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**Acquiring a Flavor for Trademarks:  
There's No Common Taste in the World**

*Amanda E. Compton*



# Acquiring a Flavor for Trademarks: There's No Common Taste in the World

By *Amanda E. Compton*\*

## I. INTRODUCTION

¶1 The adjudication arm of the United States Patent and Trademark Office (“USPTO”), the Trademark Trial and Appeal Board, hears disputes over the ownership and validity of trademarks, including trademarks that have been rejected as unregistrable by a trademark examining attorney at the USPTO. Historically, trademarks have consisted of letters, numbers, pictures, or a combination of these fundamental features.<sup>1</sup> Section 45 of the Trademark Act defines a trademark as a “word, name, symbol, or device, or any combination thereof . . . .”<sup>2</sup> Seemingly, the statute follows what had been the traditional concept of a trademark (words, slogans, drawings, etc.). On the other hand, the words “symbol” and “device” have been construed broadly to mean any item that a trademark owner uses in commerce to identify and distinguish his or her goods from those of another.<sup>3</sup> These words—“symbol” and “device”—have been used as the basis for registering trademarks that are deemed “nontraditional”—in other words, anything that is capable of carrying some meaning and that can be used as a source identifier for a trademark owner’s goods or services.<sup>4</sup> Another interpretation is that since the legislature did not exclude any subject, the statute should be interpreted to be all-inclusive.<sup>5</sup> With this in mind, the TTAB has used this language to approve color,<sup>6</sup> sound,<sup>7</sup> shape,<sup>8</sup> and fragrance<sup>9</sup> marks for registration.

¶2 In 2006, in a case of first impression and the latest battle over nontraditional trademarks, the TTAB upheld a decision by the examining attorney to refuse registration of a flavor as a trademark.<sup>10</sup> On the other hand, the TTAB continued the trend of

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<sup>1</sup> Daniel I. Schloss, A New Reality: Special Problems in the Registration of Nontraditional Trademarks, 5 NO. 4 INTELL. PROP. STRATEGIST 1 (Jan. 1999).

<sup>2</sup> Trademark Act § 45, 15 U.S.C. § 1127 (2006).

<sup>3</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

<sup>4</sup> *Id.*

<sup>5</sup> *See id.* at 162 (Justice Breyer further commented that “[s]ince human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”)

<sup>6</sup> *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (concerning the color pink used in connection with fiberglass insulation).

<sup>7</sup> U.S. Trademark Reg. No. 0,916,522 (sound mark registered by NBC Universal, Inc. on July 13, 1971 for use in connection with television programs).

<sup>8</sup> U.S. Trademark Reg. No. 1,057,884 (design mark registered by Coca-Cola Company on February 1, 1977 for use in connection with soft drinks).

<sup>9</sup> U.S. Trademark Reg. No. 2,463,044 (cherry scent mark registered by Mike Mantel on June 26, 2001 for use with synthetic lubricants for high performance racing and recreational vehicles).

<sup>10</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (T.T.A.B. 2006).

allowing “nontraditional” trademarks by opening the door for the registration of flavor trademarks.<sup>11</sup> Interestingly, the TTAB determined that after meeting a series of standard trademark tests, flavor could be protected as a trademark.<sup>12</sup> The pertinent tests are explained in more detail below. Unfortunately for Organon, it had not met these tests.

¶3 In *In re N.V. Organon*, the pharmaceutical company N.V. Organon (“Organon”) sought to protect the orange flavoring of its antidepressant tablet.<sup>13</sup> The examining attorney denied the application on the grounds that the flavor, as used in connection with this product, was functional, and that the flavor did not distinguish Organon medicine from any other pharmaceutical product. Therefore, the mark was not entitled to registration under the Lanham Act.<sup>14</sup>

¶4 Seemingly, the decision would appear to be a departure from the current trend of extending protection to nontraditional trademarks.<sup>15</sup> However, the TTAB did open the door for others to be able to make a claim for flavor as a trademark, although considerable barriers to registration still exist.<sup>16</sup> The primary apprehension is that consumers will perceive the flavor as just another characteristic of the goods, and not as a distinctive feature of a single source product.<sup>17</sup> Accordingly, flavors can never be inherently distinctive, and therefore, require proof of secondary meaning or acquired distinctiveness.<sup>18</sup>

¶5 The bigger question, however, is whether flavor should be protected as a trademark. This paper will briefly explore the history of allowing nontraditional trademarks, provide reasons why the TTAB denied registration of flavor as a trademark in the *Organon* case, and present arguments supporting why we should give careful consideration to the continued support of flavor trademarks.

## II. A HISTORICAL OVERVIEW OF NONTRADITIONAL TRADEMARKS

¶6 Trademarks can be traced to antiquity, where they identified the origins of certain goods, such as pottery, jewelry, or armor.<sup>19</sup> Many of the early trademarks were limited to

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<sup>11</sup> *Id.*

<sup>12</sup> Note, however, that simply because a person or company adopts a word, design, or device as a trademark, does not make it a trademark under the law. Those items that are not inherently trademarks, like nontraditional marks, must not be, for example, descriptive, misleadingly descriptive, or functional (i.e. a necessary component to the product or services). Additionally, the item has to have acquired secondary meaning: a legal term of art that refers to the fact that consumers recognize the item as a trademark, or source identifier, for the company.

<sup>13</sup> *N.V. Organon*, 79 U.S.P.Q.2d (BNA) at 1639.

<sup>14</sup> The Trademark Act of 1946, 15 U.S.C. §§ 1051–1072, 1091–1096, 1111–1129, 1141–1142, is popularly referred to as the Lanham Act. The Lanham Act governs the registration of trademarks, trade names, and other identifying marks used in interstate commerce, and it protects registered trademarks from interference or infringement.

<sup>15</sup> *See, e.g.*, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (establishing that color trademarks are eligible for registration); U.S. Trademark Reg. No. 0,916,522 (registered on July 13, 1971) (NBC’s trademark registration for the sound of a chime used to identify a station break); *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990) (upholding a California company’s trademark of a floral scent for knitting yarn).

<sup>16</sup> *N.V. Organon*, 79 U.S.P.Q.2d (BNA) at 14.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> Frank I. Schechter, *The Historical Foundations of the Law Relating to Trade-Marks* (Columbia Univ. Press 1925).

symbols and drawings. This was later exemplified in the early U.S. trademark history, where many of the marks adopted by businesses played on patriotic symbols such as eagles, variations on the U.S. flag, and Uncle Sam. In this same spirit, earlier American trademarks were limited to those marks that were visibly perceptible.<sup>20</sup> By 1870, when Congress enacted the first trademark act, virtually any mark in use (typically only words and symbols) was eligible for trademark registration.<sup>21</sup> In 1905, Congress amended the Trademark Act to limit registration of marks to only those matters that were inherently distinctive.<sup>22</sup> This ultimately meant that marks that were deemed to be merely descriptive, or those that would not be immediately recognized by consumers as a trademark, could never be registered. The enactment of the Lanham Act in 1946 changed the requirements for trademarks. Trademark owners could now produce distinctive and memorable “symbols,” that if not inherently distinctive, could over time qualify as a trademark worthy of receiving protection.<sup>23</sup>

¶7 As with many of our laws, it was the public’s acceptance of the varying ways that businesses branded their goods and services that ultimately influenced the change in defining what qualified as a trademark. For example, Coca-Cola, which first bottled its soft drink in 1894, began using its distinctive fluted-and-bulging bottle design in 1915. It was not until 1960 that the company succeeded in registering the bottle design as a trademark with the USPTO.<sup>24</sup> Product design is a nontraditional trademark that may not have achieved trademark status without this expansive meaning of trademarks. The United States Supreme Court broadly defined this concept of trademarks in *Qualitex*:

It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word or sign—that permits it to serve these basic purposes.<sup>25</sup>

Therefore, trademarks are no longer limited to those visibly perceptible marks comprised of only words or symbols.

¶8 In the spectrum of trademarks, nontraditional trademarks fall on the end of the scale where trademark owners must invest extra time and money to promote the trademark and familiarize the public with the trademark as a source-identifying symbol. This end of the spectrum includes those marks that are fanciful: XEROX, EXXON, KODAK, and CLOROX; arbitrary: APPLE for computers, ARROWHEAD for water, and CAMEL for cigarettes; and suggestive: GREYHOUND for bus services and COPPERTONE for tanning lotion.<sup>26</sup> These marks receive immediate protection and can be registered on the federal register once used in commerce.

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<sup>20</sup> See Nicholas Economides, *New Palgrave Dictionary of Economics and the Law* (1997) (referencing the definition of “trademarks”).

<sup>21</sup> An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights, ch. 230, §§ 77–84, 16 Stat. 198 (1870).

<sup>22</sup> Trademark Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 725 (current version at 15 U.S.C. § 1051 (2006)).

<sup>23</sup> 15 U.S.C. § 1127 (2006).

<sup>24</sup> See, *Coca-Cola Company, The Coca-Cola System—History of Bottling*, <http://www.thecoca-colacompany.com/ourcompany/historybottling.html> (last visited Aug. 26, 2010).

<sup>25</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1994) (citing William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 290 (1987)).

<sup>26</sup> Fanciful marks are completely made up words that did not exist before the trademark owners created

¶9 On the other end of the spectrum are descriptive and generic trademarks. The latter are trademarks that use the common name of the goods or services, such as PENCIL for lead-filled writing instrument. These types of marks can never qualify for trademark protection.<sup>27</sup> Descriptive trademarks, while not immediately eligible for protection, can qualify as a trademark when the trademark owner shows sufficient evidence of the trademark's ability to serve as a source-identifying device. A descriptive mark immediately informs the consumer about a quality, function, characteristic, or ingredient of the goods or services.<sup>28</sup> The USPTO will deny immediate protection to a descriptive trademark because of the concern that consumers will not perceive it as distinctive, but rather as a characteristic of the goods or services. Unlike generic trademarks, descriptive trademarks may acquire distinctiveness through proof of secondary meaning, and then become eligible for registration.<sup>29</sup>

¶10 Nontraditional trademarks face the same challenges as descriptive marks and must undergo the same scrutiny in order to serve as a trademark. Nontraditional trademarks are not immediately viewed as a trademark, in part because they have not traditionally been used as such. More importantly, consumers need to be conditioned to perceive the claimed trademark as a source-identifying feature: one that can help a consumer distinguish one brand of goods and services from that of another. The law is concerned with the mind of the consumer and not the trademark holder.<sup>30</sup> In other words, the trademark should be viewed by the consumer as a brand, not as a decorative or functional feature of the goods or services. Like descriptive marks, this is typically the case for nontraditional marks as they are perceived as simply a functional feature of the goods or services.

¶11 There are success stories that have established varying degrees of what qualifies as a nontraditional trademark. In addition to the nontraditional marks mentioned above, registrations exist for texture,<sup>31</sup> motion,<sup>32</sup> and light<sup>33</sup> trademarks. Hand gesture marks have also become popular ever since pro-wrestler Diamond Dallas Page attempted to sue rapper Jay-Z and his company, Roc-A-Fella Records, over the use of a "diamond shaped" hand gesture. This case was later settled, and Diamond Dallas Page's trademark was

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them; arbitrary marks are words found in ordinary language, but are used in connection with goods or services that are not associated with the word; suggestive marks cause the consumer to think about a particular quality or characteristic of the goods or services (i.e. greyhound dogs are fast, so GREYHOUND bus services must be fast too).

<sup>27</sup> See, e.g., *Induct-O-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 362 (6th Cir. 1984).

<sup>28</sup> *Id.*

<sup>29</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000).

<sup>30</sup> Thomas R. Lee, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, available at [http://works.bepress.com/cgi/viewcontent.cgi?article=1000&context=thomas\\_lee](http://works.bepress.com/cgi/viewcontent.cgi?article=1000&context=thomas_lee) (last visited Aug. 26, 2010).

<sup>31</sup> U.S. Trademark Reg. No. 2,751,476 (John Monnich DBA Silkwood Wines, Textured Mark) (registered on August 12, 2003 for use in connection with wines (wine bottles with a "flocked" texture)).

<sup>32</sup> U.S. Trademark Reg. No. 2,793,439 (Automobile Lamborghini Holding S.p.A., Motion Mark) (registered December 16, 2003 for use with automobiles (sought protection for the unique way its car doors open)).

<sup>33</sup> U.S. Trademark Reg. No. 2,323,892 (Ballantyne of Omaha Inc., Light Mark) (registered on February 29, 2000 for use with search lights and rental of search lights). The registration record reads, "mark consists of a pre-programmed rotating sequence of a plurality of high intensity columns of light." *Id.*

accepted for registration.<sup>34</sup> As well, other gesture marks have been accepted for registration.<sup>35</sup>

¶12 Of all of the nontraditional marks, scent trademarks probably present the closest analogy to the issues faced by trademark owners attempting to claim flavor as a trademark. Again, like other nontraditional trademarks, scent trademarks may be registered if the scent has acquired secondary meaning and does not serve a functional purpose.<sup>36</sup> This is best illustrated in another case of first impression before the TTAB: *In re Clarke*. In *Clarke*, the TTAB held that a scent can serve as a trademark for “sewing thread and embroidery yarn.”<sup>37</sup> Similar issues and concerns raised in *Clarke* are present in *Organon*. Namely, can scent function as a trademark and has the mark in question acquired secondary meaning? In *Clarke*, Celia Clarke appealed a decision from the USPTO for refusing to register her scent mark.<sup>38</sup> Her mark consisted of a floral (plumeria) scent, which was used on sewing thread and embroidery yarn.<sup>39</sup> The TTAB held that scent used in connection with yarn is not an inherent attribute of the goods, but a feature supplied by the applicant.<sup>40</sup> In other words, because consumers would not typically expect yarn to have a distinctive scent and the yarn would function in the same manner without the scent, it was eligible for registration. Ms. Clarke’s success also stemmed from her use of the trademark in the market. In her advertising, she stressed the trademark (the scent) as being a brand of the product, and consumers associated the scent with her products.<sup>41</sup> For these reasons, Ms. Clarke’s mark was eligible for registration.<sup>42</sup>

¶13 Similar to Ms. Clarke, Organon attempted to do something that had been successful for thousands of other trademark owners—take a common device used in a unique manner, and leverage it to put the company at an economic advantage. As laid out above, Organon’s basis for claiming flavor as a trademark stems from years of other trademark owners arguing that the language of the Trademark Act allows for a broad definition of what can be used as a trademark.<sup>43</sup> Consequently, Organon argued that flavor should be recognized as a “device” used to distinguish its goods from that of another.<sup>44</sup>

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<sup>34</sup> Interestingly, Diamond Dallas Page’s trademark application was ultimately abandoned, because he was unable to submit an acceptable specimen showing that the proposed gesture functioned as a trademark. After several attempts to overcome the examining attorney’s objection, Mr. Page ended his attempt at registering his gesture mark. Mr. Page’s inability to conform to the trademark application standards speaks to some of the difficulties trademark owners face when adopting nontraditional trademarks. See U.S. Trademark Application Serial No. 78,654,174 (filed on June 20, 2005).

<sup>35</sup> See, e.g., U.S. Trademark Reg. No. 3,586,649. The trademark was registered by Dharma Drum Mountain Buddhist Association on March 10, 2009 for use in connection with educational services. Dharma Drum claimed the use of the Buddhist *mudra* hand gesture, a five finger gesture with the point of the index and thumb fingers touching.

<sup>36</sup> *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990).

<sup>37</sup> *Id.*

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>44</sup> *Clarke*, 17 U.S.P.Q.2d at 1238.

### III. CAN FLAVOR FUNCTION AS A TRADEMARK?

¶14 Flavor should be protected as a trademark in accordance with the trend of broadly defining an acceptable trademark. The primary issue is whether flavor is capable of distinguishing itself as a trademark. Flavor cannot be registered as a mark unless it is used “in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in questions.”<sup>45</sup> In other words, to qualify as a trademark, it must be either inherently distinguishable or used in such a manner that consumers would recognize it as a trademark. As discussed previously, flavor, like other nontraditional marks, will never immediately be perceived as a source identifier.<sup>46</sup> Therefore, the manner in which the flavor is used in connection with the product will determine if it qualifies as a trademark.<sup>47</sup>

¶15 The evidence surrounding the use of the mark will decide whether it functions as a trademark, not the intent of the party that attempts to establish it as such.<sup>48</sup> For example, decorative features of a product, which may include colors, designs, or even words, are not protectable trademarks. This is due in large part to these devices’ inability to identify and distinguish one owner’s goods from that of another. For example, a soda bottle with a non-distinct shape, while unique, may not be readily perceived as a distinctive feature or brand for that product. In other words, without any other identifiable information—trade name or recognized trademarks—the consumer would not know the manufacturer of that soda. On the other hand, consider the distinctive shape of the Coca-Cola bottle. Without any other identifiable information, consumers are conditioned to recognize the shape of a Coca-Cola bottle against that of some other bottled soda. To determine whether a particular feature is merely decorative, the USPTO considers the following factors: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness.<sup>49</sup> Of course, it was precisely this—the manner in which the mark was used—that hurt Organon’s ability to register its orange flavor as a trademark.

#### A. *The Commercial Impression of Flavor as a Proposed Trademark*

¶16 The first issue is whether flavor can leave the overall commercial impression that is needed in order for consumers to perceive it as a trademark. “Commercial impression” involves the meaning, idea, or the mental reaction the trademark evokes in a consumer.<sup>50</sup> It is that feature of the product—the trademark—that helps to create a certain emotional connection in the consumer: YOU’RE IN GOOD HANDS (security), the Pillsbury Doughboy (comfort), EVERY KISS BEGINS WITH KAY (love), and the UPS “brown” color (reliability).

<sup>45</sup> *In re Remington Prods. Inc.*, 3 U.S.P.Q.2d (BNA) 1714, 1715 (T.T.A.B. 1987).

<sup>46</sup> See *Qualitex*, 514 U.S. at 162.

<sup>47</sup> Trademarks can be used in connection with either goods or services. Due to the nature of this particular kind of matter—flavor and taste—I will focus my discussion on flavor as a trademark as used with goods.

<sup>48</sup> *In re Morganroth*, 208 U.S.P.Q. 284 (T.T.A.B. 1980).

<sup>49</sup> United States Patent and Trademark Office, Trademark Manual of Examining Procedure, Refusals on Basis of Ornamentation § 1202.03 [*hereinafter* Trademark Manual of Examining Procedure].

<sup>50</sup> *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1296 (C.C.P.A. 1974).



¶17 Organon attempted to trademark the flavor orange for use with pharmaceutical products. Orange, as used with a medicine, does nothing to immediately convey any lasting impression on consumers. As you might imagine, walk down any pharmaceutical aisle in a local store and you will be immediately inundated with a variety of orange-flavored medicines. In light of this, it would be practically impossible to have one product stand out from another, especially if solely relying on that flavor to spark the emotion in the consumer that would make him or her want to purchase one product over another. In addition, Organon itself did nothing to differentiate its “orange feature” from any other feature of the product.<sup>51</sup> Organon did not submit any evidence of how the mark is used in the marketplace.<sup>52</sup> Therefore, there was no evidence to support that orange flavor would create the type of commercial impression needed to establish a matter as a trademark. Consequently, “consumers would not view the orange flavor of an antidepressant tablet or pill as a trademark; rather they would consider it only as just another feature of the medication, making it palatable.”<sup>53</sup>

¶18 The second factor—relevant practices of the trade—also posed a huge hurdle for Organon. If the matter used as a proposed trademark is commonly used in the same industry in which the goods are sold, then that matter will fail to function as a trademark. Take, for example, the use of a descriptive word as a trademark. It would be unfair for a trademark owner to be allowed to corner the market on a word that is needed by its competitors in order to describe its own products without showing more evidence that establishes, in the mind of the average consumer, a connection between that trademark and a trademark owner. In other words, when a consumer sees a proposed trademark, does he or she view it as a trademark, or just a needed component, feature, or descriptive element? Similarly, orange flavor in the pharmaceutical industry is a popular choice. As noted by the TTAB, orange flavor is used in many medicines.<sup>54</sup> Due to the popularity of this flavor, competitors would be at a disadvantage if one company were granted exclusive use.

### B. Secondary Meaning or Evidence of Distinctiveness

¶19 Finally, a trademark owner must show that the mark is distinctive, or has acquired a secondary meaning. Marks that are not capable of consumer recognition upon adoption can only be protected if they have acquired distinctiveness among the relevant consumers. This type of consumer recognition is also known as “secondary meaning.”<sup>55</sup> It has been frequently held that those who claim a nontraditional mark must prove that the mark has achieved secondary meaning.<sup>56</sup> Establishing secondary meaning can be

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<sup>51</sup> See the record for U.S. Trademark Application Serial No. 76,467,774.

<sup>52</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1649 (T.T.A.B. 2006).

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

<sup>56</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000) (holding that a color or product configuration trademarks must always acquire secondary meaning); *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990) (scents); but see *In re General Elec. Broad. Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978) (holding that unique sounds can be inherently distinctive, and thus eligible for immediate protection, but secondary meaning is required when the sound is commonplace).

done by submitting evidence of how long the mark has been in use (generally shown by five years worth of use), evidence of extensive sales, large advertising expenditures in promoting the mark, and various examples of how the mark is used in the marketplace (including introduction at trade shows, consumer surveys and similar evidence).<sup>57</sup> Essentially, the mark must be used in commerce to obtain supporting evidence to defend a lack of secondary meaning claim. Consequently, Organon failed to produce the evidence required by the TTAB to satisfy this condition because of its lack of use of its flavor trademark in the marketplace.

¶20 Flavors can qualify as a trademark, but will most likely require substantial use and promotion of the flavor as a trademark before it will be accepted for registration.<sup>58</sup> Also, matters that are commonly used in the industry will fail to convey the type of commercial impression that is needed to achieve trademark status. Additionally, evidence of such widespread use dictates that one particular trademark owner would not be able to corner the market on that flavor. This would go directly against one of the fundamental goals of trademark law: to promote competition. Allowing registration of an orange flavor in the pharmaceutical industry would certainly inhibit competition.<sup>59</sup>

#### IV. FUNCTIONALITY OF FLAVOR

¶21 Registration of nontraditional trademarks is frequently denied on the grounds that the mark is functional. The Lanham Act expressly provides that an application for registration may be refused if it “comprises any matter that, as a whole, is functional.”<sup>60</sup> The purpose behind the doctrine is to encourage competition by maintaining a balance between trademark law and patent law. As the Supreme Court explained in *Qualitex*:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).<sup>61</sup>

In short, patent law and the functionality doctrine ensure novelty and advancement by allowing temporary protection on utilitarian features, as opposed to indefinite protection through trademark registration. In *TrafFix Devices Inc. v. Marketing Displays Inc.*, the

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<sup>57</sup> See, e.g., *Harlequin Enters., Ltd. v. Gulf & W. Corp.*, 644 F.2d 946, 950 (2d Cir. 1981); *Thompson Med. Co. v. Pfizer, Inc.*, 753 F.2d 208, 217 (2d Cir. 1985); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (for evidenced used to establish proof of secondary meaning).

<sup>58</sup> See, e.g., TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 49, § 1202.13 (explaining that nonfunctional scents may be registered upon showing secondary meaning, but the amount of evidence required is “substantial”).

<sup>59</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1649 (T.T.A.B. 2006).

<sup>60</sup> 15 U.S.C. § 1052(e)(5) (2006).

<sup>61</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

Court supported this concept, but shaped the doctrine further by establishing that the functionality doctrine is not affected by evidence of acquired distinctiveness.<sup>62</sup> Specifically, the Supreme Court noted:

The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.<sup>63</sup>

This is important to note because even if consumers recognize a utilitarian feature as coming from a single source, the feature is deemed functional and will not be protected under trademark law.

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The concept of functionality has evolved over time.<sup>64</sup> However, in 1982, in *In re Morton-Norwich Products, Inc.*, the Federal Circuit established a four-factor test for ascertaining functionality: (1) whether there exists a utility patent that discloses the utilitarian advantage of the design to be protected, (2) whether the originator of the design touts its utilitarian advantages through advertising, (3) whether viable alternative designs are available and (4) whether the design results in a comparatively simple or cheap method of manufacturing the product.<sup>65</sup> The *Organon* Board rested much of its opinion on factors two and three, while treating factors one and four as neutral.<sup>66</sup>

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<sup>62</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001).

<sup>63</sup> *Id.* at 34–35. See also *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995).

<sup>64</sup> See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982) (noting “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost of quality of the article”); *Qualitex Co.*, 514 U.S. at 165 (expanding the definition set in *Inwood* by adding that a product feature is functional “if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage”).

<sup>65</sup> *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982).

<sup>66</sup> With respect to factors one and four, the TTAB concluded that the fact it treated this consideration as neutral did not affect the outcome. It noted that “[t]here is no requirement that all four factors must be found to favor functionality before such a finding can be reached.” *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1646 (T.T.A.B. 2006) (citing *TraFix Devices, Inc. v. Mktg. Displays, Inc.*, 58 U.S.P.Q.2d 1001, 1006 (T.T.B.A. 2006)). Certainly the existence of a utility patent covering the feature, even an expired one, is *prima facie* evidence of functionality. See *In re Howard Leight Indus., LLC*, 80 U.S.P.Q.2d 1507 (T.T.A.B. 2006) (denying registration of “bullet-shaped” earplugs under the functionality doctrine due to the existence of an expired patent, which specifically covered the functional advantages of the shape of the earplugs). The lack of an active or expired utility patent, however, is not proof that the mark is not functional, and will be treated as neutral. In *TraFix*, the Supreme Court focused on the invention claimed in a utility patent:

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

*Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29–30 (2003).

*A. Is the Device Essential to the Function or Use of the Product*

¶23 The first point to consider is what makes a device, or component of a product, “essential” to the function of that product. Certainly, the test laid out above establishes a guide for what evidence might exist to determine functionality. Functionality asks one question: is the feature necessary in order for the product to operate (function) in the same manner? The TTAB posited that it would be difficult to imagine when flavor could ever be protected as a trademark, specifically mentioning the Board’s concern over whether consumers would treat it as a distinctive feature of the product.<sup>67</sup> As a general matter, it is difficult to see how flavor could ever be protected as a trademark if used in connection with products that are expected to have some sort of taste or flavor to them.<sup>68</sup> These include pharmaceutical products, food, beverages, mixtures of spices, or similar products. These types of products are formulated not to function in the same manner or taste the same, if a particular ingredient were missing.<sup>69</sup> With that in mind, surely products that are not expected to have any flavor could, upon proper use and promotion, overcome the hurdles placed by the TTAB.<sup>70</sup>

¶24 For example, take the fictional Pen and Pencil Company that recognizes a market for consumers that like to chew on pens and pencils. That company has discovered a unique way to sell its pens and pencils to this market by adding a flavoring agent to the writing instruments. Thus, the “peppermint flavored” pen and pencil are born. Certainly, the products will work without the flavoring. The flavor is not essential to the basic function of the pen or pencil. Also, consumers would not expect pens or pencils to have unique flavor, outside of a wood or plastic taste. Additionally, those consumers that chew on pens and pencils already would likely still chew on those instruments with or

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<sup>67</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1650.

<sup>68</sup> This does not mean that those products cannot be protected under some other form of intellectual property, namely, trade secret law. To the extent that a “secret recipe” has a unique process or method its special ingredients, the secret recipe or formula may be protected as a trade secret. Like a trademark, the lifespan of a trade secret is indefinite; the basic test being that so long as the secret remains a secret it will always be protected. Still, there is an advantage to having trademark protection. Under trademark law, the senior trademark owner is protected from infringement if the junior trademark user adopts a trademark that is confusingly similar to the senior user’s trademark. This trademark infringement standard is upheld whether or not the junior user knew about the senior user’s mark. In contrast, trade secret law only protects the proprietary interest so long as it is not discovered. For example, if the owner of the trade secret is relaxed in its processes for the protecting the secret, then it will fall into the public domain to be used by all. Similarly, if a competitor figures out the formula on its own, then that competitor is free to use the formula without fear of the originator stopping it. For this reason, trade secrets are best utilized for inventions that cannot be patented or are not easily reverse-engineered, such as KFC’s “11 herbs and spices” or Coca-Cola’s soft drink.

<sup>69</sup> See also Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 801 (2005) (positing that toothpaste may be another product where it would be difficult to make a claim flavor trademark claim, especially when used in connection with a “generic” flavor like mint or bubble gum).

<sup>70</sup> See, e.g., *id.* The authors propose that unique flavors, like melon, caramel, or peanut butter when used in connection with other dental hygiene products, like toothbrushes and floss, may avoid the functional label. However, even with these goods, there is concern that consumers will simply view it as an unprotectable feature of the goods, and not as a distinctive, unique trademark. See also *N.V. Organon*, 79 U.S.P.Q.2d at 1650. The Board acknowledged that the pharmaceutical company added the orange flavor to the pill in order to achieve patient compliance. In other words, the pharmaceutical company chose that flavor for its product, because without the flavoring the pill was bitter and patients were unlikely to take the pill. Further, the company chose that particular flavor because it worked best with masking the bitter taste.

without the flavoring (so there is no “compliance” issue).<sup>71</sup> Finally, it does not put competitors at a disadvantage because they do not need to add a flavor to their products in order for the pens or pencils to work. With this in mind, even if a competitor wanted to add flavor to its writing tools, arguably it would not be placed at an unfair advantage by not being able to use any particular flavor already in use by the senior user.<sup>72</sup>

¶25 Similarly, the fictional Baby Book Company that wants to promote early reading may manufacture a “strawberry flavored” book for teething babies. Parents enjoy the books because they can read to their children. Babies like the books because they can chew on them and taste the strawberry flavor, as opposed to the taste of rubber or plastic.<sup>73</sup> In the same manner outlined for the Pen and Pencil Company, the Baby Book Company should find success with claiming flavor as a trademark.<sup>74</sup>

¶26 In contrast, the TTAB noted the following reasons why an orange flavor as used with a pharmaceutical product did not function as a trademark and therefore should not receive trademark protection:

There is nothing in the record to indicate that “an orange flavor” for applicant’s antidepressants would be perceived as a trademark for them. On the contrary, the record shows that an orange flavor is used in numerous medicines. As a result, consumers would not view the orange flavor of an antidepressant tablet or pill as a trademark; rather, they would consider it only as just another feature of the medication, making it palatable. To be sure, *the record is completely devoid of any evidence of consumer recognition* of applicant’s “orange flavor” as a trademark. Inasmuch as *flavors, including orange, are a common feature of pharmaceuticals*, we find that consumers would not view applicant’s orange flavor as a trademark.<sup>75</sup>

Along these lines, a proposed trademark will be deemed functional if there is a lack of consumer recognition, and it is a common feature in the industry in which the trademark is used.<sup>76</sup>

¶27 Therefore, if the feature is essential to the function or use of the product, consumers will not recognize the feature (here, the flavor) as being unique, and consequently, the feature will not be protected under trademark law.

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<sup>71</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1648–49.

<sup>72</sup> Discussion of the theory of flavor depletion is explored in more detail below.

<sup>73</sup> Consider, however, other baby teething products where consumers may have an expectation that those products may have some flavor due to the oral-nature of the goods. However, there does not seem to be a wide-spread use of flavored baby teething products. Therefore, in comparison with pharmaceutical products, there is not this same consumer desensitization issue. Similarly, allowing the Baby Book Company exclusive use of a flavor would not put competitors in a disadvantaged position.

<sup>74</sup> Subject, of course, to the same standard as laid out in the *Organon* case that the flavor is not the subject of a utility patent; the owner of the trademark does not promote the flavor as a utilitarian feature; other flavors are available to competitors; and the addition of the flavor does not result in a relatively simple or cheap method of manufacturing the product.

<sup>75</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1649 (emphasis added).

<sup>76</sup> *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982).

### B. *Is the Device Promoted as a Trademark*

¶28 Functionality played a significant role in the TTAB’s decision to reject registration of Organon’s proposed mark. With respect to the second *Morton-Norwich* factor, promoting the device as a utilitarian advantage, the TTAB found it to be “particularly significant.”<sup>77</sup> When a trademark owner adopts a mark, it must be used in a manner in which consumers will recognize the device for its source-identifying ability. The manner of use must be such that consumers will not believe the device to be a common feature associated with that or any similar product. When a trademark owner promotes the device as a utilitarian feature of the product, it would be difficult to foresee that consumers would ever view the device as a trademark, and therefore causing it to lack distinctiveness.

¶29 For example, Organon’s website advertised that the “pleasant orange taste” of its antidepressants gave its products an advantage over “other conventional antidepressant tablets” because the orange flavoring masked the bitterness found in many therapeutic agents, thereby increasing compliance, and indirectly, efficacy.<sup>78</sup> This clearly shows the utilitarian benefit of including the orange flavoring. Without the flavoring, the product would not work as well, and consumers would not be enticed to continue using the product. As the TTAB explained, “[Organon’s] tablets and pills are designed to dissolve on a patient’s tongue; consequently, there is a practical need for the medicine to have an appealing taste.”<sup>79</sup>

### C. *The Availability of Alternative Flavors as Evidence of Non-Functionality*

¶30 Finally, the third factor—the availability of alternative designs or flavors—should be considered when analyzing functionality of a trademark.<sup>80</sup> At the heart of this issue is not just the mere existence of other alternative designs to negate functionality, but the availability of *viable* alternative designs. As quoted by the *Organon* Board, “[t]he question is not whether there are alternative flavors that would perform the same basic function, but whether these flavors work ‘equally well.’”<sup>81</sup> Once more, one of the

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<sup>77</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1645.

<sup>78</sup> *Id.* at 1646.

<sup>79</sup> *Id.*

<sup>80</sup> There is slight confusion among the lower courts as to whether or not it is even necessary to review the third *Morton-Norwich* factor once functionality has been proven under one of the other factors. Regarding this factor, the Federal Circuit has explained that:

We did not in the past under the third factor require that the opposing party establish that there was a “competitive necessity” for the product feature. Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court’s observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

*Valu Eng’g, Inc. v. Rexnord Corp.*, 61 U.S.P.Q.2d 1422, 1427 (Fed. Cir. 2002).

<sup>81</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1645 (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1427

primary purposes of trademark law is to promote competition.<sup>82</sup> Allowing exclusive use of a design, or flavor, when equally workable options are not available to competitors, would harm competition. For example, the TTAB, in a citable pre-*TrafFix* ruling, found the color “pink” to be *de jure* functional for surgical and postsurgical wound dressings.<sup>83</sup> The TTAB observed that “[t]here is no question that ‘flesh color’ for wound dressings serves the utilitarian purpose of blending well with the natural color of human skin.”<sup>84</sup> The TTAB used excerpts from NEXIS<sup>85</sup> regarding bandage colors and competitors’ catalogs offering “flesh colored” wound dressings to conclude that pink is “one of the few superior ‘flesh’ colors available for wound dressings.”<sup>86</sup> The TTAB reasoned that to grant an exclusive right to the color “pink” for that product would “limit the options of competitors and preclude them from using similar ‘flesh colors’ on their products.”<sup>87</sup>

¶31 Similarly, the *Organon* Board found reason to deny “an orange flavor” for pharmaceutical products. The TTAB relied on the evidence presented by the examining attorney in proving that orange flavoring for pharmaceutical products was not only very common in the industry, but was necessary in masking the bitterness of certain medications, including Organon’s product. Numerous NEXIS excerpts were examined, all of which pointed to the use of orange flavoring as a way to help with patient compliance by enhancing the taste of the product.<sup>88</sup> One of the more compelling excerpts came from the website of Flavors of North America, Inc., a business that produces flavors for use in pharmaceuticals.<sup>89</sup> The TTAB highlighted the following, specifically:

The flavors act . . . as bitterness modifiers, masking agents and sweetness enhancers. The website indicates that “[b]itter principles in healthcare products are a real challenge since most therapeutic agents are alkaloids that are inherently bitter” and that . . . [t]he flavorings “are meant to be used to cover over inherent undesirable aspects of a product’s taste profile,” hiding bitterness, chalkiness, sourness and harsh metallic notes.<sup>90</sup>

¶32 Of the flavors listed, the pharmaceutical industry frequently used orange. While the TTAB did not directly comment, it could be inferred that the reason why orange is a popular choice in the pharmaceutical industry is because that flavoring agent does a superior job at masking the bitter taste of drugs. Alternatively, the pharmaceutical industry is aware that orange is a widely acceptable flavor to consumers, thus ensuring purchase of the product and “patient compliance.”

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(C.C.P.A. 1982) (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:75 (4th ed. 2006))).

<sup>82</sup> When determining whether there is an existence of viable alternative designs, the critical question is whether exclusive use of the design would put competitors at a significant disadvantage. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

<sup>83</sup> *In re Ferris Corp.*, 59 U.S.P.Q.2d 1587 (T.T.A.B. 2000).

<sup>84</sup> *Id.* at 1593.

<sup>85</sup> NEXIS is an electronic database that includes, among other things, the full texts of newspapers and periodicals articles.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> See *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1641–43 (T.T.A.B. 2006) (listing NEXIS web pages).

<sup>89</sup> *Id.* at 1643.

<sup>90</sup> *Id.*

¶33 In Organon’s defense, it asserts alternative flavor options for its product—cherry and grape. However, Organon offered no evidence that these flavors would work equally as well with its product. The TTAB seemed unconvinced that cherry or grape flavoring worked as well with Organon’s dissolving pills and tablets at masking the bitterness of its product. As proof, the TTAB highlighted the examining attorney’s evidence that flavoring agents are added to drugs for the sole purpose of enhancing the taste and encouraging consumer consumption.<sup>91</sup> If cherry or grape were viable options, then Organon should have presented evidence in support of this claim, but it did not. Even more damaging to Organon’s position were its own promotional materials, which touted the benefit of the orange flavor in making the drugs more palatable.<sup>92</sup>

¶34 Also, Organon did not make a convincing argument that there were an unlimited number of available options that competitors could use with its pharmaceutical products. The TTAB and courts have not set a minimum number of viable options needed to overcome a challenge of functionality. Arguably though, it is clear that only putting forth a few alternatives will not pass the test.<sup>93</sup> What might be inferred from the TTAB’s decision is that even if there are numerous flavoring options, there may be other factors that point to the “limiting nature” of that particular flavor. In other words, one can imagine the various flavors that may be used. Regardless of a flavor’s compatibility with the product, if that flavor is on “the short list” of popularly used flavoring agents that could be proof of a limited number of available alternatives.<sup>94</sup> The TTAB seemed to consider each of these points in determining that there were no alternative flavors, thus determining that allowing the adoption of the orange flavoring as a trademark would be anti-competitive, rendering it functional.

#### V. PRACTICAL CONSIDERATIONS: THE HURDLES PRESENT FOR REGISTERING FLAVOR AS A TRADEMARK

¶35 It is probably unfair to classify the *Organon* decision as a departure from the trend to expand the scope of trademark protection of nontraditional trademarks. The TTAB did, after all, leave open the possibility that flavor could one day be protected as a trademark.<sup>95</sup> Nevertheless, while a flavor, in theory, could meet the requirements for trademark protection, there are some issues that make flavors unique, even when compared to the other nontraditional trademarks. The TTAB gave a strong warning that there are significant hurdles to reach trademark status. There are also great practical concerns with allowing flavor to function as a trademark.

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<sup>91</sup> *Id.* at 1641.

<sup>92</sup> *Id.* at 1642–43 (A survey showed that “more than half [of those surveyed] said that . . . pleasant taste [was an] important advantage over conventional antidepressants tablet.”).

<sup>93</sup> *See, e.g.,* *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628 (3d Cir. 1992) (noting that use of one of two basic types of designs was evidence of functionality); *cf. Pebble Beach Co. v. Tour 18, Ltd.*, 155 F.3d 526, 538–40 (5th Cir. 1998) (noting that golf course designs are non-functional due to the unlimited number of alternative designs).

<sup>94</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (T.T.A.B. 2006) (noting that orange is on the short list of popular flavors for pharmaceutical products).

<sup>95</sup> Much of the TTAB’s analysis focuses on how impractical it can be to claim flavor as a trademark. However, with proper application by the trademark owner, flavor could be claimed in some foreseeable instances.



### A. Depletion of Available Flavors

¶36 One consideration for denying registration is the concern that removing a particular matter from a limited universe would put competitors at a disadvantage. The TTAB took issue with the generic description provided for the mark: “an orange flavor.”<sup>96</sup> The TTAB found that the description was vague, and that allowing registration of the mark would grant Organon exclusive rights to all orange flavors, not just the purportedly distinct flavor Organon claimed.<sup>97</sup> This “flavor depletion theory” stems from similar concerns that were raised when trademarks were permitted for colors.<sup>98</sup>

¶37 Historically, the Trademark Office shied away from the registration of a color trademarks used in connection with any particular goods or services.<sup>99</sup> The fear was that there were a limited number of colors visible to the human eye.<sup>100</sup> Thus, the argument was made that color alone could not be considered a trademark, since granting trademark status to colors would soon lead to the depletion of the number of colors available for an item.<sup>101</sup>

¶38 The *Qualitex* decision provides significant insight into the discussion of protecting nontraditional trademarks, such as flavors. First, the court in *Qualitex* rejected arguments based on the depletion theory, reasoning that alternative colors would usually be available for competitors.<sup>102</sup> Additionally, the court said that in those cases where alternative colors were not available, courts could deny trademark protection in those circumstances where depletion may actually occur.<sup>103</sup> Furthermore, the court was unconvinced that allowing the registration of colors as trademarks would result in consumer “shade confusion.”<sup>104</sup> This is important for flavor trademarks, as the same questions are present in the Organon decision: whether there are enough varieties of flavors to make a showing of distinctiveness, and would consumers be confused by these distinctions.

### B. Creating a Distinctive Flavor

¶39 Organon argued that its orange flavor was “distinctive,” although its application simply covered “an orange flavor.”<sup>105</sup> Those wishing to claim flavor in connection with their products will most likely need to either use a unique flavor or be very specific in their application and marketing as to the flavor being protected. Analogously, colors start with a basic hue, but from there can be expanded to almost unlimited shades. A trademark owner that attempts to register the color orange recognizes that the spectrum of

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<sup>96</sup> *N.V. Organon*, 79 U.S.P.Q.2d at 1649.

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 1664.

<sup>99</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 169 (1995).

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* at 168.

<sup>103</sup> *Id.* at 167.

<sup>104</sup> *Id.* (explaining that consumers would be able to visually perceive the varying degrees of shade of any basic color).

<sup>105</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006).

orange shades runs from an amber-orange to a reddish-orange to a burnt-orange and so on. Additionally, and most likely in response to the color depletion theory, it is recognized that, when a color is claimed in an application, it is not for all hues of that base color.<sup>106</sup> An applicant claiming color as a trademark must claim that color in the application and submit a color copy of the mark. This way the examining attorney, and anyone else searching the record, will be aware of the shade of color sought for protection.

¶40

In comparison, orange flavor can also have a variation of notes that will influence the taste of the flavor. As explained in the book *Flavor Creation*, an orange flavor can take on various profiles.<sup>107</sup> Particularly, the flavor components of the orange flavor are “buttery, candy, citrus, floral, fruity, green, herbal, sharp, sulfury, and vanilla.”<sup>108</sup> Illustrations of how these components enhance flavor is explained further:

Acetyl methyl carbinol (buttery) in very low concentration softens the profile, while Maltol (candy) accentuates aromatic sweetness . . . Rose aroma . . . (floral, rose) . . . increase[s] the juicy character . . . Myrcene (herbal, mango) . . . enhances the herbal note and gives depth.<sup>109</sup>

Further, these broader categories can also be divided into sub-categories, including both natural and synthetic flavors that would further distinguish one orange flavoring agent from another.<sup>110</sup> So, one distinctive orange flavor could have a citrus/orange base, with the additives of floral, herbal, and fruity, (or more specifically, have the notes of rose/citronellol, mango/neryl oxide, and pineapple/allyl hexanoate).<sup>111</sup> Understanding these various components, like hues of a color, makes it is easy to see that it is possible to have very different, distinctive flavors within these broader categories. Therefore, like color, there should not be a concern about depletion in available flavors.<sup>112</sup>

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However, this process has its issues. First, unlike color marks, flavors do not have the same visually perceptive trait that would immediately convey to the consumers the matter that is being protected as a trademark.<sup>113</sup> As explained above, there appears to be a strong indication that consumers will find the flavor to be an essential feature of the product, and not as a source identifier. This is also important because, unlike other types

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<sup>106</sup> *Qualitex Co.*, 514 U.S. at 167, (“We do not believe . . . 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 . . . We do not see why courts could not apply those standards to color.”).

<sup>107</sup> JOHN WRIGHT, *FLAVOR CREATION* 37 (Allured Publishing Corporation, 2d ed. 2005) (explaining how various notes can define flavor profiles).

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 198.

<sup>111</sup> *See, id.* at 199–203 (listing a complete chart of the “Defined flavor descriptors”).

<sup>112</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 168–69 (1995). Finding the functionality doctrine to be sufficient protection to competitors, the court rejected the color depletion theory. “[The color depletion] argument is unpersuasive, however, largely because it relies on an occasional problem to justify a blanket prohibition. When color serves as a mark, normally alternative colors will likely be available for similar use by others.” *Id.*

<sup>113</sup> Also consider the fact that we have a trademark database that uses a visually perceptive system for searching trademarks, and ultimately clearing marks for registration. It could be difficult to search for potentially conflicting marks based solely on a flavor.

of marks where the consumer is allowed to experience the mark, whether through sight or smell, before purchase, it is not immediately apparent that consumers would be able to taste the product before purchase.<sup>114</sup>

¶42 Second, there may be the issue of consumer “flavor distinction confusion” if consumers are not aware or in tune with these (possibly subtle) variations. Unlike colors, where consumers are aware of variations in shades of color and can speak in those terms, consumers have a tendency to think in broad terms with respect to flavor: it’s sweet, fruity, citrusy, etc.; or it’s orange, grape, cherry, etc.<sup>115</sup> So it would take that trademark owner, and more likely the broader business industry, to educate the average consumer to develop his or her consciousness about the variations in flavor.<sup>116</sup>

### C. Sensory Perception Issues

¶43 Another issue is whether the purported flavor to be protected as a trademark will be the same flavor that consumers taste, or whether all consumers will taste or experience the same distinctive flavor asserted to be a trademark. The TTAB appeared to be concerned that consumers would not taste a “distinct” flavor but simply a generic orange flavor. Organon asserted it was using a “distinctive orange flavor.”<sup>117</sup> However, the TTAB appeared to be concerned that consumers would not taste a “distinct” flavor, but simply a generic orange flavor.<sup>118</sup>

¶44 Take for example, the three industries of wine, coffee, and cigarettes. The wine industry has done an excellent job at educating the average consumer about the variations of notes, aroma, and ultimately taste of any particular wine (even those in the same broad category of reds and whites, or merlots and zinfandels and chardonnays and rieslings). Similarly, frequent coffee drinkers can also tell you about the differences in robustness, notes, and acidity levels of their coffee. Finally, cigarette smokers are extremely aware of the variations among different products.

¶45 While claiming a flavor as a trademark in connection with any of these products may be deemed functional,<sup>119</sup> we can use these products as an example of where the frequent consumer of wine, coffee, or cigarettes has a heightened sense of the distinctions among competing products. This begs the question, whether standards for acquiring distinctiveness should be based on the “frequent” consumer of those products? Take for

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<sup>114</sup> This becomes important because a consumer should be able to make a determination before purchasing a product in order to make sure that she is getting her intended product. With that said, this could be accomplished by providing a point-of-sale display that allows samples of the product (of course, at a greater expense to the trademark owner).

<sup>115</sup> *But see* Robert P. Erickson, *Studies on the Perception of Taste: Do Primaries Exist?*, 28 *PHYSIOLOGY AND BEHAVIOR* 57 (1982) (explaining that humans have traditionally identified four taste sensations: sweet, salty, sour, and bitter; but, further research suggest that a fifth sensation exist- fatty acids- and that there may be a continuum of flavors, like colors).

<sup>116</sup> *See* WRIGHT, *supra* note 107, at 196 (noting a balance needs to be struck between flavorist—those that create the flavors—developing simpler terms in order to communicate with consumers on their level and consumers becoming more aware of the various flavor descriptors).

<sup>117</sup> *In re N.V. Organon*, 79 U.S.P.Q.2d, 1639, 1650 (T.T.A.B. 2006).

<sup>118</sup> *Id.*

<sup>119</sup> A flavor trademark in connection with wine would most likely be deemed functional because consumers would not recognize that feature as being distinctive, or serving as a source identifier, in order to achieve trademark protection. Note, however, that secret recipes could be protected under trade secret law.

example, the new consumer, or infrequent consumer, who instead of tasting a robust, low acidic Sumatra coffee, just tastes coffee. Or the wine drinker that does not taste the flavors of black cherry, plum, and oak in her merlot, but simply tastes a dry, red wine. It is not necessary that these consumers be educated about distinctions in flavors before a flavor can truly be deemed “distinctive.” Arguably, it is the palates of the general consumer that must be considered. The way we experience flavor is affected by four aspects: (1) stimuli (the amount of flavor needed for one to detect and recognize the flavor); (2) receptors (the level at which one can judge flavor intensity over the entire range of taste); (3) processing of sensory signals; and (4) the hedonic response of individuals (the level at which one emotionally judges flavor to be pleasant or unpleasant).<sup>120</sup> Each of these factors presents a challenge in how flavor will be perceived and interpreted, and points to how subjective the sensory evaluation process can be. Nontraditional marks have the potential to serve as powerful tools in conveying the emotions and ideas underlying the most compelling brands and establish an emotional bond with the consumer, while offering the assurance of product consistency. Certainly, flavor trademarks could evoke this same bond between consumers and the product. The issue, though, is whether the same emotions and ideas underlying a flavor brand will be conveyed when consumers have such diverging palates.<sup>121</sup>

#### D. Meeting Application Requirements

¶46 All marks, regardless of type, must be capable of clear and unambiguous graphic representation to allow for accurate and effective searching and clearance by the USPTO and by third-party trademark owners. Other nontraditional marks such as color and sound marks have developed widely accepted systems for identification. Color marks are referenced by an accepted color code such as the Pantone Matching System,<sup>122</sup> and sound marks are represented by musical notations.<sup>123</sup>

¶47 A similar identification system could be adopted for flavor marks, although it may not be necessary at this point. First, a system for identifying scents has not been adopted by the USPTO, though scent trademarks have been registered. Instead, the USPTO has

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<sup>120</sup> Kathryn D. Deibler & Jeannine Delwiche, *Preface* to Handbook of Flavor Characterization: Sensory Analysis, Chemistry and Physiology (Kathryn D. Deibler & Jeannine Delwiche eds., Marcel Dekker, Inc. 2004).

<sup>121</sup> In this same vein, comes the issue with consumer recognition of a mark. The trademark tells the consumer about certain qualities of the product that are not observable before purchase. A strong trademark entices the consumer to purchase the product. For example, a Coca-Cola bottle, without any other identifying information, conveys a certain quality about the product to the consumer. The purchaser does not have to taste it before purchase to determine quality, or distinguish it from competing products. The same is true with scent marks. A consumer could “experience” that trademark before purchase (even if it is a wrapped product, a scented label could be placed on the outside of the packaging to establish that consumer connection and recognition). Trademark owners can create this same consumer recognition before purchase through free samples or point of sale displays.

<sup>122</sup> In 1963, Pantone, Inc. established a universal database of colors. These colors are consistently updated, and provide a source for selecting and determining specific shades in the color spectrum. *See* Pantone, <http://www.pantone.com> (last visited Aug. 26, 2010).

<sup>123</sup> U.S. Trademark Reg. No. 2,315,261 (filed on February 8, 2000) (registered for the Intel Inside tune consisting of a “five tone audio progression of the notes D Flat, D Flat, and A Flat” for computer hardware and software).

relied on a description of the scent to be included in the application. The same could be true for flavor marks, keeping in mind that some consideration should be given with respect to how detailed one should be in the description. Nevertheless, these descriptions could be generated through a computer program. Technology is available and can be utilized for distinguishing between various scents and flavors.<sup>124</sup> In 2004, the Journal of Pharmaceutical & Biomedical Analysis published an article entitled “Flavor analysis in a pharmaceutical oral solution formulation using an electronic-nose.”<sup>125</sup> The article explored the “electronic-nose” technology that was initially developed to distinguish six common flavoring agents: raspberry, red berry, strawberry, pineapple, orange, and cherry. Such technology could alleviate any concerns about human subjectivity issues in discerning flavors.

¶48 Furthermore, such technology would assist examining attorneys ultimately faced with the issue of determining if the mark described in the application is the same mark used on the specimen submitted with the application.<sup>126</sup> Assume our Pen and Pencil Company and Baby Book Company file applications to cover their respective marks; the examining attorney would not stick those products in his or her mouth in order to determine whether the description of the mark on the application matches the flavor on the product. Therefore, even with the adoption of a universal coding system for descriptions of flavors, without technology like the electronic-nose, the ability to effectively review applications and accept flavor trademarks for registration would be, and perhaps should be, stalled.<sup>127</sup>

## VI. CONCLUSION

¶49 In light of the TTAB’s ruling in *Organon*, achieving registration of a flavor trademark at the USPTO will be tremendously difficult. One who seeks to register a flavor trademark must only adopt the trademark after proper research of the issues, and after establishing use. Unless the applicant makes a significant effort to promote the flavor as a trademark and establish consumer recognition, there is little hope that registration can be achieved.

¶50 Additionally, if the utilitarian advantages of the flavor are disclosed or claimed in a utility patent, the applicant has touted such advantages in its advertising, or there exist few viable alternative flavors, there is a slim chance of proving non-functionality. Even

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<sup>124</sup> See, Limin Zhu, *Flavor Analysis in a Pharmaceutical Oral Solution Formulation Using an Electronic-Nose*, 34 J. OF PHARM. & BIOMED. ANALYSIS 453 (Feb. 18, 2004). This technology could be used for both scent trademarks and flavor trademarks since much of what we perceive as taste actually comes from our sense of smell. Taste buds allow us to perceive only bitter, salty, sweet, and sour flavors. As explained in the *Zhu* article, it is the odor molecules from food that give us most of our taste sensation.

<sup>125</sup> *Id.*

<sup>126</sup> It is a requirement of the trademark application process to submit a “graphic representation” of the mark, and a specimen—i.e. an example of how the mark is used on the product. The mark used on the specimen must match the graphical representation included in the application.

<sup>127</sup> Also consider Federal Drug Administration requirements, and its authority to review and object to registration of marks based on labeling issues. Companies that are not in the business of regularly dealing with the FDA may find the process complicated, and its application and placement of product in the marketplace stalled while meeting the requirements of the FDA.

if the functionality hurdle is cleared, the mark must then meet the strict burden of proof that applies to the establishment of secondary meaning for flavor trademarks.

¶51 Finally, some practical aspects of registering a trademark—graphic representation and review of acceptable specimens—pose requirements that the USPTO seemingly is not prepared to handle. Even with the proper coding system and technology in place, there would still be the concern that consumers may not recognize the subtle variances in flavor in order to distinguish between brands.