

One of the more common refusals issued by the USPTO against a trademark application is the dreaded “merely ornamental”. These come in two flavors, “capable” and “not capable” (of acquiring distinctiveness, that is). Interestingly, the word “ornamental” appears nowhere in the Lanham Act. At its core, a refusal based on “mere ornamentation” is really a refusal based on the subject matter of the trademark application not being a trademark as defined in the statute. That is to say, the mark in question does not distinguish the goods of one seller from those of others. This refusal is sometimes referred to as a “failure to function” refusal.

There are many categories of marks that can fall into this trap. It is important to note here that it is almost always the case that this refusal is not made until a specimen of use is submitted because it is the manner in which the mark is used, more so than the inherent nature of the “mark” itself that renders the “mark” merely ornamental. As an example, a word that appears in large print on the face of a t-shirt will be considered merely ornamental but that same word, when placed on a label on the t-shirt or on the breast in a smaller form will be a classic trademark use and not be subject to refusal based on ornamental use. Public perception is the key to whether or not something serves a source indicating function, and this is why this is such a subjective and fluid concept. Marketing techniques are constantly evolving and thus trademark law must also evolve to properly incorporate public perception.

All well and fine so far. Things get quite confusing when one picks up a copy of the Trademark Manual of Examining procedure (TMPEP) and studies the sections that explain non-distinctive product packaging trade dress (1202.02 (b)(ii)) and ornamental use (1202.03), respectively. In the former section, it is presumed that one knows product packaging trade dress when one sees it because the section only applies to this (without even defining product packaging trade dress). It states that unless such trade dress is inherently distinctive, acquired distinctiveness must be proven. It cites the Seabrook factors as the test for inherent distinctiveness. However when one starts to read Section 1202.03, the confusion begins. This section starts out as follows:

“Subject matter that is merely a decorative feature does not identify and distinguish the applicant’s goods and thus does not function as a trademark. A decorative feature may include words, designs, slogans, or trade dress (emphasis added)”. But if it includes trade dress then why shouldn’t we revert to the analysis described in the section on trade dress

(whether it be product design or product packaging)? What is the difference here between trade dress and “designs”? This section on ornamental refusals allows the USPTO to make a subjective determination that “trade dress” is ornamental without having to carry ANY burden of proof, namely, applying the Seabrook factors (as it must do with respect to the kind of trade dress that 1202.02 addresses). Just what kind of trade dress does Section 1202.03 refer to, if not product design or product packaging? The upshot of all of this is that Section 1202.03 and the freedom given to the USPTO to simply call something ornamental exceeds its statutory authority and creates much confusion for the applicant and her attorney alike when trying to determine whether their trademark is packaging or something else.

Packaging is such an ill defined term that it is impossible to answer this question. For example, in one case, an “abbreviated” tuxedo costume constituted product packaging because it was “part of the packaging for exotic dancing services” (Chippendales).

The point of all of this is that there is a place for the ornamental use refusal but not with respect to trade dress, because that is already addressed in Section 1202.02, where the time-tested Seabrook factors control. These factors are nowhere mentioned in Section 1202.03 however, and yet this section can apply to trade dress by virtue of the direct reference to it as noted above. This has the effect of circumventing the Seabrook factors.

Further complicating things, there is a category of things that can be deemed merely ornamental but NEVER capable of attaining secondary meaning. It is not clear why this is so when apparently ANY product packaging trade dress is at least capable of attaining secondary meaning. Again this would not be so bad if there was a clear definition of packaging, but there is none and courts have a habit of calling things packaging that are not in any sense of the word traditional packaging.

One can make a strong argument that the Supreme Court has already decided that there are only two types of trade dress – product packaging and product design. The Court also stated that when in doubt (the so-called “tertium quid”) we should call it product design. And yet, the present TMEP creates a new category of “trade dress” that can be determined to be merely ornamental without resort to the Seabrook factors, leaving the applicant with limited options to overcome the refusal. The solution is to reserve ornamental refusals for words and

logos and to put everything else in the trade dress bucket and deal with it as the Supreme Court told us to in the Wal-Mart case.