

TRADEMARKING COLORS: AN UPDATE

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A. Single-Color Marks: Different Shades Of A Color May Co-exist

Like the rest of the world, trademarks have been effected by the COVID-19 pandemic. The rush on attempts to trademark COVID-19-related marks, such as YOU TOUCHED IT, YOU GOT IT, CORONA and EVEN HATERS HATE CORONA VIRUS continues. Registrations for corona-virus related domain names are up to several thousand a day. Here is something of a break – developments in the law on trademarking colors – although medical gloves are involved.

While the registration of single-color marks continues to be challenging in its own right, the Trademark Trial and Appeal Board (“T.T.A.B.”) has indicated that different shades of a single color could co-exist as trademarks on the Supplemental Register, even where the goods used in connection with those color marks are identical.

In a recent decision involving a certain shade of green for medical gloves, the T.T.A.B. considered whether Medline Industries Inc. was entitled to register a particular shade of green (Pantone 2274C) for “medical examination gloves” shown below:

Registration was initially refused because of an existing registration for the below “color green Pantone 7488U” for “gloves for medical use” and “protective gloves for medical use” on the ground that Medline’s green glove was likely to be confused with the green glove in the existing registration.

On appeal, Medline argued that there is a “multitude of greens in the world” which are distinguishable from each other and that a “simple look outside the window confirms the many shades of green in the world” such that consumers would not confuse one shade with another. The T.T.A.B. declined to consider this “simple look out the window” argument, but instead applied the well-known likelihood of confusion analysis.

In this case, the likelihood of confusion analysis came down to the visual similarity of the marks. The T.T.A.B found there were “significant differences in visual appearance” between the existing registration which was a “bright, attention-grabbing hue that is squarely within the green color family and would be perceived and recalled” and Medline’s “subdued, pale shade that would be perceived as somewhere on the outer periphery of the green color family.” In short, there was unlikely to be consumer confusion given that Medline was using a very different shade of green than that found in the cited registration. Thus, the refusal to register the mark was reversed.

Medline offers some key insights. Although registration of a single-color mark is still pretty difficult, the way has been paved for different shades within the same color family to exist as trademarks, and even where the products and services offered in connection with those color

marks are identical. More fundamentally, the T.T.A.B's opinion shows that the "likelihood of confusion" analysis is and should be pragmatic – it came down to a simple comparison of the two color marks. What reasonable consumer would be confused between a bright green and pale green glove? Likely none.

B. The Registrability Of Multi-Color Product Packaging

In a different color related trademark case, the United States Court of Appeals for the Federal Circuit (the "Federal Circuit") determined that product packaging multicolor marks may be inherently distinctive – and would not require a detailed showing of acquired distinctiveness through substantial advertising and the like to be registered. However, there is a significant burden involved in proving inherent distinctiveness, and this may not always be the best strategy.

In May 2014, Forney Industries, Inc. ("Forney") sought registration for its product packaging color scheme, depicted below, for metal hardware, welding equipment, safety goods and marking products. The color scheme features a solid black stripe above a yellow gradient fading into red at the bottom.

The USPTO refused to register Forney's mark on the basis that the mark was not inherently distinctive and that Forney would need to provide sufficient evidence that its color scheme had acquired distinctiveness – which is feasible only after lengthy use.

On appeal, the Federal Circuit found that Forney's color scheme could very well communicate the source of its welding and machining goods to a consumer, and thus meet the criteria for inherent distinctiveness. It sent the case back for consideration of the following factors to determine whether Forney's product packaging mark is:

- (1) a "common" basic shape or design;
- (2) unique or unusual in a particular field;
- (3) a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; or
- (4) capable of creating a commercial impression distinct from the accompanying words.

Although at first glance the ruling may appear promising to companies that are looking to register color combination or multi-color product packaging marks, there is still a relatively heavy burden on an applicant's part to prove to the USPTO that its color scheme is inherently distinctive. This raises the question whether a company should maintain from the outset that the color scheme of its product packaging is inherently distinctive or whether it may be more cost effective for a company to develop evidence of acquired distinctiveness before filing its trademark application. It may be prudent for a company to develop evidence of acquired distinctiveness regardless. After all, it has already taken Forney nearly six years from when it

filed its application in May 2014 to get an optimistic but inconclusive ruling, and with more proceedings to come.

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