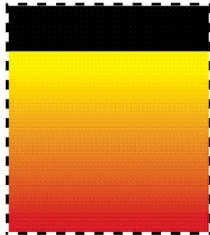


On My Mind Blog

How you can register a color mark

By [William M. Borchard](#)



The Trademark Trial and Appeal Board has decided a “threshold legal issue” as to the registrability of a multiple color mark for product packaging.

Although the current Trademark Act became law over 70 years ago, the TTAB decided for the first time in a case it designated as precedential, that a mark consisting of multiple colors applied to packaging backer cards in widely-differing shapes for a variety of hardware store items, without any consistent shape, pattern or other distinctive design element, would not be inherently distinctive and therefore was not registrable on the Principal Register without proof of acquired distinctiveness (known as “secondary meaning”). *In re Forney Industries, Inc.*, Serial No. 86269096 (T.T.A.B. September 10, 2018).

Previous cases

Previous cases had established that

- Trade dress for **packaging** sometimes can be inherently distinctive, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (restaurant décor) but this later was qualified as not applying to a single color package design without secondary meaning. See *Qualitex* below; *Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016 (T.T.A.B. 2017) (cereal box).
- Trade dress for **product design** never can be inherently distinctive, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., In*, 529 U.S. 205 (2000) (clothing decorated with appliqués); but even a single color product design can be protected if it has acquired secondary meaning, e.g., *Qualitex Co v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (green-gold dry cleaning pads); *In re Owens Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (pink insulation).

The *Forney* case

The new issue is whether a multiple color design for packaging can be inherently distinctive even though a single color for packaging cannot.

The TTAB has decided that multiple colors applied to the packaging of a product, without some other design element such as a shape or pattern, would never be inherently distinctive as a source indicator and would require proof of secondary meaning to be registrable on the Principal Register just the same as a single color mark. In this holding, the TTAB agreed with the 10th Circuit's conclusion as to the non-protectability of Forney's color mark in an infringement action Forney had brought against a similar color mark. *Forney Indus., Inc. v. Daco of Mo., Inc.*, 835 F3d 1238 (10th Cir. 2016)

The TTAB affirmed the refusal of registration, since the applicant did not claim acquired distinctiveness for its multi-color mark, and its specimens showed a variety of product packages of varying shapes and with various degrees of color-fading without any other distinctive design.



Takeaway

You can register a color mark—either a single color or multiple colors—and whether for use on a product or on its packaging—either on the Supplemental Register, meaning that you are attempting to get secondary meaning for it, or on the Principal Register if either the color is combined with a specific distinctive shape, pattern or design or you prove that the color mark has acquired secondary meaning.