

1 McCarthy on Trademarks and Unfair Competition § 7:39 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition
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J. Thomas McCarthy

Chapter 7. Trademark and Trade Dress Formats

II. COLOR

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§ 7:39. Color as element of trademark

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ¶1057(2)

Claiming the Exclusive Right to Use of a Color. The issue discussed here is whether a seller can legitimately obtain exclusive rights under the law of trademarks in the single color of its product. For example, can a seller of structural insulation obtain the exclusive right to color its insulation pink? Can the color pink serve to indicate source in the same way as does a word or picture?

Claiming Color in a Trademark Registration. As a matter of strategy, an applicant should not limit a trademark registration to a particular color unless that color is an essential and distinguishing element of the mark. A mark not limited to one color in effect covers the mark as it appears in any color.[FN1] If the trademark owner includes a particular color as an element of the registration, the owner may effectively restrict its rights to preventing use of that mark only in that color.[FN2]

[FN1] [Application of Data Packaging Corp., 59 C.C.P.A. 776, 453 F.2d 1300, 1302, 172 U.S.P.Q. 396 \(1972\)](#) (“[T]here is no reason why an applicant should not be able to obtain a single registration of a design mark covering all the different colors in which it may appear, that is to say, not limited to a particular color.”).

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[FN2] See discussion at [§ 19:58](#).

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§ 7:40. Color as element of trademark—Introduction

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ¶1057(2)

Under the traditional rule, the single color of a product was not capable of protection as a trademark.^[FN1] The traditional rule was supported by the rationales of “color depletion” and “shade confusion.” The “color depletion” rationale posited that there are only a few easy discernable colors and once all are taken in an industry, the new entrant may be deprived of a needful element of competition. The “shade confusion” rationale posited that determination of the issue of likelihood of confusion between shade of colors was too elusive and subjective.

In 1985, the Federal Circuit Court of Appeals rejected the traditional rule and held that the single color of a product is capable of being registered as a trademark.^[FN2] For the next ten years, some circuits followed the Federal Circuit and other adhered to the traditional rule.^[FN3] Finally, in 1995, in the *Qualitex* case, the Supreme Court resolved the split of opinion, favoring the Federal Circuit rule and holding that a single color of a product is capable of being registered and protected as a trademark.^[FN4] However, the court cautioned that the color depletion rule could, in the proper case, be invoked as a form of the defense of functionality.

The issue discussed here is whether a seller can legitimately obtain exclusive rights under the law of trademarks in the single color of its product. The issue is not whether a seller of goods or services can claim what could be called a “floating color”: that is, a color per se, divorced from the coloration of a specific product or container. To the author's knowledge, no court has granted a company the exclusive right to use a color per se, apart from being defined as the coloration of a specific product, shape or design. The Patent and Trademark Office will not register a color in the abstract and requires a drawing showing how the color will be applied to a product or package.^[FN5] The PTO applies the same rule of specificity to service marks.^[FN6]

The Federal Circuit has observed that a mark defined as a single color of one object is a materially different mark from a mark defined as the same color of a different object. In that case, the amendment of an application from the color blue for a vehicle rental building to the color blue for buildings, signs, uniforms, and other promotional materials was rejected as a material alteration of the mark as originally applied for.^[FN7]

Thus, a company might establish trademark rights in the greenish-gold color of cleaning press pads. But a company that makes and sells a product or service could not legitimately claim the exclusive right to use a particular color in any fashion whatsoever in advertising the service or in promoting or packaging the product. The 1995 Supreme Court decision in *Qualitex* involved the issue of a single color for a product, not a “floating color” or color per se disassociated from a specific product or package.[\[FN8\]](#) The use of a single color together with a specific, defined shape or design in advertising or on packaging has always been the subject of possible trade dress or trademark protection.[\[FN9\]](#) Similarly, a combination of colors in a specified design has usually been viewed as a candidate for trademark or trade dress protection.[\[FN10\]](#)

[\[FN1\]](#) See [§ 7:41](#).

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[\[FN2\]](#) See [§ 7:42](#).

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[\[FN3\]](#) See [§ 7:43](#).

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[\[FN4\]](#) See [§ 7:44](#).

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[\[FN5\]](#) T.M.E.P. § 1202.05(d) (2002 rev.) (“The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the shape of the product, or the shape of the package, is not claimed as part of the mark. . . . In the absence of a broken-line drawing, the Office will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.”). See [In re International Flavors and Fragrances Inc.](#), 47 U.S.P.Q.2d 1314 (T.T.A.B. 1998), *aff’d*, 183 F.3d 1361, 51 U.S.P.Q.2d 1513 (Fed. Cir. 1999) (“[T]he Office does not now permit the registration of color per se, that is, a drawing consisting merely of a particular color in the absence of a showing of how the color is or will be used on or in connection with the goods or services. . . . For example, an applicant seeking to register the color blue in connection with a farm implement must submit a drawing of the farm implement lined for the color blue rather than simply a drawing of a swatch of the color blue.”).

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[\[FN6\]](#) T.M.E.P. § 1202.05(d)(ii) (2002 rev.) (“As with color used on goods, a color service mark does not consist of color in the abstract. Rather, the mark consists of color used in a particular manner, and the context in which the color is used is critical to provide notice of the nature of the mark sought to be registered. Therefore, as with color marks used on goods, a drawing, supplemented with a written description, is required.”). For example, the United Parcel Service Registration No. 2131693 for the services of “motor vehicle transportation and delivery of personal property” describes the mark as: “The mark consists of the color brown applied to the vehicles used in performing the services.” The drawing shows a delivery van in the color brown.

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[\[FN7\]](#) [In re Thrifty, Inc.](#), 274 F.3d 1349, 61 U.S.P.Q.2d 1121 (Fed. Cir. 2001).

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[FN8] *See* § 7:44.

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[FN9] *See* § 7:45.

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[FN10] *See, e.g.,* [Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.](#), 659 F.2d 695, 703, 212 U.S.P.Q. 904, 911 (5th Cir. 1981), cert. denied, 457 U.S. 1126, 73 L. Ed. 2d 1342, 102 S. Ct. 2947 (1982) (while plaintiff could not preempt the use of red and yellow on garden chemical packaging, it could “protect the combination of particular hues of these colors, arranged in certain geometric designs, presenting in conjunction with a particular style of printing, in such fashion that, taken together, they create a distinctive visual impression”); [Gucci America, Inc. v. Dart, Inc.](#), 715 F. Supp. 566, 12 U.S.P.Q.2d 1912 (S.D.N.Y. 1989) (GUCCI color design consisting of green-red-white stripes as used on handbags, clothing, and watches is a strong mark). *Compare* [Campbell Soup Co. v. Armour & Co.](#), 175 F.2d 795, 81 U.S.P.Q. 430 (3d Cir. 1949), cert. denied, 338 U.S. 847, 94 L. Ed. 518, 70 S. Ct. 88, 83 U.S.P.Q. 543 (1949) (Campbell Soup could not claim exclusive rights in a can label horizontally divided into red and white.).

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§ 7:41. Color as element of trademark—Traditional “single product color” rule

West's Key Number Digest

West's Key Number Digest, [Trademarks](#)  [1057\(2\)](#)

Under the traditional rule, the single color of a product was not capable of protection as a trademark. The traditional rule was supported by the rationales of “color depletion” and “shade confusion,” described later. That is, under the traditional rule, one seller could not make a product in a single color and claim that product in that color as its exclusive trademark property.[\[FN1\]](#)

Even under the traditional rule, a color could be an essential element in an arrangement of colors, symbols or words. For example, in protecting a red ball embedded in the heel of a shoe as a trademark, a court stated:

Color, except in connection with some definite arbitrary design which serves to distinguish the article as made or sold by a particular person, is not the subject of a trademark, but the owner of a valid trademark, otherwise distinctive, may be protected against appropriation by a rival through mere change in color. . . . In considering likelihood of confusion of goods where a trademark is a figure or design or lettering, the owner's right may well cover that figure or design or lettering reproduced in any color for the identity of the figure, design or lettering, may mislead the purchaser in spite of the difference in color. But, the difference in color may so emphasize the difference between the figure, design or lettering as to obviate the likelihood of deceiving any purchaser. If the trademark were a black cross, certainly one in bright red would distinguish them.[\[FN2\]](#)

The above quotation reflects the law that a color of a product per se—unconfined by any defined design—could not be the subject of a trademark.^[FN3] As the Supreme Court stated in an early case: “if color be made the essential feature, it should be so defined, or connected with some symbol or design, that other manufacturers may know what they may safely do.”^[FN4] The Supreme Court concluded that “a trademark which may be infringed by a streak of any color, however applied, is manifestly too broad.”^[FN5] One reason for the ban on a seller appropriating a color as “his color” (an indication of origin) was that since there are so few colors available, in any given line of commerce, they would soon all be taken. This is why the traditional rule was sometimes known as the “color depletion” or “color monopolization” rule. As one court stated: “If they may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next, yellow in the same way. Obviously, the list of colors will soon run out.”^[FN6] While in scientific theory there may be hundreds of shades, the ordinary person can probably distinguish only a few basic colors. In addition, other practical limitations in an industry may limit the range of colors available for a product or package.^[FN7]

Another policy reason supporting the traditional rule was that if a color per se could be appropriated as a trademark symbol, determination of infringement would degenerate into deciding questions of “shade confusion” between closely similar color shades.^[FN8]

^[FN1] [James Heddon's Sons v. Millsite Steel & Wire Works](#), 128 F.2d 6, 9, 53 U.S.P.Q. 579 (C.C.A. 6th Cir. 1942) (“Color, except in connection with some definite, arbitrary symbol or in association with some characteristics which serve to distinguish the article as made or sold by a particular person is not subject to trademark monopoly.”); [Life Savers Corp. v. Curtiss Candy Co.](#), 182 F.2d 4, 9, 85 U.S.P.Q. 440 (7th Cir. 1950) (“That a man cannot acquire a trade-mark by color alone has been stated a good many times in decisions and textbooks.’ As a rule color cannot be monopolized to distinguish a product.”); [Mershon Co. v. Pachmayr](#), 220 F.2d 879, 883, 105 U.S.P.Q. 4 (9th Cir. 1955) (“We do not hold that color alone can be protected as a mark, but certainly color can be an element of a mark. . . .”); [Norwich Pharmacal Co. v. Sterling Drug, Inc.](#), 271 F.2d 569, 572, 123 U.S.P.Q. 372 (2d Cir. 1959) (“That a color may become someone's exclusive property as a perpetual monopoly in connection with a specific product has been rejected by the courts throughout the years.”); [Volkswagenwerk Aktiengesellschaft v. Rickard](#), 492 F.2d 474, 182 U.S.P.Q. 129 (5th Cir. 1974), also published at, 181 U.S.P.Q. 611, 1974 WL 323836 (5th Cir. 1974) (VW has no rights in color blue per se; injunction modified); [Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.](#), 604 F.2d 200, 5 Media L. Rep. (BNA) 1814, 203 U.S.P.Q. 161 (2d Cir. 1979) (“Although color alone is not capable of becoming a trademark, a combination of colors together with a distinctive arbitrary design may serve as a trademark.”); [NutraSweet Co. v. Stadt Corp.](#), 917 F.2d 1024, 16 U.S.P.Q.2d 1959 (7th Cir. 1990) (“As a rule color cannot be monopolized to distinguish a product.”).

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^[FN2] [Mishawaka Rubber & Woolen Mfg. Co. v. S. S. Kresge Co.](#), 119 F.2d 316, 49 U.S.P.Q. 419 (6th Cir. 1941), rev'd on other grounds, 316 U.S. 203, 86 L. Ed. 1381, 62 S. Ct. 1022, 53 U.S.P.Q. 323 (1942), reh'g denied, 316 U.S. 712, 86 L. Ed. 1777, 62 S. Ct.

[1287 \(1942\)](#) (the mark was protected as against those who also used a red ball, but not against those who used a ball symbol of a different color). Compare [Mishawaka Rubber & Woolen Mfg. Co. v. Panther-Panco Rubber Co.](#), 153 F.2d 662, 68 U.S.P.Q. 232 (1st Cir. 1946), cert. denied, 329 U.S. 722, 91 L. Ed. 625, 67 S. Ct. 64, 71 U.S.P.Q. 328 (1946), reh'g denied, 329 U.S. 826, 91 L. Ed. 702, 67 S. Ct. 183, 71 U.S.P.Q. 328 (1946), reh'g denied, 331 U.S. 868, 91 L. Ed. 1871, 67 S. Ct. 1526 (1947) (defendant's red oval with the mark PANCO on shoe heels held no infringement of the red ball mark).

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[FN3] See § 7:45.

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[FN4] [A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.](#), 201 U.S. 166, 50 L. Ed. 710, 26 S. Ct. 425 (1906), superseded by statute as stated in [Qualitex Co. v. Jacobson Products Co.](#), 514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995) (trademark claimed in wire rope with one strand of different color than the rest; held invalid as too vaguely defined, and no particular color designated). See [Wire Rope Corp. v. Secalt S.A.](#), 196 U.S.P.Q. 312 (T.T.A.B. 1977) (noting custom in the industry to use a colored strand to indicate source).

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[FN5] [A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.](#), 201 U.S. 166, 50 L. Ed. 710, 26 S. Ct. 425 (1906), superseded by statute as stated in [Qualitex Co. v. Jacobson Products Co.](#), 514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995).

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[FN6] [Campbell Soup Co. v. Armour & Co.](#), 175 F.2d 795, 81 U.S.P.Q. 430 (3d Cir. 1949), cert. denied, 338 U.S. 847, 94 L. Ed. 518, 70 S. Ct. 88, 83 U.S.P.Q. 543 (1949), superseded by statute as stated in [In re Owens-Corning Fiberglas Corp.](#), 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985). See [Diamond Match Co. v. Saginaw Match Co.](#), 142 F. 727 (6th Cir. 1906), cert. denied, 203 U.S. 589, 51 L. Ed. 330, 27 S. Ct. 776 (1906), superseded by statute as stated in [In re Owens-Corning Fiberglas Corp.](#), 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985) (“The primary colors, even adding black and white, are but few. If two of these colors can be appropriated for one brand of tipped matches, it will not take long to appropriate the rest.”); [Tas-T-Nut Co. v. Variety Nut & Date Co.](#), 245 F.2d 3, 113 U.S.P.Q. 493 (6th Cir. 1957); [Southern California Fish Co. v. White Star Canning Co.](#), 45 Cal. App. 426, 187 P. 981 (1920); [First Brands Corp. v. Fred Meyer, Inc.](#), 809 F.2d 1378, 1 U.S.P.Q.2d 1779, 1781 (9th Cir. 1987) (“Under the color depletion theory, there are a limited number of colors in the palette which may be depleted if trademark registrants are allowed to prevail.”).

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[FN7] See Summerfield, [Color as a Trademark and the Mere Color Rule: The Circuit Split for Color Alone](#), 68 Chi.-Kent L. Rev. 973, 996-997 (1993) (For example, only a certain number of colors are available for children's toys because of government toxicity standards and dark colors are unattractive for containers of many food products, such as milk and ice cream. “Dark-colored packages tend to look used, and people do not want to buy goods that look as if they had been handled a lot.”).

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[FN8] See, e.g., [NutraSweet Co. v. Stadt Corp.](#), 917 F.2d 1024, 16 U.S.P.Q.2d 1959 (7th

[Cir. 1990](#)), cert. denied, [499 U.S. 983, 113 L. Ed. 2d 735, 111 S. Ct. 1640 \(1991\)](#) (a policy supporting the “general rule” is that “infringement actions could soon degenerate into questions of shade confusion”); [Qualitex Co. v. Jacobson Prods. Co., 13 F.3d 1297, 29 U.S.P.Q.2d 1277 \(9th Cir. 1994\)](#), cert. granted, in part, [512 U.S. 1287, 129 L. Ed. 2d 935, 115 S. Ct. 40 \(1994\)](#), rev'd, [514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 \(1995\)](#). (Were the traditional color depletion rule not followed, “we could well become involved in ‘shade confusion’. ... Drawing distinctions between close shades of color could present unnecessary problems.”).

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§ 7:42. Color as element of trademark—Federal Circuit's challenge to the traditional rule

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ¶1057(2)

In a 1985 decision, the Court of Appeals for the Federal Circuit became the first court to explicitly reject the traditional color depletion rule. Collapsing the “color depletion rule” and the “functionality rule” together, the Federal Circuit, in a 2-1 decision, held that the overall color of a product was not precluded from registration as a trademark. The color pink for fiberglass insulation made by Owens-Corning was held registrable upon proof of secondary meaning through advertising promotion because “pink has no utilitarian purpose and does not deprive competitors of any reasonable right or competitive need.”^[FN1] A vigorous dissent by Judge Bissell argued for the rule that the color must be confined to “some definite arbitrary symbol or design.”

Notwithstanding the Federal Circuit's rule, the Trademark Board took the color depletion theory into account in applying the rule of functionality. The Board held that the color green for wrappers for band saw blades was unregistrable as functional because it constitutes one of a series of colors coding for types and sizes of blades.^[FN2] The Federal Circuit agreed that the functionality rule is applicable, holding that an all-black outboard motor was functional and not registrable because black has the special functional attributes of decreasing the apparent size of the motor and ensuring compatibility with many different boat colors.^[FN3]

Of the other federal circuits, only the Eighth Circuit decided to follow the *Owens-Corning* rule permitting exclusive rights in a single product color. In 1993, the Eighth Circuit rejected the traditional color depletion rule, embraced the *Owens-Corning* rule and held that the door was open for a maker of photographic splicing tape to prove itself entitled to the exclusive right to make its tape blue.^[FN4]

If the color depletion rule is satisfied, the next issue is mainstream trademark law: does

the combination of shape and color serve as a trademark to customers? The scope of the majority holding in the *Owens-Corning* case is considerably tempered by the majority's observation that the overall color of a product is "usually perceived [only] as ornamentation" and that "color marks carry a difficult burden in demonstrating distinctiveness and trademark character." It will be difficult for most firms to make the strong showing of promotion of the color which Owens-Corning did in this case with its extensive "Pink Panther" promotion.[FN5]

[FN1] [In re Owens-Corning Fiberglas Corp.](#), 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985). See [Edward Weck, Inc. v. IM, Inc.](#), 17 U.S.P.Q.2d 1142 (T.T.A.B. 1990)

(insufficient evidence to prove trademark significance for the color green for surgical instruments under the Federal Circuit rule in *Owens-Corning*).

- See Samuels and Samuels, "[Color Trademarks: Shades of Confusion](#)," 83 [Trademark Rep.](#) 554, 570 (1993) ("While trademark protection for a single product color may be difficult to achieve and limited to narrow sets of facts, it should not be barred under all circumstances.").

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[FN2] [Kasco Corp. v. Southern Saw Serv., Inc.](#), 27 U.S.P.Q.2d 1501 (T.T.A.B. 1993) (Applicant's various color coded wrappers, including the green wrapper at issue "serve to enable purchasers and users of the blades to quickly identify and distinguish one blade type from another. Thus, the various colored wrappers have a functional or utilitarian purpose.").

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[FN3] [Brunswick Corp. v. British Seagull](#), 35 F.3d 1527, 1532, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050, 131 L. Ed. 2d 309, 115 S. Ct. 1426 (1995). Cited as an example of a functional use of color in [Qualitex Co. v. Jacobson Prods. Co.](#), 514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995).

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[FN4] [Master Distributors v. Pako Corp.](#), 986 F.2d 219, 25 U.S.P.Q.2d 1794, 1798 (8th Cir. 1993), reh'g, en banc, denied, 1993 U.S. App. LEXIS 6941 (8th Cir. Apr. 5, 1993) ("If [plaintiff] can establish all the normal trademark requirements in the blue color of its Blue Max leader splicing tape, that shade may be protected against infringement. ... It is highly improbable that every distinguishable color shade has already been selected and would be subject to trademark protection.").

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[FN5] See Henry, "Right Hat, Wrong Peg: Re Owens-Corning Fiberglas Corp. and the Demise of the Mere Color Rule," 76 [Trademark Rep.](#) 389 (1986) (arguing that the color depletion justification of the mere color rule is fallacious and that color shades can and should be protected as trademarks); Keating, [Development of Evidence to Support Color-Based Trademarks](#), 9 [J. L. & Commerce](#) 1 (1989). See, e.g., [Edward Weck, Inc. v. IM, Inc.](#), 17 U.S.P.Q.2d 1142 (T.T.A.B. 1990) (insufficient evidence to prove trademark in color green for surgical instruments).

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§ 7:43. Color as element of trademark—Rejection of the Federal Circuit rule

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In adopting the traditional rule, the Ninth Circuit narrowly construed the Federal Circuit's Owens-Corning decision and affirmed denial of a preliminary injunction against imitation of PRESTONE yellow colored one-gallon jugs of automobile antifreeze.[\[FN1\]](#) The Ninth Circuit said that granting exclusive rights to the color yellow for a standard container stipulated to be of a utilitarian shape would be tantamount to giving a trademark on a color per se, which violates the “color depletion” rule:

[Plaintiff] would in effect be getting a trademark on the color yellow as a background color for an ordinary shaped container ... [T]his would deplete a primary color available to competitors and deprive them of a competitive need.[\[FN2\]](#)

As to how well defined need be the design to which color is confined, the Ninth Circuit in the *Prestone* yellow jug case remarked that the color depletion rule was satisfied if the

combination of shape and color was distinctive: “[T]he general rule remains that an element of distinctiveness of shape in combination with the color still exists before a trademark will be granted.”[\[FN3\]](#) The rule developed in this case seems to be that if the color was confined to a shape or container that is itself utilitarian, then this was an insufficient delineation or confinement of color and does not satisfy the color depletion rule. This view is supported by the Ninth Circuit's later ruling that the color depletion rule does not bar an exclusive right in the use of colors in a “particular graphic display.”[\[FN4\]](#) The Ninth Circuit said that it would follow the traditional color depletion rule and refused to follow the Federal and Eighth Circuits.[\[FN5\]](#) It was this decision that was reversed in the 1995 Supreme Court *Qualitex* decision, but the Ninth Circuit said it would protect color when it is a part of “trade dress,” even if “trade dress” only consists of combination of color and a word mark.[\[FN6\]](#)

For a period of some years, other federal courts refused to follow the ruling in *Owens-Corning* and continued to apply the traditional rule against product or package color.[\[FN7\]](#) The Eleventh Circuit held that the color royal blue did not and could not serve as a trademark in and of itself in connection with ice cream bar packages.[\[FN8\]](#) The Seventh Circuit said it would adhere to the traditional “color depletion” rule and not follow the Federal Circuit's 1987 *Owens-Corning* decision.[\[FN9\]](#) Instead, the Seventh Circuit adopted Judge Bissel's dissent in the *Owens-Corning* case. The Seventh Circuit said it would follow the traditional rule:

Although color alone cannot be protected as a trademark, it may be protected if it is used in connection with some symbol or design or impressed in a particular design, such as a circle, square, triangle, a cross or a star.[\[FN10\]](#)

The Seventh Circuit held that the color blue for restaurant packets of sugar substitute cannot be appropriated as the exclusive right of NutraSweet. Under the color depletion rule, “if each of the competitors presently in the tabletop sweetener market were permitted to appropriate a particular color for its product, new entrants would be deterred from entering the market.”[\[FN11\]](#)

[\[FN1\]](#) [First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1 U.S.P.Q.2d 1779 \(9th Cir. 1987\)](#) (The court characterized the *Owens-Corning* case as involving “an unusual set of facts,” and establishing only a “very limited rule that in certain situations a particular color could itself be registered as a trademark.” The Ninth Circuit saw two distinguishing elements in *Owens-Corning*: (1) There was no competitive need in the insulation industry for the color pink to remain free for competitors to use; and (2) there were “extraordinary and intense advertising campaigns” featuring the “Pink Panther” cartoon character, which established secondary meaning.). Compare [NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 16 U.S.P.Q.2d 1959, 1962 \(7th Cir. 1990\)](#), cert. denied, [499 U.S. 983, 113 L. Ed. 2d 735, 111 S. Ct. 1640 \(1991\)](#) (the Seventh Circuit refused to adopt a “fact-driven standard” which would turn on whether or not there was a competitive need in this industry to use color).

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[\[FN2\]](#) [1 U.S.P.Q.2d at 1782](#) (the color depletion rule was viewed as a variation of the rule

against trademark rights in functional features).

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[FN3] [1 U.S.P.Q.2d at 1781](#). The court then quoted this treatise that, “It is a matter of degree how well defined must be the design ... upon which the color is imposed.”

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[FN4] [Vision Sports, Inc. v. Melville Corp.](#), 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989).

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[FN5] [Qualitex Co. v. Jacobson Prods. Co.](#), 13 F.3d 1297, 29 U.S.P.Q.2d 1277, 1280 (9th Cir. 1994), cert. granted, in part, 512 U.S. 1287, 129 L. Ed. 2d 935, 115 S. Ct. 40 (1994), rev'd, [514 U.S. 159](#), 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995) (it was noted that in this industry of dry cleaning press pads, other manufacturers had used many different colors to identify their press pads). See [International Jensen v. Metrosound U.S.A., Inc.](#), 4 F.3d 819, 28 U.S.P.Q.2d 1287 (9th Cir. 1993) (denial of preliminary injunction was affirmed; Jensen claimed that defendant infringed on the trade dress of its auto loudspeaker in which the loudspeaker is attached to the speaker housing by a “surround” colored blue and uses the BLUE SURROUND trademark); [R.L. Winston Rod Co. v. Sage Mfg. Co.](#), 838 F. Supp. 1396, 29 U.S.P.Q.2d 1779 (D. Mont. 1993) (no protection for color green for fishing rods; limited number of colors is available).

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[FN6] The court defined “trade dress” here as the color in combination with the word mark SUN GLOW. Defendant copied the color and used the word mark MAGIC GLOW. Trade dress infringement was found.

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[FN7] See, e.g., [Russell Harrington Cutlery, Inc. v. Zivi Hercules, Inc.](#), 25 U.S.P.Q.2d 1965 (D. Mass. 1992) (in the First Circuit, the color depletion rule is the law; court refused to follow the Federal Circuit *Owens-Corning* case and refused to give exclusive rights to the color white for the handle of professional cutlery).

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[FN8] [AmBrit, Inc. v. Kraft, Inc.](#), 805 F.2d 974, 1 U.S.P.Q.2d 1161 (11th Cir. 1986), cert. denied, [481 U.S. 1041](#), 95 L. Ed. 2d 822, 107 S. Ct. 1983 (1987) (Royal blue is suggestive of coldness and in widespread use by ice cream producers. An injunction forbidding the use of royal blue is too broad and must be narrowed. “The general rule is that no seller can foreclose others absolutely from using any particular color.”). Accord: [Nor-Am Chemical Co. v. O.M. Scott & Sons Co.](#), 4 U.S.P.Q.2d 1316 (E.D. Pa. 1987) (the law in the Third Circuit is the traditional color depletion theory; plaintiff does not have an exclusive right to dye nitrogen fertilizer the color blue).

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[FN9] [NutraSweet Co. v. Stadt Corp.](#), 917 F.2d 1024, 16 U.S.P.Q.2d 1959 (7th Cir. 1990), cert. denied, [499 U.S. 983](#), 113 L. Ed. 2d 735, 111 S. Ct. 1640 (1991). Accord: [W. H. Brady Co. v. Lem Products, Inc.](#), 659 F. Supp. 1355, 3 U.S.P.Q.2d 1258 (N.D. Ill. 1987) (the law in the Seventh Circuit is the traditional rule that a party may not monopolize a color except when defined in a symbol or design); [Mitek Corp. v. Pyramid Sound Corp.](#), 20 U.S.P.Q.2d 1389 (N.D. Ill. 1991) (Court refused protection for the color blue for an audio speaker cone: “If each of the competitors in the speaker industry were permitted to appropriate a particular color for their speaker, new entrants would be

deterred from entering the market.”).

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[FN10] [16 U.S.P.Q.2d at 1962](#). *Accord*: [Keds Corp. v. Renee International Trading Corp.](#), [888 F.2d 215](#), [12 U.S.P.Q.2d 1808 \(1st Cir. 1989\)](#) (“[C]olor in combination with a distinctive design or shape may be trademarked if it develops a secondary meaning.” Blue rectangular label attached to heel or instep of a sports shoe is protectable. Such a defined use of color does not trigger “color depletion” concerns.).

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[FN11] The court further noted that while plaintiff could not assert exclusive rights in the color blue, it could prevent competitors from using packages confusingly similar to the overall trade dress of its sweetener packets.

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§ 7:44. Color as element of trademark—1995 *Qualitex* rule

West's Key Number Digest

West's Key Number Digest, [Trademarks](#)  [1057\(2\)](#)

The Qualitex Rule: A Single Color Can be a Trademark. In 1995, in the *Qualitex* case, the Supreme Court resolved the previous split of opinion and held that a single color of a product is capable of being registered and protected as a trademark.^[FN1] Noting that shapes, sounds and even scents have been regarded as candidates for trademark status, the Court said that it did not believe that there was a public policy reason with sufficient weight to bar any and all product colors from trademark status.^[FN2]

In the *Qualitex* case, the Ninth Circuit Court of Appeals had reversed the district court's injunction based on a registered trademark in the “gold/green” color of a pad used on dry cleaning presses by professional cleaners.^[FN3] Thus, the Ninth Circuit adhered to the traditional color depletion rule and refused to follow the Federal and Eighth Circuits.^[FN4] The Supreme Court reversed unanimously, stating that: “We now hold that there is no rule absolutely barring the use of color alone.”^[FN5]

Shade Depletion and Shade Confusion Arguments Rejected. The Supreme Court rejected the color depletion and shade confusion arguments as sufficient rationales underlying the traditional ban on a single product color as a trademark. The practical problem of resolving an issue of shade confusion was said to be no more difficult than determining whether differences in word marks would cause a likelihood of confusion.^[FN6] The Court converted the color depletion argument from a rationale for a blanket prohibition on single color marks into the basis for a possible functionality defense in an appropriate case:

This argument is unpersuasive, however, largely because it relies on an occasional problem to justify a blanket prohibition. When a color serves as a mark, normally alternative colors will likely be available for similar use by others. See, e.g., *Owens-Corning*, 774 F.2d, at 1121 (pink insulation). Moreover, if that is not so—if a “color depletion” or “color scarcity” problem does arise—the trade mark doctrine of “functionality” normally would seem available to prevent the anticompetitive consequences that [defendant's] argument posits, thereby minimizing that argument's practical force.^[FN7]

Color Depletion and the Bar of Functionality. Thus, the Supreme Court was of the view that while the possibility of color depletion was too remote to support a complete ban on single color trademarks, it could, in an appropriate case, serve as the basis for a functionality defense. Such a functionality bar can preclude abstract and sweeping claims to not only a single color, but also to combinations of basic colors. For example, a court held that John Deere & Co. could not claim exclusive trade dress rights in every possible shade and combination of the colors green and yellow for lawn and garden equipment. Such a broad claim was rejected as “functional,” in that it could start a trend in the lawn and garden equipment market that could deplete all colors “until there were no alternatives left.” However, Deere could establish trade dress rights in a specific shade and combination of green and yellow as applied to specific parts of lawn and garden equipment. ^[FN8]

The Supreme Court in the 1995 *Qualitex* case was well aware that sometimes color can be a utilitarian aspect of a product. In such a case, color is “functional” and barred from trademark or trade dress exclusive rights. The Court cited with apparent approval as examples of functional colors the green farm implements case, the black outboard motor

case, and the blue fertilizer case.[FN9] The Court concluded that “ordinarily, [the functionality doctrine] should prevent the anticompetitive consequences of [defendant's] hypothetical ‘color depletion’ argument, when, and if, the circumstances of a particular case threaten ‘color depletion.’”[FN10]

A Single Color Trademark Must Have Secondary Meaning. Prior to the Supreme Court's 2000 *Wal-Mart* decision, some had read the Court's *Qualitex* opinion as not settling the issue of whether a single product color can ever be so unusual as to be “inherently distinctive” and hence protectable without proof of secondary meaning.[FN11] However, in the author's opinion, the Court, albeit not in so many words, said that for this type of trademark or trade dress, a single color per se can never be classified as inherently distinctive and will always require proof of secondary meaning for protection and registration:

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. ... Over time customers may come to treat a particular color on a product or its packaging ... as signifying a brand. ... [I]f 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”).[FN12]

The Second Circuit held in accord with the author's view that after *Qualitex*, trademark or trade dress rights in a single color for a product can be achieved only upon a showing of secondary meaning.[FN13] The courts also take the view that because single color marks “by their very nature are not generally distinctive,” it is difficult to prove secondary meaning.[FN14] The Trademark Board has said that where the use of colors is common in a market segment, then applicant will have a difficult burden in proving that one specific color has achieved a secondary meaning identifying a particular source.[FN14.50]

This dispute came to an end when the U.S. Supreme Court in its *Wal-Mart* decision cleared up once and for all any lingering doubts about the rule in the *Qualitex* case. In *Wal-Mart*, the Supreme Court looked back to its previous decision and stated that in *Qualitex*, it had held that no single color can ever be inherently distinctive. Single color always requires proof of secondary meaning.[FN15]

No General Rule Against Single Color Marks in Any Particular Industry. The Second Circuit said that the Supreme Court in its *Qualitex* decision “specifically forbade the implementation of a per se rule that would deny protection for the use of a single color as a trademark in a particular industrial context.” The Second Circuit rejected the lower court's statement that a single color of wearing apparel is inherently aesthetically functional and can never serve a trademark role in the fashion industry.[FN16] The court found that plaintiff Christian Louboutin's high-fashion signature red shoe sole contrasting with the color of the shoe upper had achieved a secondary meaning but was not infringed by defendant Yves Saint Laurent's monochrome red shoe with both upper and sole in a single red color.[FN17]

[FN1] [Qualitex Co. v. Jacobson Prods. Co.](#), 514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995). See [Minnesota Mining and Manufacturing Co. v. Beautone Specialties, Co., Ltd.](#), 82 F. Supp. 2d 997, 53 U.S.P.Q.2d 1878 (D. Minn. 2000) (*Qualitex* “did not mark a sudden change in trademark law” so as to justify a 12-year delay in suing for infringement of a mark in the single color of yellow for sticky notes).

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[FN2] “If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?” [514 U.S. at 162](#).

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[FN3] [Qualitex Co. v. Jacobson Prods. Co.](#), 13 F.3d 1297, 29 U.S.P.Q.2d 1277 (9th Cir. 1994), cert. granted, in part, 512 U.S. 1287, 129 L. Ed. 2d 935, 115 S. Ct. 40 (1994), rev'd, 514 U.S. 159, 131 L. Ed. 2d 248, 115 S. Ct. 1300, 34 U.S.P.Q.2d 1161 (1995).

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[FN4] However, the Ninth Circuit said it would protect a single product color as part of “trade dress,” even if “trade dress” only consists of combination of color and a word mark. The Ninth Circuit defined “trade dress” here as the color in combination with the word mark SUN GLOW. Defendant copied the color and used the word mark MAGIC GLOW. Trade dress infringement was found.

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[FN5] [514 U.S. at 162](#).

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[FN6] “We do not believe, however, that color, in this respect, is special.” [514 U.S. at 167](#).

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[FN7] [514 U.S. at 167](#) (“Although sometimes color plays an important role (unrelated to source identification) in making a product more desirable, sometimes it does not.” [514 U.S. at 165](#)).

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[FN8] [Deere & Co. v. MTD Holdings Inc.](#), 70 U.S.P.Q.2d 1009, 2004 WL 324890 (S.D. N.Y. 2004) (“[I]f this court were to grant Deere exclusive trademark protection over the general use of basic colors (green and yellow), such protection would significantly hinder competition by limiting the range of adequate alternative designs available to other manufacturers. Therefore, under the doctrine of functionality, the court cannot grant Deere such broad protection.”).

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[FN9] Examples given were: [Deere & Co. v. Farmhand, Inc.](#), 560 F. Supp. 85, 98, 217 U.S.P.Q. 252 (S.D. Iowa 1982), aff'd, 721 F.2d 253 (8th Cir. 1983) (green color held “functional” because farmers like to have farm accessories color-coordinated with their tractors); [Brunswick Corp. v. British Seagull](#), 35 F.3d 1527, 1532, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994) cert. denied, 514 U.S. 1050, 131 L. Ed. 2d 309, 115 S. Ct. 1426 (1995) (all-black outboard motor was functional and not registerable because black has the special functional attributes of decreasing the apparent size of the motor and ensuring compatibility with many different boat colors); [Nor-Am Chemical Co. v. O.M. Scott & Sons Co.](#), 4 U.S.P.Q.2d 1316, 1320 (E.D. Pa. 1987) (users of fertilizer and the scientific

community use the color blue to designate nitrogen and hence there is a competitive need to dye nitrogen fertilizer the color blue). *See* discussion of functional use of colors at §§ [7:49](#) to [7:51](#).

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[\[FN10\] 514 U.S. at 170](#). In the author's view, one difficulty with this rule is that often, it will not be until product color becomes a standard means of brand identification in an industry and most of the standard colors are taken that it becomes obvious that “color depletion” threatens to be an anti-competitive reality. Therefore, the courts should be sensitive to apply the color depletion functionality rule as a preventative one to head off such anti-competitive problems before they become a reality. *See*: A. Bartow, [The True Colors of Trademark Law: Greenlighting a Red Tide of Anti-Competition Blues](#), 97 *Kentucky L.J.* 263 (2008) (criticizing the result of the *Qualitex* decision).

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[\[FN11\]](#) *See, e.g.,* Jordan & Jordan, “[Qualitex Co. v. Jacobson Products Co., The Unanswered Question: Can Color Ever Be Inherently Distinctive?](#)” 85 *Trademark Rep.* 371, 298 (1995) (arguing that: “The Supreme Court's decision cannot be read to summarily deny the possibility that color can ever be inherently distinctive”); Hudis, “[Removing the Boundaries of Color,](#)” 86 *Trademark Rep.* 1, 10 (1996) (opining that: “*Qualitex* left open the question whether color applied in an inherently distinctive fashion qualifies as a protectable trademark in the absence of secondary meaning.”).

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[\[FN12\] 514 U.S. at 163](#) (emphasis added).

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[\[FN13\]](#) *Fabrication Enters. v. Hygenic Corp.*, 64 F.3d 53, 35 U.S.P.Q.2d 1753 (2d Cir. 1995). *Accord:* *Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 36 U.S.P.Q.2d 1176 (2d Cir. 1995) (after the *Qualitex* decision, “color is today capable of obtaining trademark status in the same manner that a descriptive mark satisfies the statutory definition of a trademark, by acting as a symbol and attaining secondary meaning”); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 36 U.S.P.Q.2d 1737 (2d Cir. 1995) (in *Qualitex*, the Supreme Court held that a single color is capable of trademark status “only when it acquires secondary meaning”); *Forschner Group v. Arrow Trading Co.*, 124 F.3d 402, 43 U.S.P.Q.2d 1942 (2d Cir. 1997) (A single color “is never inherently distinctive” and is protectable “only when it has attained secondary meaning.” No secondary meaning was proven in the red handle of a Swiss army knife.); *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 103 U.S.P.Q.2d 1937 (2d Cir. 2012) (Christian Louboutin's high-fashion signature red shoe sole contrasting with the color of the shoe upper had achieved a secondary meaning but was not infringed by defendant Yves Saint Laurent's monochrome red shoe with both upper and sole in a single red color.).

- *See* [ERBE Elektromedizin GmbH v. Canady Technology LLC](#), 629 F.3d 1278, 1288-1290, 97 U.S.P.Q.2d 1048 (Fed. Cir. 2010) (Plaintiff did not prove secondary meaning in the color blue for endoscopic probes used for gastrointestinal conditions. “To survive summary judgment here, ERBE would have to establish a genuine issue of material fact that both the color blue is non-functional *and* has acquired secondary meaning.”).

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[\[FN14\]](#) *Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 36

[U.S.P.Q.2d 1176 \(2d Cir. 1995\)](#) (“The color black does not act as a symbol and distinguish Mana’s compacts from its competitors. It does not identify plaintiff as the source because there are countless numbers of cosmetic companies that sell black compacts. . . . [B]lack is as common a color for a makeup case as brown is for a paper bag.”). See [Sazerac Co. v. Skyy Spirits, 37 U.S.P.Q.2d 1731 \(E.D. La. 1995\)](#), aff’d without op., 1996 U.S. App. LEXIS 22908 (5th Cir. July 29, 1996) (vodka bottle in blue cobalt color cannot be protected as trade dress because of proof of “many other alcohol products, including vodka, that use a cobalt blue bottle”); [In re Florists’ Transworld Delivery Inc., 106 U.S.P.Q.2d 1784, 1792, 2013 WL 2494151 \(T.T.A.B. 2013\)](#) (A black colored box for flowers could not be registered as a mark for floral arrangements: evidence was not sufficient to prove secondary meaning.).

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[\[FN14.50\] In re Howard S. Leight and Associates Inc., 39 U.S.P.Q.2d 1058, 1996 WL 352967 \(T.T.A.B. 1996\)](#) (“Where the use of colors is common in a field, an applicant has a difficult burden in demonstrating distinctiveness of its claimed color.” Brightly colored reddish-orange hue of safety earplugs was not registerable as mark because functional and even if not, had not acquired secondary meaning because safety earplugs come in many colors.).

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[\[FN15\] Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 120 S. Ct. 1339, 1344, 54 U.S.P.Q.2d 1065, 1068 \(2000\)](#) (“ Indeed, with respect to at least one category of mark—colors—we have held that no mark can ever be inherently distinctive. [citing *Qualitex*]... We held that a color could be protected as a trademark, but only upon a showing of secondary meaning.”). *Applied in:* [Clam Corp., Inc. v. Innovative Outdoor Solutions, Inc., 89 U.S.P.Q.2d 1314, 2008 WL 5244845 \(D. Minn. 2008\)](#) (Registered blue color for ice fishing shelters is valid but not infringed. TRO denied.).

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[\[FN16\] Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc., 696 F.3d 206, 224, 103 U.S.P.Q.2d 1937 \(2d Cir. 2012\)](#). See § 7:80.

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[\[FN17\] Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc., 696 F.3d 206, 228, 103 U.S.P.Q.2d 1937 \(2d Cir. 2012\)](#) (While the court said that it did not “address” the issue of “likelihood of consumer confusion,” at the same time it held that the accused monochrome shoe was “neither a use of, nor confusingly similar to, the Red Sole mark.”).

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§ 7:44.50. Examples of single color registrations

Some examples of single color registrations for widely-known marks that have been registered after the 1995 Supreme Court *Qualitex* decision include:

- BROWN applied to vehicles, identifying the delivery services of the United Parcel Service[[FN1](#)]
- CANARY YELLOW applied to adhesive notes, identifying the goods as those of Minnesota Mining and Manufacturing Co. (MMM)[[FN2](#)]
- RED applied to knobs on cooking appliances of the Wolf Appliance Co.[[FN2.50](#)]
- LACQUERED RED applied to the sole of footwear.[[FN2.75](#)]
- ROBIN'S EGG BLUE applied to catalog covers, identifying the catalog services of Tiffany and Company.[[FN3](#)]

[[FN1](#)] U.S. Registration 2131693, registered Jan. 27, 1998, claiming a date of first use of 1917.

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[[FN2](#)] U.S. Registration 2390667, registered Oct. 3, 2000, claiming a date of first use of 1978.

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[[FN2.50](#)] U.S. Registration 3485025, registered Aug. 12, 2008, claiming a first use date of Feb 28, 2000. [Wolf Appliance, Inc. v. Viking Range Corp., 686 F. Supp. 2d 878, 94 U.S.P.Q.2d 1798 \(W.D. Wis. 2010\)](#) (preliminary injunction granted against use by Viking).

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[FN2.75] U.S. Registration 3361597, registered January 1, 2008 claiming a first use date of 1992. See [Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.](#), 696 F.3d 206, 103 U.S.P.Q.2d 1937 (2d Cir. 2012) (While plaintiff's registration was not limited to a contrasting red sole of footwear, the court exercised its power under Lanham Act § 37, [15 U.S.C.A. § 1119](#) to rectify the register by limiting the mark and its registration to a red sole that contrasted with the color of the shoe upper. The court found that plaintiff Christian Louboutin's high-fashion signature red shoe sole contrasting with the color of the shoe upper had achieved a secondary meaning but was not infringed by defendant Yves Saint Laurent's monochrome red shoe with both upper and sole in a single red color.).

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[FN3] U.S. Registration 2416794, registered Jan. 2, 2001, claiming a date of first use of 1939.

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§ 7:45. Color in connection with defined designs

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ¶1057(2)

Color Combinations and Color Confined to a Specific Design. Prior to the 1995 *Qualitex* decision, a single color was not protected. This meant that claims to an exclusive trademark or trade dress right in one color used as a background on a package or as the color of a product were usually rejected.^[FN1] However, when color was applied in a defined design or when several colors were combined in a pattern, even prior to *Qualitex*, the courts viewed the design as a candidate for trademark or trade dress rights.

After the *Qualitex* decision, whether color is confined to a defined design can determine whether inherent distinctiveness is a possible alternative to proving secondary meaning. If the color in combination with a design is ordinary and common, it will not constitute an inherently distinctive designation. For example, the use of two shades of green coloring a medical inhaler was held not to be inherently distinctive because it was common and usual, as six competitors used a two-color motif for their products.^[FN2] The degree of distinctiveness of the colored design can directly contribute to the degree of legal strength of the design as a trademark or trade dress. When secondary meaning is needed, the more unusual and elaborate the design, the more likely that it will be perceived as an indicator of source and not mere decoration. Commonplace or conventional colored designs may have little distinctiveness in the marketplace and little strength as trademarks in the courts.

In apparent discordance with the older rule that the color of a product itself was not protectable, in the taxicab cases, the courts were quite liberal in granting protection for the color of business vehicles.^[FN3] A more recent case protecting a red and black

taxicab color combination was in accord with the traditional rule, for color combinations are not barred by the color depletion rule.[FN4]

Although the uniform color of a product itself was usually not capable of trademark protection under the traditional rule, color applied to a product in a defined design could result in a composite so distinctive as to warrant protection.[FN5] However, merely coating the top of a fence post with a reflective material was held to be unprotectable because it was no “design” at all and was also functional.[FN6]

In the pharmaceutical drug color cases, drug firms have asserted trademark rights in the color or colors of drug capsules and have usually prevailed.[FN7]

In the *Campbell Soup* case,[FN8] the court held that Campbell Soup Co. could not claim any exclusive rights in a label horizontally divided into the colors red and white:

Color is a perfectly satisfactory element of a trademark if it is used in combination with a design in the form, for example, of a picture or a geometrical figure. . . . The mere division of a label into two background colors, as in this case, is not, however, distinct or arbitrary.[FN9]

The court distinguished the *Barbasol* case, which upheld the trademark significance of a shaving cream box having diagonal blue, white, and red stripes forming a border for a panel of blue.[FN10] Thus, a legal purist would say that the line defining the required degree of an “arbitrary” design or pattern was somewhere between the Campbell Soup red and white label and the Barbasol “barber pole” design.

Examples of Marks in Color Combinations and in Defined Colored Designs. Many decisions have held that various combinations of colors or defined shapes in a certain color are protectable trademarks:

- Agricultural machines: green body and yellow wheels[FN11]
- Bowling pin: red crown on neck of bowling pin[FN12]
- Champagne: MUMM's champagne with white label with red stripe running diagonally from upper left to lower right, edged in gold, with the words in gold “Cordon Rouge”[FN13]
- Charitable services: color red for six-pointed star of David[FN14]
- Computer hardware: black and white cow spots[FN15]
- Cooking appliances: red knobs[FN15.50]
- Fruit punch: pale blue can with picture of glass of red fruit punch[FN16]
- Garden chemicals: horizontal red, yellow, and white bands on bottle[FN17]
- Health insurance: blue shield design[FN18]
- Internet search engine: Words “Go” and “TO” in white font stacked vertically in a green

circle against a square yellow background[[FN19](#)]

- Personal accessories: GUCCI green-red-white stripes as used on watches, handbags, clothing and watches[[FN20](#)]
- Sports shoes: blue rectangular label attached to the heel or instep[[FN21](#)]
- Tape recording device: light colored rectangular panel on the face of the device[[FN22](#)]
- Taxi cab: registration for checkered band around taxi cab body[[FN23](#)]
- Wearing apparel: red, black, and white used in a particular graphic display in a logo[[FN24](#)]
- Wearing apparel: two color scheme used to identify a university[[FN25](#)]

Commonplace versus Distinctive Colored Designs. The more distinctive and arbitrary the design upon which a color is imposed, the more likely that buyers will really “see” the design. But if the design is a commonplace band, square, circle, etc., the buyer is more likely to regard it as mere background ornamentation or decoration.[[FN26](#)] The design and color composite must be so distinctive, or so widely advertised, that it catches the buyer's eye. It might be distinctive on its own, or the seller might so advertise the design as to cause buyers to look for the design-color combination. For example, the seller might advertise: “Look for the yellow label with the red star.”[[FN27](#)] Protection for defined designs that incorporate color has been granted by the Court of Customs and Patent Appeals.[[FN28](#)] In one case, the court, distinguishing the *Campbell Soup* case, held that a label design consisting of horizontal red and white bands with white polka dots was a distinctive combination of color and design.[[FN29](#)] The only difference between this design and the Campbell Soup design was the addition of polka dots. In holding a trademark registration on red-edged boxes and labels invalid, one court stated of such a trademark:

It seeks to obtain too much. There are only seven primary colors. These colors have been used ever since man first noticed the rainbow. Lines are common things, and people have long been using red lines and every other colored line. It would not be right to let a monopoly be created in that sort of thing.[[FN30](#)]

Similarly, another court found that the color red could not be claimed as a trademark by the use of red phonograph record labels on RCA's RED SEAL records.[[FN31](#)] The court rejected the claim that a round label on a phonograph record was a “distinctive” design upon which to use the color red, since the shape of the record dictates that the label be round. Similarly, other courts have held that merely applying color to logical divisions of a product, as to the panels of a basketball, will be perceived only as decoration, not as an identifying trademark.[[FN32](#)]

In distinguishing the RCA “Red Label” case, the C.C.P.A. held that a colored annular

band on round computer tape reels was not a functional part of computer tape reels.[FN33] Whereas all phonograph records had a circular center label, the C.C.P.A. held that the positioning of a circular band on computer tape reels was for “no functional purpose whatsoever,” and only to serve to distinguish and identify the source of the reels—that is, to act as a trademark. Similarly, the Trademark Board has held that trademark rights exist in: a blue band around a drum of chemical,[FN34] a gold band around an end of a sewer pipe,[FN35] a yellow band encircling a glass ampule,[FN36] and in a yellow band around a package of sausages.[FN37]

In a decision that stretched the limits of the traditional rule on colors, the Court of Customs and Patent Appeals in 1960 held that a square red label used as background for word marks was registrable as a trademark.[FN38] On the other hand, a year later the same court held that no trademark rights existed in red and blue bands around the top of men's white socks.[FN39]

Distinctive Colored Designs: Extent of Protection. Even if color is an integral element of a symbol (or word) mark, the symbol may be sufficiently distinctive as to prevent its use by a competitor even in connection with a different color. For example, the Fifth Circuit Court of Appeals held that the mark BLUE SHIELD with a shield design for medical insurance was infringed by RED SHIELD with a similar shield design for medical insurance. The court said, “It is the words and the symbols which are confusingly similar, not the ink applied by the printing press.” [FN40]

[FN1] [First Brands Corp. v. Fred Meyer, Inc.](#), 809 F.2d 1378, 1 U.S.P.Q.2d 1779, 1781-82 (9th Cir. 1987) (yellow one-gallon jug of antifreeze is not protectable). See [In re L. Tewelers Seed Co.](#), 140 U.S.P.Q. 75 (T.T.A.B. 1963) (registration refused for color blue for grass seed); [Vitarroz Corp. v. River Brand Rice Mills, Inc.](#), 266 F. Supp. 981, 153 U.S.P.Q. 398 (S.D.N.Y. 1967) (yellow package); [Schmidt Mfg. Co. v. Sherrill Industries, Inc.](#), 249 F. Supp. 480, 148 U.S.P.Q. 141 (W.D.N.C. 1965) (green plastic product); [Freixenet, S.A. v. Admiral Wine & Liquor Co.](#), 731 F.2d 148, 222 U.S.P.Q. 770 (3d Cir. 1984) (dictum that black colored bottle for wine is not protectable under the traditional rule); [Nor-Am Chemical Co. v. O.M. Scott & Sons Co.](#), 4 U.S.P.Q.2d 1316 (E.D. Pa. 1987) (plaintiff does not have an exclusive right to dye nitrogen fertilizer the color blue). - Compare [Gillette Safety Razor Co. v. Triangle Mechanical Laboratories Corp.](#), 4 F. Supp. 319 (D.N.Y. 1933) (recited the rule but granted protection for Gillette “Blue Blades”); [Germanow v. Standard Unbreakable Watch Crystals, Inc.](#), 283 N.Y. 1, 27 N.E.2d 212 (1940) (dictum that blue paper background protectable upon proof of secondary meaning); [Eastman Kodak Co. v. Fotomat Corp.](#), 317 F. Supp. 304, 165 U.S.P.Q. 444 (N.D. Ga. 1969), appeal dismissed, 441 F.2d 1079 (5th Cir. 1971) (Kodak alleged exclusive right in color yellow in selling photographic materials); [Eastman Kodak Co. v. Royal-Pioneer Paper Box Mfg. Co.](#), 197 F. Supp. 132, 130 U.S.P.Q. 466 (E.D. Pa. 1961) (KODAK yellow background protected); [Canon U.S.A., Inc. v. Saber Sales Corp.](#), 220 U.S.P.Q. 1003 (E.D.N.Y. 1983) (preliminary injunction issued against imitation of plaintiff's cameras in various colors).

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[FN2] [In re Glaxo Group Limited](#), 53 U.S.P.Q.2d 1920, 2000 WL 158735 (Trademark Trial & App. Bd. 2000) (“ [W]e do not think that purchasers would immediately

recognize or perceive applicant's asserted mark as a source indicator.”).

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[FN3] *See, e.g., Luxor Cab Mfg. Corp. v. Leading Cab Co.*, 125 Misc. 764, 211 N.Y.S. 886 (1925), *aff'd*, 215 A.D. 798, 213 N.Y.S. 847 (1926). *See also Southwestern Bell Tel. Co. v. Nationwide Independent Directory Service, Inc.*, 371 F. Supp. 900, 182 U.S.P.Q. 193 (W.D. Ark. 1974) (yellow colored pages protected as part of YELLOW PAGES word mark). *See* § 7:48.

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[FN4] *Transportation, Inc. v. Mayflower Services, Inc.*, 769 F.2d 952, 227 U.S.P.Q. 47 (4th Cir. 1985) (RED TOP taxi cabs' red and black color scheme was found to have acquired secondary meaning and to be infringed by a very similar red and black taxi cab design used by a competitor; injunction prohibiting defendant from using any red and black combination for its taxi cabs was affirmed as necessary to prevent further customer confusion).

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[FN5] *In re Tec Torch Co.*, 143 U.S.P.Q. 124 (T.T.A.B. 1964) (registration for three welding torch cables colored red, black, and blue, respectively); *In re Ritchie Mfg. Co.*, 170 U.S.P.Q. 291 (T.T.A.B. 1971) (red and yellow applied to arbitrarily selected portions of the product itself held registrable as a trademark); *Quabaug Rubber Co. v. Fabiano Shoe Co.*, 567 F.2d 154, 195 U.S.P.Q. 689 (1st Cir. 1977) (elongated yellow octagon on boot soles and heels held a valid mark); *In re AFA Corp.*, 196 U.S.P.Q. 772 (T.T.A.B. 1977) (gold and black colors on product held registrable); *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 216 U.S.P.Q. 102 (3d Cir. 1982) (six primary colors on faces of RUBIK'S CUBE puzzle protected as against imitator); *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989) (the colors red, black, and white used in a particular graphic display in a logo are protectable as trade dress; such a defined use of color does not trigger “color depletion” concerns).

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[FN6] *In re Pollak Steel Co.*, 314 F.2d 566, 136 U.S.P.Q. 651 (C.C.P.A. 1963); *see Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 184 U.S.P.Q. 348 (C.C.P.A. 1975) (yellow and orange fishing float held not an inherently distinctive color application and no secondary meaning proven); *Plastilite Corp. v. Airlite Plastics Co.*, 390 F. Supp. 1141, 185 U.S.P.Q. 313 (D. Neb. 1975), *rev'd*, 526 F.2d 1078, 189 U.S.P.Q. 327 (8th Cir. 1975), *cert. denied*, 425 U.S. 938, 48 L. Ed. 2d 179, 96 S. Ct. 1671, 200 U.S.P.Q. 128 (1976).

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[FN7] *See, e.g., SK&F, Co. v. Premo Pharmaceutical Laboratories, Inc.*, 625 F.2d 1055, 206 U.S.P.Q. 964 (3d Cir. 1980) (maroon and white color of diuretic drug capsule held protectable trade dress); *Ciba-Geigy Corp. v. Bolar Pharmaceutical Co.*, 547 F. Supp. 1095, 215 U.S.P.Q. 769 (D.N.J. 1982), *aff'd*, 719 F.2d 56 (3d Cir. 1983), *cert. denied*, 465 U.S. 1080, 79 L. Ed. 2d 763, 104 S. Ct. 1444 (1984). *See Smithkline Beckman Corp. v. Pennex Products Co.*, 605 F. Supp. 746, 225 U.S.P.Q. 963 (E.D. Pa. 1985) (where a trademark is asserted in the color orange of a type of nonprescription aspirin, defendant does not infringe if its container is opaque and customers cannot see that its tablets are orange; but if the container is translucent, then likely confusion is possible); *American Home Products Corp. v. Barr Laboratories, Inc.*, 656 F. Supp. 1058, 3 U.S.P.Q.2d 1194

(D.N.J. 1987), *aff'd*, [834 F.2d 368, 5 U.S.P.Q.2d 1073 \(3d Cir. 1987\)](#) (no infringement of color/shape of ADVIL brown ibuprofen tablets where copier's brown tablet was of a significantly different shape).

- *Compare* [Ives Laboratories, Inc. v. Darby Drug Co., 638 F.2d 538, 209 U.S.P.Q. 449 \(2d Cir. 1981\)](#), *rev'd, remanded*, [456 U.S. 844, 72 L. Ed. 2d 606, 102 S. Ct. 2182, 214 U.S.P.Q. 1 \(1982\)](#) (court of appeals improperly reversed district court's findings regarding contributory infringement). *See* Cooper, "Trademark Aspects of Pharmaceutical Product Design," 70 Trademark Rep. 1 (1980); "Symposium on the Ives Case," 72 Trademark Rep. 118 (1982); Weinberg, "Drug Color Copying in the Wake of Ives: A Comment on Two Decisions," 72 Trademark Rep. 285 (1982); discussion at [§ 7:50](#).

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[FN8] [Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 81 U.S.P.Q. 430 \(3d Cir. 1949\)](#), *cert. denied*, [338 U.S. 847, 94 L. Ed. 518, 70 S. Ct. 88, 83 U.S.P.Q. 543 \(1949\)](#).

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[FN9] [Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 81 U.S.P.Q. 430 \(3d Cir. 1949\)](#), *cert. denied*, [338 U.S. 847, 94 L. Ed. 518, 70 S. Ct. 88, 83 U.S.P.Q. 543 \(1949\)](#). *See* [Vitarroz Corp. v. River Brand Rice Mills, Inc., 266 F. Supp. 981, 153 U.S.P.Q. 398 \(S.D.N.Y. 1967\)](#); [H. P. Hood & Sons, Inc. v. Whiting Milk Co., 345 Mass. 287, 186 N.E.2d 904, 136 U.S.P.Q. 421 \(1963\)](#) (no protection for red design on milk carton); [Pacific Coast Condensed Milk Co. v. Frye & Co., 85 Wash. 133, 147 P. 865 \(1915\)](#) (red and white design on milk container—protection refused); [Eastman Kodak Co. v. Royal-Pioneer Paper Box Mfg. Co., 197 F. Supp. 132, 130 U.S.P.Q. 466 \(E.D. Pa. 1961\)](#) (KODAK yellow background with red and black design protected).

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[FN10] [Barbasol Co. v. Jacobs, 160 F.2d 336, 72 U.S.P.Q. 350 \(7th Cir. 1947\)](#). *See* [Pro-Phy-Lac-Tic Brush Co. v. Abraham & Straus, Inc., 11 F. Supp. 660 \(D.N.Y. 1935\)](#) (protected yellow container with the trademark written in red); [Gillette Safety Razor Co. v. Triangle Mechanical Laboratories Corp., 4 F. Supp. 319 \(D.N.Y. 1933\)](#) (blue blades protected); [Wm. Wrigley, Jr. Co. v. Colker, 245 F. 907 \(D. Ky. 1914\)](#).

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[FN11] [In re Deere & Co., 7 U.S.P.Q.2d 1401, 1988 WL 252363 \(Trademark Trial & App. Bd. 1988\)](#) (permitted registration of green body and yellow wheels for wheeled agricultural machines on showing of secondary meaning).

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[FN12] [Brunswick-Balke-Collender Co. v. American Bowling & Billiard Corp., 150 F.2d 69, 65 U.S.P.Q. 148 \(C.C.A. 2d Cir. 1945\)](#).

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[FN13] [G.H. Mumm Champagne v. Eastern Wine Corporation, 142 F.2d 499, 61 U.S.P.Q. 337 \(C.C.A. 2d Cir. 1944\)](#).

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[FN14] [In re American Red Magen David for Israel, 222 U.S.P.Q. 266, 1984 WL 63036 \(Trademark Trial & App. Bd. 1984\)](#) (held that color red for six-pointed star of David was "well within the permissible range of protectable arrangements of color," citing treatise).

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[FN15] [Gateway Inc. v. Companion Products Inc., 68 U.S.P.Q.2d 1407, 2003 WL](#)

[22508907 \(D.S.D. 2003\)](#), judgment modified on other grounds, [2003 WL 23532885 \(D.S.D. 2003\)](#) and judgment aff'd, [384 F.3d 503, 72 U.S.P.Q.2d 1591 \(8th Cir. 2004\)](#), reh'g and reh'g en banc denied, (Oct. 25, 2004) (infringement of the mark was found by similar use on computer accessories).

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[FN15.50] [Wolf Appliance, Inc. v. Viking Range Corp.](#), 686 F. Supp. 2d 878, 94 U.S.P.Q.2d 1798 (W.D. Wis. 2010) (Preliminary injunction granted. Wolf had a registered trademark for the red knobs.).

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[FN16] [RJR Foods, Inc. v. White Rock Corp.](#), 201 U.S.P.Q. 578, 1978 WL 21389 (S.D. N.Y. 1978), aff'd on point, [603 F.2d 1058, 203 U.S.P.Q. 401 \(2d Cir. 1979\)](#).

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[FN17] [Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.](#), 659 F.2d 695, 212 U.S.P.Q. 904 (5th Cir. 1981).

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[FN18] [National Ass'n of Blue Shield Plans v. United Bankers Life Ins. Co.](#), 362 F.2d 374, 150 U.S.P.Q. 80 (5th Cir. 1966) (BLUE SHIELD with a shield design for medical insurance was infringed by RED SHIELD with a similar shield design for medical insurance.).

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[FN19] [GoTo.com, Inc. v. Walt Disney Co.](#), 202 F.3d 1199, 53 U.S.P.Q.2d 1652 (9th Cir. 2000) (“It is precisely the identical colors that create the confusion: *white* script in a *green* circle on a yellow square.”).

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[FN20] [Gucci America, Inc. v. Dart, Inc.](#), 715 F. Supp. 566, 12 U.S.P.Q.2d 1912 (S.D. N.Y. 1989) (the GUCCI color design mark consisting of green-red-white stripes as used on watches, handbags, clothing and watches is a strong mark).

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[FN21] [Keds Corp. v. Renee Intern. Trading Corp.](#), 888 F.2d 215, 12 U.S.P.Q.2d 1808 (1st Cir. 1989) (A blue rectangular label attached to the heel or instep of a sports shoe is a protectable trademark. “[C]olor in combination with a distinctive design or shape may be trademarked if it develops a secondary meaning.” Such a defined use of color does not trigger “color depletion” concerns.).

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[FN22] [In re Graham Magnetics, Incorporated](#), 226 U.S.P.Q. 876, 1985 WL 72087 (Trademark Trial & App. Bd. 1985) (light colored rectangular panel on the face of a tape recording device is a defined application of color and registrable).

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[FN23] [Ex Parte Checker Cab Manufacturing Corporation](#), 99 U.S.P.Q. 480, 1953 WL 5161 (Comm'r Pat. & Trademarks 1953).

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[FN24] [Vision Sports, Inc. v. Melville Corp.](#), 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989) (the colors red, black, and white used in a particular graphic display in a logo are protectable as trade dress; such a defined use of color does not trigger “color depletion” concerns).

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[FN25] [Board of Supervisors of LA State University v. Smack Apparel Co.](#), 438 F. Supp. 2d 653, 211 Ed. Law Rep. 809, 82 U.S.P.Q.2d 1122 (E.D. La. 2006), *aff'd*, 550 F.3d 465, 89 U.S.P.Q. 2d 1338 (5th Cir. 2008) (summary judgment of infringement by selling without a license items of wearing apparel bearing the distinctive two color designs and logos of various universities).

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[FN26] [Ventura Travelware, Inc. v. Baltimore Luggage Co.](#), 66 Misc. 2d 646, 322 N.Y.S.2d 93 (1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1st Dep't 1972) (colored stripe design on luggage held merely ornamental and unprotectable).

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[FN27] In re [Swift & Co.](#), 223 F.2d 950, 106 U.S.P.Q. 286 (C.C.P.A. 1955) (“Look for the Polka Dot Label”); [Campbell Soup Co. v. Armour & Co.](#), 81 F. Supp. 114, 79 U.S.P.Q. 14 (D. Pa. 1948), *aff'd*, 175 F.2d 795, 81 U.S.P.Q. 430 (3d Cir. 1949), cert. denied, 338 U.S. 847, 94 L. Ed. 518, 70 S. Ct. 88, 83 U.S.P.Q. 543 (1949) (both parties said: “Look for the red and white label”); In re [Data Packaging Corp.](#), 453 F.2d 1300, 172 U.S.P.Q. 396 (C.C.P.A. 1972) (“Recognize them by the color-coded saturn ring around the hub”; secondary meaning proven); [Quabaug Rubber Co. v. Fabiano Shoe Co.](#), 567 F.2d 154, 195 U.S.P.Q. 689 (1st Cir. 1977) (advertising the color can serve to make a mark more distinctive); In re [AFA Corp.](#), 196 U.S.P.Q. 772 (T.T.A.B. 1977) (product advertised as “Gold and Black Means AFA”); [First Brands Corp. v. Fred Meyer, Inc.](#), 809 F.2d 1378, 1 U.S.P.Q.2d 1779 (9th Cir. 1987) (No secondary meaning found for yellow jugs of antifreeze, due in part to failure to stress color of jug in advertising: “It did not, for example, urge consumers to look for the ‘familiar yellow jug.’”). See § 7:30.

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[FN28] In re [Esso Standard Oil Co.](#), 305 F.2d 495, 134 U.S.P.Q. 402 (C.C.P.A. 1962). See In re [Data Packaging Corp.](#), 453 F.2d 1300, 172 U.S.P.Q. 396 (C.C.P.A. 1972). See also [Hygienic Products Co. v. Coe](#), 85 F.2d 264 (D.C. Cir. 1936) (yellow rectangle with blue border).

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[FN29] In re [Swift & Co.](#), 223 F.2d 950, 106 U.S.P.Q. 286 (C.C.P.A. 1955). Compare In re [Burgess Battery Co.](#), 112 F.2d 820, 46 U.S.P.Q. 39 (C.C.P.A. 1940). See § 7:24.

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[FN30] [James Heddon's Sons v. Millsite Steel & Wire Works, Inc.](#), 35 F. Supp. 169, 47 U.S.P.Q. 106 (D. Mich. 1940), *aff'd*, 128 F.2d 6, 50 U.S.P.Q. 465, 53 U.S.P.Q. 579 (6th Cir. 1942), cert. denied, 317 U.S. 674, 87 L. Ed. 541, 63 S. Ct. 79, 55 U.S.P.Q. 493 (1942). See [Caron Corp. v. V. Vivaudou, Inc.](#), 4 F.2d 995 (2d Cir. 1925) (black motif for perfume package). Compare In re [Hehr Mfg. Co.](#), 279 F.2d 526, 126 U.S.P.Q. 381 (C.C.P.A. 1960) (square red label held registrable); [Mershon Co. v. Pachmayr](#), 220 F.2d 879, 105 U.S.P.Q. 4 (9th Cir. 1955), cert. denied, 350 U.S. 885, 100 L. Ed. 780, 76 S. Ct. 139, 107 U.S.P.Q. 362 (1955) (white line on product held a trademark).

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[FN31] [Radio Corp. of America v. Decca Records, Inc.](#), 51 F. Supp. 493, 58 U.S.P.Q. 531 (D.N.Y. 1943) (the court also noted that the color “red” takes up about one-third of the visible spectrum of light, and that a claim to an exclusive right for this color for all record labels was an “egregiously exaggerated claim”).

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[FN32] [American Basketball Ass'n v. AMF Voit, Inc.](#), 358 F. Supp. 981, 177 U.S.P.Q. 442 (S.D.N.Y. 1973), *aff'd without op.*, 487 F.2d 1393, 180 U.S.P.Q. 290 (2d Cir. 1973), *cert. denied*, 416 U.S. 986, 40 L. Ed. 2d 763, 94 S. Ct. 2389, 181 U.S.P.Q. 685 (1974) (red, white, and blue panels on basketball held not inherently distinctive and devoid of secondary meaning); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 U.S.P.Q. 345 (C.C.P.A. 1975) (black and white panels on soccer ball held not inherently distinctive and devoid of secondary meaning); *In re Red Devil Tools*, 123 U.S.P.Q. 555 (T.T.A.B. 1959) (silver ball-shaped tip on glass cutter held merely a decorative dressing); *C. S. Hammond & Co. v. International College Globe, Inc.*, 210 F. Supp. 206, 135 U.S.P.Q. 56 (S.D.N.Y. 1962) (no right to color red on tube at pole of globe); *Delamere Co. v. Taylor-Bell Co.*, 249 F. Supp. 471, 148 U.S.P.Q. 368 (S.D.N.Y. 1966) (no distinctive combination of pink and white on hair curlers); *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 518 F. Supp. 607, 213 U.S.P.Q. 842 (E.D. Mo. 1981), *aff'd*, 684 F.2d 546, 215 U.S.P.Q. 97 (8th Cir. 1982) (color black on treads of ladder is nonprotectable and functional: it does not show wear and dirt).

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[FN33] *In re Data Packaging Corp.*, 453 F.2d 1300, 172 U.S.P.Q. 396 (C.C.P.A. 1972).

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[FN34] *Ex parte Nuodex Products Co.*, 107 U.S.P.Q. 300 (Comm'r Pat. 1955).

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[FN35] *Youngstown Sheet & Tube Co. v. Tallman Conduit Co.*, 149 U.S.P.Q. 656 (T.T.A.B. 1966).

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[FN36] *In re Hodes-Lange Corp.*, 167 U.S.P.Q. 255 (T.T.A.B. 1970).

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[FN37] *Ex parte Oscar Mayer & Co.*, 47 U.S.P.Q. 234 (Comm'r Pat. 1940). *See also Ex parte Checker Cab Mfg. Corp.*, 99 U.S.P.Q. 480 (Comm'r Pat. 1953) (checkered band around taxi cab body); *Wire Rope Corp. v. Secalt S.A.*, 196 U.S.P.Q. 312 (T.T.A.B. 1977) (red strand in wire rope, noting use of word mark RED STRAND).

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[FN38] *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 U.S.P.Q. 381 (C.C.P.A. 1960).

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[FN39] *In re David Crystal, Inc.*, 296 F.2d 771, 132 U.S.P.Q. 1 (C.C.P.A. 1961).

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[FN40] *National Ass'n of Blue Shield Plans v. United Bankers Life Ins. Co.*, 362 F.2d 374, 150 U.S.P.Q. 80 (5th Cir. 1966). *See* discussion of the scope of rights in color marks at § 7:45.70.

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1 McCarthy on Trademarks and Unfair Competition § 7:45.30 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition
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J. Thomas McCarthy

Chapter 7. Trademark and Trade Dress Formats
II. COLOR

[References](#)

§ 7:45.30. Registration drawing of mark in color

West's Key Number Digest

West's Key Number Digest, [Trademarks](#)  [1057\(2\)](#)

Every trademark registration, including one which comprises color as an essential element, must include a "clear drawing" of the mark.^[FN1] Over the years, there have been changes in the method of creating a drawing for a registration of a mark that is limited to one or more colors. Prior to 1999, color was indicated in a black and white drawing by various symbolic "linings" or types of cross-hatchings that indicated certain colors. After a 1999 rule change, the previous symbolic linings for color were no longer to be used. After the 1999 changes, where color was a feature of the mark, the applicant was required to submit a written statement explaining where the color or colors appear and the nature of the colors.

In 2003, the rules were changed again. The USPTO began accepting drawings in color on November 2, 2003. Starting on that date, the Office would no longer accept black and white drawings with a color claim, or drawings that show color by use of lining patterns.^[FN2] After the 2003 rule change, color drawings had to be accompanied by the following: (1) a color claim naming the colors that are a feature of the mark; and (2) a separate statement describing where the color or colors appear on the mark. For example, a properly worded color claim would read as follows: "The color orange is claimed as a distinctive feature of the mark."^[FN3] A properly worded description would read as follows: "The color orange appears in <specify portion of mark on which color or colors appear>."

Author's Comment: The basic rule of thumb is that an applicant should not submit a drawing in color unless that color is an essential and distinguishing element of the mark.

Many marks often appear on labels and advertisements in color. However, the applicant should not *restrict* the registration drawing to a particular color or colors unless color is a key and distinctive element of the mark. A mark not limited to one color in effect covers the mark as it appears in any color. If the trademark owner includes a particular color as an element of the registration, the owner may effectively re strict its rights to preventing use of that mark only in that color. At least, efforts to prevent use of the mark in other colors will be more difficult than if the registration was not limited as to a particular color at all.

[FN1] T.M.R.P. 2.21(a)(3). See [§ 19:58](#).

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[FN2] T.M.R.P. § 2.52(b)(1).

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[FN3] This could be supplemented by a definition of the color in a standard commercial color identification system, such as the Pantone system. T.M.E.P. § 807.09(c).

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1 McCarthy on Trademarks and Unfair Competition § 7:45.70 (4th ed.)

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Chapter 7. Trademark and Trade Dress Formats

II. COLOR

[References](#)

§ 7:45.70. Color infringement—Scope of rights in a color mark and “shade confusion”

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ¶1057(2)

How to Determine Infringement of Color Marks? Largely unexplored in the case law is the question of the scope of exclusionary rights when a mark consists of a single color or a combination of colors. Is a registration showing a shovel with a reddish orange handle infringed by a rake with a handle in a yellowish orange color? Is a candy package trade dress dominated by a dark purple oval infringed by a competitive candy package with a light purple circle? These are some of the most unpredictable and troublesome issues of infringement in trademark law. Of course, the law says that the ultimate decision is in the eyes and minds of customers. The test of infringement is: would the reasonably prudent customer be likely to be confused by the similar color as to source, sponsorship, affiliation or approval?

Deciding Issues of "Shade Confusion." These kinds of issues exemplify "shade confusion." This was one of the grounds for the now defunct traditional rule that the single color of a product was never capable of protection as a trademark. The "shade confusion" rationale posited that determination of the issue of likelihood of confusion between shades of colors was too elusive and subjective.^[FN1] This was unsuccessfully argued in the 1995 Supreme Court decision in *Qualitex* as a reason supporting the traditional rule against single color marks.^[FN2] However, the Supreme Court rejected the shade confusion argument as a sufficient rationale underlying the traditional ban on a single product color as a trademark. The practical problem of resolving an issue of shade confusion was said by the Court to be no more difficult than determining whether differences in word marks would cause a likelihood of confusion:

We do not believe, however, that color, in this respect, is special. Courts traditionally

decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers. ... We do not see why courts could not apply those standards to a color, replicating, if necessary, lighting conditions under which a colored product is normally sold. ... Indeed, courts already have done so in cases where a trademark consists of a color plus a design, i.e., a colored symbol such as a gold stripe (around a sewer pipe), a yellow strand of wire rope, or a 'brilliant yellow' band (on ampules).[\[FN3\]](#)

Even prior to the *Qualitex* case, some issues of shade confusion arose to a limited extent.[\[FN4\]](#)

Can Consumers Distinguish Between Two Sources by Two Different Gradations in Shades of Color? Some courts believe that consumers have no difficulty distinguishing different sources by subtle differences in shades, such as an accused “light gray” being distinguishable from plaintiff’s “gray teal blue”[\[FN5\]](#) or tennis racquet handle gauze tape in a purple hue “almost teal” as distinguishable from plaintiff’s tennis racquet handle grip tape that was “generally light blue.”[\[FN5.30\]](#)

But recognizing that ordinary consumers may not be able to distinguish between sources by differing shades of “blue,” the Trademark Board held that an applicant’s medical instrument in the color “teal” was likely to cause confusion with the prior registration of a similar medical device (used in conjunction with the applicant’s device) and using the color “blue” applied to the length of the product in the same way. The Board said that while “teal” was generally described as a shade of “greenish blue” or “bluish green,” the cited prior registration in “blue” would be considered as “any shade that would fall under the general term ‘blue.’” This included “teal.”[\[FN5.70\]](#)

Defining Shades Scientifically. There do exist scientifically accurate methods for objectively defining color shades, whether or not the human eye can distinguish them. For example, the Pantone Matching System (PMS) is an ink matching technique widely used by graphic designers in which PMS numbers designate colors. The Pantone formula guide, a three-guide set consisting of 1,114 solid Pantone colors on coated, uncoated and matte stock, shows corresponding printing ink formulas for each color that can be used for color identification, matching, and quality control.[\[FN6\]](#) Some courts have used the Pantone system as a method of defining the limits of trademark protection of a color and giving the defendant an objective benchmark for complying with an injunction.[\[FN7\]](#) Under this approach, a court could define the scope of a trademark in a color as, for example, ten numbered shades on each side of Pantone color number 165. Litigants have used the Pantone system in settlement agreements to define the scope of rights in color marks.[\[FN8\]](#)

Author's Opinion: The legal scope of a trademark in color is not defined in scientifically objective terms, like the claims of a utility patent. The test of infringement is not how many Pantone shades the defendant is distant from the senior user’s mark, but whether the reasonably prudent customer would be likely to be confused as to source, sponsorship, affiliation or approval. Some courts blithely assume that because there are hundreds of scientifically identifiable shades, consumers can distinguish between them to identify hundreds of different commercial sources by fine variations in shade and that therefore colors will never be “depleted” and no one will be confused.[\[FN9\]](#) In the author’s opinion, this is a unrealistic view which erroneously assumes that the first competitor in a

market to establish a primary color such as "red" as its distinguishing color will stand by and not sue (and likely win) when a competitor enters with a different shade of red, the junior user arguing in defense that its "yellowish red" is not confusingly similar to the senior user's "bluish red."

Anyone who has gone shopping in a paint store and been unable to distinguish between fine variations of shades will appreciate the attitude of a judge or juror asked to find that "yellowish red" does not infringe "bluish red." To complicate matters further, scientific studies have revealed that men perceive colors differently than women, creating a significant gender divide in color recognition.^[FN10]

If the decision maker thinks that the ordinary purchaser or user will see the color as a source indicator, and see them as close enough as to be likely to confuse source or affiliation, then infringement will be found. even though the color shades are not identical.

^[FN1] See § 7:41.

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^[FN2] [Qualitex Co. v. Jacobson Products Co., Inc.](#), 514 U.S. 159, 115 S. Ct. 1300, 131 L. Ed. 2d 248, 34 U.S.P.Q.2d 1161 (1995) ("First, Jacobson says that, if the law permits the use of color as a trademark, it will produce uncertainty and irresolvable court disputes about what shades of a color a competitor may lawfully use. Because lighting (morning sun, twilight mist) will affect perceptions of protected color, competitors and courts will suffer from 'shade confusion' as they try to decide whether use of a similar color on a similar product does, or does not, confuse customers and thereby infringe a trademark. Jacobson adds that the 'shade confusion' problem is 'more difficult' and 'far different from' the 'determination of the similarity of words or symbols.'" [514 U.S. at 167](#)).

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^[FN3] [Qualitex Co. v. Jacobson Products Co., Inc.](#), 514 U.S. 159, 167-168, 115 S. Ct. 1300, 131 L. Ed. 2d 248, 34 U.S.P.Q.2d 1161 (1995).

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^[FN4] See, e.g., [The Youngstown Sheet and Tube Company v. Tallman Conduit Company](#), 149 U.S.P.Q. 656, 1966 WL 7215 (TTAB 1966) (two sewer pipe manufacturers both used a colored band around the end of a pipe—one gold, the other orange); [Youngstown Sheet and Tube Company v. Armco Steel Corporation](#), 170 U.S.P.Q. 162, 1971 WL 16756 (TTAB 1971) (registration of orange fence post unsuccessfully opposed by owner of registration of mark for orange band on metal pipe); [In re Hodes-Lange Corporation](#), 167 U.S.P.Q. 255, 1970 WL 9589 (TTAB 1970) (comparing "brilliant yellow" band with "bronzy gold" band); [Wire Rope Corporation of America, Inc. v. Secalt S.A.](#), 196 U.S.P.Q. 312, 1977 WL 22574 (TTAB 1977) (registration of red and yellow strands in wire rope unsuccessfully opposed by owner of registration for red strand); [Amsted Industries, Inc. v. West Coast Wire Rope & Rigging, Inc.](#), 2 U.S.P.Q.2d 1755, 1987 WL 123828 (T.T.A.B. 1987) (likely confusion was found between opposer's wire rope with two adjacent strands of yellow as compared with applicant's wire rope with adjacent strands of yellow and yellowish green); [In re Amsted Industries Inc.](#), 972 F.2d 1326, 24 U.S.P.Q.2d 1067 (Fed. Cir. 1992) (no confusion likely between orange color of plastic sheath wrapped around wire rope and orange strand in six

strand wire rope).

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[FN5] [Regal Jewelry Co., Inc. v. Kingsbridge Intern., Inc.](#), 999 F. Supp. 477, 47 U.S.P.Q.2d 1074 (S.D. N.Y. 1998) (rejecting plaintiff's argument that because the colors of the two parties are both shades of "gray," confusion is likely, the court found plaintiff's position overly broad because it would "prevent other manufacturers from using many shades of gray as a background color for their packaging").

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[FN5.30] [Unique Sports Products, Inc. v. Ferrari Importing Co.](#), 100 U.S.P.Q.2d 1948, 2011 WL 5156798 (N.D. Ga. 2011), aff'd in part, vacated in part, 720 F.3d 1307, 107 U.S.P.Q.2d 1531 (11th Cir. 2013) (Plaintiff's federally registered "light blue" color for its product was a valid mark, but not infringed. Vacating as "unnecessary" the decision that the non-infringed mark was valid.).

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[FN5.70] [In re Cook Medical Technologies LLC](#), 105 U.S.P.Q.2d 1377, 2012 WL 6967733 (T.T.A.B. 2012) (The Board noted that applicant had the option of filing a petition to "restrict" the cited registration in order to narrow the definition of "blue" to a specific shade if it would avoid a likelihood of confusion.). *See* § 20:44.

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[FN6] *See* [www.pantone.com](#). *See also* Henry, "Right Hat, Wrong Peg: Re Owens-Corning Fiberglas Corp. and the Demise of the Mere Color Rule," 76 Trademark Rep. 389, 402 (1986) (describing the scientific basis for distinguishing and defining color shades).

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[FN7] In an injunction barring use of trade dress graphics, defendant was required to use "a discernibly different pink, at least 40 percent different in terms of PMS tones. Plaintiff did not prove secondary meaning in the pink shade apart from its use in a defined graphic design as trade dress. [Olay Co., Inc. v. Cococare Products, Inc.](#), 218 U.S.P.Q. 1028, 1983 WL 62351 (S.D. N.Y. 1983), motion for clarification of injunction denied, rejecting argument that injunction was too uncertain or vague, [Olay Co., Inc. v. Cococare Products, Inc.](#), 223 U.S.P.Q. 122, 1983 WL 44369 (S.D. N.Y. 1983); [Clam Corp., Inc. v. Innovative Outdoor Solutions, Inc.](#), 89 U.S.P.Q.2d 1314, 2008 WL 5244845 (D. Minn. 2008) (No infringement of registered color for blue ice fishing shelters by use of different shades of blue with other colors. Court defined the contesting blues by their Pantone numbers.).

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[FN8] [Newborn Brothers and Company, Inc.](#), 2002 WL 1899729 (TTAB 2002) (settlement agreement not to sell nondrip caulking guns in certain Pantone shades of yellow—specifically 77 listed shades).

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[FN9] *See, e.g.*, [Master Distributors, Inc. v. Pako Corp.](#), 986 F.2d 219, 25 U.S.P.Q.2d 1794 (8th Cir. 1993) ("Until secondary meaning has been established in every distinguishable shade of color ... there will always be an option available to a new market entrant." Court noted a color atlas listed 1,266 colors.).

- Some judges think that because technology can produce more shades, consumers are able to distinguish between them: "While there may be attractive arguments in favor of

the color depletion theory, this Court concludes that it is not a persuasive theory in light of available contemporary technology. There are a myriad of colors and shades available for products today that were certainly not available in the past." [DAP Products, Inc. v. Color Tile Mfg., Inc.](#), 821 F. Supp. 488, 27 U.S.P.Q.2d 1365, 1369 (S.D. Ohio 1993) (preliminary injunction granted against use of 3 ½-gallon red bucket containing mastic adhesive).

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[FN10] Smithsonian magazine, March 2013, citing behavioral studies done by vision specialist Israel Abramov at CUNY's Brooklyn College (“[M]en require a slightly longer wavelength to see the same hue as women; an object that women experience as orange will look slightly more yellowish to men, while green will look slightly more blue-green to men.”).

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1 McCarthy on Trademarks and Unfair Competition § 7:46 (4th ed.)

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated March 2015

J. Thomas McCarthy

Chapter 7. Trademark and Trade Dress Formats

II. COLOR

[References](#)

§ 7:46. Trademark rights in design of nonspecified color

West's Key Number Digest

West's Key Number Digest, [Trademarks](#) ⇐ [1057\(2\)](#)

Early decisions appeared to say that a design, even though adequately defined, could not be appropriated as a “colored” design without defining the exact color claimed.^[FN1] However, later decisions of the Trademark Board did grant registrations to marks consisting of things such as bands of “contrasting colors.”^[FN2] In the 1972 *Data Packaging* decision,^[FN3] the C.C.P.A. distinguished prior cases and held that a mark described as an annular band on a computer tape reel of a color that contrasts with that of the reel, was sufficiently described, although not defined in any specified color. The court interpreted cases like the *Leschen Rope* case,^[FN4] as *not* laying down any general principle that a trademark registration could not be obtained in a nonspecified color, but rather holding that it was the breadth and indefiniteness of the registration that rendered it too broad. Thus, the C.C.P.A. held that a registration can cover a colored element not limited to a particular color, as long as the description of the mark is “neither indefinite nor unduly broad.” The C.C.P.A. posited the test as one of clarity of description to the trade:

A competing manufacturer can ascertain from reading the description of the mark in [the] application exactly what design [he] regards as his trademark and can govern its selection of its own trademark accordingly with no fear of inadvertent infringement. Similarly, while appellant may have pre-empted a very desirable trademark, that is often true, and there is no reason here, in contrast to the “Leschen Rope” cases, to suspect that appellant is somehow engrossing the field of available trademarks for application to computer tape reels.^[FN5]

In the CROSS pen cases, it was held that Cross had trademark rights in a colored conical

top of a pen against a pen barrel of contrasting color.[FN6] The use of the color black, followed by use of gold and silver, was held to be a continual use of essentially the same mark, covering the application of any color to the pen top. By use of different colors at different times, the user acquired the right to use all of the different colors. Such a right first accrued as of the date of the first use of any of the colors to the pens.

However, sometimes a claim to contrasting colors of any hue may amount to an indefinite and potentially overreaching right of exclusion. In denying a preliminary injunction against an alleged infringement of plaintiff's LE CLIC camera trade dress consisting, in part, of "unusual contrasting color combinations of bold colors," the court said:

Absent a specifically defined, color-definite, and stable visual appearance, an alleged trade dress cannot receive protection. To hold otherwise and grant plaintiff trade dress protection for combinations of unspecified contrasting colors would allow the plaintiff to monopolize all combinations of contrasting colors. ... [P]laintiff's alleged trade dress consumes so much of the rainbow of available colors that trademark protection must be denied.[FN7]

Similarly, a court refused to find protectable trademark or trade dress rights in a "rainbow" concept of identifying tourist guidebooks by color according to the language of the book. For example, the cover of plaintiff's Spanish language version had a two-inch band in green, the English version was red, the German brown, and the Italian orange. The defendant's guidebooks also used a color-coding system, but used *different* colors to indicate the language. The court found that the color-coding idea was a mere generalized business concept that was not sufficiently concrete to constitute protectable trade dress.[FN8]

[FN1] [A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.](#), 201 U.S. 166, 50 L. Ed. 710, 26 S. Ct. 425 (1906); [International Braid Co. v. Thomas French & Sons, Ltd.](#), 150 F.2d 142, 66 U.S.P.Q. 109 (C.C.P.A. 1945) (colored bands on venetian blind webs).

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[FN2] [In re Dassler](#), 134 U.S.P.Q. 265 (T.T.A.B. 1962) (registration of lines on athletic shoes in "contrasting colors"); [In re Levi Strauss & Co.](#), 165 U.S.P.Q. 348 (T.T.A.B. 1970); [Federal Glass Co. v. Corning Glass Works](#), 162 U.S.P.Q. 279 (T.T.A.B. 1969) (registration of flower design in any color).

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[FN3] [In re Data Packaging Corp.](#), 453 F.2d 1300, 172 U.S.P.Q. 396 (C.C.P.A. 1972).

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[FN4] [A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.](#), 201 U.S. 166, 50 L. Ed. 710, 26 S. Ct. 425 (1906). *See* [A. Leschen & Sons Rope Co. v. American Steel & Wire Co.](#), 55 F.2d 455 (C.C.P.A. 1932).

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[FN5] [In re Data Packaging Corp.](#), 453 F.2d 1300, 172 U.S.P.Q. 396 (C.C.P.A. 1972). *Accord*: [In re Eagle Fence Rentals, Inc.](#), 231 U.S.P.Q. 228 (T.T.A.B. 1986) (held registrable as a trademark for the service of renting fences was a design of alternately

colored strands of vertical wires in a chain link fence; the fence wire strands were of two contrasting, but not specified, colors).

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[FN6] [T & T Mfg. Co. v. A.T. Cross Co.](#), 178 U.S.P.Q. 497 (T.T.A.B. 1973), modified, 449 F. Supp. 813, 197 U.S.P.Q. 763 (D.R.I.), aff'd, 587 F.2d 533, 201 U.S.P.Q. 561 (1st Cir. 1978), cert. denied sub nom. [A.T. Cross Co. v. Quill Co.](#), 441 U.S. 908, 60 L. Ed. 2d 377, 99 S. Ct. 2000, 202 U.S.P.Q. 320 (1979); [A.T. Cross Co. v. TPM Distributing, Inc.](#), 226 U.S.P.Q. 521 (D. Minn. 1985) (held that Cross has a trademark in a conical top of a pen that is of contrasting color to the barrel; confusion survey resulting in 43% and 34% identification of defendant's pens with Cross proved likely confusion).

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[FN7] [Keystone Camera Products Corp. v. Ansco Photo-Optical Corp.](#), 667 F. Supp. 1221, 3 U.S.P.Q.2d 1797 (N.D. Ill. 1987). Compare [Canon U.S.A., Inc. v. Saber Sales Corp.](#), 220 U.S.P.Q. 1003 (E.D.N.Y. 1983) (preliminary injunction issued against imitation of plaintiff's cameras in various colors). See [Al-Site Corp. v. VSI International Inc.](#), 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (No secondary meaning proven in color coding system where plaintiff changed its color coding trade dress "from time to time.").

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[FN8] [Casa Editrice Bonechi, S.R.L. v. Irving Weisdorf & Co.](#), 45 U.S.P.Q.2d 1360 (S.D.N.Y. 1997). The appearance of defendant's books in issue in the 1997 decision was a redesign of an earlier design found to be infringing. In an earlier decision, the court found infringement when the defendant's first version of its book design used the *same* color to denote each language, in addition to other similarities. [Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.](#), 37 U.S.P.Q.2d 1417 (S.D.N.Y. 1995).

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