

The Court of Appeals for the Federal Circuit Clarifies that Trademark Protection Is Available for “Graduated” and “Undefined” Color Schemes

Article

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There are a number of famous colors that are trademark protected – such as the color brown, which is registered by UPS, and the color “robin egg blue”, which is registered by Tiffany & Co. This protection stems from the fact that such marks are “inherently distinctive”. That is, the colors have become so readily recognized by the purchasing public as being associated goods or services. However, some color marks that comprise “undefined” multiple colors, including graduated colors (i.e., where one color fades into another) have generally been treated as never being able to rise to the level of being inherently distinctive.

On April 8, 2020, the United States Court of Appeals for the Federal Circuit (CAFC), held that the Trademark Trial and Appeal Board (TTAB) erred in ruling that an “undefined” color trademark on products and product packaging cannot be distinctive enough for registration unless consumers already recognize it as an indicator of product source. *In Re: Forney Industries, Inc.*, Fed. Cir., No. 19-1073, Opinion 4/8/20.

In its federal registration application, Forney Industries, Inc. described its multi-color trademark as “a solid black stripe at the top” and “[b]elow the solid black stripe is the color yellow which *fades* into the color red” (emphasis added). Early on, the Examining Attorney at the United States Patent and Trademark Office (USPTO), and later the TTAB, decided that Forney multi-color scheme could not be inherently distinctive.

The TTAB cited two Supreme Court decisions supporting its position – that product and packaging marks using color without defined borders or shape also cannot be inherently distinctive. The CAFC found that the board’s decision overstated the Supreme Court precedent and ruled that the TTAB erred by holding that: (1) a multi-color mark can never be inherently distinctive, and (2) product packaging marks that employ color cannot be inherently distinctive in the absence of a well-defined peripheral shape or border.

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The CAFC stated that the correct standard to apply in determining inherent distinctiveness is a legal question, which it could review *de novo*. The CAFC then recognized that neither the Supreme Court, nor it, has directly addressed whether a multi-color mark such as described by Forney can ever be inherently distinctive. Recognizing the “Forney is not attempting to preempt the use of the colors red, yellow, and black, but instead seeks to protect only the particular combination of these colors, arranged in a particular design”, the CAFC concluded that there are instances when a multi-color mark, as well as single color marks, can be inherently distinctive and, therefore, federally protected via the USPTO.

If your products or product packaging is recognizable by your customers, you may want to consider taking the extra step of applying for federal registration of that color, even if the color is not uniform and blends into other colors. Also, consider consulting an attorney who is well-versed in the area of trademark law to make sure that the description of your color mark is worded the best way possible.

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