



## ARE Trademark Alert: Obtaining Trade Dress Protection for Single Color Packaging at the U.S. Trademark Office

Author(s): Douglas A. Miro,

Companies should always be thinking about protecting their brands as much as possible. With the pandemic increasing the demand for online shopping, clients may want to think outside the box – or rather think about the box itself – when looking to distinguish their brand from others.

Of course, some companies, like Tiffany (think “Tiffany Blue”) have long distinguished their brand based on their product packaging. Tiffany even has its own custom color, PMS 1837 (for the year Tiffany was established), produced by Pantone. But “long” is the operative word. These so called “color marks” are not registerable on their own unless the trademark applicant can prove that a color mark has acquired distinctiveness, i.e., secondary meaning. One way this is done is by establishing a long period of use. For example, Tiffany applied to register its blue color for use on boxes only about 20 years ago but noted its first use in commerce was 1939.

A recent trademark registration by Glossier for its packaging – namely a pink pouch “featuring lining of translucent circular air bubbles and a zipper closure,” Registration No. 6,133,237, provides us a chance to revisit the types of evidence the Trademark Office has found persuasive to prove evidence of secondary meaning for color trademarks.

Glossier is a beauty company that packages its products in the above-described pink pouch. (Glossier’s website sells its pink pouches on their own noting it is “packaging so popular we sell it separately.”)

Glossier was founded less than ten years ago, in 2014, so it obviously couldn’t show decades of use as Tiffany could. When Glossier initially applied to register its trademark, the Trademark Office refused the application on several grounds including, as would be expected, that Glossier’s product packaging is not inherently distinctive.

The Trademark Examiner noted that the packaging is “a pink pouch with a bubble wrap lining”



and that not only can such packaging be acquired wholesale, but that bubble wrap is a common lining for packaging including a toiletry case sold by Victoria's Secret. Thus, consumers would not identify Glossier's pink bubble-lined pouch as a source indicator.

Glossier's extensive response to the refusal provides a nice illustration of a soup-to-nuts response, including some interesting evidence of acquired distinctiveness from the internet age.

Among the evidence was: (1) a company declaration indicating that the mark has been used continuously since 2014 and that sales of goods using the mark amounted to more than \$100 million; (2) its own advertising and marketing materials and evidence of media coverage; (3) 98 sworn customer declarations indicating that the customers "immediately recognize the color pink applied to the Glossier Pink Pouch"; (4) evidence of third-party social media posts featuring its pink pouch; and (5) evidence of parodies and copies by others as evidence.

Interestingly, the customer declarations appear to have been forms sent via e-mail to customers – presumably that ordered product or from a customer list – and was described to the customer as being "related to Glossier, Inc.'s ongoing work to obtain intellectual property for its distinctive 'Glossier pink' packaging." The customers were asked to sign the form declaration and send it back. This looks to be a low-cost way to gather consumer evidence to support a claim of acquired distinctiveness and may even help consumers feel as if they are partners in helping support their favorite brand.

After reviewing this material, the Trademark Office allowed the mark, and it has since registered. How much evidence is required to show acquired distinctiveness is of course the million-dollar question.

For example, Glossier applied for a second color mark for the use of pink as applied to the inside a box, which was recently published, Application Ser. No. 88/422,355. To show acquired distinctiveness for that application, Glossier again submitted the same 98 customer declarations, its own advertising and marketing materials and third-party social media posts, but it did not include a company declaration quantifying the dollar value of sales or evidence of parodies and copying by third parties. But this was still enough.



As seen by this pair of trademark applications, there is no one specific formula for showing acquired distinctiveness. But typically, the more material that can be provided, the better. These applications illustrate that third-party social media postings and mining one's own customer list can prove a fertile ground for such evidence.

[Douglas Miro](#) is a partner and [Benjamin Charkow](#) is an associate at Amster, Rothstein & Ebenstein LLP. Their practices involve all aspects of intellectual property law. They can be reached at [dmiro@arelaw.com](mailto:dmiro@arelaw.com) and [bcharkow@arelaw.com](mailto:bcharkow@arelaw.com).