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颜色商标在美国的保护

一. 简介

颜色可以传递一种信息，比如黄色的出租车、红色的交通信号。那么，颜色被用于传递商品或服务的信息就不足为奇，即颜色常被用于商标和服务标识。颜色不仅仅是商标的重要组成部分，只要符合1995年最高法院对Qualitex一案的判决条件，颜色本身也受保护。需特别指出的是，颜色必须具有显著性，并且在商品和服务中不具有功能性。

另外重要的一点是对颜色商标的定义。为此，美国专利商标局曾出台相关法规和案例汇编，要求商标注册时要对相关图形、商品和服务进行描述，以定义商标。另一方面，最近联邦上诉法院对Smack Apparel一案的判决显示法院给予商标权利人很大自由来定义其颜色商标以便于执法。

二. Qualitex Co. v. Jacobson Prods. Co.案

面对联邦上诉法院存在争议的问题——颜色是否可独立作为商标。美国最高法院对Qualitex Co. v. Jacobson Prods. Co.案（514 U.S. 第159页：1995年）进行了听证。Qualitex一案发生前，巡回法院对颜色是否应受到保护产生了争议。高等法院对这一问题进行了确认，一致认为“没有相关法规完全禁止对颜色进行独立使用。”

Qualitex一案涉及到一种特别的金绿色，从20世纪50年代起就被Qualitex公司用于一种干洗清洁垫。之后，其竞争对手Jacobson公司开始出售使用这一金绿色的竞争产品，Qualitex公司起诉Jacobson公司侵犯其商标权，因为他们已经在美国专利商标局对这种用于垫子的颜色进行了注册。

考虑颜色是否合乎商标保护条件时，最高法院注意到《兰哈姆法》中：“如果申请人使用的商标对其商品而言具有显著性，应予以批准。”（《美国法典》第15篇第1052节f款）。法院注意到，“标志”可以由“文字、名称、符号和图案”构成，这很明显包括了颜色。

之后，最高法院规定对商标颜色进行单独保护。任何商标的颜色标志都必须首先可用于与其他产品或商品进行区分，并且必须可表明商品来源，即使来源是不可知的。（《美国法典》第15篇第1127节）。

法院将颜色归类于“显著标志”，而实际上颜色并不能

表明商品来源。对此规定有一种假设——名称或颜色都有其他用途，而不是为了表明来源。但是，法院认为正如其他显著标志一样，颜色可通过其“第二含义”来识别、区分和表示商品来源。法院解释，当“公众认为关于商品的特征……最重要的一点是确认商品来源，而非商品本身”时，才适用“第二含义”。（Qualitex案，514 U.S. 第163页）。

法院的第二点要求是被保护的标志应当不具有功能性。法院解释：“对功能性的规定可通过允许生产者控制一种产品的功能，避免商标法对合法竞争的阻碍。”最高法院再次重申其对功能性的规定“如果一件商品的特征是其用途或功能的必要条件，或者会影响到商品的价格和质量，则其特征被认定为有功能性。”审理Qualitex一案的法院表示，有时颜色并非商品用途或功能的必要条件，也不影响价格和质量，不能对颜色标志的“功能性”要求进行统一限制。

三. Qualitex案和其结果

1. 第二含义

Qualitex案中对颜色标志的规定被用于之后的案件，包括刀具、铲草机、抗生素包装、人造糖精和鞋。

在Forschner Group, Inc. v. Arrow Trading Co., Inc.一案中（124 F.3d 第402页：联邦巡回法院第二次巡回1997年），第二巡回中，上诉法院认为原告Forschner公司应用于瑞士军刀的红色具有显著性。因缺乏显著性的相关信息，法庭指出，在过去的近40年中，至少有三家其他公司销售红色刀柄的多功能刀具，其中一些被消费者当作瑞士军刀。“像这样，用于多功能刀具的红色商业外观并不能表明Forschner公司是这种商品的唯一来源，也不能区分Forschner公司的产品和其竞争对手的产品。”所以，巡回法院认为不符合“第二含义”，对这种红色不予保护。

另一方面，颜色商标权利人知道如何获得显著性。如Deere & Co. v. MTD Holdings Inc.一案中（70 USPQ2d 第1009页：S.D.N.Y. 2004年），Deere公司试图保护其注册商标和商业外观，是由绿色和黄色构成的铲草机和园艺设备。地方法院认为，Deere公司必须证明其“第二含义”并列以下要素：（1）广告费用；（2）消费者认为此商标与商品来源有关；

(3) 媒体对此商品的报道；(4) 销量，(5) 其他人对此商标的抄袭意图；(6) 此商标的使用年限和排他性。

Deere公司证明了其黄绿商标的“第二含义”。此商标的使用年限可追溯至20世纪早期的农产品和1963年的铲草机和园艺设备。1992年至2001年十年间，Deere公司花费了近5亿美元对其黄绿商标进行广告宣传。有很多媒体对其进行了报道，百分之九十以上的问卷认为黄绿色商标的铲草机是由Deere公司制造的。后来，Deere公司的农艺设备和铲草机在1992年至2001年间销售额达到了430亿美元，符合法院对销售额的要求。这些事实使法院相信Deere公司的黄绿色商标具有显著性，符合“第二含义”的要求。

以上联邦上诉法院和初审法院的案件表明，对颜色商标“第二含义”的认定与其他商标的认定相似。无论是对刀具还是铲草机而言，“第二含义”是以消费者认知为基础的基本考量因素，并且经常会通过调查证据、广告花费、媒体报道和销售额进行体现。

2. 功能性

Qualitex一案后，对功能性的要求引起了广泛关注。在Traffix Devices, Inc. v. Marketing Displays, Inc.一案中(532 U.S. 第23、33页；2001年)，最高法院对这一点再次进行了衡量，指出了两种功能：常规功能和美学功能。常规功能指商品的物理和实用功能。美学功能指保护产品外观是否会竞争对手处于毫无声誉可言的不利地位。法院以颜色是否具有功能性来决定是否具有美学功能或常规功能。

与“第二含义”相比，功能性被认为是保护商标时更严重的障碍。法院常常认为颜色只会起到一定效果，并不会表示来源。但是，以下案件中用于药物和书籍装订的颜色商标却未受到保护。另一方面，计算机配件、铲草机和园艺设备的商标受到了保护。

在Shire U.S., Inc. v. Barr Labs., Inc.一案中(329 F.3d 第348页；联邦巡回法院第三次巡回2003年)，第三次巡回中，上诉法院发现用于药物的颜色具有功能性，所以不应予以商标保护。Shire公司的药物为蓝色或桔色，可以表示用药剂量。之后，Shire公司用颜色和形状共同表示用药剂量，将蓝色、灰白色、桔色和桃红色与圆形和椭圆形结合起来。

在Shire公司诉 Barr一案中，非专利药生产商Barr使用了与Shire公司相同颜色，上诉法院认为此案中的颜色具有功能性。法院以专家的证言为证据，认为多动症患者十分依赖视觉信号，他们依靠颜色来确认剂量可以减少混淆。因此，由于颜色在此案中有确认药物剂量的功能，而不是表示来源，法庭对此颜色标志不予保护。

在Publ'ns Int'l Ltd. v. Landoll一案中(164 F.3d 第337页；联邦巡回法院第七次巡回1998年)，第七次巡回中，上诉法院发现书籍装订中使用的金色具有功能性。Posner审判长认为金色既有美学功能又有常规功能特质。

“产品本身或其包装使用金色具有美学功能……可以使产品更吸引人购买，与识别来源无关。金色象征着财富……用于书籍装订已久，书脊也常用金色装饰。金色常用于精装烹饪书籍。PIL公司的书页尾的颜色更可以说表示的是来源。”因此，由于金色被认为有功能性，不予保护。

如果颜色商标权利人可以成功使商标颜色不具有功能性，他们即可清楚表示颜色的商标用途。在Gateway, Inc. v. Companion Prods, Inc.一案中(384 F.3d 第503页；联邦巡回法院第八次巡回 2004年)，第八次巡回，中上诉法院认为Gateway公司的黑白点奶牛标志计算机包装商业外观具有功能性。如果黑白点奶牛标志具有功能性，Companion Prods公司就可以免费将其用于自己的绒毛牛计算机配件上。法院认为：“此设计的纯装饰性功能不会对Gateway的电脑性能产生任何影响。当然，没有消费者会相信这一设计会影响Gateway电脑的电子元件和其他配件。”之后，法院转向“美学功能”。

“Gateway电脑的商业外观不能阻止Companion Prods公司将其其他颜色和设计用于其计算机装饰产品。与其他相同产品的制造商相比，他们并没有受到损害，因为其他公司不可以使用Gateway受到保护的商业外观。”

在Deere一案中，纽约南区法院认为其黄绿色具有“美学功能”，不对黄绿色基础色进行保护，阻碍其他竞争者的设计进入市场。“Deere公司不对黄绿色标志享有排他权，只要MTD公司不将黄绿色使用于与Deere公司相似的铲草机和园艺设备引起混淆，Deere就不能阻止MTD公司使用这一颜色。”(Deere案, 70 USPQ2d 第1017页)。“被告曾担心Deere会通过黄绿色标志的独占权垄断市场，这一结论消除了被告的担心。”

这些判例进一步发展了Qualitex一案对颜色商标功能性的规定。商标权利人需要证明其标志既不具有“常规功能”又不具有“美学功能”，以获得保护。

四. 对商标的定义

对商标权利人的另一挑战是对商标自身进行定义。美国专利商标局在颁布注册要求时，以Qualitex案为参考要求证明商标的显著性和不具有功能性。专利商标局进一步要求对颜色商标和商品或服务进行详细描述。但近期一项联邦上诉法院的决定建议，即使是没有进行明确定义和不应予以注册的颜色也可受到保护，这一决议使得问题更加复杂。

1. 美国专利商标局的注册要求

为强调可注册性和可保护性的区别，需要特别注意。商标权不是来自于注册，商标权利人通过对商标的使用已经享有了商标权。这就是美国商标法以使用为基础制度的体现。但是，注册商标仍有很重要的法律优势。在美国专利商标局进行注册，便可获得商标所有权证据并使商标具有有效性，即商标具有显著性，并且不具有功能性。注册商标也可帮助商标权利人在诉讼中处于有利地位，在假冒案中减少损失。

美国专利商标局主注册簿中的只由颜色构成的商标有不少。在主注册簿进行注册就意味着颜色商标不仅仅获得了专利商标局的认可，不具有功能性，还意味着符合“第二含义”要求，具有显著性。详情参见以下图片：

美国专利商标局对注册颜色商标的要求与Qualitex一案密切相关。商标审查指南指出颜色商标本身并不具有显著性，经常需要对商标的显著性在主注册簿进行注册。商标审查指南也要求颜色商标不具有功能性。但是，申请和审查过程中还有其他特殊要求。专利商标局进一步要求颜色要用于特定



1



2



3



4



5

图1（注册号3,535,474），棕灰色钢板

图2（注册号3,400,476 & 3,400,477），桔色发动机罩和灰色扇叶

图3（注册号3,315,445），红黑色卡车

图4（注册号3,297,309），蓝色、红色和黄色条纹客机

图5（注册号3,243,999 & 3,267,984），白色、红色、黄色和蓝色T恤和帽子

商品和服务，部分是由于申请和审查过程十分严格，需要提供商标的图形、文字和样本。

不仅仅需要遵循过程中的要求，美国专利商标局对图形和文字描述的要求源于严格的公共准则“向公众提供待注册商标特征说明”。（商标审查指南，1202.05d.）。专利商标局要求对颜色商标图形的描述包括对颜色出现位置的单独描述和如何进行使用的描述。加上对用于商品或服务的特定颜色的文字描述，便可避免“有名无实”的商标进行注册，即有些商标通过改变用途，违背专利商标局禁止每次申请注册超过一个以上商标的规定。

联邦巡回法院在以下案件中遇到了此问题。在In Re Thrifty Inc.一案中（274 F.3d 第1349页：联邦巡回法院2001年），法院认为商标评审与申诉委员会没有通过Thrifty公司对其汽车租赁中心、标志和员工工作服蓝色的注册是合理的。问题在于，Thrifty公司的申请图是由虚线组成的建筑，墙壁上部是蓝色，这与Thrifty公司对商标的描述不符，其租赁中心、汽车、标志、工作服和其他广告中的蓝色在摘要中都被描述为“用蓝色的实线”表示。

美国专利商标局拒绝了Thrifty公司的申请是由于描述与图片不符。“由多样商品引出的多样特征导致描述与最初对建筑颜色的描述不符。描述的多种形式……不能显示其与最初申请中对建筑的描述相同。”美国专利商标局、商标审判上诉委员会和联邦巡回法院本来认为可对Thrifty公司用于墙壁和道路的可以传递商业信息的蓝色进行保护。但是由于Thrifty公司试图在一项只显示了蓝色墙壁的申请中进行多项申请，没有通过。

因此，美国专利商标局对图形和描述的要求加上对“有名无实”商标的禁止，可对公众进行商标特征和范围说明。但是，近期的La. State Uni v. Agric. 和 Mech. Coll. v. Smack Apparel Co.案中（550 F.3d 第465页：联邦巡回法院第五次巡回2008年），法院认为颜色商标权利人执行时没必要对其商标进行如此定义。

2. Smack Apparel案

从1998年起，Smack Apparel公司就针对大学运动团体的“粉丝”生产并销售T恤，使用了与学校相关的颜色和信。而这些T恤并没有使用学校的名字或标志。根据之前学校的习惯做法，Smack公司认为其没有使用学校的注册商标就避免了潜在的商标侵权可能性。但是，Smack公司的产品确实通过与其他标志结合，体现了知名学校的相关颜色。

2004年，路易斯安那州立大学、南加州大学、俄克拉何马大学、俄亥俄州立大学和Collegiate Licensing公司（以下统称为大学）在路易斯安那州东区法院对Smack公司提起上诉。这些大学很快获得胜诉。地区法院在判决中称Smack应负责任，之后Smack公司在联邦上诉法院第五次巡回中提出上诉。

第五次巡回之前的问题集中在这些大学对标志的合法拥有权，如果存在侵权，问题就集中在Smack公司的T恤与这些大学校服的相似性是否会造成混淆。法院对以下因素进行了考量：对颜色的长久使用、颜色对商品的重要性、众所周知的颜色代表学校的特性、与团体成绩和分数的相关性与地理位置的相关性。在T恤上，这种使用具有“第二含义”。

第五次巡回认定这一相似性会造成混淆，是因为考虑到Smack公司和这些大学的授权产品有相似性，做广告的方法和

卖点也有重合，同时Smack公司也试图通过这些大学的声望获利。这些混淆点很容易使消费者将二者联系起来，因此，不允许Smack公司随意使用相似外观。

从某种意义上说，Smack一案可以看做是Qualitex一案的延伸，保护了颜色组合和颜色本身。另一方面，Smack一案中的标志最终受到了保护，即使其标志在美国专利商标局不可注册。Smack一案的审理法院认为其颜色组合和总在变化的标准可以受到保护，尽管无疑会违背专利商标局禁止“有名无实”商标的准则。在以使用为先的商标制度下，也许有人会疑问是什么使这些大学受到保护。这些大学认为他们的商标含在象征学校的颜色组合中，即“商品中与学校相关的识别要素”。（Smack案，550 F.3d 第475页）。但不明确的“识别要素”并不向公众进行说明。Smack公司的侵权T恤中，“识别要素”是指有名的体育成绩或赛季成绩，还有运动会和学校名称都可以作为这些大学的“识别要素”。

而且，商品本身就可以作为一种识别要素。如象征路易斯安那州立大学的金红色橄榄球和南加州大学的金红色旗都是商品，足以受到保护。

Smack一案看似回避了注册要求，受到保护的商标和声称应受保护的商标外观有相似性，没有遵守普通法对商标实际使用的要求，仅仅以想象中的使用为保护依据。Smack一案是否会使颜色商标的保护范围更加广泛，还是仅限于此案，还不可知。

五. 结论

可以这样说，从桃红色的玻璃纤维绝缘材料到金红色的运动服，近30年的美国商标史是多样化的。Qualitex案建立了对颜色商标进行评价的法律框架，要求其他商标也满足同样的基本要求，即颜色具有显著性和非功能性。之后的判例法进一步发展了这一框架，提出了“第二含义”、“常规功能”和“美学功能”。美国专利商标局在注册颜色商标时将这些要素进行比较，要求提供图和描述以对商标进行定义，提供的明确的指导。

但是，回到20世纪20年代，颜色商标刚刚开始出现。Smack一案对颜色商标组合进行了定义，认为有第二含义的商标应受到保护。在多变的法律环境中，颜色商标的保护、注册和执行应被予以足够重视。IP

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□ By H. David Starr and Gregory G. Bennett

Trademark Protection of Color Marks in the United States

I. Introduction

Color can communicate information, such as yellow of a taxicab or red of traffic signs. It should be no wonder, then, that color is often used to communicate the origin of goods and services—that is, used in trademarks and service marks. Not only is color often an important element of a trademark, color itself can be accorded full trademark protection provided certain requirements are met as set forth in the Supreme Court’s 1995 *Qualitex* decision. Particularly, the color mark must have acquired distinctiveness and cannot be a functional element of the goods or services.

Another important issue in the context of color marks is the defining of the mark itself. In this regard, the U.S. Patent and Trademark Office [“PTO”] has promulgated regulations and case law for registration of a color mark that require defining the mark by reference to a single drawing and referencing specific goods or services. On the other hand, the recent federal appellate court decision, *Smack Apparel*, appears to give owners extraordinarily wide latitude in defining their color marks for enforcement purposes.

II. *Qualitex Co. v. Jacobson Prods. Co.*

Facing a clear split among the federal appellate courts’ treatment of whether color alone can act as a trademark, the Supreme Court of the United States heard *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995). Before *Qualitex*, the Circuits had been split regarding whether color alone could be accorded protection. The high court settled the issue, unanimously holding that “there is no rule absolutely barring the use of color alone.” *Id.* at 160.

Qualitex involved a unique shade of green-gold that Qualitex Co. had been using on dry cleaning pads since the 1950s. After competitor Jacobson began selling competing products using that shade of green-gold, *Qualitex* sued for trademark infringement, having registered the color for press pads with the PTO.

Considering whether color was eligible for trademark protection, the Supreme Court focused on the language of the *Lanham Act*. “Nothing . . . shall prevent the registration

of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f). The Court noted that “a mark,” defined as any “word, name, symbol or device” had certainly come to include color.

The Supreme Court then established the requirements for according trademark protection to color alone. As with any mark, a color mark must first and foremost be capable of identifying and distinguishing goods from those manufactured or sold by others. It must be capable of indicating the source of those goods, even if the source is unknown. 15 U.S.C. § 1127.

The Court analogized color to the category of “descriptive marks,” which are never inherently capable of indicating source. For such categories, there is an assumption that the term—or color—was adopted for purposes other than to identify source. The Court recognized, however, that color, like descriptive marks, could come to identify, distinguish, and indicate the good’s source through “secondary meaning.” “Secondary meaning,” the Court explained, is acquired when, “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.” *Qualitex*, 514 U.S. at 163.

As a second requirement, the Court allowed protection of color marks only for those that—like all trademarks—are not functional. “The functionality doctrine,” it explained, “prevents trademark law . . . from . . . inhibiting legitimate competition by allowing a producer to control a useful product feature.” *Id.* at 164. The Supreme Court reasserted its established functionality standard, stating that “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* at 165. The *Qualitex* Court, noting that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality, found no universal “functional” bar to color marks. *Id.* at 164.

III. *Qualitex* and its progeny

1. Secondary meaning

Subsequent cases have applied the two *Qualitex* requirements to color-related marks, including pocket knives, lawn equipment, packaging for antibiotics and artificial

sweeteners, and shoes.

In the *Forschner Group, Inc. v. Arrow Trading Co., Inc.*, 124 F.3d 402 (2d Cir. 1997), the Court of Appeals for the Second Circuit addressed whether the color red on Swiss Army-style knives had come to identify plaintiff Forschner Group, Inc.. In finding acquired distinctiveness to be lacking, the court pointed to evidence that for nearly forty years at least three other companies marketed red-handled multifunction pocket knives, some of which had become known to the purchasing public as “Swiss Army knives.” “As such, the trade dress consisting of the color red as applied to multifunction pocketknives does not serve to primarily designate Forschner as the single source of the product nor does it serve to distinguish Forschner’s product from those of its competitors.” *Id.* at 408. Thus, the Second Circuit denied protection to the color red because “secondary meaning” was lacking.

On the other hand, color mark owners have found success in establishing acquired distinctiveness. For example, in *Deere & Co. v. MTD Holdings Inc.*, 70 USPQ2d 1009 (S.D.N.Y. 2004), *Deere & Company* [“Deere”] sought to enforce its registered trademarks and trade dress comprising solely the colors green and yellow for lawn and garden equipment. The District Court stated that Deere must show “secondary meaning” and enumerated the following factors: (1) advertising expenditures, (2) consumer studies linking the mark to the source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark’s use.

Deere succeeded in showing “secondary meaning” with respect to its use of green and yellow as a trademark. The length of use reached back to the early 1900s on agricultural products and to 1963 on lawn and garden products. In the ten years between 1992 and 2001 it spent nearly USD 500 million on advertising products bearing the green and yellow. There had been significant media coverage, and over ninety percent of those polled identified green and yellow lawn products as being made by Deere. Finally, Deere’s sales of agricultural and lawn and garden products totaling over forty-three billion dollars between 1992 and 2001 satisfied the Court of sales success. In total, these facts convinced the Court that Deere’s green and yellow were distinctive through “secondary meaning.”

These federal appellate and trial court cases show that the determination of “secondary meaning” for color marks is similar to the same consideration for any mark. Whether for pocket knives or lawn equipment, “secondary meaning” is a factual consideration based on consumer recognition, and is usually demonstrated through survey evidence, advertising expenditures, and media and sales success.

2. Functionality

Following *Qualitex*, the functionality doctrine received substantial attention. The Supreme Court weighed in on it again in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001) delineating two clear types of functionality: “traditional” and “aesthetic.” The “traditional” variety relates to the physical, utilitarian characteristics of the goods. “Aesthetic” functionality, on the other hand, considers whether

protecting the feature from infringement will place competitors at a significant non-reputation-related disadvantage. Whether “aesthetic” or “functional,” courts have dealt with the question of whether color is functional.

Functionality has proven to be a more serious obstacle to protection than “secondary meaning.” Courts are often cognizant that color was adopted for, or has come to serve, purposes other than source identification. Thus, in the cases discussed below, color marks have been denied protection for medication and book binding. On the other hand, protection has been accorded to computer accessories and lawn and garden products.

In *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348 (3rd Cir. 2003) the Court of Appeals for the Third Circuit found that color for medication served a functional purpose and was, therefore, ineligible for trademark protection. *Shire U.S., Inc.*’s [“Shire”] medication came in blue or orange, indicating dosage strength. Shire later began to use color in combination with shape to accommodate a greater range of dosage; combinations of blue or pale orange/peach and round or oval.

In Shire’s suit against Barr, a manufacturer of generic versions of the medication using the same color scheme, the Court of Appeals held that the colors were functional. The Court relied on expert testimony that ADHD patients place particular emphasis on visual cues and their relying on color to identify dosage during adjustment would decrease in patient confusion. Accordingly, because colors served the functional purpose of identifying dosage, not source, the Court denied protection to the claimed color marks.

In *Publ’ns Int’l Ltd. v. Landoll*, 164 F.3d 337 (7th Cir. 1998), the Court of Appeals for the Seventh Circuit found that the use of gold with bookbinding served a functional purpose. Writing for the Court, Chief Judge Posner observed that the color gold had both aesthetic and traditional functional qualities.

[T]he color gold on a product or its package is a prime example of aesthetic functionality . . . play[ing] an important role (unrelated to source identification) in making a product more desirable. Gold connotes opulence, and . . . has a long history of use in bookbinding; the spine of the book which this book is printed is decorated with gilt. Gold is a natural color to use on a fancy cookbook. A different color on PIL’s page ends would have a better claim to be a source signifier. *Id.* at 342. Accordingly, because the use of the color gold was deemed to be a functional feature, the color could not be accorded protection.

Where owners of color marks have been successful in establishing non-functionality, they have been able to clearly establish the primacy of the source indicating purpose of the color mark. In *Gateway, Inc. v. Companion Prods, Inc.*, 384 F.3d 503 (8th Cir. 2004), the Court of Appeals for the Eighth Circuit considered whether Gateway’s black and white cow spots were a functional element of its computer packaging trade dress. If the black and white cow spots were functional, Companion Products, Inc. [“CPI”] could freely use them on their computer-accessory plush cows. The court stated that “[t]he purely decorative nature of the design plays no part whatsoever on the performance of Gateway’s computers. Surely,

no consumer believes that the presence of this design affects the operation of electronic components and peripherals associated with Gateway.” *Id.* at 508. The court then turned to “aesthetic functionality.” “Gateway’s trade dress does not prevent CPI from using other colors and designs for their computer-decorative products. They are not placed at a disadvantage to other makers of such products because those companies may not use Gateway’s protected trade dress.” *Id.* at 508-09.

In *Deere & Co.*, above, the Southern District of New York considered “aesthetic functionality” as applied to Deere’s green and yellow. The Court held that protection of the very basic colors of green and yellow in the abstract should be barred as functional in hindering the availability of other designs to other market participants. “Deere cannot establish an exclusive right to the use of the colors green and yellow, and may not prevent MTD from using these colors, as long as they are not used on MTD’s lawn and garden equipment in a manner so similar to Deere’s use that MTD’s products are likely to cause confusion in the market place.” *Deere & Co.*, 70 USPQ2d at 1017. “This conclusion thereby eliminates the need to address Defendant’s concern that Deere will corner the market by obtaining exclusive ownership rights over the use of green and yellow on lawn and garden equipment.”

This recent case law has developed *Qualitex’s* functionality requirement in its application to color marks. The owner of a color mark will have to show that its mark is neither “traditionally” nor “aesthetically” functional to gain protection.

IV. Defining the mark

Another challenge for owners of color marks is defining the

mark itself. In promulgating registration requirements, the Patent and Trademark Office follows *Qualitex* in requiring demonstration of acquired distinctiveness and lack of functionality. The PTO further demands that the color mark be defined by reference to a particular representation and specific goods or services. A recent federal appellate court decision suggests, however, that even vaguely defined and unregistrable color marks may be accorded significant protection, thus muddying the waters.

1. PTO registration requirements

Lest the distinction between registrability and protectability be lost, it is critical to note that it is not registration that creates the exclusive property right in trademarks. The owner of a mark already has a property right established through his use. This is what is meant when it is said that U.S. trademark law is a use-based system. There are important legal advantages accorded to registered marks, however. Registration with the PTO establishes prima facie evidence of ownership of the mark and of the mark’s validity—that is, that the mark is distinctive and nonfunctional. Registration also grants the holder of the registered mark a forum in federal court and makes available treble damages in counterfeiting cases.

There is no shortage of color-only marks on the Principal Register of the PTO. As indicated, attaining registration on the Principal Register indicates that the color mark has not only been proven to the satisfaction of the PTO that the color is non-functional, but also that it has already acquired distinctiveness through “secondary meaning.” Among those registered are:



1



2



3



4



5

1. brown and gray for steel plates (Pic 1, Reg. No. 3,535,474),
2. orange on the starter housing and grey on the body of leaf blowers (Pic 2, Reg. Nos. 3,400,476 & 3,400,477),
3. red and black on armored cars (Pic 3, Reg. No. 3,315,445),
4. blue, red, and yellow color scheme on passenger airplanes (Pic 4, Reg. No. 3,297,309),
5. white, red, yellow, and blue for shirts and hats (Pic 5, Reg. Nos. 3,243,999 & 3,267,984)

The PTO requirements for registering a color mark track closely with *Qualitex*. The Trademark Manual of Examining Procedure [“TMEP”] instructs that color marks are never inherently distinctive, always requiring a showing of acquired distinctiveness to be registered on the Principal Register. The TMEP also demands that a color mark be non-functional. There are, however, additional requirements unique to the application and examination process. The PTO further demands that color be used in conjunction with particular goods or services. This is due in part to the unique rigors of the application and examination process, which require examination of a drawing, a written description of the mark, and a specimen.

Not based solely on procedural logistics, the PTO’s drawing and written description requirements stem from crucial public policy in “providing notice [to the public] of the nature of the mark sought to be registered.” TMEP § 1202.05(d). The PTO demands that a drawing for a color mark include a separate statement describing where the color appears and how it is used on the mark. This, plus the written description of the particular color as applied to the goods or services, prevents registration of “phantom marks”—marks that change depending on their use and offend the PTO policy forbidding registration of more than one mark per application.

The Federal Circuit faced this issue as it related to color. In *In Re Thrifty Inc.*, 274 F.3d 1349 (Fed. Cir. 2001), the Court affirmed the Trademark Trial and Appeal Board’s [“TTAB”] refusal to register the color blue as it applied to Thrifty Inc.’s [“Thrifty”] car rental centers, signs, and employee uniforms. The problem was that Thrifty’s application drawing showed a building in dotted lines with the upper portion of one wall depicted blue, which did not correspond with any of Thrifty’s several descriptions of the mark, ranging from the color blue used in conjunction with the rental centers, vehicles, signs, uniforms, and other advertising to simply “the solid color blue” in the abstract.

The PTO refused Thrifty’s application; none of the descriptions correlated to the drawing. “The multiple impressions created by the wide variety of objects sought to be covered under the proposed description differ significantly from the original mark of a color placed on a building. The multiple forms described . . . do not create the impression of being essentially the same mark as the color blue applied to a building as described in the original application.” *Id.* at 1353. The PTO, TTAB, and Federal Circuit were willing to grant Thrifty protection of the color blue as used on a wall and even as used in ways that convey commercial impressions similar to that. But because of the attempt to claim disparate uses of blue in a single application showing only blue walls, Thrifty would not succeed.

Thus, the PTO’s drawing and description requirements, along with its prohibition of “phantom marks,” serve to provide notice to the public of the nature and scope of the claimed mark. The recent federal appellate decision, *Bd. of Supervisors for La. State Uni v. Agric. and Mech. Coll. v. Smack Apparel Co.* 550 F.3d 465 (5th Cir. 2008), suggests,

however, that owners of color marks may not always need to define their marks in such a manner in an enforcement context.

2. *Smack Apparel*

Since 1998, *Smack Apparel Co.* [“Smack”] had been making and selling t-shirts targeted at fans of college sports teams, using school colors and loosely associated printed messages. Notably, these t-shirts did not use the names or even logos of the schools. Based upon previous dealings with universities, Smack believed that by avoiding use of registered trademarks it avoided possible trademark infringement liability. Smack’s products did, however, display the well-known school colors in conjunction with other indicia.

Louisiana State University, the University of Southern California, the University of Oklahoma, Ohio State University, and the Collegiate Licensing Company [collectively “Universities”] sued Smack in the United States District Court for the Eastern District of Louisiana [“District Court”] in 2004. The Universities met with immediate success. The District

This is due in part to the unique rigors of the application and examination process, which require examination of a drawing, a written description of the mark, and a specimen.

Court found liability at the summary judgment stage and Smack appealed to the Court of Appeals for the Fifth Circuit.

The issues before the Fifth Circuit were whether the Universities had ownership in a legally protectable mark, and if so, whether there was infringement, as shown through likelihood of confusion between the Smack t-shirts and authentic university apparel. The Court considered the longstanding use of the color schemes and their prominent display on merchandise, the well-known nature of the colors

as representing the schools themselves, and the presentation in combination with team feats, scores, or geographical location. In the context of t-shirts, such use had established “secondary meaning.”

The Fifth Circuit then affirmed the finding of likelihood of confusion. Among the factors considered were the similarities between Smack’s and the Universities’ licensed products, the overlap in methods of advertising and points of sale, and Smack’s intent to profit from the Universities’ reputations. These “digits of confusion” combined to create a clear impression in the consumers’ minds of affiliation. Thus, Smack was impermissibly free-riding upon this deceptive appearance of affiliation.

In one sense, *Smack Apparel* could be read as a modest extension of *Qualitex* to protect color schemes and combinations in addition to color alone. In another sense, *Smack Apparel* ultimately accords trademark protection to “marks” that would be simply unregistrable with the PTO. The *Smack Apparel* Court found that the combination of colors with ever-shifting “indicia” was sufficiently definite to accord protection despite

the fact that they would no doubt offend PTO policy against “phantom marks.” In a trademark system premised on use, one might wonder what exactly had the Universities used that garnered them such sweeping protection. They claimed that their trademarks lay in the school color combinations “on merchandise that combines other identifying indicia referring to the Universities.” *Smack Apparel Co.*, 550 F.3d at 475. Yet, the vague “identifying indicia” hardly provides notice to the public. On Smack’s offending t-shirts, “identifying indicia” referred to notable athletic victories or season results. It is conceivable that the mention of an athletic conference or a school nickname “refer” to the Universities as “identifying indicia.”

Further, “merchandise” could conceivably act as the indicia itself. Perhaps a novelty-sized football painted LSU crimson and gold, or a USC cardinal and gold pennant are “merchandise” that in themselves refer strongly enough to the respective institutions to be protected.

Smack Apparel appears to have side-stepped the registrability requirement that there exist a significantly similar commercial impression between a protected mark and an asserted one. It also arguably removes the common-law trademark requirement of actual use, skips right past intent to use, and lends protection based on imaginable use. Whether *Smack Apparel* opens the door to broader and more expansive claims of protection over color marks, or is limited to the facts in this particular case, remains to be determined.

V. Conclusion

From pink fiberglass insulation to crimson and gold athletic apparel, the last three decades in U.S. trademark history have been colorful, to say the least. *Qualitex* established a legal framework for the assessment of color marks, requiring the same basic requirements as for any mark; that the color mark be distinctive and non-functional. Subsequent case law further developed this framework, giving structured analysis to “secondary meaning” and “traditional” and “aesthetic” functionality. The PTO parallels these essentials for registration of color marks, and provides clear guidance in their definition through its drawing and description requirements.

As we turn the corner into the second decade of the twentieth century, however, color marks are taking on all new dimensions. *Smack Apparel* has broadly defined color schemes coupled with any secondary indicia as protectable marks. In this uncertain legal environment the protection, registration, and enforcement of color marks raise a number of important issues that need to be carefully evaluated. **IP**

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