

## US: TRADE MARKS



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## Narrowing colour claims

The fashion world had been abuzz in 2012 and 2013 about footwear designer Christian Louboutin's claim of exclusivity to the use of the colour red on the sole of footwear. Battles over claims of rights in particular colours did not, however, end with the resolution of the Louboutin case and have extended beyond just the fashion industry. The issue of ownership of colour trade marks recently raised its head again in a precedential decision issued by the USPTO's Trademark Trial and Appeal Board (TTAB) addressing a petition for partial cancellation or restriction of registration filed by Covidien LP against a trade mark registration owned by Masimo Corporation.

Covidien is the owner of a trade mark application for a mark consisting of the colour pink as applied to medical cables. This application was refused registration based upon a likelihood of confusion with a trade mark registration owned by Masimo for a mark consisting of the colour red for very similar products. Covidien then filed a petition with the TTAB, alleging that the colour red, as identified in Masimo's trade mark registration, does not state the particular shade of red being used by Masimo and requesting that Masimo's trade mark registration be limited from the colour red to the particular shade of red actually being used by Masimo in the marketplace, which Covidien identified as Pantone PMS 185. Covidien asserted that such limitation would avoid a finding of a likelihood of confusion between its color mark and Masimo's colour mark. Masimo responded by filing a motion to dismiss Covidien's petition for failure to state a claim.

Section 18 of the Lanham Act provides that the TTAB may "restrict or rectify ... the registration of a registered mark". In order to state a claim under Section 18, a petitioner must allege two

elements, namely, that: (1) the description of the mark in the registration is "ambiguous or overly broad"; and (2) the proposed restriction will avoid a likelihood of confusion. The TTAB read the "ambiguous or overly broad" language in Section 18 as allowing for relief "where a plaintiff alleges that a feature of the description of the mark renders the description not specific to the mark actually used by the defendant". Based on such reading, the TTAB held that Covidien's petition set forth the necessary allegations to state a claim for relief under Section 18 and, therefore, denied the motion to dismiss.

Notwithstanding the denial of the motion to dismiss, the TTAB held that Covidien's proposed amendment from "red" to "Pantone PMS 185" did not conform to USPTO rules since it did not specify the particular shade of red (which must be designated in ordinary language) but, rather, only made reference to a commercial coloring system. Therefore, Covidien was given time to file an amended pleading to address this requirement and it amended its petition to ask that Masimo's registration be limited to "fire engine red".

The TTAB has not yet addressed whether the requested limitation will be granted and the proceedings are continuing. It is still possible that there will be a final determination of a likelihood of confusion even if the description in Masimo's registration is changed. The decision does, at a minimum, indicate that trade mark registrations for colours can, in certain circumstances, be made more limited, thereby providing an alternative means of challenge for parties seeking to use variations on a protected colour.