

LEGAL AND PRIVACY

Recent legal decisions teach how to protect color trademarks

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Luxury and fashion goods companies increasingly are using color as a branding tool.

From the robin's-egg blue Tiffany box to the Louboutin red sole, color is a powerful way to signal to consumers who made the item, and for consumers to broadcast the item's brand.

But how can these companies protect their rights in this powerful branding tool?

Although a 1995 Supreme Court decision permitted colors to be protected as trademarks, the Trademark Office and courts remain in many cases skeptical, since the same colors are often used by many brands, and allowing trademark rights in a color could unfairly restrict competition.

So, it is important for brands seeking to protect color to have a well-defined strategy and strong proofs to bolster their color claims.

Two recent trademark applications by cosmetics retailer Glossier suggest some possible strategies that can be employed. And, a recent decision of a Federal Court of Appeals may widen protection for color marks in some cases.

The Glossier Applications

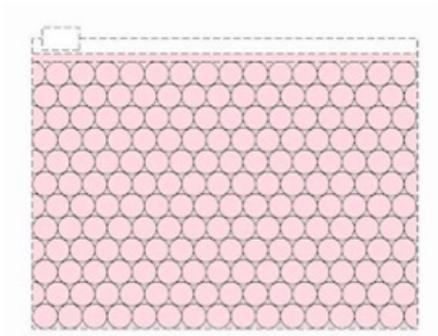
Cosmetics company Glossier uses two types of pink packaging as a signature branding tool. It uses a pink bubble-wrap plastic bag to package many of its cosmetics and skincare products, when these are shipped to the customer. And it uses boxes with an inside pink color, again for cosmetics and skincare products. Both of these, it claims, have become closely associated with its brand.

When Glossier sought to register these, both were initially rejected. It then amended its applications, and they were eventually approved.

Pink Bubble-Wrap Pouch

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Ziploc closure:



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The Trademark Office, however, rejected the application for two reasons.

First, the bubble-wrap portion was "functional" it has advantages (cushioning the product) apart from acting as a trademark, and functional marks cannot be protected.

Second, because the color pink is common in the cosmetics industry, the Trademark Office doubted that consumers would associate the pink color with just one brand, a basic requirement for any trademark.

Rather than fight these rejections, Glossier cleverly amended its application.

First, it took out the bubble-wrap part of the mark, disclaiming that the bubble wrap aspect is part of its trademark. It did so by putting the circular bubbles in dotted lines and stating clearly that it is not part of the claimed mark.

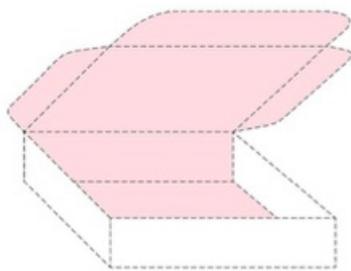
Since Glossier now no longer claimed any rights in the bubble-wrap pattern, that satisfied the functionality requirement. Its competitors are now free to use bubble-wrap without any claim by Glossier against them.

Second, it noted its long use of pink bubble-wrap pouches, and that to its knowledge no other company used that to package cosmetics. This evidenced that this packaging configuration is recognized and associated with Glossier.

The Trademark Office accepted these arguments and approved the application.

The Pink Box Application

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The Trademark Office rejected the application because many cosmetic companies use pink boxes, and so there is no reason to think that customers associate that specifically with Glossier.

Glossier dealt with this rejection also very cleverly. It noted that all the companies cited by the Trademark Office use pink on the *outside* of their boxes. Glossier, on the other hand, uses it, specifically on the *inside*.

To make this distinction even sharper, Glossier added in a new restriction on its mark: the outside of the box had to be a contrasting color.

Glossier relied on a federal court decision about Louboutin's red sole. Louboutin had claimed a red color for shoes as its mark. But the federal court restricted the mark to red soles with a contrasting color for the upper part of the shoe, thus excluding all-red shoes.

And to bolster its claim, it submitted extensive evidence from customers, social media posts and general media

coverage to demonstrate that its pink pouch had become recognized and associated with Glossier.

Glossier's arguments were accepted by the Trademark Office.

Court of Appeals Decision

The Court of Appeals for the Federal Circuit hears appeals of rejections of trademark applications by the Trademark Office. In a recent case, it considered a claim by Forney Industries, a manufacturer of accessories and tools for welding and machining.

Forney claimed that it uses a combination of black, yellow, and red colors on its packaging, and that these colors are its trademark.



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The Trademark Office held, based on a 1995 Supreme Court case, that the manufacturer had to provide evidence that it had developed recognition and association of these colors as its trademark.

But the Court of Appeals held that that requirement is *only* for colors that appear on the products themselves, not colors that appear on packaging, which is what Forney claimed.

For packaging, the court held, color trademarks, at least multi-color trademarks, can be immediately protectable as a trademark, assuming that they appear distinctive enough. It did not, however, decide whether *single color* marks for packaging might be immediately protectable.

The *Forney* decision can be very useful for companies who seek protection for color on packaging. At least for multi-color marks, companies can immediately claim trademark rights, and do not need to show recognition built up over time.

Takeaways

As noted, although color marks are protectable, they are often reviewed carefully and with skepticism by courts and the Trademark Office. So, it is important that a brand seeking to protect color as a mark formulate a strong strategy to maximize its chances of approval.

Considerations include:

- Is this a color for packaging or the product itself?

As the *Forney* case shows, color marks for packaging are now more likely to be approved.

- Consider combining the color with other limitations.

Claiming a color for all goods of a type ("red shoes") is very broad and invites increased scrutiny by courts and the Trademark Office. True, combining the colors with other limitations narrows the trademark, but it also makes it more likely that the claimed mark will be approved.

One possible limitation is to combine multiple colors, as the *Forney* case shows.

A variation on this, as seen in the Louboutin shoes and Glossier pink box, is to limit the color to one part of the product or packaging, and then require a contrasting color.

Another way to limit color marks is by including a specific shape or design as part of the color mark. Glossier's pink bag mark application stated that its "mark consists of the claimed color pink as applied to bags featuring lining of translucent circular air bubbles and a zipper closure."

Thus, not all pink packaging is covered only bags with "translucent circular air bubbles" and with a "zipper closure" are covered. These limitations allowed Glossier to protect its core branding pink bubble-bags without overreaching

to claim the color pink for *all* cosmetics packaging, which would likely have been rejected.

More targeted color marks are much more likely to be approved by the Trademark Office.

- What proof of public recognition is available?

Proof that the consuming public indeed associates the claimed color with one brand can be a powerful bolster to any trademark claim. Such proofs traditionally include proofs of extensive marketing and sales, and comments in the media and on social media about the color.

Glossier made effective use of these proofs in its application. For example, it submitted an excerpt from one magazine:

Glossier ships its products in iconic pink bubble wrap ziplock bags with minimalist pink-and-white packaging, which influencers often feature in their Instagram posts alongside Chanel perfume and Louis Vuitton handbags.

Such excerpts can be powerful evidence that branding efforts are working, and the public associates the packaging with the brand.

It is thus important for companies seeking protection for color to maintain good records of all these proofs sales, advertising campaigns, and media (including social media) mentions to later bolster any claim of trademark rights.

Conclusion

Color as a trademark can be a very valuable asset for a company. The Louboutin red sole, for example, is iconic and has provided significant rewards for the company.

But given that claims of color trademarks are reviewed with great scrutiny, it is important for brand owners claiming color as trademarks to adopt a strategy aimed at maximizing their chances of gaining protection.

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