Qualitex Co. v. Jacobson Products Co.: Orange You Sorry the Supreme Court Protected Color?

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Trademarks are vital to fair competition in the marketplace. Their existence protects owners from unfair practices of competitors and facilitates informed consumer choice between otherwise indistinguishable goods. In 1946, Congress recognized the need for uniform federal trademark law and enacted the Lanham Trademark Act ("Lanham Act") to guard against unfair competition in the marketplace. The Supreme Court's recent interpretation of the Lanham Act in *Qualitex Co. v. Jacobson Products Co.*, however, may result in unfair competition.

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2. 15 U.S.C. § 1127 (1994) (defining trademark as "any word, name, symbol, or device" used to identify and distinguish goods from those sold by others); see, e.g., *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985) (noting that trademarks "protect the ability of consumers to distinguish among competing producers"); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918) (opining that trademarks create distinguishing marks on products); *Owens-Corning*, 774 F.2d at 1123 (finding that trademarks indicate origin of goods to consumers).


4. See S. Rep. No. 1333, 79th Cong., 2d Sess. 4 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 ("To protect trademarks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not."); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (noting that Lanham Act was intended to protect persons engaged in commerce against unfair competition); *Park 'N Fly*, 469 U.S. at 198 (indicating that Lanham Act secures protection of trademark owners' good will in business).

since permitting manufacturers to trademark color alone will preclude others from using the protected color on competing products.6

In Qualitex, the Supreme Court addressed whether the Lanham Act permits the registration of a trademark consisting, "purely and simply," of a color.7 The petitioner, Qualitex Co., used a particular shade of green-gold on its dry cleaning press pads since 1957.8 In 1989, Jacobson Products, a Qualitex competitor, began manufacturing and distributing an inferior quality press pad9 in a very similar green-gold color.10 In 1991, Qualitex registered the green-gold color of its press pads as a trademark.11

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6 Id. at 1308 (stating that "color may sometimes meet the basic legal requirements for use as a trademark ... ").
7 Id. at 1302.
8 Qualitex Co. v. Jacobson Prods. Co., 13 F.3d 1297, 1300 (9th Cir. 1994), rev'd, 115 S. Ct. 1300 (1995); see Susan Upton Douglass, Color Me Happy: The Supreme Court Rules on the Trademark Registrability of Color, 7 No. 5 J. PROPRIETARY RTS. 2 (1995) (stating that Qualitex manufactured green-gold pads since 1957); Paul R. Morico, Protecting Color Per Se in the Wake of Qualitex v. Jacobson, 77 J. PAT. & TRADEMARK OFF. SOC'Y 571, 572 (1995) ("Since 1957, [Qualitex] has manufactured and sold press pads by the name of "SUN GLOW" for use on dry cleaning presses."). Press pads are a kind of "industrial-strength ironing board cover." Jon Van, Manufacturer's Bright Outcome; High Court Says Color Counts as Trademark, CHI. TRIB., Mar. 29, 1995, at 1. Inspired by his observation of the setting sun filtering through leaves, the owner of Qualitex Co., Harry Campagna, reproduced the unusual blend of gold and green color in his press pads almost 30 years ago. Mary Ellen Podmolik, Court Says Firm Can Trademark Its Color, CHI. SUN TIMES, Mar. 29, 1995, at 53.
9 Qualitex, 115 S. Ct. at 1302. For the manufacture of its own "Magic Glow" press pad, Jacobson originally purchased 700 yards of Qualitex green-gold "seconds" material which was fabricated by Amerbelle Corporation, the finisher utilized by Qualitex. Qualitex, 21 U.S.P.Q.2d at 1459. After exhausting the initial supply, Jacobson was "unable to purchase additional Qualitex material ... based upon Amerbelle's claim that the green-gold color ... was exclusive to Qualitex." Id. Jacobson then contacted "Unitex," a textile mill, requesting that the company duplicate both the material and the color of a sample Qualitex swatch. Id. Unitex used an outside lab to test the composition of the swatch in order to duplicate the Qualitex green-gold color to Jacobson's satisfaction. Id. On this basis, the district court concluded "Jacobson intentionally copied the overall look of Qualitex' green-gold press pads." Id.
10 Qualitex, 115 S. Ct. at 1302 (citing Registration No. 1,633,711 (Feb. 5, 1991)). Henry Campagna, owner of Qualitex, recognized the need to protect the special green-gold color selected for the company's press pads, Van, supra note 8, at 1, because many dry cleaning establishments are owned and operated by foreign-
Qualitex then added a trademark infringement claim to a previously filed lawsuit against Jacobson alleging unfair competition. At the district court level, Qualitex prevailed. The Court of Appeals for the Ninth Circuit reversed the district court's finding of trademark infringement, holding that the Lanham Act does not permit the registration of color alone. The Court of speaking people who have a limited command of the English language. Qualitex, 21 U.S.P.Q.2d at 1458; Van, supra note 8, at 1 (noting that dry cleaning is road of entry for immigrants and English is typically second language). Under such circumstances, a simple English word may fail to convey brand name and quality whereas a distinctive color is effective. See Van, supra note 8, at 1 (noting that knowledge of English language is unnecessary to recognize color). Not surprisingly, "[s]ome purchasers of press pads have come to identify and order Qualitex pads over the telephone by merely describing the [green-gold] color." Qualitex, 21 U.S.P.Q.2d at 1458.

Qualitex brought the trademark infringement claim under § 1114(1) of the Lanham Trademark Act which provides in pertinent part:

(1) Any person who shall, without the consent of the registrant —
(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive shall be liable in a civil action by the registrant for the remedies hereinafter provided.


Qualitex, 21 U.S.P.Q.2d at 1462 (finding Qualitex entitled to injunction against Jacobson's infringement of green-gold registered trademark pursuant to 15 U.S.C. § 1116 (1994)). The district court decided in favor of Qualitex on its claims of both trademark infringement and unfair competition. Id. at 1462.

Qualitex, 13 F.3d at 1302 (reversing judgment for Qualitex on claim of trademark infringement). The court concluded that the color depletion theory prohibits the registration of color alone. Id. Specifically, the color depletion theory postulates that there is a limited supply of usable colors. See Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir. 1949) (articulating color depletion theory and denying Campbell's request for exclusive use of red because if allowed to "monopolize red in all of its shades the next manufacturer may monopolize orange ... [o]bviously, the list of colors will soon run out."); cert. denied, 338 U.S. 847 (1949); Morico, supra note 8, at 575 (noting that color depletion theory is premised upon fact that there are only limited number of colors to designate products in given market); see also Qualitex, 115 S. Ct. at 1305-06 (stating customer appeal may further limit viable colors available); First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987) (providing protection to yellow "Prestone" container "would deplete a primary color available to competitors and deprive them of a competitive need."). Trademark protection for colors, therefore, will ultimately deplete the colors avail-
Appeals, however, affirmed the district court's judgment for damages and injunctive relief based upon unfair competition, finding that Jacobson Products was liable for infringement of Qualitex's trade dress. Granting certiorari only on the issue of color, the Supreme Court reversed the judgment of the Ninth Circuit and unanimously held that "there is no rule absolutely barring the use of a color alone" as a trademark.

In Qualitex, the Court upheld the district court's conclusion that the green-gold color utilized on the Qualitex dry cleaning press pads satisfied the requirements for a trademark. In broadly interpreting the Lanham Act definition of a trademark able to a manufacturer attempting to enter a market.

In addition to adopting the color depletion theory, the Ninth Circuit expressed concern over the unnecessary difficulties courts would face if required to distinguish between similar shades of color. Qualitex, 13 F.3d at 1302; see, e.g., NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 1027 (7th Cir. 1990) (questioning range of color protected by trademark status), cert. denied, 499 U.S. 983 (1991). The court also opined that "[a]dequate protection is available when color is combined in distinctive patterns or designs or combined in distinctive logos." Qualitex, 13 F.3d at 1302. Finally, the court concluded that further protection is available under the Lanham Act's provisions for unfair competition. Id.

Qualitex, 13 F.3d at 1305. Qualitex alleged unfair competition under § 43(a) of the Lanham Act, which holds anyone who uses in commerce any goods which are likely to cause confusion as to the origin of such goods liable in a civil action. See id. at 1300-03. See generally 15 U.S.C. § 1125(a) (1994) (imposing civil liability for use of false or misleading representation of fact likely to cause confusion).

Qualitex, 13 F.3d at 1305. Consideration of "[t]rade dress infringement ... requires that all of the [product] features be considered together, not separately." American Greetings Corp. v. Dan-Dee Importers, Inc., 807 F.2d 1136, 1141 (3d Cir. 1986) (quoting SK & F Co. v. Premo Pharmaceutical Labs., 461 F. Supp. 1184, 1187 (D.N.J. 1979), aff'd, 625 F.2d 1055 (3d Cir. 1980)). Trade dress determines whether a product has acquired secondary meaning whereby the public is likely to confuse an imitation with the original. See Qualitex, 21 U.S.P.Q.2d at 1461 (quoting First Brands, 809 F.2d at 1383); American Greetings, 807 F.2d at 1140-41; see also 15 U.S.C. § 1125 (1994).

Id. at 1304 (finding color alone may meet requirements for trademark protection under some circumstances). For a mark to qualify for trademark protection, a person must use or intend to use the mark "to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods ...." 15 U.S.C. § 1127 (1994). In addition, the mark must either be inherently distinctive, see 15 U.S.C. § 1052(a)-(f) (1994), or have attained secondary meaning. See Echo Travel Inc. v. Travel Assocs., Inc., 870 F.2d 1264, 1268 (7th Cir. 1989) ("establishing that a mark has acquired secondary meaning is precisely what removes the mark from the public domain ...."). See generally 2 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 15:1.A, at 657 (2d ed. 1984). Professor McCarthy notes that secondary meaning is the "mental association in buyers' minds between the alleged mark and a single source of the product." Id. § 15:2.A, at 659.
as "any word, name, symbol, or device," the Court found that color alone was not precluded from serving as a trademark. The Court applied a two-part test to determine when color alone may qualify for trademark protection. This test first considers whether the color has a "secondary meaning" and secondly determines if the color is "functional." In concluding that the "secondary meaning" prong was met, the Court determined that some customers associated the unusual green-gold color with Qualitex press pads. The second prong, or "functionality" doc-

20 Qualitex, 115 S. Ct. at 1302. The Court stated that "[t]he language of the Lan-
ham Act describes [t]he universe [of things that can qualify as trademarks] in the
broadest of terms." Id. See generally 15 U.S.C. § 1127 (1994) (defining words used in
trademark statutes).
21 Qualitex, 115 S. Ct. at 1302-05; see Mana Prod., Inc. v. Columbia Cosmetics Mfg., Inc., 65 F.3d 1063 (2d Cir. 1995) (applying secondary meaning/functionality
test articulated in Qualitex to hold color that black used in makeup compacts did
not pass test). See generally Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d
1210, 1215-18 (8th Cir. 1976) (providing considerations for hindering competition).
If the particular feature is an important ingredient in the commercial suc-
cess of the product, the interest in free competition permits its imitation in
the absence of a patent or copyright. On the other hand, where the feature
or, more aptly, design, is a mere arbitrary embellishment, a form of dress
for the goods primarily adopted for purposes of identification and indi-
viduality and, hence, unrelated to basic consumer demands in connection
with the product, imitation may be forbidden where the requisite showing
of secondary meaning is made. Under such circumstances since effective
competition may be undertaken without imitation, the law grants protec-
tion. Id. at 1217-18 (citations omitted).
22 "Secondary meaning" is not defined by statute. The Supreme Court has ex-
plained that secondary meaning may be defined as the process through which cus-
tomers, over time, "come to treat a particular color on a product or its packaging ...
as signifying a brand." Qualitex, 115 S. Ct. at 1303.
23 "Functionality" is controlled by a product's useful features and whether protec-
tion of those features would inhibit legitimate competition. Qualitex, 115 S. Ct. at
1304. A handle on a cup, for example, serves the functional purpose of providing a
secure hold and is therefore precluded from trademark protection. Id. The Supreme
Court noted that innovation is given limited protection by patents, whereas trade-
marks are not intended to provide a perpetual monopoly. Id. If a product feature "is
essential to the use or purpose of the article or if it affects the cost or quality of the
article" and would place competitors at a significant disadvantage, the feature is
functional and cannot be trademarked. Id. (quoting Inwood Labs., Inc. v. Ives Labs.
Inc., 456 U.S. 844, 850 n.10 (1982)).
24 Qualitex, 115 S. Ct. at 1304-05. The Court found that a product's color could
come to identify the source of the product just as a descriptive name could. Id. at
1303. Qualitex proved secondary meaning to the district court's satisfaction by es-
blishing a number of facts. Qualitex, 21 U.S.P.Q.2d at 1458. These facts included
the exclusive use of the green-gold color in Qualitex's advertising, flyers and display
trine, prevents the trademarking and thereby monopolization of a useful product feature. The Court determined that a product’s color may be trademarked if it is not essential to the product’s purpose or does not affect its price or quality. The Court accepted the district court’s findings and concluded that the green-gold color of Qualitex pads was not functional. Finally, the Court rejected Jacobson’s four arguments for a special legal rule preventing manufacturers from appropriating a particular color for their products. Jacobson argued that providing trademark protection to color alone would create problems of shade confusion, restrict competition through color depletion, upset existing booths at trade shows; the expenditure of approximately $1,621,000 for advertising and promotion of the green-gold color; and the results of a survey in which 39% of respondents identified the Jacobson look-alike pad as a Qualitex product. It is important to note, however, that the Supreme Court did not assume that color could function as a trademark without secondary meaning. Therefore, the significant issue of whether a color may be inherently distinctive and not require a showing of secondary meaning prior to trademark registration remains open. If functional features could be trademarked, an inventor could perpetually prevent competitors from using the feature in their own products, and thereby hinder effective competition. See Morton-Norwich, 671 F.2d at 1339-40 (holding that precluding competitors from imitating functional designs or features would deny them opportunity to compete effectively). In applying this doctrine to color, courts have found colors to be functional in various circumstances. See Brunswick, 35 F.3d at 1532-34 (affirming Patent Office’s finding that registration of black color mark on outboard engines would hinder competition because color black complements variety of boat colors and makes engines appear smaller); Deere & Co. v. Farmhand, Inc., 560 F. Supp. 85, 98 (S.D. Iowa 1982) (finding that color green functional when used on farm machinery because studies showed farmers prefer their equipment to match); aff’d, 721 F.2d 253 (8th Cir. 1983). See also NutraSweet, 917 F.2d at 1028 (allowing tabletop sweeteners to appropriate particular colors for their products would deter newcomers from entering market); Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3rd Cir. 1949) (holding that permitting soup company to monopolize color red may cause list of available colors to run out). But see Master
ing precedent, and be unnecessary since trade dress provides protection for color alone. None of these arguments, however, persuaded the Court.

It is submitted that the Qualitex Court erred in extending Lanham Act protection to the green-gold color of Qualitex press pads because providing trademark protection to color alone will bar new entrants to some markets. The potential inability to distinguish between various shades of color will require industry newcomers to avoid a wide range of hues similar to currently trademarked colors. Removal of wide bands of colors from

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Distribrs., Inc. v. Pako Corp., 986 F.2d 219, 224 (8th Cir. 1993) (declining to establish per se prohibition against protecting color alone as trademark because it would create confusion and inconsistency); Owens-Corning, 774 F.2d at 1128 (allowing trademark registration of color pink for fiberglass insulation).

Qualitex, 115 S. Ct. at 1307. The Court rejected existing precedent relied on by Jacobson because much of the case law predated the enactment of the Lanham Act in 1946. Id.; see Coca-Cola Co. v. Koke Co. of America, 254 U.S. 143, 147 (1920) (“coloring matter is free to all who make it”); A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166, 171 (1906) (questioning validity of color as protectable trademark). Since the Act embodied crucial changes which liberalized trademark law to permit at times the protection of color, the Court held that these decisions were no longer relevant. Qualitex, 115 S. Ct. at 1307. Moreover, Congress amended the Lanham Act in 1988 but left the words “word, name, symbol, or device” undisturbed, after those terms had already been interpreted to include color in some jurisdictions. Id.

Qualitex, 115 S. Ct. at 1308 (1995). The Court disagreed with this argument and held that trademark law afforded protection in a manner that trade dress protection could not. Id. For example, under trademark law, the holder of a mark can prevent the importation of confusingly similar goods, 15 U.S.C. § 1124 (1994), and has prima facie evidence of validity and ownership. 15 U.S.C. § 1057(b) (1994).

Qualitex, 115 S. Ct. at 1308. See, e.g., NutraSweet, 917 F.2d at 1028 (barring tabletop sweetener manufacturer from registering color of product packaging since it would deter new entrants); Spraying Sys. Co. v. Delavan, Inc., 762 F. Supp. 772, 780 (N.D. Ill. 1991) (noting that grant of permission to register colors to all present competitors would deter new entrants), aff’d, 975 F.2d 387 (7th Cir. 1992); see also Mitek Corp. v. Pyramid Sound Corp., No. 91 C20152, 1991 WL 292621, at *4 (N.D. Ill. July 9, 1991) (“The essential purpose of trademark law is to prevent confusion, not to bar new entrants into the market.”).

See infra notes 40-62 and accompanying text (discussing confusion specific to distinguishing color); see also Campbell Soup, 175 F.2d at 798 (asserting that manufacturers will monopolize colors in all of their shades until available colors would be depleted if trademark of color is allowed); Master Distribrs., Inc. v. Pako Corp., 777 F. Supp. 744, 745 (D. Minn. 1991) (noting both customers and distributors often order plaintiff's splicing tape by asking for 'the blue tape' or simply for 'blue'), rev’d, 986 F.2d 219 (8th Cir. 1993). But see Michael B. Landau, Trademark Protection for Color Per Se After Qualitex Co. v. Jacobson Products Co.: Another Grey Area in the Law, 2 U.C.L.A. Ent. L. Rev. 1, 21 (1995) (asserting that shade confusion doctrine was judicially created and not grounded in empirical studies).
those available for commercial use may deplete the supply of colors available and thereby make it difficult for market newcomers to compete effectively.\textsuperscript{35} It is further submitted that the Supreme Court failed to consider adequately the unique problems presented by color when it held that trademark protection extends to color alone. This interpretation of the Lanham Act will increase litigation as manufacturers and courts attempt to delineate which shades are still lawfully available to competitors. Absent a reasonable and easily comprehensible standard for the breadth of color protection, the \textit{Qualitex} decision will ultimately result in the virtual closing of some markets to new entrants.

This Comment suggests that both shade confusion problems and the color depletion theory provide persuasive arguments against extending trademark protection to color. Further, this Comment asserts that the implementation of the functionality doctrine effectively bars the use of trademarks consisting of color alone in most markets. Finally, even if in some rare instances the Lanham Act does protect color alone, it is submitted that the Court erred in its application of trademark law to the particular

\textsuperscript{35} \textit{See infra} notes 64-85 and accompanying text (explaining limitations of available colors in many markets). Manufacturers in certain industries already face severe practical limitations on the range of potential colors that can be used on their products. \textit{See, e.g.}, Laureysens v. Idea Group, Inc., 768 F. Supp. 1036, 1047 (S.D.N.Y. 1991) (recognizing that certain color combinations are particularly appealing in children's product market and only certain dyes may be used to produce these colors under government toxicity standards), aff'd in part, rev'd in part, injunction vacated, 964 F.2d 131 (1992); Elizabeth A. Overcamp, \textit{The Qualitex Monster: The Color Trademark Disaster}, 2 J. INTELL. PROF. L. 595, n.187 (1995) (quoting Ronald Alsop, \textit{Color Grows More Important in Catching Consumers' Eyes}, \textit{WALL ST. J.}, Nov. 29, 1984, at D1 (asserting it is "unwise to sell whole milk in anything but a red carton" and because McDonald's customers believe restaurants only sell fast food if their sign contains red and yellow)). In addition to limitations created by consumer stereotyping, manufacturers choose the color of their products to increase sales and product desirability. \textit{See Randall Lane, Does Orange Mean Cheap? (Effect of Color on Sales of Commercial Products)}, \textit{FORBES}, Dec. 23, 1991, at 144 (noting that Igloo Products Corp's 15% increase in sales of coolers since turquoise and raspberry products added to line); Anastasia Toufexis, \textit{The Bluing of America}, \textit{TIME}, July 18, 1983, at 62 (discussing manufacturers' use of color psychology to manipulate consumer tastes including use of white backgrounds accompanied by splashes of primary colors on detergent boxes to symbolize cleanliness, coloring appliances in subdued or bright hues depending upon gender of target audience, and use of white backgrounds on diet products and low-tar cigarettes to convey feeling of purity); \textit{Warm Glow of Colgate Explained}, \textit{L.A. TIMES}, Sept. 22, 1995, at D3 (stating color psychologists believe close link exists between product's color and consumer buying preferences). Some psychologists specifically linking popularity of Marlboro, Colgate, Coca-Cola, and Campbell's soup to their red colored packages. \textit{Id.}
I. SHOULD THE LAW EXTEND TRADEMARK PROTECTION TO COLOR ALONE?

The Lanham Act gives a seller or manufacturer of a product the exclusive right to register and use a trademark. The Act aims to prevent unfair competition, to protect sellers' reputations, and to preserve consumer expectations of quality. Although the language of the Act places few restrictions on what may be registered, courts have imposed limits on what is elig-

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27 See Two Pesos, 505 U.S. at 768 (noting that Lanham Act was enacted to prevent deceptive use of marks and protect persons engaged in commerce against unfair competition); Inwood Labs., 456 U.S. at 854 n.14 (stating Lanham Act aims to protect owner's goodwill in marketplace and consumers' ability to distinguish among goods of competing manufacturers).

The Lanham Act was necessitated by the lack of existing federal regulation of trademarks which, prior to 1946, was governed solely by state and federal common law. S. REP. No. 1333, 79th Cong., 2d Sess. 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1276-77. The abolition of federal common law by the Supreme Court enabled individual states to change their common law with respect to trademarks and allowed trademark rights in one state to differ from the rights enjoyed in another. Id. Additionally, the increasing number of commercial international conventions entered into by the United States required implementation of legislation designed to fully secure the rights of foreign nationals to trademark protection in the United States. Id. at 1276. The Senate Committee on Patents succinctly summarized the inequities that this legislation purported to remedy:

The purpose of this bill is to place all matters relating to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective.

Id. at 1274.

28 Qualitex, 115 S. Ct. at 1302. The language of the Lanham Act describes the “universe of things” which may qualify as a trademark in the “broadest of terms,” id., including “any word, name, symbol, or device, or any combination thereof.” 15 U.S.C. § 1127 (1994). “Since human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.” Qualitex, 115 U.S. at 1302-03; see Newman, supra note 36, at 1598
ible for protection. In light of the problems associated with shade confusion and the risk of color depletion, it appears that trademark protection should not have been extended to color alone.

A. Shade Confusion

A law that allows the trademarking of color alone will produce uncertainty among competitors and the judiciary, resulting in unnecessary litigation over which shades of color are lawfully available for use. In failing to recognize the unique challenges of shade perception, the Supreme Court determined that the

(stating that "[Lanham Act] does not expressly require that trademarks be verbal or even visual"). Courts have used this sweeping language to extend trademark protection to decorative aspects of cheerleaders' uniforms, Dallas Cowboy Cheerleaders, Inc., v. Pussycat Cinema, Ltd., 604 F.2d 200, 204-06 (2d Cir. 1979), as well as to scented yarns and threads, In re Clark, 17 U.S.P.Q.2d (BNA) 1238, 1239 (Trademark Trial & Appeal Bd. 1990). See also In re General Elec. Broadcasting Co., 199 U.S.P.Q. (BNA) 560, 563 (Trademark Trial & Appeal Bd. 1978) (recognizing sound may serve as trademark despite denying registration of bell sound at issue).

The two primary requirements for what may be trademarked are distinctiveness and nonfunctionality. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (describing system of classification to determine distinctiveness of trademark); Deere, 560 F. Supp. at 89 (denying trademark protection to functional color green). See generally 1 MCCARTHY, supra note 18, at § 7:26-28 (discussing policy reasons supporting requirement of nonfunctionality as prerequisite to trademark and providing examples of features held functional and nonfunctional). Courts often base the amount of protection given to a registered trademark on its distinctiveness. See Abercrombie & Fitch, 537 F.2d at 9. The classes of terms relating to distinctiveness are: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. Id Fanciful marks (words expressly coined to function as trademarks), arbitrary marks (common words or symbols that are arbitrarily applied to the goods or services in question in a non-descriptive or suggestive manner), and suggestive marks (words and symbols not directly descriptive but which need no secondary meaning for protection) are all classified as inherently distinctive marks. 1 MCCARTHY, supra note 18, §§ 11:1-2, at 433-36. The use of an inherently distinctive mark creates a presumption that the mark becomes synonymous with the source of the goods, obviating the necessity of establishing consumer recognition to secure legal protection. Id. at 435; see also Coach Leatherware Co., Inc. v. Ann Taylor, Inc., 933 F.2d 162, 170 (2d Cir. 1991) (holding that "inherently distinctive shape and composition of Coach hang tag" eliminated necessity of proving consumer recognition).

In Qualitex, the Court only considered whether the green-gold color qualified as a descriptive mark. Qualitex, 115 S. Ct. at 1303-04. A descriptive mark may gain trademark protection only upon a finding of "secondary meaning," that is, if purchasers have come to associate the mark with a particular source or manufacturer and to distinguish between goods possessing the mark and those that do not. Abercrombie & Fitch, 537 F.2d at 10; 1 MCCARTHY, supra note 18, at 454.

See supra note 28 and accompanying text (discussing shade confusion). 41 Qualitex, 115 S. Ct. at 1305 ("We do not believe, however, that color ... is spe-
same legal standards that guide courts in distinguishing between similar sounding words and phrases would also be used in comparing colors.\textsuperscript{42} In addition, the Court neglected to provide lower courts with sufficient guidelines with which to determine

\textsuperscript{42} Qualitex, 115 S. Ct. at 1305. \textit{But see supra} notes 41-58 and accompanying text (discussing how perception of color differs from that of words). The standard legal test for comparing words is whether the two marks and their respective products are so similar “as to be likely to cause confusion among reasonably careful purchasers.” Upjohn Co. v. Schwartz, 246 F.2d 254, 262 (2d Cir. 1957); \textit{see} Albert Dickinson Co. v. Mellos Peanut Co., 179 F.2d 265, 269-70 (7th Cir. 1950) (finding that trial court should determine likelihood of consumer confusion based upon testimony of ordinary product purchasers and evidence of manner in which both products sold and not on basis of side by side visual comparison of similar product names). There is, however, no requirement of a showing of actual confusion. Kimberly-Clark Corp. v. H. Douglas Enters., 774 F.2d 1144, 1147 (Fed. Cir. 1985); \textit{see} MGM-Pathe Communications Co. v. Pink Panther Patrol, 774 F. Supp. 869, 876 (S.D.N.Y. 1991) (“[If the law required proof of actual confusion before likelihood could be found, trademark owners would be required to incur actual irreparable harm before they could obtain protection for their marks.”). Purchasers of relatively inexpensive and frequently replaceable products are “held to a lesser standard of purchasing care.” \textit{Kimberly-Clark Corp.}, 774 F.2d at 1146 (quoting \textit{In re Martin's Famous Pastry Shoppe, Inc.}, 748 F.2d 1565, 1567 (Fed. Cir. 1984)). A strong, non-descriptive mark is given the highest degree of protection especially when exploited on a national basis. G. D. Searle & Co. v. Institutional Drug Distribs., 151 F. Supp. 715, 717 (S.D. Cal. 1957); cf: Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1569 (Fed. Cir. 1983) (noting that one factor reviewed in determining likelihood of confusion is “fame of the prior mark, as measured by volume of sales, advertising, and length of use”). \textit{See generally} Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir.) (providing non-inclusive list of factors to determine likelihood of confusion when products are different, including: “strength of [the] mark”; “degree of similarity between the two marks”; “proximity of the products”; “likelihood that the prior owner will bridge the gap”; “actual confusion”; “reciprocal of defendant's good faith in adopting its own mark”; “quality of defendant's products”; and “sophistication of the buyers”), \textit{cert. denied}, 368 U.S. 820 (1961); \textit{In re E.I. DuPont DeNemours & Co.}, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing factors that must be considered when evaluating likelihood of confusion to include “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression”; “similarity or dissimilarity and nature of the goods or services”; “similarity or dissimilarity of established, likely-to-continue trade channels”; “conditions under which and buyers to whom sales are made”; “fame of the prior mark (sales, advertising, length of use)”; “nature and extent of any actual confusion”; and “extent of potential confusion”).

In evaluating alleged trademark infringement, it has been noted that “[s]light differences in the sound of similar trademarks will not protect the infringer.” G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387 (7th Cir.) (citing Lambert Pharmacal Co. v. Bolton Chem. Corp., 219 F. 325, 326 (2d Cir. 1915), \textit{cert. denied}, 361 U.S. 819 (1959)); \textit{see, e.g.}, \textit{Kimberly-Clark Corp.}, 774 F.2d at 1146-47 (finding word “DOUGIES” infringed upon “HUGGIES” trademark when both products were disposable diapers sold to identical class of consumers in same type of retail outlets).
the range of shades protected under a color trademark.\footnote{See Qualitex, 115 S. Ct. at 1305 (stating that application of current legal standards should be sufficient for color comparisons). The Court suggested that lower courts replicate the “lighting conditions under which a colored product is normally sold” in comparing similar colors. \textit{Id}. The fact that purchasers ordered the press pads by telephone, however, demonstrates the unfeasibility of the Court’s suggestion. Qualitex Co. v. Jacobson Prods., 21 U.S.P.Q.2d (BNA) 1457, 1458 (C.D. Cal. 1991), aff’d in part, rev’d in part, 13 F.3d 1297 (9th Cir. 1994), rev’d, 115 S. Ct. 1300 (1995). An equally impracticable situation for determining “normal lighting conditions” is identifiable in the case of traveling salepersons, who display their wares in a wide variety of lighting situations. See Amsted Indus. Inc. v. West Coast Wire Rope & Rigging Inc., 2 U.S.P.Q.2d (BNA) 1755, 1758-60 (Trademark Trial & Appeal Bd. 1987) (declining to compare photographic specimen of applicant’s product with prior trademark owner’s and noting that, even if Board so desired, poor quality of photographic evidence rendered determination of actual shade impossible). \textit{But see} Youngstown Sheet & Tube Co. v. Armco Steel Corp., 170 U.S.P.Q. (BNA) 162, 163 n.2 (Trademark Trial & Appeal Bd. 1971) (recognizing that Board possessed sample of registrant’s color-coded pipe, sample, and photographs of applicant’s similarly-colored fence posts); \textit{In re} Hodes-Lange Corp., 167 U.S.P.Q. (BNA) 255, 256 (Trademark Trial & Appeal Bd. 1970) (comparing ampules manufactured by applicant with ones manufactured by trademark registrant to determine likelihood of consumer confusion).}

Courts are accustomed to dealing with words.\footnote{See Kimberly-Clark, 774 F.2d at 1146 (“HUGGIES and DOUGIES sound much alike and actually rhyme, especially if ... the latter is pronounced as if derived from the name ‘Doug.’”).} Two words, in simple visual appearance, are either identical or they are not. “HUGGIES,” for example, is simply not the same word as “DOUGIES,” despite the similarity in sound.\footnote{\textit{GEORGE A. AGOSTON, COLOR THEORY AND ITS APPLICATION IN ART AND DESIGN} 7 (Dr. Jay M. Enoch et al., eds., 1979) (explaining that color is sensation produced in brain in response to light received by eye’s retina); \textit{ANNI BERGER-SCHUNN, PRACTICAL COLOR MEASUREMENT} 1-2 (Joseph W. Goodman ed. & Max Saltzman trans., 1994) (“It is certain that the eye has receptors for light, which transform the light falling on it into stimuli, which are sent by nerves to the brain, where the color perception originates.”). The process of color perception is complicated. \textit{DEANE B. JUDD & GUNTER WYSZECKI, COLOR IN BUSINESS, SCIENCE, AND INDUSTRY} 27 (Stanley S. Ballard ed., 3d ed. 1975). While the visible radiation is capable of objective measurement, however, the imprint on the mind is entirely subjective. See \textit{JUDD & WYSZECKI, supra}, at 28; \textit{Color Measurement: Colorimeters and Spectrophotometers}, \textit{INSTRUMENT BUS. OUTLOOK}, Nov. 1, 1992, at *1 available in Westlaw, 1992 WL 2215823 [hereinafter \textit{Colorimeters and Spectrophotometers}] (noting that factors such as age, fatigue, and mood affect each individual’s subjective color perception); \textit{Color Measurement Technology Extends Application Spectrum}, \textit{INSTRUMENT BUS. OUTLOOK}, Dec. 31, 1994, at *1 available in Westlaw, 1994 WL 2644631 [hereinafter \textit{Color Measurement Technology}] (asserting that color percep-}
ing upon the environment in which it is viewed.\footnote{47}

The first variable in color perception is light.\footnote{48} A color may appear to alter several shades depending on whether it is viewed in natural, florescent, dim or bright lighting.\footnote{49} Secondly, a color's

tion can differ from person to person and consistency of individual's perception is subject to both external and internal forces, such as mood swings). All color control in industry is focused on the subjective color perception of the customer. \cite{JUDD & WYSZECKI, supra, at 28; Tim Triplett, More to Color Testing Than Meets the Eye, INDUS. PAINT & POWDER, Feb. 1, 1995, at 20, \textsuperscript{*4} available in Westlaw, 1995 WL 8465120 (stating that industries use “standard observer” based upon study of retinal responses to varying color to determine consumer’s perception of product color).}

\footnote{47} In order to perceive color precisely, it must be viewed under prescribed conditions, that is, under only one light source and for one observer. \cite{AGOSTON, supra note 46, at 9; see also BERGER-SCHUNN, supra note 46, at 2.}

In order to appreciate the complexity of color perception and the impact of external and intrinsic conditions, it is necessary to understand some fundamental principles of color. The distinct appearance of a color is the result of differences between the three main attributes of color: hue, value and chroma. \cite{Triplett, supra note 46, at \textsuperscript{*2}. “Hue is the basic color, such as red, green, yellow or blue.” Id.; see JUDD & WYSZECKI, supra note 46, at 376 (defining hue as “[a]tttribute of visual sensation which has given rise to color names”); AN\textsc{tal Nemcsics, CO\textsc{our Dynamics 1, 29 (D.H. Sharp Trans., 1993) (defining hue as “attributable to colours that permits them to be described as ... blue, green, yellow, red or purple”). Value describes “the color’s intensity or degree of lightness.” Triplett, supra note 46, at \textsuperscript{*2}; see also Nemcsics, supra, at 29 (using term “lightness” to describe attribute of colors by which “object appears to reflect or transmit ... light”). “Chroma describes the color’s vividness or dullness.” Triplett, supra note 46, at \textsuperscript{*2}; see also JUDD & WYSZECKI, supra note 46, at 376 (describing chroma as “[a]tttribute of a visual sensation which permits a judgment to be made of the amounts of pure chromatic color present, irrespective of the amount of achromatic color.”) These three attributes are affected by changes in ambient lighting, viewing angle, and surrounding objects. See Nemcsics, supra note 47, at 76-81 (providing results and analysis of experiments conducted with variances of ambient conditions); Dan R. Schinasi, \textit{Multi\textsc{angle Color Testing}, INDUS. PAINT & POWDER, Feb. 1, 1993, at 14, available in Westlaw, 1993 WL 3179021, at \textsuperscript{*2-3} (asserting that all three color attributes vary depending upon viewing angle).}

\footnote{48} See, e.g., BERGER-SCHUNN, supra note 46, at 1 (explaining that light is necessary to view colors). As light diminishes and dark increases, colors fade to shades of grey. Id.

\footnote{49} JUDD & WYSZECKI, supra note 46, at 33 (stating that replacing incandescent lamp with florescent lamp changed visual stimuli so greatly that colors were no longer perceived to be same); \cite{BERGER-SCHUNN, supra note 46, at 3-13 (explaining that source of incident light has large influence on perceived color). A viewer may perceive an exact color match under a certain light source, and very little similarity under a different illuminant. RALPH M. EVANS, AN INTRODUCTION TO COLOR 223 (1948). For example, two shades of yellow may be noticeably different in daylight, but indistinguishable in artificial light. Id.}

Colors that appear identical under one type of light, but very different under another, are called metameric pairs. \cite{Triplett, supra note 46, at \textsuperscript{*6-7. Business organizations attempting to project a uniform corporate identity have discovered that the location and illumination of their logos occasionally resulted in a radically different appearance. \textit{Colorimeters and Spectrophotometers, supra note 46, at \textsuperscript{*1. The
appearance can change dramatically when juxtaposed with another color. For example, a green item placed on a red shelf appears to be a different shade than the same green item placed on a grey shelf. Third, and most important, the perception of color is essentially subjective. Color exists only in the mind of

impact of ambient light upon color perception is especially problematic when the product possesses a metallic or pearlescent finish. See Triplett, supra note 46, at *7 (discussing “flop” which are changes in appearance of color of metallic finishes under different ambient light conditions and viewing angles); see also Schinasi, supra note 47, at *2 (noting test methods utilized by manufacturers to prevent “flop” problems); JUDD & WYSZECKI, supra note 46, at 411-38 (analyzing impact of color surface on perception). In order to ensure that customers are presented with a consistent product, manufacturers have spent approximately $115 million on colorimeters and color spectrophotometers to remedy the difficulties in color matching products manufactured in different locales under varying conditions. Colorimeters and Spectrophotometers, supra note 46, at *1.

A customer depends on a mental standard of color. JUDD & WYSZECKI, supra note 46, at 33. This standard is subject to uncertainty based upon the light source. Id. Generally, the visual mechanism of the viewer will almost always act to see related colors on a single object; that is, it will perceive the object in relation to the amount of illumination. Id. at 24-25. For example, a viewer will perceive a cube that is pale green on the top with darker shades of green on its sides to be illuminated from above. Id. at 25.

50 BERGER-SCHUNN, supra note 46, at 2 (explaining that color perception depends on color background of sample); NEMCSICS, supra note 47, at 130 (“Colour values change character when adjacent.”) (quoting JOHANN W. GOETHE, THEORY OF COLOURS 281 (Charles L. Eastlake, trans., 1810)). This phenomenon is called simultaneous color contrast. AGOSTON, supra note 46, at 5; NEMCSICS, supra note 47, at 130 (quoting GOETHE, supra). Since sensation is influenced by the contrast between two adjacent colors, the impact of a color may be enhanced or diminished by contrasting. NEMSCICS, supra note 47, at 124-31.

Another visual effect, the “spreading effect,” also depends in part on the color of adjacent areas. EVANS, supra note 49, at 181. These shifts in brightness, however, are opposite to those that would be predicted on the basis of simultaneous contrast effects. Id. For example, a blue area surrounded by black will appear darker and more intensely saturated than a blue area surrounded by white, and different in hue from a blue area surrounded by red. See id. at 192A (“Plate XI”) (providing illustrative example demonstrating spreading effect). Until this “spreading effect” can be explained without elaborate assumptions, science cannot truly state that it understands the visual process. Id. at 181.

51 AGOSTON, supra note 46, at 5. “This visual phenomenon is called simultaneous color contrast.” Id.

52 Colorimeters and Spectrophotometers, supra note 46, at *1; see also BERGER-SCHUNN, supra note 46, at 2 (“Color perception is different for all people with normal vision ...”). Although perception variations are not normally conspicuous, observers with normal vision regularly judge color variations differently when matching pairs of color samples. Id.

Approximately 96% of the population have vision in the normal range, while the remaining 4% have abnormal color vision. Id. at 2, 19-26. Normal eyes, however, are colorblind if they view an object indirectly, under insufficient light, or for an insufficient period of time. JUDD & WYSZECKI, supra note 46, at 77-78; see EVANS, supra
the observer. 53 Two colors composed of substantially different
light waves when measured with a spectrophotometer can ap-
pear virtually identical to a human observer. 54 Furthermore,
one's perception of color can vary depending upon the individual
observer's age and memory, as well as the surface attributes of
the color itself. 55 It will be extremely difficult for industry new-

53 Newman, supra note 36, at 1609. Psychological measurement is basically more
important than computerized measurement for all aspects of color. HANS ARENS,
colored images based upon the stimulation of cones, which are receptors in the eye. See BERGER-SCHUNN, supra note 46, at 20 (stating cones are responsible for color
vision); JUDD & WYSZECKI, supra note 46, at 8 (explaining process by which changes
in optic image are transmitted to brain). Normal humans have three types of cones
with which to interpret visual stimuli, each with two receptors. BERGER-SCHUNN,
supra note 46, at 23-24. People with color-defective vision may have a receptor that
is significantly less sensitive than persons with normal vision. Id. Because people
with such a problem may learn to compensate adequately for daily life, testing with
color plates or an instrument may be necessary to determine defective color vision.

54 Newman, supra note 36, at 1609 (noting that perception of color depends upon
"amount of stimulation received by receptors in the eye"); see also ROBERT M.
BOYNTON, HUMAN COLOR VISION 45-50 (1979) (asserting that not every electromag-
netic radiation corresponds to given color). Computerized color instruments may, in
some cases, produce results that correspond to a viewer's perceived sensation of
color. ARENS, supra note 53, at 61. In other cases, however, such measurement pro-
vides no indication of the viewer's actual sensation. Id.; see BERGER-SCHUNN, supra
note 46, at vii (explaining disadvantages of computerized color analysis). The identi-
cal color sensation can be elicited in viewers by color stimuli which are substantially
different when spectrally measured. See AGOSTON, supra note 46, at 36 (explaining
colors do not have to be same wavelength to be perceived as identical); NEMCSICS,
supra note 47, at 31 (discussing metamerism-phenomenon by which two or more
surface colors appear identical under differing light sources); see also JUDD &
WYSZECKI, supra note 46, at 45-46 (explaining theory that perception of object color
under given stimulus is identical to perception of object color under stimuli of same
hue, value, and chroma regardless of spectral composition).

55 As people age, their lenses develop a yellowish or brownish pigment which de-
creases sensitivity to violet and blue light, thereby changing color perception. BERGER-SCHUNN, supra note 46, at 19; see also JUDD & WYSZECKI, supra note 46, at
13 (stating that aging causes development of yellowish or brownish pigment in
lenses). Changes in the crystallinity of the lens may also contribute to variation in
color perception between young and old viewers. BERGER-SCHUNN, supra note 46, at
comers and courts to accurately determine whether a majority of viewers would find two shades confusingly similar because the perception of color depends upon lighting, adjacent colors, and the individual viewer. Consequently, market newcomers must avoid a range of similar shades in selecting a color for commercial use to avoid infringing upon a color trademark.

Moreover, courts assessing the registrability of trademarks consisting of color alone are likely to confront a lack of evidence when applying the Qualitex decision. Trademark registrations are printed only in black and white. Where color is a feature of the trademark, the color may be indicated only by using one of eight code linings. Courts may have only the black and white drawing and the verbal description of the color in the application with which to evaluate the claim and assess the likelihood of

61-62. Additionally, memory plays a role in the perception of color. "The color most frequently seen on surrounding objects is indelible from our memory, and its afterimage becomes a permanent characteristic. The so-called real colour of a given object is, in fact, the colour associated to this object in our memory." NEMCSICS, supra note 47, at 124. Moreover, eyes that have looked upon a colored surface for a few minutes may undergo a "retuning," at which time the perceived color changes. Id. at 121. For example, after retuning orange seems more yellow and violet appears more blue. Id. "Retuning" strains the eyes, and may lead to temporarily reduced color vision. Id. at 122. Finally, one's perception of a color is strongly influenced by the accompanying surface attribute such as glittering, transparent, glossy, matte, etc. ARENS, supra note 53, at 14; see supra note 49 (discussing "flop" and associated surface reflection phenomenon). The average viewer is quite incapable of comparing two colors with markedly different surface attributes. EVANS, supra note 49, at 184-85 (giving example of comparing satin with cotton). In order to accurately perceive a color, therefore, it must be completely isolated. ARENS, supra note 53, at 15.

See BERGER-SCHUNN, supra note 46, at 2 (stating that color perception is different for all people with normal vision); EVANS, supra note 49, at 185 (explaining that perception of color varies from individual to individual). "Our perception and the measured values say that both samples, if at all, match under only one light source and for one observer." BERGER-SCHUNN, supra note 46, at 2; see also supra note 52 (explaining how color perception differs for all people with normal vision).

See G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387 (7th Cir.) ("One entering a field of endeavor already occupied by another should, in the selection of a trade-name or trade-mark, keep far enough away to avoid all possible confusion.") (quoting Northam Warren Corp. v. Universal Cosmetic Co., 18 F.2d 774, 775 (7th Cir. 1927), cert. denied, 361 U.S. 819 (1959)).

37 C.F.R. § 2.53(a), (b) (1995).

37 C.F.R. § 2.52(e) (1995). The eight code linings are: Red or Pink, Brown, Blue, Gray or Silver, Violet or Purple, Green, Orange, and Yellow or Gold. Id.; see also In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1131 (Fed. Cir. 1985) (noting that Owens-Corning's trademarked pink insulation is represented by color indicator for pink or red).

customer confusion because an applicant for registration is not obliged to submit any evidence in defense of a trademark infringement claim. This paucity of information will likely result in an overly broad interpretation of the realm of color shade afforded protection under the color trademark and hasten the depletion of colors available to competitors.

B. Color Depletion

The removal of wide bands of colors from those available for commercial use in order to avoid shade confusion will deplete the remaining supply of colors and thus make it difficult for market newcomers to choose an appropriate color. This, in turn, may prevent market newcomers from competing effectively. Although the Supreme Court in Qualitex acknowledged that color depletion might occur in certain circumstances, it found this argument unpersuasive because "it relies on an occasional problem to justify a blanket prohibition." The Court, however,

in the application should describe the color or color combinations of the mark. 37 C.F.R. § 2.35 (1995). Although the Federal Regulation requires the drawing submitted with the trademark application to be a "substantially exact representation of the mark," 37 C.F.R. § 2.51 (a)(1) (1995), the determination as to the specificity of the color description is left to the discretion of the Examiner of Trademarks. 37 C.F.R. § 2.35; see 37 C.F.R. § 2.61(b) (1995) (authorizing examiner to require submission of "such information and exhibits as may be reasonably necessary to the proper examination of the application").

For example, the certificate of registration filed by Qualitex utilized the "yellow or gold" code lining for their press pads. See Qualitex Co. v. Jacobson Prods. Co., Inc., 13 F.3d 1297, 1301 (9th Cir. 1994) (quoting U.S. Patent and Trademark Office Certificate of Registration No. 1,633,711), rev'd, 115 S. Ct. 1300 (1995). The certificate defines the pads' coloring as "a particular shade of green gold." Id. A court would then have to determine whether customer confusion would result from the addition to the market of a press pad through review of the vague description of "yellow or gold" in the code lining, clarified only by the examiner's determination that "a particular shade of green-gold" constituted a "substantially exact representation of the mark." See Amsted, 2 U.S.P.Q.2d at 1760 (noting lack of provision in trademark registration for differentiation among hues created presumption that subsequently alleged infringer's product coloring could be anywhere within range of color provided by lining, including exact shade utilized by trademarked product).

See infra notes 63-84 and accompanying text (discussing color depletion theory).

See supra note 14 and accompanying text (discussing color depletion theory).

Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300, 1306 (1995) (providing for possibility that color depletion problems will arise); see also Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1532 (Fed. Cir. 1994) (explaining that color depletion theory is not per se bar to color mark registration but is factor in determination of whether trademark hinders competition), cert. denied, 115 S. Ct. 1426 (1995).

Qualitex, 115 S. Ct. at 1306.
failed to recognize the widespread potential for the problems\textsuperscript{66} that will result from its relegation of the color depletion issue solely to the protection of the functionality doctrine.\textsuperscript{67}

The Court began its analysis by asserting that "hundreds of color pigments are manufactured and thousands of colors can be obtained by mixing."\textsuperscript{68} While experts have estimated that, under ideal viewing conditions, a normal eye can distinguish about ten million different colors,\textsuperscript{69} such numbers are meaningless if the customer never gets the chance to make a side by side comparison of the two products.\textsuperscript{70} When forced to rely on memory or an advertisement,\textsuperscript{71} customers use names to distinguish between

\begin{footnotesize}
\begin{enumerate}
\item Id. (explaining that when color serves as mark, normally alternative colors will likely be available for similar use by others). The Court cited by way of example the case of Owens-Corning pink insulation. See id. at 1304. In that unusual case, Owens-Corning was the only manufacturer of all the producers to color its insulation. In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1122 (Fed. Cir. 1985). In the insulation industry, use of color on a product was the exception, while in the press pad industry, such coloration was the norm. Compare id. (finding no evidence in record of widespread industry practice of dyeing insulation color different from that obtained in manufacturing process) with Qualitex Co. v. Jacobson Prods. Co., 21 U.S.P.Q.2d 1457, 1458 (C.D. Cal. 1991) (stating other manufacturers have used various colors on press pads for decades), rev'd in part, aff'd in part, 13 F.3d 1297 (9th Cir. 1994), rev'd, 115 S. Ct. 1300 (1995).
\item "The fact that sometimes color is not essential to a product's use or purpose and does not affect cost or quality — indicates that the doctrine of 'functionality' does not create an absolute bar to the use of color alone as a [trade]mark." Qualitex, 115 S. Ct. at 1304; see also, Newman, supra note 36, at 1600 ("Functional features may not be protected under trademark law, because doing so would defeat the patent law's goals of giving inventors only a limited monopoly over their inventions and refusing protection of inventions that are either obvious or insufficiently innovative.").
\item Qualitex, 115 S. Ct. at 1305 (citing L. CHESKIN, COLORS: WHAT THEY CAN DO FOR YOU 47 (1947)).
\item See AGOSTON, supra note 46, at 101 (citation omitted) ("It is estimated that a normal eye can distinguish about 10 million different colors and that in ordinary commerce about a half million different colors are recognized."); EVANS, supra note 49, at 184 (citing possibility of ten million different perceived colors). But see AGOSTON, supra note 46, at 41 ("[i]n a color circle that contains 192 colors, the difference between the hues of adjacent colors is hardly perceptible.").
\item Newman, supra note 36, at 1614 (asserting purchaser who never gets chance to make side by side comparison "is more likely to be fooled by an infringer's similar shade.").
\item For example, advertisements of Owens-Corning Fiberglas insulation discussed "how homeowners can cut the high cost of fuel if they would only 'add another layer of pink' in their attics." In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1126 (Fed. Cir. 1985). Additionally, "[f]urther evidence of promotion of 'pink' was submitted in the form of a radio commercial. The text included, 'if you'd like to keep your house warmer in winter, cooler in summer ... you'll love that pink.'" Id.
\end{enumerate}
\end{footnotesize}
different colors. Although several hundred color names exist theoretically, the color terms that account for the majority of all color references in common usage may number as few as twelve.

Other factors may further limit the number of available colors. In the context of any particular product, customer appeal makes only certain colors appropriate. Additionally, the manufacturer of a color-trademarked product may find it difficult to ensure the consistency of a shade, thereby necessitating a broader range of protected colors. These factors, coupled with the removal of colors to avoid problems of shade confusion, will deny competitive options to industry newcomers.

In justifying its rejection of the color depletion argument, the Court unreasonably relied on the ability of the functionality doctrine to overcome such problems. The functionality doctrine

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72 EVANS, supra note 49, at 229 (explaining that “[t]o the naive observer two colors are different if he calls them by different names”). The number of available color names is obviously fewer than the list of distinguishable colors. Id. at 230. The color name “Royal Blue,” for example, “can refer to nearly twenty thousand distinguishable colors.” Newman, supra note 36, at 1610. Although different groups may use the same color terms, they may be referring to decidedly different colors. EVANS, supra note 49, at 231.

73 AGOSTON, supra note 46, at 101-02 (stating that National Bureau of Standards presented list of 267 standardized color names that apply to colors of nonluminous materials); EVANS, supra note 49, at 230 (referring to workable system for systematic naming of surface colors which has only 319 divisions).

74 See EVANS, supra note 49, at 230 (noting that of 4,416 color terms used in survey of seventeen best selling novels, 4,081 were accounted for by only twelve terms).

75 Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300, 1306-06 (1995); see also NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 1028 (7th Cir. 1990) (“NutraSweet contends that the accepted market understanding is that pastel blue means ‘Equal,’ pink means ‘Sweet ’N Low’ and yellow means ‘Sugar Twin’”), cert. denied, 111 S. Ct. 1640; Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir.) (“[T]he evidence shows those [colors] suitable for light products, such as milk, are even more limited.”) (quoting Pacific Coast Condensed Milk Co. v. Frye & Co., 85 Wash. 133, 141 (1915), cert. denied, 70 S. Ct. 88 (1949)).

76 See Youngstown Sheet & Tube Co. v. Tallman Conduit, 149 U.S.P.Q. (BNA) 656, 658 (Trademark Trial & Appeal Bd. 1966) (finding colored product may vary from deep reddish orange to light orange, which is virtually indistinguishable from competitor’s gold color); JUDD & WYSZENCKI, supra note 46, at 461 (stating that system which yields desired color only at great expense must be discarded). No one knows exactly what a commercial color match is. Id. at 36. Each company, therefore, must seek a compromise between simplicity of formulation and accuracy of resulting color. Id. at 461. But see id. at 2 (explaining color tolerances on trademarked containers must be remarkably small to ensure customer loyalty).

77 See e.g., NutraSweet, 917 F.2d at 1028 (arguing that allowing color alone to be trademarked will deter new entrants from entering market).

78 Qualitex, 115 S. Ct. at 1306 (stating that functionality doctrine is available to
forbids trademarking a product’s feature where doing so would place a competitor at a significant disadvantage because that feature is “essential to the use or purpose of the article” or “affects its cost or quality.” The Court, therefore, reasoned that the functionality doctrine deters interference with legitimate competition through “actual or potential” use of color, an important product ingredient.

The Court failed to identify clearly whether the competitive need for color in a particular market should be determined by present demand or future need. The inclusion of the words prevent anti-competitive consequences of color depletion).

79 Id.; Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850-51 n.10 (1982) (“In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”); see Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 232-33 (1964) (holding that state may not prohibit copying of article or award damages for such copying when article is neither patented nor copyrighted); Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938) (“Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all ...”). Courts have regularly invoked the functionality doctrine to deny protection to specific colors. See also Inwood Labs., 456 U.S. at 853, 857 n.20 (finding colors of prescription drugs serve function by identifying type of medication); Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1529 (Fed. Cir. 1994) (explaining black color of outboard engines serves function of making engines appear smaller and matching variety of boat colors), cert. denied, 115 S. Ct. 1426 (1995); Nor-Am Chem. Co. v. O. M. Scott & Sons Co., 4 U.S.P.Q.2d (BNA) 1316, 1320 (E.D. Pa. 1987) (finding blue color of fertilizer functional because it indicates presence of nitrogen); Deere & Co., v. Farmhand, Inc., 560 F. Supp. 85, 91-92 (S.D. Iowa 1982) (stating that green shade of farm machinery is functional since farmers want equipment to match), aff'd, 721 F.2d 253 (8th Cir. 1983).

80 Qualitex, 115 S. Ct. at 1306; see supra note 67 and accompanying text (discussing functionality doctrine). A recently developed test for determining the functionality of a product feature involves three parts: (1) whether a particular design has superior utility; (2) whether alternative designs are available; and (3) whether the design is especially economical. In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1340-41 (C.C.P.A. 1982); Nancy L. Clarke, Issues in the Federal Registration of Flavors As Trademarks For Pharmaceutical Products, 1993 U. IL. L. REV. 105, 112 (1993). In the case of color depletion in a particular market, the functionality doctrine would take effect because alternative colors would not be available. Qualitex, 115 S. Ct. at 1306.

81 See Qualitex, 115 S. Ct. at 1305-06. The conflicting views of the color depletion theory might be termed the current competitive need view and the future competitive need view. Donald M. Hill, Jr., Protection For Trademarks Consisting of Color Alone: Master Distributors, Inc. v. Pako Corp., 986 F.2d 219 (8th Cir. 1993), 63 U. CIN. L. REV. 989, 998-1001 (1995). The current competitive need view maintains that when the current number of available colors greatly exceeds the number of competitors in the market, then no competitive need exists for the color seeking protection and it can be trademarked. Id.; see In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1122 (Fed. Cir. 1985). The future competitive need view, however, holds that a competitive need would necessarily arise when new manufacturers enter the market, despite the number of currently available colors, if current manufacturers
"actual or potential" in the decision suggests that courts should consider prospective competitors’ needs. Courts, however, lack the clairvoyance necessary to accurately predict the likelihood of future competitors in a particular market. If the functionality doctrine protects future competitors, one might easily justify a ban on color trademarks in virtually all markets.

II. SHOULD THE COURT HAVE PROTECTED QUALITEX’S TRADEMARK?

Even if in some instances the colors available to industry newcomers are plentiful and the potential competitive need is slim enough to justify extending the Lanham Act’s trademark protection to color alone, it is submitted that the Court erred in upholding Qualitex’s trademark based on the particular facts of the case. The district court found other manufacturers of dry cleaning press pads have used the colors lime green, grey, dark green, light blue, orange, peach, blue-grey, brown, and other colors on their press pads “for decades.” It is asserted, therefore, that allowing each of these manufacturers to monopolize and protect their color of choice will remove shades in the color ranges of green, blue, grey, brown, and orange from those available to new competitors interested in entering the press pad market. The list of available viable colors diminishes further since the colors of a press pad must be appealing to customers while still dark enough to camouflage stains. Manufacturers attempting to enter the press pad market, therefore, will have only a limited number of undesirable choices from which to select a color. Since the functionality doctrine prohibits trade-

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52 Qualitex, 115 S. Ct. at 1306.
53 See NutraSweet, 917 F.2d at 1028 (stating “there is no way for a court to predict the likelihood of future competitors in a particular market.”).
54 See id. ("[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.").
55 Cf. Owens-Corning, 774 F.2d at 1122 (noting that Owens-Corning is only manufacturer of insulation that colors its product and there are only small number of producers).
57 See supra notes 40-62 and accompanying text (discussing broad range of protection required as result of shade confusion problems).
marking a color where doing so would actually or potentially interfere with legitimate competition, and since allowing press pad manufacturers to protect color may potentially interfere with legitimate competition, the Court should have rejected Qualitex's trademark.

CONCLUSION

By holding that the Lanham Act extends trademark protection to color alone, the Supreme Court, in Qualitex Co. v. Jacobson Products Co., ignored the potential for unfair competition in some markets. The granting of trademark status to color alone will only effectively protect sellers' reputations and consumer expectations of quality if it includes a wide range of similar colors to avoid problems of shade confusion. Removal of such shades of color from those available for commercial use could deplete the supply of suitable colors and thereby prohibit market newcomers from effectively competing in the protected industry. Although the Lanham Act is intended to protect consumer expectations of product quality, such protection should not be permitted to interfere with fair competition.

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89 Id. at 1306 (stating trademark doctrine of functionality normally would seem available to prevent anti-competitive consequences).