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TOP INTELLECTUAL PROPERTY LAWYERS

## General Mills TTAB decision is not a pink slip for single-color trade dress

By Brian M. Wheeler

Following the Trademark Trial and Appeal Board's denial of General Mills' application to register a single-color trade dress for its yellow Cheerios boxes, myriad websites posted articles suggesting the TTAB decision left the prospect for trade dress protection for colored packaging black and blue, thereby emboldening would-be infringers. *In re General Mills IP Holdings II, LLC*, 124 U.S.P.Q.2d 1016 (TTAB 2017). But this hue and cry is mostly white noise for proponents of packaging trade dress that includes color as part of a more complex, multi-element trade dress.

As the TTAB explained, General Mills did not seek to register "any multi-element trade dress in its entirety." Rather, the TTAB affirmed the refusal to register the single-color trademark for Cheerios cereal boxes because it "was not persuaded that customers perceive Applicant's proposed mark, the color yellow *alone*, as indicating the source of Applicant's goods." But while the TTAB thus rejected protection for the color yellow as a single-color trade dress, the TTAB also observed that the color yellow was "one aspect of a more complex trade dress that includes other features that perform a distinguishing and source-indicating function."

Therefore, while accused infringers may continue to wave the TTAB's Cheerios decision like a red cape to a bull, trade



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dress owners and practitioners alike should not allow their adversaries to whitewash the silver lining the TTAB provided for packaging trade dress that includes the prominent use of one or more colors as part of a multi-element trade dress. Far from marking a black day for all trade dress that features color, the TTAB's recognition

of General Mills's more complex multi-element trade dress demonstrates that single-color and multi-element trade dress featuring color are horses of a different color.

Well before the Cheerios case, protection of single-color trade dress was notoriously difficult and only granted once in a blue moon. For instance, John Deere

could not get single-color protection for the green color of farm machinery, *Deere & Co. v. Farmhand, Inc.*, 560 F.Supp. 85, 98 (S.D. Iowa 1982), aff'd, 721 F.2d 253 (8th Cir. 1983), and Brunswick Corporation was denied protection for the black color of outboard boat motors. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994).

But for multi-element trade dress, protectability is not reduced to a dissection of the individual elements of the trade dress such as color. Rather, the focus is on "the overall visual impression that the combination and arrangement of those elements create. Trade dress is the composite tapestry of visual effects." *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001). These visual effects "may include features such as size, shape, color, color combinations, texture or graphics." *Id.* at 1257.

In *Clicks Billiards*, a pool hall sued a competitor for trade dress infringement. It cited numerous similar color schemes, such as the parties' black and white floor tiles; the similar colors of the parties' bars, oak cocktail tables, ceiling fans, bar chairs, trash cans, drop ceiling, and front door signage; both parties' dark green acoustical walls and off-white fur décor; and the color of lights over the pool halls. In reversing the district court's summary judgment for the defendant, the 9th U.S. Circuit Court of Appeals ruled that the plaintiff had introduced sufficient evidence

of secondary meaning to raise questions of material fact, including survey evidence. *Id.* at 1262.

In *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987), the court held that a restaurant owner could "protect a combination of visual elements that, taken together, may create a distinctive visual impression." The court named the colors in Fuddruckers' décor, such as white tiles, brown and white checked flooring and tablecloths, brown director's chairs, and exterior yellow awnings, in listing the "most important non-food design elements."

A recent case heavily relying on color elements as features of a company's trade dress is *Moroccanoil, Inc. v. Zotos International, Inc.*, 230 F. Supp. 3d 1161, 1171 (C.D. Cal. 2017). The court there found the appearance of the defendant's hair care products "strikingly similar" to those of the plaintiff's. After noting the similar white

vertical lettering, similar placement of an orange symbol, and similar blue background on the products' packaging, the court enjoined the defendant from distributing its products.

Issues such as distinctiveness and secondary meaning for trade dress are rarely black and white, but proponents of multi-element packaging trade dress should not buy into an adversary's characterization of the *General Mills* decision as a red light for securing protection for multi-element packaging trade dress. Moreover, the TTAB would disapprove of "extensive and detailed comparison" to *General Mills* or "other single-color trademark cases." As the TTAB cautioned, "[s]uch comparisons are rarely helpful, because the critical facts of different cases almost always differ substantially."

One lesson all trade dress practitioners should take away from the *General Mills* decision is that a well-designed survey may be the difference between a golden ticket and pink slip for

demonstrating secondary meaning for asserted trade dress. In *General Mills*, participants were shown an image of an unmarked, yellow, rectangular box and asked what brand of cereal they thought it held. But because the survey used the singular form of the word "brand," the TTAB concluded that participants likely believed they should name only one brand. Thus, this evidence served only as a red herring.

The *General Mills* decision demonstrates the importance of surveys and the difficulties of single-color trade dress protection, but otherwise should not color companies' expectations about trade dress law. It is not the death knell for packaging trade dress that includes the prominent use of one or more colors as part of a complex multi-element trade dress. Such trade dress may still pass with flying colors.

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