

# WHAT COLOR IS YOUR TRADEMARK?

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# I. WHAT IS A COLOR TRADEMARK?

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## Overview

- Definition
- Registration of Color Marks
  - Acquired Distinctiveness
  - Functionality
  - Other Factors
- History
- Supreme Court Recognition of Color Marks
- Functionality Analysis in Cases
- Types of Cases Involving Color Marks



# I. WHAT IS A COLOR TRADEMARK?

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- According to Gilson on Trademarks, color trademarks are nontraditional marks that can be registered “if they have acquired distinctiveness for goods and [are] not functional, color alone can be registered and protected in the same manner as a traditional word or logo trademark.”
- Color trademarks are more difficult to demonstrate distinctiveness than word trademarks.
- Color is especially important when branding a product.

## II. REGISTRATION OF COLOR MARKS

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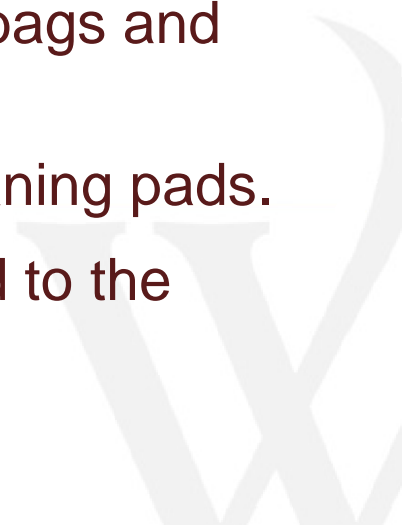
- Color can be integral in marketing products and services.
- A color can serve as a message about a product or service. Examples:
  - Red: energy, strength, power
  - Yellow: joy, happiness
  - Blue: depth, stability
  - Green: nature, harmony, freshness



## II. REGISTRATION cont.

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- The PTO adopted a policy permitting registration of color as a trademark. PTO Manual § 1202.04(e)
- Examples of registered color marks:
  - Owens-Corning owns the color pink as applied to insulation.
  - Tiffany & Co. owns robin's egg blue for boxes, bags and catalog covers.
  - Qualitex owns green-gold as applied to dry cleaning pads.
  - UPS owns the color chocolate brown as applied to the surface of vehicles and uniforms.



## II. REGISTRATION cont.

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- Examples continued:
  - Wiffle Ball, Inc. owns the color yellow as applied to plastic baseball bats.
  - Home Depot owns the a stripe in the color orange as applied to retail home improvement stores.
  - 3M owns the following:
    - ❖ The color “medium blue” for masking tape;
    - ❖ The color white as applied to the earcups of aviation headsets;
    - ❖ The color canary yellow as applied to stationary sticky notes; and
    - ❖ The color yellow for earplugs.

## II. REGISTRATION cont.

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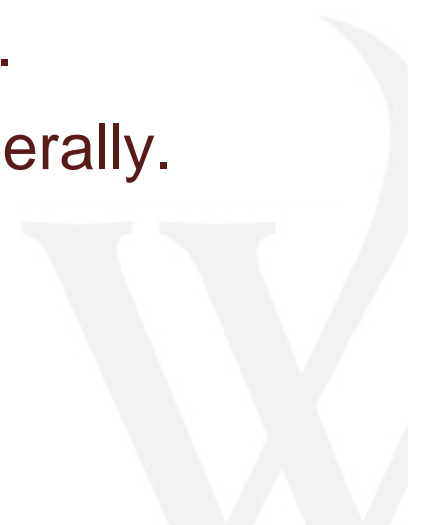
- What does it actually mean to “own a color” – i.e., a trademark registration for a color mark?
  - Companies use language such as “the color yellow is a registered trademark....”



## II. REGISTRATION cont.

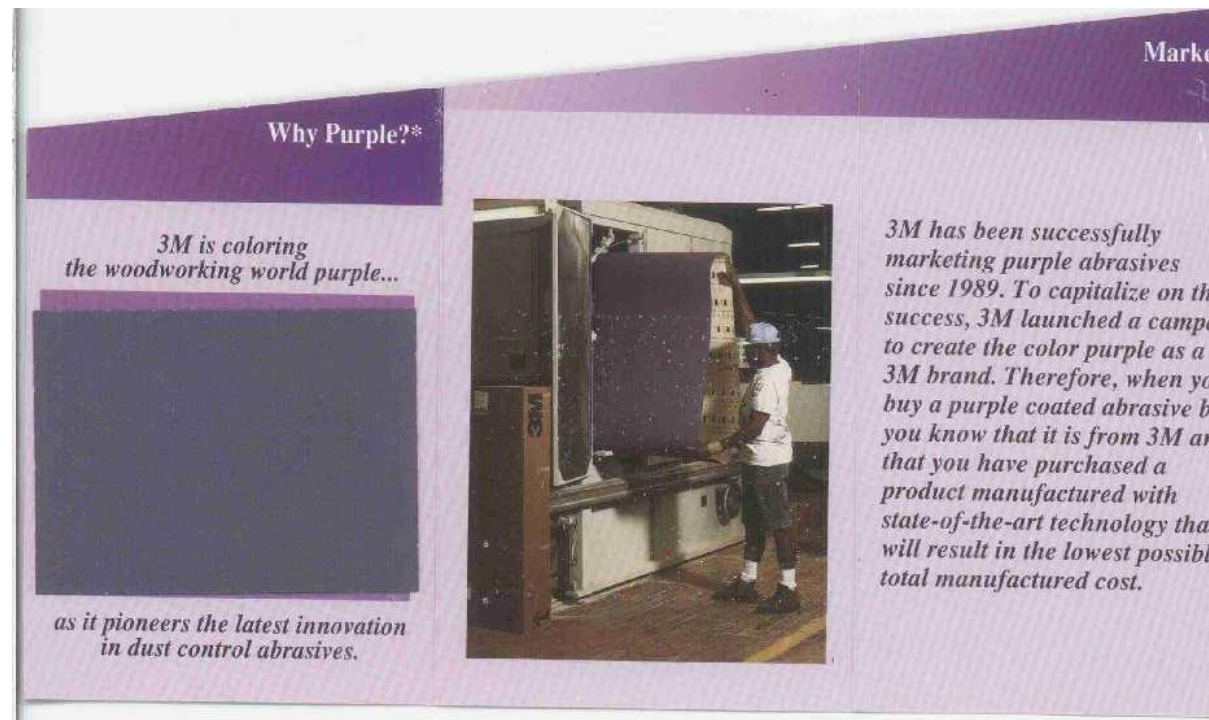
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- Does not mean a company “owns” a color.
  - A color trademark registration can only be secured within narrow parameters.
  - Must be registered in connection with specific products/services applied in a specific way.
  - Example: pink as applied to insulation only.
  - Does not mean they own the color pink generally.



## II. REGISTRATION cont.

- With list of 3M registrations, 3M was unsuccessful in attempting to register the color purple for sandpaper. Why?



## II. REGISTRATION cont.

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- Two Major Hurdles to Registration:  
Acquired Distinctiveness and Functionality
  - Acquired Distinctiveness – Refusal of “failure to function as a trademark.”
  - Functionality – Refusal is color is functional/has a functional component of the goods/services.



## II. REGISTRATION cont.

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- Acquired Distinctiveness:
  - Color marks, as a matter of law, are not inherently distinctive and can only be registered upon a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).
  - An applicant must demonstrate that the color, as applied to the relevant goods or services, has acquired distinctiveness. In other words, that the consumer, upon seeing the color used in connection with the goods or services, views the color as an indicator of source (draws an immediate connection between the color and a single source for the goods or services).

## II. REGISTRATION cont.

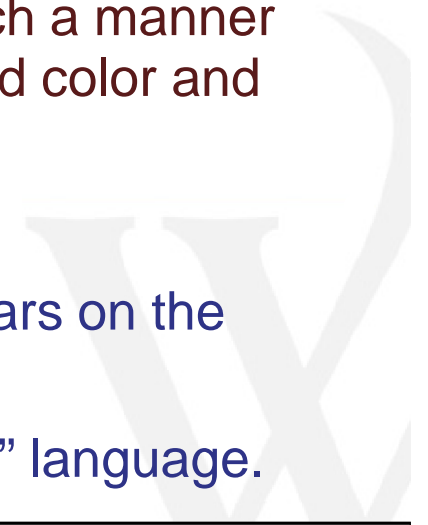
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- How do you show Acquired Distinctiveness?
- Direct and/or circumstantial evidence:
  - Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind (belief the color functions as a trademark).
  - Circumstantial evidence is evidence from which consumer association might be inferred. Examples: (1) long term use; (2) extensive sales and advertising; (3) emphasis on trademark use in advertising; and (4) unsolicited third party recognition.
  - No fixed rule for the amount of evidence necessary to demonstrate Acquired Distinctiveness. However, the Board has held that the burden of proving that a color mark has acquired distinctiveness is substantial. *In re Water Gremlin Co.*, 208 USPQ 89, 91 (CCPA 1980).

## II. REGISTRATION cont.

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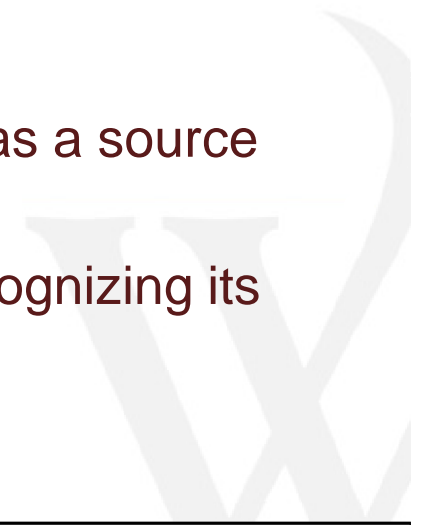
- Direct evidence is the most persuasive, but difficult/expensive to obtain.
- What is the “best” circumstantial evidence?
  - Not generally persuaded by high advertising spend or a long period of use as conclusive evidence;
  - Emphasis on how the color mark being used, i.e., have consumers been exposed to the alleged mark in such a manner to impute consumer association between the claimed color and the product’s producer?
  - Best practice? Promotion as a source indicator:
    - ❖ Advertisements focusing on the color as it appears on the goods; and
    - ❖ Include “look for,” “exclusive,” and/or “distinctive” language.



## II. REGISTRATION cont.

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- Evidence of refusals on Acquired Distinctiveness grounds:
- General Technologies attempted to register the color maroon for steel anchors. PTO refused; Board affirmed refusal. 2(f) evidence included claim of 10 years of use, an assertion as to other colors used by other parties, display on the website and ownership of two Supplemental registrations. Board noted substantial burden and lack of the following evidence:
  - No sales or advertising figures;
  - Nothing showing the color maroon being promoted as a source indicator;
  - No evidence of third party publicity identifying or recognizing its maroon anchors; and
  - No direct evidence.



## II. REGISTRATION cont.

- Lorillard Licensing Company attempted to register the colors green and orange for cigarette packaging. PTO refused; Board affirmed refusal. Evidence included:
  - Two declarations from brand directors with sales and advertising numbers;
  - Evidence that the color mark had been copied by others in parodies or advertising promotions; and
  - 6,500 “form” customer statements and 4,100 “form” dealer statements. The Board did not find this “direct” evidence to be probative due to the form and lack of substance or personalization. Noted it is not the sheer number of statements, but the content that matters.



## II. REGISTRATION cont.

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- Functionality:
- A color may be deemed functional if:
  - It yields a utilitarian advantage;
  - It is more economical to manufacture or use; or
  - It is aesthetically pleasing and helps to improve the salability of the good or service.
  - Examples will be provided in the case law section of the presentation.



## II. REGISTRATION cont.

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Other requirements:

- Description of the mark; example:
  - The marks consists of the color canary yellow as applied to plastic baseball bats.
- Specimen: color photograph showing the manner in which the color mark is used on the goods or services.



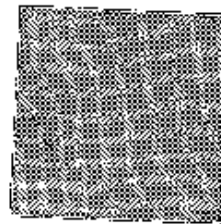
## II. REGISTRATION cont.

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- Drawing of the mark: Two forms
- Drawing that depicts the goods/services on which the color is used:



- For multiple goods or services that cannot be depicted in a drawing, a solid colored square with a dotted peripheral outline:



### III. THE HISTORY OF COLOR TRADEMARKS

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- As far back as 1906, the United Supreme Court was discussing color trademarks. *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*
  - Trademark at issue was “a red or other distinctively colored streak applied to or woven in different color from the other strands of the rope.”
  - Denied the validity of this expansive trademark.



### III. HISTORY cont.

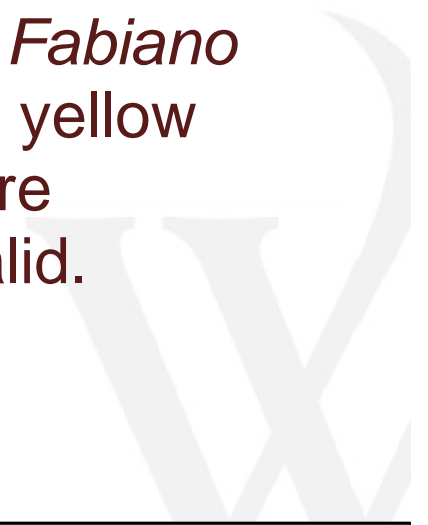
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- If the trademark were restricted to a strand of red, perhaps it might be sustained.
- Court would not sustain a trademark for a strand of *any color* in a wire rope.
- “Whether mere color can constitute a valid trademark may admit doubt.”
- “Doubtless [mere color] may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this.”

### III. HISTORY cont.

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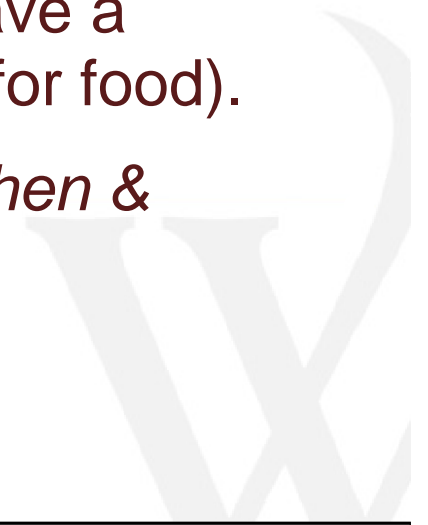
- **Adoption of the Lanham Trademark Act of 1946** – color marks were no longer barred from registration
- Most courts still did not recognize trademarks related to color alone, but would recognize trademarks based on color in combination with a distinctive arbitrary design.
  - The First Circuit in *Quabaug Rubber Co. v. Fabiano Shoe Co.*, found trademark registration of a yellow label on the soles of boots had become more distinctive based on advertising and was valid.



### III. HISTORY cont.

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- Many courts refused to recognize color trademarks based on the color depletion theory.
  - If a particular company could monopolize a certain color for its product in all its shades then “the list of colors will soon run out.” See *Campbell Soup Co. v. Armour & Co.*, (not allowing Campbell to have a trademark for red and white colored labels for food).
  - Courts often focused on dicta from *A. Leschen & Sons Rope Co.*



## IV. COLOR TRADEMARKS ARE RECOGNIZED

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- In 1985, the Federal Circuit explicitly recognized color trademarks. *In re Owens-Corning Fiberglas Corp.*
  - Attempted to register a trademark for the color “pink” in connection with its fibrous glass insulation.
  - Pink insulation was not functional.
  - No competitive need for pink; court rejected “the color depletion argument [a]s an unreasonable restriction on the protection of trademark rights.”



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- Following the *Owens Corning* case, Congress broadened the definition of trademark retaining the words “symbol or device’ so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks.” *S. Rep. No. 100-515.*



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- Circuit courts were divided regarding following *Owens Corning* or denying protection to color trademarks based on the color depletion theory and *A. Leschen & Sons Rope Co.*



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- Our own Eighth Circuit recognized that there was no per se rule prohibiting trademark protection for color alone in *Master Distributors, Inc. v. Pako Corp.*
  - Reversed district court.
  - If plaintiff could “establish all the normal trademark requirements in the blue color of its Blue Max leader splicing tape, that shade may be protected against infringement.”



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- ❖ Rejected color depletion theory: “[u]ntil secondary meaning has been established in every distinguishable shade of color and in no color at all, a highly improbable situation, there will be an option available to a new market entrant.”
- ❖ Rejected shade confusion theory: “Although protecting particular shades of color may result in some shade confusion problems, . . . distinguishing color shades is similar to comparing slogans, symbols, numbers or words.”



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- Although not deciding whether color alone could be a trademark, the First Circuit in *The Keds Corp. v. Renee Int'l Trading Corp.*, held that trademark for color blue with a distinctive design of a rectangle placed on heels or insteps of canvas shoes was valid.
  - Defendant “argue[d] that functionality is similar to a name being generic so that by analogy, it should also be a defense to an infringement claim.”



## IV. COLOR TRADEMARKS ARE RECOGNIZED cont.

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- **Functionality analysis:**
  - ❖ (1) whether the label is functional, and
  - ❖ (2) whether the “color blue for sneakers is needed . . . to compete effectively in the sneakers industry.”
    - First Circuit answered “no” to both.



## V. THE UNITED STATES SUPREME COURT EXPLICITLY RECOGNIZED COLOR TRADEMARKS

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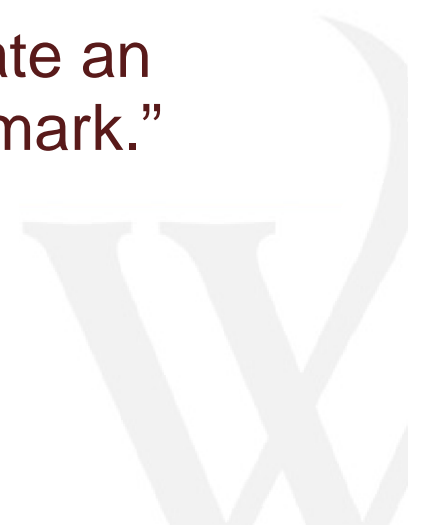
- The United States Supreme Court recognized color trademarks as legitimate in the landmark case. *Qualitex Co. v. Jacobson Prods. Co.*
  - Lanham Act permitted registration of a trademark that consisted simply of color.
  - Trademark of a particular shade of green-gold for dry cleaning press pads.



## V. THE UNITED STATES SUPREME COURT EXPLICITLY RECOGNIZED COLOR TRADEMARKS cont.

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- Reversed the Ninth Circuit: “we cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained ‘secondary meaning’ and therefore identifies and distinguishes a particular brand (and thus indicates its ‘source’).”
- “The doctrine of ‘functionality’ does not create an absolute bar to the use of color alone as a mark.”



## V. THE UNITED STATES SUPREME COURT EXPLICITLY RECOGNIZED COLOR TRADEMARKS cont.

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- Rejected arguments made by defendant as to why a trademark of color alone should be forbidden.
- ❖ Uncertainty as to shades of colors: Courts have to make these same determinations when comparing words to see if they are sufficiently similar so as to confuse buyers.



## V. THE UNITED STATES SUPREME COURT EXPLICITLY RECOGNIZED COLOR TRADEMARKS cont.

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- ❖ Color depletion theory: a limited supply of colors.
  - A blanket prohibition is not justified.
  - “When a color serves as a mark, normally alternative colors will likely be available for similar use.”
  - Functionality doctrine would prevent anticompetitive problems if there were actual color scarcity issues.



## VI. IS COLOR A FUNCTIONAL FEATURE?

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- Defense of Functionality:
  - “. . . forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature ‘is essential to the use or purpose of the article’ or ‘affects [its] cost or quality.’ *Qualitex Co.*
  - “protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation related product features.”

## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- Federal Circuit described the de facto and de jure functionality tests in *Brunswick Corp. v. British Seagull*
  - “. . . de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid.”
  - “De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape.”



## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- “[T]he ‘crux’ of the distinction between de facto and de jure functionality-determining eligibility for trademark protection or not-is a design’s effect on competition.”



## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- Registration refused because the color “‘black’ when applied to out-board marine engines, is de jure functional because of competitive need.”
- Although not making the engines function better, “the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller.”



## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- Examples of color trademarks examined as to functionality:
  - ❖ *ERBE Electromedizin GmbH v. Canady Tech., LLC*, (invalidating trademark for blue and black on the tube portion of a probe, because the color blue was functional based on making the probe more visible through an endoscopic camera or that such a color mark might lead to anti-competitive effects).



## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- ❖ *Gateway, Inc. v. Companion Prods.*, (denying summary judgment motion on functionality because defendant presented no evidence that its use of black and white spots on computer cow wrap is essential to the use or purpose of a stretch pet and that a brown, red, or black cow are equally as useful).



## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- ❖ *Unique Sports Prods., Inc. v. Ferrari Importing Co.*, (rejecting defendant's functionality defense for the light blue trademark for a racket over grip because it was not shown that the color decreased absorbency or increased performance and was not a competitive necessity to use light blue).
- ❖ *Poly-Am., LP v. Stego Indus., LLC*, (holding that yellow trademark for vapor barrier was de jure functional in that there were utilitarian benefits including a safer environment by attracting less heat and contrasting well with dark soil enabling tears to be repaired; and was therefore, not legally protectable).

## VI. IS COLOR A FUNCTIONAL FEATURE? cont.

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- ❖ *Deere & Co. v. Farmhand, Inc.*, (affirming that green was functional for loaders because farmers prefer to match their loaders to their tractors and was therefore not protectable).
- ❖ *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, (finding pink color for Pepto-Bismol may have functioned to soothe patient's suffering and therefore was not protectable.)



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS

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- Local Company 3M Has Long Recognized The Importance of Registering Color Trademarks.
  - *Minn. Mining & Mfg. Co. v. Shurtape Techs, Inc.*, involved objections to a R&R related to a settlement agreement.
  - Upholding the agreement, “the [c]ourt conclude[d] that [d]efendants had not presented sufficient evidence to demonstrate that it would be impossible to produce a blue tape outside the color boundaries agreed upon by the parties.”

## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- Responding to another 3M lawsuit, a competing tape manufacturer argued functionality of blue on painter's tape. *Minn. Mining & Mfg. Co. v. Intertape Polymer Group*.
- ❖ Declined to grant summary judgment: “if the color blue does in fact affect the UV-resistance of the tape, then the color blue may serve utilitarian purposes that affect competition, rendering the color functional and not protectable.”
- ❖ “[W]hether the color blue is functional here depends, at least in part, on the existence of an industry-wide color code, and the magnitude of the costs to competition if competitors are precluded from using it.”

## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- 3M lawsuit to protect its trademark registration for the canary yellow color used with adhesive notes. *Minn. Mining & Mfg. Co. v. Beautone Specialties Co.*
  - In determining functionality, courts assess whether similarly beneficial alternative colors are available.



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- ❖ Defendant claimed that canary yellow is superior to other alternative colors on the basis of cost, legibility, eyestrain reduction, aesthetic and others.
- ❖ 3M entered evidence that canary yellow provides no special benefit.
- ❖ The court found that there were material facts on the functionality of the color yellow.



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- Genuine issue of fact: whether there is a secondary meaning for the color because the primary significance of canary yellow is to identify 3M as the source of the sticky note.
  - ❖ This relates to acquired distinctiveness discussed earlier.



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- **The Fashion/Retail World Recognizes the Importance of Color Trademarks.**
  - *Solid 21 v. Breitling USA Inc.*, involved a color mark for “the amber hue gold alloy” the company had developed for its jewelry and watches.



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- ❖ Plaintiff had not alleged sufficient facts that its “gold with the amber hue” was non-functional.
- ❖ Needed to allege facts “showing that protecting its use of the amber gold color would not ‘impose a significant non-reputation-related competitive disadvantage.’”
- ❖ Allowed plaintiff to amend to plead sufficient facts to show color mark was not functional.



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- A Southern District of New York case dealt a blow to color trademarks in fashion earlier this year.  
*Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*
  - ❖ The trademark was for a red sole on footwear.
  - ❖ “Aesthetic appeal can be functional; often we value products for their looks.”



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- ❖ Louboutin acknowledged that “the red gives his shoe energy and that the color attracts men to women who wear my shoes.”
- ❖ The use of red outsoles also affected the costs of the shoe.
- ❖ Granting trademark rights to this use of red would “significantly hinder competition,” that is, “permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.”

## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- ❖ Declining to find a likelihood of success to enjoin: “the [c]ourt c[ould] not conceive that the Lanham Act could serve as the source of the broad spectrum of absurdities that would follow recognition of a trademark for the use of a single color for fashion items.”



## VII. TYPES OF CASES INVOLVING COLOR TRADEMARKS cont.

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- ❖ The case has now been appealed to the Second Circuit.
  - Tiffany & Co., obviously concerned about its own trademark for the beautiful robin's egg blue, filed an amicus curiae brief in support of Louboutin.
  - The International Trademark Association (INTA) has also filed an amicus curiae brief in support of Louboutin.



# CONCLUSION

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- In sum, colors are an exciting area for trademark attorneys to advise their clients in both registering such marks and enforcing their clients' rights to protect their brands.



**Any Questions??**

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**THANK YOU**



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