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The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues

*Ann Bartow*¹

INTRODUCTION

THE elevation of color to stand-alone trademark status illustrates the unbounded nature of trademarks within the judicial consciousness. The availability of color-alone marks also facilitates the commoditization of color in ways that complicate the development and distribution of products and services that use color for multiple purposes conterminously. The economic case for color-alone trademarks is severely undermined by careful observation of the ways that colors are actually deployed in commerce, which makes it clear that the trademarks of multiple goods and services can utilize the same color to telegraph the same message without confusing anyone or diluting the commercial power of textual or symbolic trademarks.

Trademark law can be used to monopolistically harness the aesthetic appeal or preexisting social meaning of a color. The Supreme Court was wrong to facilitate this abuse of trademark powers when it decided in *Qualitex v. Jacobson Products Co.* that colors alone could constitute protectable trademarks.² Long ago the Supreme Court held in the *Sears, Roebuck & Co. v. Stiffel Co.*³ and *Compco Corp. v. Day-Brite Lighting, Inc.*⁴ cases that the Intellectual Property Clause of the Constitution preserves a right to copy any product feature that is unrestricted by patents or copyrights.⁵ Ruling

¹ Professor of Law, University of South Carolina School of Law. This Article benefited greatly from the Property, Citizenship, and Social Entrepreneurship (PCSE) Workshop on Comparative, Transnational and Emerging Issues in Property Law at the University of Durham, the University of Ottawa Law & Technology Speakers Series, and the 2008 Chicago IP Scholars Colloquium. The author would like to thank the following people for helpful input: Funmi Arewa, Dan Burk, Lisa Dolak, Christine Farley, Brett Frischmann, Michael Froomkin, Shubha Ghosh, Llew Gibbons, Sarah Harding, Cynthia Ho, Tim Holbrook, Ian Kerr, Jaqui Lipton, Robin Malloy, Peggy Radin, Sharon Sandeen, and Diane Leenheer Zimmerman. This Article is dedicated to Casey Bartow-McKenney and Thelma Adams.

² *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995).

³ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

⁴ *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

⁵ See generally U.S. CONST. art. I, § 8, cl. 8; David E. Shipley, *What Do Flexible Road Signs, Children's Clothes and the Allied Campaign in Europe During WWII Have In Common? The Public Domain and the Supreme Court's Intellectual Property Jurisprudence*, 13 U. BALT. INTELL. PROP. L.J. 57 (2005).

in favor of color-alone trademarks abrogated this important principle for no good reason. The *Qualitex* holding did not lessen color related consumer confusion, because there was not evidence of any. Instead it reduced competition and consumer choice by creating illegitimate aesthetic and communicative cartels.

The primary doctrinal arguments against recognizing color-alone trademarks raised here include aesthetic functionality, the related concept of communicative functionality, uncertainty about scope, and color exhaustion. Colors always add aesthetic value, and often communicate messages unrelated to commercial source. Coupled with the uncertainties related to color-alone marks and the risks of color exhaustion, the anticompetitive effects of color monopolies outweigh any possible social benefit from a regime that permits registration of color-alone trademarks. It is further argued that if any court attempted to declare a color “famous” for dilution purposes, thereby granting a commercial entity broad rights to monopolize the color well beyond the context in which it is used in commerce, there would be a furious backlash against this ill-advised doctrine. The palette of commercially appealing colors is far more limited than the dictionary of attractive and usable words, and could be radically depleted by deployment of dilution precepts rather quickly. Courts that recognize this may relegate color-alone marks to some second class status that is ineligible for dilution protections, preserving color availability somewhat but further warping trademark doctrine.

I. COLOR MARKS AND THEIR DISCONTENTS

Congress never made a principled inquiry into the desirability of color-alone trademarks. The decision to recognize colors alone as protectable, defensible trademarks is an iconic example of reflexive expansion of trademark rights by members of the judiciary. There is a robust presumption among many judges that any signifier can be a trademark if consumers can be manipulated into connecting it with a unitary source, even if the name and nature of the source itself are unknown. At first blush, this appears to give corporations expansive liberties to devise diverse and creative trademarks with which to communicate with consumers. It is, however, a false freedom of corporate speech. Valid trademarks must be chosen or developed outside of the boundaries of established trademarks held by competitors. Because the scope of trademark rights expands beyond the literal marks into the indeterminate realm of the confusingly similar, or potentially dilutive, these boundaries are fluid. To avoid drowning in them, the construction of a new, enforceable, non-infringing trademark requires some modicum of originality vis-à-vis preexisting marks, especially the

marks of similar or related products or services.⁶ The words, symbols, and colors used by competitors to mark competing goods or services are best avoided as widely as possible from a legal standpoint, but some mark attributes are so irresistible from a marketing perspective that an entity is willing to risk trademark litigation. In other instances, the practical scope of a mark used by a competitor can be ambiguous and difficult to discern, leading to unexpected litigation.

A. *The Limitations of a Linguistic Palette*

Some types of signifiers are simply better suited to serving as simultaneously effective and distinctive trademarks than others. Words, alone or grouped as phrases or slogans, can be transmitted and recreated by writers and speakers with a high degree of faithfulness. Symbols can be visually communicated where circumstances allow or reproduced with drawings or described by words where access to a copy of the mark itself is not available, though some diminution in accuracy might be expected where humans reproduce the marks from memory or by hand. Sounds can be aurally conveyed using sound transmitting technologies, or via simple singing, humming, or instrumental improvisation as necessary, with attendant tonal and lyrical imprecisions.

Smells, however, present descriptive challenges. Odor based marks can be textually described (*e.g.*, sewing thread with “a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms”⁷), but aromas can be difficult to efficiently reproduce. Unless the scented product or package or a reasonable facsimile is available, the metes and bounds of a trademarked stench are conceptually amorphous. Two people might agree that their noses detect the fragrance of baking bread, or the stink of rotting fruit, but beyond these general descriptions, reducing an airborne bouquet to language is tricky.

Beyond obvious umbrella designations like “red” or “blue,” colors can also be difficult to accurately convey in words and challenging to casually reproduce. Yellow can mean sunflower petals, egg yolks, legal paper, or lemons. Referencing “the color of grass” does a poor job of telegraphing a precise shade of green. Even when two people are staring at the same

6 *E.g.*, Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 736 (1999) (“In the context of trademark law, the test of consumer confusion is only partly within the competitor’s control. She cannot foreclose a claim through independent creation, but she can limit potential liability through clear differentiation of source in packaging and marketing.”).

7 Clarke, 17 U.S.P.Q.2d (BNA) 1238, 1238 (T.T.A.B. 1990).

object, they may perceive its color somewhat differently,⁸ as eyes and brains process colors contextually and with surprising ambiguity.⁹

Like odors, colors alone can legally function as trademarks if they are deemed to reflect an established but nonfunctional semiotic link between the color and the source of the color-bearing goods or services.¹⁰ Occasionally, color alone will be used in an advertisement, or on product packaging. However, rare indeed is the company that relies solely on color alone to consistently identify its products in the stream of commerce, without a companion symbol or textual mark. This author was unable to come up with a single example.

The Qualitex company may be able to protect green-gold as a color-alone trademark but it never uses green-gold alone as a sole trademark. It marks its products with the words “Qualitex” and “Sun Glow” and these textual marks act as the primary source identifiers.¹¹ Without a companion textual mark or a unique symbol, it is doubtful that green-gold could effectively serve as a source identifier at all. Many corporations are happy to register and protect color-alone trademarks, but they do not use them as stand-alone trademarks.

Color is most commonly and effectively used in conjunction with textual marks. Color marks often are pragmatically valued by holders because they provide mechanisms for commercially disadvantaging competitors. This is a misuse, and indeed an abuse, of trademark power.

Commercial actors don't use color-alone marks *alone* for the same reason the Court was wrong to deem colors alone protectable marks: most people do not view colors alone as independent source identifiers. Color

8 See *Minn. Mining & Mfg. Co. v. Beutone Specialties Co.*, 82 F. Supp. 2d 997, 1000 (D. Minn. 2000) (noting term “canary yellow” could encompass a broad range of color).

9 See Austen Clark, *Qualia and the Psychophysiological Explanation of Color Perception*, 65 SYNTHESIS 377, 377 (1985), available at <http://www.ucc.uconn.edu/~wwwphil/looks.html> (“A neutral grey patch enclosed in a green surround looks somewhat red. It presents the appearance of a reddish grey, even though when one blocks the surround, one can see that the patch is not reddish at all, but merely grey. Furthermore, the same grey patch with a red surround will look somewhat green.”) (emphasis in original); see also Etienne Benson, *Different Shades of Perception*, MONITOR ON PSYCHOL., Dec. 2002, at 28, available at <http://www.apa.org/monitor/deco2/perception.html>; Robert W. Burnham, *Inter-Eye Differences in Color-Perception*, 70 AM. J. PSYCHOL. 386 (1957); John Campbell, *Transparency vs. Revelation in Color Perception*, 33 PHIL. TOPICS 105 (2005), available at <http://socrates.berkeley.edu/~jcampbel/documents/Color-PhilTopics.pdf>; Anna Franklin et al., *Categorical Perception of Color Is Lateralized to the Right Hemisphere in Infants, but to the Left Hemisphere in Adults*, 105 PROC. NAT'L ACAD. SCI. 3221 (2008), available at <http://www.pnas.org/cgi/content/abstract/105/9/3221>; Munsell Color Science Laboratory, Perception FAQ, <http://www.cis.rit.edu/mcs/outreach/faq.php?catnum=1> (last visited Apr. 1, 2008); Color Perception, http://wwwcs.uni-paderborn.de/cs/ag-domik-static/arbeitschwerpunkte/ucmm/ideas/um/ability/exp_cp_e.html (last visited Apr. 1, 2008).

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

11 See *Qualitex, Sun Glow Press Pads*, <http://www.qualitexco.com/http/pads.html> (last visited Mar. 20, 2008).

marks are simply unable to perform as inherently distinctive trademarks, as the Supreme Court noted in *Qualitex*.¹² By failing to deploy colors alone as sole trademarks, manufacturers and distributors behave as if they cannot be trusted to be singularly distinctive at all.

Mark holders typically use word marks in tandem with colors because language facilitates certainty in ways that are useful for commerce. Color marks are secondary and generally play supporting roles to dominant textual marks. This sometimes means that, in addition to marking products, product names also identify trademarked tints and shades: “Tiffany blue,”¹³ “UPS brown,”¹⁴ “Pepto Bismol pink,”¹⁵ and “Yellow Cab yellow”¹⁶ may all be familiar to the reader. “Kimberly–Clark orange” is probably a bit more obscure, unless one has reason to be familiar with disposable medical facemasks.¹⁷

Colors have multiple social meanings. In South Carolina, orange means Clemson University,¹⁸ while in Tennessee, it signifies an allegiance with the University of Tennessee Volunteers.¹⁹ If an observer saw a truck that was bright yellow from end to end, without a single textual indicator, she

¹² *Qualitex*, 514 U.S. at 162–63 (“True, a product’s color is unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs which almost *automatically* tell a customer that they refer to a brand But over time customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand Again, one might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same? 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 this indicates its ‘source’).”); *see also* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 211–12 (2000).

¹³ *See* Tiffany & Co., <http://www.tiffany.com> (last visited Apr. 1, 2008).

¹⁴ UPS registered the color brown for the vehicles and uniforms used for its transportation and delivery services. *See, e.g.*, Press Release, UPS, UPS Launches Biggest, “Brownest” Ad Campaign Ever (Feb. 7, 2002), *available at* <http://www.pressroom.ups.com/pressreleases/archives/archive/0,1363,3917,00.html>; UPS, UPS Pressroom: UPS Brownie Points, <http://www.pressroom.ups.com/mediakits/factsheet/0,2305,1160,00.html> (last visited Sept. 21, 2008).

¹⁵ *See* Pepto Bismol, <http://www.pepto-bismol.com/> (last visited Mar. 20, 2008).

¹⁶ *See* Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc., 419 F.3d 925 (9th Cir. 2005).

¹⁷ *See Court Protects Kimberly Clarke Trademark Orange Color*, IPFRONTLINE, Nov. 10, 2006, <http://www.ipfrontline.com/depts/article.asp?id=13290&deptid=7>.

¹⁸ *See* Clemson University, <http://www.clemson.edu> (last visited Mar. 20, 2008). Clemson University is a public school in South Carolina that is far inferior to the University of South Carolina in every way, including but not limited to, the fact that it does not have an associated law school. *See* Clemson University Home Page, <http://www.clemson.edu/> (last visited March 20, 2008) (This is a tongue in cheek assessment meant to tweak the University of South Carolina’s fiercest in-state rival, which, for a University that lacks a law school, is actually a surprisingly excellent school.).

¹⁹ *See* University of Tennessee, Knoxville, <http://www.utk.edu> (last visited Mar. 20, 2008).

might recognize this as a Ryder/Hertz–Penske truck. Or she might assume the vehicle was part of the Yellow Freight fleet. Or she might think that it was simply painted yellow because someone felt this was a cheerful color for a truck.

If a trucking company used a yellow sun symbol as its trademark, it is easy to understand that consumers would likely be confused if a competing company adopted a yellow sun icon as well, and both marks were employed on the sides of trucks. But the same would not be true if the competitor adopted a yellow squiggle, or a yellow steering wheel icon, or a yellow house pictogram, or a two–dimensional bouquet of yellow daisies or buttercups. Colors can make symbols more distinctive, but alone they signify too many things to function as effective trademarks.

It is true that with enough exposure via relentless advertising and expansive market permeation, any color can be linked with a product or a company in consumers' minds. This is not, however, an adequate justification for allowing commercial entities to monopolize particular colors through trademark law. Mere association does not mean a color is functioning as a trademark.²⁰ And there can be no trademark protection when a color has a function,²¹ which it always will when it is a product feature.

Companies are not allowed to register or protect generic terms as trademarks for the goods or services they identify, even if the company can make an evidentiary showing of secondary meaning as a result of market dominance.²² For example, a huge proportion of the computer–owning populace may associate the acronym DOS (which stands for Disk Operating System) with Microsoft due to that company's tremendous commercial success with its software, but, as a doctrinal matter, Microsoft should not be able to claim DOS alone as a trademark for the disc operating systems it markets. While MS–DOS can be and is a protectable trademark

20 Mere association is sometimes characterized as “de facto secondary meaning,” which is secondary meaning to which the law attaches no legal significance. *See* Boston Beer Co. L.P., 198 F.3d 1370, 1373 (Fed. Cir. 1999); *see also* Application of Sun Oil Co., 426 F.2d 401 (C.C.P.A. 1970); Audio Fidelity Inc. v. London Records, Inc., 332 F.2d 577 (C.C.P.A. 1964). *Cf.* Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 434 (2003) (“‘Blurring’ is not a necessary consequence of mental association. (Nor, for that matter, is ‘tarnishing.’)”).

21 *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 168–69 (1995) (citing *In re Owens–Corning Fiberglas Corp.*, 774 F.2d 1116, 1121 (Fed. Cir. 1985)).

22 *See, e.g.*, U.S. Patent and Trademark Office, Trademark FAQ: Can the Office Refuse to Register a Mark, <http://www.uspto.gov/web/offices/tac/tmfaq.htm> (follow “Can the office refuse to register a mark?” hyperlink under “Application Process”) (last visited Apr. 2, 2008) (“Not all words, names, symbols or devices function as trademarks. For example, matter which is merely the generic name of the goods on which it is used cannot be registered.”); International Trademark Association, Trademarks vs. Generic Terms, <http://www.inta.org> (follow “Information & Publishing” hyperlink; then follow “Basic Trademark Information” hyperlink; then follow “Trademarks vs Generic Terms” hyperlink under “Types of Protection”) (last visited Apr. 2, 2008).

for the company,²³ other software companies are free to use DOS to describe the disc operating systems that they produce. The rationale is that no manufacturer or service provider should be given an exclusive right to use words that generically identify a product or service.²⁴ Neither should trademark law grant an exclusive right to a color that plays aesthetic or communicative roles.

B. *All the Colors of the Rainbow*

Green–gold became the unassailably, federally registered trademarked color of Qualitex dry–cleaning pads via a Supreme Court case.²⁵ The Court resolved a circuit split over whether a color could be accorded stand–alone trademark status, even though this particular mark never actually stands alone in commerce. The color is instead linked and duly subservient to the words “Qualitex” and “Sun Gold,” especially at the point of sale. Although in *Qualitex* the Court held that colors alone can serve as trademarks,

²³ See, e.g., Microsoft Corp., Trademarks, <http://support.microsoft.com/library/toolbar/3.0/trademarks/en–us.mspix> (last visited Apr. 2, 2008).

²⁴ See U.S. Patent and Trademark Office, Trademark FAQ, <http://www.uspto.gov/web/offices/tac/tmfaq.htm>. The Ninth Circuit in its Model Civil Jury Instructions, defines “generic marks” as follows:

Generic Marks. The fourth category of trademarks is entitled to no protection at all. They are called generic trademarks and they give the general name of the product of the plaintiff. They are part of our common language that we need to identify all such similar products. They are the common name for the product to which they are affixed. It is the general name for which the particular product or service is an example.

It is generic if the term answers the question “what is the product being sold?” If the average [relevant] consumer would identify the term with all such similar products, regardless of the [manufacturer] [provider], the term is generic and not entitled to protection as a trademark.

Clearly, the word apple can be used in a generic way and not be entitled to any trademark protection. This occurs when the word is used to identify the fleshy, red fruit from any apple tree.

The computer maker who uses that same word to identify the personal computer, or the vitamin maker who uses that word on vitamins, has no claim for trademark infringement against the grocer who used that same word to indicate the fruit sold in a store. As used by the grocer, the word is generic and does not indicate any particular source of the product. As applied to the fruit, “apple” is simply the common name for what it is that is being sold.

9TH CIR. JURY INSTR. § 15.17 (Ninth Cir. Jury Instr. Comm. 2007).

²⁵ *Qualitex*, 514 U.S. at 159.

commercial vendors have been deeply reluctant to put this legal theory into commercial practice. None of the cases that comprise color-alone jurisprudence involved color alone uses of color-alone trademarks.

In 1985, a Federal Circuit opinion²⁶ accorded trademark status to the color pink when it is used as a source identifier in Owens–Corning fiberglass building insulation.²⁷ The backing paper of the insulation bore the trademarked words “Owens Corning,” but the court was convinced that consumers independently recognized the pink color as a signifier of source and that trademark law allowed Owens Corning to leverage this accrued recognition into a limited monopoly. Other fiberglass insulation manufacturers were free to inject alternative colors into their products, but pink insulation became Owens Corning’s exclusive prerogative.

In 1990, the Seventh Circuit contrarily refused a vendor of sugar substitutes trademark rights to the color blue itself, stating that blue packaging “used in connection with some symbol or design or impressed in a particular design” was adequate color-linked trademark protection.²⁸ In 1993, however, the Eighth Circuit rejected this limiting principle and saw no reason that the color blue could not function as a fully protectable (in a trademark sense) source identifier for the Blue Max brand of splicing tape.²⁹ This decision widened the circuit split on this judicially contested issue enough to attract the Supreme Court’s certiorari-granting attention.

In 1995, the Supreme Court held in *Qualitex* that “[s]ince human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning,” a correct reading of the Lanham Act’s definition of a trademark as “any word, name, symbol, or device, or any combination thereof”³⁰ was both literal and liberal.³¹ This opinion went on to observe that “[t]he courts and the Patent and Trademark Office [had previously] authorized” shapes, sounds, and scents for use as marks, in addition to more mundane and commonplace words and pictorial designs.³² Colors, the Court decided, could reasonably serve as marks as well once they had attained acquired distinctiveness (also known as secondary meaning), as long as their use was nonfunctional.³³ The Court framed the question presented as “why not?”³⁴ and arguably adapted the modern articulation of patentable subject

26 *Owens–Corning Fiberglas Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985).

27 *See, e.g., Owens–Corning*, <http://www.owenscorning.com/around/insulation/insulationhome.asp> (last visited Mar. 20, 2008).

28 *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990).

29 *Master Distrib., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993).

30 Lanham Act § 45, 15 U.S.C. § 1127 (2000).

31 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

32 *Id.*

33 *Id.* at 163–65.

34 *Id.* at 162.

matter to trademarks: “Anything under the sun, perceived by man.”³⁵

It is the position of this author that the *Qualitex* case was wrongly decided. It is endemically problematic because the opinion resulted in de facto lawmaking that expanded the scope of trademark law without adequately considering the competitive functional roles that product design features, like color, play. Though amicus briefs expanded the doctrinal and practical issues to an extent, the Court had full information about only one particular trademark dispute at its disposal when it decided to render colors alone legally protectable trademarks. Important issues and evidence related to color-alone trademarks were not raised by the parties, who had no obligation or incentive to present information unrelated to their specific claims, nor were these concerns raised by amici. Therefore, the Court apparently did not consider actual trademark uses and practices in commerce, or the commercial reasons marks are deployed or not deployed in various contexts when it endorsed the concept of free-floating, color-alone trademarks in *Qualitex*. This led to poorly informed, and ill-advised judicial lawmaking in this case.

II. FUNCTIONALITY

A. *The Functionality of Color*

The Lanham Act makes it clear that functional attributes cannot be protected as trademarks even if these are otherwise source identifying.³⁶ As Graeme Dinwoodie has observed:

[T]rademark protection should depend upon whether the particular

³⁵ 35 U.S.C. § 101 (2000).

³⁶ See Lanham Act § 2(e)(5), 15 U.S.C.A. § 1052(e)(5) (Supp. 2008) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— . . . (e)(5) comprises any matter that, as a whole, is functional.”); Lanham Act § 14(3), 15 U.S.C.A. § 1064(3) (Supp. 2008) (“A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed . . . [a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional”); Lanham Act § 23(c), 15 U.S.C. § 1091(c) (Supp. 2005) (“For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional”); Lanham Act § 33(8), 15 U.S.C. § 1115(8) (Supp. 2005) (“Registration as evidence of right to exclusive use; defenses . . . [t]hat the mark is functional.”); Lanham Act § 43(a)(3), 15 U.S.C.A. § 1125(a)(3) (Supp. 2008) (“In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”); 15 U.S.C.A. § 1125(c)(4)(A) (“In a civil action for trade dress dilution under this Chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that— . . . the claimed trade dress, taken as a whole, is not functional and is famous.”).

symbolic matter identifies the source of a product (*i.e.*, whether the matter is “distinctive”), and upon whether protection of the particular symbol would accord the producer a practical monopoly and prevent effective competition by others (*i.e.*, whether the matter is “functional”).³⁷

A valid mark must be nonfunctional as well as source identifying.³⁸ The functionality test articulated by the Supreme Court is whether “exclusive use of the [product] feature would put competitors at a significant non-reputation-related disadvantage.”³⁹ The Court seemed unconcerned that allowing color-alone trademarks meant that competitors would be precluded from producing products in colors that consumers preferred to purchase for aesthetic reasons. Justice Breyer wrote:

Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not. And, this latter fact – the fact that sometimes color is not essential to a product’s use or purpose and does not affect cost or quality – indicates that the doctrine of “functionality” does not create an absolute bar to the use of color alone as a mark.⁴⁰

Colors used in relation to goods or services are employed either arbitrarily, or functionally, or both. For many consumer goods, color is arbitrary. Staplers, tape dispensers and hole-punchers can be made in any color, eye-catching or bland. Office supply manufacturers may produce these items in a variety of colors to suit a range of tastes.

In other cases, color choices are clearly driven by function. For example, Astroturf, a manufactured sod substitute often used on athletic fields, is often green because it replaces and is supposed to look like grass. The color green is therefore being used in a highly functional way. Bright orange is a color often functionally used for visibility purposes, such as in traffic cones and reflective vests or on clothing marketed to hunters to help them avoid shooting each other in the woods.

In *Qualitex*, the Supreme Court gave little credence to the defendant’s functionality argument, not because the justices questioned the truth of the assertion that green-gold did a good job of hiding stains on dry cleaning pads, but because of an espoused belief that other dark colors could

³⁷ Dinwoodie, *supra* note 6, at 617.

³⁸ *Qualitex*, 514 U.S. at 164.

³⁹ *Id.* at 165 (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10). *Qualitex* putatively restated *Inwood’s* articulation of the functionality test: whether a product feature “is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.*

⁴⁰ *Id.* at 165 (citing *Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1123 (Fed. Cir. 1985)).

accomplish the same purpose.⁴¹ Even though the Court acknowledged that “it is important to use *some* color on press pads to avoid noticeable stains,” it endorsed the view that there was “no competitive need in the press pad industry for the green–gold color, since other colors are equally usable.”⁴² This was an endorsement (despite oblique protestations to the contrary⁴³) of the questionable principle that if a competitor could design or work around a functional product attribute, that attribute was not precluded from serving as a protectable trademark or trade dress element. The Court unequivocally rejected this a doctrinally dubious precept six years later in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*⁴⁴ This facet of the *Qualitex* opinion was also in harmony with the Court’s badly reasoned conclusion that color exhaustion was unlikely to become a problem among dry cleaning pad producers.⁴⁵ The Justices seemed tacitly to assume that *Qualitex* would continue to hold a dominant position in the dry cleaning industry, and that the number of competitors would remain small or decline to compete for market share based on product features like color.

B. Aesthetic Functionality

Clothing, furniture, tableware, kitchen accessories, and other consumer goods are manufactured in various shades of green, including green–gold, because consumers find green to be an appealing and desirable color. The use of green in these contexts is therefore aesthetically functional. It is also completely arbitrary, as the same manufacturers may change the colors of their products to respond to changing tastes, and consumers may be just as willing to purchase an item in blue or red.⁴⁶ Properly construed,

⁴¹ *Id.* at 166. *But see* *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (“As explained in *Qualitex*, *supra*, and *Inwood*, *supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device. The *Qualitex* decision did not purport to displace this traditional rule. Instead, it quoted the rule as *Inwood* had set it forth. It is proper to inquire into a ‘significant non–reputation–related disadvantage’ in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, 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.”).

⁴² *Qualitex*, 514 U.S. at 166 (quoting in part from *Qualitex Co. v. Jacobson Prods. Co.*, 21 U.S.P.Q.2d (BNA) 1457, 1460 (C.D. Cal. 1991), *rev’d in part*, 13 F.3d 1297 (9th Cir. 1991), *rev’d*, 514 U.S. 159 (1995)).

⁴³ *Id.* at 164 (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).

⁴⁴ *TrafFix*, 532 U.S. at 35.

⁴⁵ *Qualitex*, 514 U.S. at 166.

⁴⁶ *Eco Mfg. LLC v. Honeywell Intern., Inc.*, 357 F.3d 649, 654 (7th Circuit 2003)

aesthetic functionality concerns should preclude color-alone trademarks in most consumer goods. Otherwise, consumers can be forced to forgo obtaining products in the colors they prefer, because a single company has a monopoly on a color but charges high prices, offers goods of low quality, or fails to produce products with other desired features.⁴⁷

Some courts have properly placed the importance of allowing consumers the ability to obtain products in the colors they prefer above an entity's desire to make exclusive use of a color. Because farmers had an aesthetic preference for green farm equipment, and they liked their tractors to match their trailers, one district court refused to allow the John Deere Company to use trademark constructs to monopolize green with respect to farm machinery.⁴⁸ Because boat owners prefer outboard motors to be black for aesthetic reasons, the Federal Circuit ruled that a single outboard motor company could not use trademark law to position itself as the exclusive purveyor of black outboard motors.⁴⁹

The Qualitex company's selection of green-gold as its trademark color probably had an element of aesthetical functionality, as the company doubtlessly wanted dry cleaners to find Qualitex dry cleaning pads attractive. The adoption of green-gold specifically also must have had an element of arbitrariness, as Qualitex could have chosen green-gold from among alternative visually pleasing, stain-hiding colors to monopolize as a commercial signifier. It seems plausible too that Qualitex undertook consumer preference research which ascertained that green-gold was an aesthetically pleasing color to dry cleaning pad purchasers.

Qualitex may have obtained a color-alone trademark, but it never uses green-gold as a trademark without appurtenant textual marks, usually "Qualitex" and "Sun Gold."⁵⁰ This is probably because as a savvy competitor, Qualitex recognized what the Supreme Court did not, which is that consumers generally do not view product colors as source identifiers.⁵¹ The fact that the Qualitex company does not use green-gold as a stand alone trademark, but simply as a product feature, is powerful evidence that the color's market power is related to aesthetics, rather than source identification.

("Aesthetic appeal can be functional; often we value products for their looks.").

47 *See also* Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc., 457 F.3d 1062, 1064 (9th Circuit 2006) (where an aesthetic product feature serves a significant non-trademark function, the feature can not be protected as a trademark if it would stifle legitimate competition to do so).

48 *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982).

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

50 *See* Qualitex, <http://www.qualitexco.com> (last visited Oct. 10, 2008).

51 *See, e.g., Jerome Gilson & Anne Gilson LaLonde, Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 774-77 (2005).

In its *Qualitex* opinion, the Court clearly viewed the trademark prerogatives of manufacturers as more important than the aesthetic preferences of consumers. Using the example of purple industrial bolts, Justice Breyer solicitously observed:

One can understand why a firm might find it difficult to place a usable symbol or word on a product (say, a large industrial bolt that customers normally see from a distance); and, in such instances, a firm might want to use color, pure and simple, instead of color as part of a design.⁵²

Justice Breyer's assumption that customers of industrial bolts normally only see the bolts they purchase from a distance is somewhat questionable. Passersby and bystanders might only see the bolts from afar, but few courts ascribe passersby and bystanders important roles in driving trademark law.⁵³ Actual purchasers of industrial bolts probably conduct significant research into the performance-based features of bolts before buying any. Hopefully they do, anyway, given the potentially collapsing and crumpling consequences of utilizing inferior bolts in a structure.

Moreover, in deciding *Qualitex* as it did, the Court chose to privilege a company's desire to use trademark law to monopolize the market for, say, purple industrial bolts, over the price and quality-oriented interests of consumers in having the widest possible range of purple industrial bolts to choose from, and over the commercial interests of competitors, who would reasonably prefer to meet their customers' demands for purple industrial bolts. At least some of those consumers might prefer purple bolts because they found bolts in this nontraditional color aesthetically appealing. Trademark law should not preclude competitors from copying the uncopyrighted aesthetic attributes of a commercially successful product,⁵⁴ but in the context of color-alone marks it can, though illegitimately.

Unless the color trademark-holding manufacturer of purple industrial bolts mounts a campaign urging consumers to focus only on the color to the exclusion of any textual mark, no matter the strength of its acquired distinctiveness, the purpleness would probably be secondary to the linguistic name of the bolts or the bolt manufacturer. Similarly, while insulation purchasers may demand "the pink fiberglass stuff" from shopkeepers, chances are the store's inventory software lists its stock of pink insulation as "Owens Corning." Furthermore, this mark would generally be necessary to know if one wished to make the purchase online, due to the textual basis of most Internet related e-commerce processes.

⁵² *Qualitex*, 514 U.S. at 173–74.

⁵³ See *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 631 F. Supp. 735, 744 (S.D.N.Y. 1985) (assigning "only . . . limited weight" to a survey measuring public confusion in a post-sale context, where there is no showing that the market surveyed would have been previously exposed to the product of the alleged infringer).

⁵⁴ See *supra* notes 3–5 and accompanying text (discussing *Sears and Compo*).

Owens Corning's trademarked pink color makes its fiberglass insulation more aesthetically attractive, changing the natural dingy, off-white color of the insulation to something reminiscent of cotton candy. Additionally, to some consumers, pink might connote warmth, which in cold weather is a positive association for fiberglass insulation. It is unclear whether, in the absence of Owens Corning's successful pink-linked advertising campaigns and extraordinary market share, any competitors would have an interest in dyeing its fiberglass insulation products pink. It is easy to see why use of pink by a rival company would be perceived as illegitimate free-riding, and punished as trademark infringement. Yet it is also hard to conceive of an alternative color that would be equally appealing. Cotton candy comes in blue, but blue is culturally associated with cold. Yellow is the color of sunshine, but also of urine and cowardice. Green is the color of plant life, mold and decay. Brown is the color of dirt. The range of marketable, aesthetically appealing colors that can be effectively embedded in fiberglass insulation may be very limited indeed. Pink may be more valuable as a product attribute than as a trademark, in which case allowing its monopolization is doctrinally problematic.

The fact that the color pink may be source identifying with respect to fiberglass insulation does not trump or even mitigate its aesthetic functionality. Consumers may recognize that pink insulation is marketed exclusively by Owens Corning, but this does not mean they are purchasing it because it is produced by Owens Corning. Their only information about Owens Corning insulation probably comes from Owens Corning advertisements, which they may or may not credit. They may select Owens Corning insulation because it is pink, and the only pink insulation that can be obtained is Owens Corning. Secondary meaning may be present, but because the color pink is aesthetically functional, it is a product feature that should not be protectable as a mark.

If consumers are buying pink insulation because it is manufactured by Owens Corning, it seems unlikely that the pink color adds the kind of value that Landes and Posner credit trademarks with imparting to goods and services.⁵⁵ The "Owens Corning" mark does that. The pink color simply makes it more aesthetically appealing. Purchasers may respond to advertising by making a mental association between the source of the insulation and its color, but consumer motivation in reacting to the color is due to its visual appeal.⁵⁶ With a large marketing budget and clever

⁵⁵ See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268-70 (1987) (identifying the lowering of brand recognition costs to consumers as the justification for trademark law). See generally WILLIAM M. LANDES & RICHARD A. POSNER, *THE POLITICAL ECONOMY OF INTELLECTUAL PROPERTY LAW* 15-16 (2004), available at http://www.aei.org/docLib/20040608_Landes.pdf.

⁵⁶ For a discussion of the inherent instability of consumer understandings of trademarks, see Mark P. McKenna, *Trademark Use and the Problem of Source in Trademark Law*, 2009 U. ILL.

advertising campaign, consumers can be persuaded to mentally associate colors with textual marks or company names. This alone is not enough to justify awarding colors trademark status.

C. *The Overprotection of the Arbitrary*

Congress made functionality a barrier to enforcing all trademarks, even if they are famous⁵⁷ or have obtained incontestable status.⁵⁸ As a doctrinal matter, functional uses of color are not meant to be susceptible to monopolization as trademarks.⁵⁹ Nor are functional uses of color by competitors properly deemed infringements of existing trademarks.⁶⁰ Functionality is a death blow to trademark protection, no matter how much secondary meaning might link a mark and a product or service. Robust judicial policing of trademark functionality is a bulwark against abuses of trademark power.⁶¹

Within the analytical framework of trademark law, the polar opposite of functional is “arbitrary.” “Arbitrary” can be a very valuable doctrinal designation for a trademark. Some judges believe that arbitrary marks deserve the highest levels of trademark protection.⁶² An arbitrary mark eschews utilitarian purpose, and exudes randomness and serendipity.⁶³

Most trademark infringement adjudications require a court to make some assessment of the strength of the plaintiff’s mark. The most meaningful

L. REV. (forthcoming 2009).

57 See Lanham Act § 43, 15 U.S.C.A. § 1125(c)(2)(A) (Supp. 2008) (“[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”).

58 See Lanham Act § 15, 15 U.S.C. § 1065 (2000); Lanham Act § 16, 15 U.S.C. § 1066 (2000); Lanham Act § 33, 15 U.S.C. § 1115 (2005).

59 Lanham Act § 2(e)(5), 15 U.S.C.A. § 1052(e)(5) (Supp. 2008) (stating that a mark cannot be registered if it “comprises any matter that, as a whole, is functional”); see also *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (“[T]rade dress protection may not be claimed for product features that are functional.”).

60 Section 33 of the Lanham Act acknowledges functionality as a defense to infringement even when a plaintiff’s mark has incontestable status. Lanham Act § 33(b), 15 U.S.C. § 1115(b) (2000). In *Qualitex*, the Supreme Court noted: “The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). See also Margreth Barret, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering Traffix on the Way to Sears*, 61 WASH. & LEE L. REV. 79 (2004).

61 See, e.g., *infra* note 88 and accompanying text.

62 See, e.g., *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003) (“[T]he law accords broad, muscular protection to marks that are arbitrary or fanciful in relation to the products on which they are used.”). *But see, e.g., Banfi Prods. Corp. v. Kendall–Jackson Winery, Ltd.*, 74 F. Supp. 2d 188, 196 (E.D.N.Y. 1999) (holding that “a finding that a particular mark is arbitrary does not guarantee a determination that the mark is strong”).

63 *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

type of trademark strength is the extent of consumer recognition.⁶⁴ A mark that many consumers recognize due to heavy advertising and/or market dominance of the marked good or service, is both strong and, because it is commercially effective, likely to attract free riders.⁶⁵ Where the free riding takes the form of counterfeiting, the mark holder is unequivocally entitled to a legal remedy.⁶⁶ Whether the law should intervene is a far more complicated inquiry in cases where the free riding is alleged to be likely to cause confusion among consumers. Where the free riding is not confusing to consumers, but usurps ideas that are not protected by copyrights or patents, it can be otherwise described as legitimate competition, and trademark law should not interfere.⁶⁷ The mark holder always has non-legal options to dispatch free-riding competitors such as providing better products, charging lower prices, or leveraging its strong trademark with a persuasive advertising campaign.

A second concept sometimes referred to as strength, however, has to do with the conceptual category the trademark is assigned by a court. The four categories a judge has to choose from are generic, descriptive, suggestive, and arbitrary or fanciful. There are really only two distinctions that are important. The line between generic and descriptive is critical because while descriptive marks are protectable if the holder can show that the mark has secondary meaning (which is sometimes referred to as “acquired distinctiveness”), generic marks can not be protected at all.⁶⁸

The line between descriptive and suggestive is significant because the evidentiary burden falls heavier on the holder of a descriptive mark than it does on the holder of a suggestive mark. If its validity is challenged, the holder of a descriptive mark must convince the judicial fact finder that her mark has secondary meaning. This is usually accomplished in part by submitting consumer survey evidence, which can be arduous and expensive to compile.⁶⁹ A suggestive mark, however, is presumed “inherently distinctive” and its holder does not have to prove anything in this regard.⁷⁰ A suggestive mark is therefore far cheaper and easier to defend for validity purposes in the context of infringement litigation than a descriptive one.

64 *See, e.g.*, 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 11.74–11.75 (4th ed. 2008) (“One of the benefits of a strong mark . . . is the owner’s well-earned capacity to achieve a high degree of consumer recognition.”); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15.08 (4th ed. 2008).

65 *See* Kenner Parker Toys Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 353 (Fed. Cir. 1992).

66 *See* Lanham Act § 35(b)–(c), 15 U.S.C. § 1117(b)–(c) (2000 & Supp. 2005).

67 *See* Pampered Chef, Ltd. v. Magic Kitchen, Inc., 12 F. Supp. 2d 785, 795 (N.D.I.L. 1998).

68 15 U.S.C. § 1117; MCCARTHY, *supra* note 62, at § 11.25.

69 *See* Impreglon, Inc. v. Newco Enters., Inc., 508 F. Supp. 2d 1222, 1240 (N.D.Ga. 2007); 6 MCCARTHY, *supra* note 62, at § 32.195 (4th ed. 2008).

70 *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 774 (1992).

The same is true of arbitrary and fanciful marks.

The line between suggestive and arbitrary or fanciful is only salient when judges decide to accord a broader scope of protection to arbitrary or fanciful marks. One might conclude that Congress set up the four categories to incentivize the use of suggestive, arbitrary and fanciful trademarks, but one would be gravely mistaken. It was the courts, rather than Congress, that originated and instantiated the practice of sorting trademarks into categories that implicate the evidentiary burden on mark holders and the amount of protection they receive. All the Lanham Act requires is that valid marks be nonfunctional, have a non-generic relationship to the associative product or service, and establish a “secondary meaning” connection between the mark and the product or service within the perceptions of the consuming public.

It was judges, rather than legislators, who decided to ascribe automatic secondary meaning to suggestive, arbitrary, and fanciful marks, thus relieving holders of marks in these categories from the legal obligation to demonstrate any recognition of their marks whatsoever by consumers.⁷¹ It was also the courts that began, in a somewhat less widely followed practice,⁷² to assert that suggestive marks were entitled to more protection than descriptive ones, and gave arbitrary and fanciful marks even more protection than suggestive ones.⁷³ Although a federal registration provides a rebuttable presumption of trademark validity, reflecting a Patent and Trademark Office examiner’s opinion that the mark is not generic,⁷⁴ the registration does not provide

71 For example, see *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), and its pervasive aftermath, which a knowledgeable commentator referred to as one of the worst blights on trademark law. See Beverly W. Pattishall, *The Lanham Trademark Act—Its Impact Over Four Decades*, 76 TRADEMARK REP. 193, 220 (1986); see also *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1431 n.3 (7th Cir. 1985) (criticizing use of *Abercrombie & Fitch* factors in analysis of trademark strength).

72 Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1633–40 (2006).

73 The author reserves for another day a detailed interrogation of the judicially constructed practice of according some trademarks more protection from infringement than others. Suffice to say, in the author’s view once a mark is determined to be valid, it should have the same scope as every other protectable trademark. In addition to the foibles and deficiencies of the categorical approach to strength, linking level of protection to consumer recognition strength is also logically problematic. Strong marks are sometimes accorded elevated protection because they have “earned it,” but if they are well known and well advertised, they hardly need it. The inability of most trademark holders to muster convincing evidence of actual confusion during the course of infringement litigation, see, e.g., *id.* at 1640–42, suggesting that rare indeed is a consumer so confused by similar trademarks or trade dress that she cannot distinguish between national brands and their competitors. If the goals of the Lanham Act are to foster fair competition while protecting the public from confusion, it makes more sense to accord enhanced levels of protection to weak marks, as the lack of familiarity that consumers have with them may create market conditions that make consumer confusion more plausible.

74 See Lanham Act § 2(e), 15 U.S.C.A. § 1052(e) (Supp. 2008); Lanham Act § 7(b), 15

any other information about what category a court might ascertain that a mark falls into in any given context.⁷⁵ This means that competitors do not know the strength or scope of the trademarks employed by companies they are competing with until they find themselves defendants in trademark infringement suits and a court rules on the categorical and/or consumer recognition strength of the plaintiff's mark or marks at issue.

In terms of categorical strength, context is everything.⁷⁶

The word "apple" is the generic word for a particular tree-growing fruit, so "apple" cannot be a valid trademark for apples. It is, however, an arbitrary or fanciful trademark for computers, or for musical sound recordings, hence Apple Computers and Apple Records. Similarly, "popcorn" is generic when it references eponymous kernels of snack food drenched in butter and salt, but was found suggestive when pertaining to a line of oddly shaped silver anodes.

The word "ice" is generic for cubes of frozen water, but was held to be a suggestive and therefore protectable mark with respect to chewing gum. "Ice" also has been used as a trademark for beer, and in one lawsuit was asserted to be generic by one litigant, while the mark holder claimed that the relationship between ice and beer was "either arbitrary, fanciful or suggestive." The keys to correctly categorizing the mark are consumer understanding and common usage of the term at the time the issue is presented to a court.⁷⁷

The categorical assignment reflects the relationship between the marked product or service and the commercial and social meaning of the trademark itself. To illustrate further; the word "yoghurt" would be considered generic when used on the cultured dairy product commonly referred to as yoghurt, and therefore ineligible for trademark use. All makers of yoghurt are free to call their product yoghurt, because no one is able to monopolize the word via trademark law precepts. If a hammock maker wanted to call her product "yoghurt," for some odd reason, because there is no socially meaningful connection between hammocks and cultured dairy products, this trademark use would be arbitrary. It is true that any linkage in the public consciousness between yoghurt and hammocks could be reasonably

U.S.C. § 1057(b) (2000); *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 201 F. Supp. 861, 864 (D.C.N.Y. 1962).

⁷⁵ Nor does a trademark registration address the fact that when a mark is used for disparate products, it can fall into multiple categories simultaneously. For example, while Coca-Cola has been adjudicated a descriptive mark for a well known carbonated beverage, *see Coca-Cola Co. v. Deacon Brown Bottling Co.*, 200 F. 105 (N.D. Ala. 1912), it could reasonably be said to be an arbitrary mark for clothing.

⁷⁶ Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 738 (2004).

⁷⁷ *Id.* at 743 (citations omitted).

attributed to trademark use by the vendor, but that does not mean the mark is or will become strong in the marketplace. If “Yoghurt Hammocks” were widely marketed, the mark might attain consumer recognition strength. If they were not advertised, and only a few units were sold, the mark would be commercially weak.⁷⁸

Why a categorical distinction should lead a court to provide an evidentiary free pass, and the highest level of protection to little used or poorly recognized marks that happen to be arbitrary or fanciful, is one of the confounding perplexities of trademark law.⁷⁹ It is contrary to the precept that trademark holders have to earn their rights by building the secondary meanings of their marks through advertising and distribution of quality goods and services.

Dispensing with the requirement of evidentiary showings to prove secondary meaning when the plaintiff’s mark can be categorized as suggestive, arbitrary, or fanciful saves courts time and effort during the course of trademark infringement litigation, which may be at least part of the explanation for why so many judges decided to develop and adopt this doctrinal innovation. Why courts might also want to accord enhanced levels of protection to suggestive marks, and higher levels of protection still to arbitrary and fanciful marks, is a little more difficult to discern. Providing an incentive for companies to coin fanciful trademarks makes a certain kind of sense if one is concerned about language depletion. Suggestive and arbitrary textual marks, however, monopolize existing words or phrases just as readily as descriptive marks do, and even more rigorously than descriptive marks if they are given broader swaths of protection from infringement.

Because the four iterated trademark categories are conceptualized as a hierarchy or pyramid,⁸⁰ some judges attribute inappropriate significance to

⁷⁸ In *An Empirical Study of the Multifactor Tests for Trademark Infringement*, Barton Beebe asserts that trial courts weigh commercial recognition strength more heavily than categorical strength. Beebe, *supra* note 70, at 1635–36.

⁷⁹ *Cf. id.* at 1639 (“[T]he goal is [to] encourage the use of inherently distinctive rather than descriptive marks. These are both worthy objectives.”).

⁸⁰ See *supra* note 60; see also *Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 227 Fed. Appx. 239 (4th Cir. 2007); *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137 (2d Cir. 1997); *Am. Throwing Co. v. Famous Bathrobe Co.*, 250 F.2d 377, 381–82 (C.C.P.A. 1957) (“Though the suffix ‘Kins’ is not as strong an indication of origin as a *completely* arbitrary or coined word might be, it nonetheless is the dominant part of each of the two marks.”); *Shiraz Univ. Sch. of Med. Alumni Ass’n U.S.A. v. Sheik*, 99 Civ. 5126 (WHP), 1999 U.S. Dist. LEXIS 11566, at *11 (S.D.N.Y. July 29, 1999) (“As an arbitrary mark the Hafez gazebo is presumptively strong.”); *Bridges in Orgs., Inc. v. Bureau of Nat’l Affairs*, 19 U.S.P.Q.2d (BNA) 1827, 1831 (D. Md. 1991) (“Marks that are suggestive or arbitrary are considered ‘strong and presumptively valid.’”); *Del Labs., Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 780 (S.D.N.Y. 1981) (“[A] mark which is merely descriptive is considered to be ‘weak’ and cannot be accorded trade mark protection without proof of secondary meaning whereas a mark which is either suggestive or arbitrary is strong and presumptively valid.”). *But see* *Ignition Athletic Performance Group, L.L.C. v. Hantz Soccer U.S.A.*, 245 Fed. Appx. 456, 459 (6th Cir. 2007)

trademarks that are arbitrary, especially when the mark is non-textual. Color marks are especially susceptible to overprotection in this regard. Although the Supreme Court observed in *Qualitex* that a color-alone trademark could never be inherently distinctive,⁸¹ once secondary meaning is established, the temptation to view colors as arbitrary would understandably be a strong one. If the unadorned color of fiberglass insulation is off white, then any color that is injected into it is arbitrary. It makes little doctrinal sense to elevate the quantum of trademark protection this color receives above descriptive and suggestive marks on this basis alone.⁸² The proper analytical focus is on the strength of a mark's secondary meaning, the cognitive link between the mark and its source.⁸³ Rewarding arbitrariness with higher levels of protection incentivizes the monopolization of colors through trademark precepts, without offering a corresponding social benefit.

D. Communicative Functionality

Communicative functionality, which resides in the same analytic

("In assessing the strength of a mark, the trademark is placed into one of four categories, from weakest to strongest: generic, descriptive, suggestive, and fanciful or arbitrary. The district court correctly said that the Ignition logo is arbitrary, the strongest category of protection, because the term 'Ignition' has nothing to do with athletic performance. However, once the category is determined, we must analyze the mark's 'distinctiveness and degree of recognition in the marketplace.' Though Ignition has some exposure outside of Cincinnati, it is limited, and it did not establish any considerable strength in the Detroit market.") (citations omitted); *GOTO.COM, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) ("'[S]trength' of the trademark is evaluated in terms of its conceptual strength and commercial strength."); *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1536 (9th Cir. 1989); *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (approving placement on spectrum of distinctiveness as well as strength in the marketplace); *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) (listing factors demonstrating marketplace strength).

81 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995) ("True, a product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs which almost automatically tell a customer they refer to a brand But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand Again, one might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same? 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')."); see also *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211–12 (2000).

82 Writing for a unanimous Court, Justice Scalia noted in *Samara Brothers* that the hierarchical four category trademark taxonomy derived from *Abercrombie* could not be usefully or legitimately applied to trade dress elements such as color or shape. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

83 Rebecca Tushnet, *Gone in 60 Milliseconds: Trademark Law and Cognitive Science*, 86 *TEX. L. REV.* 507, 537 (2008).

neighborhood as aesthetic functionality, is one more complicating aspect of the use of color in commerce that ought to render color-alone trademarks unenforceable.⁸⁴ Using colors to communicate social meanings ought to be unfettered by trademark conventions.

Loyal alumni often wear their school colors while attending collegiate athletic events to communicate their affinity for a particular team. Colloquially one might accurately say that garnet and black are the trademark colors of the University of South Carolina, but wearing these colors to university sports events communicates support for the University of South Carolina Gamecocks outside the linear realm of commercial trademark use.

In *Qualitex*, Justice Stevens wrote that where a color serves a significant non-trademark function, courts should examine whether its use as a mark would permit interference “with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.”⁸⁵ Obviously the definitions of “significant” and “legitimate” are critical to giving this limiting principle practical meaning. Why, if a color is serving a significant non-trademark function, it should be protectable as a mark *at all* is never satisfactorily articulated, and seems inconsistent with the functionality language in sections 2 and 14 of the Lanham Act.

The Court did not address communicative functionality in its *Qualitex* opinion, most likely because the issue was not specifically raised by Jacobson in either its Respondent’s Brief, during oral argument, or by the sole amicus brief filed in support of Jacobson’s position.⁸⁶ Yet it is at least possible that *Qualitex* tries to signal a non-trademark related message through its use of the color green. In some contexts, green is used to subtly telegraph an ecological commitment or environmental friendliness, a message that retail dry cleaners might desire to communicate to customers, reassuring them that the chemicals used in dry cleaning are not harmful.

The Court’s subsequent holding in *Traffix Devices* suggests that once a color is shown to serve a non-trademark function, it isn’t eligible to be

84 For a discussion of the various ways consumers may use trademarks to communicate meanings unintended by the mark holder, see generally Sonia Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. (2006). See also Eduardo M. Peñalver & Sonia Katyal, *Property Outlaws* (Fordham Legal Studies, Research Paper No. 90, 2007), available at <http://ssrn.com/abstract=745324>.

85 *Qualitex*, 514 U.S. at 170 (1995).

86 See Transcript of Oral Argument, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (No. 93–1577), 1995 U.S. TRANS LEXIS 61; Brief for Respondent, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (No. 93–1577), 1993 U.S. Briefs 1577 (Lexis); Brief of Private Label Manufacturers Ass’n as Amicus Curiae in Support of Affirmance of the Decision Below, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (No. 93–1577), 1993 U.S. Briefs 1577 (Lexis).

legally recognized as a mark at all.⁸⁷ However, in the *TrafFix Devices* opinion, the Court confused matters by explicitly distinguishing *Qualitex* as a case about aesthetic functionality only in a way that implied that aesthetics do not affect the marketability of a product,⁸⁸ which is a highly questionable conclusion. Justice Kennedy, despite the arguments about the stain-hiding properties of green-gold by Jacobsen and without any explanation of why aesthetics do not effect a product's "quality," rather astonishingly wrote: "In *Qualitex* . . . esthetic functionality was the central question, 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."⁸⁹ Apparently the *TrafFix Devices* Court was so committed to bolstering the doctrinal prohibition on functional trademarks, it felt compelled to mischaracterize the facts of *Qualitex* rather than admit that this opinion had given functionality concerns short shrift.

The Court again emphasized the importance of the functionality prohibition in *Wal-Mart Stores, Inc. v. Samara Brothers*.⁹⁰ Justice Scalia wrote for a unanimous Court: "Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness."⁹¹ Communication is one of the utilitarian purposes that product design, colors particularly, can serve. Colors used in product packaging can communicate non-source related information as well.

There are many ways to make significant, arbitrary, non-aesthetic uses of color in commerce that are not considered trademarks or trademark infringement. Some judicial decisions have recognized that colors can signify a product's attributes, rather than its source. For example, in *McNeil Nutritionals, LLC v. Heartland*, a district court considering a trade dress claim held that the colors of packages of artificial sweeteners helped consumers identify the chemical composition of the sweeteners the packages contained.⁹² It noted that Sweet'N Low made red and pink the recognized color of saccharin, and competing house brands of saccharin reasonably used red and/or pink packaging to communicate their chemical composition to saccharin customers. The court observed that Equal's aggressive advertising of its product associated aspartame with blue in the public consciousness, so house brands of aspartame appropriately used blue packaging as well.

87 *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32–33 (2001).

88 *Id.* at 33.

89 *Id.*

90 *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

91 *Id.* at 213.

92 *McNeil Nutritionals, L.L.C. v. Heartland Sweeteners*, 512 F. Supp. 2d 217 (E.D. Pa. 2007), *aff'd in part and rev'd in part*, 511 F.3d 350 (3d Cir. 2007), *remanded*, 566 F. Supp. 2d 378 (E.D. Pa. 2008).

So, the court concluded that the successful marketing of Splenda made yellow the recognized color of sucralose, and therefore the company that manufactured and marketed Splenda into a 60 percent market share of artificial sweeteners could not obtain a preliminary injunction to prevent house brands from using yellow packaging too.⁹³ Although the court did not use this term, it recognized the communicative functionality of the colors employed by sugar substitute vendors and used it as a reason to limit trademark rights.

In *Nor-Am Chemical v. O.M. Scott & Sons Co.*⁹⁴ another district court ruled that the blue color of fertilizer was functional because it signaled the presence of nitrogen. In its 1982 opinion in *Inwood Laboratories v. Ives Laboratories, Inc.*,⁹⁵ the Supreme Court ruled that competitors should be free to copy the color of a medical pill because the color communicated the type of medication it contained, even though it might also serve source-identifying functions. This is another example of a court giving meaning to the concept of communicative functionality as a limitation on trademark rights, even if the term was not explicitly embraced.

The Hershey Company's use of brown in the wrapper of its famous Hershey Bar, and in the packaging of so many of its other products, communicates chocolate. Color can also communicate messages other than product ingredients per se. Continuing in the context of candy, the color red is associated with certain flavors: strawberry and cherry, which are as red as the fruits are when ripened on the tree or vine, and cinnamon, which is a far duller brown in its natural state. Red can also signal peppermint, such as in a traditional striped candy cane, even though the peppermint leaves from which the flavor is derived are bright green. Wintergreen flavored Lifesaver candies, however, are white.⁹⁶ Colors provide information the consumers want (green candies are unlikely to be orange or cherry flavored) even if it is imperfect or incomplete (green candies may be spearmint flavored, or the color may denote lime). The interference with this communication that can be caused by color-alone trademarks is one more argument against having them.

⁹³ See *McNeil Nutritionals, L.L.C. v. Heartland Sweetners*, 511 F.3d 350, 363 (3d Cir. 2007), *remanded*, 566 F. Supp. 2d 378 (E.D. Pa. 2008).

⁹⁴ See *Nor-Am Chem. v. O.M. Scott & Sons Co.*, 4 U.S.P.Q.2d (BNA) 1316, 1319–20 (E.D. Pa. 1987).

⁹⁵ See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853, 858 n.20 (1982).

⁹⁶ See *Lifesavers*, <http://www.candystand.com/shop/shop.do?brand=lifesavers> (last visited Mar. 26, 2008).

III. POTENTIAL IMPACT OF COLOR-ALONE TRADEMARKS

A. *Color Exhaustion and Scope Uncertainty*

The Supreme Court concluded in *Qualitex* that concerns about color exhaustion and uncertainty of trademark scope were outweighed by a directive Congress embedded within the wording of the Lanham Act to broadly construe the pool of signifiers from which federally registerable trademarks could be drawn.⁹⁷ The color exhaustion argument was an articulation of the possibility that there would be enough companies in a single market monopolizing color-based trademarks that all of the appealing colors would be taken, creating a barrier to entry by additional competitors. The uncertainty of scope argument referenced the likelihood of confusion standard for trademark infringement suggesting that the holder of a color trademark had a monopoly that extended beyond the registered color itself to any similar color or shade that was likely to be confusing to some cohort of the product-consuming populace.⁹⁸

Ambiguity about trademark scope likely hastens trademark exhaustion by incentivizing stake claiming, homestead-like behaviors toward color marks by commercial actors, and reasonably so. Uncertainty about whether another shade of green would be deemed confusingly similar to *Qualitex's* trademarked green-gold would cause risk-adverse competitors to avoid every permutation of green altogether. If another dry cleaning pad manufacturer trademarked one shade of blue, for all practical purposes this company would then have a monopoly over a huge swath of the blue spectrum. It wouldn't take too many color trademarks before the use of all of the colors that customers would find attractive were chilled by uncertainty, which in turn would synergistically exacerbate the color exhaustion phenomena.

Jacobson raised these concerns during the *Qualitex* litigation, but to no avail. Writing for a unanimous Court, Justice Breyer rather cavalierly dismissed these arguments, asserting that there were large numbers of color trademarks available for use, and if color exhaustion actually did begin to

⁹⁷ A comprehensive list of Jacobson's arguments opposing *Qualitex's* color-alone trademark is as follows: (1) color-alone trademarks would produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use; (2) a color-alone regime is unworkable in light of the limited supply of colors that will soon be depleted by competitors; (3) allowing color-alone trademarks was contrary to many older cases, including decisions of the Supreme Court interpreting pre-Lanham Act trademark law; and (4) allowing color-alone trademarks was unnecessary because companies could use color as components of protectable trademarks and trade dress. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166-74 (1995).

⁹⁸ For a good discussion of the uncertainties associated with color trademarks *see* Melissa E. Roth, Note, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 *CARDOZO L. REV.* 457, 476-82 (2005).

interfere with competition, the issue could be revisited in the future. He wrote: “When a color serves as a mark, normally alternative colors will likely be available for similar use by others.”⁹⁹ In the dry cleaning pad market niche this may have been true, but it doesn’t explain why trademark law compels competitors to use a second best color if consumers prefer green–gold for aesthetic reasons.

In addition, the *Qualitex* Court sanguinely touted the option of revisiting the color exhaustion issue by either successfully lobbying Congress to amend the Lanham Act, or attempting to re–argue it all the way up to the Supreme Court and convince nine Justices to abrogate the stare decisis doctrine¹⁰⁰ and overrule *Qualitex*, which is certainly a theoretical possibility. Realistically, however, it would be prohibitively expensive and far too uncertain for even a wealthy and well–established company to undertake. Because it is probably new or hopeful market entrants that are most negatively affected by enforceable color marks, the most motivated objectors may well lack the resources to mount an effective campaign for legislative or judicial change.

B. *The Potential Implosion of Trademark Dilution*

When color exhaustion and scope uncertainty are mixed into a trademark dilution dispute, the anticompetitive aspects of the doctrine are painted in stark relief. The *Qualitex* Court’s belief that the many visually observable colors in the world afford an almost unbounded trademark palette did not anticipate the limiting difficulties that the trademark dilution would soon pose by according almost absolute trademark rights to qualifying mark holders. The Federal Trademark Dilution Act was passed the year after *Qualitex* was decided and granted the holders of famous marks expansive, close–to–absolute rights that transcend the “use in commerce” limiting principles of traditional trademark law.¹⁰¹ Dilution powers were arguably

⁹⁹ *Qualitex*, 514 U.S. at 168.

¹⁰⁰ Jacobson argued that the Court would do this if it overturned the Ninth Circuit’s ruling in *Qualitex*. See Brief for Respondent, *supra* note 84, at *13.

¹⁰¹ See Lanham Act § 43(c)(1), 15 U.S.C.A. § 1125(c)(1) (Supp. 2008). The FDTA was revised and arguably strengthened in 2006, *see, e.g.*, Robert G. Bone, *Schechter’s Ideas in Historical Context and Dilution’s Rocky Road*, 24 SANTA CLARA COMPUTER & HIGH TECH. L. J. 469 (2008); Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, INTELL. PROP. L. BULL. 187 (2007). On the problems with dilution, *see generally* Christine Haight Farley, *Trademark Dilution Law: A Remedy in Search of a Harm*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 101 (2006); Sara K. Stadler, *The Wages of Ubiquity in Trademark Law*, 88 IOWA L. REV. 731 (2003); Lars S. Smith, *Implementing a Registration System for Famous Trademarks*, 93 TRADEMARK REP. 1097 (2003); Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, SANTA CLARA COMPUTER & HIGH TECH. L.J. 541 (2008). *But see* Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029 (2006); Shahar John Dillbary, *Famous Trademarks and the Rational Basis for Protecting Irrational Beliefs*, 14 GEO. MASON L. REV. 605 (2007); Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law* (Cardozo Legal Studies, Research Paper No. 175,

strengthened in 2006.¹⁰²

If non-famous within the meaning of section 43(c)(1) of the Lanham Act, Qualitex's green-gold is not entitled to protection from dilution, and can be infringed only by uses likely to be confusing to consumers, which are generally understood to be uses of the same or similar mark, on the same or similar (or "related") products,¹⁰³ which would be dry cleaning pads and auxiliary dry cleaning goods or services. However, if a court found it to be a "famous" mark, Qualitex would have cognizable dilution causes of action against a broad range of uses of the color in contexts in which there was no danger of consumer confusion. This is because dilution protection gives trademark holders the ability to prevent use of the mark by others in association with non-competing products in addition to traditional protection against acts by competitors that might confuse consumers.

Delta Airlines, Delta Faucets and Delta Dental are three different companies that peacefully coexist with the same trademark. Dilution doctrine says that once a company's trademark is famous, no one else can use the mark for any trademark purpose. Assuming away the grandparent provisions of the Lanham Act, this means that if the three companies had been formed after the FTDA took effect, and Delta Faucets convinced a court that it held a famous mark within the meaning of section 43 of the Lanham Act, subsequent market entrants Delta Airlines and Delta Dental would have to come up with alternative names for their companies. It is understandable that Delta Faucet might prefer to be the sole commercial user of Delta as a trademark, but it is not at all clear as a commercial matter that they need to be. Traditional trademark protections never gave them a doctrinal tool with which to accomplish this.

If a court deemed the green-gold mark famous within the meaning of the Lanham Act,¹⁰⁴ even uses of green-gold on disparate products such as lawn mowers or bicycles could be held dilutive of Qualitex's color mark. This would, however, restrict competition without a cognizable commercial justification, however, and few jurists are likely to be convinced that Qualitex earned this extensive a monopoly simply by using the color in connection with dry cleaning products, even if the company dominates that market. It may be that Qualitex's color mark would be unable to achieve "fame" no matter how well recognized it was among consumers.

Concerns about according color marks dilution protection should not be limited to *Qualitex*-type factual situations, either. Regardless of how well advertised and culturally familiar a color mark is among the populace, no judge who thinks through the ramifications of giving a trademark holder

2006), available at <http://ssrn.com/abstract=948576>.

¹⁰² See Trademark Dilution Revision Act 2006, H.R. Res. 683, 109th Cong., 120 Stat. 1730 (2006).

¹⁰³ See Beebe, *supra* note 70.

¹⁰⁴ Lanham Act § 43 15 U.S.C.A § 1125 (1998 & Supp. 2008).

the power to control a color in the almost absolute sense that dilution protections facilitate is going to be very enthusiastic about finding a color mark famous.¹⁰⁵ This is because awarding dilution protection to any color-alone trademark could spark a rush of color-alone mark registrations by companies fearful that unless they acted to preserve grandfathered rights to manufacture products in particular colors,¹⁰⁶ they would be seriously commercially disadvantaged in the future. That, in turn, would likely rapidly foment color exhaustion in many market sectors. Large companies would quickly become prohibitively constrained in the ways they could trademark, package, and market their goods and services, and as chaos ensued, there would be rebellion and backlash against dilution precepts.

Given dilution's popularity among well-funded mark holders, friction around color-alone marks is unlikely to be enough to upend dilution laws generally. It seems more likely that *Qualitex* could be legislatively overruled, and color-alone marks prohibited from registration on the principal registry or enforcement generally. Or, the more moderate step of deeming color-alone marks ineligible for dilution protection would be taken. However, the spectacle of Congress amending the dilution provisions of the Lanham Act yet again might hopefully telegraph the unsoundness of the ill-advised doctrine in a manner that contributes to its ultimate and much-hoped-for (by this author, at least) demise. And if color-alone marks are effectively ineligible for dilution protection regardless of fame, they are inherently second class marks. Though this approach might preserve color availability in the marketplace to an extent, it would further warp and confuse dilution doctrine, and widen the divide between the statutory provisions in the Lanham Act and what courts actually do.

CONCLUSION

Trademark rights are not supposed to interfere with competition based on anything other than the commercial reputation of a product or service, or of its source. Facilitating the registration and protection of color-alone trademarks allows companies to lock up the aesthetic and communicative

¹⁰⁵ See generally Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, INTELL. PROP. L. BULL. 187 (2007); Christine Haight Farley, *Trademark Dilution Law: A Remedy in Search of a Harm*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 101 (2006); Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029 (2006); Shahar John Dillbary, *Famous Trademarks and the Rational Basis for Protecting Irrational Beliefs*, 14 GEO. MASON L. REV. 605 (2007); Shubguh Ghosh, *Dilution and Competition Norms: The Case of Federal Trademark Dilution Claims Against Direct Competitors* (SMU Dedman Sch. of Law Legal Studies, Research Paper No. 00–14, 2007), available at <http://ssrn.com/abstract=1012645>. But see Beebe, *supra* note 99.

¹⁰⁶ When a mark is found to be famous and deserving of dilution protection, pre-existing marks that are the same or similar but in use for unrelated goods or services (so they do not infringe nor are not infringed by the now famous mark) receive the benefit of a grandparent protection clause. Lanham Act § 43, 15 U.S.C.A. § 1125 (1998 & Supp. 2008).

attributes of color, and therefore inhibits legitimate competition, to the detriment of consumers and would-be competitors alike. The approach the Supreme Court took toward color-alone marks in *Qualitex* ignored these important concerns, reflecting a “why not?” presumption about trademark expansionism that is in direct conflict with longstanding pro-competition jurisprudence of the *Sears* and *Compro* cases and their progeny.

Color-alone marks are fraught with uncertainty for competitors, as they can be perceived differently across eyeballs, lighting schemes and contexts. And the supply of commercially useful colors is fairly limited, especially when one factors in a cushion to guard against potentially similar colors as well as potentially confusing uses. The ability to compete on the basis of aesthetic attributes is significantly compromised by the color-alone mark regime.

Additionally, the virtually inherent functionality of color, especially when it is a product feature, has been inadequately recognized or doctrinally accommodated. Colors are almost always functional from a utilitarian, aesthetic, or communicative perspective. The fact that they may also have secondary meaning doesn’t “cure” the problems that functionality poses for trademark-ability, and any court that suggests otherwise is wrong as a matter of law.

The use of colors can be simultaneously arbitrary and functional, which can lead to confusion in courts smitten with the highly contestable view that arbitrariness is a valuable trademark attribute that should be judicially rewarded with extra vigorous protection. A sweatshirt can come in any color. The selection of an orange one by an individual may be superficially seen as an arbitrary choice. But maybe it is orange to make the wearer as visible as possible. Or maybe it is orange to communicate an allegiance to the Clemson Tigers, or to the University of Tennessee Volunteers. Or possibly the wearer simply finds orange to be an attractive and appealing color. None of these reasons have any innate trademark salience. Why trademark laws should incentivize the use of arbitrary marks by giving them enhanced doctrinal breath has never been cogently explained, and unless and until it is, judges should decline to do this.

Tellingly, while companies enthusiastically register color-alone marks, they never actually use color alone marks alone, unlike textual marks and symbols. They recognize that on their own, colors are not perceived by consumers as trademarks. Instead colors are interpreted as being functional from a utilitarian perspective; or because they are aesthetically functional and make a product or service more artistically or emotionally appealing; or because they communicate useful information about the product or service that is unrelated to its source. Color-alone marks can be used as effectively to disadvantage competitors as to independently and singularly signify sources.

Finally, it seems clear that if a court deemed a color-alone mark famous

and subject to broad dilution protections, there would be a justifiable backlash. The advisability of dilution protection is dubious enough when accorded to non-coined textual marks, which can at least be avoided by the use of synonyms. But there is no synonym or substitute, for example the color green. The ability of one company to own a shade of green effectively “in gross” would competitively disadvantage all other commercial entities regardless of what goods or services they proffered in the marketplace. The catastrophic anti-competitiveness that would follow according color-alone marks dilution protections illustrates the folly of dilution protection generally. It isn’t necessary, and ultimately all it may productively accomplish is a “Full Employment Act” style enrichment of trademark lawyers.

