

## Color marks: how to prove acquired distinctiveness?

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This year, one of America's favorite cereals saw its hopes to register its yellow box as a trademark crushed under the weight of the burden to prove acquired distinctiveness.

*Qualitex Co. v. Jacobson Prods. Co.* is probably one of the landmark decisions with respect to the interpretation of the language in Section 1127 of the Lanham Act that includes colors within the spectrum of registrable trademarks. In this decision, the Supreme Court reasoned that the wording "symbol" or "device" in the Act can encompass colors because human beings can use "almost anything" to convey meaning, including colors. After all, it continues, if the USPTO has allowed registering as mark shapes, sounds and even scents, there seems to be no reason to exclude colors from the list of available trademarks. This is in line with the purpose of registering a trademark, which is to help consumers quickly and reliably to identify the source of the product they are purchasing, and allow producers to reap the financial and reputation-related benefits of their products.

The fact that courts can determine whether there is infringement based on color further supports this position. Similar to the likelihood of confusion analysis between two word or design marks, courts have also engaged in a so called "shade confusion" analysis, evaluating different color hues of an applicant's mark against a registered color mark. However, in *Qualitex* the Court did point out that word and design marks are the most direct and effective way for consumers to identify a particular brand. As such, because colors have less of a source-distinguishing ability, the burden to prove acquired distinctiveness through color is necessarily higher.

On August 22, 2017, the Board rendered its decision in *In re General Mills*, one of the most recent cases dealing with the question of whether a certain color had risen to the required level of distinctiveness to win a spot on the Principal Register. The answer was no.

General Mills sought to register the color yellow for "toroidal-shaped, oat-based breakfast cereal" in International Class 30. Their goal was to protect the packaging of one of the well-known oat-based cereals: "Cheerios". In this specific instance, they were only attempting to register the color yellow as the predominant uniform background of their packaging, without any particular indication as to the position of their mark on such packaging.

To support their position, General Mills presented voluminous evidence, including a survey and an expert report showing that consumers identified the yellow cereal box not only with General Mills in general – the producer of the goods – but were normally able to relate it to the specific brand, "Cheerios". In their survey, they proved that 48.3% of the surveyed consumers associated the yellow box with the Cheerios brand and that such association was overwhelmingly due to the yellow color of the box.

The Examining Attorney, however, countered this evidence arguing that consumers might generally perceive the color yellow as a decorative feature of the packaging, especially given the variety of colors consumers encounter when they walk in the cereal aisle of any supermarket. Relying on *Qualitex*, the Examiner further explained that perceiving the color as a decoration, rather than the main factor driving the identification of the source of the product, defeats the purpose of a trademark registration. The Examiner posited that generally consumers tend to perceive colors as ornamentation. As a final note, the Examiner produced 23 cereal products that are sold in a packaging similar to Applicant's yellow Cheerios box to show that Applicant did not have "substantially exclusive" use of the yellow color for its packaging.

Despite the seemingly good survey results obtained from Applicant, the Board worried that the wording of the survey was perhaps deceiving. Applicant's questions read "What *brand* of cereal comes in this box?"; and "What.. makes you think the brand *is* ...?". The Board explained that the way the questions were phrased induced the subjects to respond naming only one brand, while responders might have connected the yellow cereal box with multiple cereal brands, in addition to Applicant's. In the Board's view, the results of the survey, while they clearly show successful promotional efforts to link the yellow cereal box to Cheerios, do not however demonstrate the color yellow alone indicates that the source of the product is Applicant's.

With respect to the format of the survey, the Board's reasoning seems to be inconsistent with the holding in *Owens-Corning*, a case on which the Board heavily relied in *General Mills*. In *Owens-Corning*, the Federal Circuit rejected the criticism that the survey at issue did not elicit plural responses from its participants. In that instance, the Court disagreed with the Board, explaining that, even if the survey was not phrased to generate plural responses, because 50% of the consumers linked the color pink for insulation to Applicant's mark, Applicant had successfully established a syndetic relationship between the color and its mark.

Owens-Corning provided evidence that it distributed substantial promotional material in pink, and engaged in considerable advertising efforts for consumers to establish a connection between the mark and the color pink. This was almost an identical marketing strategy to General Mills which, in fact, resulted in similar consumer survey data. Then, why is the decision in *General Mills* different?

The Board focused on exclusivity of use. In *Owens-Corning*, the Federal Circuit indicated that, on top of the consumer survey results, promotional and advertising efforts, no other competitor dyed its fibrous glass pink. As a result, since the color pink lacks any functionality *per se*, it had no other purpose than to identify the source of the product— which is the purpose of a trademark. Based on this analysis, the Court reversed the Board's decision not to grant registration of the color pink as a trademark for fibrous glass. In *General Mills* however, the Examining Attorney was able to identify a number of competitors that used the color yellow for the packaging of their toroidal-shaped, oat-based cereals and, although they may have not enjoyed similar brand recognition to General Mill's Cheerios, they still were entitled not to be restricted in their use of the color yellow on their packaging.

In conclusion, it seems that brand recognition alone is insufficient to establish acquired distinctiveness for color marks, despite consumer survey data evidencing a 50% brand recognition rate. In the Board's evaluation for acquired distinctiveness, it appears that exclusivity of use – or more generally the number of competitors that use the same color – plays a determining role. The lingering question remains: how many competitors defeat "substantial exclusivity" of use?

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