After *Louboutin*: Responding to Trademark Ownership of Color in Creative Contexts

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Comment

After Louboutin: Responding to Trademark Ownership of Color in Creative Contexts

"I found I could say things with color and shapes that I couldn't say any other way . . . things I had no words for."

Georgia O'Keeffe

As an artist, it would be difficult to complete a work of art if you were limited to the use of certain colors, only those colors that no other artist had claimed. Imagine, for instance, that Monet, upon completion of his water lilies, is sued by Picasso for using a certain shade of blue. Picasso claims that the blue used by Monet is the same blue he uses to express melancholy. In fact, Picasso has used that blue throughout a number of his paintings, and it has become somewhat of a theme in his work. Should Picasso have ownership of that shade of blue?

Fashion designers, artists, filmmakers, and architects alike "share a dependence on color as an indispensable medium. Color is expressive; it serves to "depict the idea" of the creator. Color serves to translate what a creator seeks to communicate to others. Despite the importance of color in the creative process, courts have allowed single colors to serve as trademarks under certain circumstances. For instance, the United States Supreme Court and the United States Court of Appeals for the Federal Circuit have recognized trademarks for a green-gold color used

1. 2 NANCY H. REILY, GEORGIA O'KEEFFE, A PRIVATE FRIENDSHIP 379 (Sunstone Press 2009).
3. Id.
4. Id.
5. Id.
6. Id. at 452.
7. Id.

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by a manufacturer on dry cleaning press pads and a shade of pink used on insulation.⁸

But is trademark registration of color inappropriate in certain artistic contexts? Specifically, should single-color marks be eligible for trademark protection in the fashion industry, “one of the world’s most important creative industries”?⁹ The answer to this question is significant in the fashion industry where “visual impact is of the utmost importance.”¹⁰ While there should not be a per se rule against such trademarks, single-color marks in the fashion context are inherently suspect.¹¹ This Comment asserts that the trademark doctrine of aesthetic functionality may provide protection for the creative use of color in fashion. In certain circumstances, as Judge Posner stated simply, “[b]eauty is function,” and when functionality is present, no trademark protection is warranted.¹² This Comment also asserts that the trademark concept of secondary meaning may serve as a check to the broad availability of color mark registration. If courts take a hard-line approach on what is required to prove secondary meaning, only those owners who have truly cultivated their color marks, and successfully created an association between their marks and the source of their marks in the minds of the public, will succeed in obtaining trademark protection.

I. TRADEMARK PROTECTION OF COLOR MARKS

A trademark is any “word, name, symbol, or device, or any combination thereof used by a person, or which a person has a bona fide intention to use in commerce . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the

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⁹ Darrell G. Mottley, Navigating Fashion Law: Leading Lawyers on Exploring the Trends, Cases, and Strategies of Fashion Law: The Tools for Protecting Fashion Law Clients, ASPATORE (Jan. 2012), at *1. The importance of the industry is reflected in the fact that the women’s fashion industry is a multibillion-dollar business annually. Id.
¹¹ Kari Heyison, If It’s Not Ripped, Why Sew It? An Analysis of Why Enhanced Intellectual Property Protection for Fashion Design is in Poor Taste, 28 TOURO L. REV. 255, 266 (“The Supreme Court’s discussion in Qualitex is inadequate when applied to the fashion industry. Trademarking colors in the fashion industry would ‘significantly hinder competition’ in an industry where color is a fundamental and functional feature.”).
¹² W.T. Rogers Co. v. Keene & Keene Mfg., 778 F.2d 334, 343 (7th Cir. 1985).
source of the goods . . . .” Trademarks serve to protect consumers from deception and confusion, ensuring that consumers receive the products they intend to purchase. Trademarks also serve to protect an owner’s cultivation of, and investment in a source-identifying product. Trademarks are of particular importance in the fashion industry because the other intellectual property regimes, copyright and patent law, offer designers very limited protection.

Trademarks in the fashion industry commonly take the form of logos and insignia. Designers often incorporate these protected marks into their designs. Classic examples of such registered marks include Louis Vuitton’s Toile monogram, Burberry’s plaid, and Gucci’s green-red-green stripe. However, in 2008, a designer applied for and successfully registered a more unconventional mark—a color. Famed shoe designer Christian Louboutin registered a trademark that claimed exclusive use of the color red for the outsoles of the shoes he designs. Unsurprisingly, it only took a few years for this mark to become a hot source of litigation. While trademark law provided the District Court for the Southern District of New York with some guidance on the issue, the validity of single-color marks was an issue of first impression in the context of the fashion industry. For that reason, it is important to look at the history of single-color marks in general, prior to examining color trademarks in the fashion industry.

15. Id.
16. Danielle E. Gorman, Protecting Single Color Trademarks In Fashion After Louboutin, 30 CARDOZO ARTS & ENT. L.J. 369, 395-98 (2012). However, some argue that designers need a blend of copyright, trademark, and patent protection in order to adequately protect their creations. Mottley, supra note 9, at *8.
18. Id. at 1137.
19. Registration No. 1,653,663.
20. Registration No. 1,241,222.
21. Registration No. 1,122,780.
22. CHRISTIAN LOUBOUTIN’S RED OUTSOLES, Registration No. 3,361,597.
23. Id.
A. In General: "Color . . . Its Own Animal"

The issue of whether color is eligible for trademark protection was addressed as early as 1906. In A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., the United States Supreme Court made the following landmark statement on the issue: "Whether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this." Despite the fact that the Court's statement was made in dicta, it became controlling on the issue of color trademarks. The Court's statement sparked a sort of prohibition era in which the courts and the United States Patent and Trademark Office (USPTO) refused trademark protection for single-color marks.

However, in a few instances, courts used common law unfair competition principles to protect the use of color. For example, in Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co., the United States Court of Appeals for the Sixth Circuit held that while a defendant cab company had no exclusive right to the use of the color yellow, it was entitled to trademark protection for the color so long as it could establish secondary meaning. Still, cases like Yellow Cab were rare following the Court's powerful dicta in A. Leschen & Sons Rope Co., and protection for the use of color was sparse.

The icy treatment of single-color marks did not change much until the passage of the federal trademark statutory scheme, the Trademark Act of 1946 (hereinafter referred to as the "Lanham Act"). The passage of the Lanham Act resulted in a broad revision of trademark law.

The Lanham Act broadly defined trademark as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." In the past, registration

25. Colman, supra note 10, at *41.
27. 201 U.S. 166 (1906).
28. Id. at 171.
31. Id. at 1118-19.
32. 147 F.2d 407 (6th Cir. 1945).
33. Id. at 415.
35. Owens-Corning, 774 F.2d at 1119.
was limited to "technical" common law trademarks. On the contrary, the Lanham Act provided that registration should not be refused on account of the nature of the mark unless one of the specific exceptions, set forth in the statute, applied.

In light of the passage of the Lanham Act, courts began to depart from the dicta of A. Leschen & Sons Rope Co., and registration became available in many circumstances where it was previously excluded, including the registration of color trademarks. For instance, in In re Hehr Manufacturing, the United States Court of Customs and Patent Appeals held that a square red label could be registered as a trademark since the label distinguished and identified the owner's goods. Gradually, the prohibition on the use of color marks dissolved and courts started to look at the facts of each color mark case individually. During this period, the registration of color marks simply depended upon meeting the legal requirements for registration, and courts took into account the "nature of the goods, how the color [was] used, the number of colors or color combinations available, the number of competitors, and customary marketing practices."

The increase in the registration of color trademarks following the passage of the Lanham Act also resulted in an increase of litigation challenging such marks. As cases on color trademarks were handed down, a number of common arguments developed as justifications for denying trademark protection of color marks. These arguments are worth noting. Among these are the color depletion theory, the shade confusion theory, and the doctrine of aesthetic functionality. The color depletion theory is based on the argument that if you give a plaintiff exclusive rights to a single color, you are effectively giving that plaintiff a monopoly in that color. Consequently, if single-color marks are granted, eventually no color will be available for competitors to use. In a famous color depletion theory case, Campbell Soup Co. v.

37. Owens-Corning, 774 F.2d at 1119.
39. Owens-Corning, 774 F.2d at 1119-20.
40. 279 F.2d 526 (CCPA 1960).
41. Id. at 527-28.
42. Owens-Corning, 774 F.2d at 1120.
43. Id.
44. Gorman, supra note 16, at 376.
45. Id.
47. Campbell Soup Co., 175 F.2d at 797-98.
Armour & Co., the United States Court of Appeals for the Third Circuit denied plaintiff Campbell Soup Company's motion for an injunction to stop defendant Armour & Company from using red and white labels. In refusing the injunction, the court of appeals noted, "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."

Another argument against trademark protection for color marks is the shade confusion theory. The premise of the shade confusion theory is that differences in colors can be slight and difficult to discern. The concern at the heart of the shade confusion theory is that trademark infringement actions will "denigrate into questions of shade confusion."

A third justification for denying trademark protection of color marks is the doctrine of functionality. There are two forms of functionality that may serve as affirmative defenses in trademark infringement claims—utilitarian (or traditional) functionality and aesthetic functionality. Utilitarian functionality is present when a product feature is either "(1) essential to the use or purpose of the article, or . . . (2) affects the cost or quality of the article." If there is a finding of utilitarian functionality, a product is generally ineligible for trademark protection. Even without a finding of utilitarian functionality, a product feature may still be deemed functional if there is a finding of aesthetic functionality; that is, the aesthetic design of the product is "itself the mark for which protection is sought" and the registration of the product would put competitors at a disadvantage.

The above-mentioned arguments achieved some success in post-Lanham Act color trademark cases. However, one still could not predict when such defenses would be successful, as the law on color marks remained muddy even after the passage of the Lanham Act. The "uncertain ground" of single-color trademarks did not become more certain until 1985, when the United States Court of Appeals for the

48. 175 F.2d 795 (3d Cir. 1949).
49. Id. at 796, 799.
50. Id. at 798.
55. Id. at *8 (quoting Inwood Labs. v. Ives Labs., 456 U.S. 844, 851 n.10 (1982)).
56. Id.
57. Id.
Federal Circuit decided *In re Owens-Corning Fiberglas Corp.*[^58] In that case, the Federal Circuit was faced with the issue of whether Owens-Corning Fiberglas Corporation could register the color pink, as used on the insulation material it sold, as a trademark.[^59] The court held that Owens-Corning's pink could be registered as a trademark because the use of the color did not perform a non-trademark function and indicated Owens-Corning as the origin of the goods.[^60] The court observed that the law had developed in a way such that so long as a mark was "capable of being or becoming distinctive of [the] applicant's goods in commerce," it was capable of serving as a trademark.[^61]

The next landmark case addressing trademark protection for color, *Qualitex Co. v. Jacobson Products Co.*[^62] was decided just ten years later. The issue in *Qualitex*, per Justice Breyer, was whether the Lanham Act permitted the registration of a "trademark that consists, purely and simply, of a color."[^63] *Qualitex*, a manufacturer of dry cleaning press pads, obtained registration for the green-gold color it used on its press pads. Qualitex subsequently sued Jacobson, a competitor, for using the green-gold color claiming unfair competition and trademark infringement. The United States District Court for the Central District of California found in favor of Qualitex on both claims. However, the United States Court of Appeals for the Ninth Circuit reversed the district court's judgment on the trademark infringement claim determining the Lanham Act did not permit the registration of color, standing alone, as a trademark.[^64]

The Supreme Court reversed the decision of the court of appeals, rejecting the court of appeals holding that trademark protection is not available for color.[^65] The Supreme Court held that no special rule barring color from serving as a trademark existed.[^66] In the Court's opinion, Justice Breyer noted, "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 ..."[^67] In addressing the functionality defense, Justice Breyer stated, "color alone,

[^58]: Id. at *5; see also Owens-Corning, 774 F.2d 1116 (Fed. Cir. 1985).
[^59]: Owens-Corning, 774 F.2d at 1118.
[^60]: Id. at 1123.
[^61]: Id. at 1120.
[^63]: Id. at 160-61.
[^64]: Id. at 161.
[^65]: Id. at 162.
[^66]: Id. at 174.
[^67]: Id. at 163.
at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm’s goods and identifies their source, without serving any other significant function.  

In sum, the Court held that so long as a color had acquired secondary meaning, and served no non-trademark function, it would be eligible for trademark protection.

The Court’s holding in Qualitex finally brought resolve to the issue of whether a color was eligible for trademark protection. Unsurprisingly, after the Qualitex decision, a number of single-color trademarks were registered. Among the single-color trademarks registered, were the brown used by United Parcel Service (UPS), the canary yellow of Minnesota Mining and Manufacturing Co.’s (MMM) sticky notes, and the robin’s egg blue used by Tiffany and Company.

B. In the Fashion Industry

Prior to Christian Louboutin S.A. v. Yves Saint Laurent America, Inc., the validity of single-color trademarks in the context of the fashion industry had never been examined. Nevertheless, color was a key component of industry marks that were afforded trademark protection. Still, registration of color trademarks, in the fashion context, was limited to the use of color “in distinct patterns or combinations of shades that manifest a conscious effort to design a uniquely identifiable mark embedded in the goods.” Trademark protection did not extend to a single color. Rather, trademark protection was only afforded when an arrangement of colors worked together to create a “distinct recognizable image.”

An example of the treatment of a color mark in the fashion industry can be found in Louis Vuitton Malletier v. Dooney & Bourke, Inc. In

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68. Id. at 166.
69. Id.
71. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:44.50 (4th ed. 2012).
73. Id. at 451; Sreepada, supra note 17, at 1135.
74. Sreepada, supra note 17, at 1135.
76. Id.
77. 454 F.3d 108 (2d Cir. 2006).
Louis Vuitton, French design giant Louis Vuitton brought an action against American handbag designer and retailer Dooney & Bourke, alleging trademark infringement and dilution. The basis of Louis Vuitton's claim was that a bag marketed by Dooney & Bourke, the "It-Bag," infringed on Louis Vuitton's multicolored trademark, which consisted of the designer's traditional LV pattern, in thirty-three different colors, on a white or black background. The District Court for the Southern District of New York denied Louis Vuitton's motion for a preliminary injunction on the ground that there was no likelihood of confusion between the two bags at issue. Even still, the district court acknowledged that Louis Vuitton's mark was a distinctive mark that had obtained secondary meaning.

On appeal, the United States Court of Appeals for the Second Circuit determined that Louis Vuitton's multicolored mark was both original and inherently distinctive. The court noted that the LV pattern itself, the "Toile pattern," had served as an indicator of the French firm for over a century. Ultimately, the court of appeals agreed with the district court's finding that the multicolored mark had acquired secondary meaning. Consequently, Louis Vuitton's multicolored mark merited protection.

Another example of a dispute involving a color mark in the fashion industry can be found in Burberry Ltd. v. Euro Moda, Inc. In that case, Burberry, a high-end British fashion brand, sued multiple defendants for trademark infringement, along with a number of other claims. Burberry alleged the defendants were using Burberry's marks on various clothing items the defendants were selling. One of the trademarks involved in the dispute was Burberry's plaid check mark. The written description of the mark reads: "The designated colors are a feature of the mark and the colors and shades of colors are light tan, dark tan, light brown, dark brown, black, white, very dark red, dark red, medium red, light red, dark grey, medium grey and light grey." In resolving the case, the United States District Court for the Southern District of New York determined Burberry's colored plaid mark was a valid trademark and entitled to protection.
A more recent example of a dispute involving a color mark in the fashion context is *Gucci America, Inc. v. Guess?, Inc.* As is typically the case in such disputes, *Gucci* involved a trademark infringement claim between two fashion heavyweights. In this case, Gucci brought a claim against Guess for infringing upon several of Gucci's trademarks. One of the Gucci marks at issue was a stripe comprised of three colors. The written description of the trademark reads: "The mark is made up of a stripe containing three distinct bands of colors, the colors being green, red then green." The District Court for the Southern District of New York found Gucci's tri-color mark to be valid and "entitled to the strictest protection." The recognition of the validity of the trademark at issue in *Gucci America, Inc.*, as well as in *Burberry, Ltd.* and *Louis Vuitton Malletier*, signaled that courts were willing to allow fashion designers to protect marks with significant color components. The courts' recognition of the validity of such color-heavy marks paved the way for designers to take their intellectual property portfolios one step further and obtain protection for their single-color marks.

II. THE LOUBOUTIN CASE

The decision in *Christian Louboutin S.A. v. Yves Saint Laurent, America, Inc.* marked the first time the validity of single-color trademarks in the fashion industry was addressed. The parties in *Christian Louboutin* were both French fashion design heavyweights. Christian Louboutin, the person, along with the corporate entities that make up his fashion house, initiated the action against Yves Saint Laurent (YSL), a French "fashion institution." Christian Louboutin is a designer specializing in high fashion women's shoes. His shoes entered the fashion market in 1992. Somewhere around that time, Louboutin began using a glossy red lacquer on the outsoles of his shoes. Louboutin's shoes have since grown in popularity, even garnering success on an international level, with the help of celebrities and fashionistas alike.

In March 2007, Louboutin filed an application with the USPTO to obtain trademark protection for his stand-out red soles. In January 2008, the USPTO granted the trademark. The written description for

88. Id. at *1.
89. GUCCI'S GREEN-RED-GREEN STRIPE, Registration No. 1,122,780.
92. See Sreepada, supra note 17, at 1135.
94. Id.
Louboutin's trademark read: "The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red sole on footwear." The description of Louboutin's mark also included a diagram, showing the placement of the color on the shoe.

In January 2011, Louboutin learned that YSL was marketing and selling a monochrome red shoe (a red shoe with a red insole, red heel, red upper, and red outsole). Shortly thereafter, Louboutin contacted YSL and requested that YSL stop selling any shoes with red outsoles. The parties subsequently entered into negotiations in hopes to avoid litigation on the matter. Unfortunately, the negotiations were unsuccessful.

In April 2011, Louboutin filed an action against YSL in the United States District Court for the Southern District of New York. Louboutin asserted a number of claims under the Lanham Act (trademark infringement, counterfeiting, false designation of origin, unfair competition, and trademark dilution), as well as state law claims (trademark infringement, trademark dilution, unfair competition, and unlawful deceptive acts and practices). Additionally, Louboutin sought a preliminary injunction to prevent YSL from marketing shoes with red soles, similar to those described in Louboutin's trademark, during the litigation period.

In response, YSL asserted two counterclaims against Louboutin. In the first, YSL sought the cancellation of Louboutin's mark on the grounds that the mark was not distinctive, it was functional and ornamental, and it was secured by fraud. In the second, YSL sought damages for tortious interference with business relations and unfair competition. Following a short period of discovery, the parties argued the preliminary injunction motion.

In examining the case, the district court noted the novel issue at hand was "whether there is something unique about the fashion world that militates against extending trademark protection to a single color." The district court began its analysis with a recitation of the Supreme Court's holding in Qualitex—that a color can meet the legal requirements for trademark protection so long as it distinguishes the goods, identifies their source, and does not serve any other function. The court then addressed the affirmative defense of aesthetic functionality. The

95. Id.; CHRISTIAN LOUBOUTIN RED OUTSOLES, Registration No. 3,361,597.
97. Id. at *2-3.
98. Id. at *3.
99. Id.
100. Id. (quoting Christian Louboutin, 778 F. Supp. 2d at 451).
district court determined that in the context of the fashion industry, single-color trademarks are inherently functional.\textsuperscript{101}

The district court based its determination that single-color trademarks are inherently functional on the nature of the fashion industry itself.\textsuperscript{102} Specifically, the court stated that color is not used in fashion in the same way it is used in other industries, such as in the manufacture of wall insulation or dry cleaning press pads.\textsuperscript{103} This is because in the context of fashion trademarks, color does not serve solely to identify the source of the mark.\textsuperscript{104} Rather, color is used in fashion designs "primarily to advance expressive, ornamental and aesthetic purposes."\textsuperscript{105} The court noted that unlike other industries, the fashion industry is unique in that production is dictated by season, taste, aesthetics, and creativity.\textsuperscript{106}

Since the district court found that single-color marks are inherently functional in the context of the fashion industry, any such registered marks were invalid.\textsuperscript{107} In light of the invalidity of single-color marks used in the fashion industry, the district court determined Louboutin would not be able to prove that his mark was eligible for trademark protection.\textsuperscript{108} Since Louboutin was unable to show a likelihood of success on the merits, a prerequisite for the granting of a preliminary injunction, the district court denied Louboutin's motion for a preliminary injunction.\textsuperscript{109}

On appeal, Louboutin argued the district court erred in its application of the doctrine of aesthetic functionality, in failing to give weight to the statutory presumption of validity as the mark was registered, in conducting an improper analysis of trademark infringement and dilution, and in ignoring the proof of likelihood of confusion and irreparable harm that was offered.\textsuperscript{110} The United States Court of Appeals for the Second Circuit reviewed the decision of the district court under an abuse of discretion standard.\textsuperscript{111} The court of appeals examined the issue in two stages: First, the court looked at whether single-color marks were protectable in trademark and second, the court addressed the doctrine

\begin{itemize}
\item 101. \textit{Id.}
\item 103. \textit{Id.}
\item 104. \textit{Id.}
\item 105. \textit{Id.}
\item 106. \textit{Id.}
\item 108. \textit{Id.}
\item 109. \textit{Id.}
\item 110. \textit{Id.} at *4.
\item 111. \textit{Id.}
\end{itemize}
of aesthetic functionality. After making determinations in those two stages, the court turned to whether Louboutin's red sole trademark was valid.

In discussing the issue of whether single-color marks are eligible for trademark protection, the court of appeals determined that Qualitex had already provided the answer to this query by holding that trademark protection is available for color. Thus, the court began its analysis at the second stage—addressing the doctrine of functionality. In examining functionality, the court again relied on the Qualitex decision in stating the general rule of functionality in trademark law—aspects or features of a product that are functional cannot serve as a trademark. The court then turned to the application of the functionality doctrine in the fashion context. The court determined that there was no per se rule of functionality for color marks in the fashion industry. Furthermore, the court noted that the district court's per se rule was out of line with the Supreme Court's decision in Qualitex, which "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."

After concluding no per se rule of functionality controlled, the court turned to the trademark at issue. The court first decided whether the mark was distinctive, and second, whether the allegedly infringing use of the mark was likely to cause consumer confusion. In examining the validity of Louboutin's mark, the court of appeals noted that since Louboutin's mark was a registered mark, the district court was correct in its finding that Louboutin's mark was entitled to a statutory presumption of validity. However, the court of appeals determined the district court erred in finding that YSL rebutted the presumption of validity. Even still, the court of appeals conceded that Louboutin's mark, as it currently stood, was ineligible for protection.

112. Id.
113. Id.
114. Id. at *7; Qualitex, 514 U.S. at 162.
116. Id.
117. Id. at *10.
118. Id.
119. Id.
120. Id. at *11.
121. Id.
122. Id.
123. Id.
124. Id. at *12.
The court of appeals continued its examination of Louboutin's mark by turning to the issue of whether the mark was distinctive. The court stated that an owner can show a mark is distinctive either by showing that the mark, in and of itself, is inherently distinctive, or by proving that the mark has acquired secondary meaning. The court noted that a single-color mark can almost never be inherently distinctive; thus, there generally must be a showing of secondary meaning with single-color marks. Still, the court found no reason that a single-color mark could not acquire secondary meaning in the fashion industry "if it is used so consistently and prominently by a particular designer that it becomes a symbol."

In examining Louboutin’s mark specifically, the court of appeals held the mark was distinctive as a matter of law. The court determined that the mark was distinctive because the record, which contained evidence of Louboutin's advertising spending, media coverage, and vast financial success, demonstrated that Louboutin had effectively created a symbol that served as a source identifier of the Louboutin brand and had acquired secondary meaning. Still, the court placed an important limitation on its determination that the mark was distinctive. The court held there was secondary meaning only when the red sole of the shoe contrasted with the upper part of the shoe. Consequently, the court modified Louboutin's mark, pursuant to its powers to do so under 15 U.S.C. § 1119, limiting the registration to where the red lacquered sole contrasted with the remainder of the shoe (the "upper"). As modified, Louboutin's mark was valid and enforceable.

Since Louboutin's mark was valid and enforceable, the court of appeals did not address the likelihood of confusion or the affirmative defense of functionality. The court's holding disposed of the claims brought by Louboutin, as YSL's monochrome use of the red sole was not comparable to Louboutin's mark, as modified. Thus, the court of appeals affirmed the district court's denial of the preliminary injunction on the

125. Id.
126. Id.
127. Id.
128. Id.
129. Id. at *13.
130. Id.
131. Id. at *14.
134. Id.
135. Id. at *15.
136. Id. at *14.
grounds that Louboutin could not have shown a likelihood of success on the merits. The case was remanded for further proceedings with regard to YSL's counterclaims.

In October 2012, YSL filed a motion to dismiss the pending counterclaims. YSL stated that since the ruling was favorable to both parties, there was no need for further litigation. In a press release, YSL's attorney noted, "By dismissing the case now, Yves Saint Laurent also wishes to ensure that the court will not make any further rulings that put at risk the ability of fashion designers to trademark color in appropriate cases."

Despite the appearance that this matter was going to come to a somewhat amicable end, the months following YSL's motion to dismiss were filled with "volleys of letters" and conferences with the district court judge as the parties continued to spar, this time over the stipulations that would finally bring the matter to an end. Specifically, the parties could not agree on how broadly the opinion by the court of appeals swept. YSL argued that the court of appeals decision barred Louboutin from ever bringing a claim over a monochrome red shoe in the future. Louboutin, on the other hand, argued that the opinion of the court of appeals left open "a possible future claim based on new facts, new evidence and/or a new registration." On December 27, 2012, the district court finally entered an order dismissing the case. Nevertheless, both parties have indicated that this order would not preclude future litigation between them, including litigation dealing with precisely the same issues.

137. Id.
138. Id. at *15.
140. Id.
143. Id.
144. Id.
145. Id.
146. Id.
147. Id.
III. The Next Steps: Responding to the Registration of Color Marks

A. Protecting Competition and the Creative Process

While a per se rule against color trademarks—generally, or in the context of the fashion industry—is not merited, single-color marks in the fashion industry are inherently suspect. The eligibility of colors to serve as marks in such an artistic context threatens the existence of an open and competitive market. The registration of color marks in such a context also poses the danger that creativity in the market will decrease and subsequently lead to a decrease in the quality of the goods produced. There are two potential solutions or ways to counteract the problems posed by such free registration of single-color marks in an artistic context. First, the affirmative defense of aesthetic functionality can serve to defeat the validity of single-color marks. Additionally, the doctrine of secondary meaning can act as a check on the broad availability of such marks. The trademark limitations of aesthetic functionality and secondary meaning are in place to prevent broader monopolies on language and imagery than are necessary to achieve the policy objectives of trademark law. Still, designers would be ill-advised not to seek protection for their color marks in light of the court of appeals decision in Christian Louboutin; thus, a "how to" on registration of color marks is merited.

1. Aesthetic Functionality. As mentioned before, the doctrine of aesthetic functionality can serve as a justification for denying trademark protection of a single-color mark. In light of the fact that courts have largely rejected the color depletion and shade confusion theories, aesthetic functionality may be the strongest defense available that a party can use when attacking the validity of a single-color mark. An aesthetic functionality argument is undoubtedly strong. One commentator even referred to the functionality defense as the only true defense in

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148. This is also true generally, "Because trademark protection can exist in perpetuity, this is an area of law in which safeguards are particularly necessary to ensure that trademarks are used to promote—and not to hinder—competition in the marketplace." Colman, supra note 10, at *39.

149. Id. at *25.

150. Id. at *41. The Supreme Court has even asserted that the doctrine of aesthetic functionality covers the color depletion theory. Qualitex v. Jacobson Prods. Co., 514 U.S. at 159, 169 (1995).
trademark law.\textsuperscript{151} Despite the doctrine's controversial nature, the district court's embrace of aesthetic functionality in \textit{Christian Louboutin} signaled that it remains alive. Using cases where the doctrine has effectively defeated trademark protection as a guide, the doctrine has the strength to act as a check on the broad availability of registration for color marks and the negative consequences that may flow from this availability.

The United States Supreme Court expressly recognized the defense of aesthetic functionality in \textit{TrafFix Devices, Inc. v. Marketing Displays, Inc.}\textsuperscript{152} In its discussion of the defense, the Court stated that the test for determining whether a product feature is aesthetically functional should be whether exclusive use of that product feature would result in a "significant non-reputation-related disadvantage" for those excluded from using the feature.\textsuperscript{153} Simply put, in examining whether a product feature is aesthetically functional, a court must determine whether there is a competitive necessity for the feature.\textsuperscript{154}

Arguably, in light of the Supreme Court's opinion in \textit{TrafFix Devices, Inc.}, in order for there to be a finding of aesthetic functionality, the characteristics of the product feature at issue must "go to the heart of the consumer demand for that product."\textsuperscript{155} The doctrine of aesthetic functionality serves to prevent manufacturers and creators from obtaining a monopoly, via trademark, over a feature that all competitors need to use—a feature that is particularly attractive to buyers.\textsuperscript{156} If a product feature is necessary to compete, and exclusive use of that feature would create a "significant non-reputation-related disadvantage," it will be deemed aesthetically functional and, consequently, ineligible for trademark protection.\textsuperscript{157}

Despite aesthetic functionality's power as a trademark defense, and the Supreme Court's acknowledgement of the doctrine, aesthetic functionality has failed to live up to its potential. Notwithstanding the fact that the doctrine has been around for almost a century, courts have only declared a few product features aesthetically functional.\textsuperscript{158} One of the biggest reasons the doctrine has failed to live up to its potential

\begin{footnotes}
\footnotetext[151]{Mark P. McKenna, \textit{(Dys)}Functionality, 48 Hous. L. Rev. 823, 823-24 (2011).}
\footnotetext[152]{532 U.S. 23, 32 (2001).}
\footnotetext[153]{\textit{Id.} at 33 (quoting Qualitex, 514 U.S. at 165).}
\footnotetext[154]{\textit{Id.}}
\footnotetext[155]{Nancy C. Morgan, \textit{Aesthetic Appeal: The Blending of Aesthetics and Usefulness in Design Can Result in Challenges to the Theoretical Foundation of Trademark Law}, 34 Los Angeles Lawyer (Feb. 2012), at 35.}
\footnotetext[156]{\textit{Id.}}
\footnotetext[157]{\textit{Id.} at 36.}
\footnotetext[158]{McKenna, supra note 151, at 824.}
\end{footnotes}
as an affirmative defense is that courts have applied it so inconsistently.\textsuperscript{159} There are splits among the circuits and scholars alike over what test is to be used for aesthetic functionality. Consequently, the few cases that actually grapple with an aesthetic functionality defense are scattered.\textsuperscript{160}

The doctrine has also failed to live up to its potential because it has only been used sparingly and some circuits are more willing to apply it than others.\textsuperscript{161} Some courts refuse to recognize the doctrine at all, and some courts that \textit{do} recognize the doctrine refuse to ever find it applicable.\textsuperscript{162} The United States Court of Appeals for the Ninth Circuit has used the doctrine more than other circuits.\textsuperscript{163} The Ninth Circuit first adopted the doctrine in 1952 in \textit{Pagliero v. Wallace China}.\textsuperscript{164} In \textit{Pagliero}, the Ninth Circuit denied trademark protection to a china plate pattern because the pattern was the “main selling point of the plate.”\textsuperscript{165} Joining the ranks of the Ninth Circuit, the United States Court of Appeals for the Tenth Circuit has also acknowledged the doctrine of aesthetic functionality.\textsuperscript{166} Still, the doctrine has received great criticism by other courts.\textsuperscript{167} The United States Courts of Appeal for the Third, Fourth, and Fifth Circuits have rejected the concept of aesthetic functionality outright.\textsuperscript{168} The United States Court of Appeals for the Federal Circuit has questioned whether the doctrine, standing alone, can serve to challenge the validity of a trademark.\textsuperscript{169} Of particular note, the Eleventh Circuit has rejected the use of the doctrine as a defense.\textsuperscript{170}

Still, in spite of the doctrine’s lack of universal acceptance, the United States District Court for the Southern District of New York’s reliance on the doctrine in \textit{Christian Louboutin} confirmed that aesthetic functionality still has some vitality.\textsuperscript{171} In addition to the district court's opinion in \textit{Christian Louboutin}, there are other cases in which the doctrine has

\begin{thebibliography}{99}
\bibitem{159} Id.
\bibitem{160} Id.
\bibitem{161} Id.
\bibitem{162} Id.
\bibitem{163} Morgan, supra note 155, at 35.
\bibitem{164} 198 F.2d 339 (9th Cir. 1952); Morgan, supra note 155, at 35.
\bibitem{165} Morgan, supra note 155, at 35.
\bibitem{166} Theodore C. Max, \textit{Coloring Outside the Lines in the Name of Aesthetic Functionality: Qualitex, Louboutin, and How the Second Circuit Saved Color Marks for Fashion}, 102 TRADEMARK REP. 1081, 1093 (2012).
\bibitem{167} Id. at 1092-93.
\bibitem{168} Id. at 1093.
\bibitem{169} Id.
\bibitem{170} Id.
\bibitem{171} Id. at 1092.
\end{thebibliography}
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successfully been applied that resulted in the denial of trademark protection of the product features at issue. As an affirmative defense, aesthetic functionality is likely the strongest defense available to oppose trademark protection for a single-color mark. Accordingly, even though it can be challenging to present an aesthetic functionality defense, practitioners should still consider doing so. Thus, it is worthwhile to examine some of the seminal cases in which the doctrine has successfully been raised as an affirmative defense.

The doctrine of aesthetic functionality was applied in a case argued before the United States Court of Appeals for the Federal Circuit, Brunswick Corp. v. British Seagull Ltd.\(^{172}\) In that case, Mercury, a division of Brunswick Corporation, sought protection for the black color it consistently used on the outboard ship engines it manufactured. Mercury had spent a number of years and countless dollars on advertising its outboard engines. Of note, many of Mercury's advertisements referred to the "all black" color of its engines. In Mercury's application to register the black as a trademark, Mercury conceded that the color black was not inherently distinctive. Nevertheless, Mercury argued its black still merited trademark protection because it had acquired secondary meaning—the black color served as a source indicator of Mercury's outboard engines. British Seagull Limited, another manufacturer of outboard motors, along with several other entities, opposed Mercury's application. After considering Mercury's application and British Seagull Limited's opposition, the United States Patent and Trademark Office's Trademark Trial and Appeal Board (Board) refused to register Mercury's mark. Mercury appealed the Board's decision.\(^{173}\)

On appeal, the Federal Circuit affirmed the Board's refusal of registration.\(^{174}\) In its opinion, the court of appeals examined whether the black used on Mercury's outboard engines was functional.\(^{175}\) The court conceded that there was no functionality in the utilitarian sense—the color did not make the engines function any better or affect any of the mechanical purposes of the engines.\(^{176}\) Nevertheless, the court held the use of the color black on the engines was functional in the aesthetic sense of the term.\(^{177}\) Specifically, the color black was aesthetically functional because it was compatible with a variety of boat

\(^{172}\) 35 F.3d 1527, 1531 (Fed. Cir. 1994).
\(^{173}\) Id. at 1529-30.
\(^{174}\) Id. at 1534.
\(^{175}\) Id. at 1531.
\(^{176}\) Id.
\(^{177}\) Id.
colors, and the color had the ability to make objects appear smaller.\textsuperscript{178} Since the black used by Mercury provided these non-trademark-related advantages, outboard engine manufacturers needed to use the color in order to effectively compete in the market.\textsuperscript{179} Thus, under these circumstances, Mercury's black color was functional.\textsuperscript{180} Since the color was functional, the court affirmed the Board's refusal of Mercury's application for registration.\textsuperscript{181}

The doctrine of aesthetic functionality also found success in \textit{Deere \& Co. v. Farmhand, Inc.}\textsuperscript{182} In that case, John Deere \& Company (Deere), a famous producer of farm machinery and equipment, sought to prevent Farmhand, Incorporated (Farmhand), a producer of front-end tractor loaders, from using the green color Deere used on all of its machinery and equipment. In its complaint, Deere alleged that the green used on all of its products served as a source identifier and that the green was commonly referred to as "John Deere green" by those in the industry. Farmhand counterclaimed seeking declaratory and monetary relief. Specifically, Farmhand argued that Deere's claims were baseless and Deere was simply seeking to monopolize the market for front-end tractor loaders. Farmhand also argued that affording trademark protection to John Deere green would violate antitrust law.\textsuperscript{183} Additionally, Farmhand asserted that the green color Deere used on its products was aesthetically functional.\textsuperscript{184} Farmhand argued John Deere green was aesthetically functional because farmers preferred to match the color of their front-end loaders to the color of their tractors.\textsuperscript{185}

In its decision of the case, the Central Division of the United States District Court for the Southern District of Iowa addressed whether the green used by Deere was aesthetically functional.\textsuperscript{186} In terms of aesthetic functionality, the court bought Farmhand's argument that farmers preferred to match their front-end loaders with their tractors.\textsuperscript{187} Consequently, the court determined that the color green, as used on these products, was aesthetically functional.\textsuperscript{188} In its opinion, the court also recognized that Farmhand would not be able to effectively

\begin{itemize}
\item \textsuperscript{178} Id.
\item \textsuperscript{179} Id. at 1531-32.
\item \textsuperscript{180} Id. at 1533.
\item \textsuperscript{181} Id.
\item \textsuperscript{182} 560 F. Supp. 85 (1982).
\item \textsuperscript{183} Id. at 88.
\item \textsuperscript{184} Id. at 96.
\item \textsuperscript{185} Id.
\item \textsuperscript{186} Id.
\item \textsuperscript{187} Id. at 98.
\item \textsuperscript{188} Id.
\end{itemize}
compete in the market if it were prohibited from using the green color at issue. Consequently, the court issued a declaration that the color “John Deere green” was functional and denied Deere trademark protection.

In a more recent case, Dippin’ Dots, Inc. v. Frosty Bites Distribution, LLC, Dippin’ Dots brought suit against Frosty Bites Distribution (Frosty Bites), alleging Frosty Bites infringed upon Dippin’ Dots’ trade dress—the Dippin’ Dots product design and logo design. Dippin’ Dots sold a colorful flash-frozen ice cream product that consisted of small beads of ice cream. Frosty Bites also sold a flash-frozen ice cream product. Frosty Bites’ product consisted of mostly small popcorn-shaped ice cream bites with some spherical shapes. After the initial pleadings were filed, Frosty Bites moved for summary judgment on all of Dippin’ Dots’ claims. The United States District Court for the Northern District of Georgia granted Frosty Bites’ motion for summary judgment. Among the reasons the district court cited for granting the motion was the fact that Dippin’ Dots’ ice cream product was functional. Dippin’ Dots appealed.

In examining the functionality of Dippin’ Dots’ ice cream product on appeal, the United States Court of Appeals for the Eleventh Circuit looked at all of the features of Dippin’ Dots’ ice cream product, including the ice cream’s size, color, and shape. The court of appeals concluded that the color of Dippin’ Dots’ ice cream product was functional. The court held the color of the product was functional because “it indicate[d] the flavor of the ice cream, for example, pink signifie[d] strawberry, white signifie[d] vanilla, brown signifie[d] chocolate, etc.” Thus, the court held that the colors used on the ice cream beads were functional and essential to the purpose of the product. Since the colors used on the product were functional, the court of appeals affirmed the district court’s grant of summary judgment in favor of Frosty Bites.

Brunswick Corp., Deere & Co., and Dippin’ Dots, Inc. are just a few examples of cases in which parties successfully argued that a product feature was aesthetically functional and, thus, not eligible for trademark

189. Id.
190. Id. at 101.
191. 369 F.3d 1197 (11th Cir. 2004).
192. Id. at 1200-01.
193. Id. at 1203.
194. Id.
195. Id. at 1203-04.
196. Id. at 1206.
197. Id. at 1209.
protection. It is important to note that the product features at issue in those cases were not determined to be functional because they made the product work more efficiently. On the contrary, the product features in those cases were deemed functional because there was a need for those features "dictated by market expectations." Explained in a simpler manner, if consumers expect their products to be a certain way, for instance, that strawberry ice cream be pink, then that product feature—the pink color of the ice cream—serves a nonTrademark-related function and is thus considered to be functional. An amicus brief filed with the United States Court of Appeals for the Second Circuit by law professors in support of YSL in Christian Louboutin provides some additional clarification on this matter:

There are instances when consumers have preferences that cannot be reduced to scientific quantification of performance ("utility"), but are real marketplace constraints nonetheless. The harm to competitors from monopolization of those features justifies barring their appropriation, especially given the many nonfunctional words, logos, and other features that remain available for use as marks. In these instances, and where the product feature in question does not meet design patent's novelty requirement, the aesthetic functionality doctrine serves to maintain robust competition, and to prevent mark owners from using trademark as a kind of back door to perpetual patent-like protection for attractive but non-novel product features. Aesthetic functionality doctrine thus plays a vital role in ensuring that trademark law does not invade the jurisdiction of patent.

It is also important to note that the product features at issue in Brunswick Corp., Deere & Co., and Dippin' Dots, Inc. were found to be aesthetically functional regardless of the fact that consumers might have associated the product features at issue with their respective sources. For instance, it did not matter that those in the industry identified the green John Deere sought to protect as "John Deere green." If a product feature is functional, it is not protectable in trademark regardless of any secondary meaning the product may have acquired. Under the Lanham Act, the defense of aesthetic functionality is

198. McKenna, supra note 151, at 853.
199. Id.
200. Id. at 853-54.
202. McKenna, supra note 151, at 854.
"independent of arguments about source significance" and "available even against marks that have achieved incontestable status." 203

So what did the Christian Louboutin case add to the doctrine of aesthetic functionality? As an initial matter, the district court's opinion in Christian Louboutin relied heavily on aesthetic functionality, and the court's application of this doctrine resulted in the denial of trademark protection for Louboutin’s red soles. The district court in Christian Louboutin did not lack merit in applying the doctrine of aesthetic functionality in that case. As noted in the law professors' amicus brief:

In fashion design, when the aim is to create color compatibility or a red monochromatic effect, there is no alternative but to use red. The question is not whether other designers can compete with Louboutin by offering attractive blue shoes to consumers who want red shoes. The question is whether Louboutin’s competitors can make red shoes for consumers who want red shoes because of their aesthetic appeal. 204

The law professors’ acknowledgment of a competitive need to use the color red in fashion designs provides support for the district court's application of the doctrine of aesthetic functionality. Again, the test for aesthetic functionality, articulated by the Supreme Court in TrafFix Devices, Inc., is whether exclusive use of the product feature would result in a "significant non-reputation-related disadvantage" for those excluded from using the feature. 205 The competitive need for the product feature at issue in Christian Louboutin—the color red used on the outsoles of shoes—is indicated in Louboutin’s own explanation of why he chose to use the color red on his shoe designs in the first place. Louboutin said he chose the color because it was "engaging" and it gave his shoes "energy." 206 Louboutin also noted the color is "sexy" and "attracts men to the women who wear [his] shoes." 207 In addition to the reasons provided by Louboutin himself, Louboutin's red soles could be considered aesthetically functional because other designers, including YSL, want to use the color red on the soles of the shoes they design to create a monochromatic effect. 208 Furthermore, red soles can serve other coordinating functions; for instance, a designer could use a red sole because it coordinates with the other items of apparel in his or her collection (as was the case with YSL's red-soled shoes that coordinated

203. Brief of Amicus Curiae, supra note 201, at *8.
204. Id. at *14.
205. 532 U.S. at 33 (quoting Qualitex, 514 U.S. at 165).
207. Id. at 453.
208. Brief of Amicus Curiae, supra note 201, at *26.
with the designer's Chinese and Spanish themed collections).\footnote{209} In light of the various purposes and advantages of using the color red on the soles of shoes, it is not surprising that the district court inquired into the potential functionality of Louboutin's red soles. It is also unsurprising that the district court found that, in this context, the color red served "[t]o attract, to reference, to stand out, to blend in, to beautify, [and] endow with sex appeal," and that all of those purposes were non-trademark functions of color in fashion.\footnote{210}

The district court's reliance on the aesthetic functionality doctrine signals that this defense is not only alive, but also particularly powerful. In light of the fact that the doctrine is so controversial, and its use is so scattered, the district court's acknowledgement of the doctrine alone may be the most significant takeaway for practitioners and businesses with trademarks. The importance of the district court's recognition of the doctrine remains in spite of the fact that the Second Circuit did not buy into the doctrine's application in this case. Specifically, the court of appeals did not deny the doctrine's validity as a defense; rather, it simply did not reach the application of the doctrine in that factual setting at all. If more infringement cases (and courts) address aesthetic functionality, courts that are not fond of the doctrine may reconsider its availability as a defense. Still, regardless of whether the doctrine undergoes a true revival, aesthetic functionality will likely operate as a powerful check to the threats posed by the free registration of color marks.

2. Secondary Meaning. In addition to the doctrine of aesthetic functionality, the doctrine of secondary meaning also serves as a check on the potentially problematic registration of color trademarks in an artistic context, such as the fashion industry. As mentioned at length above, the doctrine of aesthetic functionality is not recognized by all courts. Consequently, there are circumstances where it will not be available as a defense. In such circumstances, the doctrine of secondary meaning may serve as a good alternative to ensure that single-color marks have met the standard for distinctiveness—a requirement in exchange for a perpetual monopoly. Courts have a substantial amount of discretion in evaluating secondary meaning evidence.\footnote{211} There are no general guidelines or uniform tests for courts to follow or apply.\footnote{212}

\footnote{209} Id.\footnote{210} Christian Louboutin, 778 F. Supp. 2d at 454.\footnote{211} Schloss, supra note 70, at 713.\footnote{212} Id. at 696, 700. "Although Qualitex clearly delineates what secondary meaning is, the opinion says virtually nothing about how to go about proving it." Id. at 699.
Thus, there is room for courts to develop stringent standards for proof of secondary meaning in order to weed out overreaching trademarks that threaten a competitive market.

So what is secondary meaning? "Secondary meaning has been defined as the association of a product with a single source in the minds of the public, although it is not necessary that the public know who or what the source really is." The phrase may be a misnomer, however, "because secondary meaning really means that in the consumer's mind, this is the primary meaning." Justice Frankfurter potentially provided the most succinct explanation of what secondary meaning is:

The protection of [trademarks] is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.

Secondary meaning comes into play during an analysis of the distinctiveness (or lack thereof) of a mark. In order for a trademark to be worthy of protection, the mark must be distinctive. An owner can show a mark is distinctive either by showing that the mark, in and of itself, is inherently distinctive, or by proving that the mark has acquired secondary meaning. Therefore, secondary meaning is required when the product feature for which protection is sought is not inherently distinctive. As noted by the court of appeals in Christian Louboutin, a single-color mark can almost never be inherently distinctive.

214. Id.
217. Id. Acquired distinctiveness may also be proven during the registration stage of the process. Nevertheless, the issue of distinctiveness typically comes up during enforcement proceedings. Colman, supra note 10, at *32.
218. Christian Louboutin, 2012 WL 3832285, at *12. Perhaps this is an understatement as the Supreme Court has stated, "we held that a color could be protected as a trademark, but only upon a showing of secondary meaning." Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212 (2000). The Court noted that consumers are not predisposed to equate color with the source; rather, they understand that the color serves to render the product "more useful or more appealing." Id. at 213.
Consequently, single-color trademarks will almost always require a showing of secondary meaning.219

In the event that a showing of secondary meaning is required, the proof of same can take several forms.220 Evidence of secondary meaning can either be direct or indirect.221 Direct evidence includes testimony at trial, affidavits, surveys and statistical data, and unsolicited consumer response and testimonials.222 Indirect evidence of secondary meaning includes advertising and promotion, sales and amount of receipts, unsolicited media coverage, use of the mark by third parties, and the length and exclusivity of use of the mark.223 Alternatively, the test for determining secondary meaning is sometimes enunciated as a factors test with the factors including: "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use."224 The weight that courts give to each factor differs from court to court.225

In Christian Louboutin, the court of appeals determined that Louboutin's red soles had acquired secondary meaning.226 The court noted that the record included extensive evidence of Louboutin's advertising expenditures, media coverage, as well as a number of consumer surveys submitted by both parties.227 The court went on to conclude that Louboutin's efforts and investment in the mark were undoubtedly successful.228 The district court avowed Louboutin's success was "to the point where, in the high-stakes commercial markets and social circles in which these things matter a great deal, the red outsole became closely associated with Louboutin."229

Again, courts have a large amount of discretion in determining the sufficiency and persuasiveness of the secondary meaning evidence proffered.230 If courts follow the lead of Christian Louboutin—requir-
ing extensive evidence of secondary meaning—the doctrine can serve as a check on the registration of color marks. Put another way, strict evidentiary requirements for a showing of secondary meaning will result in a limitation of the widespread availability of registration. Under such evidentiary requirements, only those owners that have “paid their dues” by successfully cultivating their marks will receive trademark protection. Such a limitation is much needed in artistic contexts such as the fashion industry.

B. If You Can’t Beat ‘Em, Join ‘Em: Registration of Color, a “How To”

Although federal registration of a trademark is “optional,” it is recommended that businesses register any marks connected with their brand, including, of course, any color marks, and that they do so as quickly as possible. Federal registration provides constructive notice of the registrant’s trademark rights throughout the country. Furthermore, federal registration gives rise to a legal presumption that the registrant owns the mark as well as the exclusive right to use the mark.

There are certain requirements an applicant must meet in order to register a color mark. First, the applicant must show that the mark is distinctive. The United States Patent and Trademark Office will deny registration of a color mark on the Principal Register unless the applicant proves that the mark has acquired distinctiveness. According to the USPTO, “the burden of proof on the applicant to prove acquired distinctiveness is ‘substantial.’” Nevertheless, even if the color mark is not distinctive, it may still be eligible for registration on the Supplemental Register.

231. Colman, supra note 10, at *28. While there are “common-law trademark rights,” “nationwide rights can be achieved only through a formal registration process.” Id.
232. Id. at *29.
233. Id. Additionally, “[o]ne benefit of registration particularly useful to the fashion industry is the ability to record the registration with US Customs and Border Protection, in order to prevent the importation of infringing goods. Put differently, the federal government will not stop infringing goods at the border unless the allegedly infringed trademark has been registered with the USPTO and recorded with Customs.” Id. (citation omitted).
235. Id. at 793-94.
236. Id. at 793.
In order to register a color mark, an applicant must also register his mark at the right time—when the mark is ripe for registration. An applicant should wait to register a color mark until after he has actually used the color mark in commerce. An intent-to-use application is not successful in the context of color marks because one cannot "prove acquired distinctiveness for a mark that has not yet been used." Thus, an applicant seeking to register a color needs to file a use-based application after they have used the color for a length of time. Importantly, during that period of use, the applicant will have had time to cultivate his mark, for instance, by expenditures on advertising. Through advertising and other cultivation measures, the applicant builds a case for the mark's distinctiveness.

When registering a color, an applicant must also specify the color being registered and the specific location of same. The applicant must "name the color that is a feature of the mark and should describe the mark and where the color appears on the mark." One way applicants can do this is by indicating the color's PANTONE color number. The PANTONE color system is a system that can be used for identifying specific shades of colors. It is worth noting, however, if an applicant uses the PANTONE color system in his application, he must also still indicate the general name of the color. This is as simple as Louboutin identifying the color used on his outsoles as "red." As of 2003, applications for color marks must actually be filed in color. The USPTO has discontinued the use of the color lining system—a system that used different lines to indicate where the color was located on the product (as seen in the diagram accompanying Louboutin's mark).

When registering a color, an applicant must submit a drawing. This drawing is usually "a representation of the product or packaging on which the color is to be placed." Generally, the USPTO offers registration of a trademark in three different formats: "(1) standard

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237. Id. at 794.
238. Id.
239. Id.
240. Id.
241. Id.
242. Id.
243. Id.
244. Id.
245. Id.
246. Id.
247. Id.
248. Id.
character format; (2) stylized/design format; or (3) sound mark."\textsuperscript{249} The stylized/design format is the proper format for registering a color. Per the USPTO\textquotesingle s website, the stylized/design format \textquoteleft is appropriate if you wish to register a mark with a design element and/or word(s) and/or letter(s) having a particular stylized appearance that you wish to protect.\textsuperscript{250}

In reviewing the different formats, it is important to note the fact that the USPTO website also provides that \textquoteleft[F]ormats 1 and 2 may not be mixed in one mark; i.e., do not submit a representation of a mark that attempts to combine a standard character format and a stylized/design format.\textsuperscript{251} Thus, a color that is incorporated into a design will require a separate registration in order to obtain trademark protection for the color itself (for instance, if Louis Vuitton wanted protection for one of the colors used in its multicolored Toile monogram pattern, it would have to submit a separate application for that color mark). In sum, to register a color, one simply needs to actually use the color they wish to register in commerce, fill out an application with the USPTO using the stylized/design format, pay the applicable registration fees, ensure the mark is distinctive, and specify the color, as well as the location of the color on the mark by way of a drawing.

IV. CONCLUSION

In conclusion, the trademark registration and protection of color is beneficial to producers that invest in creating a source-identifying feature on their products. Such investment in a source-identifier should be rewarded and protected. Still, the protection of color remains particularly troubling in artistic contexts, such as the fashion industry. Specifically, because fashion is an art form, and designers should have all of the colors of the rainbow at their disposal. The use of color in fashion is never truly arbitrary, as it should be in order to secure trademark protection.

Still, the command of \textit{Qualitex} and the court of appeals decision in \textit{Christian Louboutin} signaled there will be no per se rule barring the trademark protection of color in certain industries, such as the fashion industry. Consequently, the only limitations to the ownership of color will be typical trademark requirements, such as distinctiveness (secondary meaning), and defenses, such as aesthetic functionality. The

\textsuperscript{250} \textit{Id.}
\textsuperscript{251} \textit{Id.}
protection of color in the fashion context is unlikely to be limited any further in light of the fact that the *Christian Louboutin* case has reached finality (for now).

In spite of my opposition to trademark protection of color in certain artistic contexts, such as in factual scenarios similar to the *Christian Louboutin* case, designers would be ill-advised not to seek trademark protection for colors they have used that may have acquired secondary meaning.\(^{252}\) The *Christian Louboutin* decision should guide the direction of designs and branding.\(^{253}\) Still, those in opposition to the protection of color in certain artistic contexts should encourage the growth of the doctrine of aesthetic functionality, or encourage Congress to limit such trademark protection in order to encourage creativity and protect the competitive market. Additionally, those opposed should encourage high evidentiary standards for proof of secondary meaning. Nevertheless, those in opposition to the free registration of color marks in artistic contests may rest peacefully knowing that in the minds of YSL and Louboutin, this dispute is not over, signaling the potential for more litigation on this issue and offering hope that the Supreme Court will revisit this issue once again.

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\(^{252}\) See supra subsection III(B).

\(^{253}\) Colman, supra note 10, at *42.