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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glaxo Group Limited

Serial No. 75/977,595

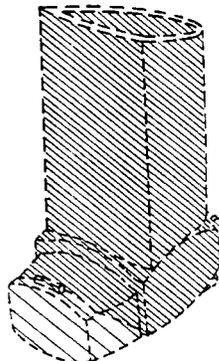
Thomas J. Moore of Bacon & Thomas for Glaxo Group Limited.

Teresa Rupp, Trademark Examining Attorney, Law Office 110
(Chris Pedersen, Managing Attorney).

Before Simms, Hanak and Rogers, 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 pharmaceutical preparations and substances for use in medical inhaler devices, in Class 5.¹

On November 22, 1994, applicant filed an application (Serial No. 74/602,027) on the basis of its bona fide intention to use the mark in commerce, under Section 1(b) of the Act, 15 USC §1051(b), for goods in Classes 5 and 10. Various amendments were submitted including a description of applicant's mark, 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.²

That application was published for opposition, and a notice of allowance was eventually issued. Applicant then filed a statement of use asserting use of the mark since March 31, 1994, on goods in both classes. The Examining Attorney then issued a refusal to register applicant's mark under Sections 1, 2 and 45 of the Act, 15 USC §§1051, 1052 and 1127, because the mark was considered mere ornamentation which did not function as a mark. Applicant argued that

¹ Application No. 75/977,595, created as a divisional ("child") application as a result of applicant's request to divide filed April 6, 1998, in application Ser. No. 74/602,027 ("parent").

² If applicant should prevail on appeal, the description of the mark should be amended to reflect that the colors are applied to the inhaler by which the goods are dispensed rather than the goods themselves.

its mark had acquired distinctiveness, although applicant did not formally amend this application to one under Section 2(f) of the Act, 15 USC §1052(f). After the Examining Attorney required applicant to make a formal amendment to proceed under Section 2(f), applicant argued that its mark was inherently distinctive or, in the alternative, had acquired distinctiveness.

Applicant subsequently filed a request to divide this application, and this appeal concerns only applicant's attempt to seek registration, under Section 2(f) of the Act, of its asserted mark for pharmaceutical preparations and substances for use in medical inhalers. With respect to applicant's attempt to register the same mark for medical inhalers for use in conjunction with an aerosol can, in Class 10, the Board on February 9, 2000, affirmed the Examining Attorney's refusal of registration, holding that the mark was not inherently distinctive. That decision is reported as *In re Glaxo Group Ltd.*, 53 USPQ2d 1920 (TTAB 2000).

It is the Examining Attorney's position in this case that the use of two colors or two shades of the same color on inhalers is a relatively common practice in the trade. This the applicant does not dispute. Because of the existence of various other colored inhalers, the Examining

Attorney argues that, in accordance with *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985), applicant has a heavy burden to establish public recognition of its colors as a trademark. It is the Examining Attorney's position that applicant's evidence of sales and advertising (1998 sales of over \$288 million and promotional expenses of \$30 million) is not sufficient to support applicant's claim of acquired distinctiveness. Among other things, the Examining Attorney observes that applicant's advertisements do not direct the purchaser's attention to the colors as a trademark for applicant's pharmaceutical preparations. There is little or no attempt to promote the color combination as a trademark for applicant's goods, according to the Examining Attorney. The Examining Attorney also argues that the apparent success of applicant's product could arise from a number of reasons including the effectiveness of applicant's goods, and that the sales and advertising figures may have nothing to do with the recognition of applicant's asserted mark as a trademark. Also, the Examining Attorney finds irrelevant and unpersuasive applicant's argument that it has successfully registered other similar marks in use since 1981 (for the colors light and dark blue and light and dark brown) based on evidence of acquired distinctiveness, such

evidence not being present in this case to demonstrate that this mark has acquired distinctiveness. Applicant must show that this asserted mark has acquired distinctiveness, according to the Examining Attorney.

Although one of applicant's promotional pieces notes, in small print, that "The Green-on-Green Inhaler Color Scheme is a trademark of the Glaxo Wellcome group of companies," it is the Examining Attorney's position that this statement does not rise to the level of promotion of color as a mark sufficient to permit registration under Section 2(f) of the Act. Such promotion is frequently referred to as "look-for" advertising.

Concerning the common use of color on inhalers, the Examining Attorney notes that there are at least two other entities which have used a light color/dark color combination on their inhalers (Proventil Inhalation Aerosol--light and dark yellow or orange, and Vanceril Inhaler--pink and red) and that others, according to pages from the Physicians' Desk Reference (51st ed. 1997), submitted by applicant, show use of the following color combinations:

Rhinocourt Nasal Inhaler -- purple and white
Alupent Inhalation Aerosol -- blue and white
Atroven Inhalation Aerosol -- green and white
Brethaire Inhaler -- yellow and white

Aerobid Inhaler System -- purple and white
Aerobid-M Inhalation System -- green and white
Intal Inhaler -- blue and white.

Because of the use by others of light and dark color combinations, the Examining Attorney argues that it is not reasonable to assume that purchasers recognize all light and dark color combinations as emanating from a single source. Finally, the Examining Attorney contends that there is no evidence that the doctors who prescribe, pharmacists who dispense or the patients and purchasing public who use applicant's goods, recognize applicant's color combination as a trademark.

It is applicant's position, on the other hand, that, in accordance with *Wal-Mart Stores, Inc. v. Samara Brothers, Inc*, 529 US ___, 54 USPQ2d 1065 (2000), product packaging, including applicant's inhalers (packaging) for the containers of pharmaceutical preparations which are placed into the inhalers, may be inherently distinctive.³

Applicant analogizes its color combination mark to the orange and blue colors applied to Tide detergent bottles, alluded to by the U.S. Supreme Court in the *Wal-Mart* case. According to applicant, therefore, since its mark is only

³ At the oral hearing, applicant's counsel argued that we must consider whether applicant's mark is registrable as inherently distinctive. However, applicant's appeal brief only presents the question of whether applicant's asserted mark has acquired distinctiveness.

"weakly non-distinctive," it need only show slight evidence of acquired distinctiveness. In this connection, applicant points to what it regards as the substantially exclusive and continuous use of its asserted mark since March 1994, as well as its annual sales and advertising figures.

Applicant notes that it already owns registrations covering goods in Classes 5 and 10 for the light blue/dark blue and light brown/dark brown color combinations. It is applicant's position that these registrations help establish a family of light color/dark color trademarks for inhalers and pharmaceutical preparations used therein.⁴

Applicant also notes that its brochures are often green in color and frequently depict the goods in two shades of green. With respect to the common trade practice for applicant and competitors to use two-color trade dress (brief, 9, 10, 11, 14-15) on their inhalers,⁵ applicant regards that as evidence that consumers are likely to view these differences as indications of origin or trademarks.

Applicant also states that the Physicians' Desk Reference

⁴ With respect to these registrations, the Examining Attorney argues that, although those registrations do not on their face reflect registration under Section 2(f), there were showings of acquired distinctiveness in those records. See TMEP §1212.03(b)(iv) for a recent change in Office policy in this regard.

⁵ According to applicant, six companies use two colors for nine different inhalers.

(PDR) prints a claim that the "appearance of this inhaler is a trademark of Glaxo Wellcome."

At the oral hearing, applicant acknowledged that refills of the canisters containing the goods (pharmaceutical preparations) may, in a significant number of instances, be purchased without the inhaler. To the extent that this happens, the medical inhaler would not be functioning as product packaging for the goods because it would not be sold with the preparations with which it is designed to be used. However, as the Examining Attorney has not stressed this as a possible reason for refusal, we merely note this fact.

Upon careful consideration of this record and the arguments, we conclude that applicant's showing of acquired distinctiveness is insufficient to permit registration under Section 2(f) of the Act. The Court of Appeals for the Federal Circuit stated in *In re Owens-Corning Fiberglas Corp.*, 227 USPQ at 422:

An evidentiary showing of a secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

Acquired distinctiveness in this case means that an asserted mark's primary significance is a designation of origin rather than simply ornamentation. This means that applicant's use of the colors light green and dark green on its inhalers must have come to be recognized as a trademark for the pharmaceutical preparations dispensed by the inhaler.

As we have noted, this record (including applicant's admissions) shows that it is common for companies to use two colors or two tones of a color on their inhalers. In this regard, the practices in the trade may be relevant in assessing applicant's burden of proving that its mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of ornamental matter frequently used in that industry so that consumers may be less apt to perceive source-indicating significance from these uses. See TMEP § 1202.04(b). In view of the fairly ordinary nature of the color scheme used by applicant, we believe that a commensurately greater amount of evidence is required to establish that this particular color scheme has acquired distinctiveness for applicant's inhalers. See *In re Boston Beer Co. Ltd. Partnership*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)(use of similar marks by others helps show that a mark has not acquired

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distinctiveness); *Levi Strauss & Co. vs. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."); *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1719-21 (TTAB 1998)(applicant did not show that the difference in appearance of its tire tread design is source-indicating, tire tread design being a mere refinement of common basic designs; purchasers of applicant's goods would regard pictures of the goods in ads as nothing more than illustrations of the product being offered for sale); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1217 (TTAB 1998)(use by others of a green background design); *In re Howard S. Leight and Associates Inc.*, 39 USPQ2d 1058, 1060 (TTAB 1996)("This record demonstrates that earplugs come in many colors. In fact, applicant also makes earplugs in blue and green. Where the use of colors is common in a field, an applicant has a difficult burden in demonstrating distinctiveness of its claimed color."); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1145 (TTAB 1990)("[W]e note that the record supports the statement

that it is relatively common in this field to use various colors for plastic medical and surgical instruments. Because of this fact, we believe that more evidence than applicant has submitted is necessary to show that green has become applicant's trademark. A difficult burden is usually present in demonstrating distinctiveness of a color mark under these circumstances... Since others have used this same color, albeit a different shade of the color green, the relevant public is less likely to view the color as an indicator of origin than as mere ornamentation lacking in trademark function."); and *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544 (TTAB 1996)(because ring designs are ordinary in nature, applicant has heavy burden to establish that designs have acquired distinctiveness and would not be regarded merely as ordinary arrangement of gems).

We agree with the Examining Attorney that, although it appears that applicant's color combination is slightly different from others used for inhalers, this record is insufficient to demonstrate that consumers now recognize applicant's asserted mark as an indication of origin.

Concerning applicant's sales and advertising figures, we agree with the Examining Attorney that, in the absence of persuasive promotion of applicant's two-toned green

inhaler as a mark for the canister containing the pharmaceutical preparations, applicant's mere use since 1994 and introduction of sales and promotional figures fail to show that the purchasing public has come to regard applicant's colored inhaler as a mark. Commercial success or popularity does not, without more, demonstrate acquired distinctiveness. See, e.g., *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990)(growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin); *In re Sunburst Products Inc.*, 51 USPQ2d 1843, 1848 (TTAB 1999); *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, *supra*; *In re Howard S. Leight and Associates Inc.*, *supra*, at 1060; *In re Semel*, 189 USPQ 285, 288 (TTAB 1975)("...in evaluating the significance of advertising figures... it is necessary to consider not only the extent of advertising but also whether the use of the designation [or design] therein has been of such a nature as to create in the minds of the purchasing public an association of the designation [or design] with the user and/or his goods").

We also note that some of the sales and advertising figures do not necessarily pertain to the L-shaped inhaler configuration shown in dotted lines on the application drawing. There is no evidence as to what portion of these

figures is attributable to the L-shaped inhaler, as opposed to the more recently introduced disc-shaped inhaler bearing these same two tones of the color green.⁶

There is simply no evidence concerning the effectiveness of applicant's efforts to make this color scheme its trademark. See, e.g., *In re Sunburst Products Inc.*, *supra*. Nor is there persuasive evidence of the promotion of applicant's asserted mark as a mark. In this regard, this case is not unlike *In re Pingel Enterprise*

⁶ At the oral hearing, applicant's counsel argued that registration of the mark shown in the drawing would allow applicant to claim rights in marks which would consist of the two shades of green, in varying proportions, on inhalers of either of these shapes, as well as other shapes. (But see *In re International Flavors & Fragrances, Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).) We disagree. The mark description clearly includes a statement that the configuration of applicant's inhaler shows "the positioning of the mark." Based on the description, "the mark" must be considered to be two shades of green, in particular proportions, applied to an L-shaped inhaler, as shown by the drawing.

The declaration attesting to sales and promotional figures references the mark as "DESIGN (Color only, Inhaler in Light Green and Dark Green)" and asserts that the figures are "for goods sold under the present mark." But for counsel's arguments at the oral hearing, we might have read this declaration to refer solely to the mark set forth in the drawing and description of record, i.e., that all sales and promotional figures were attributable to the two color mark on an L-shaped inhaler. However, in view of counsel's arguments at the oral hearing, and the evidence of record which shows that the disc-shaped inhaler was being sold during the last two of the six years covered by the sales and promotional figures, we now must read counsel's declaration as encompassing sales and promotion figures for both types of inhalers. Thus, counsel's failure to distinguish between the percentages of sales and promotional figures attributable to its different inhaler designs undercuts the probative value of the figures of record as evidence of acquired distinctiveness for the inhaler design shown in the drawing.

Inc., 46 USPQ2d 1811, 1822 (TTAB 1998), where the Board observed:

[T]he sole indications which we have been able to find in which applicant refers to and arguably promotes the design or appearance of its product as a trademark are contained in the statement, appearing in fine print on the back of the packaging for its petcock, that "The appearance of this valve is a trademark of Pingel Enterprise, Inc."...

...Even as to the so-called logo use of such design, purchasers and prospective consumers would regard the depiction of applicant's petcock configuration as nothing more than a graphical representation of applicant's product.

Furthermore, absent any advertising or other uses which promote the asserted trademark significance of applicant's petcock configuration, it is unlikely that purchasers and prospective consumers would even take notice of or appreciate the statements on applicant's packaging and installation instructions which claim that the appearance of its product is a trademark for a motorcycle fuel valve and filter.

Finally, with respect to the statement in small print under the picture of applicant's inhaler in the Product Identification Guide part of the PDR noting that the "appearance" of the inhaler is a trademark of applicant, we observe first that the word "appearance" is somewhat ambiguous and may be construed to refer to the configuration or product design of the inhaler rather than to its two-toned green color. Moreover, the Guide states that "This section is made possible through the courtesy of the manufacturers whose products appear on the following

pages." Further, the Foreword to the 54th edition (2000) of the PDR, of which we take judicial notice, notes that the book is published by Medical Economics Company in cooperation with participating manufacturers and that the function of the publisher is to compile, organize and distribute information. In addition, the Foreword states:

Each product description has been prepared by the manufacturer, and edited and approved by the manufacturer's medical department, medical director, and/or medical consultant... *Physicians' Desk Reference* does not assume, and expressly disclaims, any obligation to obtain and include any information other than that provided to it by the manufacturer.

Suffice it to say that it appears that the claim of trademark rights in the "appearance" of the inhaler was placed by applicant and not by the publisher as some kind of independent acknowledgment of trademark rights in applicant.

We conclude that applicant has not shown that its mark has become recognized as an indication of origin.

Decision: The refusal of registration is affirmed.