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# SEEING RED, SPENDING GREEN: THE COSTLY PROCESS OF REGISTERING AND DEFENDING COLOR TRADEMARKS

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*A shoe has so much more to offer than just to walk.*

—Christian Louboutin<sup>1</sup>

## I. INTRODUCTION

As demonstrated by the recent Second Circuit decision in *Christian Louboutin v. Yves Saint Laurent America Holding, Inc.*,<sup>2</sup> a shoe can certainly offer a great deal of legal controversy. In September 2012, the Second Circuit upheld the validity of designer Christian Louboutin’s trademark for the color red on the soles of his shoes.<sup>3</sup> Although Christian Louboutin and the fashion media have called the case a victory for color trademarks,<sup>4</sup> *Louboutin*’s affirmation of the “aesthetic functionality” doctrine will likely make defending color trademarks harder in the future. Further, a survey of color trademark registration activity and case law reveals that the *Louboutin* decision is an outlier, and the overwhelming

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1. Lauren Collins, *Sole Mate: Christian Louboutin and the Psychology of Shoes*, NEW YORKER Mar. 28, 2011, at 83, 83, available at <http://www.newyorker.com/magazine/2011/03/28/sole-mate>.

2. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d. Cir. 2012).

3. *Id.* at 212.

4. See, e.g., Tamlin H. Bason, *Both Sides Claim Victory as 2nd Cir. Upholds Louboutin’s Mark, Says YSL Didn’t Infringe*, BLOOMBERG BNA: PATENT, TRADEMARK & COPYRIGHT L. DAILY (Sept. 12, 2012), <http://news.bna.com/ptdm> (search “Louboutin” and “Tamlin”), reprinted at <http://www.remarksblog.com/trademark/both-sides-claim-victory-as-2nd-cir-upholds-louboutins-mark-says-ysl-didnt-infringe/>.

tendency of courts is to weaken color marks in infringement lawsuits. Therefore, color mark applicants and current color trademark holders face steep obstacles in registering and protecting their color marks, and this battle will likely become more challenging in the near future.

In 1995, the U.S. Supreme Court held in *Qualitex Co. v. Jacobson Products Co.* that a single color could be trademarked.<sup>5</sup> Although color trademarks have been litigated occasionally in recent years, the highly publicized *Louboutin* decision has thrown the issue back into the spotlight. Designer Christian Louboutin had used red soles on his luxury shoes since 1992 and was granted a trademark for his “lacquered red sole” in 2008.<sup>6</sup> In 2011, Yves Saint Laurent released a shoe line that featured red soles, and Louboutin sued claiming the design infringed his trademark.<sup>7</sup> In a controversial decision, the district court held that a color alone could never be trademarked in the fashion industry.<sup>8</sup> The Second Circuit then reversed, holding that Louboutin’s trademark was valid, but limited only to shoes of which the red soles contrast with the “upper” portion of the shoes.<sup>9</sup> As a result, Yves Saint Laurent’s shoe, which was entirely red, did not infringe upon Louboutin’s trademark.<sup>10</sup>

In light of the *Louboutin* case, this Note surveys the current state of color trademark registration and litigation to determine the prevalence of color trademarks and the success rate of defending these trademarks against infringement. Part II discusses the origin of color trademarks and the requirements for a valid color trademark and trademark litigation. Part III examines the current requirements for color mark registration and the frequency of color mark registration since *Qualitex*. Part IV surveys the federal court cases involving color trademarks since *Qualitex* and discusses the rate of success in defending color marks. Part V examines aesthetic functionality and the impact of the *Louboutin* decision on this doctrine. Part VI offers advice to practitioners seeking to register or defend color trademarks after the *Louboutin* decision. Part VII concludes.

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5. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995).

6. *Louboutin*, 696 F.3d at 213.

7. *Id.*

8. *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 447 (S.D.N.Y. 2011) *aff’d in part, rev’d in part and remanded sub nom.*, 696 F.3d 206 (2d Cir. 2012) (“But, whatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs—the creativity, aesthetics, taste, and seasonal change—that define production of articles of fashion.”).

9. *Louboutin*, 696 F.3d at 228.

10. *Id.*

## II. THE ORIGIN OF COLOR TRADEMARKS AND COLOR TRADEMARK REQUIREMENTS

### A. *QUALITEX* AND THE ORIGIN OF COLOR TRADEMARKS

In 1946, Congress enacted a group of statutes known as the Lanham Act,<sup>11</sup> which allows any “word, name, symbol, or device, or any combination thereof” to be trademarked.<sup>12</sup> Courts have interpreted this language expansively to include “almost anything [that] act[s] as an identification of source.”<sup>13</sup> The focus of trademark law is not on the development of new technology or ideas, but on the protection of symbols and the identification of source, so the trademarked symbol must be “used by a person . . . to identify and distinguish his or her goods . . . and to indicate the source of the goods.”<sup>14</sup> According to the eminent Professor J. Thomas McCarthy, modern trademark protection serves dual functions, which are “to protect both consumers from deception and confusion over trade symbols *and* to protect the plaintiff’s infringed trademark as property.”<sup>15</sup>

Trademarks are registered with the U.S. Patent and Trademark Office (“PTO”). Although registered trademarks are afforded additional protections, unregistered marks may also be protected against infringement. In order for a symbol to be protected as a registered or unregistered trademark, it must fulfill two requirements. First, the mark must be distinctive, which requires that the mark either qualify as “inherently distinctive” or as having acquired distinctiveness over time.<sup>16</sup> Distinctiveness largely focuses on the creativity of the mark as well as consumers’ ability to recognize the source associated with the mark. Second, the use of the symbol must be nonfunctional, which requires that the symbol serve no utilitarian functionality nor be a necessity to compete in the marketplace.<sup>17</sup> Until the U.S. Supreme Court’s decision in *Qualitex Co. v. Jacobson Products Co.* interpreted the language of the Lanham Act

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11. Lanham Act (Trademark Act of 1946), Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C. (2012)).

12. 15 U.S.C. § 1127 (2012).

13. Margaret A. Boulware, *Emerging Protection for Non-Traditional Trademarks: Product Packaging and Design*, in RECENT TRENDS IN TRADEMARK PROTECTION: LEADING LAWYERS ON ANALYZING RECENT DECISIONS AND ADAPTING TO EVOLUTIONS IN TRADEMARK LAW 55, 58 (Michaela Falls ed., 2009).

14. 15 U.S.C. § 1127.

15. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2, at 2-4 (4th ed. 2014).

16. See *infra* notes 43–67 and accompanying text.

17. See *infra* notes 69–73 and accompanying text.

to include trademarks for color alone, jurisdictions were historically split on whether the Act permitted colors to be trademarked.<sup>18</sup>

In *Qualitex*, the plaintiff used a “special shade of green-gold” on the dry cleaning pads it made and sold to “dry cleaning firms for use on dry cleaning presses.”<sup>19</sup> A competitor, Jacobson, “began to sell its own press pads to dry cleaning firms; and it colored those pads a similar green gold.”<sup>20</sup> Qualitex registered the color of its pads with the PTO, and sued Jacobson for trademark infringement and unfair competition.<sup>21</sup>

Qualitex won the lawsuit in the district court,<sup>22</sup> but lost at the appellate level as the Ninth Circuit held that the Lanham Act did not allow trademark registration for color alone.<sup>23</sup> The U.S. Supreme Court reversed the Ninth Circuit decision, holding that “color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm’s goods and identifies their source, without serving any other significant function.”<sup>24</sup>

In reaching its decision, the Supreme Court interpreted the Lanham Act very broadly and found that “[b]oth the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark.”<sup>25</sup> The Court also affirmed that color alone can be used “to identify and distinguish [a markholder’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>26</sup> Therefore, the Court found that at times color alone falls squarely within the subject matter that trademark law seeks to protect.

However, the Court put an important restriction on color trademarks by stating that colors can never fall within the category of inherently distinctive trademarks, since “a product’s color is unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs, which almost *automatically*

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18. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995) (“The Courts of Appeals have differed as to whether or not the law recognizes the use of color alone as a trademark.”).

19. *Id.*

20. *Id.*

21. *Id.*

22. *Qualitex Co. v. Jacobson Products Co.*, 1991 U.S. Dist. LEXIS 21172, at \*21 (C.D. Cal. Sept. 3, 1991), *aff’d in part, rev’d in part*, 13 F.3d 1297 (9th Cir. 1994) *rev’d*, 514 U.S. 159, (1995).

23. *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994) *rev’d*, 514 U.S. 159 (1995).

24. *Qualitex*, 514 U.S. at 166.

25. *Id.* at 162.

26. *Id.* (quoting 15 U.S.C. § 1127 (2012)).

tell a customer that they refer to a brand.”<sup>27</sup> Instead, the Court required color mark holders to demonstrate that the color’s use has acquired distinctiveness in the minds of consumers: “[O]ver time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand. And, if so, that color would have come to identify and distinguish the goods.”<sup>28</sup> In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Court more explicitly stated this restriction, emphasizing that “with respect to at least one category of mark—colors—we have held that no mark can ever be inherently distinctive.”<sup>29</sup>

Additionally, the Court in *Qualitex* dismissed a number of common objections to allowing colors to be trademarked. The Court stated that the functionality doctrine is not a complete bar to color marks because “sometimes color is not essential to a product’s use or purpose and does not affect cost or quality.”<sup>30</sup> Therefore, in cases in which the color serves no functional purpose, it can be trademarked.

The Court also found Jacobson’s four arguments against color trademarks—“shade confusion,” “color depletion,” precedent, and the current allowance of “color as *part* of a trademark”—unpersuasive.<sup>31</sup>

“Shade confusion” is a problem faced by courts in trying to determine the difference between the trademarked color and the allegedly infringing color.<sup>32</sup> The Court explained that this challenge is no different with colors than with any other form of trademark infringement analysis, in which the court must also determine the similarities between words or symbols.<sup>33</sup> Therefore, it could “not see why courts could not apply [existing] standards to a color, replicating, if necessary, lighting conditions under which a colored product is normally sold.”<sup>34</sup>

Jacobson’s second argument was that colors are too scarce to be trademarked, which is commonly referred to as the “color depletion” problem.<sup>35</sup> The Court defeated this argument by relying on the functionality doctrine to prohibit competitively necessary colors from being

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27. *Id.* at 162–63.

28. *Id.* at 163.

29. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (citing *Qualitex*, 514 U.S. at 162–63).

30. *Qualitex*, 514 U.S. at 165.

31. *Id.* at 167–74 (emphasis added).

32. *Id.* at 167.

33. *Id.* at 167–68.

34. *Id.*

35. *Id.* at 168.

trademarked and to thereby “prevent the anticompetitive consequences.”<sup>36</sup>

Third, the Court disregarded precedent stating that color could not be trademarked on the ground that the governing cases were decided before Congress made amendments to the Lanham Act in the late 1980s.<sup>37</sup> The amendments were highly influenced by a Trademark Commission report that “recommended that ‘the terms “symbol, or device” . . . not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark.’”<sup>38</sup> The Court interpreted this report as allowing it to “reevaluate the preexisting legal precedent which had absolutely forbidden the use of color alone as a trademark.”<sup>39</sup>

Finally, the Court determined that a color trademark was still necessary despite color being included in trade dress protection under section 43(a) of the Lanham Act because “[t]rademark law helps the holder of a mark in many ways that ‘trade dress’ protection does not.”<sup>40</sup> Therefore, the Court said it could “easily find reasons” why it might be necessary to allow trademark protection for color as well.<sup>41</sup>

Ultimately, *Qualitex* clearly articulates that a color alone can be trademarked so long as it is nonfunctional and its use has acquired distinctiveness in the minds of consumers.<sup>42</sup> The Court’s affirmation of color trademarks is also strengthened by its rejection of common objections to color marks. The next section will delve deeper into the specific requirements for registering a color trademark, including the details of secondary meaning and the functionality defense.

#### B. REQUIREMENTS FOR COLOR TRADEMARK REGISTRATION AND INFRINGEMENT CLAIMS

After *Qualitex*, a color alone may be a valid trademark so long as two factors are met: (1) the color has acquired secondary meaning and is therefore distinctive, and (2) the use of the color is not functional.<sup>43</sup> In order for a color trademark holder to succeed in an infringement suit, the

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36. *Id.* at 169.

37. *Id.* at 172.

38. *Id.*

39. *Id.* at 173.

40. *Id.* at 173–74. For a further discussion of trade dress protection, see *infra* note 108 and accompanying text.

41. *Id.* at 174.

42. *Id.* at 166.

43. See 1 MCCARTHY, *supra* note 15, § 7.44 (discussing the *Qualitex* rule for color trademarks).

plaintiff mark holder must first demonstrate that the mark is valid based on the above factors, and must additionally prove that there is a likelihood of confusion between the plaintiff's color mark and the allegedly infringing mark.

### 1. Distinctiveness and Secondary Meaning

In order for something to be trademarked it must be distinctive.<sup>44</sup> The distinctiveness requirement is fulfilled when either (1) the mark is inherently distinctive or (2) the mark has acquired distinctiveness in the relevant market.<sup>45</sup> In trademark law, "designations are placed in categories along a spectrum of distinctiveness,"<sup>46</sup> consisting of generic, descriptive, suggestive, arbitrary, and fanciful marks.<sup>47</sup> Suggestive, arbitrary, and fanciful marks are deemed "inherently distinctive." In other words, "they are irrebuttably presumed to have achieved customer recognition and association immediately upon adoption and use."<sup>48</sup> However, the *Qualitex* decision prevents colors from ever falling into these categories of distinctiveness, thereby preventing color from ever being inherently distinctive. Therefore, a color "can be registered or protected as a mark only upon proof that *it has become distinctive*."<sup>49</sup> This acquired distinctiveness is referred to as secondary meaning.

Secondary meaning requires proof that the mark has acquired distinctiveness in the minds of consumers: "The prime element of secondary meaning is a mental association in buyers' minds between the alleged mark and a single source of the product."<sup>50</sup> In other words, although the mark may not have been associated with a source when it first debuted, over time consumers have come to connect the mark with a particular brand. Determining whether secondary meaning has been acquired is a question of fact.<sup>51</sup>

In order to satisfy the secondary meaning inquiry, a mark holder must present strong direct or circumstantial evidence to prove an association between the mark and its source in the minds of consumers. Direct evidence "means the actual testimony of buyers as to their state of mind,"<sup>52</sup>

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44. 2 *id.* § 11:2, at 11-6 to -10.

45. *See id.*

46. *Id.* § 15:1, at 15-1.

47. *Id.* § 11:2, at 11-7 to -8.

48. *Id.* § 15:1.50, at 15-5.

49. *Id.* § 15:1.50, at 15-5.

50. *Id.* § 15:5.

51. *Id.* § 15:29, at 15-48.

52. *Id.* § 15:30, at 15-49.

focusing on whether the consumer thinks of the source upon seeing the mark. Direct evidence can consist of testimony from actual buyers in court, or “quasi-direct evidence” from a consumer survey.<sup>53</sup> Courts often find consumer surveys to be highly persuasive when determining whether a mark has acquired secondary meaning.<sup>54</sup>

Although direct evidence is the strongest way of proving secondary meaning, circumstantial evidence alone can be sufficient to demonstrate that secondary meaning exists.<sup>55</sup> Circumstantial evidence includes evidence of the size of the seller, number of sales, or a large amount spent on advertising.<sup>56</sup> A mark holder may also be able to demonstrate secondary meaning by showing that the infringer intentionally copied the mark to take advantage of the mark holder’s goodwill in the marketplace.<sup>57</sup>

The factual inquiry of secondary meaning remains especially intensive in color cases because the Supreme Court has not addressed the issue. Instead, the Trademark Trial and Appeal Board (“TTAB”) has developed fairly strict guidelines for determining a color’s secondary meaning. Generally, the TTAB has required those who wish to protect “a ‘less distinctive’ designation, i.e. color marks, [to] present the federal courts and the TTAB with a ‘greater . . . quantity and quality of evidence.’”<sup>58</sup> Thus, the burden of proving secondary meaning is “substantial.”<sup>59</sup> Although courts and the TTAB tend to look more favorably on colors with long histories of use,<sup>60</sup> they have repeatedly held that a “mere statement of long use is not sufficient,”<sup>61</sup> so color mark holders must present additional evidence to demonstrate the distinctiveness of their color mark in the minds of consumers.

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53. *Id.*

54. *Id.*

55. *Id.* at 15-50.

56. *Id.* at 15-51.

57. *Id.*

58. Diane E. Moir, Note, *Trademark Protection of Color Alone: How and When Does a Color Develop Secondary Meaning and Why Color Marks Can Never Be Inherently Distinctive*, 27 *TOURO L. REV.* 407, 420 (2011) (quoting 2 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 15:30 (4th ed. 2010)).

59. U.S. PATENT & TRADEMARK OFFICE, *TRADEMARK MANUAL OF EXAMINING PROCEDURE* § 1202.05(a), at 1200-64 (Oct. 2013) [hereinafter TMEP].

60. Moir, *supra* note 58, at 427 (citing the lengthy usage periods of the marks in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) and *Qualitex* as weighing in favor of their trademarks).

61. TMEP, *supra* note 59, § 1202.05(a), at 1200-64.

## 2. Functionality

The Lanham Act states “[n]o 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 . . . [c]onsists of a mark which comprises any matter that, as a whole, is functional.”<sup>62</sup> Therefore, even if a mark is found to be distinctive, it still cannot be trademarked if it is functional.

In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,<sup>63</sup> the U.S. Supreme Court articulated two tests for functionality in trademark law. First, it mentioned the “traditional” functionality test, which states that a feature is functional and cannot be trademarked “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>64</sup> *TrafFix* also recognized a second test for functionality, which states that a mark is functional if its “exclusive use would put competitors at a significant non-reputation-related disadvantage.”<sup>65</sup> This second test is commonly referred to as the “competitive necessity test.”<sup>66</sup> Therefore, a color may not be trademarked when (1) it serves a utilitarian purpose, or (2) it is so important in the market that allowing a monopoly over the color would put competitors at an unfair disadvantage. Colors have been deemed “functional” and not subject to trademark when used to indicate a characteristic of a product, when required to comply with safety regulations, or when they are traditionally present in a given context, such as green and red during Christmas.<sup>67</sup>

A third type of functionality, aesthetic functionality, has been a hotly debated topic among courts. Aesthetic functionality precludes a trademark when the aesthetics of the mark “confer[] a significant benefit that cannot practically be duplicated by the use of alternative designs.”<sup>68</sup> This doctrine will be explored in further detail in Part V.

## 3. Likelihood of Confusion

In order to succeed on a color mark infringement claim, after a plaintiff mark holder proves the validity of the mark by demonstrating that

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62. 15 U.S.C. § 1052(e)(5) (2012).

63. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

64. *Id.* at 32 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

65. *Id.* (quoting *Qualitex*, 514 U.S. at 165).

66. *E.g.*, Brett Ira Johnson, *Trade Dress Functionality: A Doctrine in Need of Clarification* 34 CAMPBELL L. REV. 125, 130 (2011).

67. MCCARTHY, *supra* note 15, § 7:49, at 7-161 to 7-166.

68. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995).

the mark has acquired secondary meaning and is not functional, the mark holder must subsequently demonstrate infringement by showing a likelihood of confusion between the trademarked color and the allegedly infringing color. A claim for trademark infringement of a registered mark asks whether the defendant's use of the mark is "likely to cause confusion, or to cause mistake, or to deceive."<sup>69</sup> Similarly, a claim for infringement of an unregistered mark focuses on whether the use is "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association' of the user with the senior user."<sup>70</sup>

Courts have developed multi-factor tests to determine the likelihood of confusion between two marks. Although the tests vary between jurisdictions, most consist of approximately eight factors that examine similar characteristics of the two marks.<sup>71</sup> For example, the Ninth Circuit has adopted the *Sleekcraft* factors, which examine the:

- (1) strength of the mark; (2) proximity of the goods; (3) similarity of the mark; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of product lines.<sup>72</sup>

In the case of colors, likelihood of confusion is not a mathematical equation, but a question of how the average consumer would perceive the two colors: "The test of infringement is not how many Pantone shades the defendant is distant from the senior user's mark, but whether the reasonably prudent customer would be likely to be confused as to source, sponsorship, affiliation or approval."<sup>73</sup> Therefore, the focus of the analysis is not on how alike the colors actually are, but how alike consumers are likely to *think* they are.

### III. COLOR TRADEMARK REGISTRATION SINCE *QUALITEX*

#### A. CURRENT REGISTRATION REQUIREMENTS FOR COLOR TRADEMARKS

In addition to the standard requirements for trademark validity discussed in Part II, a color trademark application has unique requirements it must also fulfill. A color trademark application must be accompanied by

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69. 15 U.S.C. § 1114(1)(a) (2012).

70. 4 MCCARTHY, *supra* note 15, § 23:1, at 23-9 (citing 15 U.S.C. § 1125(a)).

71. *Id.* at 23-11 to -12. *See also* 3A LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 21:10 (4th ed. 2009).

72. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

73. 1 MCCARTHY, *supra* note 15, § 7:45.70, at 7-149.

a color drawing that is a “substantially exact representation of the mark as used, or intended to be used, on the goods.”<sup>74</sup> The drawing must be accompanied by “(1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement naming the color(s) and describing where the color(s) appear and how they are used in the mark.”<sup>75</sup> Further, if the application is for a specific shade of color, the application must describe the shade in “ordinary language” such as “‘maroon,’ ‘turquoise,’ ‘navy blue,’ [or] ‘reddish orange.’”<sup>76</sup>

#### B. REGISTRATION OF COLOR MARKS SINCE *QUALITEX*

Although *Qualitex* explicitly states that a color alone can be trademarked, it appears that the decision did not lead to an increase in color trademark applications. A PTO official estimated that thirty companies registered single colors between 1985 and the *Qualitex* decision ten years later.<sup>77</sup> In May 2004, Thomson and Thomson completed a survey of trademark applications for single colors and found twenty-seven registrations on the Principal Register and ten on the Supplemental Register.<sup>78</sup> An updated Thomson Reuters search completed in January 2013 revealed that there are currently sixty-five active single color trademark registrations, with twenty-five on the Principal Register and forty on the Supplemental Register.<sup>79</sup> Therefore, it appears that the number of color trademarks has been growing at a steady pace before and after *Qualitex*, but surprisingly, *Qualitex* did not lead to the increase in color trademark applications that many expected. In fact, the growth rate of color trademarks issued is lower than the growth rate of all registered trademarks issued. Between 1995 (the year of the *Qualitex* decision) and 2010, the yearly number of registered trademarks issued increased by a factor of about 2.3,<sup>80</sup> while during the same period registered color trademarks only

74. TMEP, *supra* note 59, § 1202.05(d)(i), at 1200-67.

75. *Id.* § 1202.05(d), at 1200-66 to -67.

76. *Id.* § 1202.05(e), at 1200-69.

77. Christopher C. Larkin, *Qualitex Revisited*, 94 TRADEMARK REP. 1017, 1025 (2004).

78. *Id.* (detailing the search criterion and methods used to collect the data).

79. Thomas Reuters, *Color Trademark Survey* (Jan. 2013) [hereinafter *Thomas Reuters Survey*] (on file with author). The author would like to thank Thomson Reuters for completing this search of color trademarks. This search is an approximation of the number of active color registrations, and neither the author nor Thomson Reuters represents that this search returned every active color trademark on the Register.

80. See U.S. CENSUS BUREAU, STATISTICAL ABSTRACT OF THE UNITED STATES: 2012 512 (2012), available at <http://www.census.gov/compendia/statab/2012/tables/12s0778.pdf> (last visited Aug. 4, 2014) (stating that there were 92,500 registered trademarks issued in 1995 and 210,600 registered trademarks issued in 2010).

increased by a factor of about 1.75. This slower growth rate has likely resulted from *Qualitex*'s mandate that color marks have secondary meaning. This requires a high burden of proof, leading some scholars to conclude that *Qualitex* "[made] registration of color marks somewhat more, not less, difficult to achieve."<sup>81</sup>

Although successful color trademark applications are rare, the existing marks on the Register demonstrate the potential value of a color mark and the importance of longevity and uniqueness to the success of a color mark application. In the 2004 survey, around 66 percent of the color trademarks on the Principal Register were in use for longer than ten years at the time of registration.<sup>82</sup> In the 2013 survey, 80 percent of color trademarks on the Principal Register were in use for longer than ten years at the time of registration.<sup>83</sup> Therefore, although longevity of use of a color alone is not sufficient to demonstrate secondary meaning, it appears to be growing increasingly important in registering a color trademark. Further, a color trademark application is more successful when the use of the subject color is "unusual, unexpected or unnecessary."<sup>84</sup> Examples of unique color trademarks include: colored plastic sheeting for agricultural purposes,<sup>85</sup> blue traction motors,<sup>86</sup> yellow flexible hoses,<sup>87</sup> pink foam sealant for residential and commercial construction,<sup>88</sup> colored buckets for industrial elevator conveyors,<sup>89</sup> white golf clubs,<sup>90</sup> blue plumbing systems,<sup>91</sup> yellow-green cleaning sponges,<sup>92</sup> pink caskets,<sup>93</sup> pink fishing rods,<sup>94</sup> yellow and black stretchers,<sup>95</sup> and black dental floss.<sup>96</sup>

While most unique or unexpected uses of colors are not used by recognizable brands, there are also a number of registered color marks that

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81. Larkin, *supra* note 77, at 1026.

82. *Id.* at 1026–27.

83. See Thomas Reuters Survey, *supra* note 79.

84. Larkin, *supra* note 77, at 1028.

85. Reg. No. 4,266,019, for orange plastic sheeting for agricultural purposes.

86. Reg. No. 4,140,514, for blue traction motors in their entirety.

87. Reg. No. 4,269,990, for yellow flexible hoses for use as duct relining.

88. Reg. No. 4,128,046, for pink spray foam sealant.

89. Reg. No. 4,064,944, for red agricultural buckets and light industrial elevator-type conveyors.

90. Reg. No. 4,064,910, for entirely white golf clubs.

91. Reg. No. 3,987,352, for blue hot and cold water plumbing systems comprised of rigid pipe fittings not made of metal.

92. Reg. No. 3,717,094, for yellow-green cleaning sponges.

93. Reg. No. 3,918,252, for pearlescent pinkish white marbled caskets.

94. Reg. No. 3,545,516, for pink fishing rods, floats, lines, lures, reels, and tackle.

95. Reg. No. 3,388,874, for yellow and black wheeled transport medical apparatus.

96. Reg. No. 3,304,872, for black dental floss and dental tape.

are familiar to most consumers. For example, Tiffany & Co.'s light blue,<sup>97</sup> UPS's brown,<sup>98</sup> blue for Mauna Loa macadamia nuts,<sup>99</sup> yellow for 3M Post-It Notes,<sup>100</sup> and, of course, red for Louboutin's red soles, are all registered color trademarks.<sup>101</sup> The success of these registrations is likely due to the vast recognition of these colors among consumers. Each of these brands relies heavily on the use of their trademarked color and

these registrations collectively indicate that it is possible for single colors to function as marks for widely used goods and services if the putative registrants are willing and able to make the sustained investment over time necessary to develop secondary meaning in a competitive environment where the use of color is commonplace.<sup>102</sup>

However, even if a color trademark is granted, trying to protect the mark can still prove immensely difficult.

#### IV. LITIGATION REGARDING COLOR MARKS SINCE *QUALITEX*

This case survey examines fifty-seven federal cases involving color marks that have been litigated since the 1995 *Qualitex* decision.<sup>103</sup> Trends at both the appellate and district court levels reveal that protecting a color mark in court is a very time-consuming and expensive task, and one that the mark holder very frequently loses. While this survey focuses on published opinions in color trademark cases, there are, of course, cases in which the matter is never adjudicated. Although it is not feasible to look up all case filings in this area of law, a survey of the 2007–2012 federal dockets across all circuits on Bloomberg Law reveals that twenty-two color trademark suits were filed within the last five years, and only six of those cases were settled or otherwise dismissed. Therefore, it appears that the majority of these cases are litigated, and this survey should provide a fairly accurate depiction of the current state of color trademark litigation. Table 1

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97. Reg. No. 2,416,794, for "robin's-egg blue" for catalog covers.

98. Reg. No. 2,131,693, for brown applied to trucks.

99. Reg. No. 2,237,914, for medium blue on packaging of dried fruit and processed macadamia nuts.

100. Reg. No. 2,390,667, for canary yellow used on stationary notes containing adhesive on one side.

101. Reg. No. 3,361,597 for red on women's high fashion designer footwear.

102. Larkin, *supra* note 77, at 1029.

103. For a detailed breakdown of the fifty-seven federal cases surveyed, see the Appendix at the end of this Note. The cases included in the survey were found using Lexis's Shepardize tool and Westlaw's Keycite tool on cases citing *Qualitex*. The results were filtered by searching "color" and "trademark" or "trade dress." This is only an approximation of the number of cases that have been litigated since *Qualitex*, and the author does not contend that this is a completely exhaustive search of color trademark litigation.

provides a summary of the thirty-six fully-adjudicated cases in the survey, detailing the reason each plaintiff lost:

TABLE 1. Reasons Survey Plaintiffs Lost Infringement Claims<sup>104</sup>

| <i>Reason for Failure of Plaintiff's Claim</i> | <i>Number of Times Raised</i> |
|--|-------------------------------|
| Utilitarian Functionality                      | 14                            |
| Competitive Necessity                          | 8                             |
| Aesthetic Functionality                        | 3                             |
| Secondary Meaning                              | 12                            |
| No Confusion                                   | 6                             |

Thirty-six of the sampled cases were fully adjudicated, with the plaintiff winning only eight times.<sup>105</sup> In the remaining cases, the plaintiff lost twelve times because of a lack of secondary meaning, fourteen times because the color had a utilitarian function, eight times because the color was a competitive necessity, three times because the color was aesthetically functional, and six times because there was no likelihood of confusion.<sup>106</sup> Therefore, the courts employ almost equally the traditional trademark requirements to defeat color mark infringement claims. The frequency of invalid color marks often precludes the application of the likelihood of confusion test, but the burden of proving the likelihood of confusion based on color alone also appears very high.<sup>107</sup>

Furthermore, plaintiffs with registered color marks did not fair any

104. In some of the fully-adjudicated cases used to produce this data, the court decided against the plaintiff on multiple grounds. The "Number of Times Raised" column thus accounts for the total number of times each reason for failure was cited by a court.

105. See *infra* APPENDIX.

106. *Id.*

107. See, e.g., *Forschner Grp., Inc. v. Arrow Trading Co.*, 124 F.3d 402, 409 (2d Cir. 1997) (finding that "identical appearance" of pocketknives and the use of the color red alone was not sufficient to demonstrate likelihood of confusion); *Libman Co. v. Vining Indus.*, 69 F.3d 1360, 1363 (7th Cir. 1995) (no likelihood of confusion for multicolored brooms because their packaging was different and advertising was dissimilar); *Predator Int'l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1252 (D. Col. 2009) (no likelihood of confusion even though red ammunition was "virtually identical" because dissimilar packaging mitigated consumer confusion); *Shakespeare Co. v. Silstar Corp. of Am.*, 906 F. Supp. 997, 1011 (D.S.C. 1995) (no likelihood of confusion for red tip on fishing rods despite their being sold in the same locations and advertised through the same mediums).

better in court than those using unregistered trade dress<sup>108</sup> protection:

TABLE 2. Registered Versus Unregistered Marks<sup>109</sup>

|                             | <i>Registered Mark</i> | <i>Unregistered Mark</i> |
|-----------------------------|------------------------|--------------------------|
| Plaintiff Wins              | 1                      | 5                        |
| All Fully-Adjudicated Cases | 8                      | 20                       |

Out of the thirty-six fully-adjudicated cases, twenty cases featured marks that were unregistered,<sup>110</sup> but only five unregistered colors were protected in court.<sup>111</sup> Eight fully-adjudicated cases involved registered color trademarks, with only one protected—the mark in *Louboutin*.<sup>112</sup> On the other hand, even 3M was denied summary judgment twice for its registered trademark blue “painter’s tape” because the court found there were questions of fact about secondary meaning and functionality.<sup>113</sup> Although the sample sizes of registered and unregistered marks vary slightly, it appears from this survey that the rate of success in court of a registered color mark (12.5 percent) is likely no higher than that of an unregistered mark (20 percent).<sup>114</sup> These results may further explain the

108. Trade dress is a form of protection for the overall appearance of a product. Although traditionally limited to a product’s packaging, trade dress protection has expanded to other elements of a product’s design, including color. Trade dress is always unregistered, but is still protected under the same rules as trademarks. *See* 1 MCCARTHY, *supra* note 15, § 8:1, at 8-1 to -9.

109. Data on mark registration was not available for all of the fully-adjudicated cases in this survey, so this analysis focuses on those twenty-eight cases for which such data was available.

110. *See infra* APPENDIX.

111. *See* *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 417–19, 424 (6th Cir. 2012) (finding that although the Maker’s Mark “trademark [was] silent as to color,” there was still infringement because there existed a likelihood of confusion between the two products); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 471, 475 (5th Cir. 2008) (finding that because trademark ownership is established by use and not registration, “the colors, content, and context of the [t-shirts created by the appellant using university colors] are likely to cause confusion as to their source, sponsorship, or affiliation”); *Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006) (finding that the defendant infringed upon a university’s color scheme as the university’s “marks [were] . . . not functional and they [were] distinctive”); *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 26 F. Supp. 2d 834, 844–52 (E.D. Va. 1998) (finding that Pro-Tech Powers’ actions in the context of Black and Decker’s yellow-and-black trade dress for its DeWalt power tool line resulted in customer confusion between the DeWalt line and Pro-Tech Power tools).

112. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012).

113. *3M Co. v. Intertape Polymer Grp.*, 423 F. Supp. 2d 958, 963–64 (D. Minn. 2006).

114. *See supra* Table 2. The population of color trademark cases is relatively small, so these

infrequency of color trademarks on the Register: Parties may determine that it is not worth expending the effort necessary to register the mark, given that registration has little bearing on one's ability to protect the mark from infringement.

The cases that were not fully adjudicated reveal another obstacle to protecting color trademarks: very high litigation costs. Given the highly fact-intensive inquiry required to determine the validity and infringement of a color mark, these cases are infrequently decided on summary judgment and preliminary injunctions are rarely granted. Twenty-one cases in this survey were not fully adjudicated. Out of those twenty-one cases, nine denied motions for summary judgment, with seven denying defendants' motions for summary judgment<sup>115</sup> and two denying plaintiffs' motions for summary judgment.<sup>116</sup> Additionally, five cases denied plaintiffs' requests for preliminary injunctions,<sup>117</sup> and injunctions were granted only in two uniquely strong cases.<sup>118</sup> In *Rotoworks International v. Grassworks USA*, the plaintiff's own distributor began selling knock-offs of the plaintiff's aqua "weed wipers,"<sup>119</sup> and in *Keystone Consolidated Industrial Inc. v. Mid States Distributing Co.*, the plaintiff was able to rely on incontestable trademarks both for the color red on top of fencing as well as the general

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statistics are based on a small sample size. Therefore, they are meant to serve only as rough estimates.

115. *Kerr Corp. v. Freeman Mfg. & Supply Co.*, No. 08-3330, 2009 U.S. App. LEXIS 6342, at \*6, \*17 (6th Cir. Mar. 23, 2009); *Fabrication Enters. v. Hygenic Corp.*, 64 F.3d 53, 56 (2d Cir. 1995); *WMH Tool Grp., Inc. v. Woodstock Int'l, Inc.*, No. 07-cv-3885, 2009 U.S. Dist. LEXIS 125325, at \*3 (N.D. Ill. Dec. 9, 2009); *Unique Sports Prods., Inc. v. Babolat VS*, 403 F. Supp. 2d 1229, 1245-46 (N.D. Ga. 2005); *S&M Nutec, L.L.C. v. T.F.H. Publ'ns, Inc.*, No. 03-1033-CV-W-NKL, 2005 WL 1224607, at \*12 (W.D. Mo. May 23, 2005); *Minn. Mining & Mfg. Co. v. Shurtape Techs., Inc.*, No. Civ. 98-2134 MJD/JGL, 2001 WL 530551, at \*9 (D. Minn. May 17, 2001); *Minn. Mining & Mfg. Co. v. Beautone Specialties, Co.*, 82 F. Supp. 2d 997, 1006 (D. Minn. 2000).

116. *Johnson & Johnson v. Actavis Grp. hf*, 06 Civ. 8209 (DLC), 2008 U.S. Dist. LEXIS 17680, at \*28 (S.D.N.Y. Feb. 21, 2008) (denying J&J's summary judgment motion in part and granting in part); *3M Co.*, 423 F. Supp. 2d at 966 (denying 3M's summary judgment motion in part and granting in part).

117. *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 359 (3d Cir. 2003); *MSP Corp. v. Westech Instruments, Inc.*, 500 F. Supp. 2d 1198, 1218 (D. Minn. 2007); *R.H. Donnelley Inc. v. USA Northland Directories, Inc.*, No. 04-4144 (JNE/SRN), 2004 U.S. Dist. LEXIS 26902, at \*24 (D. Minn. Nov. 19, 2004); *Winner Int'l LLC v. Omori Enters., Inc.*, 60 F. Supp. 2d 62, 74 (E.D.N.Y. 1999); *Adjustable Fixture Co. v. Schumaker Lighting*, No. 97-C-0972, 1998 U.S. Dist. LEXIS 22051, at \*13-14 (E.D. Wis. June 17, 1998).

118. A preliminary injunction was also granted in *Casa Editrice Bonechi, S.R.L. v. Irving Weisdorf & Co.*, 95 Civ. 4008 (AGS), 1995 U.S. Dist. LEXIS 12849, at \*16, \*40 (S.D.N.Y. Aug. 30, 1995), but this case will not be analyzed because the court disregarded *Qualitex* determining that a color scheme was "arbitrary and fanciful."

119. *Rotoworks Int'l Ltd. v. GrassWorks USA, LLC*, 504 F. Supp. 2d 453, 457, 464 (W.D. Ark. 2007).

*placement* of color on fencing when trying to demonstrate infringement.<sup>120</sup> Thus, litigation for color trademarks tends to be expensive for both parties, and plaintiffs frequently run the risk of facing continued infringement during the lengthy trial process.

Although rare, successful color trademark litigation cases demonstrate methods by which color trademark holders can actively protect their marks, as well as the immense amount of time and money required to do so successfully. The winning plaintiffs in this survey are all household names and own highly recognizable brands: Black & Decker, Louisiana State University, the University of Oklahoma, Ohio State University, the University of Southern California, Texas Tech University, Maker's Mark Distillery, Wham-O (manufacturer of the Slip-n-Slide), and Christian Louboutin. The protected color marks consist of black and yellow for the DeWalt tool line (owned by Black & Decker),<sup>121</sup> the adopted color schemes of the various universities,<sup>122</sup> red dripping wax on Marker's Mark whiskey bottles,<sup>123</sup> yellow on Slip-N-Slides,<sup>124</sup> and the red soles of Christian Louboutin's shoes.<sup>125</sup>

The opinions in the winning cases reveal the importance of three elements in successful color trademark infringement suits: (1) prolonged use of the mark, (2) successful sales of the product employing the color mark, and (3) advertising that focuses on the color mark. These factors helped plaintiffs to demonstrate the strength of their color marks, which is essential to proving secondary meaning as well as likelihood of confusion.

The winning parties in these cases had used their color marks for twenty,<sup>126</sup> fifty-three,<sup>127</sup> fifty,<sup>128</sup> eighty-one,<sup>129</sup> and even over one hundred

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120. *Keystone Consol. Indus., Inc. v. Mid-States Distrib. Co.*, 235 F. Supp. 2d 901, 906–07, 916 (C.D. Ill. 2002).

121. *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 26 F. Supp. 2d 834, 867–68 (E.D. Va. 1998).

122. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 471–74 (5th Cir. 2008); *Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d. 510, 520 (N.D. Tex. 2006).

123. *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 417–19, 425 (6th Cir. 2012).

124. *SLB Toys USA, Inc. v. Wham-O, Inc.*, 330 F. App'x. 634, 636–37 (9th Cir. 2009).

125. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 229 (2d Cir. 2012).

126. *Id.* at 226.

127. *SLB Toys*, 330 F. App'x at 636.

128. *Maker's Mark*, 679 F.3d at 420.

129. *See Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d. 510, 521 (N.D. Tex. 2006) (“Many of the TexasTech marks originated in the 1920s and 1930s.”).

years.<sup>130</sup> On the other hand, Black & Decker's color mark was protected after only six years of use<sup>131</sup> because of the product's unique growth and popularity in the market.<sup>132</sup> Therefore, while prolonged use of a color mark is immensely helpful to a plaintiff's case, it may not be essential if the party is able to capture a large portion of the market in a short period of time.

Additionally, the courts focused on the success of the brand employing the color mark when determining if the mark was valid and if the defendant had infringed the mark. As just discussed, Black & Decker's success in protecting its color mark was largely attributed to the DeWalt brand's capture of over 50 percent of the professional power tool market after only six years, thereby making the colors highly recognizable among consumers in a short period of time.<sup>133</sup> The courts in the university color scheme cases also focused on the success of sales when determining the strength of the color schemes, with *Board of Supervisors* noting that the universities sold annually "tens of millions of dollars" worth of merchandise featuring the colors.<sup>134</sup>

Finally, the courts fixated on the plaintiffs' advertisements featuring the color marks. Black & Decker spent \$50 million promoting the DeWalt brand and the "promotional efforts consistently displayed a 'yellow theme with the black highlights and the silver highlights,' so that customers would associate those colors with the DeWalt line."<sup>135</sup> Similarly, the court in *Board of Supervisors* observed that the universities "advertise items with their school colors in almost every conceivable manner."<sup>136</sup> Wham-O presented instances of media coverage "in which the yellow slide was featured,"<sup>137</sup> while Maker's Mark's advertising budget "focuse[d] almost entirely on branding the red dripping wax."<sup>138</sup> Finally, Christian Louboutin had invested "substantial amounts of capital building a reputation and good will, as well as promoting and protecting Louboutin's claim to exclusive

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130. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 472 (5th Cir. 2008).

131. *See Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 26 F. Supp. 2d 834, 844 (E.D. Va. 1998) ("[The DeWalt power tool line] trade dress has possessed secondary meaning since May 1, 1992.").

132. *Id.* at 844–45.

133. *Id.*

134. *Bd. of Supervisors*, 550 F.3d at 477. *See also Tex. Tech*, 461 F. Supp. 2d at 516 (observing that Texas Tech annually sold \$8 million of licensed merchandise).

135. *Black & Decker*, 26 F. Supp. 2d at 844.

136. *Bd. of Supervisors*, 550 F.3d at 477.

137. *SLB Toys USA, Inc. v. Wham-O, Inc.*, 330 F. App'x. 634, 636 (9th Cir. 2009).

138. *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 420 (6th Cir. 2012) (internal quotation marks omitted).

ownership of the [red sole] mark as its signature in women's high fashion footwear."<sup>139</sup> Therefore, each case focused on the investments made by the plaintiffs to build the recognition of their color marks. While expensive, the consistent focus of the courts on this element suggests that extensive advertising of a color mark may be necessary to protect it in court.

Longevity, sales success, or advertising alone is likely insufficient to protect a color trademark in court, but these cases suggest that the presence of these factors together may result in successful protection of such a mark. However, the high burden associated with achieving the required longevity or success, or finding the capital to build a large marketing budget also serve as reminders of the difficulty of protecting a color trademark. Overall, this survey reveals that only rare, successful brands can meet the burdens required to win color mark infringement suits, and that most parties fail at protecting their color marks whether or not they are registered with the PTO. Courts have very frequently invalidated these marks for almost any reason—a lack of secondary meaning, utilitarian functionality, or aesthetic functionality—and have repeatedly found that no infringement occurred as no likelihood of confusion with the allegedly infringing mark existed. Therefore, parties seeking to protect their use of a color face steep, uphill battles and high court costs. Furthermore, protecting color trademarks in court will likely become even harder in the near future with the Second Circuit's affirmation of the aesthetic functionality doctrine in *Louboutin*, which is discussed in Part V.

#### V. A NEW OBSTACLE TO COLOR TRADEMARKS: THE AESTHETIC FUNCTIONALITY DOCTRINE

Aesthetic functionality has historically been a highly debated doctrine among circuits and applied only rarely in color trademark cases. In fact, only three cases included in the survey explicitly found color marks to be aesthetically functional.<sup>140</sup> However, the Second Circuit's clarification of

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139. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012) (internal quotation marks omitted).

140. *See Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203 n.7 (11th Cir. 2004) (finding that the colors of ice cream were aesthetically functional because they "easily satisfy the competitive necessity test because precluding competitors . . . from copying any of these aspects of dippin' dots would eliminate all competitors in the flash-frozen ice cream market"); *Publ'ns Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 342 (7th Cir. 1998) (finding that the gilded pages of a book were aesthetically functional because people buy books for decorations, and the gilded pages prevented "bleeding" of colors); *Sabert Corp. v. Ullman Co.*, 99 Civ. 5030 (AGS), 1999 U.S. Dist. LEXIS 18969, at \*6-7 (S.D.N.Y. Dec. 7, 1999) (finding that the plaintiff's "shiny silver" and "shiny gold" looks on their platters were aesthetically functional because a trademark would "foreclose competition in the market for Platters because the effect of imitating real gold and silver cannot practically be duplicated

the doctrine in *Louboutin* and the publicity of the decision may increase the incidence of the doctrine among other circuits. An increase in the use of the doctrine would come as a blow to color trademark holders, as it would create yet another obstacle to defending their color marks in court.

#### A. WHAT IS AESTHETIC FUNCTIONALITY?

The presence of aesthetic functionality, like traditional utilitarian functionality, invalidates a trademark. A design “which is wholly decorative or ornamental may be ‘functional’ in the sense that it enhances the eye-appeal, and hence the salability, of the product, and thus should not qualify as trademark.”<sup>141</sup> The Restatement of Unfair Competition further elaborates on a finding of aesthetic functionality:

A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs. Because of the difficulties inherent in evaluating the aesthetic superiority of a particular design, a finding of aesthetic functionality ordinarily will be made only when objective evidence indicates a lack of adequate alternative designs. Such evidence typically is available only when the range of alternative designs is limited either by the nature of the design feature or by the basis of its aesthetic appeal. The ultimate test of aesthetic functionality, as with utilitarian functionality, is whether the recognition of trademark rights would significantly hinder competition.<sup>142</sup>

Therefore, like the competitive necessity doctrine, aesthetic functionality stands for the notion that if a feature is necessary to fairly compete in the marketplace, one source should not be able to monopolize that design. However, unlike utilitarian functionality, the “point of aesthetic functionality is to capture cases in which the need for a feature is dictated by market expectations rather than engineering problems.”<sup>143</sup>

Aesthetic functionality has been closely associated with color trademarks: “In the context of color, aesthetic functionality is a companion to utilitarian functionality, ‘where the evidence indicates that the color at issue provides specific competitive advantages that, while not necessarily categorized as purely ‘utilitarian’ in nature, nevertheless dictate that the

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by the use of alternative designs” (internal quotation marks omitted)).

141. 3 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 19:9 (4th ed. 2012).

142. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995).

143. Mark P. McKenna, *(Dys)functionality*, 48 HOUS. L. REV. 823, 853 (2011).

color remains in the public domain.”<sup>144</sup> This close relationship between color and aesthetic functionality stems from the Supreme Court’s interpretation of *Qualitex* in *TrafFix Devices, Inc. v. Marketing Displays, Inc.* The *TrafFix* case is largely considered the case in which the Supreme Court affirmed the existence of aesthetic functionality, a doctrine many thought was dead at the time of the decision.<sup>145</sup> In *TrafFix*, Justice Anthony Kennedy stated, “[a]esthetic functionality was the central question [in *Qualitex*], there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.”<sup>146</sup> Therefore, in one sentence, Justice Kennedy affirmed the existence of the aesthetic functionality doctrine and connected the use of the doctrine to color trademarks.

However, many have disagreed with Justice Kennedy’s interpretation of *Qualitex*. Professor J. Thomas McCarthy points out that “the only mention of aesthetic functionality [in *Qualitex*] was in two quotations made in passing from the Restatement. Thus, aesthetic functionality was not the question in any way in *Qualitex*.”<sup>147</sup> Others have scolded Justice Kennedy for his interpretation of the doctrine, stating that “this language in *TrafFix* suggesting that a different test may be applied in cases of aesthetic functionality as contrasted with utilitarian functionality, is likely to create considerable controversy and confusion in the lower courts.”<sup>148</sup> This prediction appears correct, with different jurisdictions having vast disagreements on the validity of the doctrine.

## B. AESTHETIC FUNCTIONALITY ACROSS JURISDICTIONS

Although the Supreme Court appeared to adopt the aesthetic functionality test in *TrafFix*, courts still vary on how they interpret Justice Kennedy’s opinion.<sup>149</sup> The vast majority of courts that have adopted the doctrine interpret it as an alternative functionality test that precludes a

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144. Signe H. Naeve, *Heart Pills Are Red, Viagra Is Blue . . . When Does Pill Color Become Functional? An Analysis of Utilitarian and Aesthetic Functionality and Their Unintended Side Effects in the Pharmaceutical Industry*, 27 SANTA CLARA COMPUTER & HIGH TECH. L.J. 299, 306 (2011) (citing *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1533 (Fed. Cir. 1994)).

145. See 1 WILLIAM E. LEVIN, *TRADE DRESS PROTECTION* § 4:6, at 4-48 (4th ed. 2013) (noting that *TrafFix* “hasten[ed] the reemergence of aesthetic functionality, like Lazarus, as having arisen from the dead”).

146. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

147. 1 MCCARTHY, *supra* note 15, § 7:80, at 7-278.

148. 1 LEVIN, *supra* note 145, § 4:6, at 4-48.

149. See McKenna, *supra* note 143, at 848 (“[A]esthetic functionality . . . is deeply disputed even at the highest level of generality despite the Supreme Court’s apparent recognition of the concept in *TrafFix*.”).

trademark when an ornamental feature is a “competitive necessity.”<sup>150</sup> However, aesthetic functionality cases remain “scattered” with “some courts refus[ing] to recognize the aesthetic functionality doctrine at all, and courts that do recognize it . . . often [being] reluctant to actually find the features at issue functional, even when exclusive use of those features seems very likely to put competitors at a significant, non-reputation-related disadvantage.”<sup>151</sup> A brief survey of the aesthetic functionality doctrine and color trademark cases reveals that the doctrine is, in fact, “alive and well”<sup>152</sup> but rarely used in practice. However, the prevalence of the doctrine may soon grow as the influence of the Second Circuit’s recent *Louboutin* decision spreads across the federal courts. Table 3 summarizes the circuits’ current standing on aesthetic functionality:

TABLE 3. Circuit Standing Regarding Aesthetic Functionality

| <i>Circuit</i> | <i>Position on Aesthetic Functionality</i> |
|----------------|--|
| 1st            | Undecided                                  |
| 2d             | Adopted and applied to color case          |
| 3rd            | Undecided                                  |
| 4th            | Undecided                                  |
| 5th            | Rejected                                   |
| 6th            | Adopted and applied to color case          |
| 7th            | Adopted and applied to color case          |
| 8th            | Adopted and applied to color case          |
| 9th            | Adopted                                    |
| 10th           | Undecided                                  |
| 11th           | Adopted                                    |
| Federal        | Adopted                                    |

150. *See id.* at 851 (“Courts that apply the aesthetic functionality doctrine today overwhelmingly rely on the test the Supreme Court endorsed in *Traffix*, which . . . ask[s] whether exclusive use of the claimed feature put[s] competitors at a significant non-reputation-related disadvantage.”).

151. *Id.* at 824.

152. Sarah Hopkins, *Aesthetic Functionality: A Monster the Court Created but Could Not Destroy*, 102 TRADEMARK REP. 1126, 1126 (2012).

## 1. Circuits' Varying Opinions on the Aesthetic Functionality Doctrine and Its Application to Color Trademark Cases

Circuits remain deeply divided on the validity of the aesthetic functionality doctrine.<sup>153</sup> Seven circuits have adopted the doctrine, with four circuits applying the doctrine to color trademark cases. Four circuits remain undecided on the validity of aesthetic functionality. Finally, the Fifth Circuit has expressly rejected the doctrine. This section will provide a brief overview of the doctrine's treatment in each circuit, as well as examine the color trademark cases in which the doctrine was applied. This section will begin with the origin of the doctrine in the Ninth Circuit and will conclude with the Second Circuit's view of the doctrine in *Louboutin* and its likely impact on the future of aesthetic functionality.

### a. Ninth Circuit and the Origin of Aesthetic Functionality

The 1952 Ninth Circuit case, *Pagliario v. Wallace China Co.*,<sup>154</sup> is credited as the first case to apply the aesthetic functionality doctrine.<sup>155</sup> In *Pagliario*, a manufacturer sued for alleged infringement of the designs of its hotel china.<sup>156</sup> The court found that the use of similar china patterns did not constitute unfair competition because the designs were functional, since they were the central selling feature of the china.<sup>157</sup> Although the Ninth Circuit has waived on the aesthetic functionality doctrine in the past,<sup>158</sup> recent decisions indicate that the Ninth Circuit "remains committed to the continued viability of the doctrine of aesthetic functionality."<sup>159</sup> However, according to this Note's case survey, the Ninth Circuit has not applied the doctrine to any color trademark cases since *Qualitex*.<sup>160</sup>

### b. First Circuit

The First Circuit has not yet addressed aesthetic functionality. However, the District Court for the District of Massachusetts has stated that plaintiffs have the burden of demonstrating "that the source-identifying

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153. See *infra* Part V.B.1.a–k and accompanying footnotes.

154. *Pagliario v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952).

155. MALLA POLLACK, CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW § 4:18, at 4-36 (Supp. 2010).

156. *Pagliario*, 198 F.2d at 340.

157. *Id.* at 343–44.

158. 3 ALTMAN & POLLACK, *supra* note 141, § 19:34 ("The Ninth Circuit introduced the concept but has repeatedly revised its position." (citing § 19:35 and its summary of Ninth Circuit cases involving aesthetic functionality)).

159. Nancy Clare Morgan, *Aesthetic Appeal: The Blending of Aesthetics and Usefulness in Design Can Result in Challenges to the Theoretical Foundation of Trademark Law*, L.A. LAW., Feb. 2012, at 34, 36.

160. See *supra* Part IV and *infra* APPENDIX.

function has subordinated the design's aesthetic functions."<sup>161</sup> Therefore, while the First Circuit has not explicitly adopted aesthetic functionality, at least one court within the jurisdiction has acknowledged the doctrine.

c. Third Circuit

Scholars have disagreed on the Third Circuit's view of aesthetic functionality. Professors Louis Altman and Malla Pollack maintained that "[a]esthetic functionality was recognized [in the Third Circuit] as a matter of balancing the competing demands of trade identity confusion law against the interest in free competition."<sup>162</sup> On the other hand, Professor J. Thomas McCarthy claimed that the Third Circuit has "rejected the notion of aesthetic functionality."<sup>163</sup> Despite the disagreement, it does appear that at least one court in the Third Circuit has acknowledged the aesthetic functionality doctrine in a color trademark case, *Colur World v. SmartHealth, Inc.*<sup>164</sup> In *Colur World*, the plaintiffs claimed the use of the color pink on nitrate gloves was not functional because competitors sold gloves in a variety of other colors.<sup>165</sup> A motion to dismiss the case was not granted due to a question of fact about the aesthetic functionality of the gloves: "Whether use of the color pink . . . engenders some other essential aesthetic value, which undermines a claim of non-functionality, [is a] question[] of fact that may be explored in ensuing discovery."<sup>166</sup> Thus, it appears the Third Circuit has not entirely rejected the doctrine, but remains largely undecided about it.

d. Fourth Circuit

In 1992, a Fourth Circuit district court declared that it had "no reason to think that the Fourth Circuit would be inclined to adopt" the aesthetic functionality doctrine.<sup>167</sup> More recently, a color trademark case in 2006 rejected an aesthetic functionality argument, but did not declare the entire doctrine invalid.<sup>168</sup> In *Leviton Manufacturing Co. v. Universal Security Instruments, Inc.*, a plaintiff claimed trade dress protection for the faceplate

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161. *Carroll Shelby Licensing, Inc. v. Superformance Int'l, Inc.*, 251 F. Supp. 2d 983, 986 (D. Mass. 2002).

162. 3 ALTMAN & POLLACK, *supra* note 141, § 19:9.

163. 1 MCCARTHY, *supra* note 15, § 7:80, at 7-283.

164. *Colur World, LLC v. SmartHealth, Inc.*, No. 09-00505, 2010 U.S. Dist. LEXIS 5844 (E.D. Pa. Jan. 25, 2010).

165. *Id.* at \*16-17.

166. *Id.* at \*18.

167. *Devan Designs, Inc. v. Palliser Furniture Corp.*, No. 2:91CV00512, 1992 WL 511694, at \*13 (M.D.N.C. Sept. 15, 1992), *aff'd*, 998 F.2d 1008 (4th Cir. 1993).

168. *Leviton Mfg. Co. v. Universal Sec. Instruments, Inc.*, 409 F. Supp. 2d 643 (D. Md. 2006).

colors on its ground fault circuit interrupter.<sup>169</sup> The court was

not persuaded by [the defendant's] argument that [the plaintiff's] distinct colors [were] 'aesthetically functional.' The fact that [the defendant] may [have] want[ed] to match the color of its devices so that they [could] be used with [the plaintiff's] electrical devices [did] not vitiate the purpose and the right of [the plaintiff] to protect its trade dress.<sup>170</sup>

Therefore, while the Fourth Circuit has not foreclosed the aesthetic functionality doctrine entirely, it appears no court in the circuit has accepted an argument regarding aesthetic functionality.

e. Fifth Circuit

The Fifth Circuit has "expressly rejected the theory of aesthetic functionality, noting that the 'important ingredient in commercial success' standard would almost always permit a junior user to freely copy distinctive trade dress."<sup>171</sup> The Fifth Circuit expressed further disapproval of the doctrine in *Board of Supervisors of Louisiana State University Agricultural and Mechanical College v. Smack Apparel*, in the which it rejected the defendant's argument that the plaintiff schools' color schemes were aesthetically functional.<sup>172</sup> The court expressly rejected *TrafFix's* acknowledgement of the aesthetic functionality doctrine:

[N]either *Qualitex* nor *TrafFix* addressed aesthetic functionality as the dispositive issue, let alone the purported aesthetic functionality of a color-scheme that acts to identify and create a desired association with the particular source. We do not believe that the Court's dictum in *TrafFix* requires us to abandon our long-settled view rejecting recognition of aesthetic functionality.<sup>173</sup>

To date, the Fifth Circuit is the sole circuit to expressly reject the doctrine.

f. Sixth Circuit

The Sixth Circuit has adopted the aesthetic functionality doctrine, although it has yet to adopt a definitive test. In *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters*, the court claimed that *TrafFix*

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169. *Id.* at 647.

170. *Id.* at 650.

171. 1 MCCARTHY, *supra* note 15, § 7:80, at 7-284 (citing *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417 (5th Cir. 1984)).

172. *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 486–87 (5th Cir. 2008) ("[The use of unique color schemes on clothing] allow[s] groups of people to bond and show support for a philosophy or goal; facilitat[es] the expression of loyalty to the school and a determination of loyalties of others; and identifi[es] the wearer as a fan and indicate[s] the team the fan is supporting. These claimed functional uses are nothing more than . . . aesthetic.").

173. *Id.* at 487–88.

“did not displace the traditional functionality standard from *Inwood Laboratories*. Instead it explained the policy underlying the functionality doctrine in a way readily adaptable to the problem of aesthetic functionality, the issue presented in *Qualitex*.”<sup>174</sup>

Despite this apparent affirmation of the competitive necessity test, in *Abercrombie*, the Sixth Circuit recently took the position that it is unsettled in its opinion of the aesthetic functionality doctrine.<sup>175</sup> In *Maker’s Mark Distillery, Inc. v. Diageo North America, Inc.*, the court entertained both the (1) comparable alternatives test<sup>176</sup> and (2) the effective competition test for aesthetic functionality.<sup>177</sup> However, the court did not decide which test is proper, nor did it explicitly adopt the doctrine.<sup>178</sup>

g. Seventh Circuit

The Seventh Circuit has cautiously adopted the aesthetic functionality doctrine, and it has been one of the jurisdictions to most frequently include an aesthetic functionality analysis in color trademark or trade dress cases. The Seventh Circuit first recognized the doctrine of aesthetic functionality in 1985 when it “approved the proposition that the concept of competitive need as a defense to a charge of product simulation was broad enough to include appearance features.”<sup>179</sup> Importantly, though, the court prohibited the aesthetic functionality doctrine from barring protection for use of a color simply because consumers would find it appealing if their products matched.<sup>180</sup> Therefore, the Seventh Circuit has adopted the aesthetic

174. *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters*, 280 F.3d 619, 641 (6th Cir. 2002).

175. *See Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 418 (6th Cir. 2012) (“It seems we have not yet plainly stated which test we would apply under the aesthetic functionality doctrine . . . or that we have even adopted aesthetic functionality doctrine at all.”).

176. *Id.* (“The test for comparable alternatives asks whether trade-dress protection of certain features would nevertheless leave a variety of comparable alternative features that competitors may use to compete in the market. If such alternatives do not exist, the feature is functional; but if such alternatives do exist, then the feature is not functional.”).

177. *Id.* (“The effective competition test asks . . . whether trade dress protection for a product’s feature would hinder the ability of another manufacturer to compete effectively in the market for the product. If such hindrance is probable, then the feature is functional and unsuitable for protection. If the feature is not a likely impediment to market competition, then the feature is nonfunctional and may receive trademark protection.”).

178. *Id.* at 418–19.

179. 3 ALTMAN & POLLACK, *supra* note 141, § 19:9.

180. *Id.* (citing *W.T. Rogers Co. v. Keene*, 778 F.2d 334 (7th Cir. 1985)). *See also* *Eco Mfg. LLC v. Honeywell Int’l Inc.*, 357 F.3d 649, 654 (7th Cir. 2003) (Easterbrook, J.) (“[A]n understanding of ‘aesthetic functionality’ as broad as [the plaintiff’s] would destroy protection of trade dress, as we remarked in *Keene*. It would always be possible to show that *some* consumers like the item’s appearance; then the corner jewelry store could emulate the distinctive Tiffany blue box, which would lose its ability to identify origin. ‘Beauty lies in the eye of the beholder’ therefore cannot by itself

functionality doctrine to some degree, but limited the type of “competitive necessities” that would prevent trademark or trade dress protection.

The Seventh Circuit has addressed aesthetic functionality in two color trademark cases. In *Publications International v. Landoll, Inc.*, the court found that the gold-colored gilded pages on a cookbook were aesthetically functional and ineligible for trade dress protection, stating that “[g]old connotes opulence, and so is a standard element of the décor of food products . . . Gold is a natural color to use on a fancy cookbook.”<sup>181</sup> The District Court for the Central District of Illinois precluded summary judgment in *Keystone Consolidated Industrial Inc. v. Mid States Distributing Company* after determining there was a question of fact about whether red-colored top wires on a fence were aesthetically functional.<sup>182</sup> The court defined aesthetic functionality as depending on whether the “red colored top wire and red marks [were] pleasing to the point where it is so important to the value of the product to consumers that continued trademark protection would deprive them of competitive alternatives.”<sup>183</sup> Ultimately, therefore, the Seventh Circuit has actively adopted the doctrine, but has so far limited it to cases of competitive necessity.

#### h. Eighth Circuit

Prior to *Qualitex* and *TrafFix*, the Eighth Circuit employed a sweeping version of the aesthetic functionality doctrine; in 1982, a district court in the circuit found John Deere’s yellow-and-green loaders to be aesthetically functional because farmers wanted to match their loaders with their tractors, so the colors served some function beyond just identifying John Deere as the source.<sup>184</sup> However, since *TrafFix*, the Eighth Circuit has narrowed its definition of aesthetic functionality to the competitive necessity test in color cases. The District Court for the Western District of Missouri found there was a question of fact as to whether the green color on dog treats was aesthetically functional because “the question of what the color green ‘means’ in the eyes of consumers is appropriate only for a jury to consider.”<sup>185</sup> Therefore, the Eighth Circuit is likely willing to entertain aesthetic functionality arguments in color cases within the bounds of the

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establish functionality of trade dress.”).

181. *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 342 (7th Cir. 1998).

182. *Keystone Consol. Indus. Inc. v. Mid-States Distrib. Co.*, 235 F. Supp. 2d 901, 907–08 (C.D. Ill. 2002).

183. *Id.* (internal quotation marks omitted).

184. *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 96–98 (S.D. Iowa 1982).

185. *S&M Nutec, L.L.C. v. T.F.H. Publ’ns, Inc.*, No. 03-1033-CV-W-NKL, 2005 WL 1224607, at \*6 (W.D. Mo. May 23, 2005).

competitive necessity test.

i. Tenth Circuit

The Tenth Circuit acknowledged the aesthetic functionality doctrine in the 1987 case *Brunswick Corp. v. Spinit Reel Co.*, stating that “a feature intrinsic to the aesthetic appeal of those products may not be entitled to trademark protection.”<sup>186</sup> The Tenth Circuit has not applied the doctrine to a color trademark case.

j. Eleventh Circuit

The Eleventh Circuit has only briefly recognized aesthetic functionality. In *Dippin’ Dots, Inc. v. Frosty Bites Distribution*, the Eleventh Circuit acknowledged the doctrine in a footnote, stating that the color, size, and shape of ice cream were “‘aesthetic functions’ that easily satisfy the competitive necessity test.”<sup>187</sup> Based on this footnote, it appears that the Eleventh Circuit has at least acknowledged the competitive necessity test as it relates to aesthetic functionality. Furthermore, in *Unique Sports Products Inc. v. Babolat VS*, a district court in the Eleventh Circuit found that there was a question of fact as to whether the plaintiff’s use of “light blue” on its tennis racquet handles was functional because the color was “complimentary in color to most racquet cosmetics” and therefore “play[ed] an important role in making overgrips more desirable to consumers.”<sup>188</sup> Therefore, while the circuit has yet to apply the doctrine to a color trademark case, courts within it have at least acknowledged the relevance of the doctrine in this type of litigation.

k. Federal Circuit

The Federal Circuit has adopted a narrow interpretation of the aesthetic functionality doctrine. In *Brunswick Corp. v. British Seagull Limited*, the court found that it was not improper to deny registration for the color black on outboard motors because the color black made the motors compatible with a wide range of boat colors and minimized the apparent size of the motor.<sup>189</sup> Despite this initial application of the doctrine, the circuit has since narrowed the doctrine in another color trademark case. In *LD Kichler Co. v. Davoil, Inc.*, the court found there was a question of fact about whether the color of a light mount was aesthetically functional, cautioning that the “examination of competitive need ‘should not

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186. *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987).

187. *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203 n.7 (11th Cir. 2004).

188. *Unique Sports Prods., Inc. v. Babolat VS*, 403 F. Supp. 2d 1229, 1235 (N.D. Ga. 2005).

189. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1533 (Fed. Cir. 1994).

discourage firms from creating [a]esthetically pleasing mark designs”<sup>190</sup> and that “[m]ere taste or preference cannot render a color—unless it is ‘the best, or at least one, of a few superior designs’—*de jure* functional.”<sup>191</sup> Therefore, the Federal Circuit has also adopted the competitive necessity version of the aesthetic functionality doctrine.

### C. THE SECOND CIRCUIT AND THE FUTURE OF AESTHETIC FUNCTIONALITY

In its 2012 decision in *Louboutin*, the Second Circuit explicitly adopted the aesthetic functionality doctrine: “[I]t is clear that the combined effect of *Qualitex* and *TrafFix* was to validate the aesthetic functionality doctrine.”<sup>192</sup> In light of the deep divide among the circuits on the issue, the Second Circuit’s adoption of the aesthetic functionality doctrine in *Louboutin* was quite novel,<sup>193</sup> especially given that the court did not have to reach the functionality issue in the *Louboutin* case. The Second Circuit’s opinion in *Louboutin* marks the most detailed explanation of the aesthetic functionality doctrine and how it should be applied alongside the traditional functionality analysis. As the court explained:

[T]he test for aesthetic functionality is threefold: At the start, we address the two prongs of the *Inwood* test, asking whether the design feature is either ‘essential to the use or purpose’ or ‘affects the cost or quality’ of the product at issue. Next, if necessary, we turn to a third prong, which is the competition inquiry set forth in *Qualitex*. In other words, if a design feature would, from a traditional utilitarian perspective, be considered ‘essential to the use or purpose’ of the article, or to affect its cost or quality, then the design feature is functional under *Inwood* and our inquiry ends. But if the design feature is not ‘functional’ from a traditional perspective, it must still pass the fact-intensive *Qualitex* test and be shown not to have a significant effect on competition in order to receive trademark protection.<sup>194</sup>

Therefore, the Second Circuit mandates that the functionality analysis not end with utilitarian functionality. Instead, even if the feature in question is *not* traditionally functional, a court must always move to aesthetic

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190. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1353 (Fed. Cir. 1999) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

191. *Id.*

192. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 221 (2d Cir. 2012).

193. See Samantha L. Hayes, *The Second Circuit Speaks on Color Marks and Aesthetic Functionality Doctrine*, LAW JOURNAL NEWSLETTERS: AN ALM WEBSITE (Oct. 2012), <http://www.kilpatricktownsend.com/~media/Files/articles/2012/SHayes%20IP%20Strategist.ashx>.

194. *Louboutin*, 696 F.3d at 220.

functionality, which requires looking at the competitive necessity of the aesthetic features of the product.<sup>195</sup>

Further clarifying the doctrine, the Second Circuit stuck to a highly fact-specific analysis to determine a feature's aesthetic functionality. The court reasoned that "[i]n making [an aesthetic functionality] determination, courts must carefully weigh 'the competitive benefits of protecting the source-identifying aspects' of a mark against the 'competitive costs of precluding competitors from using the feature.'"<sup>196</sup> The court further cautioned that "courts must avoid jumping to the conclusion that an aesthetic feature is functional merely because it denotes the product's desirable source."<sup>197</sup> Therefore, while taking a strong stand in favor of the aesthetic functionality doctrine, the Second Circuit recognized the difficulty in distinguishing aesthetic functionality from successful branding, and cautioned courts applying the doctrine to consider the mark holder's right to benefit from a recognizable trademark.<sup>198</sup> Ultimately, the court was satisfied that the aesthetic functionality doctrine, so long as it involved a fact-intensive inquiry, could coincide with a manufacturer's right to benefit from brand success.

Although the Second Circuit did not apply the aesthetic functionality doctrine in the *Louboutin* decision, the court's explicit acceptance of the doctrine and articulation of a three-part test will likely increase the use of the doctrine in courts inside and outside of the Second Circuit. Michelle Mancino Marsh, an attorney at Kenyon & Kenyon, stated after *Louboutin* that "the Second Circuit's decision will help other courts . . . They set out a test, and that will have an impact on how other courts apply the doctrine."<sup>199</sup> Until now, courts have frequently ended their analysis with utilitarian functionality, but those following the Second Circuit's *Louboutin* test will also have to complete a *mandatory* aesthetic functionality analysis, creating another obstacle for those defending the validity of color

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195. *Id.* at 222 ("In short, a mark is aesthetically functional, and therefore ineligible for protection under the Lanham Act, where protection of the mark *significantly* undermines competitors' ability to compete in the relevant market.").

196. *Id.* (quoting *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 59 (2d Cir. 1995)).

197. *Id.*

198. *See id.* ("Because aesthetic function and branding success can sometimes be difficult to distinguish, the aesthetic functionality analysis is highly fact-specific. In conducting this inquiry, courts must consider both the markholder's right to enjoy the benefits of its effort to distinguish its product and the public's right to the 'vigorously competitive market[ ]' protected by the Lanham Act, which an overly broad trademark might hinder.").

199. Lisa Shuchman, *Louboutin Red-Shoe Decision Clarifies 'Aesthetic Functionality' IP Doctrine*, CORPORATE COUNSEL (Sept. 7, 2012), available at <http://www.corpcounsel.com/id=1202570408982/Louboutin-RedShoe-Decision-Clarifies-Aesthetic-Functionality-IP-Docctrine>.

trademarks. While the doctrine is likely to be utilized more frequently after the *Louboutin* decision, the debate about the doctrine and when it can be applied is far from over. One journalist has even gone so far as to say that the doctrine ultimately “must be resolved by the Supreme Court.”<sup>200</sup> Until then, however, the doctrine will likely be used to invalidate color trademarks, and practitioners should be aware of how to navigate the increasingly difficult process of registering and defending a color trademark.

## VI. ADVICE TO PRACTITIONERS REGISTERING AND DEFENDING COLOR TRADEMARKS

### A. COLOR TRADEMARK REGISTRATION

As demonstrated by the survey discussed in Part III.B, trademark registration for colors has been growing steadily and remains an essential strategy for a handful of very powerful brands. While registration itself may not be essential to defending a trademark,<sup>201</sup> successful registration of a mark may send the message to competitors that a client is serious about defending the exclusive use of a color in the marketplace. Luckily, there are a few specific strategies that can be employed in the trademark application to increase the chance of registration: (1) a careful selection of color and (2) a very specific identification of the shade of color.

A client should be cautious in its choice of color from the beginning, keeping in mind that choosing a functional color will preclude any trademark protection. As demonstrated by the survey on successful color trademark registrations, this typically means that the use of the color should be unique or unexpected. Therefore, it is important that a client select a color that “(1) does not represent a utilitarian or functional advantage over other colors . . . [or] (2) will be cheaper to make or use.”<sup>202</sup> A client should also be advised that a color combination may be easier to trademark than a single color, because a color combination is less likely to be functional.<sup>203</sup>

Second, a client seeking to register a color mark should identify the shade of color as specifically as possible. The current registration for a trademark consisting of one or more colors used on a particular object requires that a “drawing must show the mark in color, and the applicant

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200. Hayes, *supra* note 193.

201. See *supra* Part IV, Table 2.

202. Boulware, *supra* note 13, at 65.

203. *Id.*

must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature on the mark.”<sup>204</sup> While these official requirements for color descriptions are fairly broad, a client should be advised to identify the color shade as specifically as possible in order to better protect a color mark in the future. One way to identify the specific shade is through the Pantone System. The Pantone System is a “standardized, ‘international reference for selecting, specifying, matching and controlling ink colors” and can be used to identify very specific shades of color.<sup>205</sup> Although claiming a more general shade may be “strategic, in order to make possible more claims of infringement against others,”<sup>206</sup> clients should be advised to balance the breadth of possible infringement claims with the chance that a trademark for an unidentified shade of a color “risks cancellation of the mark if the claim is found to be overbroad.”<sup>207</sup> Further, a narrow description of the protected color is even more important with the threat of the aesthetic functionality doctrine,<sup>208</sup> given that there is a greater risk that a more common color will be found aesthetically necessary to compete in the marketplace. Therefore, a client may be better off claiming a more narrow shade of a color in the trademark application and having fewer potential infringement claims (which also brings with it fewer litigation costs) than risking the validity of the trademark.

#### B. COLOR TRADEMARK LITIGATION

Even if a color is successfully registered with the PTO, defending the trademark in court is still an uphill battle. As identified in Part IV, the winning cases typically feature (1) a long use of the mark, (2) highly successful sales of the brand, and (3) targeted advertising. Although the first two elements are not factors a trademark attorney can necessarily assist with developing, an attorney can certainly advise a client about advertising techniques. In addition, there are other practical steps trademark holders can take to better their chance of successfully defending the color: (1) being aware of the small but growing threat of aesthetic functionality,

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204. TMEP *supra* note 59, § 807.07, at 800-56.

205. Danielle E. Gorman, Note, *Protecting Single Color Trademarks in Fashion After Louboutin*, 30 CARDOZO ARTS & ENT. LJ. 369, 401 (2012).

206. *Id.*

207. *Id.*

208. *Color Trademarks in the Fashion Industry—Louboutin Wins the Battle; YSL Claims Victory in the War*, COVINGTON & BURLING LLP: E-ALERT (Sept. 11, 2012), <http://www.cov.com/files/Publication/10e70b54-0a2e-439e-aa81-f2c10f58efa2/Presentation/PublicationAttachment/add68cad-cd81-4f6b-9c37-f3cf3789c611/Color%20Trademarks%20in%20Fashion%20Industry.pdf>.

and (2) actively policing the mark, but picking infringement lawsuits wisely.

Advertising featuring the color trademark is one of the strongest forms of evidence a trademark holder can present in defending the validity of the trademark. As this Note's case survey illustrates, the few brands that were successful in trademark infringement litigation for their color marks had all spent significant sums of money advertising their marks and had made their colors central to their branding efforts. However, trademark holders must be extremely careful to avoid inadvertently advertising the *benefits* of the color: "[A]dvertising campaigns by the owner of the non-traditional mark are often damaging to the mark's protection. The marketing materials must be reviewed, because advertising that promotes the utilitarian advantages of the product design can, inadvertently, disqualify trademark protection."<sup>209</sup> Therefore, a color trademark owner should be advised that spending money to advertise the color of the product is an important investment, but advertising should be continually monitored to ensure the color is part of the branding, and not the function, of the product.

Moreover, existing brand owners must be aware of the new possibility that their color marks will be invalidated due to aesthetic functionality. As discussed previously, courts have historically shied away from the doctrine due to mass confusion, and consequently, lawyers have been advised to avoid arguing the doctrine.<sup>210</sup> However, the Second Circuit's clear affirmation of the doctrine in *Louboutin* will likely change the frequency of the doctrine's use in color trademark litigation. Luckily for color trademark owners, "[t]he tone of the [*Louboutin*] opinion suggests an extreme reluctance to find Louboutin's red sole mark aesthetically functional without compelling evidence red soles are necessary to compete in the marketplace."<sup>211</sup> Therefore, opponents will still have to present a strong, factually-based analysis to invalidate a color trademark using aesthetic

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209. Boulware, *supra* note 13, at 67. See also *Sabert Corp. v. Ullman Co.*, 99 Civ. 5030 (AGS), 1999 U.S. Dist. LEXIS 18969, at \*7 (S.D.N.Y. Dec. 7, 1999) ("[D]efendants contend that the gold and silver 'looks' of plaintiff's Platters serve the function of giving the Platters a look that is similar to real gold and silver platters. Plaintiff's own advertisements espouse the benefits of their color scheme.").

210. See Joseph R. Dreitler, Brian J. Downey & Mary R. True, *Trademark Practice Before the PTO 2004* (2003), in *NAVIGATING TRADEMARK PRACTICE BEFORE THE PTO 2004: FROM FILING THROUGH THE TTAB HEARING* 185, 212 (2004) ("Generally speaking, examining attorneys should exercise caution in the use of the term 'aesthetic functionality,' in light of the confusion that historically has surrounded this issue.").

211. Hillary Schroeder, *Those Little Red Shoes*, *THE RECORDER* (Oct. 19, 2012), available at <http://www.therecorder.com/id=1202574999058/Those-Little-Red-Shoes>.

functionality.<sup>212</sup> Although it remains to be seen how other courts will react to the Second Circuit's affirmation of the aesthetic functionality doctrine, color trademark owners need to be aware of the possibility that the presence and strength of this doctrine could grow rapidly in the near future.

Finally, the greatest lesson from the *Louboutin* case may be that while color trademark owners should actively police their color marks, they should also pick their infringement lawsuits very carefully. Color trademarks are invalidated so frequently in courts that if a trademark owner constantly sues for infringement, the owner rapidly increases the risk of losing the trademark. Marc Reiner, chair of the Intellectual Property Group at Anderson Kill & Olick, argues that *Louboutin*'s decision to sue Yves Saint Laurent was a mistake, even though *Louboutin*'s trademark was ultimately protected. He believes that

[t]his case was an example of why it's so important to pick your battles well . . . *Louboutin* not only wasted resources on the litigation but also needlessly put its valuable red-sole trademark in jeopardy. Had *Louboutin* lost the ability to prevent others from using a contrasting red sole, the result would have been catastrophic for the brand.<sup>213</sup>

Ultimately, counsel should advise prudent policing of the color mark over a client's adoption of a litigious attitude.

## VII. CONCLUSION

Although *Qualitex* explicitly declared color alone could be trademarked, registering and defending color marks remains difficult. While there are active color trademarks on the Register, they are largely limited to colors that are used in unique or unexpected ways, primarily due to *Qualitex*'s strict demand that colors acquire secondary meaning before they can be trademarked. However, the potential for valuable color trademarks certainly exists for established brands, as evidenced by the prominent names on the Register. Therefore, although difficult, a registered color mark may prove useful to a brand's success.

However, even with a registered trademark, protecting the mark in court is still extremely challenging. The fact-intensive nature of a trademark infringement case results in few cases ending in summary judgment and few grants of preliminary injunctions. Therefore, litigating color infringement cases is extremely expensive, and is something color

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212. See *id.* ("Those who argue that a color mark is aesthetically functional will want to assert specific facts to show how the inability to use the mark impedes marketplace competition.").

213. Bason, *supra* note 4.

mark holders must be prepared for when actively policing their marks. Further, color mark holders should be aware that historically only large brands have won in color trademark cases. It appears a successful infringement suit requires long use of the mark, extremely successful sales of products using the color, and very large advertising budgets centering on the color mark. Unfortunately, litigating infringement cases will likely be harder in the future, with aesthetic functionality likely becoming a growing defense in infringement claims. Although jurisdictions have been deeply split on the doctrine in the past, the *Louboutin* decision presents a workable test that places aesthetic functionality into the larger functionality framework for the first time. This test will likely increase other courts' application of aesthetic functionality, especially in circuits that have remained undecided on how to properly apply the doctrine.

Ultimately, color trademark holders should keep in mind the challenge they face in trying to register and defend a color trademark. The process requires immense capital and success is never guaranteed. At the end of the day, color trademarks remain an uphill battle, and the hill is only getting steeper.

APPENDIX<sup>214</sup>

| <i>Case</i>   | <i>Circuit</i> | <i>Protected?</i> | <i>Registered</i> | <i>Trademark Element Failed:</i>            |
|---|----------------|-------------------|-------------------|---|
| Yankee Candle Co. v. Bridewater Candle Co., 99 F. Supp. 2d 140 (D. Mass. 2000).   | 1              | No                | No                | Utilitarian Functionality                   |
| Casa Editrice Bonechi, S.R.L. v. Irving Weisdorf & Co., 95 Civ. 4008 (AGS), 1995 U.S. Dist. LEXIS 12849 (S.D.N.Y. Sept. 6, 1995). | 2              | ?                 | No                | N/A   |
| Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc., 696 F.3d 206 (2d. Cir. 2012).                                  | 2              | Yes               | Yes               | N/A   |
| Mana Prods., Inc. v. Columbia Cosmetics Mfg., 65 F.3d 1063 (2d Cir. 1995).  | 2              | No                | No                | Secondary Meaning                           |
| Forschner Grp., Inc. v. Arrow Trading Co., 124 F.3d 402 (2d Cir. 1997).   | 2              | No                | No                | Secondary Meaning & Likelihood of Confusion |
| Sabert Corp. v. Ullman Co., 99 Civ. 5030 (AGS), 1999 U.S. Dist. LEXIS 18969 (S.D.N.Y. Dec. 7, 1999).                              | 2              | No                | No                | Secondary Meaning & Aesthetic Functionality |
| Cumberland Packing Corp. v. Monsanto Co., 32 F. Supp. 2d 561 (E.D.N.Y. 1999).   | 2              | No                | No                | Secondary Meaning & Competitive Necessity   |
| Club Protector, Inc. v. J.G. Peta, Inc., 01-CV-0191 (NPM/GJD), 2001 U.S. Dist. LEXIS 13050 (N.D.N.Y. Aug. 30, 2001).              | 2              | No                | No                | Secondary Meaning                           |
| Deere & Co. v. MTD Holdings, Inc., 00 Civ.5936 (LMM), 2004 U.S. Dist. LEXIS 2550 (S.D.N.Y. Feb 19, 2004).                         | 2              | No                | Yes               | Competitive Necessity                       |
| Fabrication Enters., Inc. v. Hygenic Corp., 64 F.3d 53 (2d Cir. 1995).  | 2              | ?                 | No                | N/A   |
| Johnson & Johnson v. Actavis Grp. hf, 06 Civ. 8209 (DLC), 2008 U.S. Dist. LEXIS 17680 (S.D.N.Y. Feb. 21, 2008).                   | 2              | ?                 | No                | N/A   |

214. The entries marked with a question mark in the Appendix indicate that the relevant case was either settled out of court or that the final opinion was not published.

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| Winner Int'l LLC v. Omori Enters., Inc., 60 F. Supp. 2d 62 (E.D.N.Y. 1999).   | 2 | ?   | No  | N/A   |
| Shire US Inc. v. Barr Labs. Inc., 329 F.3d 348 (3d Cir. 2003).  | 3 | ?   | No  | N/A   |
| Colur World, LLC v. SmartHealth, Inc., No. 09-00505, 2010 U.S. Dist. LEXIS 5844 (E.D. Pa. Jan 25, 2010).                | 3 | ?   | Yes | N/A   |
| Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc., 26 F. Supp. 2d 834 (E.D. Va. 1998).                                  | 4 | Yes | No  | N/A   |
| Shakespeare Co. v. Silstar Corp. of Am., 906 F. Supp. 997 (D.S.C. 1995).  | 4 | No  | Yes | Utilitarian<br>Functionality<br>& Likelihood<br>of Confusion  |
| Baughman Tile Co. v. Plastic Tubing, Inc., 211 F. Supp. 2d 720 (E.D.N.C. 2002).   | 4 | No  | Yes | Utilitarian<br>Functionality                                  |
| Tex. Tech Univ. v. Spiegelberg, 461 F. Supp. 2d 510 (N.D. Tex. 2006).   | 5 | Yes | No  | N/A   |
| Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465 (5th Cir. 2008).         | 5 | Yes | No  | N/A   |
| Natural Polymer Int'l Corp. v. S & M NuTec, No. 3:03-CV-0461-P, 2004 U.S. Dist. LEXIS 31159 (N.D. Tex. April 27, 2004). | 5 | No  | No  | Secondary<br>Meaning  |
| Poly-Am., L.P. v. Stego Indus., L.L.C., No. 3:08-CV-2224-G, 2011 U.S. Dist. LEXIS 82647 (N.D. Tex. July 27, 2011).      | 5 | No  | No  | Utilitarian<br>Functionality<br>&<br>Competitive<br>Necessity |
| Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc., 679 F.3d 410 (6th Cir. 2012).                                     | 6 | Yes | No  | N/A   |
| Kerr Corp. v. Freeman Mfg. & Supply Co., No. 08-3330, 2009 U.S. App. LEXIS 6342 (6th Cir. March 23, 2009).              | 6 | ?   | No  | N/A   |
| Metro Sanitation, L.L.C. v. C & R Maint., No. 05-70673, 2005 WL 1861931 (E.D. Mich. Aug. 4, 2005).                      | 6 | ?   | No  | N/A   |
| Publ'ns Int'l, Ltd. v. Landoll, Inc., 164 F.3d 337 (7th Cir. 1998).   | 7 | No  | No  | Aesthetic<br>Functionality                                    |

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| Berlin Packaging, LLC v. Stull<br>Techs., Inc., 381 F. Supp. 2d 792<br>(N.D. Ill. 2005).   | 7 | No | No  | Utilitarian<br>Functionality<br>&<br>Competitive<br>Necessity |
| Libman Co. v. Vining Indus., Inc.,<br>69 F.3d 1360 (7th Cir. 1995).  | 7 | No | Yes | Likelihood of<br>Confusion                                    |
| Adjustable Fixture Co. v.<br>Schumaker Lighting, No. 97-C-<br>0972, 1998 U.S. Dist. LEXIS 22051<br>(E.D. Wis. June 17, 1998).                      | 7 | ?  | No  | N/A   |
| Keystone Consol. Indus. Inc. v.<br>Mid-States Distrib. Co., 235 F.<br>Supp. 2d 901 (C.D. Ill. 2002).   | 7 | ?  | Yes | N/A   |
| WMH Tool Grp., Inc. v. Woodstock<br>Int'l, Inc., No. 07-cv-3885, 2009<br>U.S. Dist. LEXIS 125325 (E.D. Ill.<br>Dec. 9, 2009).                      | 7 | ?  | Yes | N/A   |
| Ellison Educ. Equip., Inc. v.<br>Tekservices, Inc., 903 F. Supp.<br>1350 (D. Neb. 1995).   | 8 | No | No  | Secondary<br>Meaning &<br>Likelihood of<br>Confusion          |
| Minn. Mining & Mfg. Co. v.<br>Beautone Specialties, Co., 82 F.<br>Supp. 2d 997 (D. Minn. 2000).  | 8 | ?  | No  | N/A   |
| Marshalltown Trowel Co. v. Walton<br>Tool Co., 4-98-CV-90565, 2000<br>U.S. Dist. LEXIS 22960 (S.D. Iowa<br>Dec. 15, 2000) .                        | 8 | ?  | No  | N/A   |
| S & M Nutec, L.L.C. v. T.F.H.<br>Publ'ns, Inc., No. 03-1033-CV-W-<br>NKL, 04-0615-CV-W-NKL, 2005<br>WL 1224607 (W.D. Mo. May 23,<br>2005).         | 8 | ?  | No  | N/A   |
| MSP Corp. v. Westech Instruments,<br>Inc., 500 F. Supp. 2d 1198 (D.<br>Minn. 2007).  | 8 | ?  | No  | N/A   |
| Minn. Mining & Mfg. Co. v.<br>Shurtape Techs., Inc., CIV. 98-<br>2134 MJD/JGL, 2001 WL 530551<br>(D. Minn. May 17, 2001).                          | 8 | ?  | Yes | N/A   |
| R.H. Donnelley Inc. v. USA<br>Northland Directories, Inc., No. 04-<br>4144 (JNE/SRN), 2004 U.S. Dist.<br>LEXIS 26902, (D. Minn. Nov. 19,<br>2004). | 8 | ?  | Yes | N/A   |

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| 3M Co. v. Intertape Polymer Grp.,<br>423 F. Supp. 2d 958 (D. Minn.<br>2006).   | 8   | ?   | Yes | N/A   |
| SLB Toys USA, Inc. v. Wham-O,<br>Inc., 330 Fed. App'x 634 (9th Cir.<br>2009).  | 9   | Yes | No  | N/A   |
| Solid 21, Inc. v. Breitling USA Inc.,<br>CV 11-0457 GAF (PLAx), 2011<br>U.S. Dist. LEXIS 81004 (C.D. Cal.,<br>July 19, 2011).  | 9   | No  | No  | Competitive<br>Necessity  |
| Sportvision, Inc. v. Sportsmedia<br>Tech. Corp., No. C04-03115 JW,<br>2005 U.S. Dist. LEXIS 22682 (C.D.<br>Cal. Aug. 4, 2005). | 9   | No  | Yes | Competitive<br>Necessity,<br>Utilitarian<br>Functionality<br>& Likelihood<br>of Confusion |
| Acacia, Inc. v. NeoMed, Inc., No.<br>SACV 11-1329-JST (ANx), 2012<br>U.S. Dist. LEXIS 103274 (C.D.<br>Cal. July 23, 2012).     | 9   | No  | Yes | Utilitarian<br>Functionality  |
| Predator Int'l, Inc. v. Gamo<br>Outdoor USA, Inc., 669 F. Supp. 2d<br>1235 (D. Colo. 2009).                                    | 10  | No  | No  | Secondary<br>Meaning &<br>Likelihood of<br>Confusion                                      |
| Dippin' Dots, Inc. v. Frosty Bites<br>Distrib., LLC, 369 F.3d 1197 (11th<br>Cir. 2004).  | 11  | No  | No  | Utilitarian<br>Functionality<br>& Aesthetic<br>Functionality                              |
| Rotoworks Int'l Ltd. v. GrassWorks<br>USA, LLC, 504 F. Supp. 2d 453<br>(W.D. Ark. 2007).                                       | 11  | ?   | No  | N/A   |
| Unique Sports Prods., Inc. v.<br>Babolat VS, 403 F. Supp. 2d 1229<br>(N.D. Ga. 2005).  | 11  | ?   | Yes | N/A   |
| ERBE Elektromedizin GmbH v.<br>Canady Tech. LLC, 629 F.3d 1278<br>(Fed. Cir. 2010).  | Fed | No  | Yes | Secondary<br>Meaning &<br>Utilitarian<br>Functionality                                    |
| Al-Site Corp. v. VSI Int'l, Inc., 174<br>F.3d 1308 (Fed. Cir. 1999).   | Fed | No  | No  | Secondary<br>Meaning,<br>Utilitarian<br>Functionality<br>&<br>Competitive<br>Necessity    |
| L.D. Kichler Co. v. Davoil, Inc.,<br>192 F.3d 1349 (Fed. Cir. 1999).   | Fed | ?   | Yes |   |

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| Newborn Bros. & Co. v. Dripless, Inc., 2002 WL 1899729 (T.T.A.B. 2002).                  | TTAB | Yes | N/A   |
| White Consol. Indus., Inc., v. Royal Appliance Mfg. Co., 2000 WL 713972 (T.T.A.B. 2000). | TTAB | Yes | N/A   |
| <i>In re</i> Hudson News Co., 1996 TTAB LEXIS 16 (T.T.A.B. 1996).                        | TTAB | No  | Secondary Meaning                                 |
| <i>In re</i> Ferris Corp., 2000 TTAB LEXIS 709 (T.T.A.B. 2000).                          | TTAB | No  | Utilitarian Functionality                         |
| <i>In re</i> Orange Commc'n, Inc., 1996 TTAB LEXIS 22 (T.T.A.B. 1996).                   | TTAB | No  | Utilitarian Functionality                         |
| <i>In re</i> Howard S. Leight & Assocs., Inc., 1996 TTAB LEXIS 4 (T.T.A.B. 1996).        | TTAB | No  | Utilitarian Functionality                         |
| Saint-Gobain Corp. v. 3M Co., 2007 WL 2509515 (T.T.A.B. 2007).                           | TTAB | No  | Utilitarian Functionality & Competitive Necessity |
| <i>In re</i> J. Kinkerman & Sons, Inc., 1998 TTAB LEXIS 15 (T.T.A.B. 1998).              | TTAB | No  | Secondary Meaning                                 |

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