

Finding The Right Fit: The Test for Color Marks

In Re: PT Medisafe Technologies, No. 2023-1573 (Fed. Cir. April 29, 2025)

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On April 29, 2025, the Federal Circuit adopted a test from the Trademark Trial and Appeal Board (“TTAB”) for determining whether a color mark is generic. Under the test, the Federal Circuit affirmed that a color mark for medical examination gloves did not function as a source indicator, lacked sufficient evidence of acquired distinctiveness, and as such was not entitled to trademark protection.

Medisafe is a medical glove manufacturer and distributor. Medisafe applied for a color mark used in connection with its medical examination gloves, namely, “the color dark green (Pantone 3285 c) as applied to the entire surface of the goods which consist of chloroprene examination gloves.” But the trademark examiner refused to register the mark finding that the mark was not inherently distinctive and that, to be registered, the color mark required a showing of acquired distinctiveness. Medisafe submitted a declaration and color photographs and advertisements showing competitive goods in the industry, which did not convince the examiner that the mark had acquired distinctiveness. Medisafe responded to the rejection with additional declarations, but the examiner found that evidence insufficient. The examiner relied on the two-step test set forth in *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986) in determining that Medisafe’s mark was generic. Specifically, (1) identify the genus of goods or services at issue and then (2) determine if **the term** sought is understood by the relevant public to refer primarily to that genus of goods or services.



Medisafe appealed to the TTAB which applied a slight variation of the *Marvin Ginn* test that was tailored to the analysis of color marks as set out in *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 WL 6522400 (T.T.A.B. Dec. 2, 2019). *Milwaukee* considered (i) the genus of goods or services at issue, and (ii) whether **the color** sought to be registered or retained on the register is understood by the relevant public primarily as a category or type of trade dress for that genus of goods or services. The TTAB rejected Medisafe’s proposed genus (gloves to authorized resellers) in favor of a broader genus encompassing all chloroprene medical examination gloves. The TTAB agreed with the examiner that the relevant public includes “all such people or businesses who do or may purchase chloroprene medical examination gloves” and that the mark was generic because it “is so common in the chloroprene medical examination glove industry that it cannot identify a single source.” The TTAB found all 25 screenshots of third parties selling gloves in a same or near same color to be probative of genericness because “[t]he relevant consumer – even including unspecified ‘authorized resellers’ – could be exposed to . . . gloves that appear under a large number of third-party marks without identifying [Medisafe] as the source or manufacturer.” Medisafe appealed that decision.

The Federal Circuit affirmed that the TTAB had correctly applied the *Milwaukee* test. The Federal Circuit held that, although a color mark may serve as a source indicator, substantial evidence supported the TTAB’s finding that Medisafe’s proposed mark failed to function as a trademark. With this new case of first impression, there is now controlling precedent for evaluating the genericness of color marks.