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“CONTINUING COMMERCIAL IMPRESSION” AND ITS MEASUREMENT*

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and

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Under the Lanham Act, abandonment of a trademark occurs in two general situations. In the first, a mark is deemed abandoned if its use has been discontinued with intent not to resume such use. In the second, a mark is deemed abandoned when any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it its use or otherwise to lose its significance as a mark.¹

The first situation focuses on the intent of the trademark owner not to resume use. In many cases the intent not to resume use is proved circumstantially, “with the necessary inference being drawn from a showing of a sustained period of non-use.”² The Lanham Act specifically provides that nonuse for three consecutive years shall be prima facie evidence of abandonment.³ While the intent of the trademark owner is determinative, the perspective of the consuming public also is, or should be, relevant. A trademark is “a

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¹ 15 U.S.C.A. § 1127 (2000).

² ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS (2003) at 757.

³ 15 U.S.C.A. § 1127 (2000). “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark. *Id.* Thus, neither promotional use of the mark on goods in a different course of trade nor mere token use constitutes “use” under the Lanham Act. *Iowa Health System v. Trinity Health Corp.*, 177 F. Supp.2d 897, 919 (N.D. Iowa 2001).

shorthand way that merchants communicate data to the public about the attributes and qualities of their goods and services. If a mark continues to have such significance to the public, a court should hesitate to declare it abandoned.”⁴

In determining whether a mark continues to have such significance, courts and administrative tribunals often attempt to assess whether the mark has a “continuing commercial impression.” The “commercial impression” of a trademark is the meaning or idea it conveys, or the mental reaction it evokes.⁵ “Continuing commercial impression” may manifest in one of two ways. In the first instance, although a mark is not used for a period of time, the public continues to have accurate lingering impressions associated with it. An example is Rheingold beer. Although the beer is no longer manufactured and sold, many New Yorkers over the age of 50 -- whether they were beer drinkers or not -- remember Rheingold and its long-running sponsorship of the famous “Miss Subways” campaign. In the second instance, corporations periodically make slight modifications to their marks and trade dress, often in an effort to update and modernize them. Famous examples are the likeness of Betty Crocker and the trade dress of Ivory Soap, both of which have undergone numerous iterations since their inceptions.

Judicial efforts to assess continuing commercial impression are the subject of this article. The article first examines the development of the doctrine and its application by the judiciary. The article then discusses the only two known empirical assessments of continuing commercial impression in connection with trade dress and word mark infringement.⁶

⁴ SCHECHTER & THOMAS, *supra* note 2, at 759.

⁵ *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1296 (C.C.P.A. 1974).

⁶ Commercial impression is relevant in a wide range of trademark contexts. *See generally* David W. Barnes & Teresa A. Laky, *Classic Fair Use of Trademarks: Confusion About Defenses*, 20 SANTA CLARA

THE DOCTRINE OF CONTINUING COMMERCIAL IMPRESSION

1. Abandonment

Abandonment destroys a trademark, with the effect that anyone has the right to seize it immediately and acquire rights superior to the rest of the world.⁷ Whereas the first Lanham Act situation described above focuses on intent, the latter does not. As indicated, in the first instance, abandonment may be found when the use of a mark has been discontinued with intent not to resume such use. The prima facie case of abandonment that results from three consecutive years of nonuse may be rebutted by showing valid reasons for nonuse or lack of intent to abandon the mark.⁸ Abandonment is generally determined by objective, rather than subjective, factors. Hence an owner's testimony concerning lack of intent to abandon may be rebutted by objective contrary evidence.⁹

In the second situation, the Lanham Act provides that abandonment may be premised upon any act or omission of the registrant that causes the mark to lose its significance as an indicator of origin.¹⁰ A trademark may be abandoned expressly¹¹ or

COMPUTER & HIGH TECH. L.J. 833, 857 n.91 (2004) (commercial impression is relevant, *inter alia*, to determine whether: trade dress is used as a mark, a combination of descriptive and other unregistrable components of a term together create a distinctive enough impact to qualify as a mark, and amendments to a registered trademark constitute impermissible material alterations). *See also* In re Shirts Illustrated, LLC, 2003 WL 21371594 (T.T.A.B. 2003) (descriptive mark denied registration in part because it did not create same continuing commercial impression as another mark).

⁷ LOUIS ALTMAN, 3 CALLMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:75 (4th ed. 2004); Alliant Energy Corp. v. Alltel Corp., 344 F. Supp.2d 1176, 1189 (S.D. Iowa 2004).

⁸ Zelinski v. Columbia 300, Inc., 335 F.3d 633, 639 (7th Cir. 2003); Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 411 (9th Cir. 1996). In some circuits, a showing of nonuse shifts the burden of persuasion to the trademark owner to show intent to resume. In other circuits, prima facie abandonment creates only a rebuttable presumption of abandonment. *Id.* at 411 n.4. *See also* Hasbro, Inc. v. Goldman, 2005 WL 2295194 (T.T.A.B. 2005) (while the burden to produce evidence shifts, the burden of persuasion by a preponderance of evidence remains with the party asserting abandonment).

⁹ Sloan v. Auditron Elec. Corp., 68 Fed. Appx. 386, *5 (4th Cir. 2003); W. MICHAEL GARNER, 2 FRANCHISE & DISTRIBUTION LAW AND PRACTICE § 7:17 (2004).

¹⁰ Exxon Corp. v. Oxxford Clothes, Inc., 109 F.3d 1070, 1079 (5th Cir. 1997).

¹¹ 37 C.F.R. § 2.68 (2005).

inadvertently, by uncontrolled or naked licensing,¹² misuse, mutilation of the mark, or nonuse. (Conversely, failure to police infringement generally does not constitute abandonment.)¹³ Intent is not relevant with respect to any of the foregoing.¹⁴ Abandonment is effective even if the goodwill of the mark survives.¹⁵

Rights in a mark may be abandoned in certain geographic areas but not others.¹⁶ Where non-use is due to circumstances beyond the control of the trademark owner, no abandonment will be found. A plaintiff who abandoned a mark will be entitled to relief if he “replaces the mark with another, but confusingly similar mark, and adoption of the abandoned mark took place after the plaintiff’s adoption of the replacement mark.”¹⁷

Abandonment is an affirmative defense. Because it is in the nature of a forfeiture, courts often state that a party must satisfy a strict standard of proof when asserting that a

¹² Naked licenses are those licenses that fail to exercise adequate quality control over use by the licensee. *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 764 (6th Cir. 2005); *Barcamerica Int’l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 595-96 (9th Cir. 2002). A licensor who engages in naked licensing abandons the trademark or trade name. However, the majority view is that the existence of a legal right of the licensor to control the quality of its licensee’s activities is neither necessary nor sufficient. Rather, it is the control in fact of the quality of the licensee’s goods or services that is dispositive. *Ritchie v. Williams*, 395 F.3d 283, 290 (6th Cir. 2005). The lack of an express contractual right to inspect and supervise a licensee’s operations is not conclusive evidence of lack of control. Indeed, courts have upheld licensing agreements where the licensor is familiar with and relies upon the licensee’s own efforts to control quality. *Barcamerica Int’l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596 (9th Cir. 2002).

¹³ See, e.g., *Big Island Candies, Inc. v. Cookie Corner*, 244 F. Supp.2d 1086, 1095 (D. Haw. 2003) (“In the Ninth Circuit, however, failure to sue other potential infringers does not constitute abandonment.”); *Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984) (failure to police does not constitute abandonment); and *SCHECHTER & THOMAS*, *supra* note 2, at 759 (“While the failure to sue infringers might jeopardize a mark owner’s ability to protect its mark or prevail in any given lawsuit, it does not technically constitute abandonment.”). For a recent discussion of naked licensing and policing, see *Rudolph J. Kaus*, Comment, *The Naked Licensing Doctrine Exposed: How Courts Interpret the Lanham Act to Require Licensors to Police Their Licensees and Why This Requirement Conflicts with Modern Licensing Realities and the Goals of Trademark Law*, 9 MARQ. INTELL. P. L. REV. 361 (2005).

¹⁴ See, e.g., *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1080 (5th Cir. 1997) (intent to abandon is expressly not required to prove abandonment by naked licensing).

¹⁵ 3 Callman, *supra* note 7, at § 20:75.

¹⁶ *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 765 (6th Cir. 2005).

¹⁷ 3 Callman, *supra* note 7, at § 20:75.

trademark holder has abandoned his mark.¹⁸ This is particularly true where the trademark owner had no subjective intent to abandon the mark, as in the case of naked licensing.¹⁹

2. Tacking

A number of federal courts have recognized the doctrine of “tacking” in trademark cases, pursuant to which a trademark owner can claim priority in a mark based on the first use date of a similar, but technically distinct mark. Under this constructive use theory, the trademark owner seeks to tack his first use date in the earlier mark onto the subsequent mark.²⁰ Tacking does not apply where plaintiff does not assert priority of use in connection with a new mark.²¹ Where tacking applies, it provides an effective defense to a claim of abandonment.

Sound policy considerations support the notion of tacking. Absent the doctrine, a trademark owner’s priority in his mark “would be reduced each time he made the slightest alteration to the mark, which would discourage him from altering the mark in response to changing consumer preferences, evolving aesthetic developments, or new advertising and marketing styles.”²² Further, granting a trademark owner the same rights in a new mark that he has in an old one “helps to protect source-identifying trademarks

¹⁸ See, e.g., *Marshak v. Treadwell*, 240 F.3d 184, 198 (3d Cir. 2001).

¹⁹ See, e.g., *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 765 (6th Cir. 2005); *Alpha Tau Omega Fraternity, Inc. v. Pure Country, Inc.*, 2004 WL 3391781, *10 (S.D. Ind. Oct. 26, 2004); and *Halo Mgt., LLC v. Interland, Inc.*, 2004 WL 1781013, *3 (N.D. Cal. Aug. 10, 2004). See also 2 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 17.12 at 17-19 (4th ed. 2004) (“Since abandonment results in a forfeiture of rights, the courts are reluctant to find an abandonment.”).

²⁰ See generally 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 17:25-27 (4th ed. 2004). For an early discussion of tacking, see Lefkowitz, *Tips from the T.T.A.B. (Re Tacking on of Use)*, 66 TRADEMARK RPTR. 530 (1976).

²¹ *Levi Strauss & Co., v. GTFM, Inc.*, 196 F. Supp.2d 971, 984 (N.D. Cal. 2002).

²² *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999). Accord *Levi Strauss & Co. v. GTFM, Inc.*, 196 F. Supp.2d 971, 984 (N.D. Cal. 2002).

from appropriation by competitors and thus furthers the trademark law's objective of reducing the costs that customers incur in shopping and making purchasing decisions."²³

Courts have frequently specified that the standard for tacking is very strict. In *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*,²⁴ decided in 1991, the Federal Circuit set forth a test that has been widely applied in that Circuit and elsewhere in subsequent years. The Federal Circuit stated that, in order for tacking to apply, "[t]he marks must create the same continuing commercial impression, and the later mark should not materially differ from or alter the mark attempted to be tacked."²⁵ In addition, "the previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark."²⁶

It follows that improper tacking is an attempt to tack marks that are not legal equivalents conveying the same continuing commercial impression. The effect of improper tacking is the same as the effect of abandonment – the owner of the senior mark can no longer claim priority from the date of use of the senior mark.²⁷ The party seeking to tack bears the burden of establishing the required elements.²⁸

In *Navistar International Transportation Corp. v. Freightliner Corp.*,²⁹ the district court set forth a somewhat different three-part test for applying tacking: (1) do the marks make the same commercial impression?; (2) are the two impressions continuous?; and (3)

²³ *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1552 (9th Cir. 1999).

²⁴ 926 F.2d 1156 (Fed. Cir. 1991).

²⁵ *Id.* at 1159.

²⁶ *Id.* The Court applied the foregoing standard and determined as a matter of law that the mark "CLOTHES THAT WORK" was not the legal equivalent for tacking purposes of "CLOTHES THAT WORK FOR THE WORK YOU DO." *Id.* at 1160.

²⁷ *Iowa Health System v. Trinity Health Corp.*, 177 F. Supp.2d 897, 921 (N.D. Iowa 2001).

²⁸ *Navistar Int'l Transp. Corp. v. Freightliner Corp.*, 1998 WL 911776, *3 (N.D. Ill. Dec. 28, 1998). *Accord* *Yeager Fuel, Inc. v. Pennsylvania Power & Light Co.*, 22 F.3d 1260, 1266 (3d Cir. 1994).

²⁹ 1998 WL 911776 (N.D. Ill. Dec. 28, 1998).

are the marks being used on the same or substantially similar goods or services?³⁰ With respect to the second prong, the court clarified that the same impression must continue from the old mark to the new mark.³¹ *Navistar* also determined that the doctrine of legal equivalents had no place in the tacking inquiry.³²

Because the tacking standard, whatever its precise formulation, is so strict,³³ tacking claims are generally unsuccessful.³⁴ Indeed, the tacking standard enunciated in *Van Dyne-Crotty* is considerably higher than the “likelihood of confusion” standard generally applied to determine whether trademark infringement has occurred.³⁵ Two marks may not be legal equivalents even if they are found to be confusingly similar.³⁶ For example, the Trademark Trial and Appeal Board determined that the marks PRO-CUTS and PRO-KUT were confusingly similar, but not legal equivalents. The Board

³⁰ *Id.* at *3.

³¹ *Id.* at *3 n.6.

³² As set forth in *Navistar*, the doctrine of legal equivalents holds that trademark rights in a picture mark encompass rights in a word if the picture evokes the mental impression of the word (or vice versa). According to *Navistar*, this doctrine is distinct from continuing commercial impression. *Id.* at *5. In one recent case, the Trademark Trial and Appeal Board identified two separate tacking standards – prior use of the salient features of a trade name, or prior use of a trademark legally equivalent to a current mark. See *Chesapeake Bank v. Chesapeake Bank of Maryland*, 2004 WL 240313 (T.T.A.B. 2004).

³³ McCarthy notes that in the late 1980s, the Trademark Board and the Federal Circuit began to apply the continuing commercial impression test “with much more rigor and strictness than in the past.” J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17.26 (4th ed. 2004). See also *Think Computer Corp. v. H. Co. Computer Products, Inc.*, 2004 WL 2368482 , *3 (T.T.A.B. 2004). (requiring proof of tacking by clear and convincing evidence, at least where prior use is asserted).

³⁴ Melissa M. McGann, Casenote, *Web Word War (WWW): A New Approach to Trademark Infringement and Unfair Competition Claims Under the Lanham Act in Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 7 VILL. SPORTS & ENT. L.J. 363, 378 n.95 (2000). *Accord Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998) (tacking is permitted in rare circumstances); *Levi Strauss & Co. v. GTFM, Inc.*, 196 F. Supp.2d 971, 62 U.S.P.Q.2d 1394, 1403 (N.D. Cal. 2002) (tacking is allowed only in “exceptionally narrow” circumstances).

³⁵ *Brookfield Commun, Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999); *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 1998 WL 911776, *4 (N.D. Ill. Dec. 28, 1998) (standard for tacking is far higher than standard for likelihood of confusion).

³⁶ *HGI Marketing Services, Inc. v. PepsiCo, Inc.*, 50 F.3d 14, *2 (9th Cir. 1995); *Lincoln Logs, Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 735 (Fed. Cir. 1992) (no tacking allowed because LINCOLN LOGS LTD. and profile/log cabin design was not the legal equivalent of THE ORIGINAL LINCOLN LOGS LTD. and house design); and *Ushodaya Ent., Ltd. v. V.R.S. Int’l, Inc.*, 63 F. Supp.2d 329, 338 (S.D.N.Y. 1999).

noted differences between the marks in spelling and pluralization, as well as material differences in the design features. Accordingly, tacking was not allowed.³⁷

Courts apply a list of factors to determine likelihood of confusion.³⁸ While the list varies from circuit to circuit, the factors typically include some combination of the following: similarity of the conflicting designations; relatedness or proximity of the two companies' products or services; strength of the plaintiff's mark; marketing channels used; degree of care likely to be exercised by purchasers in selecting goods; defendant's intent in selecting its mark; evidence of actual confusion; and the likelihood of expansion in product lines.³⁹

The various multi-factor tests for assessing "likelihood of confusion" provide essential guidance to courts making such an assessment. Courts determining whether tacking is available have a more difficult time, because no comparable multi-factor test has been developed. Nevertheless, some guidelines have emerged over the years, as courts have sought to apply the *Van Dyne-Crotty* standard.

A threshold question is whether "legal equivalence" is a question of law or a question of fact. To date, courts have reached conflicting conclusions with regard to this issue, on the basis of limited analysis. In *In re DIAL-A-MATRESS Operating Corporation*,⁴⁰ decided in 2001, the Federal Circuit reversed the rejection of an intent-to-use application to register "1-888-M-A-T-R-E-S-S" as a service mark. In so doing, the court determined that the proposed mark was merely descriptive of the recited services and therefore was registerable only upon a showing of acquired distinctiveness. The

³⁷ *Pro-Cuts v. Schilz-Price Enterprises, Inc.*, 1993 WL 266611, 27 U.S.P.Q.2d 1224 (T.T.A.B. 1993).

³⁸ *See, e.g., E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992).

³⁹ *See, e.g., Dr. Seuss Enters. v. Penguin BooksUSA, Inc.*, 109 F.3d 1394, 1404 (9th Cir. 1997); *Frisch's Restaurants, Inc. v. Elby's Big Boy*, 670 F.2d 642, 648 (6th Cir. 1982).

⁴⁰ 240 F.3d 1341 (Fed. Cir. 2001).

court then applied Trademark Rule 2.41(b), which provides that “[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness.”⁴¹

The court then held that a proposed mark is the “same mark” as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the “legal equivalent” of another and if it creates the same continuing commercial impression such that the consumer would consider them both the same mark. According to the court, whether marks are legal equivalents is a question of law. The court cited its prior decision in *Van Dyne-Crotty* for the proposition that no evidence need be entertained other than the visual or aural appearance of the marks themselves. On the basis of such evidence the court concluded that the marks 1-888-M-A-T-R-E-S-S and (212) M-A-T-T-R-E-S were legal equivalents.⁴²

The Sixth Circuit has agreed with the Federal Circuit that legal equivalence is a pure question of law.⁴³ That conclusion seems infirm. Marks are deemed to be legal equivalents if they create the same continuing commercial impression. The impression is

⁴¹ 37 C.F.R. § 2.41(b) (2000). While ownership of existing registrations to establish acquired distinctiveness may be considered acceptable in appropriate cases under Rule 2.41(b), the Patent and Trademark Office may, at its option, require additional evidence of distinctiveness. In re Candy Bouquet Int’l, Inc., 2004 WL 2202265, *8, 73 U.S.P.Q.2d 1883 (T.T.A.B. 2004).

⁴² 240 F.3d at 1347.

⁴³ See *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998) (“A determination of legal equivalence may be based on ‘the visual or aural appearance of the marks themselves.’”). In *Data Concepts*, the court determined that a software company’s use of the mark “DCI” in its Internet address DCI.COM was not the legal equivalent of the company’s prior use of the stylized trademark “dci.” The *Data Concepts* case is discussed in Robin W. Foster, Note, *A Seamless Web of Confusion: The Sixth Circuit Obscures the Law in Applying Trademark Principles to Internet Domain Name Conflicts in the Opinion of Data Concepts Inc. v. Digital Consulting Inc.*, 26 N. KY. L. REV. 305 (1999). See also *Gaffrig Performance Indus., Inc. v. Livorsi Marine, Inc.*, 2001 WL 709483, *8 (N.D. Ill. June 25, 2001) (legal equivalence is a question of law); *Keycorp v. Key Bank & Trust*, 99 F. Supp.2d 814, 819 (N.D. Ohio 2000) (same).

one that is created in consumers.⁴⁴ Insofar as the consumers' perspective is determinative, it seems counterintuitive to conclude, as have the Federal and Sixth Circuits, that the only relevant evidence is that of the visual or aural appearance of the marks themselves.

Rather, the determination of whether marks are legal equivalents should be a mixed question of fact and law, and the existence of a continuing commercial impression for purposes of tacking, Rule 2.41(b),⁴⁵ claim preclusion,⁴⁶ a *Morehouse* defense,⁴⁷ and

⁴⁴ See, e.g., *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036 (9th Cir. 1999) (“We agree that tacking should be allowed if two marks are so similar that consumers generally would regard them as essentially the same.”). The *Brookfield* case is discussed in Shannon N. King, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 15 BERKELEY TECH. L.J. 313 (2000) and McGann, *supra* note 34.

⁴⁵ The analysis under Rule 2.41(b) is essentially the same as the analysis for determining whether tacking applies. See *In re Lawman Armor Corp.*, 2005 WL 2451654 (T.T.A.B. 2005); *In re Merion Publications, Inc.*, 2002 WL 31375534 (T.T.A.B. 2002); *In re Gear Int’l Trading Co.*, 2001 WL 741709 (T.T.A.B. 2001); and JAMES HAWES & AMANDA DWIGHT, PRACTITIONER’S TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212.04(b) (2004) (“A proposed mark is the same mark as a previously-registered mark for the purpose of 37 C.F.R. § 2.41(b) if it is the legal equivalent of such a mark. A mark is the legal equivalent of another if it creates the same continuing commercial impression such that the consumer would consider them both the same mark.”). Likewise, the analysis is essentially the same as that used to determine whether a proposed amendment to a mark would constitute an impermissible material alteration. As noted in *In re Dial A Mattress Operating Corp.*, 1999 WL 11862220, *7 (T.T.A.B. 1999), *aff’d*, 240 F.3d 1341 (Fed. Cir. 2001): “[I]n all of these situations, the issue is whether the present mark and the previous mark are ‘legal equivalents,’ i.e., whether they create the same continuing commercial impression such that the consumer would consider both as the same mark.”

⁴⁶ Under the doctrine of claim preclusion or *res judicata*, the entry of a final judgment on the merits in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies. See *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694 (Fed. Cir. 1984). A second suit is barred under *res judicata* if: (1) the parties (or their privies) are identical; (2) there has been an earlier final judgment on a claim; and (3) the second claim is based on the same set of transactional facts as the first. *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360 (Fed. Cir. 2000). The Trademark Board has held that in comparing two marks to determine if the same claim arose for purposes of claim preclusion, it will apply the tacking standard to assess whether a continuing commercial impression exists. See *Institut National Des Appellations D’Originie v. Brown-Forman Corp.*, 1998 WL 650076, 47 U.S.P.Q.2d 1875, 1894-95 (T.T.A.B. 1998) (holding that: (1) “[T]he proper test for determining whether two marks have the same commercial impression, for purposes of the claim preclusion doctrine, is the test used in tacking situations, i.e., whether the marks are legal equivalents.”; and (2) MIST AND COGNAC mark is a different mark, in terms of commercial impression, from CANADIAN MIST AND COGNAC). See also *Bank One Corp. v. Charter One Financial Inc.*, 2004 WL 902116, *3 (T.T.A.B. 2004) (no claim preclusion because two marks did not create same continuing commercial impression); *Polaroid Corp. v. C&E Vision Services, Inc.*, 1999 WL 11862222, 52 U.S.P.Q.2d 1954 (T.T.A.B. 1999) (same).

⁴⁷ The *Morehouse* defense, an equitable affirmative defense, is available in situations where the applicant already owns a registration for the same mark for substantially identical goods and services. It is based on the theory that a registration opposer cannot be injured by the registration sought because there already exists a similar registration and, therefore, an additional registration for the same mark for substantially identical goods and services can no more injure the plaintiff than the prior registration. See *Morehouse*

other contexts should be tested by a range of evidence -- including consumer survey evidence, if it is available. Whether a likelihood of confusion exists is a mixed question of law and fact.⁴⁸ This question is often resolved in modern trademark litigation with the use of survey evidence. While “there is no flat rule that a survey must be introduced to obtain a preliminary injunction, a permanent injunction, or to obtain damages, . . . an increasing number of opinions expressly rely upon survey evidence to substantiate the decision.”⁴⁹

Today, issues concerning survey evidence primarily relate to survey design and methodology. Methodological errors in trademark surveys generally go only to the weight of the evidence, rather than to its admissibility, unless the survey is so flawed that its probative value is outweighed by the risk of prejudice.⁵⁰ Similarly, the determination of whether marks are legal equivalents should be a mixed question of law and fact, and survey evidence generally should be admissible to assess the existence of a continuing

Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881 (C.C.P.A. 1969) (no injury from registration of BLUE MAGIC for pressing oil when applicant owned prior registration for BLUE MAGIC for hair dressing). *See also* O-M Bread, Inc. v. United States Olympic Comm., 65 F.3d 933 (Fed. Cir. 1995); University of Southern California v. University of South Carolina, 2005 WL 1402094 (T.T.A.B. 2005). In determining whether a *Morehouse* defense is available, courts and the Trademark Board have assessed whether a continuing commercial impression exists. *See, e.g.*, Tillamook Country Smoker, Inc. v. Tillamook County Creamery Ass’n, 333 F. Supp.2d 975, 987 (D. Ore. 2004) (“In summary, decisions applying the prior-registration doctrine indicate that whether two marks are ‘substantially identical’ turns in part on whether consumers would find that each mark conveys the same commercial impression.”); S & L Acquisition Co. v. Helene Arpels, Inc., 9 U.S.P.Q.2d 1221 (T.T.A.B. 1987). *See also* Advance Stores Co. v. Refinishing Specialties, Inc., 948 F. Supp. 643, 654 (W.D. Ky. 1996), *aff’d*, 188 F.3d 408 (6th Cir. 1999) (mere stylization of a name, or the addition of a design element, is insufficient to defeat *Morehouse* defense); Bank One Corp. v. Charter One Financial Inc., 2004 WL 902116, *6 (T.T.A.B. 2004) (*Morehouse* defense inapplicable because subject marks were not substantially identical – they were not literally identical or legally equivalent); and Big Blue Products Inc. v. International Business Machines Corp., 1991 WL 326549, 19 U.S.P.Q.2d (T.T.A.B. 1991) (tacking and *Morehouse* analyses are analogous).

⁴⁸ *See, e.g.*, Little Caesar Enters., Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 570 (6th Cir. 1987).

⁴⁹ J. THOMAS MCCARTHY, 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2004) § 32:195.

⁵⁰ Schering Corp. v. Pfizer Inc., 189 F.3d 218 (2d Cir. 1999). *See also* Kenneth A. Plevan, *Daubert’s Impact on Survey Experts in Lanham Act Litigation*, 95 TRADEMARK RPTR. 596 (2005) (study of reported Lanham Act decisions during period 1997-2004 finds that 14 such decisions excluded survey evidence altogether, while in 30 cases the admissibility of a survey was challenged but the survey was not excluded); Jacob Jacoby, *Experimental Design and Selection of Controls in Trademark and Deceptive Advertising Surveys*, 92 TRADEMARK RPTR. 890 (2002).

commercial impression. Surveys can provide the most accurate means of assessing such impressions.⁵¹

Some courts have concluded that the question of tacking is a question of fact, rather than law.⁵² They have done so, appropriately, on the basis that the impressions of consumers are critical, as they are with respect to the likelihood of confusion test for infringement.⁵³ The *Navistar* court stated: “Because the inquiry is how consumers perceive the marks, there must be some evidence demonstrating those perceptions.”⁵⁴

3. Continuing Commercial Impression – Some Applications

A few trends or rules have emerged from the efforts of courts to apply the continuing commercial impression doctrine in trademark law, particularly in the context of abandonment and tacking. First, a user who changes only the *form* of its mark can retain the benefit of its use of the earlier form, if the two forms create the same impression. Where the distinctive character of the mark is not changed, the mark is, in effect, the same.⁵⁵ Thus, minor differences in the marks such as pluralization or an inconsequential modification of modernization of the later mark will not preclude

⁵¹ See, e.g., Robert H. Thornburg, *Trademark Survey Evidence: Review of Current Trends in the Ninth Circuit*, 21 SANTA CLARA COMPUTER & HIGH TECH. L.J. 715, 715 (2005) (“Surveys represent the most scientific means of measuring relevant consumers’ subjective mental associations. . . .”); Ruth M. Corbin & Arthur Renaud, *When Confusion Surveys Collide: Poor Designs or Good Science?*, 94 TRADEMARK RPTR. 781, 783 (2004) (“[T]he field of survey research incorporates all the essential structural techniques of other scientific expert evidence, including rigorous hypothesis testing, experimental design, control conditions and statistical inference.”).

⁵² See, e.g., *Navistar Int’l Transp. Co. v. Freightliner Corp.*, 1998 WL 911776 (N.D. Ill. Dec. 28, 1998).

⁵³ *Id.* at *4 n.8 (“Our emphasis on the impressions of consumers is bolstered by Seventh Circuit precedent in an analogous trademark context – the ‘likelihood of confusion’ test for infringement.”). The *Navistar* court deemed irrelevant the fact that consumer perception evidence is not *required* to prove likelihood of confusion. This was because the standard for tacking is even higher than it is for showing a likelihood of confusion. *Id.* at *4.

⁵⁴ *Id.* at *4. See also *Chesapeake Bank v. Chesapeake Bank of Maryland*, 2004 WL 240313 (T.T.A.B. 2004) (denying summary judgment as to priority, in light of issues of fact relating to continuing commercial impression, including similarity of marks, context of their use, and customer perception).

⁵⁵ *Humble Oil & Refining Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. 597, 603-04 (T.T.A.B. 1970).

tacking.⁵⁶ Likewise, a mark's commercial impression is not changed by the presence or absence of quotation marks or the use of different typefaces.⁵⁷ McCarthy summarized the case law concerning a change of form:

[T]he following changes have been held either not to constitute abandonment or to permit tacking-on: a rearrangement of words, the combination of a mark with another word; the dropping of a non-essential word from a mark; adding a letter in a word without changing its phonetic impact; the dropping of a background design and continuing use of a word mark; the embellishment of a word or letter with a design; the insertion of a hyphen; a change in lettering style; and a modernization of a picture mark.⁵⁸

In one case, the court held that the modernization of the depiction of a lion into a more stylized drawing from earlier, more realistic versions did not constitute abandonment.⁵⁹ In another case, the court held that trivial changes in the current VERYFINE trade dress from the drawings of the trademarks set forth in the registration certificates did not constitute abandonment. These changes included the appearance of thin white line separations to the different sections of each orange and grapefruit in the design, a slightly different position of the pineapple behind the orange in the pineapple orange design, and minor color changes in part of an orange section and pineapple rind.

⁵⁶ See *In re Loew's Theatres, Inc. v.*, 223 U.S.P.Q. 513 (T.T.A.B. 1984), *aff'd*, 769 F.2d 764 (Fed. Cir. 1985) (the marks DURANGOS and DURANGO are legal equivalents); *In re Gar Int'l Trading Co.*, 2001 WL 741709 (T.T.A.B. 2001); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231 (D. Kan. 1977) ("Minor modifications of a trademark do not constitute abandonment.").

⁵⁷ *Bentwood Television Corp. v. American Theatre Wing, Inc.*, 2001 WL 935809 (T.T.A.B. 2001) (registered mark was not abandoned merely because of occasional use of the mark without quotation marks, without pluralization, or in a different font).

⁵⁸ J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:27 (4th ed. 2004). See also 3 Callman, *supra* note 7, at § 20:73 (no abandonment results from modernization of style, deletion of insignificant part of mark, minor change in punctuation or typeface, descriptive verbal elements, or other minor changes in wording).

⁵⁹ *Dreyfus Fund v. Royal Bank of Canada*, 525 F. Supp. 1108, 1115 (S.D.N.Y. 1981).

The court concluded: “The basic, overall commercial impression remains precisely the same.”⁶⁰

Second, courts have sometimes upheld tacking claims where additional words in one mark do not help identify the origin of the goods. In one case, the Court of Customs and Patent Appeals allowed “American Security” to be tacked onto “American Security Bank,” because the word “Bank” added nothing to the origin-indicating significance of the existing mark.⁶¹ Conversely, the owner of the mark “Home Protection Center” was not entitled to rely on the owner’s prior use of the mark “Home Protection Hardware.” The court in that case determined, on the basis of the words themselves, that the change from “center” to “hardware” created different commercial impressions, rather than a mere change of form.⁶²

Similarly, the Trademark Trial and Appeal Board refused to permit “AMERICAN MOBILPHONE PAGING” to be tacked onto “AMERICAN MOBILPHONE,” where the two marks had identical star and stripe designs. The Trademark Board noted that the two marks were visually barely distinguishable. However, the Board concluded, in what it conceded was a close case, that the former mark and design conveyed more information

⁶⁰ *Veryfine Products, Inc. v. Colon Brothers, Inc.*, 799 F. Supp. 240, 255 (D. Puerto Rico 1992). *See also* *ASICS Corp. v. Wanted Shoes Inc.*, 2005 WL 1691587, 75 U.S.P.Q.2d 1303 (C.D. Cal. Jan. 25, 2005) (while presentation of ASICS Stripe Design varied slightly depending on the footwear involved, it always created the same continuing commercial impression); *Applebee’s Int’l, Inc. v. Societe des Produits Nestle S.A.*, 2003 WL 22134923, *8 (T.T.A.B. 2003) (Trademark Board concludes that SKILLET SENSATIONS in stylized form could be tacked to SKILLET SENSATIONS in block and slightly stylized letters, because “for all practical purposes, they are pronounced the same way and project the same continuing commercial impression”); *Rockline Indus., Inc. v. Dental Disposables Int’l, Inc.*, 2002 WL 187291 (T.T.A.B. 2002) (FRESH N’ UP was legal equivalent of FRESH ‘N UP and FRESHENUP was legal equivalent of FRESHEN UP, so tacking was permissible in both cases); *S & L Acq. Co. v. Helene Arpels, Inc.*, 1987 WL 123899, 9 U.S.P.Q.2d 1221 (T.T.A.B. 1988) (ADRIEN ARPEL mark created continuing commercial impression whether represented in block form or in stylized lettering).

⁶¹ *American Security Bank v. American Security & Trust Co.*, 571 F.2d 564, 567 (C.C.P.A. 1978). *See also* *HGI Marketing Services, Inc. v. PepsiCo Inc.*, 50 F.3d 14, *2 (9th Cir. 1995) (evidence was sufficient to create genuine issue of material fact as to whether Taco Bell’s use of “Make a Run for the Border” and “Run for the Border” created the same commercial impression).

⁶² *See* *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221 (C.C.P.A. 1976).

to potential customers than did the latter mark and design, and the two marks were distinguishable when spoken.⁶³

Third, courts will not permit the tacking of a mark with a narrow commercial impression onto one with a broader commercial impression.⁶⁴ This restriction is designed to prevent a party seeking to tack from expanding its trademark rights, in accordance with established principles of trademark law.⁶⁵ In one application of this rule, the district court rejected an attempt to tack, after concluding that “First National Bank” has a narrower commercial impression than “FirstBank.”⁶⁶ In another case, the Ninth Circuit rejected an attempt to tack “The Movie Buff’s Movie Store” to “moviebuff.com,” on the basis that the latter contained three fewer words, dropped the possessive, omitted a space, and added .com to the end.⁶⁷ Other applications of this rule include failed attempts to tack

⁶³ American Paging, Inc. v. American Mobilphone, 13 U.S.P.Q.2d 2036 (T.T.A.B. 1989), *aff’d*, 923 F.2d 869 (Fed. Cir. 1990). *See also* Ushodaya Ent., Ltd. v. V.R.S. Int’l, Inc., 63 F. Supp.2d 329 (S.D.N.Y. 1999) (“Priya” and its format did not create same continuing commercial impression as “Priya Pickles, Homemade by Vasudean Family.”); Jimlar Corp. v. Army And Air Force Exchange Service, 1992 WL 280636, 24 U.S.P.Q.2d 1216 (T.T.A.B. 1992) (composite “A CLUB” mark, including the words “BY AMERICAN EAGLE,” permitted to be tacked to “A CLUB,” because marks created continuing commercial impression, insofar as word “CLUB” was superimposed over “A” in virtually identical manner).

⁶⁴ Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 1160 (Fed. Cir. 1991).

⁶⁵ Navistar Int’l Transp. Corp. v. Freightliner Corp., 1998 WL 911776, *4 (N.D. Ill. Dec. 28, 1998).

⁶⁶ First Savings Bank, F.S.B. v. First Bank System, Inc., 902 F. Supp. 1366, 1375 (D. Kan. 1995). The court in this case distinguished two prior cases in which tacking was permitted. In one, tacking was allowed onto a mark that was a modernized version of the same three-letter abbreviation. First Michigan Bank Corp. v. First National Bank, 887 F.2d 1095 (Fed. Cir. 1989). In the other case, the senior user had used “The Forum” for as long as it had been in business and had used the other versions of the mark – “The Forum Corporation of North America” and “The Forum Corporation” – only for limited periods. Here, the term “Forum” was the single salient and memorable feature of all three marks. Forum Corp. of North America v. Forum, Ltd., 903 F.2d 434 (7th Cir. 1990).

⁶⁷ Brookfield Commun., Inc. v. West Coast Ent Corp., 174 F.3d 1036 (9th Cir. 1999).

SHAPE UP to later mark SHAPE,⁶⁸ ALTER EGO to later mark EGO,⁶⁹ and “Marco Polo” to “Polo.”⁷⁰

Fourth, courts will not split marks into their component parts in determining whether they create a continuing commercial impression. Rather, courts evaluate the impression the marks as a whole create. In one case, the court rejected plaintiff’s argument that LONE STAR CAFÉ could be tacked onto LONE STAR STEAKHOUSE because both used the dominant term LONE STAR.⁷¹ Similarly, another court rejected a contention that KEY BANK was the legal equivalent of KEY FEDERAL SAVINGS BANK. Among other things, the latter mark imparted different and, arguably, more information than the former.⁷² And the Trademark Trial and Appeal Board rejected an attempt to tack DIAMOND DESTINATIONS to AAA FIVE DIAMOND AWARD or AAA FOUR DIAMOND AWARD. The Board stated: “[D]ue to the differences in overall sound, appearance and connotation created by the presence of the word ‘DESTINATIONS’ in petitioner’s ‘DIAMOND DESTINATIONS’ mark, such mark materially differs from each of the prior marks which it seeks to tack.”⁷³

⁶⁸ Corporate Fitness Programs v. Weider Health & Fitness, 2 U.S.P.Q.2d 1682 (T.T.A.B. 1987).

⁶⁹ Viviane Woodard Corp. v. Roberts, 181 U.S.P.Q. 840 (T.T.A.B. 1974). Cf. Club Amenities, LLC v. Pettenon Cosmetici SNC, 2005 WL 2034549 (T.T.A.B. 2005) (ALTER EGO THE PERSONAL CARE COMPANION creates same continuing commercial impression as ALTER EGO).

⁷⁰ Polo Fashions, Inc. v. Extra Special Products, Inc., 451 F. Supp. 555 (S.D.N.Y. 1978).

⁷¹ Lone Star Steakhouse & Saloon v. Longhorn Steaks, 106 F.3d 355, *mod’f* by 122 F.3d 1379 (11th Cir. 1997).

⁷² Keycorp v. Key Bank & Trust, 99 F. Supp.2d 814, 821 (N.D. Ohio 2000).

⁷³ American Automobile Ass’n, Inc. v. Diamond Tours, Inc., 1997 WL 796205, *8 n.20 (T.T.A.B. 1997). See also O-M Bread, Inc. v. United States Olympic Comm., 65 F.3d 1041 (Fed. Cir. 1995) (proposed use of OLYMPIC KIDS cannot be tacked to OLYMPIC mark); Universal City Studios LLLP v. Valen Brost, 2003 WL 22415603, *4 (T.T.A.B. 2003) (“[C]onsidering the marks in their entirety, UNIVERSAL GAMES and UNIVERSAL TOYS do not ‘create the same continuing commercial impression.’”); Impact Restaurants LLC v. Sizzling Platter, Inc., 2003 WL 22586449 (T.T.A.B. 2003) (M.J. BARLEYHOPPER’S creates different commercial impression than that created by BARLEYHOPPERS AND BARLEY HOPPERS); Super Valu Stores, Inc. v. Exxon Corp., 1989 WL 297876, 11 U.S.P.Q.2d 1539 (T.T.A.B. 1989) (applicant was not permitted to tack prior use of tiger design and slogan PUT A TIGER IN YOUR TANK for gasoline products to achieve priority of use for TIGER MART for convenience stores, because the marks were not recognized as one and the same).

Fifth, similarity of marks in connotation alone, when they are otherwise different in sight and sound, does not suffice to permit tacking. In one case applying this rule, the Trademark Trial and Appeal Board determined that the mark HILL COUNTRY FARE could not be tacked onto the mark TASTE OF THE HILL COUNTRY. The two marks had no continuing commercial impression.⁷⁴

Cases applying the foregoing principles or rules have not demonstrated a great deal of consistency. It is submitted that a root cause of the problem is the failure to adequately assess continuing commercial impression from the perspective of the consumer. In tacking situations, and a few others described above, continuing commercial impression should be tested from that perspective, by treating the issue as a mixed question of fact and law. The factual question should be resolved by resort to survey evidence, where it is available. The next section of this article describes the only two known instances where consumer surveys were conducted for the purpose of being proffered as evidence of continuing commercial impression.

EMPIRICALLY DETERMINING CONTINUING COMMERCIAL IMPRESSION

Although the proffering of consumer survey evidence has become commonplace in matters involving trademark confusion, acquired distinctiveness and secondary meaning, genericism, fame and dilution, case law searches reveal a single instance, reported toward the end of 2005, where survey research evidence was proffered to support a claim of continuing commercial impression.⁷⁵ An unreported earlier (2003) instance is known to the authors because of the junior author's involvement in that

⁷⁴ H.E. Butt Grocery Company v. Innovative Foods, LLC, 2003 WL 22988721 (T.T.A.B. 2003). *See also* Takahashi v. Bradley Imports, Ltd., 2004 WL 1957209 (T.T.A.B. 2004) (WEST SIDE and skyline design mark could not be tacked onto WEST SIDE and floral design mark so as to avoid finding of abandonment).

⁷⁵ In Re Lawman Armor Corp., 2005 WL 2451654 (T.T.A.B. 2005.)

matter.⁷⁶ These two instances are described here, as they offer insights into the kinds of approaches that can and cannot be used for empirically investigating continuing commercial impression.

1. Kubota Corp. et al. v. DaeDong - USA, Inc.

Kubota Tractor Corporation, a California corporation, is affiliated with the Kubota Corporation of Japan. As the name indicates, Kubota Tractor Corporation manufactures and sells tractors. At or around the time Kubota introduced its tractors into the United States, other competitors included John Deere, Ford/New Holland (originally separate companies and, more recently, simply “New Holland”) and Massey-Ferguson. For many years, each of these three tractor brands used a different primary color on the exteriors of their tractors. John Deere used green, Ford/New Holland used blue and Massey-Ferguson used red. Since 1969, all Kubota tractors sold in the United States have had their bodies painted a bright orange color.

In April of 2002, counsel acting on behalf of Kubota contacted the junior author with the request that he design and conduct an investigation to determine whether, and if so, to what extent Kubota’s trade dress had acquired distinctiveness and achieved secondary meaning in the minds of the relevant public. The report of this investigation was then proffered as evidence in *Kubota v. Daedong*.

Defendant, another tractor manufacturer, was selling tractors in the United States under the name Kioti which had their bodies painted in what, to the naked eye, appeared to be virtually identical to the shade of orange used on Kubota tractors. At that point,

⁷⁶ Kubota Corp. and Kubota Tractor Corp. v. DaeDong - USA, Inc., d/b/a Kioti Tractors, DaeDong Industrial Co., Ltd., and J.M. Equipment Co., Inc., No. CIV-F-02-6013 OWW (E.D. Cal.).

Daedong argued that, since Kubota now used a shade of orange that differed somewhat from the shade of orange it had used originally, the secondary meaning survey could not be relied upon to establish secondary meaning for the original shade of orange. As a consequence, in 2003, Kubota commissioned a second survey to determine whether, in the minds of relevant consumers, their new shade of orange conveyed a continuing commercial impression. Inasmuch as the second (continuing commercial impression) survey can best be understood in terms of the first (secondary meaning) survey, both are described here.

A. The Secondary Meaning Survey

The Universe. As both parties sold tractors in the 15 to 65 horsepower range, the relevant universe was defined as individuals who either decided or helped decide on the purchase of motorized farm or grounds equipment and either had bought, or in the next three years or so were likely to buy, a new or used tractor in the 15 to 65 horsepower range. Telephone directories were used to locate qualified respondents at farms, campground/RV parks, cemeteries, landscape contractors, land clearing and leveling firms, lawn services, golf courses, municipal governments and home owners with five or more acres. In all, 222 qualified respondents were tested in 12 markets dispersed around the continental United States.

The Test Stimuli. Kubota manufactures and sells several tractor models in the 15 to 65 horsepower range. Had the investigation focused on only one of these, it could have been alleged that the survey's findings were not representative of the other models. For this reason, the sample of respondents was divided into thirds, with respondents in each third being tested on a different model of Kubota tractor.

Generally speaking, data are most informative when points of comparison are available. For this reason, as well as to camouflage the brand of interest, the respondents in each of the three sub-samples were also tested on three other tractor brands in the same 15 to 65 horsepower range, a John Deere tractor, a Ford/New Holland tractor and a Massey-Ferguson tractor.

In most instances, it is preferable to provide respondents with actual exemplars of the product or package at issue so that, prior to their being asked questions, they have an opportunity to examine these items as they normally would in the sales environment. However, providing actual exemplars becomes highly impractical when the product at issue is too large to be moved to or accommodated in an enclosed testing facility (such as would be the case when testing several tractors) and when, as was the case here, multiple tractors needed to be supplied so that respondents could be tested at various sites around the country. For this reason, each of the tractors used in this investigation was represented by color-faithful photographs showing four different angles – a direct frontal view, a direct side view, a three-quarter-side view taken from the front, and a three-quarter-side view taken from the rear. These photographs were comparable to those appearing in sales brochures for tractors. Inasmuch as this study sought to assess the secondary meaning or acquired distinctiveness of trade dress, so as to prevent the respondents from relying upon other source-identifying indicia, brand names and other source-identifying marks (e.g., logos) were removed from these photographs.

The Testing Protocol. The respondents reviewed the four photos for one of the four tractors, after which they were asked, if they thought they knew, to identify its maker and indicate the reason(s) why they thought the tractor came from the source they had

indicated. The order in which the four tractors were shown to the respondents was rotated, so that different respondents saw the sets in different orders. Although all respondents saw photos of the same John Deere, Ford/New Holland and Massey-Ferguson tractors, as noted, the sample was divided into thirds, with each third seeing photos of a different Kubota model.

The Questions Asked. After looking at the four sets of photos for as long as they wished and then being cautioned not to guess when responding to the questions, the interviewer asked the following questions for the first sets of photographs:

Question 1a: If you know, who puts out the tractor shown in set # ___? (If the respondent did not name a manufacturer, the interviewer was instructed to say: By puts out, I mean manufactures. If you think you know, who manufactures the tractor shown in set ___?)

If the respondent did not know, the interviewer put away the first set of photos, took out the second set and repeated Question 1a for that set.

For each company named in Question 1a, the interviewer asked Question 1b.

What is it about the tractor shown in photo ___ that makes you think it is put out by NAME FROM Q.1a? What else, if anything, makes you say it is put out by ___? (To clarify a potentially ambiguous answer, if the respondent said “the color” or equivalent on Question 1b, the interviewer asked Question 1c. What is it about the USE RESPONDENT’S OWN WORDS FROM Q.1b that makes you say this tractor is put out by NAME FROM Q.1a? Anything else?)

Then the interviewer put away the first set of photos, took out the second set and repeated the questions for that set. The question sequence was repeated twice more, so that the respondent ended up being asked the same questions regarding each of the four photo sets. As noted, different respondents saw the sets in different orders.

If the respondent had not provided any name in answer to Question 1a, the interviewer took out the first photo set again and asked Question 5a:

Looking once again at the tractor shown in photo set #___, do you associate the color of this tractor with tractors put out by any particular company or companies?

Respondents who said "yes" were asked Question 5b:

*With what particular tractor company or companies do you associate this color?
Any others?*

The interviewer then removed the first photo set and repeated the Question 5 sequence for the other photo sets to which a name had not been provided in answer to the earlier questions.

Findings: A large proportion of consumers who are users of, or in the market for, tractors in the 15 to 65 horsepower range use color to identify the different brands of tractors. Selected quotes illustrate this fact. "... all manufactures make similar tractor. [I] recognize them by color;" said in response to John Deere photos. "Tractors have always been identified by colors. And Massey's has always been red;" said in response to Massey-Ferguson photos. "All tractor companies use one color for all their tractors and Massey's is red;" said in response to Massey-Ferguson photos.

The fundamental question addressed by the secondary meaning survey was: Had the color orange used on tractor exteriors come to signify Kubota in the minds of consumers forming the relevant universe? The data revealed that 68% of the sample correctly identified the Kubota tractor and, when asked why, said the color orange was the reason for their making this identification. To place this in perspective, although the 68% association between orange and Kubota is not as high as between green and John Deere (94%), it compares quite favorably to associations between blue and Ford/New Holland (65%) and is significantly greater than the association between red and Massey-Ferguson (43%) – this, despite the fact that the latter two brands had been using their

colors for a considerably longer period of time than Kubota had been using orange.

Illustrative quotes for those identifying Kubota by its color are:

“If I see an orange tractor from a distance, I think Kubota.”

“Everything Kubota makes is orange and I don’t know of any other manufacturers using orange.”

“The orange color, you can spot one anywhere. I always notice their color.

“The orange color is distinctive of Kubota. Standard of Kubota.”

“They must have the rights to orange. They are all orange.”

“Kubota’s trademark color is orange. I know that and this is the color of Kubota.”

Conclusions: Based upon these findings, it was concluded that the 68% association between the color orange and Kubota tractors went well beyond satisfying the requirement for establishing acquired distinctiveness/secondary meaning and likely reached the point of qualifying the connection between orange and Kubota as being “famous” within this market.

B. The Continuing Commercial Impression Survey

In the 1980s, the shade of orange used on Kubota tractors changed slightly. (Hereinafter, Orange 1 is used to refer to the shade used earlier while Orange 2 is used to refer to the later shade.) Because of this change, defendant argued that even if secondary meaning was established by the first survey, the shade of orange that was the focus of that survey (Orange 2) was not the shade of orange for which secondary meaning had to be determined (namely, Orange 1). Hence, counsel acting on behalf of Kubota commissioned another investigation to determine whether the slight change in the shade of orange used by Kubota resulted in the same “continuing commercial impression”

among relevant consumers. As examination of case law turned up no prior instance where a survey had been proffered to assess continuing commercial impression, the survey was designed *de novo*.

The survey was conducted in 12 markets dispersed around the continental United States, with different respondents being drawn from the same universe as was defined for the secondary meaning survey. The test stimuli were the same as described for the secondary meaning survey with one exception, as described in the Testing Protocol section that follows.

Testing Protocol. The testing protocol involved two phases. In Phase 1, the 227 respondents reviewed photo sets of the same four tractors -- John Deere, Ford/New Holland, Massey-Fergusson and Kubota. In contrast to the secondary meaning survey (in which the respondents were shown the Kubota tractors in Orange 2), the set of photographs in Phase 1 of the continuing commercial impression survey used Orange 1. The respondents were then asked the same questions as were asked in the secondary meaning survey. The purpose of these questions was to see if the respondents could identify the maker of each tractor and, for those identified, to indicate the reason(s) why they thought the tractor came from the source they indicated.

In Phase 2, the respondents were shown another set of photographs for the same four tractors. The only difference between the sets was that, in Phase 2, the photographs of the Kubota tractor showed its exterior in Orange 2 (as had been the case in the secondary meaning survey). Two questions were then asked to determine whether Orange 2 conveyed the same continuing commercial impression as did Orange 1.

Questions and Findings. At the start of Phase 2, the respondents were shown the photographs for all four tractors (two photographs per tractor) and told “The shade of the color used for one of these tractors may, or may not, be different than the shade used in the photographs I showed you before. As you look at these photos, do you see any tractor being shown in a different shade than before?” In response, 84% of the respondents said that the Kubota shade of orange was the same. For these consumers, seeing Orange 2 shortly after seeing Orange 1 and not detecting a difference, by necessary implication, means that Orange 2 conveyed the same commercial impression as did Orange 1.

The 16% of the respondents who said the Kubota tractor shown in Phase 2 was being shown in a different shade of orange than the Kubota tractor shown in Phase 1 were then asked: “Even if it is being shown in a different shade of the same color, do you think the shade being used here is, or is not, essentially the same as the shade used in the photo I showed you before?” In response, half of these respondents (representing 8% of the entire sample) said the shade of orange being used on the photos in Phase 2 was “essentially the same” as the shade of orange used in the Kubota tractor photos in Phase 1. For these consumers, seeing Orange 2 shortly after seeing Orange 1 also conveyed a continuing commercial impression.

Conclusions. Based upon finding that (84% + 8% =) 92% of qualified respondents found the two shades of Kubota orange either to be indistinguishable or, if distinguishable, to be essentially the same, it was concluded that the two shades of orange conveyed a continuing commercial impression. Upon information and belief, the

continuing commercial impression survey and its findings played a substantial role in plaintiff obtaining a favorable pre-trial settlement.

2. In re Lawman Armor Corp.

Lawman Armor Corporation sought to register “The Unbreakable Autolock” as a mark for metal anti-theft locks for motor vehicles, arguing that it represented a continuing commercial impression of “The Unbrakeable Autolock,” a mark for which it already held a registration. In support of its contention, it commissioned and proffered a consumer survey that the PTO examining attorney deemed unpersuasive. Upon appeal, the Trademark Trial and Appeal Board similarly concluded: “We do not find the results of the applicant’s survey persuasive.”⁷⁷ The survey is described as follows.

The survey was comprised of 200 owners of automobiles who have used automobile anti-theft devices sampled from ten different cities. The respondents were divided into two groups, each presented with one of two lists displaying the names and logos of five brands of automobile anti-theft devices. The names on the two lists were identical except for the display of the applicant’s mark on one list in the form [“The UnBRAKEable AutoLock PRO” and in the form “The UnBREAKable AutoLock PRO” on the other].

Of the 200 respondents, 97 were given the list of names with the “Unbreakable” version of the designation and 103 were given the list with the “Unbrakeable” version. The respondents in each group were asked to identify which of the devices, if any, shown on the list (1) they had ever used, (2) they had seen or heard of, and (3) they had seen or hear advertising for. The survey shows that 11 participants in the group shown the “Unbrakeable” spelling (or 11%) and 8 participants shown the “Unbreakable” spelling (or 8%) indicated they had seen or heard of the mark. Applicant concludes, based on the survey results, that any minor difference between the marks will not be perceived by consumers.⁷⁸

⁷⁷ In re Lawman Armor Corp., 2005 WL 2451654, *4 (T.T.A.B. 2005).

⁷⁸ *Id.*

Among other criticisms, the examining attorney faulted the survey for not presenting respondents with the marks at issue, and for findings that were statistically insignificant. On appeal, applicant argued that the former criticism somehow cut against its interests while, insofar as the latter was concerned, it was proper to rely on small samples for “directional evidence.” In its ruling, the TTAB wrote:

We find the survey fails to show, or even measure, the identity or continuity in commercial impression of the marks at issue in this case. The most significant problem is that the two designations presented to the respondents were neither the marks contained in the prior registrations nor the mark for which registration is now sought and they differed from the marks in significant ways. . . . Moreover, the small number of relevant participants undercuts the reliability of the survey even if it had been a survey directed to the marks actually at issue in this proceeding.

At best, the survey shows what we already know; that the marks have some similarities. However, the marks are entitled to little probative value on the question of whether the two marks are perceived as the same.⁷⁹

3. Insights Gained by Comparing the Surveys in *Kubota* and *Lawman Armor*

Kubota involved trade dress while *Lawman* involved a word mark. Apart from these differences, the surveys conducted in these cases differ in substantial respects having implications for those who would seek to measure continuing commercial impression in the future.

Arguably, the most important difference between the two surveys is that, using color-faithful photographs of as-sold tractors, the survey in *Kubota* tested the trade dress as it appeared in the marketplace (e.g., in sales brochures) while the survey in *Lawman*

⁷⁹ *Id.* at *5.

failed to show, or even measure, the impression of the marks at issue in that case. Apparently, any survey seeking to measure continuing commercial impression would do well to test the mark or dress as it is used in the marketplace.

The surveys in the two matters also differed in terms of testing and demonstrating a commercial impression in the minds of relevant consumers, or that the commercial impression was a continuing one. Specifically, after the first *Kubota* survey established that Kubota's current orange had acquired secondary meaning (namely, it possessed a clear commercial impression among relevant consumers), the second *Kubota* survey directly tested and was able to demonstrate that, for the overwhelming majority of respondents, the current shade of orange was perceived as being the same as the original shade of orange (thereby showing that the commercial impression continued between the first and second shades). In contrast, the survey in *Lawman* failed to directly test or demonstrate either that the "Unbrakeable" or "Unbreakable" marks conveyed a clear commercial impression to anything like the majority of respondents, or that the second mark ("Unbreakable") was perceived as being the same as the first.

As to the issue of sample size, from the standpoint of statistics, as long as the respondents are representative of the relevant consumer population as a whole, there is little wrong with sample sizes of 100. The substantive issue is the proportion of respondents out of the group who respond in a consistent and material way, specifically, whether that proportion is the vast majority or a small minority. Clearly, there is a difference between showing that 92% of a sample of prospective purchasers find the two

shades of Kubota orange to be indistinguishable or essentially the same, versus showing that 11% of participants claimed to have seen or heard of the “Unbrakeable” mark.⁸⁰

CONCLUDING OBSERVATIONS

The continuing commercial impression of a trademark is significant in a variety of contexts. Such contexts include, but are not limited to, abandonment and tacking, Rule 2.41(b), claim preclusion, and the *Morehouse* defense. In each of these situations, the critical issue is whether two marks are legal equivalents – *i.e.*, whether in the minds of consumers, the two marks are the same. Most courts that have considered the subject have concluded that legal equivalence is a pure question of law. But this conclusion is infirm. It is submitted that legal equivalence – like confusingly similar – is a mixed question of law and fact. The question is one that should be resolved by a range of evidence, including consumer survey evidence, when available. Set forth herein are the first known empirical assessments of continuing commercial impression, in the context of trade dress and word mark infringement.

In describing the surveys used for assessing continuing commercial impression, our principal objective has been to call attention to the fact that, just as consumer survey evidence has become commonplace in other legal arenas, such empirical assessment is also possible in regard to determining whether or not a continuing commercial impression is being conveyed to the public. The two-phased approach used in *Kubota* is but one approach. No doubt, other appropriate approaches can be and should be developed. In particular, the *Kubota* surveys focused on trade dress, specifically, color. Yet marks are

⁸⁰ A fuller discussion of the issue of sample size may be found in Jacob Jacoby, Amy H. Handlin & Alex Simonson, *Survey Evidence in Deceptive Advertising Cases Under the Lanham Act: An Historical Review of Comments from the Bench*, 84 TRADEMARK RPTR. 541, 572-75 (1994).

more often conveyed verbally, symbolically and sometimes acoustically, and approaches for empirically assessing the continuing commercial impression of such marks also need to be developed.