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Dedicated to Jerre B. Swann 1939–2025

In Memoriam: Jerre B. Swann (1939–2025)
William H. Brewster, Theodore H. Davis Jr., and R. Charles Henn

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IN MEMORIAM

Jerre B. Swann

By William H. Brewster, Theodore H. Davis Jr., and R. Charles Henn*

The Trademark Reporter ("TMR") dedicates this issue to our friend and colleague, Jerre B. Swann (1939–2025), who served as the TMR's Editor-in-Chief from May 1988 through April 1990 and who remains one of the most prolific contributors to the TMR in its history.

Jerre's accomplishments during his 58-year career at Kilpatrick Townsend & Stockton were many, but, consistent with his long-standing relationship with the TMR, perhaps the greatest was his extraordinary writing, which continues to have a substantial influence on United States trademark law and the way cases are litigated.[1] That output was not limited purely to the basics of

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* The authors each practiced with Jerre Swann for multiple decades at Kilpatrick Townsend & Stockton (Member, International Trademark Association) and its predecessor firms. Mr. Brewster's contribution to this dedication is posthumous and drawn from his comments on the occasion of Jerre's receipt of a 2024 IP Legends Award from the Georgia Intellectual Property Alliance.

1 For representative (and not exhaustive) examples of courts citing favorably to representative (and not exhaustive) examples of Jerre's scholarship, see, e.g., Elevate Fed. Credit Union v. Elevations Credit Union, 67 F.4th 1058, 1068 (10th Cir. 2023) (citing Jerre B. Swann & R. Charles Henn Jr., *Likelihood of Confusion Surveys: The Ever-Constant Eveready Format; the Ever-Evolving Squirt Format*, 109 Trademark Rep.

trademark, copyright, and unfair competition litigation; instead, his scholarship went back and forth with judges, academics, and expert witnesses alike, and he always seemed to have the upper hand in those arguments. Indeed, Jerre's body of work on survey evidence in particular is so respected that even survey experts routinely rely on it.[2] It therefore was no surprise when one of his many scholarly articles in this publication received the 2000 Ladas Memorial Award.[3]

But the significance of Jerre's written output was not limited to its substantive quality. Anyone working with—or, better yet, *writing* with—Jerre quickly became familiar with his extreme economy of words. His breviloquence in allocating responsibility for particular portions of briefs and articles could (and often did) inadvertently result in competing versions of what otherwise was the same work product. On those occasions, comparisons of the two versions always led to the same conclusion: Jerre had accomplished far more in far fewer words than anyone else possibly could have. And that pithiness extended to his speaking style as well: Because he was not one for small talk, working on cases with Jerre meant that you got to the point, and he got to the point, whether inside or outside the courtroom.

Dr. Shari Diamond, with whom Jerre co-edited the leading treatise on trademark and false advertising surveys,[4] recently noted that he "was always filled with curiosity, a true scholar as well as an exceptional trial attorney, with high standards and a rare combination of incisive and accessible writing ability—and he was the most generous collaborator one could imagine . . . . In the course of [our] work, I experienced one additional sterling—and rare—

671, 680–81 (2019)); Parks LLC v. Tyson Foods, Inc., 863 F.3d 220, 232 (3d Cir. 2017) (citing Jerre B. Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirt*, 98 Trademark Rep. 739, 746 (2008)); Maker's Mark Distillery, PBC v. Spalding Grp., No. 319CV00014GNSLLK, 2024 WL 947475, at *3 (W.D. Ky. Mar. 5, 2024) (citing Jerre B. Swann, *A "Reading" Test or A "Memory" Test: Which Survey Methodology Is Correct?*, 95 Trademark Rep. 876, 876–77, 880 (2005)); Hypnotic Hats, Ltd. v. Wintermantel Enters., 335 F. Supp. 3d 566, 596 (S.D.N.Y. 2018) (citing Shari Seidman Diamond & Jerre B. Swann, Trademark and Deceptive Advertising Surveys: Law, Science, and Design 54, 67–68 (2012)); Bodum USA, Inc. v. A Top New Casting, Inc., No. 16 C 2916, 2017 WL 6626018, at *6 (N.D. Ill. Dec. 28, 2017) (citing Jerre B. Swann, *Eveready and Squirt-Cognitively Updated*, 106 Trademark Rep. 727, 727–28 (2016)), *aff'd*, 927 F.3d 486 (7th Cir. 2019); Pharmacia Corp. v. Alcon Lab'ys, 201 F. Supp. 2d 335, 381 (D.N.J. 2002) (citing Jerre B. Swann, *Dilution Redefined for the Year 2000*, 90 Trademark Rep. 823, 860 n.237 (2000)).

2 *See* In-N-Out Burgers v. Doll n' Burgers LLC, No. 20-11911, 2022 WL 791924, at *13 (E.D. Mich. Mar. 14, 2022) (noting that "Jerre Swann [is] an expert in trademark survey design who is cited extensively in both parties' expert reports").

3 Of almost certainly lesser significance to Jerre personally, he also served on INTA's Board of Directors (1989–1991) and received INTA's 2009 President's Award and 2002 Volunteer Service Award for the Advancement of Trademark Law.

4 *See* Shari Seidman Diamond & Jerre B. Swann, Trademark and Deceptive Advertising Surveys: Law, Science, and Design (2022 ed.).

quality in Jerre: he was a master at disagreeing agreeably. His charm and his intellect were ever-present in every exchange."

As Dr. Diamond's comments suggest, Jerre was as formidable a trial and appellate lawyer as he was a writer. Success in litigation often turns on the management of the surprises that occur in every case, and Jerre was an accomplished master of that skill. Whatever happened in adversarial disputes, Jerre simply adjusted to the new playing field and carried on. His apparent serenity in the face of evolving facts and sometimes dubious behavior by opposing counsel allowed him to filter out all distractions and therefore always to prioritize his clients' interests. Those clients were his friends, people with whom he did things outside of work and had very close relationships. And that tenacious loyalty extended as well to his law firm, in the best interests of which he always acted, just as he did where trademark and unfair competition law were concerned. He is greatly missed by all who knew and practiced with him.

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SHOULD WE WORRY ABOUT COLOR DEPLETION? AN EMPIRICAL STUDY OF USPTO SINGLE-COLOR TRADEMARK REGISTRATIONS*

*By Dr. Xiaoren Wang***

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* This article should be cited as Dr. Xiaoren Wang, *Should We Worry About Color Depletion? An Empirical Study of USPTO Single-Color Trademark Registrations*, 115 Trademark Rep. 522 (2025).

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ABSTRACT

Trademark law across the United States ("U.S."), European Union ("EU"), and United Kingdom ("UK") allows companies to register single colors as trademarks, thereby preventing competitors from registering and using the same or confusingly similar colors in related markets.[1] Allowing companies the exclusive right to use and register single-color trademarks, however, may ultimately lead to color depletion: when more colors are registered and protectable as trademarks, fewer colors are available for new entrants. With fewer color options left, color depletion can create market entry barriers and impose anticompetitive costs on new entrants. Psychological and marketing research suggests that color depletion and concentration may exist in business-preferred colors, but scholars debate whether color depletion is severe in practice. Unfortunately, there has been no quantitative empirical research assessing the actual severity of color concentration and depletion—until now.

This article explores the findings of the first quantitative investigation into the extent of color concentration and depletion. The color study uses a software program written in the Python language to code and analyze 854 single-color trademark applications and registrations across all 45 international classes of goods and services recorded in the United States Patent and Trademark Office ("USPTO"). The study reveals that trademark filings are most concentrated in the red hue segment and in color areas with high brightness and high saturation. The results of this study lead us to estimate that there may be substantial depletion in certain classes; for example, according to our methodology: 41% of the color space has been claimed in Class 9 (electronic and technological products, etc.), 40% has been claimed in Class 10 (medical instruments, etc.), and 30% for each of Class 5 (pharmaceuticals, etc.) and Class 7 (machines, etc.). Furthermore, the results of the study hint that some classes, including Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42, are likely to be depleted in the near future. Based on these findings, this article offers recommendations for the USPTO and courts to address color concentration and depletion. This study also calls for a reflection and reconstruction of the fundamental justification of trademark law.

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[1] In the United States and a number of other countries, applicants may register a color as a trademark if that color serves as a single source identifier and is not used ornamentally or serve a utilitarian purpose. To register a color at the U.S. Patent and Trademark Office ("USPTO"), the applicant must show, inter alia, that the color has achieved secondary meaning and is not functional. *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995).

I. INTRODUCTION

Trademark law in the U.S., EU, and UK allows for the registration of single colors as trademarks, such as Louboutin's red shoe sole that contrasts with the upper body of a shoe and Tiffany's use of PANTONE 1837 blue in connection with jewelry. Competition over colors has become intense. For example, in 2014, T-Mobile sued Aio Wireless (Aio, a subsidiary of AT&T) over Aio's use of a plum color (PANTONE 676C, depicted on the right side of Figure 1) for wireless telecommunication services and products.[2] The court granted T-Mobile's Motion for Preliminary Injunction, holding that Aio's plum color was confusingly similar to T-Mobile's registered magenta color (PANTONE Process Magenta, depicted on the left side of Figure 1) and that there is a substantial likelihood of success on the merits of T-Mobile's trademark infringement claim.[3]

Figure 1. Single-color trademarks of T-Mobile and Aio

T-Mobile (plaintiff) Aio (defendant)

Aio resisted T-Mobile's Motion by arguing that all "primary and secondary colors (red, yellow, blue, green, and orange), except violet are owned in the prepaid/wireless space, as most colors had already been claimed by other companies in the sector."[4] As a result, Aio explained that it was exceedingly challenging for it to select a brand color sufficiently distinct from existing ones. Indeed, Verizon claims red, Sprint claims yellow, AT&T claims orange, T-Mobile claims magenta, and Cricket claims green.[5] It is thusly difficult for entrants to find a color that is available and sufficiently distinct from the rainbow of existing color trademarks claimed by competitors. Although the court ruled against Aio, the discussion of Aio's predicament sheds light on the limited color options in the telecommunications sector. Allowing companies to register and claim exclusive rights to use single colors will deplete the available color choices for new entrants in all sectors. This phenomenon is known as "color depletion."

To understand color depletion, we first need to define color. Color is the human visual perception on a segment of the electromagnetic spectrum, with wavelengths from around 0.38 to

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2 T-Mobile US, Inc. v. Aio Wireless LLC, 991 F. Supp. 2d 888 (S.D. Tex. 2014).

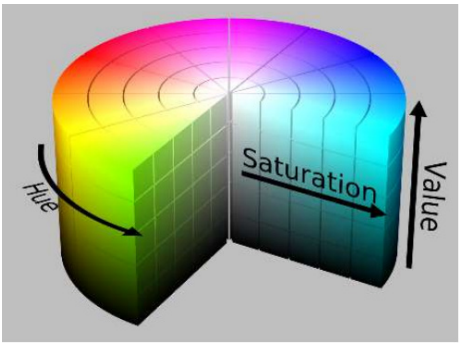
3 *Id.* at 931–32.

4 *Id.* at 901 (quoting Interbrand presentation).

5 *Id.* at 894, 896, 901–02.

0.78 micrometers.[6] Every visible color can be identified by three dimensions: hue, saturation, and brightness (Figure 2).[7] Hue refers to the color category, such as red, orange, yellow, green, blue, etc., represented on a scale ranging from 0 to 360 degrees.[8] Saturation measures how gray or colorful a color is, represented on a scale ranging from 0 to 1.[9] Brightness characterizes how light or dark a color is, also represented on a scale ranging from 0 to 1.[10] The color space can be visualized as a cylinder (Figure 2) measured by these three dimensions.

Figure 2. An HSB (Also Called "HSV") Color Space. (In this figure, "Value" is exchangeable with "Brightness."[11])



Color depletion is a process by which a decreasing number of potential colors remain unclaimed by any trademark owner.[12] In theory, color space can be divided into millions of individual units based on the three dimensions, which would seemingly provide plenty of colors for use by trademark owners. The reality, however, is that human eyes can distinguish between two colors only when their distance in the color space is relatively large. Therefore, distinguishable colors are not infinite and depletion of commercially useful colors is a concern.

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6 Alessandro Bettini, A Course in Classical Physics 4—Waves and Light, 105 (2016).

7 Mohan Lal Gulrajani, ed., Colour Measurement: Principles, Advances and Industrial Applications, 11, 55-56 (Elsevier 2010). There are different coding systems of color: HSB, HSL, PANTONE, LAB, etc. This research uses the HSB code system, which is widely used in psychological research.

8 *Id.* at 55-56.

9 *Id.*

10 *Id.*

11 SharkD, Wikimedia Commons, https://commons.wikimedia.org/wiki/File:HSV_color_solid_cylinder.png (last visited May 17, 2025).

12 *See* Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 Harv. L. Rev., 945, 950 (2018) (discussing "trademark depletion"); *see also id.* at 977.

In addition, psychological research[13] and anecdotal evidence[14] suggest that companies tend to favor certain colors for branding over others. For example, studies indicate that people generally prefer blue and dislike yellow-green, which might influence company choices regarding trademark colors[15] (see Section II for more details). Therefore, some colors might be "good" for trademarks while others might be "inferior." This preference suggests that "color concentration"—a clustering of trademark registrations in certain color areas—should occur.

Color concentration and color depletion are distinct yet interrelated phenomena. Color concentration may occur when certain colors are preferred disproportionately in business contexts, while color depletion refers to the shortage of available colors. Thus, the very existence of color concentration suggests a risk of color depletion in some color areas; excessive concentration of use and registrations in a business-preferred color area cause a depletion of available colors in that area for new businesses. Therefore, high color concentration can be seen as a manifestation of color depletion within a specific area. Furthermore, the same concern, namely, the anticompetitive costs discussed in the paragraph below, underlies both phenomena. Accordingly, this article will investigate both color concentration and color depletion.

The real concern with color concentration and depletion is not that companies will have no colors left to use or register as trademarks. Rather, the harm is the anticompetitive costs that color concentration and depletion can cause. There are three types of these anticompetitive costs: First, when there is color concentration and depletion, a new entrant incurs additional expenses when selecting a color to ensure that it chooses a color that is far enough from the concentrated areas to avoid conflicts with colors that have already been claimed, but that are not too far from the "good" colors in any given industry.[16] After choosing a color, entrants also may need to design around colors that established users are already using on their own products and services in terms of the shape,

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13 J. P. Guilford & Patricia C. Smith, *A System of Color-Preferences*, 72 Am. J. Psych. 487, 490-491 (1959); Patricia Valdez & Albert Mehrabian, *Effects of Color on Emotions*, 123 J. Experimental Psych.: Gen. 394, 398 (1994); Nilgün Camgöz, Cengiz Yener & Dilek Güvenç, *Effects of Hue, Saturation, and Brightness on Preference*, 27 Color Rsch. & Application 199, 203 (2002) [hereinafter Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness* (2002)]; Nilgün Camgöz, Cengiz Yener & Dilek Güvenç, *Effects of Hue, Saturation, and Brightness: Part 2: Attention*, 29 Color Rsch. & Application 20, 25 (2004) [hereinafter *Hue, Saturation, and Brightness: Part 2: Attention* (2004)]; Lauren I. Labrecque & George R. Milne, *To Be or Not to Be Different: Exploration of Norms and Benefits of Color Differentiation in the Marketplace*, 24 Mktg. Letters 165, 171 (2013);

14 Pacific Coast Condensed Milk Co. v. Frye & Co., 85 Wash. 133, 142, 147 P. 865, 869 (1915).

15 Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness (2002), supra* note 13.

16 Beebe & Fromer, *supra* note 12, at 951.

contour, or location of the color to distinguish further from colors that are already in use or registered. This selection and design process requires entrants to invest more resources—whether money or time—than incumbents.

Second, there may be added costs associated with establishing a trademark using "inferior" colors.[17] When the business-preferred color areas are crowded, some entrants have to settle for "inferior" colors.[18] Therefore, entrants need to devote more efforts than incumbents to develop an "inferior" color into a good trademark, which may involve more advertising expenses or longer periods of usage.[19]

Third, entrants may face legal costs associated with potential conflicts with incumbents. These costs might include the risk of trademark registration refusals from the USPTO, the expense of responding to cease-and-desist letters, or even litigation. Theoretically, the higher the costs invested in selecting a color and designing around it (the first type of cost), the lower the cost needed in developing the color into a trademark (the second type of cost). Likewise, higher costs devoted to the first and second types can mitigate the legal costs (the third type of cost).

Despite these costs, the U.S. Supreme Court claimed in *Qualitex* (1995) that color depletion is only "an occasional problem" and dismissed color depletion as an argument for disproportionately instituting a blanket ban against single-color trademarks.[20] Academic scholars are split on whether color depletion is a real concern.[21] Some scholars have argued that color depletion is not a real concern while others argue that color depletion occurs and should not be ignored (Details in Section III).

Which side is correct? Unfortunately, there is a lack of empirical research on this issue. Both judicial practice and academic debates reveal a gap between the theory of color depletion and the lack of empirical evidence to prove or disprove it. The research examined in this article seeks to bridge this gap.

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17 *Id.* at 1021–29; Stephen L. Carter, *The Trouble with Trademark*, 99 Yale L. J. 759, 769-774 (1989).

18 Beebe & Fromer, *supra* note 12.

19 Carter, *supra* note 17.

20 Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 168 (1995).

21 J. Christopher Carraway, *Color as a Trademark under the Lanham Act: Confusion in the Circuits and the Need for Uniformity*, 57-Aut Law & Contemp. Probs. 243 *passim* (1994); Ann Bartow, *The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues*, 97 Ky. L.J. 263, 286–89 (2008); Beebe & Fromer, *supra* note 12, at 977; Christopher C. Larkin, Qualitex *Revisited*, 94 Trademark Rep. 1017, 1017, 1025–29 (2004); Elizabeth A. Overcamp, *The* Qualitex *Monster: The Color Trademark Disaster,* 2 J. Intell. Prop. L. 595, 616-617 (1995); Craig Summerfield, *Color as a Trademark and the Mere Color Rule: The Circuit Split for Color Alone*, 68 Chi.-Kent L. Rev. 973, 994–98 (1993); Lauren Traina, *Seeing Red, Spending Green: The Costly Process of Registering and Defending Color Trademarks*, 87 S. Cal. L. Rev. 1319, 1329-1331 (2013).

This research quantitatively analyzes 854 single-color trademark filings on the registers of the USPTO from 2003 to 2019.[22] This research focuses on two empirical questions: (1) does color concentration exist in trademark registrations, and if so, which color areas are more concentrated? (color concentration) and (2) what is the current status of color depletion, and how rapidly might we deplete the color space? (color depletion).

The study's findings reveal high concentrations in certain color areas. For example, 22% of single-color trademark filings are in the red hue segment (hue 345-15). Moreover, 91% of single-color trademark filings appear in color areas with high brightness (brightness > 0.5), while 61% are found in areas with both high brightness (brightness > 0.5) and high saturation (saturation > 0.5). Trademarks can be registered in connection with goods and services falling within some 45 classes of goods/services in the United States.[23] Looking at color concentration in specific classes reveals concentrations in red (hue 246-15), orange (hue 16-25, 46-55), yellow (hue 56-65), and green (hue 96-155) color areas in Classes 7, 9, 10, 11, and 35. The findings show obvious color concentration in registrations and resulting potentially anticompetitive costs to avoid these concentrations within the current trademark registration system.

The estimation of color depletion presented in this research is explorative, but still offers insights into the status of color depletion and how quickly we might deplete the color space in different classes. Among the 45 classes, four classes (Classes 5, 7, 9, and 10) have depletion percentages above 30%, which means that 30% of the color space has been claimed. Some classes (Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42) are projected to reach 100% depletion by 2050 based on the current division of the color space and the rate of adoption of color marks in those classes. This projected schedule implies the anticompetitive costs might become substantial in the near future.

Based on these findings, this author suggests several strategies to mitigate color concentration and depletion: (1) standardizing and monitoring single-color trademark applications, (2) adopting heavier auditing in those highly-concentrated and rapidly depleted areas, (3) increasing the maintenance/renewal fees in highly concentrated and rapidly depleted areas, and (4) allowing for greater similarity between single-color trademarks in highly concentrated and rapidly depleted areas. Finally, the findings,

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[22] The study excluded single-color trademark filings before 2003 because there were very few trademark filings before that year. It also did not collect single-color trademarks filed after 2019, as the pandemic had affected trademark filing after 2019. The single-color trademark filings after 2019 might not represent normal trends.

[23] U.S. Patent & Trademark Office, *Goods and Services*, USPTO.gov, https://www.uspto.gov/trademarks/basics/goods-and-services (last visited May 17, 2025).

together with other empirical research, challenge a fundamental justification of trademark law: symbols are unlimited and equally good to be trademarks. This article calls for a re-examination and refinement of the justification for allowing exclusive rights in color.

This research is the first quantitative exploration into color concentration and depletion. Its contributions lie in three key aspects. First, it fills the gap between the theory of color depletion and the lack of supporting empirical evidence. The findings provide quantitative insights into color concentration and depletion across product and service classes. These findings are valuable for trademark scholars seeking to advance trademark theories and for regulators aiming to understand the potential costs associated with the trademark registration system. Second, this research is the first to use Python programming to code and analyze color trademark specimens (images) recorded by the USPTO. This methodology may inspire other empirical researchers who need to process and analyze large volumes of image data when researching their legal topics. Third, based on the empirical findings, this research proposes specific policy recommendations to the USPTO and courts to mitigate color concentration and depletion and the effects thereof.

Section II reviews psychological and market research on colors; such research implying that there might be lots of colors available, but that they may not all be equally "good" colors to serve as trademarks. Therefore, color concentration might tend to exist more often in "good" color areas. Section III covers the law of single-color trademarks in the United States. It also discusses U.S. court opinions and academic debate on color depletion. Section IV explains the methodology of this research. Section V presents the results, which suggest that color concentration and depletion should be substantial concerns for trademark stakeholders, at least within certain classes of goods and services and certain hue segments. Section VI puts forth policy recommendations to mitigate the anticompetitive costs brought by color concentration and depletion and reflects on a fundamental assumption of trademark law. Finally, Section VII outlines the limitations of this research and proposes directions for future research.

II. RELEVANT PSYCHOLOGICAL RESEARCH AND COLOR CONCENTRATION

As mentioned in the Introduction, every visible color can be identified by three dimensions: hue, saturation, and brightness. Psychological research implies that not all colors are equally good as trademarks: consumers prefer colors in specific hue segments with certain saturation and brightness.

Although there is no specific uniform standard as to what makes a "good" color as a trademark, brand owners often base their

color trademark choices on consumer reactions to colors.[24] Therefore, consumer preference and attention play a significant role in determining whether a color is considered "good." A good color trademark should easily capture consumer attention and please them.

Psychological studies have shed light on color preferences. The most popular color among consumers is blue;[25] the least favored is yellow-green.[26] People tend to favor colors with high brightness over those with low brightness and prefer colors with high saturation over those with low saturation.[27] Moreover, brightness has a more substantial impact on human pleasure than saturation.[28] These studies show that changing brightness has larger impacts on human pleasure than changing saturation.

When it comes to consumer attention, empirical studies have shown that colors with high saturation and brightness tend to evoke greater attention than colors with low saturation and brightness.[29] However, the effects of specific hues on attention have been inconsistent. One study suggests that cyan attracts more attention,[30] while another research indicates that green-yellow elicits higher attention.[31] Additionally, warm hues such as red, orange, and yellow capture more attention than cold hues such as blue and purple.[32]

One study analyzed 281 logos in use in the U.S. across 15 product categories and 40 subcategories.[33] This study found that the

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[24] *How to Choose Your Brand Colors*, Canva, https://www.canva.com/learn/choose-right-colors-brand/ (last visited May 17, 2025); Mary Kate Miler, *How To Choose A Color For Your Logo: The Ultimate Cheat Sheet* (May 8, 2024), https://foundr.com/articles/building-a-business/best-logo-colors; *Color psychology: The logo color tricks used by top companies—and how to design your own*, Canva, https://www.canva.com/logos/color-psychology-the-logo-color-tricks-used-by-top-companies/ (last visited May 17, 2025).

[25] Valdez & Mehrabian, *supra* note 13, at 398; Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness* (2002), *supra* note 13, at 203.

[26] Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness* (2002), *supra* note 13, at 203.

[27] Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness* (2002), *supra* note 13; Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness: Part 2: Attention* (2004), *supra* note 13; J. P. Guilford, *The Affective Value of Color as a Function of Hue, Tint, and Chroma*, 17 J. Experimental Psych. 342, 369 (1934); Guilford & Smith, *supra* note 13, at 490–91; Gerda Smets, *A Tool for Measuring Relative Effects of Hue, Brightness and Saturation on Color Pleasantness*, 55 Perceptual & Motor Skills 1159, 1163 (1982); Valdez & Mehrabian, *supra* note 13.

[28] Valdez & Mehrabian, *supra* note 13, at 398.

[29] Camgöz, Yener & Güvenç, *Hue, Saturation, and Brightness: Part 2: Attention* (2004), *supra* note 13. *Id.* at 398.

[30] Camgöz, Yener & Güvenç *Hue, Saturation, and Brightness: Part 2: Attention* (2004), *supra* note 13.

[31] Valdez & Mehrabian, *supra* note 13, at 403.

[32] Faber Birren, Color & Human Response (1978); Klaus Warner Schaie & Robert Heiss, Color and Personality (1964).

[33] Labrecque & Milne, *supra* note 13, at 168.

most frequently used hues in logos are blue (48.2%), white (39.3%), red (31.4%), and black (26.1%), with color preferences varying significantly by industry.[34] For example, in alcoholic beverages, red is the most frequently used hue.[35] In fast food, red, yellow, and white are the most preferred hues. In apparel, black is the most frequently used hue.[36] Red is the most popular color for cars.[37] In the field of computers/electronics, blue is preferred.[38] For household products, white is the most used color in logos.[39] In retail, red has the highest usage in logos.[40] Although logo colors are not necessarily single-color trademarks,[41] this research implies that color concentration is most likely to occur around the predominant color in a particular industry or product category.

To sum up, the research implies that colors characterized by high saturation and brightness might be considered "good" colors that brand owners might strive to claim as trademarks. Despite inconsistent findings on what hues are "good," blue and red are repeatedly mentioned as attractive colors in several studies. Accordingly, we would expect that trademark use and registrations would mirror such preferences, potentially resulting in a concentration of trademark usage and registrations in these color areas.

III. SINGLE-COLOR TRADEMARKS AND COLOR DEPLETION

This section will introduce the law of single-color trademarks in the U.S. and how this law might potentially cause color depletion. It will further summarize the judicial opinions and academic debate on color depletion.

A. Single-Color Trademarks and the U.S. Trademark Registration System

Single-color trademarks are one category of trademarks. These trademarks involve the use of a specific color on a good or in connection with a service to indicate its origin or producer. In the case of goods, a single-color trademark pertains to the color applied

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34 *Id.* at 171.

35 *Id.*

36 *Id.*

37 *Id.*

38 *Id.*

39 *Id.*

40 *Id.*

41 Color trademarks might be used on logos but not all colored logos are claimed or registered as color trademarks.

to a part of or the entire surface of the item or its packaging,[42] such as the red color used on the outsole of Louboutin high-heeled shoes.[43] For services, a single-color trademark refers to the color utilized on all or part of the materials used for advertisement or the items associated with the rendering of the services.[44] Examples include the brown uniforms of UPS or the use of magenta in T-Mobile's advertisements.[45] A single color must satisfy the requirements of distinctiveness,[46] no conflicts with earlier marks,[47] and non-functionality to be eligible for registration,[48] just like other categories of trademarks. Further details of these requirements are provided in the footnotes 46, 47, and 48.

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42 TMEP § 1202.05.

43 Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 212 (2d Cir. 2012).

44 TMEP § 1202.05.

45 *See* U.S. Trademark Registration No. 2159865 (UPS brown color trademark applied to clothing); U.S. Trademark Registration No. 5706644 (Deutsche Telekom AG's magenta color trademark).

46 Distinctiveness is a symbol's ability to distinguish a unique supplier's goods or services from those of others. *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992). A symbol, regardless of words, logos, designs, colors or a combination thereof, can be protected as a trademark only when it is distinctive. 15 U.S.C. § 1127, 1052. Distinctiveness can either be inherent in the mark (inherent distinctiveness) or acquired through market usage and promotion (acquired distinctiveness or secondary meaning). *See Two Pesos*, 505 U.S. at 768–69. For example, PEPSI is inherently distinctive because the word is made up and has no connection with any objects except the soft-drink supplier. The egg-blue color is not inherently distinctive as it did not link with Tiffany at the beginning, but through usage and promotion, this color became associated with Tiffany and therefore established the secondary meaning in consumers' minds. So the egg blue color has acquired distinctiveness after extensive use and promotion and is eligible for trademark protection. *See also* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976).

47 To register, a mark must not resemble an earlier registered mark, as the co-existence of two similar/identical marks in connection with similar goods or services would be likely to cause consumer confusion as to the source of the product. 15 U.S.C. § 1052(d).

48 Functionality is a doctrine used in the U.S. to prohibit trademark protection when such protection might hinder competition. If the USPTO determines that a mark is functional, it will deny registration. Functionality includes utilitarian functionality and aesthetic functionality. Utilitarian function means a symbol or product feature is essential to the use or purpose of the product; or affects the cost or quality of the product. *See* TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001). An example of utilitarian function is the shape of a football. The shape has a utilitarian function and cannot be a trademark because footballs rely on the shape to perform their function and trademarking this shape will deprive the rights of competitors to produce a football. Aesthetical functionality refers to a symbol or product feature that is attractive in the aesthetic sense so that trademarking it might impose disadvantages to competitors. *See* Qualitex v. Jacobson Products, 514 U.S. 159 (1995). For example, a spoon with a Baroque-style handle might be considered as aesthetically functional as the design is attractive to many consumers. If one company claims trademark rights on the Baroque design of the spoon handle, other companies cannot use the same/similar design in cutlery market to freely compete. *See* Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., 916 F.2d 76 (2d Cir. 1990).

Both U.S. courts and the USPTO regard single-color marks as lacking inherent distinctiveness.[49] This means that if a brand owner wants to claim trademark rights in a single color, either through registration or litigation, it must provide evidence that the color has acquired distinctiveness. Without evidence proving acquired distinctiveness, a brand owner can still register such a color on the Supplemental Register, which is a Register for trademarks that are not distinctive but that are nevertheless capable of distinguishing goods or services.[50] A registration on the Supplemental Register, while without the advantages of a registration on the Principal Register, such as nationwide trademark protection and prima facie evidence of trademark rights in litigation,[51] may serve as a potential obstacle—or at least notice—to later applicants and their applications.[52] Therefore, this research collected single-color trademark filings on both Registers.

The protective scope of single-color trademarks is limited by how the color is applied to products or services. Applicants must precisely define the context of the color in their color trademark application.[53] And a registered color will not block a later registration of the same or similar color if the later registration claims the color in a different context, namely, a different position, contour, or shape, that distinguishes it sufficiently from the first color.[54] This restricted protection reduces color conflicts and somewhat downgrades color depletion, which will be further explained in Section III.B.2 and Section VII.B.

In addition, single-color trademarks used on one product might not prevent the same color from being used on another unrelated product. Therefore, this research investigates color depletion and concentration within each product category. The USPTO currently adopts the "Nice Classification," which categorizes products and

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49 TEMP 1202.05; *Qualitex*, 514 U.S. at 162–63; Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 211–12, (2000); *In re* Thrifty, Inc., 274 F.3d 1349, 1353 (Fed. Cir. 2001).

50 15 U.S.C. §§ 1091, 1094.

51 15 U.S.C. §§ 1057(b), (c).

52 Application of Clorox Co., 578 F.2d 305, 308 (C.C.P.A. 1978). The USPTO has rejected several later trademark applications for the Principal Register by citing earlier marks on the Supplemental Register. For example, the trademark registration with Serial No. 77029015 in the Supplemental Register prevented registration on the Principal Register of the trademark with Serial No. 77106100. The trademark with Serial No. 77124981 on the Supplemental Register blocked registration on the Principal Register of the trademark with Serial No. 85029983.

53 TMEP § 1202.05(c). This provision indicates that when seeking registration for a single-color trademark, the applicant must provide a detailed description of the color's context—how and where the color is used on a particular product or item related to the service. Abstract claims of color without defining its context are not permitted. This is because a color in abstract without context opens the door for multiple trademarks in one application, which would lead to overbroad protection that is undesired.

54 Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 228 (2d Cir. 2012).

services into 45 classes.[55] Trademark owners must register their trademarks in connection with specific products or services in one or multiple classes.[56] Goods and services within the same class are likely to be more related than those in different classes because "the purpose of the Nice Classification is to group, as much as possible, like goods or services in a single class."[57] Consequently, a single color registered in one class is more likely to block the later applications in the same class. So, this research regards each class as a unit to investigate color concentration and depletion. However, some goods or services within the same class may be unrelated. Section VII.A will further explain this situation.

In the United States, trademark rights arise under common law upon use of a mark in commerce. As a result, common law protects trademarks in the United States that are in use, but that are not registered.[58] U.S. law encourages federal trademark registration by giving additional advantages to registered trademarks over unregistered trademarks, such as by providing nationwide protection and more effective remedies for infringement.[59] This research examines only trademarks registered (and applications for registration) at the USPTO since there is no database recording unregistered color trademarks. Because of this limitation, actual color depletion might be more severe than what is predicted in this research.

B. Judicial Treatment and Academic Debates on Color Depletion

The U.S. Supreme Court held in Qualitex (1995) that color depletion is merely "an occasional problem."[60] This holding stands in contrast to observations by several lower courts that have considered color depletion to be a real concern.[61] Scholars are also

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55 U.S. Patent & Trademark Office, *Nice Agreement current edition version*, USPTO.gov, https://www.uspto.gov/trademarks/trademark-updates-and-announcements/nice-agreement-current-edition-version-general-remarks (last visited May 17, 2025). For instance, Class 9 includes electronic products and other instruments for scientific or research purposes like laptops computers and smartphones, while Class 7 encompasses includes machines, machine tools, motors, and engines.

56 U.S. Patent & Trademark Office, *Trademark scope of protection*, USPTO.gov, https://www.uspto.gov/trademarks/basics/scope-protection (last visited May 17, 2025).

57 TMEP § 1401.11.

58 15 U.S.C. § 1125(a); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 767–68 (1992).

59 15 U.S.C. §§ 1057(b), (c); 15 U.S.C. § 1065; 15 U.S.C. § 1115(b); 15 U.S.C. § 1117.

60 *Qualitex*, 514 U.S. at 168.

61 Diamond Match Co. v. Saginaw Match Co., 142 F. 727, 729–730 (6th Cir. 1906); Pacific Coast Condensed Milk Co. v. Frye & Co., 85 Wash. 133, 142, 147 P. 865, 869 (1915); Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir. 1949), *abrogated by Qualitex Co.*, 514 U.S. at 159 (quoting *Pacific Coast Condensed Milk*, 85 Wash. at 142, 147 P. at 869).

split on whether color depletion is a real concern. The empirical research set out in this article was needed.

1. The Court Opinions on Color Depletion

Early cases evidence that U.S. courts have long been concerned by color depletion. Based on the color depletion theory, some courts rejected the idea of conferring trademark status to a single color. In *Diamond v. Saginaw* (1906), the U.S. Sixth Circuit Court of Appeals reasoned that "[t]he primary colors, even adding black and white, are but few. If two of these colors can be appropriated for one brand of tipped matches, **it will not take long to appropriate the rest**." (emphasis added).[62] In *Pacific Coast Condensed Milk v. Frye & Co.* (1915), which involved a specific color used on milk, the court found that "[t]he primary colors are few, and as the evidence shows those suitable for light products, such as milk, are even more limited. **To allow [the colors] to be appropriated as distinguishing marks would foster monopoly by foreclosing the use by others of any tasty dress**." (emphasis added).[63] In *Campbell Soup v. Armour* (1949), the plaintiff Campbell claimed trademark rights on food container labels that were half red and half white. The court refused this claim and explained that if the plaintiff may "monopolize red in all of its shades **the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out**." (emphasis added).[64] The same color depletion theory was also supported in *First Brands* (1987)[65] and *R.L. Winston* (1993).[66]

The first significant attack on the color depletion theory was *In re Owens-Corning* (1985), in which the Trademark Trial and Appeal Board held that, "in a case where there is no competitive need (whether characterized as 'aesthetic' or otherwise) for colors to remain available to all competitors, the color depletion argument is an unreasonable restriction on the acquisition of trademark rights."[67] The Supreme Court shared the same opinion in *Qualitex*.[68]

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62 *Diamond,* 142 F. at 729 (emphasis added).

63 *Pacific Coast Condensed Milk,* 85 Wash. at 143, 147 P. at 869 (emphasis added).

64 *Campbell Soup*, 175 F.2d at 798 (emphasis added).

65 First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1382–83 (9th Cir. 1987).

66 R.L. Winston Rod Co. v. Sage Mfg. Co., 838 F. Supp. 1396, 1400 (D. Mont. 1993).

67 *In re* Owens-Corning Fiberglas Corp., 221 U.S.P.Q. 1195, 1198 (T.T.A.B. Apr. 13, 1984).

68 Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 168–69 (1995). One possible reason of this change of view on color depletion is that the blanket ban based on color depletion did not match the need of companies to use any type of symbols to promote their brands. Section 45 of the Lanham Act (1946) defined a trademark as "any word, name, symbol, or device or any combination thereof . . .," which reflects this business need. Since the Lanham Act (1946), Federal Circuits have become less concerned on color depletion. The Supreme Court simply affirmed this trend in *Qualitex*.

In that case, the plaintiff claimed trademark rights on a golden-green color used on the surface of press pads for dry cleaning, and asserted that the defendant's use of the same color on a competing product was infringement.[69] The defendant argued color depletion to defend its actions.[70] The defendant argued that in any particular industry, "only some colors are usable."[71] Removing unusable colors and registered colors, "one is left with only a handful of possible colors."[72] The Supreme Court rejected the defendant's color depletion argument, claiming that color depletion was only an occasional problem.[73] Therefore, a generalized application of color depletion was unreasonable because "it relies on **an occasional problem** to justify a blanket prohibition."[74] *Qualitex* effectively declared the death of the color depletion theory: post-*Qualitex* cases rarely support or mention the theory of color depletion.[75]

However, the Supreme Court did not have any evidence indicating that color depletion is merely an occasional problem in reality. Similarly, the early cases that had endorsed color depletion pointed to no evidence to support the proposition that color depletion is severe. Again, the empirical research set out in this article was needed.

2. Academic Debate on Color Depletion

Some scholars believe that color depletion is not a significant worry.[76] J. Christopher Carraway contends that there are thousands or millions of colors available for companies to utilize, making color depletion an unlikely scenario in the near future.[77] Researchers have found that human eyes can distinguish around 150 hues, and when considering different shades of each hue, the number of distinguishable colors becomes even larger.[78] As Christopher Larkin and Lauren Traina point out, a color must gain a secondary meaning through use (i.e., to acquire distinctiveness) to

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69 *Qualitex*, 514 U.S. at 159.

70 *Id.* at 168

71 *Id.*

72 *Id.*

73 *Id.*

74 *Id.* (emphasis added).

75 *See, e.g.*, *In re* Haruna, 249 F.3d 1327 (Fed. Cir. 2001); Minnesota Mining & Mfg. Co. v. Beautone Specialties, Co., 82 F. Supp. 2d 997 (D. Minn. 2000); Moldex-Metric, Inc. v. McKeon Prods., Inc., 891 F.3d 878 (9th Cir. 2018); Poly-Am., LP v. Stego Indus., L.L.C., No. 3:08-CV-2224-G, 2011 WL 3206687 (N.D. Tex. July 27, 2011) *aff'd sub nom.* Poly-Am., L.P. v. Stego Indus., LLC, 482 F. App'x 958 (5th Cir. 2012); Leapers, Inc. v. SMTS, LLC, 879 F.3d 731 (6th Cir. 2018).

76 Carraway, *supra* note 21; Larkin, *supra* note 21; Traina, *supra* note 21.

77 Carraway, *supra* note 21, at 262.

78 *Id.*

be protected as a trademark; thereby setting a high threshold for protecting a single color and downgrading color depletion concerns.[79] Traina's research supports this point, showing that single-color registrations did not significantly increase after the *Qualitex* decision.[80] A USPTO official estimated that between the *Owens-Corning* decision in 1985 and the *Qualitex* decision in 1995, the USPTO issued only 30 single-color trademarks registrations.[81] And, as of 2013, there were only 65 single-color trademark registrations.[82]

Another argument against color depletion is that a single color can be concurrently used by several companies if the context of the color (e.g., the positions, contours, or products) differs enough to avoid consumer confusion.[83] Under this argument, protecting a single color as a trademark is not a real concern because the context is critical. This argument discounts the severity of color depletion. There are limited ways to differentiate the positioning, contours, or contexts in which a color can be used on any given product. And, as more companies share the same color, the options for future applicants become more restricted with each new market entrant. Moreover, color depletion does not mean that no colors remain available for entrants to register or use. Color depletion exists as soon as entrants need to adjust the context of their color use to work around existing color trademarks, demonstrating the anticompetitive costs that may arise.

Other scholars argue that depletion might be more severe than estimated.[84] Craig Summerfield argues that although there are more colors than just a few primary hues, the color spectrum is not unlimited and could lead to depletion in specific industries.[85] Ann Bartow and Elizabeth Overcamp posit that while millions of colors exist across the entire spectrum, the number of "good" (business preferred) colors in a particular industry may be limited, potentially causing depletion in specific color categories within certain

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79 Larkin, *supra* note 21, at 1026–29; Traina, *supra* note 21, at 1325-26.

80 Traina, *supra* note 21, at 1329–331.

81 Larkin, *supra* note 21, at 1025 (citing Sachs, *High Court's Ruling May Color Ad Plans*, Advertising Age, Apr. 10, 1995 (quoting Lynne G. Beresford)).

82 Traina, *supra* note 21, at 1329.

83 This argument is based on the limited scope of protection explained in TMEP § 1202.05(c). As explained previously, this provision requests that when registering a color trademark, the applicant must provide a detailed description of the color's context—how and where the color is used on a particular product or item related to the service. This requirement leads to a restrictive protection scope, meaning that one color registration does not block a later similar or identical color if the color context is different.

84 Summerfield, *supra* note 21, at 996-97; Bartow, *supra* note 21, at 263; Overcamp, *supra* note 21, at 616-17; Beebe & Fromer, *supra* note 12.

85 Summerfield, *supra* note 21, at 996–97.

sectors.[86] Barton Beebe and Jeanne Fromer predict that color or word depletion may grow faster than anticipated because once a color or word is protected as a trademark, it could prevent other companies from claiming not only the identical color or word but also many similar colors or words that may cause consumer confusion.[87]

However, color depletion is not just a theoretical issue; it is also an empirical one. Neither the courts, nor current academic debates have quantitative evidence to support their positions regarding color depletion. The following sections will seek to fill this gap by quantitatively and empirically investigating color depletion and color concentration. The study aims to answer the following questions: (1) Does color concentration exist in trademark registrations, and, if so, which color areas are most concentrated? (2) What is the current state of color depletion, and how quickly might we exhaust the available color space?

IV. METHODOLOGY

The methodology for this study is to collect all single-color trademark filings on the USPTO trademark registers and plot them into a three-dimensional (hue, saturation, and brightness) color space. The plotting shows the color areas that have been taken by single-color applications and registrations, based on which this paper estimates color concentration and depletion.

A. Developing the Color Space

One challenge is developing the color space. The color space is a continuous space (see Figure 3 (a)), which makes it difficult to estimate how much space has been claimed by single-color trademark filings. To conduct the research, the continuous cylinder-shaped space needs to be divided into countable cells (see Figure 3(b)). This study uses HSB (hue, saturation, brightness) dimensions to divide the continuous color space into a discrete color space containing many cells (see Figure 3 (a) and (b)).

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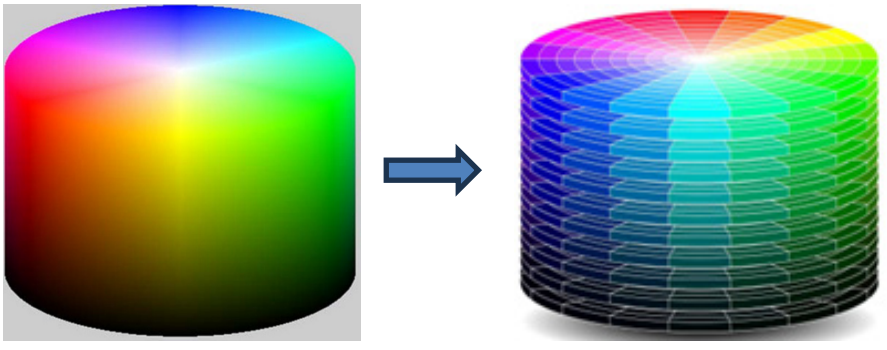
[86] Bartow, *supra* note 21, at 263; Overcamp, *supra* note 21, at 616–17.

[87] Beebe & Fromer, *supra* note 12, at 979.

Figure 3. Transformation of the Color Space[88]



(a) **(b)**

Each color cell should be sufficiently distinctive to average consumers; that is, it should represent a single, distinguishable color from the perspective of a consumer.

This means the size of a single cell should be neither too large to cover two distinguishable colors, nor too small to have one distinguishable color extending across two cells. So far, however, no scientific research exists to tell us the correct cell size based on a consumer perspective. Thus, this research must establish the proper size of each cell. To do so, the color space is first cut along the cue dimension of the cylinder, and then along the saturation and brightness dimensions separately. The steps are as follows:

1. Step 1: Dividing the Hue Dimension

Figure 4(a) illustrates that distinguishable colors are not evenly distributed across the 360-degree hue spectrum. For example, there is little visible difference in green hues from hue 96 to 155, as perceived by the human eye. In contrast, the color change in other hue ranges, such as those between green and blue (hue 155-185), is much more noticeable. Therefore, instead of an even division, the hue spectrum should be divided based on perceptible color changes. Where the change between neighboring color areas is hardly sensed, these color areas are grouped into the same hue segment. Where the change is easily visible, those areas should be separated into different hue segments. Following this principle, the hue dimension is divided into 25 hue segments as shown in Figure 4(b).

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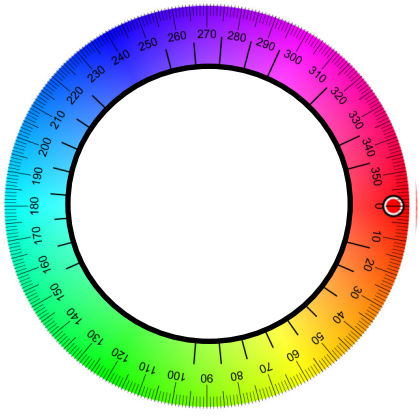
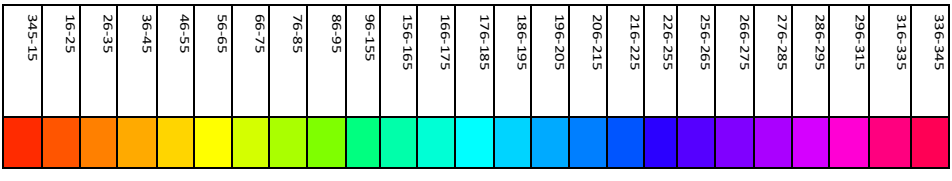
[88] Figure 3(a) is developed based on Fig.1(a) from Tieling Chen, Jun Ma & Zhongmin Deng, *Attributes of Color Represented by a Spherical Model*, 22 J. Elec. Imaging 1, 2 (2013); Figure 3(b) is developed by Ric Mann. *See* Ric Mann, *HSB Color Module (DISCS)*, https://lightcolourvision.org/diagrams/hsb-colour-model-discs-white/ (last visited May 17, 2025).

Figure 4. The Division of the Hue Spectrum[89]



(a)



(b)

An additional assessment indicates that the 25-hue segment division is adequate for the purpose of this research. The details of this additional assessment are in Appendix 1.

2. Step 2: Dividing the Brightness and Saturation Dimensions

Each of the 25 hue segments is further divided into four shades based on brightness and saturation. Figure 5 (a) shows the dimensions of brightness and saturation: The vertical axis represents brightness (0–1), and the horizontal axis represents saturation (0–1).

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[89] In Figure 4(b), most segments cover 10 degrees each (e.g., hue 16-25; hue 26-35; hue 36-45, etc.). However, there are five hue segments that cover more than 10 degrees. The five segments are the red segment (hue 346-15), the green segment (hue 96-155), the dark blue segment (hue 226-255), the magenta segment (hue 296-315) and the plum segment (hue 316-335). The image of Figure 4(b) is made by the author through Microsoft Word. The protractor in Figure 4(a) is made by Clker-Free-Vecotr-Images, Pixabay, https://pixabay.com/vectors/circle-math-education-360-degree-41073/ (last visited May 17, 2025). The color wheel in Figure 4(a) is made by the author through a free online tool. See Development Tools, Color Picker, https://www.developmenttools.com/color-picker/ (last visited May 17, 2025).

Figure 5. Four Shades in the Hue Segment 36-45.

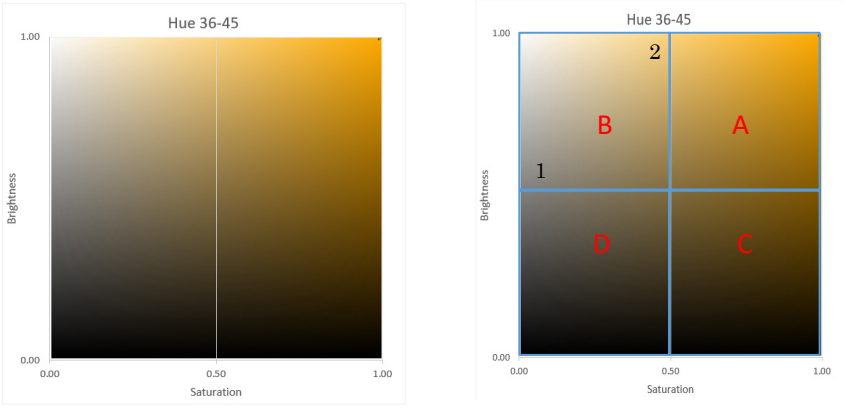


Figure 5(b) displays the divided four shades:

(A) high brightness (0.5–1) with high saturation (0.5–1),

(B) high brightness (0.5–1) with low saturation (0–0.5),

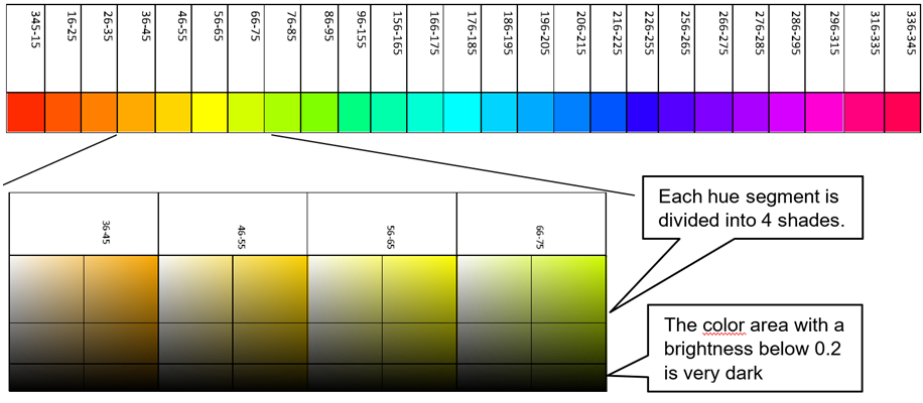
(C) low brightness (0–0.5) with high saturation (0.5–1), and

(D) low brightness (0–0.5) with low saturation (0–0.5).

With close observation, one will notice that spot 1 and spot 2 in Shade B of Figure 5(b) are different. However, further dividing this shade is unnecessary because, in the real market environment, consumers are less likely to have two color trademarks side by side. Instead, they often confront one color, in advertising or stores, and retrieve the other color stored in their brains. In this situation, they are unlikely to discern slight differences in brightness and saturation.

To summarize, for this research, the color space is divided into 25 hue segments, and within each segment, there are four shades (Figure 6). Therefore, the entire color space is divided into 100 cells, making a total of 100 distinguishable colors that companies can use to claim trademarks.

Figure 6. The Summary of the Division



3. The Validity of the Current Division

Although the current division may overlook slight differences within each cell of the 100-cell space, this level of division is reasonable for the current research. First, the distance between the core positions (centroid) of any two cells[90] is even shorter than the distance between color pairs that the USPTO has determined to be similar or the same (Details of this comparison are in Appendix 1). In other words, the current division applies finer color gradations than what the USPTO has applied in practice. Second, the purpose of this research is to estimate the approximate color area that has been taken by single-color trademark filings. Just like predicting the snowing region in weather forecasting, we do not need a high-definition map showing the specific streets and houses. To estimate color concentration and depletion area, we do not need a high-definition map of the color space. A map with reasonably lower definition can achieve the same purpose.

B. Coding and Plotting Single-Color Trademarks into the Color Space

With the 100-cell division of the color space, the next step is to collect all single-color trademark applications and registrations on the USPTO registers, code each such trademark filing, and plot them into the color space. The steps are as follows:

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[90] To put it simply, let us consider each cell as a cube, even though it is not. The distance between two cells can be measured by the distance between their centroids. Each centroid has hue, brightness, and saturation values. We can estimate the distance between two cubes using the hue distance, brightness distance, and saturation distance between their centroids, calculated as: $\sqrt{hue\ distance^2 + saturation\ distance^2 + brightness\ distrance^2}$.

1. Collecting Single-Color Trademark Filings

The USPTO's electronic search system allows users to search records of all filed trademark applications and registrations.[91] The USPTO's Design Search Code Manual ("DSCM") provides codes for extracting different types of marks, such as word marks, logo marks, color trademarks, etc.[92] Using the DSCM codes,[93] this study collected a preliminary set of 3,584 single-color trademark applications filed between January 1, 1991, and December 31, 2019.[94]

After sorting, 1,416 single-color trademark filings remain, spanning from 2003 to 2019,[95] of which 854 are alive (registered or pending applications) and 562 are no longer active.[96] This research focuses on the 854 live trademarks, spanning from 2003 to 2019, as the inactive trademarks do not occupy or deplete the color space. The study also includes the drawings for these 854 trademarks in the coding.

2. Coding and Plotting

A computer program using the Python programming language was developed (Appendix 2) to encode the 854 drawings into three dimensions: hue, saturation, and brightness (HSB code). The process is straightforward, as shown in Figure 7: all 854 drawings

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91 U.S. Patent & Trademark Office, *Trademark Search*, USPTO.gov, https://tmsearch.uspto.gov/search/search-information (last visited May 17, 2025).

92 U.S. Patent & Trademark Office, *Design Search Code Manual*, USPTO.gov, https://tmdesigncodes.uspto.gov/ (last visited May 17, 2025).

93 *Id.* The DSCM code system has three parts: xx.xx.xx. The first two numbers represent the design or images of the marks; for example, 03 represents animals, 05 represents plants, and 29 represents trademarks that consist solely of colors. The second two numbers represent how the single color is used: 02 represents a single color used for the entire goods/service; 03 presents a single color used on a portion of the goods; and 04 refers to a single color used on packaging, labels, or signs. The last two numbers represent the hue: 01 represents red or pink, 03 represents blue, etc.

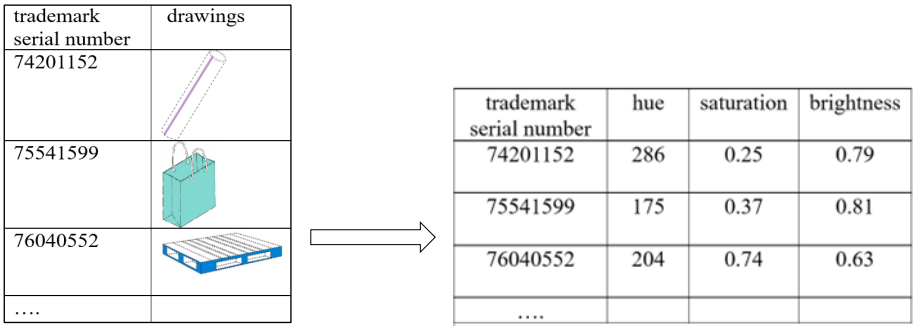
94 Due to coding errors in the USPTO, some trademarks were not considered in the study. These marks include multiple-color trademarks or marks that consist of color(s) but the claimed part is not color related. These marks are not the single-color trademarks relevant to this research. In addition, not all single-color trademarks have color drawings stored in the system. Some early applicants submitted a black and white drawing and described the color as blue, making accurate coding impossible. Also excluded are the gray/silver, white, clear or translucent, and black colors, as they do not fit within the current color space. These colors might be researched separately in the future.

95 After sorting, the registrations before 2003 were removed due to various reasons mentioned above. Consequently, the single-color trademarks analyzed data from 2003 to 2019.

96 The live and dead status of individual trademarks reflects data from April 2020, when the data was collected. Any changes after this date are not considered in this research. However, this does not affect the validity of the study, as post-2020 changes may have been influenced by the pandemic and may not reflect normal trademark application trends.

are input into the Python program, which processes the color in each drawing and generates a unique HSB code for each drawing. This approach ensures that the HSB code of each single-color trademark is accurate, as it is derived from the drawings submitted by the trademark applicants.

Figure 7. The Process of Coding Each Single-Color Trademark[97]



Input Output

With a unique HSB code associated with each single-color trademark, all 854 single-color trademarks are plotted into the 100-cell space. Section V below presents the results.

V. RESULTS

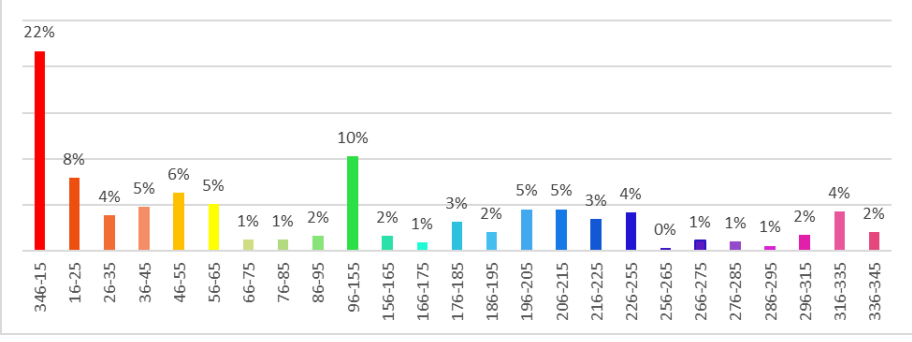
A. Color Concentration

1. Concentration on the 25-Hue Spectrum

Figure 8 displays the distribution of single-color trademarks across the 25-hue spectrum, disregarding saturation and brightness. The percentages in Figure 8 represent the proportions of single-color trademarks registered (or pending for registration) within each hue segment.

[97] The trademark drawings in Figure 7 are downloaded from the USPTO, https://www.uspto.gov/trademarks/search (last visited May 17, 2025).

Figure 8. The Distribution of Single-Color Trademarks Across the 25-Hue Spectrum



This analysis shows that companies tend to prefer the red hue (hue 346-15) for their trademarks (22% of all single-color filings).

This trend is not surprising, as psychological research has shown that red is used in connection with a relatively high proportion (31.4%) of U.S. brands.[98] Moreover, the red hue belongs to warm colors, which are known to attract more attention than cold colors.[99] This attention-capturing advantage could be a reason behind the popularity of adopting red colors.

Interestingly, the green segment (hue 96-155) holds the second highest proportion (10%) of all single-color filings. The popularity of green might be attributed to the recent rise of the green economy, leading more companies to use green to attract environmentally conscious consumers. The previous psychological and marketing research, conducted over a decade ago,[100] might have missed capturing this emerging trend, explaining why the popularity of green went unnoticed in psychological research.

The lower proportion of the blue segments seems to be inconsistent with psychological research, which reveals a public preference for blue.[101] However, this discrepancy can be explained by the fact that blue is a broad color category covering several hue segments (e.g., hues 176-185, 186-195, 196-205, 206-215, 216-225, and 226-255 in Figure 8). When these hue segments are considered together as blue, the overall blue color area accounts for 22%, which is on par with the red segment (22%).

Other segments with lower proportions include the yellow-green segment (hue 66-95), the green-blue segments (hue 156-175), and the purple-magenta-crimson segments (hue 256-315). The

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98 Labrecque & Milne, *supra* note 13, at 170.

99 Birren, *supra* note 32, at 45.

100 Camgöz, Yener & Güvenç, Hue, Saturation, and Brightness: Part 2: Attention (2004), *supra* note 13; Labrecque & Milne, *supra* note 13; Valdez & Mehrabian, *supra* note 13.

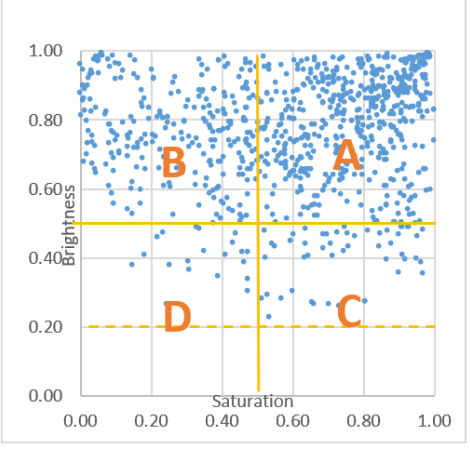
101 *Id.*

unpopularity of the yellow-green segment could be due to its status as the least favored hue according to psychological research.[102] As for the purple-magenta-crimson segments, U.S. culture may perceive these colors as feminine,[103] leading businesses to be careful in using them for branding.

2. Concentration on Brightness and Saturation

When examining brightness and saturation, regardless of hue, 61% of the 854 filings fall in quadrant A (high brightness: 0.5–1 and high saturation: 0.5–1) (Figure 9). Additionally, 30% fall in quadrant B (high brightness: 0.5–1 and low saturation: 0–0.5). Only around 8% fall in quadrants C and D (low brightness 0–0.5). The filings are highly concentrated in high brightness and high saturation (quadrant A). The distribution of single-color trademark filings aligns with psychological research, which indicates that people generally prefer and pay attention to colors with high brightness and high saturation.[104]

Figure 9. The Distribution of Single-Color Trademark Filings on Brightness (X-Axis) and Saturation (Y-Axis)



[102] Valdez & Mehrabian, *supra* note 13, at 203.

[103] Some movie posters might contribute to the association between pink, purple, or magenta and females, such as *Breakfast at Tiffany's* (1958), *Pretty in Pink* (1986), *Pretty Woman* (1990), *Legally Blonde* (2001), *Bend it like Beckham* (2002), *Bride Wars* (2009), *Bridesmaids* (2011), and *How to be Single* (2016). Some perfume brands such as DIANA VREELAND, CHANNEL, VERSACE, SHE, ANTONIO BANDERAS, and NEW YANKEES use pink or purple decoration to display female perfumes, while using blue decoration for male perfumes. *See* Shehreen Ataur Khan, *Pink and Blue: Gendered Consumerism*, 8 Crossings: A Journal of English Studies, 120, 122 (2017); Liz Goodgold, Red Fire Branding: Create a Hot Personal Brand and Have Customers for Life (2009).

[104] Camgöz, Yener & Güvenç, *Hue, Saturation and Brightness: Part 2: Attention* (2004), *supra* note 13. Valdez & Mehrabian, *supra* note 13, at 398.

In addition, Figure 9 suggests that the impact of brightness to the distribution is larger than that of saturation. If saturation were as influential as brightness, we could expect to see similar registration and application numbers between quadrant B (high brightness: 0.5–1 and low saturation: 0–0.5) and quadrant C (low brightness: 0–0.5 and high saturation: 0.5–1). However, the data shows that quadrant B (30% of registrations) has over four times the number of registrations as quadrant C (less than 8%). This indicates that brightness has a significantly greater impact than saturation. This conclusion is also consistent with the psychological finding that brightness is a stronger factor than saturation in color preference (triggering human pleasure).[105]

Interestingly, there are no single-color trademark filings located in the area below brightness 0.2 (Figure 9). Figure 6 shows that the area below brightness 0.2 is too dark to be seen by consumers, resulting in no registrations in this area.

3. Concentration in the 45 Goods/Services Classes

Figure 10 illustrates that the number of single-color trademarks varies across the different international classes of goods and services. 12% (102/854) of these single-color trademark filings fall into Class 9 (electric and technical products), followed by 11% (92/854) in Class 10 (medical products), 10% (83/854) in class 7 (machines), and 6% (53/854) in Class 5 (pharmaceuticals). These four classes attract around 40% of all single-color trademark filings. In contrast, some classes have very few filings, with less than two for each class: Class 22 (canvas & other materials, etc.), Class 23 (yarns & threads), Class 26 (dressmakers' articles, etc.), Class 27 (floor and wall covers), and Class 34 (tobaccos, etc.).

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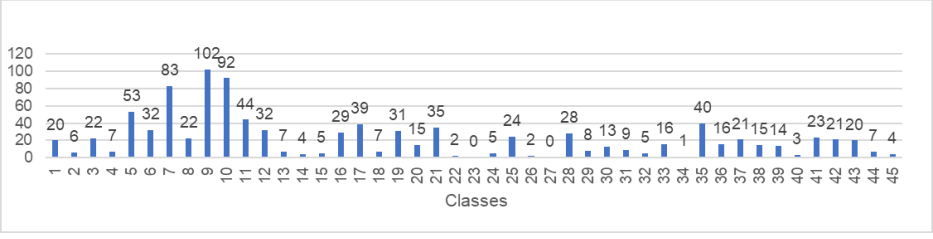
[105] Valdez & Mehrabian, *supra* note 13, at 398.

Figure 10. Distribution of Single-Color Trademark Filings Across the 45 Classes



4. Concentration Within Each Hue Segment in Each Class

This section looks into each class to determine which hue segments are the most concentrated in each class.

Table 1 shows the concentration of single-color trademark filings in hue segments across the 45 classes of goods and services. The first column on the left identifies the class. The top row represents the main hues: red, orange, yellow, green, cyan, blue, purple, magenta, and plum. The second row presents the 25 hue segments underlying the main hues. The numbers in the remaining cells of Table 2 represent the number of single-color trademark filings that have been made in each hue segment in each class. The registrations above 10 are highlighted in black and the registrations between 5 and 10 are highlighted in gray. Remember that each hue segment has only four shades—so even just five single-color trademark filings in the same class of related goods or services might have already made that hue segment crowded. As mentioned in Section III above, however, not all goods or services in a class are related, so depending on the specific distribution of the filings across a class, it could also take more—maybe significantly more—than five filings to cause depletion.

Table 1. The Number of Single-Color Trademark Filings Across the 25 Hue Segments and 45 Classes

	red	orange				yellow		green				cyan			blue						purple	magenta			plum
Class	346-15	16-25	26-35	36-45	46-55	56-65	66-75	76-85	86-95	96-155	156-165	166-175	176-185	186-195	196-205	206-215	216-225	226-255	256-265	266-275	276-285	286-295	296-315	316-335	336-345
1	6	1	0	3	1	1	0	0	1	2	0	0	1	0	0	1	0	1	0	0	0	0	0	1	1
2	0	2	0	0	0	0	0	0	0	0	0	0	0	0	0	3	0	0	0	0	0	0	0	0	1
3	8	2	0	2	0	1	0	1	0	0	0	1	0	0	0	2	1	2	0	0	0	0	0	1	1
4	4	0	0	0	0	0	0	0	0	1	0	0	0	0	0	0	0	1	0	0	0	0	0	1	0
5	7	2	1	2	2	1	0	3	0	2	0	1	5	5	2	3	1	5	0	0	3	2	0	5	1
6	7	5	1	1	3	1	0	0	1	6	0	0	1	0	1	0	0	0	0	1	0	0	0	3	1
7	19	13	1	3	4	3	1	3	0	9	2	0	0	0	5	6	6	3	0	0	1	0	0	2	2
8	4	6	0	1	2	1	0	0	0	2	0	1	0	0	0	3	0	1	1	0	0	0	0	0	0
9	18	4	6	3	11	10	2	1	2	9	4	0	1	2	5	6	3	2	1	2	0	0	0	9	1
10	9	3	7	3	5	4	0	2	0	15	2	1	3	1	6	5	4	4	0	2	2	0	4	3	7
11	15	1	0	6	2	3	0	0	1	5	0	0	1	0	1	2	2	1	1	0	2	0	0	1	0
12	7	3	1	5	2	2	1	0	1	0	1	0	1	0	2	1	2	2	0	0	0	0	1	0	0
13	2	0	0	0	1	0	0	0	0	0	1	0	1	0	1	0	0	1	0	0	0	0	0	0	0
14	1	1	0	0	1	0	0	0	0	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0	0
15	2	2	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	1	0	0	0	0	0	0	0
16	5	3	2	3	3	3	1	0	1	0	2	0	3	0	2	1	0	0	0	1	0	0	0	0	1
17	5	5	0	3	2	2	1	0	2	2	1	1	1	1	1	3	4	2	0	1	0	2	0	0	0
18	2	2	0	0	0	1	0	0	0	1	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0
19	8	0	1	0	2	5	0	0	0	6	0	0	0	0	2	1	2	4	0	0	0	0	0	0	0
20	3	1	1	0	0	1	0	0	1	1	0	0	2	1	0	1	3	1	0	0	0	0	0	0	0
21	8	3	3	0	3	0	1	0	0	7	0	1	2	0	1	1	2	1	0	0	0	0	2	1	1
22	2	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0
23	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0
24	1	0	0	0	1	0	0	0	0	0	0	0	0	0	2	0	1	0	0	0	0	0	0	0	0
25	6	1	2	1	3	0	0	0	1	2	0	1	0	2	0	1	0	0	0	1	0	0	0	1	2
26	0	0	0	0	0	0	0	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0	1	0	0
27	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0
28	6	3	2	3	6	1	1	0	0	1	0	0	0	0	1	0	1	0	0	0	0	0	2	1	0
29	3	0	0	0	0	1	0	0	0	3	0	0	0	0	0	0	1	0	0	0	0	0	0	0	0
30	2	0	0	0	0	0	0	0	0	0	0	0	1	1	1	1	0	3	0	1	0	0	0	3	0
31	1	1	1	0	3	0	1	0	0	0	0	0	1	0	0	0	0	0	0	0	0	0	1	0	0
32	1	0	0	0	0	0	0	0	0	1	0	0	0	0	1	0	0	0	0	0	1	0	0	0	1
33	4	1	0	1	1	0	1	0	0	1	0	1	1	1	1	1	0	0	0	0	0	1	1	0	0
34	0	0	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0
35	12	5	0	0	2	2	1	0	2	7	1	1	1	2	1	1	0	1	0	0	0	0	0	1	0
36	2	1	0	0	1	0	0	0	1	2	1	0	2	1	2	0	0	1	0	0	0	0	0	2	0
37	5	2	1	1	1	0	0	0	1	2	1	0	1	0	1	0	2	0	0	1	0	0	0	2	0
38	5	0	0	0	1	2	1	0	0	1	0	0	0	0	0	1	0	1	0	0	0	0	0	3	0
39	0	5	1	0	0	2	0	0	0	2	2	0	0	0	1	0	0	0	0	0	0	0	0	1	0
40	0	0	0	0	0	0	0	0	1	2	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0
41	8	2	2	0	1	1	0	0	1	2	0	0	0	0	1	0	0	2	0	0	0	0	1	2	0
42	5	1	1	1	2	0	1	0	0	2	2	0	0	1	0	1	0	3	0	0	0	0	0	1	0
43	6	0	1	0	0	2	0	1	0	0	0	0	0	1	4	0	0	0	0	0	0	0	1	4	0
44	1	1	0	0	1	1	1	0	0	0	0	0	0	1	0	0	0	0	0	0	0	0	1	0	0
45	1	1	0	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	1	0

Table 1 shows three levels of concentration:

High concentration: In this level, some hue segments have 10 or more single-color trademark filings. As each hue segment has only four shades, the fact that one hue segment has 10 or more single-color trademarks may make each high concentration segment very crowded. Such high concentrations can be seen in:

Class 7 (machines, etc.)	red (hues 346-15), orange (hues 16-25)
Class 9 (electronic goods, etc.)	red (hues 346-15), orange (hues 46-55), yellow (hues 56-65)
Class 10 (medical instruments, etc.)	green (hues 96-155)
Class 11 (apparatus for lighting, cooking, cooling & sanitizing, etc.)	red (hues 346-15)
Class 35 (general business, etc.)	red (hues 346-15)

Middle concentration: At this level, some hue segments have between five and nine single-color trademark filings. Classes 1, 3, 5, 8–12, 16–17, 19, 21, 25, 28, 35, 37–39, and 41–43 have this middle concentration on red, orange, yellow (hues 56-65), green (hues 96-155), cyan (hues 176-185; 186-195), blue (hues 196-205, 206-215, 216-255), magenta (hues 316-335) and plum (hues 336-345). This paper does not list the segments here individually, but they are shown in Table 1.

Low concentration: These hue segments have fewer than five single-color trademarks at this level, meaning that the concentration is low. Classes 2, 4, 13–15, 18, 20, 22–24, 26–27,29–34, 36, 40, and 44–45 are at this low concentration level. Again, this paper does not list the segments here individually, but they are shown in Table 1.

Overall, the concentration of different hue segments varies across different goods and services and the hue, but a high concentration appears mainly in the red hue segment. These results are consistent with findings in Labrecque and Milne's research. For example, in their research, red is popular on alcoholic beverages, which fall within Class 33, and on retail services, which fall within Class 35.[106] Table 1 also shows that the red segment in Classes 33 and 35 has more filings than other color segments in the same classes. However, there are also some inconsistencies between this research and Labrecque and Milne's research. For instance, Table 1 reveals that the red hue is the most popular hue in Class 9 (electronic goods, etc.), while Labrecque and Milne's research suggests that blue would be preferred in connection with computers and electronic goods.[107] This apparent discrepancy could be explained by the fact that their research focused on the colors of entire logos in the market, rather than on single-color trademark

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106 Labrecque & Milne, *supra* note 13.

107 *Id.*

filings at the USPTO. In addition, Labrecque and Milne's research used a different classification of goods and services than the Nice Classification system used in this research.

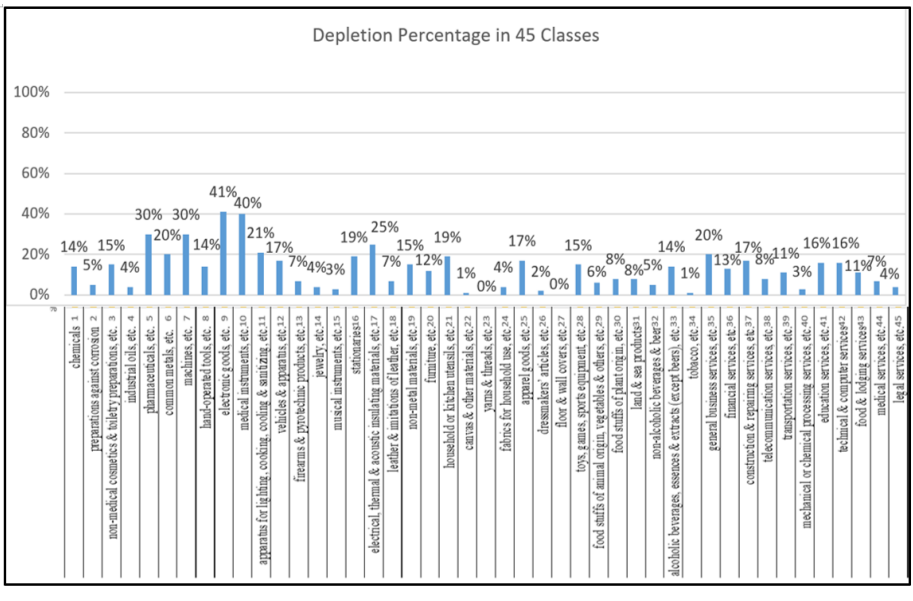
B. Color Depletion

1. Depletion Proportion: How Many of the 100 Cells Have Been Claimed?

This section will analyze the status of color depletion in each good or service class. The basic approach is to plot the single-color trademark filings into the 100-cell space and calculate the percentage of the cells that have been claimed. Appendix 3 explains the details of the method.

Figure 11 indicates the percentages of depletion on the 100-color cell space (x-axis: 45 product or service classes; y-axis: depletion percentages). Each percentage tells the portion of how many cells in the 100-cell space have registrations or pending applications. Four classes of products/services have depletion above 30%: **Class 9 (41%), Class 10 (40%), Class 5 (30%), and Class 7 (30%).** It means that among the 100 color cells, more than one third have been claimed by single-color trademarks in these classes. Although perhaps not severe, the depletions in these four classes could still be substantial, depending on the distribution of the single-color trademark filings in these classes. In the remaining classes, the depletion is lower than 30%, and in many cases in the single digits.

Figure 11. Depletion Percentages Across the 45 Classes



These estimated depletion percentages should be considered explorative rather than conclusive. This is because the depletion percentage is partially influenced by this study's division of the color space into 100 cells. If we were to divide the color space into 1,000 cells, the estimated depletion percentages would likely be lower than those shown in Figure 11. On the other hand, if we were to divide it into 50 cells, the depletion percentages could be higher. However, this estimation is not meaningless. First, as explained in Section IV.A, the division into 100 cells considered consumer's ability in sensing color differences and the USPTO's applied standards in determining color similarity, such that the estimated depletion percentages are reasonable based on the 100-cell division. Second, the estimated depletion percentages provide an indicative view of the depletion situation. These percentages can be seen as conditional estimates. Depending on practical needs, regulators such as the USPTO may adopt predictions that are either more optimistic or more pessimistic than the current estimate. With this in mind, the following section analyzes the estimated depletion speed.

2. Depletion Speed: How Soon Will the 100-Cell Space Be Fully Depleted?

This study used three steps to estimate the rate of depletion: (1) calculating the historic depletion percentage per year based on the data from 2003 to 2019; (2) with the input of historic annual depletion percentages from 2003 to 2019, developing a mathematical function to describe how the depletion percentage changes over the years; and (3) based on this function, calculating or predicting the year when the depletion percentage will reach 100%, namely, the year when all 100 color cells will have been claimed by trademark registrations. For readers who are interested, the methodology details are included in Appendix 4, and the mathematical function and curve figure for each class is listed in Appendix 5.

Figure 12 below hypothesizes how soon the 100-cell space of each class will be depleted. The vertical axis displays the class, and the horizontal axis denotes time. The classes with fully saturated bars show the estimated year when that class will reach 100% depletion. The classes with dotted bars are estimated to reach a plateau below full depletion. For the classes without bars, the dataset contained insufficient information to make a useful projection.

Figure 12. The Prediction of Depletion in 45 Classes

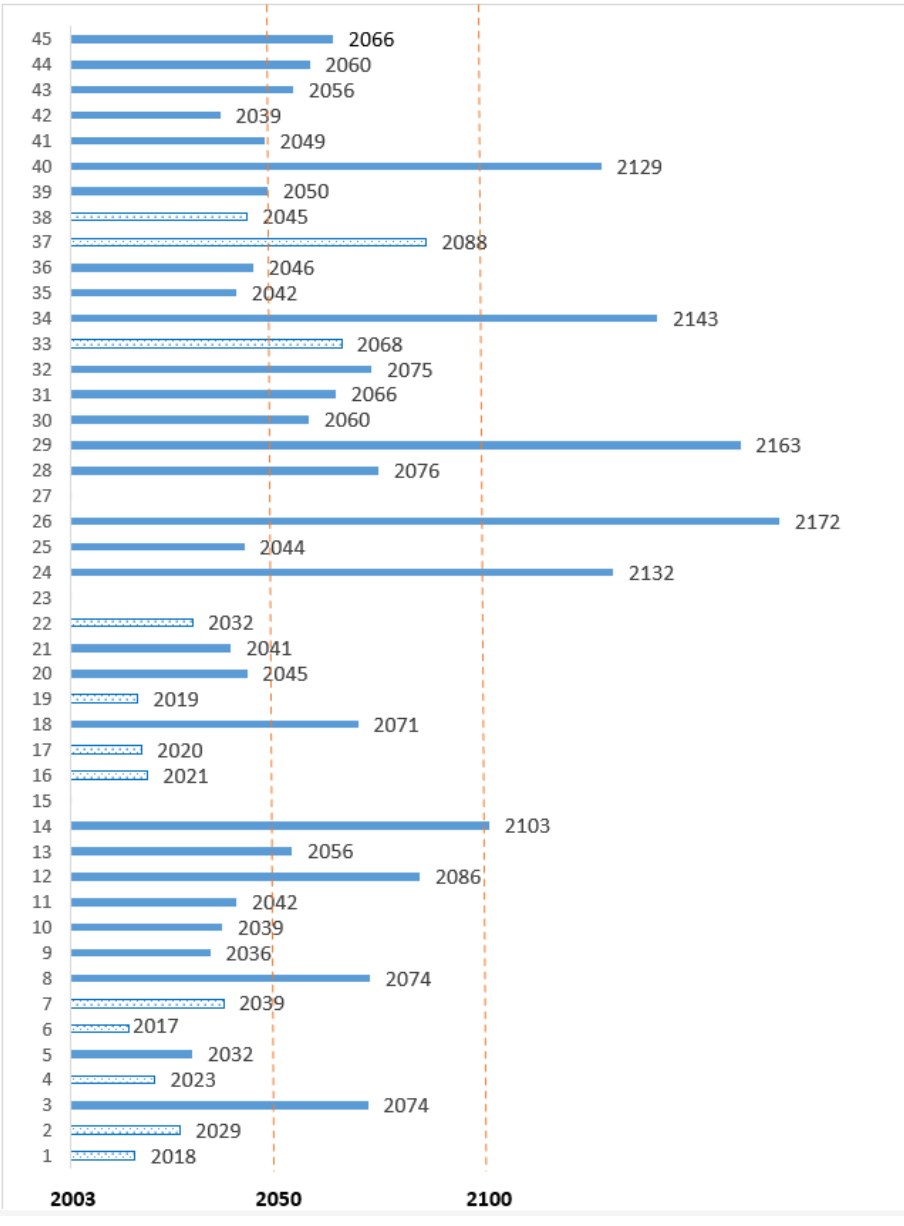


Figure 12 shows that the following classes are estimated to reach full depletion by 2050: Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42 (indicated by the saturated bars in Figure 12). Other classes are estimated to reach full depletion between 2050 and 2100, namely: Classes 3, 8, 12, 18, 28, 30, 31, 32, 43, 44, and 45. The

remaining classes (Classes 14, 24, 26, 29, 34, and 40) might reach full depletion after 2100.

As explained in Section V.B.1, this depletion schedule is explorative rather than conclusive, as the depletion percentage and speed are partially influenced by the division of the color space used in this study. Readers might consider this schedule as an indicative map of the future depletion trend based on the 100-cell space. This map is meaningful to trademark regulators such as the USPTO to evaluate color registration dynamics.

In addition, full depletion would not necessarily mean that companies could not register any individual color. The real concern, as previously explained, would be in the increased costs for new entrants—costs for selecting a color, establishing a trademark based on that color, and handling legal conflicts—from the rising color concentration and depletion. The prediction in this study might overestimate the immediacy of 100% depletion, yet the anticompetitive costs could increase before we reach 100% depletion. What the projected schedule suggests is that those costs in the trademark registration system might become substantial—and occur across multiple industries—in the near future, and we should act before it gets that far.

Readers might notice that in Figure 12, Classes 23 and 27 have no estimated date of full depletion. This is because, as of the end of 2019, there were no single-color trademark filings in the two classes (Figure 11), and it is therefore not possible to predict a schedule for these classes. Figure 12 provides no schedule for Class 15 because the data predicts that depletion of this class will take 3.2537×10^{58} years (see Appendix 5) to reach full depletion. It is not useful to show such a long term in Figure 12, and there is no appreciable concern of color depletion in Class 15 with such a long time frame. Furthermore, the estimated schedule of some classes in Figure 12 are shown in dotted bars (Classes 1,2, 4, 6, 7, 16, 17, 19, 22, 33, 37, and 38). The mathematic analysis indicates that these classes will never reach full depletion, which is further explained in Appendix 6.

Lastly, depletion of each of the 45 classes could progress in one of two ways: In some classes, the depletion may increase slowly at first and accelerate later. In other classes, depletion could increase quickly at first and slow later, possibly never reaching 100% depletion. Classes that correspond to each pattern are shown in Table 2. See Appendix 6 for details of the two patterns.

Table 2. The Two Patterns of the Depletion Trend Across the 45 Classes

Patterns	Classes
1. Depletion increases slowly at first and accelerates later	3, 5, 8, 9, 10, 11, 12, 13, 14, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 34, 35, 36, 39, 40, 41, 42, 43, 44, and 45[108]
2. Depletion increases quickly at first and slows later, never reaching 100% depletion	1, 2, 4, 6, 7, 16, 17, 19, 22, 33, 37, and 38

C. Summary and Implication

1. Findings and Implications of Color Concentration and Depletion

The research implies that colors are not equally good or preferred as trademarks. Across different goods and services, there is a high concentration of single-color trademark filings in the red hue segment and in the area of high saturation and high brightness. Looking into each class, single-color trademark filings are most highly concentrated in red, orange, yellow, and green in Classes 7, 9, 10, 11, and 35. These hue segments in these classes have more than 10 single-color trademark filings. Given that each hue segment has only four shades (cells), the level of concentration in these areas is quite high.

The scope of depletion also varies among the classes. While some classes show substantial depletion (around 40%), overall, the current level of depletion is not severe. Despite having non-severe depletion percentages, some classes might nevertheless deplete quickly. For example, Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42 could reach full depletion by 2050. In other words, by 2050, new entrants who wish to use or register a single-color trademark in these classes would encounter more difficulties and higher costs, compared to incumbents.

As repeatedly mentioned, these findings of color depletion are speculative rather than conclusive. However, the findings of color concentration are robust because the concentration remains unchanged regardless of how many cells into which the color space

[108] Classes 23 and 27 have zero single-color trademarks and therefore do not belong to either of the two patterns. Class 15 also does not belong to the two main patterns, and therefore, is not shown in this table.

is divided. Color concentration already implies some costs to entrants, such as settling for "inferior" colors, spending more to develop them into trademarks, and undertaking more legal risks. Considering the impact of the robust color concentration findings, along with a conservative approach to the prediction of color depletion, the implied anticompetitive costs in the trademark registration system cannot be ignored. These costs may be even higher in reality, given that studies show that around 40%–50% of trademark registrations in the U.S. are registered in connection with at least some goods or services that are not actually in use.[109] These findings call for actions to address color concentration and depletion and reduce anticompetitive costs.

2. Different Severity Levels of Color Concentration and Depletion

Before proposing specific solutions, distinguishing between the severity levels of color concentration and depletion is crucial for legislators, regulators, and courts to adopt tailored strategies to address color concentration and depletion. As shown in Table 3, the highly concentrated hue segments in those rapidly depleting classes (reaching full depletion by 2050) should be given top priority and addressed first (the black cell in Table 3), namely: red (hues 346-15), orange (hues 46-55), yellow (hues 56-65) in Class 9, green (hues 96-155) in Class 10, red (hues 346-15) in Class 11, and red (hues 346-15) in Class 35.

The second priority is found in the gray cells in Table 3, which represent highly concentrated hue segments in less-depleted classes (reaching full depletion after 2050) and those less-concentrated hue segments in rapidly depleted classes (reaching full depletion by 2050), namely: red (hues 346-15) and orange (hues 16-25) in Class 7 as well as Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42.

The remaining hue segments and classes are of low concern at present (the white cell in Table 3).

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[109] U.S. Patent & Trademark Office, *Post Registration Audit Program Statistics*, USPTO.gov, https://www.uspto.gov/trademarks/maintain/post-registration-audit-program-statistics (last visited May 17, 2025).

Table 3. The Severity Level of Color Concentration and Depletion

	Highly concentrated hue segments	Less-concentrated hue segments
Rapidly depleted classes (reaching full depletion by 2050)	Class 9: red (hues 346-15), orange (hue 46-55), yellow (hues 56-65) Class 10: green (hues 96-155) Class 11: red (hues 346-15) Class 35: red (hues 346-15)	All hue segments in Classes 5, 9, 10, 11, 20, 21, 25, 35, 36, 39, 41, and 42, except the hue segments listed in the black cell
Less-depleted classes (reaching full depletion after 2050)	Class 7: red (hues 346-15), orange (hues 16-25)	All remaining hue segments in the remaining classes

VI. DISCUSSION AND SOLUTIONS

A. Standardization and Monitoring

It is crucial to regularly capture the status of single-color registrations so that the USPTO can respond timely and strategically. For this reason, the author recommends that the USPTO standardize and monitor color trademark applications as described below.

1. Standardization of Color Identifications

Currently, trademark applicants are not required to provide a specific color code to identify their color, such as an HSB code, but simply to "name[e] the color(s)" being registered.[110] Although applicants must submit a drawing and a description of their color,[111] vagueness often persists. Some descriptions are imprecise and broad, such as "dark blue"[112] or "blue,"[113] and color deviations can occur when drawings are viewed on different computer screens. This vagueness may cause uncertainty and inconsistency in protection

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110 TMEP § 1202.05(e).

111 *Id.*

112 *See* U.S. Trademark Application Serial No. 98405168.

113 *See* U.S. Trademark Registration Nos. 4119742 and 3748644, 5952059; U.S. Trademark Application Serial No. 98308887.

scope. Therefore, requiring the applicant to submit a color code (HSB codes or other code systems) is essential for eliminating ambiguity and standardizing color trademark applications. Color codes would help examiners quickly identify similar earlier color trademark filings. They would also enhance objectivity in deciding whether colors are similar, because with an HSB code, examiners could easily locate the claimed color in a color space and use the color distance with earlier marks as a factor to assess color similarity. Most importantly, color codes would enable the USPTO to monitor color registrations and timely react to areas of severe color concentration and depletion.

This standardization would not impose substantial costs on either applicants or the USPTO. Applicant could get the color codes from their trademark designers. If not, applicants could easily obtain the color code using free online color identification tools.[114] And even if a trademark applicant is not able to get the color code before filing, the USPTO could develop a color identification software application to include in its application system so that when an applicant uploaded the drawing of their color trademark, the application would automatically generate the color code. The app could be developed based on the Python code provided in Appendix 2.

2. Monitoring

With the standardization of color identifications, the USPTO could monitor color trademark filings to capture the dynamics of color depletion and intervene in a timely manner.

The monitoring might include three steps: (1) color coding, (2) color plotting, and (3) analysis and prediction. The USPTO could decide the frequency of the monitoring based on its capacity.

First, the USPTO should obtain the HSB code for each single-color registration. This step would already be realized if the USPTO were to require standardized color identifications for new trademark applications claiming color, as discussed above. If not, this step is not substantially difficult because the USPTO can use a simple software program to code each single-color trademark filing, just as what this study has done (Appendix 2).

Second, with the HSB codes, the USPTO could use the same method as was used in this research (Appendix 3) to plot the single-color trademark filings to the existing color map—i.e., the 100-cell color space. The USPTO may also adjust the number of cells in the

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[114] Examples of these free online color identification tools include: Pixelied, https://pixelied.com/colors/image-color-picker (last visited May 17, 2025); Color Picker, https://colorpicker.tools/ (last visited May 17, 2025); RedKetchup, https://redketchup.io/color-picker (last visited May 17, 2025).

color space, using more or fewer than the 100 cells used in this research, based on practical requirements.

Third, using the plotting, the USPTO could estimate color concentration and depletion percentages in each class, just as has been done in this study (methods in Appendix 3 and Appendix 4). These estimations could provide the USPTO with trends of concentration and depletion over time.

If single-color trademark applications are standardized, monitoring would not impose significant additional costs. Also, the frequency of monitoring could be as low as biannually, which would reduce the costs of such a program.

Based on the information obtained from monitoring single-color trademark filings, the USPTO could adopt appropriate strategies to alleviate issues arising from color depletion or concentration, including those discussed in the following sections.

B. Weighted Post-Registration Audit to Remove Non-Used Trademarks

Since 2017, the USPTO has conducted a Post Registration Audit Program (the "Audit") in order to remove non-used trademarks from its registers so that the trademark registers can function as "a reliable reflection of trademarks in use in commerce."[115] Under the Audit, the USPTO chooses certain trademark registrations for review and requires the owners of those registrations to submit evidence of use in commerce for selected goods/services.[116] If the trademark owners fail to submit such evidence, the audit can expand to all goods/services in their registrations, which at minimum will be narrowed to the goods/services on which the mark is actually used.[117] This program releases more space for entrants, reducing trademark concentration and depletion.[118]

However, it appears that the current Audit strategy employs random sampling, without weighting by good/service class or type of mark, and thus without a specific focus on the highly concentrated and depleted color areas.[119] This simple random sampling strategy

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115 U.S. Patent & Trademark Office, *Post Registration Audit Program*, USPTO.gov https://www.uspto.gov/trademarks/maintain/post-registration-audit-program (last visited May 17, 2025).

116 *Id.*

117 *Id.*

118 The USPTO published the audit results from 2019 to 2023. If the Audit works well in clearing unused marks, we expect that the cancellation rates resulting from the Audit will go down over time. Indeed, data published by the USPTO indicates that cancellation rates have declined from around 50%–60% in 2020 to 40%–50% in 2023. *See Post Registration Audit Program*, *supra* note 115.

119 U.S. Patent & Trademark Office, Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases, 81 Fed. Reg. 40589,

is less efficient in addressing color concentration and depletion. Therefore, this author suggests weighted sampling—varying the weight of samplings according to depletion levels. Based on the findings of this research, the USPTO might sample most heavily in the concentrated hue segments in rapidly depleting classes (the black cell in Table 3), and perform a mid-size sampling in the highly concentrated hue segments in less depleted classes and those non-concentrated hue segments in quickly depleting classes (the gray cells in Table 3). For the area in the white cell of Table 3, the USPTO might not sample or use the lightest sampling. The weighted sampling might be adjusted based on the findings captured in the proposed regular monitoring.

Beebe and Fromer have suggested weighted sampling to target areas with severe word mark depletion.[120] However, when the USPTO launched its pilot audit program, some commentators expressed concern that the program "is not capable of being applied equally to all 'applicants.'"[121] Responding to these concerns, the USPTO promised that its audits would not "have a disproportionate impact upon any particular class of registrant" through randomly selecting the registrations.[122] The USPTO has softened its stance more recently, though, announcing a new program of "directed audits" aimed at registrations maintained with fabricated specimens, such as "digitally altered" images or specimens from a "specimen farm."[123]

The time has come, therefore, for the USPTO to consider using weighted sampling audits. The evidence of color concentration provided in this article and the word-mark congestion in the research of Beebe and Fromer[124] give objective justification for the USPTO to conduct weighted sampling audits. The purpose of such weighted sampling is not to discriminate against a particular group of trademark registrations, but to reduce the number of registrations on the register for marks that are not in use in highly concentrated areas and to open up more space for entrants.

40590, govinfo.gov (June 22, 2016), https://www.govinfo.gov/content/pkg/FR-2016-06-22/html/2016-14791.htm (last visited May 17, 2025).

120 Beebe & Fromer, *supra* note 12, at 1035.

121 U.S. Patent & Trademark Office, Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases, 82 Fed. Reg. 6259, 6261, govinfo.gov (Jan. 19, 2017). https://www.govinfo.gov/content/pkg/FR-2017-01-19/pdf/2017-00317.pdf (last visited May 17, 2025).

122 *Id.*

123 Changes in Post-Registration Audit Selection for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases, 89 Fed. Reg. 85435, 85436 (Oct. 28, 2024).

124 Beebe & Fromer, *supra* note 12.

C. Increasing the Maintenance and Renewal Fees of Trademark Registration

In addition to weighted sampling audits, another way to reduce concentration and depletion is by increasing trademark maintenance and renewal fees in highly concentrated and rapidly depleting areas. This strategy might discourage trademark owners from maintaining non-used trademarks in these areas.

After five years from registration, and then at each 10-year anniversary of registration, the USPTO requires trademark registrants to prove that their mark remains in use and to pay maintenance fees to maintain their registration.[125]

The author recommends raising these maintenance and renewal fees in areas that are concentrated and being quickly depleted.[126] Based on this research, the USPTO could consider three tiers of fees: the highest fees for areas with top priority (the black cell in Table 3), a middle tier for areas with second priority (the gray cells in Table 3), and the lowest fees for areas in the white cell in Table 3, where there is no concern about color concentration or depletion. The amounts of the maintenance and renewal fees could be based on and varied according to the regular monitoring discussed above.

Although increasing maintenance and renewal fees would increase the cost to companies to maintain validly used marks, it would also encourage efficient allocation of limited color resources to companies who will make the most use of them.[127] This finance incentive will force companies to examine whether they indeed need to keep a single-color registration. If the commercial values generated by a color brand is less than the maintenance/renewal fees, a company might decide to abandon its single-color trademark registration. The previously occupied color space could therefore effectively be released to the public, and a new player could re-use the color.

This adjustment is not expected to fully resolve the problems of color concentration and depletion, as the underlying driver is businesses's need to use industry-preferred colors to promote their goods and services. Instead, the adjustment aims to eliminate unused color trademarks that companies are holding, freeing up color space for businesses with genuine needs. Therefore, it is crucial to increase maintenance and renewal fees to a level that

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125 USPTO, *Trademark Fee Information*, USPTO.gov, https://www.uspto.gov/trademarks/trademark-fee-information (last visited May 17, 2025).

126 Beebe and Fromer have also suggested increasing the maintenance and renewal fees to reduce word mark depletion. They further suggested increasing the fee for those areas that have severe depletion while reducing the fees for areas without depletion. Beebe and Fromer, *supra* note 12, at 1030–31.

127 *Cf. id.* at 1031.

discourages the continued registration of unused trademarks while remaining reasonable for businesses that actively use their trademarks.

Implementing a variable fee policy might increase the USPTO's administrative costs to some extent, but considering the USPTO's current fee practices, a variable fee to address depletion and concentration would not be wholly impractical. Every other year, the USPTO reviews and updates various trademark fees, including maintenance and renewal fees.[128] In the past, the USPTO had varied its trademark fees to discourage or encourage certain behaviors. For example, to discourage paper filing, it increased the renewal fee from $400 to $500[129] for paper filing, while reducing the renewal fee from $400 to $300 if the applicant filed the renewal online.[130] Further, to cover increased examination costs, the USPTO has increased maintenance fees three times, from $100 to $125[131] in 2017, to $225[132] in 2021, and to $325 in 2025.[133] As such, it is practical for the USPTO to adjust renewal and maintenance fees to achieve policy purposes such as reducing color or trademark depletion.

One might suggest also increasing the initial application fee that the applicant needs to pay when applying for registration. The author disagrees with this suggestion for several reasons. First, increasing the application fee targets only new entrants, which will increase barriers to entry.[134] Second, using maintenance/renewal fees as a policy tool will be more effective than using application fees. The maintenance/renewal fees are first paid five years after registration. Initially, a company does not know whether their color brand will become valuable and worth the application fee when they register it. But they will know the value of their brand five years

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128 U.S. Patent & Trademark Office, *Summary of FY 2021 Final Trademark Fee Rule*, USPTO.gov, https://www.uspto.gov/trademarks/laws/updated-trademark-ttab-fees-processes (last visited May 17, 2025); U.S. Patent & Trademark Office, *Summary of 2025 trademark fee changes,* USPTO.gov, https://www.uspto.gov/trademarks/fees-payment-information/summary-2025-trademark-fee-changes (last visited May 17, 2025).

129 U.S. Patent & Trademark Office, Trademark Fee Adjustment, 81 Fed. Reg. 72694 (Oct. 21, 2016), https://www.federalregister.gov/documents/2016/10/21/2016-25506/trademark-fee-adjustment (last visited May 17, 2025).

130 U.S. Patent & Trademark Office, Reduction of Fees for Trademark Applications and Renewals, 79 Fed. Reg. 74633 (Dec. 16, 2014), https://www.federalregister.gov/documents/2014/12/16/2014-29413/reduction-of-fees-for-trademark-applications-and-renewals (last visited May 17, 2025).

131 *Trademark Fee Adjustment*, *supra* note 129.

132 U.S. Patent & Trademark Office, *Summary of FY 2021 Final Trademark Fee Rule*, USPTO.gov, https://www.uspto.gov/trademarks/laws/updated-trademark-ttab-fees-processes (last visited May 17, 2025).

133 *Summary of 2025 Trademark Fee Changes*, *supra* note 128.

134 Beebe & Fromer, *supra* note 12, at 1030.

later. Therefore, adjusting the maintenance/renewal fees is more effective than adjusting the registration fee as a policy lever.

D. Greater Tolerance for the Co-Existence of Similar/Identical Colors

To reduce color concentration and depletion, the author also suggests that the tests and standards applied in evaluating potentially conflicting color marks should be changed to allow more similar colors to co-exist together. This suggestion is directed not only to the USPTO but also to the courts and legislatures. A higher tolerance for co-existence of similar colors will practically enlarge the available color space in the concentrated areas and reduce entry barriers for new entrants.

1. Reducing the Color Distance for Co-Existence

Currently, the USPTO has a low tolerance for similar colors on the register, giving a broad scope of protection to single-color registrations. Table 4 illustrates some colors that the USPTO regards as being confusingly similar and which therefore cannot co-exist as registrations.[135] One can see that the colors in Pairs 2, 3, 6, 7, and 8 appear very different and therefore should be unlikely to confuse consumers even in a real market setting. But these paired colors have been found to be confusingly similar by the USPTO, and an application to register the latter color has been rejected.[136] Not allowing these distinguishable colors to co-exist causes each color trademark to occupy too much room, limiting the availability of distinct color options. To efficiently use the color space and reduce color concentration/depletion, the USPTO might raise the tolerance of similar colors, to allow more similar single-color trademark registrations to co-exist on the registry.

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[135] These color pairs are obtained from USPTO office actions in which a USPTO Examining Attorney rejected a later application to register a mark based on the ground that the later mark is considered confusingly similar to the mark an earlier filing. Those rejected applications are U.S. Trademark Application Serial Nos. 88288570, 8684147, 85149118, 78937340, 85684740, 86593915, 87009034, and 77279314.

[136] *See* U.S. Trademark Application Serial Nos. 8684147, 85149118, 86593915, 87009034, and 77279314.

Table 4. Examples of USPTO Judgment on Similar Marks

	USPTO judgement on similar marks	
	Earlier marks	Later marks
Pair 1		
Distance	H 170, B 0.44, S 0.55	H 145, B 0.63, S 0.98
Pair 2		
Distance	H 56, B 1, S 0. 80	H 53, B 0.76, S 0.63
Pair 3		
Distance	H 358, B 0.99, S 0.98	H 326, B 0.91, S 0.42
Pair 4		
Distance	H 222, B0.67, S0.58	H 236, B 0.46, S0.86
Pair 5		
Distance	H174, B 0.85, S 0.40	H 188, B 0.88, S 1.00
Pair 6		
Distance	H 198, B 0.92, S0.74	H185, B 0.36, S0.81
Pair 7		
Distance	H 105, B 0.55, S 0.54	H 120, B 1.00, S 1.00
Pair 8		
Distance	H215, B 0.80, S0.41	H 199, B 0.76, S1.00

Of course, shrinking the allowable distance between two single-color trademarks might increase the likelihood of consumer confusion and therefore the search cost—the time and resources consumers might spend on identifying a specific brand. However, there are several reasons justifying shrinking this color distance. First, trademark law is not about eliminating all consumer confusion. A healthy trademark system should strike a balance between lowering consumer confusion and avoiding anti-competitive effects. In the context of color concentration and depletion, we might tolerate a low level of confusion for an efficient usage of color space, rather than shutting the door to entrants in order to achieve zero confusion. Second, consumers can tolerate certain amounts of confusion and share the cost. Consumers' capacity to distinguish between brands can be shaped by commercial practice. Realizing that color brands have become

closer, consumers will naturally increase their attention to avoid confusion in some cases. And this might take them only extra seconds to look at the word mark or logo and recognize a distinction between otherwise similar single-color trademarks, which is not a substantial time investment to individual consumers. Therefore, consumers are less expensive confusion avoiders, compared with the costs that entrants might pay to avoid confusion, including re-designing the color contexts or settling for other "inferior" colors, etc.

This does not mean that an unlimited tolerance for consumer confusion should exist. Those colors that are very similar or identical and lead to unacceptably high levels of confusion should not co-exist. Future empirical research might explore what color distance and what level of consumer confusion are reasonable.

2. Different Legal Standards for Color Conflicts

In addition to allowing coexistence with reduced color distance, the USPTO, legislatures, and courts might also apply different legal standards in trademark infringement and other conflicts between different claimants to single-color trademarks.

a. Dilution on Dissimilar or Unrelated Goods/Services

U.S. dilution law extends the protection scope that an earlier famous trademark enjoys beyond just related or similar goods/services. Thus, dilution law might worsen color depletion because, an earlier, famous single-color trademark filing might block a later-filed single-color trademark application on dissimilar goods or services. Despite the broad scope of protection afforded by dilution law, the plaintiff's burden of proof in a dilution case—once the plaintiff establishes that the mark is famous—is relatively light: the Trademark Dilution Revision Act of 2006 ("TDRA") requires only that the plaintiff prove a likelihood of dilution instead of actual dilution.[137] This lower threshold for proving dilution could result in over-blocking others' trademarks. In practice, large brand owners can exploit dilution laws to intimidate small businesses in unrelated industries.[138] Large companies do not necessarily need to file

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137 15 U.S.C. § 1125(c)(2)(B).

138 Take T-Mobile as an example. T-Mobile threatened to sue small companies in non-related sectors including OXY (a watch maker), Engadget (a news blog), DataJar (a British software company), Compello (an invoice service provider), Slam FM (a Netherland radio station), etc. *See* Timothy Geigner, *Telekom Gets Smartwatch Maker To Change All Its Logos Because Magenta*, Techdirt (Dec. 18, 2015, 6:26 PM), https://www.techdirt.com/2015/12/18/telekom-gets-smart-watch-maker-to-change-all-logos-because-magenta/; Digital Media Law Project, *T-Mobile v. Engadget*, Berkman Center for Internet and Society (April 3, 2008, 12:21 PM), https://www.dmlp.org/threats/t-mobile-v-engadget#node-legal-threat-full-group-description; *T-Mobile Owner Battles DataJAR over Magenta Logo*, BBC (May 14, 2018), https://www.bbc.co.uk/

lawsuits, either; a cease-and-desist letter alone can scare off many small businesses and allow incumbents to claim a large color area expanding across non-related industries that they might never engage with.[139]

This author suggests that the appropriate standard for single-color marks should require a plaintiff to prove actual dilution rather than a likelihood of dilution. Actual dilution should be proven by substantial evidence of the damage to the distinctiveness or good reputation of the plaintiff's mark. For example, the plaintiff could demonstrate dilution by tarnishment by providing survey evidence or witness testimony to prove that, after exposure to a defendant's color mark, some consumers start to perceive goods or services identified by the plaintiff's color trademark as having reduced quality or negative connotations. The evidence should be examined on its validity and objectiveness, dilution arguments should not succeed if the plaintiff does not provide such evidence of actual dilution.

b. Consumer Confusion on Similar or Related Goods/Services

In non-dilution cases where two parties' goods or services are similar or related, additional consideration or weight should be given to the context of the two parties' color usages. If the contexts of the two parties' colors are different enough to avoid consumer confusion, the court should allow the defendant's usage of the color. For example, in *Louboutin*, the plaintiff's red color was used on the outsole contrasting with the upper part of the shoes, while the defendant's red color was used on the entire shoe.[140] The different context and contour of the color was sufficient to distinguish the sources and prevent consumer confusion. In this situation, the court refused to enjoin the defendant's usage of the same color.[141] This ruling is reasonable because it protects the plaintiff's trademark right and allows the defendant to compete by using the same color in a different manner. The decision enabled efficient usage of the concentrated red hue segment by allowing the co-existence of the same color in different contexts.

Lastly, even if the two parties' goods or services are similar and the context of the color use is not by itself sufficient to avoid a likelihood of consumer confusion, additional factors should be

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news/uk-england-sussex-44107621; *T-Mobile Claims Exclusive Rights to Color Magenta*, nu.nl (Nov. 1, 2007 4:27 PM), https://www.nu.nl/economie/1297382/t-mobile-claimt-alleenrecht-op-kleur-magenta.html.

139 Emma Perot, Commercialising Celebrity Persona: Intellectual Property Law and Practice 129, 144–45 (1st ed. 2017).

140 Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 225 (2d Cir. 2012).

141 *Id.* at 228–29.

considered before prohibiting use of the defendant's color mark. In particular, the court should consider both the consequence of consumer confusion and the existing color concentration and depletion level in the disputed sector. The existing color concentration and depletion level can be captured through the USPTO's adoption of regular monitoring, as suggested in Section VI.A. If the color concentration and depletion level is already high in the disputed sector, the court might consider allowing the parties to coexist since few if any color alternatives remain free and available for use. For example, in *T-Mobile v. Aio*, the co-existence of the parties' colors might initially lead to a few consumer confusions due to the similar services and color context.[142] In this situation, however, the court should further examine whether color concentration and depletion is substantial in connection with telecommunication services given that "all 'primary and secondary colors (red, yellow, blue, green, orange) except violet are owned in the prepaid/wireless space.'"[143] If yes, the court might consider allowing the defendant's usage of the plum color, provided that consumer confusion remains at a low level in an industry with concentrated and depleted color spaces. As explained previously, consumers' capacity to distinguish between brands can increase when realizing that color brands have become closer: they will raise their attention to avoid confusion, which only takes extra seconds. And therefore, such co-existence does not necessarily lead to significant consumer confusion.

E. Reflection on the Fundamental Justification of Trademark Law

In addition to proposing strategies to reduce color concentration and depletion, the research also offers new insights to reflect on the fundamental justification of trademark law. According to mainstream law and economics theory, trademark rights granted on any symbol entail both cost and benefit.[144] The benefit is generated because a trademark helps consumers to identify the desired products quickly and therefore reduces consumer search cost.[145] And the cost stems from the loss of a symbol, which is valuable in economizing product information, from the public domain.[146]

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142 T-Mobile US, Inc. v. Aio Wireless LLC, 991 F. Supp. 2d 888, 926 (S.D. Tex. 2014).

143 *T-Mobile*, 991 F. Supp. 2d at 901.

144 William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, in The Economic Structure of Intellectual Property Law 166, 166-174 (2003); Carter, *supra* note 17; Nicholas S. Economides, *The Economics of Trademarks*, 78 Trademark Rep. 523, 526, 537 (1988).

145 Carter, *supra* note 17, at 762; Landes & Posner, *supra* note 144; Economides, *supra* note 144, at 526.

146 Carter, *supra* note 17, at 770-75.

It is believed that in most cases, the benefit (the reduction of search cost) is greater than the cost (the loss of a symbol) and trademark right granted on a symbol is justified.[147] This is because no matter the actual reduction of search cost, the cost is deemed as zero in most cases.[148] The absence of cost is based on the assumption that there are infinite and equally good symbols in the public domain.[149] If this assumption was true, it would mean the substitutability of symbols would be high, and the loss of any one symbol would not cost the public domain very much.[150] In other words, if all symbols are more or less equally good, an entrant will spend no more costs than an incumbent in developing a trademark by choosing another equally good symbol. Therefore, the cost of removing a symbol from public domain is considered as zero.[151]

Consequently, trademark law is justified by this inequality: the reduction of search cost > the cost of losing a symbol.[152] Courts also note this assumption in trademark infringement cases, emphasizing that it is easy for entrants (defendants) to find and adopt another equally good symbol and turn it into a trademark.[153]

However, the assumption of equally good symbols bears little resemblance to reality. Carter pointed out that if symbols were equally good that we would not see brand owners taking part "in the selection and testing of marks."[154] On the contrary, firms are very serious about selecting and testing marks. Psychological and marketing research explained in Section II also implies some colors are preferred to other colors in branding. Beebe and Fromer have provided empirical evidence that not all single words are equally good, and serious congestion exists for one-syllable word marks.[155] The finding of color concentration in this article further challenges the assumption that all single colors are equally good as marks. If not every word, color, or other symbol is equally good as a

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147 Landes & Posner, *supra* note 144, at 173; Economides, *supra* note 144, at 537–38.

148 Carter, *supra* note 17, at 769. These situations do not include generic or descriptive words as trademarks because these words are considered to be more efficient information economizers than fanciful words such as "Exxon" or "Kodak." Therefore, the cost of using a generic or descriptive word as a trademark would be substantial as the public domain loses an efficient information economizer for which other words cannot substitute. *See* Landes & Posner, *supra* note 144, at 173. Economides, *supra* note 144, at 538.

149 Economides, *supra* note 144, at 537-538; Landes & Posner, *supra* note 144, at 172; Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 833 (1927)

150 Landes & Posner, *supra* note 144, at 172.

151 Carter, *supra* note 17, at 769-770.

152 Carter, *supra* note 17, at 787.

153 Lettuce Entertain You Enters., Inc. v. Leila Sophia AR, LLC, 703 F. Supp. 2d 777, 791 (N.D. Ill. 2010); Aveda Corp. v. Evita Mktg., Inc., 706 F. Supp. 1419, 1429 (D. Minn. 1989); Stork Rest., Inc. v. Sahati, 166 F.2d 348, 361 (9th Cir. 1948).

154 Carter, *supra* note 17, at 770.

155 Beebe & Fromer, *supra* note 12, at 988.

trademark, we should not regard the cost of losing a symbol, such as a color, as zero.

The assumption that there is an unlimited supply of equally good symbols might have seemed true when the trademark registration system was developed—at that time, the number of trademarks in use was relatively small and therefore the universe of available symbols seemed to be nearly infinite. With the rise of branding and marketing, however, millions of symbols have been used and registered in different jurisdictions.[156] The assumption of unlimited symbols is thus no longer realistic. The finding of this article and Beebe & Fromer's findings on word mark depletion reveal a gradually depleting space.[157] As mentioned, the consequence of this trend is not necessarily that we will run out of all existing symbols. Rather, the trend implies that the cost of an ever-shrinking color space will continue to rise and cannot be ignored.

Moreover, the other key assumption underlying trademark law and economics—a reduction of search costs—cannot always be guaranteed in practice. Evidence from the USPTO's Audit program suggests that a significant portion of registered marks in the U.S. are not in use in connection with all of the goods and services in connection with which they are registered,[158] which means many symbols removed from the public domain do not reduce the searching costs because they are not, in fact, in use as trademarks. In addition, as discussed above, so called "trademark bullies" might use their trademark rights to intimidate other companies—especially small businesses—to keep them from using similar trademarks even in markets in which the "bully" does not operate. In such cases, registering a symbol in a concentrated area generates only costs.

The reflection above is not intended to repudiate all trademark rights for single-color or other existing symbols (e.g. single-word marks). Rather, it should inform scholars, policymakers, and judicial practitioners that the assumptions underlying the current trademark law do not always play out in reality. Stakeholders should account for this disconnect between assumption and reality when proposing trademark policies or engaging with trademark matters. The reflection also calls for modifying the unsupported assumption of unlimited, equally good symbols. With more

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156 From 2013 to 2022, the number of annual trademark applications in many countries doubled or tripled. In the U.S., annual trademark applications rose from 441,059 to 767,237; in China, from 1,878,389 to 7,515,424; in the UK, from 104,212 to 353,820; in India, from 200,392 to 500,250; and in Brazil, from 163,424 to 404,148. *WIPO IP Statistics Data Center*, WIPO (December 2023), https://www3.wipo.int/ipstats/key-search/search-result?type=KEY&key=241.

157 Beebe and Fromer, *supra* note 12, at 1041.

158 *Post Registration Audit Program Statistics*, USPTO.gov, *supra* note 109.

empirical evidence provided, future theoretical research might develop a formula for the cost of losing an existing symbol, instead of assuming that claiming a symbol as a trademark has no cost. This research can provide theoretical guidance to policymakers and regulators to identify and reduce the costs in the trademark registration system.

VII. LIMITATIONS AND FUTURE RESEARCH

This research is the first quantitative empirical investigation into color concentration and depletion, making contributions on three key levels. First, the research addresses the gap that existed between the theory of color depletion and supporting empirical evidence. The findings provide quantitative insights into color concentration and depletion across product and service classes. These findings are valuable for trademark scholars in advancing trademark theories and for trademark regulators in understanding potential costs within the trademark registration system. Second, this research is the first to use Python programming to code and analyze color trademark specimens (images) recorded at the USPTO, providing methodological inspiration for other empirical legal researchers who need to process and analyze large volumes of image data for research in various law topics. Last, based on the empirical results, this research proposes specific policy recommendations to the USPTO and courts to mitigate color concentration and depletion.

However, as a first attempt at the quantitative investigation of color concentration and depletion, this research unavoidably has some limitations and flaws. The following paragraphs will discuss some of them and suggest potential directions for future research.

A. Single Color Registered on Non-Related Goods/Services Within the Same Class

As discussed in Section III.A, this research examines color concentration and depletion based on the Nice Classification, assuming that goods/services in the same class are similar or related. However, some goods/services within one class are often unrelated or dissimilar to other goods/services falling within that same class. This means that even within one class, the co-existence of the same or similar single-color trademarks is possible if the goods or services are sufficiently unrelated. Ideally, further analysis would divide each class into groups of related goods or services and assess concentration and depletion within each subgroup just as the USPTO's Trademark Examining Attorneys and judges do today when evaluating the likelihood of confusion for trademarks before them. However, this refined investigation is not practical at this stage. No uniform published standards exist to define the

relatedness or similarity between goods/services within one class, as goods/services are evaluated on a case-by-case basis at the USPTO, in the courts, and in the marketplace. Future empirical research could address this gap by coding and analyzing the USPTO and court decisions on good/service similarity in an effort to establish a standard. With such a standard, future research on trademark concentration and depletion could be conducted with greater rigor.

B. The Color Context

As explained previously, the protection scope of single-color trademarks is limited by the context in which the color is used, specifically its design, contour, and location. Consequently, identical or similar colors can coexist if they are applied in distinct designs, contours, or locations. Due to technological limitations, however, this research focuses only on color itself, without considering contextual factors. This approach may overstate the severity of color concentration and depletion, although context alone does not entirely negate the trend of color depletion or concentration.

Future research could incorporate color context into estimations by using image-processing AI technologies. For instance, an AI tool capable of comparing images and grading their similarity could enable more accurate estimations of color depletion and concentration.

C. Black, White, Gray, and Translucent Colors

This research focuses on chromatic colors instead of achromatic ones such as black, white, gray, and translucent. Registering achromatic colors as single-color trademarks is difficult, as they are sometimes considered to be functional in connection with certain goods/services. For example, the color of black flower packaging boxes[159] and black out-board engines[160] have both been held to be aesthetically functional. Nonetheless, depletion and concentration may still occur with these colors, because colors such as black, white, and gray offer limited distinguishable shades. Future empirical research might explore concentration and depletion in these achromatic colors.

D. The Interpretation of Color Depletion and Concentration

This research aims to reveal the status of color concentration and depletion rather than to provide specific interpretations of these phenomena. However, it does not diminish the importance of

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159 *In re* Florists' Transworld Delivery, Inc., 106 U.S.P.Q.2d 1784, 1790 (T.T.A.B. 2013).

160 Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1531 (Fed. Cir. 1994).

interpretation: a deep understanding of the causes behind concentration and depletion is essential for policymakers and regulators to address these issues and develop long-term strategies. Future research could investigate the specific reasons underlying color depletion and concentration, offering greater interpretive insight.

APPENDICES

Appendix 1. Supplemental Assessment of Color Wheel Division Sufficiency

1. The assessment on whether the division of 25-hue spectrum needs to be further divided

In the 25-hue spectrum (Figure A), most segments cover 10 degrees each (e.g., hue 16-25; hue 26-35; hue 36-45, etc.). However, there are five hue segments that cover more than 10 degrees: the red segment (hue 346-15), the green segment (hue 96-155), the dark blue segment (hue 226–255), the magenta segment (hue 296-315), and the plum segment (hue 316-335).

Figure A. The 25-Hue Spectrum

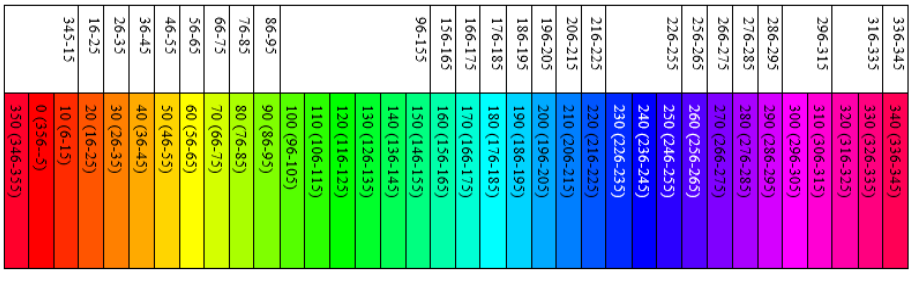

Figure A shows that the subdivision within the green segment (hues 96–155) is unnecessary since the six cells in this segment (hues 96–155) are difficult to distinguish. The same holds true for all of the five hue segments. The differences within these segments are expected to be hardly noticeable in a real market environment, where consumers rarely compare two colors side by side. Instead, they typically encounter one color in a shop or online advertisement and retrieve the corresponding color from their memory. This suggests that the 25-hue division is not under-divided and sufficiently captures the relevant color distinctions for this research. Further divisions within the segments would not yield significant perceptible differences and are therefore unnecessary.

2. The assessment on whether the division of 100-cell color space is sufficient for this research

For this research, the entire color space is divided into 100 independent cells: 25 hue segments multiplied by four shades (varied in saturation and brightness). This 100-cell color space is sufficient for this research, compared with the implicit standards of the USPTO.

Table A below lists seven pairs of colors determined to be confusingly similar in the USPTO's official decisions.[1] The hue, saturation, and brightness values (the HSB codes) are provided under each color. The USPTO has determined that consumers in the market are likely to overlook the difference between the two colors in each pair, and therefore consumer confusion is likely.

Table A

	USPTO Standard for similar marks	
	Earlier marks	Later marks
Pair 1		
Distance	H 170, B 0.44, S 0.55	H 145, B 0.63, S 0.98
Pair 2		
Distance	H 56, B 1, S 0. 80	H 53, B 0.76, S 0.63
Pair 3		
Distance	H 358, B 0.99, S 0.98	H 326, B 0.91, S 0.42
Pair 4		
Distance	H 222, B0.67, S0.58	H 236, B 0.46, S0.86
Pair 5		
	H174, B 0.85, S 0.40	H 188, B 0.88, S 1.00
Pair 6		
	H 198, B 0.92, S0.74	H185, B 0.36, S0.81
Pair 7		
	H215, B 0.80, S0.41	H 199, B 0.76, S1.00

These pairs are then plotted into the 100-cell color space. If the pairs, which the USPTO considers to be non-distinguishable to consumers, fall into different cells in the 100-cell space, it means that the current division is more sensitive and sophisticated than the USPTO standard and therefore is adequate for this research.

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[1] These color pairs are obtained from USPTO office actions that rejected a later mark based on the ground that it is confusingly similar to an earlier mark. Those refused marks are U.S. Trademark Application Serial Nos. 88288570, 8684147, 85149118, 78937340, 85684740, 86593915, and 77279314.

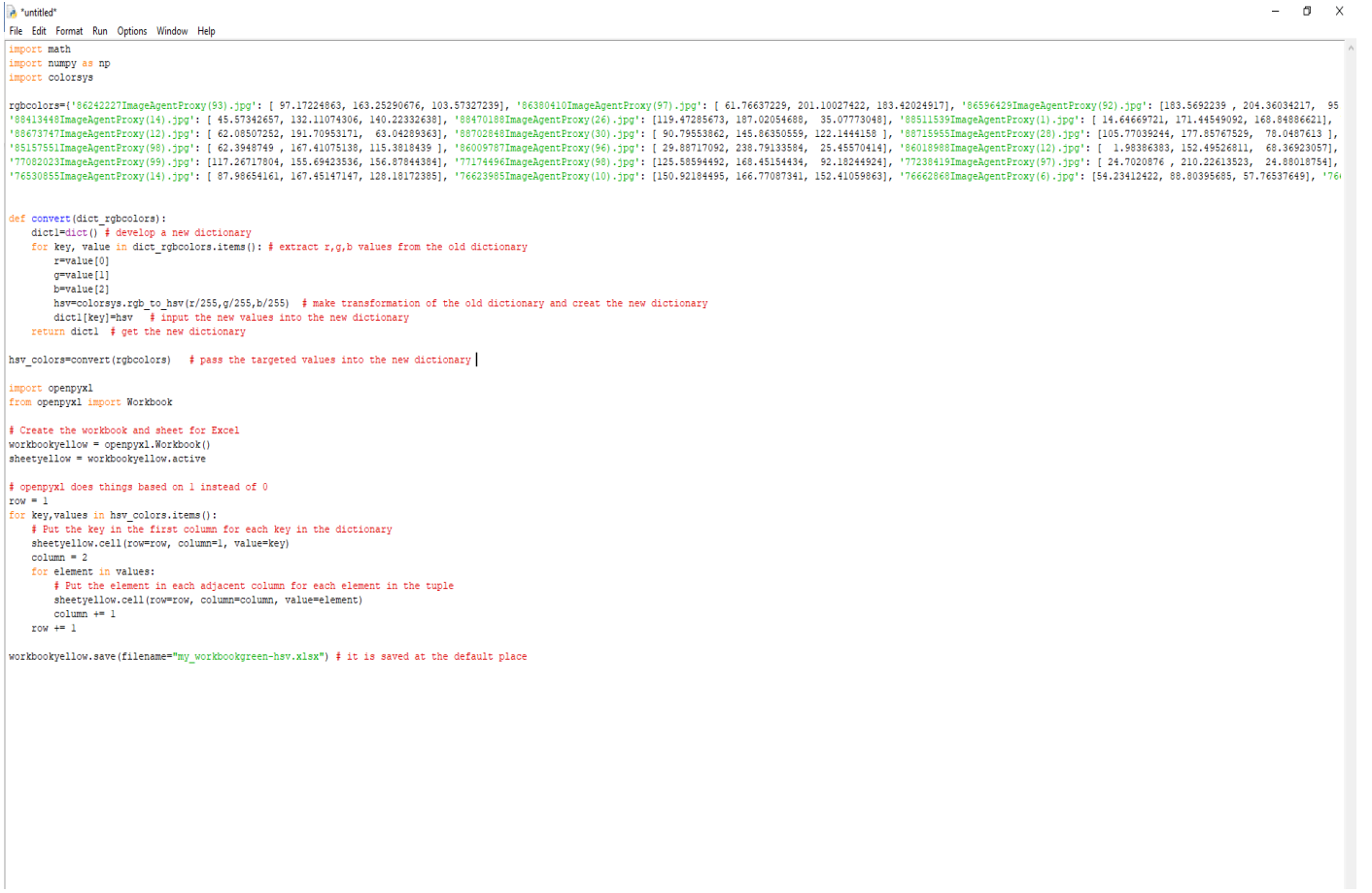
The plotting includes two steps. For the first step, the pairs are plotted into the 25-hue spectrum regardless of brightness and saturation. If one pair falls into different hue segments in the 25-hue spectrum, the pair definitely falls into different cells in the 100-cell space. If a pair falls into the same hue segment, the colors' saturation and brightness must be checked to see if the pair falls into the same cell in the 100-cell space.

According to the hue values in Table A, all pairs fall into different hue segments. Therefore, all pairs fall into different cells in the 100-cell space, and there is no need to further check the dimensions of saturation and brightness. This plotting indicates that the 100-cell color space is more sophisticated than the USPTO standard and is therefore adequate for this research.

Appendix 2. Python Code for Processing Color Trademark Drawings

File Edit Format Run Options Window Help

```
from sklearn.cluster import KMeans
import matplotlib.pyplot as plt
import numpy as np
import cv2
from collections import Counter
from skimage.color import rgb2lab, deltaE_cie76
import os
from os import listdir
from os.path import isfile, join
import math
import colorsys

def RGB2HEX(color):
    return "#{:02x}{:02x}{:02x}".format(int(color[0]), int(color[1]), int(color[2]))

def get_image(image_path):
    image = cv2.imread(image_path)
    image = cv2.cvtColor(image, cv2.COLOR_BGR2RGB)
    return image

def modify_image(image):
    modified_image = cv2.resize(image, (600, 400), interpolation = cv2.INTER_AREA)
    modified_image = modified_image.reshape(modified_image.shape[0]*modified_image.shape[1], 3)
    return modified_image

def cluster_image(modified_image,n_clusters):
    clf=KMeans(n_clusters)
    labels=clf.fit_predict(modified_image)
    counts=Counter(labels)
    center_colors=clf.cluster_centers_
    ordered_colors=[center_colors[i] for i in counts.keys()]
    hex_colors=[RGB2HEX(ordered_colors[i]) for i in counts.keys()]
    rgb_colors = [ordered_colors[i] for i in counts.keys()]
    return rgb_colors

path=r'C:
#print(path)
onlyfiles = [f for f in listdir(path)if isfile(join(path, f))]

color_results=dict()
for f in onlyfiles:
    # print(f)
    image=get_image(join(path,f))
    #print(image)
    modified_image=modify_image(image)
    rgb_colors=cluster_image(modified_image,2)
    #print(rgb_colors)
    look=rgb_colors[0]
    is_white=(look[0]>240)and (look[1]>240)and (look[2]>240)
    is_black=(look[0]<30)and (look[1]<30)and (look[2]<30)
    if not (is_white or is_black):
        color_results[f]=rgb_colors[0]
    else:
        color_results[f]=rgb_colors[1]

print(color_results)
#print(hex_colors)
```



untitled

File Edit Format Run Options Window Help

```
import math
import numpy as np
import colorsys

rgbcolors={'86242227ImageAgentProxy(93).jpg': [ 97.17224863, 163.25290676, 103.57327239], '86380410ImageAgentProxy(97).jpg': [ 61.76637229, 201.10027422, 183.42024917], '86596429ImageAgentProxy(92).jpg': [183.5692239 , 204.36034217,  95
'88413448ImageAgentProxy(14).jpg': [ 45.57342657, 132.11074306, 140.22332638], '88470188ImageAgentProxy(26).jpg': [119.47285673, 187.02054688,  35.07773048], '88511539ImageAgentProxy(1).jpg': [ 14.64669721, 171.44549092, 168.84886621],
'88673747ImageAgentProxy(12).jpg': [ 62.08507252, 191.70953171,  63.04289363], '88702848ImageAgentProxy(30).jpg': [ 90.79553862, 145.86350559, 122.1444158 ], '88715955ImageAgentProxy(28).jpg': [105.77039244, 177.85767529,  78.0487613 ],
'85157551ImageAgentProxy(98).jpg': [ 62.3948749 , 167.41075138, 115.3818439 ], '86009787ImageAgentProxy(96).jpg': [ 29.88717092, 238.79133584,  25.45570414], '86018988ImageAgentProxy(12).jpg': [  1.98386383, 152.49526811,  68.36923057],
'77082023ImageAgentProxy(99).jpg': [117.26717804, 155.69423536, 156.87844384], '77174496ImageAgentProxy(98).jpg': [125.58594492, 168.45154434,  92.18244924], '77238419ImageAgentProxy(97).jpg': [ 24.7020876 , 210.22613523,  24.88018754],
'76530855ImageAgentProxy(14).jpg': [ 87.98654161, 167.45147147, 128.18172385], '76623985ImageAgentProxy(10).jpg': [150.92184495, 166.77087341, 152.41059863], '76662868ImageAgentProxy(6).jpg': [54.23412422, 88.80395685, 57.76537649], '76


def convert(dict_rgbcolors):
    dict1=dict() # develop a new dictionary
    for key, value in dict_rgbcolors.items(): # extract r,g,b values from the old dictionary
        r=value[0]
        g=value[1]
        b=value[2]
        hsv=colorsys.rgb_to_hsv(r/255,g/255,b/255)  # make transformation of the old dictionary and creat the new dictionary
        dict1[key]=hsv   # input the new values into the new dictionary
    return dict1  # get the new dictionary

hsv_colors=convert(rgbcolors)   # pass the targeted values into the new dictionary

import openpyxl
from openpyxl import Workbook

# Create the workbook and sheet for Excel
workbookyellow = openpyxl.Workbook()
sheetyellow = workbookyellow.active

# openpyxl does things based on 1 instead of 0
row = 1
for key,values in hsv_colors.items():
    # Put the key in the first column for each key in the dictionary
    sheetyellow.cell(row=row, column=1, value=key)
    column = 2
    for element in values:
        # Put the element in each adjacent column for each element in the tuple
        sheetyellow.cell(row=row, column=column, value=element)
        column += 1
    row += 1

workbookyellow.save(filename="my_workbookgreen-hsv.xlsx") # it is saved at the default place
```

Appendix 3: The Methodology of Estimating Depletion Proportions (Percentages) in Each Product/Service Class

To estimate depletion, the method plots all single-color trademark filings in one class into the 100-cell space and examines how many cells have been taken up. For example, Class 24 has in total five single-color trademark filings (Reg. Nos. 3474557, 3097115, 5056526, and 5338162 and Application Serial No. 88692739).[2] These five trademark filings are plotted into the 100-cell space. The process includes two steps:

Step 1: Plot the five single-color trademark filings into the 25-hue segments. Each dot in Figure B(a) (below) represents a single-color trademark in Class 24. Among the five dots, three fall separately into three hue segments: hues 345–15, 46–55, and 216–225. This means the three dots fall into three separate cells in the 100-cell space. The remaining two dots fall into the same hue segment 196–205, requiring a further check of the two dots' brightness and saturation to identify whether they fall into different shades.

Step 2: Plot the remaining two single-color trademark filings into the four-shade quadrant. Figure B(b) (below) shows the four-shade quadrant (horizontal axis: brightness; vertical axis: saturation). If the two dots fall into the same shade, it means that they are in the same cell in the 100-cell color space, while if they fall into different shades, it means that they are in two different cells. The plotting of the remaining two dots indicates that they are in the same shade area (the area of high brightness and low saturation). It means the two dots fall into the same cell in the 100-cell space.

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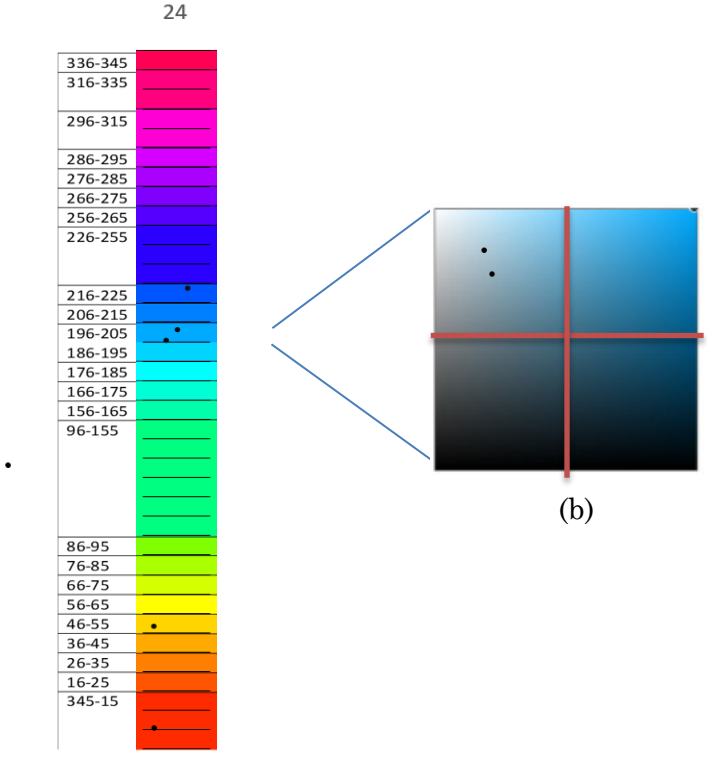
[2] The data set was collected at the end of 2019. After 2019, the status of some trademarks collected might change. Two single-color trademark filings (Reg. No. 5338162 and Application Serial No.88692739 in Class 24) were cancelled or abandoned after 2019. We still keep them in the analysis, as it is not practical to re-check the large volume of trademark filing one by one given that the status of trademark filings changes every day. And the status change after 2019 should not influence the validity of the data collected between 2003 and 2019 in this research. In addition, the trademark filing under Reg. No. 5338162 is labeled as a word mark, but the applicant also claimed "Red or pink (single color used for the entire goods/services)" under the single-color trademark code 29.02.01. As a result, the research considers this situation to be a single-color trademark based upon this applicant's claim and the design code used.

Figure B



To sum up, the five dots in Class 24 fall into four separate color cells: the first three fall into three cells and the remaining two fall into one cell. So, the 100-cell color space has **four cells being taken up by single-color trademarks in Class 24, which means the color space has 4% depletion in this class**. Through this method of plotting and calculation, the depletion in each product/service class can be estimated.

Appendix 4: The Methodology of Estimating Depletion Speed

The methodology includes three steps:

Step 1: Calculate the depletion percentage in each year in one good/service class.

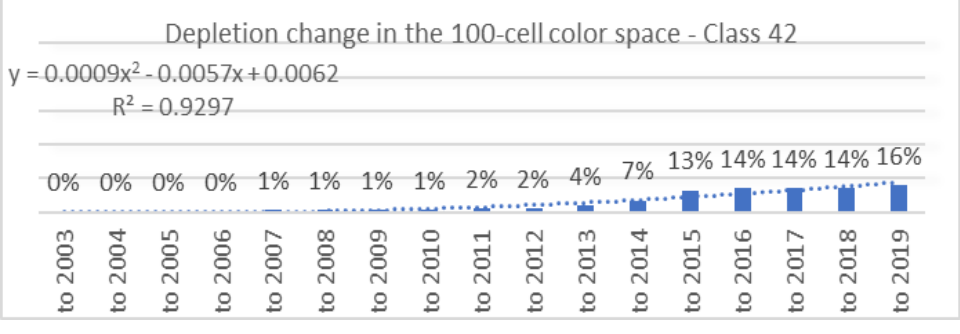
The calculation is the same as the method in Appendix 3 except that the depletion percentage is calculated for each year. The depletion percentage for each year counts both the new single-color trademark filings that year and those filed in previous years that are still alive in that year. For example, the depletion percentage of 2005 counts both the single-color trademarks filed in 2005 and those filed before 2005 that are still alive in 2005.

Step 2: Plot the depletion percentage for each year in one good/service class in the column chart and develop the mathematic function of the historical trend of depletion.

Figure C (below) plots the depletion percentages from 2003 to 2019 in Class 42. The horizontal axis (x) denotes the year: 2003 is year 1 (x=1), 2004 is year 2 (x=2), 2019 is year 17 (x=17). The vertical axis (y) denotes the depletion percentage.

Based on the depletion percentage for each year, a mathematic function revealing the depletion percentage in response to the year is developed: $y= 0.0009x^2 -0,0057x+0.0062$.[3]

Figure C

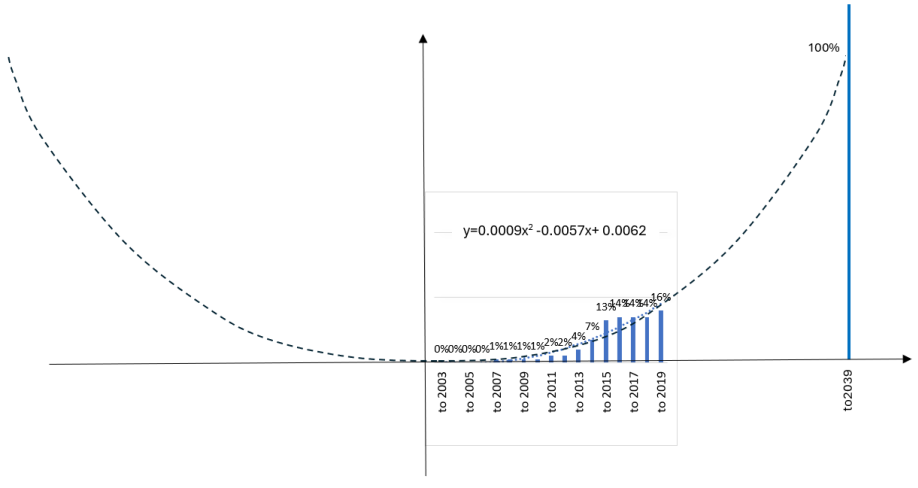


[3] This mathematic function is generated using Microsoft's Excel spreadsheet software, which can generate optional functions and curves such as linear, polynomial, logarithm, etc. from the data. Each available function was applied to each plot of depletion versus time, and the function providing the highest R^2 (coefficient of determination) value was selected. The higher the R^2 value, the better fit of the function to the data.

Step 3: Predict the year when the depletion percentage is 100% (all 100 cells are claimed by trademarks).

With the mathematic function developed in Step 2, one can calculate the corresponding year for a full depletion percentage, namely y = 100% (Figure D, below). The method is straightforward: calculating the x value, given y =1 (100%).[4]

Figure D



With this method (Steps 1–3), one can estimate the time when full depletion will occur in each of the 45 classes of goods and services. The schedule of all 45 classes is shown in Figure 15 in the main body of this article.

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[4] For the function y = 0.0009x² - 0,0057x + 0.0062, given y = 1, x = 37. It means 100% depletion (y = 1) happens when x = 37, namely 2039 (= 2003 + 37 - 1).

Appendix 5: The Mathematic Functions and Curves of the Annual Depletion Percentages Across 45 Classes

Chart 1. Depletion change in the 100-cell color space—Class 1. Peak point: x= 16.2857, y = 0.1451.

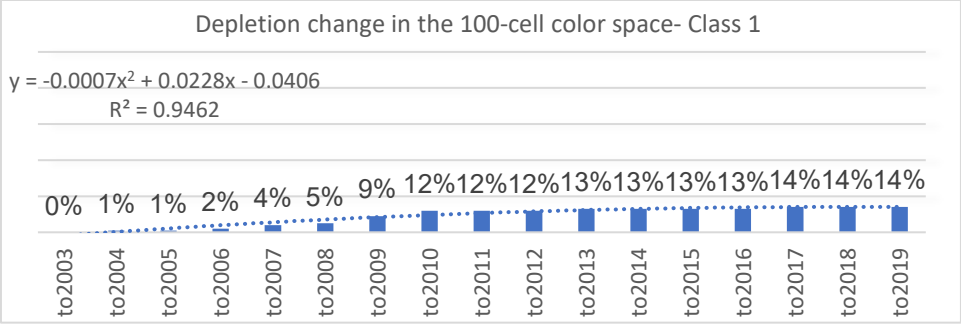


Chart 2. Depletion change in the 100-cell color space—Class 2. Peak point: x = 27, y = 0.0636.

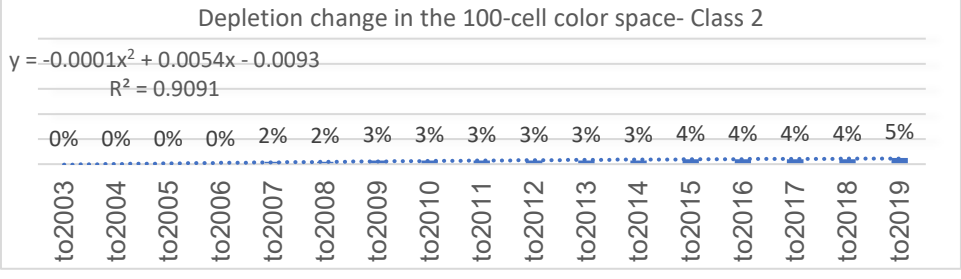


Chart 3. Depletion change in the 100-cell color space—Class 3. Given y = 1, x = 71.7733.

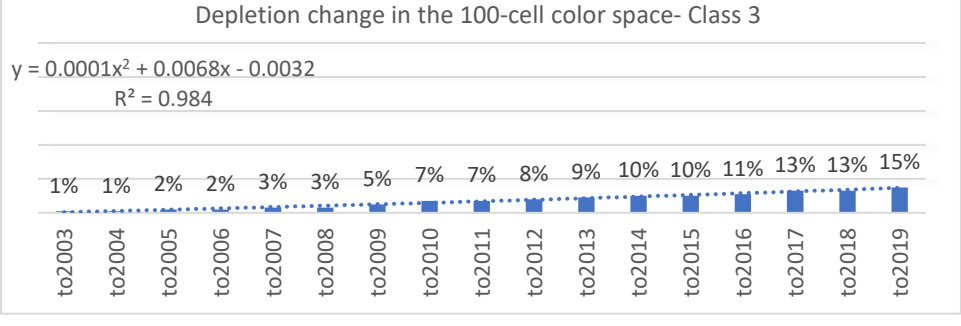


Chart 4. Depletion change in the 100-cell color space—Class 4. Peak point: y = 0.0438, x = 21.

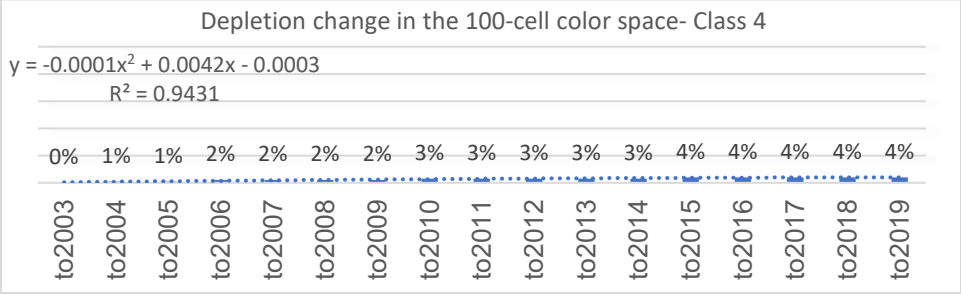


Chart 5. Depletion change in the 100-cell color space—Class 5. Given y = 1, x = 29.9324.

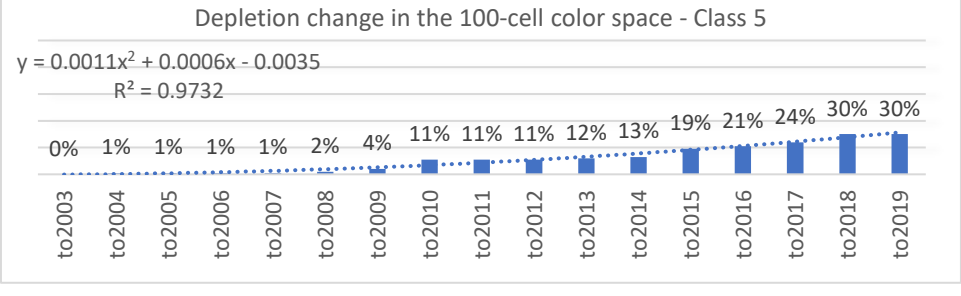


Chart 6. Depletion change in the 100-cell color space—Class 6. The peak point x = 14.85, y = 0.1951.

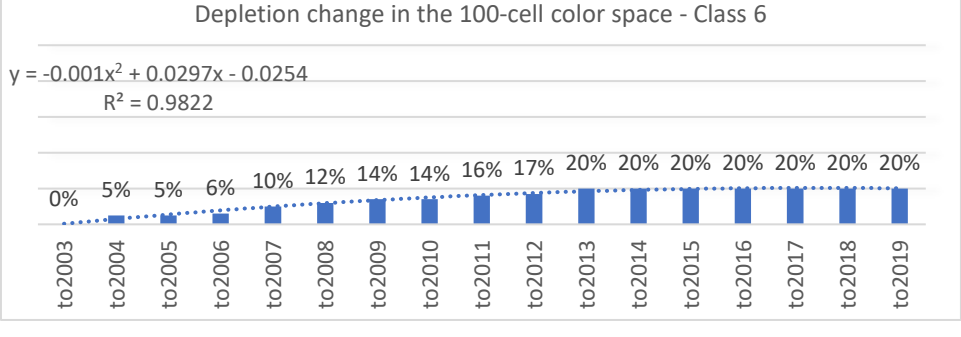


Chart 7. Depletion change in the 100-cell color space—Class 7. Peak point: y = 0.3726, x = 31.375.

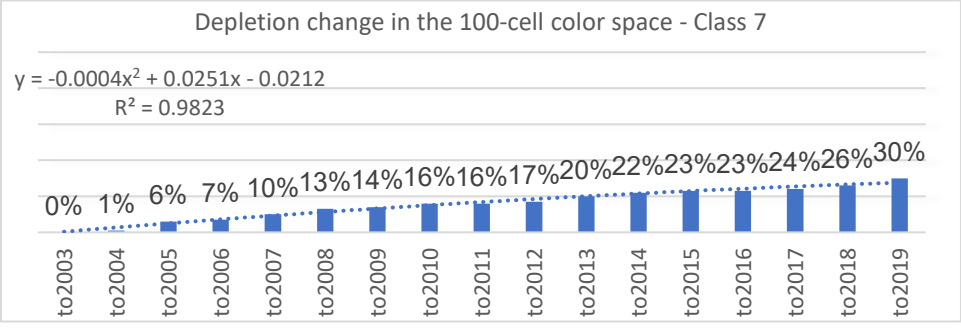


Chart 8. Depletion change in the 100-cell color space—Class 8. Given y = 1, x = 72.3043.

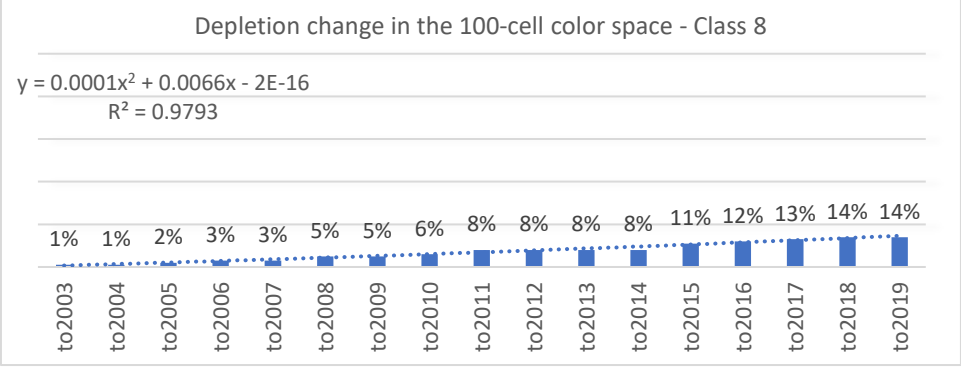


Chart 9. Depletion change in the 100-cell color space—Class 9. Given y = 1, x = 34.2036.

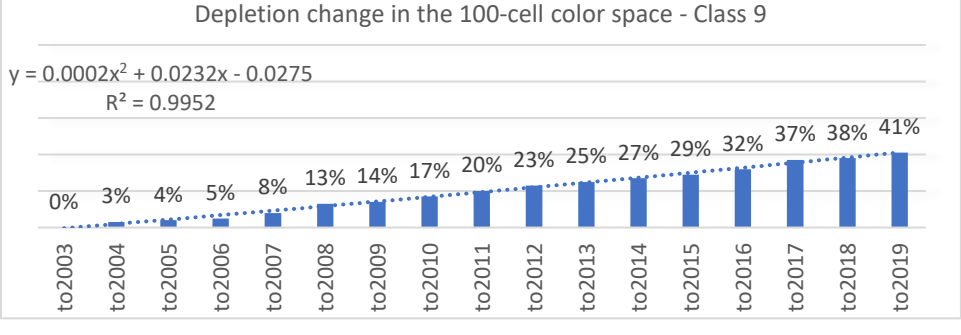


Chart 10. Depletion change in the 100-cell color space—Class 10. Given y = 1, x = 37.0976.

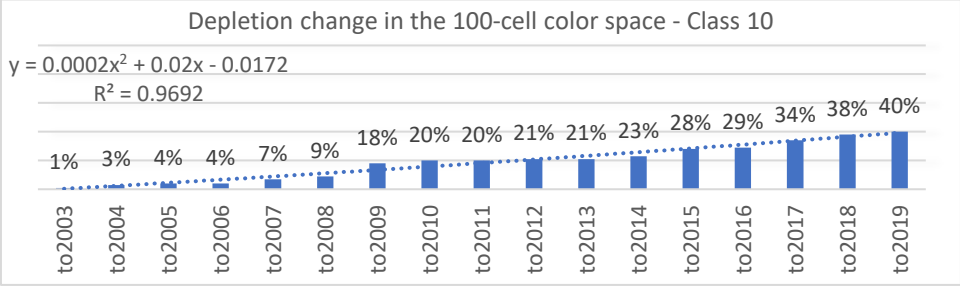


Chart 11. Depletion change in the 100-cell color space—Class 11. Given y = 1, x = 40.4872.

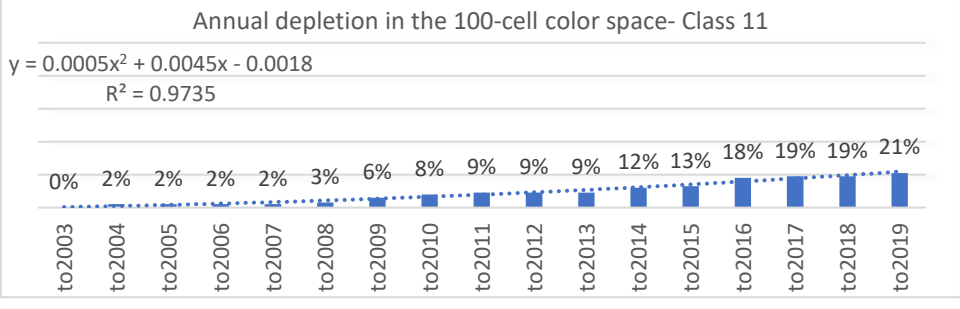


Chart 12. Depletion change in the 100-cell color space—Class 12. Given y = 1, x = 84.1883.

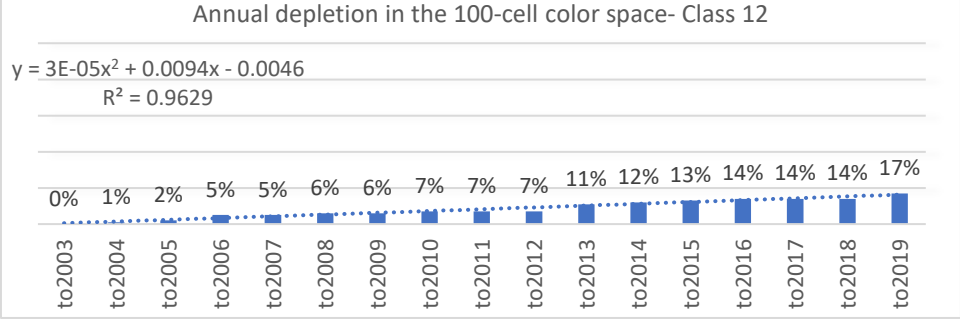


Chart 13. Depletion change in the 100-cell color space—Class 13. Given y = 1, x = 53.7481.

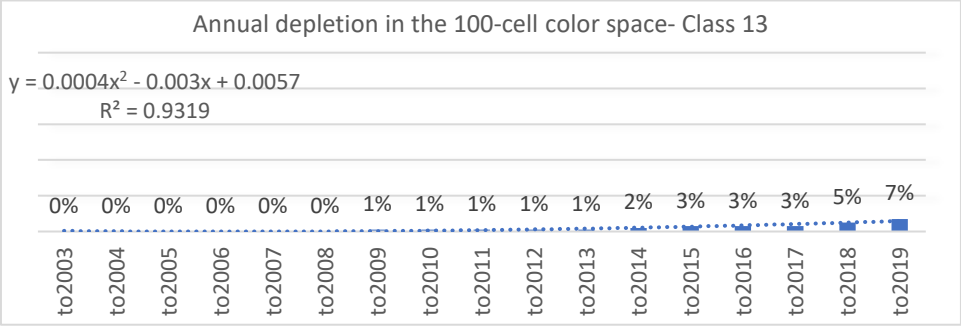


Chart 14. Depletion change in the 100-cell color space—Class 14. Given y = 1, x = 100.7420.

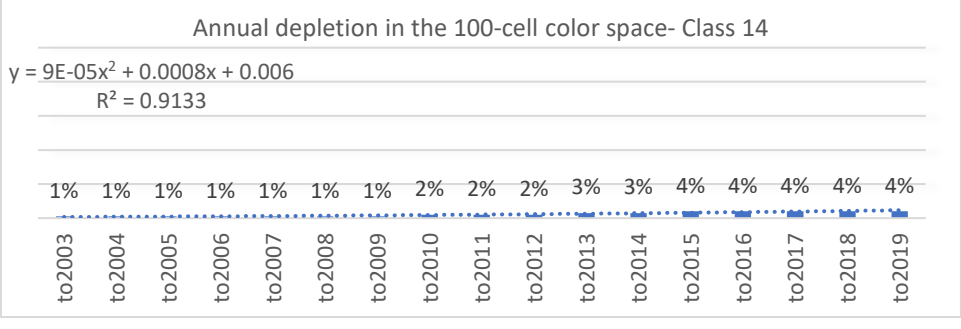


Chart 15. Depletion change in the 100-cell color space—Class 15. Given y = 1, x = 3.2537 X 10^{58}.

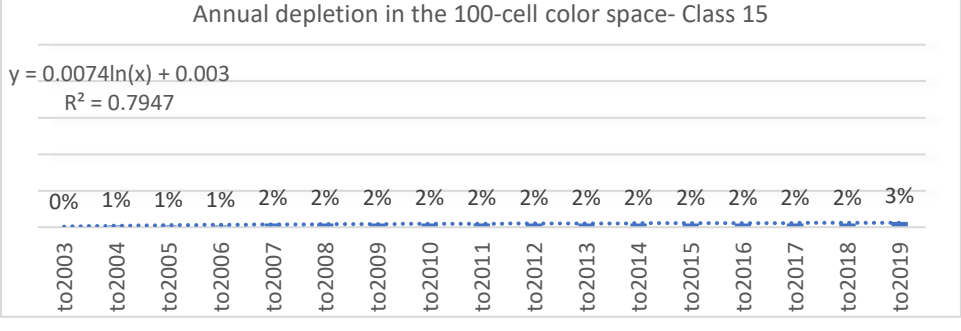


Chart 16. Depletion change in the 100-cell color space—Class 16. Peak value: y = 0.1827; x = 19.25.

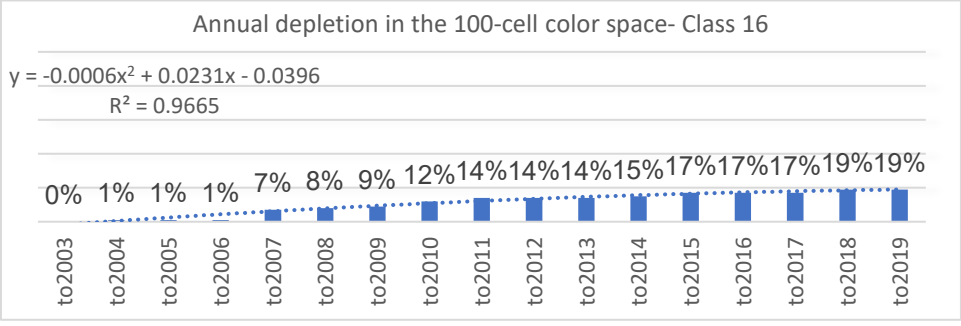


Chart 17. Depletion change in the 100-cell color space—Class 17. The peak point x = 17.85, y = 0.2574.

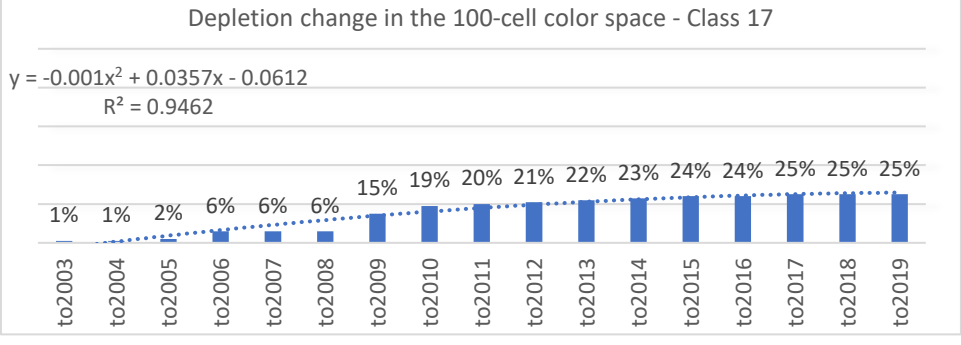


Chart 18. Depletion change in the 100-cell color space—Class 18. Given y =1, x = 69.4137.

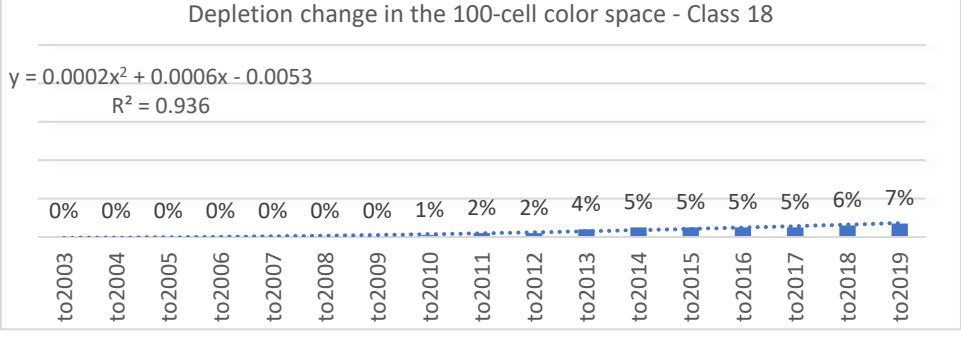


Chart 19. Depletion change in the 100-cell color space—Class 19. The peak point x = 16.9167, y = 0.1542.

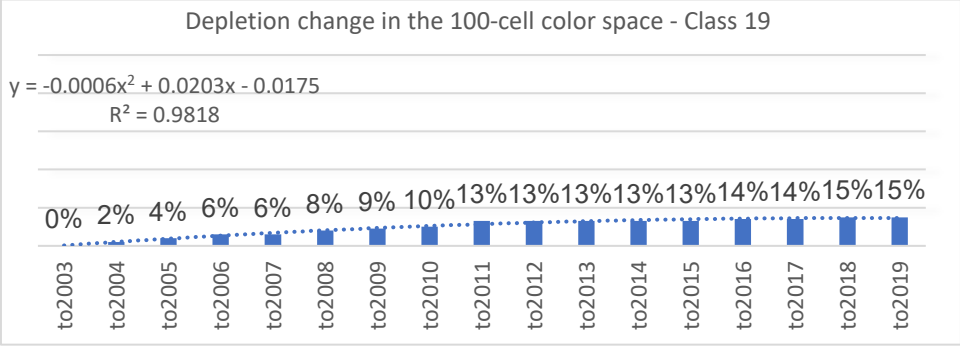


Chart 20. Depletion change in the 100-cell color space—Class 20. Given y = 1, x = 42.9470.

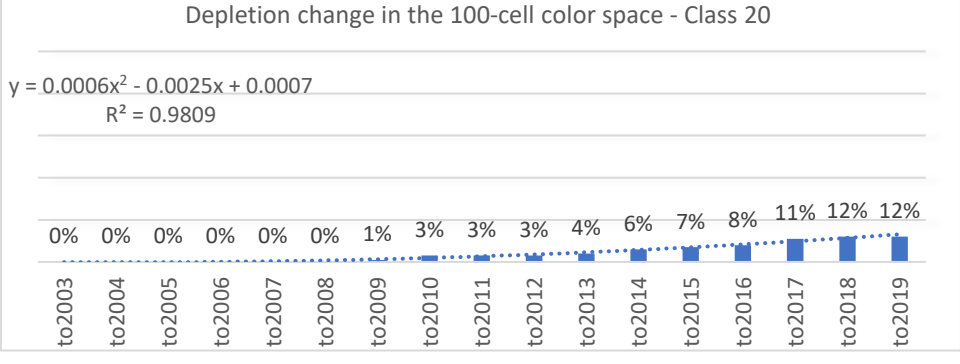


Chart 21. Depletion change in the 100-cell color space—Class 21. Given y = 1, x = 39.1432.

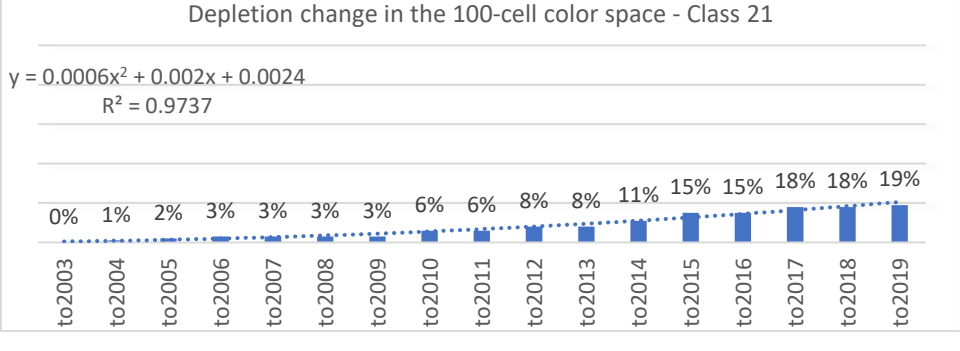


Chart 22. Depletion change in the 100-cell color space—Class 22. Peak point: y = 0.0145; x = 30.

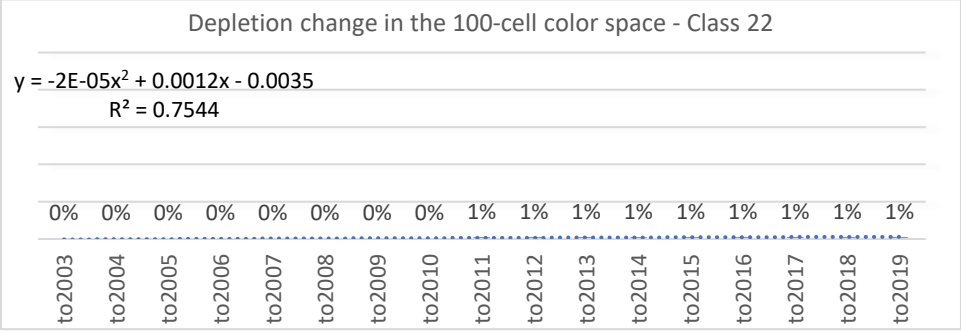


Chart 23. No single-color registrations in Class 23.

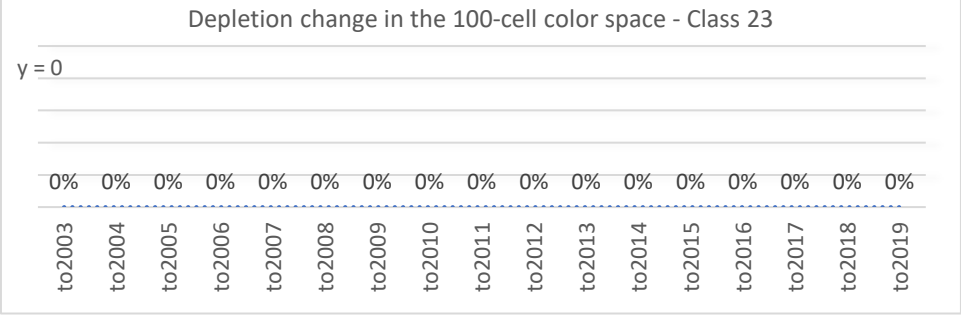


Chart 24. Depletion change in the 100-cell color space—Class 24. Given y = 1, x = 130.3259.

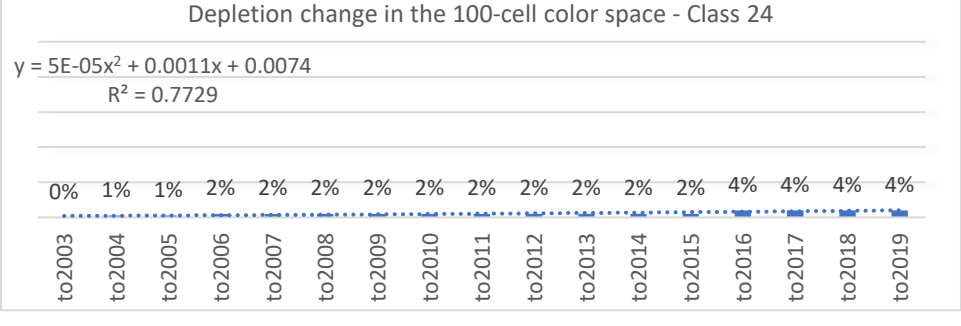


Chart 25. Depletion change in the 100-cell color space—Class 25. Given y =1, x = 42.2471.

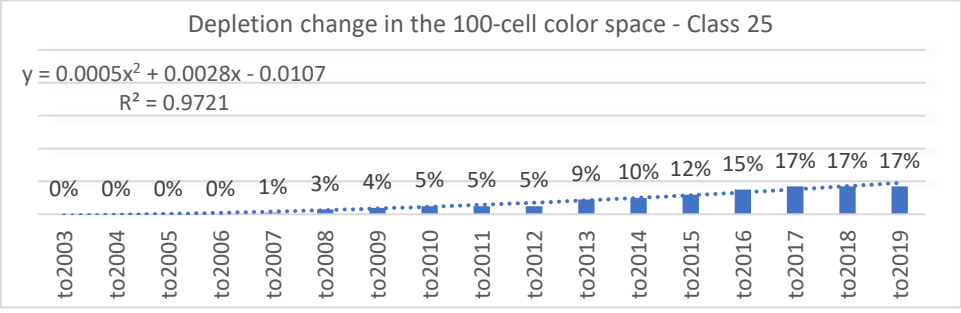


Chart 26. Depletion change in the 100-cell color space—Class 26. Given y = 1, x = 169.9182.

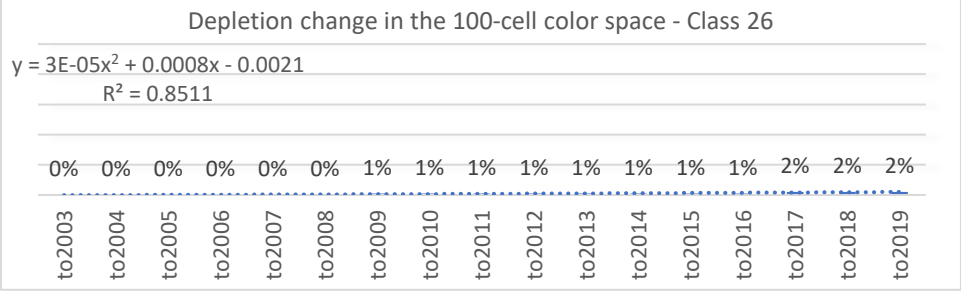


Chart 27. No single-color registrations in Class 27.

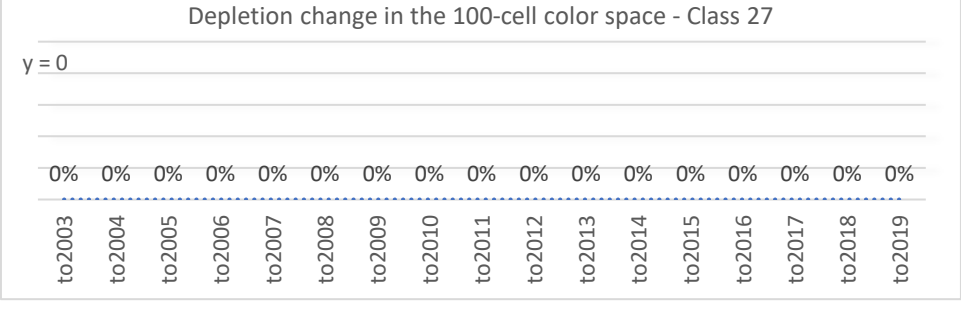


Chart 28. Depletion change in the 100-cell color space—Class 28. Given y=1, x = 74.3184.

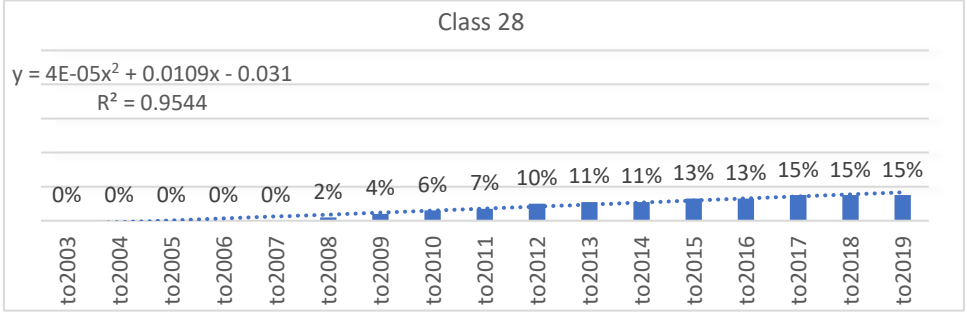


Chart 29 Depletion change in the 100-cell color space—Class 29. Given y=1, x = 160.5525.

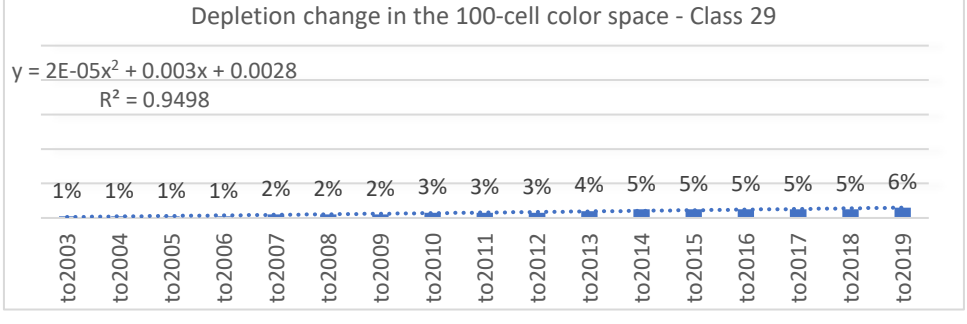


Chart 30. Depletion change in the 100-cell color space—Class 30. Given y = 1, x = 51.7124.

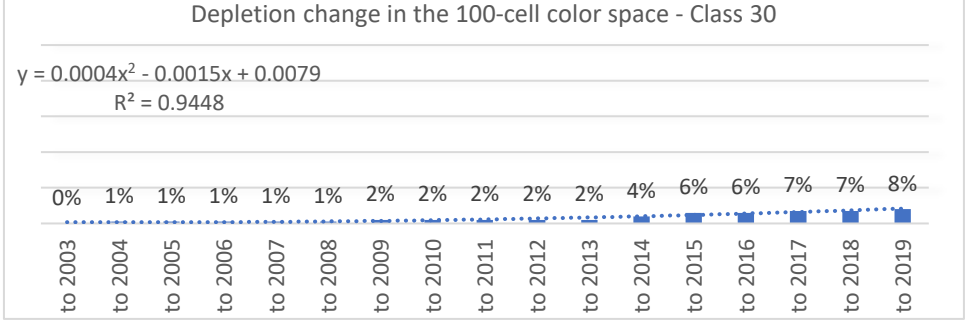


Chart 31. Depletion change in the 100-cell color space—Class 31. Given y = 1, x = 64.1367.

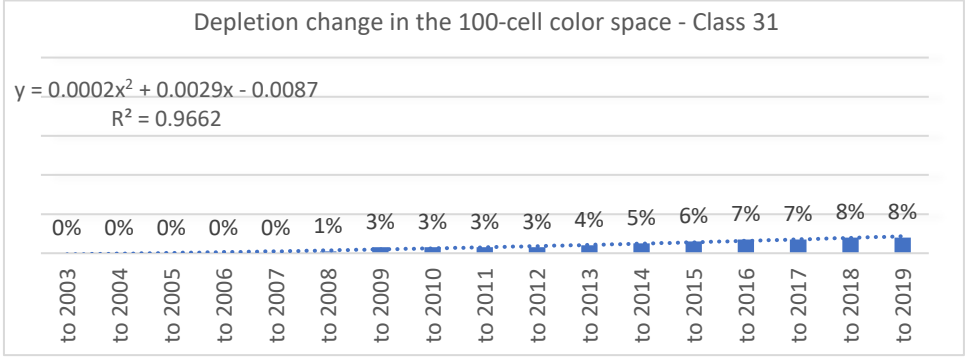


Chart 32. Depletion change in the 100-cell color space—Class 32. Given y = 1, x = 72.7036.

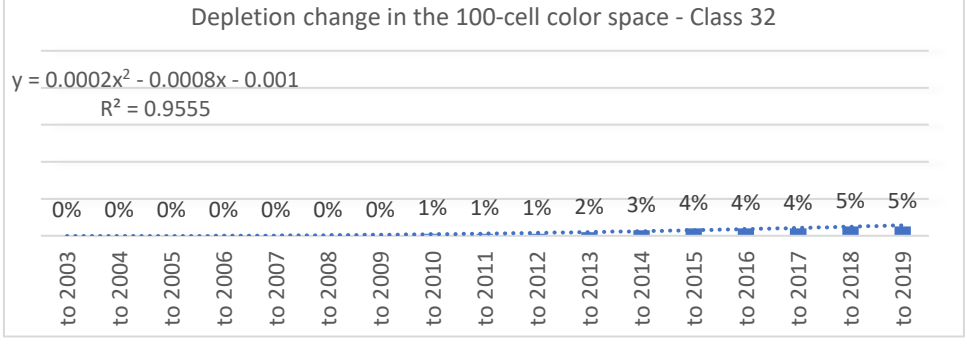


Chart 33. Depletion change in the 100-cell color space—Class 33. Peak point: x = 65.5, y = 0.402725.

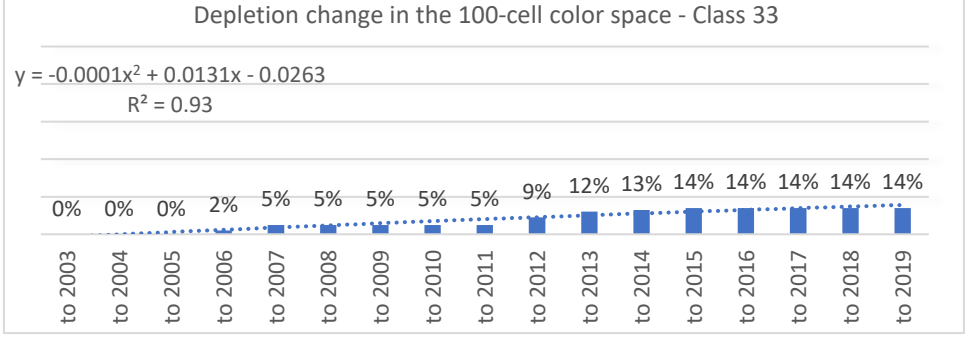


Chart 34. Depletion change in the 100-cell color space—Class 34. Given y = 1, x = 140.8515.

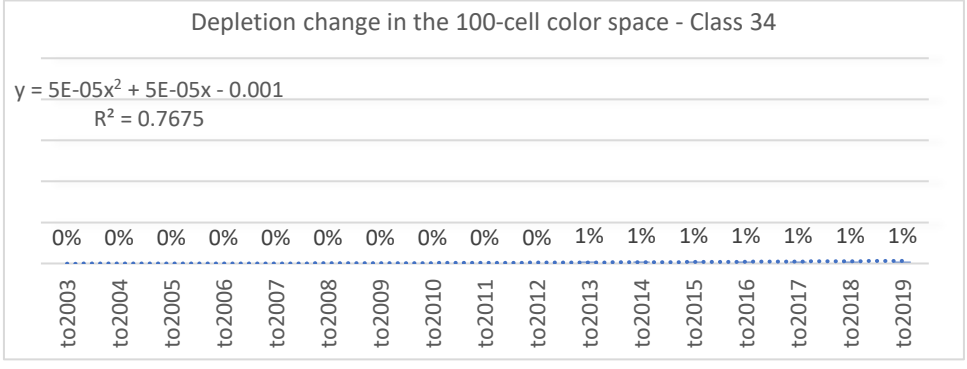


Chart 35. Depletion change in the 100-cell color space—Class 35. Given y =1, x = 40.4009.

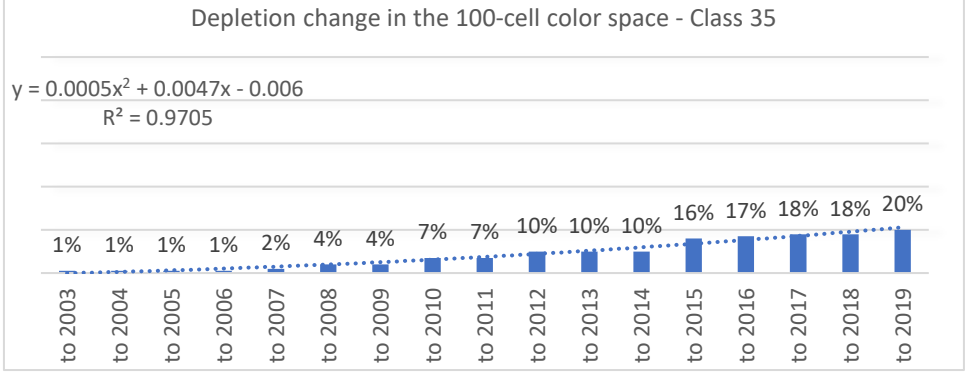


Chart 36. Depletion change in the 100-cell color space—Class 36. Given y = 1, x = 44.4425.

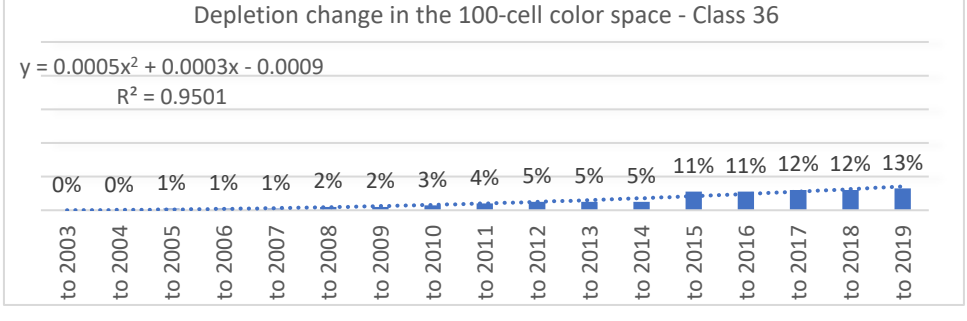


Chart 37. Depletion change in the 100-cell color space—Class 37. Peak point: y = 0.5031, x= 85.7143.

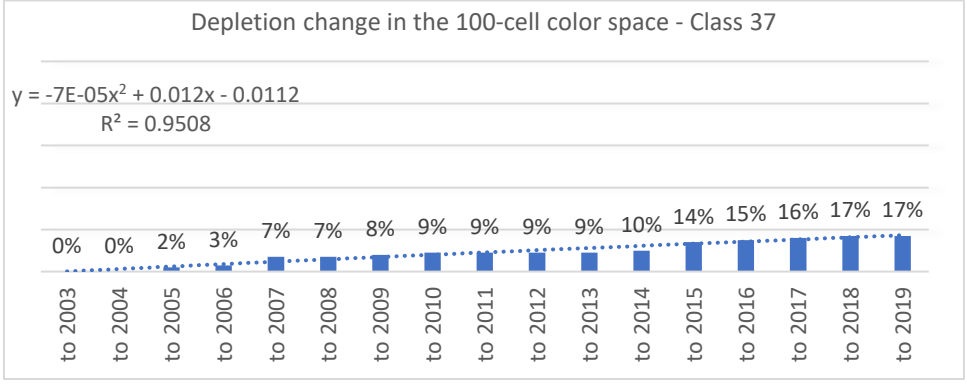


Chart 38. Depletion change in the 100-cell color space—Class 38. Peak point: y = 0.1637; x = 43.

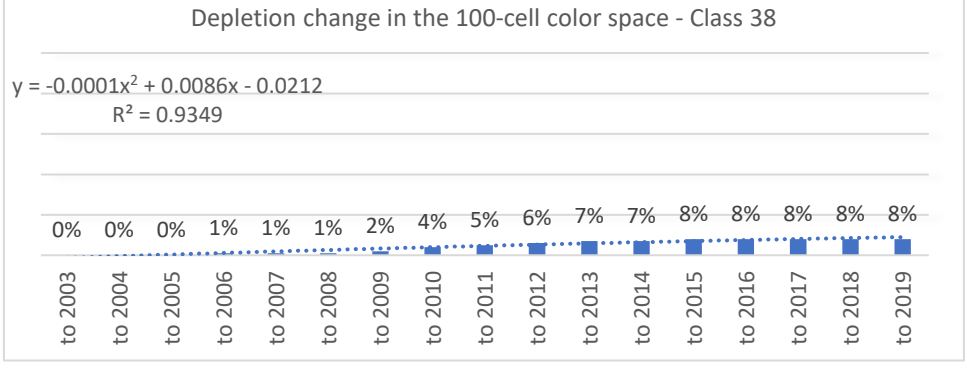


Chart 39. Depletion change in the 100-cell color space—Class 39. Given y = 1, x = 47.9190.

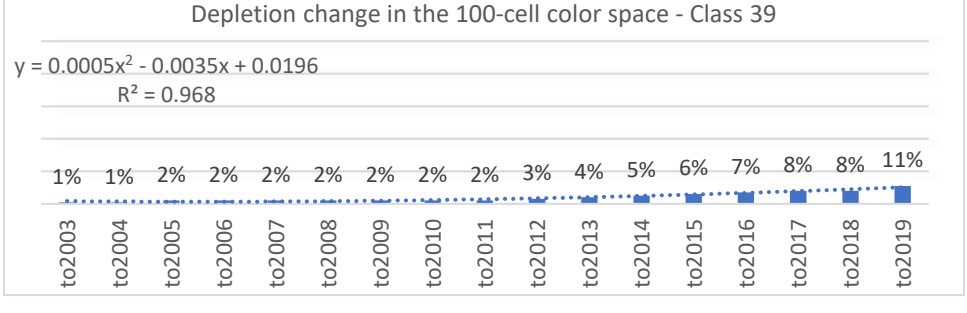


Chart 40. Depletion change in the 100-cell color space—Class 40. Given y = 1, x = 127.4177.

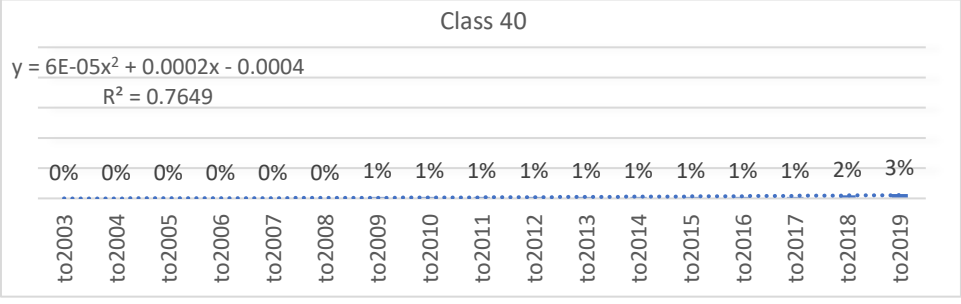


Chart 41. Depletion change in the 100-cell color space—Class 41. Given y = 1, x = 47.1228.

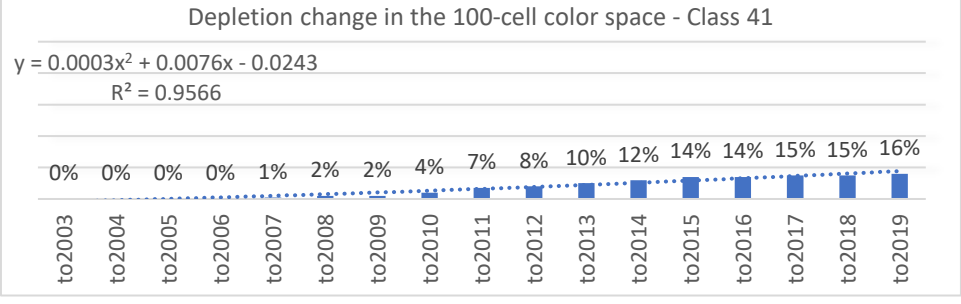


Chart 42. Depletion change in the 100-cell color space—Class 42. Given y = 1, x = 36.5471.

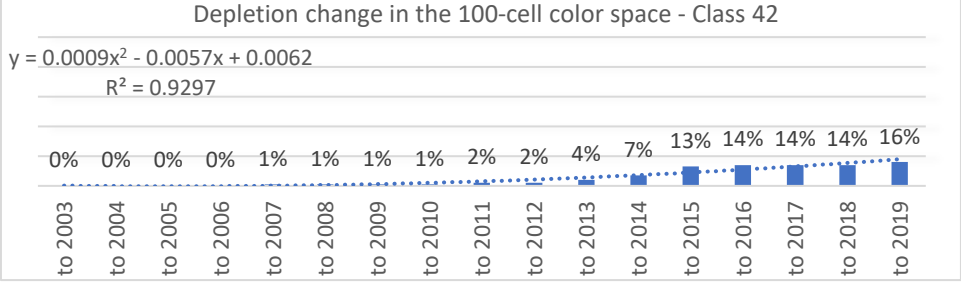


Chart 43. Depletion change in the 100-cell color space—Class 43. Given y = 1, x = 54.0172.

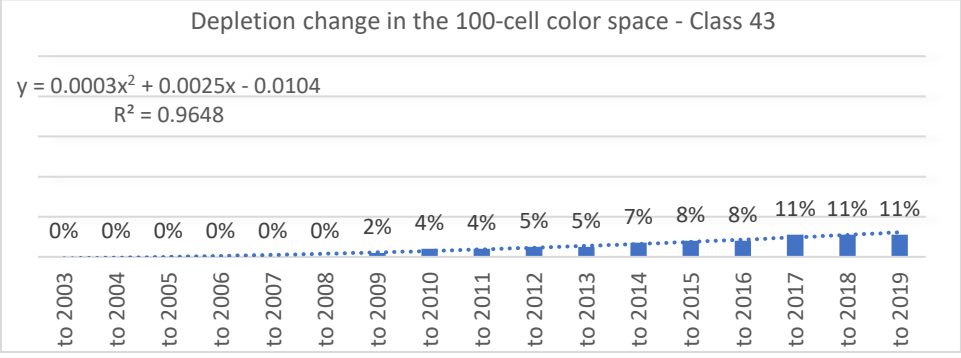


Chart 44. Depletion change in the 100-cell color space—Class 44. Given y = 1, x = 57.9422.

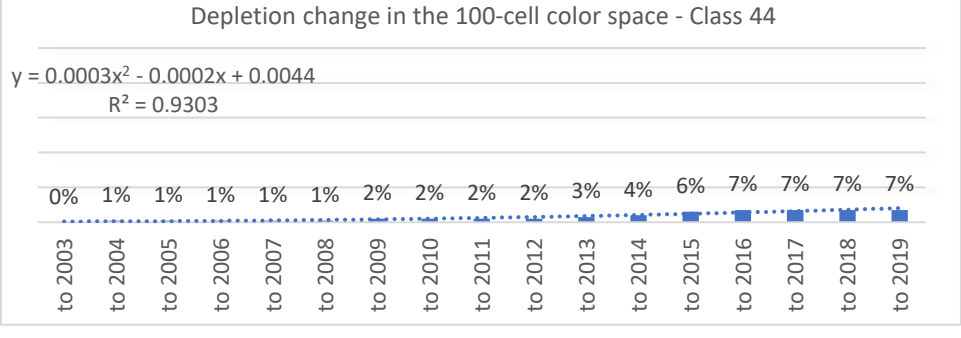
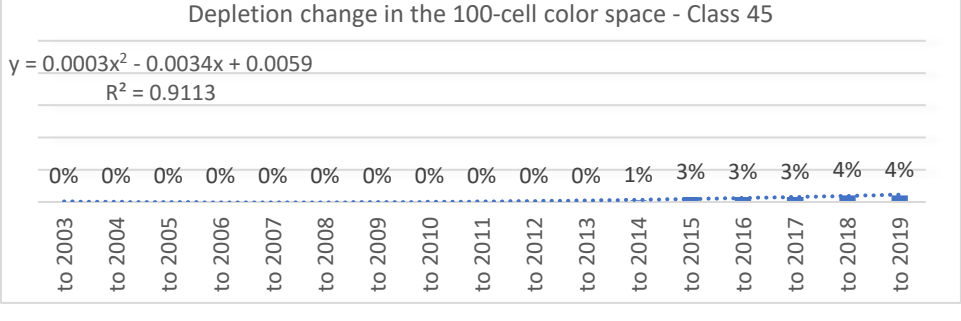


Chart 45. Depletion change in the 100-cell color space—Class 45. Given y = 1, x = 63.5094.



Appendix 6. The Two Patterns of Depletion Trend

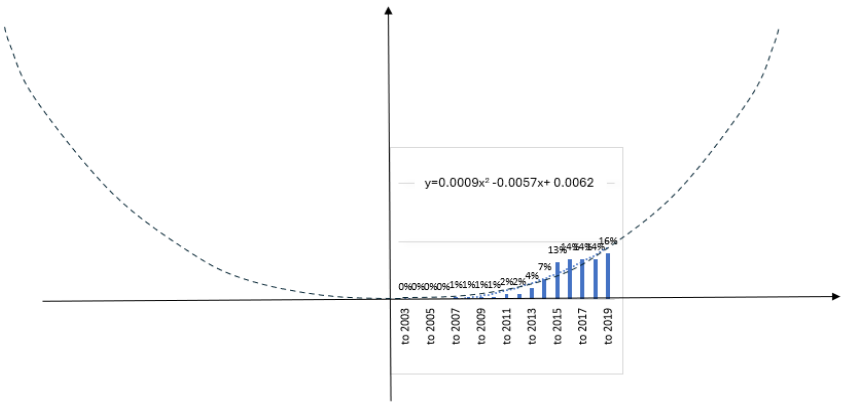
Based on the mathematic functions and curves of the annual depletion percentages in the forty-five classes of goods and services (Appendix 5), two general pattens of depletion trends exist:

Pattern 1: The depletion increases slowly at first, but accelerates later

Pattern 1 is that the depletion percentages increase slowly at first, but accelerate later, illustrated by Figure 13. Classes 3, 5, 8, 9, 10, 11, 12, 13, 14, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 34, 35, 36, 39, 40, 41, 42, 43, 44, and 45 share this pattern (check Appendix 5 for the specific pattern for each of these classes).

Take Class 42 as an example (Figure E, below), the trendline (depicted by the dashed line) shows that the depletion of Class 42 goes up slowly at the beginning, but accelerates later: the depletion grew by 2% from 2003 to 2011, but saw a more significant increase, escalating from 2% to 16% in the period from 2011 to 2019. The fitted mathematic function in Figure 13 shows that the whole curve is shaped as a U and the trendline of Class 42 locates at the upward right side of the U shape. This location suggests that the depletion in Class 42 will continue to accelerate after 2019. This acceleration also explains why Class 42 had a non-severe depletion percentage (16%) in 2019, but that it might be fully depleted before 2050.

Figure E



Why do these classes increase slowly but accelerate later? One interpretation lies in the development pattern of the industry related to each class. For example, Class 42 covers technical and computer services. The depletion pattern of Class 42, which

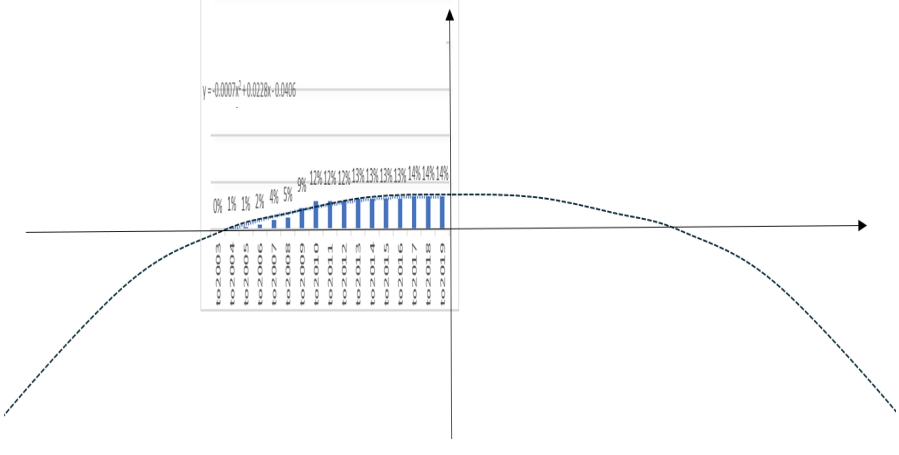
increased slowly from 2003 to 2011, but accelerated quickly from 2011 to 2019, might be attributed to the rapid development in this sector since 2011. Verifying this association would require a separate project and is not the purpose of this article.

Pattern 2: The depletion increases quickly at first but flattens later, never reaching full depletion.

Figure 12 in the main text has dotted bars: Classes 1, 2, 4, 6, 7, 16, 17, 19, 22, 33, 37, and 38. These classes share Pattern 2, which increases quickly at first, but flattens later, illustrated by Figure F below. This pattern arises from the mathematical function describing the depletion percentage change over years.

Using Class 1 as an example, the trendline (represented by the dashed line) in Figure F initially exhibits a swift ascent, but gradually levels off. The fitted mathematic function in Figure F shows that the whole curve is shaped as an inverted "U."[5] The trendline of Class 1 is positioned just before and touching the peak point of the inverted "U" curve, where the depletion percentage is 14.5% in 2019. Therefore, the depletion trendline in Class 1 will touch the maximum depletion percentage 14.5% and go down later.

Figure F



The interpretation of Pattern 2 might be dependent on industry trends and development during 2003 to 2019, which would require separate research. Therefore, no attempt at interpretation is provided here.

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[5] The associated function also reflects this shape—a quadratic polynomial expressed as $y = -0.0007x^2 + 0.0228x - 0.0406$, with the first coefficient (-0.0007) being negative. This negative first co-efficient determines that the curve shape is an inverted "U."

MULTICULTURALISM, MINORITY LANGUAGE RIGHTS, AND TRADEMARK LAW: PROTECTING THE LESS-THAN-AVERAGE CONSUMER*

*By Ilanah Fhima***

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I. INTRODUCTION

Trademarks and minority rights may not seem like natural bedfellows.[1] However, this article argues that our approach to which marks we register, and the scope of protection they are afforded, once registered, play an important role in recognizing minority interests as part of a multicultural society.[2] In particular, it is argued that trademark law's frequent recourse to seemingly neutral "one size fits all" approach to the average consumer fails to take into account the particular need of minorities. While trademark law may not deliberately treat minorities worse than consumers generally, it is argued that protecting minority interests requires us to go beyond treating everyone the same, with a view to eliminating inequalities that might otherwise occur from different starting points and pursuing goals of equality and a wider understanding of non-discrimination. In particular, this article focuses on the United Kingdom's treatment of languages other than the majority language, English. It examines empirically and qualitatively the extent to which the UK Trade Mark Registry (the "Registry") and courts consider the meaning of a language that may be unknown to the majority of consumers when assessing descriptiveness in particular, and in judging confusion and misappropriation-type actions. This involves considering whether tribunals consider knowledge of terminology and pre-existing uses that may be known only to a limited subset of consumers on national, religious, or ethnic grounds. These narrow but important questions have much to tell us about how minorities are treated.

Drawing on political philosophy, this article identifies the importance of *recognizing* the language of minorities both as an intrinsic value, and also as part of the achievement of a multicultural society. Moreover, on a practical level, if the law does not take into account minority language meanings, there is a risk that the very harms that trademark law seeks to prevent will be suffered by minority group members (and indeed wider society if the term might enter the English language in the future). For example, terms that can be understood descriptively, but only by a limited

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[1] Although there is some work in the United States on this issue. In particular, William Michael Schuster, Miriam Marcowitz-Bitton and Deborah R. Gerhardt have traced minority ownership of trademarks in *An Empirical Study of Gender and Race in Trademark Prosecution*, 94 S. Ca. L. Rev. 1407 (2022) and in terms of substantive trademark law Kevin J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 Syracuse L. Rev. 431 (2008).

[2] There is further work to be done on marks that are offensive to particular minorities, but that is for another article. This has been the subject of considerable attention in the United States in the light of the Supreme Court's ruling that the bar on the registration of offensive terms, including racial slurs, was unconstitutional in *Matal v. Tam*, 582 U.S. 218 (2017) and *Iancu v. Brunetti*, 588 U.S. 388 (2019). *See also* Vicki Huang, *Trademarks, Race and Slur Appropriation: An Inter-Disciplinary and Empirical Study*, U. Ill. L. Rev. 1605 (2021).

subset of consumers, could be monopolized by third parties, impairing the ability of minority group members to use their own language to describe competing goods. Likewise, a failure to take into account meanings and uses of terminology that are known to a limited subset of consumers runs that risk that these consumers will suffer confusion, if a third party uses a similar term.

This article analyzes the approach to minority languages adopted by the Registry. It identifies a seeming tension between trademark law and adequate protection for minorities: trademark principles are judged through the eyes of the average consumer, and yet an "average" (in the colloquial, numerical mean sense) member of the UK population is unlikely to be familiar with the meaning of terms in Tamil, Arabic, Gaelic, or indeed any language other than English. Should trademark law pay attention to words that are unfamiliar to most UK consumers, and if so, how? The law on this issue is unclear, and indeed it will be demonstrated that the fundamental lack of consistency regarding how we view the average consumer in trademark law gives cause for concern. In particular, prior case law that ruled that the "average consumer" is some form of hypothetical generalization of the characteristics of a UK consumer remains prevalent, even though more recent decisions have held that there is greater flexibility to take into account that the body of UK consumers is diverse in many ways. This research identifies both approaches at the appellate level and tracks how this filters down to Registry decisions. It is argued that having clarity in this area is important, not just for minority language speakers.

We speak about the "average consumer" as if this average consumer is a single unified entity, but the reality is that consumers, particularly of mass-market goods, vary in many ways including age, (dis)ability, education and literacy level, and socio-economic status as well as ethnocultural background, as discussed in this article. If such differences cannot be taken into account, then we are accepting the possibility of vulnerable consumers being confused. To be clear, there is no suggestion that any institution or individual involved in making trademark decisions intends to discriminate against minorities or otherwise treat them unfavorably. Rather, the article suggests that following the ethnoculturally and linguistically neutral logic of trademark law without giving thought to wider social consequences can unwittingly lead us to places we do not want to go.

Part II introduces why acknowledging the meaning of foreign languages in trademark law is important, both on a practical level, and from the perspective of political philosophy, where the importance of recognition has been identified. Part III identifies the different, and often conflicting characteristics that have been attributed to the average consumer in the case law. Part IV considers quantitatively and qualitatively the way in which the

Registry has treated foreign language terms, with a particular emphasis on the role of the average consumer in those determinations. Part V discusses a number of allied problems faced in recognizing the meaning of foreign language trademarks. Part VI concludes with some lessons to be learnt, both in relation to the treatment of foreign language marks and more generally in terms of how the average consumer is understood in trademark law.

II. WHY IS THE INTERFACE BETWEEN LANGUAGES AND TRADEMARKS IMPORTANT?

Language, and the meaning behind the terms embodied therein, are fundamental to trademarks. Acknowledging meaning not only prevents registration of descriptive terms (so that such terms remain free to enable communication) rather than falling into the hands of a single undertaking, but also forms the basis for the conceptual comparison of marks that shapes the scope of protection against confusion. Sidelining the meanings of marks (perhaps unintentionally) means tolerating speakers of minority languages being unable to use terms that are most suitable in their language to refer to products and other artifacts and concepts. It could also distort confusion findings where the non-English meaning of a mark is not duly taken into account when assessing a mark's distinctiveness and conceptual similarity. Moreover, on a societal level, there are strong reasons for recognizing and protecting minority languages based on equality, dignity, and recognition. This section will consider the trademark-based and the societal-based concerns in turn.

A. Trademark Law and Monopolization of Minority Languages

A trademark indicates the commercial origin of goods to consumers. This facilitates consumer choice by enabling consumers to make repeat purchases of goods they have previously enjoyed, or to select goods from trusted traders. At the same time, protecting marks enables proprietors to ensure that their investment in marketing their goods and services will be attributed back to them and will not be diverted to other traders.[3] Thus, the law grants exclusive rights to trademark owners to make use of their marks on the goods and/or services for which they are registered. The marks that are inherently best suited to this function are made-up terms or arbitrary words that have no direct connection to the goods. The

[3] William Landes & Richard Posner, *The Economics of Trademark Law*, 78 Trademark Rep. 267 (1988).

registration of descriptive or generic terms in particular is barred[4] in part because they do not lead consumers back to a single point of origin, but also because, in the interests of competition, other traders will need to use those terms in order to inform consumers about the characteristics of their goods or services.[5] Trademark law has long recognized that if a descriptive term is registered as a mark, a single undertaking will be able to exercise a degree of control over the underlying product market because the proprietor will be able to prevent others from using that mark to describe their goods in the most effective way. The same argument holds true for terms that are descriptive in minority languages. However, as will be argued in this article, to date the meaning of foreign terms has generally not been acknowledged in trademark decisions in the UK.

The most profound effect that discounting the meaning of foreign terms will have is on the minority group whose members will not be able to receive information in a familiar language on competing offerings.[6] It has also been argued that, if descriptive words are placed in the hands of a single undertaking, minority consumers familiar with that language may be deceived into believing that there is only one supplier of such goods in the jurisdiction in question.[7] As discussed below, while the size of these populations may be small as a percentage of the entire UK population, speakers of each foreign language often amount to hundreds of thousands of people. However, as Mr. Alexander KC, sitting as Appointed Person ("AP") has pointed out, the entire UK population is also potentially deprived if registration of minority

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4 Although consumers can learn to recognize descriptive terms as trademarks that indicate commercial origin through the doctrine of acquired distinctiveness under section 3 of the Trade Marks Act. Trade Marks Act, 1994, c. 26, § 3(1) (U.K.) ("TMA").

5 § 3(1)(c) TMA. The Court of Justice of the European Union ("CJEU") identified the public interest behind the ban on the registration of descriptive marks in *Windsurfing Chiemsee*. Joined Cases C-108/97 & 109/97, Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber & Franz Attenberger, ECLI:EU:C:1999:230, ¶ [26] (May 4, 1999).

6 Brauneis and Moerland also argue that traders from the jurisdiction whose language has not been recognized could also suffer if they are unable to export their goods bearing the original getup into the country where the descriptive term is a registered trademark, or otherwise they may have to invest in new packaging/branding. For example, if MATRATZEN is on the Spanish Trade Mark Register covering mattresses, then a German mattress maker might be unable to export mattresses bearing the descriptive term "Matratzen" into Spain. Consumers will ultimately lose out too, because fewer competing products will be on offer to them. *See* Robert Brauneis & Anke Moerland, *Monopolizing Matratzen in Malaga: The Mistreatment of Distinctiveness of Foreign Terms in EU and US Trademark Law*, GRUR Int. 1118 (2018).

7 Anne Gilson LaLonde, *Far from Fluent: Making Sense of the Doctrine of Foreign Equivalents*, 112 Trademark Rep. 771, 780 (2022), *adapted and reprinted from* Gilson on Trademarks with permission. Copyright © 2022.

descriptive words prevents the development of markets that may expand to offer products to the entire UK population.[8]

There are only a limited number of published Registry decisions (including Hearing Officer ("HO") and AP decisions[9]) that have considered whether descriptive foreign terms should be refused pursuant to the bar on the registration of descriptive marks contained in Section 3(1)(c) of the Trade Marks Act 1994 ("TMA"). While the low numbers may just reflect the fact that that few such applications are being made, it should be noted that, in general, most objections raised on absolute grounds are resolved between the applicant and the primary examiner, such that they do not require a hearing before an HO. Unfortunately, examination records are not easily accessible in the UK, so it is difficult to see how such applications are treated on a routine basis. However, based on an analysis of objections raised on relative grounds (i.e., where the owner of an earlier trademark objects to a later application because of a perceived conflict between the marks), it seems unlikely that many foreign-language descriptive marks will be refused on the basis of Section 3(1)(c) of the TMA. It is reasonable to presume that applications for this type of mark are being filed in the UK because there are examples of applications for purely descriptive terms in foreign languages taking place in other jurisdictions. For example, the Australian Trade Marks Manual identifies applications including the term "Australian beef" in Chinese characters for "beef" in Class 29 and "unlimited calls" in Arabic for "telecommunication services" in Class 38.[10]

As foreshadowed above, the majority of Registry decisions that have considered the meaning of foreign terms are relative grounds decisions. In particular, HOs and APs are asked to consider the impact that a foreign term included in one or both marks has on likelihood of confusion. Here, the conceptual analysis of the mark is particularly relevant. For example, one of the marks under consideration may include a foreign term and the other mark may include the equivalent English term, but unless the meaning of the foreign term is acknowledged, there is no conceptual similarity. Two

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8 O/224/16, *In re Elite Ocakbasi Restaurants Ltd.* [2016], ¶¶ [8]-[9] (UKIPO) [*BEST MANGAL*]. *See also* O/782/21, Qima Coffee Ltd v. The Cooperative Union of Yemeni Coffee Producers Ass'n [2021], ¶ [40] (UKIPO) (considering the arguable descriptiveness of a new coffee variety).

9 Parties to trademark proceedings can request that their dispute be heard by a senior examiner, known as a "Hearing Officer" if the issues therein cannot be resolved as the examination or opposition stages. *See Trade mark disputes resolution: hearings*, Gov.uk, www.gov.uk/guidance/trade-mark-disputes-resolution-hearings (last visited May 28, 2025). If the parties are dissatisfied after the hearing, then an appeal either to the civil court or to a senior lawyer, known as an "Appointed Person" is possible. *See id.*

10 IP Australia, Trade Marks Manual of Practice and Procedure, 22.11.2 (Dec. 19, 2022) [hereinafter Trade Marks Manual], https://manuals.ipaustralia.gov.au/trademark/11.-words-in-languages-other-than-english.

marks may even contain a term that is descriptive in a foreign language. While common use of a descriptive term is rarely decisive in a finding of similarity, where the descriptive term is in a foreign language, it will be at best neutral to similarity of marks.[11] This is seen in a decision involving the senior FRANGOS mark for "restaurant services," shown in Figure 1 and the junior FRANGO mark, shown in Figure 2, registered for the same services.

Figure 1

Figure 2

The word "frango" means "chicken" in Portuguese. However, because the HO found that the word would not be known to the average UK consumer, the word "FRANGO" was deemed "neither allusive nor descriptive" and therefore had a "high degree of inherent distinctive character." Although the chicken device and other verbal elements were of low distinctiveness, the prominence of the "highly distinctive" word "FRANGO"[12] in both marks was significant in the ultimate finding of likelihood of confusion.[13] In other words, the "foreignness" of the descriptive term makes a likelihood of confusion *more* likely, whereas, had the descriptive meaning of the word been acknowledged, the mark's level of distinctiveness would be low, reducing the likelihood of confusion. The result of the HO's approach is that descriptive foreign terms get an enhanced degree of protection (because they are viewed as meaningless in English), extending the penumbra of protection against third-party uses that will be viewed as confusingly similar, and therefore infringements.

An earlier example of this phenomenon can be seen in *KIAP MOU*, an early decision of the General Court of the EU ("GC").[14] The senior mark was MOU, registered in the UK for various food products including meat. The junior mark was KIAP MOU, applied

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11 This phenomenon is identified in Brauneis and Moerland. Brauneis & Moerland, *supra* note 6. *See also* Ilanah Fhima & Dev S. Gangjee, The Confusion Test in European Union Trade Mark Law 58-61 (2019).

12 O/558/19, Chadha v. Frango UKI Ltd. [2019], ¶ [52] (UKIPO).

13 *Id*. at ¶ [55].

14 Case T-286/02, Oriental Kitchen SARL v. OHIM, 2003 E.C.R. 311.

for as an EUTM also for food products. The proprietor of the MOU mark opposed the EUTM application, claiming a likelihood of confusion. The applicant countered that as "mou" means "pork" in Indochinese languages, the registration for MOU was, in fact, invalid for descriptiveness. The GC rejected the applicant's arguments because there was nothing to suggest that a "significant proportion" of the UK public for the foodstuffs in question would be familiar with Thai or Laotian.[15] Consequently, the term was distinctive and dominant in both marks, and its presence in both marks meant that there was a likelihood of confusion.[16]

Another UK example involves the word mark VIRUNDHU, which is Tamil for "feast" and was the mark of the senior user for restaurant and catering services. The senior user was able to prevent the registration of the mark ROYAL VIRUNDHU for a range of food and related services. Rather than being treated as a descriptive term, the word "VIRUNDHU" was seen as highly distinctive, and so the word "ROYAL," considered less distinctive, was insufficient to differentiate the two marks.[17] The HO acknowledged that there would be a small number of consumers who might not be confused because they would recognize the descriptive meaning of the term but concluded "the majority is more important in my assessment."[18]

It is not just the failure to recognize a descriptive term in a senior mark that spotlights problems. One decision involved a senior mark including the term "LAV." The junior application was for the word "LAVASH" combined with a device for restaurants and associated services, where "lavash" is a form of Armenian flatbread. However, this fact was not taken into consideration because "most consumers" in the UK would be unfamiliar with the word's meaning.[19] Ultimately the marks were too different to lead to likelihood of confusion, but taken to its logical conclusion, failure to recognize the descriptive meaning of the word "LAVASH" in the junior mark would mean the descriptive use defense[20] would not be

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15 *Id.* at ¶ [41].

16 Although the junior mark was also descriptive, as the term "KIAP" means "crispy," the marks were PORK versus CRISPY PORK. *Id.* at ¶ [16].

17 O/673/18, Virundhu Restaurant Limited v. Virundhu Ltd. [2018], ¶ [65] (UKIPO).

18 *Id.* at [66].

19 O/509/21, Gürok Turizm Ve Madencilik Anonim Sirketi v. Ozkahraman [2021], at ¶ [36]. *See also* O/112/21, Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi v. Gulener [2021] (UKIPO) (concerning the mark 46 MARAS DONDURMAYI ADIYLA ISTEYIN for ice cream where the words in the mark meant "mastic ice cream from Maras" in Turkish, with Maras being a town in Turkey).

20 *See* TMA § 11(2)(b) ("A registered trade mark is not infringed by— . . . the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services. . .".)

available if the term were used by a third party where there might otherwise be infringement.

Finally, one of the measures of whether two marks are similar enough to lead to a likelihood of confusion is their conceptual similarity. An unwillingness to recognize the meaning of foreign terms means that conceptual similarity may be overlooked, thus increasing the risk that two marks that minority consumers (who do understand the terms) would find confusingly similar would be registered. For example, where the earlier mark was SALAM (to use the terminology of the HO, an Islamic greeting) and the later mark was SALAAM (which would be understood by Arabic, Urdu, and Farsi speakers in the same way),[21] the HO found that while those marks would be meaningful to the minority groups, they would not be so understood by the average consumer.[22] Thus, there was no "conceptual hook" as the HO put it, meaning that no conceptual comparison was possible.[23] Consequently, minority language terms may be stripped of their meaning, as in so doing, on the measures of similarity of marks, making it more difficult to demonstrate likelihood of confusion in respect of those marks. This unfortunate outcome is particularly prominent in relation to non-Roman character words where, as discussed below, the marks are presumed meaningless because the average consumer cannot read Chinese, Cyrillic, Arabic, Hebrew, etc.

It should be noted that many of these decisions relate to applications filed by members of the minority group to whom the mark has a meaning. This does not diminish the competition concerns.[24] Whatever the background of the applicant, the lack of availability of what amounts to a descriptive term in the minority language remains the same and, by bringing the dispute before the Registry, the member(s) of the minority group have caused the Registry to become involved.

B. Recognition and Wider Societal Concerns

We have seen that failure to recognize the meaning of foreign terms, particularly descriptive terms, can significantly impact the availability of terms to other traders. This can limit competitors' ability to provide and reference competing goods to minority consumers, and indeed the market more generally. It can also lead to confusion among minority consumers. However, the effect of failing to recognize minority languages in trademark law is more profound. Indeed, in some instances, failure to recognize the

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21 O/311/19, Flying Trade Ltd. v. Salam Foods Ltd. [2019] (UKIPO) (*SALAM FOODS*).

22 *Id.* at ¶ [62].

23 *Id.* at ¶ [50].

24 Although this fact might counter concerns of cultural appropriation by those outside the minority group.

meaning of a minority language does not directly affect the scope of protection, but rather the problem is the mere failure to acknowledge that the term has a meaning to minorities.[25]

When looking at trademark law, it might be asked why speakers of minority languages should be given special rights. On one level, there is no equality problem, in the sense that all languages, and even non-verbal cues such as sounds, shapes, colors, etc. are treated the same: if the "average consumer" reads a meaning into the object or word in question, this will be recognized. If such an average consumer does not, then it will not. This, though, is a superficial approach. True equality is not achieved by treating everybody and everything the same. We need to look also to the outcome.[26] If minority consumers cannot benefit from protection against confusion, and if words that are descriptive in their languages can fall into the hands of a single undertaking, then it is difficult to say that trademark law provides them with the same protection as that afforded to solely English-speaking consumers. However, the normative argument for language recognition in trademark law goes beyond equality of outcome and into the realm of recognizing human dignity.

From a normative perspective, it is helpful to think briefly about how our society is structured. As Parekh[27] identifies, any society made up of two or more cultural communities must choose how to respond to this "cultural diversity." Some societies take a "monocultural" approach, expecting minorities to assimilate into the mainstream culture. However, other societies have adopted "multiculturalism," whereby they seek to "welcome and cherish" cultural diversity.[28] It is argued in this article that the multiculturalism approach better recognizes the needs of minority language groups.

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25 For example, where one sign but not the other has a non-descriptive conceptual element, such as a foreign language name and this is treated as meaningless as part of the conceptual comparison conducted in comparing marks for the purpose of judging likelihood of confusion.

26 *See* Sandra Fredman, *Discrimination Law* 16 (3d ed. 2022) ("[T]he equality principle goes beyond a demand for consistent treatment of likes and requires, instead, that the results be equal. The strength of this notion of equality lies in its recognition that apparently identical treatment can in practice reinforce inequality because of past or ongoing discrimination.").

27 Bhikhu Parekh, Rethinking Multiculturalism: Cultural Diversity and Political Theory 5-7 (2d ed. 2017).

28 More recently, an additional theory, interculturalism, has been put forward, involving increased emphasis on building links between multiculturalism's diverse groups (*see, e.g.*, Ricard Zapata-Barrero, *Interculturalism in the post-multiculturalism debate: A defence*, 5 (14) Comparative Migration Studies 1 (2017)). At the heart of this theory, though, remains the recognition and protection for the diverse cultural groups that engage in such a dialogue (*see, e.g.*, Christian Joppke, *War of words: interculturalism v. multiculturalism*, 6 (1) Comparative Migration Studies 1, 3 (2018).

What is needed for a society to be multicultural is contested. However, the building blocks of any multicultural society are, according to Song,[29] religion, ethnicity, language, nationality, and race as aspects of culture to be considered in this context. Thus, a key question in this area is the degree to which minority languages should be recognized. The leading theorist on the interplay between language rights and multiculturalism is Will Kymlicka, who writes against the background of the ongoing debate over the recognition of French language rights for the Quebecois in his native Canada.

1. Collective Rights for National and Ethnic Minorities

Kymlicka[30] argues for "group collective rights" to be shared by members of minority groups. He identifies two categories[31] of minorities.[32] National minorities include indigenous people and national groups such as the Quebecois in Canada or Puerto Ricans in the United States.[33] These groups are, according to Kymlicka, entitled to broader rights because their role in society arises from conquest and colonization, or from federation. On the other hand, migrants are entitled to lesser rights. He labels this category of people as benefitting from "polyethnic" rights.[34] Although such people require differentiated rights to maintain their cultures, their presence in the dominant nation is a matter of choice[35] and indeed the ultimate aim of migrants (says Kymlicka) is to integrate into the host nation.[36]

This difference in justification for minority rights leads to lesser rights for polyethnic groups than national minorities. According to Kymlicka, only national minorities are entitled to political "special group representation rights" and self-government However,

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29 Sarah Song, *The Subject of Multiculturalism: Culture, Religion, Language, Ethnicity, Nationality, and Race?*, *in* New Waves in Political Philosophy 183 (Boudewijn de Bruin & Christopher Zurn, eds. 2009), 177.

30 Will Kymlicka, Multicultural Citizenship: A Liberal Theory of Minority Rights (1996).

31 These categories are not uncontroversial. For example, Kymlicka himself acknowledges that he cannot fit those whom he calls "African-Americans" into his schema. This is because (according to his categorization) many did not come to the United States voluntarily, they were prevented from integrating, and they have no "homeland" in the United States and no common historical language. *See* Kymlicka, *supra* note 30, at 24; *see also* Adrian Favell, *Applied Political Philosophy at the Rubicon: Will Kymlicka's Multicultural Citizenship*, 1 Ethical Theory & Moral Prac. 255, 266-267 (1998).

32 Kymlicka focuses solely on national and ethnic minorities, though he notes that some of his arguments may apply to other "marginalized groups," giving the examples of "women, gays and lesbians, and the disabled." Kymlicka, *supra* note 30, at 18-19.

33 *Id.* at 29.

34 *Id.* at 30, 37-38.

35 *Id.* at 63.

36 *Id.* at 79. Controversially, he applies the same logic to refugees, even though it is difficult to argue that their choice of location is "voluntary." For our purposes, this is unimportant because Kymlicka advocates for language rights for both groups. *See id.*

"polyethnic rights" protect specific religious and cultural practices that would otherwise be unprotected[37] and are afforded to immigrant, ethnic, and religious groups. It is these rights that will most frequently apply in the trademark context.

We might question the importance of protecting language rights in particular. Kymlicka explains that group collective rights, including language rights, promote equality. He notes that "freedom of choice is dependent on social practices, cultural meanings and a shared language."[38] Further, he argues "Some groups are unfairly disadvantaged in the cultural marketplace and political recognition and support rectify this disadvantage."[39] He dismisses the alternative approach to multiculturalism, which he labels "benign neglect," where minorities are not afforded special rights. Benign neglect, he argues, is not neutral, because in the case of a language, to ignore that language "is almost inevitably condemning that language to ever-increasing marginalization."[40] In most, if not all, cases involving trademarks, the language rights we might argue for are likely to fall within Kymlicka's "polyethnic rights." Accepting the logic of Kymlicka's argument would mean that it is socially important to recognize the meaning of minority languages.

2. Why Language Rights?

In a world plagued by social, economic, religious, gender, and numerous other forms of inequality, we might question why language is so important to Kymlicka and other liberal thinkers. Kymlicka[41] highlights the role of language in establishing identity. In making this argument, Kymlicka draws heavily on the work of the importance of recognition. Indeed, in *Multicultural Citizenship*, Kymlicka highlights the importance of cultural identity, of which language is part, noting "people's self-respect is bound up with the esteem in which their national group is held. If a culture is not generally respected, then the dignity and self-respect of its members will also be threatened."[42] Thus, it is necessary to examine the role that language plays in that recognition.

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37 *Id.* at 37-38.

38 *Id.* at 126.

39 *Id.* at 108-109.

40 *Id.* at 111.

41 Alan Patten & Will Kymlicka, *Introduction: Language Rights and Political Theory: Context, Issues, and Approaches*, in Language Rights and Political Theory 14-15; 44-46 (Alan Patten & Will Kymlicka, eds. 2023). Kymlicka also stresses the importance of minorities maintaining their identity. *Supra* note 30, at 89-90 (citing Charles Taylor, *The Politics of Recognition*, *in* Multiculturalism: Examining the Politics of Recognition (Amy Gutmann, ed. 1994)).

42 Kymlicka, *supra* note 30, at 89.

3. Language and Recognition

Many states have an agreed "official" language or perhaps a number of such languages, in which official business is conducted. This privileges certain languages over others. Both Kymlicka and Song argue that this results in unfair treatment of the speakers of minority languages if their languages are not also recognized. Song argues that this conflicts with recognition of people's dignity and self-respect. Thus, Song identifies recognition of minority languages as having an important symbolic dimension, stating:

> Justice demands linguistic accommodations not simply in virtue of their effects on the distribution of minorities and opportunities, but also because the symbolic recognitions of minority languages is integral to treating linguistic minorities with equal dignity.[43]

In reaching this conclusion, Song draws on the work of Taylor, who describes recognitions as "not just a courtesy we owe people" but rather as a "vital human need."[44] Recognition, Taylor argues, shapes a person's identity, and so its absence can "inflict harm, can be a form of oppression, impressing someone in a false, distorted, and reduced mode of being."[45]

Taylor traces the origins of the importance of recognition to the development at the end of the 18th century of individualized identity, with "being in touch with our feelings" acting as a moral compass, telling us the right thing to do. This inner moral voice can be lost through pressure to outward conformity or false views of the self.[46] This, though, tells only part of the story, as human life is not purely monological and inward looking. Instead, it is dialogical. Taylor argues "We become full human agents, capable of understanding ourselves, and hence of defining our identity, through our acquisition of rich human languages of expression." Taylor takes "language" here in a wide sense, to include art, love, etc., but we might pause to reflect that language in the narrow sense of the term, as well as the concepts it represents, must play a vital role in such dialogue and in particular in intra-cultural interactions that shape who we are. Thus, the key role of recognition is "universally acknowledged" on the "social" as well as the intimate plane, on which the repercussions of legal decisions, including trademark law, would be felt.[47] Indeed, Taylor argues:

> Equal recognition is not just the appropriate mode for a healthy democratic society. Its refusal can inflict damage on those who

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43 Song, *supra* note 29, at 183.

44 Taylor, *supra* note 41, at 26.

45 *Id.* at 25.

46 *Id.* at 30-31.

47 *Id.* at 36.

> are denied it. . . . The projection of an inferior or demeaning image on another can actually distort and oppress, to the extent that the image is internalised.[48]

4. Implications of Recognition for Trademarks: Language Protects Culture

Thus, failure to acknowledge the meaning of trademarks in minority languages is not only an inconvenience for members of those minorities but also has a crucial symbolic value in recognizing the dignity and needs of the members of those minorities. To fail to recognize that meaning, even if it is not one that would be understood by those who do not speak those languages, plays a role in denying minority group members their identity on an individual level, and as full members of society. This is true even for "run-of-the-mill" terms, but how much more so must this be for terms of cultural significance. And yet we will see that there are examples of the Registry discounting the meaning[49] of cultural artifacts such as personal names,[50] place names,[51] names of cuisine,[52] and even religious practices[53] because they would not be known to the "average consumer" in the UK.

Here we should pause to note that recognition that a term has a meaning should not automatically result in refusal of the registration. A prominent example, for which the Registry received media criticism, was in relation to the registration of CARIAD for

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48 *Id.*

49 Generally, in the sense of treating the terms as invented words for the purposes of the comparison as part of the likelihood of confusion assessment under Section 5(2) of the TMA. As previously stated, there are few publicly accessible examination reports raising descriptiveness or lack of distinctiveness objections, under Sections 3(1)(b) or (c) of the TMA, to applications for foreign descriptive terms. However, the Registry's "Alphabetical List of Examination Practice" in the Manual of Trade Marks Practice states that "[t]here are no grounds for refusing registration of trade marks on the basis that they are descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question." UKIPO, Manual of Trade Marks Practice, The Examination Guide, pt. B (Jan. 2021 ed.), https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide [hereinafter The Examination Guide].

50 O/500/21, Animaccord Ltd. v. Popova [2021] (UKIPO) (discussing the name "Masha"); O/484/21, Mebarak v. Tayub [2021] (UKIPO) (discussing the names "Shakera" and "Shakira").

51 *See, e.g.*, O/704/18, Gima (UK) Ltd. v. Disa Foods Ltd. [2018] (UKIPO) (discussing the Turkish town Didim); O/112/21, Yasar Dondurma Ve Gida Maddeleri Anonim Sirketi v. Gulener [2021] (UKIPO) (discussing the Turkish town Maras).

52 *See., e.g.*, O/619/20, Famous Food Ltd. v. Rahman, Madbar, & Matin [2020] (UKIPO) (discussing the rice dish biryani).

53 *See., e.g.*, O/195/15, Pooja Sweets Ltd. v. Pooja Sweets & Savouries Ltd. [2015] (UKIPO) (*Pooja Sweets*) (discussing "pooja" foods used in Hindu ceremonies).

candles.[54] Recognition means acknowledging that the term is not an invented word but that it means "love" in Welsh, even though most UK consumers would be unfamiliar with the word. However, normal trademark principles should then apply. Thus, because the word "LOVE" is not descriptive of candles, the mark should proceed to registration, as this mark did. (Indeed, there is a registration for a mark for candles containing the English word "LOVE" on the UK Register.[55]) There is no need to prevent the registration of every meaningful or even allusive foreign term, and indeed to do so runs the risk of chilling the development of markets aimed at minority consumers wherein traders might want to use allusive terms to communicate with consumers. To impose such a rule also misunderstands the scope of trademark law, whereby registration does not prevent the use of a meaningful term in language—just in relation to the goods or services for which it is registered. However, the meaning of the term in question should be acknowledged.

5. Parallel Developments

What can be seen in the political philosophical writing reflects wider trends in the law's treatment of minorities. Taylor's vision of recognition as a vital human need shaped by identity finds a parallel in Fredman's vision of equality. In her monograph, *Discrimination Law*, she argues that equality is a "multidimensional principle," not limited to "treating likes alike."[56] One of those dimensions is equality as dignity.[57] This focusses on "[t]he value attached to individuals simply by virtue of their humanity."[58] It might therefore be argued that, if Taylor views recognition of language rights of minorities as essential to living as a human, failure to recognize such language rights would amount to inequality in a legal sense by failing to acknowledge the dignity of the users of minority languages.

Moreover, the logical endpoint of viewing language recognition as a component of humanity is for language rights to be treated as

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54 *See Cariad: Welsh word for love trademarked, sparking anger*, BBC (June 29, 2022), https://www.bbc.co.uk/news/uk-wales-61973267, although the applicant ultimately surrendered the mark, *see Cariad: Company drops plan to trademark Welsh word*, BBC (August 12, 2022), https://www.bbc.co.uk/news/uk-wales-62518455.

55 UK Trademark No. 00914525992, although technically this is a figurative mark, including some not particularly distinctive design elements.

56 Fredman, *supra* note 26, at 29. The parallel with Kymlicka's argument that group collective rights must, in the interests of equality, trump universalism is obvious.

57 *Id.* at 23.

58 *Id.* at 24.

a human right.[59] De Varennes argues that such rights do exist.[60] However, these are generally at the declaratory level, and do not yet translate into individual enforceable rights. Moreover, language rights as human rights exist at a high level of abstraction, and as Kymlicka notes, may often lack the detail to be successfully applied.[61] Even where specific rights are given, they focus on delivery of public services and judicial decisions, rather than content. Thus, the presence of such rights would seem to have little to say on how language should be treated as part of the substantive reasoning of a decision.[62] Therefore the legal instruments do not give a specific right on which recognition of minority languages in trademark law can be based. At the same time though, the existence of a (albeit outline) framework of protection for minority languages enhances the argument that language, and the ability to have one's use and understanding of one's language matters. Were concrete, detailed human rights in the use of language ever to be codified, this would raise the prospect of the ability of individuals to enforce their own personal right to have their language use and understanding recognized, which contrasts with a collective rights approach that might be particularly persuasive at the policy level.[63]

III. THE ROOT OF THE PROBLEM: UNDERSTANDING THE AVERAGE CONSUMER

The previous section examined the importance of not treating everyone the same and the legal and social importance of recognizing minority rights. It also identified how this serves as the basis for recognizing minority language rights in particular for both practical and normative reasons. Following from this is the need to acknowledge the meaning that foreign language terms have to members of minority groups, including in the decisions made by

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59 For the benefit of clarity, such positive rights to use one's own language and have that use recognized officially must be distinguished from the right to free speech, which is neutral to the content or medium of the speech, save where it is harmful.

60 Fernand de Varennes, *Language Rights as an Integral Part of Human Rights*, 3 Int'l J. Multicultural Societies 1 (2001). He has written in greater depth on this in Language, Minorities and Human Rights (1996).

61 It is worth noting that in Kymlicka, *supra* note 30, at 2-5, Kymlicka dismisses this approach because, in their universalism, human rights lack the detail to answer difficult questions pertaining to the application of minority rights. For example, free speech does not tell us what language that speech should take place in, and the right to vote does not tell us how to draw up boundaries that might ultimately determine self-government rights. Thus, in his view, human rights can only provide answers in association with a theory of minority rights. He notes further that while there have been attempts to create minority rights through international law, these are often vague and influenced by external factors.

62 Although in O/631/20, *In re MacKenzie* [2020] (UKIPO), at ¶ [29], the HO relied on The European Charter for Regional and Minority Languages.

63 de Varennes, *supra* note 60, at 16.

legal bodies, such as the Registry. This both enables minority group members access to those terms and to recognize the members' dignity as participants in society.

This section will consider the range of approaches applied by the courts as to who counts as the "average consumer" for the purposes of trademark law, and in particular whether a member of a minority can be viewed as a relevant consumer. If not, trademark law seems unable to take into account minority understandings of language, which would not protect the group minority rights that Kymlicka has advocated for. The definition of the average consumer has evolved in recent years, but elements of each of those approaches can be identified in the body of Registry decisions. It will be argued that the law has shifted, from treating everyone the same in the guise of a numerical or hypothetical average consumer, to a more nuanced approach that identifies multiple different groups of consumers whose perceptions are relevant provided those groups are "significant." However, this shift has not been linear and has not always been implemented in Registry decisions. Where it has, significance has been defined at a level that excludes almost all ethnocultural minority groups.

The difficulty is that trademark law works on averages. Almost every aspect of trademark law is calibrated through the eyes of the "average consumer." Averages tend to lead to generalizations and generalizations gloss over individual distinctions, which makes considerations of the needs of minorities difficult. Even though trademark law at the appellate level seems to have (mostly) rejected the need for numerical average, i.e., a majority of consumers, this has not always filtered through before the Registry. Moreover, looking for a "significant" number of consumers—the measure that stands in its place—is in a state of development. In particular, the fact that empirical evidence of consumer perception is not required in trademark cases has meant that the substitute measures also frequently draw on assumptions and generalizations. Even in cases where courts and tribunals have recognized that account can be taken of the perceptions of a minority of consumers *if* the number of such consumers is significant, there are no clear rules on what percentage or absolute number is "significant," and the CJEU, in particular, has been unwilling to give any specific figures. Finally, it is argued that percentages can be misleading in the absence of information about how large a population one is looking at. For example, 1% of the UK population might not sound like so much, but for an estimated population of around 68.0 million people,[64] this

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64 Off. for Nat'l Stat., United Kingdom population mid-year population estimate (Oct. 8, 2024), https://www.ons.gov.uk/peoplepopulationandcommunity/populationandmigration/populationestimates/timeseries/ukpop/pop.

equates to some 680,000 consumers[65] who might be confused, or blocked from using or receiving information about what to them is a descriptive term. In this section we will examine the judicial definition of who the average consumer is, and who is not.

A. The Statistically Average Consumer

The term "average" might suggest some form of statistical or empirical examination—perhaps gathering survey evidence and looking whether the majority of consumers in the sample are, for example, confused or view a mark as indicative of trade origin. This approach, though, has been rejected for a number of reasons.[66] For one thing, the CJEU has shown a repeated reluctance to set any percentage level in relation to the average consumer.[67] Obtaining such data would anyway be challenging: courts in the UK in particular have been skeptical of survey evidence[68] Moreover, when it comes to registration, marks can be registered without use, meaning that there is no evidence available regarding consumer perceptions of those marks, unless perhaps somewhat artificial surveys are conducted.

From the point of view of minority language rights, the rejection of defining the average consumer by reference to a numerical

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65 Although not all members of the population, e.g., small children, will engage with trademarks, it is still a large number.

66 *See* Hearst Holdings Inc. v. A.V.E.L.A. Inc. [2014] EWHC 439 (Ch), ¶ [60] (Justice Birss) (writing, "The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."); *see also* Jennifer Davis, *Revisiting the average consumer: an uncertain presence in European trade mark law*, Intell. Prop. Q. 15, 18 (2015); London Taxi Corp Ltd. v. Frazer-Nash Rsch. Ltd. [2017] EWCA Civ 1729 (*London Taxi*), ¶ [20] ("[T]he average consumer is not some form of mathematical average. Rather, the average consumer was "a notional person whose presumed expectations are to be taken into account by the national court in assessing the particular question it is called upon to decide.") (*citing* Interflora Inc. v. Marks & Spencer plc [2014] EWCA Civ 1403, ¶ [128]). Graeme Dinwoodie & Dev Gangjee, *The Image of the Consumer in European Trade Mark Law*, *in* The Image(s) of the Consumer in EU Law: Legislation, Free Movement and Competition Law (Dorota Leczykiewicz & Stephen Weatherill, eds., 2016), at 362 (citing James Mellor et al., Kerly's Law of Trade Mark and Trade Names, ¶ 20-02-h (15th ed. Supp. 2014) (suggesting the problem here is "linguistic" and that a better choice of language might have been a "reasonable" or "ordinary" consumer) (citing Jacob LJ in Reed Exec. Plc v. Reed Bus. Info. Ltd. [2004] EWCA Civ 159, ¶ [82]).

67 *See, e.g.*, *Windsurfing Chiemsee*, *supra* note 5, at [52], where in relation to acquired distinctiveness, the CJEU held that the perception had to be held by "the relevant class of persons, or at least a significant proportion thereof," but this could not be determined by "reference to general, abstract data such as predetermined percentages." In making this statement, the CJEU implicitly rejected a suggestion from the defendant that the perception had to be held by more than 50% of the relevant class of consumers. Likewise, in Case C-342/97, the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV* [1999] E.C.R. I-03819, ¶ [24], held that no set percentage of consumers could be predetermined for enhanced distinctiveness for likelihood of confusion purposes.

68 Dinwoodie & Gangjee, *supra* note 66, at 371-72; Fhima & Gangjee, *supra* note 11, at 186-87.

average is to be welcome. By definition, speakers of minority languages would never constitute the majority of consumers[69] and so could never satisfy such a test. A note of caution is required, though—while numerical measures may have fallen out of favor, it remains the case (discussed below) that the Registry does sometimes look for perception on the part of the "vast majority" of consumers. While the terminology used is not overtly empirical, even those with a basic grasp of math will realize that a majority is more than 50%—again, a standard that minorities will be unable to reach.

B. The Hypothetical Consumer

There has been some suggestion in UK jurisprudence that the average consumer may be hypothetical—deemed to have certain properties and constructed to fit the particular facts of the case. Davis identifies the roots of this approach in a neoclassical economic belief that inequalities of wealth and class had been eliminated. Thus, it was assumed that all consumers would act in broadly the same way.[70]

In *Whirlpool*, Geoffrey Hobbs KC, sitting as a Deputy Judge, observed that because the scope of protection of a trademark is a matter of law, some EU Member States have defined the average consumer as a "synthetic person with the 'correct' mindset and behaviour patterns."[71] Additionally, the CJEU has spoken of confusion being judged from the point of view of the average consumer who is "deemed to be reasonably well-informed and reasonably observant and circumspect."[72] Likewise, Davis observes that Lewison LJ in *Interflora I* seemed close to embracing the idea of the notional consumer.[73] Lewison LJ speaks of the average consumer as having the "underlying concept of a legal construct"[74]and notes:

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69 Except perhaps for when the goods are specifically aimed at a minority. We will see below that the Registry has been quite unwilling to class goods as aimed at minorities.

70 Davis, *supra* note 66; *see also* Jennifer Davis, *Locating the Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law*, Intell. Prop. Q. 183, 193-194 (2005). Davis goes on, though, in the remainder of the *Revisiting the average consumer* article, to review how that homogenous consumer has been put into question, and how this reflects challenges posed to neo-classical economics from behavioral economics, which focuses more on how consumers *actually* behave, rather than how the economically rational consumer would behave. Davis, *supra* note 66, at 21 onwards.

71 Whirlpool Corp v. Kenwood Ltd., [2008] EWHC 1930 (Ch), ¶ [70], although this approach is ultimately rejected.

72 *Lloyd Schuhfabrik*, *supra* note 67, at ¶ [26].

73 Davis, *supra* note 66, at 19.

74 Marks & Spencer plc v. Interflora Inc. [2012] EWCA Civ 1501 (*Interflora I*), ¶ [44].

> the ultimate issue [is] one for the judge, rather than the witnesses; but also that the judge can reach a conclusion in the absence of evidence from consumers. He or she is in the position of a notional juror, using his or her own common sense and experience of the world.[75]

Gangjee and Dinwoodie note that, while Lewison LJ's judgment has been viewed by some as a mere firming up of the UK courts' existing prejudices against survey evidence, in fact it is possible to read the case as a move toward what these authors call a "European approach."[76]

In theory, the notional or hypothetical consumer could be an opportunity for minority language rights. Like patent law's "person skilled in the art," who encounters no language barriers when it comes to understanding prior art documents[77] (even if it is to be found in an Australian library, and written in Sanskrit[78]), trademark law's average consumer could be deemed to have similar all-encompassing language skills. Indeed, when it comes to assessing the registrability on grounds of distinctiveness/ descriptiveness of EU trademarks, the meanings of terms in *all* EU languages are taken into account.[79] However, the CJEU has not taken the same approach to the average consumer in relation to national trademark registrations, where instead the average consumer has been imbued with the language skills of an average consumer in the Member State in question.[80] Once we revert to a more descriptive version of the average consumer who typifies the consumer base of the goods or services in question, it seems unlikely that the notional or hypothetical consumer in the UK would be deemed to have even a knowledge of EU languages, let alone non-EU minority languages.

Lewison LJ's approach in *Interflora I* has subsequently fallen out of favor. In *Interflora II*, Arnold J (as he then was) considered whether there was a "single meaning" rule in trademark law, that is, "a rule that the use of a sign in context is deemed to convey a single meaning in law even if it is in fact understood by different

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75 *Id.* at ¶ [50].

76 *See* Dinwoodie & Gangjee, *supra* note 66, at 375.

77 The Patents Act 1977, Section 3 (U.K.). This is a person who "is well acquainted with workshop technique and who has carefully read the relevant literature. He is supposed to have an unlimited capacity to assimilate the contents of what may be scores of patent specifications but to be incapable of scintilla of invention," per Lord Reid in *Technograph Printed Circuits Ltd. v. Mills & Rockley (Elecs.) Ltd.*, [1972] RPC 346, 355.

78 Admittedly a fanciful example, as per Jacob LJ *in* Green Lane Prods. Ltd. v. PMS Int'l Grp. plc [2008] EWCA Civ 358, ¶ [26].

79 Case T-236/12, Airbus SAS v. OHIM (NEO), ECLI: EU:T:2013:343, ¶¶ [34], [57] (July 3, 2013). *See* Dinwoodie & Gangjee, *supra* note 66, at 375.

80 Case C-421/04, Matratzen Concord AG v. Hukla Germany SA. [2006] E.C.R. I-2322, ¶¶ [22]-[26].

people in different ways."[81] Why this matters for our purposes is that a single, hypothetical consumer would be the most likely entity to embody the single meaning rule. The hypothetical consumer is presumably capable of holding only one view of whether, for example, two marks are confusingly similar, or a term is descriptive rather than distinctive of origin. As we have mentioned that hypothetical consumer is likely to typify an "average" UK member of the public, who is unlikely to be knowledgeable about foreign languages. In this sense, she is descriptive rather than normative.[82] Although, as discussed in the next subsection, the approach seems to have been rejected in subsequent cases, including by the Supreme Court,[83] it will be seen below that this notional or average consumer with little knowledge of languages is alive and well in very many Registry decisions.

C. Cutting Up Consumers: The Role of "Significance"

The hypothetical consumer and his single understanding of the meaning of trademarks has found little support subsequent to *Interflora I*. When *Interflora* returned to the High Court, as a matter of precedent it was not open to Arnold J to depart from Lewison LJ's decision. Instead, he offered various reasons why Lewison LJ's judgment, while seeming to introduce a single meaning rule, does not do so, including consistency with the approach taken to validity and the approach taken by prior CJEU case law.

Even though Arnold J technically followed Lewison LJ's ruling, there is a clear tension between the two visions of the average consumer. Thus, when Arnold J's judgment in *Interflora II (HC)* was appealed, this left the Court of Appeal with a difficult task. While the Court of Appeal in *Interflora II (CoA)* seemed to have sympathy with Arnold J's rejection of marks being understood through the single meaning that they have to a single hypothetical average consumer, the doctrine of *stare decisis* meant that the Court was bound by the *Interflora I* Court of Appeal's decision.[84] In *Interflora II (CoA)*, the Court of Appeal resolved the issue by finding that there was no real difference between judging trademark matters through the eyes of a single, hypothetical consumer, or, if the hypothetical consumer "provides the benchmark or threshold for the purposes of identifying the population of internet users whose views are material."[85]

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81 Interflora Inc. v. Marks & Spencer plc [2013] EWHC 273 (Ch) (*Interflora II (HC)*), ¶ [212].

82 Dinwoodie & Gangjee, *supra* note 66; John Gardner, *The Many Faces of the Reasonable Person*, 131 L.Q. Rev. 563 (2015).

83 *In* Lifestyle Equities CV v. Amazon UK Servs. Ltd. [2024] UKSC 8.

84 Interflora Inc. v. Marks and Spencer plc [2014] EWCA Civ 1403 (*Interflora II (CoA)*).

85 *Id.* at ¶ [126].

The difficulty is that in *Interflora II*, the Court of Appeal then seems to revert to a more numerically based approach.[86] It finds there will be confusion where the junior use "is likely to cause at least *a significant section of the target public* to establish a link between the goods or services to which it refers and the trade mark owner" [emphasis added].[87] In identifying this standard, the Court highlights the many instances where the CJEU has referred to a "significant" number or proportion of consumers, including in relation to whether consumers would link marks for the purposes of establishing confusion,[88] whether they would be confused in an Internet context,[89] whether they would view a mark as descriptive,[90] or lacking distinctiveness,[91] in relation to comparative advertising[92] and consumer protection.[93] This raises a further question: what makes any one section of the public significant? Earlier, speaking in relation to the consumer law case[94] from which the CJEU "borrowed" the definition of the average consumer, the Court notes "absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use."[95] In seeking a set percentage that will render a group of consumers "significant," the Court of Appeal seems to be reverted to a *de facto* numerical approach, albeit not one that requires the majority of consumers to share the perception.

There is a lack of clarity in the Court of Appeal's approach to which consumers are *not* average in this and subsequent cases: is it those consumers who are so few in number that they are not considered "significant" or is it those whose perceptions of a mark are not "reasonable" (presumably because they are not sufficiently knowledgeable, observant, or circumspect or have these qualities in

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86 The Court's use of both the hypothetical consumer and a more empirical approach is identified in Davis, *supra* note 66, at 20.

87 *Interflora II (CoA)*, *supra* note 84, at [126].

88 *Id.* Note that confusion was relevant as the means for prejudicing the essential function of the earlier mark for double identity purposes.

89 *Id.* at ¶ [120] (citing *Lloyd Schuhfabrik*, *supra* note 67).

90 *Id.* at ¶¶ [86]-[88] (citing Case C-278/08, Die BergSpechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v. Günther Guni and trekking.at Reisen GmbH [2010] E.C.R. I-2517).

91 *Id.* at ¶ [119] (citing *Windsurfing Chiemsee*, *supra* note 5).

92 *Id.* at ¶ [121] (citing Case C-299/99, Koninklijke Philips Electronics NV v. Remington Consumer Prods. Ltd. [2002] E.C.R. I-5475).

93 *Id.* at ¶ [124] (citing Case C-356/04, Lidl Belgium GmbH & Co. KG v. Etablissementen Franz Colruyt NV [2006] E.C.R. I-8501).

94 *Id.* at ¶¶ [117]-[118] (citing Case C-210/96, Gut Springenheide GmbH v. Oberkreisdirektor des Kreises Steinfurt, [1998] E.C.R. I-4657).

95 *Id.* at ¶ [118].

excess) and therefore do not accord with those of the average consumer? In any event, unless our hypothetical average consumer is normative in the sense of having a desirable judicially set level of knowledge etc., the two approaches merge into one because what is reasonable depends on the typical reactions of consumers in the specific market in question. This then becomes a fact-specific question in each case, meaning that what is not reasonable will be judged by likely responses of groups of consumers of that particular product, bringing us back to an approach based on percentages of groups of consumers. Indeed, we will see that even in those decisions of the Registry where the focus has been on a "significant" number of consumers, rather than a hypothetical consumer, frequently a numerical approach has been taken to what is significant.

The lack of clarity in the *Interflora II (CoA)* approach can be tracked in subsequent Court of Appeal decisions. In its summary of the characteristics of the average consumer in *GLEE*, the Court both endorsed the idea of the average consumer as "a hypothetical person or, as he has been called, a legal construct" but at the same time found that infringement should be found where "a significant proportion of the relevant public is likely to be confused."[96] A more cautious approach was taken by the Court of Appeal in *Muzmatch*,[97] where the Court noted that consumers have a spread of characteristics, but nonetheless recognized a role for the "hypothetical consumer" to exclude those consumers with atypical characteristics such as greater or less knowledge than the norm or who would pay more or less attention than is usual.

More recently there are signs of a shift in how significance is understood. One notable example is the Supreme Court's judgment in *Amazon v. Lifestyle*,[98] a case concerning whether the "average consumer" would consider a website based in the United States to be "targeting" UK consumers, and so to fall within the reach of UK trademark law. In their co-authored judgment Lord Briggs and Lord Kitchin find:

> The adoption [in this case] of the average consumer does not require the court to attempt to identify a "single meaning" of the activity in issue—it is enough that a significant proportion of the relevant consumers (that is to say, those who are reasonably well informed and circumspect) would consider the website to be directed and targeted at them.[99]

Clearly this decision adopts the "significance" approach over single meaning. Perhaps surprisingly the Supreme Court does so with

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96 Comic Enters. Ltd v. Twentieth Century Fox Film Corp. [2016] EWCA Civ 41 (*GLEE*), ¶ [34].

97 Match Group LLC v. Muzmatch Ltd. [2023] EWCA Civ 454.

98 Lifestyle Equities CV v. Amazon UK Servs. Ltd., *supra*, note 83.

99 *Id.* at ¶ [31].

little comment on the uncertainty in this area following the various *Interflora* cases. Moreover, it does not explain *how* it can be determined whether the mark has the argued-for impact on a significant number of consumers. Indeed, the Supreme Court details a number of facts pointing to targeting UK consumers, but these seem to be presented as objective facts,[100] arguably echoing the perceptions of a hypothetical consumer. No doubt the Supreme Court intended to move away from such a construct, but this decision demonstrates once again that unless there is a clear understanding of how significance can be understood it tends to default into a numerical test or even based on hypothetical groups or the majority.

Most recently, a more nuanced approach seems to be taken in *Lidl v. Tesco*.[101] There Arnold LJ (as he now is) with whom Lewison LJ (perhaps surprisingly given his stance in *Interflora I*) agreed, rejected both numerical and hypothetical visions of the average consumer, stating:

> the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test.[102]

Instead "They[103] represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group." Consequently, there may be a finding of infringement where some consumers are confused, even when the "average" consumer (who presumably typifies the numerical majority of consumers) is not confused. This decision makes clear the potential inherent in the "significance" test: it is able to take into account the perceptions of minority groups, and while Arnold LJ does not mention this specifically, there is no reason why this should not include minority language groups. It also raises the prospect of confusion among such a minority leading to a finding of infringement that would prevent the registration of the mark for all consumers. Presumably the same would be true if a minority perceived such a mark to be, for example, descriptive. What Arnold LJ does not make clear is what amounts to a "significant" proportion. As we will see, the Registry sometimes

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100 *Id.* at ¶¶ [71]-[73]. On the website in question, the landing page noticed delivery to the UK, a pop-up box said consumers would be shown only goods available for delivery to the UK, the "review your order" page included UK specific delivery times and prices, and the site offered the ability to pay in sterling coupled with an exchange rate.

101 Lidl Great Britain Ltd v. Tesco Stores Ltd. [2024] EWCA Civ 262. Note that the roots of this approach can be seen in *London Taxi*, *supra* note 66, at [31]-[35], where the Court of Appeal allows for the possibility of different classes of consumer, some confused and some not, based on whether they are purchasers or end users.

102 *Lidl*, *supra* note 101 at ¶ [17].

103 From the context, it appears that this is a non-gendered reference to the legal notion of an average consumer.

rejected minority language perceptions as irrelevant on the basis that the speakers of that language do not amount to a "significant" proportion of the UK population. There is reason, though, to be hopeful that a different approach might be taken in decisions following *Lidl v. Tesco*, both because Arnold LJ rejected the idea of a statistical test, but also because of his explicit emphasis of the perceptions of minority groups. While *Lidl v. Tesco* was decided after the period of the study, and so cannot have directly influenced the decisions included, the beginnings of such an approach can be seen in certain Registry decisions that will be detailed below.

To sum up, there has been a gradual, sometimes halting, move in the case law from looking at a single hypothetical consumer to searching for a perception shared by a "significant" number of consumers. Whether the "significant proportion" measure of the average consumer promotes recognition of minority language speakers" depends very much on what amounts to a "significant" section, given that:

(i) in numerical terms the number of foreign language speakers varies greatly, depending on the language;

(ii) in percentage terms compared to the general population of the UK speakers of foreign languages will often be small in number, but in absolute terms, they may well amount to hundreds of thousands or even millions; and

(iii) significance need not be understood as a numerical measure, and may instead be a measure of how we value such people and their understanding and perceptions.

As will be seen, though, in the decisions studied, significance is often treated as a numerical measure, rather than a measure of importance or value, leading to very limited recognition of minority languages.

IV. APPROACHES TO AVERAGE BEFORE THE TRADEMARK REGISTRY

The lack of clarity in the case law and the frequent implicit reliance on numerical measures has, unsurprisingly, led to inconsistency in how cases involving foreign languages that will be understood only by a minority of consumers have been treated by the Registry. This section will consider how the average consumer has been defined in practice by the Registry, focusing particularly on cases involving minority languages. To gather this information, a quantitative and qualitative analysis of the 2731 decisions of HOs and APs[104] made available on the Registry website over a recent six-

[104] Hearing Officer and Appointed Person decisions were selected as the sample because they are made publicly available at https://www.ipo.gov.uk/t-challenge-decision-results.htm. Ideally, I would have also examined the file histories of all applications for

year period was conducted. Of these, 203 pertained to trademarks with foreign language components.[105] In sum, during the period between January 1, 2018, and December 31, 2023, no less than eight different approaches were identified in the decisions to the level of understanding of foreign terms required on the part of the average consumer for that understanding to be legally cognizable. It is argued that the presence of this number of conflicting definitions of the average consumer points to a lack of clarity and consistency, not just in relation to how the meanings of foreign languages are determined, but also as to how the average consumer is understood more generally. The research also revealed different approaches were applied to cases involving the same language, and that individual HOs and APs typically adopted a number of different approaches in the cases that came before them.

A. The Approaches

The eight approaches identified are:

1. Those that relied on the notion of the "average" consumer without defining the characteristics of that consumer;
2. Those that required the perception to be held by the "vast majority" of UK consumers;
3. those that required the meaning of the term in question to be immediately recollected by consumers;
4. Those that focused on foreign terms that would be familiar to UK consumers;
5. Those that, while relying on the notion of the average consumer, allowed for this to be viewed in terms of the perceptions of a "significant" proportion of consumers rather than the majority of consumers;
6. Those that allowed for a range of consumers with different understanding of the terms in question; and
7. Those that focused less on the understanding of consumers, and more on whether there was a competition-based need to keep certain foreign terms free for other traders to use.
8. Other approaches, including those where insufficient evidence was provided and so no conclusion could be reached

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non-English language terms. However, unlike the EUIPO and USPTO, file histories are not made available to view via the Registry website, but must be requested individually; also, file histories are not available for applications that have been refused or withdrawn (perhaps because refusal is anticipated) prior to publication.

105 The Registry does not identify which decisions involve foreign languages. Therefore, research assistants read all of the decisions and identified those involving foreign languages. I then read those decisions and coded them for the different approaches that I identified.

on the validity of the foreign meaning and those involving Scottish and Welsh language marks.

There did not seem to be a clear chronological progression between the approaches, with each of the approaches used at various points across the five-year period.

This inconsistency between approaches is, to an extent, unsurprising since, as discussed above, until recently there was a lack of clarity in how the average consumer is defined generally.[106] Consequently, decision-makers have often reverted to earlier definitions of the average consumer that have fallen out of favor with the higher courts. Even where they have focused on identifying significant numbers of consumers (where the majority may not share the perception question), a lack of clarity over when a proportion is "significant" has generally resulted in minority perceptions being rejected out of hand. However, we will also see that a more subtle approach is in evidence, which, while recognizing that minority perceptions are not the norm, takes these into account as a *minority but significant* part of a diverse group of consumers whose perceptions need to be considered in analyzing trademark questions, because they represent a relevant part of the market for the goods and services in question. This approach would seem closest to Kymlicka's notion of recognizing minority interests in languages that is lacking in those approaches that treat the meaning of minority languages as not legally cognizable. Finally, we will see that other considerations, such as the more general need to keep marks free in the interests of *all* consumers, have also occasionally come into play. The normative basis for this approach is different from Kymlicka et al.'s because it focuses on the interests of wider society (not those of the minority), but it nonetheless has the capacity in terms of effect to limit the registration or scope of protection of minority language terms.

This section will log the prevalence of each approach and consider its implications for recognition of foreign languages in trademark law with a view to drawing wider conclusions in the final section about the nature of the average consumer.

1. Just Average

In the period studied, 36.45% (74) of the language decisions identified[107] considered whether the average consumer understands

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106 Note also that APs are not bound by each other's decisions, which also leaves room for diverging approaches. Manual of Trade Marks Practice, Tribunal Section § 1.2 (Feb. 2003), http://www.gov.uk/guidance/trade-marks-manual/tribunal-section.

107 *See, e.g.*, O/839/21, Beaupreau v. Yuk Fong Jay Lee [2021], at ¶ [67] (UKIPO) ("I do not consider 'méduse' [the French word for jellyfish] to be a common word that will be understood by the average consumer in the UK."); O/342/20, Gehlot v. Nessa Skincare Ltd. [2020], at ¶ [40] (UKIPO) ("I agree with the applicant that there is no evidence to support the view that the average consumer—who is a member of the UK general

the meaning of the foreign term in question, but without actually attempting to define the characteristics of that average consumer. It should be noted that while the prevalence of this approach reduced over the period of the study as the definition of the average consumer offered by the courts became clearer, it still played some role in the later years of the study.[108] It is difficult to comment on the precise impact this approach has on minority rights because it is unclear what is needed to satisfy it, though it often seems to be shorthand for a numerical majority that does not understand the language, which I comment on below.

2. The Vast Majority of UK Consumers

Given the repeated judicial statements that the understanding of the "average consumer" does not equate to the knowledge of the majority of consumers, it is perhaps surprising to see that in more than 10% of language decisions,[109] HOs have discounted the meaning of a foreign term because it is "not widely known," nor is it known by a "vast majority of consumers" or by "most consumers." Such decisions were split relatively evenly over the period of the study and, in fact, were more common in the final year of the study.[110] Terms that were found to be meaningless in this way include:

- LOS AMANTES—Spanish for "the lovers" would not be known by the "vast majority" of UK consumers;[111]
- GATO NEGRO—Spanish for black cat ("it cannot be assumed that a 'majority' of consumers are familiar with Spanish");[112]
- ALMA LIBRE—UK consumers would not recognize the woman's name ALMA, nor would the "vast majority of

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public—would know this"); *Qima Coffee Ltd.*, *supra* note 8, at ¶ [40]; O/486/21, ELORA v. Rahardjo [2021], at ¶ [34] (UKIPO); O/620/22, Organizacion Nacional De Ciegos Espanoles v. La Fed Mgmt. Co. Ltd. [2022], at [51]-[52] (UKIPO); O/440/20, Bodegas Martin Codax SA v. Carballido [2020], at ¶ [58] (UKIPO) ("To my mind, it is more reasonable to find that the average consumer would perceive this word as an invented term."); O/331/20, Fabi S.p.A. v. Amazon Europe Core S.à r.l. [2020], at ¶ [68] ("[I]n my view, it is more likely that the average consumer of the category of goods in question will see it as an invented word."); O/679/19, Sfera Joven, S.A. v. Krause [2019], at ¶ [27] (UKIPO) ("It does not seem to me that knowledge of a foreign language can be assumed for the average consumer.").

108 The high point was 52.72% of language decisions in 2019, going down to 20% by 2023.

109 10.34% (21).

110 2018—3.7%; 2019—10.34%; 2020—11.20%; 2021—6.82%; 2022—11.11%; 2023—17.4%).

111 O/440/20, *supra* note 107, at ¶ [58], though ultimately this did not affect a finding of likelihood of confusion because the senior mark also consisted of the words LOS AMANTES.

112 O/774/21, Vina San Pedro Tarapaca S.A. v. Grape Passions Ltd. [2021], ¶ [35] (UKIPO).

consumers in the UK" recognize that LIBRE means "free" in a number of European languages;[113]

- KOCCA and KOKKA—while (supposedly) pronounced differently in Italian would be pronounced in the same way by the vast majority of UK consumers;[114]
- LAVASH—although this is an Armenian flatbread, "most consumers" would see it as a meaningless term;[115]
- VIRUNHDHU—a Tamil term for "feast"; while this might be known to a "small group of consumers", this was discounted because it was not known to the "vast majority of UK consumers;[116]
- MEVLANA—the name of a Turkish saint that would have no meaning to the "majority" of UK consumers, even though it might be recognized by "some within the Turkish community."[117]

It is difficult to disagree with the finding that most UK consumers would not recognize these terms. In many of these cases, it is also difficult to see the competitive harm that would result from the lack of recognition (though the argument based on the loss of dignity for minorities whose language is not recognized remains). For example, in relation to the LES AMANTES mark, the term "THE LOVERS" would be equally distinctive for wine and beverages whether in English or Spanish, and because the marks were identical, confusion was anyway bound to result. However, as discussed earlier, failure to recognize LAVASH and VIRHINDU means that descriptive words would potentially fall into the hands of a single undertaking, thereby blocking competitors from using these terms in a descriptive way to communicate to those communities that would understand the term.

There is also the symbolic significance of an approach that subjugates the knowledge of minority communities to the "vast" or "overwhelming" majority of UK consumers, even if that subjugation is driven solely by an (attempted) adherence to trademark law principles rather than anything more sinister or deliberate. However, this approach would seem to be incorrect even in trademark terms given the repeated statements that the "average" consumer is neither a numerical average, nor a majority, and that instead a "significant" number of consumers can be less than 50%.

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113 O/254/20, FFI Global S.R.L. v. Kamara [2020], ¶ [28] (UKIPO). Interestingly there was no discussion of the meaning of this compositive phrase as "free soul."

114 O/904/22, KOCCA S.R.L. v. KOKKA Co., Ltd. [2022], ¶¶ [47]-[48] (UKIPO).

115 O/509/21, *supra* note 19, ¶ [36].

116 O/673/18, *supra* note 17, ¶ [65].

117 O/544/22, GORAN-TEE Grobhandel GmbH & Co. KG v. Mevlana Ceylon Tea (Pvt) Ltd. [2022], ¶ [56] (UKIPO).

3. Immediate Recollection

The approach of the AP in *CHEROKEE* was utilized in 6.90% (14) of decisions. The question in that decision was whether the "general public" would be aware that the word CHEROKEE was the name of a Native American tribe, where no evidence had been submitted on this point. The AP held that while this clearly was the meaning of the term in an objective sense, and so judicial notice could be taken of it, this did not mean that the *average consumer* was aware of this meaning.[118] Thus, absent evidence not just as to the objective meaning of the term, but also to the average consumers' understanding of it—unless that level of understanding was "too notorious to be the subject of serious dispute"—it had to be assumed that the average consumer would not understand the term.[119]

This presumption that consumers do not hold knowledge, unless that knowledge is "notorious" sets the bar high. In its application to foreign language cases, this has meant that when this test is applied it is almost always the case that consumers will be assumed *not* to understand the foreign language term. In fact, the *CHEROKEE* test was satisfied only once in the six-year period studied, in relation to the term "BELLISIMO."[120] The *CHEROKEE* test also seems to adopt a homogenous approach to the average consumer. There is no discussion of how different consumers might have different degrees of knowledge. Instead, notoriety suggests knowledge so obvious that it would be held by all—in other words, bringing us back to the vast majority of consumers, rather than allowing for the possibility that there may be legally cognizable groups of consumers who recognize the meaning of a term, even if most consumers do not.

It is also possible to see a subset of the *CHEROKEE* test in operation in a number of the decisions. The HO's decision in *CHEROKEE*, which was ultimately overturned by the AP (discussed above), spoke of the meaning of a potentially obscure mark being admissible where it can be "grasped immediately."[121] This too sets the bar high. Like the AP's approach in the same case, it is rooted in an abstract view of how consumers will understand a mark, and like the AP's approach, it would seem to demand a very high level of knowledge and obviousness for the term to be understood without thought or reflection inherent in the term "immediately." Again, no term subject to this test satisfied it. In

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118 O/048/08, Cherokee Inc. v. Chorkee Ltd. [2008], ¶¶ [37]-[38] (UKIPO).

119 *Id.* at [36].

120 O/237/19, Bellisimos Academy Ltd. v. Rigney [2019], ¶¶ [34]-[35] (UKIPO) (*BELLISIMO STUDIO*).

121 O/251/07, Cherokee Inc. v. Chorkee Ltd. [2007], ¶ [35] (UKIPO).

short, both iterations of the *CHEROKEE* test make it almost impossible for minority consumers" languages to be cognized.

4. Well-Known Foreign Terms Familiar to a Significant Number of UK Consumers

There are certain foreign terms that HOs have found *would* be familiar to a significant number of UK consumers.[122] These account for 11.33% (23) of foreign language decisions. However, the rationale for this is not based on recognition of minority groups speaking the language but rather, following *Matratzen*, that while descriptive foreign terms would not automatically be rejected, they would be if "the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term."[123] In *Matratzen* this meant that "MATRATZEN," the German term for "mattresses" was considered distinctive for "mattresses" because the average Spanish consumer would not be familiar with the meaning of the word.[124]

Thus, the basis for acknowledging the meaning of foreign terms in this line of decisions is that the average *English-speaking* UK consumer would be familiar with certain foreign language terms. However, UK consumers' foreign language skills are generally thought to be weak. Perhaps this is best summed up by HO Salthouse's pithy observation:

> few UK consumers have any knowledge of languages other than English, and most are not overly proficient even in their mother tongue.[125]

Thus, the words that English-speaking consumers have been found likely to recognize are either rather basic, similar to the same word in English, or would be familiar from wider cultural experiences and encounters with in particular foreign foodstuffs available in the UK. These include:

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122 Similarly, the Registry Manual of trademark practice allows for the possibility that in respect of the most widely understood European languages in the UK (i.e., French, Spanish, Italian, and German), "most" UK consumers "have an appreciation of some of their more common words," *see* The Examination Guide, *supra* note 49, under the headings "The Most Commonly Understood European Languages," "Non-English Words which resemble English Descriptive Words," "Further Considerations which apply to Non-English Descriptive Marks for Services," and "Non-English Words which have become customary in the Current Language or in the Bona Fide and Established Practices of the Trade."

123 Matratzen, *supra* note 80, ¶ [26].

124 *See id.*

125 O/418/21, Restaurant Grp. (UK) Ltd. v. Ahm Lifestyles—Creative Hospitality Co. Ltd. [2021], ¶ [26]. *See also* O/352/19, Felix Solis Avantis UK Ltd. v. Consorzio Priogrigio [2019], ¶ [29] (describing UK consumers as "notoriously monolingual").

- **French:** LES[126] and LA[127]
- **Spanish**: AMIGOS[128]; MAESTRO[129]; OLIVA[130]; CASTELL[131]
- **Italian**: CIAO[132]
- **Mexican**: TACO[133]
- **Greek**: GYROS[134]
- **Hindu/Urdu**: CHAI and PAANI[135]
- **Turkish:** BODRUM;[136] CHOCCO[137]
- **Arabic:** SHAKIRA (seemingly from the pop star of the same name since confusion was found to be particularly likely in relation to entertainment services).[138]

Even though this approach does lead to the recognition of some foreign language terms, it focusses not on minorities, and how they might understand language, but rather on how these terms would be understood to the majority UK population as a whole. Thus, both in terms of the very basic terms that are recognized, and the rationale behind the recognition, this cannot be seen to provide meaningful recognition of minority language rights.

5. A "Significant Proportion" of UK Consumers

The approach taken by both the CJEU and the Court of Appeal in *Interflora II* when considering a mark that is in a foreign language or has an obscure meaning is to ask whether a particular perception of the mark is shared by a "significant proportion of the

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126 O/887/22, Chanel Ltd v. AYA Design Grp. Ltd. [2022], ¶ [34] (*LES BOYS*) (UKIPO).

127 O/839/21, *supra* note 107, ¶ [67] (finding that the "meduse" element in the LA MEDUSE mark was not considered to be familiar).

128 O/335/19, Selection Diffusion Ventes v. Sepco Europe Ltd. [2019], ¶ [33] (UKIPO) (*EL AMIGOS*).

129 O/890/22, Olive Line Int'l, S.L. v. Aceitunas y Encurtidos Artesanos de Navarra S.A. [2022], ¶ [95] (UKIPO) (*MAESTROS ACEITUNEROS DESDE* 1968).

130 *Id.* at ¶ [96].

131 O/475/20, Faber-Castell Aktiengesellschaft v. Castelli (Diaries) Ltd. [2020], ¶ [87] (UKIPO) (*CASTELLI*).

132 O/873/21, LMSJ Ltd. v. MCJB Enters. Ltd. [2021], ¶ [57] (UKIPO) (*CIAO BELLISIMA*).

133 O/307/20, Taqueria Worldwide Ltd. v. W. A. Essex Ltd. [2020], ¶ [72] (UKIPO) (*TACO RIA*). Of course, this is an example of a national cultural phenomenon and Mexican is not a language.

134 O/1102/22, Bromhead Johnson LLP v. Rhodes EA Ltd. [2022], ¶ [18] (UKIPO) (*GYROS*).

135 O/858/21, Chai Paani Ltd. v. Ahmed [2021], ¶ [26] (UKIPO) (*CHAYEE PAANI LOVE AT FIRST SIP*). Hindu and Urdu are the terms used by the HO to describe the origins of the word "paani."

136 O/704/18, *supra* note 51, ¶ [70].

137 O/634/18, Yadex Int'l GbmH v. Şölen Çikolata Gida Sanayi Ve Ticaret Anonim Şirketi [2018], ¶ [32] (*CHOCO DAN'S*).

138 O/484/21, *supra* note 50, ¶ [60] (*SHAKERA*).

public." This was the approach taken by the GC in the *KIAP MOU* case, described above, in a decision specifically involving foreign language trademarks. There it was held that there was nothing to suggest that a significant proportion of the UK public understood Thai or Laotian, and so the average UK consumer would not recognize MOU as descriptive of pork in those languages.[139]

This approach is adopted in 12.32% (25) of Registry decisions. In itself, the term "significant" does not tell us much. We assume that it is less than a majority, but equally the courts have generally eschewed mathematical concepts such as statistical significance. Thus, no court-level decisions could be located specifically addressing the percentage of consumers that would be viewed as significant. Perhaps this is unsurprising, as the CJEU has repeatedly avoided setting percentages. However, it is difficult to find any indication even in broad terms of where the border between significance and insignificance lies. Instead, in every decision except *BEST MANGAL* (discussed below) the AP or HO has found that the meaning of terms is *not* known to a significant number of consumers.

Space does not permit detailed consideration of all the decisions where a foreign language-speaking minority was held not significant. Instead, this article will focus on the largest minority population to be considered by the Registry. This was in *Pooja Sweets*, [140] a decision that falls slightly outside the dates of the study but remains a key reference point. The dispute concerned rival claims for marks, both for foodstuffs, containing the words "pooja sweets & savouries." It was argued that the word "pooja" was descriptive, as it referred to the food offerings made at Hindu pooja ceremonies. The AP found that even if this was the case,[141] the Hindu[142] population of the UK who were familiar with the term amounted to only 1.2% of the UK population,[143] and this was insufficient to satisfy the average consumer test.[144] While 1.2% may be small in percentage terms, it amounted to 558,810 people who would be unable to easily use a potentially descriptive term to describe their products or receive information about products they might wish to purchase. Yet neither the HO nor the AP made any reference to the absolute number of people in question.

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139 Case T-286/02, *supra* note 16, ¶ [41].

140 *Pooja Sweets*, O/195/15, *supra* note 53.

141 *Id.* at ¶ [54]. The AP also doubted whether the term would have described the foodstuffs for which was sought, rather than the ceremony at which the foods were to be offered. *Id.*

142 While most of the decisions we examine are about languages, sometimes there is a cross-over with adherents to a certain religion sharing common terminology.

143 *Pooja Sweets*, *supra* note 53, ¶ [48]. This figure appears to be derived from the 2001 census. I have drawn the number of people in absolute terms from that same census.

144 *Id.* at ¶¶ [48]-[49].

As Hindus were the largest minority group considered in by the Registry, it is unsurprising therefore, that when the HOs and APs considered other smaller minority groups, these groups were found not to be significant. These include speakers of Turkish, Tamil, Arabic, Japanese, Chinese, Russian, Greek, Bulgarian, Portuguese, French, German, Italian, Catalan, Vietnamese, Danish, and Scots Gaelic. Interesting, there were no decisions involving Polish or Romanian words in the period studied, even though these languages were the third and fourth most common languages in the UK (after English and Welsh) amounting to 1.1% (612,000) and 0.8% (472,000) of the UK population, respectively.

During the period studied, only one minority group, namely the UK's Turkish community, was identified as amounting to a significant number of consumers,[145] despite the fact that often hundreds of thousands, or even a million consumers would potentially understand the meaning of the mark in question, and even though the Turkish-speaking minority group had been labelled as insignificant in previous decisions. This is surprising in the extreme and reflects an (institutional) acceptance that some members of minority groups will be confused and will be unable to use or receive information that is descriptive. From a recognition perspective, this is troubling not only because so many minorities are described as "not significant" but also because *no* minorities (bar Turkish speakers in only one instance) were found to be significant under this approach.

It thus seems unlikely that on this approach the minority understandings of trademarks will ever be recognized, which is at odds with the multicultural approach. It is true that there are minority groups with a greater number of individuals in the UK than the Hindu population considered insignificant in *Pooja Sweets*: in the religion question of the 2021 UK census,[146] 3.9 million people (6.5% of the UK population) identified as Muslim. Of course, those people come from diverse national backgrounds and will not necessarily share a common language, though they may, as was argued in *Pooja Sweets*, share terminology for religious rituals. If we look to the census data on ethnicity:

- 1,864,318 (3.1%)—Asian, Asian British, or Asian Welsh: Indian;

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145 In *BEST MANGAL*, the AP upholds the HO's finding in O/491/14 that the Turkish community in the UK amounted to a significant proportion of the UK population. *BEST MANGAL*, *supra* note 8, ¶ [14]. However, other decisions have found that self-same group of consumers is not significant. This would seem to be at odds with *Pooja Sweets*, where the Hindu population, which formed a larger percentage of the UK population than the Turkish, was found not be significant. *Pooja Sweets*, *supra* note 53, ¶¶ [48]-[49].

146 *See* U.K. Off. for Nat'l Stats., Religion, England and Wales: Census 2021 (Nov. 29, 2022), *available at* https://www.ons.gov.uk/peoplepopulationandcommunity/culturalidentity/religion/bulletins/religionenglandandwales/census2021.

- 1,587,819 (2.7%)—Asian, Asian British, or Asian Welsh: Pakistani;
- 1,488,381 (2.5%)—Black, Black British, Black Welsh, Caribbean, or African: African.

Again, this exceeds the percentage of the UK population in *Pooja Sweets*, but there is likely to be linguistic diversity among these groups, so it is likely that not all consumers in each ethnic group will understand particular minority language terms. Moreover, there remains an open question about what percentage would count as significant: would any of the minority groups entered in the census be classed as significant? While the question is not a strictly numeric one, it would be hard to justify if, say, 2.5% was significant but the 1.2% in *Pooja Sweets* was not. Significance has the potential to take minority rights into account *if* minorities are considered *qualitatively* significant because they embody a particular language, ethnicity, or national background. Such an approach would reflect the recognition given to group collective rights by Kymlicka, Song, and Taylor described above. However, the approach to date has been to concentrate on a quantitative approach to significance, and to draw the threshold for this at a high level. Thus, without a different approach, it is argued that prospects for recognition of minority languages are bleak.

6. Variegated Consumer Groups

A further approach evident in 19.21% (39) of Registry decisions concerning issues of language acknowledged that some consumers would be confused, and some would not, to then find a likelihood of confusion on the basis of the group of consumers that would be confused. In a sense this would seem to be true of the "significant part" for the average consumer as it acknowledges that the average consumer is not a single notional person, but rather reflective on the whole body of consumers, where some will be confused, and others will not, but where each group needs to be taken into account. Indeed, AP Michaels, in *SANSKRITI GURU*, explained how this approach accords with that in *Interflora II*. She notes that in rejecting the "single meaning" rule, Arnold J allows for the possibility of different classes of consumer, and so it was correct for the HO in this case to consider the impact of the mark on *each* type of consumer.[147] As there was no need to limit the consideration to the majority group of consumers, it was just as legitimate to consider the understanding of those consumers who were familiar with Sanskrit as much as those who were not.[148] Unlike in the "significant part" cases we examined above, the AP made no attempt

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147 O/830/18, *In re Joshi* [2018], ¶ [10] (UKIPO) (*SANSKRITI GURU*).

148 *Id.*

to quantify the size of the minority consumer group, either in absolute or percentage terms.[149] This pattern is also evident in subsequent decisions of HOs who have likewise tended not to assess whether each subgroup of consumers is numerically or qualitatively significant before taking their perspectives into account. In terms of minority rights, this approach is well-suited, as it allows for the perspectives of subgroups of consumers, though small in percentage terms, to be considered on equal terms to the more general body of consumers.

Indeed, it is revealing to see how this translates into different outcomes from the "significant part" approach, with minority recognition of non-straightforward words in different languages, or similar to words in different languages, French (*Entre Elles*[150]), German (KINDI KIDS,[151] OTO[152]), Italian (BELLISIMO[153]), Arabic (SALAM[154]), Russian (*Командирские* (transliterated as "Komandirskie"[155])), Chinese (QI)[156] and Turkish (ZEUGMA[157]) are all taken into account. By contrast, the meaning of words in none of these languages were taken into account under the "significant part" approach where it was held in those cases that there were insufficient numbers of consumers who would speak those languages. Thus, the *SANSKRITI GURU* approach is to be welcomed because it recognizes that the perceptions of trademarks of minority groups of consumers should be taken into account, even if the size of the group is small in numerical terms. In this way it would seem to be the approach that is most closely aligned to Kymlicka et al.'s notion of minority group collective rights in language. It also opens the door for the recognition of other groups of consumers whose perceptions may be different from that of the majority of consumers, which will be discussed further below.

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149 Indeed, there are no speakers of Sanskrit as a mother tongue, and it does not appear as a response in the 2021 census language question. However, it is used in religious practices.

150 O/914/21, Rousselet v. Kouloufoua [2021], ¶ [44] (UKIPO).

151 O/274/20, Kindy Project SAS v. Moose Creative Mgmt. Pty. Ltd. [2021], ¶ [70] (UKIPO).

152 O/119/20, Otto (GmbH & Co. Kg) v. OTO Int'l Ltd. [2021], ¶ [75] (UKIPO).

153 *BELLISIMO STUDIO*, O/224/16, *supra* note 120, ¶ [35]. Although this is the Spanish rather than Italian spelling of the word the HO [33] was of the opinion that the average UK consumer would miss this nuance.

154 *SALAM FOODS*, O/311/19, *supra* note 21, ¶¶ [48]-[49].

155 O/362/21, Vostok Chistopolskij chasovoj zavod, ZAO v. SOLEI BG [2019], ¶ [25] (UKIPO).

156 O/587/21, RSG Grp. GmbH v. Glycologic Ltd. [2021] (UKIPO), ¶ [43].

157 O/0421/23, Yirtar v. Zeugma Turkish Cuisine Ltd. [2023], ¶ [59] (UKIPO).

7. Keeping Descriptive Words Free and Downplaying the Consumer

In *BEST MANGAL*, AP Alexander looked not just at how the average consumer in the UK would perceive the mark, but also at the need to keep descriptive words free for others to use.[158] He noted that words that are descriptive in a language other than English but currently have no meaning to most consumers in the UK may nevertheless become descriptive in the UK over the passage of time.[159] Failing to acknowledge a potentially descriptive meaning from the onset of the use of those words in the UK may ultimately deprive competitors of the ability to use those terms, and so stifle the development of markets for the products those names represent.[160] In *BEST MANGAL*, the AP conceded that the average consumer in the UK would be unfamiliar with the term "mangal"—a form of Turkish barbeque. However, he drew an analogy to terms such as "tandoori" and "stollen" which, while once obscure, have now become a common part of the British cultural landscape.[161] Identifying that concern for *future* descriptive uses was in accordance with the approach of the CJEU in cases such as *Windsurfing Chiemsee*, and also aligned with public policy concerns,[162] he observed:

> It is also worth emphasising the importance of that public interest in cases of this kind. Where a trade mark is registered for a term which is descriptive and which other traders may reasonably want to use to describe their products in the same way, that can have a chilling effect on the ability of third parties to set up rival businesses offering the same kinds of products. That is particularly so where traders are bringing to wider public attention new kinds of products and services from foreign countries or from new frontiers of technology where a term may be in common use, but which is less well known among the general public in the UK. If marks are registered for those less familiar but nonetheless descriptive terms, others are restricted in their ability to set up rival businesses (in this case restaurants offering similar food) and describe them in the appropriate way. Trade mark registration is not there to make trade harder. It is there to make it easier, for traders and consumers alike. One can imagine that the flourishing Indian restaurant scene in this country may have been adversely affected if the first restaurant in the UK to offer tandoori food

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158 *BEST MANGAL*, O/224/16, *supra* note 8, ¶ [8].

159 *Id.*

160 *Id.*

161 *Id.*

162 *Id.* at ¶ [15].

> had registered (and sought to enforce) the mark "Best Tandoori" for food on the basis that the restaurant was well known under that name in a neighbourhood of London and "tandoori" was not yet well known to the general public in the UK.[163]

What is particularly interesting about this decision is that while the AP did find that the Turkish-speaking community was a significant part of the UK average consumer base,[164] his justification does not depend on how the consumers currently perceive the mark, but rather on the intrinsic need to keep certain words free so as not to impinge on the development of future product markets. Moreover, the beneficiaries of this approach are not only those that speak the language in question, but also the wider community who, it is envisaged, will one day benefit from the products that were initially aimed at a niche foreign-language-speaking market. The reasoning in this decision is particularly attractive because not only is it based on protection of minority rights, but it also shows the benefits to the community of consumers as a whole that can arise from recognizing those rights.[165] Given that this approach was evident in only one case, it amounted to 0.49% of the language decisions.

At this point, it might reasonably be asked how those foreign terms that might need to be kept free can be identified. After all, only a fraction of the very many foreign terms are likely to come to the attention of the public in the UK.[166] It is perhaps possible to work by analogy to geographically descriptive marks. In *Windsurfing Chiemsee*, the original case where the CJEU identified the public interest in keeping potentially descriptive marks free, the Court instructed that not every mark with a geographical connection should be treated as descriptive. Instead, only certain marks were "capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question."[167] This depended on "the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned."[168]

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163 *Id.* at ¶ [8].

164 *Id.* at ¶ [14].

165 *See* Brauneis & Moerland, *supra* note 6, for further perspective on the competition aspects of failing to recognize foreign terms. It should be noted, though, that from a minority rights perspective, the ultimate justification for recognizing the descriptive nature of the term is similar to the well-known foreign terms in (e), based on the meaning to the average member of the UK public, albeit in the future, rather than to members of the minority.

166 By analogy, the difficulty of determining which foreign languages are "modern" versus which are "dead" is at the root of much of the U.S. criticism of the doctrine of foreign equivalents.

167 *Windsurfing Chiemsee*, *supra* note 5, ¶ [31].

168 *Id.* at ¶ [32].

In interpreting this test, the European Intellectual Property Office ("EUIPO") Guidelines seek a "reasonable assumption"[169] that the term will become descriptive in the future. Thus, it might be possible to look for those minority language terms that, it is reasonable to assume, could become descriptive in the future. The Guidelines and indeed the CJEU seek a knowledge level to establish this, looking at the fame and size of the geographical location. Working by analogy, we could look for those terms that are well known to the relevant minority group as a descriptive term, as these might be most likely to "leak" into wider consciousness. The type of goods is also identified as relevant by both the Guidelines and the CJEU. It might be speculated, again by analogy, that terms used in certain market sectors are more likely to reach awareness of the wider, non-minority public, with an obvious example being food and restaurant services, where there is an established practice of bringing new forms of cuisine to the general consumer of the UK.

8. Other Decisions

There were a small number of language decisions that did not fall into any of the categories above. These include decisions involving Scottish Gaelic and Welsh as well as decisions where there was not sufficient evidence provided to enable the HO or AP to decide on the meaning of the term in the relevant foreign language. These decisions amount to 3.49% (7) of the total number of language decisions.

B. Summary and Reflections

This part of the discussion has sought to demonstrate that there is a lack of clarity on the meaning of the average consumer with a variety of approaches in use in Registry proceedings to defining this slippery actor. In a sense this is unsurprising given that during the period of this study and immediately before, the Court of Appeal itself provided conflicting visions of the average consumer, indeed sometimes in the same case. This lack of consistency is concerning in terms of how we understand trademark law's average consumer. It has also resulted in a situation where the meanings of minority language terms are routinely discounted.

Despite the UK courts' rejection of a numerical average of more than 50% as the relevant measure, because many Registry decisions still look for knowledge on the part of a "vast majority" of consumers, they have effectively adopted that standard. Likewise, standards such as the *CHEROKEE* test that require immediate recollection or

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169 EUIPO Trade Mark Guidelines, pt. B, § 4, ch. 4, ¶ 2.6.2 (2024 ed.) (discussing assessment of geographical terms) [hereinafter Trade Mark Guidelines], *available at* https://guidelines.euipo.europa.eu/2214311/2226661/trade-mark-guidelines/2-6-2-assessment-of-geographical-terms.

notoriety also effectively marginalize perceptions of all but the majority. Even tests that would seem to give more flexibility to recognize minorities, such as requiring a "significant" number of consumers to share a perception, rather than the majority, have been construed so that minorities will not form a large enough percentage to be classed as "substantial," even though it could be argued that substantiality should be a question of significance as much as numbers. None of these approaches sit easily with the moral imperative that has been identified, from Kymlicka et al., for minority languages to be recognized.

These approaches are likely to be driven by a desire to adhere to a view of trademark law that rests on a hypothetical average consumer and are in no way motivated by discriminatory instincts. However, as has been argued, contemporary views of equality, as well as a prominent trend in liberalist thought, rest on acknowledging differences and addressing them in a way that is designed to result in equal outcomes, even if it would seem on the surface as if "special" rights are being awarded to minority groups. Indeed, an approach that acknowledges the importance of minority perceptions of language, and indeed the benefit that this brings to society more widely, is evident in AP Michaels' willingness in *SANSKRITI GURU* to take into account the perceptions of diverse groups of consumers in, as well as in the subsequent decisions following that approach. The *BEST MANGAL* approach, which looks to future uses of foreign language terms, may take us slightly outside the justification based on minority rights, and more toward the interests of society more generally, but nonetheless its effect is to limit the grant of exclusive rights in foreign language terms. While neither of these decisions directly address the issue of minority rights, the impact of their respective approaches is clearly to protect minority language rights in a way that aligns with thinking on multiculturalism in this area.

V. OTHER LANGUAGE ISSUES

Before concluding, it is worth considering the analogous situation of non-Roman lettering, which highlights the same trend of discounting the meaning of foreign languages. Also, it should be noted that foreign language terms, even those that would not be known to the "average" UK consumer, can in principle be considered where the use is on goods that are aimed at the minority that would be familiar with the language. Here too, the no-doubt unintentional effect of the Registry's narrow approach to defining such minority goods has made it difficult for the meaning of foreign terms to fall into this category. Again, though, there are signs of a developing minority-friendly approach. Finally, the correspondence between the Registry's approach to Scots Gaelic and Welsh and Kymlicka's protection for "national minorities" is noted.

A. Non-Roman Lettering

Marks composed of non-Roman lettering are particularly badly served in terms of embracing minorities' understanding of languages and reflecting this in how trademarks are protected.[170] Unless the goods for which protection is sought are aimed at a minority group, the approach taken by the Registry is that the average consumer will not understand non-Roman lettering and will view it as a figurative mark or element of a mark. Marks or elements of marks in Chinese[171] and Tamil[172] were subject to this approach in the period examined for this study.[173] Again, this approach strips the mark of any meaning, and so it will be neutral in any conceptual comparison, making a finding of confusion based on a shared meaning of the two marks unlikely. It also means that the mark will not sound in any phonetic comparison because figurative marks are purely visual. Perhaps more importantly, if a mark is meaningless, it cannot be descriptive. This leaves open the possibility that a purely descriptive term rendered in foreign characters, such as the proverbial word "SOAP" for "soap," could be accepted onto the UK Register on the basis that this meaning would not be apparent to UK consumers. There is also an obvious symbolic significance in rendering such marks meaningless. It should be noted that, although the Registry Examination Guide calls for marks in non-Roman characters to be translated and refused registration if this translated meaning is descriptive or generic,[174] the study came across no example of this approach being applied in the hearings, though it is possible that it occurs at the examination stage. If the descriptive meaning of such terms were to be taken into account, this would seem to be more generous than how other

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170 For a recent empirical study of the registration on non-Roman terms in the EU and UK, *see* Mitchell Adams & Amanda Scardamaglia, *Non-English character trade marks in Europe and the United States*, 4-5 E.I.P.R. 565 (2023). The authors track how many of such marks are registered but they do not engage with the meaning of the terms and consequently do not comment on whether descriptive marks are being registered.

171 *See, e.g.*, O/423/21, Alibaba Grp. Holding Ltd. v. Play'n Go Marks Ltd. [2021] (UKIPO) (*ALI BABA*); O/602/21, Speedo Holdings B.V. v. Beijing Hongguang Dongying Sports Training Co., Ltd. [2021] (UKIPO) (*SPEEDO*); O/429/18, Houzz, Inc. v. Uhouzz (Tianjing) Network Tech. Co., Ltd., [2018] (UKIPO) (*UHOUZZ*).

172 *See, e.g.*, O/593/18, Ramesh v. Chithambara Mathematics Challenge (CMC) Ltd. [2018] (UKIPO) (*CHITHAMBARA*).

173 Outside the time period of this study, *see also* O/399/13, Omar Kassem Alesayi Mktg. Co. Ltd. v. Greene [2013] (UKIPO) (*GREEN FARM FRESH FOODS*), *aff'd*, O/374/14, where, although the senior mark was composed of two "lozenges," one containing the term "GREEN FARM" in English and the other containing words in Arabic, the Arabic words were given very little weight because they could not be understood or pronounced by the average consumer. *Id.*

174 *See* The Examination Guide, *supra* note 49, under the heading "Characters (e.g., Chinese, Japanese, Cyrillic)."

foreign language marks are treated under *KIAP MOU*,[175] as described above.

Arguably the UK approach in treating non-Roman characters as figurative contrasts unfavorably with that in Australia, where marks in non-Roman letters are considered to be aimed at the minority that can actually read and understand that lettering.[176] In Australia, it is the nature of the sign, rather than the nature of goods (as in the UK) that dictates who the sign is aimed at. This ensures that the actual meaning of those marks is not lost and can be properly taken into account. Consequently registrations that would have negative competitive effects, albeit within a subgroup of consumers, can be stopped. In contrast, the UK approach to date does not look at the characteristics of the sign, but rather it assesses whether a mark is aimed at a minority group by examining whether the *goods* specified would be the sort purchased particularly by a minority group. The meaning of such marks is simply lost within the trademark system.

B. Marks Aimed at Minority Groups

Where a trademark is aimed at a specific minority group, the practice outlined in the Registry Examination Guide establishes an exception from the usual rule that UK consumers will be unlikely to recognize the meaning of foreign language words and so that meaning cannot be taken into account. For this type of mark, the Examination Guide states:

> [when] the goods or services are aimed at a specific consumer who is far more likely to understand the language of the mark rather than the average UK consumer as a whole, this should be taken into account in determining whether the mark is objectionable under section 3(1)(c).[177]

In other words, the meaning of foreign terms can be taken into account when the goods in question are aimed at a minority group. This approach reflects the CJEU's *LOUFTI* ruling, where the court considered the meaning of Arabic elements of the two parties' marks to assess confusing similarity, even though Arabic is not an official language of the EU, because the respective goods sold under both marks were halal foods aimed at Muslim consumers of Arab origin.[178]

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175 *See supra* note 14.

176 *Supra* note 10.

177 *See* The Examination Guide, *supra* note 49, under the heading "Goods or Services aimed at Minority Groups."

178 Case C-147/14, Loutfi Management Propriété Intellectuelle SARL v. AMJ Meatproducts NV, ECLI:EU:C:2015:420, ¶ [22] (June 25, 2015).

However, the generosity of this approach depends on when exactly goods are considered to be aimed at a minority group. The example given in the Examination Guide is the Arabic for the word "NIQAB," which would be descriptive for niqabs in Class 25. Such goods are clearly aimed only at the minority community. However, beyond such specialty goods, Hearing Officers and APs have been strict about when goods are aimed at minority groups. Thus in *Pooja Sweets*, the AP found that while the mark was registered for Asian foods and also specific foods such as Asian sweets and confectionary, kulfi, and various types of specialty bread such as naan and poppadom, such foods were also purchased by the general public and so the mark was not specific to a minority group.[179] This was followed in *ORIGINAL HAJI NANNA'S BIRIYANI*[180] where the HO, following *Pooja Sweets*, found that just because a mark *may* be of special interest to a minority group it should be judged according to the standards of the average consumer if the class of restaurants was aimed at the public at large. Thus, while the applicant may have targeted his restaurant services to the Bengali community, he had applied for "restaurant services" more generally which were aimed at the public at large. In contrast, *UK MALAYALEE MATRIMONY* arguably adopted a more sophisticated approach that focused on the interplay between the mark and the services applied for. Thus, even though the general public might use "dating services" covered by the specification sought, the terminology of the mark made it clear that the target market was a minority group. Consequently, the meaning of the mark should be judged from the understanding of that particular group.[181]

The Registry's approach to marks aimed at minorities would seem to reflect that of marks in minority languages. While according to the Examination Guide, marks aimed at minorities are, in principle, treated in a way that takes their specific language knowledge into account,[182] in practice it appears to be quite difficult to establish that the goods in question are actually aimed at minorities, particularly where the applicant has designated a broad category of goods while perhaps intending to use it only for a subset of those goods aimed at a minority. However, like *SANSKRITI GURU*, the *UK MALAYALEE MATRIMONY* decision suggests there may be a move toward greater acknowledgment of the differing perceptions of minority groups.

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179 *Pooja Sweets*, *supra* note 53, ¶ [44].

180 O/619/20, *supra* note 52, ¶ [46]-[47].

181 O/788/21, Ukmalayalimatrimony.com Ltd. v. UK Malayalee Matrimony Ltd. [2021], ¶¶ [24]-[29] (UKIPO).

182 *See* The Examination Guide, *supra* note 49, under the heading "Goods or Services aimed at Minority Groups."

C. "National Groups": Welsh and Scots Gaelic

As mentioned earlier in the article, Kymlicka argued in favor of affording extra rights to "national groups." The 2021 UK census identifies 538,000 Welsh speakers resident in Wales and an additional 7,349 located in England. This is fewer in number than the minority groups identified as not "significant" above. Indeed, there are even fewer speakers of Scots Gaelic with the number at just over 700.[183] Yet, both of these languages have a special status in the UK,[184] and as such have been granted special recognition by the Registry. Thus, the Examination Guide states: "Where marks contain Welsh or Gaelic words they will be treated in the same way as trade marks consisting of the equivalent English words for the purposes of section 3(1)."[185]

Despite this direction, special recognition of these languages has not been universal in the decisions of HOs. In a decision regarding the registrability of the mark INBHIR NIS for "whisky,"[186] the HO did ultimately find that the term was descriptive. However, to reach this conclusion he did not rely directly on the special rule in the Guidelines that "Where marks contain Welsh or Gaelic words they will be treated in the same way as trade marks consisting of the equivalent English words for the purposes of section 3(1)." If he had, "Inbhir Nis" would have been found equivalent to "Inverness," which would have been descriptive because third parties already had whisky distilleries in that geographical area. Instead, he engages in a detailed discussion of the public policy reasons justifying why Scots Gaelic should be treated as equivalent to Welsh.[187] While this is a powerful justification for the sorts of minority rights discussed in this article, it is be argued that this HO is "reinventing the wheel." While he appears to have recognized that the Registry Examination Guide affords special status to Welsh and Gaelic, he takes the Guidelines as still not requiring refusal of terms descriptive in these language *unless* they would also be understood by the average consumers.[188]

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183 It should be noted that these figures do not strictly compare like with like: the Scots Gaelic numbers are, like the other figures pertaining to foreign languages, derived from the census figures for those for whom the language is their *first* language. However, the figures regarding Welsh speakers include all who speak Welsh whether or not it is their first language.

184 Welsh is deemed to have equal status to English in Wales by virtue of the Welsh Language Act 1993 and Welsh Language (Wales) Measure 2011. Similarly, Gaelic is an official language of Scotland under the Gaelic Language (Scotland) Act 2005. Additionally, both languages are protected as minority languages under the European Charter for Regional or Minority Languages, together with Scots, Ulster Scots, and Irish.

185 *See* The Examination Guide, *supra* note 49, under the heading "Non-English words."

186 *Supra* note 62.

187 *Id.* at ¶¶ [29]-[42].

188 *Id.* at ¶¶ [24]-[25].

This does not seem to be the natural reading of the Examination Guide (the relevant provisions of which are reproduced in the footnotes[189]). Instead, the two paragraphs should be read in the alternative, with Gaelic and Welsh automatically translated, whereas the meaning of other foreign language terms is taken into account only if they would be familiar to the average UK consumer.

More troubling is the HO decision concerning likelihood of confusion in *GLENREIDH*. The term "REIDH" and the earlier mark AN REIDH were treated as having no meaning because "the overwhelming majority of UK consumers . . . are English-speakers with no knowledge of Gaelic."[190] It is unclear whether this is inconsistent with the Examination Guide because this specifically refers to the guidance in relation to Gaelic (and Welsh) being "for the purposes of section 3(1) [the absolute grounds where there is something inherently wrong with the mark],"[191] whereas this was a decision concerning Section 5(2) (the relative grounds where two parties' marks conflict). Using the logic of Kymlicka, it is hard to see why national languages should be recognized in relation to the absolute grounds but not the relative grounds.

VI. LESSONS TO LEARN

This final section will consider what lessons the treatment of foreign languages might hold for trademark law policy and practice more generally.

A. The Need for More Clarity in Understanding the Nature of the Average Consumer

The first lesson is a general one. This article has highlighted an historic array of approaches to how to define who must be confused in relation to conflicting trademarks, or who must find a mark descriptive for this to be legally cognizable. The result has been a

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189 Non-English words: "Trade marks may consist of words in languages other than English. Where marks contain Welsh or Gaelic words they will be treated in the same way as trade marks consisting of the equivalent English words for the purposes of section 3(1). Where marks contain words from languages other than those mentioned above the following will be considered. There are no grounds for refusing registration of trade marks on the basis that they are descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question. In contrast, non-English word marks which are likely to be recognized as a description of a characteristic of the goods or services (or otherwise be descriptive of the goods/services) in the application will be objectionable." The Examination Guide, *supra* note 49, under the heading "Non-English words."

190 O/645/19, Chivas Holdings (IP) Ltd. v. Bagchi [2019], ¶ [22] (UKIPO). Indeed, the HO did not give the contended meaning of the term as he found it to be unevidenced.

191 The Examination Guide, *supra* note 49, under the heading "Non-English words" ("Trade marks may consist of words in languages other than English. Where marks contain Welsh or Gaelic words they will be treated in the same way as trade marks consisting of the equivalent English words for the purposes of section 3(1).").

range of outcomes ranging from those looking at only the perceptions of the overwhelming majority of consumers to analyzing every subset of the market.[192] They cannot all be correct. This confusion would seem to be down to a lack of clear direction from the courts on what is ultimately the fundamental barometer of trademark law. Statements from the CJEU have been abstract and the Supreme Court's pronouncement on the average consumer in *Lifestyle v. Amazon* lacks detail.[193] Indeed, while the CJEU's case law describes a consumer who is "reasonably well informed and reasonably circumspect and observant,"[194] there is also an acknowledgment before the CJEU and the Court of Appeal (case detailed above) that consumer groups are varied and that the impugned perception need only be shown among a "significant" number of those consumers. But this raises the unanswered question of what does "significant" mean? While it is probably a good thing that the CJEU has eschewed the inflexible percentage-based German pre-harmonization approach, the steadfast refusal to give any idea of even a range of cognizable percentages has led to uncertainty and inconsistency both within the Registry and between the Registry and the EUIPO. While our attention has focused here on foreign language consumers, as the average consumer's perspective is so fundamental as a benchmark for registrability and infringement, if we do not understand what this really is, then much of current trademark law way beyond foreign language questions is built on shaky foundations.

A further uncertainty, and one that comes across less clearly in the decisions examined, is whether our average consumer is even the same in relation to confusion versus registrability. One can see good reasons for taking a more normative approach to which marks should be barred from registration on descriptiveness grounds,[195] given that underlying that provision is the normatively grounded public interest in keeping certain marks free for others to use, compared to the ultimately empirically grounded question of when consumers are confused.[196]

B. Lessons from Other Jurisdictions: Significance and Foreign Equivalents

It has been described how the UK's quantitative approach to significance has meant that minorities have not been recognized as

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192 As in *SANSKRITI GURU*, O/830/18, *supra* note 147.

193 *Lifestyle Equities, CV*, *supra* note 83.

194 *Lloyd Schuhfabrik*, *supra* note 67.

195 As AP Alexander did in *BEST MANGAL*, *supra* note 8.

196 For a similar debate, *see* Graeme B. Dinwoodie, *Trademark Law as a Normative Project*, Sing. J. L. Stud. 305-341 (2023).

"significant." This result, though, is not inevitable, as can be seen by contrasting the UK approach with that taken in other jurisdictions. Although the UK is still[197] meant to apply the same test as the EUIPO and GC, there is a subtle difference. While the UK looks (positively) for a *significant* number of consumers, the EU institutions adopt a negative definition, in that a group of consumers will count provided that they are "not negligible," with the result that a smaller percentage of consumers suffices. With this small step, the EU institutions have recognized the rights of minorities in a way that seems in better accord with Kymlicka's approach. The most telling example is a decision involving the trademark SHAKAHARI.[198] The term, which means "vegetarian" in Hindi, was refused registration as an EUTM because it would be descriptive among the Hindi-speaking population of the UK and the Indian and Nepali population of the EU more generally. This sits in stark contrast with *Pooja Sweets*, where a potentially larger part of that self-same population[199] was not viewed as significant by the Registry. A case refusing the registration of the word mark KLÖTENKÖM on descriptiveness grounds is further evidence that the EU standard is less strict. The term was descriptive of a type of alcoholic drink in "Low German," an "unofficial" language spoken by just 3% of Germans. Again, this small number of consumers (particularly because this was an EU trademark so the entire population of the EU could potentially be relevant) demonstrates that the non-negligible standard is more able to take minority interests into account. A further, more sizeable example is the recognition that Finns are a non-negligible minority in Sweden.[200] Though, as this population makes up 6.7% of the Swedish population[201] and is recognized as an "official minority" in Sweden, we might hazard a guess that such a minority might be considered significant even according to the UK rules.[202]

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197 While the UK has left the European Union, UK and EU trademark law were harmonized prior to Brexit, and it remains the case that UK courts and tribunals still pay attention to European decisions in this field.

198 EUTM No. 0017680521, cited in Trade Mark Guidelines, pt. § 4, ch. 4, ¶ 4.1.2.2 (2024 ed.), *available at* https://guidelines.euipo.europa.eu/2214311/2226597/trade-mark-guidelines/4-1-2-2-eu-regional-languages-and-non-eu-languages.

199 The Hindu population of the UK identified in *Pooja Sweets* would include those who spoke Hindi as a first language, but also speakers of other regional languages and even those who speak only English but are familiar with Hindu concepts through religious practice.

200 Case T-878/16, Karelia v. EUIPO, ECLI:EU:T:2017:702, ¶ [28] (Oct. 6, 2017). *See also* Case T-432/16, Lackmann Fleisch- und Feinkostfabrik v. EUIPO, ECLI:EU:T:2017:527, ¶ [29] (Jul. 19, 2017); Case T-830/16, Monolith Frost v. EUIPO, ECLI:EU:T:2018:94, ¶ [56] (Dec. 13, 2018).

201 There appear to be 700,000 Finns out of a total population of 10.5 million, so 6.7%.

202 Sweden recognizes five groups as official minorities. The others are the Sámi, Tornedalers, Roma, and Jews. S*ee* United Nations, Sweden Finns—two cultures, two

It is also worth drawing a contrast with the U.S. doctrine of foreign equivalents. Like the Registry, the USPTO does not automatically translate all foreign terms and assess for descriptiveness, etc., on the basis of that translated meaning. Instead, the U.S. test is whether the ordinary consumer would "stop and translate" the foreign term.[203] This is very similar to the *CHEROKEE* approach of asking whether the average consumer would immediately recollect the foreign term. However, it seems much easier to satisfy the U.S. test because the assumption, subject to certain contextual exceptions, is that consumers will stop and translate whenever the mark is in a common modern language,[204] and not one that is "dead, obscure or unusual."[205] Gilson Lalonde, in her study of the doctrine of foreign equivalents, concludes that "vanishingly few" languages fall into this latter category.[206] Indeed, languages that have been viewed as not understood by a significant number of consumers in the UK, including Chinese, Russian, Arabic, Greek, and Japanese, have all been taken into account in the United States.[207] In particular, the courts have looked behind the numbers of speakers reported on the 2019 U.S. Census and have considered those with familiarity with the language even if they would not be frequent speakers and looking at the existence of cultural activities pertaining to the language.[208] Greek is the language with the lowest number of speakers recorded in the 2019 U.S. census included in Lalonde's list, with 264,066 speakers, amounting to 0.09%[209] of the surveyed population. Indeed, other languages on Lalonde's list, including Swahili and Afrikaans, are not even separately recorded in the census.[210] While U.S.

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languages, https://unric.org/en/sweden-finns-two-cultures-two-languages/ (last visited May 28, 2025).

203 TMEP § 1209.03(g); Veuve Clicquot Ponsardin, Maison Fondee en 1772 v. Palm Bay Imps., Inc., 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, 1696 (Fed. Cir. 2005).

204 TMEP § 1207.01(b)(vi)(B).

205 *Id.*, citing Veuve Clicquot Ponsardin Maison Fondee en 1772 v. Palm Bay Imps., Inc., 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, 1696 (Fed. Cir. 2005).

206 Lalonde, *supra* note 7, 773, 800-801.

207 On the other hand, Tamil, which the 2019 language usage question in the U.S. census (U.S. Census Bureau, *Language Use in the United States: 2019* (2022), http://www.census.gov/content/dam/Census/library/publications/2022/acs/acs-50.pdf, p. 3) records as having 181,698 speakers, was viewed as obscure. *See* Gilson Lalone *id.* at 801, citing Aachi Spices & Foods v. Raju, 2016 TTAB LEXIS 469 (T.T.A.B. 2016).

208 Lalonde, *supra* note 7, 806.

209 The language question recorded data concerning the 308,834,688 members of the population over five years old. Interestingly, the census asks about languages spoken at home, allowing for second languages to be included. By contrast, the UK census asks only about first language, meaning that if the question had been asked as it is in the UK, the percentage of Greek speakers in the United States would have been even lower. U.S. Census Bureau, *Language Use in the United States: 2019*, *supra* note 207.

210 Lalonde, *supra* note 7, 805-806.

commentators have criticized their "doctrine of equivalents" on the grounds that "tiny percentages of US consumers have a disproportionate influence on whether a mark is registered or enforced,"[211] it is argued that, by looking beyond the percentage that speaks any particular language, the United States has made it possible for minorities to have their languages and what they mean to them recognized.

The adoption of a "doctrine of foreign equivalents" in the UK was mooted but ultimately rejected in the *SPOSE DI GIO* decision.[212] It was argued that, in the interests of the ability of goods to flow freely between different Member States, when considering whether two marks were confusingly similar, regard should be given not only to whether the marks were similar in English but also whether the marks, or components thereof, shared a meaning in another language. This would have been wider than the formal structure of the U.S. doctrine, as it did not seem to have the "stop and translate" requirement. While the Registry supported the approach,[213] and AP Hobbs had sympathy for the position,[214] he ultimately held that employing a "doctrine of foreign equivalents" was not open to him because the GC had held in *KIAP MOU* that the meaning of a mark could be considered only if it was understood by a significant proportion of the consumers in the country in question.

Thus, because the AP did not believe that a significant proportion of UK consumers would understand the Italian words that made up both the junior and senior marks, he could not take the meanings of those foreign elements into account in comparing the two parties' marks.[215] Interestingly, the AP's motivation to support a doctrine of equivalents in principle was not a belief in the inherent need to recognize the value of foreign languages, or even based on the need to keep descriptive foreign terms open to all, but rather on a desire to maintain free movement of goods within the EU.[216] It could be argued that, post-Brexit, the UK is no longer bound to follow the approach in *KIAP MOU* (though, of course, other EU Member States would be), and there are strong, keep-free–based reasons for paying more attention to the meaning of foreign

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211 *Id.* at 808. *See also* Serge Krimnus, *The Doctrine of Foreign Equivalents at Death's Door*, 12 N.C. J.L. & Tech. 159 (2010).

212 O/253/05, GA Modefine SA v. Di Gio' Srl [2005] (UKIPO). The term "Spose di Gio" meaning "the brides of Gio." Since the application was for bridalwear, it was argued that the term "spose" would not be as important as the "di Gio" element, meaning that the mark would be confusingly similar to the mark AQUA DI GIO. *See id.* at ¶ [7].

213 *Id.* at ¶ [16], [33].

214 *Id.* at ¶ [32].

215 *Id.* at ¶¶ [35]-[41].

216 Interestingly, the same justification lies behind the argument in favor of recognizing the doctrine of foreign equivalents in Brauneis & Moerland, *supra* note 6.

language marks, even if they are not apparent to a large number of consumers. A doctrine of foreign equivalents—whether on the U.S. model, or that outlined in *SPOSE DI GIO*—would certainly accord greater recognition to minority rights because it demonstrates a willingness to take into account the meaning of the term to the minority group in a way that even the definition of the average consumer that requires understanding by a significant proportion of consumers has not to date.

C. Should We Abandon the Average Consumer?

The average consumer has been a feature of UK and EU trademark law for two decades, but it was not always so. In a series of articles, Jennifer Davis tracks the development of the average consumer, arguing that historically courts in the UK *did* take into account the characteristics of sub-groups of consumers. Thus, courts

> did not assume that all participants in the market could be equally responsible. Instead, the courts assumed the market was made up of a heterogeneous public, some of whom by reasons of, for instance, education or economic status were not equally well informed and so were not in a position to exercise equal choice in the marketplace.[217]

However, post–World War II, divisions in class, affluence, and education narrowed, making recourse to a hypothetical "average" consumer, mirroring the single, utility-maximizing consumer found in economics, possible.[218] While it might be correct that socio-economic divisions between consumers have narrowed, this move toward viewing all consumers embodying the same characteristics fails to take into account non-economic characteristics that might lead to different consumers perceiving different trademarks differently. We have focused on how linguistic and ethno-religious minorities might view trademarks differently from the hypothetical average consumer. However, there are undoubtedly other minorities who may experience trademarks differently from the majority of people. For example, Eric Johnson details how certain people with disabilities experience trademarks, placing particular importance on the visual if their particular impairment means they are unable to read.[219] Even the idea that socio-economic status no longer makes a difference to how people shop is questionable with Laura Heymann[220] considering factors including the impact of

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217 Davis, *supra* note 66, 199.

218 *Id*. at 195-199.

219 Eric E. Johnson, *Intellectual Property's Need for a Disability Perspective*, 20(2) Geo. Mason U. C.R. L.J. 181, 191 (2010).

220 Laura Heymann, *Trademark Law and Consumer Constraints*, 64 Ariz. L. Rev. 339 (2022).

literacy levels, access to Internet shopping via mobile devices, and differing purchase priorities in the face of more limited financial resources. But, returning to issues of language, it might also be considered that certain terms or concepts may be familiar to other non-majority groups[221]—for example, the LGBTQ+ community[222] or speakers of slang[223]—even if they are unfamiliar to the majority of consumers.

It is undoubtedly the case that we want and need to ground our trademark concepts within the perception of consumers. After all, it is consumer protection that serves as the traditional justification for our trademark system.[224] The difficulty is in employing the all-encompassing concept of a single hypothetical average consumer who is reasonably well informed and reasonably circumspect and

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221 Kymlicka, *supra* note 30, 18, does not afford his group collective rights to non-national/ethnic minorities as he seeks to draw a distinction between "ethnocultural" groups and other forms of "culture." However, he seems to have adopted a more expansive approach in Will Kymlicka, *Finding Our Way: Rethinking Ethnocultural Relations in Canada* (1998).

222 There do not seem to be a large number of examples of such marks, but it is striking that in the *LES BOYS* decision, *supra* note 126, the meaning of the term was examined from the point of view of the general consumer, rather than those who might fit into that group of people—this arguably has echoes of the approach to foreign terms that understands their meaning by reference to the understanding of British people rather than the understanding of members of the minority group. As noted, AP Alexander's approach here does not seem to be entirely on all fours with that in *BEST MANGAL*. There is likewise little scholarship on this theme, though of interest is Michael Goodyear, *Queer Trademarks*, 164 U. of Ill. L.R. 163 (2024). While this examines registration of marks including LGBTQ+ terminology from the perspective of registration of offensive marks, the arguments based on the symbolic importance of language and its relationship to identity have parallels in this work. Indeed, in later work, Kymlicka draws analogies between the treatment of the LGBTQ+ community and ethnocultural groups. *See* Kymlicka, *supra* note 221, ch. 6.

223 To date, slang terms have been treated in a similarly inconsistent way as foreign language terms. *See, e.g.*, *LES BOYS*, *supra* note 126, where AP Alexander discounted applicant's argument that *LES BOYS* would be understood as short for "lesbian boys." *Id.* at ¶¶ [34]-[35]. While he noted that "some" of the UK public might view the mark in that way, AP Alexander found that the HO was not in error to find that the "majority" of consumers, and so the average consumer, would view the term "les" as the French word for "the." *Id.* at [34]. This focus on the majority and discounting minority understanding in this context is surprising given AP Alexander's approach in *BEST MANGAL*. *See also* O/864/22, Cake v. Cake Pte. Ltd. [2022], ¶¶ [88], [89] (UKIPO) (*CAKEDEFI*) (holding that a "large proportion of the average consumer" would be familiar with the term "DEFI" as an abbreviation for "decentralized finance," even though some would not). In two decisions regarding the term "crep" (slang for trainers), the meaning was either accepted by both parties, or by the HO in the absence of an alternative meaning. O/396/21, RIN Intell. Prop. Ltd v. Kensulate Holdings Ltd. [2021] (UKIPO) (*CREPSLOCKER*); O/456/21, RIN Intell. Prop. Ltd. v. Roulland [2021] (UKIPO) (*CREP SELECT*). However, we can see echoes of *SANSKRITI GURU*, *supra* note 147, in O/570/19, Cbm Creative Brands Marken GmbH v. Yolo Prods. Ltd. [2019] (UKIPO), where it was accepted that the term YOLO might mean "you only live once" to some consumers and as a made-up word to others, but then proceeded to analyze the possibility of confusion for both. *Id.* at ¶ [42].

224 *See, e.g.*, Graeme Dinwoodie, *Ensuring Consumers "Get What They Want": The Role of Trademark Law*, 83(1) Cambridge L.J. 36 (2024).

observant. This drive to objectivity lends itself to efficient decision-making but does not take into account the diversity of those who are active in the market. Rather there is a need to protect the interests of all who may be impacted by the registration of trademarks. To an extent this has been recognized by the subtle shift toward looking for a "significant number" of consumers. Indeed, as detailed above, the diversity benefit of this approach is highlighted by Arnold LJ in *Lidl v. Tesco*. However, it could be argued that a better approach is to adopt that of the European institutions in looking for the impugned perception on the part of a non-negligible number of consumers. This allows for all groups of people, even those that are relatively small, to be taken into account but allows for genuine outliers[225] to be discounted.[226]

D. Looking Out

One of the reasons minority perceptions have not been adequately recognized is that there has been, in at least some decisions, a strict adherence to trademark principles without due consideration of concerns outside trademark law. I would add my voice to those scholars calling for trademark adjudicators to pay due consideration to wider societal interests that may be impacted by the inexorable application of "trademark" thinking without considering extrinsic policy concerns such as sustainability, free competition, and free speech.[227] It could be argued that the value in recognizing diversity and in avoiding unintended discrimination should trump the strict application of trademark law. The CJEU has been willing to do this before, recognizing the importance of making technology available to consumers in Google[228] and of establishing a single market in the exhaustion of rights cases.[229]

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225 One example that springs to mind is the small number of speakers of Klingon, a constructed language used in the science fiction universe of the *Star Trek* media franchise.

226 The "flip side" of this approach is the risk that competitively valuable commercial activity is blocked by measures that protect a small number of consumers. *See, e.g.*, Dinwoodie, *supra* note 228, at 44. In the case of minority rights, this seems a price worth paying given the values extrinsic to trademark law that are at stake.

227 *See, e.g.*, Anna Tischner & Katarzyna Stasiuk, *Spare Parts, Repairs, Trade Marks and Consumer Understanding*, 54 IIC 26 (2023) (arguing that sustainability, circularity and competition will need to trump strict trademark law); Dinwoodie, *supra* note 224 at 56 (arguing that values such as "free speech, valuing free competition, facilitating public health concerns, enabling artistic creativity, comparative advertising, trying to have a climate where there is certainty for innovators, avoiding the chill of abuse of rights in litigation, respecting commercial ethics" should be balanced against overly wide trademark law based on perceptions of consumer protection).

228 Case C-236/08, Google France SARL and Google Inc. v. Louis Vuitton Malletier SA, ECLI:EU:C:2010:159 (Sept. 22, 2009).

229 Case C-355/96, Silhouette Int'l Schmied GmbH & Co. KG v. Hartlauer Handelsgesellschaft mbH, ECLI:EU:C:1998:374 (July 16, 1998), whereby there was exhaustion only when the goods were put on the market first in the EEA and not where

E. Diversity and Trademark Law

More generally, it is hoped that this work demonstrates that there is room for further consideration of diversity and minority interests in trademark law.[230] As noted above, trademark law, with its focus on rights for traders, might not be the most obvious place to consider issues of diversity. However, because consumers are the barometer of trademark law, and consumers are diverse, any trademark law decision potentially impacts differently on different groups of people. This stretches beyond issues we have looked at in this piece considering descriptiveness and confusion to take in issues such as whether trademarks are offensive and how to deal with trademarks that may be well known abroad, or even in the hands of a particular organization, but that have no business in the UK. This phenomenon seems prevalent, in particular, in relation to religious groups, where often rival offshoots may both seek to register the mark for the organization.[231] There is also further work to be done in understanding how diverse groups of consumers might experience trademarks. While there is some writing on how disability[232] and socio-economic factors might influence purchasing decisions, there is more work, potentially empirical or drawing on previous cross-disciplinary empirical studies, to be done. While there has been some discussion in the case law about how gender[233] and age and disability[234] might result in consumers having differing responses to trademarks, these cases have been characterized by

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they were first put on the market outside the EEA, even though from a trademark perspective the marks communicated exactly the same information.

230 The author has made a modest contribution to this effort in her chapter *Trade Mark Law and Diversity in* Research Agendas in Trade Mark Law (Ilanah Fhima & Anke Moerland, eds., forthcoming).

231 In the U.S. context, *see* David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion, and Identity*, 49 IDEA 233 (2009).

232 Substantially more attention has been given to the interplay between copyright and disability, *see, e.g.*, in the UK context, Sabine Jacques, *The UK pathways towards an equal access to creative works*, *in* Int'l Perspectives on Disability Exceptions in Copyright Law and the Visual Arts Feeling Art (Ana Ramalho & Jani McCutcheon, eds. 2020), though there are many more examples including the detailed consideration of the U.S. position in Blake E. Reid, *Copyright and Disability*, 109 Calif. L. Rev. 2173 (2021).

233 *See* Case T-344/09, Hearst Commc'ns v. OHIM, ECLI:EU:T:2012:324, ¶¶ [31]-[32] (June 27, 2012). The applicant argued that the marks in question (the name of the well-known magazine COSMOPOLITAN or COSMO) were "female trade marks" aimed at "women of all ages who are interested in love, sexuality, men, but . . . also in beauty and life-style." The EUIPO countered that "female trade marks" might possibly apply in relation to goods such as "panty liners or tampons." *Id.* at ¶ [32]. Neither approach would seem to particularly capture the female experience.

234 *See, e.g.*, Case T-369/10, You-Q BV v. OHIM, ECLI:EU:T:2012:177, ¶ [72] (Mar. 29, 2012), where the GC found that purchasers of the junior BEATLES wheelchairs would be attracted on account of their handicap but the image of "freedom, youth and mobility" of the 1960s pop group of the same name.

gross generalizations, highlighting even more strongly the need for further research in this area.

VII. CONCLUSION AND RECOMMENDATIONS

Despite current political pressures, respect for diversity, and the protection of minorities in particular, is a fundamental value in today's society. Liberal thinkers have shown how recognition of the needs of minorities plays a vital role in the cohesion of our multicultural society, and that achieving equality of outcomes sometimes means affording minority groups different rights to the majority. Trademark law has not always lived up to these goals. In adhering to a view of the average consumer that treats him or her as a single hypothetical entity, or the embodiment of the "vast majority" of UK consumers, the Registry has repeatedly discounted the language knowledge of minorities. No doubt this was motivated by a desire to respect trademark principles in the face of a definition of the average consumer that lacks clarity rather than because of any discriminatory impulse. However, it demonstrates how UK and EU trademark law is not currently equipped to deal with perceptions of marks that are shared by small but important groups of consumers whose interests we want to protect, be they speakers of foreign languages, the disabled, or any other group of consumers that is limited in numbers. Likewise, even when the goods are aimed at minorities, courts are cautious about recognizing that this is the case, often assimilating such uses to goods aimed at the "entire" public.

More recent developments, though, have shown a greater willingness to recognize diversity among consumers as well as the societal benefits of recognizing how minorities interact with trademarks. These developments should be used as a basis by the Registry for an approach that, in the interest of recognizing the needs of minorities in our multicultural society, acknowledges the meanings of trademarks, even if they are not known to the numerically average consumer. As a first step, the Registry may consider inviting applicants to indicate the meaning of any foreign terms as part of their trademark application, as is the practice in the United States and Australia.[235] This would level the playing field somewhat by proactively exposing the examiner to the contended meaning of any term at an early stage in the examination process, in the same way that the examiner would be exposed to the meaning of an English term, rather than relying on the examiner to

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[235] Translations of foreign terms and transliterations of non-Roman lettering are required in the United States. *See* TMEP §§ 819.01(m), 809.01, which provides a translation and/or transliteration of any foreign language term or term in non-Roman characters. IP Australia Trade Marks Manual of Practice and Procedure, *supra* note 10, at § 10.4 (Jan. 21, 2025), https://manuals.ipaustralia.gov.au/trademark/4.-translation-transliteration-of-non-english-words-and-non-roman-characters.

appropriately research potential meanings.[236] A more substantive option would be to adopt the EUIPO's "not negligible" standard to which groups of consumers are relevant. But perhaps even better is the *SANSKRITI GURU* approach, whereby all groups of consumers are considered without the need to engage in a determination of their quantitative or qualitative role in the overall group of consumers. There is also a strong argument, as noted in *BEST MANGAL,* for taking into account those marks that, while not widely understood now, may come to be known by the numerically average consumer. While the *BEST MANGAL* approach does not directly focus on the needs of minorities, it will provide them with de facto protection if their marks cannot be monopolized, while also benefiting society more generally. Similarly, there is greater scope for taking proper account of the meaning of marks and goods aimed at minorities by acknowledging that even when a class of goods might be of interest to the general public, the particular applicant or owner's offering may be of particular interest to a minority, who would understand its meaning. Finally, the adoption of the Australian approach to non-Roman lettering, treating goods bearing such lettering as aimed at the minorities who can understand it, rather than relying on the type of goods to ascertain who the mark is aimed at, is recommended.

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[236] Although it should be noted that in many of the decisions examined, the HO *was* aware of the meaning of the foreign term, as it had been argued by the parties, and sometimes even accepted but nonetheless concluded that *consumers* would not be so aware. However, including it in the form would guarantee that the meaning is available at an early stage.

KEEPING PROMISES: ENFORCEMENT STRATEGIES FOR CERTIFICATION MARKS IN THE UNITED STATES*

*By B. Brett Heavner*** *and Caroline Segers****

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I. INTRODUCTION

A promise made should be a promise kept, and that is what owners of certification marks do: make a promise that the goods or services bearing their mark meet the safety, quality, or geographic requirements claimed on their packaging and in their advertising. To ensure that these promises are kept, and that no "certified" claim is false, U.S. law provides the owners of certification marks with an arsenal of weapons to protect their marks and consumers from an infringer's false claims. Depending on the circumstances, the certifier can stop the importation of infringing goods, seize and destroy falsely labelled products, obtain court injunctions forbidding further improper use of their certification marks, and obtain monetary damages from the infringers, all to ensure the accuracy of the standard promised to consumers by the display of its certification mark.

A certification mark is a "special creature."[1] Unlike traditional trademarks, the certification mark is not used by its owner to identify the source of a particular product or service. Rather, it is a promise from the certifier to the public that any product or person legitimately displaying the mark has met the desirable qualities or characteristics guaranteed by the certifier. To ensure this promise is met, in the United States, the certifier must adhere to strict statutory requirements, including the duty to control the use of the certification mark by others.[2] Failure to abide by this requirement imperils the validity of the certification mark. Thus, in addition to the usual concerns that a traditional trademark owner might have about reputational damage and lost sales, the owner of a certification mark has a strong incentive and responsibility to eliminate unauthorized uses of its mark. Fortunately, the U.S. Trademark Act of 1946 (the "Lanham Act") provides certifiers with powerful weapons to combat improper uses of their certification marks, including customs and ex parte seizures, preliminary and permanent injunctions, a variety of damages, and attorney fees. Although these weapons mirror those available in traditional trademark infringement disputes, their use by certifiers presents some unique twists, which are shown in recent certification mark cases. This article provides an overview of these cases as a guide to help certifiers navigate these twists and the various issues brand owners may not otherwise encounter with more traditional types of marks.

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1 Idaho Potato Comm'n v. M & M Produce Farms & Sales, 335 F.3d 130, 131 n.1 (2d Cir. 2003) (quoting J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 19:91 (4th ed.)).

2 15 U.S.C. § 1064(5).

II. SEIZURES OF GOODS

The most dramatic and immediate weapon available to the certifier is a seizure of goods that bear a counterfeit certification. This weapon is designed to keep such falsely certified products off the U.S. market as soon as they are discovered. There are two types of seizures available to a certifier: a seizure of imported goods by U.S. Customs and Border Protection ("CBP")[3] and an ex parte seizure order obtained from a U.S. district court in trademark infringement litigation.[4]

A. Obtaining a CBP Seizure of Falsely Certified Goods

The CBP seizure is the most cost-effective weapon available to a trademark owner. CBP seizures are available to certifiers, just as they are to the owners of traditional trademarks.[5] Once the certifier has recorded its U.S. trademark registration with CBP,[6] which monitors goods entering the United States, CBP will seize such goods that are infringing on the certifier's mark.[7] The certifier can also submit optional documents, including an authentication manual or enforcement-oriented trainings that can further aid CBP officers to effectively identify imported goods that are using the certifier's mark without authorization.[8] In addition, the certifier will typically work hand-in-hand with CBP to confirm whether a good entering the United States is illegitimate by identifying which parts of the entering good are falsely labelled as certified.[9] The certifier must respond promptly, as CBP can hold possibly infringing goods for only thirty days.[10]

The Federal Circuit recently considered the appropriateness of a CBP seizure involving goods that were improperly labelled with a

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3 19 C.F.R. § 133.21.

4 15 U.S.C. § 1116(d).

5 *See* ICCS USA, Corp. v. United States, 952 F.3d 1325, 1329 (Fed. Cir. 2020) (discussing a CBP seizure of butane gas canisters bearing the UL certification mark); LKQ Corp. v. U.S. Dep't of Homeland Sec., 369 F. Supp. 3d 577, 581-82 (D. Del. 2019) (discussing a CBP seizure of automotive repair grilles).

6 *U.S. Customs & Border Protection e-Recordation Program*, U.S. Customs & Border Protection, https://iprr.cbp.gov/s/ (last visited May 12, 2025) (outlining the process of registration with CBP).

7 *U.S. Customs & Border Protection, What Every Member of the Trade Community Should Know About: CBP Enforcement of Intellectual Property Rights* (Aug. 2012), https://www.cbp.gov/sites/default/files/assets/documents/2020-Feb/ICP-IPR-Enforcement-2012-Final.pdf.

8 *U.S. Customs & Border Protection e-Recordation Program*, U.S. Customs & Border Protection, https://iprr.cbp.gov/s/ (last visited May 14, 2025).

9 *Best Practices in Working with U.S. Customs and Border Protection to Help Enforce Your Intellectual Property Rights at the Border*, U.S. Customs & Border Protection, https://www.cbp.gov/trade/priority-issues/ipr/bestpractices (last visited May 14, 2025).

10 19 C.F.R. § 133.21(b)(1).

certification mark in *ICCS USA, Corp. v. United States*.[11] There, the "MEGA-1" line of butane gas canisters manufactured by One Jung Can Manufacturing Co. Ltd. ("OJC") had been certified by Underwriter's Laboratories Inc. ("UL") and was authorized to bear UL's widely used certification mark (shown below), indicating that the canister had met UL's safety standards.[12]

However, OJC did not have the UL certification for its PREMIUM line of gas canisters as of January 19, 2017, when the products entered the U.S. market bearing the UL certification mark.[13] Although OJC's U.S. importer ICCS was contractually obligated to obtain verification from UL for the PREMIUM line to also bear the UL certification mark, it did not do so until after the PREMIUM canisters entered the U.S. market.[14] Without receiving UL's approval, ICCS imported 56,616 PREMIUM gas canisters into the United States bearing the UL certification mark.[15] In February 2017, CBP issued a notice to ICCS under Section 1526(e)[16] of the Tariff Act of 1930, seizing 29,008 of the 56,616 canisters.[17]

ICCS appealed the CBP seizure to the Federal Circuit,[18] arguing that it did not need "express authorization" from UL prior to using the certification because the PREMIUM models corresponded to the previously certified MEGA-1 product.[19] The Federal Circuit determined that "the question of whether [CBP] properly seized ICCS's product turns on whether the PREMIUM model canisters at the time of importation displayed a 'counterfeit'

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11 952 F.3d 1325 (Fed. Cir. 2020).

12 *ICCS USA*, 952 F.3d at 1329.

13 *Id*. at 1329-30.

14 *Id*.

15 *Id*. (Notably, the contractual agreement "authorized ICCS to display UL's certification mark on any ICCS 'models' that are the same physical product as OJC's MEGA-1 canister, but only after UL verifies that any differences between ICCS's model and the MEGA-1 'basic product' are merely 'superficial'").

16 19 U.S.C. § 1526(e) (prohibiting the importation of a product into the United States that bears a trademark that is registered with the USPTO and permits seizure of such goods in accordance with customs laws).

17 *ICCS USA*, 952 F.3d at 1300.

18 *Id*. at 1330-31 (discussing procedural history including ICCS's protest challenging CBP's "unlawful" demand for redelivery and ICCS's complaint to the Court of International Trade challenging CBP's denial of the protest, leading to the subject appeal to the Federal Circuit).

19 *Id*.

certification mark within the meaning of § 1127."[20] Under Section 1127 of the Lanham Act, a counterfeit mark is "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark."[21] The court found that ICCS falsely communicated to consumers that the PREMIUM model had obtained a UL safety certification, when in fact such certification had not yet happened.[22] This misleading use of the UL certification mark, according to the court, qualified as "spurious."[23]

Additionally, ICCS argued that the fact that UL eventually granted the certification for the PREMIUM butane gas canisters demonstrates that its use of the UL certification mark was not "counterfeit."[24] The court disagreed with this argument because UL only agreed to the safety certification *after* the canisters were already imported.[25] The court held that the counterfeiting analysis focuses on the time of importation, at which point ICCS's use was counterfeit.[26]

The decision in *ICCS* demonstrates that the CBP seizure can be an effective weapon that a certifier can use to protect their mark, by preventing importers from both prematurely claiming certification and/or attempting to correct false certification claims by obtaining certification after the fact. To take full advantage of this tool, certifiers must record their U.S. certification mark registrations with CBP for CBP to seize goods and protect against the importation of counterfeit goods. This tool not only gives the certifier an extra set of eyes on the protection of their goods but also provides for a cost-effective form of enforcement.

B. Obtaining an Ex Parte Seizure Order for Falsely Certified Goods

While a CBP seizure is very cost-effective, it has significant limitations. Specifically, it is available only for products that are both *imported* into the U.S. market and *detected* by CBP agents. Consequently, while CBP should perhaps be a certifier's first line of defense against fake or unauthorized certification marks, certifiers should not rely solely on CBP to stop unauthorized use of their certification marks. As a second weapon to combat improper use of a certification mark, certifiers can obtain a court-ordered ex parte seizure of goods bearing counterfeit certification marks. An ex parte

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20 *Id.* at 1331.

21 15 U.S.C. § 1127.

22 *Id.* at 1332.

23 *Id.*

24 *Id.* at 1333.

25 *Id.*

26 *Id.*

seizure is an extraordinary remedy, governed by 15 U.S.C. § 1116, allowing U.S. marshals to seize falsely certified goods without the defendant being present or receiving notice, and before there has been a trial to determine whether infringement has occurred.[27]

Under this statute, the certifier must meet a high bar to prove that the seizure is warranted. This high bar exists because the alleged infringer does not have an opportunity to defend the allegations. There are seven statutory elements that the certifier must show to successfully obtain an ex parte seizure order, the seventh of which may be the most critical. First, the certifier must prove that it is likely to succeed in establishing that the products bear a counterfeit mark.[28] As shown by the following cases, this can be demonstrated by providing evidence that the infringer has essentially the same mark on their goods, even though they are not certified. Second, the certifier must show that no order other than an ex parte seizure would be an adequate remedy.[29] Because an ex parte seizure is such an extreme remedy, the certifier must show that nothing else would suffice to fix the harm the infringer is causing. Third, the certifier must affirm that it has not publicized the requested seizure so that there is no chance that the infringer has been "tipped off." Again, because ex parte seizures are such an extreme weapon, typically granted in part based on a fear that the infringer will destroy the goods if they were put on notice, there is a requirement that the certifier does not give notice to the infringer of the requested seizure (whether intentionally or inadvertently). Fourth, an immediate and irreparable injury will occur if the seizure is not ordered.[30] Here, the certifier must show that the infringer's conduct is so damaging to the certifier that the infringing conduct must stop immediately. Fifth, the goods to be seized will be located at the place identified in the application for such seizure.[31] This factor requires the certifier to identify, with specificity, the location where the infringing goods are being held. Sixth, the harm to the certifier in denying the seizure application outweighs the interests of the person who is having their goods seized.[32] For this, the certifier must show that the immediate interests of stopping the infringing actions outweigh the business interests of the infringing party. Seventh and most importantly, the certifier must show that if it were to provide notice to the party whose goods are being seized, that party would immediately sell, move, destroy, or make otherwise inaccessible the goods in question. This element requires

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27 15 U.S.C. § 1116(d)(9).

28 15 U.S.C. § 1116(d)(4)(B).

29 *Id.*

30 *Id.*

31 *Id.*

32 *Id.*

that the certifier state with certainty and provide evidence demonstrating that the defendant has a history of hiding its identity or otherwise affirmatively making it difficult to find the location of the infringing goods.[33] In addition to these requirements, the applicant must also give notice to the United States attorney in the relevant judicial district for a possible criminal action[34] and must provide a security bond in the event that the seizure is found to be wrongful.[35]

In *UL LLC v. Space Chariot, Inc.*, the UL certification mark provides another case study for how courts analyze whether an ex parte seizure order is appropriate.[36] At least as early as January 2016, Space Chariot sold hoverboards through a website prominently claiming that "ALL Space Chariots are UL CE FCC RoHS Safety Certified," and displaying what appeared to be the UL certification mark.[37] However, UL did not adopt a safety standard for hoverboards until February 2016 and did not certify any hoverboard product until May 2016.[38] On April 26, 2016, UL sent a cease-and-desist letter to Space Chariot stating that its use of the UL certification marks was unauthorized and demanding that Space Chariot stop using any UL certification marks.[39] Though one of Space Chariot's suppliers of hoverboards did receive UL certification on June 30, 2015, Space Chariot still distributed non-UL certified products that improperly bore UL's certification mark.[40] When the demand letter and follow-up discussions failed, UL sued and filed a motion for an ex parte seizure against Space Chariot on November 3, 2016. Although UL had properly filed the motion under seal to avoid publicizing the requested seizure, the court denied the seizure order because UL failed to establish two critical elements, namely that it would suffer an immediate injury, and that Space Chariot would move or destroy the falsely labelled goods if the seizure order was denied.[41] The judge denied UL's motion for a seizure order because UL failed to satisfy all of the required criteria. In particular, UL did not submit any evidence demonstrating that Space Chariot would move, hide, or destroy the

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33 Evidence can be provided that the infringer is a "fly-by-night" operation that will quickly reappear. *See* World Wrestling Entm't, Inc. v. Unidentified Parties, 770 F.3d 1143, 1144 (5th Cir. 2014).

34 15 U.S.C. § 1116(d)(2).

35 15 U.S.C. § 1116(d)(4)(A).

36 UL LLC v. Space Chariot, Inc., 250 F. Supp. 3d 596 (C.D. Cal. 2017) (*Space Chariot*).

37 *Id.* at 603.

38 *Id.* at 604.

39 *Id.*

40 *Id.* at 609.

41 Order on Mot. For Temporary Restraining Order, *Space Chariot*, No. 2:16-cv-08172, ECF No. 12 (C.D. Cal. Nov. 3, 2016).

counterfeit goods, as required by the seventh criterion.[42] Although it denied the application for the seizure of goods, the court nevertheless granted UL's motion for ex parte temporary restraining order because UL did appear to satisfy the other criteria, in particular showing that Space Chariot had used and was continuing to use the UL certification mark despite knowing it was not permitted to do so. After entry of the restraining order, the parties stipulated to a preliminary injunction by which the court enjoined Space Chariot from using UL's certification marks or otherwise falsely claiming certification and from dispersing personal and corporate assets.[43]

UL's failed motion for an ex parte seizure provides several important lessons to certifiers. First, it is critical for the plaintiff/certifier to provide the court with some evidence or reasonable factual argument that the infringer will move, hide, or destroy the infringing goods unless they are seized.[44] It is not enough for the certifier to baldly allege that such conduct will occur. Second, the plaintiff/certifier must establish that it will suffer immediate injury in the absence of a seizure. Relying on a presumption of irreparable injury due to counterfeiting is insufficient. For example, UL's seizure order would likely have been granted if it had shown that the falsely "certified" hoverboards were dangerous or in fact did not meet UL's safety standards. Potential consumer injury from a dangerous falsely certified product would almost certainly have caused UL an immediate injury, as it would have led consumers to doubt the reliability of UL's entire certification program. UL could have demonstrated this fact by working with an investigator to test Space Chariot's products to determine the deficiencies of those products. A second way a certifier could try and show an immediate injury or that the infringer will destroy the infringing goods is by showing the use of shell companies, hiding the identity of the owner, or providing evidence of other nefarious conduct. Finally, this case highlights that a plaintiff/certifier can fail to obtain an ex parte seizure order but can still obtain a preliminary and permanent injunction at a later stage in the proceeding. Although certifiers must meet a high standard to obtain an ex parte seizure of goods bearing counterfeit

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42 *Id.*

43 *Space Chariot*, 250 F. Supp. 3d at 602; Ex Parte Temporary Restraining Order, Seizure Order, Order for Expedited Discovery, and Order to Show Cause for Preliminary Injunction, *Space Chariot*, No. 2:16-cv-08172, ECF No. 25 (C.D. Cal. Nov. 17, 2016) (granting the ex parte temporary restraining order, but striking paragraphs related to the seizure order).

44 *World Wrestling Entm't*, 770 F.3d at 1144 (vacating a district court's refusal to grant a seizure order because WWE provided evidence that defendants were "fly-by-night" counterfeiters who "upon detection and notice of suit, disappear without a trace and hide or destroy evidence, only to reappear later at the next WWE event down the road.").

certification marks, the ex parte seizure is another valuable weapon that certifiers can use to quickly eliminate counterfeit goods from the marketplace.

III. INJUNCTIVE RELIEF

If a seizure of falsely certified goods is not available, the certifier can nevertheless use another weapon in their arsenal and seek a court order prohibiting further sales of the defendant's goods, either before trial as a preliminary injunction or after trial as a permanent injunction. These forms of injunctive relief impose a less onerous evidentiary burden than the ex parte seizure does. It is useful to think of the three types of injunctive relief (ex parte seizure, preliminary injunction, and permanent injunction) as imposing three different levels of difficulty for the plaintiff. The ex parte seizure sets the highest bar because the infringer is given no opportunity to defend against the allegations before the court issues its order. Preliminary injunctions fall into the middle level and still have a high bar as they give the alleged infringer notice of the action but deny the infringer the opportunity to engage in discovery and present all its evidence at a full trial. Finally, a permanent injunction has the lowest bar for a certifier to meet, because the infringer has had the opportunity to engage in discovery and to present all evidence in its favor at a full trial. The sections below will discuss how a certifier can use these weapons to vigorously attack any unauthorized or false use of its certification mark.

A. Obtaining a Preliminary Injunction for Falsely Certified Goods

The preliminary injunction is another weapon that a certifier can employ to obtain immediate relief from the infringement before a full trial. To obtain any form of injunctive relief, the certifier must generally prove it is suffering irreparable harm from the infringement that cannot be adequately compensated by monetary damages.[45] Given that it can take a year or more for a trademark infringement case to come to trial, most certifiers will request a preliminary injunction requiring the defendant to temporarily cease its infringing activities while the proceeding is pending. Preliminary injunctions provide certifiers with a vehicle to quickly remove infringing goods from the marketplace, with a less onerous burden than the ex parte seizure order. Specifically, for a pretrial preliminary injunction, the certifier only needs to establish that (a) it has a likelihood of success on the merits, (b) there is a

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[45] *See, e.g.*, Whirlpool Corp. v. Shenzhen Salinda Electrical Tech. Co., 80 F.4th 536 (5th Cir. 2023). Note that the requirements for being entitled to preliminary injunctive relief is a lower bar than an ex parte seizure order and fewer elements are required to be shown.

likelihood of irreparable harm in the absence of preliminary relief, (c) the balance of hardships favors issuance of the preliminary relief, and (d) the public policy favors issuing an injunction.[46] Still, obtaining a preliminary injunction can be challenging. Unlike the seizure orders, a preliminary injunction is not ex parte, meaning that the defendant has an opportunity to argue that the infringement claim will likely fail, that the plaintiff is not suffering irreparable harm, or that harm to the defendant or the general public, should the infringing product be taken off the market, outweighs any harm suffered by the plaintiff. If the plaintiff/certifier successfully argues that a preliminary injunction is warranted, the court will issue a preliminary injunction only "if the movant gives security in an amount that the court considers proper to pay the costs and damages sustained by any party [later] found to have been wrongfully enjoined or restrained."[47]

USA-Halal Chamber of Commerce, Inc. v. Best Choice Meats, Inc. provides an excellent example of a certifier obtaining a preliminary injunction to quickly remedy a situation where falsely certified products were available in the market.[48] USA Halal certifies meat products as being slaughtered and prepared in accordance with Islamic law.[49] In 2016, Best Choice Meats ("Best Choice") was certified and licensed to use USA Halal's certification mark, but Best Choice failed to provide the required monthly production reports to USA Halal in 2017, so USA Halal revoked Best Choice's certification in 2018.[50] After revocation, and after USA Halal filed its complaint and motion for a preliminary injunction,

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46 Las Vegas Sands Corp. v. Fan Yu Ming, 360 F. Supp. 3d 1072, 1075-76 (D. Nev. 2019). Factors assessed in determining whether a preliminary injunction is proper vary jurisdictionally. For example, in the Fifth Circuit, for a preliminary injunction to be proper, the plaintiff must show:

> (1) a substantial likelihood of success on the merits, (2) a substantial threat of irreparable injury if the injunction is not issued, (3) that the threatened injury if the injunction is denied outweighs any harm that will result if the injunction is granted, and (4) that the grant of an injunction will not disserve the public interest.

Whirlpool Corp., 80 F.4th at 543. In the Seventh Circuit, the threshold requirements for a preliminary injunction require a showing "that [the movant] has some likelihood of success on the merits; that [the movant] has no adequate remedy at law; [and] that without relief [the movant] will suffer irreparable harm." USA-Halal Chamber of Commerce, Inc. v. Best Choice Meats, Inc., 402 F. Supp. 3d 427, 433 (N.D. Ill. 2019) (quoting GEFT Outdoors, LLC v. City of Westfield, 922 F.3d 357, 364 (7th Cir. 2019)).

47 Fed. R. Civ. P. 65(c).

48 *USA-Halal*, 402 F. Supp. 3d at 441.

49 *Id.* at 431.

50 *Id.* at 432.

Best Choice removed the certification mark from its website but did not remove the certification mark from the product packaging.[51]

USA Halal successfully established each of the four required factors for a preliminary injunction. USA Halal was likely to succeed on the merits because it owned an incontestable registration for its certification mark, and a nearly identical version of the mark was displayed on Best Choice's packaging.[52] As to irreparable harm, USA Halal established that "there is a real risk that Best Choice will use its [certification] mark on products that do not meet USA Halal's certification standards, thereby damaging its reputation and the credibility of its certification and trademarks."[53] The court also determined that the balance of harms and the public interest both favored granting a preliminary injunction.[54] Specifically, although Best Choice would have to recall existing products, to repackage already packaged goods, and to acquire new packaging, resulting in spoliation of inventory and delivery delays, the court noted that the delay is not too burdensome and that Best Choice could still distribute meat products in the interim.[55] The court also found that Best Choice's harm was self-inflicted because it continued to use USA Halal's certification mark after being repeatedly told not to do so.[56] Finally, the court determined there is a strong public interest in granting the preliminary injunction because the public must be able to confidently purchase foods that are, in fact, halal, without concern of misrepresentation of certification.[57]

Once the court determined that a preliminary injunction was appropriate, it required USA Halal to post a bond of $95,000 to cover Best Choice's losses should the certifier not ultimately prevail at trial.[58] The court arrived at this amount based on the $70,000 value of the packaging that Best Choice would lose, the delay of several weeks' worth of sales for Best Choice to obtain new packaging, and Best Choice's losses relating to recalled products.[59]

A key lesson for certifiers from *USA Halal* is that, while establishing a prior authorized user's liability for infringement is likely to be clear, to obtain the preliminary injunctive relief, the certifier must be prepared to prove more than the continued

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51 *Id.* at 433. This case is not discussed in the ex parte seizure section above because USA Halal did not seek an ex parte seizure.

52 *Id.* at 434-36.

53 *Id.* at 437.

54 *Id.* at 439-40.

55 *Id.* at 440 (noting that Best Choice could still claim its products are halal because it is being certified by another entity).

56 *Id.*

57 *Id.* at 440-41.

58 *Id.* at 441.

59 *Id.*

unauthorized use of the certification mark. It was critical that USA Halal articulated the significant risk of harm it faced if the infringing meat failed to meet its standards. USA Halal also established that whatever difficulties the prior authorized user faced from the preliminary injunction, the harm was either significantly less than that facing the certifier, or the harm was directly attributable to the now infringer's own conduct. Finally, the availability of a bond puts the certifier in a good position to argue that the risk to the prior authorized user could be counterbalanced by monetary compensation in the unlikely event that the infringement claim failed.

B. Obtaining a Permanent Injunction for Falsely Certified Goods

Regardless of whether a certifier obtained a preliminary injunction, when a certifier establishes at trial that the infringer has used the certification mark without authorization or has used a copy of the certification mark in a manner that is likely to create consumer confusion, the certifier is entitled to a permanent injunction prohibiting the infringer from engaging in this conduct.[60] Although "irreparable harm" to the certifier is a prerequisite for an injunction, under U.S. law, the court must presume irreparable harm upon a finding that consumer confusion is likely.[61] Further, courts can issue permanent injunctions even after an infringer claims that it has voluntarily ceased its unauthorized use of the certification mark.[62]

For example, in *National Examining Board of Ocularists v. Adkins*, the National Examining Board of Ocularists ("NEBO"), the certifying professional organization for ocularists (manufacturers of prosthetic eyeballs) sued Adkins, a formerly certified ocularist who had allowed his certification to lapse.[63] Although Adkins' certification had expired, he continued to use the NEBO certification mark, holding himself out as a board-certified ocularist, and, in fact, he forged the certification when he was visited by a Medicare inspector who was conducting a three-year Medicare qualification and office inspection.[64] NEBO sought a permanent injunction that prohibited Adkins from "using the NEBO trademark to deceive the public/insurance companies or otherwise violating its

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60 15 U.S.C. § 1116(a).

61 *Id*. Note that this presumption applies to ex parte seizure orders as well as preliminary injunctions; however, the irreparable harm is only one element needed in these analyses.

62 *See generally*, Nat'l Examining Bd. of Ocularists v. Adkins, No. 22-cv-6550, 2024 WL 2109348 (N.D. Ill. Apr. 29, 2024)

63 *Id*. at *1.

64 *Id*. at *2.

rights in the NEBO trademark."[65] Adkins argued that the injunction was "moot" because he had "no need or desire to associate himself with NEBO in any way."[66] The court, however, determined Adkins was still holding himself out as a "Certified Ocularist" at the start of the trial and even after briefing on the motion for summary judgment was underway.[67] As such, the court determined a permanent injunction was appropriate, especially because Adkins did not oppose the injunction, and Adkins's counsel "could not definitively declare that Adkins had forever ceased all infringing activities."[68]

When granting a permanent injunction, as illustrated in *NEBO*, the court is particularly concerned with instances in which the facts indicate that the infringer might not stop its infringing conduct, despite being told to do so. Thus, to obtain a permanent injunction, the certifier should provide evidence that the court order is the only relief that would prevent the infringer from continuing or recommencing unauthorized use of the certifier's mark, even after being warned against it. Injunctive relief is an effective weapon certifiers can employ to halt infringing use and protect their brand and the promises set forth by the certification. Given the critical importance of controlling the use of a certification mark, certifiers must establish a track record of effectively policing their marks. So, pressing for a permanent injunction against an initially uncooperative infringer, even one that eventually stops the infringing activity, is essential to stave off accusations that the certifier is not adequately controlling the use of its mark. Indeed, even if infringement litigation settles, the certifier should insist that the settlement includes an injunction entered by the court barring the infringer from any future infringement or risk being held in contempt of court. This weapon is a long-lasting remedy that not only stops the current infringement but can also put the certifier at ease so that there will be additional consequences should this specific infringer decide to repeat their conduct.

IV. MONETARY DAMAGES

Monetary damages are another weapon in a certifier's arsenal to protect their rights and ensure that the certifier's promises to the public regarding the quality of the certifier's goods are kept. Damages are typically used in combination with the injunctive relief discussed above. Damage awards serve two functions: (a) compensating the certifier for injuries caused by the infringer's

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65 *Id.* at *7.

66 *Id.* (quoting Def.'s Resp. in Opposition to Mot. for Summary Judgment, *Adkins*, at 9, No. 22-cv-6550, ECF No. 64 (Nov. 29, 2023)).

67 *Id.* at *7-8.

68 *Id.*

actions, and (b) deterring any future infringement.[69] Specifically, these functions help the certifier by stopping future infringers due to a fear of financial punishment and by helping the certifier recoup lost sales. However, even successful infringement plaintiffs are not automatically entitled to any monetary damages where injunctive relief satisfies the equities of the case.[70] Monetary relief for infringing use of a counterfeit mark can take the form of actual damages or statutory damages. As detailed in this section, for certifiers, actual damages present some significant hurdles to a meaningful recovery. Given these challenges, statutory damages, if available, are likely to be the most effective way for a certifier to recover monetarily and to deter infringement of the certification mark.

A. Actual Damages

Damages in traditional trademark infringement cases tend to focus on compensating the injured plaintiff/certifier. They are measured by the actual harm to the trademark owner, such as lost sales due to the infringing product or the profits that the infringer earned from the sale of the infringing product.[71] Moreover, the court has discretion to raise or lower the actual profits if it determines that the total amount is not warranted under the circumstances of the case.[72] For certification mark owners, the certifier must show adequate evidence of the actual damages.[73]

Both the lost sales and the infringer's possible profits are problematic for certifiers. The unauthorized use of the certification mark by a non-certified party is not likely to cause others to forgo certification, so there are no lost sales. And it can be difficult to establish the infringer's profits that can be attributed to the unauthorized use of the certification mark. Though the Lanham Act gives courts discretion to deter future infringement by trebling damages in cases of willful infringement,[74] this is still problematic for certifiers when the actual damages are zero.

One scenario where the certifier may be awarded actual damages is when the court requires the defendant to pay any license

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69 *See, e.g.*, Sara Lee Corp. v. Bags of N.Y., Inc., 36 F. Supp. 2d 161, 166 (S.D.N.Y. 1999) (noting that statutory damages "serve two purposes—compensatory and punitive").

70 *See, e.g.*, Quick Techs., Inc. v. Sage Grp. Plc, 313 F.3d 338 (5th Cir. 2002) (noting that monetary damages are not automatic, refusing an award of profits and only issuing injunctive relief); Champion Spark Plug Co. v. Sanders, 331 U.S. 125 (1947) (holding that injunctive relief alone satisfies the equities of the case).

71 15 U.S.C. § 1117.

72 *Id.*

73 Henry v. Pro 10 Originals, LLC, 698 F. Supp. 2d 1279 (D. Wy. 2010) (discussing the evidence that a trademark owner must provide and the adjustments to be considered when looking at actual damages).

74 15 U.S.C. § 1117(b).

fees that the certifier would have been owed had the goods been properly certified.[75] Most certifiers charge fees based on the volume of sales of certified products. In some cases, if a high volume of infringing products were sold, the licensing fees might add up to a significant sum.[76] In most cases, however, it is not economically viable, given that the licensing fees owed to the certifier are likely less than the cost of litigation. For example, certifying an individual's professional qualifications would likely generate very modest licensing fees for the certifier.[77]

Though actual damages may be an effective weapon that is awarded to a certifier in certain instances, as shown by cases involving traditional trademark licensing, certifiers are more likely to seek statutory damages to deter future infringers due to the difficult nature of determining the actual damages and the larger potential dollar amounts offered by statutory damages.

B. Statutory Damages for Falsely Certified Goods

Given the difficulties of establishing the certifier's actual monetary loss, certifiers are fortunate to have another weapon in their arsenal when pursuing monetary damages. In cases involving the use of counterfeit marks, the Lanham Act enables the trademark owner to seek an award of statutory damages rather than having to prove actual damages.[78] Statutory damages per types of goods or services sold can range from is $1,000 to $200,000, and up to $2,000,000 should the use of the counterfeit mark be found to be willful.[79] Statutory damages can be particularly helpful if actual damages are low or hard to prove with specificity. Fortunately for certifiers, courts often view unauthorized use of certification mark as a counterfeit mark because a counterfeit certification mark is usually identical to the certification mark displayed on genuinely certified products.[80] In both cases discussed

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75 *See* Microban Prods. Co. v. Iskin Inc., No. 14-cv-05980, 2016 WL 4411349, *5 (S.D.N.Y. Feb. 23, 2016) ("[W]here the defendant was the plaintiff's prior licensee, and continued to use the plaintiff's trademarks past the period of authorization, the plaintiff may show actual damages based on the loss of reasonable royalty payments to which it would have been entitled, had it been able to reap the benefit of the legal exploitation of its intellectual property rights"); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 30:85 (5th ed. 2025).

76 Henry v. Pro 10 Originals, LLC, 698 F. Supp. 2d 1279 (D. Wy. 2010) (noting that the actual damages of a prior authorized user, after adjustments, was $164,229.00 based on the defendants' profits).

77 *See*, *e.g.*, Freeman v. Nat'l Ass'n of Realtors, 64 U.S.P.Q.2d 1700 (T.T.A.B. 2002) (noting that the fee to join the National Association of Realtors was $64 at the time of the opinion).

78 15 U.S.C. § 1117.

79 *Id.*

80 *See*, *e.g.*, *Space Chariot*, 250 F. Supp. 3d 596, 608-09 (C.D. Cal. 2017) (determining that Space Chariot's use of UL's certification mark was a counterfeit use because it was

in this section, *Space Chariot* and *UL v. American Energy Products*, the plaintiff, UL, sought statutory damages to punish those who infringed the UL certification mark and to deter others from repeating the infringers' bad behavior.

1. Statutory Damages Cannot Be a Windfall

The case *UL LLC v. Space Chariot Inc.*, discussed earlier in Section I, provides an excellent example of how U.S. courts analyze the availability and amount of statutory damages. As discussed in more detail above, Space Chariot placed a fake UL certification mark on its hoverboards before UL even released the certification for hoverboards.[81] The court first determined that Space Chariot's use was counterfeit because UL presented "undisputed evidence" that the mark that Space Chariot was using was "identical with, or substantially indistinguishable from" the UL certification mark.[82] The court then agreed with UL's argument that Space Chariot's use was willful because "[defendants] never sought permission to use UL marks and because defendants were repeatedly put on notice that their hoverboards were not UL certified."[83] Specifically, the evidence shows that defendants used the certification mark before the certification for hoverboards was even available.[84]

The court then turned its analysis to the amount of statutory damages to award. Looking at various factors,[85] the court determined that neither party provided complete records as to the profits of the defendant, profits lost by the plaintiff, or the value of the certification mark.[86] In assessing an appropriate amount of damages to award, the court found that while the defendants' conduct was willful, $2,000,000 would be a "windfall."[87] Thus, the

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"identical with, or substantially indistinguishable from, a registered mark") (quoting 15 U.S.C. § 1127).

81 *See supra* Section II.B.

82 *Space Chariot*, 250 F. Supp. 3d at 608 (quoting 15 U.S.C. § 1127).

83 *Id.* at 613-14.

84 *Id.* at 613.

85 *Id.* at 614. The factors considered by courts in determining the appropriate amount of statutory damages to award vary by jurisdiction. For example, the Northern District of California considers:

> (1) the expenses saved and the profits reaped by the defendant; (2) the revenues lost by the plaintiff; (3) the value of the copyright; (4) the deterrent effect on others besides the defendant; (5) whether the defendant's conduct was innocent or willful; (6) whether a defendant has cooperated in providing particular records from which to assess the value of the infringing material produced; and (7) the potential for discouraging the defendant.

Coach, Inc. v. Diva Shoes & Accessories, No. 10-cv-5151-SC, 2011 WL 1483436, at *6 (N.D. Cal. Apr. 19, 2011).

86 *Space Chariot*, 250 F. Supp. 3d at 614.

87 *Id.* at 615.

court opted to award UL statutory damages in the "more reasonable" amount of $1,000,000.[88]

Here, the court held that even in the case of a willful infringer, the statutory damages may not be a "windfall" for the certifier. Specifically, the damages must be high enough to deter future infringement, but not so high as to be an unjustifiable monetary bonanza for the plaintiff. Thus, when a certifier is seeking statutory damages, they should ensure that there is a rationale behind the number they provide to give the court guidance and a reason to award such a high amount.

2. Statutory Damages as a Multiple of Damages

In another recent case involving UL, *UL LLC v. American Energy Products, LLC*, the court awarded UL $500,000.00 in statutory damages.[89]

UL, as previously mentioned, tests products and certifies that they meet certain safety standards.[90] There are two steps to UL's certification: (1) the manufacturer sends a representative sample to UL, and (2) UL inspects the products and manufacturing processes and locations to ensure that they meet certain safety standards.[91]

American Energy Products, LLC ("AEP") manufactures Sky Blue butane canisters.[92] In 2014, Jude Shao, AEP's then chief executive officer and an individually named defendant, sought to have AEP's butane canisters certified by UL.[93] Though the parties entered into a series of agreements under which AEP would follow the steps to obtain UL certification, UL later determined, through undisputed records, that AEP was, in fact, using the UL certification mark before the first inspection in 2014 and long after it received cease-and-desist letters from UL.[94] The parties disagreed over whether the use of the UL certification mark was permissive; however, the parties agreed that AEP sold at least $634,460, and perhaps more, of its Sky Blue butane canisters bearing the UL certification mark during the relevant period.[95]

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88 *Id.*

89 UL LLC v. Am. Energy Prods., LLC, 358 F. Supp. 3d 753, 761 (N.D. Ill. 2019).

90 *Id.* at 754.

91 *Id.* at 754-55.

92 *Id.* at 755.

93 *Id.*

94 *Id.* at 756-57. At the time of AEP's fraudulent application of the UL certification mark on its butane canisters, AEP was actively seeking UL certification, and a UL inspector physically saw the canisters bearing the UL certification mark prior to any sort of approval.

95 *Id.* at 757. AEP argued that an initial product inspection occurred in November 2014, which permitted the use of the UL certification mark. UL argued, on the other hand,

The court ultimately determined that AEP's infringement was willful because AEP used the UL certification mark despite being repeatedly warned that they were not authorized to do so until the final product inspection occurred.[96] Because UL was able to prove willfulness, UL sought statutory damages in the amount of $1,000,000, or at least $381,000 of damages, roughly three times the profit the defendant admitted to receiving from the sale of its Sky Blue butane canisters bearing the UL certification mark.[97] The court awarded damages in the amount of $500,000 because AEP's misuse was willful and because the "goal of deterrence d[id] not warrant a higher damages award" given that AEP already stopped selling the Sky Blue butane products.[98]

Statutory damages are an incredibly helpful weapon for certifiers to leverage as a way to protect their rights in their certification marks, while also having the additional benefit of acting as a deterrent to future infringement. Of particular importance in assessing the sum of statutory damages awarded is the infringer's intent, as illustrated in both UL cases above. When the certifier demonstrates that the infringer was on notice that its actions constituted infringement, the continued unauthorized use of the certification mark constitutes willful infringement, thereby warranting a higher statutory award. These cases show that when willful infringers break the promise that the certifier makes to the public, the certifier can use the remedy of statutory damages to fix the promise that was broken.

Lastly, a notable distinction between the two UL cases above is whether the defendant was in the process of receiving UL certification. AEP was in the process of being certified when it infringed the certification mark and was penalized $500,000. In contrast, Space Chariot was required to pay a much higher $1,000,000 in statutory damages because it used the certification mark before UL even released certification standards for hoverboards and repeatedly sold falsely certified hoverboards. Thus, if certifiers choose to seek statutory damages, they should tailor their request to the facts of their case and to the specific supportive evidence available to them. Certifiers should look to the infringer's conduct, whether the infringer was in the process of seeking certification, and whether the infringer had notice of the infringing conduct in order to maximize the total award sought.

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that no initial inspection was ever completed because the canisters were not in production at the time of the initial visit.

96 *Id.* at 760.

97 *Id.*

98 *Id.*

C. Attorney Fees

The last weapon available to certifiers facing unauthorized use of their certification mark is an award of the attorney fees incurred in enforcing their rights. An award of attorney fees is authorized in either "exceptional" cases or in cases where the infringing conduct constitutes counterfeiting. Under 15 U.S.C. § 1117(b), an award of attorney fees is required in the case of counterfeiting, regardless of the exceptionality requirement in other cases.[99] Under 15 U.S.C. § 1117(a), attorney fees are available only in "exceptional" cases. An "exceptional" case is "one that stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated."[100] To make this determination, the court must look to the totality of the circumstances.[101] To determine whether the case is exceptional, the court looks to the totality of the circumstances.[102] Though attorney fees cannot be awarded in conjunction with statutory damages, they can be awarded in conjunction with actual damages.[103] Thus, attorney fees can serve as a deterrent by having an additional monetary penalty beyond the damages actually suffered by the certifier. Though statutory damages will typically be higher in most cases involving certification marks, cases where actual damages are easily discernable, typically involving holdover licenses (i.e., previously authorized users), provide an instance where actual damages plus attorney's fees can be applicable. Another instance in which attorney's fees can be applied, as discussed below, includes cases where a previous settlement was reached regarding the infringing conduct, and then breached.[104] Thus, when considering whether to seek attorney's fees, in cases not involving counterfeit goods, the certifier should also consider the conduct of the infringer and whether it will constitute an extraordinary case under the language of the statute.

Another important consideration when requesting attorney fees is the requirement to provide sufficient evidence to the court so it can properly determine whether the fees requested are

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99 15 U.S.C. § 1117(b) (noting that in a case involving a counterfeit mark "the court shall . . . enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee.").

100 Octane Fitness, LLC v. Icon Health & Fitness, Inc., 572 U.S. 545, 572 (2014).

101 *Id.*

102 *Id.* at 554 (noting that an "exceptional" case "is simply one that stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.").

103 Am. Registry of Radiologic Technologists v. Cox, No. 18-cv-09915, 2019 WL 8198235 (C.D. Cal. June 3, 2019).

104 *Id.* at *5.

reasonable.[105] This could include invoices or billing records.[106] However, simply providing the attorney names and how many hours they worked on the case is insufficient.[107] The court must have something more to make the determination that the remedy is reasonable.

A notable example where a certifier received an award of attorney fees is *American Registry of Radiologic Technologists v. Cox.*[108] The American Registry of Radiologic Technologists' ("ARRT") is a national registry of radiologic technologists, and the "only organization in the United States that certifies individuals qualified in radiography."[109] Cox was originally certified by ARRT and permitted to use some, but not all, of the ARRT designations and certification marks; nevertheless, he falsely represented he was certified in all ARRT specifications.[110] As a result, ARRT revoked Cox's ARRT certification for one year.[111] During that one-year suspension, Cox misrepresented to an employer that he was currently ARRT-certified.[112]

After this misrepresentation, ARRT sued Cox for trademark infringement and unfair competition, and that case ultimately settled.[113] Under the settlement agreement, Cox acknowledged the false representation and agreed to refrain from misrepresenting his credentials and, in exchange, ARRT agreed to release Cox from the suit.[114] Despite this agreement, Cox once again misrepresented the certifications he had with ARRT, and the present suit followed.[115] ARRT then moved for default judgment after Cox did not respond to the litigation.[116]

Among other remedies, ARRT sought attorney fees and costs, on the basis that the case was "exceptional."[117] To determine whether it was "exceptional," the court looked to the totality of the circumstances.[118]The court found that Cox's "conduct, particularly in light of the Settlement Agreement, was willful and therefore

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105 *Id.*

106 *Id.*

107 *Id.*

108 *Id.*

109 *Id.* at *1.

110 *Id.*

111 *Id.*

112 *Id.* at *2.

113 *Id.*

114 *Id.*

115 *Id.*

116 *Id.*

117 *Id.* at *4.

118 *Am. Registry of Radiologic Technologists*, No. 18-cv-09915, 2019 WL 8198235, at *5 (C.D. Cal. June 3, 2019).

sufficiently exceptional to justify an award of attorney fees."[119] ARRT sought a total of $14,215 in attorney fees.[120] In its request, ARRT provided the hours worked by five attorneys, but did not provide any other supporting evidence, such as an invoice or billing record.[121] As such, the court required ARRT to submit additional documentation or it would otherwise only receive an award of $1,200 in attorney fees.[122] In response, ARRT's attorneys submitted an affidavit that included invoices detailing the work conducted, the hours spent on each task, and which attorney performed what task.[123] Based on the addition of ARRT's affidavit to the record, the court determined that the originally requested amount of $14,215 in attorney fees was appropriate and held that Cox must pay the full amount.[124]

As illustrated in *ARRT*, to best utilize the remedy of attorney fees, it is important for certifiers to provide sufficient evidence to show that the case is "exceptional." This can include evidence that the defendant's conduct is willful, such as an intentional breach of a settlement agreement. Then, once it is determined that the case is exceptional, the certifier should submit detailed evidence demonstrating that the amount of the attorney fees requested is reasonable, such as invoices and/or billing records that demonstrate how the certifier arrived at the fee requested.

V. CONCLUSIONS

Certifiers should use all the weapons in their arsenal to protect their certification mark. The certifier is responsible for stopping the infringing uses, removing those uses from the market, and preventing unlawful use of the certification mark in the future. As such, the remedies discussed in this article are incredibly important, since they enable the certifiers to keep the promise made by their certification marks and thereby protect the consuming public from potentially unsafe or poor-quality products that are masquerading as bona fide certified products.

Seizure of goods that bear a counterfeit certification can be enforced by the government or the owner of the certification

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119 *Id.*

120 *Id.*

121 *Id.*

122 *Id.*

123 Declaration of Lynnda A. McGlinn in Support of Plaintiff's Motion for Default Judgment, Am. Registry of Radiologic Technologists v. Cox, No. 2:18-cv-09915, ECF No. 19 (C.D. Cal. June 5, 2019).

124 Report on the Determination of an Action, Am. Registry of Radiologic Technologists v. Cox, No. 2:18-cv-09915, ECF No. 21 (C.D. Cal. July 31, 2019).

mark.[125] The government's ability to seize goods with counterfeit certification marks helps control the importation of infringing products and prevent these products from entering the market. CBP seizure is also a cost-effective way for the certifier to protect its mark without costly litigation. On the other hand, the owner of a certification mark can, on its own, file an application for an ex parte seizure order to stop an infringer once the goods are already in the country; however, as shown in the *Space Chariot* case, the certifier should ensure that they meet the more stringent requirements for ex parte seizures, such as knowing where the goods are located and providing evidence that the infringer will destroy the counterfeit goods unless they are seized. These seizures are effective weapons especially in the cases of counterfeit goods. Additionally, the certifier should anticipate using these methods at the beginning of a possible litigation. CBP seizures can give the certifier notice of a new infringer, while an ex parte seizure can be used by the certifier and serves as a first shot in infringement litigation.

Injunctive relief is similar to the ex parte seizure in that both provide a way for the certifier to stop an infringing use that is ongoing in the United States. Preliminary injunctions are used at the outset of litigation to halt an infringing use pending the outcome of a full trial. When seeking a preliminary injunction, the certifier must do so early in the litigation to avoid the possibility that the court will deny the injunctive relief as being sought too late.[126] A permanent injunction is issued as part of a final judgment to ensure that the infringer will not resume its unauthorized use of the certification mark, as illustrated in the *NEBO* case discussed above. Injunctive relief is critical in maintaining the promise that the certification mark makes to the public, namely, guaranteeing the public's expectations that products bearing the mark actually meet the standards claimed on packaging, advertising, and labelling.

Monetary damages are also an important form of relief for certifiers. Actual damages, while not always practical in certification mark cases, can be effectively used in situations where willful infringement allows them to be combined with attorney fees. Alternatively, statutory damages are an important deterrent where actual damages cannot be proven, and can be especially useful when the infringement is found to be willful, as the damages can be

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125 Note that the case of *Board-Tech Electronics Co., Ltd. v. Eaton Elec. Holdings LLC*, No. 17-cv-5028 (KBF), 2017 WL 4990659 (S.D.N.Y. Oct. 31, 2017), *aff'd*, 737 Fed. App'x 556 (2d Cir. 2018) demonstrated that other third parties who receive the benefit of the certification mark cannot sue an alleged infringer. The court held that it was up to the certifier to police the certification mark, not other parties.

126 Tough Traveler, Ltd. v. Outbound Prods., 60 F.3d 964 (2d Cir. 1995) (holding that a delay in bringing the action and seeking a preliminary injunction negated the presumption of irreparable harm from likelihood of confusion).

awarded up to $2,000,000 per infringing use of the mark.[127] Given that the very purpose of a certification mark is to promise that the product meets standards of safety, quality, geographic location, or an ecological promise, courts are often willing to impose high statutory damages awards when a counterfeit certification mark is employed to intentionally deceive consumers.[128] Seeking statutory damages is a powerful way for a certifier to protect its marks and certification standards.

Finally, attorney fees awards, while not guaranteed, can be a powerful weapon in certification mark cases. The "exceptional" case standard sets a high bar, but it can be met where a defendant's conduct is particularly egregious as demonstrated in *ARRT* where the defendant in that case breached a prior settlement agreement with the certifier and made several misrepresentations**.** *ARRT* also provides helpful guidance on how to recover attorneys' fees by providing the court with detailed, substantiated evidence to show that the fees requested are warranted. Although attorney's fees cannot be pursued independently, they may be awarded in conjunction with actual damages to help make the certifier whole.

Overall, the remedies available in certification mark cases play a significant role in enabling certifiers to effectively protect their marks. These remedies truly are an arsenal and can be pursued either individually or in combination, depending on the specific objectives of the certification mark owner. Thus, when enforcing against infringement of one's certification mark, the certifier should carefully consider what it hopes to achieve through litigation. Different remedies may be better suited to address particular forms of infringement. By tailoring their approach to the unique facts of each case and drawing on the guidance provided in this article and the cases discussed, certifiers can help maximize the impact of their enforcement actions and safeguard the integrity of their certification marks.

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[127] 15 U.S.C. § 1117(c)(2).

[128] *See Space Chariot*, 250 F. Supp. 3d at 613 (noting that Space Chariot was purporting it was "safety certified" by UL and that it had met certain safety requirements).

COMMENTARY

OH, SNAP! A SHIFT IN CONSUMER PERCEPTION SURVEYS IN GENERICNESS LITIGATIONS AFTER *SNAP INC. V. VIDAL*[*]

By David H. Bernstein,[**] Jared I. Kagan,[***] and Daniel N. Cohen[****] [*****]

I. INTRODUCTION

In what may prove to be one of the most influential judicial decisions on the issue of trademark genericness since the Supreme Court's decision in *Booking.com*,[1] the Central District of California in *Snap Inc. v. Vidal* rejected the assertion of the United States Patent and Trademark Office ("USPTO") that the term "SPECTACLES" is generic for technology-embedded augmented reality ("AR") glasses, commonly referred to as smart glasses.[2] In the process, the court provided a masterclass on the kind of evidence that is relevant to the assessment of genericism, including a deep dive into consumer perception surveys concerning genericness. Specifically, in finding that the USPTO failed to meet its burden of proving by clear and convincing evidence[3] that Snap's

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[*] This commentary should be cited as David H. Bernstein, Jared I. Kagan & Daniel N. Cohen, *Oh, Snap! A Shift in Consumer Perception Surveys in Genericness Litigations After* Snap Inc. v. Vidal, 115 Trademark Rep. 680 (2025).

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[*****] Messrs. Bernstein, Kagan, and Cohen were part of the trial team representing Snap Inc. in the case discussed in this commentary.

[1] U.S. Pat. & Trademark Off. v. Booking.com B.V., 591 U.S. 549 (2020) (rejecting the USPTO *per se* rule that a generic term, when combined with the .com top-level domain, must automatically be deemed generic and consequently ineligible for trademark protection).

[2] Snap Inc. v. Vidal, 750 F. Supp. 3d 1120 (C.D. Cal. 2024).

[3] Up until the parties' Hearing on Post-Trial Briefs, including throughout the entirety of the bench trial, the USPTO argued that the burden of proof should be the simple "preponderance of the evidence" standard, as adopted by the May 2022 amendment to the Trademark Manual of Examining Procedure ("TMEP"). USPTO Examination Guide 1-22: Clarification of Examination Evidentiary Standard for Marks Refused as Generic (May 2022). Snap, in response, argued that the USPTO should be required to prove

SPECTACLES trademark for AR glasses was understood by the relevant public to be a generic name for AR glasses, the court heavily criticized, and ultimately declined to rely on, the USPTO's *Teflon*-style consumer perception survey, even though courts have generally expressed a preference for *Teflon*-style surveys when assessing whether a term is generic.[4]

This commentary briefly discusses the types of consumer perception surveys used in genericness litigations, details the *Teflon* survey presented by the USPTO in the *Snap* case, discusses the court's criticisms of that survey, describes the alternative *Thermos*-style survey submitted by Snap, and outlines some practical guidance for designing surveys in future genericness disputes.

II. CONSUMER PERCEPTION SURVEYS IN GENERICNESS LITIGATION

Although courts recognize several forms of evidence as relevant to the assessment of genericness (including dictionary definitions, generic use by third parties, generic use by the mark holder, media usage, and consumer usage, which also has been referred to as "voice of the consumer" evidence[5]), consumer surveys long have carried substantial weight (when they are conducted reliably).[6]

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genericness by "clear and convincing evidence," as that standard was plainly adopted by the Federal Circuit in cases like *In re Cordua Rests., Inc.*, 823 F.3d 594, 601 (Fed. Cir. 2016), *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009), and *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987). Furthermore, Snap argued, the USPTO cannot, through an Examination Guide or TMEP amendment, overrule the Federal Circuit. *See In re Isi, LLC*, Ser. No. 90523287, 2023 WL 4743716, at *7 (T.T.A.B. July 10, 2023) (the TMEP "does not have the force of law, is not binding, and cannot be considered a mandate") (quoting *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 1127 n.8 (Fed. Cir. 1994)).

The parties briefed the burden issue fully in their respective post-trial briefs (*Snap Inc. v. Vidal*, C.D. Cal. No. 2:22-cv-00085, ECF Nos. 143, 144) and addressed this issue at the hearing on those briefs. At that hearing, the Court noted that, if it were to accept Snap's argument, that would necessarily undermine the USPTO's position on the burden of proof in examinations before the USPTO and in cases nationwide. At that point, the Court offered the USPTO a face-saving solution, under which it would accept the clear and convincing evidence standard for this case given that the USPTO had applied that standard when Snap's SPECTACLES applications were under examination, and the TTAB had applied that standard on appeal, both of which occurred before the May 2022 amendment to the TMEP. To preserve its ability to defend the May 2022 amendments and to try to continue to apply the preponderance standard in other contexts, the USPTO agreed that the Court could apply the "clear and convincing evidence" standard in this case. *See* ECF No. 152 at 74:3–81:20.

4 E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel* [hereinafter *Genericness Surveys*], *in* Trademark & Deceptive Advertising Surveys: Law, Science, & Design 120 (Shari Seidman Diamond & Jerre B. Swann, eds., 2d ed. 2022).

5 *See* Brief of Professor Peter N. Golder, Ph.D., and Other Marketing Academics as *Amici Curiae* in Support of Respondent at 12-14, *Booking.com*, 2020 WL 1131479 at *10-11; *see also Booking.com*, 591 U.S. at 561 n.6 (referencing amicus brief).

6 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition [hereinafter McCarthy], § 12:14 (5th ed. 2025) ("Consumer surveys have become almost de rigueur in

Over the years, "[t]wo preferred models of surveys to test for genericness have been credited by the courts: The *Thermos* survey and the *Teflon* survey."[7]

The *Teflon*-style survey, first used in *E.I. DuPont de Nemours & Co. v. Yoshida International, Inc.*[8] to determine whether "TEFLON" was a generic name for nonstick coating, begins by educating respondents about the difference between a generic (or common) name and a brand name by defining both and providing examples of each (the so-called "mini-course"). In the *Teflon* case, the mini-course instructed respondents that "by *brand* name, [the surveyor meant] a word like *Chevrolet* which is made by one company; by *common* name, [the surveyor meant] a word like *automobile* which is made by a number of companies."[9]

Once respondents complete the mini-course, they proceed to a "mini-test" to determine whether they understand the common name/brand name distinction.[10] In the *Teflon* case, respondents were asked in the mini-test to characterize "washing machine" as either a common name or brand name.[11] Those who pass the mini-test proceed to the main survey, which presents the mark at issue alongside "control" terms,[12] including both common names and brand names, and asks the respondents to classify each of the marks as either a common name or brand name.[13] In the *Teflon* case, the term "TEFLON" was presented along with the following terms: "MARGARINE," "THERMOS," "REFRIGERATOR," "STP," "JELLO," "ASPIRIN," and "COKE."[14] If more than half of the respondents deem the tested term to be generic, that is generally seen as powerful evidence that the term is, in fact, a generic reference for the goods at issue.[15] In the *Teflon* case, 68% of

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litigation over genericness. Judges are now used to survey evidence and often expect to receive evidentiary assistance by surveys in resolving genericness disputes.").

7 *Id.*

8 393 F. Supp. 502 (E.D.N.Y. 1975).

9 McCarthy, *supra* note 6, § 12:16.

10 *Id.*

11 *Id.*

12 These "control" terms serve to disguise the particular term of interest, so the respondents do not know which term is being tested. Further, these "control" terms "are used to evaluate respondents' ability to distinguish brand names from common names, and they also provide a measure of the amount of guessing or 'noise' in the survey." *See* Jay, Genericness Surveys, *supra* note 4, at 131.

13 McCarthy, *supra* note 6, § 12:16.

14 *Id.*

15 *See* Jay, Genericness Surveys, *supra* note 4, at 135-36 (stating that "courts have found that a properly constructed and implemented Teflon Survey in which a majority classifies a mark as a brand name supports a nongenericness finding, or helps to create a material issue of fact as to whether the name is generic," and collecting cases); McCarthy, *supra* note 6, § 12:6 (stating that whether a term is a generic name depends on the principal significance of that term, and that, if the majority or the public or survey

respondents classified "TEFLON" as a brand name. Relying in part on this evidence, the court found that "TEFLON" was not a generic term.[16]

A *Thermos*-style survey provides a different way to assess whether a term is generic. That type of survey, named after the case in which it was first presented (*American Thermos Products Co. v. Aladdin Industries, Inc.*[17]), asks a series of open-ended questions to understand how potential consumers of the category of goods at issue would ask for or identify a product.[18] For example, in the original *Thermos* survey, which assessed whether THERMOS was generic for portable containers designed to keep liquids hot or cold, one of the questions asked respondents to identify words they would use for such a container (specifically, it asked respondents what they would tell a store clerk they were looking for).[19] The responses to these open-ended questions show what generic terms consumers use to refer to the goods at issue. Conversely, the absence of a particular term in response to the open-ended questions may be evidence that consumers do not use that term as a common name for the product class, which has been described as "highly relevant" toward a finding that the term is not generic.[20]

It is worth noting the key differences between these two survey methodologies. The *Teflon* survey is aided; it presents respondents with the term at issue and asks whether it is a common name or a brand name. In contrast, the *Thermos* survey is unaided; it probes consumers' minds to encourage them to identify the terms they consider to be generic for certain categories of goods or services.

Although courts may credit well-designed *Thermos* surveys,[21] the *Teflon* survey has become the "preferred format for genericness surveys."[22] For example, the district court in *Booking.com* characterized the *Teflon* survey in that case as "highly relevant" to "shed[ding] light on how the [mark] is understood by consumers,"

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respondents perceive a term to be a generic name, then that term should be found generic even if some smaller portion of the public recognizes the term to be a brand).

16 E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 526-27 (E.D.N.Y. 1975).

17 207 F. Supp. 9 (D. Conn. 1962).

18 McCarthy, *supra* note 6, § 12:15.

19 Am. Thermos Prods. Co. v. Aladdin Indus., Inc., 207 F. Supp. 9, 21 n.8 (D. Conn. 1962).

20 Booking.com B.V. v. U.S. Pat. & Trademark Off., 915 F.3d 171, 182-83 (4th Cir. 2019), *as amended* (Feb. 27, 2019) (ruling that district court did not err in finding the "absence of evidence" that consumers frequently used the term to describe the genus to be "highly relevant" to evaluating the term's primary significance), *judgment vacated on other grounds,* 141 S. Ct. 187 (2020).

21 *See, e.g.*, Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc., No. 1:04-cv-2112, 2007 WL 4563873, at *5-7 (N.D. Ga. July 17, 2007); E.T. Browne Drug Co. v. Cococare Prods., Inc., 538 F.3d 185, 195 (3d Cir. 2008).

22 Jay, Genericness Surveys, *supra* note 4, at 120.

and as the "preferred method of proving genericness."[23] Other courts have described the *Teflon* survey method as the "most accepted and used survey method for determining the generic name-trademark distinction,"[24] in part because it was originally described as "the only survey which really gets down to [the] critical element" of the genericness inquiry.[25] At least one court that was presented with competing *Teflon* and *Thermos* surveys, relied on the results from the *Teflon* survey alone.[26]

Although courts have generally shown a preference for *Teflon* surveys, past performance is not indicative of future results, and *Teflon* surveys are not immune from scrutiny. Where the survey is not carefully designed to account for the particular facts of a case, courts have declined to give substantial, and in some cases any, weight to such flawed surveys.[27] Such scrutiny is especially appropriate in light of the Supreme Court's caution in *Booking.com* that "[s]urveys . . . require care in their design and interpretation,"[28] and "[f]laws in a specific survey design . . . may limit the probative value of surveys in determining whether a particular mark is descriptive or generic."[29] Indeed, as Snap's survey expert testified at trial, when that care in design is applied, it will be evident that, in some cases, the *Thermos* methodology will be more effective at divining the terms consumers view as generic references for certain goods or services.[30] Moreover, as the Supreme Court recognized, "difficult questions may be presented when a term has multiple concurrent meanings to consumers or a meaning that has changed

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23 Booking.com B.V. v. Matal, 278 F. Supp. 3d 891, 917-18 (E.D. Va. 2017), *amended,* No. 1:16-CV-425, 2017 WL 4853755 (E.D. Va. Oct. 26, 2017), *aff'd sub nom.* Booking.com B.V. v. U.S. Pat. & Trademark Off., 915 F.3d 171 (4th Cir. 2019), *as amended* (Feb. 27, 2019), *cert. granted, judgment vacated,* 141 S. Ct. 187 (2020).

24 McCarthy, *supra* note 6, § 12:16 (collecting cases).

25 E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 527 (E.D.N.Y. 1975).

26 Premier Nutrition, Inc. v. Organic Food Bar, Inc., No. 06-cv-0827, 2008 WL 1913163, at *9-11 (C.D. Cal. Mar. 27, 2008), *aff'd*, 327 F. App'x 723 (9th Cir. 2009). Although the survey at issue in *Premier Nutrition* was not explicitly characterized as a *Thermos* survey, it was undoubtedly modeled after one. Specifically, in attempting to prove that the term "organic food bar" was not generic for nutrition bars, the survey presented respondents with several nutrition bars and asked what they would ask for if they were looking for that product in a grocery store. *Id.* at *10. The court found the survey flawed, explaining that the defendant "offer[ed] no case law in support of its open-ended questions," and that all the survey showed was that "organic food bar" might not be the *most* generic term, which, the court explained, doesn't prove non-genericness. *Id.* at *10-11.

27 *See, e.g.*, *In re* Hotels.com, L.P., 87 U.S.P.Q.2d 1100, 2008 WL 779325, at *10-12 (T.T.A.B. 2008), *aff'd*, 573 F.3d 1300 (Fed. Cir. 2009).

28 U.S. Patent & Trademark Office v. Booking.com B.V., 591 U.S. 549, 561 n.6 (2020).

29 *Id.* at 564 (Sotomayor, J., concurring).

30 Am. Transcript of Bench Trial [hereinafter Bench Trial Tr. Day 1] at 165, 168, 181, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. Apr. 10, 2024), ECF No. 138.

over time."[31] That "difficult question" is precisely what was at issue in *Snap*, as "SPECTACLES" has multiple concurrent meanings—it is an antiquated generic term for corrective eyewear, a description of visually striking performances or displays, and a brand name for Snap's AR glasses.[32]

III. THE USPTO'S *TEFLON* SURVEY

In *Snap*, the USPTO introduced two *Teflon* surveys (the second of which was a modified version of the first in response to criticisms against the first survey by Snap's survey expert).[33]

Both surveys used the same examples to educate respondents in the mini-course on the difference between brand names and common names, including iPHONE, HERO, and THINKREALITY as brand names and "smartphone," "camera," and "smart glasses" as common names.[34] Notably, the mini-course portion of the survey used one of the key generic terms for the goods at issue—"smart glasses"—which prevented the survey from being able to assess whether respondents identify that term as a generic term for the goods at issue. Additionally, the mini-course's examples of brand names were all arbitrary or fanciful terms (i.e., made-up words or words with no relationship to smart glasses);[35] the mini-course did not use descriptive terms with secondary meaning as examples of brand names. These design choices may have biased respondents into believing that only arbitrary or fanciful terms should be characterized as brand names for purposes of the questions in the survey.

The first survey's mini-test told respondents they would be shown a series of names "relating to smart glasses" and then presented respondents with two terms, "ANZU" and "DISPLAY," and asked the respondents to classify the terms as a common name or brand name.[36] Respondents who said they were unsure, said "ANZU" was a common name, or said "DISPLAY" was a brand name, were terminated from the survey because they failed to demonstrate an understanding of the difference between common names and brand names.[37]

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31 *Booking.com*, 591 U.S. at 561 n.6 (majority decision).

32 Snap Inc. v. Vidal, 750 F. Supp. 3d 1120, 1153-54 (C.D. Cal. 2024).

33 *Id.* at 1144. *See also* USPTO's Post-Trial Brief, Exhibit C, Part 10 [hereinafter Anderson Expert Report 1] at 91-434, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. May 1, 2024), ECF No. 144-12 (Plaintiff's Exhibit 271, containing expert report with Anderson's first *Teflon* survey); USPTO's Post Trial Brief, Exhibit C, Part 11 [hereinafter Anderson Expert Report 2] at 1-169, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. May 1, 2024), ECF No. 144-13 (Plaintiff's Exhibit 272, containing expert report with Anderson's second *Teflon* survey).

34 *Id.* at 1147.

35 *Id.*

36 *Id.*

37 Am. Transcript of Bench Trial [hereinafter Bench Trial Tr. Day 2] at 141-42, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. Apr. 10, 2024), ECF No. 139.

Respondents who classified both terms correctly moved onto the main survey where they were shown the following seven terms and asked to classify the terms as common names or brand names: "MOVERIO," "NREAL," "SOLOS," "SPECTACLES," "MICROPHONE," "PHOTOGRAPH," and "SCREEN."[38] Importantly, when respondents were shown these terms, they were not reminded to consider them in the context of "smart glasses"—an instruction that was presented only prior to the mini-test, and several questions before these terms were displayed.[39] That may have led some respondents to characterize "MICROPHONE," "SCREEN," "PHOTOGRAPH," and "SPECTACLES" as words that can be generic depending on the goods with which they are used (even if they are not generic terms for smart glasses).[40] As shown in the chart below, of the respondents that completed this survey, 82.4% classified "SPECTACLES" as a generic name.[41]

Do you think that [NAME] is a brand name that refers to a product that is made by only one company, a generic name that refers to a type of product that may be made by more than one company, or you don't know?	**Percent Who Classified the Term as a Generic Name**	**Percent Who Classified the Term as a Brand Name**	**Percent Who Did Not Know How to Classify the Term**
SPECTACLES	82.4%	15.2%	2.4%
Average of generic controls	94.2%	4.6%	1.3%
MICROPHONE	95.4%	4.0%	0.6%
SCREEN	94.3%	4.4%	1.4%
PHOTOGRAPH	92.9%	5.3%	1.8%
Average of brand controls	4.1%	93.4%	2.6%
MOVERIO	3.2%	93.9%	3.0%
SOLOS	5.0%	93.1%	2.0%
NREAL	4.2%	93.1%	2.8%

Excerpt from Anderson Expert Report 1[42]

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38 *Snap Inc.*, 750 F. Supp. 3d at 1147.

39 Bench Trial Tr. Day 2, *supra* note 37, at 143-44; Am. Transcript of Bench Trial [hereinafter Bench Trial Tr. Day 3] at 153-54, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. Apr. 10, 2024), ECF No. 140.

40 Bench Trial Tr. Day 3, *supra* note 39, at 154-56.

41 *Snap Inc.*, 750 F. Supp. 3d at 1145.

42 Anderson Expert Report 1 at 107. *See supra* note 33.

The second survey's mini-test presented respondents with two new terms, "STORIES" and "EYEWEAR," as potential common or brand names "relating to smart glasses," and utilized six new control terms, alongside "SPECTACLES" in the main survey: "VISION PRO," "ECHO FRAMES," "BLADE," "CAMERA GLASSES," "WIFI GLASSES," and "LENSES."[43] In this survey, the instruction to think about the names as "relating to smart glasses" was included with each question (as opposed to only before the mini-test), and 72.9% of respondents classified "SPECTACLES" as a generic name for "smart glasses."[44]

Do you think that [NAME] is a brand name that refers to a product that is made by only one company, a generic name that refers to a type of product that may be made by more than one company, or you don't know?	Percent Who Classified the Term as a Generic Name	Percent Who Classified the Term as a Brand Name	Percent Who Did Not Know How to Classify the Term
SPECTACLES	72.9%	23.8%	3.3%
Average of generic controls	86.0%	10.6%	3.3%
CAMERA GLASSES	90.5%	6.2%	3.3%
WIFI GLASSES	87.1%	10.5%	2.4%
LENSES	80.5%	15.2%	4.3%
Average of brand controls	5.5%	92.7%	1.7%
VISION PRO	4.3%	95.7%	0.0%
ECHO FRAMES	5.2%	91.4%	3.3%
BLADE	7.1%	91.0%	1.9%

Excerpt from Anderson Expert Report 2[45]

IV. SNAP'S *THERMOS* SURVEY

Snap's survey expert testified that the *Teflon*-style survey was a poor methodology for the facts of the case because (i) "SPECTACLES" has multiple meanings, which made challenging the use of the *Teflon* survey format, in which respondents were given a binary choice to classify a term as either brand or generic; (ii) the fact that most brand names in the relevant category were arbitrary or fanciful made selection of appropriate control names difficult; and (iii) given that most common names in the relevant category were plural (much like "SPECTACLES"), selection of appropriate control names compounded the challenge (since

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43 *Id.* at 1146.

44 *Id.*

45 Anderson Expert Report 2 at 47. *See supra* note 33.

respondents, upon seeing only plural terms as examples of generic terms, might have incorrectly drawn the conclusion that plural terms are generic).[46] Instead, Snap's expert testified, the *Thermos* approach was a more appropriate methodology given the descriptive nature of "SPECTACLES," which can have multiple concurrent meanings.[47]

Snap's *Thermos* survey[48] was designed to "empty the mind[s]"[49] of relevant consumers to understand the generic terms they would use to refer to the category of the products at issue. Specifically, the *Thermos* survey asked respondents questions like, "[w]hat word or words would you use to identify or describe eyeglasses that can connect to your smartphone via Bluetooth or Wi-Fi to provide features such as photo and audio/video capture?" or, if you wanted to purchase such a product, "what would you tell the salesperson you wanted, or what would you type into a search bar online?"[50] The results of Snap's *Thermos* survey demonstrated that, of the 273 respondents, only 4 (or 1.5% of total respondents) used "spectacles" as a generic term to refer to these goods.[51] The terms that were most commonly identified as generic references for these types of goods were "smart glasses" (60.1%), "Bluetooth/Wi-Fi/Wireless glasses" (47.6%), and other "smart" mentions (e.g., "smart tech," "smart device," and "smart design") (27.1%).[52]

V. THE COURT'S CRITIQUES OF THE USPTO'S *TEFLON* SURVEYS

Looking only at the results, and not at the methodology, the USPTO's surveys on their face would appear to provide evidence that consumers understand "SPECTACLES" to be a generic term for smart glasses. But the court identified several significant flaws in the USPTO's survey designs that rendered them unreliable for assessing genericness in this context.

The court identified four design flaws as the most significant: (1) the USPTO's *Teflon* surveys could not account for respondents who, while not recognizing "SPECTACLES" as a brand designation, did not think "SPECTACLES" was a generic name for smart glasses;

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46 Bench Trial Tr. Day 3, *supra* note 39, at 153-55, 171-73.

47 Bench Trial Tr. Day 1, *supra* note 30, at 179-80.

48 *See* Plaintiff's Admitted Exhibits, Volume 2 at 2-29, Snap Inc. v. Vidal, No. 2:22-cv-00085 (C.D. Cal. Apr. 2, 2024), ECF No. 136-2 (Plaintiff's Trial Exhibit 13, which contains Expert Report of Brian Sowers [hereinafter, Sowers Expert Report], without appendices).

49 Bench Trial Tr. Day 1, *supra* note 30, at 165.

50 Bench Trial Tr. Day 1, *supra* note 30, at 170-72.

51 *Id.* at 174-75, 185 (testimony from Snap's expert, Brian Sowers, about the results of his *Thermos* survey); *see also* Sowers Expert Report, *supra* note 48, at 26.

52 *Id.*

(2) the USPTO's *Teflon* surveys conditioned respondents to believe that fanciful and arbitrary terms for smart glasses are brand names while common vernacular words for technology products are generic names; (3) the USPTO's *Teflon* surveys utilized mini-test control names that likely biased the representativeness of each of the relevant consumer samples; and (4) the results of the USPTO's *Teflon* surveys were riddled with uncertainty due to improper question design.[53] Because of these design flaws, described in greater detail below, the court concluded that "this consumer survey evidence cannot carry the PTO's burden."[54]

A. Failure to Account for Respondents' Deeming "SPECTACLES" Descriptive, Rather than Generic

First, the court explained, the USPTO's *Teflon* surveys took for granted an unproven assumption that ran throughout the USPTO's entire case: that any terms consumers may associate with eyewear, including smart glasses, can only be unprotectible generic terms and never registrable descriptive marks.[55] Prior to trial, when the court denied the USPTO's motion for summary judgment, it specifically criticized this unproven assumption.[56] The court explained that it viewed the USPTO's argument as relying on three logical steps: (i) "spectacles" is generic for "eyeglasses," (ii) "eyeglasses" is a "portion" or "part" of "smart glasses," and therefore, (iii) "spectacles" is generic for "smart glasses."[57] The court explained that just because "spectacles" is generic for one component of the product (i.e., "smart glasses"), it is not necessarily the case that "spectacles" is itself generic for the same product.[58] The court explained that there is a reasonable scenario in which "smart glasses" and "eyeglasses" could be placed in separate, though at times overlapping, categories.[59] In such a scenario, the USPTO's proffered reasoning fails, since even if "spectacles" is a generic term for eyeglasses, that would not necessarily mean it is a generic term for smart glasses, a product in a separate, distinct category.[60]

Because the USPTO's survey expert relied on this unsupported assumption in designing the *Teflon* surveys, the court was skeptical of the seemingly high percentage of respondents classifying

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53 Snap Inc. v. Vidal, 750 F. Supp. 3d 1120, 1146-51 (C.D. Cal. 2024).

54 *Id.* at 1151.

55 *Id.* at 1146-48.

56 Snap Inc. v. Vidal, 721 F. Supp. 3d 1070, 1075-77 (C.D. Cal. 2024).

57 *Id.* at 1075-76.

58 *Id.* at 1076-77.

59 *Id.*

60 *Id.*

"SPECTACLES" as a generic name for "smart glasses."[61] Specifically, the court pointed out that the *Teflon* surveys proffered by the USPTO forced the respondents to select between "generic name" and "brand name," despite being presented with terms that could arguably be deemed descriptive (and therefore neither generic nor a brand name).[62] Because "generic" was the only option other than "brand," the court reasoned that, when presented with terms such as "LENSES," "SCREEN," or "EYEWEAR," respondents who otherwise might have deemed those terms descriptive of "smart glasses" classified them as "generic," simply because they did not recognize them as brand names. As a result, the court explained, it could not determine what proportion of those respondents who classified "SPECTACLES" as generic did so because they actually thought "SPECTACLES" was generic, as opposed to thinking "SPECTACLES" simply was not a brand name and therefore chose the only other available option.[63] Because descriptive marks are eligible for trademark protection upon a showing of secondary meaning, this flaw was significant, and the court recognized that a critical mass of respondents may very well have selected "generic" only because they did not believe "SPECTACLES" was a brand name (but would have categorized it as descriptive if given that option).[64]

B. Improper Selection of Control Names

Second, the court criticized the selection of control names in the USPTO's *Teflon* surveys. Specifically, the court highlighted the "stark contrast in the corresponding pairs of control brand and generic names."[65] As noted above, as part of the initial mini-course, respondents were affirmatively instructed that words like "HERO," "ANZU," and "THINKREALITY" were brand names for smart glasses, and words like "CAMERA," "DISPLAY," and "SMART GLASSES" were generic names for smart glasses.[66] The court criticized the use of these names because they could result in a demand effect[67]—that is, respondents may have taken the use of

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61 Snap Inc. v. Vidal, 750 F. Supp. 3d 1120, 1146-47 (C.D. Cal. 2024).

62 *Id.*

63 *Id.* at 1147.

64 *Id.* ("[T]he percentages of consumers who classified SPECTACLES as a generic name strictly according to Anderson's survey design cannot differentiate those who, while they may not have recognized the mark as a brand designation, still may have thought the mark was only descriptive of smart glasses rather than a generic name for the product.").

65 *Id.*

66 *Id.*

67 McCarthy, *supra* note 6, § 32:172 ("'Demand Effects' in a survey are produced when respondents use cues from the survey procedures and questions to infer the purpose of the survey and identity the 'correct' answers.").

these names as a cue that the survey was seeking to have them categorize all descriptive terms as common names and all fanciful or arbitrary terms as brand names.[68] The court explained that, given the nature of the terms selected to instruct respondents on the distinction between common names and brand names, it was no surprise that many respondents classified "SPECTACLES" as generic.[69] In other words, respondents were essentially trained to believe a brand name must be arbitrary or fanciful (along the lines of ANZU or THINKREALITY), and because "SPECTACLES" did not align with those examples, respondents were pushed toward characterizing it as generic.[70] Further contributing to this "demand effect" was what the court characterized as the "conceptual closeness" between "SPECTACLES" and the generic examples provided ("LENSES," "SCREEN," and "EYEWEAR").[71] Because "SPECTACLES" led the respondents to conjure up a product that was closer to the generic examples provided than the fanciful brand examples provided, respondents were biased into categorizing "SPECTACLES" as generic.[72]

C. Biased Respondent Pool Due to Improper Screening Criteria

Third, the court concluded that the control names used in the mini-test biased the ultimate respondent pool because it only allowed respondents to proceed beyond the mini-test if they believed that dictionary words describing some element of smart glasses ("DISPLAY" and "EYEWEAR") are common terms (even though neither is technically a generic term for smart glasses).[73]

Specifically, in the mini-tests for both surveys, the only respondents who were allowed to take the survey were those who classified "DISPLAY" (for the first survey) and "EYEWEAR" (for the second survey) as generic names for smart glasses.[74] However, as the court recognized, those terms, at best, *describe* an aspect of smart glasses and are not themselves generic terms for smart glasses.[75] Accordingly, respondents who passed the mini-test and advanced to the main survey were those with an incorrect

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68 *Snap Inc.*, 750 F. Supp. 3d at 1147-48.

69 *Id.* at 1148.

70 *Id.*

71 *Id.* ("[T]he conceptual closeness between SPECTACLES and the inherently nondistinctive generic names is impossible to miss: two have 'GLASSES' in the names while the third, LENSES, is the name of an object probably most associated with eyewear.").

72 *Id.*

73 *Id.* at 1148-49.

74 *Id.*

75 *Id.* at 1149.

understanding that a term that describes an aspect of the product at issue is a generic term.[76] As Snap's expert explained in his rebuttal testimony, that meant that the survey was biased to include only those respondents who were likely to characterize "SPECTACLES" as generic as well since "SPECTACLES" is also a term that could describe an aspect of smart glasses.[77]

D. Improper Question Design in Main Survey

The fourth flaw identified by the court was that the questions in the USPTO's surveys were improperly phrased. Respondents in the USPTO's surveys were instructed to think about the terms used in the questionnaires as they "relat[e]" to smart glasses.[78] When viewing each term, respondents were asked whether the terms are brand names that "refer[ ]" to a product that is made by one company or are generic names that "refer[ ]" to a type of product made by more than one company.[79] However, as the court rightly explained, merely relating or referring to a product category is not enough to make a term a generic name for that product.[80] For example, a word like "CAMERA" or "HIGH-TECH" might *refer* to a product such as smart glasses, but that does not make either a generic term *for* "smart glasses." In the court's view, the way in which the USPTO's surveys asked the questions was "misleading and incorrect" and "smear[ed] the critical line between a generic name and a descriptive word."[81]

The court held that this improper question design, combined with the improper selection of control names, compounded the flaws in the survey.[82] In particular, respondents were provided with generic examples such as "DISPLAY," "SCREEN," "MICROPHONE," "EYEWEAR," and "LENSES," each of which is a common word relating to ordinary eyewear (or some feature/component of smart glasses), but none of which are *themselves* actually generic for the product category at issue.[83] With that understanding, and the instruction that merely *referring to* a

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76 *Id.*

77 Bench Trial Tr. Day 1, *supra* note 30 at 180; Bench Trial Tr. Day 3, *supra* note 39-40 at 171-73.

78 *Snap Inc.*, 750 F. Supp. 3d at 1147-48.

79 *Id.* Specifically, the question for each control and test name read as follows: "Thinking about names **relating** to smart glasses, do you think that [TERM] is a brand name that **refers** to a product that is made by only one company, a generic name that **refers** to a type of product that may be made by more than one company, or you don't know?" Anderson Expert Report 2, *supra* note 33 at 44 (emphases added).

80 *Snap Inc.*, 750 F. Supp. 3d at 1150.

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

82 *Id.* at 1150-51.

83 *Id.*

product was sufficient for classification, it is no surprise respondents likewise characterized "SPECTACLES," another common ordinary eyewear term, as generic.[84]

As the court rightly asked, "[i]f respondents were asked to think[ ] of names relating to smart glasses and told that it is enough if the word refers to a product, is there much chance that most wouldn't classify SPECTACLES alongside the generic control names in the right-hand column?"[85] (referencing the table below, which is quoted from *Snap*[86]).

Distinctive Names	Disputed Name	Nondistinctive Names
HERO	*SPECTACLES*	*CAMERA*
ANZU		*DISPLAY*
STORIES		*EYEWEAR*
SOLOS		*MICROPHONE*
MOVERIO		*PHOTOGRAPH*
NREAL		*SCREEN*
VISION PRO		CAMERA *GLASSES*
ECHO *FRAMES*		WIFI *GLASSES*
BLADE		*LENSES*

VI. THE COURT'S COMMENTS ON SNAP'S *THERMOS* SURVEY

The court ultimately did not reach the question of whether Snap's *Thermos* survey was sufficient to prove that the mark was not generic, given that the USPTO bore the burden of proving that "SPECTACLES" was generic and failed to do so. The court did note, however, that, had it more fulsomely considered Snap's *Thermos* survey, the results would have prevented the USPTO from meeting its burden of proving that "SPECTACLES" was generic.[87] The court further commented that, although it was skeptical of the usefulness of some of the *Thermos* survey questions, one question was particularly relevant: namely, what would respondents tell a salesperson they wanted, or what they would type into a search bar

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84 *Id.*

85 *Id.* at 1150 (internal quotation marks omitted).

86 *Id.* (italics and boldface in original).

87 *Id.* at 1151 n.17 ("There is no need, as a result, to weigh the Teflon surveys against Snap's Thermos survey[.] If the court were to consider that evidence, though, it would prevent the PTO from carrying its burden even by a preponderance of the evidence.").

online, if they wanted to purchase smart glasses.[88] The court highlighted that only 1 out of 273 respondents said "spectacles" in response to this question.[89] The court's acknowledgement that Snap's *Thermos* survey would have been sufficient to rebut the USPTO's evidence that "SPECTACTLES" was a generic term indicates that the court believed the *Thermos* results to be probative to establish that "SPECTACTLES" is not a generic term for AR glasses.

VII. PRACTICAL GUIDANCE FOR FUTURE GENERICNESS LITIGATIONS

The *Snap* opinion underscores the importance of thoughtful design choices when crafting genericness surveys, whether in the context of prosecutions before the USPTO, registration, opposition and cancellations challenges in the TTAB or federal courts, or infringement litigations. As the opinion makes clear, when designing genericness surveys, it is crucial to select the appropriate methodology and carefully tailor the survey to the specific circumstances of the case. Although both *Teflon* and *Thermos* surveys are accepted by the USPTO, TTAB, and federal courts, the context and characteristics of the term at issue—such as its descriptiveness and the availability of suitable control names—can influence which approach is more reliable. Survey designers should avoid introducing bias, consider adapting standard formats to address descriptive terms (including, when appropriate, by designing modified versions of the standard *Teflon* and *Thermos* surveys), and ensure that questions are focused solely on the core inquiry of genericness. Properly crafted questions are essential to elicit relevant, unambiguous responses and produce reliable results. Additional guidance for designing genericness surveys post-*Snap* is described in more detail below:

- **Where the term at issue is arguably highly descriptive, a *Thermos* survey may be more probative than a *Teflon* survey.** It is important to recognize that both survey methodologies are accepted by federal courts, and although *Teflon* surveys have received some preferential treatment, context is key. As seen in *Snap*, there are some factual circumstances that a *Teflon* survey may not be well suited to address, and rather than pushing the *Teflon* survey past its capabilities, it may be a smart choice to consider alternative methodologies.
- **Consider the availability of appropriate control names.** When considering a mark that makes selection of

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[88] *Id.*

[89] *Id.*

effective control names difficult, the *Thermos* survey may be preferable because it does not require the selection of control names at all, thus eliminating the potential bias that can be caused by use of specific control names and avoiding doubts about the reliability of the answers. For example, in *Snap*, almost all the available brand names in the relevant product category were arbitrary or fanciful, and almost all the available common names were plural, which led to the demand effects discussed above, ultimately making the *Teflon* survey results unreliable. In designing genericness surveys, it may be advisable to adjust the survey format, rather than pursuing a *Teflon* survey that may result in biased responses.

- **Avoid introducing demand effects (e.g., through leading questions) when selecting control names.** Where the term being tested is neither arbitrary nor fanciful, selection of highly arbitrary or fanciful names for brand control terms risks implicitly and misleadingly educating respondents that brand names must be arbitrary or fanciful, and anything else, even a descriptive, non-generic mark, must then be a common name (which of course, is incorrect).
- **Consider adapting the *Teflon* survey to the circumstances at hand.** If using a *Teflon* survey for a term that may be considered descriptive, consider educating respondents in the mini-course and mini-test on brand names that are descriptive but have secondary meaning (e.g., American Airlines). Another approach may be to modify the standard *Teflon* survey to provide three categories: generic terms, descriptive terms, and brand names. Another modification that may be worth considering would be to include in the survey an option for respondents to indicate that, although they do not believe the term is a brand name, they also do not believe the term is a generic name. Allowing respondents to select "descriptive" as a third option (or neither a generic term nor a brand name) would clarify the percentage of respondents who truly believe the term is generic, bolstering the reliability of the ultimate survey results. Such deviations from the industry-standard *Teflon* survey are not unprecedented.[90]

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[90] *See, e.g.*, vonRosenberg v. Lawrence, 413 F. Supp. 3d 437, 448 (D.S.C. 2019) (explaining that the *Teflon* survey presented should have been adapted to ask if the mark at issue "refer[red] to an organization or a religion" as opposed to a "trademark name versus a category name"); Zipee Corp. v. U.S. Postal Serv., 140 F. Supp. 2d 1084, 1087 (D. Or. 2000) (explaining that "[a]sking consumers to choose between a 'common name' or a 'brand name' when describing 'postal service' is simply too narrow since it fails to give the consumer the option of identifying the phrase as a reference to an organization"); *see also* Jay, Genericness Surveys, *supra* note 4, at 128-29.

- **Carefully tailor questions to the core inquiry only.** For genericness surveys, the questions should all be directed at the core inquiry: whether respondents consider the term being tested to be a generic name for the relevant product category. Questions that go beyond that core inquiry by asking about whether the term is a brand (which could be an arbitrary term or a fanciful term or a suggestive term or a descriptive term with secondary meaning) run the risk of skewing results and rendering them unreliable. Specifically, since there is such a broad range of marks that can be a brand, from the utterly arbitrary to the obviously descriptive, and everything in between, bringing that range into a respondent's mind when their sole task should be determining whether a mark is generic or not may cause confusion. Although *Teflon* surveys have long asked respondents whether the terms presented are generic names *or* brand names, perhaps it is time to consider whether the respondents should merely be asked if the marks presented are generic names or *not* generic names. In support of this change, it should not be forgotten that *Teflon* surveys are *genericness* surveys, not secondary meaning surveys, and ultimately, whether a consumer classifies the mark at issue as a *brand* is ancillary to an inquiry that focuses on whether a term is generic.
- **Ensure that survey questions are drafted to elicit a relevant response.** In designing survey questions for genericness surveys, be sure to elicit answers that are responsive to the inquiry at issue. In the *Snap* case, due to the design of the questions in the USPTO's *Teflon* surveys, it was impossible to tell how many respondents classified "SPECTACLES" as a generic term only because they believed it *related or referred to* smart glasses. In particular, because *Teflon* surveys do not generally include open-ended questions, there is no opportunity for respondents to indicate *why* they have characterized a term as a common name or brand name. As a result, if the way the questions are crafted allows for ambiguous responses (i.e., a respondent that characterized a mark as generic either (i) thought it was generic full stop or (ii) thought it was generic merely because it related to smart glasses), then the ultimate answer may not be helpful, and therefore deemed not relevant. In other words, if all the responses that characterized "SPECTACLES" as generic did so merely because they thought "SPECTACLES" *refers to* smart glasses in some way, and not because it was in fact a generic term, then the survey provided no helpful information on the issue of genericness. Because here, the questions were not carefully

crafted to elicit responses that answer the inquiry at issue (because they allowed for that ambiguity), the survey results were unpersuasive and unreliable.

- **Consider the Appropriate Burden of Proof.** In examinations, the USPTO will likely continue to follow USPTO Examination Guide 1-22: Clarification of Examination Evidentiary Standard for Marks Refused as Generic (May 2022), which provides that the USPTO need only prove that a mark is generic by a preponderance of the evidence. In close cases, applicants should consider challenging that Examination Guide on the ground that the USPTO cannot overturn controlling Federal Circuit precedent through an examination guide, and that the USPTO must meet a heightened burden of proving a mark generic by clear and convincing evidence. *See, generally*, note 3, *supra*.

BOOK REVIEW*

*By Mathilde P. Florenson***

Les grands arrets du droit vitivinicole. *Sous la direction de Théodore Georgopoulos*. 2022. Pp. 636. 53,99 €. Edition Mare & Martin.***

Viti-viniculture encompasses all aspects of the wine-making process—from grapevine growth and cultivation (viticulture) to the art and science of making wine (viniculture) and its trade. In France and most European countries, viti-viniculture is subject to labyrinthine rules and regulations, and an equally complex body of case law. Rulings emanate from various legal bodies, including national and European courts, administrative and judicial courts, trademark offices, competitive authorities, and the like, to create a dense, complicated, and sometimes inconsistent jurisprudence.

Les grands arrets du droit vitivinicole (or *Landmark Cases in the Field of Viti-viniculture*, as I translate it and subsequently will refer to it in my review) offers a meticulously curated selection of pivotal cases that have shaped the field of viti-viniculture over the years and continue to be relevant for its future. Although it does not encompass all the jurisprudence on the subject—nor could any textbook—it serves as an invaluable resource for students and professionals seeking to understand key decisions and their impact on the wine industry.

The expertise laid out in this book stems from years of research, study, and practical experience. Twenty-seven specialists, including law professors and professionals, contributed to writing it under the editorial supervision of Théodore Georgopoulos— a renowned expert who has been researching and teaching Wine, Spirits & Food Law for decades, including in numerous prestigious schools in France (University of Reims Champagne-Ardenne, Aix-Marseille University and Sciences-Po), the United States (University of California, Berkeley; Harvard University; Stanford University; University of California, Davis; and New York University), and Canada (McGill University), to name a few.

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* This book review should be cited as Mathilde P. Florenson, *Book Review: Les grands arrets du droit vitivinicole, sous la direction de Théodore Georgopoulos*, 115 Trademark Rep. 698 (2025).

** Attorney, Law Office of Carrie Hedayati, Member, International Trademark Association.

*** This book currently is available only in its original language of French. Ms. Florenson, a native French speaker, read this book in French and then wrote her review of it in English.

Landmark Cases in the Field of Viti-viniculture is divided into thematic sections, each focusing on different aspects of the literal and metaphorical field. Decisions that impact vineyards (e.g., leases, taxes, etc.) are examined in one section. Sections featuring seminal cases affecting the wine itself (e.g., flavors, additives, alcohol content, etc.), its packaging (e.g., labels, trade dress, etc.) and commercialization (e.g., purchasing contracts, shipping regulation, etc.) follow.

An entire section is dedicated to foundational cases on geographical indications. It covers the French Supreme Court's famous ruling allowing use of the term "Champagne" in advertising for CHAMPOMY sparkling apple juice, the reasoning being that after two decades of use, the CHAMPOMY mark had established its own distinct identity associated with children's parties, and determining that confusion with the protected designation was no longer likely.[1] The authors also discuss *CIVC v. Aldi Sud Dienstleistungs-GmbH*,[2] where the Court of Justice of the European Union ("CJEU") held that "champagne sorbet" did not infringe on the CHAMPAGNE designation, since one of its essential characteristics was a taste attributable primarily to the presence of Champagne wine in its ingredients. Important cases on other geographical indications are also explored, such as the CJEU's ruling explaining that the average European consumer must think directly of "Scotch Whisky" when confronted with the German whisky GLEN BUCHENBACH; it is not sufficient for the disputed mark to evoke some vague association with the protected geographical indication.[3]

The textbook also delves into major rulings that are not explicitly about wine or spirits but have, nonetheless, impacted the field of viti-viniculture. For instance, the authors meticulously analyze the *Coty Germany GmbH v. Parfümerie Akzente GmbH*[4] case, in which the CJEU ruled that suppliers of luxury goods may prohibit retailers from selling their products on third-party online marketplaces, concentrating their focus on the court's interpretation of "luxury goods" and assessing its impact on luxury wine suppliers. The textbook also does not limit its range to cases originating from French and EU courts and authorities. Indeed, it ends with a comparative study of the U.S. Supreme Court's notable *Granholm v. Heald*[5] case, which established that states may not

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1 Cass. com., Jul. 7, 2009, No. 08-10.817.

2 Case C-393/16, Comité Interprofessionel du Vin de Champagne v. Aldi Sud Dienstleistungs-GmbH, 2017 ECLI:EU:2017:991.

3 Case C-44/17, Scotch Whisky Association v. Michael Klotz, 2018 ECLI:EI:C:2018:415.

4 Case C-230/16, Coty Germany GmbH v. Parfümerie Akzente GmbH, 2017 ECLI:EU:C:2017:941.

5 544 U.S. 460 (2005).

ban, or severely restrict, the direct shipment of wine by out-of-state wineries to consumers while simultaneously allowing shipment by in-state wineries.

Its scholarly approach, meticulous research, and insightful analysis make *Landmark Cases in the Field of Viti-viniculture* an essential read for students, legal professionals, and wine professionals seeking to deepen their understanding of the legal landscape of viti-viniculture. However, the book's current availability in French only is a significant limitation. English-speaking students and professionals would benefit immensely from having access to this wealth of knowledge and perspective.

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