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## **TRADEMARK PROTECTION OF COLOR ALONE: HOW AND WHEN DOES A COLOR DEVELOP SECONDARY MEANING AND WHY COLOR MARKS CAN NEVER BE INHERENTLY DISTINCTIVE**

*Diane E. Moir*<sup>\*</sup>

### **I. INTRODUCTION**

According to a study performed by the University of Loyola, Maryland, “[c]olor increases brand recognition by up to 80 percent.”<sup>1</sup> Additional research shows that color has a significant impact on sales since “people make a subconscious judgment about a . . . product within 90 seconds of initial viewing and . . . between 62% and 90% of that assessment is based on color alone.”<sup>2</sup> As a result, many product manufacturers have turned to color psychologists and brand experts to discover innovative and interesting ways of using color to distinguish their products from the products of others,<sup>3</sup> and have sought protection of their names as well as their color identity through trademark registration.<sup>4</sup>

In 1995, the United States Supreme Court decided the landmark case, *Qualitex Co. v. Jacobson Products Co., Inc.*<sup>5</sup> In *Qualitex*, the Supreme Court held that color alone could be registered as a trademark, provided it had acquired distinctiveness through second-

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<sup>1</sup> Jill Morton, *Why Color Matters*, COLORCOM (2005), [http://www.colorcom.com/why\\_color.html](http://www.colorcom.com/why_color.html) (citation omitted).

<sup>2</sup> *Id.* (citation omitted).

<sup>3</sup> *See, e.g., id.*

<sup>4</sup> *See* Jill Morton, *Who Owns Hues?*, COLORCOM (2008), [http://www.colormatters.com/color\\_trademark.html](http://www.colormatters.com/color_trademark.html).

<sup>5</sup> 514 U.S. 159 (1995).

ary meaning.<sup>6</sup> Since the Court believed that the Lanham Act did not pose a bar to the registration of color alone, the Court held color could be registered on the principal or supplemental register if it met trademark requirements.<sup>7</sup>

Although the Court in *Qualitex* did not explicitly state that color alone could never be inherently distinctive, the Court ended all inquiries five years later when it decided *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>8</sup> In *Wal-Mart*, the Court explicitly stated “that no [color] mark can ever be inherently distinctive,” but it may be protected as a trademark provided the color acquired a secondary meaning.<sup>9</sup>

In *Qualitex* and *Wal-Mart*, the issue the Court did not decide, and the issue that the federal courts and the Trademark Trial and Appeal Board (“TTAB”) have tried to develop, is by what means, and at what point, color marks attain secondary meaning for trademark purposes.<sup>10</sup> Since color is considered a nontraditional trademark,<sup>11</sup> federal courts and the TTAB face a “fact-sensitive inquiry”<sup>12</sup> as to whether a single color, or combination of colors, is capable of, and does in fact serve as a sufficient indicator of product source.<sup>13</sup>

This Comment explores the current state of color trademark registration by examining federal statutes, court cases, and the federal trademark examining procedure. Part II discusses the history and background of federal trademark protection, the importance of the

<sup>6</sup> *Id.* at 163.

<sup>7</sup> *Id.* at 162.

<sup>8</sup> 529 U.S. 205, 212 (2000).

<sup>9</sup> *Id.* at 211-12.

<sup>10</sup> See, e.g., *White Consol. Indus., Inc. v. Royal Appliance Mfg. Co.*, No. 74/156,648, 2000 WL 713972, at \*6 (T.T.A.B. May 31, 2000).

<sup>11</sup> MALLA POLLACK, CORPORATE COUNSEL’S GUIDE TO TRADEMARK LAW § 4:14 (2009).

<sup>12</sup> *Major League Baseball Props., Inc. v. Salvino, Inc.*, 420 F. Supp. 2d 212, 222 (S.D.N.Y. 2005).

<sup>13</sup> The TTAB “hears and decides adversary proceedings involving: oppositions to the registration of trademarks[,] petitions to cancel trademark registrations[,] proceedings involving applications for concurrent use registrations of trademarks.” *Trademark Trial and Appeal Board*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/about/office/s/ogc/ttab.jsp> (last visited Dec. 2, 2009). Additionally, an applicant who has been denied federal registration by “the trademark examining attorney[]” will take his appeal to the TTAB. *Id.* Once a proceeding has been held and decided by the TTAB, “TTAB decisions can be appealed to a United States District Court or directly to the United States Court of Appeals for the Federal [C]ircuit.” Interview by Damien Allen with Brian Hall, Attorney, Traverse Legal PLC (Sept. 14, 2009), available at <http://ttab-trademark.com/traverse-legal-radio-brian-hall-discusses-trademark-opposition-cancellation-and-the-ttab/2009/09/>.

Lanham Act, and the major policy reasons for federal trademark protection. Part III examines the *Qualitex* decision and its impact on the registration of color marks. Part IV discusses the requirements which must be satisfied for trademark protection. Additionally, this section clarifies the differences between inherently distinctive marks and those marks which will be afforded protection only upon showing “acquired distinctiveness,” also known as secondary meaning. This part will explore instances in which functionality has provided a bar to trademark registration. Part V examines the present state of color trademark law. Part VI concludes with suggestions for the producers that seek to register one or more colors.

## II. HISTORY AND BACKGROUND OF FEDERAL PROTECTION FOR TRADEMARKS

### A. Lanham Act

The laws governing trademark protection have undergone several revisions over the years.<sup>14</sup> Under the Trademark Act of 1905, federal trademark registration required that “marks . . . be arbitrary or fanciful; words or symbols that merely described the product were not allowed.”<sup>15</sup> However, during 1946, the federal government enacted a number of federal statutes, collectively referred to as the Lanham (Trademark) Act, stating that “[t]rademarks were no longer restricted to arbitrary or fanciful words or symbols, but could consist of ‘any word, name, symbol, or device, or any combination thereof.’”<sup>16</sup>

While “the Lanham Act . . . imposes a few other miscellaneous restrictions on the types of subject matter eligible for trademark registration,” registration always requires that an applicant prove the mark is distinctive.<sup>17</sup> This requirement may be satisfied by showing

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<sup>14</sup> Lanham Act (Trademark Act of 1946), 15 U.S.C.A. §§ 1051-1141 (West 2010). See also Margaret A. Boulware, *Emerging Protection for Non-Traditional Trademarks: Product Packaging and Design*, RECENT TRENDS IN TRADEMARK PROTECTION: LEADING LAWYERS ON ANALYZING RECENT DECISIONS AND ADAPTING TO EVOLUTIONS IN TRADEMARK LAW (2009), available at 2009 WL 3358962, at \*2 (citation omitted).

<sup>15</sup> Boulware, *supra* note 14, at \*2 (citation omitted).

<sup>16</sup> *Id.* (citing 15 U.S.C.A. § 1127 (West 2006)).

<sup>17</sup> See 2 JAY DRATLER, JR. & STEPHEN M. MCJOHN, *INTELLECTUAL PROPERTY LAW: COMMERCIAL CREATIVE AND INDUSTRIAL PROPERTY* § 9.02 (2009).

the mark (1) is either inherently distinctive, or has acquired distinctiveness through secondary meaning and (2) is not functional.<sup>18</sup>

Depending on a mark's eligibility for trademark registration, an owner of a mark may seek federal protection under either the principal or supplemental register.<sup>19</sup> Before deciding which register to employ, a color trademark applicant should understand what each register offers. The differences between the principal and supplemental register, including the advantages and disadvantages of each, are discussed below.

Marks which satisfy the requirements set forth in the Lanham Act—those which “have been ‘used in commerce’ . . . [and] ‘affixed’ to the goods”—may apply for registration on the principal register.<sup>20</sup> Among the most important of the benefits afforded trademarks registered on the principal register is automatic “[f]ederal jurisdiction for [any allegations of trademark] infringement.”<sup>21</sup> Additionally, “registration . . . upon the principal register . . . [is] prima facie evidence of the validity of the registered mark . . . and of the owner's exclusive right to use the registered mark.”<sup>22</sup> Finally, “[r]egistration of a mark on the principal register . . . [gives the world] constructive notice of the registrant's claim of ownership.”<sup>23</sup>

Marks which do not meet the requirements set forth for registration on the principal register may benefit from registration on the supplemental register, so long as the mark is “capable of distinguishing [the] applicant's goods” from the goods of others.<sup>24</sup> While distinctiveness is a pre-requisite for registration on the principal register,<sup>25</sup> the supplemental register is less insistent about the mark's level of distinctiveness.<sup>26</sup> Therefore, it appropriately follows that owners of marks registered under the supplemental register do not receive the same advantages afforded to owners of marks registered under the

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<sup>18</sup> *See id.*

<sup>19</sup> *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:36 (4th ed. 2010).

<sup>20</sup> *Id.* § 19:10 (indicating that principal registration receives the strongest federal trademark protection).

<sup>21</sup> *Id.* § 19:9.

<sup>22</sup> 15 U.S.C.A. § 1057(b) (West 2010).

<sup>23</sup> *Id.* § 1072.

<sup>24</sup> *Id.* § 1091.

<sup>25</sup> Boulware, *supra* note 14, at \*8.

<sup>26</sup> *Id.*

principal register.<sup>27</sup>

## B. Policy Reasons for Trademark Protection

Unlike copyrights and patents, trademarks are not constitutionally protected.<sup>28</sup> “A trade[]mark is [just] a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants.”<sup>29</sup> In other words, the basic idea of trademark law is to help consumers make a decision between similar products.

There are many reasons for trademark protection. The primary purpose of trademark law is to “provide[] national protection of trademarks in order . . . to protect the ability of consumers to distinguish among competing producers.”<sup>30</sup> Since the public can become confused when producers of similar goods use similar trademarks, trademark law seeks to “prevent[] undesirable confusion.”<sup>31</sup> “[B]y preventing others from copying a source-identifying mark, [trademark law] ‘reduce[s] the customer’s costs of shopping and [helps customers] mak[e] purchasing decisions.’ ”<sup>32</sup> Furthermore, trademark law “quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked . . . in the past.”<sup>33</sup>

A second purpose of trademark protection is to “encourage[] . . . competition through accurate labeling.”<sup>34</sup> In this way, “the law helps assure a producer that it . . . will reap the financial, reputation-related rewards associated with a desirable product.”<sup>35</sup> As a result, the law encourages producers to make quality goods, while discouraging competitors from “sell[ing] inferior products by capitalizing on a consumer’s inability [to] quickly . . . evaluate the quality of an

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<sup>27</sup> 15 U.S.C.A. § 1094 (West 2010).

<sup>28</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[1].

<sup>29</sup> *Mishawaka Rubber & Woolen Mfg. Co. v. S. S. Kresge Co.*, 316 U.S. 203, 205 (1942).

<sup>30</sup> *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (citation omitted).

<sup>31</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[1].

<sup>32</sup> *Qualitex*, 514 U.S. at 163-64 (citation omitted).

<sup>33</sup> *Id.* at 164.

<sup>34</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[1].

<sup>35</sup> *Qualitex*, 514 U.S. at 164.

item” he or she is thinking about purchasing.<sup>36</sup>

Finally, the purpose of trademark law is to “provide[] national protection of trademarks in order to secure to the owner of the mark the goodwill of his [or her] business . . . .”<sup>37</sup> Since many makers of goods invest their time and energy into generating effective “advertising, promotion, quality, service, innovation, and customer satisfaction, their resulting good will becomes associated in the public’s mind with their trademarks.”<sup>38</sup> Therefore, “[t]rademark law protects this good will, and the investment and effort that lie behind it, from” unauthorized use by competing producers.<sup>39</sup>

### III. THE EMERGENCE OF COLOR MARKS

Before 1995, the Federal Circuit and the Ninth Circuit were split on the issue of whether color alone could be protected under federal trademark law.<sup>40</sup> In 1995, the United States Supreme Court laid to rest any doubts concerning “whether the . . . Lanham Act . . . permits the registration of a trademark that consists, purely and simply, of . . . color.”<sup>41</sup> The Court held that “sometimes, a color will meet ordinary legal trademark requirements[;] . . . when it does so, no special legal rule prevents color alone from serving as a trademark.”<sup>42</sup>

The facts of *Qualitex* are simple and straightforward. Qualitex was a manufacturer and seller of green-gold colored dry cleaning pads, which it manufactured in that color since the 1950s.<sup>43</sup> Qualitex sold its pads “to distributors who then [sold the pads] to . . . dry cleaning” businesses for use on their presses.<sup>44</sup> During 1989, Jacobson, a rival of Qualitex, began selling its own green-gold colored press pads to those same distributors.<sup>45</sup> Qualitex then registered the green-gold color as a trademark with the Patent and Trademark Of-

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<sup>36</sup> *Id.* (citation omitted).

<sup>37</sup> *Park 'N Fly*, 469 U.S. at 198.

<sup>38</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[1].

<sup>39</sup> *Id.*

<sup>40</sup> Michael B. Landau, *Trademark Protection for Color Per Se After Qualitex Co. v. Jacobson Products Co.: Another Grey Area in the Law*, 2 UCLA ENT. L. REV. 1, 5 (1995).

<sup>41</sup> *Qualitex*, 514 U.S. at 160-61.

<sup>42</sup> *Id.* at 161.

<sup>43</sup> *Qualitex Co. v. Jacobson Prods. Co.*, No. CV 90-1183 HLH(JRX), 1991 WL 318798, at \*1 (C.D. Cal. Sept. 3, 1991).

<sup>44</sup> *Id.* at \*3.

<sup>45</sup> *Id.*

fice in 1991, and sued Jacobson for unfair competition and trademark infringement.<sup>46</sup>

Since “Qualitex began manufacturing and selling its SUN GLOW® press pad[s] in . . . 1957,” and Jacobson began to sell its similar looking “Magic Glow” pads in 1989,<sup>47</sup> Jacobson was a junior user.<sup>48</sup> Even though some junior users may be able to use a senior (first) user’s trademark,<sup>49</sup> here, Jacobson was not afforded that benefit since it was using the mark in the same geographic territory as Qualitex, and it had not registered the color mark first.<sup>50</sup>

Qualitex won in district court, but lost on appeal.<sup>51</sup> The United States Supreme Court reversed the circuit court’s decision and found that “[t]he green-gold color acts as a symbol[,] [h]aving developed secondary meaning [since] customers identified the green-gold color as Qualitex’s[], . . . [a]nd, the green-gold color serves no other function.”<sup>52</sup> Jacobson argued that various court precedents supported its position, that there was a potential for shade confusion and color depletion, and that color alone does not need trademark protection because it is already protected as a type of trade dress.<sup>53</sup> However, the Court explicitly rejected all of Jacobson’s arguments against the protection and registration of color alone as a trademark.<sup>54</sup>

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<sup>46</sup> *Qualitex*, 514 U.S. at 161.

<sup>47</sup> *Qualitex*, 1991 WL 318798, at \*1, \*3.

<sup>48</sup> See 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 26:1 (4th ed. 2010) (citation omitted). A junior user can be described as “[a] person other than the first person to use a trademark.” BLACK’S LAW DICTIONARY 925 (9th ed. 2009). “A junior user may be permitted to continue using a mark in areas where the senior user’s mark is not used, if the junior user did not know about the other user, and was the first user to register the mark.” *Id.*

<sup>49</sup> See e.g., 5 MCCARTHY, *supra* note 48, § 26:1. A senior user can be described as “[t]he first person to use a mark . . . [t]hat person is usually found to be the mark’s owner.” BLACK’S LAW DICTIONARY, *supra* note 48, at 1484.

<sup>50</sup> *Qualitex*, 1991 WL 318798, at \*1, \*3.

<sup>51</sup> *Qualitex*, 514 U.S. at 161.

<sup>52</sup> *Id.* at 166.

<sup>53</sup> *Id.* at 166-68, 170-71, 173. Trade dress “ ‘involves the total image of a product and may include features such as size, shape, color, or color combinations, texture, graphics, or even particular sales techniques.’ ” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). See also BLACK’S LAW DICTIONARY, *supra* note 48, at 1630 (stating that trade dress can be described as “[t]he overall appearance and image in the marketplace of a product or a commercial enterprise . . . . If a trade dress is distinctive and nonfunctional, it may be protected under trademark law.”)

<sup>54</sup> *Qualitex*, 514 U.S. at 166-67.

In reaching its conclusion, the Court stated that “[t]he Lanham Act gives a seller . . . the exclusive right to ‘register’ a trademark, [under] 15 U.S.C. § 1052 . . . and to prevent his or her competitors from using that trademark . . . .”<sup>55</sup> Resting on “[b]oth the language of the Act and the basic underlying principles of trademark law, . . . [the Court decided that color fell] within the universe of things that can qualify as a trademark.”<sup>56</sup> Since the Court believed that the language of the Lanham Act was extremely broad, and since a person “might use . . . anything . . . that is capable of carrying meaning [to represent his mark], this language . . . [was] not restrictive.”<sup>57</sup>

Further, the Court found that color may fit within the meaning of ‘symbol’ or ‘device,’ as defined in the Lanham Act.<sup>58</sup> Therefore, the Court stated that color can satisfy the statutory trademark requirement “that a person ‘us[e]’ or ‘inten[d] to use’ the mark ‘to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.’”<sup>59</sup>

By stating that “a product’s color is unlike [those marks which are] ‘fanciful,’ ‘arbitrary,’ or ‘suggestive,’ ” the Court essentially stated that color is capable of trademark recognition, but only as a descriptive mark.<sup>60</sup> The Court supported its theory by stating that “over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand.”<sup>61</sup> Accordingly, the Court went on to claim “that color would have come to identify and distinguish the goods—*i.e.*, ‘to indicate’ their ‘source’—much in the way that descriptive words on a product . . . can come to indicate a product’s origin.”<sup>62</sup> Essentially, the Court categorized color as a descriptive mark, and impliedly stated that when a color has achieved a secondary meaning, it “cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark.”<sup>63</sup>

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<sup>55</sup> *Id.* at 162.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> *See id.*

<sup>59</sup> *Qualitex*, 514 U.S. at 162 (quoting 15 U.S.C.A. § 1127).

<sup>60</sup> *Id.* at 162-63.

<sup>61</sup> *Id.* at 163.

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

Additionally, the Court rejected the notion that a color could not serve as a legitimate trademark due to the fact that the color applied to a product occasionally serves a functional purpose.<sup>64</sup> While the Court did not deny that color occasionally serves a functional purpose, it could not disregard “the fact that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality[;] . . . [therefore, the] doctrine of ‘functionality’ does not create an absolute bar to the use of color alone as a mark.”<sup>65</sup> For these reasons, the Court stated that “at least sometimes, [color alone] can meet the basic legal requirements for use as a trademark.”<sup>66</sup>

As previously stated, the *Qualitex* decision did not change the fact that sometimes a color’s only purpose is to decorate or to embellish certain goods and, in such instances, color may not be registered as a trademark.<sup>67</sup> For a color mark to meet trademark standards it must act as the source identifier and the color of the good must form a distinctive look.<sup>68</sup> When a color is used in the simplest of ways, by “adding a colored stripe,” for example, it may be hard to decipher whether it will “be taken by consumers as a form of decoration” or whether the average consumer will recognize that mark to indicate its source.<sup>69</sup> Either way, the courts have made it clear that “adding a colored strip is hardly a distinctive way of marking a product.”<sup>70</sup>

#### IV. TRADEMARK REQUIREMENTS FOR FEDERAL PROTECTION

In the years following *Qualitex*, courts have continued to protect trademarks of color alone when the color mark is distinctive of the applicant’s goods—it has acquired secondary meaning—and is

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<sup>64</sup> *Qualitex*, 514 U.S. at 164. It is well established that functional product features may not be registered. *Id.* at 165 (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

<sup>65</sup> *Id.* at 165 (citation omitted).

<sup>66</sup> *Id.* at 166.

<sup>67</sup> *Am. Basketball Ass’n, v. AMF Voit, Inc.*, 358 F. Supp. 981, 985 (S.D.N.Y. 1973), *aff’d*, 487 F.2d 1393 (2d Cir. 1973), *cert. denied*, 416 U.S. 986 (1974) (citing *Norwich Pharm. Co. v. Sterling Drug, Inc.*, 271 F.2d 569 (2d Cir. 1959)). The *American Basketball Association* (“ABA”) court found that the red, white and blue panels on an otherwise ordinary basketball were decorative, but did not form a distinctive design. *Id.*

<sup>68</sup> *See id.* at 985-86.

<sup>69</sup> *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1363 (7th Cir. 1995) (“[W]e do not hold that Libman’s contrasting-color trademark was insufficiently distinctive to be registrable.”).

<sup>70</sup> *Id.*

nonfunctional.<sup>71</sup>

### A. Distinctiveness

"In trademark law, designations are placed in categories . . . of distinctiveness."<sup>72</sup> For example, while "fanciful," "arbitrary" and "suggestive" marks are considered inherently distinctive because the combination of mark and product is entirely random, descriptive marks are not inherently distinctive because they only describe the goods they represent.<sup>73</sup> Therefore, descriptive marks must "have acquired distinctiveness as a [trade]mark in buyers' minds," which is known as secondary meaning.<sup>74</sup>

"The general rule regarding distinctiveness is clear: a[] . . . mark is distinctive and . . . [will be] protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning."<sup>75</sup> The purpose of distinctiveness is "to insure that a trademark is capable of performing its main function, identifying the source and quality of products or services."<sup>76</sup>

A mark is classified in one of four categories of distinctiveness, depending on its type.<sup>77</sup> The categories are described as "(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."<sup>78</sup> Depending on the distinctiveness of the mark, the mark may be entitled to strong protection<sup>79</sup> or no protection.<sup>80</sup>

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<sup>71</sup> See 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[1].

<sup>72</sup> See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:1 (4th ed. 2010) (citation omitted).

<sup>73</sup> See *id.* § 11:13.

<sup>74</sup> See *id.* § 15:1.

<sup>75</sup> *Id.* § 15:1.50 (citing *Two Pesos, Inc.*, 505 U.S. 763).

<sup>76</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02.

<sup>77</sup> See *id.* § 9.02[2].

<sup>78</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>79</sup> 2 MCCARTHY, *supra* note 72, §§ 11:4-11:5 (citation omitted). A "fanciful" mark is entitled to the strongest form of trademark protection since "[f]anciful marks . . . have been invented or selected for the sole purpose of functioning as a trademark[.]" and "[a]n arbitrary mark consists of a word or symbol that is in common usage in the language, but is arbitrarily applied to the goods or services in . . . such a way that is not descriptive or suggestive." *Id.*

<sup>80</sup> See *Abercrombie*, 537 F.2d at 9 (noting that generic marks may never act to identify the goods of only one seller); see also 2 MCCARTHY, *supra* note 72, § 12:1.

### 1. *Generic*

Inherently distinctive marks “are . . . capable of functioning immediately upon use as a . . . ‘trademark.’”<sup>81</sup> For this reason, “suggestive,” “arbitrary,” and “fanciful” marks are given legal protection immediately upon use, since these kinds of marks “have [presumably] achieved consumer recognition.”<sup>82</sup> Registration of descriptive marks, on the other hand, requires that an applicant prove that its designation has acquired distinctiveness in the minds of the consuming public.<sup>83</sup> But generic marks are unlike the other categories of marks in that generic marks merely identify the product itself—as opposed to the producer of the product—and cannot, therefore, be registered, even upon a showing of secondary meaning.<sup>84</sup>

### 2. *Descriptive*

“Marks [that fall with]in this category actually describe the nature, quality, characteristics, [or] ingredients . . . of products or services.”<sup>85</sup> Though the law will afford descriptive marks protection once it is shown that the mark has acquired distinctiveness, the law does not give descriptive marks automatic protection.<sup>86</sup> These marks are not automatically protected “[b]ecause competitors may have a legitimate need to use descriptive marks to identify or describe their own products.”<sup>87</sup>

Therefore, descriptive marks are afforded protection under the Lanham Act when they possess the ability to acquire distinctiveness over time—the process otherwise known as “secondary meaning.”<sup>88</sup> Designations that are considered to be “more descriptive and the less inherently distinctive” require more—and better—“evidence of secondary meaning to prove that level of distinctiveness necessary to achieve trademark . . . status.”<sup>89</sup>

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<sup>81</sup> 2 MCCARTHY, *supra* note 72, § 15:1.50.

<sup>82</sup> *Id.*

<sup>83</sup> *See id.*

<sup>84</sup> *See, e.g., Park ‘N Fly*, 469 U.S. at 194.

<sup>85</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[2][c].

<sup>86</sup> *See id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> 2 MCCARTHY, *supra* note 72, § 15.1 (citation omitted). *But see Two Pesos*, 505 U.S. at

In 2000, the United States Supreme Court specifically stated that color marks can never be inherently distinctive.<sup>90</sup> Though the *Wal-Mart* case technically dealt with trade dress infringement,<sup>91</sup> the Court expressly stated “that a color *could* be protected as a trademark” once it has achieved a secondary meaning.<sup>92</sup> The Court again analogized color marks to word marks, and seemed to conclude that color is like a descriptive mark in that it may ultimately be able to indicate a product’s source, but color “does not ‘ . . . automatically tell a customer that [it] refer[s] to a brand . . . .’ ”<sup>93</sup> Because the connection between the product and the mark is almost one and the same with descriptive marks, such marks are incapable of inherent distinctiveness, but are nonetheless able to be trademarked upon acquiring secondary meaning.<sup>94</sup>

### 3. *Suggestive*

Unlike descriptive marks, “[s]uggestive marks . . . suggest, but do not actually describe, the nature, quality, characteristics, or ingredients of the products . . . with which they are used.”<sup>95</sup> Though descriptive and suggestive marks appear similar, a suggestive mark “requires imagination, thought and perception” in order to understand its meaning, while a descriptive mark conveys product information directly and immediately.<sup>96</sup> For this reason, the Lanham Act allows a suggestive mark to “be registered without special proof of distinc-

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776 (stating that trade dress is inherently distinctive); *Wal-Mart*, 529 U.S. at 215 (finding that although *Two Pesos* established that “trade dress [is] inherently distinctive . . . it does not establish that product-design trade dress can be”) (emphasis omitted).

<sup>90</sup> See *supra* note 9 and accompanying text.

<sup>91</sup> *Wal-Mart*, 529 U.S. at 209-10 (stating that trade dress is a “category that originally included only the packaging . . . of a product, but . . . has been expanded by many Courts of Appeals to encompass the design of a product”).

<sup>92</sup> *Id.* at 212 (emphasis added).

<sup>93</sup> *Id.* (quoting *Qualitex*, 514 U.S. at 162-63) (emphasis omitted).

<sup>94</sup> See, e.g., Daniel A. Tysver, *Strength of Trademarks*, BITLAW, <http://www.bitlaw.com/trademark/degrees.html#descriptive> (last visited Mar. 17, 2010) (“[D]escriptive marks are often difficult to distinguish from suggestive marks. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination . . . .”).

<sup>95</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[2][b].

<sup>96</sup> *Abercrombie*, 537 F.2d at 11 (citation omitted). See also *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 73-75 (2d Cir. 1988).

tiveness.”<sup>97</sup>

#### 4. *Arbitrary or Fanciful*

Arbitrary and fanciful marks “may [also] be registered without special proof of distinctiveness.”<sup>98</sup> These marks are inherently distinctive because “they convey nothing about the product or service,” and there is no connection between the mark and the underlying product.<sup>99</sup>

#### B. The Doctrine of Secondary Meaning

Professor McCarthy recognized that the “doctrine of secondary meaning is the law’s recognition of the psychological effect of trade symbols upon the buyer’s mind.”<sup>100</sup> In fact, the primary importance “of secondary meaning is [the] *mental association* . . . between the alleged mark and a single source of the product.”<sup>101</sup> Simply put, secondary meaning is some “new meaning added second in time to the original primary meaning of the designation.”<sup>102</sup> In order for a mark to generate a second meaning, customers must associate the mark with “a single commercial source.”<sup>103</sup>

When a mark “is *not* inherently distinctive, it can [only] be registered or protected as a [trade]mark [provided] . . . *it has become distinctive*.”<sup>104</sup> In other words, “[w]ithout achieving distinctiveness through secondary meaning, a noninherently distinctive designation, [i.e. a descriptive mark] does not have the legal status of a ‘trade-mark.’ ”<sup>105</sup>

The federal courts and the TTAB continue to follow *Wal-Mart*, and maintain that color can never be inherently distinctive,<sup>106</sup> and refuse to entertain an argument that color is not descriptive, but

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<sup>97</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[2][b].

<sup>98</sup> *Id.* §§ 9.02[2][a]-[2][b].

<sup>99</sup> *Id.* § 9.02[2][a].

<sup>100</sup> 2 MCCARTHY, *supra* note 72, § 15:5.

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* § 15:1.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.* § 15:1.50.

<sup>105</sup> 2 MCCARTHY, *supra* note 72, § 15:1 (noting that “[t]he term ‘distinctive’ has a special meaning in trademark law. If a designation is not ‘distinctive,’ it is not a ‘mark.’ ”)

<sup>106</sup> *See, e.g., Wal-Mart*, 529 U.S. at 211.

rather, inherently distinctive.<sup>107</sup> Therefore, in order for trademark law to protect a manufacturer's color indicator, a user must prove its color mark has acquired distinctiveness "as a matter of law," as opposed to just "in the marketplace."<sup>108</sup>

Proving secondary meaning depends greatly on the facts presented in a given case. Because "secondary meaning is customer identification of a trademark as an indicator of source, i.e., a brand,"<sup>109</sup> a trademark "applicant may submit any 'appropriate evidence tending to show that the mark distinguishes [applicant's] goods' "<sup>110</sup> in order to help courts determine whether a mark has acquired distinctiveness.

The federal courts and the TTAB examine all the direct and circumstantial evidence submitted by an applicant to determine whether the applicant's color mark has developed a secondary meaning.<sup>111</sup> Since each case is different, a federal court or the TTAB generally considers only the evidence an applicant presents and makes its decision accordingly. As a general rule though, applicants that wish to protect a "less distinctive" designation, i.e. color marks, must present the federal courts and the TTAB with a "greater . . . quantity and quality of evidence."<sup>112</sup> This evidence includes, but is not limited to (1) customer surveys; (2) extent of sales and advertising expenditures; (3) advertisements and promotional materials; and (4) length and exclusivity of use.<sup>113</sup>

### 1. *Direct Evidence*

Consumer surveys may be considered the most useful evidence an applicant can provide the TTAB or federal court judges

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<sup>107</sup> See *H & H Indus. v. LTG, Ltd.*, No. 92042050, 2008 WL 853845, at \*4 (T.T.A.B. Jan. 11 2008) (explicitly pointing out that "respondent's contentions regarding the inherent distinctiveness of its asserted mark will be given no consideration.").

<sup>108</sup> *Johnson & Johnson v. Actavis Group HF*, No. 06-Civ. 8209(DLC), 2008 WL 228061, at \*2 (S.D.N.Y. Feb. 21, 2008).

<sup>109</sup> 2 DRATLER & MCJOHN, *supra* note 17, § 9.02[3][d].

<sup>110</sup> *Royal Appliance*, 2000 WL 713972, at \*6.

<sup>111</sup> 2 MCCARTHY, *supra* note 72, § 15:30.

<sup>112</sup> *Id.* § 15:28; see also *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, No. 96,404, 1998 WL 998958, at \*16 (T.T.A.B. Sept. 11, 1998) (acknowledging "that the greater the degree of descriptiveness which a design possesses, the heavier is a party's burden of proving that such a design has in fact become distinctive of the goods with which it is associated").

<sup>113</sup> See, e.g., 2 MCCARTHY, *supra* note 72, § 15:30.

since “the chief inquiry [in trademark law] is the attitude of the consumer toward the mark,” meaning, whether or not the consumer identifies a mark with a specific producer.<sup>114</sup> When available, federal courts and the TTAB are greatly influenced by professionally conducted consumer surveys.<sup>115</sup> Even though customer survey evidence is not essential to the determination of whether a mark has acquired distinctiveness, it “ ‘is the most direct and persuasive way of establishing secondary meaning.’ ”<sup>116</sup>

Although customer surveys are given considerable weight by the TTAB and federal courts, they are less likely to afford “substantial weight” to such surveys where the survey “ ‘universe’ . . . [is] too narrow.”<sup>117</sup> In *American Basketball Association v. AMF Voit, Inc.*, the court considered a pilot survey, conducted by plaintiff, the American Basketball Association (“ABA”), inadequate since the survey was performed on “males . . . ages . . . 12[-]23 . . . who had played basketball within the last year,” instead of individuals “who would actually purchase [their red, white and blue colored] basketballs.”<sup>118</sup> The court was further dissatisfied with the survey because it “showed that at best, only 61 percent of the persons surveyed associated the red, white and blue basketball with the ABA.”<sup>119</sup> The court held that plaintiff’s survey did not “entitle[] [it] to the protection of a trademark,” since the purpose of a trademark is for the ordinary person to identify the mark with the source of the goods.<sup>120</sup>

To further understand the importance of direct evidence, it is

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<sup>114</sup> Sec. Ctr., Ltd. v. First Nat’l Sec. Ctrs., 750 F.2d 1295, 1301 (5th Cir. 1985) (citation omitted).

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* (quoting *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983)).

<sup>117</sup> *Am. Basketball Ass’n*, 358 F. Supp. at 986 (citations omitted).

<sup>118</sup> *Id.* (noting that the simple fact that “[n]o attempt was made to contact those who would actually purchase basketballs [was reason enough to] find the ‘universe’ to be too narrow”) (emphasis added); compare with RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (1995) (“[S]econdary meaning . . . [has been achieved in the minds of a] ‘substantial number of present or prospective customers.’ ”) (citation omitted).

<sup>119</sup> *Am. Basketball Ass’n*, 358 F. Supp. at 986 (noting that although it might appear to some onlookers that 61% of the people asked associated the red, white and blue colored basketball with the ABA, the court appeared dissatisfied with the 61% association because “[w]hen considered with the control group which showed a 18% ‘guess’ factor, it . . . appear[ed] that approximately 42% of the people interviewed knowingly associated the ABA with the red, white and blue basketball.”).

<sup>120</sup> *Id.* at 986-87.

helpful to consider the “mall intercept survey” submitted by the applicant in *White Consolidated Industries, Inc. v. Royal Appliance Manufacturing Co.*<sup>121</sup> In *Royal Appliance*, the applicant submitted a survey, which was performed on visitors to a Chicago mall, who were “screened for either the recent purchase of a hand-held vacuum cleaner or the intention to purchase a hand-held vacuum cleaner within the next year.”<sup>122</sup> Ultimately, 480 people participated in the study,<sup>123</sup> and the results indicated “that consumers are more likely to associate the color red with Dirt Devil vacuum cleaners than . . . with other brands or manufacturers of hand-held vacuum cleaners.”<sup>124</sup>

Although mall intercept surveys, similar to pilot surveys, do not extend to the entire population, the TTAB reasoned that it has repeatedly found “shopping mall surveys . . . to be sufficiently reliable” at proving acquired distinctiveness.<sup>125</sup> Mall intercept surveys are sufficient since secondary meaning “need not be proven among the *general* public if a product is targeted at only a specific segment of the general public.”<sup>126</sup> Since the applicant submitted evidence which showed “that purchasers associate the color red . . . for hand-held vacuum cleaners with applicant,” the surveys served as a particularly useful piece of evidence.<sup>127</sup>

## 2. *Indirect (Circumstantial) Evidence*

While direct evidence is the most useful type of evidence an applicant can supply to persuade the federal courts or the TTAB that the consuming public associates its color mark with its brand, indirect evidence alone is entirely capable of proving acquired distinctiveness.<sup>128</sup> Of course, the courts will consider the combination of direct and indirect evidence, when available.<sup>129</sup> Because the cost of profes-

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<sup>121</sup> *Royal Appliance*, 2000 WL 713972, at \*6.

<sup>122</sup> *Id.*

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at \*7.

<sup>125</sup> *Id.* See also *Miles Labs., Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1458, 1986 WL 83319 (T.T.A.B. Dec. 2 1986).

<sup>126</sup> 2 MCCARTHY, *supra* note 72, § 15:46.

<sup>127</sup> *Royal Appliance*, 2000 WL 713972, at \*6.

<sup>128</sup> 2 MCCARTHY, *supra* note 72, § 15:48.

<sup>129</sup> *Royal Appliance*, 2000 WL 713972, at \*11 (“[T]he evidence in its entirety establishes that red . . . has acquired distinctiveness as applicant’s mark for hand-held vacuum cleaners.”).

sionally conducted customer surveys are quite steep, the federal courts and the TTAB typically receive only indirect evidence.<sup>130</sup>

**a.      Extent of Sales and Advertising Expenditures**

“Public association of a . . . [mark] with a certain source . . . is most often achieved through the dual channels of actual sales and advertising.”<sup>131</sup> Federal courts and the TTAB admit that while sales figures may be taken into consideration by the courts and the TTAB when deciding whether a designation has acquired distinctiveness, sales figures alone typically have very little, if anything, to do with the power of the mark.<sup>132</sup> Since advertisements are designed to “create a mental association . . . in the minds of . . . [both consumers who have, and] who have never actually purchased . . . [a particular] product,”<sup>133</sup> federal courts and the TTAB generally demand that “the trademark and the popularity” of the product be proven by additional evidence.<sup>134</sup>

In *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, the TTAB found that “applicant’s, [Interco Tires,] sales figures . . . [merely] demonstrate[d] a growing degree of popularity or commercial success for its tires, but . . . [did] not demonstrate [brand] recognition [of its tire tread among] the purchasing public.”<sup>135</sup> The TTAB explained that “given the high degree of descriptiveness inherent in tire tread designs . . . [it was] not convinced that the purchasing public ha[d] come to view applicant’s three-stage lug configuration as a trademark for its tires.”<sup>136</sup>

Additionally, the federal courts and the TTAB consider “the amount of money [the applicant] spent” on advertising its product.<sup>137</sup>

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<sup>130</sup> 2 MCCARTHY, *supra* note 72, § 15:42.

<sup>131</sup> *Id.* § 15:50.

<sup>132</sup> *Id.* § 15:47.

<sup>133</sup> *Id.* § 15:50.

<sup>134</sup> *Id.* § 15:47 (“To make popularity relevant as evidence, causation between the trademark and the popularity must be proven.”).

<sup>135</sup> *Goodyear Tire*, 1998 WL 998958, at \*16.

<sup>136</sup> *Id.*

<sup>137</sup> 2 MCCARTHY, *supra* note 72, § 15:51. *See also* Field Enters. Educ. Corp. v. Cove Indus. Inc., 297 F. Supp. 989, 993 (E.D.N.Y. 1969); Norsan Prods., Inc. v. R. F. Schuele Corp., 286 F. Supp. 12, 14-15 (E.D. Wis. 1968); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 141 (C.C.P.A. 1954).

Although the federal courts and the TTAB state that the amount of money an applicant spends on advertisements is relevant to the inquiry, “the mere expenditure of money is not . . . determinative of the actual result in buyers’ minds.”<sup>138</sup> The federal courts and the TTAB reason that certain advertisements resonate in prospective consumers more than others, and therefore, “evidence . . . of extensive advertising” alone will be insufficient to prove acquired distinctiveness of the mark.<sup>139</sup>

Finally, while federal courts and the TTAB consider indirect evidence of sales and advertising figures applicable to their analysis, they generally prefer more direct evidence.<sup>140</sup> For example, in *H & H Industries, Inc. v. LTG, Ltd.*, the TTAB seemed to indicate that LTG’s moderate advertising expenditures and total sales would have weighed heavier in its analysis had LTG presented it with more “direct evidence [proving] that relevant consumers view the color gold on end caps as a distinctive source indicator for applicant’s fluorescent lighting products.”<sup>141</sup> Therefore, it seems that the federal courts and the TTAB prefer to examine product sales and advertising costs in the shadow of direct evidence, i.e. consumer surveys.

#### **b. Advertisements and Promotional Materials**

In addition to product sales and advertising costs, the federal courts and the TTAB consider promotional efforts and advertising as proof of acquired distinctiveness.<sup>142</sup> The federal courts and the TTAB require that these advertisements promote the color itself “so that consumers [can] make the required association between the color trademark and the source of those goods.”<sup>143</sup> Unfortunately for some users, the federal courts and the TTAB will find those advertisements insufficient where the color mark seeking protection does not take center stage.

For example, in *Johnson & Johnson v. Actavis Group HF*,<sup>144</sup>

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<sup>138</sup> 2 MCCARTHY, *supra* note 72, § 15:51.

<sup>139</sup> *See id.* (citations omitted).

<sup>140</sup> *See H & H Indus.*, 2008 WL 853845, at \*8.

<sup>141</sup> *Id.* at \*6, \*8.

<sup>142</sup> *See* 2 MCCARTHY, *supra* note 72, § 15:30 (citation omitted).

<sup>143</sup> James L. Vana, *Color Trademarks*, 7 TEX. INTELL. PROP. L.J. 387, 400-01 (1999).

<sup>144</sup> No. 06 Civ. 8209(DLC), 2008 WL 228061, at \*1 (S.D.N.Y. Jan. 25, 2008).

plaintiff Johnson & Johnson sold antibiotic ointment in a gold/yellow colored box.<sup>145</sup> Johnson & Johnson brought an infringement action in federal district court alleging that Actavis was infringing on its “Gold Mark” by using the same color on its own antibiotic ointment.<sup>146</sup> Although Johnson & Johnson had not registered its “Gold Mark,” it claimed that the gold color “ha[d] acquired secondary meaning and [wa]s entitled to protection” under the Lanham Act.<sup>147</sup> The court considered the advertising materials submitted by Johnson & Johnson, but concluded that the advertisements “do[] not always emphasize or even include the Gold Mark.”<sup>148</sup> Therefore, while “advertising need not explicitly direct the consumer’s attention to the mark[,]”<sup>149</sup> . . . [the court stated that] advertisements are only relevant . . . to the extent they feature the . . . [m]ark and . . . serve to link the . . . brand with the gold/yellow . . . color.”<sup>150</sup>

It is clear from opinions like *Johnson & Johnson* “that even highly substantial advertising and promotional expenditures . . . are not sufficient to support a finding of acquired distinctiveness.”<sup>151</sup> The federal courts and the TTAB will only find advertisements and promotional materials sufficient when “[t]he color is . . . [a] prominent[] feature[] in virtually every advertisement,” so that the color mark is likely to “reinforce[] the association of the . . . color with” the source to the consumer.<sup>152</sup>

For a better understanding of the TTAB’s decision in *Johnson & Johnson*, it is helpful to compare it to the decision reached in *Royal Appliance*. The TTAB in *Royal Appliance*, unlike in *Johnson & Johnson*, was satisfied with the amount of evidence presented by the applicant, with regard to its total sales and advertising, since almost all of applicant’s advertisements regarding the Dirt Devil vacuum

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<sup>145</sup> *Id.*

<sup>146</sup> *Id.*

<sup>147</sup> *Id.*

<sup>148</sup> *Id.* at \*2.

<sup>149</sup> *But see Royal Appliance*, 2000 WL 713972, at \*11 (finding that advertisements are more likely to persuade when “a significant number of advertisements specifically call attention to the . . . color of the product”).

<sup>150</sup> *Johnson & Johnson*, 2008 WL 228061, at \*2.

<sup>151</sup> *H & H Indus.*, 2008 WL 853845, at \*6 (citations omitted).

<sup>152</sup> *Royal Appliance*, 2000 WL 713972, at \*11 (describing that the applicant advertised extensively, including advertisements on national television, and also in nationally distributed consumer magazines and trade journals).

cleaner featured the color red.<sup>153</sup> Additionally, since sales of the red hand-held vacuum cleaners were strong,<sup>154</sup> the TTAB was convinced that the applicant's evidence was capable of proving, and did in fact prove, that its red mark had acquired distinctiveness.<sup>155</sup> For those reasons, the TTAB was satisfied that the applicant successfully demonstrated "that purchasers associate the color red . . . for hand-held vacuum cleaners with applicant."<sup>156</sup>

From these and similar cases, it appears that advertising is only indicative of acquired distinctiveness when it successfully "alter[s] the meaning of [the trademark] . . . [in the minds of] the consuming public."<sup>157</sup> However, it is important to note that the federal courts and the TTAB tend to actually consider advertisements projected towards customers directly; "catalogs, newsletters and holiday cards sent to its sales representatives"<sup>158</sup> do not demonstrate acquired distinctiveness since such sales pitches are conducted internally and not considered trademark use.<sup>159</sup>

Finally, the federal courts and the TTAB consider "the amount of money [the applicant] spent" on promotional materials and advertising.<sup>160</sup> Clearly, the amount of money an applicant spends on advertisements is relevant to the inquiry, but "the mere expenditure of money is not . . . determinative of the actual result in buyers' minds."<sup>161</sup> The federal courts and the TTAB reason that certain advertisements resonate with prospective consumers more than others, and therefore, "evidence . . . of extensive advertising" alone will be insufficient evidence to prove acquired distinctiveness of the mark.<sup>162</sup>

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<sup>153</sup> *Id.*

<sup>154</sup> *Id.* at \*10 ("Sales of red hand-held vacuum cleaners . . . approached \$400 million with nearly 12 million red hand-held vacuum cleaners sold.").

<sup>155</sup> *Id.* at \*6.

<sup>156</sup> *Id.*

<sup>157</sup> *Sec. Ctr., Ltd.*, 750 F.2d at 1301 (quoting *Aloe Crème Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970), *cert. denied*, 398 U.S. 928 (1970)) (internal quotation marks omitted).

<sup>158</sup> *H & H Indus.*, 2008 WL 853845, at \*6.

<sup>159</sup> *Id.* See also *Royal Appliance*, 2000 WL 713972, at \*10 (acknowledging that "spen[d]ing over \$35 million in television advertisements" was sufficient).

<sup>160</sup> 2 MCCARTHY, *supra* note 72, § 15:51.

<sup>161</sup> *Id.*

<sup>162</sup> See *id.* (citation omitted).

### c. Length and Exclusivity of Use

Since different marks achieve acquired distinctiveness at different stages of their existence, the law does not give an exact number of days, months, or years necessary to acquire distinctiveness.<sup>163</sup> However, it seems clear that courts take a similar view to that offered under “Section 2(f) of the Lanham Act, [which provides] that substantially exclusive use of the mark for five years immediately preceding the filing of an application for registration may be considered *prima facie* evidence of distinctiveness.”<sup>164</sup> Since descriptive designations, like color, “are less likely to be perceived as trademarks and more likely to be useful to competing sellers than . . . less descriptive terms,”<sup>165</sup> the federal courts and the TTAB look more favorably upon longer lengths of use.<sup>166</sup>

### C. The Doctrine of Functionality

Color marks deemed to be “essential to the use or purpose of the article or . . . [that] affect[] the cost or quality of the article,” may not be registered.<sup>167</sup> Furthermore, “[n]o mark is entitled to protection if a company’s competitors must be able to use [it] in order to effectively communicate information regarding their products to consumers.”<sup>168</sup> These declarations of descriptions, also known as the doctrine of functionality, prohibit registration and protection of a mark that consists of “purely functional features.”<sup>169</sup> For instance, “[a] color that performs some utilitarian function in connection with a product cannot be appropriated as a trademark.”<sup>170</sup> Additionally,

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<sup>163</sup> See *id.* § 15:55 (“There is no legal rule that states the minimum amount of time necessary to achieve secondary meaning.”).

<sup>164</sup> Vana, *supra* note 143, at 399 (citation omitted) (indicating that the TTAB favors longer durations).

<sup>165</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e.

<sup>166</sup> Vana, *supra* note 143, at 399-400 (“[T]wenty-nine years of . . . use weighed in favor of [Owens-Corning proving] secondary meaning, . . . [and so] did the thirty year use by Qualitex . . .”) (citations omitted).

<sup>167</sup> *Inwood Labs.*, 456 U.S. at 850 n.10 (citation omitted).

<sup>168</sup> *Johnson & Johnson*, 2008 WL 228061, at \*3 (citation omitted) (internal quotation marks omitted).

<sup>169</sup> See, e.g., Boulware, *supra* note 14, at \*2.

<sup>170</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:49 (4th ed. 2010).

when a producer uses a color to indicate a particular flavor, which is typically the case with ice cream<sup>171</sup> and candy,<sup>172</sup> the federal courts have denied trademark protection for the color used.

### 1. *Utilitarian Functionality*

While non-functional features of a product can qualify for trademark protection, useful features cannot.<sup>173</sup> Understanding this distinction is important because the federal courts and the TTAB want to “prevent[] trademark law[] . . . from . . . inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>174</sup> Therefore, if a federal court or the TTAB finds that exclusive use of a product feature by one manufacturer “ ‘would put competitors at a significant . . . disadvantage,’ ” the feature is functional and not deserving of protection.<sup>175</sup> However, the inquiry should not focus on overall usefulness of the product,<sup>176</sup> but on whether the color mark, when applied to a particular product, is so useful that protection would hinder a competitor’s ability to produce the same item.<sup>177</sup>

For instance, in *Dap Products, Inc. v. Color Tile Manufacturing, Inc.*, a federal court decided that even though plaintiff Dap Products’s red 3½ gallon buckets contained functional features, such as “reinforcement ridges near the lip [and] the handle,” the color red was nonfunctional, and could be protected.<sup>178</sup> The court reasoned that “the bucket[’s color was] not essential to the use or purpose of” plaintiff’s tile cement contained within the bucket, and that it did not

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<sup>171</sup> *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203-04 (11th Cir. 2004) (“The district court took judicial notice of the fact that [pink signifies strawberry, white indicates vanilla and brown indicates chocolate].”).

<sup>172</sup> *Life Savers Corp. v. Curtiss Candy Co.*, 182 F.2d 4, 7 (7th Cir. 1950) (holding colors printed on the package to be functional because they indicate the flavor of the candy enclosed therein).

<sup>173</sup> See Boulware, *supra* note 14, at \*4.

<sup>174</sup> *Qualitex*, 514 U.S. at 164.

<sup>175</sup> *Royal Appliance*, 2000 WL 713972, at \*4 (quoting *Qualitex*, 514 U.S. at 165). In *Royal Appliance*, the Board noted that “[s]ome vague expectation that . . . red might [someday] become ‘popular’ ” is insufficient to show “a ‘significant’ competitive disadvantage.” *Id.* at \*5. Likewise, the Board further recognized that “while . . . red may be a desirable or popular color for products in general,” when it comes to hand-held vacuum cleaners, the color “red . . . offers [no] significant competitive advantage.” *Id.*

<sup>176</sup> 1 MCCARTHY, *supra* note 170, § 7:70.

<sup>177</sup> See *id.*

<sup>178</sup> 821 F. Supp. 488, 493 n.1 (S.D. Ohio 1993).

“affect the cost or quality of” its cement.<sup>179</sup> The court further based its decision to enjoin defendant’s use of red buckets on defendant’s sale of cement “in other types and colors of buckets.”<sup>180</sup> Finally, the court concluded that since white and black buckets cost defendant less to buy than the red buckets, using red buckets to sell its cement did “not [increase] the cost or quality of the [product] itself.”<sup>181</sup>

## 2. *Aesthetic Functionality*

The doctrine of aesthetic functionality prevents color marks from being registered when “there is a competitive need for . . . certain” colors to remain available in a given industry.<sup>182</sup> Proponents of aesthetic functionality reason that color features do not typically make a certain product perform better, but may still be considered functional if the use of a specific color provides a real and significant competitive advantage to one competitor over another.<sup>183</sup>

While the doctrine of aesthetic functionality has been used to keep certain colors available in a number of industries, the recent trend in trademark protection “reject[s] the doctrine of aesthetic functionality.”<sup>184</sup> Opponents of the doctrine suggest that banning the protection of aesthetically pleasing marks would only punish manufacturers who take the time to create original and attractive marks to signify their brand.<sup>185</sup>

Many federal courts and the TTAB appear to reject the doctrine and frequently suggest that just because a color or combination of colors may be “visual[ly] pleasing” when applied to . . . [certain goods, that] does not mean that the color . . . is . . . functional when applied to those goods.”<sup>186</sup> Even the *Trademark Manual of Examin-*

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<sup>179</sup> *Id.* at 493.

<sup>180</sup> *Id.* (indicating that the defendant’s cement could have been bought in red, white, or black buckets).

<sup>181</sup> *Id.*

<sup>182</sup> Boulware, *supra* note 14, at \*5.

<sup>183</sup> *Royal Appliance*, 2000 WL 713972, at \*4.

<sup>184</sup> See Christopher C. Larkin, *Qualitex Revisited*, 94 TRADEMARK REP. 1017, 1034 (2004); 1 MCCARTHY, *supra* note 170, § 7:80.

<sup>185</sup> 1 MCCARTHY, *supra* note 170, § 7:80 (citing *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J. concurring)).

<sup>186</sup> *Royal Appliance*, 2000 WL 713972, at \*4. See also *In re Hudson News Co.*, 39 U.S.P.Q.2d 1915, 1919 (T.T.A.B. Aug. 7, 1996) (holding that the color blue was nonfunctional when applied to a newsstand).

*ing Procedure* (“PTO Manual”) indicates that the doctrine of aesthetic functionality may be irrelevant today because colors found to be “purely ornamental . . . will result in an ornamentation refusal under §§ 1, 2 and 45, and a determination that the [color] sought to be registered is functional will result in a functionality refusal under § 2(e)(5).”<sup>187</sup>

With that said, the doctrine of aesthetic functionality has kept a multitude of colors from being registered in connection with certain goods. For example, in *Brunswick Corp. v. British Seagull Ltd.*,<sup>188</sup> and in *Deere & Co. v. Farmhand, Inc.*,<sup>189</sup> federal courts found that the color black, used for outboard engines, and the color green, used on farm equipment, would provide visual advantages and could not be protected.<sup>190</sup> Additionally, Aromatique, the producer of a “pillow-like shape[d]” bag of potpourri, was unable to protect the colors red and green “because such colors are traditionally used for products relating to Christmas,” and were deemed aesthetically functional.<sup>191</sup> Furthermore, the TTAB held that the color coral, when applied to safety earplugs, could not be registered as a trademark since coral is similar to the color orange, which is “the color most often used for high visibility, [and was] clearly [chosen] to make safety checks easier and quicker.”<sup>192</sup> Finally, in 1996, the TTAB would not allow an

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<sup>187</sup> Trademark Manual of Examining Procedure (“TMEP”) § 1202.02(a)(iii)(C) (4th ed. 2005). See also *First Brands Corp. v. Fred Meyer Inc.*, 809 F.2d 1378, 1381-82 n.3 (9th Cir. 1987) (“[T]he antifreeze packaging industry has a competitive need for the color yellow” because customers respond favorably to yellow and because “some antifreeze sellers select[] a yellow jug because it [forms] the most attractive background for their labels.”); *Union Carbide Corp. v. Fred Meyer, Inc.*, 619 F. Supp. 1028, 1033 (D. Or. 1985); *In re Ferris Corp.*, 59 U.S.P.Q.2d 1587, 1591 (T.T.A.B. Oct. 6, 2000) (stating that “the applied-for color ‘pink’ is one of the best . . . ‘flesh colors’ available for wound dressings[,]” and was therefore denied registration on both the principal and supplemental registers).

<sup>188</sup> 35 F.3d 1527, 1533 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995).

<sup>189</sup> 560 F. Supp. 85, 98, 101 (S.D. Iowa 1982). In 2004, the United States District Court for the Southern District of New York held that Deere could not claim exclusive right to the colors green and yellow since the court considered use of these colors to be functional. *Deere & Co. v. MTD Holdings, Inc.*, No. 00 Civ. 5936(LMM), 2004 WL 324890 (S.D.N.Y. 2004). However, Deere & Company was able to successfully registered the colors green and yellow on the principal register in connection with its agricultural machinery in 2010. See e.g., UNITED STATES PATENT AND TRADEMARK OFFICE, <http://tess2.uspto.gov/bin/gate.exe?f=search&state=4009:f41na.k.1.1>.

<sup>190</sup> *Brunswick*, 35 F.3d at 1533; *Deere & Co.*, 560 F. Supp. at 101.

<sup>191</sup> *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 874 (8th Cir. 1994).

<sup>192</sup> *In re Howard S. Leight & Assocs. Inc.*, 39 U.S.P.Q.2d 1058, 1060 (T.T.A.B. Mar. 22, 1996).

applicant to register the colors yellow and orange, when applied to pay phone booths, as these colors made the “booths more noticeable to the public.”<sup>193</sup>

## V. THE PRESENT STATE OF COLOR TRADEMARK REGISTRATION

Today, a business or individual interested in registering a color mark with the PTO can visit its website, and learn about color applications.<sup>194</sup> The PTO Manual defines a color mark as any “mark[] . . . consist[ing] *solely* of one or more colors used on particular objects.”<sup>195</sup> Furthermore, the PTO explicitly states that color marks “may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods.”<sup>196</sup> Suffice it to say that color marks may take any form which is not specifically rejected by the PTO Manual.

The PTO Manual approves registration of color alone depending on how the proposed mark is used.<sup>197</sup> Accordingly, it appears that some colors will be protected when used on one product, but not protected when used on another. This is because “[a] color[] takes on the characteristics of the object or surface to which it is applied, and the commercial impression of a color will change accordingly.”<sup>198</sup>

Additionally, the PTO demands “that [i]f the mark includes color, the drawing must show the mark in color.”<sup>199</sup> Therefore, the PTO will deny any application which does not show the drawing of the mark in color since color cannot be effectively communicated

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<sup>193</sup> *In re Orange Commc'ns Inc.*, 41 U.S.P.Q.2d 1036, 1042 (T.T.A.B. Oct. 30, 1996).

<sup>194</sup> See *Chapter 1200: Substantive Examination of Applications*, UNITED STATES PATENT AND TRADEMARK OFFICE, [http://tess2.uspto.gov/tmdb/tmep/1200.htm#\\_T120205](http://tess2.uspto.gov/tmdb/tmep/1200.htm#_T120205) (last visited Aug. 7, 2010).

<sup>195</sup> *Id.*

<sup>196</sup> *Id.* (noting that there are examples of color trademarks, such as the color “purple used on a salad bowl, pink used on the handle of a shovel, or a blue background and a pink circle used on all or part of a product package”).

<sup>197</sup> *Id.*

<sup>198</sup> *Id.* (citing *In re Thrifty, Inc.*, 274 F.3d 1349, 1353 (Fed. Cir. 2001) (finding that “a word mark retains its same appearance when used on different objects, but color is not immediately distinguishable as a service mark when used in similar circumstances”).

<sup>199</sup> *In re Peter S. Herrick, P.A.*, 91 U.S.P.Q.2d 1505, 1511 (T.T.A.B. June 10, 2009) (citation omitted) (internal quotation marks omitted) (denying registration for an applicant who claimed color as a feature of the mark, but submitted a black and white drawing).

through words alone.<sup>200</sup> Moreover, the PTO prevents registration of color marks on the principal register without a showing of “acquired distinctiveness . . . under § 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).”<sup>201</sup>

Finally, the PTO Manual makes it clear that “color can function as a mark if it is used in the manner of a trademark . . . and if it is perceived by the purchasing public to identify and distinguish the goods.”<sup>202</sup> Thus, “[i]f a color is not functional and is shown to have acquired distinctiveness on or in connection with the applicant’s goods or services,” the PTO will not deny the color mark registration.<sup>203</sup>

## VI. CONCLUSION

It is easy to lose track of the principal reasons we choose to protect only certain distinguishing marks in commerce. It makes perfect sense for a manufacturer or producer of goods to want to distinguish its goods from the goods of its competitors, and for the government to want to protect the consuming public by helping them make informed purchasing decisions, while at the same time, discouraging the production of inferior quality goods.<sup>204</sup> Unfortunately for users of color marks, the current federal trademark law makes it especially difficult to obtain the very benefits our laws have been invented to protect.

By classifying color marks as designations which will not be deemed inherently distinctive, the United States Supreme Court has placed a heavy burden upon users of color marks that wish to enjoy all of the protections offered by registration on the principal register.<sup>205</sup> In just one sentence, made approximately a decade ago, the Supreme Court essentially mandated that color marks be unquestionably and forever deemed descriptive; incapable of being classified as any other designation, nor as inherently distinctive. As mentioned earlier, even the TTAB, as late as 2008, dismissed a registered owner’s suggestion that its color mark be viewed by the TTAB as inhe-

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<sup>200</sup> UNITED STATES PATENT AND TRADEMARK OFFICE, *supra* note 194, § 1202.05(d).

<sup>201</sup> *Id.* § 1212.

<sup>202</sup> *Id.* § 1202.05.

<sup>203</sup> *Id.*

<sup>204</sup> See *supra* Part II.B.

<sup>205</sup> *Wal-Mart*, 529 U.S. at 211.

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rently distinctive.<sup>206</sup> In that particular instance, the TTAB explicitly stated that the owner's "contentions regarding the inherent distinctiveness of its asserted [color] mark will be given no consideration."<sup>207</sup> This appears to mean that the federal courts and the TTAB will continue to require users of color marks, that wish to enjoy the strong and numerous protections of the principal register, to present satisfactory evidence of the color mark's acquired distinctiveness.

While some scholars anticipated color mark applications would flood the PTO after the Supreme Court decided *Qualitex*, the opposite may be true.<sup>208</sup> One reason may be related to the difficulty of proving to a federal court or the TTAB that a particular color or combination of colors has achieved distinctiveness. The time and resources an applicant must spend to convince the examining attorney, the TTAB, and the federal courts that its mark has acquired secondary meaning, might better be served in other ways.

However, for the producers and individuals who wish to protect their color marks it is important to select a color that: (1) has acquired distinctiveness over many years of use in advertisements and promotions; (2) does not affect the cost or quality of their product so as to inhibit their competitors from producing the same good; and (3) truly has the power to help consumers recognize the brand when they see the color mark.

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<sup>206</sup> *H & H Indus.*, 2008 WL 853845, at \*4.

<sup>207</sup> *Id.*

<sup>208</sup> Boulware, *supra* note 14, at \*5 (citation omitted).

