

## GUEST OPINION

# Have You Trademarked Your Product's Color?

By Lawrence Savell

**P**roduct designers and marketers know that a product's color alone often can effectively distinguish it from its competitors. But did you ever consider that a product's distinctive color could be trademarked? According to some courts, maybe you should.

In the most recent decision on this issue, *Master Distributors, Inc., v. Pako Corp. and Pakor, Inc.*, the Eighth Circuit Court of Appeals on Feb. 17 ruled that under certain circumstances a product's color could be trademarked.

MDI manufactured and sold "Blue Max," a leader splicing tape that is used in photoprocessing. Leader splicing tape traditionally had been black. MDI dyed its Blue Max tape blue. Blue Max went on to become the industry standard. Distributors and customers apparently ordered the brand by asking for "the blue tape" or simply "blue."

Pakor came out with its own blue leader tape, which it called Pakor Blue. MDI sued, alleging among other claims infringement of its trademark on the color blue.

A lower court ruled in Pakor's favor. MDI appealed. The Court of Appeals ruled for MDI, reversed the lower court and sent the case back to the lower court.

The Court of Appeals reviewed the modern federal appellate cases addressing whether color could be protected as a trademark. In 1985, the Federal Circuit in *In re: Owens-Corning Fiberglass Corp.* allowed Owens-Corning to register the color pink as a trademark for its fibrous glass insulation. Owens-Corning had made the color a central part of its positioning, from the color of its insulation down to using the Pink Panther animated character in its ads.

However, in 1990, the Seventh Circuit,

in *NutraSweet v. Stadt Corp.* ruled that color alone could not be protected. It decided against the manufacturer of a sugar substitute packaged in a blue, single-serve packet who sued to stop another firm from packaging its sugar substitute in a blue, single-serve packet.

Among the reasons given were: (1) protecting color as a trademark would prejudice companies relying on

**It's worked, so far,  
for Blue Max leader  
tape. And the Blue  
Max ruling could help  
you in the battle to  
defend your brand.**

prior law; (2) color already could be protected if used in connection with a symbol or design; and (3) "color depletion" (which supposedly would occur as the colors of the spectrum were used and protected) would deter new entrants in the tabletop sweetener market.

The MDI court followed the lead of *Owens-Corning* instead of *NutraSweet*.

First, on the issue of color depletion, the court agreed that allowing a manufacturer to monopolize a color "in all of its shades" would deplete the color choices available to other market participants. But it ruled that allowing one to protect a specific shade was another matter. The court observed that hundreds of distinctive colors and shades have been recognized.

Moreover, a manufacturer's use of a color would not automatically grant it

proprietary rights, since it still had to establish the usual requirements for trademark protection, including "secondary meaning." Secondary meaning is a legal concept meaning that through advertising or other techniques a feature such as color has gained secondary meaning linking the product to a specific manufacturer in the consumer's mind. For example, it is logical for MDI to argue blue gained secondary meaning for Blue Max.

Until secondary meaning had been established for every distinguishable shade of color—"a highly improbable situation"—options always would be available to new entrants, the court said.

Second, the court rejected a "shade confusion" argument, concluding that deciding likelihood of confusion among color shades would be no more difficult than confusion among word marks.

Third, the court addressed "the functionality doctrine," which provides that if a feature such as a color is essential to the utility of or is a natural attribute of a product, no one may acquire exclusive trademark rights to that feature. In the case at hand, MDI could be expected to argue that blue was not a functional feature.

The court concluded the functionality doctrine was not inconsistent with protection of some color trademarks, since if in a particular case the color did serve a primarily utilitarian purpose, it would not qualify for protection as a trademark.

The federal court split between the *MDI/Owens-Corning* and *Nutrasweet* decisions suggests the U.S. Supreme Court ultimately will have to decide whether a product's color may qualify for trademark protection. For now, product designers and marketers at least should be aware of the possibility that a product's distinctive color may be a property right that a court will protect, allowing its owner the exclusive right to have it, so to speak, "made in the shade." ■