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Are Colors for You? A Primer on Protecting Colors as Marks in the United States

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Color can be an integral element in the marketing of products and services. It telegraphs to consumers an immediate, distinctive message about the product or service. For example, white usually conveys the idea of purity or cleanliness, while gray can evoke an industrial, commercial or modern feel.



In a marketplace that abounds with a jarring cacophony of words, designs and slogans spread out over an ever-increasing range of marketing media, color can cut through the noise and present a simple, distinctive identity. Instant recognition. Instant message. When we see a pink insulation product, we immediately think of Owens-Corning and its Pink Panther spokes-cartoon. Likewise, these days the color brown conjures up UPS delivery services.

While exclusive rights in individual colors cannot lightly be monopolized by any one entity, in certain cases trademark rights in a particular color can be secured within narrow and fair parameters. This article addresses how businesses can protect color as a mark in the United States.



Colors as Marks: A History Lesson

In the United States, color marks are marks that consist solely of one or more colors used on particular objects. But this was not always the case.

Previously, you could register only a combination of colors in connection with some definite, arbitrary design. The refusal to recognize a single color as a mark was based on the “color depletion” and “shade confusion” theories. Under the color depletion theory, the view was that there were only a few easily discernable colors, and if trademark owners could claim exclusive rights to them, their competitors would be disadvantaged. The shade confusion theory attacked color marks a little differently. While a single color could conceivably function as a mark, the theory deemed any likelihood-of-confusion analysis between shades of colors too subjective to stand.

The Federal Circuit Paves the Way in Owens-Corning

The Federal Circuit Court of Appeals rejected the color depletion theory in 1985 when it decided *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985). Owens-Corning tried to register the color pink for its insulation products. Relying on the color depletion theory, the USPTO refused to register pink as a mark. On appeal, the Trademark Trial and Appeal Board held that, while the overall color of goods can function as a mark, the plaintiff had not demonstrated that pink had acquired

distinctiveness in connection with insulation products, and therefore upheld the USPTO's refusal to register the mark.

On Owens-Corning's further appeal, the Federal Circuit confirmed that a single color is protectable as a mark, but only if the color does not primarily serve a useful purpose and has acquired distinctiveness in connection with the relevant goods or services. The court held that pink did not serve a useful purpose for insulation products and that the color had acquired distinctiveness in connection with such products. Owens-Corning's use of pink for its products for nearly 30 years, along with its extensive advertising of pink in connection with such products, was sufficient to show that pink had acquired distinctiveness in connection with insulation products.

The Supreme Court Seals the Deal in Qualitex

Not everyone agreed. For roughly a decade following *Owens-Corning*, the courts of appeals split on whether a single color could function as a mark.

In 1994, the Ninth Circuit rejected *Owens-Corning* in *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994). Qualitex sued for infringement of the green-gold color mark it had used for its dry-cleaning pads for decades. Relying on *Owens-Corning*, the district court held that the plaintiff had established protectable trademark rights in the color that were infringed by the defendant's use of a confusingly similar color for the same goods. But the Ninth Circuit reversed, holding that "no person should have a monopoly on a primary color."

The following year, the U.S. Supreme Court finally resolved the conflict among the circuits by holding that a single color is capable of functioning as a mark. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995). It rejected the color depletion theory, which, it explained, lacked "practical force" because the doctrine of functionality would preclude registration of colors as marks when their registration would have anticompetitive consequences. The Court concluded that a color is registrable if it has acquired distinctiveness for the relevant goods or services and does not function as a necessary element of the product, or does not otherwise improve the product's appeal to consumers.

Registering a Color with the USPTO Post-Qualitex: What Every Applicant Should Know

Acquired Distinctiveness. In order to claim trademark rights in a color, you must demonstrate that the color has acquired distinctiveness as applied to the relevant goods or services. In other words, the trademark owner must show that the consumer, upon seeing the color used in connection with the goods or services, views the color not as merely ornamental but, rather, as a means of indicating the origin of those goods or services.

The showing required in this regard can be extensive. Generally, the USPTO looks for such things as declarations attesting to long, substantially exclusive use of the color as a mark, as well as surveys, third-party articles, customer testimonials and extensive advertising dollars.

In addition, claims of color as a mark *for services* require a further explanation of exactly how the applicant uses the color in connection with those services. For example, if you want to register the color yellow for, say, legal services, you must identify the objects on which you use yellow in connection with the offering of those legal services—for example, pens and stationery. But that's not all. You also must provide evidence of acquired distinctiveness for *each* claimed mode of use—that is, evidence that supports recognition of the color yellow as a mark for legal services when used on *each* of the objects you identify to the USPTO. This can prove difficult.

For example, UPS applied to register the color brown for delivery services. It claimed that it used brown as a mark by applying it consistently to a variety of items, including vehicles, uniforms, signage, pencils and pens, stationery and watches. The USPTO initially refused to register the mark on the ground that UPS had not established the requisite acquired distinctiveness.

In response, UPS submitted substantial evidence of acquired distinctiveness of the color brown, including hundreds of consumer testimonials. However, while UPS's new evidence supported recognition of brown as a mark when used on motor vehicles and uniforms, it did not support the recognition of the color when used on the other objects UPS identified in the application, for example, pencils and pens. To obtain registration of its color mark, UPS limited the mark's description to only motor vehicles and uniforms.

Nonfunctionality. The applicant also should be prepared to defend against a challenge by the USPTO that the color is functional. A color may be deemed functional if (a) it yields a utilitarian advantage, (b) it is more economical to manufacture or use or (c) it is aesthetically pleasing and helps to improve the salability of the good or service. For example, pink has been deemed functional as applied to an antacid, and black has been deemed functional as applied to marine outboard motors.

The USPTO's Other Requirements

Description of the Mark. The application must submit a "description of the mark" that includes the following: (1) a claim that the color is a feature of the mark, (2) the generic name of the claimed color and (3) a statement describing where the claimed color appears on the mark. For example, "The color(s) canary yellow is/are claimed as a feature of the mark. The mark consists of the color canary yellow as applied to vehicles used in delivering the goods. The representation of the vehicle shown in broken lines is not claimed as part of the mark."

Specimen. The specimen for a color mark should consist of a *color* photograph of the manner in which the color mark is used for the identified goods or services, or the context in which those goods or services are offered. For example, when Minnesota Mining and Manufacturing Company (3M) applied to register the color canary yellow for its adhesive-stationery notes, it submitted a color photograph of the canary yellow adhesive-stationery notes.

Drawing of the Mark. Color marks also require a drawing. The type of drawing that you should submit depends on whether you are applying to register the color as a mark for goods or services.

• **Goods.** A color may be registered for goods when it is used on the entire surface of the goods, a portion of the goods or all or part of the packaging of the goods. In order to apply to register a color for goods, the applicant must submit a drawing that depicts the object on which the color is used. The drawing must depict the object, because the commercial impression of color may change depending on the object to which it is applied. Further, the outline of the object depicted in the drawing should appear in broken lines. The drawing describes where, and how, the color is used on the product or package, and the broken lines indicate that the shape of the product, or the shape of the package, is not claimed as part of the mark.

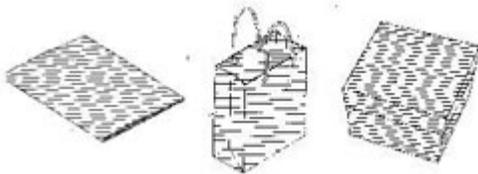


For example, in 2000, 3M used the drawing shown for its registration of the color canary yellow for its adhesive-stationery notes. The drawing demonstrates the placement of the color on the goods, as well as the broken lines to indicate that the shape of the product is not claimed.

If you are applying to register the mark for a number of goods, the drawing that you should submit depends on whether the applied-for goods are similar in form and function. If they are similar in form and function, you can submit a single drawing that depicts only one of the products on which you use the color. If the goods are not similar in form and function, you will have to apply to register the color for each good that is different from the others. For example, Tiffany & Co. registered the color “Robin’s-egg blue” separately for its boxes and shopping bags because, while their functions are similar, their forms are different.



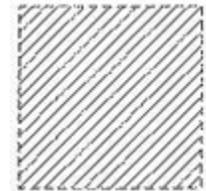
• **Services.** If you are applying to register color for services, then the drawing you should submit depends on how you use the color in connection with your services.



For example, if you use the color on a variety of objects in connection with your services, but in a “setting” that makes a single, commercial impression, such as a retail store or catalog, then you should submit a broken-line drawing of that setting. Tiffany registered the color “Robin’s-egg blue” for catalog services featuring jewelry, watches, clocks and baby gifts. Tiffany submitted a broken-line drawing of its catalog,

which depicts the “setting” in which it uses the “Robin’s-egg blue” color.

On the other hand, if you use color as a mark for services on a number of objects that consumers do not view simultaneously, such as on uniforms, pens and store awnings, then you must submit a drawing that depicts a solid-colored square with a dotted peripheral outline, together with a description of the drawing that specifies the objects on which the color is used. For example, UPS submitted the drawing shown to depict its brown mark for its delivery services as used on a variety of things including trucks and uniforms.



(Note: In past practice before the USPTO, when drawings could not be submitted in color, applicants were required to “line” black-and-white drawings to represent certain colors. The square above is “lined” for the color brown. Today, the applicant would simply submit a drawing of a square in the actual color being claimed in the application, with the outline of the square in broken lines to indicate that the shape of the square is not claimed as part of the mark.)

Color mark drawings control the scope of the mark’s protection. Moreover, once filed, the applicant cannot amend the drawing of the mark to show the color on a different object, because that would be a “material alteration” of the mark. Thus, particular care should be given to the type of drawing used. For example, the applicant in *In re Thrifty*, 61 U.S.P.Q.2d 1121 (Fed. Cir. 2001), applied to register the color blue for vehicle leasing services. It claimed use of the color blue on signage, canopies, vehicles and displays, but submitted a drawing that depicted the color only on a building. The application was refused because the description was broader than the applicant’s drawing of the mark, in that the drawing did not depict the other items claimed in the description. The applicant should have submitted a drawing of the color blue on a solid-colored square.

Colors Aren’t for Everybody

While color is an effective means to distinguish one brand from another, trademark owners should understand that color marks can be difficult and expensive to register in the USPTO. They require an extensive evidentiary showing of acquired distinctiveness, as well as compliance with many technical points. Nonetheless, where color is integral to the marketing of your product or service, color registrations—and the protection they afford—are well worth the effort.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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