preference of some localities to have incorporated the color red, in part, to indicate a nonfunctioning weapon, other bright colors have the same significance in the same or other localities.

Besides relying on references regarding applicant's products and widespread

recognition of the color red reflecting the quality of applicant's goods, the examining attorney has referred to toy guns as being red or the practice of the FBI's past private practice of painting red stripes on the handles of guns. First, toy guns are not applicant's goods and do not travel in the same channel of trade. Second, the FBI now buys all of its red guns from Applicant for use in training, did not use the red stripe commercially and did not apply red to the entire surface of the gun.

The Examining Attorney, relying on what is presently TMEP Section 1202.05(b) (4th ed. April 2005), takes the position in his brief that:

A color mark is not registrable on the ... Supplemental Register ... if the color is functional. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (colors yellow and orange held to be functional for public telephones and telephone booths, since they are more visible under all lighting conditions in the event of an emergency); *In re Howard S. Leight & Associates Inc.*, 39 USPQ2d 1058 (TTAB 1996) (color coral held to be functional for earplugs, because it is more visible during safety checks); *Brunswick Corp. v. British Seagull, supra* (holding the color black functional for outboard motors because while the color did not provide utilitarian advantages in terms of making the engines work better, it nevertheless provided recognizable competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *In re Ferris Corp[.]*, 59 USPQ2d 1587 (TTAB 2000) (color pink used on surgical wound dressings is functional because the actual color of the goods closely resembles Caucasian human skin).

Citing, in addition, *Qualitex Co. v. Jacobson Products Co.*, supra at 34 USPQ2d 1164, the Examining Attorney acknowledges that while the absence of a "competitive need for colors to remain available in the industry" is an indication that, in some circumstances, a particular color is not functional, the Examining Attorney also notes that the Supreme Court, "in discussing the appropriateness of finding a color functional," stated that "sometimes color plays an important role (unrelated to source identification) in making the product more desirable" In light thereof, the Examining Attorney contends that:

The applicant's arguments that the Court's ruling in *Qualitex* favor registration in the present case are misplaced. The functionality issue herein should be decided based upon the reasons why hand-held training equipment would be colored red as opposed to another color, for example, silver or black. The central issue in this appeal is to determine what purpose the color red serves on the identified goods. The examining attorney believes that [the] color red allows the goods to clearly "stand out" or be more visible at a distance. The color red is a bright color, one which is visible even in dimly lit buildings.

In support of his conclusion that "[t]he color red is functional when used on the identified goods because it is a high-visibility safety color," the Examining Attorney asserts that:

The evidence of record overwhelmingly demonstrates that the color red is functional. The color red is commonly applied to guns and gun look-alikes in order to indicate that they are non-functioning, such as training articles or toys. Purchasers would understand the use of the color red to indicate that the particular item is not a functioning one and is

appropriate for training exercises. For [a pistol or other] guns, this is important so that it would not be confused with a real gun that could fire a lethal round. For electronic equipment, this indicates that the articles may be dropped or thrown without breaking. For knives, it indicates that there is no risk of a sharp blade. The use of an unusual color is clearly a beneficial feature to distinguish training articles, and there is already a prevalent past practice in the industry of use of the color red for this purpose.

The Examining Attorney, in particular, insists that he has "made of record numerous web pages to demonstrate that the color red is functional when used on the identified goods," including the following (emphasis added):

(i) a page from the website "movieprop.com" which depicts a rubber and metal replica of an "AK-47 [assault rifle which] was used in the 1984 film Red Dawn" and states that **the "[t]ip of the rifle barrel is painted red to avoid being confused with a real gun";**

(ii) a page from the website "alt-bbguns.com" which contains the statements that **"US law requires that the end of the barrels of bb guns be painted red"** and that **"[a]ll guns exported to the US will have to have the tips of the barrels painted red** to avoid seizure at customs";

(iii) a page pertaining to a "NRA Pistol Instruction" course which indicates, with respect to "fake ... or practice ammo," that "snapcaps or *clearly* **unfirable ammo (eg. [sic] wooden dowel painted red)** for dry-firing is allowed"; and

(iv) a page relating to a "Tactical Talk" article which, in discussing training accidents, states that "[r]ole play should **ONLY** be conducted with **non-firing weapons, such as red guns**, air soft guns, or Simunitions kit equipped guns, **NOT** live duty weapons."

Other web pages, the Examining Attorney notes, "show that trainees are required to bring or use 'red guns' to training exercises and classes." As examples thereof, we observe that a page from "hometown.aol" lists as a requirement of a training program for law enforcement personnel that "[s]tudents must bring a **red gun type mock weapon** that will fit in their duty holster"; a page from "Craven Community College" sets forth, as part of a list of "Equipment Requirements" for several law enforcement officer training programs, that "**[r]ed guns will be supplied for use**" during such programs; and a page comprising an article, entitled "For Every Action," which discusses, in order to "ensure the safety of all participants" in various live training scenarios, "using '**red guns**' (**plastic guns with no ability to deliver projectiles**) and padded batons"⁶ (emphasis added). As the Examining Attorney further observes, several other "web pages of record clearly demonstrate that the relevant industry is using the color red as a safety color to identify training weapons that are non-firing." For instance, the Examining Attorney maintains that a "web page entitled *Officer Safety Tip, August 2000, Issues Related to Less-Than-Lethal Force* ... demonstrates the functionality of the color red on training weapons" by stating that (emphasis added):

Agencies should give some thought as to how and when less-than-lethal munitions are carried. One recommendation is to have a weapon solely dedicated to less-than-lethal

⁶ Such article also mentions that "[o]fficers are given red guns, padded batons, fake pepper spray, and perhaps other simulated weapons."

munitions and this weapon is so marked either by painting the stock and forearm a bright orange or yellow, or by placing a large stencil on the stock noting that the weapon is loaded with less-than-lethal munitions. I would not paint the weapon red as **officers are used to training with so called "red guns" that are[,] in fact, not weapons at all but are used in scenario or defensive tactics training.**

Still other examples, according to the Examining Attorney, include a "web page ... entitled *CITIZEN POLICE ACADEMY, Chesterfield Police Accepting Applications for Citizen Police Academy*, [which] discusses that, during training sessions, class members assumed the role of a police officer, in what police call 'red handle gun' training, acting out several car stop scenarios," and pages from two additional websites "showing the use of simulation 'red guns' in self-defense training." Examples of the latter, we note, are as follows (emphasis added):

"Schmidt helped coordinate the purchase of ... 15 **red guns, a fake training gun police officers use.**

'A **red gun** is the same size as a real gun,' Schmidt said. 'It **looks like a gun only it's red plastic.**'

Participating physicians received items including a **red gun for use in safety demonstrations**" -- "Business Journal" (Overland Park, KS) article entitled "Locked and unloaded," taken "[f]rom the August 25, 2000 print edition; and

"The SIMULATION helps put you into a real life situation. It was alot [sic] more realistic than ... even using the **red guns.**" -- "Active Shooter" article, August 9, 2001.

In addition, we note that a page from a "FLORIDA HIGHWAY PATROL POLICY MANUAL" states, as to "TRAINING WEAPONS," that the "**grips or stock of the weapon shall also be painted red,**" while a page

from "THE DAILY CALIFORNIAN online" reports that "**[s]tate law mandates that all fake guns have a red barrel**" (emphasis added).

The Examining Attorney, in addition, points out that he has "made of record numerous LEXIS/NEXIS stories to demonstrate that the color red is functional when used on the identified goods." Specifically, the Examining Attorney maintains that such evidence shows that "the color red is the common color applied to guns to indicate ... that they are nonfunctioning firearms, firearm look-alikes, or merely toys," noting that:

There are numerous stories on instances where loaded weapons were accidentally used in training exercises, resulting in shootings that would have been avoided if red-colored simulated firearms had been used instead. Other stories involved realistic looking toys which were mistaken for actual firearms, shootings which were avoided because toy guns were colored red, and various laws requiring toys to be brightly colored.

Representative examples of such stories are set forth below (emphasis added):

"Maurice's best friend ... said the boy who shot Maurice might have mistaken the toy gun for a real one, but police said the **toy gun was made of red plastic**." -- St. Louis Post-Dispatch, March 28, 1992;

"Altered **guns are sometimes painted red, made inoperable and used for training**, Sheetz said." -- Arizona Republic and Phoenix Gazette, June 22, 1994;

"'I always said, give him a **red-handled gun**,' says acting assistant director Robert Reuter, **referring to safety guns without firing pins** handed out to FBI [agents]." -- American Lawyer, October 1994;

"Palo Alto Police say they have switched from real guns to look-alike **red plastic firearms for use in training** because of the

shooting death in May of Officer Ted Brassinga during an exercise." -- San Francisco Examiner, October 28, 1994 (article headlined: "Palo Alto cops buy dummy training guns");

"Sheriff's Department policy now restricts all training with loaded weapons to the sheriff's academy, and bars the use of any firearm in field training sessions. Even **a clearly marked toy gun--such as a red plastic gun--is now off limits.**" -- Los Angeles Times, December 25, 1994;

"[Kenneth] Krna had disguised the toy to look like a semi-automatic handgun by putting black tape over the toy's red tip, police said. **All toy guns are required to have red tips to distinguish them from real ones.**" -- Tampa Tribune, June 7, 1995;

"[Police Chief Steven] Emery said he spotted a gun, which appeared to be a chrome-plated revolver, on the living room floor, but because it had a red tip on the barrel, he knew it was a toy. Emery said toy **manufacturers have been identifying toy guns with red tips to enable police to recognize toy weapons.**" -- Bangor Daily News (Bangor, ME), November 25, 1995;

"At the heart of the recommendations will be one to **require weapons used during such [police officer training] exercises to be rendered inoperable and for the handles of those weapons to be painted red.**

'We're talking about the red-handled guns,' Whittington said last week. 'We're talking about real firearms that have just been deactivated'

.....
Whittington has spoken with the FBI about the procedures they use during training. He has been told **an effective way to prevent accidents is to paint the gun grips 'discernably [sic] red.'**

That way, people know when somebody walks in and is not packing the right kind of weapon to take part in the training, officials have said." -- Advocate (Baton Rouge, LA), September 15, 1996;

"Last week, Sgt. Michael Black, an instructor at the patrol academy in Columbus, demonstrated several scenarios troopers encounter as part of their **'Red Handle Gun' training**.

Black and two other patrol instructors ... each carried .40-caliber Berettas, the same guns troopers use. The only difference is that **each gun was marked with a red handle to signal that it was loaded with blanks to prevent accidental shootings**" -- Columbus Dispatch, December 29, 1996;

"The [police] department also will buy **red plastic guns for training programs**" -- Los Angeles Times, November 26, 1997;

"The Cabot Police Department will use **red plastic guns for training** after one of its officers shot and injured another during a training exercise early Tuesday morning." -- Arkansas Democrat-Gazette, May 2, 1998;

"'From now on, we're going to use (**fake, plastic**) **red guns** in the citizens academy,' Chief Howard said." -- Cincinnati Enquirer, March 13, 1999 (article headlined: "Cop errs, shoots student at citizens police academy");

"'It's part of our training on stops and approaches,' Keener said. 'Our trainers are acting as violators in the cars. We use **red-handled-guns** and blanks. The instructors go through many different scenarios to make it as lifelike as possible. We do it over and over again.'" -- Columbus Dispatch, July 12, 2000;

"The **handles of the plugged guns were painted red to indicate to users that primer rounds, not blanks or bullets, should be used** in them, Sarasota police Chief ... Jolly said." -- Sarasota Herald Tribune, October 14, 2000;

"Six police officers in black combat boots and gripping **red rubber handguns** stormed an empty office building as they practiced high-risk raid tactics at the Regional Counterdrug Training Academy at Naval Air Station Meridian." -- Atlanta Journal & Constitution, December 22, 2000;

"I make sure the deputies are not armed with any live ammunition, and they put their magazines in their vehicles,' Capt. Roy Myers said. 'The [school-violence training] entry team is issued **red rubber guns to prevent any mishaps.**'" -- Augusta Chronicle (Augusta, GA), July 25, 2001; and

"The deputies ... used **red rubber knives and guns to practice.**" -- St. Petersburg Times, October 22, 2001 (article headlined: "Deputies learn defense techniques").

With respect to the use of colors other than red to indicate or distinguish mock training equipment, we observe that the record contains pages from various websites which indicate that:

"Under New York City's Public Safety Law, it is against the law to sell or offer to sell any toy or imitation firearm that can reasonably be perceived to be an actual firearm unless the exterior surface of the toy or imitation firearm is predominantly brightly colored. The range of acceptable colors include white, bright red, bright orange, bright yellow, bright green, bright blue, bright pink, or bright purple." -- "News from the BLUE ROOM" online press release, March 16, 2004 (with such announcement reported in the April 1, 2004 edition of the Bronx Times);

"Toy guns didn't become a target of federal lawmakers until the late 1980s, when the Federal Imitation Gun Law was passed, requiring manufacturers to modify their toy guns to make them appear less realistic. In October 1992, the U.S. Department of Commerce issued regulations governing the 'Marketing of Toy Look-Alike and Imitation Firearms.' Under the new specifications, toy guns were required to bear a solid, 'blaze-orange' plug at the tip of their barrel, or be colored entirely white, bright red, orange, yellow, green, blue, pink or purple." -- "CourtTV.com" article, March 29, 2004; and

"The United States already has laws regulating the manufacture of imitation firearms. The U.S. Department of Commerce mandates that the muzzle end of the gun barrel be painted 'blaze orange,' the gun must be translucent in color, or it must be [a] bright color, such as red, orange or purple." -- "Albuquerque Tribune Online" article, August 19, 1993.

In particular, the Examining Attorney emphasizes in his brief that, in view thereof: "The United States Congress has ... recognized ... the need to use bright colors to distinguish toy, look-alike and imitation firearms from real firearms." The Examining Attorney notes, furthermore, that he has "made of record a portion of Title 15 of the United States Code regarding imitation firearms" which, as set forth in Section 5001, "requires that toy, look-alike and imitation firearms have as an integral part, permanently affixed, a blaze orange plug inserted in the barrel of such toy, look-alike or imitation firearm." Specifically, such section, which is entitled "Penalties for entering into commerce of imitation firearms," provides in relevant part that:

(a) Acts prohibited

It shall be unlawful for any person to manufacture, enter into commerce, ship, transport, or receive any toy, look-alike, or imitation firearm unless such firearm contains, or has affixed to it, a marking approved by the Secretary of Commerce, as provided in subsection (b) of this section.

(b) Distinctive marking or device; exception; waiver; adjustments and changes

(1) Except as provided in paragraph (2) or (3), each toy, look-alike, or imitation firearm shall have as an integral part, permanently affixed, a blaze orange plug inserted in the barrel of such toy, look-alike, or imitation firearm.

(2) The Secretary of Commerce may provide for an alternative marking or device for any toy, look-alike, or imitation firearm not capable of being marked as provided in paragraph (1) and may waive the requirement of any such marking or device for any toy, look-alike, or imitation firearm that will only be used in the theatrical, movie or television industry.

(3) The Secretary is authorized to make adjustments and changes in the marking system provided for by this section, after consulting with interested persons.

(c) "Look-alike firearm" defined

For purposes of this section, the term "look-alike firearm" means any imitation of any original firearm which was manufactured, designed, and produced since 1898, including and limited to toy guns, water guns, replica nonguns, and air-soft guns firing nonmetallic projectiles. Such term does not include any look-alike, nonfiring, collector replica of an antique firearm developed prior to 1898, or traditional B-B, paint-ball, or pellet-firing air guns that expel a projectile through the force of air pressure.

....
(f) Effective date

This section shall become effective on the date 6 months after November 5, 1988, and shall apply to toy, look-alike, and imitation firearms manufactured or entered into commerce after November 5, 1988.

The Examining Attorney, in addition, points out that he has "made of record Rule 1150 of Title 15 of the Code of Federal Regulations concerning the marking of toy, look-alike and imitation firearms." The Examining Attorney notes that, as set forth below, such rule, which took effect as of May 5, 1989 and was amended as of October 26, 1992, in pertinent part requires that "the entire exterior surface of toy, look-alike and imitation firearms must be colored in white, bright red, bright orange, bright yellow, bright green, bright blue, bright pink, or

bright purple so that these imitation weapons may be easily distinguished from real weapons" (emphasis added):

§1150.1 Applicability.

This part applies to toy, look-alike, and imitation firearms ("devices") having the appearance, shape, and/or configuration of a firearm and produced or manufactured and entered into commerce on or after May 5, 1989, including devices modeled on real firearms manufactured, designed, and produced since 1898. This part does not apply to:

(a) Non-firing collector replica antique firearms, which look authentic and may be a scale model but are not intended as toys modeled on real firearms designed, manufactured, and produced since 1898;

(b) Traditional B-B, paint-ball, or pellet-firing air guns that expel a projectile through the force of compressed gas or mechanical spring action, or any combination thereof ... ; and

(c) Decorative, ornamental, and miniature object having the appearance, shape and/or configuration of a firearm, including those intended to be displayed on a desk or worn on bracelets, necklaces, key chains, and so on, provided that the objects measure no more than thirty-eight (38) millimeters in height by seventy (70) millimeters in length, the length measurement excluding any gun stock length measurement.

§1150.2 Prohibitions.

No person shall manufacture, enter into commerce, ship, transport, or receive any toy, look-alike, or imitation firearm ("device") covered by this part as set forth in §1150.1 of this part unless such device contains, or has affixed to it, one of the markings set forth in §1150.3 of this part, or unless this prohibition has been waived by §1150.4 of this part.

§1150.3 Approved markings.

The following markings are approved by the Secretary of Commerce:

(a) A blaze orange ... solid plug permanently affixed to the muzzle end of the barrel as an integral part of the entire device and recessed no more than 6

millimeters from the muzzle end of the barrel.

(b) A blaze orange ... marking permanently affixed to the exterior surface of the barrel, covering the circumference of the barrel from the muzzle end for a depth of at least 6 millimeters.

(c) Construction of the device entirely of transparent or translucent materials which permits unmistakable observation of the device's complete contents.

(d) **Coloration of the entire exterior surface of the device in white, bright red, bright orange, bright yellow, bright green, bright blue, bright pink, or bright purple,** either singly or as the predominant color in combination with other colors in any pattern.

§1150.4 Waiver.

The prohibitions set forth in §1150.2 of this part may be waived for any toy, look-alike or imitation firearm that will be used only in the theatrical, movie or television industries.

§1150.5 Preemption.

In accordance with section 4(g) of the Federal Energy Management Improvement Act of 1988 ..., the provisions of this part supersede any provision of State or local laws or ordinances which provides for markings or identification inconsistent with the provisions of section 4 of that act or the provisions of this part.

That "applicant recognized the functional aspect of using bright colors such as red on training equipment," the Examining Attorney further insists, is shown by its "filing for patent protection" on October 4, 1991. Specifically, the Examining Attorney notes in his brief that:

The applicant is the owner of Utility Patent Number 5,451,162 for MOCK TRAINING WEAPON AND METHOD OF TRAINING LAW ENFORCEMENT PERSONNEL USING SAME The applicant submitted a copy of its utility patent with its request for reconsideration on November 25, 2003. The applicant's patent teaches the ... need

for training weapons to be brightly colored to prevent training accidents and deaths.

Among other things, the "BACKGROUND OF THE INVENTION" section of such patent, which issued on September 19, 1995, indicates that, "[m]ore recently, standard issue weapons have been substituted with 'plugged' live weapons or a variety of mock weapons in order to minimize the risk of accidental firing during training exercises," while the "SUMMARY OF THE INVENTION" portion thereof states, *inter alia*, that (emphasis added):

To further increase the safety aspects of the mock weapon of the subject invention , the mock weapon may be molded in a bright distinguishable color so that it cannot be confused with a standard issue weapon or, may be coated with a color of choice to properly distinguish the weapon from standard issue weapons.

....

It is a further object and feature of the subject invention to provide for a mock weapon having an appearance which is clearly distinguishable from a standard issue weapon even though the mock weapon is of the same size, shape and balance as the standard issue weapon.

Applicant's patent, moreover, provides in the "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT" that (emphasis added):

In the preferred embodiment, the base material of the mock weapon ... is provided with a bright pigment, producing a mock weapon of a bright distinguishing color, clearly differentiating the mock weapon from a standard issue weapon. While red pigmentation is the color of choice, it will be readily understood that any differentiating color can be utilized to achieve this objective. Further, the same objective could be achieved by coating the mock weapon ... with an exterior finish coat of any desired color.

....

.... **The subject invention provides an enhanced training method** for training law enforcement personnel in the proper and proficient handling of the specific standard issue side arm weapon **while providing maximum safety to personnel during the training program.**

Furthermore, applicant's patent specifically claims both a training method "wherein said **mock weapon includes an outer shell of a bright color clearly distinguishing it from said standard issue side arm weapon**" (claim 3) as well as a training method "wherein the **mock weapon is made of a material which is clearly distinguishable from the appearance of the standard issue side arm weapon**" (claim 11) (emphasis added). The Examining Attorney maintains, in view thereof, that "applicant's patent teaches that 'bright colors' should be used on training weapons so that they are not confused with real weapons" and thus that applicant has essentially acknowledged that "'bright colors' are 'safety aspects of the mock weapon of the subject invention.'"

Based, therefore, upon all of the above evidence, and notwithstanding that the record also reveals that applicant forced a competitor to cease and desist from using the color red in connection with training weapons and to use the color blue instead, the Examining Attorney insists in his brief that applicant is not entitled to the registration it seeks, arguing in particular that (*italics in original*):

The applicant's argument that the lack of competitors who presently use the identical color [red] is evidence that no such industry need exists is not persuasive.

The examining attorney believes that to consider only present competitive need is an unduly narrow view of the industry. The TTAB in *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996)[,] was not only concerned with competitive use of the color in existence at the time of registration but was also concerned with any future competitive need. The Board stated, "[C]ompetitors who would be *precluded* by a registration from producing a similar telephone would be at a competitive disadvantage." 41 USPQ2d 1036, 1042 n. 6 (Emphasis added). Therefore, the issue herein is whether the applicant's competitors would need to make training equipment in the color presented for registration, even if that need arose in the future.

In determining whether a proposed mark is functional, the courts are primarily concerned with protecting the need to compete effectively. The applicant herein stresses the fact that other colors are available to its competitors. However, as the Court of Appeals for the Federal Circuit noted in *Brunswick Corp. v. British Seagull Ltd.*, 32 USPQ2d (Fed. Cir. 1994), the inquiry is not whether the color is essential to compete but rather whether it is unfair to allow one manufacturer to appropriate a color that may be needed by everyone in the industry. The Court explained that the inquiry must revolve around the question of competitive fairness. In *British Seagull*, the color black was found to be *de jure* functional because it was a more desirable color for reasons of color capability. In the present case, the color red provides the applicant with an unfair competitive advantage of being able to appropriate a color that is synonymous with non-firing training equipment that is used by law enforcement personnel.

The Examining Attorney concludes that the color red, as applied to the entire surface of applicant's goods, is incapable of registration on the Supplemental Register because such matter is functional. The color red, the Examining Attorney asserts, "is so commonly used in the relevant field that it should remain in

the public domain for use by all consumers and companies as a safety color to indicate that the training weapon is incapable of firing a lethal round."

Section 23(c) of the Trademark Act provides in relevant part that "[f]or ... purposes of registration on the supplemental register, a mark may consist of ... any matter that as a whole is not functional, ... but such mark must be capable of distinguishing the applicant's goods" Section 45 of the Trademark Act indicates among other things that "[t]he term 'mark' includes any trademark," which in pertinent part is defined as follows: "The term 'trademark' includes any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Therefore, while applicant's proposed mark, consisting of the color red as applied to the entire surface of its goods, is a mark eligible for registration as the term "trademark" is defined in the statute, such mark is registrable on the Supplemental Register only if it as a whole is not functional and is hence capable of distinguishing applicant's goods.

Upon careful consideration of the arguments and evidence presented, we agree with the Examining Attorney that applicant's proposed mark is functional and is thus incapable of registration on the Supplemental Register. While, as a starting point for our analysis, we are mindful that the Supreme Court, in

Qualitex Co. v. Jacobsen Products Co. Inc., supra at 34 USPQ2d 1163-64, held that a single color *may* indeed be registrable as a mark⁷ provided that, *inter alia*, it is not functional, the Court also pointed out in its discussion of such issue that, in general (italics in original; emphasis added):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained and could be extended forever (because trademarks may be renewed in perpetuity). See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119-120[, 39 USPQ 296, 300] (1938) ...; *Inwood Laboratories, Inc. [v. Ives Laboratories, Inc.]*, [456 U.S. 844 (1982)] ... at 863[, 214 USPQ 1 at 9] **This Court consequently has explained that, "[i]n general terms, a product feature is functional," and cannot serve as a trademark, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.** *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10[, 214 USPQ, at 4, n. 10]. **Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not.** And, this latter fact--the fact that sometimes color is not essential to a product's use or purpose and does not affect cost or quality--indicates that the doctrine of "functionality" does not create an absolute bar to the use of color alone as a mark. See [*In re*] *Owens-Corning [Fiberglas Corp.]*, 774 F.2d [1116 (Fed. Cir. 1985)], at 1123[, 227

⁷ Specifically, in "hold[ing] that there is no rule absolutely barring the use of color alone," the Supreme Court "conclude[d] that, *sometimes*, a color will meet ordinary legal trademark requirements" and that, "when it does so, no special legal rule prevents color alone from serving as a trademark" (italics added). 34 USPQ2d at 1162.

USPQ 417, at 421] (pink color of insulation in wall "performs no nontrademark function"). **It would seem, then, that color alone, at least sometimes, can meet the basic legal requirements for use as a trademark.** Qualitex's green-gold [dry cleaning] press pad color has met these requirements. The green-gold color acts as a symbol. ... [I]t identifies the press pads' source. And, the green-gold color serves no other function. (Although it is important to use *some* color on press pads to avoid noticeable stains, the [district] court found "no competitive need in the press pad industry for the green-gold color, since other colors are equally usable." **Accordingly, unless there is some special reason that convincingly militates against the use of color alone as a trademark, trademark law would protect Qualitex's use of the green-gold color on its press pads.**

Moreover, while the Supreme Court in *Qualitex* also considered, as one of the special reasons advanced as to why a single color should not be protected as a trademark, the argument that "colors are in limited supply" in that generally, "in the context of a particular product, only some colors are usable," 34 USPQ2d at 1165, it dismissed--in light of the functionality doctrine--the color depletion theory as an absolute bar to trademark recognition, stating that (emphasis added):

This argument is unpersuasive ... largely because it relies on an occasional problem to justify a blanket prohibition. **When a color serves as a mark, normally alternative colors will likely be available for similar use by others. See, e.g., Owens-Corning, 774 F.2d, at 1121 (pink insulation).** Moreover, if that is so--if a "color depletion" or "color scarcity" problem does arise--the trademark doctrine of "functionality" normally would seem available to prevent the anticompetitive consequences that Jacobson's argument posits, thereby minimizing that argument's practical force.

The functionality doctrine ... forbids the use of a product's feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is "essential to the use or purpose of the article" or "affects [its] cost or quality." *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10. The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation-related product features. For example, this Court has written that competitors might be free to copy the color of a medical pill where that color serves to identify the kind of medication (e.g., a type of blood medicine) in addition to its source. See *id.*, at 853, 858, n. 20 ("[S]ome patients commingle medications in a container and rely on color to differentiate one from another") And the federal courts have demonstrated that they can apply this doctrine in a careful and reasoned manner, with sensitivity to the effect on competition. **The upshot is that, where a color serves a significant nontrademark function-- ... to distinguish a heart pill from a digestive medicine ... -- courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient. But, ordinarily, it should prevent the anticompetitive consequences of Jacobson's hypothetical "color depletion" argument, when, and if, the circumstances of a particular case threaten "color depletion."**

Id. at 1165-66.

In light of the above, the issue in this case is whether the record demonstrates that the color red as applied to the entire surface of applicant's "hand-held nonfunctioning plastic training equipment in the shape of knives, radios, flashlights, pistols, rifles, handguns and shotguns for use in

training law enforcement personnel" is functional in that it is essential to the use or purpose of the goods or affects their cost or quality; that is, whether there is a competitive need for the color red as applied to the entire surface of training implements to remain available in the trade because the exclusive use of such a feature by applicant would put competitors at a significant non-reputation-related disadvantage. In finding in the affirmative, we note that as indicated in, for example, *In re Ferris Corp.*, 59 USPQ2d 1587, 1589:

When determining whether a color is ... functional, courts (including our primary reviewing court--the U.S. Court of Appeals for the Federal Circuit) have considered factors including (i) whether the color serves a non-trademark purpose; (ii) whether that purpose is important to consumers; (iii) whether the color is the best, or at least one, of the few superior colors available for that purpose; (iv) whether competitors are using the color for that purpose; and (v) whether there are alternative colors available for similar uses by others. *Qualitex*, 514 U.S. at 168, 34 USPQ2d at 1164; *Brunswick*, 35 F.2d at 1532, 32 USPQ2d at 1122, quoting *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985).

We concur with the Examining Attorney that, contrary to applicant's contentions, the record shows that the color red has traditionally been used as a safety indication to denote a mock training implement and is one of a relatively limited number of bright colors which, by contrast to the black, gray and silver colors of lethal firearms, at a glance enable the former to be readily and assuredly distinguished from the latter (and vice versa). In particular, the record demonstrates that the color red not only has long been used for the non-trademark purpose of

serving as a safety feature to provide an immediately apparent visual indication that a piece of equipment used in training law enforcement personnel is an imitation or mock implement and not an actual or real weapon or other item, but the color red is recognized and regarded as the principal color for so marking and distinguishing such training equipment. Whether applied to the stock, grip, handle or barrel tip of a firearm, or covering the entire surface of a training implement such as a replica firearm or imitation flashlight or radio, the webpage and "LEXIS/NEXIS" excerpts establish that the color red has become essentially synonymous with the function of denoting that the implement so marked is exclusively for use in training exercises and is not to be used elsewhere.⁸

Moreover, it is significant that, although not claiming the color red, even applicant's utility patent recites, in the detailed description of the preferred embodiment of its mock training weapon and method of training law enforcement personnel using same, that "red ... is the color of choice" for "producing a mock weapon of a bright distinguishing color, clearly differentiating the mock weapon from a standard issue weapon," so

⁸ Applicant's contention, as noted earlier, that the mentions in such evidence of "red gun(s)" are in fact references solely to its goods is nothing more than unsubstantiated argument. Plainly, on this record, such references are simply descriptions of guns used for training purposes which are entirely colored red. While, as previously indicated in this opinion, a descriptive designation such as "red gun" is not the equivalent of, for purposes of the registrability thereof as a trademark, the color red as applied to the overall surface of a gun which is used for training, references to "red gun" and "red guns" are evidence of training guns which are entirely red in color and thus are relevant to whether the color red, as applied to the entire surface of a training weapon, is functional.

as to provide "maximum safety to personnel during the training program." Plainly, in the case of a mock weapon which is made in accordance with the teachings of the preferred embodiments of applicant's utility patent, and thus is designed among other things to imitate the look and feel of an actual weapon, it is the color red alone which provides the non-trademark safety function of identifying and distinguishing the weapon as being a training implement and not a potentially lethal firearm. To be sure, while other bright contrasting colors would similarly serve such a safety feature, a preferred mode of practicing applicant's invention, as disclosed in its utility patent, is to utilize the color red.

As applicant concedes in its initial brief, "[t]he training weapons industry is directly and inextricably linked to the real weapon[s] industry as well as the general meaning of colors within society." Although applicant argues that colors such as "green, yellow and orange are used to indicate safety while the color red can mean danger for live weapons," we see no such incongruity or inapposite meaning in the use of the color red on training implements. Clearly, just as the color red can mean danger for a live weapon, it can also signify safety since, obviously, a training weapon is dangerous if accidentally taken into the field or on patrol where live weapons are a necessity. Plainly, use of the color red on training implements, by enabling law enforcement personnel to tell immediately that such implements are not live weapons or other actual equipment, serves a crucial safety function in either context.

As applicant additionally admits in its initial brief, "[d]arker colors have the desirable effect of looking more like a genuine weapon and brighter colors look less like a weapon." It is therefore clear that for safety purposes, a brighter color is more functionally advantageous as it is more visible and looks less like a real gun or other piece of law enforcement equipment. Applicant's advertising literature, as shown by the record, depicts its training weapons, flashlights and radios in a bright red color and includes the statements that: "Red Guns® are realistic, lightweight replicas of actual law enforcement equipment. They are ideal for weapon retention, disarming, room clearance and sudden assault training." Such literature further states, for instance, that "[m]odern firearms training teaches an officer caught in a confrontation with a radio or flashlight in his hand that the device simply 'ceases to exist' as the officer draws his weapon" and notes that:

A problem with this training has been a lack of devices that an officer on the line can hold and have "cease to exist." The result is the Training Radio and Training Flashlight from ASP. A continuation of the ASP Red Gun® product line, these two devices are intended for officers to have in their hand as they are confronted by an assailant. Instead of dropping \$2,000 radios and \$100 rechargeable flashlights on a range floor, these training units can be dropped repeatedly without fear of damage.

Accordingly, while having nothing to do with making its training implements work better as training equipment in terms of their realistic look and feel, the color red serves the vital, non-trademark safety function of having a single bright color

instantly denote that an item of law enforcement training equipment which is entirely so colored is a training implement and not an actual or standard issue firearm or other piece of equipment. It is therefore like the color black as applied to outboard marine engines, which was found in *British Seagull*, supra at 28 USPQ2d at 1199, to be functional not because it made the engines function better as engines, since the paint on the external surface of an engine does not affect its mechanical purpose, but due instead to the fact that the color black exhibited both color compatibility with a wide variety of boat colors and an ability to make objects appear smaller. Just as those advantages for customers created a competitive need for engine manufacturers to use black on outboard engines, the safety advantages from the use of the color red on training equipment mandates that the color red, as a color which has long been used for such purposes and is one of the best therefor, remain available to manufacturers of competitive law enforcement training equipment for their use in connection with such goods.

Furthermore, the record reveals that the color red is important to law enforcement personnel, as the end or ultimate consumers of training equipment, because it is the most commonly or frequently utilized color for identifying and distinguishing training implements from their actual or standard issue counterparts. As each of the 11 form declarations submitted by applicant from various police officers and training officials clearly emphasizes, "[p]eople in my line of work tend to be visually aware." It is thus plain that law enforcement personnel

are accustomed to and rely upon visual clues, and thus by the nature of their jobs would pay particular attention to and recognize a training weapon or other training equipment by the color red thereon, notwithstanding any de facto secondary meaning which they may also happen to afford that color as a result of applicant being the sole source of which they are aware for such specialized training implements.

Moreover, while at first blush it might seem that any of various shades of any contrasting color, that is, virtually any color other than the customary black, gray or silver colors of actual or real firearms, would serve the same safety function as the color red applied to the entire surface of a mock weapon or training item, a careful perusal of the record reveals that the color red is not only, as noted above, the color which many law enforcement personnel are accustomed to seeing used in connection with training equipment, but at a minimum it is also one of the best of a relatively limited number of bright colors which are suitable for such a safety purpose. This case is thus unlike, for example, the green-gold color used on the dry cleaning press pads in *Qualitex*, which served, as the Supreme Court observed therein, no other function except as a symbol to identify the press pads' source. Specifically, the Supreme Court noted that even though, as the District Court had found, it was important to use *some* color on press pads to avoid noticeable stains, there was no competitive need in the press pad industry for the green-gold color since other colors were equally usable.

Here, by contrast, in order to best achieve the need for high visibility, so that law enforcement officers can tell at a glance whether, for instance, a piece of equipment is a standard issue firearm or a mock training gun, bright red is one of only eight colors, namely, white, bright orange, bright yellow, bright green, bright blue, bright pink, bright purple and bright red, mandated by federal regulations and a New York City law for such a safety purpose. Bright red, which is a shade of the color red encompassed by the registration which applicant seeks, is thus one of only a relatively few colors which all makers of imitation or mock training firearms are required by law to use as a safety feature. Moreover, as noted previously, while applicant's utility patent does not specifically claim use of the color red, such patent does encompass claims for a training method in which the mock weapon used therein "includes an outer shell of a bright color clearly distinguishing it from said standard issue side arm weapon" (claim 3) and "is made of a material which is clearly distinguishable from the appearance of the standard issue side arm weapon" (claim 11), which would be the case with the use of a brightly colored material. Such patent clearly teaches that bright colors (which of course includes bright red), should be used on training weapons so that they are not confused with real weapons. Bright colors, as is plainly apparent from applicant's utility patent as well as both federal regulations and New York City law governing marking of imitation firearms, are essential safety features of replica or mock weapons. Thus, to bar others from the use of the color red,

which allowance of the registration which applicant seeks in effect would do, would put competitors of applicant in the field of hand-held plastic law enforcement training equipment at a significant non-reputation related disadvantage.

Tellingly, nowhere in either its initial or reply briefs does applicant deal with the requirements of federal regulations and New York City law that certain imitation or replica firearms, including mock training guns, be colored entirely in one of eight specific colors, including bright red. The record, instead, indicates that through a suit for trademark infringement, applicant has forced a competitor who, it would otherwise appear, was legitimately using the color red in connection with the entire surface area of its mock weapons to cease such use and switch to use of the color blue. In addition, although the extent of competitors' use thereof is not apparent, applicant has conceded, in its supplemental response to the Office Action of November 4, 1998, that "[w]hile other red training implements have appeared on the market, in each case the applicant has approached the manufacturer and the color of the product has been changed in light of applicant's trademark."⁹ Nonetheless, the fact that competitors have indeed used the color

⁹ Although applicant, in such response, refers to what it calls the "acquiescence of others" as constituting "clear evidence that the color [red] is not functional," the cessation of use of the color red by third-parties may be explained by the desire to avoid litigation rather than an acknowledgment of applicant's claim of proprietary rights therein. See, e.g., In re Wella Corp., 565 F.2d 143, 196 USPQ 7, 8 at n. 2 (CCPA 1977) [letters from competitors indicating discontinuance of use of mark upon threat of legal action show a desire to avoid litigation rather than distinctiveness of asserted mark].

red for their law enforcement training equipment, until forced by applicant to cease and desist such use, is further evidence that the color red is functional.

Finally, as to whether there are alternative colors available for similar uses by others, the record establishes that as a practical matter there is no other single distinguishing color which, like the color red, is equally desirable because the highly visible contrast it provides immediately differentiates a mock weapon or other training implement from a real weapon or other item of public safety equipment. Applicant insists, as indicated previously, that there is no competitive need for others to use the color red, pointing out among other things that the record reflects that its competitors "use or have used the single colors white, blue and black on their training implements." Such competitors, however, with respect to the use of the colors white and blue, are simply doing what federal regulations and New York City law mandate that they do with respect to marking mock or imitation weapons used for law enforcement training purposes. Specifically, as a safety feature, such goods must, as noted earlier, be colored either white or one of seven bright colors, namely, bright red, bright orange, bright yellow, bright green, bright blue, bright pink or bright purple. It thus appears on this record that all practical alternatives to, for instance, the use of a bright red color such as applicant uses for its goods are equally functional and, therefore, all must remain available for potential use by competitors. As a necessary corollary thereto, none of those

colors may legally be the subject of proprietary trademark rights. To recognize or allow applicant potential trademark rights in the color red, which issuance of a registration for such color on the Supplemental Register would do, would result in the anti-competitive effect of depriving others who seek to market training implements for law enforcement purposes, including mock or imitation weapons, from using a color required by law for safety reasons. Although, for instance, we note that the federal regulations also permit use of such colors "as the predominant color in combination with other colors in any pattern," it is intuitively obvious that marking training weapons in such a manner is economically less desirable, given the added costs and manufacturing steps, than using a single color applied to the entire surface area of the training implement.

We accordingly find that the record in this case shows that the color red, as applied to the entire surface of applicant's "hand-held nonfunctioning plastic training equipment in the shape of knives, radios, flashlights, pistols, rifles, handguns and shotguns for use in training law enforcement personnel," is functional. Such color is essential to the safe use of the goods and in fact is required by both federal regulations, issued prior to the date of first use claimed by applicant, and New York City law. In view thereof, there is a competitive need for the color red, as applied to the entire surface of training implements, to remain available for use by others in the trade because permitting the exclusive use of such a safety feature by applicant would hinder competition by putting

competitors at a significant non-reputation-related disadvantage. Plainly, if a municipality or other jurisdiction requires that mock firearms for use in law enforcement training be colored red, whether by deference to tradition or otherwise, competitors will be unfairly excluded if only applicant has the recognized exclusive right to use the color red in connection with the sale of such products. See, e.g., In re Orange Communications Inc., supra at 1042 [use of colors orange and yellow on the outer surfaces of pay telephones and telephone booths held functional since goods in such colors are more easily visible under virtually all lighting conditions in the event of an emergency]; and In re Howard S. Leight & Associates, Inc., supra at 1059-60 [use of the color coral on the entire surface of earplugs held functional because brightly colored earplugs are more readily visible and thus aid in monitoring employee compliance with health and safety regulations by enabling quicker and easier safety checks].

Decision: The refusal under Sections 23(c) and 45 is affirmed.