

MARKS OF DISTINCTION: RETHINKING
SECONDARY MEANING STANDARDS IN
TRADEMARK LAW AFTER
QUALITEX v. JACOBSON

I. INTRODUCTION: COLOR AND SECONDARY MEANING

The United States Supreme Court recently resolved a long-standing ambiguity in trademark law by holding that, under certain circumstances, a color could be validly registered as a federal trademark.¹ This holding resolved a split among the circuit courts, some of which had categorically held that “mere color” could never be a validly registered trademark² and some of which had allowed registration of pure color marks.³ At first glance, the *Qualitex* ruling might give the impression that the Court has “opened the floodgates” for manufacturers to attempt to register their colors as trademarks and obtain the benefits of trademark protection. Indeed, some practitioners and the author of at least one law review article have espoused this view.⁴ However, anyone rushing to capitalize on the apparent new judicial willingness to protect colors as trademarks will almost certainly⁵ face the daunting evidentiary

¹ *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995).

² See, e.g., *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990) (denying protection for blue color of Nutrasweet’s tabletop sweetener packets on the grounds that color alone could not function as a trademark).

³ See, e.g., *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993) (recognizing validity of trademark for blue-colored “leader splicing tape” used in process of developing film); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (allowing registration of pink color for home insulation as a trademark).

It is important to note at the outset that *Qualitex* dealt specifically with the issue of trademark registration for color alone; protection for unregistered marks is available under section 43(a) of the Lanham Trademark Act of 1946 (codified at 15 U.S.C. § 1125(a)(1994)). The relevant portion of section 43(a) provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

In determining the strength of a mark, courts must often examine the issue of secondary meaning to determine whether an original or allegedly infringing mark actually merits any protection. The clear prioritization of secondary meaning in *Qualitex* will likely have significant ramifications for cases addressing section 43(a) claims as well as cases involving registered marks. See *infra* note 6 for a general explanation of secondary meaning.

⁴ Elizabeth A. Overcamp, *The Qualitex Monster: The Color Trademark Disaster*, 2 J. INTELL. PROP. L. 595 (1995).

⁵ At least in theory, a color mark may be registered if it is “inherently distinctive.” That is, if the color itself—without any accompanying label, logo, or other mark—was somehow

burden of proving that the color mark has acquired secondary meaning.⁶ Proving secondary meaning can be an extraordinarily difficult task, and potential applicants for trademark registration may be further deterred by the glaring lack of uniform standards for the sufficiency and evaluation of such proof.⁷

In the wake of *Qualitex*, the issue of secondary meaning evidence should take on a new sense of urgency. The Court granted certiorari to *Qualitex*⁸ primarily to rule on the “mere color rule,” which the Ninth Circuit had invoked in denying trademark registration for *Qualitex*’s color mark.⁹ A unanimous Court came down

able to immediately identify and distinguish a given product without any further action by either the manufacturer or the marketplace, then the color would be eligible for registration without any showing of secondary meaning. In practice, such a scenario would be extremely rare, as the Court suggested in *Qualitex*. “[A] product’s color is unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs, which almost *automatically* tell a customer that they refer to a brand.” *Qualitex*, 115 S. Ct. 1300, 1303 (emphasis in original). However, developing or existing technologies may well produce “inherently distinctive” colors at some point.

⁶ “Secondary meaning” refers to the concept that a mark—such as a color—connected with a particular good or service has developed the ability to bring to mind a single, possibly unnamed “source” of that good or service among a relevant group of consumers upon seeing the mark. Although the idea of secondary meaning is a judicial creation, it was incorporated into section 2(f) of the Lanham Trademark Act of 1946: “[N]othing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f) (1994). Proving secondary meaning entails the presentation of evidence showing that the mark has developed “distinctiveness” to pertinent buyers in a particular market, who view the mark as representative of a single manufacturer. See *infra* text accompanying note 13 for the *Qualitex* Court’s definition of secondary meaning.

⁷ The following additional language of section 2(f) of the Lanham Trademark Act of 1946 constitutes the entirety of this (or any other) statute’s guidance on the issue of proving secondary meaning:

The Commissioner [of the United States Patent and Trademark Office] may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f). In other words, the trademark examiner would *have the option* of considering a mark distinctive after five years of sole and uninterrupted use by the applicant. This leaves the vast majority of cases with little or no statutory guidelines as to acceptable proof of secondary meaning. While courts have made considerable strides in identifying appropriate factors to consider in determining whether a mark has achieved a secondary meaning, the lack of uniform standards in this area has led to inconsistent results, prompting critics to observe that: “It is impossible to lay down any generalized rule as to the minimum amount of distinctiveness necessary to achieve secondary meaning in a mark.” 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15.10[1], at 44 (3d ed. 1995). The Patent and Trademark Office’s own internal guidelines for its examining attorneys state that “there are no quantifiable rules as to the kind and amount of evidence necessary to establish that a mark has acquired distinctiveness . . .” U.S. DEPT. OF COMMERCE, PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212.01, at 1212-2 (2d ed. 1993).

⁸ 115 S. Ct. 40 (1994).

⁹ 13 F.3d 1297, 1302-03 (9th Cir. 1994), *rev’d*, 115 S. Ct. 1300 (1995) (affirming district court’s finding of trade *dress* infringement—the wrongful appropriation of the overall appearance of *Qualitex*’s product, which had acquired secondary meaning—and its award of damages to *Qualitex*, but ordering the cancellation of *Qualitex*’s registered color trade-

unambiguously in favor of registering color per se—provided that the color is not “functional”¹⁰ and has acquired secondary meaning.¹¹ In so holding, the Court reaffirmed the definition of secondary meaning that it had first set forth in a 1982 case involving the color of prescription drug capsules: “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”¹² The Court

mark on the grounds that “the better rule is that a trademark should not be registered for color alone”).

Trade dress has been defined as “the totality of elements in which a product or service is packaged. These elements combine to create the whole visual image presented to customers and are capable of acquiring exclusive rights as a type of trademark or identifying symbol of origin.” J. THOMAS MCCARTHY, MCCARTHY’S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 337 (1991). For purposes of evaluating secondary meaning evidence, the same factors apply in both trademark and trade dress cases. See, e.g., PAF S.R.L. v. Lisa Lighting Co., 712 F. Supp. 394, 402 (S.D.N.Y. 1989) (“A trademark, or in this case trade dress, acquires secondary meaning when it can be demonstrated that consumers associate the product with a particular source.”); *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 4 (N.D. Ill. 1996) (“[A]s with trademarks and service marks, a product’s appearance is entitled to trade dress protection only if that appearance serves as a signifier of the product’s source.”); see also *infra* note 20 and accompanying text for further discussion of trade dress and the Supreme Court’s *Two Pesos* decision.

¹⁰ The Supreme Court in *Inwood Labs* defined a “functional” product feature as one “essential to the use or purpose of the article or . . . affect[ing] the cost or quality of the article.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850-51 n.10 (1982). A product feature may not be protected by trademark law if it is needed for the product to work properly or to be marketable. *Id.* If there are other viable alternatives that would allow the product to work just as well or to be sold as efficiently, then the feature is not functional and may be protected. *Id.* At trial, the defendant Jacobson unsuccessfully argued that the green-gold color in question was functional because it was needed to make the dry-cleaning press pads look better; without the coloring, the pads would stain. *Qualitex*, 115 S. Ct. at 1305. However, Jacobson had used a different color in the past, and other colors that served the same purpose were still readily available at no extra cost. *Id.* The district court concluded, based on these factors, that the color was not functional, and both subsequent appellate rulings accepted the following conclusions of law:

Qualitex’ [sic] green-gold mark is not functional . . . Color is not an inherent attribute or natural characteristic of the press pad, but instead is a feature added by Qualitex and other manufacturers. The color is not added to make the product work better, it is only added as an ornamental or aesthetic adornment, and to improve the appearance of the pad while being used.

Qualitex Co. v. Jacobson Products Co., 21 U.S.P.Q.2d (BNA) 1457, 1462 (C.D. Cal. 1991). The district court also noted that “[f]or decades, other manufacturers have used the colors lime green, grey, dark green, light blue, orange, peach, blue/grey and other colors on their press pads.” *Id.* at 1458.

Just a few days after the Supreme Court handed down its decision in *Qualitex*, it denied certiorari in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994), *cert. denied*, 115 S. Ct. 1426 (1995), thereby leaving intact the Federal Circuit’s ruling that the color black was functional for outboard motors made for boats (because it matched the colors of any boat and made boat motors look smaller) and thus was not eligible for trademark registration. Functionality remains an absolute barrier to trademark registration for colors or any other type of mark.

¹¹ *Qualitex*, 115 S. Ct. at 1303 (“We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained ‘secondary meaning’ and therefore identifies and distinguishes a particular brand (and thus indicates its ‘source’).”).

¹² *Inwood Labs.*, 456 U.S. at 850 n.11.

in *Qualitex* adopted this basic outline and refined it by emphasizing that secondary meaning generally evolves gradually: "over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—i.e. 'to indicate' their 'source'"¹³ In *Qualitex*, the facts of the case resembled a law-school hypothetical designed to illustrate an "easy" case of secondary meaning. For nearly thirty years, Qualitex sold green-gold pads that dry cleaners used to cover pressing machines. Qualitex was the acknowledged market leader, its pads were of a superior quality, and it advertised its pads at conventions and in dry-cleaning trade publications with displays and advertisements emphasizing the color of the pad.¹⁴ Many of its customers were not fluent in English,¹⁵ and they looked for the familiar green-gold color when buying the pads.¹⁶ When Jacobson, a Qualitex competitor, began manufacturing and marketing identically colored pads, the "likelihood of confusion"¹⁷ became readily apparent. Jacobson's continued use of the distinctive green-gold color would have exploited the goodwill that Qualitex had spent thirty years developing. Although the Ninth Circuit upheld the district court's injunction and recognized that Jacobson had engaged in unfair competition, Judge Hug's opinion asserted that Qualitex had adequate grounds for relief based on trade dress infringement,¹⁸ and the loss of protection for its newly invalidated trademark would be inconsequential.¹⁹ The Supreme Court opinion rejected that contention, noting that federal registration provided benefits that common law trademark and trade dress infringement remedies did not.²⁰

¹³ *Qualitex*, 115 S. Ct. at 1303.

¹⁴ These were among the district court's unchallenged factual findings. *Qualitex*, 21 U.S.P.Q.2d at 1457-58. During the thirty years that it used the color exclusively, Qualitex spent over \$1.6 million (a considerable amount in light of the relatively small size of the market for dry-cleaning equipment) in advertising the pads, which it sold under the name "SUN GLOW." *Id.* at 1459. Jacobson copied the unusual color exactly and sold its pads beginning in 1989 under the name "MAGIC GLOW." *Id.* at 1458.

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ "Likelihood of confusion" is a term of art referring to a determination as to "whether [a] substantial number of ordinarily prudent purchasers are likely to be misled or confused as to source of different products." BLACK'S LAW DICTIONARY 925 (6th ed. 1990). In this case, Qualitex presented evidence of *actual* confusion, which, although technically unnecessary to prove likelihood of confusion, may certainly make a court more inclined to find a likelihood of future confusion.

¹⁸ See *supra* note 9. 15 U.S.C. § 1125(a) [§ 43(a) of the Lanham Act], in addition to serving as a basis for trademark infringement claims stemming from any "false designation of origin," also applies to trade dress infringement actions.

¹⁹ See *supra* note 9.

²⁰ Trademark law helps the holder of a mark in many ways that 'trade dress' does not. See 15 U.S.C. § 1124 (ability to prevent importation of confusingly similar

The overriding message of *Qualitex*, though, is simply that, for purposes of registration, color should not be treated differently than other types of marks. In addressing Jacobson's claim that "shade confusion" would tremendously complicate the efforts of courts trying to decide disputes over color marks, Justice Breyer pointed out that courts regularly decide similar and equally complex issues: "We do not believe, however, that color, in this respect, is special. Courts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers."²¹ A straightforward reading of *Qualitex* would then suggest that in deciding cases involving color marks, courts should employ the same analytical methods they would normally use to decide other types of trademark cases. Since a large number of such cases ultimately turn upon the question of whether plaintiffs have established secondary meaning for their marks, courts and the business world would greatly benefit from consistent general guidelines for the sufficiency of secondary meaning evidence. Although *Qualitex* clearly delineates what secondary meaning is, the opinion says virtually nothing about how to go about proving it. Part II of this Note examines the inconsistent case law pertaining to the evaluation of secondary meaning evidence. Part III proposes that more weight be accorded to certain kinds of secondary meaning evidence in order to make judicial determinations as to the existence of secondary meaning more equitable and consistent.

goods); 15 U.S.C. § 1072 (constructive notice of ownership); 15 U.S.C. § 1065 (incontestable status); § 1057(b) (prima facie evidence of validity and ownership). Thus, one might easily find reasons why the law might provide trademark protection in addition to trade dress protection.

Qualitex, 115 S.Ct. at 1308. This marked prioritization of trademark protection over trade dress protection came on the heels of the Court's 1992 holding in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). The case involved a trade dress dispute between two Mexican restaurants, each of which had a very similar and distinctive decor that functioned as protectable trade dress. *Id.* at 765-66. The Court, in finding trade dress infringement, held that in trade dress cases (as in trademark cases), as long as the disputed trade dress is not functional, a finding of inherent distinctiveness obviates the need for proving secondary meaning. *Two Pesos*, 505 U.S. at 769, 774. This resolved a circuit split, since some circuits—including the Second Circuit—had previously required proof of secondary meaning even if a trade dress was shown to be inherently distinctive. The Court in *Two Pesos* opted to treat trade dress the same way that trademarks were already being treated in this regard: "There is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to [trademark] infringement suits under § 43(a) [of the Lanham Act]." *Id.* at 770. In other words, an inherently distinctive trade dress does not need secondary meaning to merit protection, just as an inherently distinctive trademark does not need secondary meaning to be validly registered. See *infra* note 25 for a discussion of a disturbing recent trend, in which some courts have begun to question the closely analogous nature of trademark and trade dress law strongly suggested by both *Two Pesos* and *Qualitex*.

²¹ *Qualitex*, 115 S. Ct. at 1305.

II. WHEN DOES SECONDARY MEANING MATTER?

Before examining situations in which courts have and have not found secondary meaning, a preliminary clarification is necessary: not all trademark infringement actions involve secondary meaning. However, courts often need to decide whether two or more marks are apt to create a likelihood of confusion for buyers.²² By now, every circuit in the country has developed its own formal criteria for evaluating whether there is a likelihood of confusion between marks.²³ Before *that* inquiry begins, however, a court must first decide whether a likelihood of confusion would even matter at all, since some marks are ineligible for trademark registration under any circumstances. The basic approach to this issue was defined by the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,²⁴ which set forth four categories—now universally recognized—bearing on the registrability of marks. The four categories are “[a]rrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.”²⁵ Generic marks can never be

²² See *supra* note 17.

²³ For a comprehensive list of the likelihood of confusing factors in each circuit, see DORIS E. LONG, UNFAIR COMPETITION AND THE LANHAM ACT 55-64 (1993). The first and by far the most influential set of criteria was formulated by the Second Circuit in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961). In that case, Polaroid knew of and ignored the much smaller company's use of the similar name for eleven years, until that company's business expanded substantially. *Id.* at 493-94. In holding that there was no likelihood of confusion (mainly because the two businesses were largely non-competing and Polaroid waited so long to sue), the court enumerated what have come to be known in the Second Circuit and elsewhere as the oft-cited “*Polaroid* factors”:

Where the products are different, the prior [trademark] owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and . . . defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.

Id. at 495. Every circuit now employs at least some of the *Polaroid* factors in some fashion; many circuits have cited them approvingly in formulating their own factors.

²⁴ 537 F.2d 4 (2d Cir. 1976).

²⁵ *Id.* at 9. The Second and Third Circuits have recently begun to test the limits of the analogous nature of trademarks and trade dress described in *Two Pesos* and *Qualitex* by positing that the *Abercrombie & Fitch* categories cited in the text (which had essentially been adopted by every circuit in assessing the likelihood of confusion in both trademark and trade dress cases and cited prominently in *Qualitex*) should be discarded in trade dress cases analyzing the likelihood of confusion between product configurations. The first such attack on the *Abercrombie & Fitch* categories came in a pre-*Qualitex* case, *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994). The court stated that:

[W]e do not think it helpful or proper to transplant the categorical distinctiveness inquiry developed for trademarks to product configurations, where the alleged trade dress lies in the very product itself The difficulty is that, perhaps unlike product packaging, a product configuration differs fundamen-

tally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product). Being constitutive of the product itself and thus having no such dialectical relationship to the product, the product's configuration cannot be said to be "suggestive" or "descriptive" of the product, or "arbitrary" or "fanciful" in relation to it [W]e conclude that the trademark taxonomy, carefully and precisely crafted through a long succession of cases to accommodate the particularities of trademarks, does not quite fit the different considerations applicable to product configurations.

Duraco, 40 F.3d at 1440-41. In a footnote, the *Duraco* court qualified its radical departure from universally cited precedent: "We do not suggest that the same taxonomy might not be efficacious in the context of product packaging." *Id.* at 1441 n.8. One might be tempted to dismiss this holding as an aberration. After *Qualitex*, which applied the *Abercrombie & Fitch* categories almost as a matter of course in dealing with product color, and suggested that a similar analysis of secondary meaning would apply equally to a product's packaging, one would think that the relevance of the categories to product configuration trade dress cases would be a settled issue. However, in a rather stunning turn of judicial events, a Second Circuit panel recently cited *Duraco* with approval and went on to endorse and expand upon *Duraco's* distinction between product packaging and product configuration trade dress analysis. *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007 (2d Cir. 1995). The court announced that the *Abercrombie & Fitch* categories:

[n]ot only . . . make little sense when applied to product features, but . . . [applying the categories to them] would have the unwelcome, and likely unintended, result of treating a class of product features as "inherently distinctive," and thus eligible for trade dress protection, *even though they were never intended to serve a source identifying function.*

Knitwaves, 71 F.3d at 1008 (emphasis added). According to the *Knitwaves* court then, there could be no inherent distinctiveness in the absence of an intent to use the product feature as a source indicator. *Id.* The court cited *Qualitex* in support of its newly created "intent" requirement:

[Color alone is] capable of satisfying the more important part of the statutory definition of a trademark, which requires that a person "us[e]" or "inten[d] to use" the mark "to identify and distinguish his or her goods from those manufactured or sold by others and to indicate the source of the goods . . ." *Qualitex*, 115 S. Ct. at 1303 [quoting 15 U.S.C. § 1127].

The Second Circuit's reading of both *Qualitex* and the statutory language on this point is fundamentally flawed in its reliance on "intent"; the word in the amended Lanham Act merely allows applicants to file notice of an "intent to use" a mark or dress before it is actually used in commerce, as it must be in order to merit registration on the principal register of the Patent and Trademark Office ("PTO"). 15 U.S.C. § 1051(b) is captioned "Trade-marks intended for use in commerce" and reads in relevant part: "[a] person who has a bona fide intention . . . to use a trademark in commerce may apply to register the trademark . . . [b]y filing . . . a written application . . . specifying applicant's bona fide intention to use the mark in commerce . . ." 15 U.S.C. § 1051(b) (1994). Apparently, the Second Circuit in *Knitwaves* ignored or overlooked the fact that the word "intent" in § 1127's definition of the term "trademark" refers to a mark for which an intent-to-use application has been filed. There is no requirement stating that an applicant *must* file such an application; it merely affords applicants the opportunity to do so if they wish to begin the application process and lay the groundwork for a possible priority of use claim before actual use of a mark in commerce. Therefore, there can be no reasonable inference that the Trademark Act mandates any "intent" on the part of applicants. In fact, a situation may well arise in which a product feature quickly but unexpectedly serves to distinguish a manufacturer's goods, and the manufacturer consequently decides to attempt to register it with the PTO. Under the *Knitwaves* scheme, this would not be possible. Fortunately, a backlash has already begun to take shape. See *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 606 (S.D.N.Y. 1996) ("*Knitwaves* seems to instruct that a design can serve only one primary purpose: either aesthetic or source-identifying, but not both. This approach is neither helpful nor logical I see no need to force the courts to choose between ideas that are not mutually exclusive."); see also *Stuart Hall Co. v. Ampac Corp.*, 51 F.3d 780 (8th

registered as trademarks,²⁶ and, although this makes intuitive sense, whether or not a given mark is generic is not always obvious. For example, marks such as “CHOCOLATE MILK” or “LAMP SHADE” are clearly generic and unregistrable, but what about the mark “LITE” for beer?²⁷ Once a court determines that a mark is generic the mark cannot be protected as proprietary to one party. Thus, the mark is not inherently distinctive, nor can it acquire secondary meaning. As the court noted in *Abercrombie & Fitch*:

No matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.²⁸

On the other extreme of the registrability spectrum, arbitrary or fanciful marks are protectable without any showing of secondary meaning.²⁹ Again, common sense supports this rule. If a mark is completely unrelated to the product—and perhaps totally incongruous with typical expectations of or associations with the product—then clearly the mark serves absolutely no purpose except to distinguish one particular brand of goods or services from another. If someone were to apply the mark “CATFISH” to a line of automo-

Cir. 1995) (rejecting the *Duraco* abandonment of the *Abercrombie & Fitch* categories for product configuration).

²⁶ Citing to sections 2(e) and 14(c) of the Lanham Act (15 U.S.C. §§ 1052(e) and 1064(c)), the Supreme Court stated that:

Marks that constitute a common descriptive name are referred to as generic. A generic term is one that refers to the genus of which the particular product is a species. Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.

Park 'N Fly, Inc. v. Dollar Park And Fly, 469 U.S. 189, 194 (1985) (citations omitted). Note that despite the somewhat misleading portion of Justice O'Connor's definition of generic terms as those that are “common descriptive name[s],” descriptive marks are a separate, more protectable category that may be registered if they acquire distinctiveness. Justice O'Connor distinguishes this latter type of mark by calling it “merely descriptive,” but the term “descriptive” is commonly used by courts and practitioners without any adjectives attached.

²⁷ See *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5 (1st Cir. 1981) (holding that “LITE” is generic for beer, despite large sales figures and advertising campaigns). Interestingly, a number of words that most people now assume were always generic actually began as trademarks that were not adequately policed by their owners; the most notable example is “ASPIRIN.” See *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

²⁸ *Abercrombie & Fitch*, 537 F.2d at 9.

²⁹ “Arbitrary or fanciful terms bear no relationship to the products or services to which they are applied. Like suggestive terms, arbitrary and fanciful marks are protectable without proof of secondary meaning.” *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983) (emphasis in original). The Court in *Qualitex* noted that “a product's color is unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs, which almost automatically tell a customer that they refer to a brand.” 115 S. Ct. at 1303 (emphasis in original). The Court went on to explain that the color in question was analogous to a descriptive mark that had acquired secondary meaning and was thus registrable. *Id.*

tive spark plugs, that mark would be arbitrary and fanciful, and thus "inherently distinctive"; there would be no need to wait for it to *acquire* distinctiveness via consumer association of the mark with the source. A manufacturer choosing to market "CATFISH" spark plugs presumably does so for the sole purpose of making its chosen brand name distinctive and memorable to the buying public. Of course, this would not be true in the case of swimming wind-up toys shaped like catfish, because then the mark would be descriptive at best, and possibly even generic. The mark "CATFISH" is a rather obvious choice for the latter type of product, and nothing about the mark would clearly set apart one manufacturer's fish-shaped toys from another's; the mark would unquestionably be generic if applied to actual catfish.

Suggestive marks are one notch below arbitrary and fanciful marks,³⁰ but they too qualify for trademark registration without secondary meaning.³¹ Such marks are not so far removed from the product as to be arbitrary or fanciful, but they require some sort of imaginative connection between the mark and the product.³² The exceptionally fact-specific nature of this type of mark makes it relatively rare; an example would be "*GEZUNDTHEIT*" for tissues.

Descriptive marks say something about the products or services with which they are connected—but they do not simply identify them the way generic marks do. For example, the marks may describe something about a product's appearance or about the way it works. Descriptive marks require proof of secondary meaning in order to merit trademark registration³³ and will be the focus of discussion. Not surprisingly, heated litigation has centered on the issue of whether a contested mark is descriptive of a product or creatively detached from it, and thus more readily protectable as

³⁰ "Suggestive marks . . . may be thought of as a middle ground between arbitrary or fanciful names and descriptive names." *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 378 (7th Cir. 1976).

³¹ A *suggestive* term suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services. A suggestive mark is protected without the necessity for proof of secondary meaning.

Zatarains, 698 F.2d at 791 (citations omitted).

³² "A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 587 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merchants & Mfrs. Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

³³ "A 'merely descriptive' mark . . . describes the qualities or characteristics of a good or service, and this type of mark may be registered only if the registrant shows that it has acquired secondary meaning, i.e. it 'has become distinctive of the applicant's goods in commerce.'" *Park 'N Fly*, 469 U.S. at 193-94 (1985) (quoting 15 U.S.C. §§ 1052(e), (f)).

suggestive or arbitrary. For all practical purposes, arbitrary or fanciful marks and suggestive marks may be viewed as “inherently distinctive”; these marks may therefore be validly registered without secondary meaning.³⁴

III. SECONDARY MEANING EVIDENCE FOR APPEARANCE-RELATED MARKS AND TRADE DRESS

When confronted with any disputed mark, courts evaluating proof of secondary meaning must essentially decide what the mark means to the relevant sector of the purchasing public. The Supreme Court first undertook this difficult task in a 1942 case, *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*³⁵ In that case, a shoe manufacturer placed its trademark directly on its product. The mark “consisted of a red circular plug embedded in the center of a heel . . . [and the company] has spent considerable sums of money in seeking to gain the favor of the consuming public by promoting the mark as an assurance of a desirable product.”³⁶ The defendant sold inferior-quality heels (separately from shoes) that featured similar red plugs, and its main defense was that Mishawaka had failed to prove any instances of actual confusion.³⁷ In other words, there was no evidence that any customer had actually mistaken Mishawaka’s heels for Kresge’s, or vice versa. Nevertheless, the Court held that the proper test was likelihood of confusion—rather than actual confusion—and also held that the buyers’ association with (*i.e.* the secondary meaning of) the mark was the most important factor in deciding whether a likelihood of confusion was present.³⁸ Given the primacy of the buyer’s mental con-

³⁴ See *Two Pesos, Inc.*, 505 U.S. at 768 (“The latter three categories of marks [suggestive, arbitrary, and fanciful], because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.”).

³⁵ 316 U.S. 203 (1942).

³⁶ *Id.* at 203-04.

³⁷ *Id.*

³⁸ Justice Frankfurter wrote:

The protection of trade-marks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. *Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.*

Id. at 205 (emphasis added). For a more recent case protecting a color mark on sneakers, see *Keds Corp. v. Renee Int’l Trading Corp.*, 888 F.2d 215 (1st Cir. 1989) (holding that a “blue rectangular rubber label” on sneakers was non-functional and validly registered as a trademark).

nections between the mark and the product (and *not* merely the buyer's spending habits), it logically follows that actual confusion is superfluous. Similar points were made by Judge Learned Hand in an earlier Second Circuit opinion, which may be the earliest articulation of secondary meaning.³⁹ In deciding that a wrench manufacturer was not entitled to an injunction against the maker of similar-looking wrenches, the court described a common type of situation that secondary meaning doctrine still seeks to avoid: the appropriation of a mark that has acquired secondary meaning.⁴⁰

Exactly how and when does a mark acquire secondary meaning and the benefits that come with that legal label? Courts have used varying lists of factors, but the overriding goal of an equitable outcome clearly influences many secondary meaning decisions as well. One very frequently cited case amply illustrates this point: *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*⁴¹ That case involved a pornographic film featuring an actress who wore "a uniform closely similar to that of the Dallas Cowboy Cheerleader uniform."⁴² In holding that the film (and its marquee displays and newspaper ads) violated the Lanham Act's prohibition against false

³⁹ *Crescent Tool Co. v. Kilborn Bishop Co.*, 247 F. 299 (2d Cir. 1917).

⁴⁰ [When a product] has become associated in the public mind with the first comer as manufacturer or source, and, if a second comer imitates the article exactly . . . the public will believe his goods have come from the first, and will buy, in part, at least, because of that deception. Therefore it is apparent that it is an absolute condition to any relief whatever that the plaintiff in such cases show that the appearance of his wares has in fact come to mean that some particular person—the plaintiff may not be individually known—makes them, and that the public cares who does make them, and not merely for their appearance and structure.

Id. at 300. Plaintiff Crescent Tool failed to make an evidentiary showing of this sort and lost accordingly. *Id.* at 301. In addition to providing a lucid and insightful definition of secondary meaning, Judge Hand anticipated an additional and crucial point of law that was not widely accepted for decades: that consumers only need to associate the product or service with a single anonymous source. *Id.* at 301. This concept has since been codified in 15 U.S.C. § 1127 (1994), which defines a trademark as "any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

Note that the latter part of the secondary meaning definition here, involving the public's "caring" about the mark and buying the product because of it, is not generally considered to be normative. See Vincent N. Palladino, *Surveying Secondary Meaning*, 84 TRADEMARK REP. 155, 161 (1994). Nevertheless, the Seventh Circuit recently demonstrated that it still requires evidence that consumers "care":

It is not enough that the consumers associate the form of the product with a particular producer Consumers must also care that the product comes from a particular producer (though they need not be able to identify him) and must desire the product with the particular feature because it signifies that producer.

Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 658-59 (7th Cir. 1995).

⁴¹ 467 F. Supp. 366 (S.D.N.Y. 1979).

⁴² *Id.* at 371.

designations of origin,⁴³ the court held that the uniform was inherently distinctive.⁴⁴ In dicta (since the issue of secondary meaning had no bearing on the disposition of the case after the finding of inherent distinctiveness), the court went on to assert that the uniform had also acquired secondary meaning.⁴⁵ Although the court had alluded in general terms to the fame of the Cheerleaders, only scant evidence of secondary meaning surfaced in the opinion.⁴⁶ The court in *Dallas Cowboys Cheerleaders* largely presumed public familiarity with the Cheerleaders and their uniforms. While the presumption may indeed have been factually correct, the lack of a more precise analysis here is symptomatic of a larger problem: there are no guidelines for courts to rely upon in evaluating secondary meaning evidence.

“Looking For” Secondary Meaning

A more methodical approach to examining secondary meaning claims was followed in *In re Hehr Mfg. Co.*⁴⁷ In this much earlier case, the court recognized the inherent difficulty of establishing rigid rules for secondary meaning,⁴⁸ but still examined all the rele-

⁴³ 15 U.S.C. § 1125(a); see *supra* note 3.

⁴⁴ I reject these [functionality] arguments. It is true, of course, that the Dallas Cheerleaders uniform serves the function of clothing However, the specific elements of the uniform—their [sic] color, design, and ornamentation—are distinctive and arbitrary, and thus susceptible of becoming a valid trademark and service mark.

Dallas Cowboys Cheerleaders, 467 F. Supp. at 373.

⁴⁵ The evidence shows that plaintiff, through promotion and use of the uniform, has established a strong identification between the uniform and the particular entertainment furnished by the Dallas Cowboys Cheerleaders, as distinct from cheerleading or other entertainment furnished by other parties, and also identifying the particular products licensed by plaintiff. Thus, the evidence shows that the uniform has acquired a secondary meaning associated with the Dallas Cowboys Cheerleaders.

Id. at 373.

⁴⁶ The only specific, concrete numbers relating to the development of secondary meaning in the uniform are that from 1972 (when the Cheerleaders “came into being”) until the time of the case, the Cheerleaders had performed “at about 90 professional football games” and that “there have been about 150 to 200 personal appearances per year at such functions as sporting goods shows and openings of shopping malls.” *Id.* at 370. The court also made several references to the “substantial revenues” generated by the personal appearances and television appearances and the sale of licensed merchandise, and an additional reference to the “substantial effort and care to promote the popularity of the Dallas Cowboys Cheerleaders and to give them a particular public image.” *Id.* at 370. The court provided no further details in this regard, but it did devote much space to the seedy details of the infringing film. *Id.* at 371. One suspects that a judicial distaste for pornography exploiting a popular fad had something to do with the unnecessary and inadequately supported finding of secondary meaning here.

⁴⁷ 279 F.2d 526 (C.C.P.A. 1960).

⁴⁸ With respect to the degree of proof required to establish secondary meaning sufficient to identify an applicant’s goods, the statute [the Lanham Act] is silent except for the suggestion that substantially exclusive use for a period of five years . . . may be considered prima facie evidence. Congress has chosen to

vant evidence in a way that addressed the issue of buyer association. The Trademark Trial and Appeals Board ("TTAB") of the Patent and Trademark Office had denied Hehr's application to register its square red labels on mobile homes as trademarks, on the grounds that they were not distinctive.⁴⁹ The court here reversed, holding that the labels had acquired secondary meaning by virtue of Hehr's advertising, which "repeatedly emphasized the shape and color of the Red Square per se as a trademark identifying . . . [its] goods. Over the years, some \$112,000 has been spent in advertisements, of which amount \$30,000 is directly attributable to having the Red Square . . . printed in the color red wherever possible."⁵⁰ Additionally, the court was careful to note that many of the ads had "slogans stressing the Red Square as an identifying trademark . . . [including] phrases such as 'Always Look for the Red Sticker,' 'Look for these red stickers, they are your guide to quality.'"⁵¹ Even though inflation and current printing technology make the advertising expenditures and methods described in this case seem small, Hehr was, in a sense, a model plaintiff for secondary meaning purposes. In light of the relatively limited market for mobile homes generally, Hehr was certainly unlikely to achieve national fame and media exposure. Nevertheless, it did all the right things by advertising heavily (by 1960 standards) and persistently linking its mark to itself as manufacturer in the ads, thereby cultivating secondary meaning with each consumer exposure.

Secondary Meaning Via Unavoidable Media Blitz: The Pink Panther Case

A more recent and better-known "model plaintiff" was Owens-Corning Fiberglas, the company that advertised its pink insulation with numerous television, radio, and print ads featuring the "Pink Panther" cartoon character.⁵² The Federal Circuit in *Owens-Corning* reversed the TTAB's denial of registration for the pink color as applied to residential insulation. The TTAB had found that

leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts.

Id. at 528.

⁴⁹ *Id.* at 527. The labels included phrases such as "A New Hehr Mobile Home Window," or featured Hehr's logo surrounding the words "Trailer Windows" or "No Draft Vents." *Id.*

⁵⁰ *Id.* at 528.

⁵¹ *Id.* at 527.

⁵² *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985). In retrospect, it can reasonably be said that this case, by creating a circuit split on the issue of registrability for color per se, started the chain of judicial events that led directly to the definitive resolution of the issue in *Qualitex*.

Owens-Corning failed to present sufficient evidence that its color mark had developed secondary meaning, because no breakdown was given as to what percentage of advertising expenditures were specifically devoted to promoting the mark.⁵³ The Federal Circuit disagreed, noting that no such breakdown was necessary, especially in light of the very large size of the advertising expenditures in this case.⁵⁴ Aside from evidence of extensive spending on advertisements, Owens-Corning also submitted survey evidence indicating that forty-one percent of homeowners identified Owens-Corning as the maker of pink insulation; another survey taken shortly after an increased television advertising campaign showed that the "recognition rate" rose to fifty percent.⁵⁵ In response to the concerns expressed by the TTAB and the dissent⁵⁶ about the lack of a detailed breakdown of the precise expenditures devoted to the promotion of the color per se, the court listed a number of the slogans and tag lines used in the ads, including "Put Your House in the Pink"; the court even cited excerpts from a thirty-second radio ad that mentioned the word "pink" at least eight times.⁵⁷

Hehr and *Owens-Corning* were unusual cases in the sense that the companies involved were actually seeking declaratory relief rather than suing alleged infringers. Also, there was little question that the marks in those cases were highly "source-indicating"; the main point of contention in each was whether enough evidence supported the claim that the mark had successfully conveyed the message to enough consumers. The *Dallas Cowboys Cheerleaders* case was also atypical, since the pornographic film was mainly a reputation-related concern for the Cheerleaders, and no meaningful competition was taking place between them and the makers of the film. Most of the time, secondary meaning issues arise in common trademark infringement actions such as *Truck Equipment Service Co.*

⁵³ *In re Owens-Corning Fiberglas Corp.*, 221 U.S.P.Q. (BNA) 1195 (T.T.A.B. 1984).

⁵⁴ *Owens-Corning*, 774 F.2d at 1125. Owens-Corning spent \$42,421,000 on advertising in television, radio, and print media between 1956 and 1984, with \$11,400,000 of that coming in the period between 1971 and 1981. *Id.* It spent *additional* money "on brochures, displays, and other promotional items that highlighted the 'pink' color as applied to . . . [its] insulation." *Id.* Its advertising schedule revealed that Owens-Corning's "Pink Panther" ads ran during television programs with some of the largest national audiences, including the *Rose Bowl* and *Sixty Minutes*, as well as first-run network broadcasts of *M*A*S*H** and *Magnum, P.I.* *Id.* at 1126.

⁵⁵ *Id.* at 1127.

⁵⁶ *Id.* at 1128-32. Judge Bissell's dissent in *Owens-Corning* offers a forceful defense of the "mere color rule," on the grounds of "shade confusion" and other policy problems, but the dissent also asserts that the TTAB was correct in its determination that the descriptive pink mark was not adequately supported by secondary meaning evidence. *Id.* at 1130. In particular, Judge Bissell faults Owens-Corning for failing to provide a color-specific breakdown of expenditures.

⁵⁷ *Id.* at 1126.

*v. Fruehauf Corp.*⁵⁸ Truck Equipment (“TESCO”) made grain-sifting machines with an unusual design and appearance, which Fruehauf copied for its own machine.⁵⁹ The court ruled that the design was not functional⁶⁰ and that, due in large part to its unusual appearance, it had acquired secondary meaning.⁶¹ Again though, in the same problematic way discussed earlier, the court here inferred secondary meaning based on little evidence outside of its own observations.

Best Sellers, as Advertised: Evidence of Large Advertising Expenditures and High-Volume Sales in the Hawaiian Punch and Harlequin Cases

Conversely, the court in *RJR Foods, Inc. v. White Rock Corp.*⁶² relied principally on evidence of consumer survey results and advertising expenditures to uphold the district court’s finding that the label design for “Hawaiian Punch” had achieved secondary meaning for its trade dress.⁶³ During the two years before the trial, RJR had spent \$36,000,000 advertising Hawaiian Punch; perhaps the best indication that this large investment bore fruit was that “two-thirds of the persons contacted by the [survey] researchers identified as Hawaiian Punch an Hawaiian Punch can with the [brand] name, the character ‘Punchy,’ and the words ‘Fruit Punch’ and ‘with 7 real fruit juices and other natural flavors’ removed.”⁶⁴ This evidence clearly demonstrated that RJR had effectively bombarded the public with the Hawaiian Punch trade dress, to the point where a clear super-majority of customers was able to identify it as emanating from the makers of Hawaiian Punch without any visual clues that would aid someone who had never seen the design. Indeed, assuming that the survey was validly conducted and that its results were properly tabulated, this evidence practi-

⁵⁸ 536 F.2d 1210 (8th Cir. 1976).

⁵⁹ *Id.* at 1213.

⁶⁰ *Id.* at 1217.

⁶¹ *Id.* at 1220. The design of TESCO’s machine was “dissimilar from any other hopper bottomed grain trailer on the market. *The trailer was purposely so designed to serve as a badge of identification in the public mind.*” *Id.* (emphasis added).

⁶² 603 F.2d 1058 (2d Cir. 1979).

⁶³ *Id.* at 1060. Before the Supreme Court’s 1992 ruling in *Two Pesos*, the Second Circuit required proof of secondary meaning even for inherently distinctive trade dress in order to grant trademark protection under section 43(a) of the Trademark Act. RJR had no trouble showing that its Hawaiian Punch trade dress was inherently distinctive, and so the bulk of the case deals with the secondary meaning issue. *Id.* at 1059-61. For a fuller discussion of the Second Circuit’s erstwhile secondary meaning requirement for inherently distinctive trade dress, see *Stormy Cline Ltd. v. Progroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987).

⁶⁴ *RJR Foods*, 603 F.2d at 1059.

cally compels the factual conclusion that most people have been exposed to the design and internalized it as being representative of the products of a single source. The court here recognized that the trial court had acted appropriately in admitting and considering the survey and expenditure evidence in arriving at a determination of secondary meaning: "the district judge properly considered evidence of plaintiff's extensive advertising and sales The results of the research study could also be accepted as probative."⁶⁵

Drawing on similar principles but less weighty evidence, the Second Circuit found secondary meaning for romance novel covers in *Harlequin Enterprises Ltd. v. Gulf & Western Corp.*⁶⁶ In this case a Gulf & Western subsidiary, Simon & Schuster, was sued by the market leader in romance novels for allegedly copying its cover design.⁶⁷ In doing so, Harlequin claimed, Simon & Schuster attempted to cash in on Harlequin's goodwill by tricking unsuspecting and inattentive consumers into buying a book from Simon & Schuster's newer "Silhouette Romance" series, rather than one from the "Harlequin Presents" series.⁶⁸ In holding that the covers for the "Harlequin Presents" series had acquired secondary meaning, the court cited familiar factors such as advertising expenditures, sales of the product, and a survey.⁶⁹ The court further noted that "extensive, unsolicited media coverage further supports the district court's finding of secondary meaning,"⁷⁰ and also that, despite the presence of other persuasive evidence, "[p]erhaps the most significant evidence of secondary meaning in this case,

⁶⁵ *Id.* at 1060. Note the barely implicit value judgment the court makes in stating that survey evidence "could also be accepted"—it probably reflects a healthy judicial wariness of surveys, the language and results of which can be easily manipulated to yield a desired outcome. See *infra* note 84. Nevertheless, the survey evidence in this case, combined with the huge advertising expenditures, were overwhelming proof of secondary meaning, as the court recognized. *Id.* at 1061. For a comprehensive discussion of the use and methodology of surveys in proving secondary meaning, see Palladino, *supra* note 40, at 155.

⁶⁶ 644 F.2d 946 (2d Cir. 1981).

⁶⁷ *Id.* at 948-49.

⁶⁸ *Id.* at 948. The claim was consequently brought under section 43(a) of the Lanham Act for false designation of origin. *Id.* Ultimately, the court gave much weight to the strong evidence of Simon & Schuster's deliberate copying. *Id.* at 949.

⁶⁹ The court's secondary meaning findings read:

Harlequin has . . . adduced sufficient evidence to support the district court's finding that the Harlequin Presents cover has a "secondary meaning" for romance readers. By secondary meaning, we mean that romance readers associate the Harlequin Presents cover with a particular series and publisher. . . . Harlequin's extensive national advertising, its phenomenal sales success, and the results of a consumer survey indicate that romance readers correlate the Harlequin Presents cover with Harlequin and the Harlequin Presents series.

Id. at 949-50. Fifty percent of those questioned for the survey identified Harlequin as the publisher of the series when shown "copies of unpublished Harlequin Presents titles with the Harlequin name and colophon deleted . . ." *Id.* at 950 n.2.

⁷⁰ *Id.*

however, was the attempt by Simon & Schuster to capitalize on the Harlequin Presents cover when it introduced its own romance series.⁷¹ Again, the court divulged little concrete financial information about the advertising expenditures, although both sides agreed that Harlequin was the clear market leader. Significantly, the Second Circuit now views intentional copying as persuasive evidence of secondary meaning.⁷² The logic behind this approach goes something like this: if a competitor is copying the mark, it must be successful and popular; therefore, consumers must be associating the mark with the desirable product and buying it, and the copying competitor has recognized that consumer association and tried to benefit from it.⁷³

Bags and Bed Covers: How Much Secondary Meaning Evidence is Enough?

In *LeSportsac, Inc. v. K Mart Corp.*,⁷⁴ the products in question were fashionable bags.⁷⁵ At trial, LeSportsac successfully claimed that its bag design had acquired secondary meaning, and K Mart appealed, claiming that "LeSportsac presented insufficient evidence to establish secondary meaning."⁷⁶ The court here declined to review the district court's finding of secondary meaning, citing the presence of the usual secondary meaning factors, but only in the most general terms.⁷⁷ The catalogue of secondary meaning criteria provided by the court here is useful in its own sense, and the lack of hard numbers or probing analysis makes procedural sense, since this ruling was merely a refusal to vacate a preliminary injunction. Clearly, the factors examined in a typical Second Circuit secondary meaning case have consistently come to include advertising expenditures, survey results, and sales figures, in addition to more doctrinally marginal factors such as intentional copying and media coverage.

Of course, consistency in the application of standards is far

⁷¹ *Id.*

⁷² See *Centaur Communications v. A/S/M Communications*, 830 F.2d 1217, 1224 (2d Cir. 1987) ("The most persuasive . . . [secondary meaning] factor is the finding that A/S/M had intentionally copied Centaur's mark.").

⁷³ For a critique of the judicial emphasis on intentional copying, see Timothy R. Bryant, *Trademark Infringement: The Irrelevance of Copying to Secondary Meaning*, 83 Nw. U. L. Rev. 473 (1989).

⁷⁴ 754 F.2d 71 (2d Cir. 1985).

⁷⁵ *Id.* at 72.

⁷⁶ *Id.* at 78.

⁷⁷ "While LeSportsac might have presented additional evidence, it did offer proof of phenomenal sales success, substantial advertising expenditures, unsolicited media coverage, requests from third parties to license the use of its design and K Mart's deliberate attempt to imitate its trade dress." *Id.* at 78.

different from consistent results. In *Perfect Fit Industries, Inc. v. Acme Quilting Co.*,⁷⁸ the plaintiff had introduced a new type of mattress cover that covered the entire mattress, rather than only the top of the mattress, as all other manufacturers had done previously.⁷⁹ Perfect Fit was simultaneously responsible for another industry first, in that it packaged its new mattress cover in a clear plastic bag with a contoured piece of cardboard inside the bag (known as a "J-board") featuring the product's name ("BedSack") and a photograph of a model lying on a bed with the new type of cover.⁸⁰ Perfect Fit's new product sold well, and within four months, the defendant had introduced a very similar mattress cover, which it marketed in very similar packaging.⁸¹ Perfect Fit sued for trade dress infringement (after its original copyright claim was dismissed) and lost in the district court on the grounds that it failed to prove secondary meaning.⁸² The circuit court agreed with this finding, explaining that the secondary meaning evidence proffered by Perfect Fit "consisted solely of evidence of BedSack sales and advertising expenditures. No consumer surveys were offered, and no evidence was presented as to any instance in which a consumer actually mistook the BedMate [the defendant's allegedly infringing product] for the BedSack."⁸³ The court seemed to be drawing troubling negative inferences here from the absence of survey evidence and actual confusion, neither of which are required to prove secondary meaning.⁸⁴ Despite the negative finding regarding sec-

⁷⁸ 618 F.2d 950 (2d Cir. 1980).

⁷⁹ *Id.* at 951.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.* at 951-52.

⁸³ *Id.* at 952.

⁸⁴ Actual confusion does not necessarily justify an inference that many people are likely to be confused. See *supra* notes 37-39 and accompanying text. As to the apparent survey evidence requirement expressed in cases like *Perfect Fit*, a former editor of the *Trademark Reporter* and eminent authority on the use of consumer surveys in trademark infringement actions recently wrote that "[a]lthough one can imagine cases where a plaintiff's failure to survey likely confusion may be held against it, routinely requiring such a survey would fundamentally change the character of trademark litigation because the existence or absence of a likelihood of confusion is an issue in every infringement case." Palladino, *supra* note 40, at 156. Nevertheless, a front-page story in a more recent issue of a popular legal weekly described the increasing judicial acceptance of and demands for survey evidence:

Once unacceptable in courtrooms, the use of polls and surveys is now standard operating procedure in trademark and false advertising lawsuits Many judges now say that a survey is necessary to prove that an ad, a claim, or a name is misleading Polls have gotten so established in commercial suits that judges sometimes draw a negative inference if a case doesn't include one, survey advocates say.

And that worries some in the legal community. While surveys seem to present empirical evidence, critics maintain that polling is still just a pseudoscience Questions can be loaded, and results can be manipulated.

ondary meaning, the court still held that there was a likelihood of confusion based on the stronger evidence indicating that defendant Acme had intentionally copied Perfect Fit's trade dress.⁸⁵ The court's resort to a fallback position facilitated an equitable result, but it may have also demonstrated the court's reluctance to grant injunctive relief to a manufacturer whose product was on the market for only a short period of time before it was imitated. In fact, the court may have been deliberately steering clear of the dubious doctrine of "secondary meaning in the making."⁸⁶ In any event, this case demonstrates that courts exercise considerable discretion in evaluating secondary meaning evidence.

Actual Confusion of Products by Retailers May Not Be Enough To Prove Secondary Meaning: The *Schwinn Bicycle* Case

At the trial level, this sort of discretion factors even more heavily into the equation. A notable example of this was *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*,⁸⁷ a well-known case involving a dispute over the design of bicycle tire rims. It had been standard industry practice to conceal the "unsightly" weld seam holding the rim together by "grind[ing] the weld so as to bring it into alignment with the attached pieces of steel, polish the same, and then apply chrome to the entire rim."⁸⁸ Apparently, this procedure, which had nothing to do with the functioning of the bicycle, was considered to be an expensive but necessary measure. In 1949, Schwinn developed a new and cheaper way of accomplishing the same goal, which was to "knurl the inner surface of the rim [The people at Schwinn soon realized that] they had stumbled onto the very

Andrew Blum, *Once Shunned, Surveys Gain Favor of Courts: Rise in Advertising and Trademark Suits Leads to Use of Polls as Proof*, NAT'L. L.J., Oct. 30, 1995, at A1.

⁸⁵ *Perfect Fit*, 618 F.2d at 953-55.

⁸⁶ The doctrine seeks to account for the reality that successful goods and services sometimes achieve public recognition of their marks in a shorter period of time on the market than courts would normally require for proof of secondary meaning. However, the problem with such a doctrine is that, for all its equitable intentions, it may actually defeat the purpose of secondary meaning generally. The very words "in the making" essentially concede that secondary meaning has not yet been established. Protecting such a trade dress or mark thus inappropriately circumvents secondary meaning requirements and inhibits competition before any buyer connection with the first-comer is firmly established. Similar sentiments were expressed by the court in *Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 216 (2d Cir. 1985) ("In the absence of secondary meaning, however, there will be no such association in the minds of the purchasing public."). The Second Circuit formally rejected secondary meaning in the making four years ago. See *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131 (2d Cir. 1992). For a discussion of the doctrine's degree of acceptance by the circuit courts generally, see Willajeanne F. McLean, *The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 AM. U. L. REV. 737 (1993).

⁸⁷ 339 F. Supp. 973 (M.D. Tenn. 1971).

⁸⁸ *Id.* at 976.

type of identifying mark that they had been seeking.”⁸⁹ Schwinn eventually succeeded in registering the knurled-rim design as a trademark, but it did so only after persuading the Patent and Trademark Office to overlook a significant problem noticed by one of its examiners, who “expressed reservations as to whether this trademark was of such a distinguishable nature as to be subject to registration.”⁹⁰ When defendant Murray was looking for a less expensive method of covering the weld seams on its own tire rims in 1964, one of its employees examined Schwinn’s design and copied it, using sixteen parallel marks inside the rim as opposed to Schwinn’s thirty-two.⁹¹

At trial, Murray challenged the validity of Schwinn’s trademark on functionality grounds,⁹² asserting that the money-saving attributes of the knurling method created a competitive need for it. Schwinn claimed that its mark had acquired secondary meaning and tried to prove this in several ways. First, it claimed that people in the industry could instantly identify a Schwinn bicycle “by seeing the knurling on the inner surface of the rim.”⁹³ Schwinn also introduced evidence that “in one bicycle shop, two of the mechanics could not read and thus they selected bicycle rims based on the knurling.”⁹⁴ Finally, Schwinn pointed to two incidents demonstrating actual confusion. In one, a retailer was confused “concerning the identity of a bicycle rim which had knurling thereon. The confused individual apparently looked only at the knurling and not at the name imprinted on the respective rim.”⁹⁵ In the other actual confusion occurrence, one customer sent a knurled rim made by Murray back to Schwinn to have it repaired.⁹⁶ The court was unimpressed by Schwinn’s secondary meaning evidence and said so in rather vigorous terms.⁹⁷

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.* at 977. The court also noted Murray’s uncontested claim that it did not know that Schwinn was claiming exclusive trademark rights in the design. *Id.* This “innocent infringer” factor probably bolstered Murray’s functionality argument as well by lending credence to the idea that Murray simply adopted a very useful (and non-source-indicating) feature that one of its employees happened to come across. *Id.*

⁹² *Id.* at 980. To prevail, Murray had to—and did—overcome the rebuttable presumption of validity that comes with the registration of a mark. *Id.* at 981-82.

⁹³ *Id.* at 978.

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ The court’s discussion here reads more like a harangue:

No proof was introduced to show confusion in the minds of the purchasing public. The only evidence introduced was directed at confusion, or possible confusion, in the minds of individuals who were operating sales rooms and/or bicycle repair shops [W]ith minor exceptions, the basic thrust of the

Overall, the court here would probably have been on firmer ground by emphasizing the functionality issue. While the court may have been correct in holding that Schwinn offered insufficient proof, it apparently gave short shrift to the very plausible argument that even limited actual confusion among *sellers* of the product created a likelihood of confusion among buyers. If a customer were to walk into a bicycle shop and ask for a Schwinn bicycle rim, but a clerk instead sold the customer a knurled Murray rim by mistake, that could be a very injurious sort of actual confusion, and possibly grounds for finding secondary meaning. It seems that aside from the small number of people involved in the confusion episodes, the fatal defect in Schwinn's evidence was its failure to show either that rims were a significant part of what bicycle consumers look for when purchasing,⁹⁸ or that there was much of a separate, spare parts market for rims.

Knowing What You're Looking At: The Difficulty of Proving that a Mark is Actually Functioning as a Mark

In re Mogen David Wine Corp.,⁹⁹ offers a more unambiguous instance in which inadequate secondary meaning evidence precluded a product's appearance from being a registered trademark. The TTAB had denied Mogen David's application for registration of "the configuration of . . . [its] decanter bottle,"¹⁰⁰ and the Court of Customs and Patent Appeals here affirmed on the grounds that no secondary meaning had been shown. In support of its application, Mogen David submitted copies of its numerous print advertisements depicting its allegedly distinctive bottle, as well as affidavits from customers to the effect that they associated the shape of the bottle with Mogen David.¹⁰¹ The court discounted both the ads and the affidavits as unpersuasive. None of the ads ever referred to the bottle itself, and the bottle was never depicted

proof was that certain storage problems were eliminated and would be eliminated if only one bicycle manufacturer were allowed to use the knurled inner surface No proof of any survey of consumer reaction to the Schwinn or Murray Ohio bicycle rim was introduced; no proof was introduced reflecting that the consuming public was interested in whether or not the rims on their bicycle were manufactured by Schwinn or by some other company; no proof was introduced that one wheel was superior to the other in quality or use, but as stated above, the primary thrust of the plaintiff's proof was inconvenience among dealers and repair shop personnel.

Id.

⁹⁸ A survey might have been particularly useful in this regard.

⁹⁹ 372 F.2d 539 (C.C.P.A. 1967).

¹⁰⁰ *Id.* at 540.

¹⁰¹ *Id.* at 541.

without the label, which prominently displayed the brand name.¹⁰² Along similar lines, since the bottles sold in stores were always labeled, the customers had no opportunity to see the bottle without the identifying label, and thus had no opportunity to independently associate the shape of the bottle with its producer.¹⁰³ This reasoning seems a bit convoluted,¹⁰⁴ but the affidavits were already highly suspect since they contained nearly verbatim language, which suggests that the witnesses were coached in extensive detail.¹⁰⁵ The evidence in this case was clearly too flimsy to justify a finding of secondary meaning for the shape of Mogen David's bottles.

A similar case was *In re Soccer Sport Supply Co.*,¹⁰⁶ in which the court affirmed the TTAB's denial of registration for the design of a soccer ball. The design was indistinguishable from the typical black and white design one would normally associate with a typical soccer ball, but the court was careful to explain that this fact alone would not prevent registration upon a showing of secondary meaning.¹⁰⁷ Soccer Sport offered affidavits from soccer coaches and one retail seller of soccer equipment, with each stating in effect that he "associate[d] appellant's design only with appellant."¹⁰⁸ This evidence was deemed to be lacking, however,¹⁰⁹ as were the advertising submissions, none of which adequately spoke to the issue of the mark's alleged source-indicating power for average buyers.¹¹⁰

A more recent TTAB case further illustrated the difficulty manufacturers can often encounter in trying to "get the word out"

¹⁰² *Id.*

¹⁰³ *Id.* at 542.

¹⁰⁴ In his concurrence, Judge Smith pointed out that the labeling was legally required and thus irrelevant, with the real issue being whether "its [Mogen David's] *container shape* did in fact identify its wines." *Id.* at 546 (emphasis in original).

¹⁰⁵ *Id.* at 541.

¹⁰⁶ 507 F.2d 1400 (C.C.P.A. 1975).

¹⁰⁷ "Although appellant's mark is not inherently distinctive, it would nevertheless be registrable under section 2(f) if it 'has become distinctive' of appellant's goods. However, the evidence is not persuasive of such a conclusion." *Id.* at 1403.

¹⁰⁸ *Id.* at 1402.

¹⁰⁹ The coaches and the retailer were not convincingly representative of "a large class of purchasers." *Id.* at 1404.

¹¹⁰ The advertisements of record do not support an inference of distinctiveness inasmuch as the evidence fails to disclose information from which the number of people exposed to the design could be estimated—such as circulation of the publications in which the advertisements appear, advertising expenditures, number of advertisements published, volume of sales of the soccer balls, and the like.

Id. at 1403. Perhaps the most crucial observation the court made regarding the advertising evidence was that the ads actually used three different word marks (WORLD DOT, WORLD CUP, and TEL-STAR), with the result that "the advertisements . . . provide no indication of a nexus between appellant's design per se and a single source." *Id.*

to consumers. In *Edward Weck Inc. v. IM Inc.*,¹¹¹ the TTAB denied registration to IM for the green color of its surgical instruments. Weck opposed IM's application on the grounds that the color was functional,¹¹² while IM claimed that the color had developed secondary meaning through its promotion of the color.¹¹³ Unlike Soccer Sport, Mogen David, and Schwinn, IM had actually undertaken an independent and systematic campaign to promote the color green as a mark for its surgical implements. As the board noted:

Applicant's goods are advertised in medical journals and newspapers and are promoted by brochures and at trade shows, where applicant's booth is colored green and decorated with green curtains At trade shows, applicant's representatives wear a hat which displays the slogan "Green Instrument People," and applicant has given away green pens with the same slogan. Applicant also uses green printing on its labels, envelopes and letterheads and uses green ink on its postage meter stamps.¹¹⁴

In the context of the highly specialized market for its products, IM certainly seemed to make every reasonable effort to publicize the mark and create for it a connection to its source in the minds of buyers, even going so far as to identify itself in terms of the color of its product. Citing to the Federal Circuit's *Owens-Corning Fiberglas* decision¹¹⁵ (which had reversed its own initial invocation of the mere color rule), the board acknowledged that color could be registered. Surprisingly though, IM's evidence was not enough to convince the TTAB: "the relatively small size of applicant's advertising expenditures and the limited extent to which that advertising is directed to the promotion of the color green as a trademark militate against the finding of distinctiveness."¹¹⁶ The board did not specify any numbers regarding the advertising expenditures or the percentages of ads devoted specifically to emphasize the color, so it is impossible to understand the measuring standards it applied to

¹¹¹ 17 U.S.P.Q.2d (BNA) 1142 (T.T.A.B. 1990).

¹¹² The board summarily rejected Weck's functionality argument, which characterized the color as "eye-ease green" and asserted that the color reduced eye strain for surgeons by providing a visual contrast with the red blood, thereby making it less likely that a surgeon would lose sight of an instrument and inadvertently leave it inside the patient's body. *Id.* at 1144. The board disposed of this scare tactic as "not realistic" and "unsupported." *Id.* at 1145. Weck also conceded "that there are alternative colors available and that there is no economy of manufacture in the use of this color." *Id.* at 1144.

¹¹³ *Id.* at 1144-45.

¹¹⁴ *Id.* at 1144.

¹¹⁵ *In re Owens-Corning*, 774 F.2d at 1116.

¹¹⁶ *Edward Weck*, 17 U.S.P.Q.2d at 1146.

reach its decision.¹¹⁷

Judging by its own description of IM's promotional efforts, however, the question of whether secondary meaning had been created in this case would at least appear to be a close call. Depending on factors such as the number of buyers or decision-makers who attended the trade shows and the circulation of the medical publications in which it advertised, IM might well have generated enough buyer association to warrant a finding of distinctiveness and registration for its mark. The board's reasoning in this case might not have survived an appeal.

Under some rare circumstances, even "obvious" or conceded secondary meaning might not be sufficient to create trademark protection in a visual mark; an illustrative case of this unusual scenario is *International Order of Job's Daughters v. Lindeburg and Co.*¹¹⁸ In that case, the plaintiff, "a young women's fraternal organization,"¹¹⁹ sued a jeweler who was selling unauthorized jewelry depicting the organization's emblem.¹²⁰

¹¹⁷ However, earlier TTAB rulings underscore the importance of demonstrating that a mark is source-indicating and not merely widespread. A notable example of this is *In re Redken Labs., Inc.*, 170 U.S.P.Q. (BNA) 526 (T.T.A.B. 1970), in which the TTAB rejected evidence of exclusive use for ten years, 300 shows per year, and \$500,000 in advertising expenditures as insufficient to establish secondary meaning for "THE SCIENTIFIC APPROACH" for lectures on skin and cosmetic treatments. The Board explained its refusal to find secondary meaning as follows:

Large scale expenditures in promoting and advertising goods or services under a particular designation are always significant in proceedings of this character in that they serve to indicate the extent to which the mark has been used. But, large expenditures in this regard, cannot, per se, establish that the term functions as a mark to identify and distinguish services or goods rendered by an applicant. It is necessary to examine the advertising material to determine how the term is being used therein, what is the commercial impression created by such use and what it should mean to purchasers.

Id. at 529 (emphasis added). Ultimately then, the TTAB's analysis turns on the examiner's subjective evaluation of the source-indicating content of the mark's promotional materials. One wonders how an examiner could accurately determine the "commercial impression" of a mark's use *without* advertising expenditure evidence. Of course, advertisements that do not include or make reference to a mark obviously do not contribute to its acquisition of distinctiveness. But, if promotional materials do include a mark in some fashion, what guidelines should examiners follow in deciding whether a given ad adequately emphasizes the mark? Not coincidentally, the above language constitutes an almost verbatim lift of the language of section 1212.06(b) of the current version of the manual used by PTO examiners, U.S. DEPT. OF COMMERCE, PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (2d ed. May, 1993); the section is titled "Advertising Expenditures," and one gets the clear impression that the examining attorney simply copied the language as insurance against a judicial reversal. Rigorous analysis was noticeably absent here.

¹¹⁸ 633 F.2d 912 (9th Cir. 1980).

¹¹⁹ *Id.* at 914.

¹²⁰ *Id.* "The emblem consists of a representation of three girls within a double triangle. The girls carry a dove, an urn, and a cornucopia. Between the bases of the two triangles are the words 'Iyob Filiae,' the Latin translation of 'Daughters of Job.'" *Id.* Clearly, even if the mark were somehow not found to be inherently distinctive, its offbeat nature might make it relatively easy to establish secondary meaning. Ultimately, the case was decided on other grounds. *Id.* at 920.

The Ninth Circuit framed the issue this way: "we must decide whether [the defendant] Lindeburg is likely to confuse the public about the origin of its jewelry by inscribing the Job's Daughters name and emblem on it."¹²¹ Clearly, many, if not most, buyers confronted with a piece of jewelry bearing the insignia and name of an organization might fairly infer that the organization had something to do with the production or marketing of the jewelry. Not so, said the court:

Lindeburg never designated the merchandise as "official" Job's Daughters' merchandise or otherwise affirmatively indicated sponsorship. Job's Daughters did not show a single instance in which a customer was misled about the origin, sponsorship, or endorsement of Lindeburg's jewelry, nor that it received any complaints Finally, there was evidence that many other jewelers sold unlicensed Job's Daughters jewelry, implying that consumers did not ordinarily purchase their fraternal jewelry from only "official" sources. We conclude that Job's Daughters did not meet its burden of proving that a typical buyer of Lindeburg's merchandise would think that the jewelry was produced, sponsored, or endorsed by the organization. The name and emblem were functional aesthetic components of the product, not trademarks. There could be, therefore, no infringement.¹²²

As in other cases examined previously, the court needlessly emphasized actual confusion, but Job's Daughters lost mainly because it failed to adequately assert its rights early on¹²³ in what could have been a distinctive and revenue-generating mark.

IV. SECONDARY MEANING EVIDENCE FOR WORD MARKS

The mere color rule may have survived as long as it did because plaintiffs were able to essentially scare courts into believing that color and visual marks generally were somehow less amenable to rigorous judicial analysis than word marks. In fact, the defend-

¹²¹ *Id.* at 917.

¹²² *Id.* at 920.

¹²³ In addition to the sale of unlicensed jewelry by others, another factor working against Job's Daughters was its long-term tolerance of Lindeburg's unauthorized sales; between Lindeburg's occasional requests to be named an "official" vendor of goods bearing the emblem, the organization let blocks of time ranging from one to seven years elapse before doing so much as asking him to stop selling the items. *Id.* Job's Daughters relented and allowed Lindeburg to proclaim himself "authorized" from 1973 until 1974, before revoking permission and finally bringing suit in 1975. *Id.* at 914. This long, drawn-out history of bluffs and inaction on the part of Job's Daughters made it virtually impossible for it to prevail in what could have otherwise been an eminently winnable case.

ant in *Qualitex* advanced just such an argument.¹²⁴ In reality, word marks are not easier to examine, in the same way that color marks are not actually more difficult. Inconsistent results have also emerged in word mark cases, mainly because of the ambiguities of the secondary meaning doctrine, but perhaps partly due to a sense in the courts—fueled by the notion continually urged upon them that word marks are “easier”—that judicial intuition can more readily fill gaps left by empirical evidence. However, word marks are often found to be merely descriptive of the product, and so secondary meaning evidence must often be closely examined to determine whether such marks have acquired distinctiveness.

Evidence of Advertising Expenditures: How Much is Persuasive?

In *W.E. Bassett Co. v. Revlon, Inc.*,¹²⁵ the “leading manufacturer of manicuring implements”¹²⁶ sued for the alleged infringement of its registered trademark “Trim” by Revlon’s competing nail clipper called “Cuti-Trim.”¹²⁷ Although the court agreed with Revlon that “Trim” was a descriptive term as applied to nail clippers, it also agreed with the district court’s finding that the mark had developed secondary meaning. The main pieces of evidence supporting this finding were the huge sales success of “Trim” products, “heavy” advertising, and exclusive use of the mark for eighteen years.¹²⁸ In adopting the district court’s finding that there was secondary meaning, the Second Circuit placed particular emphasis on advertising expenditures and their presumptive effect on consumers.¹²⁹ In its paraphrase of the district court’s factual determination that there was secondary meaning, the court relied on advertising expenditures even though they are technically only indirect evidence

¹²⁴ “[Defendant] Jacobson adds that ‘shade confusion’ problem is ‘more difficult’ and ‘far different from’ the ‘determination of the similarity of words or symbols.’ Brief for Respondents 22.” *Qualitex*, 115 S. Ct. at 1305.

¹²⁵ 435 F.2d 656 (2d Cir. 1970).

¹²⁶ *Id.* at 659. From 1947 to 1970, Bassett had sold more than two hundred million of its nail clippers bearing the mark. *Id.* From 1947 through 1970, Bassett spent more than \$1,000,000 promoting the mark. *Id.* Once again, inflation must be borne in mind, since that figure sounds paltry in current dollars.

¹²⁷ *Id.* at 659-60. Bassett had also registered several variant forms of the mark, including “Trim-clip,” “Trim-pac,” and “Trim-ette.” *Id.* at 659.

¹²⁸ *Id.* at 660.

¹²⁹ On the question of secondary meaning, Judge Frankel was persuaded by the fact that Bassett had pursued a course of steady promotion of its mark and by Mr. Justice Frankfurter’s statement that the effect of such activities is often “to impregnate the atmosphere of the market with the drawing power of a congenial symbol.” *Mishawaka Rubber and Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942). He therefore concluded that it was more likely than not that Bassett’s [advertising] endeavors had enough effect—even if subconscious—on consumers to give “Trim” secondary meaning. We agree.

Id. at 661.

of secondary meaning. This reliance is entirely appropriate, since, as the court recognized, Bassett's long exclusive use of the mark, in conjunction with its extensive advertising, probably created the optimal sort of conditions for the mark to effectively seep into the public consciousness and achieve secondary meaning.

Another case with important ramifications for weighing advertising expenditure evidence is *Union Carbide Corp. v. Ever-Ready Inc.*¹³⁰ As the maker of the EVEREADY line of batteries, flashlights, and light bulbs, Carbide was understandably moved to sue a company that incorporated under the name "Ever-Ready" and prominently placed its corporate name—in addition to each of several different brand names—on light bulbs, flashlights, and lighting fixtures.¹³¹ At trial, the district court ruled for the defendant, holding that the EVEREADY trademark was invalid¹³² for lack of secondary meaning.¹³³ Although the district court had enumerated appropriate criteria for assessing claims of secondary meaning,¹³⁴ it was not swayed by the fact that Carbide spent \$50 million on advertising the mark over a four-year period, or by the diversity of the advertising, which appeared "in magazines and trade journals, on radio and television and through point of sale displays"¹³⁵ The circuit court here indicated that it might have been willing to go along with the district court's finding if these already formidable numbers had been the extent of Carbide's secondary meaning evidence. Undoubtedly, some costly advertising campaigns fail to achieve their goal of creating widespread consumer identification of the manufacturer via the mark.¹³⁶

However, Carbide also commissioned two consumer surveys showing that more than "50% of those interviewed associated Carbide products, such as batteries and flashlights, with defendants' ["Ever-Ready"] mark."¹³⁷ The combination of the large advertising

¹³⁰ 531 F.2d at 366.

¹³¹ *Id.* at 370. Carbide's predecessor began using the mark EVER READY in 1898; it changed the mark to EVEREADY in 1901. *Id.* In the ten years preceding the trial, Carbide had sold in excess of \$100 million worth of EVEREADY products annually. *Id.* Ever-Ready incorporated in 1944 as a fluorescent light repair business and began selling lamps, flashlights, bulbs, and fixtures in 1946. *Id.*

¹³² *Id.* at 371.

¹³³ *Id.* at 381.

¹³⁴ "We agree with the district court's summary of the factors relevant on the issue of secondary meaning: 'The amount and manner of advertising, volume of sales, the length and manner of use, direct consumer testimony and consumer surveys.'" *Id.* at 380 (quoting *Union Carbide Corp. v. Ever-Ready Inc.*, 392 F. Supp. 280, 288 (N.D. Ill. 1975)).

¹³⁵ *Id.* (internal quotation marks omitted).

¹³⁶ See, e.g., *Mana Prods., Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 1071 (2d Cir. 1995) (holding that despite claimed advertising expenditures of \$3,000,000, the color of plaintiff's makeup cases had not acquired secondary meaning).

¹³⁷ *Union Carbide*, 531 F.2d at 381. The court also recounted a terrible mistake made by

expenditures, the far larger sales of products bearing the mark, and the strong survey evidence amounted to overwhelming evidence of secondary meaning, and the court had ample grounds for reversing the district court's contrary finding as clearly erroneous.¹³⁸ It seems a bit surprising that a claim supported by such resounding numbers needed appellate intervention to reach this outcome.

Of course, impressive expenditures, even when taken together with other persuasive factors, do not automatically create secondary meaning, as courts have made clear. In *Ralston Purina Co. v. Thomas J. Lipton, Inc.*,¹³⁹ Purina sought an injunction against Lipton's use of "Tender Dinners" as a mark for cat food, claiming that its own "Tender Vittles" mark had acquired secondary meaning by virtue of Purina's substantial advertising expenditures and the results of two surveys.¹⁴⁰ The court's initial statements about proving secondary meaning are widely cited and demonstrate the inherently ambiguous standards that lead to inconsistent results: "Proof of secondary meaning is often difficult. No precise guidelines are applicable and no single factor is determinative. Each case must be decided on its own facts, considering such elements as length and exclusivity of use, sales levels, extent of advertising and promotion, etc."¹⁴¹ Note the order of the court's list of factors; it may indicate a descending order of preference, which would explain the result in this case. Also, the court's statement regarding the lack of fixed standards in no way implies that proof of secondary meaning can be readily fudged. Soon after the text cited above the court warned that "[p]roof of secondary meaning entails rigorous evidentiary requirements."¹⁴² In this case, the court based its decision

Ever-Ready's attorney in which he essentially admitted, albeit inadvertently, that Carbide's "EVEREADY" mark had acquired secondary meaning: "The public's attitude is more directly indicated by remarks of counsel for Ever-Ready. In his opening statement he said, 'All right. We don't sell batteries, and that's what everybody thinks of when you mention the name 'EVEREADY.' Later during the trial he made a similar remark.'" *Id.* (emphasis added).

¹³⁸ *Id.* Carbide also showed three cases of actual confusion between the marks. In one, a customer wrote to Carbide complaining about an Ever-Ready bulb, and referred to "your fine reputation," further indicating to the court that the customer had the mistaken impression that Carbide had made the inferior-quality product. *Id.* at 384. In another instance, a store clerk gave a customer (who was the secretary of a Carbide attorney) Ever-Ready bulbs but "assured her that the bulbs were made by Carbide." *Id.* Cf. *supra* note 94 and accompanying text in discussion of the *Schwinn Bicycle* case, in which the court gave little credence to a similar actual confusion by a retailer. Finally, another complaining customer called the store where she had purchased an unsatisfactory Ever-Ready bulb and asked for the address of the "EVEREADY battery people"; the store accordingly gave her Carbide's address. *Id.* at 384-85.

¹³⁹ 341 F. Supp. 129 (S.D.N.Y. 1972).

¹⁴⁰ *Id.* at 133-34.

¹⁴¹ *Id.* at 133.

¹⁴² *Id.* at 134.

primarily on the period of time that Purina's product had been on the market—two years.¹⁴³ In so doing, the court gave only minimal consideration to other evidence that might well have fared better in another court. The court discounted evidence that Purina's product was the clear market leader,¹⁴⁴ that Purina had extensively advertised the mark,¹⁴⁵ that a survey showed substantial consumer recognition of the mark,¹⁴⁶ and that another survey showed a substantial amount of confusion.¹⁴⁷

A recent case involving the marketing of an insurance plan as "THE ALTERNATE PLAN" shows that courts can still be surprisingly indifferent to highly relevant secondary meaning evidence, especially large sums spent in the promotion of marks:

This court is not persuaded by the plaintiff's attempt to convince this court that its trademark is descriptive in nature and has [acquired] secondary meaning by pointing to B & S'[s] extensive use of the mark in its marketing of the B & S Program, its registration of the mark and the substantial funds it has invested in advertisements bearing the marks. This court is not interested in the extent of B & S's promotional efforts.¹⁴⁸

The court in *B & S Underwriters v. Clarendon National Insurance Co.*, stated that it was concerned only with direct consumer-based evidence of secondary meaning, and granted summary judgment for the defendant based strictly on depositions from an unspecified number of people in the industry stating that they did not associate the mark with the plaintiff. It is important to note that the court in *Ralston Purina* was only ruling on a motion for a preliminary in-

¹⁴³ "In a market so new and unsettled [as the one for semi-moist cat food in 1970], it is doubtful that the name of any product could have acquired secondary meaning in so short a time." *Id.* Judicial statements like this make it clear why some courts began promulgating the flawed but well-intentioned "secondary meaning in the making" doctrine. See *supra* note 86. Clearly, some situations do in fact justify findings of secondary meaning within relatively short time frames. No arbitrary minimum period can reflect market realities, as this very court must have realized on at least one occasion. See *Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L.*, 673 F. Supp. 1238 (S.D.N.Y. 1987) (finding that secondary meaning had been established in three years).

¹⁴⁴ "The fact that Tender Vittles became the biggest seller of the semi-moists means nothing more than that it became the most popular." *Ralston Purina*, 341 F. Supp. at 134.

¹⁴⁵ "[T]he fact that Purina spent \$4,000,000 promoting its product merely indicates its efforts to establish secondary meaning, but does not determine the success of those efforts" *Id.* In 1968-70, \$4,000,000 in advertising was a very significant sum and, in light of the other evidence, the court may have dismissed it too glibly.

¹⁴⁶ "Surveys showing levels of brand awareness for cat food products among consumers demonstrate only that consumers have knowledge of brand names." *Id.*

¹⁴⁷ "Approximately 35 of 175 [20%] exhibited greater or lesser confusion between Tender Vittles and Tender Dinners. This amounts to nothing more than that the customer could not read or did not really care." *Id.*

¹⁴⁸ *B & S Underwriters v. Clarendon Nat'l Ins. Co.*, 36 U.S.P.Q.2d (BNA) 1769, 1773 (W.D. La. 1995).

junction rather than making a final determination at trial or granting summary judgment. Even so, the *Ralston Purina* court appeared to focus excessively on the time factor and belittle other credible and relevant evidence.

The court in *James Burrough Ltd. v. Sign of the Beefeater*¹⁴⁹ recognized that, in evaluating all forms of secondary meaning evidence, the primary purpose of trademark law¹⁵⁰ comes to the fore: “[t]he trademark laws exist not to ‘protect’ trademarks, but . . . to protect the consuming public from confusion, [thereby] concomitantly protecting the trademark owner’s right to a non-confused public.”¹⁵¹ For this reason, the court credited evidence of large advertising expenditures over a long period of use (\$32 million over nineteen years),¹⁵² enormous sales (\$1 billion in that same period),¹⁵³ and survey evidence showing confusion¹⁵⁴ in finding secondary meaning.¹⁵⁵ Significantly, in a case replete with judicial admonitions regarding the primacy of trademark law’s responsibilities to consumers, the court still emphasized advertising and sales-related evidence, recognizing the ability of such evidence to objectively indicate widespread consumer association between mark and source.

¹⁴⁹ 540 F.2d 266 (7th Cir. 1976).

¹⁵⁰ While the court correctly notes that trademark law’s first priority is consumer protection, the safeguarding of a manufacturer’s investment in a mark is *not* merely incidental, as the legislative history of the Lanham Act makes clear:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so that it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. *Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.*

S. REP. NO. 1333, 79th Cong., 2d Sess. 3 (1946) (emphasis added).

¹⁵¹ *James Burrough*, 540 F.2d at 276. Plaintiff successfully proved infringement of its widely advertised “BEEFEATER” mark for British-made gin by an expanding restaurant chain that used the name “Sign of the Beefeater” and displayed signs with unflattering depictions of “a fat hungry man . . . having a bib about his neck.” *Id.* at 269.

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ Fifteen percent of consumers shown a picture of the restaurant’s sign indicated that they thought the restaurant had something to do with plaintiff’s gin; another 7.5% “did not say ‘Beefeater’ but did mention gin or other liquor-related product[s] or service[s].” *Id.* at 278.

¹⁵⁵ The court’s clarification of the policy underlying trademark law was apparently prompted by the manner in which the district judge ruled for the restaurant—he gave an oral opinion from the bench based on a side-by-side comparison of the two marks. The court here correctly rejected that method of analysis on the grounds that “[t]he consuming public is unlikely ever to be presented with the opportunity for such comparison.” *Id.* at 275. The district court had also been unimpressed by the survey results, citing what it characterized as the inconsequentially “small percentage” of apparent actual confusion it showed. *Id.* at 272.

Who Needs to Know?—The Relevant Market May Not be the General Public, but Promotional Efforts are Still Crucial to a Successful Showing of Secondary Meaning

In *President and Trustees of Colby College v. Colby-College-New Hampshire*,¹⁵⁶ a four-year liberal arts school in Maine with an excellent academic reputation successfully enjoined an unaffiliated two-year New Hampshire institution from using the name “Colby.” Plaintiffs’ institution was widely recognized within the larger academic world, which the court considered to be the relevant consuming public for secondary meaning purposes.¹⁵⁷ In light of its status as a well-regarded place of higher learning, Colby was not expected to generate secondary meaning through traditional advertising means; instead, the court examined evidence relating to the school’s enrollment, endowment, and reputation. The Maine-based Colby College far exceeded the defendant in all three categories, leading the court to state that “the size or prominence of an enterprise may warrant the inference that its name has acquired secondary meaning.”¹⁵⁸ While the court viewed the “direct” evidence of “academic consumer” testimony with much weight, it took care to analyze the strong inference that it justifiably drew from the various publications and activities sponsored by the plaintiff, which comprised its academic form of advertising: “while secondary meaning is shown by the success rather than by the mere fact of an enterprise’s promotional efforts . . . *the normal consequence[s] of substantial publicity may be inferred.*”¹⁵⁹ In other words, if the mark has been widely disseminated within the relevant market, a court may reasonably lean in the direction of finding secondary meaning. The court’s finding of secondary meaning here was further supported by a survey of 1500 people indicating that the plaintiff school had a much stronger overall association with the “Colby” name among New Englanders generally.¹⁶⁰

A 1987 Second Circuit case, *Centaur Communications v. A/S/M Communications*,¹⁶¹ also endorsed the notion that proving secon-

¹⁵⁶ 508 F.2d 804 (1st Cir. 1975).

¹⁵⁷ *Id.* at 808. Plaintiffs’ star witness was the president of Middlebury College, who testified that “the name ‘Colby College’ is exclusively understood ‘in the academic field as meaning the plaintiff.’” *Id.*

¹⁵⁸ *Id.* at 807.

¹⁵⁹ *Id.* at 808 (emphasis added).

¹⁶⁰ *Id.* at 809. The survey asked 500 people from each of three states—Maine, New Hampshire, and Massachusetts—where “Colby College” was and whether it was a four-year school. *Id.* The following percentages from each state said that “Colby” was in Maine: Massachusetts 40%, Maine 79%, New Hampshire 37%. *Id.* The figures for those answering “four year school” were: Massachusetts 57%, Maine 72%, New Hampshire 45%. *Id.*

¹⁶¹ 830 F.2d 1217 (2d Cir. 1987).

dary meaning within smaller markets may involve different expectations for supporting documentation and statistical evidence. First-comer Centaur published a magazine called *Marketing Week*, while A/S/M later put out *ADWEEK's Marketing Week*.¹⁶² The district court found that Centaur's mark had acquired secondary meaning and that A/S/M's mark created a likelihood of confusion between its mark and Centaur's.¹⁶³ On appeal, A/S/M pointed to two surveys it had conducted showing that not one consumer asked associated Centaur's mark with Centaur. The circuit court and the trial court both properly discounted this survey evidence, however, because the surveys were directed at the general public instead of the relevant, specialized market in which the two magazines competed.¹⁶⁴ Centaur's advertising efforts were a prominent and persuasive factor in finding secondary meaning, even though they were of a relatively unorthodox sort. Centaur spent just \$10,000 on traditional print advertising for its magazine, but its employees traveled extensively to make "pitches" for new advertisers (and made Centaur \$250,000 annually from advertisers in *Marketing Week*), it mailed brochures to major advertising agencies, it sponsored conferences, and it was listed in "a source guide to European marketing."¹⁶⁵ Collectively, these promotional factors convinced the court to credit testimony from an executive at a large ad agency and an editor of *Advertising Age* that people in the industry associated Centaur's mark with it: "[t]hese activities support the conclusion that Centaur's efforts were effective in causing the relevant group of consumers to associate *Marketing Week* with it."¹⁶⁶ The court stated that A/S/M's intentional copying was strongly indicative of secondary meaning,¹⁶⁷ but this factor is not universally recognized.¹⁶⁸

The Third Circuit's most widely cited secondary meaning case is *Scott Paper Co. v. Scott's Liquid Gold, Inc.*,¹⁶⁹ which places even greater emphasis on the importance of evidence regarding a mark's promotion. The case centered on the defendant's use of the "Scott's" mark for furniture polish, which Scott Paper, an older and much larger company, did not manufacture. Nevertheless, Scott Paper claimed that its mark was so well known that it had

¹⁶² *Id.* at 1219.

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 1223-24.

¹⁶⁵ *Id.* at 1222-23.

¹⁶⁶ *Id.* at 1222.

¹⁶⁷ *Id.* at 1224.

¹⁶⁸ See *supra* notes 72 and 73 and accompanying text.

¹⁶⁹ 589 F.2d 1225 (3d Cir. 1978).

acquired secondary meaning, even in the household cleaner market, in which it had no products. The court in *Scott* reversed the district court's finding of secondary meaning, on the grounds that the district court failed to adequately explain the evidentiary basis for its finding.¹⁷⁰ Before setting forth its own holding, the circuit court defined secondary meaning¹⁷¹ and explained what it considered to be the normative and perhaps definitive method of proving it: "[s]econdary meaning is generally established through extensive advertising which creates in the minds of consumers an association between different products bearing the same mark. This association suggests that the products originate from a single source."¹⁷² Scott Paper introduced no advertising-related evidence, presumably because it had not made any attempt to enter the furniture polish market. Accordingly, the court here found that the district court had committed reversible error by inferring secondary meaning based on nineteen misdirected consumer letters,¹⁷³ the fact that the products of SLG and Scott were sold in many of the same stores, the similar price ranges of the products, and the argument that the household cleaner market would be "a logical area for Scott Paper's expansion."¹⁷⁴ The fundamental problem with the factors cited by the district court is that they do not show promotional efforts on behalf of the mark, nor do they show significant consumer association. Without advertising evidence, manufacturers may be hard pressed to adequately demonstrate that their marks have developed secondary meaning.

V. TOWARD CLEARER STANDARDS FOR SECONDARY MEANING EVIDENCE: A CONCLUDING PROPOSAL

The *Qualitex* decision was based partly on an expansive reading of the statutory definition of trademarks. 15 U.S.C. § 1127 provides that "any word, name, symbol, or device, or any combination thereof" may potentially become a trademark, and the Court focused on the decidedly broad nature of these categories in allowing protection for color alone:

Since human beings might use as a "symbol" or "device" almost anything at all that is capable of carrying meaning, this lan-

¹⁷⁰ *Id.* at 1230.

¹⁷¹ "Secondary meaning exists when the trademark is interpreted by the consuming public to be not only an identification of the product, but also a representation of the product's origin." *Id.* at 1228.

¹⁷² *Id.*

¹⁷³ *Id.* at 1231.

¹⁷⁴ *Id.* at 1229-31.

guage, read literally, is not restrictive If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?¹⁷⁵

In light of this language and the disposition of the case generally, the Patent and Trademark Office may well be inundated with applications for the registration of color marks and other less traditional marks.¹⁷⁶ The case law amply demonstrates that secondary meaning requirements will probably continue to screen out most descriptive marks. However, 15 U.S.C. § 1052(f), in its current form,¹⁷⁷ provides little guidance for courts, which, as illustrated in the cases discussed, have applied inconsistent methods of analysis and produced inconsistent results. Nevertheless, the extremely fact-dependent nature of secondary meaning claims makes all-encompassing judicial tests inappropriate in this context.

In the absence of statutory guidance, courts and trademark examiners evaluating secondary meaning evidence face a multifaceted problem. In determining whether such evidence is sufficient to merit the often dispositive label of secondary meaning, they must engage in a kind of ad hoc line-drawing regarding its sufficiency and persuasiveness. In so doing, they may choose to emphasize or reject a particular type of evidence. This broad discretion as to acceptable types of secondary meaning evidence may have direct and unfortunate ramifications. For example, one court might be persuaded of a mark's acquired distinctiveness solely on the basis of evidence of an alleged infringer's copying of it, while disregarding evidence that the original mark was only sporadically advertised or displayed to the relevant buying public. Another court could point to an increase in sales (which could of course be attributable to any number of factors) after the adoption of a mark as a strong sign of a mark's secondary meaning, and all but ignore evidence that a properly conducted survey showed that only a very small percentage of respondents recognized the mark as source-indicating.

An Equitable and Sensible Solution: Prioritize Advertising

Additional language in the text of 15 U.S.C. § 1052(f) could

¹⁷⁵ *Qualitex*, 115 S. Ct. at 1302-03.

¹⁷⁶ Recent applications to the PTO include an application to register the "Lone Ranger" theme music as a sound mark and several applications for computer-generated moving image marks. Interview with Erik W. Kahn, Trademark Litigation Counsel to Liddy Sullivan Galway & Begler, in New York, N.Y. (Jan. 22, 1996); see also Erik W. Kahn and George Stephanopoulos, *Starting to Register: Moving-Image Marks*, NAT'L L.J., May 20, 1996, at C25.

¹⁷⁷ See *supra* notes 6-7 and accompanying text.

provide a clearer framework in which courts and trademark examiners could take particular factual situations into account and still retain a considerable amount of discretion. An excellent model for such language is a provision in article 6 of the International Convention for the Protection of Industrial Property.¹⁷⁸ The language of the International Convention could be modified and incorporated into section 1052(f) as follows: "In arriving at a decision as to whether a mark has become distinctive of an applicant's goods or services in commerce, all the factual circumstances must be taken into consideration, particularly any expenditures made and activities undertaken in the advertising and promotion of the applicant's mark." Under these evaluative guidelines, trademark examiners and courts could still conclude that advertising has been ineffective or inadequate and thus failed to create secondary meaning. Nevertheless, they would be required to at least address the issue of advertising expenditures and efforts.

While it is true that consumers themselves may be the sole source of direct secondary meaning evidence, the measuring of public perception of a mark is an inexact science. Surveys are subject to the influence of attorneys who commission them and the potential for flawed and leading questions. Conversely, advertising expenditures are objective dollar figures that, in conjunction with further evidence of the ads' source-indicating content, of the timing and frequency of their publication or broadcasting, and of the applicant's other promotional efforts on behalf of a given mark, can function as an objective barometer in helping to determine how much of the mark-related message has in fact impregnated the atmosphere of the marketplace. At some point, which varies with the facts of each case, the saturation of a specifically targeted market with a message designed to create a link between a mark or trade dress and the source it represents can be reasonably presumed to have made enough of an impression to have created secondary meaning.

The current provision in section 1052(f) allowing the Patent and Trademark Office to accept five years of continuous and exclusive use of a mark as evidence of its secondary meaning appears to

¹⁷⁸ Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, *as amended* July 14, 1967 and Oct. 2, 1979, 21 U.S.T. 1583, *reprinted in* TRADEMARKS THROUGHOUT THE WORLD App. C-53 (Jeanine M. Politi ed., 4th ed. 1996). Article 6 of the Convention deals with trademark registration and reads, in relevant part: "[i]n determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use." As noted *supra*, the current version of § 1052(f) already specifies a five-year period of continuous and exclusive use in commerce, after which a mark may be considered to have become distinctive.

reflect a similar view of consumer thinking. The five-year period may be an arbitrarily designated one. Nevertheless, by allowing for any such “automatic” creation of a presumption in favor of secondary meaning, Congress effectively recognized that after some point, the mere continued and exclusive presence of a descriptive mark in commerce is sufficient to justify a finding of acquired distinctiveness. In this context, exclusive use over time, the effects of which have been amplified by presumed exposure to and familiarity with the mark, creates secondary meaning. Since advertising and other promotional activities may of course constitute use of a mark, and particularly since they often have the express goal of creating buyer association between a mark and a product or service through repeated exposure, such activities warrant special consideration. Unlike other kinds of uses, which may indirectly create secondary meaning by, for example, appearing for years on store shelves, advertising deliberately seeks to address and influence consumer perception. While an expensive and ubiquitous advertising campaign may be unsuccessful in creating secondary meaning for a mark, this should not be the presumption. In today’s media-saturated society, consumers are probably more likely to encounter a mark in an advertisement—whether on television or radio, in print, or online—before they actually see it on a product in a store. As such, advertising is often the primary vehicle for the creation of secondary meaning. It cannot be equitably ignored, and it deserves to be prioritized.

Further, looking closely at advertising expenditures in the evaluation of secondary meaning evidence serves the two primary interests of trademark law generally—protecting the public from confusion and protecting the investments made by trademark owners in the promotion of their marks.¹⁷⁹ Courts now face an emerging challenge in protecting these complementary interests in light of the likely proliferation of nontraditional marks after the *Qualitex* case. In the young multimedia marketplace, trademark owners and consumers alike would benefit from more consistent and predictable secondary meaning determinations, which may be achieved by the institution of clearer standards. Explicitly mandating the examination of advertising-related evidence would ensure that courts and trademark examiners consider the very materials with which trademark owners normally make their marks known to the buying public, and through which the buying public encounters the message. Information regarding the nature and use

¹⁷⁹ See *supra* note 150.

of such materials should therefore factor prominently into a determination as to the existence of secondary meaning.

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