

This Opinion is a Precedent of the TTAB

Hearing: October 4, 2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Forney Industries, Inc.

Serial No. 86269096

William W. Cochran of Cochran Freund & Young LLC,
for Forney Industries, Inc.

Emily K. Carlsen, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.¹

Before Taylor, Kuczma and Adlin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Forney Industries, Inc. (“Applicant”) seeks registration of the following as a mark
on the Principal Register:

¹ Emily K. Carlsen was the Trademark Examining Attorney during prosecution, and is now serving in the Office of Trademark Petitions; Stacy Wahlberg is the current manager of Law Office 103.



The colors black, yellow and red are claimed as features of the mark. The application includes the following description of the mark:

The mark consists of the colors red into yellow with a black banner located near the top as applied to packaging for the goods. The dotted lines merely depict placement of the mark on the packing backer card.²

Applicant asserts the proposed mark is used on packaging³ for:

Metal hardware springs, metal chains, steel chains, metal rods for brazing and welding, silver solder, lead free solder

² Description of the mark submitted in March 17, 2015 Response to Office Action, TSDR at 18. (Page references herein to the application record refer to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system.) A "packing backer card" refers to part of the packaging for Applicant's goods; we understand the term to refer to the cardboard on which Applicant's products are mounted for display and sale.

³ The description of the mark originally presented in the application was: "The mark consists of a solid black stripe at the top. Below the solid black stripe is the color yellow which fades into the color red. These colors are located on the packaging and or labels." Application, TSDR at 1. The Examining Attorney required an amendment to the mark description and suggested in pertinent part "... as applied to product packing for the goods. The dotted lines function solely to indicate placement of the mark on the packaging." September 16, 2014 Office Action, TSDR at 3. Applicant's amendment of the description of its mark in the March 17, 2015 Response to Office Action, TSDR at 18, which indicates that the "dotted lines merely depict placement of the mark on the *packing backer card*," [emphasis added] may serve to restrict the placement of the mark such that the specimens filed with its application for goods in Classes 6 and 17 may not be acceptable as they are not "packing backer card" specimens. We have considered Applicant's mark in the context of Applicant's description and the Examining Attorney's suggested broader description. In view of our decision, it is not necessary to remand at this time. However, in the event Applicant successfully appeals this decision, the application will need to be remanded for further examination to ensure compliance with the requirements for a complete application and acceptable specimens in support of registration pursuant to 37 C.F.R. §§2.32(a)(8) and 2.56 et seq.

wire, welding cable, welding wire all of which are used in metal working in International Class 6;

Welding torches, power-operated grinding wheels, abrasive wheels for power-operated grinders, wire brushes for use in machines, gas-operated welding machines, sanding discs, welding kits comprising torches and gauges all for metal working in International Class 7;

Welding helmets, welding masks, welding lens dust masks, battery terminal connector clamps, jumper cables, protective ear coverings, safety eyewear, magnets for metal working purposes in International Class 9;

Paint markers for highlighting and marking metals, window markers, Industrial marking products, namely, soapstone in International Class 16; and

Plastic tape for use in auto safety in International Class 17.⁴

The Trademark Examining Attorney refused registration of the proposed mark on the ground that it is not inherently distinctive under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. Specifically, the Examining Attorney argues the proposed mark is of a type that can never be inherently distinctive.

After the Examining Attorney made the refusal final, Applicant appealed to this Board. Briefs were filed and oral arguments were presented. For the reasons set forth below, the refusal to register is affirmed.

⁴ Application Serial No. 86269096 was filed on May 1, 2014, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as March 2011 in International Classes 6 and 17; June 2012 in International Class 7; July 2011 in International Class 9; and August 2008 in International Class 16.

I. Evidentiary Issue

Applicant objects on several grounds to the Internet materials submitted by the Examining Attorney, claiming among other things that the materials were not cited in accordance with Trademark Manual of Examining Procedure (TMEP) § 710.01(b) (Oct. 2015),⁵ because they do not indicate either the date they were accessed from the Internet or their source, i.e., the URL addresses of the websites from which they were obtained.⁶ Because we decide this case on a threshold legal issue and thus do not rely on these materials, we do not address Applicant's arguments regarding their admissibility.

II. The Proposed Mark

We first address the nature of the applied-for mark because, as explained below, that determines whether the proposed mark can be inherently distinctive. Applicant disputes the Examining Attorney's position that it has applied for a "color mark," characterizing its mark instead as a "distinctive design and layout of colors on its packaging that functions as a 'symbol'."⁷ Applicant uses several alternative but

⁵ This is the edition of the TMEP in force at the time of filing of Applicant's Brief on January 11, 2016. With respect to making Internet evidence part of the record, the requirements on examining attorneys are the same in the current October 2017 edition of the TMEP.

⁶ Applicant's Brief p. 13 (4 TTABVUE 18). Page references to the briefs include a reference to the Board's TTABVUE docket system.

⁷ Applicant's Brief, pp. 10-11 (4 TTABVUE 15-16).

undefined names for the type of mark it seeks to register, including, e.g., a “symbol,”⁸ “design of colors,”⁹ and “color design.”¹⁰

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 and use varying degrees of fading of red into yellow, without any other, much less uniform, distinctive design:¹¹



⁸ *Id.*, pp. 11-12 (4 TTABVUE 16-17).

⁹ *Id.*, p. 9 (4 TTABVUE 14).

¹⁰ *Id.*, p. 10 (4 TTABVUE 15).

¹¹ *See* specimens filed with Application, TSDR at 9-15.





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.

Applicant maintains that its applied-for mark should be treated as product packaging claiming multiple colors, such that it is product packaging trade dress that may be inherently distinctive and, therefore, registrable without proof of acquired distinctiveness.¹² As support for its position, Applicant relies on *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069-70 (2000), *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1085-86 (1992), and *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010).

¹² Although the Examining Attorney informed Applicant that its mark could be registered upon adequate proof of acquired distinctiveness (September 16, 2014 Office Action, TSDR at 1), Applicant did not attempt to demonstrate acquired distinctiveness.

However, based on the drawing of the mark, we agree with the Examining Attorney that Applicant's mark is a color mark, consisting of multiple colors applied to product packaging. 37 C.F.R. § 2.52 (the drawing that any applicant is required to submit "depicts the mark sought to be registered"). Here, the drawing shows Applicant's mark surrounded by dotted or broken lines, indicating the mark's placement on product packaging. The mark description confirms this understanding. It states that the dotted lines are used to "merely depict placement of the mark" on the packing backer card. 37 C.F.R. §2.52(b)(4) (requiring mark description to explain the purpose of the broken lines); *see also* TMEP § 807.08. The particular shape of the product packaging (which varies as revealed by the specimens) is not claimed as part of the mark. The only elements claimed by Applicant, as amended, in the applied-for mark are the colors as applied to "the packer backing card." This is confirmed by the specimens submitted with the application, in which the mark appears in widely-differing shapes. We therefore treat Applicant's applied-for mark as a color mark, consisting of multiple colors applied to product packaging.

III. Registrability of Applicant's Proposed Mark

Both Applicant and the Examining Attorney cite the Supreme Court's *Wal-Mart* decision in support of their respective positions. Relying on *Wal-Mart*, Applicant contends that "trade dress can be inherently distinctive and that product packaging 'normally is taken by the consumer to indicate origin,' *i.e.*, an indication of source,

and not simply decoration.”¹³ Therefore, Applicant maintains that its mark is registrable on the Principal Register without proof of acquired distinctiveness.

The Examining Attorney asserts that color marks, such as Applicant’s applied-for mark, are never inherently distinctive and can be registered only on the Supplemental Register, or on the Principal Register with sufficient proof of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1162-63 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 419 (Fed. Cir. 1985); *cf. Wal-Mart*, 54 USPQ2d at 1068.¹⁴ The Examining Attorney argues that neither *Wal-Mart* nor *Two Pesos* instructs that a color mark can be inherently distinctive.¹⁵

¹³ Applicant’s Brief p. 7 (4 TTABVUE 12), quoting *Wal-Mart*, 54 USPQ2d at 1069:

“In [*Two Pesos*], we held that the trade dress of a chain of Mexican restaurants, which the plaintiff described as ‘a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals,’ 505 U. S., at 765 (internal quotation marks and citation omitted), could be protected under §43(a) without a showing of secondary meaning, see *id.*, at 776. *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, see, e.g., *id.*, at 773, but it does not establish that product-design trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the décor of a restaurant, seems to us not to constitute product design. It was either product packaging—which, as we have discussed, normally is taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.”

¹⁴ Examining Attorney’s Brief (11 TTABVUE 7). The Examining Attorney’s Brief was originally filed on March 28, 2016. It was subsequently re-filed in the proper format on April 7, 2016. Citations are to the Examining Attorney’s Brief filed on April 7, 2016.

¹⁵ In *Qualitex*, the Supreme Court framed the issue as “whether the . . . Trademark Act . . . permits the registration of a trademark that consists, purely and simply, of a color.” 34

The Examining Attorney maintains that the applied-for mark, a color mark applied to product packaging, consisting of the colors red into yellow with a black border applied to a particular type of Applicant's product packaging, specifically, a packaging backer card, cannot be inherently distinctive and is therefore registrable on the Principal Register only with a showing of acquired distinctiveness.¹⁶

Qualitex and *Owens-Corning*, which considered color marks, differ from the present case in two ways: 1) the color at issue in those cases was applied to products, not product packaging; and 2) they involved marks consisting of a single color. Here, by contrast, the issues presented are: (A) whether there is a different rule for inherent distinctiveness for color marks applied to product packaging than for color applied to a product itself; and (B) whether the rule that single-color marks cannot be inherently distinctive applies to color marks consisting of more than one color. For the reasons set forth below, we find that a color mark consisting of multiple colors applied to product packaging is not capable of being inherently distinctive. Thus, we do not reach the question of whether any particular proof has shown Applicant's mark to be inherently distinctive.

USPQ2d at 1162. "We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained 'secondary meaning' and therefore identifies and distinguishes a particular brand (and thus indicates its 'source')." *Id.* at 1163. The Court held that "sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark." *Id.* at 1162.

¹⁶ Examining Attorney's Brief (11 TTABVUE 17).

A. When assessing marks consisting of color, there is no distinction between color(s) applied to products and color(s) applied to product packaging

In *Two Pesos*, the trade dress at issue involved the overall visual appearance of Taco Cabana’s Mexican-themed restaurants. The sole issue before the Court was whether trade dress could ever be inherently distinctive. The Court held that the “inherently distinctive” restaurant trade dress could be protected without proving acquired distinctiveness.¹⁷ The decision is silent however, on the question of how to determine inherent distinctiveness in trade dress cases. See *Forney Indus., Inc. v. Daco of Mo., Inc.*, 835 F.3d 1238, 120 USPQ2d 1035, 1039 (10th Cir. 2016) (“Although the Supreme Court has held that trade dress can be inherently distinctive, it has given little guidance on what is required.”). In *Forney*, Applicant herein, as plaintiff, asserted infringement of a mark similar to the applied-for mark. As addressed more fully below, *Forney* considered Supreme Court decisions, as well as other court decisions, in the context of deciding whether a variation of Applicant’s applied-for color mark, consisting of multiple-colors applied to product packaging, could be protected as inherently distinctive. It held that it could not. See *Forney*, 120 USPQ2d 1040-42.

A few years after *Two Pesos*, the Supreme Court issued its decision in *Qualitex* holding that color alone may serve as a trademark and that the green-gold color of

¹⁷ The Supreme Court addressed “trade dress” in general throughout its opinion in *Two Pesos* without making a distinction between “product design” trade dress and “product packaging” trade dress. Several years later in *Wal-Mart*, discussed *infra*, the Court limited its *Two Pesos* decision by, in essence, excluding product design from the scope of its earlier decision in *Two Pesos* and creating a secondary meaning requirement for product design.

Qualitex’s dry cleaning press pads was registrable in view of its “secondary meaning.” 34 USPQ2d at 1166. We agree with the Tenth Circuit’s reading in *Forney* that, “[a]lthough . . . the color at issue was the product’s color, not the color of a package, nothing in the opinion suggests that the distinction matters.” *Forney*, 120 USPQ2d at 1040.

Five years after *Qualitex*, the Supreme Court decided *Wal-Mart*, holding that, like color alone, product design is protectable only upon a showing of secondary meaning. 54 USPQ2d at 1070. According to the Court, “*Two-Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive...but it does not establish that *product-design* trade dress can be.” The Court explained that the trade dress involved in *Two Pesos*, the decor of a restaurant, was not “product” design, but was “either product packaging . . . which, . . . normally *is* taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging” *Wal-Mart*, 54 USPQ2d at 1069 (emphasis in original).

While *Wal-Mart* states that color is not inherently distinctive, and requires a showing of secondary meaning to establish rights, 54 USPQ2d at 1068, Applicant asserts that the Court, in citing *Qualitex*, was referring to color used on the product itself (the green-gold dry cleaning pads), rather than product packaging.¹⁸ The relevant passage explains:

Indeed, with respect to at least one category of mark—colors—we have held that no mark can ever be inherently distinctive. See *Qualitex*, [514 U.S. at 162-63, 34 USPQ2d at 1162]. In *Qualitex*, . . . [w]e held that a color could be

¹⁸ Applicant’s Brief p. 8 (4 TTABVUE 13).

protected as a trademark, but only upon a showing of secondary meaning. Reasoning by analogy to the *Abercrombie & Fitch* test developed for word marks, we noted that a product's color is unlike a "fanciful," "arbitrary," or "suggestive" mark, since it does not "almost automatically tell a customer that [it] refer[s] to a brand," *ibid.* [*Qualitex*, 514 U.S. at 163, 34 USPQ2d at 1162], and does not "immediately . . . signal a brand or a product 'source,'" *id.* However, we noted that, "over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand." *Id.*, [*Qualitex*, 514 U.S.] at 162-163, [34 USPQ2d 1162-63]. Because a color, like a "descriptive" word mark, could eventually "come to indicate a product's origin," we concluded that it could be protected *upon a showing of secondary meaning. Ibid.*

54 USPQ2d at 1068 (emphasis in original).

Wal-Mart clarifies that, while certain types of product packaging may be inherently distinctive source indicators, a color mark, that is, a mark consisting of color—whether applied to a product or its packaging—is not among them. *Wal-Mart* and *Qualitex* together make clear that "a particular color on a product or its packaging," 54 USPQ2d at 1068, can never be inherently distinctive and may only be registered on a showing of acquired distinctiveness.

Relatively recently, in *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017), we held that although a "color applied to a product or *its packaging* may function as a trademark . . . color can never be inherently distinctive as a source indicator." *Id.* (emphasis added) (citing *Wal-mart*, 54 USPQ2d at 1068). Here, while we recognize that product packaging, unlike product design and shape, is capable of being inherently distinctive and registrable on the Principal Register without a showing of acquired distinctiveness, *see* authorities collected and discussed

in TMEP § 1202.02(b)(ii), this principle does not apply to the analysis of Applicant's mark, which is a color mark, not a product packaging trade dress mark.

B. A mark consisting of multiple colors without additional elements is still a “color” mark, and thus cannot be inherently distinctive

We also see no legal distinction between a mark consisting of a single color and one, such as Applicant's, consisting of multiple colors without additional elements, e.g., shapes or designs. The Tenth Circuit's decision in *Forney* is instructive.

After reviewing *Two Pesos*, *Qualitex*, *Wal-Mart*, and several other pertinent cases, the *Forney* court held:

[i]n light of the Supreme Court's directive that a product's color cannot be inherently distinctive and its concern that inherent distinctiveness not be the subject of excessive litigation, we hold that the use of color in product packaging can be inherently distinctive (so that it is unnecessary to show secondary meaning) only if specific colors are used in combination with a well-defined shape, pattern, or other distinctive design. A review of the pertinent case law, both before and after *Wal-Mart*, indicates that our view is consistent with the practice of other courts.

Forney, 120 USPQ2d at 1040. Further, the *Forney* court noted that “[n]one of these cases support the proposition that a color scheme or palette, in and of itself, can be inherently distinctive. Each looked to color in association with shapes and other patterns or designs.” *Id.* at 1042.

Finding that Applicant used the combination of colors in its trade dress in such diverse ways that there was no consistent shape, pattern, or design it could discern from Applicant's description of its color mark,¹⁹ the court found that Applicant failed

¹⁹ Applicant defined the trade dress, *i.e.*, the “Forney Color Mark,” in *Forney v. Daco* as:

to establish an inherently distinctive trade dress. *Id.* at 1044. None of the pertinent decisions reviewed by the *Forney* court support the proposition that a mark consisting of colors applied to product packaging can be inherently distinctive. We agree with the Tenth Circuit’s analysis of the relevant case law, and hold that a color mark consisting of colors applied to product packaging cannot be inherently distinctive, and may be registered on the Principal Register only upon adequate proof of acquired distinctiveness. Under that legal standard, we find that Applicant’s color mark which is not combined with a distinctive well-defined shape, pattern or other distinctive design is not inherently distinctive.

IV. Conclusion

Colors alone cannot be inherently distinctive. Even if they could be, nothing in the record presented in this case indicates that Applicant’s color mark, consisting of three colors, with the color red merging into yellow and a black banner located across the top, applied to a “packer backing card,” or more generally product packaging for the

The Forney Color Mark is a combination and arrangement of colors defined by a red into yellow background with a black banner/header that includes white letters. More specifically, the Forney Color Mark includes red and yellow as the dominate [sic] background colors. Red typically starts at the bottom of the packaging, continues up the packaging and may form borders. Red may also be used in accents including but not limited to lettering. Yellow typically begins higher than the red and continues up the packaging. Yellow may also provide borders and be used in accents including but not limited to lettering. A black banner is positioned toward the top of the package label or backer card. Black may also be used in accents including but not limited to lettering. White is used in lettering and accents.

120 USPQ2d at 1043.

goods, would be perceived as inherently distinctive. Inasmuch as Applicant has not requested registration under § 2(f) in the alternative, acquired distinctiveness is not at issue.

Decision: The refusal of registration pursuant to §§ 1, 2 and 45 of the Trademark Act is affirmed.