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THINK PINK! COLOR CAN BE A TRADEMARK

The Lanham Act¹ governs the registration² and protection³ of trademarks⁴ used in interstate commerce.⁵ To qualify as a trademark, the owner of the

1. Lanham Act, 60 Stat. 427 (1946) (codified at 15 U.S.C. §§ 1051-1127 (1982)).

2. 15 U.S.C. §§ 1051-1096 (1982) (provisions governing trademark registration on Principle and Supplemental Registers). Under the Lanham Act, the owner of a trademark cannot obtain federal registration of the mark until the owner has used the mark in commerce. *Id.* § 1051. The term "commerce" under the Lanham Act means all commerce that Congress may regulate. *Id.* § 1127; see U.S. CONST. art. I, § 8 (Congress has power to regulate commerce with foreign nations, among states, and with Indian tribes). The Lanham Act provides for the federal registration of a mark on either the Principle Register or the Supplemental Register. See 15 U.S.C. § 1051 (satisfaction of enumerated prerequisites permits owner of trademark used in commerce to register on Principle Register); *id.* § 1091 (trademarks used in commerce and not registrable on Principle Register are registrable on Supplemental Register). Any trademark that distinguishes the goods or services of the registration applicant from the goods or services of others is registrable on the Principle Register unless the mark falls within certain exceptions provided in § 1052 of the Lanham Act. *Id.* § 1052(a)-(e). Subsection (a) of § 1052 bars the registration upon the Principle Register of immoral, deceptive, or scandalous matter. *Id.* § 1052(a). Subsection (b) prohibits the registration of a mark that consists of an insignia or simulation of an insignia of the United States, a state, a municipality, or a foreign nation. *Id.* § 1052(b). Subsection (c) bars the registration of names, portraits, or signatures of living persons without the written consent of those persons. *Id.* § 1052(c). Subsection (c) also prohibits the registration of the name, signature, or portrait of a deceased United States president during the widow's life except by written permission of the widow. *Id.* Subsection (d) bars the registration of any mark so similar to a currently registered trademark that, if applied to the applicant's goods, the mark likely would cause confusion, mistake, or deception in the marketplace. *Id.* § 1052(d). Subsection (e) prohibits the registration of a mark that is merely descriptive or deceptively descriptive of the owner's goods or of a geographical location. *Id.* § 1052(e). Additionally, subsection (e) bars the registration of a surname as a trademark. *Id.* Section 1052(f) of the Lanham Act provides that any mark not excluded under subsections (a)-(d) is registrable if the mark has "become distinctive" of the applicant's goods in commerce. *Id.* § 1052(f). A mark has "become distinctive" or gained "secondary meaning" if consumers associate the mark exclusively with the product owner. See *infra* notes 16-18 and accompanying text (defining acquired distinctiveness, otherwise known as secondary meaning); see also *infra* notes 124-37, 215-36 and accompanying text (discussing § 1052(f) as basis of secondary meaning test). Proof of substantially exclusive and continuous use of a mark in commerce by the applicant for the five years prior to application is *prima facie* evidence of acquired distinctiveness under subsection (f). 15 U.S.C. § 1052(f).

Although several conditions may prohibit registration on the Principal Register, the registration requirements for the Supplemental Register are less stringent. See *id.* § 1091. Marks that are not registrable on the Principle Register and do not fall within the § 1052(a)-(d) exceptions are registrable on the Supplemental Register. *Id.* Under § 1091 of the Lanham Act, the marks must be capable of distinguishing the applicant's goods or services. *Id.* In addition, the owner of the mark exclusively must have used the mark in connection with the owner's goods in commerce for the year prior to application. *Id.* Furthermore, if the applicant shows that the applicant requires domestic registration as a basis for foreign trademark protection, the one year use requirement may not be a prerequisite for registration. *Id.*

Registration on the Principal Register rather than on the Supplemental Register, however, creates several substantive and procedural advantages for the registrant. See *id.* §§ 1065, 1072, 1115(a), 1124. For example, a Principal Register registration, unlike a Supplemental Register registration, generally is incontestable if the owner continuously uses the trademark for five

consecutive years after registration. *See id.* § 1065 (conditions under which trademark incontestable). In addition, unlike registration on the Supplemental Register, registration on the Principal Register gives nationwide constructive notice of the registrant's claim of ownership. *Id.* § 1072. Registration on the Principal Register also constitutes prima facie evidence of the registrant's exclusive right to use the mark in commerce on the goods specified in the registration, whereas registration on the Supplemental Register does not constitute such prima facie evidence. *Id.* § 1115(a). Furthermore, the Principal Register registrant, unlike the Supplemental Register registrant, may record a registered trademark with the United States Treasury Department to block the importation of goods bearing an infringing mark. *See id.* § 1124 (forbidding importation of goods bearing infringing marks). *See generally* J. GILSON, 1 TRADEMARK PROTECTION AND PRACTICES §§ 4.02-4.05 (1985) (discussing substantive and procedural advantages of Principal Register registration).

While Principal Register registration is preferable to Supplemental Register registration, Supplemental Register registration is preferable to no federal trademark registration. *See* M. BERAN, AN INTRODUCTION TO TRADEMARK PRACTICE 144-45 (1970). Registration of a mark on the Supplemental Register gives the registrant the right to bring suit in a federal court without a showing of diversity of citizenship. *Id.* at 144. Supplemental Register registration also provides the basis for trademark registration in foreign countries in which the trademark owner has not used the mark. *Id.* In addition, registration on the Supplemental Register deters innocent infringement since persons seeking to select a trademark will search the trademark records of the United States Patent Office to determine the availability of the proposed mark. *Id.* at 145.

The process for registration on the Principal and Supplemental Registers begins with the trademark owner's filing of a signed, written application with the Patent and Trademark Office. *See* U.S.C. § 1051 (discussing application process for obtaining federal registrations of trademark). The application should specify the applicant's domicile, citizenship, the date of the applicant's first use of the mark, and the date of the applicant's first use of the mark in commerce. *Id.* § 1051(a)(1). The application also should describe the manner in which the applicant uses the mark in connection with specified goods or services. *Id.* Furthermore, the applicant must verify in writing on the application that the applicant is the rightful exclusive owner of the mark that the applicant seeks to register. *Id.*; *see* 37 C.F.R. § 2.31-2.47 (1985) (discussing requirement of written application in trademark registration). In addition to filing the written application, the registration applicant must submit a drawing of the mark and actual specimens or copies of the mark as used in commerce. 15 U.S.C. § 1051(a)(2)-(3); 37 C.F.R. § 2.51-2.58 (1985) (discussing drawing and specimen requirements in trademark registration application). The applicant also must pay the Patent and Trademark Office a filing fee. 15 U.S.C. § 1051(b). As of 1985, the filing fee was \$175 for each classification of goods for which the applicant sought registration. 37 C.F.R. § 2.6(a) (1985).

Upon the applicant's filing of an application and payment of the filing fee, the Commissioner of the Patent and Trademark Office (Commissioner) transfers the application to an Examiner, who determines the registrability of the mark. 15 U.S.C. § 1062; *see supra* (discussing requirements of registering on either the Principle or Supplemental Registers). The Examiner inspects the application for correctness in form and content and searches the records of the Patent and Trademark Office for prior registration of the mark by another market competitor. D. BURGE, PATENT AND TRADEMARK TACTICS AND PRACTICE 136-37 (2d ed. 1984). If the Examiner finds the applicant's mark unregistrable, the applicant may reply or amend the application within 6 months. 15 U.S.C. § 1062(b); *see* 37 C.F.R. § 6(g) (1985) (filing fee for amendment to trademark registration application is \$100). The applicant may repeat the amendment process until the Examiner makes a final ruling. 15 U.S.C. § 1062(b). The applicant may appeal any final decision of the Examiner to the Trademark Trial and Appeal Board (TTAB). *Id.* § 1067. The TTAB includes the Commissioner, the Deputy Commissioner, Assistant Commissioners, and other members appointed by the Commissioner. *Id.* If the Examiner finds the applicant's mark entitled to registration, the Commissioner will publish the mark in the Official Gazette of the Patent and Trademark Office after notifying the applicant. *Id.* § 1062(a). Any person who believes that the registration would damage him or her may file an opposition

mark must use the mark to identify the owner's product and to distin-

in the Patent and Trademark Office within 30 days after the publication. *Id.* § 1063. If anyone opposes the trademark registration, the Commissioner will notify all parties and refer the case to the TTAB for a determination of the applicant's right to registration. *Id.* § 1067.

The registration applicant or party to an opposition proceeding who is dissatisfied with the TTAB's decision may appeal to the United States Court of Appeals for the Federal Circuit within 60 days after the TTAB ruling. *Id.* § 1071(a)(1)-(2). The Commissioner must send to the Federal Circuit copies of all necessary papers and evidence specified by the parties. *Id.* § 1071(a)(3). In the case of an appeal by a registration applicant involving the Patent and Trademark Office (Office) as a litigant, the Commissioner additionally must furnish the circuit court with a brief, setting out the grounds of the Office's decision not to register the mark and the issues on appeal. *Id.* The Federal Circuit will not reverse a TTAB ruling unless the TTAB clearly erred in determining a question of fact or abused the TTAB's discretion in determining a question of law. J. GILSON, *supra*, § 3.05[4][a][ii].

As an alternative to appeal to the Federal circuit, the dissatisfied applicant or the party opposing registration may seek standard civil redress before any district court not less than 60 days after the TTAB ruling. 15 U.S.C. § 1071(b)(1). Unlike the Federal Circuit review, the district court proceeding is similar to a trial de novo in that the parties may present additional evidence not included in the TTAB record. *Id.* § 1071(b)(3)-(4); J. GILSON, *supra*, § 3.05[4][b]. If the parties do not present new evidence, however, the district court will employ the standard of review used in the Federal Circuit appeal process, reversing only for clear error or abuse of discretion. J. GILSON, *supra*, § 3.05[4][b][ii]. Even if the parties present new evidence, the district court must accord the TTAB findings considerable weight. *Id.*

3. See 15 U.S.C. § 1114 (1982) (providing remedy for infringement); *id.* § 1116 (empowering courts to grant injunctions to protect registrant's rights); *id.* § 1117 (providing registrant recovery of illegal profits, damages, and court costs in infringement suit); *id.* § 1118 (providing for destruction of infringing articles); *id.* § 1124 (forbidding importation of goods bearing infringing marks); *id.* § 1125 (establishing liability for use of false origin designations or false descriptions in connection with goods in commerce). Under the infringement provisions of the Lanham Act, a person is civilly liable if, without the registrant's consent, the person uses a copy of a registered mark in commerce in a manner that is likely to deceive or to cause mistake or confusion in the market. *Id.* § 1114(1)(a). A person also is liable for damages if the person deceptively or confusingly applies an imitation of a registered mark on goods the person intends to use in commerce. *Id.* § 1114(1)(b); see *id.* § 1114(2) (limiting remedies to owner of infringed right). No clear guide exists by which courts may determine the likelihood of consumer confusion in distinguishing among similarly marked goods. J. GILSON, *supra* note 2, § 5.01.

The United States Court of Appeals for the Fifth Circuit however has considered several conditions in determining the likelihood of confusion. See *Louisiana World Exposition, Inc. v. Logue*, 746 F.2d 1033, 1040 (5th Cir. 1984). The Fifth Circuit has looked at the nature of the marks involved, the similarity of the parties' marks, and the similarity of the marked goods. *Id.* In addition, the Fifth Circuit has considered the identity of retail outlets, purchasers, and advertising media. *Id.* Finally, the Fifth Circuit has examined the intent of the alleged infringer and the actual confusion generated in the market. *Id.*

4. See 15 U.S.C. § 1127 (1982). The United States Code defines trademark as any word, name, symbol, device, or any combination of such marks. *Id.*

5. See *id.* §§ 1127 (federal trademark protection extends only to trademarks used in interstate commerce); see also Trademark Act of 1905, 33 Stat. 724 (authorizing registration and protection of trademarks used in foreign and interstate commerce). See generally J. GILSON, *supra* note 2, § 1.04[1] (discussing Lanham Act replacement of Trademark Act of 1905 as federal trademark statute). Unlike the Lanham Act, the Trademark Act of 1905 required that the registration applicant exclusively use a mark for 10 years in commerce to show that the mark had acquired distinctiveness. Compare 15 U.S.C. § 1052(f) (1982) (five year presumption of acquired distinctiveness) with 33 Stat. 724 (1905) (10 year presumption of distinctiveness).

guish the owner's goods from the goods of competitors.⁶ An important issue arising in trademark litigation is whether the Lanham Act extends federal trademark protection to the color of a product.⁷ Whether federal trademark law protects the use of color is important because color attracts the consumer's attention to products and, therefore, is an effective marketing tool.⁸ The United States Supreme Court never has denied expressly the possibility that federal trademark law might protect color.⁹ Since the passage of the Lanham

Otherwise, the Lanham Act substantially parallels the Trademark Act of 1905. S. Rep. No. 1333, 79TH CONG., 2D SESS. 5, reprinted in 1946 U.S. Code Cong. & Ad. News 1274, 1275 [HEREINAFTER CITED AS 1946 Senate Report]. Before the passage of the Lanham Act, federal trademark statutes were widely scattered 1946 Senate Report, *supra*, at 1276; see, e.g., 52 Stat. 638 (1938) (authorizing registration of certain trademarks used to indicate membership in organization); 46 Stat. 590, 741 (1930) (Tariff Act of 1930 prohibiting importation of goods bearing infringing mark); 33 Stat. 724 (1905) (Trademark Act of 1905). Congress found that policies concerning trademark protection had changed since 1905 and that subsequent federal statutes had failed to keep pace with commercial practices. 1946 Senate Report, *supra*, at 1276. The Lanham Act repealed only those portions of former acts that were inconsistent with the Lanham Act. 15 U.S.C. § 1051. Congress in effect incorporated and refined the various trademark statutes in enacting the Lanham Act. 1946 Senate Report, *supra*, at 1276.

6. 15 U.S.C. § 1127 (1982); see Diamond, *The Historical Development of Trademarks*, 73 TRADE-MARK REP. 222,246-47 (1983) (discussing trademark functions). One commentator has described three functions of the modern trademark. Article, *supra*, at 246-47. First, through the trademark's identifying function, the consumer may distinguish among similar products. *Id.* at 246. Without such identification, the buyer could not make a knowledgeable choice among goods of varying quality. *Id.*; see J. GILSON, *supra* note 2, § 1.03 (trademark's identification of product and product source protects buyer from confusion and deception). Second, through the guarantee function, the trademark assures the buyer of consistent quality among goods bearing the trademark. Article, *supra*, at 246; see J. GILSON, *supra* note 2, § 1.03 (trademark denotes standard of quality and symbolizes good will of owner). Finally, the trademark serves as an advertising function, attracting the attention of potential purchasers. Article, *supra*, at 247; see *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge*, 316 U.S. 203, 205 (1942) (trademark induces buyer to purchase goods bearing that trademark).

7. See *infra* notes 9-260 and accompanying text (discussing cases addressing issue of color protection).

8. See Note, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 FORDHAM L. REV. 345, 345, 346 n.5 (1983) (color's aesthetic appeal is important to marketing potential of product); Lehrer, *Pink is Taken; But a Few Hues Are Still Left*, Wall St. J., Jan. 14, 1986, at 33, col. 3 (color is important marketing tool because color "grabs" consumer's attention); see also Diamond, *supra* note 6, at 247 (trademark advertising function important when products bought off shelf); *infra* notes 9, 196-97 and accompanying text (discussing doctrine of aesthetic functionality).

9. See *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 170-72 (1906). In *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, the United States Supreme Court denied infringement protection of the plaintiff's trademark. *Id.* at 170. The plaintiff's trademark consisted of an unspecified distinctively colored streak woven in a wire rope. *Id.* The Supreme court found the mark too indefinite to constitute a valid trademark. *Id.* The Supreme court, therefore, held that the defendant had not infringed upon the plaintiff's trademark rights when the defendant produced a similarly colored wire rope. *Id.* at 172. The Supreme Court further stated that protection of the plaintiff's trademark was doubtful even if the plaintiff had restricted the mark to a particular color applied in a particular manner. *Id.* at 171-72. The Court stated that though color impressed in a particular design could constitute a

Act in 1946, however, the majority of federal circuit courts have denied trademark protection of product color unless the product owner uses the color in conjunction with words, designs, or other distinguishing matter.¹⁰ In the recent case of *In re Owens-Corning Fiberglas Corp.*,¹¹ the United States Court of Appeals for the Federal Circuit considered whether the Federal Circuit should construe the Lanham Act, post-Lanham Act case law,

valid trademark, no court had ruled on the validity of color alone as trademark. *Id.* at 171. subsequently, in dictum, the Supreme Court referred to an English case in which the Chancery Division denied color protection to avoid potential monopoly of all the colors of the rainbow and, thus, to encourage free competition in commerce. *Id.* at 172. Nowhere in the *A. Leschen & Sons Rope Co.* decision, however, did the Supreme court expressly deny the possibility that color alone might gain trademark protection. *See id.* at 170-72 (containing no language expressly prohibiting federal trademark protection of color alone).

In the more recent case of *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, the Supreme Court suggested that product color may serve non-trademark functions, in which case color would not enjoy federal trademark protection. *See Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 853, 858-59 (1982) (Supreme Court suggested that functionality of capsule coloring might bar trademark protection of coloring); *see also Ives Laboratories, Inc. v. Darby Drug Co.*, 488 F. Supp. 394, 398-99 (E.D.N.Y. 1980) (denying trademark protection to capsules under functionality doctrine in part because patients associated capsule colorings with therapeutic affect). Under the functionality doctrine, courts generally deny protection of functional marks. *See infra* notes 45-50, 105-07, 189-92 and accompanying text (discussing cases in which court applied functionality doctrine). Functional marks are those product features that are essential to the use of a product or that merely affect the purpose, performance, or efficiency of a product. Note, *supra* note 8, at 359-61; *see* RESTATEMENT OF TORTS § 742 (1938) (defining "functional" product features); *see also Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982) (product feature functional if essential to use or purpose or if affects cost or quality of product). *See generally* 3 L. ALTMAN, CALLMAN UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 19.33 (1983) (discussing functional product features); Zelnick, *The Doctrine of Functionality*, 73 TRADE-MARK REP. 128, 128-50 (1983) (discussing history and court application of doctrine of functionality to promote free competition). In light of *Leschen* and *Inwood*, the issue whether color alone can gain federal trademark protection remains open. *See infra* notes 170-260 and accompanying text (suggesting that color alone may gain federal trademark protection).

10. *See, e.g., North Shore Laboratories Corp. v. Cohen*, 721 F.2d 514, 523 (5th Cir. 1983) (courts uniformly have rejected exclusive rights to color as trademark); *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 n.6 (2d Cir. 1979) (one cannot acquire trademark of color alone); *Quabaug rubber Co. v. Fabiano Shoe Co.*, 567 F.2d 154, 161 (1st Cir. 1977) (same); *Midwest Plastics Corp. v. Protective Closures Co.*, 285 F.2d 747, 750 (10th Cir. 1960) (basic colors cannot acquire secondary meaning because basic colors belong to public); *Mershon Co. v. Pachmayr*, 220 F.2d 879, 883 (9th Cir.) (finding color alone unprotectable as trademark), *cert. denied*, 350 U.S. 885 (1955); *Life Savers Corp. v. Curtiss Candy Co.*, 182 F.2d 4, 9 (7th cir. 1950) (producer cannot monopolize multi-stripping to distinguish goods); *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798 (3d Cir.) (no exclusive right found to use red & white labels), *cert. denied*, 338 U.S. 847 (1949); *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 96 (S.D. Iowa 1982) (color per se not capable of appropriation as trademark), *aff'd*, 721 F.2d 253 (8th Cir. 1983). *But see In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985) (granting trademark registration of pink for home insulation). *See generally* 3 L. ALTMAN, *supra* note 9, § 18.13 (overall color cannot designate trade identity); J. GILSON, *supra* note 2, § 2.11 (color per se not protectable as trademark); 1 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 7:16 (1973) (same).

11. 774 F.2d 1116 (Fed. Cir. 1985).

and federal policy interests to protect color alone as a trademark.¹²

In *In re Owens-Corning Fiberglas Corp.*, the appellant, Owens-Corning Fiberglas Corp. (OCF) was a manufacturer of fibrous glass home insulation.¹³ On January 25, 1980, OCF applied with the United States Patent and Trademark Office (Office) for trademark registration of the color pink, which OCF had applied to the entire surface of OCF's insulation product.¹⁴ OCF claimed entitlement to registration under section 1052(f) of the Lanham Act, which provides for the registration of marks that have become distinctive of the registrant's goods in commerce.¹⁵ A mark has acquired distinctiveness, otherwise known as secondary meaning,¹⁶ when the mark has lost the mark's natural meaning and has begun to symbolize the goods of a particular supplier.¹⁷ A mark may acquire distinctiveness through extensive advertising or through substantially exclusive and continuous use in commerce.¹⁸

To establish acquired distinctiveness, OCF presented substantial evidence to the Office in support of OCF's registration application.¹⁹ For example,

12. See *id.* at 1118-28 (considering trademark registration of pink applied to entire surface of home insulation); see also *infra* notes 62-149 and accompanying text (discussing holding and reasoning of Federal Circuit in *In re Owens-Corning Fiberglas Corp.*).

13. *In re Owens-Corning Fiberglas Corp.*, 221 U.S.P.Q. (BNA) 1195, 1196 (1984), *rev'd*, 774 F.2d 1116 (Fed. Cir. 1985).

14. See Appendix for Appellant at 1, *In re Owens Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (OCF application for trademark registration on Principle Register); see also *supra* note 2 (discussing registration process).

15. *Owens-Corning*, 221 U.S.P.Q. at 1196; see 15 U.S.C. § 1052(f) (1982) (providing for registration of marks that have acquired distinctiveness); see also *supra* note 2 (detailed discussion of § 1052 of Lanham Act).

16. See J. McCARTHY, *supra* note 10, § 15.2(F). One commentator has noted that two synonyms exist for the term "secondary meaning" that judges have commonly referred to in the judges' opinions decided under state common law principles. *Id.* The Lanham Act has used the term "has become distinctive," and the 1938 Restatement of torts has used "special significance." *Id.*; see 15 U.S.C. § 1052(g) (1982) (providing for registration of marks that have become distinctive); RESTATEMENT OF TORTS § 716 (1938) (referring to special significance of product designation); see also *infra* text accompanying notes 16-17 (defining secondary meaning); *infra* notes 71-82, 126-36, 218-26 and accompanying text (discussing cases addressing secondary meaning).

17. Diamond, *Untangling the Confusion in Trademark Terminology*, 73 TRADE-MARK REP. 290, 293 (1983); see J. GILSON, *supra* note 2, § 2.09. One commentator has stated that if marks do not perform the classical trademark functions of identifying and distinguishing an owner's product immediately upon adoption and use, the marks are unprotectable as trademarks unless the marks acquire secondary meaning. J. GILSON, *supra* note 2, § 2.09; see *supra* note 6 and accompanying text (discussing trademark functions). Through extensive use and advertising of the mark, the mark may acquire a secondary meaning, which identifies in the mind of the buyer the source of the products and distinguishes the products from the products of others. J. GILSON, *supra* note 2, § 2.09. Marks that have acquired secondary meaning generally are protectable as trademarks unless overriding public policies against monopolization and in favor of free competition exist. See *id.* § 2.09 [2] (discussing instances when public policy overrides secondary meaning to prevent trademark protection).

18. J. GILSON, *supra* note 2, § 2.09; see *infra* notes 124-35, 216-25, 255-56 and accompanying text (discussing what may constitute extensive advertising or substantially continuous use).

19. See Record at 11-81, *Owens-Corning* (evidence presented by OCF to Patent and

OCF submitted the affidavit testimony of OCF's Vice President of Marketing Communications.²⁰ The affidavit stated that OCF had used OCF's pink mark in conjunction with OCF home insulation since 1956.²¹ The affidavit further noted that OCF had spent more than 42 million dollars from 1972 to 1981 advertising OCF's pink product on television and radio, and in newspapers and magazines.²² The affidavit also stated that OCF had devoted additional expenditures to promotional materials.²³ The OCF Vice President's affidavit finally asserted that the results of an independent survey showed that consumer recognition of OCF as the manufacturer of pink insulation rose from forty-one percent in 1980 to fifty percent in 1981.²⁴ In addition to providing the affidavit, OCF presented the actual consumer survey evaluation²⁵ and numerous sample brochures to the Office as evidence of the acquired

Trademark Office to establish acquired distinctiveness); *see also infra* notes 20-26 and accompanying text (discussing evidence offered by OCF to Patent and Trademark Office).

20. *See* Record at 11, 15, *Owens-Corning* (two sworn affidavits by OCF Vice President of Marketing Communications concerning acquired distinctiveness of OCF pink mark).

21. *Id.* at 11.

22. *Id.* at 11-12; *see id.* at 67 (listing over 80 television advertisement spots in which OCF advertised pink insulation from August 17, 1980, to January 17, 1981); *see also id.* at 58 (listing consumer magazines carrying OCF advertisements).

23. *Id.* at 12; *see id.* at 24-81. During proceedings before the United States Patent and Trademark Office, Owens-Corning Fiberglas Corp. (OCF) presented to the Trademark Examiner sample brochures promoting OCF's pink insulation. *Id.* The brochures, included in the Appendix for the Appellant, reflect OCF's promotion of pink in connection with OCF's insulation product. *Id.* Some brochures used slogans, such as "Plant Some Pink Insulation In Your Attic" and "We'll Help You Keep Your Customer's Igloo Cool With The Pink Cooler," to promote sales of pink insulation. *Id.* at 32-39. Other brochures featured the cartoon characters, "Big Pink" or "Pink Panther." *Id.* at 40-81. OCF's April 23, 1981 amendment of OCF's January 25, 1980 registration application noted that the brochures featuring Pink Panther illustrated the then current OCF television advertisements. *Id.* at 8.

24. *See id.* at 13-14. The affidavit of OCF's Vice President of Marketing Communications (Vice President) described a consumer survey entitled "Unaided Awareness of Manufacturer of Pink Insulation: Male Homeowners." *Id.* The affidavit stated that Chilton Research conducted the survey of Ogililvy & Mather, Inc. of New York City upon the request of OCF. *Id.* at 13. The affidavit also summarized the telephone interview responses to the question "To the best of your knowledge, what manufacturer makes pink insulation?" *Id.* at 14. According to the consumer survey report, the survey results reflected only the responses of male homeowners. *Id.* at 20. The surveyor excluded the responses of female homeowners because the female interviewees showed little intent to purchase insulation. *Id.* Of 301 males interviewed in June 1980, 41% responded "Owens-Corning Fiberglas Corp.," to the question "... what manufacturer makes pink insulation?" *Id.* at 21. 14% of those interviewed in June 1980 responded with the name of another manufacturer. *Id.* In January 1981, 50% of the 801 male homeowners interviewed responded correctly with "Owens-Corning Fiberglas Corp.," and 14% responded incorrectly with the name of another manufacturer. *Id.* OCF's Vice President suggested in the Vice President's affidavit that the increase in consumer recognition of OCF as the manufacturer of pink insulation was due to OCF's Pink Panther advertising campaign. *Id.* In support of that assertion, the Vice President attached to the affidavit a magazine article describing the Pink Panther campaign as a "big splash." *Id.* at 15; *see id.* at 22 (magazine article entitled "Mfr. promotions boost insulation traffic").

25. *See id.* at 16-21 (consumer survey report).

distinctiveness of the color pink in the use of OCF home insulation.²⁶

The Examiner for the Office's Trademarks Examining Operation²⁷ reviewed the evidence of acquired distinctiveness presented by OCF and found OCF's pink mark unregistrable as a trademark for OCF home insulation.²⁸ The Examiner reasoned that despite OCF's extensive evidence of consumer recognition of the color pink in relation to OCF's insulation, OCF could not register the mark because of the nature of the mark.²⁹ Specifically, the Examiner relied on case precedent to conclude that color alone indiscriminately applied to the entire surface of a product could not function as a trademark.³⁰ Since OCF had applied the color pink indiscriminately to the entire surface of OCF's insulation, the Examiner denied registration of the OCF pink mark.³¹

26. See *id.* at 24-81 (sample brochures).

27. See *supra* note 2 (discussing role of Examiner in trademark registration process).

28. See Record at 4, 82, 89, *Owens-Corning*. In *In re Owens-Corning Fiberglas Corp.*, the Examiner for the Patent and Trademark Office's Trademarks Examining Operation (Examiner) first refused to register Owens-Corning Fiberglas Corp.'s (OCF) pink mark on November 3, 1980. *Id.* at 4. Based on OCF's application and drawing of OCF's pink insulation, the Examiner found that OCF's mark constituted a configuration or shape of the goods and was, thus, merely descriptive of OCF insulation. *Id.* The Examiner concluded that in the absence of a showing of acquired distinctiveness, the descriptive mark was unregistrable. *Id.* On April 23, 1981, OCF amended OCF's original application to claim only the color pink, not the shape of OCF insulation, as a trademark. *Id.* at 5. OCF included in the amended registration package evidence of the pink mark's acquired distinctiveness. *Id.* at 11-81; see *supra* notes 21-26 and accompanying text (discussing evidence presented to Examiner to establish acquired distinctiveness). On January 11, 1982, the Examiner affirmed the examiner's former denial of registration after considering OCF's supplemental evidence. Record at 82, *Owens-Corning*; see *supra* notes 29-31 and accompanying text (discussing Examiner's rationale in denying registration of pink mark).

29. Record at 82, *Owens-Corning*.

30. *Id.* (citing *In re The AFA Corp.*, 196 U.S.P.Q. (BNA) 772, 774-75 (T.T.A.B. 1977); *Plastilite Corp. v. Kassnar Imports*, 184 U.S.P.Q. (BNA) 348, 350 (C.C.P.A.), *aff'd* 508 F.2d 824 (C.C.P.A. 1975); *In re Ritchie Mfg. Co.*, 170 U.S.P.Q. (BNA) 291, 292 (T.T.A.B. 1971)).

31. Record at 82, *Owens-Corning*. In *In re Owens-Corning Fiberglas Corp.*, Owens-Corning Fiberglas Corp. (OCF) submitted to the Examiner a second amendment to OCF's original registration application on July 2, 1982. *Id.* at 83-87. In the second amendment OCF argued that the Trademark Trial and Appeal Board cases upon which the Examiner had relied to deny registration were distinguishable from the OCF facts. *Id.* at 85; see *supra* note 30 (listing cases on which Examiner relied in refusing to register pink mark). Specifically, OCF stated that in the cases cited by the Examiner the applicants had not presented evidence of secondary meaning. Record at 85, *Owens-Corning*. OCF proceeded to discuss the Trademark Trial and Appeal Board's grant of trademark registration in *In re Hehr Mfg. Co.* upon a showing of secondary meaning. *Id.* at 85-86 (citing *In re Hehr Mfg.*, 126 U.S.P.Q. (BNA) 381, 383 (TTAB), *aff'd*, 279 F.2d 526 (C.C.P.A. 1960)); see *infra* note 115 and accompanying text (discussing *Hehr*). On February 1, 1983, the Examiner made a final decision in response to OCF's second amendment. Record at 89, *Owens-Corning*. The Examiner distinguished *In re Hehr* from the OCF application on the basis that *In re Hehr* involved the registrability of red square labels whereas Owens-Corning's application concerned the registrability of the color pink applied to the entire surface of the insulation. *Id.* The Examiner, therefore, reaffirmed the Examiner's former decision that the color pink alone was unregistrable as a trademark for OCF home insulation. *Id.*

OCF appealed the Examiner's decision to the Trademark Trial and Appeal Board (TTAB).³² The TTAB considered whether the color pink applied uniformly to the surface of home insulation could constitute a valid trademark.³³ In determining the registrability of OCF's pink mark, the TTAB first acknowledged that a large body of prior TTAB decisions and past federal circuit court decisions had denied protection to marks consisting solely of color.³⁴ The TTAB noted, however, that several federal circuit courts and the TTAB had granted trademark registration to colors that formed part of an arbitrary, distinctive design or were arranged in an arbitrary, distinctive design.³⁵ An arbitrary, distinctive design is a design randomly applied to goods in a manner that does not describe or suggest characteristics of the product, but serves the classical trademark functions of identification and distinction.³⁶ In considering whether the OCF mark was an arbitrary, distinctive design, the TTAB examined the TTAB's earlier decision in *In re Shaw*³⁷ denying trademark registration of green suede covers for books.³⁸ In *In re Shaw* colored book covers were popular in the book

32. *Owens-Corning*, 221 U.S.P.Q. 1196; see *supra* note 2 (describing appellate review of Trademark Trial and Appeal Board decisions).

33. See *Owens-Corning*, 221 U.S.P.Q. at 1196-99 (considering registrability of OCF pink); see also *infra* notes 34-60 and accompanying text (discussing rationale and holding of Trademark Trial and Appeal Board in *In re Owens-Corning Fiberglas Corp.*).

34. See *Owens-Corning*, 221 U.S.P.Q. at 1196 (citing judicial decisions denying protection of color marks); see also, e.g., *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 827 (C.C.P.A. 1975) (half yellow and half orange coloring for fishing floats found to lack distinctiveness); *Volkswagenwerk Aktiengesellschaft v. Rickard*, 492 F.2d 474, 480 (5th Cir. 1974) (finding that automobile manufacturer had no exclusive rights in color blue under color depletion theory); *Life Savers Corp. v. Curtiss Candy Co.*, 182 F.2d 4, 9 (7th Cir. 1950) (multi-stripping of candy wrapper denied protection under functionality doctrine); *Campbell Soup v. Armour's Co.*, 175 F.2d 795, 789 (3d Cir. 1949) (red and white for canned food labels found unprotectable under color depletion theory). See generally *infra* notes 94-104 and accompanying text (discussing various doctrines under which courts have denied protection of colored marks).

35. *Owens-Corning*, 221 U.S.P.Q. at 1197; see, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat, Ltd.*, 604 F.2d 200, 203-04 (2d Cir. 1979) (uniform consisting of white boots, white shorts, blue blouse, star-studded vest and belt deemed arbitrary, distinctive design); *In re Data Packaging Corp.*, 453 F.2d 1300, 1302 (C.C.P.A. 1972) (contrasting colored band design found distinctive of owner's computer tape reels); *In re Esso Standard Oil Co.*, 305 F.2d 495, 498 (C.C.P.A. 1962) (label consisting of colored brands, oval frames, and dots found registrable as arbitrary distinctive design); *supra* note 120 (discussing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*); *supra* note 121 (discussing *In re Data Packaging Corp.*). See generally *infra* note 36 and accompanying text (defining arbitrary, distinctive design).

36. See J. McCARTHY, *supra* note 10, § 11:2. One commentator has described marks of arbitrary, distinctive design as one of the most common types of inherently distinctive marks. *Id.* Inherently distinctive marks are protectable as trademarks immediately upon use and require no proof of secondary meaning. *Id.*; see *supra* notes 16-18 and accompanying text (discussing secondary meaning). The term "arbitrary" denotes that the ordinary meaning of the mark is applied to the goods without descriptive or suggestive significance. J. McCARTHY, *supra* note 10, § 11:4(A). See generally *id.* § 11:4(c) (giving examples of arbitrary marks).

37. 184 U.S.P.Q. (BNA) 253 (T.T.A.B. 1974).

38. *Owens-Corning*, 221 U.S.P.Q. at 1197; see *In re Shaw*, 184 U.S.P.Q. at 255 (refusing to register green suede covers for books).

industry when the manufacturer sought registration of the green mark under the theory of acquired distinctiveness.³⁹ In addition, the manufacturer had applied the color green to the entire surface of the manufacturer's book covers.⁴⁰ The TTAB, in *In re Shaw*, therefore concluded that the book cover's green coloring lacked the arbitrary distinctiveness of design necessary to distinguish the applicant's books from the books of other manufacturers.⁴¹ Although insulation manufacturers generally did not apply color uniformly to insulation,⁴² the TTAB in *Owens-Corning* held that *In re Shaw* and other case precedent precluded the registration of the OCF mark under the theory of arbitrary distinctiveness of design because OCF had applied the color pink to the entire surface of OCF insulation and not in combination with other distinguishing matter.⁴³

Finding the OCF pink mark unregistrable in *Owens-Corning* under the arbitrary distinctiveness of design theory, the TTAB next considered whether the functionality doctrine would bar protection of the color pink.⁴⁴ Under the functionality doctrine, courts deny protection of functional product features, those features that are essential or useful to the performance or efficiency of a product.⁴⁵ In considering the functionality doctrine, the TTAB relied on the decision of *Deere & Co. v. Farmhand, Inc.*,⁴⁶ in which the United States District Court for the Southern District of Iowa had refused to protect the color, John Deere green, for farm machinery.⁴⁷ The district court noted in *Deere* that tractor owners generally bought tractor attachments in a color that matched the owner's tractors.⁴⁸ The district court, therefore, deemed John Deere green a functional mark, a mark that is essential or useful to the performance or efficiency of a product.⁴⁹ Adopting the doctrine

39. *In re Shaw*, 184 U.S.P.Q. at 255; see *supra* notes 16-18 and accompanying text (discussing theory of acquired distinctiveness).

40. *Id.*

41. *Id.*

42. See *Owens-Corning*, 221 U.S.P.Q. at 1198 (no evidence in records show widespread industry practice of dyeing insulation).

43. See *id.* at 1197 (distinguishing *Owens-Corning* from cases protecting colors arbitrarily applied in designs on basis that OCF applied pink to entire surface of goods).

44. *Id.* at 1197-98 (discussing functionality doctrine's application to *Owens-Corning*).

45. See *supra* note 9 (discussing doctrine of functionality).

46. 560 F. Supp. 85 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983).

47. *Owens-Corning*, 221 U.S.P.Q. at 1197-98; see *Deere*, 560 F. Supp. at 94-101 (considering protectibility of John Deere green for farm machinery).

48. *Deere*, 560 F. Supp. at 98.

49. See *id.*; see also *supra* note 9 (discussing functional marks). In *Deere & Co. v. Farmland, Inc.*, the United States District Court for the Southern District of Iowa considered whether the color, John Deere green, was an aesthetically functional mark in relation to farm machinery. *Deere*, 560 F. Supp. at 98; see Note, *supra* note 8, at 364 (aesthetically functional mark is pleasing in appearance and contributes substantially to value of goods). The district court noted that the early decisions under the doctrine of aesthetic functionality denied protection of aesthetic product features that were important to the commercial success of the product regardless of whether the product feature contributed to the efficient performance of the product. *Deere*, 560 F. Supp. at 97-98; see, e.g., *International Order of Job's Daughters v.*

of functionality, the district court in *Deere* denied trademark protection of the green color applied uniformly to the surface of farm equipment.⁵⁰ In light of *Deere*, the TTAB in *Owens-Corning* concluded that the functionality doctrine did not bar the registration of OCF's pink mark because the color pink served no function, aesthetic or otherwise, in relation to home insulation.⁵¹

Refusing to recognize the color pink as a functional product feature, the TTAB next addressed whether OCF's pink mark applied to the entire surface of OCF's insulation was protectable as product ornamentation.⁵² Product ornamentation is any feature that gives goods a unique external appearance.⁵³ The TTAB stated that ornamentation functioned primarily as a trademark to identify and distinguish the trademark owner's goods.⁵⁴ In determining

Lindeburg & Co., 633 F.2d 912, 918 (9th Cir. 1980) (design signifying fraternal organization used on jewelry held aesthetically functional as mode of expressing allegiance), *cert. denied*, 452 U.S. 941 (1981); *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343-44 (9th Cir. 1952) (floral design on hotel china denied protection because design important to product's commercial success); *J.C. Penney Co. v. H.D. Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941) (rounded bib pocket on overalls denied protection because mark contributed materially to product marketability). The *Deere* court stated, however, that a more recent decision interpreted the aesthetic functionality doctrine to bar, in the interest of free competition, only those aesthetic features related to the use of the product. *Deere*, 560 F. Supp. at 98; see *Keene v. Paraflex Indus., Inc.*, 653 F.2d 822, 826-28 (3d Cir. 1981) (denying protection of commercial lighting fixture under doctrine of aesthetic functionality because of marketable architectural compatibility between fixture and building design). Adopting the more recent approach, the *Deere* court concluded that John Deere green was aesthetically related to the use of John Deere farm machinery because farmers selected tractor attachments in a color that matched the farmer's tractors. *Deere*, 560 F. Supp. at 98. The *Deere* court, therefore, refused to extend trademark protection to the color John Deere green. *Id.*

50. *Deere*, 560 F. Supp. at 101; see *supra* note 9 (discussing doctrine of functionality).

51. *Owens-Corning*, 221 U.S.P.Q. at 1198. In *In re Owens-Corning Fiberglas Corp.* the Trademark Trial and Appeal Board held that the doctrine of aesthetic functionality did not bar the registration of the color pink for home insulation. *Id.* Unlike the situation in *Deere & Co. v. Farmhand, Inc.*, insulation consumers do not purchase insulation in a color to match the consumer's home furnishings because once installed, the insulation is out of public view. See Brief for the Commissioner of Patents and Trademarks at 11-12, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (once installed, insulation is out of sight); cf. *Deere*, 560 F. Supp. at 98 (John Deere green held aesthetically functional because consumers preferred matching farm equipment); *supra* notes 46-50 and accompanying text (discussing *Deere*).

52. *Owens-Corning*, 221 U.S.P.Q. at 1198-99.

53. See, e.g., *Vuitton et Fils S.A. v. J. Young Enter., Inc.* 644 F.2d 769, 773 (9th Cir. 1981) (considering protectibility of ornamental floral design for luggage); *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 826 (C.C.P.A. 1975) (addressing registrability of ornamental yellow and orange coloring for fishing floats); *Application of Swift & Co.*, 223 F.2d 950, 953-55 (C.C.P.A. 1955) (considering registrability of ornamentation consisting of polka dot banded label for household cleanser container).

54. *Owens-Corning*, 221 U.S.P.Q. at 1198; see, e.g., *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 332 (2d Cir. 1983) (ornamental mark may indicate product origin); *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 826 (C.C.P.A. 1975) (ornamentation not barred from registration if ornamentation primarily indicates product source); *Application of David Crystal, Inc.*, 296 F.2d 771, 773 (C.C.P.A. 1961) (fact that design is ornamental does not preclude design from becoming valid trademark); *Application of Swift & Co.*, 223 F.2d 950, 953

whether OCF's pink mark of ornamentation functioned as a trademark, the TTAB reviewed OCF's evidence paralleling evidence of secondary meaning and consisting of exclusive and continuous use, substantial advertising expenditures, and a survey indicating consumer recognition of OCF as the manufacturer of pink insulation.⁵⁵ The TTAB found that OCF's evidence did not establish that the pink color functioned as a trademark under the ornamentation doctrine.⁵⁶ The TTAB reasoned that OCF had failed to indicate the degree to which OCF advertisements had emphasized the color pink.⁵⁷ The TTAB also stated that OCF had failed to indicate the extent to which OCF had used the sample advertisements of record.⁵⁸ Furthermore, the TTAB criticized the survey for failing to show that buyers of home insulation had associated pink insulation with a single source.⁵⁹ The TTAB, therefore, affirmed the Examiner's decision to refuse trademark registration of the color pink.⁶⁰ OCF appealed the TTAB's decision to the United States Court of Appeals for the Federal circuit.⁶¹

In determining whether the TTAB properly denied OCF trademark registration, the Federal Circuit in *Owens-Corning* initially addressed the history of trademark protection for color before the Lanham Act.⁶² The

(C.C.P.A. 1955) (ornamental mark registrable if mark adopted and used primarily to identify and to distinguish product). *But cf. Plastilite*, 508 F.2d at 827 (mere ornamentation consisting of orange and yellow coloring for fishing floats found unregistrable); *Swift*, 223 F.2d at 953 (mere ornamentation or trade-dress not subject to trademark registration because ornamentation only gives goods distinctive external appearance.); *In re Paramount Pictures Corp.*, 213 U.S.P.Q. (BNA) 1111, 1113 (T.T.A.B. 1982) (merely ornamental marks do not function as indicators of product source).

55. *See Owens-Corning*, 221 U.S.P.Q. at 1198-99 (considering OCF's evidence offered to show secondary meaning); *see also supra* notes 20-26 and accompanying text (discussing OCF evidence of secondary meaning). In *In re Owens-Corning Fiberglas Corp.*, the Trademark Trial and Appeal Board (TTAB) refused to consider Owens-Corning Fiberglas Corp.'s (OCF) claim for registration under the Lanham Act's secondary meaning provision. *Owens-Corning*, 221 U.S.P.Q. at 1198 n.3; *see* 15 U.S.C. § 1052(f) (1982) (providing for registration of marks upon showing of secondary meaning). The TTAB in *Owens-Corning*, however, considered the same evidence that courts use to determine the existence of secondary meaning when the TTAB considered whether OCF pink, as ornamentation, functioned as a trademark. *Owens-Corning*, 221 U.S.P.Q. at 1198. The TTAB then noted that proving that a single color applied uniformly to the surface of goods functioned as a trademark required greater evidence of consumer recognition, use, and advertising than providing that an arbitrary and distinctive colored design functioned as a trademark. *Id.* The TTAB, however, did not specify the amount of evidence necessary to prove that ornamentation applied to a product functioned as a trademark. *Id.* Instead the TTAB merely stated that the evidence which OCF presented was insufficient to establish that OCF pink functioned as a trademark. *Id.* at 1199. *See generally* J. MCCARTHY, *supra* note 10, §§ 7:6-7:11 (discussing evidence required in proving that ornamentation functioned as trademark).

56. *Owens-Corning*, 221 U.S.P.Q. at 1199.

57. *Id.*

58. *Id.*

59. *Id.*

60. *Id.*

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

62. *Id.* at 1118-19.

Owens-Corning court first examined the 1906 United States Supreme Court case of *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*⁶³ In *Leschen*, the Supreme Court recognized, in dictum, that color in the form of a design, such as a square or circle, could constitute a valid trademark.⁶⁴ Relying on the popular color depletion theory, the Court in *Leschen*, however, doubted the validity of color alone as trademark.⁶⁵ The color depletion theory recognizes that a limited number of colors exist.⁶⁶ According to the theory, manufacturers' ownership of exclusive trademark rights in the use of primary colors eventually would deplete the number of available colors.⁶⁷ Consequently, new manufacturers in the industry, denied the use of colorful trademarks, would be unable to compete effectively in the market.⁶⁸

The *Owens-Corning* court acknowledged that the federal courts generally have adopted the Supreme Court's earlier dictum denying trademark protection of color alone.⁶⁹ The Federal Circuit noted, however, that at least two courts had protected single colors as trademarks upon the showing of acquired distinctiveness or secondary meaning.⁷⁰ First, the *Owens-Corning* court noted that in *Clifton Manufacturing Co. v. Crawford-Austin Manufacturing Co.*,⁷¹ the Court of Civil Appeals of Texas protected reddish-brown coloring for tents, tarpaulins, and wagon covers.⁷² In *Clifton*, the Texas

63. *Id.* at 1118; see *A. Leschen & Sons rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 166-72 (1906) (considering protectibility of colored wire strand woven into wire rope).

64. *Leschen*, 201 U.S. at 171; see *supra* note 9 (discussing *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*)

65. *Leschen*, 201 U.S. at 171; see *supra* note 9 (discussing *Leschen*).

66. See J. GILSON, *supra* note 2, § 2.11 (only seven primary colors exist); J. MCCARTHY, *supra* note 10, § 7:16 (very few colors are available for use in any industry).

67. J. GILSON, *supra* note 2, § 2.11; see J. MCCARTHY, *supra* note 10, § 7:16 (if seller could appropriate color, sellers would soon deplete all colors); see also Cooper, *Trademark Aspects of Pharmaceutical Product Design*, 70 TRADE-MARK REP. 1, 23 (1980) (traditional color depletion doctrine asserts that list of available colors will diminish if manufacturers monopolize major hues).

68. Cf. J. GILSON, *supra* note 2, § 2.11 (color depletion doctrine is based on federal policy against monopoly); J. MCCARTHY, *supra* note 10, § 7:16 (same).

69. *Owens-Corning*, 774 F.2d at 1118; see, e.g., *James Heddon's Sons v. Millsite Steel & Wire Works, Inc.*, 128 F.2d 6, 9 (6th Cir.) (color except in connection with definite, arbitrary symbol is not subject to trademark monopoly), *cert. denied*, 317 U.S. 674 (1942); *In re Security Eng'g Co.*, 113 F.2d 494, 496 (C.C.P.A. 1940) (color must be part of particular design to constitute trademark); *In re General Petroleum Corp.*, 49 F.2d 966, 968 (C.C.P.A. 1931) (as rule seller cannot monopolize color alone to distinguish product); *Radio Corp. of Am. v. Decca Records*, 51 F. Supp. 493, 495 (S.D.N.Y. 1943) (color must be in form of design to constitute trademark).

70. *Owens-Corning*, 774 F.2d at 1118-19; see *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945) (protecting yellow for taxicabs); *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.*, 12 S.W.2d 1098, 1102 (Tex. Civ. App. 1929) (protecting reddish-brown coloring for canvas products); see also *infra* notes 71-82 and accompanying text (discussing *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.* and *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*).

71. 12 S.W.2d 1098 (Tex. Civ. App. 1929).

72. See *id.* at 1102 (enjoining competitor's confusing and similar use of reddish-brown mark for canvas products).

appellate court considered whether the reddish brown color had acquired secondary meaning.⁷³ Clifton Manufacturing Co. (Clifton) had used the reddish-brown color for three years in commerce.⁷⁴ Clifton claimed that buyers asked for Clifton's canvas products by the coloring alone.⁷⁵ The appellate court, therefore, enjoined Crawford-Austin Manufacturing Co. from producing inferior canvas products with reddish-brown coloring similar to Clifton's colored mark.⁷⁶ The *Owens-Corning* court next reviewed the case of *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*,⁷⁷ in which the United States Court of Appeals for the Sixth Circuit protected Louisville Taxicab & Transfer Co.'s (Louisville Taxi's) long established use of the color yellow color for taxicabs.⁷⁸ The Sixth Circuit found Louisville Taxi's long established use of the color yellow protectable under the theory of secondary meaning.⁷⁹ Louisville Taxi had painted its cabs yellow with black trimming and black fenders and had used the word yellow in its various trade names for over twenty-five years.⁸⁰ In addition, Louisville Taxi's extensive advertising campaign resulted in the public's recognition of the Louisville Taxi color scheme and trade names.⁸¹ The Sixth Circuit, therefore, enjoined Yellow Cab Transit Co. (Yellow Cab) from painting its taxicabs yellow to prevent public confusion between Louisville and Yellow Cab taxicabs.⁸² The decisions of

73. See *id.* at 1100-01. In *Clifton Mfg. Co. v. Crawford-Austin Co.*, the Court of Civil Appeals of Texas stated that the rule governing the use of geographical names as trademarks governed the use of single color marks. *Id.* at 1100. A geographical mark describes the place where the manufacturer makes the product bearing the mark. J. GILSON, *supra* note 2, § 2.07. As a general rule, geographical marks must have secondary meaning to receive trademark protection. *Clifton*, 12 S.W.2d at 1100; see J. GILSON, *supra* note 2, § 2.07 (discussing trademark protection of geographical marks). The *Clifton* court, therefore, concluded that the court would protect a color mark that had secondary meaning. *Clifton*, 12 S.W.2d at 1101.

74. See *Clifton*, 12 S.W.2d at 1099 (Clifton began manufacturing reddish-brown canvas products in June 1926).

75. *Id.* at 1100.

76. *Id.* at 1102.

77. 147 F.2d 407 (6th Cir. 1945).

78. *Owens-Corning*, 774 F.2d at 1118-19; see *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d at 415 (protecting color yellow for taxicabs).

79. See *Yellow Cab*, 147 F.2d at 415. In *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, the United States Court of Appeals for the Sixth Circuit held that under the color depletion theory, Louisville Taxicab & Transfer co. (Louisville Taxi) had no right to the exclusive use of the primary color yellow. *Id.* The Sixth Circuit, nevertheless, protected Louisville Taxi's use of yellow cabs for transportation services in the city of Louisville upon a showing of secondary meaning. *Id.*; see *infra* notes 80-81 and accompanying text (discussing *Yellow Cab's* evidence indicating secondary meaning of yellow mark). *Id.*

80. See *Yellow Cab*, 147 F.2d at 409 (Louisville adopted yellow mark in 1919).

81. *Id.*

82. See *id.* at 415. In *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, the United States Court of Appeals for the Sixth Circuit ordered Yellow Cab Transit Co. (Yellow Cab) to identify Yellow Cab's building in the city of Louisville with the words, "Yellow Transit

Clifton and *Yellow Cab*, thus, left the door open to the Federal Circuit's further examination of the registrability of OCF's pink mark.⁸³

Acknowledging that case precedent did not necessarily bar the possibility of protection for color, the majority in *In re Owens-Corning Fiberglas Corp.* considered the legislative history of the Lanham Act in determining whether to grant protection to OCF pink as a trademark for OCF insulation.⁸⁴ The *Owens-Corning* court first examined the 1946 Report by the Senate Committee on Patents, which described the purpose of the Lanham Act.⁸⁵ The Report indicated that Congress had attempted to compile all federal statutes concerning trademarks into one piece of legislation, the Lanham Act.⁸⁶ The Report also suggested that Congress had intended to revise the existing federal statutes to conform to current commercial practices.⁸⁷ In addition, the Report revealed that Congress had intended to protect the public from the deception resulting from imitated marks and false trade descriptions.⁸⁸ Furthermore, through the enactment of the Lanham Act, Congress had sought to protect the established goodwill of the trademark owner in the product.⁸⁹ Finally, Congress had intended to make trademark registration simpler and more liberal.⁹⁰ The OCF court emphasized that the 1946 Senate Report had concluded that courts should construe the Lanham Act liberally to afford trademarks the greatest protection possible in light of the policy interests designed to promote consumer free choice and product goodwill in quality goods.⁹¹

Company, of Oklahoma City, Oklahoma Freight Lines." *Id.* The Sixth Circuit also ordered Yellow Cab to identify Yellow Cab trucks and taxicabs in the same manner. *Id.* The circuit court further stated that Yellow Cab must paint Yellow Cab taxicabs a color other than yellow. *Id.*

83. See *Owens-Corning*, 774 F.2d at 1119-28 (considering registrability of OCF pink mark for home insulation); see also *infra* notes 84-149 and accompanying text (discussing Federal Circuit's analysis of OCF mark for trademark registration).

84. *Owens-Corning*, 774 F.2d at 1119.

85. *Id.*; see 1946 SENATE REPORT, *supra* note 5, at 1274-77 (discussing purposes of Lanham Act).

86. 1946 SENATE REPORT, *supra* note 5, at 1276; see *supra* note 5 (discussing existence of widely scattered federal trademark statutes before passage of Lanham Act).

87. See 1946 SENATE REPORT, *supra* note 5, at 1276. The 1946 Senate Report by the Senate Committee on Patents stated that ideas concerning trademark law had changed in the 40 years since the passage of the Trademark Act of 1905. *Id.* The Senate Report further noted that federal statutes did not reflect the commercial development of trademarks. *Id.*

88. *Id.*

89. See *id.* at 1276. The report of the 1946 Senate Committee on Patents stated that federal law should protect the trademark owner's time and money invested in advertising the owner's mark from misappropriation by market competitors. *Id.*; see D. BURGE, *supra* note 2, at 120-21. One commentator has explained that trademarks are linked to the goodwill of the trademark owner's business. D. BURGE, *supra* note 2, at 121. The commentator noted that trademarks assure the public of quality and consistency in trademark bearing products. *Id.* The commentator, therefore, concluded that a manufacturer's trademark may constitute one of the manufacturer's most valuable assets. *Id.*

90. See 1946 SENATE REPORT, *supra* note 5, at 1274 (supporting liberal trademark registration's increased protection of trademarks).

91. See *Owens-Corning*, 774 F.2d at 1119 (legislative history of Lanham Act suggests that

The Federal Circuit in *Owens-Corning* explained that judicial decisions following the passage of the Lanham Act reflected the liberal view of trademark protection embodied in the Lanham Act.⁹² The Federal Circuit stated that those judicial decisions no longer had barred automatically the registration of colored marks.⁹³ Upon review of the case law concerning color protection, the *Owens-Corning* court concluded that the proper standard for registrability of colored marks involved a five-part test.⁹⁴ The first prong of the test required the court to determine whether the color was functional.⁹⁵ If the color was functional, then trademark protection for the color would be unavailable.⁹⁶ If the color was not functional, the next question was whether the color was solely ornamental.⁹⁷ If the color was solely ornamental, the Federal Circuit would deny trademark protection.⁹⁸ If the color was not solely ornamental, the circuit court would apply the third prong of the test that focused on whether the color was part of an arbitrary, distinctive design.⁹⁹ If the color was part of an arbitrary, distinctive design, the color was protectable if the marks satisfied the fifth prong of the test addressing federal policy.¹⁰⁰ If the color was not an element of an arbitrary, distinctive

public policy requires trademarks to receive greatest possible protection); 1946 SENATE REPORT, *supra* note 5, at 1277 (same).

92. See *Owens-Corning*, 774 F.2d at 1120 (post-Lanham Act case law suggests that all marks capable of being or becoming distinctive of goods are protectible); see, e.g., *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344 (C.C.P.A. (1982) (case remanded to determine registrability of spray pump container); *Application of Penthouse Int'l, Ltd.*, 565 F.2d 679, 682-83 (C.C.P.A. 1977) (stylized key logo as jewelry design held registrable); *Application of World's Finest Chocolate, Inc.*, 474 F.2d 1012, 1015 (C.C.P.A. 1973) (candy wrapping held registrable); *In re Swift & Co.*, 223 F.2d 950, 955 (C.C.P.A. 1955) (polka dot banded label found registrable).

93. *Owens-Corning*, 774 F.2d at 1120; see *infra* notes 105-07, 120-22, 132-36 and accompanying text (discussing post-Lanham Act decisions protecting color marks).

94. See *Owens-Corning*, 774 F.2d at 1120-28 (applying doctrines of functionality, ornamentation, arbitrary distinctiveness of design, secondary meaning and federal public policy in addressing color protection issue).

95. See *id.* at 1120-23 (discussing functionality of OCF mark); *infra* notes 105-12 and accompanying text (same); see also *supra* note 9 (discussing functionality doctrine).

96. See *Owens-Corning*, 774 F.2d at 1120-23 (discussing functionality of OCF pink); *infra* notes 105-12 and accompanying text (same); see also *supra* note 9 (discussing functionality doctrine).

97. See *Owens-Corning*, 774 F.2d at 1124-25 (considering significance of OCF pink as ornamental mark); *infra* notes 113-17 and accompanying text (same); see also *supra* notes 53-54 and accompanying text (defining ornamentation doctrine and explaining that mere ornamentation does not identify and distinguish goods primarily).

98. See *Owens-Corning*, 774 F.2d at 1124-25 (considering significance of OCF pink as ornamental mark); see also *infra* notes 53-54 and accompanying text (defining ornamentation doctrine).

99. See *Owens-Corning*, 774 F.2d at 1120, 1123-25 (addressing doctrine of arbitrary distinctiveness of design); *infra* notes 118-23 and accompanying text (same); see also *supra* note 36 and accompanying text (defining arbitrary distinctive design).

100. See *Owens-Corning*, 774 F.2d at 1122-24 (considering federal policy interests of free competition and trademark protection embodied in color depletion and shade confusion doctrines); *infra* notes 138-48 and accompanying text (same); see also *supra* notes 66-68 and accompanying text (defining color depletion doctrine).

design, the circuit court next would consider whether the color had secondary meaning.¹⁰¹ If the color did not have secondary meaning, the Federal Circuit would deny trademark protection.¹⁰² If the circuit court found that the color had secondary meaning, the Federal Circuit would proceed to consider the final prong of the test concerning federal policy considerations.¹⁰³ Only if no overriding federal policy interest existed would the Federal Circuit then grant protection of a color mark.¹⁰⁴

In determining whether the OCF pink mark was a functional feature of home insulation, the Federal Circuit in *Owens-Corning* reviewed federal circuit court decisions that had found functional color marks such as reflective, colored coatings for fence posts,¹⁰⁵ blue dots for flashbulbs,¹⁰⁶ and the color green for farm machinery.¹⁰⁷ The Federal Circuit concluded that the relevant considerations under the functionality doctrine were whether the color mark served a utilitarian or economical purpose and whether alternative color marks existed to maintain free competition.¹⁰⁸ On the issue of functionality, the *Owens-Corning* court found persuasive that OCF was the only manufacturer among the few insulation producers who dyed fibrous glass insulation a color different from the insulation's natural yellow-white color.¹⁰⁹ The Federal Circuit further found no evidence in the record to suggest that OCF competitors desired or needed to dye the competitors' insulation products.¹¹⁰ The *Owens-Corning* court, therefore, concluded that OCF's use

101. See *Owens-Corning*, 774 F.2d at 1124-28 (applying secondary meaning doctrine); *infra* notes 124-37 and accompanying text (same); see also *supra* notes 16-18 and accompanying text (defining secondary meaning).

102. See *Owens-Corning*, 774 F.2d at 1124-28 (applying secondary meaning doctrine); *infra* notes 124-37 and accompanying text (same); see also *supra* notes 16-18 and accompanying text (defining secondary meaning).

103. See *Owens-Corning*, 774 F.2d at 1122-24 (considering policy interests of free competition and trademark protection embodied in color depletion and shade confusion doctrines); *infra* notes 138-48 and accompanying text (same); see also *supra* notes 66-68 and accompanying text (defining color depletion doctrine).

104. See *Owens-Corning*, 774 F.2d at 1122-24 (considering policy interests behind color depletion and shade confusion theories); *infra* notes 138-48 and accompanying text (same).

105. *Owens-Corning*, 774 F.2d at 1121; see *In re Pollak Steel Co.*, 314 F.2d 566, 570 (C.C.P.A. 1963) (denying registration of functional reflective coating applied to tops of fence posts).

106. *Owens-Corning*, 774 F.2d at 1121; see *Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 733-34 (3d Cir. 1957) (despite showing of secondary meaning, functional blue dot for flashbulbs denied protection).

107. *Owens-Corning*, 774 F.2d at 1121; see *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 101 (S.D. Iowa 1982) (refusing to protect aesthetically functional green coloring for farm equipment); see also *supra* notes 46-50 and accompanying text (discussing *Deere & Co. v. Farmhand, Inc.*).

108. *Owens-Corning*, 774 F.2d at 1121; accord *In re Morton-Norwick Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982) (considering under functionality test whether color serve utilitarian or economical purpose and whether alternative color existed).

109. *Owens-Corning*, 774 F.2d at 1122; see Record at 21, *Owens-Corning* (identifying only four manufacturers of home insulation).

110. *Owens-Corning*, 774 F.2d at 1122. But see *id.* at 1130 (Bissell, J., dissenting) (asserting

of the color pink served no necessary function in relation to home insulation and conferred no monopoly in the insulation market.¹¹¹ The Federal Circuit, thus, found the functionality doctrine inapplicable in *Owens-Corning*.¹¹²

Finding the OCF mark non-functional, the Federal Circuit next considered the pink mark's status as mere ornamentation.¹¹³ The *Owens-Corning* court noted that courts generally perceive color marks as ornamentation.¹¹⁴ The Federal Circuit did not determine expressly whether the OCF's pink mark was ornamental.¹¹⁵ The *Owens-Corning* court noted, however, that whether the pink mark was incidentally ornamental was unimportant because the mark's status as ornamentation would not preclude the mark's functioning primarily as a trademark.¹¹⁶ The Federal Circuit explained that ornamental marks also may obtain trademark protection under either the arbitrary distinctive design doctrine or the secondary meaning doctrine.¹¹⁷

Having found the issue of ornamentation irrelevant to the pink mark's registrability, the *Owens-Corning* court addressed the issue of arbitrary distinctiveness of design.¹¹⁸ An arbitrary, distinctive design randomly combines color with other distinguishing matter to identify and distinguish a particular owner's goods.¹¹⁹ The *Owens-Corning* court first reviewed cases in which federal circuit courts had granted protection of arbitrary distinctive designs such as red, white, and blue cheerleading uniforms,¹²⁰ contrasting

that registration of OCF pink would grant OCF monopoly in insulation industry that OCF already dominated); *infra* notes 163-66 and accompanying text (discussing dissent's argument in *Owens-Corning* that color protection would result in monopoly of insulation market). In *In re Owens-Corning Fiberglas Corp.* the dissent noted that pink insulation was practically synonymous with home insulation market. *Owens-Corning*, 774 F.2d at 1130 (Bissell, J., dissenting). The dissent, therefore, concluded that if insulation manufacturers could not make pink insulation, the manufacturers could not compete effectively in the insulation market. *Id.* The dissent's fear of monopoly, however, is unreasonable because the record in *Owens-Corning* did not indicate that OCF competitors desired or needed to dye the competitors' insulation pink or any other color. *Id.* at 1122.

111. *Owens-Corning*, 774 F.2d at 1123.

112. *See id.* at 1122 (registration of OCF pink for insulation not barred on basis of functionality).

113. *See id.* at 1124-25 (considering significance of pink as ornamentation).

114. *Id.* at 1124.

115. *See id.* at 1124-25 (majority fails to determine whether OCF pink is ornamental mark).

116. *Id.* at 1124; *see supra* note 54 (listing cases finding that ornamental marks are registrable if marks identify and distinguish owner's goods).

117. *Owens-Corning*, 774 F.2d at 1124.

118. *Id.* at 1120, 1123-25.

119. *See supra* note 36 and accompanying text (defining arbitrary, distinctive design).

120. *Id.* at 1120; *see Dallas Cowboys Cheerleaders, Inc. v. Pussycat, Ltd.*, 604 F.2d 200, 207 (2d Cir. 1979). In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema*, the United States Court of Appeals for the Second Circuit enjoined the defendant, Pussycat Cinema, from distributing or exhibiting a film featuring a uniform similar to the ones worn by the plaintiff's Dallas Cowboy Cheerleaders. *Dallas Cowboys*, 604 F.2d at 206-07. The Second Circuit found the combination of white boots, white shorts, blue blouse, and white star-studded vest and belt to be an arbitrary design worthy of trademark protection. *Id.* at 203-04.

colored bands applied to computer reels,¹²¹ and red square labels applied to automobile trailer windows.¹²² The Federal Circuit suggested, however, that OCF's pink mark applied uniformly to the entire surface of OCF's insulation product was not arbitrarily distinctive in design.¹²³

The *Owens-Corning* court next focused on whether OCF's mark had secondary meaning under section 1052(f) of the Lanham Act.¹²⁴ Section 1052(f) of the Lanham Act provides that five years of substantially continuous and exclusive use of a mark in commerce by the registration applicant constitutes prima facie evidence of secondary meaning.¹²⁵ The circuit court noted that the exact type and amount of evidence needed to prove secondary meaning depended on the facts of each case.¹²⁶ The *Owens-Corning* court, however, stated that the registration applicant generally must submit evidence concerning the applicant's use of the mark.¹²⁷ According to the evidence presented by OCF, OCF had used the pink mark exclusively and continuously

121. *Owens-Corning*, 774 F.2d at 1120; see *Application of Data Packaging Corp.* held an annular unspecified colored band applied to a particular location on computer tape reels registrable as a trademark. *Data*, 453 F.2d at 1304. The court found the color contrasting band distinctive of the product's origin although the design's specific color varied among Data Packaging Corp. (Data) goods. *Id.* at 1302. The court further found no evidence that other producers in the industry had used designs similar to Data's design on their products. *Id.* at 1303. Data's colored mark, therefore, retained its capacity to function as a trademark. *Id.*

122. *Owens-Corning*, 774 F.2d at 1120; see *Application of Hehr Mfg. Co.*, 279 F.2d 526, 527-28 (C.C.P.A. 1960). The United States Court of Customs and Patents Appeals (C.C.P.A.) in *Application of Hehr Mfg. Co.* granted trademark registration of square red labels applied to automobile trailer windows. *Hehr*, 279 F.2d at 527-28. Hehr Manufacturing Co. (Hehr) submitted evidence that Hehr had used the red square mark continuously since 1950. *Id.* at 527. Hehr's evidence also showed that since 1954 Hehr had advertised its mobile home windows, emphasizing the shape and color of the Hehr mark. *Id.* at 527-28. In addition, Hehr presented evidence that Hehr had expended \$112,000 in total advertising costs, and \$30,000 specifically, towards promoting the red square. *Id.* at 528. Hehr advertisement slogans included, "Look for these red stickers: they are your guide to quality." *Id.* Finally, Hehr submitted the results of a survey taken among trailer manufacturers to show that a majority of persons surveyed associated the red square with Hehr's products. *Id.* The C.C.P.A. concluded that Hehr's red square mark had acquired secondary meaning, and, thus, was entitled to registration. *Id.*

123. See *Owens-Corning*, 774 F.2d at 1124 (if mark is not inherently distinctive, mark is registrable upon showing of secondary meaning); see also *supra* note 43 (arbitrary distinctive mark is inherently distinctive).

124. See *Owens-Corning*, 774 F.2d at 1124-28 (considering secondary meaning doctrine); see also 15 U.S.C. § 1052(f) (1982) (providing for registration of marks with secondary meaning).

125. 15 U.S.C. § 1052(f) (1982); see *supra* note 2 (discussing § 1052 of Lanham Act in detail).

126. *Owens-Corning*, 774 F.2d at 1125; accord *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 663 (2d Cir. 1979) (court must determine secondary meaning based on facts of each case, *cert. denied*, 445 U.S. 951 (1980); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528 (C.C.P.A. 1960) (same)).

127. *Owens-Corning*, 774 F.2d at 1125; see *Barton v. Rex-Oil Co., Inc.*, 2 F.2d 402, 405 (3d Cir. 1924) (length of use usual but not exclusive standard to determine secondary meaning). See generally J. Gilson, *supra* note 2, § 2.09[1] (length, manner, and exclusivity of use bear directly on mark's secondary meaning).

for 29 years.¹²⁸ The Federal Circuit also stated that the applicant generally must show that the applicant's use of the mark has caused the consumer to identify the mark with the source of the product.¹²⁹ In determining the extent of consumer recognition of the OCF mark as an indicator of OCF home insulation, the *Owens-Corning* court considered OCF's consumer survey.¹³⁰ In response to the TTAB's criticism that OCF failed to state the degree to which advertisements focused on the color pink,¹³¹ the circuit court stated that the amount of advertising expenditures alone may serve as strong evidence of secondary meaning.¹³² The Federal Circuit, thus, stated that an applicant need not show that the applicant specifically directed expenditures to promote a mark when the applicant had made very large expenditures.¹³³ The *Owens-Corning* court, therefore, found OCF's expenditure of over forty-two million dollars made from 1972 to promote OCF's pink insulation highly probative in determining secondary meaning.¹³⁴ Furthermore, the Federal

128. *Owens-Corning*, 774 F.2d at 1125; see *supra* note 21 and accompanying text (discussing OCF's exclusive and continuous use of pink mark since 1956).

129. *Owens-Corning*, 774 F.2d at 1125.

130. *Id.* at 1125-1128; see *supra* notes 22-26 and accompanying text (discussing OCF's advertisement of pink insulation and OCF's consumer survey).

131. See *Owens-Corning*, 221 U.S.P.Q. at 1199 (criticising OCF evidence of secondary meaning on ground that OCF failed to show that advertisements focused on color pink).

132. *Owens-Corning*, 774 F.2d at 1125; accord *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823, 829 n.10 (C.C.P.A. 1970) (amount of advertising alone is highly probative of secondary meaning); see *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (\$400,000 advertising expenditures over five year period evidence of secondary meaning); *American Seventh Chemical, Inc., v. American Hosp. Supply Corp.*, 690 F.2d 791, 792 (9th Cir. 1982) (annual advertising expenditure of \$8,500,000 evidence of secondary meaning); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528 (C.C.P.A. 1960) (advertising expenditures of \$112,000 found indicative of secondary meaning); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 141 (C.C.P.A. 1954) (only one-third of \$1,135,000 devoted to promoting mark over six year period found indicative of secondary meaning). But see *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 663 (2d Cir. 1979) (promotion expenditures exceeding \$20,000,000 insufficient to prove secondary meaning); *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir.) (\$3,000,000 spent in advertising found insufficient to show secondary meaning), *cert. denied*, 398 U.S. 928 (1970); see also *Bank of Texas v. Commerce Southwest, Inc.*, 741 F.2d 785, 788 (5th Cir. 1984) (in determining secondary meaning, results achieved by advertising more important than amount spent); *Zatarains, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (same); *Aloe Creme Laboratories, Inc.*, 423 F.2d 845, 850 (5th Cir.) (same), *cert. denied*, 398 U.S. 928 (1970).

133. *Owens-Corning*, 774 F.2d at 1125; see *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1060 (2d Cir. 1979) (district court properly found plaintiff's thirty-six million dollar advertising campaign highly probative of secondary meaning without regard to advertisement's specific focus on mark); see also *In re American Home Prods. Corp.*, 226 U.S.P.Q. (BNA) 327, 330 (TTAB 1985) (given plaintiff's advertising expenditure of eight million dollars, plaintiff's failure to focus advertisements specifically on mark does not preclude trademark protection); cf. *Thompson Medical Co. v. Pfizer, Inc.*, 753 F.2d 208, 217 (2d Cir. 1985) (no single type of evidence determinative and every type of evidence need not exist to prove secondary meaning); *Zatarains*, 698 F.2d 786, 795 (5th Cir. 1983) (same); *Am. Footwear Corp.*, 609 F.2d 655, 663 (2d Cir. 1979) (same).

134. See *Owens-Corning*, 774 F.2d at 1125, 1127 (finding expensive, wide promotion of pink mark in conjunction with OCF home insulation strong evidence of secondary meaning).

Circuit recognized that OCF spend additional sums on promotional items specifically highlighting OCF's pink mark.¹³⁵ Moreover, the Federal Circuit stated without elaboration that the TTAB's criticism of the independent survey for inhibiting multiple interviewee responses did not require outright rejection of OCF's survey showing that fifty percent of the survey respondents associated pink insulation with OCF.¹³⁶ The Federal Circuit, therefore, concluded that OCF had established the secondary meaning of its mark.¹³⁷

Having found that OCF's pink mark had secondary meaning, the *Owens-Corning* court finally considered whether overriding federal policy interests of free competition and effective trademark protection warranted against the registration of the OCF mark.¹³⁸ The Federal Circuit first addressed the popular color depletion theory based on the federal policy against market monopoly.¹³⁹ The circuit court stated that when no competitive need, aesthetic or otherwise, exists for colors to remain available to market competitors, as in the case of *Owens-Corning*, the color depletion theory unreasonably restricted the acquisition of trademark rights.¹⁴⁰ The *Owens-Corning* court, therefore, rejected the color depletion theory as inapplicable to OCF's situation.¹⁴¹ The Federal Circuit next addressed the shade confusion theory based on the federal policy in favor of effective trademark protection.¹⁴²

135. See *id.* at 1127; see also *supra* note 23 and accompanying text (describing OCF promotional items focusing on pink mark). In *In re Owens-Corning Fiberglas Corp.*, Owens-Corning Fiberglas Corp. (OCF) submitted evidence showing that OCF supplied insulation dealers with point-of-sale advertising materials associated with OCF television campaigns. *Owens-Corning*, 774 F.2d at 1127. The Trademark Trial and Appeal Board (TTAB) had criticized this evidence on the ground that OCF had failed to indicate the degree to which dealers actually had used the advertising materials. *Owens-Corning*, 221 U.S.P.Q. at 1199. The United States Court of Appeals for the Federal Circuit responded that the TTAB's objection did not outweigh the total evidence of OCF's broad distribution and sales efforts. *Owens-Corning*, 774 F.2d at 1127. The Federal Circuit further noted that OCF's offer of pink promotional items, such as coffee mugs and stuffed animals, to real estate developers was indicative of the pink mark's secondary meaning. *Id.*

136. *Owens-Corning*, 774 F.2d at 1127; see *Owens-Corning*, 221 U.S.P.Q. at 1199 (criticizing OCF survey for inhibiting multiple responses); see also *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (23% telephone responses and 28% personal responses associating mark with product source held sufficient to establish secondary meaning); cf. *Wesley-Jessen Div. of Schering Corp. v. Bausch & Lomb, Inc.*, 698 F.2d 862, 865-66 (7th Cir. 1983) (court credits survey showing 96.7% correct responses and rejects survey showing 7.7% correct responses). But see *Bank of Texas v. Commerce Southwest, Inc.*, 741 F.2d 785, 789 (5th Cir. 1984) (rejecting as evidence of secondary meaning telephone survey showing that 58.7% of those interviewed had heard of "Bank of Texas"); *Harlequin Enter. Ltd. v. Gulf & Western Corp.*, 644 F.2d 946, 950 n.2 (2d Cir. 1981) (consumer survey showing 50% correctly identified mark with product source found inconclusive because of seller's dominance in market).

137. *Owens-Corning*, 774 F.2d at 1128.

138. See *id.* at 1122-24 (discussing color depletion and shade confusion theories).

139. *Id.* at 1122; cf. *infra* notes 179-82 and accompanying text (federal policy interest exists not to promote monopolies).

140. *Owens-Corning*, 774 F.2d at 1122.

141. *Id.*

142. *Id.* at 1123; cf. *infra* notes 175-78 and accompanying text (federal policy interest exists to grant only effective trademark protection).

According to the shade confusion theory, if courts protect color as trademark, courts will have the difficult task of determining the likelihood that the public will mistake similarly colored marks for the registered colored mark.¹⁴³ To avoid such confusion, proponents of the shade confusion theory suggest that courts should protect color as trademark.¹⁴⁴ The *Owens-Corning* court found the task of measuring the likelihood of confusion in cases involving colored marks no more complex than in cases involving word marks.¹⁴⁵ Furthermore, the Federal Circuit noted that courts had analyzed variations in shade in the past without apparent difficulty.¹⁴⁶ The circuit court, therefore, found that the shade confusion theory did not bar the registration of OCF's pink mark.¹⁴⁷ The *Owens-Corning* court concluded that the registration of OCF's mark would not defeat the federal policy interests of promoting free competition and effective trademark protection embodied in the color depletion and shade confusion theories.¹⁴⁸ The Federal Circuit, therefore, held that the TTAB clearly erred in refusing registration pursuant to section 1052(f) of the Lanham Act of OCF's nonfunctional, ornamental pink mark as a trademark for OCF home insulation.¹⁴⁹

Despite the majority's holding that OCF pink was protectable as a trademark, the dissent in *Owens-Corning* asserted that the Federal Court should deny registration of the pink mark in light of case precedent, adverse legal consequences, the sufficiency of current judicial protection, federal policy considerations, and insufficient proof of secondary meaning.¹⁵⁰ The dissent first stated that all federal circuit courts confronted with the issue of trademark protection for single color marks had followed the rule that color, when not used in combination with other distinguishing matter, is not protectable as a trademark.¹⁵¹ Additionally, the dissent argued that the Federal Circuit owed a certain degree of deference to the consistent decisions

143. See J. MCCARTHY, *supra* note 10, § 7:16 (if infringement suits involve colored marks, court must determine likelihood of shade confusion); see also *supra* note 3 (discussing likelihood of confusion test for determining infringement liability).

144. See J. MCCARTHY, *supra* note 10, § 7:16 (one reason to ban color appropriation is possibility of shade confusion).

145. *Owens-Corning*, 774 F.2d at 1123.

146. *Id.*; see, e.g., *Wire Rope Corp. v. Secalt S.A.*, 196 U.S.P.Q. (BNA) 312, 315 (T.T.A.B. 1977) (considering whether registered red strand rope was confusingly similar to red and yellow strand rope); *In re Hodes-Lange Corp.*, 167 U.S.P.Q. (BNA) 255, 256 (T.T.A.B. 1970) (brilliant yellow band compared to bronzy-gold band to determine likelihood of confusion); *Youngstown Sheet & Tube Co., v. Tallman Conduit Co.*, 149 U.S.P.Q. (BNA) 656, 657-58 (T.T.A.B. 1966) (gold banded sewer pipe compared to orange banded sewer pipe to determine likelihood of confusion).

147. *Owens-Corning*, 774 F.2d at 1123.

148. See *id.* at 1125 (no public policy exists to prohibit OCF's registration of pink mark under secondary meaning provision of Lanham Act).

149. *Id.* at 1128; see *supra* note 2 (discussing application of clearly erroneous standard of review in trademark litigation).

150. *Owens-Corning*, 774 F.2d at 1128-32 (Bissell, J. dissenting).

151. *Id.* at 1128-29. See *supra* note 10 (listing federal circuits currently adopting view that color alone cannot constitute valid trademark).

of the regional circuits.¹⁵² Since the federal circuits have refused to protect color alone as a trademark, the dissent found no reason for the majority to grant a registration that the regional circuits would not recognize in infringement actions.¹⁵⁵

Furthermore, the dissent noted that the majority's failure to follow the regional circuit courts in denying trademark protection for color would invite forum shopping by trademark registration applicants desiring to protect the use of color as trademark.¹⁵⁶ Aware that the regional circuits do not register marks consisting of color alone, the dissent suggested that applicants would appeal registration denials from the TTAB to the Federal Circuit to obtain favorable judgments.¹⁵⁷ The dissent then asserted that the division between the Federal Circuit court and the regional circuits concerning the color protection issue also would upset the current predictability in trademark law.¹⁵⁸ The dissent noted that predictability in trademark law is important for attorneys in planning for registration and potential litigation, and in advising clients.¹⁵⁹ Additionally, the dissent noted that the current court interpretation of the Lanham Act adequately protected color as trademark.¹⁶⁰ The dissent explained that color was protectable when used in combination with a distinctive design.¹⁶¹ The dissent further reasoned that current federal law prohibits the intentional "palming off" of one's goods for those of another regardless of whether the owner of the goods has a registered mark.¹⁶²

152. *Owens-Corning*, 774 F.2d at 1129 (Bissell, J., dissenting).

153. *Id.* at 1129 n.3. *But see* 15 U.S.C. § 1071(b)(1) (1982) (establishing concurrent jurisdiction between United States Court of Appeals for the Federal Circuit and regional circuit courts on matters of trademark registration).

154. *Owens-Corning*, 774 F.2d at 1129 n.3; *see* U.S.C. § 1114(1) (1982) (establishing civil liability of persons who infringe upon another's registered trademark); *see also* 15 U.S.C. § 1121 (granting jurisdiction of all civil damage suits under chapter to federal courts of appeals other than the Federal Circuit). Although the regional circuit courts have exclusive jurisdiction over matters of trademark infringement, the United States Court of Appeals for the Federal Circuit retains jurisdiction to review appeals from the Patent and Trademark Office, including those appeals from the Trademark Office, including those appeals from the Trademark Trial and Appeal Board (TTAB). S. REP. NO. 275, 97th Cong., 2nd Sess. 1, 2-3, *reprinted in* 1982 U.S. CODE & AD. NEWS 11, 12-13. The Federal Circuit in *Owens-Corning*, therefore, properly exercised the Federal Circuit's jurisdiction in reviewing the TTAB's decision concerning the protectibility of OCF pink.

155. *See supra* note 3 (discussing infringement provision of Lanham Act).

156. *Owens-Corning*, 774 F.2d at 1129 (Bissell, J., dissenting).

157. *Cf. id.* (majority's decision inconsistent with current federal circuit court consensus inevitably will invite forum shopping).

158. *Id.*

159. *See id.* In *In re Owens-Corning Fiberglas Corp.*, the dissent stated that the public had a valuable interest in the consistency and predictability of the law. *Id.*

160. *See id.* at 1129-31 (discussing current protection of colored marks under Lanham Act).

161. *See id.* (discussing current protection of distinctive colored designs under Lanham Act; *see also supra* notes 120-22 and accompanying text (discussing protectible color combinations and designs)).

162. *Owens-Corning*, 774 F.2d at 1130-31; *see* 15 U.S.C. § 1125(a) (1982) (prohibiting use

Moreover, the dissent criticized the majority's consideration of the potential risks of market monopoly and shade confusion as well as the majority's finding that OCF had established the secondary meaning of OCF's pink mark.¹⁶³ The dissent argued that color protection in *Owens-Corning* might create a barrier to lawful, free competition in the home insulation industry.¹⁶⁴ The dissent explained that OCF claimed 75% of the insulation market and dominated the field to such a degree that some buyers would not purchase insulation unless the insulation was pink.¹⁶⁵ The dissent, therefore, concluded that new entrants in the insulation business might be unable to compete if the color pink was unavailable for use.¹⁶⁶ The dissent found the shade confusion theory persuasive in refusing trademark protection of the color pink for reasons of practicality in administering the trademark protection process.¹⁶⁷ The dissent stated that since registration applicants must include black and white drawings of proposed trademarks, including proposed colored marks, a reviewing court would have difficulty in determining the likelihood of confusion among colored marks.¹⁶⁸ Finally, the dissent found that OCF had failed to carry the difficult burden of proving that the OCF pink mark had acquired secondary meaning because OCF failed to state the degree to which OCF advertisements focused on the color pink and because OCF's consumer survey failed to show that consumers associated pink insulation with one source.¹⁶⁹

of false designations of origin and false descriptions of goods in commerce); see also *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 859 n.11 (11th Cir. 1983). In *Brooks Shoe Manufacturing Co. v. Suave Shoe Corp.*, the United States Court of Appeals for the Eleventh Circuit defined "palming off" as the intentional attempt to induce consumers to believe that the deceiving person's product is the product of another. *Brooks*, 716 F.2d at 859 n.11.

163. *Owens-Corning*, 774 F.2d at 1130-32 (Bissell, J. dissenting).

164. *Id.* at 1130.

165. *Id.*

166. *Id.*

167. See *id.* at 1131 (discussing shade confusion rationale); see *supra* notes 143-44 and accompanying text (same).

168. *Owens-Corning*, 774 F.2d at 1131; see 15 U.S.C. § 1051(a)(2) (1982) (registration applicant must submit drawing of mark to Patent and Trademark Office); see also 37 C.F.R. § 2.52(b) (1985) (registration in black pen on white paper). The dissent in *Owens-Corning* implied that a reviewing court would have difficulty in determining the likelihood of confusion among colored marks because the court would have before it only a black and white drawing of the proposed mark. *Owens-Corning*, 774 F.2d at 1131. The Code of Federal Regulations (CFR) provides color designations and a color chart, however, to the TTAB and the Federal Circuit to aid in the resolution of protection issues. 37 C.F.R. § 2.52(e). Furthermore, the TTAB already has decided issues of trademark protection involving color shades. See *Wire Rope Corp. v. Secalt S.A.*, U.S.P.Q. (BNA) 255, 256 (T.T.A.B. 1970) (brilliant yellow band compared to bronzy-gold band to determine likelihood of confusion). The ability of the TTAB and the courts to examine the CFR's color designations and color chart to determine whether to protect a color mark combined with the existence of case precedent resolving the issue of color shade protection suggests that the dissent's concern has little merit.

169. *Owens-Corning*, 774 F.2d at 1131-32; see *Owens-Corning*, 221 U.S.P.Q. at 1199 (discussing Trademark Trial and Appeal Board's criticism of OCF evidence); *supra* notes 57-59 and accompanying text (same).

The majority and the dissent in *In re Owens-Corning Fiberglas Corp.* relied on case precedent to reach different results on whether color alone is protectable as trademark.¹⁷⁰ The majority correctly stated that following the passage of the Lanham Act, courts could and did protect color marks.¹⁷¹ Admittedly, the majority failed to note that courts generally have limited color protection to marks consisting of color in combination with words, designs, or other distinguishing matter.¹⁷² Indeed, courts have protected color marks applied to the entire surfaces of products in very few instances.¹⁷³

Despite the nearly unanimous view against single color protection, the legislative intent behind the Lanham Act and federal policy considerations support the Federal Circuit's decision to protect color alone as trademark.¹⁷⁴ The report by the 1946 Senate Committee on Patents stated that Congress intended to liberalize and, thus, encourage trademark registration through the Lanham Act.¹⁷⁵ In the Senate Committee's view, federal statutes should encourage trademark registration because registration prevents a manufacturer from adopting a mark whose use might cause confusion in commerce.¹⁷⁶ Congress also recognized that trademarks allow the consumer to choose

170. Compare *Owens-Corning*, 774 F.2d at 1118-20 (majority finds color trademarks protectable after Lanham Act) with *id.* at 1128-30 (dissent states that before and after Lanham Act overall color not subject to trademark protection).

171. *Id.* at 1120; see *supra* note 90 and accompanying text (after Lanham Act, color marks subject to trademark registration).

172. Compare *Owens-Corning*, 774 F.2d at 1120 (majority states that contrary to absolute prohibition, courts decide color protection issue case-by-case) with *id.* at 1130 (dissent states that color is protectable only as part of arbitrary design).

173. See *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945) (protecting yellow for taxicabs under secondary meaning doctrine); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc.*, 371 F. Supp. 900, 911 (W.D. Ark. 1974) (yellow paper granted protection under secondary meaning doctrine when used in conjunction with term Yellow Pages); *In re AFA Corp.*, 196 U.S.P.Q. (BNA) 772, 775 (T.T.A.B. 1977) (configuration of overall gold mistmaking machine with black handle granted registration under arbitrary distinctiveness of design test); *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.*, 12 S.W.2d 1098, 1102 (Tex. Civ. App. 1929) (protecting reddish-brown color for wagon covers and tents under doctrine of secondary meaning); see also *supra* notes 71-82 and accompanying text (discussing *Yellow Cab* and *Clifton*).

174. See *infra* notes 175-82 and accompanying text (liberal legislative intent and public policy to foster free competition support single color trademark registration).

175. See *Hearing on S.2679 Before Joint Comm. on Patents*, 68th Cong., 2d Sess. 33, 93 (1925), reprinted in 3 J. GILSON, *TRADEMARK PROTECTION AND PRACTICE* § 2 (1985) (Lanham Act liberalizes registration to encourage trademark registration); 1946 SENATE REPORT, *supra* note 5, at 1274 (purpose of Lanham Act was to liberalize trademark registration); 128 CONG. REG. S.12634 (daily ed. Sept. 29, 1982) (statement of Sen. Hatch) [hereinafter cited as CONG. REC.]. The Congressional Record of September 29, 1982, indicates that before a business adopts a trademark, the business needs reasonable assurance that the business will be able to use the mark uniformly throughout the trading area. CONG. REG., *supra*, at S.12634. The Record further notes that Congress included the registration provision of the Lanham Act to assure businesses that federal courts uniformly would enforce commercial trademark rights. *Id.* In light of Congress' intent to encourage trademark registration, courts should construe liberally the Lanham Act to provide registration to as many marks as possible. *Id.*

176. CONG. REG., *supra* note 175, at S.12633.

effectively between competing articles by enabling the buyer to distinguish between similar goods.¹⁷⁷ Moreover, trademarks encourage the development and maintenance of quality by protecting the supplier's earned good will from misappropriation by competitors.¹⁷⁸ According to the 1946 Senate Report, trademarks do not create monopolies like patents and copyrights.¹⁷⁹ A trademark only gives the trademark owner the right to prohibit the use of the mark to the extent necessary to protect the owner's good reputation.¹⁸⁰ Finally, the 1946 Senate Report concluded that trademarks are the essence of competition.¹⁸¹ The Senate Committee, therefore, implicitly would find the protection of color as trademark consistent with the federal policy of free competition.¹⁸²

If courts were to protect color marks, the question remains concerning which standard among the several available standards courts should use to determine the registrability of color marks.¹⁸³ As a general rule, courts have construed narrowly the functionality doctrine as one standard available to determine whether certain marks are barred from trademark protection.¹⁸⁴ Under a narrow construction of the functionality doctrine courts refuse to protect functional product features because the protection of marks that affect the purpose, performance, or efficiency of products might create barriers to free competition.¹⁸⁵ In *Owens-Corning*, the Federal Circuit stated that the registration of OCF pink would not hinder competition because the mark served no essential or aesthetic function in relation to home insulation.¹⁸⁶ Earlier decisions generally support the Federal Circuit's conclusion that the color pink was not a functional feature of home insulation.¹⁸⁷ In

177. 1946 SENATE REPORT, *supra* note 5, at 1275.

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.*; see CONG. REC., *supra* note 175, at S.12633. The Congressional Record of September 29, 1982, indicates that competition between businesses could not exist without trademarks. CONG. REC., *supra* note 175, at S.12633. The Record explains that competition is socially and economically desirable. *Id.* According to the Record, when market competition exists, the consumer is free to deal with the seller's competitors. *Id.* Similarly, market competition protects the seller from buyer coercion because the seller may sell to other buyers. *Id.* Given the desirability of competition and the trademark's relationship to competition, Congress should promote and protect trademarks. *Cf. id.* See generally M. FRIEDMAN, CAPITALISM AND FREEDOM 14 (1962) (discussing federal policy of free competition).

182. See *supra* notes 175-82 and accompanying text (since all trademarks promote free competition, color trademarks promote free competition).

183. See *infra* notes 185-245 and accompanying text (discussing proper tests for determining registrability of color marks).

184. See *supra* notes 45-50, 105-07, and accompanying text (discussing cases considering trademark protection under functionality doctrine); *infra* notes 189-92 and accompanying text (same). See generally J. MCCARTHY, *supra* note 10, §§ 7:26-7:28 (same).

185. See *supra* note 9 (discussing functionality doctrine).

186. *Owens-Corning*, 774 F.2d at 1122.

187. See *infra* notes 189-99 and accompanying text (distinguishing *Owens-Corning* from cases finding color marks functional).

William R. Warner & Co. v. Eli Lilly & Co.,¹⁸⁸ the United States Supreme Court found that chocolate as an ingredient in a quinine preparation was a functional element because the chocolate functioned to make the quinine taste good.¹⁸⁹ Similarly, the United States Court of Appeals for the Sixth Circuit denied protection to color used on match heads and tips because the coloring distinguished the striking tip from the head of the match.¹⁹⁰ The United States Court of Appeals for the Second Circuit later suggested that the color pink for a stomach remedy might be functional and, thus, unprotectable because of the pink color's psychosomatic effect on consumers.¹⁹¹ By contrast, OCF's use of the color pink on OCF's home insulation does not affect the purpose, performance, or efficiency of the insulation product.¹⁹² Consumers choose home insulation according to product thickness, price, size, and availability, not color.¹⁹³ The *Owens-Corning* court therefore properly held that a narrow interpretation of the functionality doctrine would not preclude the registration of OCF's pink mark.¹⁹⁴

Although the traditional, narrow view of the functionality doctrine generally focuses on product features that are essential or helpful to product performance, some courts also consider functional those marks that are primarily ornamental on the ground that the marks improve the appearance of the goods and, thus, increase the likelihood that consumers will purchase the attractive goods.¹⁹⁵ At least one federal circuit court, however, has criticized the broad interpretation of the functionality doctrine denying protection of performance and aesthetic product features for having a numbing effect on the competitive imagination necessary to create aestheti-

188. 265 U.S. 526 (1924).

189. *Id.* at 531.

190. *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727, 729-30 (6th Cir. 1906).

191. *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572 (2d Cir. 1959), *cert. denied*, 362 U.S. 919 (1960).

192. *See infra* notes 195-96 and accompanying text (color serves no nontrademark function in relation to home insulation).

193. *See* Brief for the Commissioner of Patents and Trademarks at 11-12, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (insulation color is not important to consumer because once installed, insulation is out of sight). *But cf. supra* notes 46-50 and accompanying text (discussing *Deere & Co.*, in which court found color functional because tractor owners matched colored farm machinery).

194. *See supra* notes 185-93 and accompanying text (under narrow view of functionality doctrine OCF pink serves no performance function in relation to insulation). *See also infra* notes 195-98 and accompanying text (discussing broad interpretation of functionality doctrine).

195. *See, e.g.,* *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343-44 (9th Cir. 1952) (floral pattern on china found functional because design was essential selling feature); *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949 (8th Cir. 1941) (rounded bib pocket for overalls held functional because mark contributed substantially to marketability of product); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744 (D. Hawaii 1979) (wavy bottom sole design for shoes held functional because design substantially contributed to shoes, commercial success), *aff'd, mem.*, 652 F.2d 62 (9th Cir. 1981). *See generally supra* note 49 (discussing aesthetic functionality doctrine).

cally pleasing product features.¹⁹⁶ Furthermore, Congress enacted the Lanham Act, in part, to encourage judicial protection of the creativity of market competitors in the development of trademarks.¹⁹⁷ Consequently, although OCF's pink mark arguably enhances the commercial appeal of home insulation, the Federal Circuit properly held that the functionality doctrine did not bar the pink mark's registration.¹⁹⁸

In addition to the limited functionality doctrine, courts apply the ornamentation doctrine in determining the registrability of color marks.¹⁹⁹ Federal circuit court decisions generally support the *Owens-Corning* majority's application of the ornamentation doctrine in finding that an ornamental mark may constitute a valid trademark if the mark's primary purpose is to identify and to distinguish the owner's goods.²⁰⁰ Federal circuit courts, however, disagree concerning whether both the arbitrary distinctiveness of design test and the secondary meaning test are appropriate tests to determine whether ornamental marks perform the necessary trademark functions of identification and distinction.²⁰¹ The registration provision of the Lanham Act suggests

196. See *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 825 (3d Cir. 1981). In *Keene Corp. v. Paraflex Indus., Inc.*, the United States Court of Appeals for the Third Circuit rejected the broad construction of the functionality doctrine that barred the protection of aesthetic product features contributing to the commercial success of products. *Id.* The Third Circuit reasoned that such a broad interpretation of functionality created a disincentive for the development of imaginative, attractive designs. *Id.* The *Keene* court further noted that the broad view of functionality was not necessary to protect the federal policy of free competition. *Id.* The Third Circuit explained that the narrower view of functionality, which focused on whether the design related to the use of the product, sufficiently promoted free competition. *Id.* See generally Note, *supra* note 8, at 372-78 (criticizing broad construction of functionality doctrine for denying business' right to encourage consumer demand for products through aesthetically pleasing product features).

197. See *supra* notes 174-82 and accompanying text (discussing federal policy interests of consumer choice and manufacturer good will).

198. See *supra* notes 192-97 and accompanying text (under proper, narrow view of functionality doctrine, OCF pink serves no performance function in relation to OCF insulation).

199. See *supra* notes 52-56, 114-17 and accompanying text (discussing ornamentation doctrine).

200. See *supra* note 54 (listing cases holding ornamental marks registrable if marks identify and distinguish owner's goods). But see *supra* note 53 (listing cases holding solely ornamental marks unprotectable). See generally J. McCARTHY, *supra* note 10, § 7:6 (discussing protectibility of ornamental marks).

201. See, e.g., *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 827 (C.C.P.A. 1975) (half yellow and half orange fishing floats found unregistrable under arbitrary distinctiveness and secondary meaning tests); *In re Hehr Mfg. Co.*, 279 F.2d 526, 527-28 (C.C.P.A. 1960) (protecting red square window labels under secondary meaning doctrine); *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 409-15 (6th Cir. 1945) (applying secondary meaning test to protect yellow for taxicabs); *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 1189 (W.D. Pa. 1981) (applying secondary meaning test to protect combination of 14 various colors on novel shims); *supra* notes 77-82 and accompanying text (discussing *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*); *supra* note 122 (discussing *In re Hehr Mfg. Co.*) But see, e.g., *Midwest Plastics Corp. v. Protective Closures Co.*, 285 F.2d 747, 750 (10th Cir. 1960) (secondary meaning analysis inappropriate to determine protectibility of red used in combination with shape of product); *Vitarroz Corp. v. River Brand rice Mills, Inc.*,

that both the arbitrary distinctiveness test and the secondary meaning test are applicable when considering the registrability of color marks.²⁰² Section 1052(a)-(e) of the Lanham Act permits the registration of any mark, other than the listed exceptions, that distinguishes the applicant's goods from the goods of others.²⁰³ A color mark does not fall within the exceptions unless the color is confusingly similar to a currently registered mark.²⁰⁴ In addition, section 1052(f) allows the registration of any mark not falling within certain exceptions that has acquired secondary meaning in relation to the applicant's goods.²⁰⁵ Consequently, the secondary meaning test applies to color marks unless the color mark is confusingly similar to a currently registered trademark.²⁰⁶ In light of the absence of overriding policy considerations, the mixed case precedent, and the legislative intent underlying the Lanham Act to grant trademark protection liberally, courts should permit color registration claims under the arbitrary distinctiveness provision of the Lanham Act as well as under the secondary meaning provision.²⁰⁷ The *Owens-Corning* court's application of both the arbitrary distinctiveness test and the secondary meaning test in deciding whether to grant registration of OCF's pink mark, therefore, was appropriate.²⁰⁸

The Federal circuit properly analyzed the facts in *Owens-Corning* under the arbitrary distinctiveness of design test.²⁰⁹ In the rare cases involving the protection of a single color applied to the entire surface of goods, state and federal circuit courts never have granted protection under the arbitrary distinctiveness doctrine.²¹⁰ Moreover, one commentator has suggested that

266 F. Supp. 981, 985 (S.D.N.Y. 1967) (possible secondary meaning of yellow as background color for rice packages found irrelevant because color alone is not subject to appropriation); *In re Shaw*, 184 U.S.P.Q. (BNA) 253, 255 (T.T.A.B. 1974) (denying protection of green suede book covers under arbitrary distinctiveness test without regard to possible secondary meaning); *supra* notes 37-41 and accompanying text (discussing *In re Shaw*).

202. See *infra* notes 203-06 (discussing tests suggested by Lanham Act determining registrability of color).

203. See 15 U.S.C. § 1052(a)-(e) (1982) (providing for registration of inherently distinctive marks, with noted exceptions); see also *supra* note 2 (discussing exceptions of § 1052 of Lanham Act).

204. See 15 U.S.C. § 1052(d) (1982) (mark confusingly similar to registered mark barred from registration).

205. See *id.* § 1052(f) (providing for registration of marks with secondary meaning not excepted by § 1052(a)-(d) of Lanham Act); see *supra* note 2 (discussing § 1052 exceptions).

206. See 15 U.S.C. § 1052(d) (1982) (mark confusingly similar to registered mark barred from registration under inherent and acquired distinctiveness tests).

207. See *supra* notes 174-87, 201-08 and accompanying text (discussing legislative intent, mixed case precedent concerning proper test for resolving color protection issue, and express Lanham Act provisions); see also *infra* notes 237-45 and accompanying text (discussing invalidity of color depletion and shade confusion theories).

208. See *Owens-Corning*, 774 F.2d at 1120, 1123-28 (applying arbitrary distinctiveness and secondary meaning tests); see also *supra* notes 118-37 and accompanying text (discussing Federal Circuit's application of arbitrary distinctiveness and secondary meaning tests in *Owens-Corning*).

209. See *infra* notes 210-13 and accompanying text (case precedent does not support protection of single color applied to product surface under arbitrary distinctiveness test).

210. See *supra* note 173 (discussing rare cases in which courts have protected single color marks).

the required degree of arbitrariness in a design lies between the mere division of a label into two background colors²¹¹ and the application of three colors diagonally, in a barber pole design.²¹² Since OCF applied OCF pink alone uniformly to the surface of OCF home insulation, the pink mark did not fall within the required degree of arbitrariness to warrant protectability under the arbitrary distinctiveness of design test.²¹³ The *Owens-Corning* court, therefore, correctly resorted to the secondary meaning test to determine whether OCF pink constituted a valid trademark.²¹⁴

The Federal Circuit properly applied the secondary meaning doctrine in *Owens-Corning*.²¹⁵ Section 1052(f) of the Lanham Act provides that five years of substantially exclusive and continuous use of a mark in commerce by the applicant constitutes a rebuttable presumption of secondary meaning.²¹⁶ Admittedly, despite the minimal five year legislative presumption, some courts have placed heavier evidentiary burdens on applicants alleging secondary meaning.²¹⁷ For example, in *Plastilite Corp. v. Kassnar Imports*,²¹⁸ the United States Court of Customs and Patent Appeals disregarded the presumption of secondary meaning created by Plastilite Corp.'s exclusive seven year use of yellow and orange for fishing floats.²¹⁹ On the other hand, some courts have found that in rare cases the exclusive and continuous use

211. J. MCCARTHY, *supra* note 10, § 7:17; see *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798 (3d Cir.) (mere division of label into red and white found not arbitrary or distinct), *cert. denied*, 338 U.S. 847 (1949).

212. J. MCCARTHY *supra* note 10, § 7:17; see *Barbasol Co. v. Jacobs*, 160 F.2d 336, 338-39 (7th Cir. 1947) (protecting red, white, and blue barber pole design for shaving cream box under doctrine of arbitrary, distinctive design).

213. See *supra* notes 211-12 and accompanying text (design must be more arbitrary than the two background colors to be arbitrarily distinctive in design); see also *supra* note 36 and accompanying text (defining arbitrary, distinctive design).

214. See *Owens-Corning*, 774 F.2d at 1124-28 (analyzing *Owens-Corning* facts under secondary meaning test).

215. See *infra* notes 216-33 and accompanying text (in light of Lanham Act, legislative history of Lanham Act, and case precedent, OCF established pink mark's secondary meaning in *Owens-Corning*).

216. 15 U.S.C. § 1052(f) (1982); see J. MCCARTHY, *supra* note 10 § 15:20 (discussing Lanham Act's arbitrary five-year presumption of secondary meaning).

217. See, e.g., *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 797 (5th Cir. 1983) (commercial use of "Chick-Kri" for food product for fifteen years insufficient to establish secondary meaning); *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824 (C.C.P.A. 1975) (commercial use of colored fishing floats for eight years held insufficient proof of secondary meaning); *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir.) (continuous use of "Alo" for skin products for seventeen years failed to prove secondary meaning), *cert. denied*, 398 U.S. 928 (1970); *In re Synergistics Research Corp.*, 218 U.S.P.Q. (BNA) 165, 167 (T.T.A.B. 1983) (five years use alone held insufficient to prove secondary meaning). But see *Wesley-Jessen Div. v. Bausch & Lomb, Inc.*, 698 F.2d 862, 867 (7th Cir. 1983) (continuous use of "U3" designation for six years and "U4" designation for four years for contact lenses held indicative of secondary meaning).

218. 508 F.2d 824 (C.C.P.A. 1975).

219. See *id.* at 824, 827 (denying protection under secondary meaning doctrine despite seven year use because plaintiff did not direct advertisements toward consumer).

of a mark for less than five years may be sufficient to establish secondary meaning.²²⁰ For example, in *Barton v. Rex-Oil Co.*,²²¹ the United States Court of Appeals for the Third Circuit held that the term "Dyanshine" had acquired secondary meaning within only three years due to extensive sales, advertising, and unusual circumstances.²²² In *Owens-Corning*, by comparison, OCF exclusively and continuously used OCF's pink mark for 29 years.²²³ Given that several courts have granted trademark protection of marks used only for three years or less²²⁴ and that the Lanham Act provides a presumption of secondary meaning after only five years of continuous use, OCF's use of the mark for 29 years fell within the permissible range necessary to establish secondary meaning.²²⁵

Though the Lanham Act focuses on the exclusive and continuous use of a mark in commerce as evidence of secondary meaning, courts also have relied on consumer surveys to prove that the use and advertisement of a mark has created an association between the mark and a particular product source.²²⁶ One commentator has suggested that the appropriate survey to

220. See, e.g., *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538, 544 (2d Cir. 1956) (secondary meaning of "Maternally Yours" established in eleven months through extensive advertising); *Barton v. Rex-Oil Co.*, 2 F.2d 402, 405 (3d Cir. 1924) (three years use of "Dyanshine" for shoe polish, and extensive sales and advertising held sufficient to prove secondary meaning); *Fund of Funds, Ltd. v. First Am. Fund of Funds, Inc.*, 274 F. Supp. 517, 524-25 (S.D.N.Y. 1967) (extensive sales and promotion of "Fund of Funds" over three years found to establish secondary meaning). See generally J. GILSON, *supra* note 2, § 2.09[1][4] (discussing length of use as evidence of secondary meaning).

221. 2 F.2d 402 (3d cir. 1924).

222. See *id.* at 404-05. In *Barton v. Rex-Oil Co.*, Barton's sales of Dyanshine shoe polish increased from 1,198,600 bottles in 1919 to 3,485,000 bottles in 1922. *Id.* at 405. The great increase in sales in only three years was the result of Barton's proximity to Camp McArthur where the Dyanshine name quickly became popular among the camp's troops. *Id.* at 404. The United States Court of Appeals for the Third Circuit found that in light of the unusual circumstances, Barton's Dyanshine mark had acquired secondary meaning. *Id.* at 405.

223. See *Owens-Corning*, 774 F.2d at 1125 (OCF has right to benefits of 29 years of pink use).

224. See *supra* notes 220-22 and accompanying text (discussing cases finding secondary meaning established by continuous use for three years or less).

225. See 15 U.S.C. § 1052(f) (1982) (providing five year presumption of secondary meaning). See also J. GILSON, *supra* note 2, § 2.09[1](4) (generally, longer manufacturer uses mark, greater chance secondary meaning will attach to mark); *supra* notes 217-22 and accompanying text (discussing range in years of use found indicative of secondary meaning in federal courts).

226. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (question in secondary meaning analysis is not extent but effectiveness of advertising); *Aloe Creme Laboratories, Inc. v. Milsan*, 423 F.2d 843, 850 (5th Cir. 1970) (same); J. GILSON, *supra* note 2, § 2.09[1](2) (valid consumer survey may be best direct evidence of secondary meaning); *Palladino, Techniques for Ascertaining If There Is Secondary Meaning*, 73 TRADE-MARK REP. 391, 395 (1983) (survey designed to test for secondary meaning should measure level of association between claimed trademark and plaintiff's product); *supra* note 129 (citing cases focusing on surveys as evidence of secondary meaning); see also *supra* note 26 (defining secondary meaning as association between mark and product source). But see *American Scientific Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 793-94 (9th Cir. 1982) (lack of consumer

determine secondary meaning asks two questions.²²⁷ The first question is whether the interviewee associates the claimed trademark with one or more than one company.²²⁸ If the interviewee associates the mark with only one company, the next question asks the interviewee to identify the one company.²²⁹ According to one commentator, surveys should not include persons, such as retailers, who are not members of the ultimate purchasing public.²³⁰ In addition, a valid survey must not ask interviewees leading questions that suggest only the desired response.²³¹ In *Owens-Corning*, the survey appropriately involved the ultimate purchasers of home insulation.²³² As stated by the dissent, however, the OCF single survey question encouraged interviewees to respond with only one company name, thus inhibiting multiple responses.²³³ The OCF survey, therefore, had questionable probative value.²³⁴ Nevertheless, the registration provision of the Lanham Act, as well as Congress' goal of liberalizing and promoting trademark registration, support

survey evidence does not defeat protection under secondary meaning analysis when trademark owner shows continuous use in small market, advertisement of mark, and actual consumer confusion).

227. See Article, *supra* note 226, at 397-99 (noting sample survey questions to determine secondary meaning).

228. *Id.* at 397.

229. *Id.*

230. J. GILSON, *supra* note 2, § 2.09[1](2); see Sorensen, *Survey Research Execution in Trademark Litigation: Does Practice Make Perfect?*, 73 TRADE-MARK REP. 349, 354 (1983) (survey population should include persons whose attitudes are in dispute) [hereinafter cited as Sorensen]; see also *supra* notes 16-18 and accompanying text (secondary meaning is consumer association between mark and source of goods). See generally, Reiner, *The Universe and Sample: How Good is Good Enough?*, 73 TRADE-MARK REP. 366, 366-75 (1983) (concluding that survey population in trademark litigation must consist of potential buyers) [hereinafter cited as Reiner].

231. See Sorensen, *supra* note 230, at 356-59. One commentator has suggested that a biased survey does not measure what the survey purports to measure. *Id.* at 356-57. The commentator lists ways in which the surveyor may introduce bias into survey research. *Id.* at 357-58. The surveyor may ask questions that presume that interviewees know or should know the answers. *Id.* at 358. Additionally, the surveyor may produce bias survey results by asking leading questions to signal desired responses. *Id.* For example, to determine the likelihood of confusion among similar marks, the surveyor might ask the question, "Do you confuse this mark with another?" *Id.* at 357. Such a leading question produces bias by coaxing the interviewee to give the desired rather than the true response. *Id.* at 358.

232. See *Owens-Corning*, 221 U.S.P.Q. at 1199 (survey population included only male homeowners because female homeowners showed little intent to purchase insulation).

233. *Owens-Corning*, 774 F.2d at 1131; see *id.* at 1127 (survey asked: "... what manufacturer makes pink insulation?").

234. See Palladino, *supra* note 226, at 402; see also note 226 and accompanying text (results of survey ascertaining secondary meaning must show association between mark and single source). One commentator has suggested that the survey results in *Owens-Corning* would have fallen in the permissible range of buyer association between trademark and product origin had the surveyor asked the appropriate questions. See Palladino, *supra* note 226 at 402. The commentator stated that courts generally find secondary meaning when more than 50% of those interviewed associate the trademark in question with the product source. *Id.* The commentator noted, however, that courts have accepted as little as 42% buyer association and denied as much as 61% buyer association in determining secondary meaning. *Id.*

the protection of OCF's long established and continuous use of OCF's pink mark.²³⁵ The Federal Circuit majority in *Owens-Corning*, therefore, correctly applied the secondary meaning test to grant registration of pink for OCF fibrous glass insulation.²³⁶

The Federal Circuit's registration of OCF pink does not undermine the federal policy interests of competition and effective trademark protection embodied in the color depletion and shade confusion theories.²³⁷ Under the infringement and false description provisions of the Lanham Act, courts may protect an owner's use of a mark only to the extent necessary to avoid consumer confusion.²³⁸ The color depletion theory, which attempts to prevent the inappropriate trademark protection that produces market monopoly,²³⁹ is valid only if courts protect an owner's use of a mark consisting of a primary color.²⁴⁰ If courts instead recognize the limitless variations of color hue, saturation, and brightness, the possibility of color depletion through color trademark appropriation is remote.²⁴¹ The shade confusion theory, likewise, fails to override the benefits of color protection.²⁴² As noted by the TTAB and by the Federal Circuit in *In re Owens-Corning Fiberglas Corp.*, shade confusion questions are no more difficult to resolve than the routinely presented questions in trademark litigation of similarity in sound, appearance, and meaning.²⁴³ In fact, courts

235. See *supra* notes 175-82 and accompanying text (legislative history of Lanham Act reflects congressional intent to liberalize and to encourage trademark protection); see also *supra* note 216 and accompanying text (discussing Lanham Act's five year presumption of secondary meaning).

236. Cf. *supra* notes 174-82, 216-25 and accompanying text (legislative intent, Lanham Act's secondary meaning provisions, and case precedent supported Federal Circuit's finding of secondary meaning in *In re Owens-Corning Fiberglas Corp.*).

237. See *infra* notes 238-45 and accompanying text (discussing limited validity of color depletion theory and invalidity of shade confusion theory).

238. See 15 U.S.C. § 1114 (1982) (providing remedy for infringement); *id.* § 1125 (establishing liability for use of false origin designations or false descriptions in connection with goods in commerce); see also *supra* note 3 (discussing protection of trademark from competitor's use of deceptively similar mark).

239. See *supra* notes 66-68 and accompanying text (discussing color depletion theory).

240. *Cooper*, *supra* note 67, at 23; see *id.* at 26. One commentator has stated that only six primary colors exist. *Id.* at 26. According to the commentator, the primary colors are red, yellow, green, blue, violet, orange, and indigo. *Id.*

241. See *id.* at 24. According to one commentator, slight variations in a color's hue, saturation, or brightness greatly increases the pool of colors available for a manufacturer's use. *Id.* The commentator defines a hue as a basic color sensation, and brightness as the amount of white in a color tint. *Id.* at 23 n.81. The commentator also explained that saturation is the strength of a hue compared to neutral gray. *Id.*

242. See *infra* notes 243-44 (attacking validity of shade confusion theory); see *supra* notes 142-47 (discussing shade confusion theory).

243. See *Owens-Corning*, 774 F.2d at 1123 (deciding likelihood of confusion among color shades no more subtle than when word mark involved); *Owens-Corning*, 221 U.S.P.Q. at 1198 (same); *Cooper*, *supra* note 67, at 24 (same); see also, e.g., *G.S. Searle & Co. v. Charles Pfizer & Co.*, 265 F.2d 385, 387-89 (7th Cir.) ("dramamine" and "bonamine" found acoustically similar), *cert. denied*, 361 U.S. 819 (1959); *Upjohn Co. v. Schwartz*, 246 F.2d 254, 262 (2d Cir. 1957) ("syracol" and "cheracol" held not acoustically similar); *Hancock v. Am. Steel & Wire Co.*, 203 F.2d 737, 740 (C.C.P.A. 1953) ("tornado" and "cyclone" found similar in meaning).

already have addressed the likelihood of color confusion in the market without apparent difficulty.²⁴⁴ The Federal Circuit, therefore, correctly found that the federal policies to promote free competition and effective trademark protection do not require the rejection of color alone as a trademark.²⁴⁵

The Federal Circuit's protection of a single overall color mark will have a significant effect on the use of color trademarks to identify goods and to distinguish the goods from the goods of market competitors.²⁴⁶ The Federal Circuit's case-by-case approach to secondary meaning, however, creates no clear standard for proving secondary meaning.²⁴⁷ Consequently, manufacturers planning to adopt a new single color trademark will remain uncertain concerning how to ensure trademark protection after *Owens-Corning*.²⁴⁸ Despite the Federal Circuit's failure to establish a clear standard by which to measure the protectability of color marks, the Federal Circuit implicitly has alerted manufacturers to the necessity of maintaining comprehensive records to show the manufacturer's use of the mark, expenditures on advertising, and the success of advertising in the form of consumer surveys.²⁴⁹

Manufacturers, uncertain how to create protectable color trademarks after *Owens-Corning*, also may look to the general guidelines that have developed in case law prior to the *Owens-Corning* decision concerning the protection of color marks.²⁵⁰ For example, color that affects the purpose, performance, or efficiency of a product cannot constitute a valid trademark for the product.²⁵¹ Furthermore, color is unprotectable if the color's primary function is only to decorate or to embellish the good's external appearance.²⁵² As a general rule, courts protect color only when the manufacturer uses the color as an element of a distinctive design or in combination with words, symbols, or other distinguishing matter.²⁵³ In addition, since color marks

244. Article, *supra* note 67, at 24; see *supra* note 146 (listing cases involving shade confusion).

245. See *Owens-Corning*, 774 F.2d at 1122-24 (rejecting color depletion and shade confusion theories); see also *supra* notes 138-48 and accompanying text (discussing *Owens-Corning* court's rejection of color depletion and shade confusion theories).

246. See *infra* notes 247-60 and accompanying text (Federal Circuit's registration of OCF pink mark encourages the risktaker to adopt single color trademark); see also Lehrer, *Pink is Taken; But a Few Hues Are Still Left*, Wall St. J., Jan. 14, 1986, at 33, col. 3 (holding in *re Owens-Corning Fiberglas Corp.* will encourage consistent use of color in package design).

247. See *Owens-Corning*, 774 F.2d at 1125 (kind and amount of evidence needed to prove secondary meaning depends on particular circumstances).

248. Cf. *id.* (*Owens-Corning* court holds that kind and amount of evidence needed to prove secondary meaning depends on particular circumstances).

249. See *id.* at 1124-28 (discussing OCF's substantial evidence of secondary meaning); see also *supra* notes 20-26, 124-37 and accompanying text (same).

250. See *infra* notes 251-57 and accompanying text (stating general guidelines concerning protectability of color as trademark).

251. See *supra* notes 44-51, 105-12, 185-99 and accompanying text (discussing functionality doctrine).

252. See *supra* notes 52-54, 113-17, 200 and accompanying text (discussing ornamentation doctrine).

253. See *supra* notes 10, 34-43, 118-23, 209-13 and accompanying text (discussing doctrine of arbitrary distinctiveness of design).

may not convey trademark meaning immediately to the consumer, the manufacturer always should prepare to establish the mark's secondary meaning.²⁵⁴ Proof of secondary meaning requires at least three years of substantially exclusive and continuous use in commerce.²⁵⁵ In assessing secondary meaning, courts also rely heavily on consumer directed advertising expenditures in the range of 112 thousand dollars to three million dollars, preferably focused on the mark itself rather than the product.²⁵⁶ Furthermore, consumer surveys are highly probative of secondary meaning when the survey results show that more than fifty percent of those interviewed associate the color mark with a single source.²⁵⁷ In light of the near unanimity in judicial opposition to single color protection and very strict requirements in proving the protectability of all color marks, a manufacturer's adoption of a single color mark is a risky strategy.²⁵⁸ The manufacturer must weigh the costly risk against the substantial benefits of colorful goods, namely, consumer attraction and a potential increase in sales.²⁵⁹ The Federal Circuit decision in *In re Owens-Corning Fiberglas Corp.*, therefore, opens the door for the willing risktaker to colorful competition.²⁶⁰

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254. See *supra* notes 10-18, 124-37, 215-36 and accompanying text (discussing doctrine of secondary meaning).

255. See *supra* notes 125-28, 216-25 and accompanying text (discussing exclusive and continuous use of trademark as evidence of secondary meaning).

256. Cf. *supra* notes 132-33 and accompanying text (discussing general advertising expenditures as evidence of secondary meaning).

257. See *supra* notes 135-36, 226-34 and accompanying text (discussing use of consumer surveys to establish secondary meaning). See generally *Palladino*, *supra* note 226, at 401-02 (discussing level of association necessary to establish secondary meaning).

258. See *supra* notes 250-57 and accompanying text (discussing federal circuit prevailing new and general requirements concerning color protection).

259. See *supra* note 8 and accompanying text (color is effective marketing tool); see also *supra* note 6 (discussing trademark advertising function).

260. See *supra* note 10 (Federal Circuit only circuit court currently protecting overall product color as trademark); *supra* note 8 and accompanying text (color is effective marketing tool); *supra* notes 250-57 and accompanying text (discussing strict requirements for ensuring trademark protection of color).

