

2014

Red Touches Black: The First Application of Maker's Mark and Louboutin in the Context of Color Trademarks

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Recommended Citation

Green, Ashley E. "Red Touches Black: The First Application of Maker's Mark and Louboutin in the Context of Color Trademarks."
American University Journal of Gender Social Policy and Law 22, no. 4 (2014): 981-1006.

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RED TOUCHES BLACK: THE FIRST APPLICATION OF *MAKER'S MARK* AND *LOUBOUTIN* IN THE CONTEXT OF COLOR TRADEMARKS

ASHLEY E. GREEN*

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I. INTRODUCTION

As a general rule, design features that are considered functional are not protected under the Lanham Act because they are: (1) essential to the use or purpose of the product; or (2) serve some form of competitive necessity.¹ However, the doctrine of aesthetic functionality has evolved to protect certain functional elements that are aesthetic, such as color, if the use of that color meets certain criteria.² The test for whether a design element, including color, can be trademarked involves a four part analysis, inquiring whether the feature: (1) is essential to the use and/or purpose of the product; (2) affects the cost and/or quality of the product; (3) significantly impacts competition; and, (4) has secondary meaning.³

Ever since the Supreme Court decided in *Qualitex v. Jacobson Products*

1. See *Traffix Devices v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33 (2001) (clarifying that a comprehensive definition of functionality includes the tests laid out in *Inwood* and *Qualitex*).

2. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-66 (1995) (explaining that because color can identify a brand name without serving some additional function, it too, like words or designs, can meet the basic legal requirement for use as a trademark).

3. See *Qualitex*, 514 U.S. at 169 (examining whether color that serves a non-functional purpose interferes with market competition); *Inwood Labs. V. Ives Labs*, 456 U.S. 844, 856-57 (1952) (evaluating whether mislabeling a generic drug with the brand name affects whether people use and purchase it); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224 (2d Cir. 2012) (asserting that color is capable of acquiring a secondary meaning and identifying the brand name).

that color can qualify as a trademark, just like a word or design, lower courts have struggled to identify the types of circumstances under which color can serve as a trademark.⁴ Several of the cases examining the protectability of color, however, have focused on the four-part test to analyze the presence of color on a product and its effect on the use, price, market, and overall character of the product.⁵

In May and September 2012, the Sixth and Second Circuits applied this four-part test to grant trademark protection to the red wax seal on Maker's Mark bourbon bottles and the red soles on French fashion designer Christian Louboutin's ("Louboutin") high-end shoes.⁶ In 2013, the Trademark Trial and Appeal Board ("TTAB") addressed the question of whether a florist company could trademark the color black.⁷ The TTAB's decision to deny Florists' Transworld Delivery ("FTD") a trademark for the color black was a federal court's first attempt at applying the four-step analysis following the landmark *Maker's Mark* and *Louboutin* case.⁸ Unfortunately, the TTAB misapplied the test, leaving unanswered questions for other courts, and possibly the Supreme Court, to address.⁹

While courts have struggled to identify the circumstances in which color can be trademarked, the recent *Maker's Mark* and *Louboutin* decisions appear to settle upon a useful analysis.¹⁰ This Comment argues that in *FTD*, the TTAB ignored this standard by denying the trademark simply on the basis that black was functional, and did not engage in a full secondary meaning analysis.¹¹ Part II examines the history of trademark protection for single colors and the four-part test for analyzing trademark

4. See *Qualitex*, 514 U.S. at 163 (explaining that there is no obvious reason why color on a product cannot also express secondary meaning).

5. See *Louboutin*, 696 F.3d at 224-28 (applying the four part test to decide whether red can be protected in the fashion industry).

6. See *Louboutin*, 696 F.3d at 213 (explaining that informed consumers instantly associate the red sole with the Louboutin brand); *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 420 (6th Cir.) (explaining that the red wax seal was instantly recognizable as part of Maker's Mark's identity).

7. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1785 (T.T.A.B. 2013) (describing the purported unique mark as black floral packaging).

8. See *generally Louboutin*, 696 F.3d at 206.

9. See 106 U.S.P.Q.2d at 1792 (applying the competition prong to a broad market and ignoring the secondary meaning prong of the four-part test for color protection).

10. See, e.g., *Maker's Mark Distillery*, 679 F.3d at 421 (agreeing with the district court that red dripping wax seal has acquired secondary meaning); *Louboutin*, 696 F.3d at 227-28 (holding that the case turns on secondary meaning).

11. See *infra* Part III (arguing that color in certain contexts has secondary meaning because color can identify brand).

infringement claims involving color.¹² Part III argues that the TTAB did not correctly apply the test when it decided that the color black could not be trademarked without even engaging in a full secondary meaning analysis, which is the last step in evaluating a trademark infringement claim.¹³ Part IV offers a policy argument that advocates for more stringently applying the four-part test in order to clarify the circumstances under which color can be trademarked.¹⁴ Part V concludes that the TTAB should reexamine the *FTD* case and fully analyze the color black in a way that is consistent with the analysis in *Maker's Mark* and *Louboutin*.¹⁵

II. BACKGROUND

A. The History of Color Trademarks

1. Pre-*Qualitex*

Prior to the adoption of the Lanham Act, the principal statutory framework governing trademarks in the United States, very few courts addressed the issue of whether color could be trademarked; thus the courts' posture towards color trademarks was ambiguous.¹⁶ It was not until 1945 in *Yellow Cab Transit v. Louisville Taxicab & Transfer*—when the Sixth Circuit decided that the yellow color on taxicabs was sufficiently recognizable to be given some protection—did courts begin to recognize how color could identify a brand in certain contexts.¹⁷ Still however, it was not until after the passage of the Lanham Act that the courts rejected the idea that color alone is never subject to trademark protection.¹⁸

The issue of whether color could be trademarked, however, remained relatively inactive until 1985 when the United States Court of Appeals for the Federal Circuit was faced with the question of whether a fiberglass manufacturer could trademark the pink color of its insulation in *In re*

12. See *infra* Part II (outlining the history and modern approach to color analysis).

13. See *infra* Part III (arguing that TTAB did not complete its analysis because it neglected to apply the six factor test).

14. See *infra* Part IV (explaining that even if the outcome in the *FTD* case was right, the analysis was wrong).

15. See *infra* Part V (concluding that the unclear analysis in *FTD* only further emphasizes the need for clarification).

16. See *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 170-71 (1906) (casting doubt on the possibility that color can be trademarked).

17. See *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945) (holding that the yellow color on taxicabs is unique enough to have secondary meaning).

18. See, e.g., *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 1190 (W.D.Pa. 1981) (protecting the plaintiff's color arrangement on metal spacers).

Owens-Corning Fiberglass.¹⁹ The Federal Circuit held that the color of the pink insulation was distinctive and allowed the manufacturer, Owens-Corning Fiberglass, to register its trademark.²⁰

2. *Qualitex and Beyond*

In 1995, the question of whether color could be trademarked finally reached the Supreme Court.²¹ In *Qualitex v. Jacobson Products*, Qualitex, used green-gold dry cleaning press pads, and its competitor, Jacobson Products, began selling similarly colored pads.²² The Supreme Court, in reversing the lower court's decision, held that color was not ineligible for trademark protection.²³ Furthermore, the Court was careful to observe that color can identify a product and serve something other than a functional purpose.²⁴ The decision in *Qualitex* was the Supreme Court's official imprimatur on color trademarks, representing its general willingness to accept that color in the right context can be trademarked.²⁵

B. Trademark Infringement Under The Lanham Act

The Lanham Act gives trademark owners the opportunity to register their trademarks, thereby granting the owner of the mark the right to prevent others from using it.²⁶ The primary purpose of trademark protection is to ensure that the public knows who created a product, and that the trademark

19. See *Christian Louboutin S.A. v. Yves Saint Am. Holding, Inc.*, 696 F.3d 206, 218 (2d Cir. 2012) (noting that the issue of single color mark registration lay idle until 1985).

20. See *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1122 (Fed. Cir. 1985) (reasoning that there is no public policy interest in preventing the color pink from receiving protection).

21. See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 160-61 (1995) (questioning whether the Lanham Act permits the registration of a trademark consisting only of a color).

22. See *id.* at 161 (granting *certiorari* to review the Ninth Circuit Decision that color alone can never be trademarked).

23. See *id.* at 171-72 (reasoning that if the Lanham Act permits an ordinary word to be trademarked logic dictates that this rule would apply to colors as well).

24. See *id.* at 164 (explaining that it is difficult to find a *per se* rule precluding the use of color as a trademark).

25. See *id.* at 170 (explaining that the "ultimate test" for extending trademark protection to a color is whether recognizing the feature would significantly impact competition).

26. See LANHAM ACT 15 U.S.C. § 1127 (2006) (defining a trademark as "any word, name, symbol, or device, or any combination thereof" which a person has an intention to use in commerce and registers to identify her product from those sold by others).

owner can benefit from building her brand's reputation.²⁷ Trademark law, unlike patent and copyright law, however, does not give a producer monopoly over a particular product.²⁸

Trademark infringement claims are analyzed according to: (1) whether the trademark merits protection; and (2) whether the competing mark is likely to cause consumer confusion.²⁹ Even if the mark merits protection, and the alleged infringement causes consumer confusion, the plaintiff still cannot prevail if the mark is deemed functional.³⁰ The functionality of a mark can be demonstrated through either utilitarian functionality or aesthetic functionality.³¹

C. The Affirmative Defenses to Trademark Infringement: Utilitarian Functionality and Aesthetic Functionality

As the Supreme Court mentioned in *Qualitex*, functional features on a product generally cannot be trademarked.³² There are two types of functionality, utilitarian and aesthetic, and both the utilitarian and aesthetic functionality doctrines prevent the owner of a trademark from having a monopoly on a particular product.³³

1. The Traditional Approach: Utilitarian Functionality

A feature is considered functional in the utilitarian sense if it affects how

27. See, e.g., *Qualitex*, 514 U.S. at 163-64 (explaining that trademark protection tells consumers who produced a product while also helping to guarantee that the producer will benefit monetarily from her creation).

28. See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115 (2d Cir. 2001) (noting that trademark law is less about innovation and more about preserving a competitive market for the benefit of consumers).

29. See *Louis Vuitton Malletier v. Dooney & Burke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006) (explaining that in the two step analysis courts evaluate the mark's distinction and whether defendant's use of the mark has confused consumers).

30. See, e.g., *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 58, 59 n.4 (2d Cir. 1995) (noting in dictum that functional features can only be protected through the patent system, which provides a monopoly over a design feature for only a limited amount of time).

31. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012) (explaining that both utilitarian and aesthetic functionality can serve as affirmative defenses to trademark infringement claims).

32. See *Qualitex*, 514 U.S. at 165 (providing in example that if a special shaped light bulb is shaped that way to enhance illumination the shape of the light bulb is functional and therefore cannot be trademarked).

33. See, e.g., *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 145 n.5 (2d Cir. 1997) (explaining that unlike patent law, trademark law is not meant to grant trademark owners a monopoly on production).

the product is used or affects the cost of the product.³⁴ There are four factors, the *Morton Norwich* Factors, that courts generally rely on when evaluating whether the purpose or cost of the product is affected: (1) does a utility patent exist; (2) do advertisements highlight the design's utilitarian advantages; (3) are there available alternative designs; and, (4) does the design simplify manufacturing.³⁵ In *Traffix Devices v. Marketing Displays*, the Supreme Court examined the concept of utilitarian functionality.³⁶ Specifically, a manufacturer of road signs alleged that a mechanism it created and patented to keep the signs upright in strong winds also had secondary meaning, such that consumers associated the look of the mechanism with the company, Marketing Displays (MD).³⁷ While the springs were a unique patented component of the sign, the Court decided that registering the spring as a trademark would be inappropriate because the springs were clearly made to affect how the design worked, not how it looked.³⁸ In other words, the alleged trademark was a functional part of the product configuration, and therefore could not be protected under the Lanham Act.³⁹

2. *The Highly Fact-Specific Approach: Aesthetic Functionality*

Generally, when a design is deemed functional in the two-pronged utilitarian sense and affects: (1) the use of the product; and (2) the cost of the product, there is no need to continue the analysis.⁴⁰ In contrast, when examining the aesthetic design of a product, such as color, a mark may still be deemed functional if it significantly impacts competition.⁴¹ In other words, under the aesthetic functionality doctrine, if a design feature is essential to the purpose of a product, or affects its cost or quality, then the

34. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1788 (T.T.A.B. 2013) (paraphrasing the two prongs of the *Inwood* test).

35. See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982) (applying the test to the factors in the case).

36. See *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 33 (2001) (concluding that trade dress protection cannot be applied when a design is deemed functional).

37. See *id.* at 26 (explaining that MD brought suit under the Lanham Act against Traffix for trademark infringement based on the copied dual spring design).

38. See *id.* at 30 (concluding that the trademark claim was barred because MD did not overcome the strong presumption of functionality based on the dual-spring design being a formerly protected patent).

39. See *id.* at 26 (explaining that consumers clearly did not associate the look of the dual-spring design with MD).

40. See *id.* at 33 (explaining that if both portions of the bi-part *Inwood* test are satisfied, asking whether there is a competitive necessity for the feature is irrelevant).

41. See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995) (adding to the general rule precluding registration on the basis of utilitarian functionality).

design feature is considered functional and it will not be protected.⁴² But, if a design element is not functional under the traditional two-pronged test, the applicant must still show that protecting the feature does not have a significant impact on competition in order to receive trademark protection.⁴³ In *British Seagull v. Brunswick* an engine manufacturing company attempted to trademark the color black.⁴⁴ In its decision, the Federal Circuit stated that the eligibility for trademark protection turned on the effect the design would have on competition.⁴⁵ The court found that there was a competitive need for engine manufacturers to use the color black on outboard engines; color compatibility with boats and the ability to make the engine look smaller.⁴⁶ Similarly, the Federal Circuit focused on competitive need in *L.D. Kichler v. Davoil*, in which the court found that using a brick finish on the back of lighting fixtures constituted a competitive need.⁴⁷ Finally, in *Dippin Dots v. Frosty Bites*, Dippin Dots argued that the color and shape of its ice cream beads were non-functional because Frosty Bites could still compete in the ice cream market by serving soft-serve ice cream without the Dippin Dot bead component and thus would not infringe upon its trademark.⁴⁸

In cases involving a claim of aesthetic functionality, the analysis is complicated because it is difficult to distinguish between a merely decorative design feature and one distinct enough to identify the source of the product.⁴⁹ In a recent Seventh Circuit case, *Clemens Franek*, the creator and trademark owner of the circular beach towel sought to enjoin *Jay Franco & Sons*, a distributor of bedding and beach accessories from

42. See *id.* (explaining that a feature is functional if it affects the use or cost of the product).

43. See *Landscape Forms, Inc. v. Colum Cascade Co.*, 70 F.3d 251, 253 (2d Cir. 1995) (holding that a prerequisite for determining that a design is aesthetically functional is a finding that it is essential to effective market competition).

44. See *British Seagull Ltd. v. Brunswick Co.*, 28 U.S.P.Q.2d (BNA) 1197, 1 (T.T.A.B. 1993) (explaining that the purported mark consists of the color black as applied to the entire outside of an outboard boat engine).

45. See *id.* at 2, 7.

46. See *id.* at 2 (noting that the prevalent use of black on outboard engines points to a competitive need to use the color black within that market).

47. See *L.D. Kichler v. Davoil*, 192 F.3d 1349, 1353 (Fed. Cir. 1999).

48. See *Dippin Dots, Inc. v. Frost Bites Distribution, LLC*, 369 F.3d 1197, 1203 n.7 (11th Cir. 2004) (holding that ice cream beads are in a different market than traditional soft serve ice cream).

49. See Alexandra J. Schultz, Comment, *Looks Can Be Deceiving: Aesthetic Functionality in Louboutin and Beyond*, 15 TUL. J. TECH. & INTELL. PROP. 261, 256 (2012) (explaining that in aesthetic functionality cases, courts must determine whether an aesthetic feature of a product is merely ornamental).

selling its own brand of round beach towels.⁵⁰ In this case, the Seventh Circuit focused on the usefulness of the circular design whereby sunbathers are able to rotate on the towel without getting up to reposition.⁵¹ Because of this practical characteristic, the Seventh Circuit found the design functional under the doctrine of aesthetic functionality.⁵²

In *W.T. Rogers v. Keene*, the Seventh Circuit illustrated the concept of aesthetic functionality using a football to explain that the shape of the football itself could not be trademarked because it is an inherent feature and therefore functional.⁵³ The shape of a football is aesthetically functional because it is an element that all brands of footballs share, and therefore has a significant effect on competition within the football market.⁵⁴ Because granting the trademark would effectively prevent others from making footballs, the court found the shape functional and not eligible for trademark protection.⁵⁵ The issue of what types of features should be classified as competitively necessary, and those that are merely ornamental in nature has been litigated extensively.⁵⁶

3. *The Relationship Between Aesthetic Functionality and Secondary Meaning*

To register a trademark, a designer must demonstrate that a design feature is non-functional or that it is distinct enough to identify a brand through secondary meaning.⁵⁷ In *Morton-Norwich Products*, the appellant

50. See *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 856 (explaining that in 1994 Franek trademarked the circular beach towel and when settlement negotiations fell through with Jay Franco & Son he filed a lawsuit for trademark infringement).

51. See *id.* at 859, 861 (explaining that Franek should have pursued a design patent and not a trademark).

52. See *id.* at 859 (holding that Franek would have a strong competitive advantage if allowed to trademark the circular towel).

53. See *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 339 (7th Cir. 1985) (explaining that a functional feature is something so intrinsic to the product that the designer must design around that feature).

54. See *id.* (explaining that the shape of the football is not designed to differentiate the brands, like a logo).

55. See *id.* (explaining that the football's oval shape is functional because it is found in all brands of football).

56. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012) (holding that red on the bottom of Louboutin's shoes can be protected); *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.* 679 F.3d 410, 418 (6th Cir. 2012) (holding that the red wax on Maker's Mark bottles is not functional and therefore trademark protected); *In re Florists' Transworld Delivery, Inc.* 106 U.S.P.Q.2d 1785, 1792 (T.T.A.B. 2013) (holding that black floral packaging is not functional).

57. See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1343 (C.C.P.A.

sought to register a glass container as a trademark, and the trademark examiner rejected the action on the basis that the design was not distinct and therefore functional.⁵⁸ On appeal, the court acknowledged that the trademark examiner intertwined the issues of functionality and secondary meaning.⁵⁹ The court emphasized that secondary meaning and functionality must be evaluated separately.⁶⁰

There are four parts to the test for color protection, but one of these factors is secondary meaning, which includes six sub-parts.⁶¹ In *Louboutin*, the Second Circuit listed six factors relevant to determining whether a design feature has secondary meaning: (1) advertising expenses; (2) consumer studies linking the purported mark to the source; (3) media coverage of the product; (4) sales success; (5) attempts at plagiarism; and (6) length of time the mark has been used.⁶²

D. The Four-Part Test: Purpose, Price, Competition, and Character

The circumstances under which color can be successfully registered as a trademark has been particularly unclear.⁶³ The few cases that have addressed this issue, however, have relied on the four-part color protection test, and, if necessary, the six-part test for secondary meaning.⁶⁴ Three recent cases demonstrate the application of these tests with varying outcomes: *Maker's Mark Distillery v. Diageo*, *Louboutin v. Yves Saint Laurent*, and *In re Florists' Transworld Delivery*.⁶⁵

In the May 2012, *Maker's Mark Distillery*, Maker's Mark, a bourbon

1982) (emphasizing that both of these requirements must be kept separate from each other).

58. See *id.* at 1334-35 (noting that the examiner repeatedly emphasized that the container was a "non-distinctive purely functional container.").

59. See *id.* at 1343 (explaining that a non-distinctive design does not necessarily mean it is a functional design).

60. See *id.* at 1335, 1344.

61. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012) (explaining that the six factor test helps resolve the crucial question of whether the source of a product influences buyers to purchase that product).

62. See *id.* (listing the six-part test as a method for determining what motivates consumers to purchase a product).

63. See, e.g., *id.*

64. See *id.* (asserting that color is capable of acquiring secondary meaning and identifying a brand).

65. See *id.* at 228 (holding that Louboutin's red sole mark could be trademarked); *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.* 679 F.3d 410, 424 (6th Cir. 2012) (holding that the Maker's Mark red wax seal could be trademarked); *In re Florists' Transworld Delivery*, 106 U.S.P.Q.2d 1785, 1792 (T.T.A.B. 2013) (holding that the color black on floral packaging was functional).

distillery, accused Diageo, a tequila company, of trademark infringement contending that the seal that Diageo placed on its tequila products strongly resembled the Maker's Mark's red wax seal.⁶⁶ Diageo argued that the seal was functional and therefore could not be protected. The Sixth Circuit held, however, that the red wax was part of Maker's Mark's identity and therefore protected.⁶⁷ The court did not uphold the aesthetic functionality defense.⁶⁸ Running through the purpose, cost, and competition analysis, the court emphasized that red wax was not the only wax and color that could be used to seal the bottle, and that competing companies were not placed at a significant disadvantage when prevented from using red wax.⁶⁹

Five months later, in *Louboutin*, the Second Circuit upheld trademark protection for the red lacquered outer sole on Louboutin's high-end footwear.⁷⁰ At the time of the decision, Louboutin had been producing shoes featuring a red outer sole for about two decades.⁷¹ Appearing regularly on celebrities and icons in the fashion industry, Louboutin obtained a trademark for the well-known red soles in 2008.⁷² In 2011, competing fashion designer, Yves Saint Laurent ("YSL") began making a monochromatic red shoe with a similar red sole.⁷³ After several attempts to discuss the monochrome red shoe, and YSL's refusal to withdraw the model from the market, Louboutin asserted a claim against YSL under the Lanham Act.⁷⁴ In 2012, the Second Circuit, held on appeal that there was no rule preventing color from serving as a trademark in the fashion industry

66. See *Maker's Mark Distillery*, 679 F.3d at 415 (describing the trademark in question as a seal made from red dripping wax).

67. See *id.* at 420 (noting that the lower court was correct in its finding of uniqueness).

68. See *id.* at 418, 424 (concluding that there is a likelihood of confusion between Maker's red wax seal and Diageo's red wax seal).

69. See *id.* at 422-23 (finding that the strength of the trademark in identifying Maker's Mark bourbon renders it non-functional).

70. See *Louboutin*, 696 F.3d at 227 (holding that the District Court's conclusion that a single color can never serve as a trademark was based on an incorrect understanding of the doctrine of aesthetic functionality and that the mark had developed secondary meaning).

71. See *id.* at 213 (explaining that the red sole mark is instantly recognizable to informed consumers as Louboutin's handiwork).

72. See *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 448-49 (S.D.N.Y. 2011) (introducing that within the actual trademark application the mark is described as a lacquered red sole on footwear).

73. See *id.* at 448 (describing the shoe in question as the "Tribute," belonging to YSL's 2011 and 2008 Cruise collections, appearing in stores in November of each year).

74. See *Louboutin*, 696 F.3d at 213.

and that Louboutin's red sole mark, when limited to uses in which the red outer sole contrasts with the color of the remainder of the shoe, carried a secondary meaning and was a protected mark.⁷⁵ In other words, when a red sole is placed on an all red shoe, there is no trademark protection.⁷⁶ In reaching its conclusion, the Second Circuit, focused first on the final step of the four-part test and introduced several of the factors relevant to determining secondary meaning, as well as extensive evidence of Louboutin's advertising expenditures, media coverage, and sales success.⁷⁷ In finding that Louboutin's red sole mark had secondary meaning, there was no need for the court to engage in a full assessment under the aesthetic functionality doctrine, as even if something is functional, if it has secondary meaning, it is still eligible for trademark protection.⁷⁸

After *Louboutin*, it seemed that the test for color analysis was settled, but in March 2013, the Trademark Trial and Appeals Board (TTAB) was presented with the question of whether the color black could be trademarked in *In re Florists' Transworld Delivery*.⁷⁹ The TTAB evaluated the color under the four-part test, assessing the purpose, price, competitive market, and acquired meaning of the product feature, and affirmed the trademark examiner's decision that black is functional because of a strong competitive need to use black in the floral industry to convey particular messages.⁸⁰ The TTAB briefly addressed the secondary meaning portion of the analysis and concluded that black lacked secondary meaning, emphasizing that a single color mark can never be distinctive, and apparently ignoring the *Qualitex* decision in which the Supreme Court made it clear that color in the right context, just like a word or design, can be trademarked.⁸¹ Moreover, because a finding of functionality does not

75. See *id.* at 228 (holding that the District Court's conclusion that a single color can never serve as a trademark was based on an incorrect understanding of the doctrine of aesthetic functionality and that the mark had developed secondary meaning).

76. See *id.* at 227 (reasoning that Louboutin's red sole mark is closely associated with contrast).

77. See *id.* at 225-26 (emphasizing that the red sole of the shoe was instantly recognized in high-end commercial markets and social circles).

78. See *id.* at 228 (holding that it would be "axiomatic" to evaluate the likelihood of confusion and functionality under the aesthetic functionality doctrine after a finding of secondary meaning).

79. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1785 (T.T.A.B. 2013) (describing the purported unique mark as black floral packaging).

80. See *id.* at 1792 (concluding that the applicant did not defeat the *prima facie* case of functionality established by the examining attorney and that the mark is functional).

81. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-66 (1995) (explaining that because color can identify a brand name without serving some

preclude registration if the purported mark has secondary meaning, the TTAB applied the test incorrectly in the *FTD* case.⁸²

III. ANALYSIS

A. Because Maker's Mark And Louboutin Were Decided Within A Few Months Of Each Other, And Apply Similar Four-Part Tests, The TTAB In FTD Should Have Followed The Maker's Mark And Louboutin Precedent.

Qualitex affirmed that there is no rule preventing color from being trademarked but remained silent how to determine whether a particular color is eligible for protection.⁸³ Since *Qualitex*, when evaluating aesthetic features, including color, courts have taken a highly fact-specific approach.⁸⁴ Lacking guidance from the Supreme Court, for several decades, the lower courts have attempted to differentiate the best way to analyze color under the various tests for varying circumstances.⁸⁵ For instance, courts have attempted to delineate between satisfactory and unsatisfactory industries, occasionally finding that the nature of the business precludes trademark registration for color.⁸⁶

The trial court in *Louboutin* precluded single color trademarking in the fashion industry, holding that color in the context of fashion is functional.⁸⁷ The reasoning behind the ruling was that if single colors in the fashion

additional function, it too, like words or designs, can meet the basic legal requirement for use as a trademark).

82. See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982) (emphasizing that functionality and secondary meaning must be analyzed separately).

83. See *Qualitex* at 174 (holding only that color may sometimes meet the basic legal requirements for trademark protection, but not elaborating on the circumstances under which these requirements could be satisfied)

84. Compare *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 417-24 (6th Cir. 2012) (conducting a fact specific analysis under both the doctrine of aesthetic functionality and the *Frisch* Test), with *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 860 (7th Cir. 2010) (conducting a fact specific analysis under the aesthetic functionality doctrine).

85. See *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (explaining that because branding success is difficult to distinguish, the aesthetic functionality doctrine is highly fact specific).

86. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 457 (S.D.N.Y. 2011) (reasoning that if Louboutin was granted a trademark for the color red, there would be no end to the colors that could be trademarked in the fashion world).

87. See *id.* (reasoning that color is such a major part of fashion that the Lanham Act could never accommodate the "broad spectrum" of claims that would inevitably arise from single color trademarks in the industry).

industry could be trademarked, then courts would be inundated with applications for trademark protection.⁸⁸ However, in *Maker's Mark* and *Louboutin*, the courts begin to move towards a standard analysis for trademarking color, and then the TTAB, in the first application of the standardized test after the landmark *Louboutin* decision breaks from precedent.⁸⁹

In *Maker's Mark* and *Louboutin* on appeal, the test for whether color could be trademarked involved a four-part analysis, that assessed whether the color was essential to the purpose and affected the cost of the product, and also significantly impacted competition and the overall character or meaning of the product.⁹⁰ The factors then relevant for determining whether a design feature had acquired secondary meaning included: advertising expenditures; consumer study reports; media coverage details; product sales revenue; plagiarism attempts; and the length of time the market had been in use.⁹¹ *Maker's Mark* dealt with the first two prongs of aesthetic functionality and offered a detailed analysis of the competition theory of functionality, finding that there was a likelihood of consumer confusion between *Maker's Mark's* red wax seal and the Diageo seal.⁹² In *Louboutin*, the court found the red soles to be functional under the competitive prong of the four-part test, and then focused heavily on the secondary meaning analysis.⁹³

In *FTD*, the TTAB applied the correct test, evaluating purpose, price, competition, and secondary meaning, but incorrectly found that because black was functional, a secondary meaning analysis was not necessary.⁹⁴

88. See *id.* (conjecturing that if *Louboutin* is given trademark protection for his red sole mark, other designers will stake out other shades of red, leading to absurd results).

89. See *In re Florists' Transworld Delivery*, 106 U.S.P.Q.2d 1785, 1792 (T.T.A.B. 2013) (rejecting the necessity of a complete analysis under the doctrine of secondary meaning).

90. See *Maker's Mark Distillery, Inc. v. Diageo N. Am.*, 679 F.3d 410, 418, 420 (6th Cir. 2012) (moving through the first two prongs of the test, and then applying the competition theory of functionality and secondary meaning); *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 223-227 (2d Cir. 2012) (delineating the analysis between aesthetic functionality (including competition) and secondary meaning).

91. See *Louboutin*, 696 F.3d at 222, 226 (explaining that the six-part test is part of the highly fact specific approach of identifying brand success within a market).

92. See *Maker's Mark Distillery*, 679 F.3d at 413.

93. See *Louboutin*, 696 F.3d at 227 (holding that *Louboutin's* red shoes qualify for trademark protection under the secondary meaning analysis).

94. See *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982) (emphasizing that functionality and secondary meaning must be analyzed separately).

On the contrary, a mark that is functional can still obtain trademark protection if it has acquired secondary meaning.⁹⁵ In *FTD*, the TTAB excused itself from completing a full secondary meaning analysis on the basis that black was functional under the competition prong of the aesthetic functionality test.⁹⁶ Failing to conduct this stage of analysis was a misapplication of the doctrine of aesthetic functionality because it ignored the fact that a functional feature can still be trademarked if it is significant enough to identify the product brand.⁹⁷ Instead of looking at advertising expenses, consumer studies, media coverage, sales figures, attempts at plagiarism, and the length of time the mark had been used, the TTAB merely looked at six statements from FTD's Senior Vice President of Marketing to dispel the notion that the company's black floral packaging was in any way distinct.⁹⁸ While the evidentiary statements did include total sales figures, there was no mention of the other five factors pertinent to determining secondary meaning.⁹⁹ Instead, the TTAB looked at the number of times the FTD website had been visited after the introduction of the black floral packaging, and then after a targeted advertising campaign was implemented; in addition, the TTAB looked at the mere fact that FTD advertised the black floral packaging in direct mailings.¹⁰⁰ Conversely, in *Louboutin*, the record included extensive evidence of Louboutin's advertising expenditures, media coverage, and sales successes, as well as statements from the fashion world attesting to Louboutin's uniqueness.¹⁰¹ As compared to *Louboutin*, the record in *FTD* was dearth of the factors pertinent to a fair analysis of meaning behind the black floral packaging.¹⁰² However, even if one could argue that the TTAB was correct in stopping short of a full secondary meaning analysis, the Sixth Circuit still carried out

95. *See id.* (explaining that a non-distinctive design does not necessarily mean it is a functional design).

96. *See In re Florists' Transworld Delivery*, 106 U.S.P.Q.2d 1785, 1792 (T.T.A.B. 2013) (concluding that because applicant did not refute a *prima facie* case of functionality it is not necessary to conduct a full secondary meaning analysis).

97. *See In re Morton-Norwich Products, Inc.*, 671 F.2d at 1343 (noting that it was incorrect to refer to an object as indistinct because of its overall functionality).

98. *See* 106 U.S.P.Q.2d at 1792 (considering only six statements submitted in 2011 by Larry Plawsky, Senior Vice President of Marketing at FTD).

99. *See id.*

100. *See id.* (noting that the FTD website was visited 350 million times after the introduction of the black floral packaging, and nine million times after the advertising campaign was initiated).

101. *See Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 227 (2d Cir. 2012) (including statements from the Chief Executive Officer of YSL, Louboutin's competitor, acknowledging the notoriety of the red sole mark).

102. *See* 106 U.S.P.Q.2d at 1792.

its analysis under the competition prong of the aesthetic functionality doctrine poorly.¹⁰³

B. In FTD the TTAB Erred In Its Analysis Because It Did Not Apply the Four-Part Test for Trademark Color Infringement.

In *FTD*, the TTAB erroneously chose not to fully analyze the color black under all four prongs of the four-part test.¹⁰⁴ The TTAB failed to identify the market that *FTD* was competing in and therefore made it impossible to satisfactorily evaluate the competitive need for the color black.¹⁰⁵ Furthermore, in choosing not to engage in a full secondary meaning analysis under the six-factor test, the TTAB never fully dispelled the possibility that black could be trademarked.¹⁰⁶ Accordingly, when the TTAB in *FTD* decided that there was a competitive need for the color black, and stopped short of a full secondary meaning analysis, it incorrectly labeled the color black as functional.¹⁰⁷

1. Because the TTAB in the FTD Case Did Not Clearly Identify the Market FTD Was Competing In, It Erred In Identifying the Color Black As Functional.

To the extent that functionality is determined by competitive need, courts will always have to engage in market definition because the question of whether exclusive use over a design element, including color, puts competitors at a disadvantage is always based on the nature of the market in which the parties compete.¹⁰⁸ In evaluating the competition, the TTAB did not narrowly construe the market in the *FTD* case.¹⁰⁹ Courts, however, have traditionally favored preserving competition within narrowly construed markets.¹¹⁰

103. See generally *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 423 (6th Cir. 2012) (analyzing competitive necessity under the *Frisch* test).

104. See 106 U.S.P.Q.2d at 1792 (explaining that there is a presumption of non-functionality under the first two prongs of the test and that a finding of functionality precludes registration without regard to secondary meaning).

105. See *id.* at 1792.

106. See *id.*

107. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1791 (T.T.A.B. 2013) (laying out its road map, the TTAB bases its analysis on whether protecting the color black would hinder competition).

108. See Mark McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 830 (2011) (explaining that market definition can be difficult because courts have never been able to develop a methodology for defining relevant markets in functionality cases).

109. See 106 U.S.P.Q.2d at 1789 (applying the market analysis to not only black floral packaging but all parts of the floral industry, such as containers and flowers).

110. See McKenna, *supra* note 108, at 832 (explaining that while the narrow

Prior to the *FTD* case, courts focused on the issue of competitive need in determining whether a single color can be registered as a trademark.¹¹¹ In *British Seagull*, the TTAB stated that the color black could not be trademarked because it was needed for aesthetic reasons on outboard boat engines; color compatibility with boats and the ability to make the engine look smaller.¹¹² In other words, it would be unfair to boat engine makers, to grant exclusive use of the color black to one single company.¹¹³ Similarly, the Federal Circuit also addressed competitive need in *L.D. Kichler*, in which the court held that using a brick finish on lighting fixtures must be available to all lighting fixture producers.¹¹⁴

In *Maker's Mark*, the Sixth Circuit limited its analysis to liquor bottles using the seal, and did not include other food items, such as wines and cheeses, which also often bear a red wax seal.¹¹⁵ Likewise, in *Louboutin*, the Second Circuit limited its analysis to high-end shoes that contrasted with the red sole, and excluded athletic shoes and monochromatic red shoes.¹¹⁶ In both of these cases, the courts narrowly construed the market to include only the relevant merchandise, but in *FTD*, the TTAB used an overly broad market definition by including the entire floral industry instead of just floral boxes.¹¹⁷

In *Dippin Dots*, the soft ice cream beads case, the Eleventh Circuit, tightly grouped the merchandise.¹¹⁸ Accordingly, Dippin Dots' beaded ice

construction may not be right, courts offer no other methodology for determining relevant markets).

111. See generally *British Seagull Ltd v. Brunswick Corp.*, 28 U.S.P.Q.2d (BNA) 1197, 1197 (T.T.A.B. 1988) (describing applicant who sought to register the color black for outboard engines).

112. See *id.* at 1199 (holding that based color was functional based on this competitive need).

113. See *id.* (explaining that in the outboard engine market, black must be available to all engine manufacturers so that they can compete with each other fairly).

114. See *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1353 (Fed. Cir. 1999) (stating that while it is clear that many people prefer Old Brick finish, it was not established that Old Brick was uniquely superior to other brands).

115. See *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 415 (6th Cir. 2012) (discussing the history of bourbon and other liquors in its historical market analysis).

116. See *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012) (failing to extend trademark protection to shoes in which the red sole does not contrast with the rest of the shoe).

117. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1789 (T.T.A.B. 2013) (applying the purported mark, black floral packaging, to all parts of the floral industry).

118. See *Dippin Dots v. Frosty Bites*, 369 F.3d 1197, 1209 (11th Cir. 2004) (holding that Dippin Dots cannot claim trade dress infringement because Frosty Bites

cream was considered distinct enough from soft serve ice cream to occupy a different market.¹¹⁹ In *FTD*, the mark originally introduced for trademark protection was black floral packaging, but the TTAB not only analyzed packaging, but flowers and holiday containers as well.¹²⁰ Broadly construing the market, the TTAB argued that if *FTD* obtained a trademark on black floral packaging then other florists would be precluded from using the color black in floral bouquets and containers.¹²¹

Analyzing the market across such broad terms misinterprets the purpose of trademark law.¹²² Trademark protection for a design feature, such as color, does not create monopoly control over that feature for all uses.¹²³ Even if, the TTAB awarded *FTD* trademark protection for its black floral packaging, the color black could still be used; it simply could not be used in a way that would cause consumer confusion in the floral market.¹²⁴ With that said, it is highly unlikely that a potential customer would be confused by whether black floral packaging and black flowers were designed by the same company, because even though both share a similarity in color, the overall concepts are different.¹²⁵ In the lower court's decision in *Louboutin*, Louboutin's red sole mark was not eligible for trademark protection in part because the district court believed that the implication of approving the trademark would result in potentially overbroad protection.¹²⁶ On appeal, the Second Circuit resolved this concern when it

occupies a different market).

119. *See id.* at 1203-04 n.7 (explaining that there is little chance of consumer confusion between beaded ice cream and soft serve ice cream).

120. *See* 106 U.S.P.Q.2d at 1790 (noting that black flowers can communicate elegance and/or mourning).

121. *See id.* at 1789 (explaining that because black is a traditional Halloween color it must be available for holiday bouquets and containers).

122. *See* *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115 (2d Cir. 2001) (noting that trademark law is less about innovation and more about preserving a competitive market for the benefit of its customers).

123. *See* *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 640 n.10 (7th Cir. 1993) (explaining that Kohler was free to copy Moen's design so long as it insured that the public was not deceived).

124. *See* *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224 (2d Cir. 2012) (explaining that part of trademark regulation involves providing enough differentiation to ensure that consumers are not confused).

125. *See* 106 U.S.P.Q.2d at 1789 (applying erroneously the purported mark, black floral packaging, to all parts of the floral industry).

126. *See* *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 456 (S.D.N.Y. 2011) (explaining that if Louboutin was allowed to trademark a single color there would be no end to the colors that people would attempt to trademark, particularly in fashion).

concluded that the protection did not extend to all red shoes and permitted YSL to produce a monochromatic red shoe.¹²⁷ The court was so particular in its market analysis that it limited the merchandise in question to shoes consisting of red soles and a contrasting color, which is not at all what the TTAB did in *FTD*.¹²⁸ In *FTD*, the TTAB even seemed confused by whether the purported mark included black flowers or just a black box.¹²⁹ The black floral packaging had nothing to do with the flowers, but rather it only dealt with the color of the box in which FTD packaged and delivered the flowers.¹³⁰ Furthermore, even when the TTAB did focus on packaging, it was not particular in distinguishing a black floral cardboard box from black vases and non-perishable black containers.¹³¹ In *Dippin Dots*, the court's analysis exemplified how narrowly market analysis is generally construed.¹³² If beaded ice cream and soft serve ice cream are in different markets, then certainly a black box is different from black flowers and vases.¹³³ Without offering a compelling reason to broaden the market beyond floral packaging, the TTAB failed to establish the competitive necessity of the color black in the floral industry and thus did not establish its functionality under the aesthetic functionality doctrine.¹³⁴

2. Because the TTAB Did Not Apply the Six-Factor Test Outlined In Louboutin, It Did Not Fully Engage In a Secondary Meaning Analysis.

The TTAB did not apply the test for secondary meaning in the *FTD* case correctly because it ignored several of the six factors involved in a true secondary meaning analysis.¹³⁵ A fact-specific inquiry into the nature of the trademark is required when the secondary meaning analysis is

127. See *Louboutin*, 696 F.3d at 227 (concluding that the trademark protection does not extend to all red shoes).

128. See *id.* (noting that Louboutin's mark is as much about color as it is about contrast).

129. See 106 U.S.P.Q.2d at 1789 (including in the record evidence that the color of flowers communicate particular messages).

130. See 106 U.S.P.Q.2d at 1789 (explaining that this issue for consideration is whether trademarking the color black for flower boxes would hinder competition).

131. See *id.* at 1791.

132. See *Dippin Dots v. Frosty Bites*, 369 F.3d 1197, 1207 (11th Cir. 2004) (explaining that there is little chance of confusing ice cream beads and soft serve ice cream, so they occupy two different markets).

133. See 106 U.S.P.Q.2d at 1788-89 (describing the purported mark as black cardboard packaging, which does not include flowers and vases).

134. See *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 419 (6th Cir. 2012) (applying the *Frisch* test to competitive necessity).

135. See 106 U.S.P.Q.2d at 1792-93.

applied.¹³⁶ The six-factor test for determining secondary meaning considers: advertising expenditures; consumer study reports; product sales revenue; attempts at plagiarism; and the length of time the mark has been in use.¹³⁷ In *FTD* the only factors the TTAB observed in this six-part test was noting the length of time the mark had been in use and its sales figures.¹³⁸ Returning once more to *Maker's Mark*, the Sixth Circuit engaged in a much deeper analysis when it explained the secondary meaning behind the red wax seal.¹³⁹ The court not only looked at the company's extensive marketing campaign, but also the public attention that the brand received through the media.¹⁴⁰ Similarly, in *Louboutin*, the Second Circuit not only analyzed Louboutin's advertising expenditures, media coverage, and sales success, but also admitted testimony that the red sole mark was instantly recognizable in high-end commercial markets and social circles.¹⁴¹ In *FTD*, the TTAB's failure to address almost all of the necessary factors under the fourth part of the four-part test for color trademark resulted in the erroneous determination that black floral packaging was not distinct enough to identify FTD.¹⁴² Rather than applying the six-factor test for secondary meaning, the TTAB denied a finding of secondary meaning solely on the basis that FTD had placed the floral packaging into commerce two years ago, sold 1.8 million arrangements, and promoted its product through the Internet and direct mailings.¹⁴³ Furthermore, in its request for reconsideration, FTD asked the TTAB to review statements from consumers, but the examiners declined to consider them because they were submitted as form statements.¹⁴⁴ In both *Maker's Mark* and *Louboutin*, the

136. See *Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (noting that courts must balance the trademark owner's rights to enjoy the benefits of her mark, and the public's rights to a competitive market).

137. See *id.* at 226 (noting that the six factors help answer the question whether the public buys a product because of its brand, which is a crucial element in secondary meaning analysis).

138. See 106 U.S.P.Q.2d at 1792 (stating that the black box mark had been on the market for at least two years).

139. See *Maker's Mark Distillery*, 679 F.3d at 420-21 (holding that the red wax seal was part of Maker's identity).

140. See *id.* at 420 (noting the strong presence of the mark in Maker's advertising).

141. See *Louboutin*, 696 F.3d at 225 (quoting YSL's chief executive officer that "[i]n the fashion or luxury world, it is absolutely clear that we recognize the notoriety of the distinctive signature constitute by the red sole of Louboutin).

142. See 106 U.S.P.Q.2d at 1792 (holding that the black floral packaging was functional and failed to acquire secondary meaning).

143. See *id.* at 1792-93.

144. See *id.* at 1793 n.9 (explaining that while form statements may be used to show secondary meaning they have many shortcomings).

courts thoroughly reviewed advertising expenditures, media coverage, and sales successes to demonstrate that both companies had created a unique trademark using color.¹⁴⁵

Further, it is notable that in *Maker's Mark*, the Sixth Circuit laid out a fairly complicated, but thorough test for assessing competitive need.¹⁴⁶ The first part of the two-part test was whether rendering trademark protection for a design feature, including color, would leave competitors with alternative designs.¹⁴⁷ The second part of the test was whether trademark protection would prevent another manufacturer from competing in the same market.¹⁴⁸ In *Louboutin*, the Second Circuit focused less on the competition prong of functionality.¹⁴⁹ Conversely, in *FTD*, the TTAB fully engaged in a competitive functionality analysis, but in broadly construing the market it wrongfully applied the test to all of the floral industry, and not just black in the context of floral packaging.¹⁵⁰

C. In FTD the TTAB Erred In Its Analysis Because It Directly Contradicted the Supreme Court's Holding in Qualitex.

In *FTD*, the TTAB stated that color can never be inherently distinctive.¹⁵¹ Even if this statement was supported in the *Qualitex* decision at the TTAB level, this decision was later appealed to the Supreme Court.¹⁵² In a unanimous decision, the Court held that nothing precludes color from receiving trademark protection.¹⁵³ Both *Louboutin* and *Maker's*

145. See, e.g., *Louboutin*, 696 F.3d at 225 (noting that Louboutin had invested a substantial amount of money in building a reputation and promoting its exclusive ownership of the mark).

146. See *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 418 (6th Cir. 2012) (explaining that under the competition theory of functionality the Sixth Circuit considers two different tests).

147. See *id.* (explaining that if alternative designs are not available the feature is functional).

148. See *id.* (explaining if such a barrier is probable, the feature is likely functional).

149. See *Louboutin*, 696 F.3d at 227 (finding secondary meaning to be the crux of the case).

150. See *In Re Florists' Transworld Delivery*, 106 U.S.P.Q.2d 1785, 1791 (T.T.A.B. 2013) (applying its analysis to several parts of the floral industry, including holiday containers and flowers).

151. See *id.* at 1793 n.6 (citing the *Qualitex* TTAB decision which originally prohibited single color registration).

152. See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 161 (1995) (reversing on appeal the Ninth Circuit's decision that color alone cannot be registered as a trademark).

153. See *id.* at 164 (holding that color may sometimes meet the basic legal

Mark followed the *Qualitex* precedent, and so it is unclear why the TTAB did not follow the decisions in these recent cases.¹⁵⁴ The TTAB's statement that color cannot have secondary meaning contradicted the Supreme Court precedent in *Qualitex* where the court held that color can identify a product and serve something other than a functional purpose.¹⁵⁵

Additionally, even without the *Qualitex* decision, courts have repeatedly shown a tendency to support the notion that color in the right context has just as much capacity to identify a brand as words or logos.¹⁵⁶ Long before, *Qualitex*, in *Yellow Cab Transit v. Louisville Taxicab & Transfer*, the Sixth Circuit recognized that the yellow on taxicabs was distinct enough to be given some trademark protection.¹⁵⁷ Likewise, in *In re Owens-Corning Fiberglass*, ten years before *Qualitex*, the Federal Circuit allowed the insulation company to trademark the pink color of its insulation product.¹⁵⁸ Finally, in *British Seagull Limited v. Brunswick*, another TTAB case decided two years before *Qualitex*, the court considered whether black could be trademarked, and it once again clarified that acquired secondary meaning is possible for colors.¹⁵⁹ Given this context, the TTAB's posture towards color trademarking in *FTD* was both misguided and historically inaccurate.¹⁶⁰

IV. POLICY RECOMMENDATIONS

It has been almost two decades since the Supreme Court weighed in on color trademarks. Although the contexts in which color can qualify for trademark protection is still unclear, there are two persuasive policy

requirements for use as a trademark).

154. See *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.* 679 F.3d 410, 421 (6th Cir. 2012) (holding that red in the red wax seal is protected); *Louboutin*, 696 F.3d at 213 (holding that the color red on the bottom of Louboutin's shoes can be protected).

155. See *Qualitex*, 514 U.S. at 166 (explaining that color alone in some instances can meet the basic legal requirements for use as a trademark).

156. See, e.g., *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945) (holding that the yellow color on taxicabs had acquired secondary meaning).

157. See *id.* at 411 (holding that defendant was precluded from using Yellow Cab Transit's distinctive "yellow scheme.").

158. See *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1120 (Fed Cir. 1985) (noting that under the language of the Lanham Act color marks are not precluded from registration).

159. See *British Seagull Ltd. v. Brunswick Corp.*, 28 U.S.P.Q.2d (BNA) 1197, 1200 (T.T.A.B. 1993) (explaining that because color is not inherently distinctive there must be a showing of secondary meaning).

160. See, e.g., *In re Owens-Corning Fiberglass Corp.*, 774 F.2d at 1120 (explaining that the Lanham Act explicitly allows for color trademarks).

arguments that support the notion that the continued use of the four-part test should be encouraged.¹⁶¹ First, it appears to provide a systematic way to evaluate color for trademark protection regardless of industry.¹⁶² Second, because the Supreme Court has not provided a test for determining whether color can be trademarked, the four-part test is the best tool available to resolve this question.¹⁶³ Accordingly, the TTAB should have more stringently applied this test, and in not doing so, failed to offer much needed guidance on the circumstances when color can be trademarked.¹⁶⁴

A. The Continued Application Of The Four-Part Test Provides A Systematic Way To Assess Color For Trademark Protection.

With the Sixth and Second Circuits similar application of the doctrines of aesthetic functionality, competition, and secondary meaning in *Maker's Mark* and *Louboutin*, the court showed a clear inclination towards the adoption of a four-part test.¹⁶⁵ Since courts have differing views on the purpose of the aesthetic functionality doctrine, synthesizing the prongs of these differing doctrines into one four-part standard eliminates confusion.¹⁶⁶ For instance, even in the similar *Louboutin* and *Maker's Mark* cases, the courts analyzed competition according to two different subtests.¹⁶⁷ If the courts continue to ignore the four-part test like it did in *FTD*, then confusion surrounding when color can be trademarked will perpetuate.¹⁶⁸

161. See McKenna, *supra* note 108, at 824 (stating that courts do not understand the aesthetic functionality doctrine).

162. Compare *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 414 (6th Cir. 2012) (evaluating whether a purported mark in the bourbon industry renders trademark protection), with *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 211 (2d Cir. 2012) (evaluating whether a single color in the fashion industry renders trademark protection).

163. See McKenna, *supra* note 108, at 824 (stating that courts have different views on the purpose of the aesthetic functionality doctrine).

164. See *id.* at 860 (stating that in evaluating trademarks under the aesthetic functionality doctrine there is "much work [improvement] to be done.").

165. See, e.g., *Louboutin*, 696 F.3d at 227 (holding that the case turns on secondary meaning).

166. See McKenna, *supra* note 108 at 823 (explaining that the use of the aesthetic functionality doctrine in case law is "scattered" with some courts refusing to recognize the doctrine, and others being reluctant to find any features aesthetically functional).

167. See *Maker's Mark Distillery*, 679 F.3d at 419 (applying the *Frisch* Test to analyze competition); *Louboutin*, 696 F.3d at 221 (asking only whether trademark protection would hinder competition by limiting the range of adequate alternative designs).

168. See McKenna, *supra* note 108, at 824 (highlighting the lack of consensus between courts on aesthetic functionality and trademark law).

Further, the *FTD* case made it easier to ignore secondary meaning, which is really the crux of color analysis.¹⁶⁹ Instead of looking comprehensively at all four factors under the four-part test, the TTAB presumed that if color is functional then it cannot have secondary meaning.¹⁷⁰ Because of the lack of standardization in evaluating color trademarks, courts need a test that can be used across industries. Establishing a set evaluative norm will eliminate further confusion, and this can be accomplished through the use and standardization of the four-part test.¹⁷¹

B. Because Of the Lack Of Guidance From the Supreme Court On Color Trademarks, Courts Must More Stringently Apply The Four-Part Test.

Concurring in *FTD*, Judge Bucher expressed support for the majority decision, but ardently noted that the majority opinion should have delved further into competitive necessity.¹⁷² Further, Judge Bucher also engaged in a deeper analysis of secondary meaning and rooted his concurrence in the notion that examining attorneys should exercise caution when using the term aesthetic functionality in light of historical confusion.¹⁷³ Highlighting that standardization in color trademarking is desperately needed, Judge Buchner proposed another test for color analysis: a bifurcated approach.¹⁷⁴ In introducing this alternative, Judge Bucher's concurrence emphasized that the majority did not fully analyze the facts according to whether the color black affects the purpose, price, competitive market for, and overall meaning of the product.¹⁷⁵

169. See *In re Florists' Transworld Delivery*, 106 U.S.P.Q.2d 1785, 1792 (T.T.A.B. 2013) (concluding that a finding of functionality precludes registration).

170. See *id.* at n.6 (stating "[a]lthough trade dress may be inherently distinctive, color can never be.").

171. See McKenna, *supra* note 108, at 860 (explaining that we cannot expect the aesthetic functionality doctrine to work in application without a better understanding of trademark law and competition).

172. See 106 U.S.P.Q.2d at 32 n.13 (T.T.A.B. 2013) (Bucher, J., concurring).

173. See *id.* at 1794 (discussing why trademark examiners should be cautious in applying aesthetic functionality).

174. See 106 U.S.P.Q.2d at 1795 (Bucher, J., concurring) (noting that his bifurcated approach is consistent with the latest version of the Trademark Manual for Examining Procedures).

175. See *Christian Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012) (holding that Louboutin's red sole mark can be trademarked on the basis of secondary meaning); *Maker's Mark Distillery, Inc. v. Diageo N. Am.*, 679 F.3d 410, 424 (6th Cir. 2012) (holding that because there is no competitive need for red wax, the Maker's Mark red wax seal can be trademarked).

V. CONCLUSION

The question of under what circumstances can color be trademarked remains unanswered, but the decisions in *Maker's Mark* and *Louboutin* introduce the possibility that when a color on a product satisfies the four-part test—encompassing the doctrines of functionality, competition, and secondary meaning— it can be trademarked.¹⁷⁶ The pertinent elements of the test include whether the color: (1) affects the purpose of the product; (2) affects the use of the product; (3) significantly impacts competition; and (4) has secondary meaning.¹⁷⁷ Further, the elements for determining whether a design feature, including color, has secondary meaning are: (1) advertising expenses; (2) consumer studies linking the color to the source of the product; (3) media coverage of the product; (4) sales success of the product; (5) attempts at plagiarism; and (6) length of time the color has been used to identify the source of the product.¹⁷⁸ However, due to the TTAB's poor application of these tests in *FTD*, this Comment argued that courts have a responsibility to more stringently apply all portions of the four-part test in such a way that is consistent with the *Maker's Mark* and *Louboutin* cases.¹⁷⁹ Furthermore, because the question remains unresolved of whether the four-part test is the best method for color analysis, it is time for the Supreme Court to expand upon its decision in *Qualitex* and set specific guidelines for determining when color can be trademarked.¹⁸⁰

At the very least, the analysis in *FTD*, must be revisited as a showing of functionality was not shown, and a complete analysis under the secondary meaning doctrine was never executed.¹⁸¹ Ultimately, this Comment argued that the court should reexamine the *FTD* case and fully analyze the color black in such a way that is consistent with the *Maker's Mark* and *Louboutin*

176. See *Qualitex Co. v. Jacobson Products, Co.*, 514 U.S. 159, 166 (1995).

177. See *Qualitex*, 514 U.S. at 170 (examining whether color that serves a non-functional purpose interferes with market competition); *Inwood Labs v. Ives Labs.*, 456 U.S. 844, 856-57 (1952) (examining whether mislabeling a generic drug with the brand name affects whether people use and purchase it); *Louboutin*, 696 F.3d at 224 (asserting that color is capable of acquiring a secondary meaning and identifying the brand name).

178. See *Louboutin*, 696 F.3d at 228; *Maker's Mark Distillery*, 679 F.3d at 424.

179. See *In re Florists' Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1785, 1788, 1790-91 (T.T.A.B. 2013) (misapplying the competition and secondary meaning prongs of the four-part test the TTAB finds a showing of functionality).

180. See *Qualitex*, 514 U.S. at 166 (concluding only that sometimes color can meet the basic legal requirements for trademark protection).

181. See 106 U.S.P.Q.2d at 1789 (describing how the misapplication of the four-part test resulted in a showing of aesthetic functionality without considering a secondary meaning analysis).

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analyses.¹⁸² Such a reexamination should concentrate on whether the color black affects: the purpose and price of the floral packaging; the market for flower boxes; and the acquired character of the packaging.¹⁸³ Further, this Comment suggested that courts should begin to consistently analyze color trademarks according to the four-part test because it is the most recent, clear, and systematic analysis available.¹⁸⁴

In *Qualitex*, the majority opinion made it clear that:

[O]ver time, customers may come to treat a particular color on a product or its packaging (say, a *color that in the context seems unusual*, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods . . . much in the way that descriptive words on a product . . . can come to indicate a product's origin.¹⁸⁵

Accordingly, now it is time to ensure that the circumstances under which such colors can be trademarked are clarified and standardized.¹⁸⁶

182. See, e.g., *Louboutin*, 696 F.3d at 228.

183. See *id.* at 224.

184. See *id.* at 206.

185. See *Qualitex*, 514 U.S. at 163 (quoting dicta from J. Breyer's majority opinion supporting the proposition that color can be trademarked).

186. See *id.* at 166.