

IN RE PT MEDISAFE TECHNOLOGIES, Appeal No. 2023-1573 (Fed. Cir. April 29, 2025).
Before Prost, Clevenger, and Stark. Appealed from the TTAB.

Background:

Medisafe applied for registration of a color mark for use on medical examination gloves, describing 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." The examiner relied on the two-step test to determine genericness as set forth in *Marvin Ginn*, which states, "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?" When applying the two-step test, the examiner determined that the proposed mark was not inherently distinctive and thus could not be registered unless Medisafe could show the mark had acquired distinctiveness. Medisafe was unable to do so.

Medisafe appealed to the TTAB and claimed that the examiner had erred by misapplying the *Marvin Ginn* test to color marks by interchanging the word "term" with "color." On review, the TTAB determined that the modified test is the appropriate genericness test. The TTAB also rejected Medisafe's proposed genus, which would have consisted of only gloves sold to authorized resellers, and instead broadened the genus to include all chloroprene medical examination gloves.

The TTAB upheld the examiner's finding 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." Medisafe then timely appealed.

Issues/Holdings:

Did the TTAB use the proper test in assessing whether a mark is generic? If so, did the TTAB apply the test correctly? The Federal Circuit answered both in the affirmative.

Discussion:

The Federal Circuit agreed with the TTAB that the modified *Marvin Ginn* test is appropriate. It explained that the facts of *Marvin Ginn* did not require the court to consider color marks but the court, nevertheless, articulated in that decision that the test applies to marks without limitation to their type.

Moreover, in response to Medisafe's argument that the modified test ignores statutory language which allows for cancellation of a mark for genericness only where the mark is a "generic name," the Federal Circuit emphasized the plain meaning of "generic" does not exclude trade dress because a narrower interpretation of "generic name" would allow trade dress to have more protection than a word mark under the Lanham Act.

Additionally, the Federal Circuit held that substantial evidence supports the TTAB's finding that, while a color mark may serve as a source indicator, Medisafe's proposed mark failed to do so.

Medisafe's Proposed Color Mark:

