

Registration of Color Trademarks on Product Packaging: The TTAB Lays Down Some Black and White Rules

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Obtaining trademark registration for color trademarks can be a complicated undertaking. In a recent precedential opinion, the Trademark Trial and Appeal Board in *In re Forney Industries, Inc.* weighed in on the registrability of a color mark when used on product packaging, holding that: (1) color marks can never be inherently distinctive when used either on a product or product packaging; and (2) a mark consisting of multiple colors without any additional design elements is treated the same as a single color mark and cannot be inherently distinctive.

Forney involved an application to register this mark consisting of three colors, for use on products in multiple classes including metal hardware, welding products, industrial marking products and plastic tape used in auto safety:



Applicant's description of the mark stated: "*The mark consists of the colors red into yellow with a black banner located near the top as applied to packaging for the goods.*"

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The dotted lines merely depict placement of the mark on the packing backer card.” As the Board noted, “Applicant has not attempted to combine its color mark with a uniform shape, pattern or other distinctive design. Instead, the specimens filed in the application show the colors applied to product packaging of varying shapes....The specimens also confirm — consistent with product packaging generally -- that Applicant’s proposed mark serves as a background carrier for other elements on the packaging.” Two examples of the specimens are shown here:





After a refusal of registration on the ground that the mark was not inherently distinctive, Applicant argued in an *ex parte appeal* that the mark should be treated as product

packaging with multiple colors that may be considered inherently distinctive and registrable without proof of acquired distinctiveness. The Board disagreed, holding that the Examiner correctly determined that Applicant was attempting to register a color mark as applied to product packaging (the packaging backing cards), not a product packaging mark.

Having determined that Forney's applied-for mark was a color mark, the Board then held that when evaluating marks that consist of color, the same rules apply whether the color is applied to the products themselves (like the pink color of fiberglass insulation in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985), or the green-gold color of dry cleaning pads in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995), or to product packaging. In both situations, the color mark cannot be considered inherently distinctive and an applicant must present proof of acquired distinctiveness.

According to the Board, this standard of equivalent treatment for color marks whether used on the products themselves or on product packaging is dictated by the Supreme Court's decision in *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205 (2000), which held that "a particular color on a product or its packaging" can never be inherently distinctive and may only be registered on a showing of acquired distinctiveness.

The Board's decision in *Forney* also clarified that the same requirement of proving acquired distinctiveness of color marks applies equally to both single color marks and to multi-color marks that do not include any additional elements, such as shapes and designs. In order to be considered inherently distinctive, a single color or multiple colors must be combined with a well-defined shape, pattern or other distinctive design. Here, Forney's mark applied consisted of three colors without any "distinctive well-defined shape, pattern or other distinctive design...." Accordingly, the mark could not be considered inherently distinctive.

Forney has already filed a Notice of Appeal to the Court of Appeals for the Federal Circuit, so there may be one more round on the complex issues involved in this decision — The TMCA will continue to monitor the case and report on any further colorful developments!