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TRADEMARK PROTECTION FOR COLOR: BASKING IN THE WARMTH OF "SUN GLOW"

*"[O]ut of all the colors in the spectrum, greenish-gold . . . will be the focus of this high-court clash. 'It's just a putrid color If you saw it, you wouldn't know why anyone would fight over it.'"*¹

INTRODUCTION

In *Qualitex v. Jacobson Products, Co.*² the United States Supreme Court resolved the disagreement among the federal circuits over whether color alone may receive trademark protection.³ The Court ruled that color may receive trademark protection under the Lanham Act,⁴ the law

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1. Paul M. Barrett, *Color in the Court: Can Tints Be Trademarked?*, WALL ST. J., Jan. 5, 1995, at B1, B6. An attorney for Jacobson Products Co. made this remark prior to the Supreme Court's decision in *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995).

2. 115 S. Ct. 1300.

3. *Id.* at 1302. Prior to the passage of the Lanham Act, 15 U.S.C. §§ 1051-1127, the Supreme Court had ruled that trademarks consisting solely of a color are not registerable. *A. Leshen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 171 (1906) (stating "[w]hether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this").

4. 15 U.S.C. §§ 1051-1127 (1988 and Supp. 1993). Section 1052 states in pertinent part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

- (a) Consists of or comprises immoral, deceptive, or scandalous matter
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States
- (c) Consists of or comprises a name, portrait, or signature identifying particular living individual except by his written consent
- (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark of trade name previously used in the United States by another and not abandoned, as to be likely . . . to cause confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person . . . concurrent registrations may be issued
- (e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of

governing federal trademark protection.⁵ Although the Supreme Court's decision in *Qualitex* eliminated a per se rule barring trademark protection for color, significant hurdles await those seeking such protection. Color must meet the traditional trademark requirements including secondary meaning, absence of functionality and non-descriptiveness.⁶ Furthermore, it must overcome those obstacles particular to trademark protection such as shade confusion and color depletion.⁷ A discussion of

them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them . . . (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, or (4) is primarily merely a surname.

- (f) Except as expressly excluded in paragraphs (a), (b), (c), (d), and (e)(3) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

Id. § 1052.

5. 115 S. Ct. at 1302. Under the Lanham Act, 15 U.S.C. §§ 1052-1127 (1988 and Supp. 1993), "[a]ny person who wishes to distinguish his goods from others used in commerce" may obtain trademark protection. *Park 'N Fly, Inc. v. Park & Fly, Inc.*, 489 F. Supp. 422, 424 (D. Mass. 1979). As drafted, the Lanham Act "assumes that the applicant has developed a trademark and states that no trademark may be denied registration except for specific reasons such as fraud, misrepresentation, obscenity, deception or other violations of public policy set forth in the Act." William J. Keating, *Development of Evidence to Support Color-Based Trademarks*, 9 J.L. & COM. 1, 5 (1989) (citing 15 U.S.C. § 1052 (1982 and Supp. 1987)). The Act does, however, prohibit registration if others have attained prior rights to the mark. *Id.* The trademark may consist of "any word, name, symbol, or device or any combination thereof." 15 U.S.C. § 1045 (1988 and Supp. 1993). A mark will receive registration unless it falls into one of the exceptions enumerated in § 1052 of the Lanham Act. *Park 'N Fly*, 489 F. Supp. at 424; 15 U.S.C. § 1052 (a)-(f) (1988 and Supp. 1993). Registration of a trademark creates a rebuttable presumption that the mark is valid and the registrant maintains the right to use the mark exclusively. *Id.* at 424. See 15 U.S.C. §§ 1056-59 for more information on trademark registration, such as certificates of trademark registration, duration of registration, and renewal of registration, §§ 1062-64 for information on examination and publication, and §§ 1066-71 for information on interference and appeals; see also 15 U.S.C. §§ 1112-13 for classification and fees.

6. See *infra* notes 11-79 and accompanying text.

7. See *infra* notes 80-112 and accompanying text.

the case law preceding the *Qualitex* decision is useful in understanding the difficulties facing those seeking trademark protection for color.

Part I of this Comment will examine the disagreement among the federal circuits prior to the Supreme Court's decision, as well as explains the trademark requirements of secondary meaning and absence of functionality. Additionally, the color depletion and shade confusion theories will be explained in this section.⁸ Part II will analyze the *Qualitex* decision of the Ninth Circuit, and its subsequent reversal by the United States Supreme Court.⁹ This Comment will conclude by arguing that acquisition of trademark protection for color will continue to be difficult, despite the Supreme Court's recent ruling in *Qualitex*.¹⁰

I. DISAGREEMENT AMONG THE CIRCUITS

A. Courts Permitting Trademark Protection For Color: The Federal Circuit's Decision in *In re Owens-Corning Fiberglas and the Secondary Meaning Requirement*

A trademark applicant must establish that the color has achieved a "secondary meaning"¹¹ that identifies the goods or services as coming from a particular source in the mind of the consuming public.¹² The United States Patent and Trademark Office [hereinafter "PTO"] places the burden on the applicant to provide evidence demonstrating that the mark is recognized by consumers.¹³

8. See *infra* notes 11-112 and accompanying text.

9. See *infra* notes 113-148 and accompanying text.

10. See *infra* notes 149-161 and accompanying text.

11. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1124 (Fed. Cir. 1985). The court stated that: "Section 2(f) [of the Lanham Act] provides that 'nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce,' codifying the common-law doctrine of secondary meaning." *Id.* (emphasis added).

12. William J. Keating, *Development of Evidence to Support Color-Based Trademarks*, 9 J.L. & COM. 1, 5 (1989) (citing 15 U.S.C. § 1052(f) (1982 and Supp. 1987)). See *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844 (1983). "[T]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Id.* at 851 n. 11 (citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938)).

13. See Keating, *supra* note 12, at 5-6.

Secondary meaning is one of the most heavily weighted requirements for trademarks, as evidenced by *In re Owens-Corning Fiberglas*,¹⁴ where secondary meaning was a central issue. Owens-Corning's application for trademark protection of its pink fiberglass insulation was denied by the PTO's Trial and Appeal Board [hereinafter "the Board"].¹⁵ Though the Board denied registration, it found that "the overall color of goods is capable of functioning as a trademark."¹⁶ The United States Court of Appeals for the Federal Circuit reversed the Board's decision and found that Owens-Corning was entitled to trademark protection for its pink insulation.¹⁷

The Federal Circuit began its analysis by noting that the Lanham Act was intended to modernize trademark law, as well as to "facilitate commerce and to protect the consumer."¹⁸ It stated: "[t]he legislative history of the Act as a whole describes its objective as making registration 'more liberal,' dispensing with 'mere technical prohibitions and arbitrary provisions' and modernizing the trademark statutes 'so that they will conform to legitimate present-day business practice.'"¹⁹

The court determined that the pink fiberglass insulation satisfied all of the traditional trademark requirements. Specifically, the pink color was not utilitarian to the product; however, it had acquired secondary meaning.²⁰ The court concluded that:

OCF's use of the color "pink" performs no non-trademark function, and is consistent with the commercial and public purposes of trademarks. A pink color mark registers for fibrous glass insulation does not confer a "monopoly" or act as a barrier to entry in the market. It serves the classical trademark function of indicating the origin of the goods, and thereby protects the public²¹

In addition, the court rejected the application of the color depletion theory, which if utilized, would constitute "an unreasonable restriction on the acquisition of trademark rights."²² The court found that there was

14. 774 F.2d 1116 (Fed. Cir. 1985).

15. *Id.* at 1118.

16. *Id.*

17. *Id.* at 1128.

18. *Id.* at 1119.

19. *Id.* (quoting *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973)) (footnotes omitted).

20. *Id.*

21. *Id.* at 1123.

22. *Id.* at 1122. The court cited the Lanham Act's legislative history:

Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from another. Trade-marks encourage the maintenance of quality by securing to

"no competitive need . . . for colors to remain available to all competitors."²³ The court further stated that "this theory is not faulted for appropriate application, but following passage of the Lanham Act courts have declined to perpetuate its *per se* prohibition which is in conflict with the liberating purposes of the Act."²⁴

In re Owens-Corning Fiberglas Corp. is illustrative of the heavy burden that must be met by an applicant attempting to establish secondary meaning. The *Owens-Corning* court noted that the Lanham Act was "silent as to the weight of evidence required" to demonstrate secondary meaning under section 2(f).²⁵ However, the court explained that a showing of exclusive use for five years immediately preceding the application for trademark protection may be considered *prima facie* evidence of secondary meaning.²⁶

The *Owens-Corning* court devoted a considerable portion of its opinion to a discussion of the scope and magnitude of the company's advertising. The court noted that the company had spent approximately \$42,421,000 advertising pink insulation to consumers via television, radio, newspapers and magazines from 1972 to 1981.²⁷ It estimated that it had expended "\$11,400,000 in the year 1981 alone."²⁸ Additionally, Owens-Corning submitted its advertising schedule to the Examiner and the Board. The schedule revealed that within a seven month period, Owens-Corning had advertised pink insulation in nearly two hundred blocks of network advertising time during the broadcasting of many major sporting events, such as the World Series, Super Bowl, U.S. Tennis Open and the Rose Bowl.²⁹

The court scrutinized the content of television and radio commercials, articles, promotions to real estate developers and consumer survey in-

the producer the benefit of the good reputation which excellence creates. To protect trademarks, therefore, is to protect the public from deceit, to foster fair competition, and to secure the business community from advantages of reputation and good will by preventing their diversion from those who have created them to those who have not. This is the end to which this bill is directed.

Id. at 1123. (quoting S. REP. NO. 1333, 79th Cong., 2d Sess., pt. 4 (1946)).

23. *Id.*

24. *Id.* at 1120.

25. *Id.* at 1125.

26. *Id.* See 15 U.S.C. § 1052(f), *supra* note 4. The court warned that courts must decide each case upon its individual facts in order to comply with efficient "administrative and judicial implementation of the statute." *Owens-Corning*, 774 F.2d at 1120.

27. *Id.* at 1125.

28. *Id.*

29. *Id.* at 1126.

formation.³⁰ The Board originally held that the evidence submitted did not demonstrate secondary meaning because it had not “establish[ed] that those [survey] respondents associate[d] pink insulation with a single source.”³¹ The Federal Circuit disagreed, and reversed, holding that the Board had placed “an inappropriately heavy evidentiary burden” on Owens-Corning.³² The court found that the company had clearly met the statutory trademark requirements, and therefore, the mark was entitled to obtain protection.³³

Judge Bissel’s ardent dissent in this case set forth four arguments as to why colors should not receive trademark protection. First, Judge Bissel argued that a deviation from the established precedents would potentially have a “divisive effect” on the law.³⁴ Allowing trademark protection for color would create inconsistency among the circuits, encourage forum shopping and defeat the “valuable public interest in consistency and predictability in the law.”³⁵ Second, the judge argued that color currently receives sufficient protection under trademark law when used in conjunction with an arbitrary symbol or design, though that was not true in the case of pink insulation.³⁶ Third, the judge feared that if protection

30. *Id.* at 1126-27. The court described Owens-Corning’s advertising: “[T]wo different commercials aired during this time featured the ‘Pink Panther,’ a pink cartoon character . . . [T]he narration of these commercials discusses how homeowners can cut the cost of [home heating] if they would ‘add another layer of pink.’” *Id.* at 1126. The court further described commercials that depicted “an igloo encased in a ‘pink’ blanket of [plaintiff’s] insulation.” *Id.* Some of the slogans utilized by plaintiff included “Pink of Perfection;” “The Pink Cooler;” “Love that Pink;” “America’s Favorite Pink Product;” “Put your House in the Pink;” “Beat the Cold with Pink;” and “Plant Some Pink Insulation in your Attic.” *Id.* at 1126-27.

31. *Id.* at 1127.

32. *Id.* at 1128.

33. *Id.*

34. *Id.* at 1129 (Bissel, J., dissenting). Judge Bissel stated:

Lawyers have advised clients, clients have conducted their affairs, litigants have won, lost and settled, all in light of the interpretation universally applied by the federal courts. Discarding the established jurisprudence and breaking away from the lines of decisions in the regional circuits will have a divisive effect on the trademark law. To create such a fundamental division in the law is directly contrary to this court’s mandate to bring uniformity to the law and will inevitably invite forum-shopping.

Id.

35. *Id.* (Bissel, J., dissenting).

36. *Id.* at 1129-30 (Bissel, J., dissenting). Judge Bissel explained that, “[u]nfortunately for Owens-Corning . . . [c]olor uniformly applied to a product is *not* a design because it has not been used in connection or combination with or impresses in some definite arbitrary symbol or design.” *Id.* at 1130 (Bissel, J., dissenting) (emphasis in original).

were granted, competitors would be precluded from entering the market, a result which would be at odds with the purpose of trademark law.³⁷ “[t]he ‘property’ in trademark is the right to prevent confusion, not to bar new entrants into the market.”³⁸ Fourth, Judge Bissel cited problems of color confusion.³⁹

In contrast to the majority’s opinion, Judge Bissel agreed with the Board’s determination that Owens-Corning’s product had failed to attain secondary meaning.⁴⁰ Bissel opined that although the company had demonstrated evidence of advertising expenditures, it did not demonstrate “to what extent that advertising has emphasized ‘pink’ as a mark.”⁴¹ Judge Bissel argued that market survey data submitted to the court indicating “that some 50% of male homeowners who responded to the survey question knew the applicant makes insulation that is pink does not establish that those respondents associate pink insulation with a single source,”⁴² and therefore, the data did not establish secondary meaning.

Secondary meaning was also heavily weighted in *DAP Products v. Color Tile*,⁴³ in which a federal district court found that secondary meaning had attached to DAP’s red plastic bucket packaging⁴⁴ for its

37. *Id.* at 1130 (Bissel, J., dissenting).

38. *Id.* (Bissel, J., dissenting).

39. *Id.* at 1131 (Bissel, J., dissenting). “The final reason for the general rule that denies to one the appropriation of a particular color is that infringement actions could soon denigrate into questions of shade confusion.” *Id.* (Bissel, J., dissenting). Thus, actions for the registration and subsequent infringement of colors will be brought over the slightest deviation in the color. Where will the line be drawn? By not allowing such registration, the courts are avoiding the inevitable suits over such trivial matters.

40. *Id.* (Bissel, J., dissenting).

41. *Id.* at 1130 (Bissel, J., dissenting). See *infra* notes 27-33 and accompanying text for detailed discussion of the evidence that was presented regarding Owens-Corning’s advertising and expenditures.

42. *Id.* at 1131 (Bissel, J., dissenting).

43. 821 F. Supp. 488 (S.D. Ohio 1993)

44. *Id.* at 489. In 1978, DAP began to sell an adhesive known as mastic. *Id.* The mastic was originally packaged in various sizes of white or black containers that resembled the generic containers used by other mastic manufacturers. *Id.* Since the 3 1/2 gallon size was the most popular, DAP altered the appearance of the packaging and began to market the mastic in red 3 1/2 gallon buckets. *Id.* The significance of this decision is rooted in the fact that no other mastic product was packaged in a similar red 3 1/2 gallon bucket and DAP “decided to provide a *distinctive appearance* for [the mastic].” *Id.* (emphasis added). In 1990, Color Tile, a competitor, began packaging its mastic in 3 1/2 gallon red buckets that “did not contain any indications of the identity of the manufacturers or the place where the product was manufactured, so consumers would not know whose product was in the red bucket.” *Id.* at 490. By copying DAP’s packaging, Color Tile realized an increase in mastic sales. *Id.*

tile mastic in an action alleging trade dress infringement.⁴⁵ The court found secondary meaning from the intentional copying of DAP's packaging by its competitors because "there is no logical reason for the attempt at copying save an attempt to realize upon secondary meaning that is in existence."⁴⁶

The court explained secondary meaning and stated that:

[t]o acquire secondary meaning in the minds of the buying public, an article of merchandise, when shown to a prospective customer, must prompt the affirmation, 'This is the article I want because I know its source,' and not the negative inquiry as to 'Who makes that article?' In other words, the article must proclaim its identification with its source and not simply stimulate inquiry about it.⁴⁷

B. Courts Denying Trademark Protection for Color: The Functionality Requirement as Applied by the Seventh, Eleventh and Federal Circuits

Many manufacturers have found it difficult to overcome the absence of functionality requirement. The courts seek to prevent the inherent unfairness that would flow from granting trademark protection for a feature that is functional in nature. The Supreme Court stated in *Qualitex* that "a product feature is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."⁴⁸ Granting a monopoly on a functional feature would effectively bar competitors from entering the market.⁴⁹ The following

45. *Id.* at 492. "The term trade dress refers to how a product looks, its total image, or its overall appearance. As such, it includes a product's 'composition and design, including size, shape, color, texture and graphics.'" *Mana Prods., Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 1068 (2nd Cir. 1995) (quoting *Coach Leatherware Co., v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2nd Cir. 1991)).

46. *Id.* at 492. *But see* *Brunswick Corp. v. British Seagull, Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994) (holding that the plaintiff did not show secondary meaning despite its submission of a market survey which demonstrated that 73% of the respondents surveyed made an association between the company and black outboard engines).

47. *DAP Prods.*, 821 F. Supp. at 492 (citations omitted).

48. *Qualitex v. Jacobson Prods., Co.*, 115 S. Ct. 1300, 1304 (1995) (citing *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

49. *Id.* The *Qualitex* court explained the functionality doctrine in the following manner:

[T]o take an imaginary example, that even if customers have come to identify the special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition — not by pro-

factors have been used to determine if a feature is functional: “1) whether a particular design yields a utilitarian advantage, 2) whether alternative designs are available in order to avoid hindering competition, and 3) whether the design achieves economies in manufacturing or use.”⁵⁰

One of the classic cases supporting denial of trademark protection based upon a color’s functionality is *Life Savers v. Curtiss Candy Co.*⁵¹ In that case, the plaintiff, Life Savers Corp., sought a permanent injunction against defendant, Curtiss Candy Co., to stop its use of a label with a multi-colored striped background for its assorted flavored hard-candy discs.⁵² The plaintiff’s action was based upon trademark infringement as well as unfair competition.⁵³ The Seventh Circuit affirmed the district court’s determination that no trademark infringement or unfair competition had been established.⁵⁴ The court found that it was a “general practice of the trade” for hard candy manufacturers to sell their candy in packages with “multi-colored background[s] for their assorted flavored discs, and labels with single-colored background for their packages for their packages containing one flavor of candy discs.”⁵⁵ The court stated that:

[t]he color of the background is in fact descriptive and serves as a ready identification of the flavor of the candy in the package. The use of a combination of colored stripes as a background indicated to the consumer that the package contains an assortment of candy discs or tablets of various colors and flavors.⁵⁶

tecting the reputation of the original bulb maker, but by frustrating competitors’ legitimate efforts to produce an equivalent illumination enhancing bulb.

Id. at 1304.

50. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1121 (Fed. Cir. 1985) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982)).

51. 182 F.2d 4 (7th Cir. 1950).

52. *Id.* at 6.

53. *Id.* at 5. The court described the similarity of the packaging:

Both plaintiff and defendant manufacture and market hard candy discs of various colors and flavors in cylindrical-shaped packages or rolls about 2 3/4 inches in length and 3/4 of an inch in diameter. Each package or roll bears an identifying label and contains eleven candy disks To illustrate: plaintiff and defendant market lime flavored candy discs in wrappers with a green background, lemon flavored discs in wrappers with a yellow background

Id. at 5-6.

54. *Id.* at 9.

55. *Id.* at 7.

56. *Id.*

The court deemed the label “functional” and ruled that preventing the defendants and other candy manufacturers from using striped backgrounds would give the plaintiff a “monopoly” on multi-colored striped backgrounds which were essentially descriptive of the package’s contents.⁵⁷

Comparably, in *Ambrit v. Kraft*,⁵⁸ the Eleventh Circuit held that royal blue, when used to package frozen desserts, was functional and could not be monopolized in a trademark.⁵⁹ “Royal blue is a ‘cool color;’ it is suggestive of coldness and used by a multitude of ice cream and frozen dessert producers.”⁶⁰ Therefore, “any order precluding Kraft from using the color royal blue must be tailored to achieve the goal of protecting the consuming public from confusion,” yet avoid creating a monopoly.⁶¹

Similarly, the court in *Specialty Surgical Instrumentation Inc. v. Phillips*⁶² found that the use of the color gray by the plaintiff, SSI, in its promotional materials was primarily functional, and thus refused to grant protection for its trade dress.⁶³ The color gray was found to be utilitarian because it “serves to make SSI’s catalogs more effective as the color gray highlights the design of the instruments in SSI’s catalogs.”⁶⁴ Had the court provided protection for the color gray in this case, it would have precluded competitors in the surgical instrument industry from their “reasonable right” to use the color gray to highlight their instruments.⁶⁵ In sum, the court found a “competitive need for the color gray in the surgical instruments industry.”⁶⁶

The doctrine of “aesthetic functionality” has also prevented colors from receiving trademark protection in some courts. According to this doctrine, the function of a color lies in its aesthetic appeal, making it more desirable to consumers. This differs from the traditional doctrine of functionality in which the color serves a utilitarian purpose i.e., to communicate a meaning, such as royal blue signals “coolness.”⁶⁷ In

57. *Id.* at 8-9 (stating that “[p]laintiff’s and defendant’s labels lack any similarity in appearance except that the background of each has multi-colored stripes and, as we have seen, this is a functional aspect of each label.”).

58. 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

59. *Id.* at 1548.

60. *Id.*

61. *Id.*

62. 844 F. Supp. 1211 (M.D. Tenn. 1994).

63. *Id.* at 1217-18. *See supra* note 45 for definition of trade dress.

64. *Id.* at 1217 (describing the catalog as having a gray background for photographs and line drawings).

65. *Id.* at 1217-18.

66. *Id.* at 1218.

67. *See supra* notes 58-61 and accompanying text.

Deere & Co. v. Farmhand Inc.,⁶⁸ the court denied trademark protection for the color green due to alleged consumer preferences of color.⁶⁹ Deere sought protection for the shade of green that has become known as "John Deere green"⁷⁰ and an injunction to prevent its competitor from using that or any "confusingly similar" shade of green.⁷¹ The court denied protection on the ground that the color was "aesthetically functional."⁷² The court stated that "the determinative question on the issue of functionality is whether protection against imitation will hinder the competitor in competition . . . [U]nder the doctrine of aesthetic functionality, the inquiry should focus on the extent to which the design feature is related to the utilitarian function of the product or feature."⁷³

The court found that a monopoly on the color "John Deere green" would prevent competitors from offering equipment to the consumers in the color they desired due to its aesthetically pleasing quality.⁷⁴

In *Brunswick Corp. v. British Seagull, Ltd.*,⁷⁵ the Federal Circuit held that a company could not receive registered trademark protection for the color black used on the outboard engines it manufactured.⁷⁶ The court cited the Board's decision to deny protection because black as applied to engines was "de jure" functional.⁷⁷

68. 560 F. Supp. 85 (S.D. Iowa 1982) (holding that Deere's use of the color green was functional within the meaning of the Lanham Act), *aff'd*, 721 F.2d 253 (8th Cir. 1983).

69. *Id.* at 98.

70. *Id.* at 88. Deere & Company [hereinafter "Deere"] is a manufacturer of farm machinery and equipment. *Id.* In the industry, the color was known as "John Deere green." *Id.* Thus, the color itself had become a means of identifying Deere products. *Id.* Furthermore, Deere alleged that Farmhand had designed its front-end loaders in a similar way to Deere's "front-end loader," which "embod[ies] distinctive exterior design features that give the loaders a unique configuration or appearance that serves the purpose of identifying [John Deere products]." *Id.*

71. *Id.* at 96.

72. *Id.* at 98.

73. *Id.* (citing *Keene v. Paraflex Indus., Inc.*, 653 F.2d. 822 (3d Cir. 1981)).

74. *Id.* The court based this conclusion on the fact that farmers like to match their loaders to their tractors. *Id.* The court analogized this preference to that of consumers in *Keene*, which involved lighting fixtures that were designed to match the architecture of a building. *Id.* (citing *Keene v. Paraflex Industries, Inc.*, 653 F.2d. 822 (3d Cir. 1981)). See *contra In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985). The *Owens-Corning* court found that in the case of fibrous glass insulation, which has a "light yellow-white coloring" in its natural state, there was no utilitarian purpose for dyeing fiberglass insulation pink. *Id.* at 1122. In fact, the evidence indicated that Owens-Corning was the only manufacturer to dye its insulation. *Id.*

75. 35 F.3d 1527 (Fed. Cir.), *cert. denied*, 115 S. Ct. 1426 (1994).

76. *Id.* at 1532.

77. *Id.* at 1529.

[B]lack is more desirable from the perspective of prospective purchasers because it is color compatible with a wide variety of boat colors and because objects colored black appear smaller than they do when they are painted either lighter or brighter colors. The evidence shows that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.⁷⁸

The case law is not specific as to what factors should be considered in determining whether a color is "aesthetically functional." Thus, it can be especially difficult to establish that a color is not aesthetically functional.⁷⁹

C. The Third Circuit: The Color Depletion Theory

One of the most serious obstacles facing those seeking trademark protection for color is the color depletion theory, which has been "the most widely used justification for denying trademark rights to colors."⁸⁰ The underlying premise of this theory is the belief that granting trademark protection would eventually "deplete the reservoir" of colors and interfere with the "free availability of colors."⁸¹ Essentially, the argument states that the spectrum features a finite number of colors.

78. *Id.*

79. See Susan Upton Douglass, *Color Me Happy: The Supreme Court Rules On the Trademark Registrability of Color*, 5 J. OF PROPRIETARY RTS. 2, 9-10 (1995). This article offers some practical advice for those seeking trademark protection for a color:

Some colors may be deemed "functional" because they are associated with the category of products: for example, pink is associated with products for little girls, and bright primary colors are associated with toys and sporting equipment. Green signals to consumers that the product is environmentally friendly. It is unlikely that such colors would ever acquire secondary meaning and become source-indicating.

80. *Cooper Indus., Inc. v. Channellock, Inc.*, 778 F. Supp. 873, 876 (W.D. Pa. 1992) (stating that trademark issues are better resolved by a "full hearing before a 'fair minded' jury" rather than by summary judgment "so that a 'reasonable' decision may be made regarding the validity of [the] trademark.").

81. *Id.* In *Qualitex*, 115 S. Ct. 1300, 1304 (1995), the Supreme Court held that the doctrine of functionality would prevent problems such as color depletion because the doctrine would not permit exclusive use of an important product characteristic.

Prior to *Qualitex*, some scholars had opined that the color depletion theory should not act to bar trademark protection for color.

[W]hen a color is nonfunctional for the product, even though the appropriator has a large percentage of the market, a competitor may still viably compete in the market by making his product better and/or cheaper, using a different color of shade, or no color at all. We should not penalize the trademark applicant for is

The Third Circuit's decision in *Campbell Soup Co. v. Armour & Co.*⁸² is illustrative of the denial of trademark protection under the color depletion theory. Campbell Soup sought an injunction against Armour to stop that company's use of a "red and white label used on some of its food products."⁸³ The court found that "[t]he Campbell red is not the same as [Armour's] Carnation red."⁸⁴ Additionally, the court found that Armour's Carnation red "is not the same on all of its products," and "[t]he usual Armour label is white over red instead of red over white, as the plaintiffs use the colors, but in some cases Armour uses the red and white bands vertically."⁸⁵

After deciding that the plaintiffs were seeking the exclusive right to use "half red and half white labels" for food items,⁸⁶ the court stated that such a trademark would allow the plaintiffs a monopoly on all shades of red.⁸⁷ The court reasoned that if it granted the trademark, "the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out."⁸⁸

very success in the marketplace in acquiring secondary meaning. Nor should we confuse the consumer by allowing confusingly similar uses of color on similar products by competitors.

Marc Lieberstein and Susan L. Cohen, *Protecting Color*, N.Y. ST. B.A. INTELL. PROP. LAW NEWSL. (Vol. 2, No. 1) (1993) (citation omitted).

82. 175 F.2d 795 (3d Cir. 1949). One court stated that this case stands for the proposition that "[the fact that] a man cannot acquire a trade-mark by color alone has been stated a good many times in decisions and textbooks." *Life Savers v. Curtiss Candy Co.*, 82 F.2d 4, 9 (7th Cir. 1950).

83. *Campbell Soup Co.*, 175 F.2d at 796.

84. *Id.* at 798.

85. *Id.*

86. *Id.*

87. *Id.*

88. *Id.* The court held that trademark protection cannot be obtained for color alone. *Id.* at 798. The court noted that the company might receive trademark protections in other ways: "In denying the plaintiffs the exclusive use of color alone we are not passing upon the question whether they have acquired trademarks entitled to protection in the sum total of the combinations which make up their respective labels for their goods." *Id.* at 799. See *James Heddon's Sons v. Millsite Steel and Wire Works*, 128 F.2d 6, 9 (6th Cir. 1942) (explaining that color is not subject to trademark monopoly unless it is used in combination with "some definite, arbitrary symbol or in association with some characteristics which serve to distinguish the article as made or sold by a particular person"); *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727, 729 (6th Cir. 1906) (holding that "as a rule, a color cannot be monopolized to distinguish a product"); *Pacific Coast Condensed Milk Co. v. Frye & Co.*, 147 P. 865, 869 (Wash. 1915) (stating that "[t]he primary colors are few, and as the evidence shows those suitable for light products, such as milk, are even more limited. To allow them to be appropriated as distinguishing marks would foster monopoly by foreclosing the use by others of any tasty dress.").

D. Shade Confusion in the Seventh Circuit: A Per Se Prohibition Against Granting Trademark Protection

Shade confusion, a theory somewhat related to the color depletion theory, provides that if colors receive trademark protection, disputes would arise concerning the similarity of a protected color and those of competitors.⁸⁹ The theory provides that it would be very difficult for courts to determine whether infringement had occurred.

In *NutraSweet Co. v. Stadt Corp.*,⁹⁰ NutraSweet contended that its competitor's sweetener, "Sweet One," was packaged similarly to its artificial sweetener which was sold in blue packets.⁹¹ Although the company did not allege that the packaging was identical, it claimed that "based on market research, that the shades of blue are confusingly similar."⁹² In denying protection of NutraSweet's blue packet, the court noted that "[t]he case before the court provides a vivid example of the problems with shade confusion," which it found could only be settled through litigation.⁹³

Defendant's company revolutionized the sugar industry by selling refined, white granulated sugar in "small single-serving size white packets or envelopes."⁹⁴ These packets are now found in practically all food establishments, served in bowls or caddies. From 1948 to 1958, the defendants' packaged sugar was the only sugar of its kind.⁹⁵ In 1958, the defendants introduced a low calorie sugar substitute under the brand name "Sweet 'N Low."⁹⁶ The new product was packaged in "single-serving pink paper packets"⁹⁷ and was served together with the white sugar packets in food establishments.⁹⁸

89. See generally JEROME GILSON & JEFFREY M. SAMUELS, 1 TRADEMARK PROTECTION AND PRACTICE § 2.11, at 2-158.5 (1995) ("It remains to be seen whether the courts in particular cases will consider color marks weak or strong, and what procedures they will follow in determining whether a shade of blue, for example, is likely to cause confusion with a federally registered shade of blue-green."); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7.16, at 7-69 (3rd ed. 1992) ("[I]f a color per se could be appropriated as a trademark symbol, determination of infringement would degenerate into deciding questions of 'shade confusion' between closely similar color shades.").

90. 917 F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991).

91. *Id.* at 1026.

92. *Id.* at 1027.

93. *Id.*

94. *Id.* at 1025.

95. *Id.*

96. *Id.*

97. *Id.*

98. *Id.*

In 1981, the plaintiffs introduced a sugar substitute of their own, "Equal," packaged in blue single-serving packets.⁹⁹ In 1988, the defendants introduced another sugar substitute to the market, "Sweet One," also packaged in blue single-serving packets.¹⁰⁰

The district court denied NutraSweet's motion for a preliminary injunction and granted summary judgment for the defendants.¹⁰¹ Stating that the "fundamental issue" before the court was "whether mere color should ever be accorded trade-dress protection under Section 43(a) of the Lanham Act,"¹⁰² the Seventh Circuit ultimately held that color may not be granted trademark protection, except in conjunction with a design or symbol.¹⁰³ The court refused to grant protection for NutraSweet's blue sweetener packets because such protection would prevent others from entering the market, as well as create problems with shade confusion.¹⁰⁴

The Seventh Circuit in *NutraSweet* adopted the reasoning in Judge Bissel's dissent in *Owens-Corning*.¹⁰⁵ The court cited Judge Bissel's four reasons for adopting per se prohibition of color trademarks: (1) "[c]onsistency and predictability of the law," (2) protection already available for color when used in connection with a symbol or design, (3) barriers to competitors entering the market, and (4) shade confusion.¹⁰⁶ The *NutraSweet* court found that "the case before the court provides a vivid example of problems with shade confusion . . . NutraSweet [argued that] . . . based upon market research, [it had proved] that the shades of blue are confusingly similar."¹⁰⁷

Additionally, the court determined that a fact-driven standard, requiring the court to determine whether the trademark would prevent future competitors from entering the market, would "prove unworkable, for there is no way for a court to predict the likelihood of future competitors

99. *Id.* at 1026.

100. *Id.*

101. *Id.*

102. *Id.*

103. *Id.* at 1027 (citing *Life Savers v. Curtiss Candy Co.*, 82 F.2d 4, 9 (7th Cir. 1950)). "As a rule color cannot be monopolized to distinguish a product. Color is not subject to trade-mark monopoly except in connection with some definite arbitrary symbol or design." *Id.* (citations omitted).

104. *Id.* at 1028.

105. *Id.*

106. *Id.* at 1027-28.

107. *Id.* at 1027. The court queried, "[h]ow different do the colors have to be? Under NutraSweet's proposed test, the only way to answer that question is through litigation." *Id.*

in a particular market.”¹⁰⁸ Though finding that NutraSweet could receive protection for its trade dress, the court denied trademark protection, stating that “[t]he essential purpose of trademark law is to prevent confusion, not to bar new entrants into the market.”¹⁰⁹ If the fact-driven rule proposed by Nutrasweet were to be adopted, the court opined that trial courts would be required to “scrutinize the tabletop sweetener market to determine the number of competitors and the likelihood of future competitors in that market to determine whether there is a competitive need for the color blue to remain available.”¹¹⁰ Thus, the Seventh Circuit affirmed the district court’s judgment that “as a matter of law, color is not subject to trademark protection.”¹¹¹

In *Qualitex*, the Supreme Court held that the potential for shade confusion should not act as a per se bar against receiving trademark protection. The Court reasoned that courts are often required to make subtle distinctions, and such were generally capable of differentiating between shades of a color.¹¹² Therefore, the Court held that potential shade confusion problems should not act as a bar to trademark protection for color alone.

II. *QUALITEX* IN THE COURTS

A. *The Ninth Circuit*

The Qualitex Company manufactured and sold pads for dry cleaning presses which were dyed an unusual green-gold color, called “SUN GLOW.”¹¹³ The company had been using “Sun Glow” since the 1950’s.¹¹⁴ Qualitex contended that this color functioned as a trademark because it indicated the source of the press pads and distinguished the product from other press pads.¹¹⁵

108. *Id.* at 1028.

109. *Id.*

110. *Id.*

111. *Id.* at 1026.

112. *Qualitex v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995).

113. *Qualitex v. Jacobson Prods. Co.*, 13 F.3d 1297, 1300 (9th Cir. 1994), *rev’d*, 115 S. Ct. 1300 (1995). Qualitex’s predecessor had previously registered the mark in 1959. *Id.*

114. *Id.* at 1302.

115. *Id.*

Qualitex received trademark registration for the green-gold color in 1991.¹¹⁶ In 1989, Jacobson had begun producing and selling a press pad in the same greenish-gold color as Qualitex's press pad, under the name "Magic Glow."¹¹⁷ The similarity of the press pads was not accidental; Jacobson had "admitted intentionally copying the overall look of Qualitex's green-gold press pad."¹¹⁸ As a result, Qualitex initiated a suit against Jacobson alleging trademark infringement and unfair competition.¹¹⁹ The district court awarded damages for both trademark infringement and unfair competition and granted an injunction to prevent Jacobson from "manufacturing, marketing, or selling press pads of the same green-gold color as the pads marketed by Qualitex."¹²⁰

On appeal, the Ninth Circuit held that Qualitex's trademark for "Sun Glow" was invalid, but affirmed the judgment for unfair competition.¹²¹ The court noted that although the Lanham Act does not explicitly bar the registration of color, the "courts of appeals generally have refused to grant trademark protection for color alone."¹²² After giving consideration to the majority's position in *Owens-Corning*, the Ninth Circuit adopted the position of Judge Bissel's dissent: "We conclude that the better rule is that a trademark should not be registered for color alone."¹²³ The court found that shade confusion problems would be insurmountable for those seeking to trademark color alone.¹²⁴ The court also found there to be "[a]dequate protection . . . available when color is combined in distinctive patterns or design or combined in distinctive logos."¹²⁵ Finally, the court noted that additional protection is afforded under unfair competition principles.¹²⁶

116. *Id.*

117. *Id.*

118. *Id.*

119. *Id.* at 1299-1300.

120. *Id.* at 1300.

121. *Id.*

122. *Id.* at 1301 (citing *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1128, n.2 (Bissel, J., dissenting)).

123. *Id.* at 1302.

124. *Id.* The court stated: "As many cases have noted, under the color depletion theory, no person should have a monopoly on a primary color. We recognize that there are countless shades of colors that could not be depleted, but then, we could well become involved in 'shade confusion.'" *Id.*

125. *Id.*

126. *Id.*

B. The United States Supreme Court

The Supreme Court reversed the Ninth Circuit's decision unanimously in an opinion delivered by Justice Breyer.¹²⁷ The Court began by recognizing the broad language of the Lanham Act and the "basic underlying principles of trademark law," which it said "would seem to include color within the universe of things that can qualify as a trademark."¹²⁸ Color was found to be capable of attaining secondary meaning by helping a consumer identify a product.¹²⁹ The Court stated that: "[O]ver time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand."¹³⁰ Thus, the Court found that color may merit protection because "the law helps [to] assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product."¹³¹ The Court rejected the notion that the functionality doctrine is an absolute bar to the registration of color because "sometimes color is not essential to a product's use or purpose and does not affect cost or quality. . ."¹³²

The Court responded to Jacobson's claim that "four special reasons" should justify a prohibition against granting trademark protection for color.¹³³ The Court found that shade confusion would not create unsolvable conflicts over whether similar shades confuse customers and constitute infringement.¹³⁴ The Court stated that "[c]ourts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context to confuse buyers."¹³⁵ The Court recognized that although color presents unique problems, as it may appear different in various lights, such as "morning sun" and "twilight mist,"¹³⁶ this quality should not prevent a color as serving as a trademark. The Court analogized differences between shades of color with differences between words, which courts have successfully handled in the past.¹³⁷ However, it failed to recognize that words, unlike color, provide several grounds for comparison, such as spelling, meaning,

127. *Qualitex v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995).

128. *Id.* at 1302.

129. *Id.* at 1303.

130. *Id.*

131. *Id.*

132. *Id.* at 1304.

133. *Id.* at 1305.

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.*

sound, as well as appearance. Color is different due to the fact that its comparison can only be based on visual perception.

Second, Jacobson contended that “colors are in limited supply . . . [so that] if one of many competitors can appropriate a particular color for use as a trademark, and each competitor then tries to do the same, the supply of colors will soon be depleted.”¹³⁸ The Court determined that color depletion would be an “occasional problem,” but should not result in a “blanket prohibition.”¹³⁹ Furthermore, the Court found that the functionality doctrine would aid in the prevention of such “anti-competitive consequences.”¹⁴⁰ However, it is difficult to imagine that there are no anti-competitive consequences of trademark protection for color because of the potential for color depletion. Once a color is used as a trademark by a company, a competitor is likely to use a similar yet distinctive shade of the protected color. As greater numbers of competitors enter the market, the ability to compete is naturally reduced. Additionally, problems of shade confusion would emerge as a by-product of robust competition.

Third, Jacobson relied upon precedent to support its position.¹⁴¹ The Supreme Court found that the history and purpose of the Lanham Act “undercuts the authority of the precedent on which Jacobson relies.”¹⁴² The Court concluded that much of the case law cited “rested on statements in Supreme Court opinions that interpreted pre-Lanham Act trademark law and were not directly related to the holdings in those cases.”¹⁴³ Though the Lanham Act has a broad construction, the per se prohibition against trademark protection for color has been the prevailing view for nearly a century.¹⁴⁴ There is merit in the argument that long standing precedents create predictability and uniformity in the law, which are qualities that are valued in American jurisprudence.

Fourth, Jacobson argued that trade dress protection adequately protects color which may receive protection in combination with a design or

138. *Id.*

139. *Id.* at 1306.

140. *Id.* at 1307.

141. *Id.* (citing *Coca-Cola Co. v. Koke Co. of America*, 254 U.S. 143 (1920); *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166 (1906); *McLean v. Fleming*, 96 U.S. 245 (1878)).

142. *Qualitex*, 115 S. Ct. at 1308.

143. *Id.*

144. See *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727 (6th Cir. 1906). This case was decided over 30 years before the Lanham Act was enacted and the court held that “appropriating colors . . . would soon take all the colors not in use by [any] complainant, and thus cover the entire field [of colors] at once.” *Id.* at 730.

symbol.¹⁴⁵ However, the Court was not persuaded by this reasoning because "one can easily find reasons why the law might provide trademark protection in addition to trade dress protection."¹⁴⁶ The Court stated that "a firm might want to use color, pure and simple, instead of color as part of a design."¹⁴⁷ The Court arguably gave too much weight to the desires of such firms, and not enough to the problems inherent in granting trademark protection for color in its brief discussion of pre-*Qualitex* protection for color.

The Supreme Court concluded that absent a justification for a per se bar against granting trademark protection for color, and in light of the fact that *Qualitex* had met the traditional trademark requirements, *Qualitex* should retain its trademark.¹⁴⁸

CONCLUSION: SIGNIFICANT OBSTACLES FACE THOSE SEEKING TRADEMARK PROTECTION FOR COLOR

The problems inherent in seeking trademark protection for color were neatly described in *Cooper Industries v. Channellock*:¹⁴⁹

[s]omewhat daunting conditions . . . are necessary for a color mark to be protected. First, there must not be a competitive need for the color within the particular market. Second, the use of color must be non-functional and non-utilitarian. Third, the registrant must show that the color mark had achieved secondary meaning under Section 2(f) of the Lanham Act.¹⁵⁰

It may at first seem that, in light of the Supreme Court's decision in *Qualitex*, colors may easily receive trademark protection. However, once the relevant case law has been examined, however, it becomes apparent that rather unusual circumstances must be present to meet the trademark requirements. Because of the inherent nature of color and its frequent use in the packaging and marketing of products, it is particularly challenging to find a product and color match that may result in the acquisition of trademark protection. This difficulty can be seen in *Ambrit v.*

145. *Qualitex*, 115 S. Ct. at 1308.

146. *Id.*

147. *Id.*

148. *Id.* The Supreme Court accepted the district court's undisputed findings that the color had met the traditional trademark requirements: "[t]he evidence showed that readers of a trade publication associated the green-gold color with *Qualitex*, and the 'SUN GLOW' pad had acquired secondary meaning, as a result of its long and exclusive use by *Qualitex*." *Id.*

149. 788 F. Supp. 873 (W.D. Pa. 1992).

150. *Id.* at 877-78.

Kraft,¹⁵¹ a case in which a frozen dessert producer was denied protection for use of the color royal blue for its ice cream product.¹⁵² For similar reasons, the court in *Brunswick Corp. v. British Seagull, Ltd.*¹⁵³ found that the color black was not eligible for trademark protection when used on outboard motors.¹⁵⁴

Once that match is made, it is an equally difficult challenge to demonstrate that unique situation to the Board and the courts. The evidentiary burden of demonstrating secondary meaning and lack of functionality is a large one, as was shown by *Owens-Corning*.¹⁵⁵

Shade confusion and color depletion will remain concerns of the Board and courts, though they cannot act as a per se bar against registered trademark protection in light of *Qualitex*. The court in *Master Distributors v. Pako*¹⁵⁶ stated the proposition that “[t]riers of fact must often answer close and difficult questions, and the traditional likelihood of confusion standard should be applied to distinguish similar colors, as it is when similar slogans, symbols, or words are compared.”¹⁵⁷

This may be an overly simplistic argument because comparisons of slogans and words provide a greater variety of grounds for comparison. In *Qualitex*, the Supreme Court used the example of the trademarks “Cyclone” and “Tornado” by wire fence companies as marks readily distinguished by a court.¹⁵⁸ The Court did not state how such a comparison would be different from one between colors. In the case of “Cyclone” and “Tornado,” for example, the words have the same meaning, conjure up the same visual image and the spelling of each of these words may be altered while preserving the sound. However, the Supreme Court had to rely primarily on its visual determination that Jacobson’s colored press pads were too similar to those sold by Qualitex. Symbols functioning as trademarks require a visual analysis. They arguably have more grounds for comparison than color because a symbol may have, for example, a historical or cultural meaning.

In *Master Distributors v. Pako*,¹⁵⁹ the court stated that “we believe that not allowing manufacturers to protect color marks when all the traditional requirements have been met will actually promote inconsistency

151. 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

152. *Id.* at 1549.

153. 35 F.3d 1527 (Fed. Cir. 1994).

154. *Id.* at 1530.

155. 774 F.2d 1116, 1127-28 (Fed. Cir. 1985).

156. 986 F.2d 219 (8th Cir. 1993).

157. *Id.* at 223. See *Qualitex v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1305 (1995).

158. *Qualitex*, 115 S. Ct. at 1305.

159. 986 F.2d 219 (8th Cir. 1993).

and confusion.”¹⁶⁰ Great challenges remain for those seeking to obtain registered trademark protection, but the possibility of meeting these challenges exist. In sum, companies should take advantage of the possibilities for using color as a trademark under *Qualitex*, and be fully aware of the fight ahead of them.¹⁶¹

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160. *Id.* at 223.

161. Two federal courts have dealt with the issue of protection for color after the Supreme Court's decision in *Qualitex*. In both cases, the courts denied protection for the colors. *See* *Mana Prods., Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 1071 (2d Cir. 1995) (finding that plaintiff had not established secondary meaning in a trade dress action for its black cosmetic compacts because “the color black does not act as a symbol and distinguish Mana’s compacts” from those of its competitors.’ The court also noted that “plaintiff failed to submit any consumer surveys, information as to the relative market share of its cosmetics, unsolicited media coverage, or the amount of time that the compacts made exclusive use of the challenged design.”); *Ellison Educ. Equip., Inc. v. Tekservices, Inc.*, No. 8 Civ. 94-00350, 1995 WL 606814, *7 (D. Neb. Apr. 12, 1995) (denying trade dress protection for colors used to display plaintiff’s product in its catalog. The court found that the colors had not acquired secondary meaning and were not inherently distinctive, and that the defendant’s use of the colors in its catalog was not likely to cause customer confusion).