

# True Colors Shining Through: Update on Protection for Product Packaging and Its Impact on the Nutrition and Food Industry

## Related People:

James H. Donoian  
Alexander L. Ried

## Nutrition Industry Executive

09.01.2020

The nutrition and food industry has long struggled to protect product and packaging designs from competitors and copycats seeking to trade on their looks. But even after committing significant resources to creating a design that will resonate with the public, companies may find it hard to convince the U.S. Patent and Trademark Office (USPTO) or a federal court that their packaging is worthy of trademark or trade dress protection.

Protecting shapes and colors is particularly challenging because trademark law seeks to prevent monopolizing of common words, shapes or colors. However, the Court of Appeals for the Federal Circuit, which oversees the USPTO, may have opened a narrow window for nutrition and food brands. The court reversed the USPTO's refusal to register the following multicolor mark, owned by Forney Industries (though the case dealt with packaging for welding and machining products, it is applicable to all industries): Before the Federal Circuit's decision, the USPTO had operated under the presumption that (1) product configuration and color marks are not inherently distinctive (i.e., worthy of protection based on their unique design and impressions) and, therefore, (2) one seeking protection must show that the packaging or color configuration had become recognized by consumers through years of exclusive use, promotion, commercial success or other indicators. This requisite consumer recognition is often referred to as "secondary meaning" or "acquired distinctiveness." Nutrition and food product packaging presents fundamental obstacles, given the common use of certain shapes, colors, and functional elements (for example, the color green for natural or herbal products, clear packaging or "windows," or common shapes such as a heart for health-related products). Even well-known package designs, like the iconic Coke bottle or the turquoise Tiffany box, needed to meet the secondary meaning threshold. In contrast, unique brand names are considered to be inherently distinctive and are accorded almost automatic protection (for example, Zoom for videoconferencing or Charmin for toilet paper).