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insights

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THE SECOND PRECEDENTIAL DECISION ON SINGLE COLOR MARKS THAT THE BOARD HAS ISSUED IN THE 25 YEARS SINCE *QUALITEX*

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Medline Wins Important Case on Trademark Registration of a Color

By Janet Marvel and Seth Appel

Whether, and to what extent, a color can be protected under the trademark laws has long been a vexing issue, both in the courts and in the Trademark Trial and Appeal Board (“TTAB”). Our client, Medline Industries, Inc., recently won an important case on this issue. In a precedential decision, the TTAB reversed the Examining Attorney and held that Medline could register its shade of green for gloves because it did not conflict with another company’s registration for a different shade of green for gloves.

This is the first precedential 2(d) *ex parte* reversal since 2015. It is also only the second precedential decision on single color marks that the Board has issued in the 25 years since the Supreme Court’s landmark “color” decision, *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995). The Board agreed with our position that the scope of the prior registration cannot extend to all shades of green gloves, as a single entity cannot properly claim exclusive rights to the entire spectrum of greens:

We agree with [Medline] that [the Examiner’s] position is untenable. Beyond being inconsistent with the application and registration, it would in essence result in a *per se* rule, the effect of which would be to remove the color green entirely from the supply of colors available for potential use as marks for medical gloves, even if a particular shade of green is unlikely to cause confusion with the registered mark.

Thus, the Board permitted Medline’s mark to proceed to registration on the Supplemental Register.

Background

In its 1995 *Qualitex* decision, the Supreme Court held that a single color can be protected and registered as a trademark. The lower courts have recognized, however, that multiple companies can use different shades of a color for the same product without trademark confusion. For example, the court found no likelihood of confusion between different shades of blue grip tape for tennis rackets in *Unique Sports Products, Inc. v. Ferrari Importing Co.*, 100 U.S.P.Q.2d 1948 (N.D. Ga. 2011), *aff'd in part, vacated in part*, 720 F.3d 1307 (11th Cir. 2013). Similarly, the court denied a temporary restraining order in *Clam Corp., Inc. v. Innovative Outdoor Solutions, Inc.*, 89 U.S.P.Q.2d 1314 (D. Minn. 2008) where the parties sold different shades of blue ice fishing shelters.

In the sole prior precedential TTAB decision on likelihood of confusion between two single-color marks since *Qualitex, In re Cook Med. Tech. LLC*, 106 U.S.P.Q.2d 1784 (T.T.A.B. 2012), the Board found confusion was indeed likely between the applicant's design, which included the color teal, and a prior registered mark for the color blue. The Board explained that teal is a shade of blue, i.e., greenish blue, and therefore, was encompassed by the prior registered mark: By contrast, in the present case, the registered mark and the applied-for mark did not overlap because each was expressly stated to be a specific, different, shade of green.

Color Claims in Trademark Applications

The Trademark Office encourages trademark owners to identify their colors by Pantone:

[R]egistered marks designating commercial color identification systems, such as PANTONE ..., may appear in connection with a color identifier in the description of the mark, because greater precision in identifying the color may be critical in accurately describing the mark.

T.M.E.P. § 808.02; *see also* T.M.E.P. § 807.07(a)(i) (“The color claim may also include a reference to a commercial color identification system.”).

Since specific Pantone colors were identified in Medline's application and the cited registration, the Board held

that neither trademark owner “claims plenary rights in the color green for medical gloves, but only rights limited to a certain shade.” The Board also noted that Medline's claim to Pantone color number 2274C affords greater precision than a “vague description” such as “light green.”

Colors and Likelihood of Confusion

As we argued, the Examining Attorney's position effectively created a monopoly on a significant portion of the color spectrum, giving the prior registrant the exclusive right to use all shades of green, and to stop competitors from using any shade of green, whether confusingly similar or not. The courts have generally rejected the “color depletion” theory, that sellers will run out of colors if we acknowledge exclusive rights to use this or that color, on the ground that there are in fact many colors to choose from. *See Qualitex Co.* 514 U.S. at 168 (“When a color serves as a mark, normally alternative colors will likely be available for similar use by others.”); *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219, 223 (8th Cir. 1993) (rejecting color depletion theory due to large number of different shades available: “Until secondary meaning has been established in every distinguishable shade of color and in no color at all, a highly improbable situation, there will always be an option available to a new market entrant.”). However, if one entity could claim the exclusive right to all shades of a particular color – based on a registration for one specific shade – competitors would indeed run out of competitive options.

Taking into account the many other greens available, the TTAB compared the parties' colors at issue and found that they were dissimilar enough to make confusion unlikely – even when used for identical products in identical trade channels – since the registered mark was a “bright, attention-grabbing hue,” while Medline's mark was a “subdued, pale shade.” It found that the parties' marks “would be viewed and remembered, at most, as distant relatives in the green family.”

Our team handling the case included partners Janet Marvel and Seth Appel and associate Jacquelyn Prom. ■

*firm*UPDATE

NEW ASSOCIATE

■ Anne Lewis



We are pleased to welcome Anne Lewis as a new associate. Anne received her J.D. from Tulane Law School in 2015, where she was a published member of the *Journal of Technology and Intellectual Property*. Anne's

experience includes trademark prosecution and litigation, as well as false advertising, defamation, and trade secret matters. During her summers in law school, Anne interned for Time Inc.'s legal department in New York, and the Ministry of Art And Culture in Cambodia. Prior to law school Anne worked for a photography foundation, where she handled gallery sales and exhibition/ event management.

PUBLICATIONS

■ Jonathan Jennings



Jonathan's update to the Illinois chapter for the book *State Trademark and Unfair Competition Law* will be published online by INTA in April, 2020.

PRESENTATIONS

■ Ashly Boesche



Ashly spoke on "Trademarks and Unfair Competition" to the Attorney Mom Social Club on March 11.

■ Belinda Scrimenti

Belinda will moderate a panel discussion on May 20 for the DC Bar on "Scandalous Marks One Year Later: The Impact of *Brunetti* and the PTO's Commonplace Words Doctrine." The panel will include Mr. Brunetti's Supreme Court counsel, John Sommer, General Counsel of Stussy, Inc., and Megan Carpenter, Dean and Professor of Law, University of New Hampshire Franklin Pierce School of Law. The program will examine Mr. Brunetti's "F.U.C.T." applications and other applications to register allegedly vulgar or inappropriate terms. Online/In person Registration: <https://bit.ly/2ULRd7j> (date subject to change due to coronavirus).

TEACHING

■ Jonathan Jennings

Jonathan will teach an online course on Right of Publicity Law this summer for the UIC John Marshall Law School.

*firm*NOTEWORTHY

SCOTUS Amicus Curiae Brief

Thad Chaloeintiarana, Phillip Barengolts and **Jacquelyn Prom** filed an *Amicus Curiae* brief in the U.S. Supreme Court on behalf of a Coalition of .Com Brand Owners in Support of Booking.com in *USPTO v. Booking.com B.V.* The Coalition opposes the USPTO's *per se* rule barring registration of any mark that consists of an arguably generic term plus a top level domain.

Managing IP – Americas IP Awards

Pattishall McAuliffe is proud to receive the 2020 "Trade Mark Contentious Midwest Firm of the Year" award from *Managing IP*.

Saul Lefkowitz Moot Court Competition

In February, **Jonathan Jennings** and **Janet Marvel** served as judges for the 2020 INTA Saul Lefkowitz Moot Court Competition.

WTR 1000 RANKINGS

Pattishall McAuliffe received the top Gold Band ranking both nationally and in Illinois in the 2020 *WTR 1000* report. **Bob Sacoff** was nationally ranked Silver for “enforcement and litigation.” **Jonathan Jennings** was ranked Silver nationally for “enforcement and litigation,” and Gold in Illinois for “enforcement and litigation” and “prosecution and strategy.” **Janet Marvel** was nationally ranked Gold for “prosecution and strategy” and Gold in Illinois for “prosecution and strategy.” **Brett August, Phil Barengolts, Thad Chaloeintiarana, Bradley Cohn, Janet Marvel, Bob Sacoff and Joe Welch** were ranked Silver in Illinois for “enforcement and litigation.” **Belinda Scrimenti** was ranked Silver in Illinois for “prosecution and strategy.” **Ashly Boesche** was ranked Bronze in Illinois for “enforcement and litigation.” **David Hilliard** was honored as one of two Intellectual Property Luminaries in Illinois.

A few select WTR quotes:

“Pattishall, McAuliffe ... boasts a deep bench of top professionals who protect their clients with passion and pride while being ‘incredibly supportive of the wider legal community’ in terms of expertise and time.

[M]anaging partner, **Bradley Cohn** ... is ‘one of the best there is at it’, with great instincts regarding trial strategy and a gift for diagnosing the strengths and weaknesses of a case.

Thad Chaloeintiarana ... ‘is always ready with a timely, well-reasoned and thoughtful response to any issue. ... Thad always delivers, no matter how quick the turnaround time required is or what sort of chaos you can throw at him.’

Jonathan Jennings continues to shine on high-end cases. ‘Jonathan is extremely approachable and is hands-on with the work assigned to him and his team. He has profound IP knowledge and can convey complex legal concepts in business language, allowing you to understand the work being done and make well-informed decisions.’

Phillip Barengolts ... ‘gets you where you need to be through his hard work and dedication. He is quick to respond and provides comprehensive yet practical advice while keeping budget concerns in mind.’

Brett August is ... ‘very up-front and will tell you when a case is a dog and you need to get out. A ... high-calibre guy who adds heft to Pattishall’s practice.’

Janet Marvel ... a ‘wonderful mentor and superb listener who really tailors her advice to the particular needs of clients.’

Joseph Welch II ... is a zealous advocate for his clients in litigation.

Robert Sacoff is also a prominent author, speaker and bar leader with decades of experience ... in prosecution, clearance and enforcement.

Performing flawlessly on both sides of the contentious/non-contentious divide, **Belinda Scrimenti** can ‘solve any issue in the most creative and efficient manner. ... She [is] thorough, highly responsive and extremely knowledgeable on all topics related to trademarks.’

Ashly Boesche is ... ‘thoughtful, creative and practical, and someone to call when you have a particularly tough question to work through.’ It is no wonder then that she makes her debut in the *WTR 1000* this year.”



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