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

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ASHLEY E. GREEN

I. Introduction ............................................................................................ 982
II. Background ........................................................................................... 984
   A. The History of Color Trademarks .................................................. 984
      1. Pre-Qualitex ........................................................................... 984
      2. Qualitex and Beyond ........................................................... 985
   B. Trademark Infringement Under The Lanham Act ..................... 985
   C. The Affirmative Defenses to Trademark Infringement:
      Utilitarian Functionality and Aesthetic Functionality .......... 986
      1. The Traditional Approach: Utilitarian Functionality ........... 986
      2. The Highly Fact-Specific Approach: Aesthetic
         Functionality ........................................................................ 987
      3. The Relationship Between Aesthetic Functionality and
         Secondary Meaning .................................................................. 989
   D. The Four-Part Test: Purpose, Price, Competition, and
      Character .................................................................................. 990
III. Analysis ............................................................................................... 993
   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 ......................... 993
   B. In FTD the TTAB Erred In Its Analysis Because It Did Not
      Apply the Four-Part Test for Trademark Color
      Infringement. ........................................................................... 996

*J.D. Candidate 2015, American University Washington College of Law; B.A. 2004, University of Delaware. I would like to thank Professor Christine Farley, Lauryn Guttenplan, and Peter Bean for their invaluable suggestions and encouragement. I would also like to express my gratitude to Megan McCray and my family for their unwavering support. Finally, I would like to thank the editorial staff of the American University Journal of Gender, Social Policy & the Law.

981
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. .......... 996

2. Because the TTAB Did Not Apply the Six-Factor Test Outlined In Louboutin, It Did Not Fully Engage In a Secondary Meaning Analysis. ..................... 999

C. In FTD the TTAB Erred In Its Analysis Because It Directly Contradicted the Supreme Court’s Holding in Qualitex. ....... 1001

IV. Policy Recommendations .............................................................. 1002

A. The Continued Application Of The Four-Part Test Provides A Systematic Way To Assess Color For Trademark Protection.............................................. 1003

B. Because Of the Lack Of Guidance From the Supreme Court On Color Trademarks, Courts Must More Stringently Apply The Four-Part Test. ........................................ 1004

V. Conclusion ......................................................................................... 1005

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

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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. 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.

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. In 2013, the Trademark Trial and Appeal Board (“TTAB”) addressed the question of whether a florist company could trademark the color black. 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. Unfortunately, the TTAB misapplied the test, leaving unanswered questions for other courts, and possibly the Supreme Court, to address.

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. 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.

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

2. Qualitex and Beyond

In 1995, the question of whether color could be trademarked finally reached the Supreme Court. In *Qualitex v. Jacobson Products*, Qualitex, used green-gold dry cleaning press pads, and its competitor, Jacobson Products, began selling similarly colored pads. The Supreme Court, in reversing the lower court’s decision, held that color was not ineligible for trademark protection. Furthermore, the Court was careful to observe that color can identify a product and serve something other than a functional purpose. 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.

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. The primary purpose of trademark protection is to ensure that the public knows who created a product, and that the trademark...
owner can benefit from building her brand’s reputation.\textsuperscript{27} Trademark law, unlike patent and copyright law, however, does not give a producer monopoly over a particular product.\textsuperscript{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.\textsuperscript{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.\textsuperscript{30} The functionality of a mark can be demonstrated through either utilitarian functionality or aesthetic functionality.\textsuperscript{31}

\textbf{C. The Affirmative Defenses to Trademark Infringement: Utilitarian Functionality and Aesthetic Functionality}

As the Supreme Court mentioned in \textit{Qualitex}, functional features on a product generally cannot be trademarked.\textsuperscript{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.\textsuperscript{33}

\textbf{1. The Traditional Approach: Utilitarian Functionality}

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

\begin{itemize}
\item \textsuperscript{27} See, e.g., \textit{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).
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{32} See \textit{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).
\item \textsuperscript{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).
\end{itemize}
the product is used or affects the cost of the product. 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. In Traffix Devices v. Marketing Displays, the Supreme Court examined the concept of utilitarian functionality. 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). 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. In other words, the alleged trademark was a functional part of the product configuration, and therefore could not be protected under the Lanham Act.

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. 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. 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

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).
design feature is considered functional and it will not be protected. 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. In *British Seagull v. Brunswick* an engine manufacturing company attempted to trademark the color black. In its decision, the Federal Circuit stated that the eligibility for trademark protection turned on the effect the design would have on competition. 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. 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. 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.

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. 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

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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).


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).


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).

sells its own brand of round beach towels. 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. Because of this practical characteristic, the Seventh Circuit found the design functional under the doctrine of aesthetic functionality.

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. 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. Because granting the trademark would effectively prevent others from making footballs, the court found the shape functional and not eligible for trademark protection. 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.

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. 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).


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.\textsuperscript{58} On appeal, the court acknowledged that the trademark examiner intertwined the issues of functionality and secondary meaning.\textsuperscript{59} The court emphasized that secondary meaning and functionality must be evaluated separately.\textsuperscript{60}

There are four parts to the test for color protection, but one of these factors is secondary meaning, which includes six sub-parts.\textsuperscript{61} In \textit{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.\textsuperscript{62}

\textbf{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.\textsuperscript{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.\textsuperscript{64} Three recent cases demonstrate the application of these tests with varying outcomes: \textit{Maker’s Mark Distillery v. Diageo}, \textit{Louboutin v. Yves Saint Laurent}, and \textit{In re Florists’ Transworld Delivery}.\textsuperscript{65}

In the May 2012, \textit{Maker’s Mark Distillery}, Maker’s Mark, a bourbon

\textsuperscript{58}. See id. at 1334-35 (noting that the examiner repeatedly emphasized that the container was a “non-distinctive purely functional container.”).

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

\textsuperscript{60}. See id. at 1335, 1344.

\textsuperscript{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).

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

\textsuperscript{63}. See, e.g., id.

\textsuperscript{64}. See id. (asserting that color is capable of acquiring secondary meaning and identifying a brand).

\textsuperscript{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); \textit{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. 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. The court did not uphold the aesthetic functionality defense. 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.

Five months later, in Louboutin, the Second Circuit upheld trademark protection for the red lacquered outer sole on Louboutin’s high-end footwear. At the time of the decision, Louboutin had been producing shoes featuring a red outer sole for about two decades. Appearing regularly on celebrities and icons in the fashion industry, Louboutin obtained a trademark for the well-known red soles in 2008. In 2011, competing fashion designer, Yves Saint Laurent (“YSL”) began making a monochromatic red shoe with a similar red sole. 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.

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).
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. In other words, when a red sole is placed on an all red shoe, there is no trademark protection. 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. 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.

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

## 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. Since *Qualitex*, when evaluating aesthetic features, including color, courts have taken a highly fact-specific approach. 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. 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.

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

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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).


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. 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.

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. 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. 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. 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.

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.
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).
102. See 106 U.S.P.Q.2d at 1792.
its analysis under the competition prong of the aesthetic functionality doctrine poorly.\textsuperscript{103}

\textbf{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{107}

\textbf{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.\textsuperscript{108} In evaluating the competition, the TTAB did not narrowly construe the market in the FTD case.\textsuperscript{109} Courts, however, have traditionally favored preserving competition within narrowly construed markets.\textsuperscript{110}

\begin{itemize}
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{105} See id. at 1792.
\item \textsuperscript{106} See id.
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{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).
\item \textsuperscript{110} See McKenna, supra note 108, at 832 (explaining that while the narrow
\end{itemize}
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).

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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).


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. 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. 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.

Analyzing the market across such broad terms misinterprets the purpose of trademark law. Trademark protection for a design feature, such as color, does not create monopoly control over that feature for all uses. 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. 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. 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. On appeal, the Second Circuit resolved this concern when it

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).
applied. 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. 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. 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. The court not only looked at the company’s extensive marketing campaign, but also the public attention that the brand received through the media. 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. 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. 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. 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. In both *Maker’s Mark* and *Louboutin*, the

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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.\textsuperscript{145}

Further, it is notable that in \textit{Maker’s Mark}, the Sixth Circuit laid out a fairly complicated, but thorough test for assessing competitive need.\textsuperscript{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.\textsuperscript{147} The second part of the test was whether trademark protection would prevent another manufacturer from competing in the same market.\textsuperscript{148} In \textit{Louboutin}, the Second Circuit focused less on the competition prong of functionality.\textsuperscript{149} Conversely, in \textit{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.\textsuperscript{150}

\textbf{C. In FTD the TTAB Erred In Its Analysis Because It Directly Contradicted the Supreme Court’s Holding in Qualitex.}

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

\begin{itemize}
\item \textsuperscript{145} \textit{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).
\item \textsuperscript{146} \textit{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).
\item \textsuperscript{147} \textit{See id.} (explaining that if alternative designs are not available the feature is functional).
\item \textsuperscript{148} \textit{See id.} (explaining if such a barrier is probable, the feature is likely functional).
\item \textsuperscript{149} \textit{See Louboutin}, 696 F.3d at 227 (finding secondary meaning to be the crux of the case).
\item \textsuperscript{150} \textit{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).
\item \textsuperscript{151} \textit{See id.} at 1793 n.6 (citing the \textit{Qualitex} TTAB decision which originally prohibited single color registration).
\item \textsuperscript{152} \textit{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).
\item \textsuperscript{153} \textit{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{159} Given this context, the TTAB’s posture towards color trademarking in FTD was both misguided and historically inaccurate.\textsuperscript{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).

\textsuperscript{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).

\textsuperscript{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).

\textsuperscript{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).

\textsuperscript{157} See id. at 411 (holding that defendant was precluded from using Yellow Cab Transit’s distinctive “yellow scheme.”).

\textsuperscript{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).

\textsuperscript{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).

\textsuperscript{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. \(^{164}\)

\[ A. \text{ The Continued Application Of The Four-Part Test Provides A Systematic Way To Assess Color For Trademark Protection.} \]

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).


\(^{163}\) 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. 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. 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.

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. 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. Highlighting that standardization in color trademarking is desperately needed, Judge Buchner proposed another test for color analysis: a bifurcated approach. 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.


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 1794 (discussing why trademark examiners should be cautious in applying aesthetic functionality).

173. See id. at 1795 (Bucher, J., concurring) (noting that his bifurcated approach is consistent with the latest version of the Trademark Manual for Examining Procedures).

174. 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. 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. 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. 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. 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.

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. 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

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.
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).
analyses. 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. 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.

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.

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

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.