

No.

IN THE
SUPREME COURT OF THE UNITED STATES

PT MEDISAFE TECHNOLOGIES,
Petitioner,

v.

UNITED STATES PATENT AND TRADEMARK OFFICE,
Respondent.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Does the “generic name” requirement of the trademark statute, 15 U.S.C. § 1064(3), apply equally to all marks or is there a special rule for color trademarks?

II

PARTIES TO THE PROCEEDING AND RULE 29.6 DISCLOSURE STATEMENT

1. All parties to the proceeding are named in the caption.

2. Petitioner PT Medisafe Technologies is not publicly traded and has no parent corporation, and no publicly held corporation owns 10% or more of its stock.

III

RELATED PROCEEDINGS

U.S. Trademark Trial and Appeal Board:

In re PT Medisafe Technologies,

Serial No. 88083209 (February 15, 2023)

U.S. Court of Appeals for the Federal Circuit:

In re PT Medisafe Technologies,

No. 2023-1573 (April 29, 2025)

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Petitioner PT Medisafe Technologies respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit (Pet. App. 1a-14a) is reported at 134 F.4th 1368 (Fed. Cir. 2025). The order of the Trademark Trial and Appeal Board (Pet. App. 15a-66a) is reported at *In re PT Medisafe Techs.*, 2023 TTAB LEXIS 61 (February 15, 2023).

JURISDICTION

The judgement of the Federal Circuit was entered on April 29, 2025. The Federal Circuit denied a petition for rehearing on July 3, 2025. This Court has jurisdiction under 28 U.S.C. § 1254(1).

The Federal Circuit had jurisdiction under 15 U.S.C. § 1071 and 28 U.S.C. § 1295.

STATUTORY PROVISIONS INVOLVED

The Lanham Act, 15 U.S.C. § 1064, provides in pertinent part that:

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed * * * (3) At any time if the registered mark becomes the generic

name for the goods or services, or a portion thereof, for which it is registered.

STATEMENT

Just over thirty years ago, this Court held that “there is no rule absolutely barring the use of color alone” as a trademark. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63 (1995) (“We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark.”).

And since then, the trademark office has registered thousands of such marks. Many of these trademarks are well-known to consumers, including “robin egg blue” for Tiffany, “brown” for UPS, and “magenta” for T-Mobile.

This case presents a critical question for the owners of color trademarks and the consumers who rely on them to identify the source of the products on which they are used. Namely, what is the legal test for determining whether color trademarks are “generic” under the Trademark Statute?

Petitioner Medisafe argued before the Federal Circuit that its dark green color applied to the surface of chloroprene medical examination gloves (shown below) is not generic under 15 U.S.C. § 1064.



In particular, Petitioner Medisafe argued that, based on the plain language of 15 U.S.C. § 1064(3), a mark becomes generic only when it “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.”

The Federal Circuit rejected this argument and held that the “generic name” requirement of 15 U.S.C. § 1064(3) does not “apply equally to all types of marks.” The Federal Circuit adopted a test for genericness that does not ask if the mark in question “names” or “refers” to the goods and asks instead:

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.

But in so doing, the Federal Circuit crafted a test for genericness that runs afoul of the Trademark Statute, the precedent of this Court, and every other court of appeals. And it presents a risk of grave harm to the owners of legitimate product design trade dress who may lose protection of the trademark law.

A. Statutory Framework

1. The Federal Circuit affirmed the Trademark Office’s refusal to register Petitioner Medisafe’s mark based on 15 U.S.C. 1064(3), which provides that a “cancellation petition” may be filed “if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” Although the phrase “generic name” is not defined in the statute, it is used in two other statutory sections. 15 U.S.C. § 1127 (“A mark shall be deemed to be ‘abandoned’ if . . . any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used.”); 15 U.S.C. § 1065(4) (“no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.”).

Despite the absence of a definition in the statute, this Court’s precedent instructs that “a ‘generic’ term names a ‘class’ of goods or services, rather than any particular feature or exemplification of the class.” *United States PTO v. Booking.com B.V.*, 591 U.S. 549, 556 (2020) (the term “booking.com” is not generic for the class of “travel-related services.”). Thus, for example, “the name of the good itself (e.g., ‘wine’) is incapable of ‘distinguishing one producer’s goods from the goods of others’ and is therefore ineligible for registration.” *Id.* at 554. Some other examples of generic terms are “aspirin,” “brassiere,” “cellophane,” “dry ice,” “escalator,” “thermos,” and “yo-yo.” *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J. 1952), *aff’d*, 206 F.2d 144 (3d Cir.

1953), and *modified*, 207 F.2d 509 (3d Cir. 1953); *Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528, 532 (7th Cir. 2003).

2. This case does not involve a word used as a mark and instead involves a color used as product design “trade dress.” The distinction the Trademark Statute makes between trade dress and other marks (such as words or logos) is that “the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.” 15 U.S.C. §§ 1125(a)(3), 1125(c)(4) (“the person who asserts trade dress protection has the burden of proving that . . . the claimed trade dress, taken as a whole, is not functional.”).

Like “generic name,” the phrase “trade dress” is not defined in the Trademark Statute. But “[i]t is well established that trade dress can be protected under federal law” and that trade dress is “[t]he design or packaging of a product.” *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 28 (2001). In particular, under this Court’s precedent, “trade dress” is “a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product . . . and we conclude likewise.” *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 209 (2000).

B. Case Background

1. This case arises out of Petitioner Medisafe's 22 years of continuous use of its dark green color on chloroprene medical examination gloves. Appx107.¹ Chloroprene is "a colorless liquid C_4H_5Cl used especially in making neoprene by polymerization." Appx627. Chloroprene gloves are sometimes referred to as "neoprene" or "polychloroprene" gloves. Appx539, 547, 559, and 567.

Petitioner Medisafe's dark green (Pantone 3285 c) color is not a by-product of the manufacturing process for its gloves. Appx109. Petitioner Medisafe's gloves have their distinctive dark green (Pantone 3285 c) color because of the addition of green pigment during the manufacturing process. Appx109. In addition to Pantone 3285 c, Petitioner Medisafe manufactures chloroprene gloves in other shades of green, including Pantone 3255 c and 359U. Appx107.

Petitioner Medisafe sought to register its dark green (Pantone 3285 c) trade dress with the Trademark Office for use on chloroprene medical examination gloves. The drawing of the mark in the application is below (the broken line serves only to show positioning of the mark and no claim is made to it):

¹ References to "Appx" are to the Joint Appendix located on the Federal Circuit's Electronic Case Filing system for this case (Federal Circuit Case No. 2023-1573) at docket entry 22 (filed October 22, 2023).



Appx253.

The specimen accompanying the application is below:



Appx252.

The Trademark Office has allowed registration on the Supplemental Register of at least the following colors for medical gloves:



Appx179, 181, 328, 329, and 175. And the Trademark Office has allowed the color “purple” to be registered on the Principal Register for “gloves for medical and surgical uses.” Appx 177, 330.

As for “chloroprene gloves” in particular, the evidence below showed that chloroprene medical examination gloves come in colors other than Petitioner Medisafe’s dark green (Pantone 3285 c). Appx082-83 (lime green), Appx037 (blue; “Le Soothe Sapphire”).

2. The Trademark Examining Attorney refused to allow the registration of Petitioner Medisafe’s color mark on the Supplemental Register. The Trademark Examining Attorney held that Petitioner Medisafe’s color mark was “generic” based on evidence of “common and widespread use of the color dark green on medical gloves.” Pet. App. 79a. And, although there were no declarations or other testimony from any member of the “relevant public” to this effect, the Trademark Examining Attorney found that “the color dark green used on medical gloves is understood by the relevant public primarily as a category or type of

trade dress for that genus of goods.” *Id.* The Trademark Examining Attorney further found that—again with no testimony from any member of the “relevant public”—that “the color dark green used on medical gloves is understood by the relevant public primarily as a category or type of trade dress for that genus of goods.” *Id.* Thus, the Trademark Examining Attorney found that “the relevant public would understand this designation to refer primarily to that genus of goods due to its common and widespread use.” *Id.*

Petitioner Medisafe appealed to Trademark Trial and Appeal Board (the “TTAB”), which affirmed the finding of genericness. The TTAB based its decision on its holding in a previous case which set forth the TTAB’s test for determining the genericness of a color mark as:

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.

Pet. App. 19a-20a (citing *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *7-8 (TTAB, December 2, 2019)).

Petitioner Medisafe then appealed to the Federal Circuit, which affirmed the TTAB. The Federal Circuit rejected Medisafe’s argument that the “‘generic *name*’ requirement [of 15 U.S.C. § 1064(3)] applies equally to all types of marks, meaning that trade dress—including a color mark—may, like a

word mark, be found generic only if it is a ‘generic *name*’ for the goods with which it is used.” Pet. App. 11a (emphasis added by Federal Circuit). The Federal Circuit instead held “that the statutory language ‘must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as . . . trade dress.’” *Id. citing Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1325-26 (Fed. Cir. 1999).

This petition followed.

REASONS FOR GRANTING THE PETITION

I. Courts Are Split on the Issue Raised

There are three conflicting approaches to the issue of genericness as it relates to color used as product design trade dress.

A. The Trademark Statute and This Court’s Precedent Suggest That Color Should be Treated the Same as Other Marks in Evaluating Genericness.

The Trademark Statute, 15 U.S.C. § 1064, was the statutory basis for the Federal Circuit’s determination that Petitioner Medisafe’s mark was not eligible for federal trademark registration. Pet. App. 10a-11a (“15 U.S.C. § 1064(3) provides that a registered mark may be cancelled ‘[a]t any time if the registered mark becomes the generic *name* for the goods or services, or a portion thereof, for which it is registered.” (emphasis added by Federal Circuit)).

This Court’s test for genericness is well known and tracks the language of the statute: “Marks that constitute a common descriptive name are referred to as generic. A generic term is one that refers to the genus of which the particular product is a species.” *Park’n Fly v. Dollar Park & Fly*, 469 U.S. 189, 194 (1985); *Booking.com B.V.*, 591 U.S. at 557 (2020) (the term “booking.com” is not generic because, if it were, “we might expect consumers to understand Travelocity—another such service—to be a ‘Booking.com.’ We might similarly expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite ‘Booking.com’ provider.”).

There is nothing in this Court’s precedent which suggests that a different test for genericness would apply to color. The foundational case addressing the use of “color alone” under the Trademark Statute is *Qualitex Co.*, 514 U.S. at 162 (“We now hold that there is no rule absolutely barring the use of color alone”). In *Qualitex*, this Court began its analysis by recognizing that the Trademark Statute describes the “the universe of things that can qualify as a trademark. . . in the broadest of terms.” *Id.* Because “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, th[e] language [of the Trademark Statute], read literally, is not restrictive.” *Id.* Thus, the Court found that a color alone can serve as a trademark because, “if a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?” *Id.*

Underlying the Court's analysis in *Qualitex* was the notion that there is nothing in the Trademark Statute that warrants treating color alone differently than any other "symbol" or "device." *Id.* at 162 (color is "capable of satisfying the more important part of the statutory definition of a trademark, which requires that a person 'use' or 'intend to use' the mark 'to identify and distinguish his or her goods'"). Thus, while it is "true [that] a product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost automatically tell a customer that they refer to a brand," there is nothing in the trademark law prohibiting a color that has attained secondary meaning from acting as a mark. *Id.* 162-63 ("if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same?").

An early example of this Court's analysis of color trade dress to identify a "genus of goods" arose—perhaps not surprisingly—in the context of generic drugs. *Inwood Labs. v. Ives Labs.*, 456 U.S. 844 (1982). In *Inwood*, the Plaintiff Ives sold "the drug cyclandelate, a vasodilator used in long-term therapy for peripheral and cerebral vascular diseases" under the brand name "CYCLOSPASMOL." *Id.* at 846. Plaintiff Ives also used color as product design trade dress by "arbitrarily select[ing] a blue capsule, imprinted with 'Ives 4124,' for its 200 mg dosage and a combination blue-red capsule, imprinted with 'Ives 4148,' for its 400 mg dosage." *Id.* at 846-847. Ives sued several generic drug manufacturers for trademark infringement on the grounds that they sold

“cyclandelate in 200 mg and 400 mg capsules in colors identical to those selected by Ives.” *Id.* at 847.

Although the majority opinion in *Inwood* focused on the issue of contributory liability, a concurring opinion by Justice White (joined by Justice Marshall) set forth a foundational analytical approach for color as product design trade dress. In particular, Justice White held that the colors used by Ives and the generic manufacturers “functioned” to identify the capsules as cyclandelate and, thus were not eligible for protection as trademarks. *Id.* at 862-63 (“It is my view that a finding of functionality offers a complete affirmative defense to a contributory infringement claim predicated solely on the reproduction of a functional attribute of the product.”). And critical to Justice White’s analysis were the findings of the district court that “capsule color was functional in several respects: . . . capsule colors assist patients in identifying the correct pill to take [and] standard colors help physicians identify the drug involved in case of overdose.” *Id.* at 862 and n. 3 (“color or shape may be a convenient shorthand code by which to identify the drug and its milligram dosage so that mistakes can be avoided in the interests of pharmaceutical precaution and patient safety. For the patient-user, of course, the constancy of color and shape may be as psychologically reassuring and therefore as medically beneficial as the drug itself; in addition, they also serve to identify the drug for his ingestion.”).

This Court’s precedent thus reveals no reason to treat color differently than any other trademark for purposes of analyzing genericness. *Qualitex* instructs that there is no statutory or other reason to treat

“color alone” used as trade dress differently than other marks. And *Inwood* demonstrates the feasibility of determining when and how color, used as product design trade dress, can function to identify a genus of goods and thus be ineligible to serve as a trademark.

Despite this, the Federal Circuit, on the one hand, and the Second and Third Circuits, on the other, treat product design trade dress such as color differently than other trademarks when assessing genericness. And the tests those Circuits apply conflict with each other and this Court’s precedent.

B. The Federal Circuit’s Differential Treatment of Color Marks Creates a Conflict with the Other Circuits.

In this case, the Federal Circuit “considered and rejected” Petitioner Medisafe’s contention that the “‘generic *name*’ requirement [of Section 1064(3)] applies equally to all types of marks.” Pet. App. 11a. (emphasis added by Federal Circuit). And in so doing, the Federal Circuit went out of its way to reject the notion “that trade dress—including a color mark—may, like a word mark, be found generic only if it is a ‘generic *name*’ for the goods with which it is used.” *Id.* (emphasis added by Federal Circuit).

But in rejecting a test for genericness for color marks that would require the mark to be a “generic name,” the Federal Circuit has created a conflict with the test for genericness used for other types of marks adopted by every other court of appeals. Indeed, the test for genericness articulated by every other court of appeals requires a showing that the mark at issue

“names” (or some synonym thereof, such as “refers to,” “identifies,” “signifies,” “depicts,” or “denotes”) the goods on which it is used. *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 374 (1st Cir. 1980) (a generic term is one that “has come to be understood as referring to the genus of which the particular product is a species” and “15 U.S.C. § 1064(c) provides for cancellation of any mark that has become the common descriptive name of an article or substance, *i.e.*, a generic term.”); *RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 120 (2d Cir. 2022) (“A generic mark is a common name, such as automobile or aspirin, that identifies a kind of product.”); *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000) (“Generic marks are those that function as the common descriptive name of a product class.”); *Retail Servs. v. Freebies Publ’g*, 364 F.3d 535, 538 (4th Cir. 2004) (“a ‘generic’ mark . . . merely employs ‘the common name of a product or service.’”); *Springboards to Educ. v. Houston Indep. Sch. Dist.*, 912 F.3d 805, 814 (5th Cir. 2019) (“A generic mark is simply the ordinary name of the product.”); *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 762 n. 10 (6th Cir. 2005) (“A generic term is one that is commonly used as the name of a kind of goods.”); *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996) (“A generic or common descriptive term is one which is commonly used as the name or description of a kind of goods.”); *Cellular Sales, Inc. v. MacKay*, 942 F.2d 483, 485-486 (8th Cir. 1991) (“A generic term is the name of a particular type, kind, genus or class of goods in which an individual article or service is but a member.”); *Elliott v. Google, Inc.*, 860 F.3d 1151, 1155 (9th Cir. 2017) (“generic terms are ‘common descriptive’ names which identify only

the type of good ‘of which the particular product or service is a species.’”); *Creative Gifts, Inc. v. UFO*, 235 F.3d 540, 545 (10 Cir. 2000) (a mark is generic where “the public understands the mark to signify the class of goods or services of which the trademarked product or service is a part.”); *Welding Servs. v. Forman*, 509 F.3d 1351, 1358 (11 Cir. 2007) (identifying three “approaches to defining ‘generic.’ By one test, a generic name refers to ‘a particular genus or class of which an individual article or service is but a member.’ By another measure, a generic name is the term by which the product or service itself is commonly known. Still other courts say a generic name depicts the product or service as a whole, rather than any particular feature, quality, or characteristic of the whole.”); *Blinded Veterans Ass’n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 1039 (D.C. Cir. 2007) (“A generic term is one commonly used to denote a product or other item or entity, one that indicates the thing itself, rather than any particular feature or exemplification of it.”).

Indeed, when it comes to a word mark, the Federal Circuit itself requires that the term “refer” to the good at issue for a finding of genericness. The Federal Circuit’s test for word marks thus asks, “whether members of the relevant public primarily use or understand the term sought to be protected to *refer* to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990 (Fed. Cir. 1986) (emphasis added).

But when it comes to trade dress, the Federal Circuit’s jurisprudence on genericness conflicts

sharply with that of the other Courts of Appeals. According to the Federal Circuit—when it comes to trade dress—“the term ‘generic name’ as used in 15 U.S.C. § 1064(3), must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as names, words, symbols, devices, or trade dress.” *Sunrise Jewelry*, 175 F.3d at 1326.

And in applying this test here, the Federal Circuit rejected a test that asks whether the trade dress “names” or “refers” to the goods at issue. Instead, the Federal Circuit held that a color is generic when “the color sought to be registered is understood by the relevant public primarily as a category or type of trade dress for a genus of goods or services.” Pet. App. 10a.

But by asking whether a color is a “type or category of trade dress” the Federal Circuit omits any requirement that the color “name” or “refer” to the product on which it is used. And, in so doing, it has created a test for genericness that conflicts with the test applied by every other court of appeals.

C. The Second and Third Circuits Treat the Genericness Inquiry as “Inapplicable” to Product Design Trade Dress.

The Second and Third Circuit take a different approach altogether when it comes to product designs and have held that the genericness inquiry is “inapplicable” to product design trade dress.

The Second Circuit, in evaluating a product feature, does “not ask whether it is ‘generic,’ ‘descriptive,’ ‘suggestive,’ or ‘arbitrary or fanciful’—categorizations which we find inapplicable to product features.” *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007-8 (2d Cir. 1995) (“the classification of marks into ‘generic,’ ‘descriptive,’ ‘suggestive,’ or ‘arbitrary or fanciful’ make little sense when applied to product features.”).

Likewise, the Third Circuit has held that, while “[s]ome courts have nonchalantly applied the trademark generic/descriptive/suggestive/arbitrary/fanciful taxonomy in the product configuration context (though none of them has inquired whether it makes sense to do so) . . . we do not think it helpful or proper to transplant the categorical distinctiveness inquiry developed for trademarks to product configurations, where the alleged trade dress lies in the very product itself.” *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1440, 1442 (3d Cir. 1994) (“What is ‘generic’ in trademark law is a word with so few alternatives (perhaps none) for describing the good that to allow someone to monopolize the word would debilitate competitors.”). “The difficulty is that, perhaps unlike product packaging, a product configuration differs fundamentally from a product’s trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product).” *Id.* at 1440-1441 (“The very basis for the trademark taxonomy—the descriptive relationship between the mark and the product, along with the degree to which the mark describes the product—is unsuited for application to the product itself.”).

There thus exist three conflicting approaches to the evaluation of genericness when color is used as product design trade dress: (1) the Trademark Statute and this Court, which would ask whether the mark “names” or “refers” to products, (2) the Federal Circuit, which asks if it is “a type or category of trade dress,” and (3) the Second and Third Circuits, which would consider genericness “inapplicable” to product features.

II. The Question of When Color Is “Generic” Is Important, Recurring, and Squarely Presented.

1. The proper test for assessing whether a color mark is generic is important given the proliferation of color marks since this Court’s 1995 ruling in *Qualitex*. According to one study, between 1991 and 2019, 3,584 color trademark applications were filed with the Trademark Office. Xiaoren Wang, *Should We Worry About Color Depletion? An Empirical Study of USPTO Single-Color Trademark Registrations*, 115(3) *The Trademark Reporter* (International Trademark Association) 545 (2025) (“Using the DSCM code¹⁰⁴, this study has collected 3,584 single-color trademarks filed between January 1, 1991 and December 31, 2019.”). And between 2003 and 2019, there were 1,416 single-color trademarks, 854 of which were registered or pending registration and 562 of which were not registered, either through denial of registration by the Trademark Office, abandonment, or some other reason. *Id.* That amounts to, on average, more than one registration or pending registration per week.

Adopting a lower standard for whether a color mark is generic will have dire consequences for the owners of single-color marks and the public that relies on them. “To determine that a trademark is generic and thus pitch it into the public domain is a fateful step.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §12:12 (4th ed. 2008). “The fateful step [of finding a mark generic] ordinarily is not taken until the trademark has gone so far toward becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name to designate the product they are selling.” *TY Inc.*, 353 F.3d at 531.

Moreover, a trademark or trade dress that is found generic can never be entitled to trademark protection and such registrations can be canceled at any time. “Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.” *Park 'n Fly*, 469 U.S. at 194 (citing 15 U.S.C. §§ 1052, 1064(c)). Even upon a showing of secondary meaning, generic marks are never entitled to trademark protection. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“No matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.”).

2. Despite the significance of the issue and the unsettled legal framework, District Courts are often

called upon to resolve the issue of the genericness of color marks. *OTR Wheel Eng'g, Inc. v. West Worldwide Servs.*, 2015 U.S. Dist. LEXIS 179505, *5 (E.D. Wash. 2015) (“The court finds as a matter of law that the light gray color is ‘generic’ and therefore, incapable of trade dress protection. Accordingly, it is not a valid trademark.”); *SafeRack LLC v. Bullard Co.*, 350 F. Supp. 3d 438, 454 (D.S.C. 2018) (rejecting “arguments regarding the mark being generic [because] orange [is] a color that denotes safety” and finding, “[t]herefore, it is undisputed that SafeRack’s [orange color] mark is not generic.”); *3M v. Shurtape Techs., Inc.*, 2001 U.S. Dist. LEXIS 27337, *12-13 (D. Minn. 2001) (holding “that summary judgment on the generic issue is not appropriate” where defendants argued “that the blue mark on painter’s tape is generic because the mark’s primary significance is identifying the product, rather than the source.”).

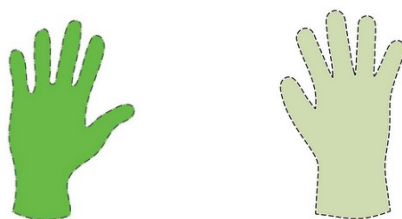
The Trademark Trial and Appeal Board (the “TTAB”) also has been called on repeatedly—in addition to the case at bar—to address the issue of whether the color of a product is generic for an entire class of products. *Poly-America, L.P. v. API Indus.*, 2020 TTAB LEXIS 67, *19 (TTAB 2020) (cancelling trademark registration for “orange color drawstring bags” because “consumers would not perceive the color orange as an indicator of source, they would perceive it as a type of trade dress for the genus trash bag[, and] [i]n view thereof, Poly Am.’s orange color drawstring is generic for trash bags.”); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *53-54 (TTAB, December 2, 2019) (“because the evidence establishes that the color red was widely used by others at the time [the trademark

owner] filed the underlying applications. . . , the color red was generic for power saw blades when [the trademark owner] applied for both of its marks and remains so now.”).

And within the Trademark Office, there is substantial inconsistency in the treatment of the issue of genericness. Indeed, the test for genericness set forth in the Trademark Manual of Examining Procedure (“TMEP”) recites that, when assessing genericness, “[i]t is not necessary to show that the relevant public uses the term to refer to the genus.” TEMP § 1209.01(c)(1) (2025). But such a pronouncement may have come as a surprise to the members of this Court who joined the majority opinion in *Park’n Fly*, 469 U.S. at 194, holding that “[a] generic term is one that refers to the genus of which the particular product is a species.”

The inconsistency in the Trademark Office also was apparent in this case when the Trademark Examining Attorney initially agreed to allow Petitioner Medisafe’s color to register on the Supplemental Register only to reverse course days later and without explanation. *Compare* Appx594 (July 26, 2021, email from Examining Attorney stating: “Yes, that is the proposal. Applicant agrees to seek registration on the Supplemental Register and the generic refusal will be withdrawn. The result will be that this application is registered on the Supplemental Register.”) *with* Appx593 (August 2, 2021, email from Examining Attorney stating: “After further consideration, I will be filing a request to remand to address applicant’s amendment of the application to the Supplemental Register that was

made in the alternative. I apologize for the inconvenience.”). The Trademark Office also has allowed other color marks to register on the Supplemental Register—including other green marks—without any consideration of whether they are generic. Appx.328-29 (marks shown below).



3. This case squarely presents the issue of what the proper test for the genericness of a color mark should be under 15 U.S.C. § 1064(3). Below, the Federal Circuit adopted a test that “asks ‘whether the color sought to be registered is understood by the relevant public primarily as a category or type of trade dress for a genus of goods or services.’” Pet. App. 10a. And the Federal Circuit specifically rejected the argument that the phrase “generic name” in Section 1064(3) “applies equally to all types of marks, meaning that trade dress—including a color mark—may, like a word mark, be found generic only if it is a ‘generic name’ for the goods with which it is used.” Pet. App. 11a. Indeed, the only issue the Federal Circuit addressed in any detail was whether Petitioner Medisafe’s mark was generic. Pet. App. 14a (“we affirm the Board’s determination that Medisafe’s proposed mark is generic and, hence, ineligible for registry on either the principal or supplemental registers. . . . We have considered Medisafe’s remaining arguments and find them either

unnecessary to address or unpersuasive. For the reasons stated above, we affirm the Board’s decision.”).

III. The Federal Circuit’s Decision in This Case is Wrong.

1. The Federal Circuit’s test for the genericness of color trade dress does not follow the Trademark Statute:

Trademark Statute 15 U.S.C. § 1064(3)	Federal Circuit Test Pet. App. 10a
A registered mark is generic when it “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.”	A color is generic when it “is understood by the relevant public primarily as a category or type of trade dress for a genus of goods or services.”

The plain language of the Trademark Statute and the Federal Circuit test have different meanings. To ask if something is the “name for goods or services” is to ask if it “constitutes the distinctive designation of” that thing. Merriam-Webster DICTIONARY (2025) (definition of “name”). To ask if something is “a category or type of trade dress for a genus of goods or services” is to ask if it is a category or type of “the overall appearance of a product and its packaging.” *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140, 145 (2023); *Wal-Mart*, 529 U.S. at 209 (“trade dress” is “a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent

years has been expanded by many courts of appeals to encompass the design of a product.”).

And the difference is critical. The answer to the question of whether a color is “a type or category of trade dress” is always “yes” because, as this Court has explained, color is “a category or type” of trade dress. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764, n. 1 (1992) (trade dress is the “total image of a product [which] may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”). And, as a result, the Federal Circuit’s test does not address whether a color is the “generic name” for the products on which it is used and does not comport with the Trademark Statute.

2. The problem with the Federal Circuit’s test is highlighted by the types of product design trade dress that this Court has dealt with in the past. For example, in *Two Pesos*, the trade dress was:

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 765 (1992). This is plainly “a type of category of trade dress.” But it is hard to imagine that anyone would agree that this type of trade dress serves as the “generic name” for the genus of services at issue in that case, namely, “restaurants [that] serve Mexican food.” *Id.*

This Court’s other cases dealing with product design trade dress likewise demonstrate that whether something is “a type or category of trade dress” has no relation to the “name” of the product or service on which it is used:

Type or Category of Trade Dress	Name of the Product
“green-gold color” <i>Qualitex Co.</i> , 514 U.S. at 161.	“pads that . . . dry cleaning firms . . . use on dry cleaning presses” <i>Id.</i>
“spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like.” <i>Wal-Mart</i> , 529 U.S. at 207.	“children’s clothing” <i>Id.</i>
“dual-spring design” <i>Traffix Devices</i> , 532 U.S. at 26.	“Temporary road signs with warnings like ‘Road Work Ahead’ or ‘Left Shoulder Closed’” <i>Id.</i>
“distinctive beverage bottle-with-label”	“durable rubber squeaky novelty dog toy” <i>Id.</i> at 150.

<i>Jack Daniel's Props.</i> , 599 U.S. at 149.	
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Indeed, if one were to cover the right-hand column, it seems unlikely that anyone would be able to guess the name of the product or service based on the type or category of trade dress listed in the left-hand column.

3. And there is nothing about color used as product design trade dress that warrants eschewing a test for genericness that asks whether a color “names” or “refers” to genus of goods on which it is used. For decades, Courts—including this one—have had no trouble identifying situations where the color of a product serves (or “functions”) to identify the genus of goods on which is used. *Inwood Labs.*, 456 U.S. at 862 (finding court of appeals erred in setting aside District Court’s factual finding that “capsule colors assist patients in identifying the correct pill to take [and] standard colors help physicians identify the drug involved in case of overdose.”); *Qualitex Co.*, 514 U.S. at 170 (observing that “color [can] serve a significant nontrademark function [such as] to distinguish a heart pill from a digestive medicine.”); *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 358 (3d Cir. 2003) (recognizing “the functional nature of the color of medical pills [including] where the color serves to identify the kind of medicine (e.g., a type of blood medicine).”; *Novartis AG v. Novadoz Pharms. LLC*, 2025 U.S. Dist. LEXIS 134796, *9 (D.N.J. 2025) (“for many patients, the overall look of a drug can come to represent to large numbers of those taking the drug not its source but its ingredients and their effects.”); *PIM Brands Inc. v. Haribo of Am. Inc.*, 81 F.4th 317,

322 (3d 2023) (“the candy’s color scheme is functional because it helps to identify its watermelon flavor. . . . Communicating the candy’s flavor is a legally recognizable function. And the candy’s colors serve that function: they are oriented like the fruit’s colors and evoke the fruit.”).

4. The undisputed facts of the case at bar further illustrate the problematic nature of the Federal Circuit’s test for whether a color is generic. Here, the goods at issue are “chloroprene medical examination gloves.” But Petitioner Medisafe’s dark green (Pantone 3285 c) color has nothing to do with that genus of goods. As the Trademark Examining Attorney in this case found, chloroprene itself is “a *colorless* liquid C_4H_5Cl used especially in making neoprene by polymerization.” Appx627 (emphasis added). And Petitioner Medisafe’s dark green (Pantone 3285 c) color is not a by-product of the manufacturing process for its gloves. Appx109. Instead, Petitioner Medisafe’s gloves have their distinctive dark green (Pantone 3285 c) color because of the addition of green pigment added during the manufacturing process. Appx109. Moreover, Petitioner Medisafe manufactures chloroprene gloves in other shades of green, including Pantone 3255 c and 359U in addition to Pantone 3285 c. Appx107. And there was no dispute below that chloroprene medical examination gloves come in colors other than Petitioner Medisafe’s dark green (Pantone 3285 c). Appx082-83 (lime green), Appx037 (blue; “Le Soothe Sapphire”). It was also undisputed that medical gloves in general are produced in a wide variety of colors unrelated to the composition of the glove and that the Trademark Office has allowed those colors to

be registered on the Supplemental or Principal Register. Appx175, 177, 179, 181, 328, 329, 330. And given this evidence, it is not surprising that there was no testimony from even a single consumer that Petitioner Medisafe's dark green (Pantone 3285 c) color named, referred, or was otherwise related to chloroprene medical examination gloves.

* * *

The Federal Circuit's decision in this case should be reviewed. It needlessly conflicts with the Trademark Statute and this Court's precedent—as well as that of the other courts of appeals—and undermines the settled expectations of the owners of color marks and the consumers that rely on them.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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October 1, 2025

APPENDIX

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**APPENDIX A — OPINION OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT,
DECIDED APRIL 29, 2025**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2023-1573

IN RE: PT MEDISAFE TECHNOLOGIES,

Appellant.

Appeal from the United States Patent and Trademark
Office, Trademark Trial and Appeal Board in No.
88083209.

Decided: April 29, 2025

Before PROST, CLEVINGER, and STARK, *Circuit Judges.*

STARK, *Circuit Judge.*

PT Medisafe Technologies (“Medisafe”) appeals from a decision of the United States Patent and Trademark Office’s (“PTO”) Trademark Trial and Appeal Board (“Board”) denying registration of its proposed mark. Because the Board applied the correct test for determining whether a color mark is generic, and substantial evidence supports the Board’s determination that Medisafe’s proposed mark is generic, we affirm.

2a

Appendix A

I

Medisafe, a medical glove manufacturer and distributor, applied to the PTO for registration of a color mark for use on medical examination gloves. The operative amended version of Medisafe’s application describes the proposed mark as “the color dark green (Pantone 3285 c) as applied to the entire surface of the goods which consist of chloroprene examination gloves.” J.A. 247. The application included a drawing of the mark, reproduced below (the broken line shows the positioning of the mark but is not part of it), and was accompanied by a specimen, also shown below:



J.A. 252-53.

Upon review of Medisafe’s initial application, the PTO’s examining attorney found that the dark green color was not inherently distinctive, so the proposed mark could not be placed on the principal or supplemental register without a showing that it had acquired distinctiveness.¹

1. Trademarks used in commerce may be placed on the principal register under 15 U.S.C. § 1051(a)(1). Marks “capable

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Medisafe attempted to make such a showing by providing the examiner with a declaration from Medisafe's Executive Vice President and promotional literature. At the examiner's request, Medisafe also submitted "[c]olor photographs and color advertisements showing competitive goods in [its] industry." J.A. 99. After reviewing these materials, the examining attorney determined that Medisafe's proposed color mark was generic and had not acquired distinctiveness with respect to Medisafe's goods.²

Medisafe responded to this rejection by trying again to prove that its mark had acquired distinctiveness, including by submitting additional declarations. The examining attorney remained unpersuaded and issued a final decision, finding Medisafe's proposed mark was generic, that Medisafe had failed to prove acquired distinctiveness, and the mark could not be placed on the principal register. The examining attorney further refused Medisafe's alternative request to register its mark on the supplemental register. J.A. 498 (finding mark generic and "thus incapable of distinguishing applicant's goods"); *see also* J.A. 620.

of distinguishing [the] applicant's goods or services and not registrable on the principal register" may be placed on the supplemental register under 15 U.S.C. § 1091(a). *See Matal v. Tam*, 582 U.S. 218, 224-25, 137 S. Ct. 1744, 198 L. Ed. 2d 366 (2017).

2. "[A] 'generic' term names a 'class' of good or services, rather than any particular feature or exemplification of the class." *United States PTO v. Booking.com B.V.*, 591 U.S. 549, 556, 140 S. Ct. 2298, 207 L. Ed. 2d 738 (2020).

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In determining that Medisafe’s color mark was generic, the examining attorney relied on the two-step test we originally set forth in *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986): “First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” J.A. 274; *see also* J.A. 206.

Medisafe appealed to the Board. In evaluating the examining attorney’s genericness determination, the Board applied a “slight variation” of our *Marvin Ginn* test, tailoring the analysis to color marks. J.A. 4-5. This modified test had first been set out in the Board’s precedential decision in *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 TTAB LEXIS 384, 2019 WL 6522400 (T.T.A.B. Dec. 2, 2019). *Milwaukee* states:

We further believe it is appropriate to apply a two-step inquiry to determine genericness of a single color similar to the inquiry we would apply to word marks and other kinds of trade dress, where we [(i)] first consider the genus of goods or services at issue, and [(ii)] second consider 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. . . . Accordingly, we will identify the appropriate genus of goods and then determine whether the color . . . is so common within the relevant genus that

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consumers would primarily associate it with the genus rather than as indicating a unique source of goods within the genus.

Id. at *9.

Applying the *Milwaukee* test, the Board rejected Medisafe’s proposed genus, which would have consisted of only gloves sold to authorized resellers, and instead defined the applicable genus as all “chloroprene medical examination gloves.” J.A. 8. At the second step, the Board agreed with the examining attorney that the relevant public includes “all such people or businesses who do or may purchase chloroprene medical examination gloves.” J.A. 12.

Considering the entire record, the Board then agreed with the examining attorney that Medisafe’s color mark is generic because it “is so common in the chloroprene medical examination glove industry that it cannot identify a single source.” J.A. 45. The Board pointed to, for example, screenshots of websites selling, under third-party marks, “chloroprene/neoprene medical examination gloves in the same or nearly the same dark green color as in [the] proposed mark.” J.A. 13. While Medisafe claimed to be the manufacturer behind 15 of the screenshot examples, Medisafe made no such claim as to the other 10. The Board found all 25 screenshots 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.” J.A. 14.

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The Board also evaluated Medisafe’s evidence that manufacturers make gloves in other colors besides the dark green of Medisafe’s proposed mark. It also considered customer declarations and a survey submitted by Medisafe. The Board placed little weight on this evidence because the other color gloves were not probative of whether the color Medisafe used is generic, the declarations were not “sufficiently representative or convincing of the relevant consumer perception of the proposed mark in general to carry much weight,” and the survey was “so flawed as to be entitled to no probative weight.” J.A. 40, 44.³

The Board’s genericness determination “serves as an absolute bar to registration.” J.A. 45. Nonetheless, like the examining attorney, the Board proceeded to consider acquired distinctiveness, agreeing that Medisafe had failed to meet its burden on this ground as well. Thus, the Board affirmed the examining attorney’s refusal to enter the proposed mark on either the principal or supplemental registers.

Medisafe timely appealed. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

3. The Board explained that the survey was administered by Medisafe’s counsel, not a survey expert; consisted of leading questions (e.g., “How long have you purchased the Medisafe dark green chloroprene glove, shown below?”); was sent to only six respondents, all of whom were part of Medisafe’s established customer base; and only three of those six respondents submitted responses—one of whom responded that she did *not* consider Medisafe’s color mark to be distinctive. J.A. 41; *see also* J.A. 42-44.

*Appendix A***II**

We review the Board’s legal conclusions de novo and its factual findings for substantial evidence. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016). Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 217, 59 S. Ct. 206, 83 L. Ed. 126 (1938). Whether the Board applied the proper test in assessing whether a mark is generic is a question of law, but “whether a particular mark is generic under the applicable standard is a question of fact, which we review for substantial evidence.” *In re Cordua Rests.*, 823 F.3d at 599.

To refuse registration based on a proposed mark being generic, the examining attorney must “establish a *prima facie* case that a term is generic.” *Trademark Manual of Examining Procedure* (“TMEP”) § 1209.01(c)(i) (2022). Thereafter, “the burden shifts to the applicant to come forward with evidence to rebut the *prima facie* case.” *In re Pacer Tech.*, 338 F.3d 1348, 1350 (Fed. Cir. 2003). Then the Board, in reviewing an examining attorney’s refusal to register a mark, considers the full record and reaches its own conclusion as to whether the examiner made out a *prima facie* case and, if so, whether the applicant rebutted it, which may be accomplished by proving the mark had acquired distinctiveness. *See In re Steelbuilding.com*, 415 F.3d 1293 1299 (Fed. Cir. 2005); *see also In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“In reviewing the examiner’s decision on appeal, the Board [of Patent Appeals and Interferences] must necessarily weigh all of the evidence and argument.”). We review for substantial evidence the Board’s findings as to the *prima facie* case

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and whether it was rebutted by the applicant. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1301-02 (Fed. Cir. 2009); *see also In re Pacer Tech.*, 338 F.3d at 1352.⁴

III

Medisafe argues that the Board applied the wrong legal standard for assessing whether a color mark is generic. Medisafe further contends that the Board's finding that its proposed mark is generic is not supported by substantial evidence. We disagree on both points, as we explain below.

A

In evaluating whether Medisafe's proposed color mark is generic, the Board applied the two-part test it had set out in *Milwaukee Electric Tool*, 2019 TTAB LEXIS 384, 2019 WL 6522400, at *9. That test was itself a modification of our *H. Marvin Ginn* test, which had not expressly considered color marks. We agree with the Board that the *Milwaukee* test is appropriate and hereby adopt it.

4. Medisafe mistakenly suggests that on appeal the Board has a burden of proof and that this burden is to show by clear and convincing evidence that the proposed mark is generic. *See* Open. Br. at 10, 29. As the PTO correctly points out, the Board is a reviewing body, not a litigant, and has no burden of proof. *See* Resp. Br. at 18. Moreover, we have never held that the examining attorney must find genericness by clear and convincing evidence. A potentially confusing reference to "clear evidence" in the TMEP, which we referenced in *In re Hotels.com*, 573 F.3d at 1302, has recently been clarified and no longer suggests a clear and convincing evidence burden, *compare* TMEP § 1209.01(c)(i) (2021), *with* TMEP § 1209.01(c)(i) (2022)

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In *H. Marvin Ginn*, 782 F.2d at 988, we reviewed the Board’s cancellation of the mark FIRE CHIEF for a magazine directed to the field of firefighting. The Board had found the mark generic, but we reversed. *See id.* at 989, 991. In doing so, we explained that the Board’s analysis, which was based primarily on cases relating to marks associated with magazines, was too narrow. *See id.* at 991. We set out the appropriate legal standard as follows:

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id. at 990. While the facts of *H. Marvin Ginn* did not require us to consider color marks, we articulated our test as applying to “mark[s],” without limitation as to their type.

More than three decades later, in *Milwaukee*, the Board confronted the issue of whether a color mark was generic. Expressly relying on *H. Marvin Ginn*, the Board found it “appropriate to apply a two-step inquiry to determine genericness of a single color similar to the inquiry we apply to word marks and other kinds of trade dress.” 2019 TTAB LEXIS 384, 2019 WL 6522400, at *9. The *Milwaukee* test begins with the same inquiry as *H. Marvin Ginn*, requiring identification of the genus of

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goods or services at issue. Compare 2019 TTAB LEXIS 384, 2019 WL 6522400, at *9, with 782 F.2d at 990. The *Milwaukee* test then slightly modifies the second-step inquiry to tailor it to color marks. Whereas *H. Marvin Ginn* asks whether “the *term* sought to be registered or retained on the register [is] understood by the relevant public primarily to refer to [a] genus of goods or services,” 782 F.2d at 990 (emphasis added), *Milwaukee* asks “whether the *color* sought to be registered . . . is understood by the relevant public primarily as a category or type of trade dress for [a] genus of goods or services,” 2019 TTAB LEXIS 384, 2019 WL 6522400, at *9 (emphasis added).

Here, the Board applied the *Milwaukee* test to Medisafe’s proposed color mark. See J.A. 6-13. Medisafe asserts this was legal error. We disagree.

The *Milwaukee* test is entirely consistent with *H. Marvin Ginn*. *Milwaukee* minimally, but appropriately, modifies *H. Marvin Ginn* to address the specific circumstances of a *color* mark being assessed for genericness. See generally *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 115 S. Ct. 1300, 131 L. Ed. 2d 248 (1995) (“It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve [the] basic purposes [of trademark law].”).

Medisafe’s principal attack on the *Milwaukee* test is that it purportedly ignores statutory language, which allows for cancellation of a mark for genericness only where that mark is a “generic *name*.” See, e.g., Open. Br. at 17 (“There are many problems with the [Board’s] *Milwaukee* test but the most obvious is that ‘trade dress’ is not the name of a genus of goods or services. . . .”).

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Medisafe predicates this contention on 15 U.S.C. § 1064(3), which provides that a registered mark may be cancelled “[a]t any time if the registered mark becomes the generic *name* for the goods or services, or a portion thereof, for which it is registered” (emphasis added). According to Medisafe, this “generic *name*” requirement applies equally to all types of marks, meaning that trade dress—including a color mark—may, like a word mark, be found generic only if it is a “generic *name*” for the goods with which it is used.

We considered, and rejected, essentially this same contention in *Sunrise Jewelry Manufacturing Corp. v. Fred S.A.*, 175 F.3d 1322 (Fed. Cir. 1999). In *Sunrise Jewelry*, the Board had concluded that a registered mark of a “metallic nautical rope design” for clocks, watches, and jewelry could not be cancelled as generic because, as trade dress, the design could not be a “generic name.” *Id.* at 1323, 1325. We disagreed with the contention that “the plain meaning of ‘generic name’ in § 1064(3) excludes trade dress” and held, instead, that the statutory language “must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as . . . trade dress.” *Id.* at 1325-26. “Any narrower interpretation of ‘generic name’ would,” we explained, accord trade dress “more protection than a word mark under the Lanham Act,” and thereby “directly contravene the purpose of the Lanham Act.” *Id.* We reiterate, as we held in *Sunrise Jewelry*, *id.* at 1326, “trade dress,” including a color mark, “that cannot serve as an indicator of source is generic and unprotectable.”⁵

5. At oral argument, counsel for Medisafe conceded that a color mark can be generic. *See* Oral Argument at 2:32-2:44,

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Applying the *Milwaukee* test, we conclude that substantial evidence supports the Board's determination that Medisafe's proposed color mark is generic.

At the first step of the inquiry, the Board identified the genus of goods at issue as "chloroprene medical examination gloves." J.A. 8. Substantial evidence supports this finding, including the fact that Medisafe's initial application identified the goods for which it sought to register its marks as "[m]edical examination gloves." J.A. 53. The Board did not err in rejecting Medisafe's amended application's narrowing of the goods at issue to "chloroprene medical gloves *sold only to authorized resellers*." J.A. 10-11 (emphasis added).⁶ The Board is not compelled to accept an applicant's proposed definition of the applicable genus, and was right not to "limit the universe of chloroprene medical examination gloves under evidentiary consideration to [Medisafe's] own products." J.A. 10-11 (citing *In re i.am.symbolic, LLC*, 866 F.3d 1315, 1324 (Fed. Cir. 2017) (finding no error where Board refused to limit identification of goods to products "associated with" singer will.i.am)).

available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=23-1573_08082024.mp3.

6. Although Medisafe frames its "authorized resellers" argument as directed to the definition of the relevant public, part of the second step of the genericness inquiry, we view Medisafe's argument as challenging the Board's exclusion of the authorized retailer limitation from the genus of goods at issue. At either the first or second step of the *Milwaukee* test, Medisafe points to no meritorious reason to include its "authorized resellers" limitation.

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Turning to the second step, substantial evidence supports the Board’s finding, which it reached after reviewing the entire record, that Medisafe’s color mark “is so common in the chloroprene medical examination glove industry that it cannot identify a single source” and is, therefore, generic. J.A. 45. This evidence includes screenshots of third-party websites showing unaffiliated sellers of “chloroprene/neoprene medical examination gloves in the same or nearly the same dark green color as in [the] proposed mark,” J.A. 13; customer declarations, which the Board reasonably found are not “sufficiently representative or convincing of the relevant consumer perception of the proposed mark in general to carry much weight,” especially because the “declarations are few in number, identical in form (which, while not fatal, makes them less persuasive), and relatively conclusory,” J.A. 40; and the survey, whose “flaws” the Board reasonably found “too numerous to detail” and include that they were “conducted by Applicant’s counsel,” who was not qualified as a survey expert, was given “to a small subset of Applicant’s established customer base,” and relied on “leading” questions (nevertheless resulting in one of three respondents “indicat[ing] that Applicant’s proposed color mark was *not distinctive* in the industry”), J.A. 41-44.⁷

7. Medisafe points out that the Board reproduced in its opinion a different specimen of its mark than what Medisafe’s survey used. Open. Br. at 34-35 (comparing J.A. 252 with J.A. 43); Reply Br. at 17-18. This error cannot have had any impact on the Board’s analysis and, hence, is harmless. *See generally Swagway, LLC v. Int’l Trade Comm’n*, 934 F.3d 1332, 1343 (Fed. Cir. 2019) (finding that error was harmless in absence of showing of any prejudice).

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In sum, as the Board recognized, while a color mark may serve as a source indicator, substantial evidence supports the Board’s finding that Medisafe’s proposed mark failed to do so. J.A. 39 (“There is no question that color marks generally are capable of serving as source-indicators—that is not the ground for refusal here. Rather, the relevant inquiry focuses on the consumer perception of the particular color at issue as to the genus set by Applicant’s identified goods.”). Therefore, we affirm the Board’s determination that Medisafe’s proposed mark is generic and, hence, ineligible for registry on either the principal or supplemental registers.

IV

We have considered Medisafe’s remaining arguments and find them either unnecessary to address or unpersuasive.⁸ For the reasons stated above, we affirm the Board’s decision.

AFFIRMED

8. We do not reach Medisafe’s challenges to the Board’s finding that it failed to prove acquired distinctiveness. Because a generic mark is “the ultimate in descriptiveness,” it “cannot acquire distinctiveness.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 972 n.3 (Fed. Cir. 2018).

**APPENDIX B — OPINION OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE,
FILED FEBRUARY 15, 2023**

**This Opinion is Not a
Precedent of the TTAB**

Serial No. 88083209

UNITED STATES PATENT
AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PT Medisafe Technologies

Hearing: October 25, 2022 Mailed: February 15, 2023

Filed February 15, 2023

Before Heasley, Lynch, and English,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Preliminary Matters

PT Medisafe Technologies (“Applicant”) seeks to register the color mark shown below on the Principal Register with a claim of acquired distinctiveness, or in the alternative, on the Supplemental Register for

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“Chloroprene medical examination gloves sold only to authorized resellers” in International Class 10.¹



According to the current description in the application, “[t]he mark consists of the color dark green (Pantone 3285 c) as applied to the entire surface of the goods which consist of chloroprene examination gloves. The matter shown in the drawing in broken lines serves

1. Application Serial No. 88083209 was filed August 17, 2018, based on an allegation of use of in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Applicant amended the application on March 9, 2021 to seek registration on the Supplemental Register “[s]hould the evidence submitted in support of this registration be found insufficient with respect to acquired distinctiveness.” March 9, 2021 Request for Reconsideration at TSDR 13. In the initial application, Applicant identified its goods as “medical examination gloves,” but in its March 9, 2021 Request for Reconsideration, Applicant amended the identification to its current iteration that limits the material composition of the medical examination gloves, and indicates that they are “sold only to authorized resellers.”

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only to show positioning of the mark and no claim is made to it.” The color “dark green (Pantone 3285 c)” is claimed as a feature of the mark.²

The Examining Attorney finally refused registration of the mark on the Principal Register as generic and therefore incapable of distinguishing the identified goods under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052 and 1127, or in the alternative on the Supplemental Register under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§ 1091(c) and 1127. The Examining Attorney also finally refused registration of the mark on the Principal Register for lack of inherent distinctiveness and insufficient proof of acquired distinctiveness under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052 and 1127.³

2. In the initial application, Applicant described its mark as “the color green as applied to the entire surface of the goods which consist of chloroprene examination gloves.” Applicant subsequently amended the description to “the color green Pantone 3255C, Pantone 3285C, or Pantone 359U applied to gloves.” January 30, 2019 Response to Office Action at 3. Applicant next amended the description to “the color dark green (Pantone 3285 c) as applied to the entire surface of the goods which consist of chloroprene examination gloves.” April 20, 2020 Response to Suspension Inquiry. Applicant amended the description of the mark to its current iteration in the August 6, 2020 Response to Office Action.

3. The prosecution history also included a request for reconsideration by Applicant, which the Examining Attorney denied, and a request for remand by the Examining Attorney, which the Board granted. Applicant previously filed a motion to revoke the remand, and the Board denied the motion in an order

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Applicant has appealed the refusals, and the appeal has been fully briefed.

II. Genericness**A. Legal Background**

A generic proposed mark “cannot be registered as a trademark because such a [proposed mark] cannot function as an indication of source.” *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1557 (Fed. Cir. 1995). The references in the Trademark Act to “generic name” apply to proposed trade dress marks, including color marks. *See Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1535 (Fed. Cir. 1999) (“the term ‘generic name’ as used in 15 U.S.C. Section 1064(3), must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as names, words, symbols, devices, or trade dress”); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*,

dated October 7, 2021. 13 TTABVUE; *see also* 17 TTABVUE. Applicant spends a substantial portion of its Supplemental Brief rehashing the same arguments as in its motion, contending that the Board should not have found good cause to remand the application. 18 TTABVUE 20-25. We decline to revisit the denied motion and entertain what essentially constitutes an extremely late request for reconsideration of the Board’s 2021 order. *Cf.* Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b) (“Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof.”); Trademark Rule 2.144, 37 C.F.R. § 2.144 (“Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision.”).

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2019 USPQ2d 460354, at *17 (TTAB 2019) (applying the genericness analysis to color marks). A generic proposed mark cannot acquire distinctiveness. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018); *see also USPTO v. Booking.com B.V.*, 591 U.S. ___, 140 S. Ct. 2298, 207 L. Ed. 2d 738, 2020 USPQ2d 10729, at *2 (2020).

Whether a proposed mark is generic rests on its primary significance to the relevant public. *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The relevant public is the purchasing or consuming public for the identified goods. *Magic Wand*, 19 USPQ2d at 1553. In this context, we consider whether the proposed trade dress mark is “so common in the industry that it cannot be said to identify a particular source.” *In re Odd Sox LLC*, 2019 USPQ2d 370879, at *6 (TTAB 2019) (quoting *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1555 (TTAB 2009) (generic product design unregistrable)); *see also Sunrise Jewelry*, 50 USPQ2d at 1535-36 (noting that trade dress can be considered generic if it “consists of the shape of a product that conforms to a well-established industry custom”) (citation omitted). The applicable test is a slight variation on the genericness test for word marks. We use a two-step inquiry:

we first consider the genus of goods or services at issue, and second consider whether the color sought to be registered or retained on the register is understood by the relevant public

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primarily as a category or type of trade dress
for that genus of goods or services.

Milwaukee Elec. Tool Corp., 2019 USPQ2d 460354, at *7-8
(citations omitted).

Applicant insists that because the evidence does not show that its proposed color mark “refers to the genus,” it should not be considered generic.⁴ To the extent Applicant implies that *Milwaukee Elec. Tool Corp.* “is not consistent with the Lanham Act and Supreme Court precedent on genericness,”⁵ we disagree because, as explained above, the statute encompasses trade dress and does not require an attempt to narrowly apply a test from caselaw on word marks. “Accordingly, we will identify the appropriate genus of goods and then determine whether the color [at issue] is so common within the relevant genus that consumers would primarily associate it with the genus rather than as indicating a unique source of goods within the genus.” *Id.* at *8 (citing *Sunrise Jewelry*, 50 USPQ2d at 1536).

The Examining Attorney must establish that a proposed mark is generic. *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). “Evidence of the public’s understanding of the [proposed mark] may be obtained from any competent source, such as

4. 18 TTABVUE 15 (Applicant’s Supplemental Brief).

5. *Id.* at 19.

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purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Merrill Lynch*, 4 USPQ2d at 1143; *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016).

B. Genus

Applicant and the Examining Attorney dispute the proper genus. The Examining Attorney contends that Applicant’s original identification, the broader category of “medical examination gloves,” serves as the appropriate genus. According to the Examining Attorney, the chloroprene “modifier and trade channel language do not alter the essential nature of applicant’s goods, which are medical examination gloves,”⁶ and were added to the identification “in order to avoid a likely finding of genericness.”⁷ The Examining Attorney points to third-party characterization of Applicant’s goods as “Healthcare Gloves,” “Exam Gloves,” “Exam Grade Gloves,” “Medical Gloves,” “Gloves,” and “Disposable Gloves,” as proof that goods such as Applicant’s are considered “medical examination gloves.”⁸ As additional support, the Examining Attorney emphasizes that Applicant’s Executive Vice President’s declaration repeatedly refers to Applicant’s “protective gloves,” “gloves,” and “glove products.”⁹

6. 20 TTABVUE 9 (Examining Attorney’s Brief).

7. *Id.* at 11.

8. *Id.* at 9 (citing to the application record regarding third-party characterizations of Applicant’s goods).

9. *Id.* at 10 (citing to the Taneja Declaration).

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Applicant, on the other hand, contends that its current identification, “chloroprene medical examination gloves sold only to authorized resellers,” is the proper genus, because the identification of goods **must** establish the genus.¹⁰ According to dictionary evidence in the record, chloroprene is “a colorless liquid C₄H₅Cl used especially in making neoprene by polymerization.”¹¹ Applicant emphasizes that there is no allegation that it uses its proposed mark on a broader range of gloves than what is specified in the current identification, nor that the trade channel restriction is inaccurate. According to Applicant, therefore the identification absolutely must serve as the genus, and that any contention otherwise “is based on an incorrect recitation of Federal Circuit caselaw.”¹²

As background information on the broader and more specific categories of goods, the record reflects that medical gloves are personal protective equipment used for various purposes, including in medical exams and procedures to protect the wearer and patient from infection and illness.¹³ The evidence also shows that there are several types of medical examination gloves, and the main types appear to be vinyl, latex, nitrile and chloroprene/neoprene.¹⁴ Chloroprene and neoprene

10. 21 TTABVUE 3-4 (Applicant’s Reply Brief).

11. February 16, 2022 Office Action at TSDR 2 (merriam-webster.com).

12. 21 TTABVUE 3 (Applicant’s Reply Brief).

13. September 7, 2021 Office Action at TSDR 78 (fda.gov).

14. *Id.* at 38-39 (benco.com); *id.* at 44-45 (mercedesscientific.com); *id.* at 58 (sunlinesupply.com); *id.* at 66-67 (hallofcare.com).

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refer to the same material composition for gloves.¹⁵ The various material compositions of gloves have different properties that may render them more or less well-suited to particular tasks. Websites in the record that sell exam gloves tend to include information that compares and contrasts the different materials, and suggests with what types of uses the materials might be most appropriate. For example, chloroprene gloves generally are described as more durable and chemical-resistant, so they often are preferred for administering chemotherapy, whereas nitrile gloves are described as a light weight general-purpose alternative to latex, which has more significant allergy risks.¹⁶

Because the identification of goods in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), generally “a proper genericness inquiry focuses on the description of [goods] set forth in the [application or] certificate of registration.” *Cordua Rests.*, 118 USPQ2d at 1636 (quoting *Magic Wand*, 19 USPQ2d at 1552). In *Cordua Rests.*, the Federal Circuit indicated that the “correct approach” is to focus on the identification in the application, in that case for restaurant services, and noted it was erroneous (harmlessly so, in

15. September 7, 2021 Office Action at TSDR 38 (benco.com), 46 (mercedesscientific.com), 66 (hallofcare.com).

16. September 7, 2021 Office Action at TSDR 45-46 (mercedesscientific.com), 57-58 (sunlinesupply.arnoldsofficefurniture.com), 66-67 (hallofcare.com).

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that case) for the Board to rely on the applicant's narrower actual services, a particular type of restaurant, as the genus. Nonetheless, Federal Circuit precedent allows for extrinsic evidence to inform the interpretation of terms in the identification. For example, in *In re Reed Elsevier Props.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007), the Court approved the Board's use of a genus based on the identification of services, but construed the identification by considering Applicant's website through which the services were provided, and other use in the same industry of the matter (in that case, terminology) in the mark.

Given the emphasis on the identification of goods, we define the genus as chloroprene medical examination gloves. Applicant has represented that it "does not use the identified color on other products," i.e. on gloves with other material compositions, so we do not conclude that Applicant carved out non-chloroprene gloves despite use of the proposed mark in connection with such goods.¹⁷

17. Nonetheless, we note that Applicant itself repeatedly characterized the relevant industry more broadly, as including medical examination gloves with material compositions other than chloroprene. When asked to provide photos and ads "showing competitive goods in applicant's industry," Applicant referred the Examining Attorney to Amazon search results for "green nitrile gloves." January 30, 2019 Response to Office Action at TSDR 10-16. Applicant also relies on third-party applications and registrations as evidence of the use of color in its industry, including gloves that are identified as "disposable latex and synthetic gloves," "disposable nitrile gloves," "gloves for medical and surgical uses," "gloves for medical and dental use, made of nitrile." January 30, 2019 Response to Office Action at TSDR 24-30. Thus, Applicant

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Rather, Applicant's narrowing of the identification to chloroprene medical examination gloves seems to accurately reflect its actual use of the proposed mark. Also, as noted above, the material composition of medical examination gloves appears to have significance in the industry, so Applicant's specificity as to chloroprene is not a distinction without a difference. We note that Applicant's amendment to limit its identification came in the wake of the Examining Attorney's genericness evidence showing similarly-colored dark green nitrile medical examination gloves. Because nitrile examination gloves fall outside the amended identification and the genus, we do not discuss such evidence, and as Applicant's counsel acknowledged at the oral hearing, any registration issuing with its amended identification would not establish rights against non-chloroprene gloves.

We acknowledge the additional limitation in the identification, "sold only to authorized resellers." A reseller is one who "sell[s] again" or "sell[s] (a product or service) to the public or to an end user, especially as an authorized dealer."¹⁸ We consider the limitation as an indication that Applicant's trade channels involve selling its goods to persons or entities that will resell

categorizes its industry and its competitors broadly as medical gloves and explicitly includes manufacturers and sellers of medical gloves of various compositions like latex and nitrile, not just chloroprene. Applicant's marketing materials for its identified chloroprene gloves refer to the goods as "A glove that combines the best of Nitrile and Natural Latex." April 20, 2020 Response to Suspension Inquiry at TSDR 44.

18. February 16, 2022 Office Action at 3 (ahdictionary.com).

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the gloves. Mr. Taneja, Applicant's Executive Vice President, Customer Strategies, testified that Applicant has "approximately 30 resellers nationwide,"¹⁹ and that "Applicant's customers are resellers that sell its gloves ... to health care equipment distributors nationwide."²⁰ Mr. Lanham, Applicant's Executive Vice President, Customer & Product Strategies, testified that "[o]ur six most significant customers in the United States market are CSC, Benco, TNT, Darby, Henry Schein, and Tranzonic."²¹ However, the identification does not reflect, nor did Applicant provide evidence, that "authorized resellers" restricts the nature or type of entity or person who could be a consumer of Applicant's identified goods.

Ultimately, this indeterminate limitation cannot limit the scope of the genus to Applicant's own products, for obvious reasons. Giving credence to such a limitation to "authorized resellers" necessarily would limit the universe of chloroprene medical examination gloves under evidentiary consideration to Applicant's own products. Thus, for purposes of the genus, this limitation is similar to the hypothetical addition of "sold to my customers," and crediting the "authorized resellers" limitation would exclude any third-party chloroprene medical examination gloves of the identical color. *Cf. In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017)

19. April 20, 2020 Response to Suspension Inquiry at 24 (Taneja Declaration).

20. April 20, 2020 Response to Suspension Inquiry at 24 (Taneja Declaration).

21. March 9, 2021 Request for Reconsideration at TSDR 65.

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(TTAB did not err by disregarding a limitation in the identification that the goods were “all associated with” the applicant because the limitation was not meaningful and did not alter the nature of the goods or their trade channels). Limiting the genus to goods sold to Applicant’s authorized resellers would foreclose relevant evidence to prove that chloroprene medical gloves in the color in question are common in the industry and come from numerous sources. Apparently, this is Applicant’s intention because, after proposing to confine the genus to goods sold to its authorized resellers, Applicant posits that “there is simply no authority for the proposition that an applicant’s use of a mark on its own goods would support a finding of genericness.”²² This limitation, particularly when the nature of Applicant’s so-called “authorized resellers” is completely open-ended and subject to change, cannot be relied on to restrict the genus only to Applicant’s goods.

Therefore, we conclude that “chloroprene medical examination gloves” appropriately expresses the genus of goods at issue.

C. Public Understanding

We next consider whether the relevant public understands the dark green color identified by Applicant, as applied to the entire surface of chloroprene medical examination gloves, primarily as a category or type of trade dress for such goods. The relevant public for a genericness determination is the purchasing or consuming

22. 18 TTABVUE 17 (Applicant’s Supplemental Brief).

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public for the genus of goods at issue. *Loglan Inst. Inc. v. Logical Language Grp. Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992). The record suggests that consumers of chloroprene medical examination gloves include a broad range of the general public and industry, such as “caregivers, food handlers, dentists and other professionals,”²³ healthcare personnel and institutions,²⁴ research laboratories,²⁵ food processing facilities,²⁶ and people who want gloves for “general cleaning tasks.”²⁷ Thus, all such people or businesses who do or may purchase chloroprene medical examination gloves constitute the relevant public. *See Magic Wand*, 19 USPQ2d at 1552-53.

The record includes background information, with which the relevant public likely would be familiar, regarding the use of color generally in the medical examination glove industry. According to an article on the Mercedes Scientific website:

Medical gloves are available in various colors. While this may be a matter of personal preference for some, others use different glove hues for color-coding. For example, a facility might choose blue nitrile gloves to set them

23. September 7, 2021 Office Action at TSDR 56 (sunlinesupply.arnoldsofficefurniture.com).

24. *Id.*

25. September 7, 2021 Office Action at TSDR 43 (mercedesscientific.com).

26. *Id.* at 50.

27. *Id.* at 53.

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apart from white or clear latex ones. Colorful gloves can also help staff detect punctures or tears easier if they wear a darker glove over a light one. White gloves may be preferred to show contaminants better.

You might use varying glove colors in a laboratory to help prevent cross-contamination.²⁸

In response to an information requirement regarding competitor use of the subject color or other colors, Applicant stated, in part, that “the use of color, including green in gloves is common. These colors are used as trademarks.”²⁹ Applicant’s Executive Vice President provided internally inconsistent testimony about this alleged practice in the industry. First, he stated, “[t]he colors **purple**, blue, white, and nude for gloves are common in the glove industry. These colors are considered standard colors in Applicant’s industry and are not used as source identifiers.”³⁰ Immediately afterward in the same declaration, however, he cited to third-party examples of “identifiable colors as a source identifier for their gloves,” and he described two of the examples as registrations “for the color **purple** as applied to” gloves.³¹

28. September 7, 2021 Office Action at TSDR 50 (mercedesscientific.com).

29. January 30, 2019 Response to Office Action at TSDR 10.

30. April 20, 2020 Response to Suspension Inquiry at TSDR 21 (Taneja Declaration) (emphasis added).

31. *Id.*

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In any event, while Applicant concedes that the use of the color green is common for medical gloves, it maintains that its use of the shade of green specified in its application can and does serve as a source-indicator.

1. Examining Attorney’s Evidence of Genericness

The record contains voluminous evidence under third-party marks of chloroprene/neoprene medical examination gloves in the same or nearly the same dark green color as in Applicant’s proposed mark. Competitors’ use of the trade dress at issue for the genus of the goods can be evidence of genericness. *See Sunrise Jewelry*, 50 USPQ2d at 1535-36 (trade dress that is shown to conform to an established industry standard is generic); *Stuart Spector Designs*, 94 USPQ2d at 1555 (trade dress is generic if “the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source.”).

For some – but not all – of the examples provided by the Examining Attorney, Applicant submitted declaration evidence that the gloves “were manufactured by Applicant and sold to its customers.”³² While we set those out separately below, contrary to Applicant’s contention, we consider them relevant to the genericness assessment. The relevant consumer – even including Applicant’s unspecified “authorized resellers” – could be exposed

32. *See* March 9, 2021 Request for Reconsideration at TSDR 64; *see also* January 13, 2022 Response to Office Action at TSDR 6-8.

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to Applicant's gloves that appear under a large number of third-party marks without identifying Applicant as the source or manufacturer. "Generally, when a company sells a product to third parties for re-sale under the third parties' marks rather than under the manufacturer's mark, that circumstance cripples any attempt to show that consumers uniquely associate the product's trade dress with one source, i.e., the manufacturer." *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1520 n.48 (TTAB 2017) (citations omitted); *see also Mine Safety Appliances Co. v. Elec. Storage Battery Co.*, 405 F.2d 901, 160 USPQ 413, 415 (CCPA 1969); *In re Hillerich & Bradsby Co.*, 204 F.2d 287, 97 USPQ 451, 454 (CCPA 1953).

This principle applies in the context of color marks: "When [] a party has sold its own goods, bearing a color which it asserts has become distinctive of its goods, to third parties for resale to the consuming public as the products of those third parties, such practice detracts even further from the alleged distinctiveness of the color as that party's trademark." *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1203 (TTAB 1993), *aff'd* 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1999). Therefore, given that Applicant's identically-colored chloroprene medical examination gloves are offered to consumers under a wide variety of third-party marks, with no evidence of identifying Applicant as the source of the gloves, these examples are relevant to the genericness determination.

Applicant criticizes the website evidence because "there is no evidence that any of the products identified by the Examining Attorney have actually been purchased by

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anyone – much less in what quantities or by consumers in the United States,”³³ but this type of evidentiary showing by an Examining Attorney is unnecessary. *See In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1631-32 (Fed. Cir. 2003) (recognizing different evidentiary standards in ex parte cases, given that the USPTO “is an agency of limited resources”). This type of website evidence is regularly relied on, and in this case, regardless of the extent of actual purchases, or in some instances, indications that products are temporarily out-of-stock, websites available to U.S. consumers tend to reflect consumer exposure to their contents. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (Internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein”). Thus, we find the evidence relevant to and probative of the inquiry in this case.

For the following examples the Examining Attorney introduced of dark green chloroprene gloves under various third-party marks, Applicant claims to be the manufacturer,³⁴ although the third-party websites do not so indicate:

33. 21 TTABVUE 6 (Applicant’s Reply Brief).

34. March 9, 2021 Request for Reconsideration at TSDR 65-73, 80; January 13, 2022 Response to Office Action at TSDR 7.

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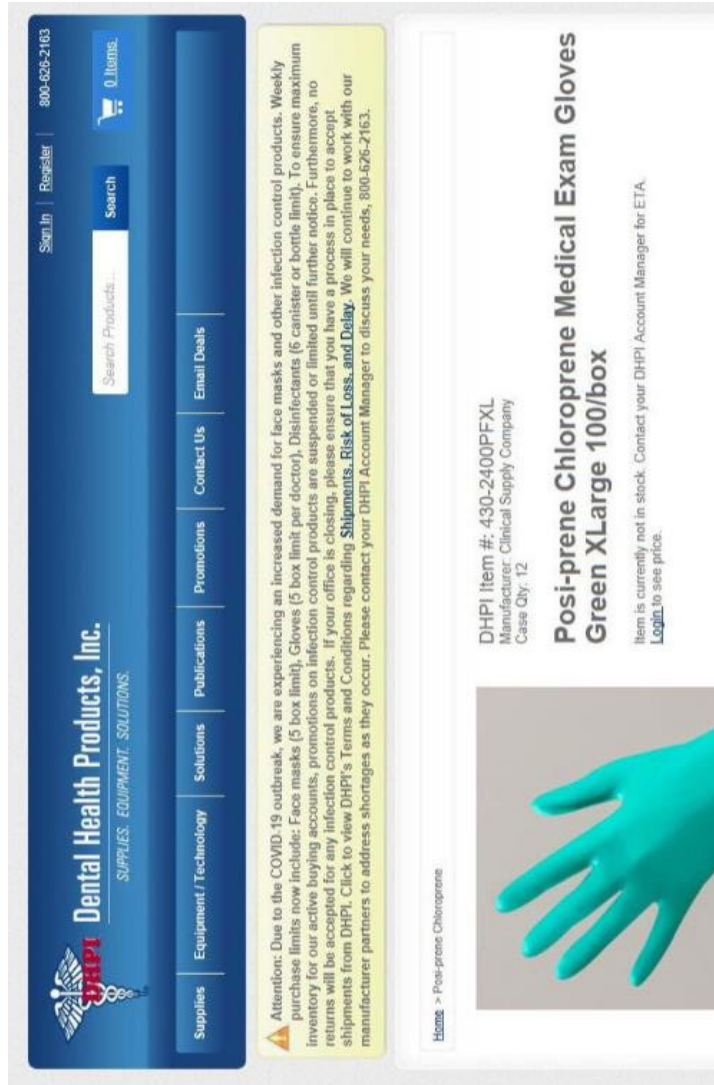
35. September 9, 2020 Office Action at TSDR 4 (henryschein.com).

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36. May 19, 2020 Office Action at TSDR 18 (kingpintattoosupply.com).

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37. May 19, 2020 Office Action at TSDR 25 (dhpionline.com). We note that this screenshot shows the manufacturer as

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Appendix B

800-447-5495 | My Account | Privacy Policy | FAQ's | About Us | Contact Us

MED EXPRESS
your premier glove source

LOGIN | REGISTER
SHOPPING CART (0)

HOME | NITRILE GLOVES | LATEX GLOVES | VINYL GLOVES | DENTAL DISPOSABLES | POLYCHLOROPRENE GLOVES

Home | Polychloroprene Gloves | POSI-PRENE Green



POSI-PRENE Green

Write a Review

Your Price: \$10.95

Powder-Free, Nitrile-Free, Sizes: MD, LG, XL, ~100 Gloves Per box, 12 boxes per case (mixed cases available by calling customer service to order) Exam Grade

Part Number: P2400

Availability: In Stock

Feature: Nitrile-Free

Feature: Latex-Free

CHOOSE OPTIONS

Size

X-small

12 Add to Cart

Like Sign Up to see what your friends like

38

“Clinical Supply Company,” even though Applicant claims to have manufactured these gloves. March 9, 2021 Request for Reconsideration at TSDR 80 (Lanham Declaration).

38. September 9, 2020 Office Action at TSDR 20 (shopping.medexpressgloves.com).

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https://harmonycr.com/gloves-and-finger-cots/duraskin-12-green-8-mil-chloroprene-gloves/lb2012w

Harmony
LAB & SAFETY SUPPLIES

Search the store

SHOP ALL LAB & SAFETY SUPPLIES SHOP BY BRAND SUPPLY BLOG ABOUT US CONTACT US

LIVE CHAT

Home / Gloves & Finger Cots / Disposable Gloves / Chloroprene Gloves

/ DuraSkin 12 in. Green 8 mil Chloroprene Gloves

SHOP BY CATEGORY

- Disposable Apparel
- Gloves & Finger Cots
- Swabs & Applicators
- Wipes
- Cleanroom Supplies
- Medical Supplies
- Janitorial
- Lab Supplies
- Safety Gear
- Static Control
- Shop by Industry
- Clearance & Overstocks

8 mil **Out of Stock** **Powder Free**



DuraSkin

DuraSkin 12 in. Green 8 mil Chloroprene Gloves

SKU: LB2012W
UPC: 744897101272
AVAILABILITY: Usually Ships Same Business Day
HARMONY PRICE: **\$13.99**

UNIT: REQUIRED
Box/50 Case/500

SIZE: REQUIRED
Small Medium Large
Extra-Large

To be notified when back in stock, enter your email address.

Email Address

NOTIFY ME

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39. May 19, 2020 Office Action at TSDR 27 (harmonycr.com).

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Free Shipping for Orders Over \$100

SAFCO
75 YEARS!

Search by Product, Item #, or Manufacturer #

Products ▾ Order History ⌵ Catalog Request 📄 Sales Flyer 📄 Quick Order Pad 📄

Log In / Create My Account ▾

Free Offers Blog Contact Us (800) 621-2178

Cart

Home » Products » Infection control » Chloroprene gloves » Micro-Touch® Denta-Glove® Green Neoprene

Micro-Touch® Denta-Glove® Green Neoprene

Ansell
(Made in Malaysia.)

Product Details
Powder-free neoprene examination gloves.

- Textured fingertip finish
- Beaded cuff
- Ambidextrous
- Green color
- Thickness: at palm 3.1 mils; at fingertip 4.3 mils
- 100 gloves per box
- 10 boxes in a case

++ Notice ++
We are currently only accepting orders from dentists, hygienists, physicians, nurses, and first responders for infection control products. We are not accepting orders from consumers. Click here for information on infection control supply disruptions.

40. September 9, 2020 Office Action at TSDR 24 (safcodental.com).

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LabMart[®]
Serving Science Since 1952

Home > Lab Supplies > CHLOROPRENE EXAM GLOVES > CHLOROPRENE EXAM GLOVES LARGE POWDER FREE NEOGARD GREEN

CHLOROPRENE EXAM GLOVES

Currently Viewing Product 1 of 4

Previous 1 2 3 4 Next

CHLOROPRENE EXAM GLOVES LARGE POWDER FREE NEOGARD GREEN

Catalog Number: M110273

larger image

product video

Neogard

Features

Package	Price	Quantity
Pack of 100	\$46.30	
Case of 1000	\$422.70	

NOTE: All related products are listed below.

Add to Cart >

LabMart Videos

42. May 19, 2020 Office Action at TSDR 34 (labmart.com).

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43. May 19, 2020 Office Action at TSDR 36 (glovesamerica.com).

We Believe You are Important.
How Can We Help?
855.541.5181 (7x24)
International Sales

CART (0)

COVID-19 **LABORATORY** **CLINICAL** **CONTROLLED ENVIRONMENT** **PHENIX** **E&K** **SERVICES** **DEALS**

Home Controlled Environment Gloves Specialty Gloves Chemical Resistant Gloves

Search My Profile Frequent Buy List Quick Order

Ansell
**NeoTouch Green Neoprene Powder-Free Lab-Exam
Gloves, Textured Fingertips**

★★★★★
★★★★★
★★★★★
★★★★★
★★★★★

Email This Page Print Page

DESCRIPTION

NeoTouch creates a new category in disposable gloves for its comfort, durability and chemical resistance. The first neoprene single-use gloves for industrial usage. An alternative to natural rubber latex that protects against Type I allergies. Excellent resistance to acids, bases and alcohols. Exclusive formulation provides superior comfort Exam grade Food grade - complies with FDA food handling requirements (21 CFR 177.2600).

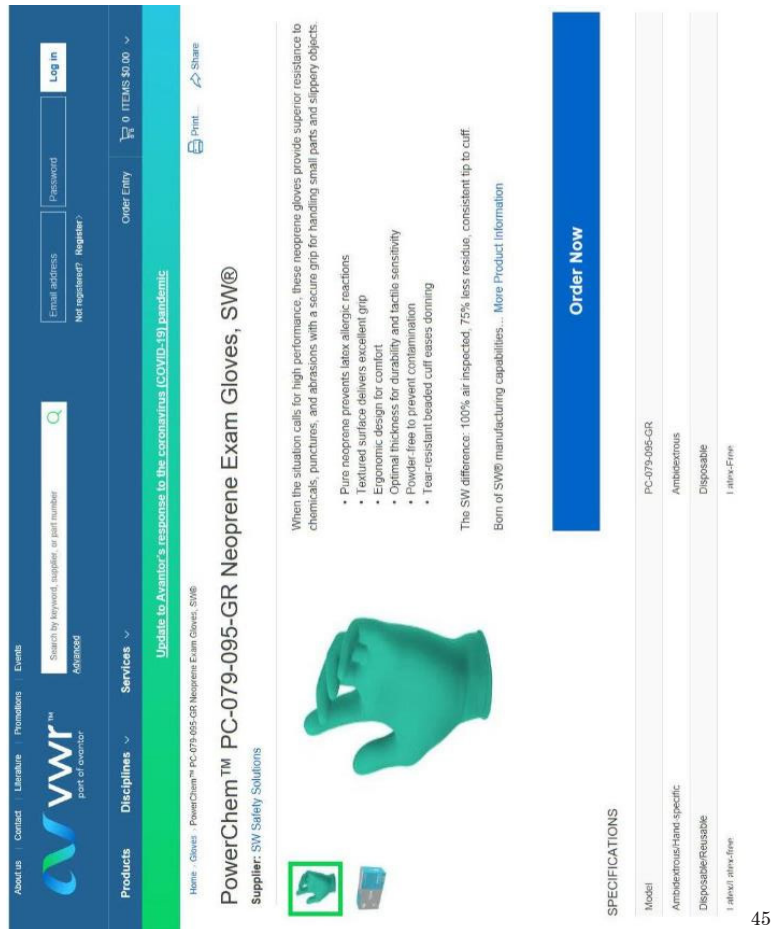
PRODUCT AVAILABILITY: Did you know you can view a product's availability right on the product page? Simply enter the quantity you want to purchase and the current availability will appear below the item.

Please Enter Your Order Info

Filter by: Avail Qty CLEAR FILTERS

PRODUCT DETAIL		List Price/Quantity	Total
25-201-L	Mfr No. 305661	\$599.57 C/S (1000 C/S)	\$0.00
Description	Gloves: Ansell Neo Touch, Green Neoprene Powderfree, Textured Fingertips, Rolled Cuff, 13 mil, Long Length 12", Large, 100 per box, 10 boxes per case, 1000PCS		
25-201-M			Total

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When the situation calls for high performance, these neoprene gloves provide superior resistance to chemicals, punctures, and abrasions with a secure grip for handling small parts and slippery objects.

- Pure neoprene prevents latex allergic reactions
- Textured surface delivers excellent grip
- Ergonomic design for comfort
- Optimal thickness for durability and tactile sensitivity
- Powder-free to prevent contamination
- Tear-resistant beaded cuff eases donning

The SW difference: 100% air inspected, 75% less residue, consistent tip to cuff
Born of SW® manufacturing capabilities... More Product Information

SPECIFICATIONS	
Model	PC-079-095-GR
Ambidextrous/Hand-specific	Ambidextrous
Disposable/Reusable	Disposable
Latex-free	Latex-free

Order Now

45. September 9, 2020 Office Action at TSDR 5 (us.vwr.com). We note that this screenshot shows the statement, “Born of SW® manufacturing capabilities,” even though Applicant claims to have manufactured these gloves. March 9, 2021 Request for Reconsideration at TSDR 66.

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Industrial & Scientific

Best Sellers

Prime

Customer Service

New Releases

Today's Deals

Find a Gift

Whole Foods

Books

Kindle Books

Gift Cards

Free Shipping

Automotive

Registry

Fashion

Sell

Amazon Home

Computers

Coupons

Try Prime

Lab

Test & Measurement

Safety

Agricultural & Wildlife

Food Service

Education

Material Handling

Materials

Medical Working

Electrical

Fish & Wildlife Items

Deals

Tools & Home Improvement

Safety & Security

Personal Protective Equipment

Hand & Arm Protection

Lab, Safety & Work Gloves

Disposable Gloves

Find the perfect paint color

Try Paint Finder

Visit the Aura Store

DDS AuraPrene Powder Free Neoprene Examination Gloves, Green (X-Large) -90/bx

Available with an Amazon Business account and healthcare license.

Specifications for this item

Brand Name	Aura
Color	green
Item Depth	inches
Material	Latex Free, Chloroprene
Material Feature	neoprene
Model Number	DDS-505
Number of Items	1
Part Number	DDS-505

See more

See more product details

Roll over image to zoom in

Share

Available with an Amazon Business account and healthcare license.

Create a Business Account

Learn more about healthcare licenses.

Already a business customer? Sign in

46. September 9, 2020 Office Action at TSDR 10 (amazon.com).

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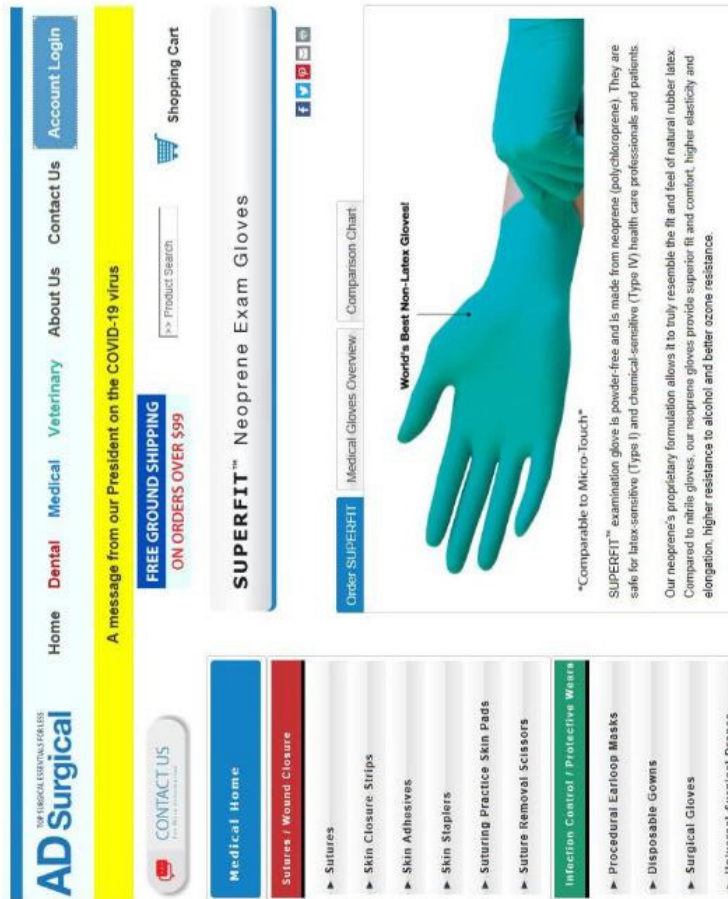
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47. September 9, 2020 Office Action at TSDR 15 (wbmason.com).

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Unlike for the previous examples, Applicant has **not claimed** to be the manufacturer of the following examples

48. September 9, 2020 Office Action at TSDR 17 (ad-surgical.com).

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ABOUT USCUSTOMER GATEWAY

Search

PRODUCTS CAPABILITIES RESOURCES CONTACT US FAQs TOOLS NEWS PERIOD PARTNER

Products

Home • Products • Gloves • Chloroprene Gloves • Verdant™ Chloroprene Powder Free Exam Gloves, 4 mil, Green (GL-CR106GF)



Verdant™ Chloroprene Powder Free Exam Gloves, 4 mil, Green (GL-CR106GF)

Product Description

- Made from Poly Chloroprene Synthetic Polymer
- Provides the comfort, feel and tactile sensitivity of latex and barrier properties and strength of Nitrile Gloves
- Ambidextrous, beaded cuff, single use/disposable
- Thickness: Palm: 4 mil; Finger 5.10 mil
- Latex Free
- Finger Textured
- Lime Green Color
- Very Low modulus provides superior dexterity and comfortable to wear extended period with minimum fatigue
- Strong Puncture and Tearing Resistance
- Excellent chemical resistance to many solvents, alcohol, oils
- Standard: Meets ASTM D6977
- Complies with CFR Title 21 Indirect Food Additive Regulations Part 177 for use in contact with food
- Non Sterile

Not available for sale in Canada.

SIZE

X-Small (GL-CR106GFXS) [LOGIN TO SEE PRICE](#)

↓ SPECS

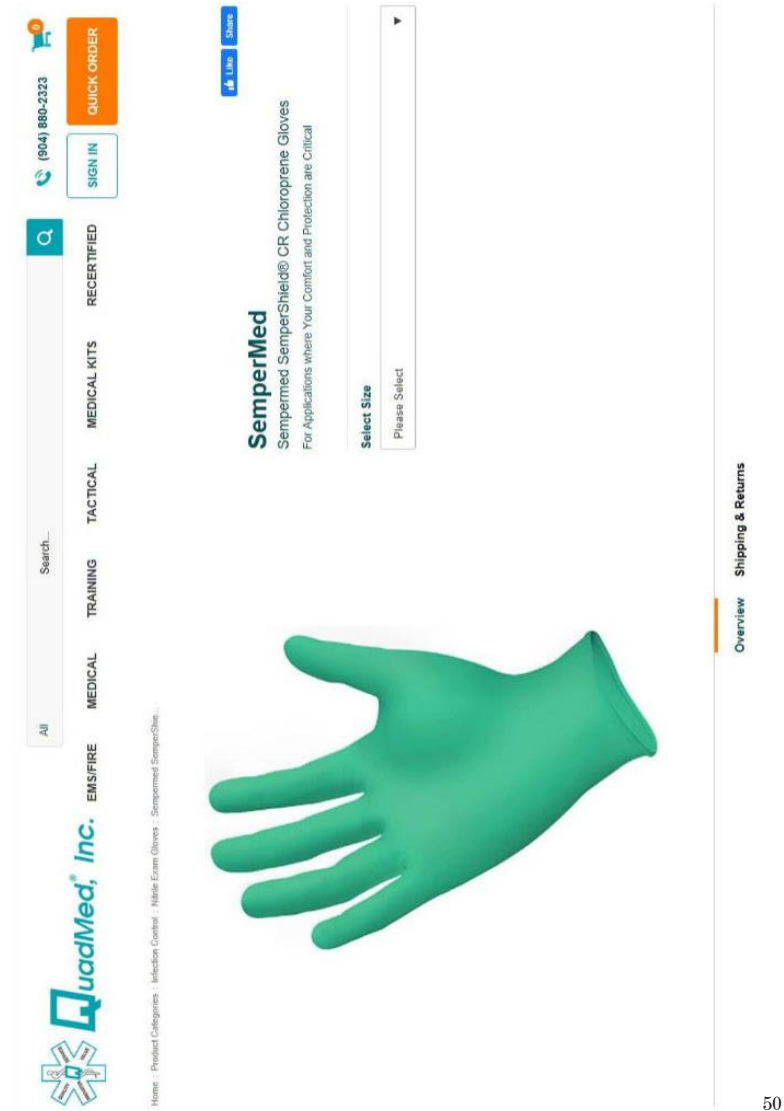


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49. September 9, 2020 Office Action at TSDR 36 (hospesco.com).

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50. May 19, 2020 Office Action at TSDR 28 (quadmed.com).

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51. May 19, 2020 Office Action at TSDR 21 (quickmedical.com).

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Free Shipping for Orders Over \$100

safco
SAFETY

**CELEBRATING
75 YEARS!**

Search by Product, Item #, or Manufacturer #

Products

Order History

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Cart

About Us

Safco Brand Products

Free Offers

Blog

Contact Us

(800) 621-2178

Catalog Request

Quick Order Pad

**** Important Notice ****
We are currently only accepting orders from dentists, doctors, nurses, and first responders for infection control products. We are not accepting orders from consumers. Click here for information on infection control supply disruptions.

Home • Products • Infection control • Chloroprene gloves • Safco Chloroprene Green

Safco Chloroprene Green

Safco
(Made in Malaysia)



safco Chloroprene Green
Powder-free exam gloves
Nitrile-free exam gloves
Safco Chloroprene Green

Product Details
Powder-free chloroprene examination gloves.

Safco's chloroprene gloves give you comfort and tactile sensitivity comparable to latex, without the risk of allergic reactions to latex proteins. Superior elasticity. High tensile strength.

- Textured fingertip finish
- Beaded cuff
- Antimicrobial
- Green color
- Thickness: at palm 2.4 mils, at fingertip 3.5 mils
- 100 gloves per box
- 10 boxes in a case

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[Merchandise](#)
[Equipment](#)
[Services](#)
[Software](#)

Patterson COVID-19 resource center: The Patterson team is closely monitoring the coronavirus (COVID-19) to understand how it impacts our we serve. [Learn more.](#) Read about UPS delivery changes [here](#).

Categories: [Personal Protective Equipment \(PPE\)](#) : [Gloves](#)



Patterson® Chloroprene Examination Gloves
– Powder Free, Latex Free, 200/Box -
Patterson Dental Supply

Chloroprene Examination Gloves offer durability and comfort, which is especially beneficial during periods of extended wear.

- Latex free
- Textured
- Single use only
- Nonsterile
- Ambidextrous

Additional Resources:

- [Patterson® Chloroprene Glove Specifications](#)

53. May 19, 2020 Office Action at TSDR 16 (pattersondental.com).

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TOP GLOVE

TOP QUALITY. TOP EFFICIENCY.

HOME

OUR CHAIRMAN

ABOUT US

PRODUCTS

BUY NOW

CUSTOMER PORTAL

INVESTOR RELATIONS

CAREER

RESEARCH & DEVELOPMENT

MEDIA CENTRE

CONTACT US

CORPORATE INTEGRITY

FRAUD ALERT

IMPORTANT NOTICE

Overview

Hand Protection

Face Mask

Sexual Wellness

Dental Care

Others

Product & ISO Certification

CHLOROPRENE ACCELERATOR FREE SURGICAL GLOVE

CHLOROPRENE ACCELERATOR FREE SURGICAL GLOVE

Type

Chloroprene Examination Glove, Online Single

Chlorinated, Non-sterile

Material

Chloroprene

Colour

Green

Design & Features

Antidextrous, finger textured, beaded cuff

Storage

The gloves shall maintain their properties when stored in a dry condition. Avoid direct sunlight

Shelf-life

3 years from the date of manufacturing

DOWNLOAD BROCHURE

SEND ENQUIRY



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54. September 9, 2020 Office Action at TSDR 29 (topglove.com).

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55. May 19, 2020 Office Action at TSDR 14 (henryschein.com).

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YOUNG
SPECIALTIES

(800) 558-6684 Hello Guest ▾

Products Find your product 🔍

Our Story Resources ▾ Catalogs Support ▾ Quick Order  0

Home / Plak Smacker / Infection Control / Gloves / 100ct TruFit™ Ultra Thin Chloroprene Gloves, Green



100ct TruFit™ Ultra Thin Chloroprene Gloves, Green
Item #TF-ULTRAG
\$29.29 - \$29.79

Glove Size Choose an option ▾

Quantity - 1 +

Add to list

Add to cart

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56. February 16, 2022 Office Action at 10 (young specialties.com).

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The Dental Box™
Acute Dental Emergency Care

Search part # qty [Add to Cart](#)

0 items \$0.00

Reflection® Polychloroprene Powder Free Exam Gloves

SmartPractice

Temporary Customer Limit: 1 case per brand per week (until further notice)

Polychloroprene gloves provide a superior fit that gives Reflection Polychloroprene Exam Gloves the excellent comfort. It latex-wearers prefer due to its unique formulation with superior elasticity. Revolutionary super-stretch technology offers the tactile sensitivity of latex that is not typically found with non-latex materials. Free of natural rubber latex, ideal for patients or staff who may be allergic to NRL proteins. Unique green color helps quickly identify the product as non-latex.

- Thin feel for improved tactile sensitivity
- Superior stretch and fit with no NRL proteins
- Powder free, with polymer coating for easy donning
- Textured grip for improved tactile sensitivity
- 100 gloves in a box, 12 boxes to a case.
- Ambidextrous, Medical-grade, non-sterile, single use. Meets or exceeds ASTM standards

Glove Caution Statements

Glove Sizing Chart >> Measure your hand to determine the best size to order

State License Required:
Due to extreme increased demand in gloves we are only able to ship to medical professionals. Fax your state medical license to 800.522.8529 so that we can process your order.

Product	Availability	Price			
		Qty	Each	Extended	
X-Small, Reflection Green Polychloroprene Exam Gloves Item #: 423051 100 gloves in a box, 12 boxes to a case. <i>Requires a State License</i>	In Stock Ships within 24 hours from SmartPractice	12	\$17.19	\$206.28	Add to Cart Shopping List
X-Small, Reflection Green Polychloroprene Exam Gloves Item #: 423081BX 100/box <i>Requires a State License</i>	In Stock Ships within 24 hours from SmartPractice	1	\$17.19	\$17.19	Add to Cart Shopping List
		6	\$17.19	\$103.14	

You may also need

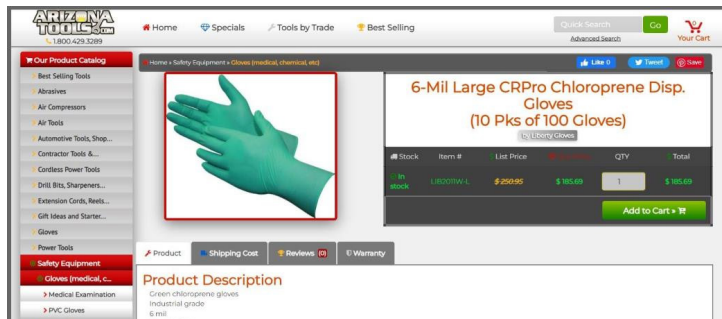

Le Soothe® Sapphire™ Polychloroprene Powder Free Exam Gloves
SmartPractice | \$17.19/box

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57. February 16, 2022 Office Action at TSDR 11 (thedentalbox.com).

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58. February 16, 2022 Office Action at TSDR 12 (arizonatools.com).

59. February 16, 2022 Office Action at TSDR 14 (toolsid.com).

*Appendix B***2. Applicant's Evidence**

Applicant contends that the existence of “gloves made of a variety of colors, including for example, light gray, lavender, clear, and blue,” weighs against the genericness of Applicant’s proposed color mark.⁶⁰ That is, because there are many different colors of medical examination gloves, no particular color could be generic for the genus.

Applicant also submitted third-party statements in responses to Office actions from the prosecution histories of other applications for proposed color marks for gloves, and Applicant maintains they show that others in its industry made representations that the proposed color marks were source-indicating, or that color was used for source-indication in the glove industry.⁶¹ However, statements made by third-party trademark applicants pertaining to other colors and other types of gloves are not probative of the consumer perception of Applicant’s proposed mark in this case. There is no question that color marks generally are capable of serving as source-indicators – that is not the ground for refusal here. Rather, the relevant inquiry focuses on the consumer perception of the particular color at issue as to the genus set by Applicant’s identified goods.

Turning to evidence regarding the color at issue, Applicant submitted two customer declarations, identical in substance, stating in part that “[a]lthough various shades of

60. 18 TTABVUE 15.

61. *E.g.*, March 9, 2021 Request for Reconsideration at TSDR 3-5 and accompanying attachments..

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green are used on disposable medical examination gloves,” the declarants recognize Applicant “as the sole source of gloves with the distinctive dark green Pantone 3285C color.”⁶² The declarations do not address how close any of the other “various shades of green . . . used on disposable medical examination gloves” come to Applicant’s proposed color mark. We give these declarations some probative weight, but do not find them sufficiently representative or convincing of the relevant consumer perception of the proposed mark in general to carry much weight. The declarations are few in number, identical in form (which, while not fatal, makes them less persuasive), and relatively conclusory. *See, e.g., In re OEP Enters.*, 2019 USPQ2d 309323, at *64-66 (TTAB 2019) (discounting four reseller declarations based in part on similar reasons); *see also In re Pohl-Boskamp GmbH & Co. KG*, 106 USPQ2d 1042, 1051 (TTAB 2013) (criticizing form declarations that “merely assert[ed] that applicant’s product is the only one in the marketplace having a peppermint flavor or scent,” which was contradicted by the record, and that “each declarant is himself or herself familiar with applicant’s product and associates its scent with applicant alone”).

Applicant’s so-called “survey” evidence also lacks persuasiveness. The “survey” in this case was conducted by Applicant’s counsel, who offers no credentials for conducting surveys, through the online “Survey Monkey” platform.⁶³ According to counsel’s declaration, he sent six

62. August 6, 2020 Response to Office Action at TSDR 6-14 (Cohen and Maloney Declarations).

63. March 9, 2021 Request for Reconsideration at TSDR 74-79 (Clark Declaration).

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respondents a questionnaire that included “a copy of the specimen filed with the Application,” and he summarized his results of the three responses received in the following table:

Question	Response 1	Response 2	Response 3
How long have you purchased the Medisafe dark green chloroprene glove, shown below? ²	“Over 6 years”	“13”	“at least 7 years, probably more”
Is the dark green shade used by Medisafe distinctive among manufacturers of chloroprene gloves?	Yes	No	Yes
Would you question whether Medisafe was the actual source of a particular lot of dark green chloroprene gloves if those gloves did not use Medisafe’s usual shade of dark green?	Yes	Yes	Yes
When you see Medisafe’s dark green chloroprene gloves what does that signify to you?	“A quality glove / a happy customer”	“quality”	“QUALITY. I know they came from Medisafe and I know they are high quality. This is because Medisafe has taken many years to perfect chloroprene disposable gloves.”

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64. March 9, 2021 Request for Reconsideration at TSDR 75 (Clark Declaration).

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As the Supreme Court has noted, trademark surveys “can be helpful evidence of consumer perception but require care in their design and interpretation.” *U.S. Patent & Trademark Office v. Booking.com*, 2020 USPQ2d 10729, at *7 n.6 (citation omitted). The flaws in Applicant’s survey evidence are too numerous to detail, but we will highlight some of the more glaring problems.

To begin with, trademark surveys typically are conducted by survey experts who follow accepted norms that ensure the reliability of the survey. Otherwise, such surveys generally are not considered. *See, e.g., M2 Software, Inc., a Delaware corporation v. Madacy Ent.*, 421 F.3d 1073, 76 USPQ2d 1161, 1171 (9th Cir. 2005) (“Both district judges properly rejected the M2 Software’s survey because the survey’s creator ‘did not qualify as an expert on designing or analyzing consumer surveys.’”); *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 92 USPQ2d 1835, 1839 (S.D.N.Y. 2009) (Pro se plaintiff’s ad hoc genericness “survey” was “flawed methodologically” and did not rebut the presumption of validity of plaintiff’s registered mark.); *Valador, Inc. v. HTC Corp.*, 242 F. Supp. 3d 448, 458 (E.D. Va. 2017), *aff’d*, 707 Fed. Appx. 138 (4th Cir. 2017) (Survey excluded because, among other reasons, the survey person was not qualified to conduct a trademark confusion survey). As noted above, the survey here was conducted by Applicant’s counsel, who provides no indication that he qualifies as a consumer survey expert or followed any accepted methodology for such surveys.

Indicative of the methodology problems, the “specimen filed with the Application,” which the survey respondents

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were shown as the basis for their responses, shows gloves with various shades of green (see below), and contains extraneous matter such as the tagline “[t]he green glove everybody’s talking about.”

CHLOROPRENE EXAM.

The green glove
everybody’s talking about.



We do not consider this an appropriate survey stimulus for Applicant’s subject mark, shown in the drawing as



Another issue with methodology involves the universe of respondents for the survey. A proper survey universe likely would include all potential consumers of chloroprene medical examination gloves, but this survey was limited to a small subset of Applicant’s established customer base. Even apart from the general problem of limiting the universe to Applicant’s own consumers, we note that despite Applicant’s separate representation that it

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has approximately 30 reseller customers,⁶⁵ the survey declaration indicates that the survey was sent to only six of them, and only three responded.⁶⁶ The declaration contains no explanation of why and how the six entities were selected. Among the six customers that received the SurveyMonkey invitation was the employer of one of the customer declarants, so it also is unclear whether there is overlap between the three “survey” respondents and the two customer declarants. Ultimately, Applicant has not demonstrated that the survey universe was appropriate.

We also find the survey questions to be inappropriately formulated. The questions already refer to Applicant as the source of the gloves in question, and are otherwise leading, such as the reference to “Medisafe’s **usual** shade of dark green.” Notably, despite the leading, one of the three respondents nonetheless indicated that Applicant’s proposed color mark was **not distinctive** in the industry.

Overall, the survey is so flawed as to be entitled to no probative weight on the issues in this case. *See In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981) (non-*Teflon* survey not persuasive because of survey defects); *Zimmerman v. Nat’l Ass’n of Realtors*, 70 USPQ2d 1425, 1435 (TTAB 2004) (“given all the deficiencies of petitioner’s survey, we accord it very little weight”); *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1894-95 (TTAB

65. April 20, 2020 Response to Suspension Inquiry at 24 (Taneja Declaration)

66. March 9, 2021 Request for Reconsideration at TSDR 74-75 (Clark Declaration).

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2006) (non-*Teflon* survey did not elicit relevant responses); *Sheetz of Del., Inc. v. Doctors Assocs. Inc.*, 108 USPQ2d 1341, 1360–66 (TTAB 2013) (Applicant’s survey given little weight because of flawed structure).

D. Conclusion as to Genericness

The record as a whole clearly demonstrates that consumers of chloroprene medical examination gloves are exposed, under a wide variety of marks and from manufacturers other than Applicant, to such goods in the same color as in Applicant’s proposed mark, or in very similar shades of dark green so as to be essentially indistinguishable. We find that the evidence as a whole, including material not specifically excerpted or discussed herein, shows that dark green, in a shade identical or similar to Applicant’s, is so common in the chloroprene medical examination glove industry that it cannot identify a single source. The proposed color mark is generic, and cannot serve as a source-indicator.

III. Lack of Inherent Distinctiveness and Insufficient Proof of Acquired Distinctiveness

Applicant has submitted a claim under Section 2(f), or, in the alternative, an amendment to the Supplemental Register. While the genericness determination serves as an absolute bar to registration of Applicant’s proposed mark, in the event a different conclusion were to be reached on appeal, we include for completeness an assessment of Applicant’s claim of acquired distinctiveness.

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Single-color marks, such as this one, are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068-69 (2000) (“In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist.”). The burden of proving acquired distinctiveness for a single-color mark is substantial. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985) (“By their nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character.”).

Our ultimate Section 2(f) analysis and determination in this case is based on all of the evidence considered as a whole, under the following six factors:

(1) association of the [mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

In re SnoWizard, Inc., 129 USPQ2d 1001, 1105 (TTAB 2018) (quoting *Converse, Inc. v. Int’l Trade Comm’n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)).

Under the first factor, we discussed Applicant’s so-called survey and its customer declarations above; our assessment of the probative weight to be accorded that evidence applies equally here.

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Under the second factor, Applicant offered testimony that it has used the proposed mark for 18 years.⁶⁷ Despite Applicant's declaration testimony that Applicant is the only manufacturer of gloves in the color at issue,⁶⁸ and that its use is substantially exclusive, the record suggests otherwise. We find that Applicant's use is far from "substantially exclusive" within the meaning of Section 2(f). *See Sheetz of Del.*, 108 USPQ2d at 1370 ("In this case, the widespread use of 'Footlong' demonstrated by this record would itself be sufficient to dispose of applicant's claim of acquired distinctiveness"); *see also Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.").

Under the third and fourth factors, the evidence submitted by Applicant is not specific to the claimed color at issue, but instead refers to gloves of multiple shades of green with differing Pantone designations. For example, Applicant's Taneja Declaration testimony regarding sales volume, sales revenue, trade show promotion and advertising expenditures and activities address "Pantone 3255C, Pantone 3285C and Pantone 359U,"⁶⁹ and provides no breakdown specific to the color

67. January 30, 2019 Response to Office Action at TSDR 18.

68. January 30, 2019 Response to Office Action at TSDR 18.

69. April 20, 2020 Response to Suspension Inquiry at TSDR 23-30

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at issue in this case. Thus, because this evidence does not correlate to the proposed mark at issue, we cannot rely on it to demonstrate that the proposed color mark in particular has achieved significance as a source-indicator.

Under the “intentional copying” factor, while Applicant submitted a couple of articles about counterfeit nitrile medical examination gloves in different colors,⁷⁰ the articles simply do not relate to any alleged copying of the proposed color mark at issue.

Applicant did not point to any evidence under the sixth factor.

Based on our review of the evidence in its entirety, we find that Applicant has failed to meet its burden of proving that consumers seeking chloroprene medical examination gloves would understand the primary significance of the color dark green (Pantone 3285 c) alone as a source-indicator for Applicant and, therefore, it has not acquired distinctiveness.

Decision: The refusal to register Applicant’s proposed mark on the Principal or Supplemental Register on the ground that it is generic is affirmed. In the alternative, the refusal to register Applicant’s proposed mark on the Principal Register as not inherently distinctive and lacking acquired distinctiveness is affirmed.

70. March 9, 2021 Request for Reconsideration at TSDR 55-60.

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**APPENDIX C — EXAMINER’S LETTER,
DATED FEBRUARY 16, 2022**

UNITED STATES PATENT AND
TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT
APPLICANT’S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 88083209

APPLICANT: PT MEDISAFE TECHNOLOGIES

FINAL OFFICE ACTION

Issue date: February 16, 2022

INTRODUCTION

This Office action is in response to applicant’s communication filed on January 12, 2022.

In a previous Office action dated September 7, 2021, the trademark examining attorney refused registration of the applied-for mark on the Supplemental Register based on Trademark Act Sections 23(c) and 45 because the applied-for mark is generic and thus incapable of distinguishing applicant’s goods. In addition, the trademark examining attorney continued and maintained the following refusals: 1) Trademark Act Sections 1, 2, and 45 because it is generic for applicant’s goods, and 2) Trademark Act Sections 1, 2, and 45 because the proposed mark is not inherently distinctive. Finally, the trademark examining attorney

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continued and maintained the denial of applicant's claim of acquired distinctiveness under Trademark Act Section 2(f) for the proposed mark, in the alternative, because applicant's evidence of acquired distinctiveness is insufficient.

The trademark examining attorney maintains and now makes FINAL the refusals and denial in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

SUMMARY OF ISSUES MADE FINAL that applicant must address:

- Final Refusal—Applicant's Mark Is Generic

**FINAL REFUSAL—APPLICANT'S MARK IS
GENERIC**

The refusal to register the applied-for mark is generic for applicant's goods is **continued and made final**. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, 1127; *see* TMEP §§1209.01(c) *et seq.*, 1209.02(a)(ii). Thus, applicant's claim of acquired distinctiveness under Section 2(f) is insufficient to overcome the refusal because "generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be." *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (quoting *In re Northland Aluminum Prods.*, 777 F.2d 1556, 1558, 227 USPQ2d 961, 962 (Fed. Cir. 1985)); *see* TMEP §1212.02(i). In the alternative, the refusal to register the applied-for mark on the Supplemental Register because applicant's

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mark is generic for applicant's goods is **continued and made final**. Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; see TMEP §§1209.01(c) et seq.

Precedent holding that product design may be deemed generic where it is, “at a minimum, so common in the industry that it cannot be said to identify a particular source” has been held to apply to product packaging. *In re Odd Sox LLC*, 2019 USPQ2d 370879, at *6 (TTAB 2019) (quoting *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1555, 1567 (TTAB 2009)); cf. *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1326-27, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999) (noting that trade dress can be considered generic if it “consists of the shape of the product that conforms to a well-established industry custom”)); see also *Nora Beverages Inc. v. Perrier Grp. of Am. Inc.*, 269 F.3d 114, 119-20, 60 USPQ2d 1038, 1041 (2d Cir. 2001) (affirming the district court’s finding that the water bottle manufactured and sold by Nora was generic because “it was used, with minor variations, throughout the entire market of similar products”); *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1069-70, 36 USPQ2d 1176, 1180 (2d Cir. 1995) (“[W]here it is the custom in a particular industry to package products in a similar manner, a trade dress done in that style is likely to be generic. In other words, when the possibilities of the ultimate trade dress for a product are limited and the trade dress is therefore in commonplace use, it is unlikely that consumers will view the trade dress as distinctive of the goods or services of a particular seller.”). The precedent holding that product design may be generic applies equally to trade dress

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consisting of a single color. *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *16-17 (TTAB 2019). In this case, due to the wide-spread use of the color dark green on applicant's goods as well as closely related goods, the applied-for color appears to be understood by the relevant public primarily as a category or type of trade dress for that genus of goods.

"A mark is generic if its primary significance to the relevant public is the class or category of goods or services on or in connection with which it is used." TMEP §1209.01(c)(i) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1600 (TTAB 2014)). Determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods and/or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

In re Cordua Rests., Inc., 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d at 990, 228 USPQ at 530); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods **may** be defined by an applicant's identification of goods. See *In re Cordua Rests., Inc.*, 823 F.3d at 602, 118

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USPQ2d at 1636 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)); *see also In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361, 1363, 92 USPQ2d 1682, 1682, 1684 (Fed. Cir. 2009).

The fact that the genus is often derived from the identification of the goods in the application is based on the premise that the identification accurately reflects an applicant's actual use of the applied-for mark. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437-38 (TTAB 2005) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)). Nevertheless, other relevant evidence of record may be considered in order to properly determine the genus at issue. *In re DNI Holdings Ltd.*, 77 USPQ2d 1437-1438 (TTAB 2005).

Here, applicant's identification of goods helps to clarify, but does not completely define, the overall genus of goods. The evidence of record from the Benco Dental, Mercedes Scientific, Sunline Supply, Hall of Care, My Glove Depot, FDA, and CDC websites shows that an examination glove is a type of medical glove and, further, that an examination glove composed of chloroprene is a type of medical glove. September 7, 2021 Office Action (TSDR 37-89). For example, the evidence of record from the Benco Dental website states, "There are several variants of disposable medical gloves that possess different levels of protection, comfort, and durability. In the medical field, the most used gloves are made from latex, nitrile, or chloroprene." September 7, 2021 Office Action (TSDR 38). Also, the evidence of record from the FDA website explains, "Medical gloves are examples of personal protective

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equipment that are used to protect the wearer and/or patient from the spread of infection or illness during medical procedures and examination. Medical gloves are one part of an infection-control strategy.” September 7, 2021 Office Action (TSDR 78).

In *In re DNI Holdings Ltd.*, the applicant structured its identification of services in a manner that avoided reference to its core sports betting services in an effort to avoid a finding that its mark was generic. *In re DNI Holdings Ltd.*, 77 USPQ2d at 1437-1438 (TTAB 2005). Despite the exclusion of a reference to applicant’s core services in *DNI Holdings*, the Board looked to the record for deciding whether the applicant’s mark in that case was generic. In so doing, the Board found that the genus of services included “wagering on sporting events” “despite applicant’s tactical decision to carve them out of its recitation of services.” *In re DNI Holdings Ltd.*, 77 USPQ2d at 1438. In this case, the first Office action to include a refusal to register the applied-for mark because it is generic for applicant’s goods was issued on May 19, 2020. The generic refusal was made final in an Office action issued September 9, 2020. Applicant amended the identification of goods to include a material composition limitation and to limit the channels of trade on March 9, 2021. Applicant’s amendment of the identification of goods to include material composition and trade channel limitations was arguably intended to avoid a finding that the applied-for mark is generic. Under such circumstances, it is appropriate to look to the application record when determining whether applicant’s mark is generic.

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In this case, the application presently identifies the goods, as amended, as “chloroprene medical examination gloves sold only to authorized resellers.” The composition of applicant’s identification of goods places “medical examination gloves” at its center with a material composition modifier at the beginning and wording intended to identify trade channels at the identification’s end. This modifier and the trade channel language do not alter the essential nature of applicant’s goods, which are medical gloves.

The nature of applicant’s goods is supported by the declaration of Anil Teneja, applicant’s “Executive Vice President.” Teneja Decl. ¶1 attached to the 1/30/2019 Response to Office Action (TSDR 17-23). In this declaration, applicant declares, “Applicant is an Indonesian company that is the business of designing, manufacturing, and distributing protective gloves to customers in North America, Europe, and Asia.” Teneja Decl. ¶3 attached to the 1/30/2019 Response to Office Action (TSDR 18). Throughout applicant’s declaration, applicant’s goods are identified as “protective gloves,” “gloves,” or “glove products.” Teneja Decl. ¶¶ 9, 11, 12-31, and 34 attached to the 1/30/2019 Response to Office Action (TSDR 18-23). Finally, applicant’s declaration concludes, “As a result of Applicant’s substantial advertising and promotional efforts, Applicant’s customers recognize the Pantone 3255C, Pantone 3285C and Pantone 359U green color mark used in connection with protective gloves as identifying Applicant and its products.” Teneja Decl. ¶34 attached to the 1/30/2019 Response to Office Action (TSDR 23). The repeated description of its goods as “protective

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gloves,” “gloves,” and “glove products” is consistent with and supports a finding that the genus of goods at issue is medical gloves.

Further, the genus of applicant’s goods is supported by the evidence of record consisting of website excerpts showing applicant’s goods being offered through third-party retail outlets. In particular this evidence shows applicant’s goods categorized as “Healthcare Gloves” (Scimetrics website), “Exam Grade Gloves” (Blue Thunder website), and “Disposable Gloves” (Harmony website). May 19, 2020 Office Action (TSDR 8-13 and 27). Further, the evidence of record shows applicant’s goods categorized as “Gloves” (Henry Schien and VWR websites), “Disposable Gloves” (Amazon website), and “Medical Gloves” (AD Surgical website). September 9, 2020 Office Action (TSDR 4-14 and 17-19). Finally, the evidence of record consisting of an excerpt from the AAA Wholesale Company website shows applicant’s goods categorized as “Exam Gloves.” September 7, 2021 Office Action (TSDR 29-31).

As discussed above, the evidence of record provides further support for the finding that the genus of goods at issue is medical gloves. The inclusion of the modifier “chloroprene” in the identification of goods merely refers to a sub-group or type of the genus of goods. Specifically, the attached evidence from the Merriam-Webster website shows that “chloroprene” is “a colorless liquid C_4H_5Cl used especially in making neoprene by polymerization.” Consequently, the inclusion of “chloroprene” in the identification of goods merely refers to a sub-group or type of medical gloves, namely, medical gloves that are

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composed of neoprene made by the polymerization of C_4H_5Cl , a colorless liquid.

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods. *The Loglan Inst. Inc. v. The Logical Language Grp.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553).

Throughout the course of the examination of this application, applicant has identified evidence submitted by the trademark examining attorney as identifying gloves manufactured by applicant that feature the applied-for mark and are offered by applicant's authorized resellers. Specifically, the evidence attached to the Office action dated May 19, 2020 from the Scimetries, Blue Thunder, Dental Health Products, Harmony, Hantover, LabMart, and GloveAmerica.com websites feature applicant's goods in the applied-for color. (TSDR 8-13, 25-27, and 33-37). Also, evidence attached to the Office action dated September 9, 2020 from the Thomas Scientific, Henry Schien, VWR, Amazon, W.B. Mason, AD Surgical, and Med Express websites all feature applicant's goods bearing the applied-for mark applied to gloves manufactured by applicant. (TSDR 2-21). Finally, evidence attached to the Office action dated September 7, 2021 Office action from the AAA Wholesale Company and Hospeco websites feature applicant's goods in the applied-for color. (TSDR 29-31 and 36). This identified evidence of record, all of which is incorporated herein by reference, shows that applicant's authorized resellers offer applicant's gloves

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bearing the applied-for mark to ordinary consumers. Indeed, this evidence includes applicant's gloves being offered to consumers on the widely-used Amazon website. September 9, 2020 Office Action (TSDR 10-14). In light of the evidence of record that shows applicant's goods are widely offered to ordinary consumers, the relevant public comprises ordinary consumers who purchase applicant's goods. Additionally, applicant's authorized resellers are not the relevant public that is the purchasing or consuming public for the identified goods that is contemplated by the relevant controlling authority. *The Loglan Inst. Inc. v. The Logical Language Grp.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In *Magic Wand* the Federal Circuit stated, "The 1984 amendment makes the understanding of the 'relevant public' for a product sold in the marketplace, the Clarification Act means the relevant public which does or may purchase the goods or services in the marketplace." *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1552-53. The attached evidence from The American Heritage Dictionary website defines "resell" as "to sell (a product or service) to the public or to an end user, especially as an authorized dealer." Also, the attached evidence from the Ecommerce Platforms website defines a "reseller" as,

A company that purchases services or goods for resale rather than consumption. In ecommerce, this can often apply to an affiliate marketer. Retailers are considered resellers, as they resell goods to end consumers. Wholesalers are also considered resellers as they resell the goods they purchase to retailers.

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Even though applicant's authorized resellers may purchase applicant's identified goods, they do so to sell applicant's gloves to the public or to end users. Further, applicant's authorized resellers do not consume applicant's goods and, rather, sell applicant's goods to end consumers who actually consume applicant's goods. In this regard, the relevant public for applicant's goods are those individuals who purchase the medical glove goods applicant manufactures in the marketplace as well as those who consume or use applicant's medical glove goods. Because applicant's authorized resellers are not the parties who purchase applicant's medical glove goods in the marketplace and also do not consume or use applicant's medical glove goods, they are not the relevant public to be considered here for the purposes of determining whether applicant's mark is generic. Instead, the relevant public are those individuals and parties that would purchase medical gloves in the marketplace and that would consume medical gloves. The attached evidence from the Gloves.com website states,

Medical grade gloves are worn by surgeons during surgery, medical lab technicians when handling hazardous materials and chemicals, and other medical personnel who might need protection. Exam-grade gloves are a vital form of protection for any industry with exposure to biological hazards. This ranges from caregivers, tattoo artists, and aestheticians to janitors, housekeeping staff, and childcare providers.

Consequently, the relevant public to be considered here is comprised of surgeons, medical lab technicians,

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and medical personnel. Further, the relevant public may also include tattoo artists, aestheticians, janitors, housekeeping staff, and childcare providers.

The attached evidence consisting of excerpts from the Young Specialties, The Dental Box, Arizona Tools, Accutome, and TOOLSiD websites shows the applied-for color dark green used on medical gloves. Additionally, the evidence attached to the May 19, 2020 Office action from the Scimetrix, Blue Thunder, Dental Health Products, Harmony, Quad Med, Safco, Hantover, LabMart, and GloveAmerica.com websites shows the applied-for color used on medical gloves. May 19, 2020 Office Action (TSDR 7-14 and 25-37). Also, the evidence attached to the September 9, 2020 Office action from the Thomas Scientific, Henry Schien, VWR, Amazon, W.B. Mason, AD Surgical, Med Express, Medicom, Safeco, Harmony Lab & Safety Supplies, Top Glove, Stauffer, Clean Pro, Bound Tree, and Trillium Industrial Safety Inc. websites also shows applicant's dark green color used on medical gloves. September 9, 2020 Office action (TSDR 2-42). The evidence attached to the April 8, 2021 reconsideration letter from the MDS, Emerald, We Share Safety Supply, Allmedtech.com, InSource, 8Health, My Glove Depot, ServMart, and OfficeSupplyNow.com websites shows the applied-for dark green color used on medical gloves. April 8, 2021 Reconsideration Letter (TSDR 2-19). Finally, the evidence attached to September 7, 2021 Office action the from Reflexx, ECVV, Dynarex, Sempermed, VWR, Amazon, AAASWholesaleCompany, R.S. Hughes, DQE, and Hospeco websites shows applicant's dark green color used on medical gloves. September 7, 2021 Office Action

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(TSDR 2-36). Collectively, the attached evidence and the above-listed evidence of record, which is incorporated herein by reference, shows common and widespread use of the color dark green on medical gloves. Furthermore, this evidence shows that the color dark green used on medical gloves is understood by the relevant public primarily as a category or type of trade dress for that genus of goods; thus, the relevant public would understand this designation to refer primarily to that genus of goods due to its common and widespread use.

Accordingly, the generic registration refusal under Trademark Act Sections 1, 2, and 45 as well as Trademark Act Sections 23(c) and 45, in the alternative, are hereby continued and made FINAL.

**REFUSAL IN THE ALTERNATIVE—APPLIED-
FOR MARK IS NOT DISTINCTIVE**

In the alternative, if the applied-for mark is ultimately determined not to be generic by an appellate tribunal, then the refusal of registration based on the applied-for mark being not inherently distinctive is maintained and continued. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166, 34 USPQ2d 1161, 1164 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1121-23, 227 USPQ 417, 420-21 (Fed. Cir. 1985); TMEP §1202.05(a). Specifically, applicant seeks registration of the color dark green (Pantone 3285 c) used with goods presently identified as “chloroprene medical examination gloves sold only to authorized resellers.” The applied-for mark fails to

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function as a trademark because it consists solely of a color used on the goods. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. at 163 (1995). Purchasers do not perceive color, including applicant's color dark green (Pantone 3285 c), as identifying a source or origin for goods, but rather as a feature of the goods. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d at 1124 (Fed. Cir. 1985) ("We agree that color is usually perceived as ornamentation."). The above-listed and cited evidence of record shows that dark green is commonly used on medical gloves.

In addition, applicant's claim of acquired distinctiveness in the response is a concession that the mark sought to be registered is not inherently distinctive as used with applicant's goods. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *9 (TTAB 2019) (citing *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Am. Furniture Warehouse Co.*, 126 USPQ2d 1400, 1403 (TTAB 2018)).

**APPLICANT'S EVIDENCE OF ACQUIRED
DISTINCTIVENESS IS INSUFFICIENT**

With respect to applicant's claim of acquired distinctiveness, the following evidence was provided in support of such claim: a declaration from applicant's officer, evidence of sales figures and advertising expenditures, evidence of applicant's marketing efforts, declarations from officers of two entities that sell applicant's goods, and survey results. *See* 37 C.F.R. §2.41.

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Applicant provided a declaration from applicant's officer (April 20, 2020 Applicant's Response to Suspension Inquiry (TSDR 17-33)) to support applicant's claim that the applied-for mark acquired distinctiveness under Trademark Act Section 2(f). *See* 15 U.S.C. §1052(f). Although consumer affidavits and declarations that assert recognition of a mark as an indicator of source are relevant in establishing acquired distinctiveness, affidavits and declarations of an applicant's employees, officers, and attorneys are usually self-serving and entitled to little weight. *See In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c). Moreover, the declaration from applicant's officer concerns three colors, i.e. "Pantone 3255C, Pantone 3285C and Pantone 359U," rather than the single color that is presently subject of this application. Teneja Decl. ¶¶5-10 attached to the 1/30/2019 Response to Office Action (TSDR 18-19). In light of the identification of three colors throughout this declaration, it is unclear what averments relate solely to the applied-for dark green (Pantone 3285 c) that applicant currently seeks to register.

Applicant provided evidence of high sales figures and significant advertising expenditures for applicant's goods to support the claim that the applied-for mark acquired distinctiveness under Trademark Act Section 2(f); however, this evidence is not dispositive of applicant's claim. Teneja Decl. ¶¶15-16, 22 attached to the 1/30/2019 Response to Office Action (TSDR 20 and 22). Applicant's extensive sales and promotion may demonstrate the commercial success of applicant's goods, but not that

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relevant consumers view the matter as a mark for these goods. *See In re Boston Beer Co.*, 198 F.3d 1370, 1371-73, 53 USPQ2d 1056, 1057-58 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1132-34 (TTAB 2000). Furthermore, this evidence relates to three colors rather than the single color applicant presently seeks to register. Teneja Decl. ¶¶15-18 attached to the 1/30/2019 Response to Office Action (TSDR 20). Therefore, it is unclear what component of the sales figures and advertising expenditures relate solely to the applied-for color.

Similarly, applicant's advertising expenditures are merely indicative of its efforts to develop distinctiveness for three colors; not evidence that the applied-for mark consisting of a single shade of green has acquired distinctiveness. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1757-58 (TTAB 1991).

Applicant's evidence of its marketing efforts is insufficient to show that it has caused consumer to associate a single color, absent any other indicia, as an identifier of source and origin of applicant's goods. Teneja Decl. ¶¶20-21 and 23-29 attached to the 1/30/2019; Response to Office Action (TSDR 21-22); 1/30/2019 Response to Office Action (TSDR 36). While applicant does use the phrase "The Green Glove everybody's talking about" in the provided advertisement, it uses this phrase or slogan, which arguably is in the nature of "look for" advertising, with three different shades of green used on gloves. Response to Office Action (TSDR 21-22); 1/30/2019 Response to Office Action (TSDR 36). Because this phrase or slogan is used with multiple colors, this minimal evidence is insufficient to meet its

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substantial burden to show that the applied-for color mark, which is a single shade of green, has acquired distinctiveness.

Applicant provided declarations from officers of two entities that sell applicant's goods to support its claim of acquired distinctiveness. August 6, 2020 Response to Office Action (TSDR 6-13). These declarations, however, are virtually identical. Although each declaration includes specific information to identify each of declarant, they are otherwise identical. Since the content of these declarations is identical, despite the fact that they are intended to present each declarant's impression of the distinctiveness of the applied-for mark, the persuasive value of these declarations is exceedingly minimal.

Applicant's evidence of acquired distinctiveness includes survey evidence to support applicant's claim that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f). *See* 15 U.S.C. §1052(f). An applicant may, in support of registrability, "submit . . . statements from the trade or public" to prove distinctiveness. 37 C.F.R. §2.41(a)(3); *see* TMEP §1212.06(d).

However, to be probative, survey results must show that consumers view the applied-for mark as indicating the source of the relevant goods and/or services. TMEP §1212.06(d) (citing *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1402-03 (TTAB 2009); *Boston Beer Co. v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 183, 28 USPQ2d 1778, 1784 (1st Cir. 1993)). A survey must also

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be properly conducted to have probative value. *See Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1569-71 (TTAB 2009); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996) (citing *Flowers Indus. Inc. v. Interstates Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987)). Thus, in addition to relevance, “how [the] survey was conducted, the number of participants surveyed, and the geographic scope of the survey” are assessed when determining the probative weight of the survey. TMEP §1212.06(d).

In the present case, applicant’s survey is unpersuasive due to the format and/or the method in which it was conducted, and thus has little or no probative value on the issue of acquired distinctiveness of the applied-for mark. *See Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d at 1569-71; TMEP §1212.06(d); J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§32:158, 32:170 (rev. 4th ed. Supp. 2016).

Specifically, an insignificant number of people were surveyed. Therefore, applicant’s survey, which consists a meager three responses, fails to show that a substantial portion of the relevant consuming public associates the applied-for mark with applicant. Furthermore, applicant’s survey fails to establish the number of actual consumers who viewed the applied-for mark as an indicator of source. Finally, applicant’s survey, given that the three respondents appear to be self-selected from a limited population comprised of six of applicant’s “most significant customers,” is not reliable and neutral evidence of acquired

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distinctiveness due to the method used for questioning participants.

Due to the nature of applicant's survey, this evidence is not probative on the issue of applicant's claim of acquired distinctiveness.

If the applied-for mark is ultimately determined to be not inherently distinctive and not generic, the Section 2(f) evidence is insufficient to show acquired distinctiveness because the evidence of record shows that many third-parties offer medical gloves to consumers in colors identical or substantially similar to the applied-for color. Specifically, the above-referenced and attached evidence from the Young Specialties, The Dental Box, Arizona Tools, Accutome, and TOOLSiD websites as well as the following referenced evidence in the application record show use of applicant's dark green color with medical gloves:

- Quad Med and Safco websites (May 19, 2020 Office Action (TSDR 28-32));
- Medicom, Safco, Harmony Lab & Safety Supplies, Top Glove, Stauffer, Clean Pro, Bound Tree, and Trillium Industrial Safety Inc. websites (September 9, 2020 Office Action (TSDR 22-42));
- MDS Associates, Emerald Professional Products, We Share Safety Supply, Allmedtech.com, InSource, 8 Health, My Glove Depot, ServMart, and The Trimmer Place OfficeSupplyNow.com (April 8, 2021 Reconsideration Letter (TSDR 2-19)); and

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- Reflexx, ECVV.com, Dynarex, Sempermed, Avantor, Amazon, R.S. Hughes, and DQE websites (September 7, 2021 Office Action (TSDR 2-28, 32-35)).

The attached and above-referenced evidence demonstrates that many third parties manufacture, produce, and/or provide medical examination gloves with a dark green exterior. This evidence contradicts applicant's claim of acquired distinctiveness based on substantially exclusive and continuous use of the color dark green used on the exterior of medical examination gloves. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."); *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1024 (TTAB 2017) (finding that "the presence in the market of yellow-packaged cereals from various sources . . . would tend to detract from any public perception of the predominantly yellow background as a source-indicator pointing solely to Applicant").

In the course of the examination of this application applicant has identified evidence submitted by the trademark examining attorney as identifying gloves manufactured by applicant that feature the applied-for mark and are offered by applicant's authorized resellers. Specifically, applicant has identified the following evidence of record as identifying gloves that it has manufactured:

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- Scimetrics, Blue Thunder, Dental Health Products, Harmony, Hantover, LabMart, and GloveAmerica.com website excerpts (May 19, 2020 the Office Action (TSDR 8-13, 25-27, and 33-37);
- Thomas Scientific, Henry Schien, VWR, Amazon, W.B. Mason, AD Surgical, and Med Express websites excerpts September 9, 2020 Office Action (TSDR 2-21)); and
- AAA Wholesale Company and Hospeco website excerpts (September 7, 2021 Office Action (TSDR 29-31 and 36).

None of the evidence applicant has identified as showing gloves applicant has manufactured and bearing the applied-for color identifies the color dark green as an identifier of the source and origin of any parties' goods whatsoever. While these website excerpts may show that third-parties offer goods applicant has manufactured for sale to consumers, this evidence does not show that any party of any kind recognizes the applied-for dark green color as a trademark for any party. To the extent that anyone associates any of the gloves as originating from a particular source and origin, it is likely that consumers would associate these goods with the, apparently, registered trademarks that are featured in this website evidence. For example, the evidence of record from the Blue Thunder website features a dark green exam grade glove offered to consumers under the Microflex® and Neogard® marks. May 19, 2020 Office Action (TSDR 10-13). Therefore, even the evidence of record that has been

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identified by applicant as evidence of gloves that it has manufactured does not show that the applied-for mark has acquired distinctiveness.

To summarize, the application record does not include evidence that shows that applicant has met its substantial burden to show the specific shade of green that applicant seeks to register, i.e. dark green (Pantone 3285 c), has acquired distinctiveness.

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); TMEP §1212.01. An applicant's evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d at 1365, 127 USPQ2d at 1045 (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)).

The burden of proving that a color mark has acquired distinctiveness is substantial. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (holding the color pink used on fibrous glass residential insulation to have acquired distinctiveness based on evidence of twenty-nine years' use, extensive affidavit and documentary evidence, surveys, and extensive media advertising expenditures); *In re Am.*

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Home Prods. Corp., 226 USPQ 327 (TTAB 1985) (holding combination of colors pink, white and yellow used on an analgesic/muscle relaxant tablet to have acquired distinctiveness based on evidence of more than twenty years' use, extensive advertising, and sales of over two billion tablets from 1960-1980); *cf. In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214 (TTAB 1998). A mere statement of long-time use of the color mark is not sufficient; an applicant must provide evidence demonstrating that the color mark has acquired source-indicating significance in the minds of consumers. TMEP §1202.05(a); *see* TMEP §1212.06.

ADVISORY—RESPONSE ASSISTANCE

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

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**APPENDIX D — ORDER OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED JULY 3, 2025**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2023-1573

IN RE: PT MEDISAFE TECHNOLOGIES,

Appellant

Appeal from the United States Patent and Trademark
Office, Trademark Trial and Appeal Board in No.
88083209.

ON PETITION FOR PANEL REHEARING

Before PROST, CLEVINGER, and STARK, *Circuit Judges*.

PER CURIAM.

ORDER

The Acting Director of the United States Patent and
Trademark Office filed a petition for panel rehearing.

Upon consideration thereof, and in light of the errata
issued in this case on July 3, 2025,

IT IS ORDERED THAT:

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The petition is denied as moot.

FOR THE COURT

/s/ Jarrett B. Perlow
Jarrett B. Perlow
Clerk of Court

July 3, 2025
Date