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The New Black: Trademark Protection for Color Marks in the Fashion Industry

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Cover Page Footnote

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INTRODUCTION

Copyright, patent and trademark laws provide only limited intellectual property protection to fashion designs.[1] These incomplete protections leave designs vulnerable to piracy,[2] particularly those in the "designer" or "luxury" categories because of their innovative design content and high prices.[3] In order to

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1 *See infra* Part I.A.

2 *See generally A Bill to Provide Protection for Fashion Design*: *Hearing on H.R. 5055 Before the H. Subcomm. on Courts, the Internet and Intellectual Property*, 109th Cong. 77–85 (2006) (statement of Susan Scafidi, Visiting Professor, Fordham Law School, Associate Professor, Southern Methodist University); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006).

3 Lynsey Blackmon, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107, 118 (2007–08). The fashion market is divided into sectors. Raustiala & Sprigman, *supra* note 2, at 1693. These sectors compose what has been termed the "fashion pyramid." *Id*. At the top of the pyramid are designer fashions, consisting of haute couture, designer ready-to-wear and bridge collections. *Id*. Next are "better" fashions, and below are "basic or commodity" fashions. *Id*. Not only do these categories differ by price, but also by "design content." *Id*. at 1694. Designer fashions typically

enhance the rights they have, designers should push the boundaries of the available protection by utilizing new strategies rooted in existing intellectual property law.

Trademark law, for instance, could be extended beyond the protection of designer logos and insignia.[4] Using color marks, designers could take advantage of a form of legal protection for their designs consistent with the aesthetic and brand-oriented nature of their products.[5] Source-identifying color marks could be used in a similar manner to designer logos and insignia to more subtly add distinctiveness to designs.

Color has the power to make a design stand out in the marketplace and to define a brand.[6] Many prominent luxury goods and fashion labels are linked with signature colors, including Hermés's orange, Louis Vuitton's brown and Tiffany blue.[7] Consumers tend to notice the color of a product or its packaging before other visual characteristics.[8] Colors convey subtle psychological messages that can be utilized by retailers and manufacturers to influence decisions made in the marketplace, both at the point of sale[9] and using advertising.[10]

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have greater "design content," therefore resulting in faster turnover, whereas other fashions typically have less "design content," therefore experiencing slower change. *Id.*

4 *See infra* Part I.A.3.

5 *See infra* text accompanying notes 135–37.

6 *See* STEVEN BLEICHER, CONTEMPORARY COLOR THEORY & USE 43 (2005); UCHE OKONKWO, LUXURY FASHION BRANDING: TRENDS, TACTICS, TECHNIQUES 102 (2007) ("A brand is . . . an identifiable entity that makes specific and consistent promises of value and results in an overall experience for the consumer or anyone who comes in contact with the brand . . . . [That] includes names, terms, signs, symbols, designs, shapes, colours or a combination of these elements.").

7 OKONKWO, *supra* note 6, at 107. "[C]olor is used for brand identification. Conceived broadly, this could include a designer's line of clothing or the introduction of a single color. Ralph Lauren tends to select middle value hues of low intensity for his depiction of 'traditional' values. Elsa Schiaparelli introduced a single identifier, 'shocking pink.'" Marilyn Revell DeLong, "Color in Dress," *in* 1 ENCYCLOPEDIA OF CLOTHING AND FASHION 280, 283 (Valerie Steele, Ed., 2005).

8 *See infra* text accompanying notes 84–85.

9 During a panel discussion on color and design at the Cooper-Hewitt Design Museum, Diana Mora, a representative of Glaceau, producer of Vitaminwater and Fruitwater described the use of color in marketing their products:

> Vitaminwater is a brand that most people form an emotional bond with, primarily because of the packaging. As a matter of fact, it's the

Fashion retailers often take advantage of the messages that colors convey in designing their stores.[11] For example,

> the dark colour tones found in the stores of Alexander McQueen evoke a smouldering sexiness which is associated with the brand. Also the gold and brown colour tones found in Louis Vuitton stores are in harmony with the brand's visual identity and luxurious brand appeal. The Chanel monochrome black and white, which evokes classic chic, is felt both in the stores and in the other aspects of the brand's communications.[12]

Distinctive colors are nothing new to the fashion industry. Extending more formal protection to those colors is a means to further distinguish a brand and its designs.

Part I of this Note outlines the current intellectual property protections of both fashion designs and of single colors used in product design. Part II discusses Christian Louboutin's trademark of the red soles on his shoe designs and the primary objections to their protection arising from the color depletion theory. Part III argues that these marks should be protected despite those objections because color depletion is not a legitimate threat to competition in the fashion industry.

> first intro, our first point of contact. . . . It's the "pick me, pick me" off the beverage shelf.
> . . . It's our point of difference. It's what we are known for and how we describe ourselves. . . .
> Vitaminwater is colors; it all started with the belief that color, through its simplicity, not only evokes emotion, but evokes a feeling of nostalgia. . . .
> . . . Our strong color bands, while so simple, were, and still are, the best way to cut through the clutter known as the beverage shelf.

Diana Mora, Representative of Glaceau, Customization through Color, Panel Discussion at Cooper-Hewitt National Design Museum Fashion in Colors Symposium (Feb. 11, 2006), *available at* http://cooperhewitt.org/_docs/education/colors_symposium_afternoon.pdf.

[10] Studies have shown that readers will spend significantly more time looking at a color advertisement than one black and white ones. *See* BLEICHER, *supra* note 6, at 137.

[11] *See* OKONKWO, *supra* note 6, at 83.

[12] *See id*. at 82–83.

I. BACKGROUND

Since the validity of a color mark used in the fashion industry has not yet been tested, the degree of protection afforded to such marks must be considered in light of protections recognized for all marks used in the fashion industry and color marks used in product designs generally.

A. Current Intellectual Property Protection of Fashion Designs

Although an entire fashion design rarely falls within the scope of protectable intellectual property, elements of designs may still be worthy of protection under copyright, patent or trademark laws.

1. Copyright Law & Fashion Designs

Copyright law protects a small class of fashion designs.[13] Although fashion designs could fall within the copyright category of "pictorial, graphic, and sculptural works,"[14] courts have excluded them from copyright protection by classifying them as "useful article[s]" having "intrinsic utilitarian function[s] that [are] not merely to portray the appearance of the article[s] or to convey information."[15] Copyright law protects fashion designs despite the "useful articles" doctrine if the "expressive component is 'separable' from its useful function."[16] Under the separability

[13] In the future, there may be greater copyright protections for fashion designs stemming from the proposed Design Piracy Prohibition Act, which would provide three years of copyright protection to registered designs. *See* Susan Scafidi, *Intellectual Property and Fashion Design*, *in* 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 126 (Peter K. Yu ed., 2007).

[14] Copyright law protects works "fixed in any tangible medium" belonging to a wide range of creative or artistic works—"(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works." 17 U.S.C. § 102(a) (2006).

[15] *Id.* § 101; *see also* Raustiala & Sprigman, *supra* note 2, at 1699.

[16] Raustiala & Sprigman, *supra* note 2, at 1699; *see* Poe v. Missing Persons, 745 F.2d 1238, 1242 (9th Cir. 1984) (holding that a clear vinyl and rock swimsuit was copyrightable because evidence showed that it was "artwork and not a useful article of clothing"); *cf.* Galiano v. Harrah's Operating Co., 416 F.3d 411, 422 (5th Cir. 2005) (holding that a uniform was not copyrightable because the uniform's expressive component was not separable from its utilitarian function). Although a finished garment

doctrine, copyright protection is allowed if "such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."[17] Courts invoke this doctrine, albeit infrequently, to "distinguish between the artistic elements of a new fashion design and its basic function of covering the human body."[18] Most clothing is unlikely to meet this test[19] because "most often the design itself, such as the cut of a sleeve, simultaneously serves its function as clothing to 'cover the wearer's body and protect the wearer from the elements.'"[20]

2. Patent Law & Fashion Designs

Patent law provides little protection for fashion designs. Utility patents can be used for specialty designs,[21] or for elements of designs like fasteners[22] and fabrics[23] that satisfy the requirements of utility, novelty and nonobviousness.[24] A designer may seek a design patent if the design's formulation is not determined entirely by its function,[25] but clothing has been held to be inherently

may not have copyright protection, its fabric may be protected because designs printed on fabric have long been held to be subject matter appropriate for copyright protection. *See, e.g.*, Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc., 169 F. Supp. 142 (S.D.N.Y. 1959).

17 17 U.S.C. § 101.

18 Scafidi, *supra* note 13, at 123 (citing HR Rep. No. 94-1476, at 55); *see also* Chosun Int'l., Inc. v. Chrisha Creations, Ltd., 413 F.3d 324, 329 (2d Cir. 2005); Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 765–66 (2d Cir. 1991); Eve of Milady v. Impression Bridal, Inc., 957 F. Supp. 484, 488 (S.D.N.Y. 1997); Peter Pan Fabrics v. Candy Frocks, Inc., 187 F. Supp. 334, 336 (S.D.N.Y. 1960).

19 Olivera Medenica, *Bill Would Protect Fashion Designs: Designers Seek to Prevent Cheaper Knockoffs*, 28 NAT'L L.J., S1, S1 (2006); *see also* Whimsicality, Inc. v. Rubie's Costume Co., Inc., 891 F.2d 452, 455 (2d Cir. 1989).

20 Emily S. Day, *Double-Edged Scissor: Legal Protection for Fashion Design*, 86 N.C. L. REV. 237, 247 (2007) (quoting Celebration Int'l, Inc. v. Chosun Int'l, Inc., 234 F. Supp. 2d 905, 912 (S.D. Ind. 2002)).

21 Scafidi, *supra* note 13, at 122 (citing U.S. Patent No. 7,062,786 (filed Apr. 9, 2002) (hazmat suit) and U.S. Patent No. 7,089,995 (filed May 10, 2002) (space suit)).

22 *Id*. (citing U.S. Patent No. 2,717,437 (filed Oct. 15, 1952) (Velcro) and U.S. Patent No. 504,038 (filed Nov. 7, 1891) (zipper)).

23 *Id.* (citing U.S. Patent No. 3,919,587 (filed Sept. 7, 1971) (Kevlar) and U.S. Patent No. 2,692,874 (filed Apr. 17, 1952) (Lycra)).

24 35 U.S.C. §§ 101–03 (2006).

25 23 CHISUM ON PATENTS § 23.03 (2008). However, a design that includes utilitarian elements will not be denied protection if the whole design was not dictated by a

functional, thus barring the issue of design patents, though they are still available for accessories and shoes.[26]

Utility patents and design patents both require a lengthy application process incompatible with the seasonal nature of the fashion industry.[27] A fashion design usually has a lifespan of approximately three to six months, whereas it may take up to eighteen months to obtain either type of patent.[28] The patent application process is also very expensive, placing it beyond the reach of many fashion designers.[29]

3. Trademark and Trade Dress Background

Trademark law provides protection to famous marks used in the fashion industry, usually designer logos and insignia.[30] The protection of logos and insignia has led designers to incorporate them into their designs to distinguish them from those of imitators.[31] This strategy allows a designer to protect the design based on the trademark protection afforded the logo.[32] For example, Burberry holds a trademark on a particular plaid that it uses in apparel and accessory designs, and Louis Vuitton handbags and accessories often feature the "LV" toile monogram.[33] However, only designers with recognizable trademarks can take advantage of this pragmatic design strategy.[34] Those with lesser brand recognition are not able to benefit as effectively because their designs lack the same appeal to consumers.

Trade dress is a form of trademark protection used to protect the overall appearance of an item, including its size, shape, colors

utilitarian purpose. *See* L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993).

26 *See* Julie P. Tsai, Comment, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 456 (2005).

27 Scafidi, *supra* note 13, at 122.

28 Day, *supra* note 20, at 251.

29 Scafidi, *supra* note 13, at 122.

30 *Id.* at 121.

31 *Id.*

32 Raustiala & Sprigman, *supra* note 2, at 1701.

33 *Id.*

34 Scafidi, *supra* note 13, at 121.

or texture.[35] This broad definition suggests that trade dress may be used to protect the entirety of a garment, handbag, or shoe, but nondistinctiveness frequently bars its use to protect fashion designs.[36] Trademarks fall on a continuum between those that are inherently distinctive and those that are nondistinctive.[37] To become valid trademarks, nondistinctive marks must acquire distinctiveness through their use, which is termed "secondary meaning." Secondary meaning is an "association in buyers' minds between the alleged mark and a single source of the product."[38]

Fashion designs must have secondary meaning to qualify for trade dress protection. In *Wal-Mart Stores v. Samara Brothers*,[39] the Supreme Court determined that aesthetic or functional purposes, rather than source-identifying purposes, governed the design of the children's apparel at issue.[40] The Court noted that:

> In the case of product design . . . we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.[41]

Unlike product packaging, where frequently the purpose is to identify the source, the design of the product itself is rarely dictated by that same concern.

B. Color Marks

Traditionally, colors were not recognized as valid trademarks. However, more recently, the Supreme Court ruled that a color can

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35 Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 765 n.1 (1992) (quoting John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983)).

36 Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212–13 (2000).

37 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:1 (4th ed. 1997).

38 *Id* § 15:5.

39 *Wal-Mart*, 529 U.S. 205.

40 *Id.* at 210–15.

41 *Id.* at 213.

act as a trademark if it meets all other trademark requirements.[42] Color marks may be registered on the principal register or recognized as trademarks under the common law.[43]

1. Color Marks in the PTO

Registration of a color mark with the PTO requires a showing of secondary meaning in the applicant's use of the color.[44] Secondary meaning is more difficult to prove for color marks than traditional marks, as the Trademark Trial and Appeal Board ("TTAB") has reasoned that "the inherent non-distinctive nature of the applied-for mark [raises the burden of proof because] consumers do not associate a single color of a product with a particular manufacturer as readily as they do a trademark or product packaging trade dress."[45] The PTO also considers the functionality of a color mark when determining its validity.[46]

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[42] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 171–74 (1995).

[43] *In re* Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1121 (Fed. Cir. 1985).

[44] *See* PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.05(a) (5th ed. 2007) [hereinafter TMEP]; *see also* Midge M. Hyman & Hannah Y. Cheng, *Registrability and Enforceability of Non-Traditional Trademarks in the United States*, 834 PLI/PAT 213, 217–18 (2005).

[45] *In re* Ferris Corp., 59 U.S.P.Q.2d 1587, 1591 (T.T.A.B. 2000). The PTO looks to a series of factors in determining whether the color has secondary meaning, including:

> whether the use of the color is common in the relevant segment of the market in question;
> the product's sale volume;
> whether publicity directly captures the customer's attention with respect to the color of the product;
> whether the color is also used in promotional articles;
> whether consumers associate the color with the nature of the product; and
> whether the color serves some utilitarian purpose.

Glenda Labadie-Jackson, *Through the Looking Hole of the Multi-Sensory Trademark Rainbow: Trademark Protection of Color Per Se Across Jurisdictions: The United States, Spain and the European Union*, 7 RICH. J. GLOBAL L. & BUS. 91, 99 (2008) (formatting altered for quotation); *see also* Hyman & Cheng, *supra* note 44, at 218–19.

[46] A color mark also may not be registered if it "yields a utilitarian or functional advantage, for example, yellow or orange for safety signs." TMEP, *supra* note 44, § 1202.05(b). A color may also be functional if it makes the product more economical to manufacture or use, including where the color is a natural result of the manufacturing process. The PTO also considers aesthetic functionality, which it defines as "where the evidence indicates that the color at issue provides specific competitive advantages that,

2. Court Decisions Establishing the Validity of Color Marks

In *Qualitex Co. v. Jacobson Products Co., Inc.*,[47] the U.S. Supreme Court ruled that it was possible to obtain trademark protection over a single color.[48] The *Qualitex* decision resolved a circuit split that formed after the Federal Circuit ruled that a color alone could be registered as a trademark in *In re Owens-Corning Fiberglas Corp*.[49] This case arose from a TTAB refusal to grant Owens-Corning a trademark for the color pink used on fiberglass insulation because of a failure to show distinctiveness in its use of the color.[50] The TTAB and Federal Circuit both ruled that the Lanham Act permitted registration of a trademark consisting solely of a color.[51]

In *Qualitex*, the Supreme Court considered whether the green-gold color used on dry cleaning pads could be a valid trademark.[52] The Court noted that a trademark may be "almost anything at all that is capable of carrying meaning," including a single color.[53] The Court reasoned that "[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word or sign—that permits it to serve [the] basic purposes" of a trademark.[54]

The Court also considered whether the color was functional.[55] Although the existence of a color on the pads avoids noticeable

while not necessarily categorized as purely 'utilitarian' in nature, nevertheless dictate that the color remain in the public domain." *Id.*; *see infra* Part I.D.

47 *Qualitex*, 514 U.S. 159.

48 *Id.* at 171–74.

49 *In re* Owens-Corning Fiberglas Corp., 774 F.2d 1116 (Fed. Cir. 1985). The Eighth Circuit followed the Federal Circuit's line of reasoning in *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219, 224–25 (8th Cir. 1993). The Ninth and Seventh Circuits declined to follow this reasoning in *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297, 1301–02 (9th Cir. 1994) and *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1025 (7th Cir. 1990), respectively. See also James L. Vana, *Color Trademarks*, 7 TEX. INTELL. PROP. L.J. 387, 391 (1999).

50 *In re* Owens-Corning Fiberglas Corp., 221 U.S.P.Q. 1195, 1196 (T.T.A.B. 1984), *rev'd*, 774 F.2d 1116 (Fed. Cir. 1985).

51 *Owens-Corning*, 774 F.2d at 1118.

52 *Qualitex*, 514 U.S. at 161.

53 *Id.* at 162.

54 *Id.* at 164.

55 *See id.* at 164–66.

stains, the green-gold color served no function besides identifying the pad's source.[56] Since the district court found "no competitive need in the press pad industry for the green-gold color, since other colors are equally usable," the Court held that functionality did not bar its protection.[57]

The Court went on to reject arguments for a per se rule against the protection of color marks. First, the Court rejected the "shade confusion" argument that courts and competitors will be unable to effectively differentiate between colors to determine whether confusion would result from their uses.[58] The Court reasoned that color is not unique in posing this problem, as courts often resolve difficult questions regarding words and symbols as well.[59] Second, the Court rejected the "color depletion argument"[60] because the functionality doctrine would bar protection to colors that competitors required.[61] Finally, the court rejected the argument that color did not need to be protected as it could be protected as a part of overall trade dress because "one can easily find reasons why the law might provide trademark protection in addition to trade dress protection."[62]

3. The Color Depletion Argument

Traditionally, color depletion has been one of the primary arguments against recognizing color marks. The color depletion theory posits that although there are numerous colors available for use by a manufacturer, only some colors are actually usable.[63] The United States Supreme Court explained:

> By the time one discards colors that, say, for reasons of customer appeal, are not usable, and adds the shades that competitors cannot use lest they risk

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56 *Id.* at 166.

57 *Id.* (quoting Qualitex Co. v. Jacobson Prods. Co., 21 U.S.P.Q.2d 1457, 1460 (C.D. Cal. 1991)).

58 *Id.* at 167–68.

59 *Id.*

60 *See infra* Part I.B.3.

61 *Qualitex*, 514 U.S. at 168–69.

62 *Id.* at 174.

63 *Id.* at 168.

> infringing a similar, registered shade, then one is left with only a handful of possible colors. And, under these circumstances, to permit one, or a few, producers to use colors as trademarks will "deplete" the supply of usable colors to the point where a competitor's inability to find a suitable color will put that competitor at a significant disadvantage.[64]

In *Qualitex*, the Court collapsed the color depletion theory into the functionality inquiry.[65]

Prior to *Qualitex*, courts occasionally relied on the color depletion theory to reject color marks. For example, in *NutraSweet Co. v. Stadt Corp.*,[66] the Seventh Circuit affirmed a grant of summary judgment on the basis of the color depletion theory.[67] Plaintiff NutraSweet argued that consumers already identified three major brands of artificial sweetener with a particular color.[68] It argued that consumers understood pastel blue to refer to the brand "Equal," pink to "Sweet 'N Low" and yellow to "Sugar Twin."[69] NutraSweet argued that it was a question of fact whether consumers would confuse a different shade of blue employed by a competitor with Equal's blue.[70] The court rejected this argument as necessitating an unworkable standard under which the court would have to consider the "likelihood of future competitors in that market to determine whether there is a competitive need for the color blue to remain available."[71] The court therefore determined that "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

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64 *Id.*

65 "[I]f a 'color depletion' or 'color scarcity' problem does arise—the trademark doctrine of 'functionality' normally would seem available to prevent the anticompetitive consequences that Jacobson's argument posits . . . ." *Id.* at 169.

66 NutraSweet Co. v. Stadt Corp., 917 F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1990).

67 *See id.* at 1028.

68 *See id.*

69 *See id.*

70 *See id.*

71 *Id.*

market."[72] The court insisted that NutraSweet would obtain adequate protection using its overall trade dress instead of a color mark.[73]

Other circuits, including the Federal Circuit,[74] collapsed the color depletion inquiry into the functionality inquiry, the approach eventually adopted by the Supreme Court in *Qualitex*.[75] For example, the Eighth Circuit followed the Federal Circuit in rejecting the color depletion theory as a per se bar in *Master Distributors, Inc. v. Pako Corp.*,[76] reasoning that "[i]t is highly improbable that every distinguishable color shade has already been selected and would be subject to trademark protection."[77] The court determined that a trademark could be granted upon a showing of all of the other requirements of protectability, including

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[72] *Id.* Similarly, in *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 797–99 (3d Cir. 1949), the Third Circuit denied trademark protection to a combination of red and white used on Campbell's soup can labels to prevent Campbell's monopolization of all shades of red in an industry where use of color on a label was the norm. The shades of red employed by the plaintiff and defendant differed, and the defendant used a design of red over white instead of white over red. *See id.* at 798. The court reasoned that the plaintiff was actually seeking exclusivity in their use of labels that are half white and half red for food products. *See id.* The court reasoned that if this were permitted, each competitor would adopt a particular color, resulting in the eventual monopolization of all available colors. *See id.* The Eighth Circuit affirmed a district court opinion denying the validity of a color mark based on a color depletion theory. *See* Deere & Co. v. Farmhand Inc., 560 F. Supp. 85 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983) (per curiam). The court refused to grant Deere a trademark in a particular shade of green used on farm equipment, despite evidence of extensive advertising, because of concerns that doing so would limit the number of colors available to Deere's competitors. *See id.* at 97. In this decision, denial of registrability seems to have turned on the aesthetic functionality doctrine, discussed *infra* Part I.D.2. *See also* Mitek Corp. v. Pyramid Sound Corp., No. 91C20152, 1991 U.S. Dist. LEXIS 16867, at *9 (N.D. Ill. July 9, 1991) ("The essential purpose of trademark law is to prevent confusion, not to bar new entrants into the market. If each of the competitors in the speaker industry were permitted to appropriate a particular color for their speaker, new entrants would be deterred from entering the market. A court cannot begin appropriating certain colors to certain manufacturers as the court would have no way to predict the likelihood of future competitors in the speaker market. While Plaintiff's overall trademark is protected, this court cannot protect the mere color of Plaintiff's speaker.").

[73] *See NutraSweet*, 917 F.2d at 1028.

[74] *In re* Owens-Corning Fiberglas Corp., 774 F.2d 1116 (Fed. Cir. 1985).

[75] Qualitex Co. v. Jacobson Prods. Inc., 514 U.S. 159, 169 (1995).

[76] Master Distribs., Inc. v. Pako Corp., 986 F.2d 219 (8th Cir. 1993).

[77] *Id.* at 225.

secondary meaning.[78] The court added that color depletion does not become a barrier to entry into the market "[u]ntil secondary meaning has been established in every distinguishable shade of color and in no color at all, a highly improbable situation."[79]

The Supreme Court rested its rejection of color depletion as a per se bar on two separate grounds.[80] First, it rejected the proposition because it "relies on an occasional problem to justify a blanket prohibition" because there are often alternative colors available for use by competitors.[81] Second, the court exhibited a preference for the functionality doctrine when issues of color depletion arise.[82] The court reasoned that functionality is available to prevent the anticompetitive consequences that formerly justified use of the color depletion doctrine.[83] Thus, color depletion analysis must be done within the framework of the functionality doctrine.

C. Color & the Fashion Industry

Color is the design element that first attracts a consumer to a particular product.[84] Color not only attracts attention, but also plays a role in whether consumers choose to purchase the item.[85] Since color plays such a significant role in the appeal of a design, the monopolization of a particular color has the potential to have a substantial impact on competition.

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78 *Id.* at 223.

79 *Id.*

80 *Qualitex*, 514 U.S. at 167–68.

81 *See id.* at 168.

82 *See id.* at 169.

83 *See id.*; *see also* Kasco Corp. v. S. Saw Serv., Inc., No. 18,761, 1993 WL 13649606, at *4 (T.T.A.B. June 24, 1993) ("As for the 'color depletion theory,' this is simply 'a variation of the rule against trademark rights in functional features.' . . . Accordingly, in considering the issue of functionality, we will take into account the 'appropriate application' of the color depletion theory or rule." (citations omitted)); *infra* Part I.D (providing a discussion on functionality).

84 Barbara Bloemink, *The New Century of Color*, *in* FASHION IN COLORS 9, 9 (Esther Kremer ed., 2005); DeLong, *supra* note 7, at 280.

85 Color is the "most important aesthetic criterion in consumer preference." DeLong, *supra* note 7, at 282; *see* GINI STEPHENS FRINGS, FASHION: FROM CONCEPT TO CONSUMER 73, 226 (9th ed. 2008).

1. What is Color?

Each wavelength in the visible spectrum corresponds to a distinct hue,[86] and adjusting the brightness or the saturation of a certain hue can create more shades.[87] A color may consist of a single wavelength in the spectrum or a mixture of wavelengths.[88] When mixtures are considered, the number of possible colors that may be created seems infinite.[89] However, not every mixture appears as a discrete color,[90] which limits the number of colors available. A further limitation is that the human eye can recognize hundreds of thousands of colors, but most people cannot retain this knowledge for longer than a few seconds.[91]

2. Meanings Behind Colors

Colors generate specific associations in the minds of consumers that can be harnessed by sellers to influence decision making in the marketplace.[92] Color associations are shaped by both universal and cultural forces, such as religion, mythology, history and popular culture.[93] Universal color associations usually originate in physiological reactions to colors and in symbols found in the natural world. For example, the color red is naturally associated with fire, blood, sexuality and danger,[94] whereas blue is

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86 BLEICHER, *supra* note 6, at 4; JAMES T. ENNS, THE THINKING EYE THE SEEING BRAIN 98 (Jon Durbin & Aaron Javsicas eds., 2004); TOM FRASER & ADAM BANKS, THE DESIGNER'S COLOR MANUAL 34 (2004).

87 EVELYN L. BRANNON, FASHION FORECASTING 164 (2d ed. 2005); FRASER & BANKS, *supra* note 86, at 34, 35.

88 ENNS, *supra* note 86, at 98.

89 *Id.* ("In fact, a large class of color mixtures . . . result in color experiences that cannot even be placed onto the wavelength spectrum. Some purples, for example, result from the mixture of long and short wavelength light; these colors never appear in the rainbow or light bent in some other prism.").

90 *Id.*

91 BRANNON, *supra* note 87, at 163.

92 *See supra* text accompanying notes 6–12.

93 *See* BRANNON, *supra* note 87, at 160–61.

94 "The red breast of the male robin, like the all-over red of the male cardinal, functions as a sexual attraction for the females of the species and as a warning to other males to stay away. Red in reptiles and amphibians is often a sign that the animal is poisonous. Red is also associated with certain parts of the body, such as the lips and genitals, which become engorged with blood during sexual arousal. It is not surprising, then, that within human culture, red clothing and body paint have often functioned as

linked with the sky, sea, and calmness.[95] Some researchers claim that different colors elicit different physiological responses that affect how people perceive objects with those colors. Red, for example, causes rapid breath, increased blood pressure, pulse rate, heart beat, adrenaline flow, and perspiration, all physiological responses demonstrating the color red's automatic link with excitement.[96] Blue, on the other hand, lowers skin temperature, pulse rate, speed of breath and blood pressure, relating to its perceived calming effect.[97]

3. Color Trends

Each season, a fashion line is designed around a particular color theme.[98] Top designers often choose their color story[99] based on their inspiration, but mainstream designers tend to draw at least part of their color stories from trend forecasts[100] to ensure that their lines are within fashion's mainstream.[101] Consumer choice each season is limited to what the industry offers, which is usually limited to those that are within the popular trend.[102] Amongst the available options, color choice is usually guided by

warning signals signifying 'Danger!' and 'Red alert!' and as means of sexual attraction proclaiming, 'Stop!' and 'Look!'" VALERIE STEELE, THE RED DRESS para. 7 (2001).

95 FRASER & BANKS, *supra* note 86, at 20.

96 STEELE, *supra* note 94, para. 2; *see also* BLEICHER, *supra* note 6, at 38; BRANNON, *supra* note 87, at 160.

97 *See* BLEICHER, *supra* note 6, at 38.

98 "The color story might be all brights, or all muted, or a balance of darks and lights. The group may be anchored with neutrals, darks, white, or black." FRINGS, *supra* note 85, at 228.

99 *See* BRANNON, *supra* note 87, at 156 (defining "color story" as the "selected colors that signal the personality of the collection").

100 BLEICHER, *supra* note 6, at 32–33 ("The industry uses color-forecasting services as a barometer to see what's predicted and to develop their own ideas." (quoting designer and FIT faculty member Ellen Lynch-Goldstein)); BRANNON, *supra* note 87, at 158.

101 FRINGS, *supra* note 85, at 228.

102 Akiko Fukai, *The Colors of a Period as the Embodiment of Dreams*, *in* FASHION IN COLORS 12, 15 (Esther Kremer ed., 2005) ("When we choose the clothes that we wear, we are fully convinced that we are selecting the colors that we like. However, in examining the eternal theme of color, it is evident that our color choices are made within the restrictions of a certain period. That is to say, we are limited to the choices offered by the market at any given time; after all, the market itself is strictly controlled by the economics of fashion trends and the structure of the industry.").

the "emotional imagery" behind the colors and by the consumer's desire to express herself with color.[103]

Colors cycle in and out of fashion, starting when a designer first introduces a color.[104] The color is then accepted into the mainstream over time until it saturates the marketplace, after which

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[103] BRANNON, *supra* note 87, at 158.

[104] Author Evelyn L. Brannon provides the following brief description of recent color trends:

> Beginning with the first color forecast for women's apparel in 1917, the cycles in colors can be accurately charted. That first forecast accurately identified the bright purples, greens, and blues show by avant-garde couture designer Paul Poiret, that would move into wider use. These colors were appropriated in the short dresses worn by 1920s flappers as a badge of rebellion against traditional women's roles. In the 1930s, Jean Harlow vamped in slinky white dresses for Hollywood films while those hit hard by the Depression preferred soil-resistant brown. In the late 1930s, Schiaparelli mixed art and fashion and introduced "shocking pink"—a radical repositioning of a traditionally pale color symbolizing sweetness and femininity. The years of World War II brought the withdrawal of dyes and pigments from consumer products.
>
> After the war, pent-up demand for fashion was satisfied in the lavish use of fabrics and more vivid color palettes of the New Look by Dior. For less upscale consumers, the postwar period meant the practical, comfortable look of American fashion epitomized by Claire McCardell—bright-colored clothes, mix-and-match possibilities, and styles for a casual lifestyle. The stability of the Eisenhower era (1953–61) was reflected in the popularity of pastels and American favorites, red and navy blue. With the 1960s came florescent, acid, and hot colors associated with the youth movement and psychedelic drug experiences. In the 1970s, hippies in denim became fascinated with the authenticity of the American Southwest, beginning the domination of earthy colors associated with the region.
>
> The 1970s ended on a bright note influenced by the "punks" with their bold clothing statements and green and purple hair. There color explosion continued into the 1980s with an upscale pastel phase, the postmodern influence of Memphis designers on furnishings, and Nancy Reagan's signature red. Lacroix reintroduced Schiaparelli's pink as a fashion color, but because of the brights and neons of the 1960s, the color that had once been shocking was now perceived as a soft, bright color. . . . The fashion industry pushed colors from gray to red, beige to pink during the 1990s, but consumers clung to the safety, simplicity, and chic of black. In the early 2000s, texture merged with color to create newness as special effects from matte to shiny, and glitter to pearl added dimension to color.

Id. at 168–69 (citations omitted).

consumers move on to the next popular color, and, over time, memory of these colors is diminished and the color may be repositioned for a return to popularity.[105]

D. Color, Fashion & Functionality

Trademark protection is unavailable for functional product features.[106] A product feature may be functional in the utilitarian or the controversial aesthetic sense.[107] Often aesthetic

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[105] For example,

> designer Stephen Sprouse introduced acid shades in the early 1980s but they were not included in the forecast until 1989 because some colors take longer to become trends. By 1995, yellow-green was in every store from Neiman Marcus to Wal-Mart. A color that had been popular as "avocado" and "olive" in the late-1960s, then declined into a cliché for bad taste by the 1980s, had reemerged as kiwi and lime. Helped along by new advances in textiles and dyes, the yellow-green family of colors could be reinvented for an audience of young people who did not remember the originals. Colors and color palettes move from trendy to mainstream. In time, interest in the colors wane, and they are replaced by the next new thing. This mechanism means that colors have somewhat predictable lifecycles. It also means that colors that were once popular can be repositioned in a future season—the harvest gold of the 1970s became the sunflower gold of the 1990s.

Id. at 168 (citations omitted).

[106] Mitchell M. Wong, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 CORNELL L. REV. 1116, 1117 (1998).

[107] The aesthetic functionality doctrine first arose in the 1938 Restatement of Torts:

> A feature which merely associates goods with a particular source may be, like a trade-mark or trade name, a substantial factor in increasing the marketability of the goods. But if that is the entire significance of the feature, it is non-functional; for its value then lies only in the demand for goods associated with a particular source rather than for goods of a particular design.

RESTATEMENT (FIRST) OF TORTS § 742 cmt. a (1938); *see also* Wong, *supra* note 106, at 1133. Under the "identification theory" of aesthetic functionality, a feature is functional if it "renders a product more desirable for any reason other than association with a source or sponsor." *Id.* (citing Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 873 (8th Cir. 1994)). The doctrine was expanded upon in a 1952 Ninth Circuit decision where the court ruled, "[i]f the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright." Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952). Under the court's reasoning, the china patterns were functional because the aesthetic appeal of the design was the benefit consumers were seeking to purchase. *Id.* at 343–44. Other courts rely on the "competition" theory of aesthetic functionality, which

functionality issues arise when trademark protection is sought for a fashion design.[108] Although many circuits have discredited the aesthetic functionality doctrine, the Supreme Court legitimized the doctrine in a 2001 opinion.[109]

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."[110] This test is referred to as the *Inwood* standard, for the case in which it was first articulated.[111] In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,[112] the Supreme Court clarified its discussion of functionality in *Qualitex* by explaining that if a product is not functional according to the *Inwood* definition of utilitarian functionality, courts must consider whether the feature if protected would put competitors at "a significant non-reputation-related disadvantage."[113] The Court added that in cases of aesthetic functionality, it is appropriate to examine competitive need, using *Qualitex* as an example where the Court looked to the aesthetic functionality of the green-gold color of the laundry press pad.[114]

recognizes that a design feature could serve the purposes of source-identification and aesthetic appeal to customers equally. Wong, s*upra* note 106, at 1142–43 (quoting W.T. Rogers Co. v. Keene, 778 F.2d 334, 341–43 (7th Cir. 1985)). Under this theory, courts will look to alternatives remaining in the market, lower cost of the product feature and other anticompetitive effects in the market. *Id*. at 1145–49.

[108] *See* Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, 280 F.3d 619, 641 (6th Cir. 2002).

[109] TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001); *see also* TMEP, *supra* note 44, § 1202.02(a)(iii)(C) (2007) ("Although the references to aesthetic functionality in the *TrafFix* decision are dicta, the Court's use of this terminology appears to indicate that the concept of aesthetic functionality—at least when used properly is a viable legal principle.").

[110] Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850 n.10 (1982); *see also TrafFix*, 532 U.S. at 32; *see also Qualitex*, 514 U.S. at 165.

[111] *Inwood*, 456 U.S. at 851 n.10.

[112] *TrafFix*, 532 U.S. 23.

[113] *Id*. at 32 (quoting *Qualitex*, 514 U.S. at 165).

[114] *See id*. This Supreme Court dictum suggests that the line of aesthetic functionality cases under the "identification" theory may no longer be legally relevant. *See supra* note 107; *infra* text accompanying note 123.

1. Functionality Under the *Inwood* Formulation

A color mark used in a fashion design typically would be nonfunctional under the *Inwood* formulation, as it would most likely not be "essential to the use or purpose" of the design or affect "the cost or quality."[115] For example, in *In re Howard S. Leight & Associates Inc.*,[116] the TTAB held that the color of coral-colored earplugs could not be trademarked because the color of the earplugs was more visible, a safety function.[117] The court reasoned that coral is close to orange, and orange is the color most frequently used for high visibility and to denote safety compliance.[118] Similarly, in *In re Ferris Corp.*,[119] the applicant sought to register the color pink used in surgical wound dressings.[120] Pink, termed "flesh color," was functional because it is one of the best colors available for wound dressings, as it blends in with some skin tones.[121]

2. Competitive Need as Functionality

The appropriate functionality inquiry would be whether allowing exclusive use of that particular color in that same manner would subject competitors to "a significant non-reputation-related

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[115] *Inwood*, 456 U.S. at 851 n.10. There are cases in which clothing may raise this particular functionality issue. For example, clothing colored bright orange, worn in situations requiring high visibility, would be functional in this sense because the color connotes safety. However, the analysis here extends only to clothing and accessories that may be considered "fashion." "Fashion" is defined as "the style or styles most popular at a given time," rather than specialty garments. FRINGS, *supra* note 85, at 62.

[116] *In re* Howard S. Leight & Assocs. Inc., 39 U.S.P.Q.2d 1058 (T.T.A.B. 1996).

[117] *Id.* at 1059–60.

[118] *Id.* at 1060.

[119] *In re* Ferris Corp., 59 U.S.P.Q.2D 1587 (T.T.A.B. 2001).

[120] *Id.* at 1587; MCCARTHY, *supra* note 37, § 7:49; *see also* N. Shore Labs. Corp. v. Cohen, 721 F.2d 514, 523 (5th Cir. 1983) (finding brown coloring of tire repair product functional because color resulted from use of red component that is needed in manufacturing process); Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co., 518 F. Supp. 607, 617 (E.D. Mo. 1981), *aff'd*, 684 F.2d 546, 617 (8th Cir. 1982) (finding black used on ladder treads functional because it hides wear and dirt); *In re* Orange Commc'ns Inc., 41 U.S.P.Q.2d 1036, 1036 (T.T.A.B. 1996) (noting colors orange and yellow used on phone booths are functional because they aid in visibility).

[121] *Ferris*, 59 U.S.P.Q.2d at 1591.

disadvantage."[122] In the context of the fashion industry, such an argument would center on whether allowing one designer to monopolize a single color used in a particular manner puts its competitors at a disadvantage because the available colors are limited or that color has a particular significance in the industry. That color must be proven to be special in some way that makes it a part of a smaller pool of available colors.[123]

The Sixth Circuit has read the Court's language in *TrafFix*[124] as favoring the competition theory of aesthetic functionality, stating that "[b]ecause the Supreme Court has never intimated that aesthetic functionality should be evaluated in a manner consistent with the identification theory and has repeatedly followed the competition theory's approach in addressing the second form of functionality . . . we expressly adopt the competition theory of functionality."[125] Similarly, the Ninth Circuit has held that "design decisions . . . made for aesthetic reasons—and not, for example,

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[122] TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 32 (2001) (quoting *Qualitex*, 514 U.S. at 165).

[123] *See* Minn. Mining & Mfg. Co. v. Beautone Specialties, Co., 82 F. Supp. 2d 997, 1003 (D. Minn. 2000). In the *Beautone* case, manufacturer 3M sought protection of the color "canary yellow" used on its Post-It notes. *Id.* at 999. The defendant argued that canary yellow was superior to other colors that could be used for sticky notes because of its "cost, legibility, conspicuity, eyestrain reduction, gender-neutrality," aesthetic qualities and photocopyability. *Id.* at 1001. 3M, however, argued that these criteria were not all relevant to customer demand for sticky notes, producing evidence that canary yellow is not superior to other colors, including expert testimony that other shades of yellow are equally viable. *See id.* at 1001–02. 3M also showed that the cost advantage resulted from "volume-driven discounting practices and production efficiencies of paper manufacturers, not by any specific cost savings inherent in canary yellow paper." *Id.* at 1002. The court determined that the functionality issue was inappropriate for summary judgment because "3M has introduced evidence . . . that any number of colors perform the job as well as or better than canary yellow and that protecting canary yellow via trademark law will foreclose defendants from nothing other than their ability to trade on the good reputation of the 3M POST-IT brand." *Id.* at 1003.

[124] *TrafFix*, 532 U.S. at 33 ("It is proper to inquire into a 'significant non-reputation-related disadvantage' in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.").

[125] Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, 280 F.3d 619, 641 n.16 (6th Cir. 2002).

because they were the only, the cheapest, or the most efficient way to design a pool hall—is evidence of nonfunctionality."[126]

Courts have recognized the distinction between color marks used on products purchased for their aesthetic appeal and products where aesthetic appeal may be important, but is not a primary consideration.[127] Although a court has not yet considered the competitive need for a particular color used in the fashion industry, it has done so in the context of other industries where aesthetic appeal is also considered important, such as home decorating.[128] In *L.D. Kichler Co. v. Davoil, Inc.*,[129] the Federal Circuit looked to the aesthetic appeal of a color used in household furnishings in assessing whether a color mark was functional.[130] Kichler

[126] Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1260 (9th Cir. 2001) (holding that the design of a pool hall was nonfunctional because it did not limit the design alternatives available to competitors).

[127] See, for example, *White Consolidated Industries, Inc. v. Royal Appliance Manufacturing Co.*, No. 107,081, 2000 WL 713972 (T.T.A.B. May 31, 2000), in which the TTAB considered whether the color red used on vacuum cleaners was functional. The opponent argued that there was competitive need for use of the color red because "for many years, manufacturers, including applicant, have chosen red because that color calls attention to the product in a marketing environment." *Id.* at *4. The opponent claimed that red was unique in the marketplace because "'[i]t's a hot, action color. . . . [that is really] nice to use if . . . you want your product to really stand out on the shelf, because it attracts the eye.'" *Id.* (citations omitted). The opponent added that competitive need resulted from the potential for red to become more popular in the future, "' . . . if all of a sudden there was a phase where red became very popular . . . this would put us at an unfair disadvantage if we did not have the ability to use red and it became popular over an extended period of time.'" *Id.* (citations omitted).

The TTAB rejected this argument because the record did not show any competitive need on the part of other manufacturers, noting that "merely because a red color may have certain visual appeal when applied to hand-held vacuum cleaners does not mean that the color red is de jure functional when applied to those goods." *Id.* The TTAB noted that

> [t]his is not a situation where the color of the product is important to a consumer for its visual properties as it would be in such products as carpeting, living room furniture or clothing. We have no evidence that consumers have a need, or even a desire, to own a hand-held vacuum cleaner in any particular color. Some vague expectation that the color red might become "popular" at some unidentifiable point in the future is far from sufficient to demonstrate the existence of a "significant" competitive disadvantage.

Id. at *5 (emphasis added).

[128] *See* BRANNON, *supra* note 87.

[129] L.D. Kichler Co. v. Davoil, Inc., 192 F.3d 1349 (Fed. Cir. 1999).

[130] *Id.* at 1353.

received a trademark for its "Olde Brick" finish, composed of several distinct colors applied to light fixtures, which was commercially successful due to its compatibility with interior designs.[131] Kichler claimed that Quorum, a competitor, sold fixtures decorated with a confusingly similar color called "Cobblestone."[132] The district court granted summary judgment, ruling that "Olde Brick" was "de jure functional" due to its compatibility with interior furnishings.[133] The Federal Circuit reversed, holding that "Olde Brick" would be functional and, therefore, unworthy of trademark protection only if there were a competitive need for others to use it as well, as demonstrated by a showing that it is "one of the few colors that are uniquely superior for use in home decorating."[134] This standard would likely be that applied in the fashion industry, as well, because of similar trends in color usage.[135]

II. CONFLICT

Although the law typically treats clothing as being functional in nature,[136] consumer choices tend to be based on aesthetics.[137] The reality of the fashion industry is that people do not simply replace their clothes when the old ones wear out, but instead purchase clothing based on trends and styles that they like.[138] One argument for prohibiting designers from owning color marks is that the aesthetic appeal of certain colors is greater than that of others when used in fashion designs, and allowing a monopoly over those colors puts competitors at a disadvantage. If color depletion is shown to be a genuine risk, the color mark is functional and cannot be protected using the trademark laws.

A. Designer Christian Louboutin Obtained a Trademark on His

131 *Id.* at 1351.
132 *Id.*
133 *Id.* at 1352.
134 *Id.* at 1353.
135 Bloemink, *supra* note 84.
136 *See supra* Part I.
137 *See* Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 1006 (2d Cir. 1995).
138 *See id.*

Shoe's Lacquered Red Soles

In early 2008, the trademark office granted Christian Louboutin a trademark for lacquered red soles,[139] which he has used continuously as a feature of his shoe designs since 1992.[140] In his trademark application, Louboutin claimed that the soles were not functional in the utilitarian sense because "[t]he red sole is not a by-product of the manufacturing process; adding red lacquer to the soles of the shoes is more expensive than producing lacquer-less soles."[141] Louboutin explained that he selected red "because it is engaging, flirtatious, memorable, and the color of passion . . . [and] attracts men to the women who wear my shoes."[142]

Louboutin also claimed that the red soles were primarily source-identifying and distinctive in nature:

> The shiny red color has no function other than to identify to the public that the shoes are mine. . . . The red-soled shoes were an immediate sensation, and clients specifically came in to my stores looking for my red-soled shoes. The red sole quickly became my signature. My footwear is instantly recognizable by the immaculately lacquered red soles; upon seeing the red sole of the shoe, because it is so well known, people know that the shoes are designed by me.[143]

Louboutin's shoes are often photographed on the feet of countless celebrities featured in images found in tabloids and similar websites, often with text discussing their fashions.[144]

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139 U.S. Trademark No. 3,361,597 (registered Jan. 1, 2008).

140 U.S. Trademark Appl. No. 77,141,789 (filed Mar. 27, 2007).

141 *Id.* at Declaration ¶ 3.

142 *Id.*

143 *Id.*

144 *See* Cindy Clark, *Christian Louboutin's Red-Soled Shoes are Red-Hot*, USA TODAY, Dec. 25, 2007, at 8D, *available at* http://www.usatoday.com/life/lifestyle/fashion/2007-12-25-louboutin-shoes_N.htm ("Though many people can't pronounce his name (Lu-bu-TAHn), his signature red sole is instantly recognizable. 'I definitely think Christian is, for lack of a better word, the hottest shoe designer that there is out there,' says Filipa Fino, senior accessories editor at *Vogue* magazine. 'He has captivated not only the socialite market but also Hollywood, and it is really the 'it' shoe to own right now.' The red sole 'has given him an edge, because it's a visible touch that brands him. Women

Louboutin's shoes also receive editorial coverage in fashion magazines and are sold in his own boutiques and department stores.[145]

B. Possible Defense to Infringement—Allowing Color Marks Would Deplete the Number of Colors Available to Competitors

No United States court has heard a case challenging a color mark used in fashion designs, although such a case may arise in the near future.[146] An opponent to a color mark used in fashion design may attempt to resurrect the color depletion argument. Color marks used in the fashion industry are distinguishable from marks that have arisen in many other contexts because the aesthetic appeal of the design, particularly the color, often drives sales, and because the industry is driven by trend cycles.[147] The Supreme Court has already held that color depletion is not a per se bar, but is, instead, a part of the functionality inquiry. Therefore, an opponent would have to show that the color is a functional aspect of the design by showing that the color is the best or one of a few superior colors available for use.[148]

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tend to feel others notice, and it's a way of saying you've got the shoe.'"). His shoes have been the subject of numerous other mainstream newspaper and fashion editorial coverage. *See, e.g.*, Patrick Huguenin, *Christian Louboutin's Skyscraper Stilettos Take City by Storm*, N.Y. DAILY NEWS, Mar. 17, 2006, http://www.nydailynews.com/lifestyle/2008/03/17/2008-03-17_christian_louboutins_skyscraper_stiletto.html.

145 Huguenin, *supra* note 144.

146 A French court heard such a case in *Christian X v. Paciotti SPA*, (2007) 06 / 06228 (Tribunal De Grande Instance De Paris), *available at* http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000018858029&fastReqId=1014124305&fastPos=1. *See* Juliette Robin, *Christian Louboutin c/ Cesare Paciotti*, TGI PARIS, Dec. 5 2007, http://translate.google.com/translate?u=http://www.ip-talk.fr/%3Fp%3D241&sl=fr&tl=en&hl=en&ie=UTF-8 (providing a discussion, translated into English, of the *Christian X* decision). In this decision, the court refused to bar one of Louboutin's competitors, shoemaker Cesare Paciotti, from also applying red soles to his shoes. *Id.* The court determined that red soles have been used on shoes for centuries, Louboutin's informed consumers would not think that Paciotti's shoes were created by Louboutin, Paciotti shoes have a dagger and "Paciotti" label on the sole to prevent confusion. *Id.*

147 *See supra* Part I.C.3.

148 The color need not be "essential" for competition. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531 (Fed. Cir. 1994). *See generally* Brief for Defendant-Appellee Davoil, Inc., L.D. Kichler Co. v. Davoil, Inc, No. 98-1488, 1998 WL 34300944 (Fed. Cir. Nov. 02, 1998).

1. The Number of Available Colors is Limited by Fashion Industry Conventions

For a signature color to be identified with a brand, the designer would have to use it consistently through all seasons. However, colors used in fashion designs are often considered seasonal—earth tones for fall, jewel tones for holidays, pastels for spring and whites for summer.[149] As a result, there are limited colors that consumers identify with all seasons. The colors used as marks may be limited to those colors to blend with the consumer's seasonal wardrobe, as well as the designer's seasonal collection.[150] If a designer varied the color according to the season to be compatible with the seasonal palette, no color would become identified with the brand to provide the distinctiveness sought by the designer.

Red is one of very few colors used in every season.[151] Opponents to Louboutin's red mark might argue that they are placed at a competitive disadvantage when left with the few remaining colors that are color compatible with different palettes and designs besides neutral colors and black. Further, if other shoe designers follow suit and obtain color marks for use of the remaining colors on the soles of their designs, the pool of available colors would be depleted, putting the excluded designers at a competitive disadvantage and deterring new designers from entering the market because they will not be able to use colors that consumers find appealing.

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149 FRINGS, *supra* note 85, at 226.

150 This argument is equivalent to the color compatibility argument discussed in *Kichler*, 192 F.3d 1349 and *Brunswick*, 35 F.3d 1527. In *Kichler*, the Federal Circuit clarified that color compatibility is insufficient to show functionality without a showing that protecting the mark permits the mark's owner "'to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.'" *Kichler*, 192 F.3d at 1353 (quoting Qualitex v. Jacobsen Prods., 514 U.S. 159, 170 (1995)). In *Brunswick*, the Federal Circuit held that the use of black on outboard boat motors was functional because black is a color compatible with many different boat colors and has the ability to make objects seem smaller. *Brunswick*, 35 F.3d at 1531.

151 FRINGS, *supra* note 85, at 227.

Due to color cycles in fashion, the number of colors available are limited to those that are trendy at a particular time.[152] Competitors might argue that colors that are to be used as marks in the fashion industry must be capable of withstanding trends, and such colors are in limited supply.[153] These colors are often considered limited to black, white, red, navy and ivory.[154] Colors that come in and out of style are undesirable because of the potential that goods bearing the color mark will sell poorly after consumers become tired of the color.[155] Conversely, when a designer develops distinctiveness in a particular color, competitors are at a disadvantage when that color becomes fashionable.[156] Competitors would be excluded from using the color in the manner protected by the mark.[157]

2. Certain Colors are Functional Because They Have Developed a Particular Meaning Within the Industry

Competitors may also argue that a color is unworthy of protection because it has been used frequently or traditionally in that same context, so protecting the mark provides an unfair competitive advantage to the mark owner.[158] A color whose meaning suggests that it would be a natural choice for that particular purpose might not be afforded trademark protection. The Seventh Circuit held in *Publications International, Ltd. v.*

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[152] BRANNON, *supra* note 87, at 158; Fukai, *supra* note 102, at 15.

[153] BRANNON, *supra* note 87, at 191–92 (referring to certain colors being able to withstand trends).

[154] *Id.*

[155] *See id.*

[156] This argument was posed in *White Consolidated Industries, Inc. v. Royal Appliance Mfg. Co.*, No. 107, 081, 2000 WL 713972, at *1 (T.T.A.B. 2000). *See supra* note 127.

[157] The converse of this point is that when there is a backlash against that color, it will be felt more strongly by the designer who owns a mark in that color because consumers will be tired of it. *See* BRANNON, *supra* note 87, at 192.

[158] For example, courts have denied protection for colors used in holiday items when those colors are frequently associated with a particular holiday. *See* MCCARTHY, *supra* note 37, § 7:49 (citing Aromatique, Inc. v. Gold Seal, 28 F.3d 863 (8th Cir. 1994) (finding red and green cords not protectable "because such colors are traditionally used for products relating to Christmas and are therefore neither distinctive nor nonfunctional")).

Landoll, Inc.,[159] that gold edges on a cook book were aesthetically functional. The purported purpose of the coating was to prevent bleeding, a purpose that could have been accomplished by using any uniform color on the edges.[160] The court held that the color gold played "'an important role (unrelated to source identification) in making a product more desirable'" because

> [g]old connotes opulence, and so is a standard element of the décor of food products, such as chocolate, that are valued for their rich taste rather than for their nutritional value. It also has a long history of use in bookbinding; the spine of the book in which this opinion is printed is decorated with gilt. Gold is a natural color to use on a fancy cookbook.[161]

Instead, a different color would have been a more likely source signifier.[162] The court cited the example of a blue orange juice carton as opposed to an orange carton.[163]

Certain colors have established a particular meaning in fashion over time.[164] In determining whether a particular color is a natural color for that purpose, competitors would draw their arguments

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[159] Publ'ns Int'l, Ltd. v. Landoll, Inc., 164 F.3d 337, 342 (7th Cir. 1998), *cert. denied*, 526 U.S. 1088 (1999); *see also* Sabert Corp. v. Ullman Co., 53 U.S.P.Q.2d 1597, 1601 (S.D.N.Y. 1999), *aff'd without pub. op.*, No. 00-0732, 2000 U.S. App. LEXIS 13553 (2d Cir. June 8, 2000) ("If this court were to uphold plaintiff's trade dress, it could potentially result in a permanent monopoly for plaintiff in the specialized market for disposable Platters designed to imitate the look of real silver and gold.").

[160] *Publ'ns Int'l*, 164 F.3d at 342.

[161] *Id.* (quoting Qualitex Co. v. Jacobsen Prods. Co., 514 U.S. 159, 165 (1995)).

[162] *Id.*

[163] *Id.*

[164] *See* Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC, 369 F.3d 1197, 1205–06 (11th Cir. 2004), *cert. denied*, 543 U.S. 1054 (2005) (ice cream colors are functional because they indicate flavor); Warner Lambert Co. v. McCrory's Corp., 718 F. Supp. 389, 396 (D. N.J. 1989) (finding the color of Listerine functional because "the amber color has taken on a particular significance in the mouthwash industry" and because "[a]n amber liquid signifies an unflavored, medicinal mouthwash. . . ."); Nor-Am Chem. Co. v. O. M. Scott & Sons Co., 4 U.S.P.Q.2d 1316, 1320 (E.D. Pa. 1987) (finding the blue coloring of nitrogen fertilizer functional because blue is used in the scientific community to denote nitrogen).

from color associations made by consumers[165] and designers.[166] As a result of its natural and cultural associations, red has developed symbolism in fashion relating to sensuality and luxury.[167] Other colors have developed meanings tied to their use in fashion as well. For example, purple was historically reserved for monarchs in the middle ages because it was so rare and expensive.[168] Today, purple represents wealth and dignity.[169] Competitors would stress that not being able to communicate these same color associations would put them at a disadvantage in the marketplace.

III. ARGUMENT: COLOR MARKS USED IN THE FASHION INDUSTRY ARE NONFUNCTIONAL AND UPON A SHOWING OF SECONDARY MEANING SHOULD BE AFFORDED TRADEMARK PROTECTION

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[165] "However, no matter how restricted our choices may be, the colors of the clothes that we wear on a day-to-day basis represent the easiest and most effective way for us to express a range of different feelings—our hopes, desires and emotions." Fukai, *supra* note 102, at 15.

[166] *See supra* note 141 and accompanying text.

[167] Red's strong symbolism was described in Valerie Steele's book *The Red Dress:*

> Red is strongly associated with sexuality, especially female sexuality. In the movie *Jezebel*, Bette Davis's character shocked everyone by wearing a scarlet dress to a debutante ball when all the other girls wore virginal white. In Nathaniel Hawthorne's novel *The Scarlet Letter*, the adulterous Hester Prynne is forced to wear the letter 'A' on her dress. . . . Throughout much of recorded history, the high cost of producing red dyes meant that red clothing was worn only by those with power and status. Medieval and Renaissance portraits frequently depict aristocrats and important officials in what were literally rich red garments. . . . In medieval Europe, there was a certain type of luxury fabric called "scarlet," a name that indicates that the cloth was worth the expense of being dyed bright red. In some European societies, only princes were allowed to wear gold and red. . . . Although clothing colors are no longer governed by sumptuary laws and red is no longer particularly expensive to produce, it is still regarded as a prestigious color.

STEELE, *supra* note 94, at Introduction paras. 3, 8.

[168] Bloemink, *supra* note 84, at 9.

[169] FRINGS, *supra* note 85, at 227.

A color mark only excludes competitors from using the mark in the same manner as the mark's owner.[170] Competitors may still use the color in different ways or use a different color in the same way. In Louboutin's case, his mark only prevents other designers from using a confusingly similar shade of red on their shoe soles.

A. Functionality

To prove that the color mark is functional, opponents would have to show that not being able to use the mark would put them at a "significant non-reputation-related disadvantage."[171] The Sixth Circuit considered competitive need for a feature of a fashion design in *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*:

> [If] these design features are 'something that other producers of [casual clothing] have to have as part of the product in order to be able to compete effectively in the market. . . [it is not] the kind of merely incidental feature which gives the brand some individual distinction but which producers of competing brands can readily do without.'[172]

Opponents would have to prove that that there is a market for red-soled shoes unrelated to Louboutin's reputation.[173] If there is

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[170] *See* MCCARTHY, *supra* note 37, § 7:49; *supra* Part I.B.1 for a discussion on color marks.

[171] *See supra* note 123; *see also* Part I.D.1 for a discussion on functionality.

[172] Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, 280 F.3d 619, 643–44 (6th Cir. 2002). In *Abercrombie*, the Sixth Circuit refused to allow trade dress protection to Abercrombie's clothing designs because protection "would leave competitors at a significant non-reputational competitive disadvantage and would, therefore, prevent effective competition in the market." *Id.* at 643. Abercrombie sought to protect certain words used as designs on its garments, such as "performance," which it claimed conveyed the active nature of the clothing, and others they claimed conveyed the reliability of the clothing, such as "authentic," "genuine brand," "trademark" and "since 1892." *Id.* Abercrombie argued for protecting these words used in conjunction with its trademarks and clothing bearing "'primary color combinations. . . in connection with solid, plaid and stripe designs'" and made from 'all natural cotton, wool and twill fabrics.'" *Id*. The court denied protection, refusing to grant Abercrombie a monopoly over its selected words, as "[t]he English language currently contains a limited list of synonyms for reliable and other words that convey a product's integrity." *Id.*

[173] In *California Board Sports, Inc. v. Vans, Inc.*, No. 06CV2365 IEG(AJB), 2007 WL 3276289, at *7 (S.D. Cal. 2007), the court explained:

evidence that other designers' red-soled shoes are purchased because of the status associated with owning a pair of Louboutin's shoes, then the red soles are nonfunctional, and worthy of trademark protection if they have acquired secondary meaning.[174]

The functionality inquiry raises the question of what drives sales of red-soled shoes. Even if at first the excitement generated by the red soles drove sales, the distinctiveness and luxury status of the shoes and Louboutin's brand have arguably taken over.[175] It is not always aesthetics that directs consumers towards certain fashion designs. Clothing purchases are also driven by the message they send about the purchaser.[176] Fashion is a means to communicate with others—through the design itself or the display of logos and insignia.[177] Wearing the latest fashions is an effective way to signal one's socioeconomic status to others,[178] since what one wears can express purchasing power to peers and society at large.[179]

> While Plaintiff has set forth evidence that the checkerboard pattern is widely used in fashion generally and hence desirable as an available shoe pattern, Plaintiff has not connected the protection of the checkerboard pattern with competitive consequences by, for example, introducing evidence that consumers have an affinity for the checkerboard pattern unrelated to Defendant's use of the pattern on its shoes. Defendant's evidence that the checkerboard design on casual and sports shoes acts as a source identifier for Defendant, and its related evidence of the significant recognition Defendant's brand name has received, when viewed in the light most favorable to Defendant, creates a genuine issue as to whether the alleged disadvantage to competition associated with protection of the checkerboard pattern would be related to Defendant's reputation. *In other words, Defendant's evidence supports a plausible case that the checkerboard pattern's appeal to consumers comes primarily from its association with Defendant's shoes and the reputation or prestige associated with owning one of Defendant's shoes.* At trial, Plaintiff is free to rebut this case with its own evidence that consumers who buy shoes adorned with a checkerboard pattern do so for reasons unrelated to a desire to own Defendant's product.

Id. (citations omitted).

174 *Id.*

175 See *supra* Part II.A for a discussion of the brand's fame and prestige.

176 *See* JAMES B. TWITCHELL, LIVING IT UP: OUR LOVE AFFAIR WITH LUXURY 60 (2001).

177 *See* Raustiala & Sprigman, *supra* note 2, at 1719.

178 *See* TWITCHELL, *supra* note 176, at 94.

179 *Id.* at 97.

Many consumers are influenced by their peers in what they choose to wear.[180] Interpersonal communications with peers, combined with influence from other social systems and media outlets strongly shape consumer choice.[181] Luxury goods, including designer clothing and accessories, are positional goods—goods whose values are linked to the perception of others.[182] In the clothing market, luxury brands, such as Chanel or Louis Vuitton, confer exclusivity and prestige, but this message arises only when such items are out of the reach of broader clientele.[183]

In *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc,*[184] the Ninth Circuit considered the functionality of status-conferring logos. In that case, the defendant produced and sold automobile accessories bearing the plaintiffs' trademarks.[185] The court acknowledged that the value consumers often purchase is in the logo itself and not necessarily in its association with the mark's owner:

> Famous trademarks have assumed an exalted status of their own in today's consumer culture that cannot neatly be reduced to the historic function of trademark to designate source. Consumers sometimes buy products bearing marks such as the Nike Swoosh, the Playboy bunny ears, the Mercedes tripoint star, the Ferrari stallion, and countless sports franchise logos, for the appeal of

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[180] One study showed that verbal communication with one's peers was highly effective in shaping a woman's fashion decisions. *See* YUNIYA KAWAMURA, FASHION-OLOGY: AN INTRODUCTION TO FASHION STUDIES 75 (2004). The women in the study responded most strongly to reactions of their friends and acquaintances, and to women much like themselves. *Id.* The study showed that women receiving admiration or approval from their peers would continue to wear similar fashions, while disapproval or other unfavorable responses prompted a change in dress. *Id.*

[181] *Id*. at 79. As individuals perceive the design choices of their peers, as well as those depicted in television, film and magazines, they evaluate their own design choices, questioning, "Am I fashionable?" *Id.* at 102.

[182] Raustiala & Sprigman, *supra* note 2, at 1719.

[183] *Id*.

[184] Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc., 457 F.3d 1062 (9th Cir. 2006).

[185] *Id*. at 1065.

> the mark itself, without regard to whether it signifies the origin or sponsorship of the product.[186]

However, the court reiterated that "the mere fact that the mark is the 'benefit that the consumer wishes to purchase' will not override trademark protection if the mark is source-identifying."[187] Therefore, even if consumers wish to purchase red-soled shoes to follow a trend, their choices do not strip the mark of its secondary meaning.[188] Even if consumers would purchase any shoe with a red sole, if Louboutin can show that the status of the color originates in his brand, the color is more likely nonfunctional.

Functionality arising from color associations requires proof of a nexus between the meaning conveyed to consumers using the color and increased sales of the product bearing the color.[189] In *In re Hudson News Service*,[190] the TTAB rejected an argument that a blue color mark in the decoration of a store was functional because of the psychological effect it had on customers.[191] The examining attorney, who rejected the trademark application, contended that the marks consisted primarily of the color blue, and that there was competitive need for the color because it created a calming, soothing atmosphere, which competitors should be able to create as well.[192] The examining attorney based the decision on news

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186 *Id.* at 1067.

187 *Id.* at 1069 (quoting Vuitton Et Fils S.A. v. J. Young Enters., Inc., 644 F.2d 769, 774 (9th Cir. 1981)).

188 "In practice, aesthetic functionality has been limited to product features that serve an aesthetic purpose wholly independent of any source-identifying function." *Id.* at 1073.

189 *In re* Hudson News Co., 39 U.S.P.Q.2d 1915, 1920 (T.T.A.B. 1996). Although early cases suggest otherwise, these cases have been criticized by commentators for their lack of grounding in psychological evidence. *See* MCCARTHY, *supra* note 37, § 7:49. For example, in a 1959 decision, the Second Circuit suggested that the pink color of a stomach remedy may be considered functional because of the psychological soothing effect of the color. *See* Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569, 572 (2d Cir. 1959), *cert. denied*, 362 U.S. 919 (1960). Similarly, in a 1955 decision, a federal district court held that the use of pastel colors was functional because their use was intended "to create a mental impression that the tissues are soft as baby's or baby skin and soft enough for use upon infants and children; and if so soft, then certainly soft enough for milady's face." *See* Doeskin Prods., Inc. v. Levinson, 132 F. Supp. 180, 184 (S.D.N.Y. 1955).

190 *In re Hudson*, 39 U.S.P.Q.2d at 1915.

191 *Id.* at 1919–20.

192 *Id.*

articles discussing color associations, but the TTAB considered the examining attorney's reliance on such materials misplaced, stating:

> Even if we were to accept as a fact that blue is a soothing color, we do not see why a blue interior necessarily is beneficial to a retail newsstand. In this connection, there is no evidence to even suggest that a newsstand (or any retail store) with a blue interior would attract more customers and/or increase sales. That people are soothed by or feel good in a blue environment does not necessarily mean that these people, as customers in applicant's newsstand, will buy more products.[193]

In light of In re Hudson News Co., an opponent to a color mark who wished to argue that the number of colors available is limited due to the psychological impact of those colors would have to show that the color had a psychological effect on consumers and that effect provided the mark owner with a competitive advantage. In Louboutin's case, that would mean a showing that the color red and the feelings of excitement, sensuality or danger associated with it are directly linked with increased shoe sales.

B. Secondary Meaning & Depletion

The color depletion theory rests on the idea that there are a limited number of colors appropriate for a product, and allowing one manufacturer to monopolize one of the available colors is anticompetitive.[194] However, mere use of a particular color is not enough to obtain trademark protection—the manufacturer's use of the color must also have secondary meaning.[195]

Often when courts determine that a color used in a natural or traditional manner is functional they do not clearly distinguish between the functionality and distinctiveness inquiries.[196]

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193 *Id.* at 1920.

194 *See, e.g.*, Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir. 1948), *cert. denied*, 338 U.S. 847 (1949); *see also supra* Part I.B.3.

195 Master Distribs., Inc. v. Pako Corp., 986 F.2d 219, 224 (8th Cir. 1993).

196 This might be due to the greater expense and factual findings needed to determine the distinctiveness of a particular color.

Although the two inquiries may be based on overlapping evidence, the functionality of a feature is not directly related to its source-identifying role.[197] An item can still be aesthetically pleasing to consumers and be source-identifying.[198] If a color is one that is naturally or traditionally used for a particular purpose, then distinctiveness will likely arise as an issue, and may prevent protection of a color mark.

Secondary meaning is particularly difficult to obtain in fashion designs due to the seasonal nature of the fashion industry. Fashion is constantly changing,[199] and fashionable colors change season to season much like any other fashion trend.[200] Designers use different colors to reinvent basic designs season to season.[201] In trying to keep up with the latest trends, designers will be less inclined to invest in a single color used over several seasons.[202] Trends are becoming increasingly short-lived,[203] so colors are changing with greater frequency. In such a context, when a fashion designer uses the same color consistently over a period long enough to obtain secondary meaning, the color's

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197 Clicks Billiards v. Sixshooters, Inc., 251 F.2d 1252, 1260 (9th Cir. 2001).

198 *Id.*

199 FRINGS, *supra* note 85, at 62–63 ("What makes fashion interesting is that it is always changing. Designer Karl Lagerfeld said, 'What I like about fashion is change. Change means also that what we do today might be worthless tomorrow, but we have to accept that because we are in fashion. There's nothing safe forever in fashion. . . .' Vera Wang tells her assistants, 'If you're afraid of change, you're in the wrong business.'").

200 *See supra* Part I.C.3.

201 BRANNON, *supra* note 87, at 156–57; Oliver Horton, *Upping the Color Quotient*, INT. HERALD TRIBUNE, Oct 1, 2008, http://www.iht.com/articles/2008/10/01/style/rcolor.php.

202 BRANNON, *supra* note 87, at 156.

203 "When dye technology permitted making only a few colors, fashion colors persisted for decades and developed deep symbolic associations. Now it is possible to dye any color, and the multiplicity of colors leads to seasonal change and color meanings that are more ephemeral." BRANNON, *supra* note 87, at 161 (citations omitted). "'Because fashion is so rapid. . . trends are more about catching the eye. So you had bright yellow in summer '08 because the chemists could do yellow really fast. That's not a sensible trend, it hasn't taken time to evolve.'" Horton, *supra* note 201 (quoting Jackie Nash of forecasting agency Global Color Research). "Fashion cycles are faster, and designers want help scoping out competitors' designs, discovering trends, experimenting with colors and fabrics and mocking up designs." Claire Cain Miller, *Fashion Designers Go Online for Latest Trends*, INT. HERALD TRIBUNE, Sept. 8, 2008, http://www.iht.com/articles/2008/09/08/technology/trend.php; *see also* FRINGS, *supra* note 85, at 62–63.

distinctiveness is enhanced by comparison with other designers' changing colors.

C. Color Associations in Fashion are Weak

Throughout history, colored dyes were costly and difficult to obtain. Since they were used so infrequently, they developed deep, symbolic associations.[204] When there were fewer colors available, those colors remained in the marketplace for longer periods, and colors were more likely to develop strong associations within fashion.[205] More recent innovations in synthetic dyes have made colored textiles less expensive and more readily available.[206] Today, consumers are seeing more color options than they did in the past, as designers are using a greater variety of colors,[207] and choosing them less consistently with traditional seasonal color palettes.[208] Since trends have become more fleeting and more colors are available,[209] color meanings have become less influential,[210] and should not be relied upon to determine the functionality of a color used in fashion designs.

Courts have rejected the color depletion theory based on the ever-increasing number of colors available. In *DAP Products v. Color Tile Manufacturing, Inc.*,[211] the court held that color depletion is not a persuasive theory in light of available contemporary technology. There are myriad colors and shades

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[204] Bloemink, *supra* note 84, at 9.

[205] BRANNON, *supra* note 87, at 161–62. Even as recently as the mid-20th century, a single color could saturate the market, generating strong symbolic associations. *Id.*

[206] *Id.* at 161.

[207] Horton, *supra* note 201 ("'Consumers are now seeing 10 to 15 colors where before they saw five,' said Martin Raymond, co-founder of the Future Laboratory, a consulting agency in London. This season, for example, alongside subdued blacks and charcoals for autumn, retailers are carrying purple, bold reds and blues, forest green and muted oranges. And that's just the knitwear."); *see also* BRANNON, *supra* note 87, at 161–62 ("But today four or five major color stories emerge at the same time—a reflection of the diversity among eth[n]ic groups and consumer generations. Today's consumer is more eclectic appreciating 'sophisticated' colors (those created by a complex mixture of pigments), offbeat combinations, and color effects like translucence, pearlescence, and metallics.") (citations omitted).

[208] *See* FRINGS, *supra* note 85, at 226.

[209] *See id.*

[210] *Id.*

[211] DAP Prods., Inc. v. Color Tile Mfg., Inc., 821 F. Supp. 488 (S.D. Ohio 1993).

available for products today that were certainly not available in the past. This, coupled with the reasoning of the *Owens-Corning* court and the broad language of the Lanham Act, led this court to conclude that the color depletion theory should not be applied in this case.[212]

Designers also have the power to change color associations. For example, in the 1920s black clothing was transformed from a symbol of mourning to a symbol of elegance and glamour by Chanel's little black dresses.[213] Designers could capitalize on weakening color associations amongst consumers and add distinctiveness to their goods by using colors that are unexpected. In doing so, depletion is no longer a danger. For example,

> [t]raditional rules of what colors are considered most inherently 'appetizing' no longer apply. The color blue rarely occurs in nature, and almost never from edible organic sources. In the past, if your meat or cheese turned blue, it indicated that it was rotting and no longer healthy to eat. Currently, however, tomato catsup comes in bright blue, purple, and green as well as red; M&M's has introduced blue into its traditional candy palette; and electric-blue coloring is regularly found in carbonated and high-energy drinks, ice cream, and snacks.[214]

These changes mean that designers are able to create color associations with their own brands or their own meanings.

CONCLUSION

Using color marks, designers could add distinctiveness to their designs, and limit others' ability to copy the designs, without the use of a visible logo. Although opponents may raise color depletion concerns arising out of trends and seasonal color palettes, the reality of the fashion industry is quickly changing. Designers

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212 *Id.* at 495.

213 Bloemink, *supra* note 84, at 10.

214 *Id.* at 11.

are no longer adhering to traditional color rules, and colors are moving in and out of fashion even faster. As a result, colors are losing their long-felt associations in the minds of consumers. Depletion is even less likely in light of these abbreviated trends, because designers are less likely to develop secondary meaning in particular colors if they are constantly changing. When a designer uses a color consistently enough to be identified with his brand, the fashion cycle takes over. Thus, when the color is emulated, it is because of the connection to the designer's status, making the color mark inherently source-identifying.