

## When Can You Claim A Color As Your Trademark?

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In a recent case, *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, Docket No. 11-3303-cv (2d Cir. September 5, 2012), the Court held there was no “per se rule that would deny protection for use of a single color as a trademark in a particular industrial context.” *Id.* at 22. In that case, the Court found that the single color red on the sole of a women’s shoe which contrasted with the color on the upper portion of the shoe could be protected as a trademark in the fashion industry. Another Federal District Court in California ruled recently, that a company’s use of the color orange for markings and text on its medical syringe could *not* be protected as a trademark since the color was “functional” when applied to that product. *Acacia Inc. v. Neomed Inc.*, Case No. 8:11-cv-01329-JST-AN, C.D.Cal. 7/23/12. It determined that the color orange was functional in the medical industry because it signifies that a device is for oral use. So, how does this color-as-a-trademark work?

Many companies have successfully obtained trademark protection for a single color, for example, United Parcel Service’s registration for the color brown for transportation and delivery services, Reg. 2901090; Tiffany’s multiple registrations for a particular color of blue used on bags, boxes and various other products and services, Reg. Nos. 4177892, 2359351, 2416795, 2416794, 2184128; 3M’s registrations for yellow as a trademark for telephone maintenance instruments and POST-IT® notes, Reg. Nos. 2619345, 2390667; and Owens Corning’s registrations for the color pink for masking tape, insulation, and other products used in the building and construction industry, Reg. Nos. 3165001, 2380742, 2380445, 2090588, 1439132.

The U.S. Supreme Court held that color alone may be protected as a trademark, “when that color has attained ‘secondary meaning’ and therefore identifies and distinguishes a particular brand (and thus indicates its ‘source’).” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161, 163, 115 S. Ct. 1300, 131 L.Ed. 2d 248 (1995). The Court held color may *not* be protected as a trademark when it is “functional”. *Id.* at 165, 115 S.Ct. at 1300. There are two types of functionality: “utilitarian” and “aesthetic.” A color is functional under the utilitarian test if it is essential to the use or purpose of the product, or affects the cost or quality of the product. A color is aesthetically functional if its exclusive use “would put a competitor at a significant non-reputation-related disadvantage”. *Id.* at 165. If color “act(s) as a symbol that distinguishes a firm’s goods and identifies their source, *without serving any other significant function*,” it can be protected as a trademark. *Id.* at 166, 115 S.Ct. 1300 (*emphasis added*). So, how do you know if a color you are using or plan to use in your business can be protected as a trademark to the exclusion of your competitors?

Protecting color as a trademark can be a very powerful advantage if the color has no particular function or meaning in the industry in which it is used. However, in order to claim color as a trademark the color must be showcased as a source indicator for products or services in its marketing campaigns and advertising materials. Good examples of this are UPS’s reference to itself as “brown” in its advertising [<http://www.ajc.com/business/ups-packs-up-brown-612964.html>] and Owen Corning’s very blatant use of the color pink in its advertising. [<http://www.owenscorning.com/>] Both companies very clearly highlight a color in their ads and identify it strongly with their respective products and

services. This type of careful and clever planning, implementation, and marketing strategy is critical to developing a strong, unique and highly recognized color trademark.

Whatever color is used, it must not be "functional" in any respect in the industry in which it is used. Various "functionality" tests have been developed by the courts over time, and some include:

- whether the design (or color) yields utilitarian advantage,
- whether alternative designs (or colors) are available,
- whether advertising touts utilitarian advantages of the design (or color), and
- whether the particular design (or color) results from a comparatively simple or inexpensive method of manufacture.

*See Disc Golf Association V. Champion Discs Inc., 158 F. 3d 1002, 48 USPQ 2d 1132 (9<sup>th</sup> Cir. 1998).*

Functionality is evaluated within the context of the specific industry in which the goods or services for which color is claimed as a trademark will be offered. Had the markings on the medical devices in the *Acaia* case been red, it is possible that there would not have been a finding of functionality. Thus, know your industry before selecting a color on which to focus your marketing and advertising efforts.

Thinking outside the box when selecting trademarks and planning marketing strategy is critical in any industry. The explosion of social media and changes in traditional advertising and marketing methods have changed the way products and services are recognized. Companies need more unique and nontraditional approaches for a competitive edge. Promoting non-traditional trademarks such as a color, or other unique source indicators such as sounds, scents, flavor, and product shapes, may provide a fresh method to attract and entice a wider audience. So get out those color wheels and start plotting a new course.

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