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UNITED STATES: Multiple Colors Applied to Product Packaging Cannot Be Inherently Distinctive

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The Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office, in a case of first impression, ruled on September 10, 2018, that multiple colors applied to product packaging cannot be inherently distinctive. *In re Forney Industries, Inc.*, 127 USPQ2d 1787 (TTAB 2018).

Applicant Forney Industries, Inc. (Forney) applied to register a multiple color mark, as depicted on the right, which it described as consisting of “the colors red into yellow with a black banner located near the top as applied to packaging for the goods” and the “dotted lines merely depict placement of the mark on the packing backer card.” Application Serial No. 86269096. The associated goods are generally metal hardware and welding equipment for metalworking purposes. Forney submitted specimens showing the colors applied to product packaging of “varying shapes and use with varying degrees of fading red into yellow without any other, much less uniform, distinctive design.”



Forney considered its mark to be product packaging, and that such product packaging was inherently distinctive. The examining attorney considered Forney’s mark to be a color mark, and thus refused registration of the mark absent acquired distinctiveness. The TTAB considered: (1) whether a different rule applies for inherent distinctiveness for color marks applied to product packaging than for color applied to a product itself; and (2) whether the rules that single-color marks cannot be inherently distinctive applies to color marks consisting of more than one color.

Both Forney and the examining attorney relied on the U.S. Supreme Court decision of *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000). Forney relied on the *Wal-Mart* decision, contending that “trade dress can be inherently distinctive and that product packaging” can be considered by a consumer to indicate origin and not be simply decorative. The examining attorney argued that Wal-Mart did not instruct that a color mark can be inherently distinctive. The TTAB followed the examining attorney’s arguments, and clarified that, based on *Wal-Mart*, a color mark, whether applied to a product or its packaging, can never be inherently distinctive and may only be registered on a showing of acquired distinctiveness.

The TTAB also considered the Tenth Circuit Court’s decision which ruled against Forney in a trademark infringement action. The court considered U.S. Supreme Court decisions and other court decisions and ultimately held that Forney’s applied-for mark consisting of multiple colors applied to product packaging could not be held to be inherently distinctive.

Given the various uses of the applied-for mark on Forney’s products with no consistent use as to the shape of the applied-for mark on the product packaging, the TTAB found that the applied-for mark was a color mark, not product packaging. Thus, it held that a color mark consisting of multiple colors applied to product packaging is not capable of being inherently distinctive. Forney appealed the decision to the Court of Appeals for the Federal Circuit in October 2018.

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